
USER ASSOCIATIONS SURVEY

Response ID

84

Basic Data

Please indicate the User Association you represent:

International Trademark Association

Please indicate your name and email address:
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<i>(In case clarification is needed regarding any of your answers)</i>
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Hélène Nicora, hnicora@inta.org

Three-dimensional marks, sound marks, motion marks, multimedia marks and hologram marks

1. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised? [Three-dimensional marks]
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No [A2]

1. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised? [Sound marks]
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No [A2]

1. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised? [Motion marks]

No [A2]

1. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised? [Multimedia marks]

No [A2]

1. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised? [Hologram marks]

No [A2]

1.a What are the main problems that you face because of the divergence of practices in the EU IP Offices regarding these types of marks?

(In case your answer was 'No' or 'I don't know' in question 1)

3D marks are more harmonized but there are still differing assessment criteria among national offices. E.g. in Spain: There is no harmonization for motion marks, multimedia marks, hologram marks (all of which are not even admitted by the Spanish Office) and for 3D marks. Sound marks are harmonized (but only when a sonogram was admitted).

Clarifications are needed to increase legal certainty: there are differing requirements for different types of marks. For instance, there is a certain level of protection in most EU countries for 3D packaging marks and single colour marks. There is however no adequate registration or protection in most jurisdictions for smell and taste marks.

Sometimes, an applicant can obtain a EUTM for a nontraditional mark but experiences difficulty to obtain such mark at national level when national registration is needed, and vice-versa. This may be explained by the difference of criteria to consider application for nontraditional marks, or by the time needed by different offices to adopt new criteria. For instance, EUIPO may apply a stricter approach regarding 3D marks than the Italian office in evaluating absolute grounds, and in particular distinctiveness of the sign.

The absence of consistent regulation of trademark rights among jurisdictions threatens principles of legal certainty and legitimate expectations of rights protection. An applicant can never be sure whether a certain type of mark is acceptable by the local EU IP Office and, even if it is, in what form that mark should be applied for, and whether its scope of protection would be the same in different EU Member states. This constitutes an issue for businesses' global strategies.

To be truly harmonized there must be a common infrastructure in place within all EU IP Offices as well as an effective monitoring system which grades compliance in accordance with agreed Common Practices.

1.b Do you think that agreeing on a Common Practice among the EU IP Offices regarding these types of marks would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 1)

Yes [A1]

1.b Do you think that agreeing on a Common Practice among the EU IP Offices regarding these types of marks would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 1)

[Comment]

INTA believes that a three-dimensional shape, a sound that is connected with a product or service, a color, whether a combination of colors or a single color and a properly defined touch characteristic that is distinctive in relation to a product or service may function as a trademark or service mark and, therefore, in appropriate circumstances, should be entitled to trademark recognition, protection and registration (see INTA Board Resolutions of November 20, 1996, February 25, 1997, May 7, 1997 and November 8, 2006). It is also the position of INTA that smell, taste, or touch marks should be registrable where these satisfy the criteria described in INTA's "Model Law Guidelines" as revised in 2007.

Agreeing on a Common Practice would increase legal certainty. It would be most useful for trademark users, as it would provide a concrete standard for implementing a harmonized and uniform practice. It would also prevent "forum shopping" and benefits users not only for claiming priority but also for enforcing their rights at a local level. It would also be useful for trademark owners who have a particular reputation in their mark in particular countries which would allow them to collate acquired distinctiveness evidence.

However, the Common Practice should follow a liberal approach, be flexible as new technologies develop. Borderline cases should be decided by the courts.

2. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice regarding these types of marks?

One should take into account:

- the various practical guidelines used in examination,
 - the examiners' approach in evaluating absolute grounds,
 - the position/trend of an Office -especially if in use for extended periods or enshrined in their national legislation,
 - the inherent cultural differences.
 - In addition, the differences of IT infrastructures and the need to ensure that the Common Practices are achievable by all offices is a significant difficulty.
- An agreement on the basic standards should be reached.

Position marks, pattern marks, colour per-se marks and tracer marks

3. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised?

[Position marks]

No [A2]

3. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised?

[Pattern marks]

No [A2]

3. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised?

[Colour per-se marks]

No [A2]

3. Do you think that the practices of the EU IP Offices regarding the following types of marks are harmonised?

[Tracer marks]

No [A2]

3.a What are the main problems that you face because of the divergence of practices in the EU IP Offices regarding these types of marks?

(In case your answer was 'No' or 'I don't know' in question 3)

For instance:

Spain: there is no harmonization for position marks, pattern marks, and tracer marks (they are not even admitted by the Office). Colour per se marks are harmonized.
UK: there is harmonization for position marks, but not for pattern, colour and tracer marks.
Italy: there is no harmonization in respect of all types of marks.

Different national practices for different types of marks create uncertainty in the users' rights. For instance, in Italy, there were different decisions taken, resulting in different outcomes and thus different protection of trademarks. See also INTA's response to question 1a.

Particular difficulties are faced in respect of block colour filings or abstract colour filings. Office practice on acceptance and requirements for acceptance vary significantly from accepted representation, form of description to threshold for securing registrability (e.g. via acquired distinctiveness). For instance, Latvia accepts colour & colour combination trademark registration but requires distinctiveness, whereas Portugal prohibits their registration.

The divergence of requirements and lack of legal certainty and consistency is time-consuming, costly, difficult to navigate and inefficient for trademark users. It also creates barriers and issues when dealing with a global portfolio of trademarks.

3.b Do you think that agreeing on a Common Practice among the EU IP Offices regarding these types of marks would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 3)

Yes [A1]

3.b Do you think that agreeing on a Common Practice among the EU IP Offices regarding these types of marks would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 3)

[Comment]

Please refer to answer for question 1b.

4. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice regarding these types of marks?

One should take into account the various approaches of examiners in evaluating absolute grounds, the position/trend of an Office -especially if in use for extended periods or enshrined in their national legislation and the inherent cultural differences.

In addition, the differences of IT infrastructures and the need to ensure that the Common Practices are achievable by all offices is a significant difficulty.

However, less difficulties are envisaged with respect to these types of marks.

Technical solutions for filing and searching 3D, sound, motion, multimedia and hologram marks

5. Do you think that the technical requirements established by the EU IP Offices for filing the following types of marks are harmonised? [Three-dimensional marks]

No [A2]

5. Do you think that the technical requirements established by the EU IP Offices for filing the following types of marks are harmonised? [Multimedia marks]

No [A2]

5. Do you think that the technical requirements established by the EU IP Offices for filing the following types of marks are harmonised? [Motion marks]

No [A2]

5. Do you think that the technical requirements established by the EU IP Offices for filing the following types of marks are harmonised? [Sound marks]

No [A2]

5. Do you think that the technical requirements established by the EU IP Offices for filing the following types of marks are harmonised? [Hologram marks]

No [A2]

5.a What are the main problems that you face because of the different technical requirements established by the EU IP Offices for filing these types of marks?

(In case your answer was 'No' or 'I don't know' in question 5)

There are different parameters for different countries. It is more complicated to search, clear and to file this kind of mark. There are divergences in:

- online filing system,
- types of size of electronic files it is possible to use for filing
- required formats of representation
- access to registers for searches
- Requirements and procedures...

All these differences result in legal uncertainty as to the trademark registration and scope of protection in different jurisdictions. They are time-consuming and costly to the applicant.

E.g.: the Spanish perspective: the Spanish Patent and Trademark office will need to implement technical developments for accepting applications and make the content available to the public. For instance the official form in Spain contains a box to tick when filing 3D or sound trademarks. However the official E-form does not offer the possibility to select a box for filing other nontraditional trademarks; the applicant is forced to choose between traditional marks (otherwise you are not able to file the e-form). Furthermore the type of computer file to submit images is very limited. The official form to be submitted in person contains a box where the applicant claims that his sign is an "OTHER" type of trademarks, but then he needs to bring the images claimed in a separate document (no other type of representation is admitted).

5.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 5)

Yes [A1]

5.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 5)

[Comment]

This would lead to certainty, consistency and therefore ease of use.

6. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice in this area?

Yes. One should take into account the various approaches of examiners in evaluating absolute grounds, the position/trend of an Office -especially if in use for extended periods or enshrined in their national legislation and the inherent cultural differences.

In addition, the differences of IT infrastructures and the need to ensure that the Common Practices are achievable by all offices is a significant difficulty.

Not all IP Offices are equipped to handle multimedia or hologram marks. Changes to IT would be required to ensure consistency.

Three-dimensional trade marks containing verbal and/or figurative elements

7. Do you think that the practices of the EU IP Offices regarding **three-dimensional trade marks containing verbal and/or figurative elements** are harmonised?

No [A2]

7.a What are the main problems that you face because of the divergence of practices in the EU IP Offices in this area?

(In case your answer was 'No' or 'I don't know' in question 7)

For e.g., in the UK, examination practice is similar but there are divergences on technical matters (such as the types of file) and the scope of protection.

INTA recognizes that these types of mark may serve as a trademarks and, therefore, in appropriate circumstances, should be entitled to be registered as trademarks (Board Resolution May 7, 1997 3D trademarks).

The same mark can be accepted in some countries but refused in other countries.

There are high thresholds of examination of distinctiveness for 3D marks and inconsistent examination practice amongst national offices. However, there is a natural reluctance to encourage the automatic rejection or high distinctiveness threshold for 3D marks.

The absence of consistent regulation of trademark rights among jurisdictions threatens principles of legal certainty and legitimate expectations of rights protection. Users experience inconsistency, uncertainty and additional costs and a lack of faith in the trademark system in general.

7.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 7)

Yes [A1]

7.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 7)

[Comment]

We acknowledge that this would be a difficult exercise given the many different types of marks which would be caught by this heading.

8. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice in this area?

Yes, see answer to question 1a. It will be very hard to be fully comprehensive, and since IT infrastructures change, it will be necessary to ensure that the Common Practices take this into account. Regular assessments and updates may be necessary to ensure success. Also, there are jurisdictions like Spain where there is not unanimous case law/jurisprudence.

Impact of dominant components when assessing likelihood of confusion

9. Do you think that the practices of the EU IP Offices regarding the **impact of dominant components when assessing likelihood of confusion** are harmonised?

No [A2]

9.a What are the main problems that you face because of the divergence of practices in the EU IP Offices in this area?

(In case your answer was 'No' or 'I don't know' in question 9)

Not every aspect is harmonized.

Conflicting decisions can be obtained when enforcing a trademark owners' rights.

9.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 9)

Yes [A1]

9.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 9)

[Comment]

When enforcing rights, it would be beneficial to know that all the offices apply the same criteria. This would improve legal certainty.

10. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice in this area?

There is also a need to leave space for a case-by-case assessment. Probably the best approach would be offering a broad range of clear examples.

Generic or misleading marks as different grounds for revocation

11. Do you think that the practices of the EU IP Offices regarding **generic or misleading marks as different grounds for revocation** are harmonised? [Generic marks]

No [2]

11. Do you think that the practices of the EU IP Offices regarding **generic or misleading marks as different grounds for revocation** are harmonised? [Misleading marks]

No [2]

11.a What are the main problems that you face because of the divergence of practices in the EU IP Offices in this area?

(In case your answer was 'No' or 'I don't know' in question 11)

The main divergences and problematic aspects are:

- Language and generic words. To what extent words in other languages are understandable? What type of evidence needs to be submitted to show that they are generic or not?
- Interpretation of distinctiveness. Variations on threshold make weak distinctive character levels vary.
- Criteria to evaluate misleading marks still differ.
- Regulatory issues (e.g. an application for a sign that cannot be used afterwards due to specific sectorial regulation).
- Generic and descriptive signs and signs that are usually used and are admissible by certain sectors such as cosmetics, pharmaceuticals, banks, insurances, newspapers...etc.

11.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 11)

Yes [A1]

11.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 11)

[Comment]

12. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice in this area?

The Common practice should in any case leave room to take into account local consumers, as they are one of the most important criteria to determine when a trademark is misleading.

Collective marks

13. Do you think that the practices of the EU IP Offices regarding the **collective marks** are harmonised?

No [2]

13.a What are the main problems that you face because of the divergence of practices in the EU IP Offices in this area?

(In case your answer was 'No' or 'I don't know' in question 13)

Although EUIPO registers collective marks, only 21 of the 28 EU Member states (at last count) do so at the national level.

Unlike standard trademark law for goods and services in each Member state which is fairly harmonized with the EU trademark (EUTM), the collective mark requirements (e.g., what is required to prove the existence of a collective body, classification problems, etc.) are not. In addition, by creating gaps at the national level, there is an imbalance between EU level and national protection, as well as between Member states.

In addition, not all regulations governing the use of collective trademarks are easily accessible. For instance, in the Benelux, they are not accessible online contrary to other jurisdictions or the EUIPO.

13.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 13)

Yes [A1]

13.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 13)

[Comment]

14. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice in this area?

National law concerning collective marks and certification marks vary substantially; finding a common practice will not be an easy and prompt project.

There will be a need for education for Member states which are not currently registering collective marks as to their function and their benefits. For example, owners of geographical indications (GIs) may wish to supplement protection for their GIs with collective mark protection if their GIs are regulated by a collective body.

In addition, collective marks registration in the home country will facilitate protection of GIs in those countries which do not have sui generis registration systems for GIs.

Guarantee or certification marks

15. Do you think that the practices of the EU IP Offices regarding **guarantee or certification marks** are harmonised?

No [2]

15.a What are the main problems that you face because of the divergence of practices in the EU IP Offices in this area?

(In case your answer was 'No' or 'I don't know' in question 15)

National law concerning certification marks vary substantially; finding a common practice will not be an easy and prompt project. Although EUIPO will begin registering guarantee/certification marks in 2017, only 9 EU Member states (at last count) currently register them at the national level. Unlike standard trademark law for goods and services in each Member state which is fairly harmonized with the EU trademark (EUTM), the guarantee/collective mark requirements (e.g., which body needs to guarantee or certify quality, which types of documents need to be filed concerning qualification procedures and standards, classification problems, etc.) are not. In addition, by creating gaps at the national level, there is an imbalance between EU level and national protection. For instance, we fail to understand why geographical origins are excluded as a basis for a certification mark (Article 74a) in the Regulation, while EU Member States have the possibility to provide that signs or indications which may serve to designate the geographical origin of the goods or services are registered either as collective or certification marks (Articles 28, 4° and 29, 3° of the Directive).

15.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 15)

Yes [A1]

15.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 15)

[Comment]

A Common Practice could be useful for instance to clarify once and for all the differences between certification or guarantee trademarks, and other kinds of certifications (e.g. CE certification).

16. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice in this area?

There will be a need for education for Member states which are not currently registering guarantee/certification marks as to their function and their benefits. For example, owners of geographical indications (GIs) may wish to supplement protection for their GIs with guarantee/certification mark protection if their GIs are regulated by a certifying body. In addition, guarantee/ certification marks registration in the home country will facilitate protection of GIs in those countries which do not have sui generis registration systems for GIs.

Use of a trade mark in a form differing from the one registered

17. Do you think that the practices of the EU IP Offices regarding the **use of a trade mark in a form differing from the one registered** are harmonised?

No [2]

17.a What are the main problems that you face because of the divergence of practices in the EU IP Offices in this area?

(In case your answer was 'No' or 'I don't know' in question 17)

Different national practices create uncertainty in the users' rights. Registered marks used together and assessment of minor differences omissions or additions) seem to differ at national level. There is not a clear case law practice in certain Member States like Spain.

17.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 17)

Yes [A1]

17.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 17)

[Comment]

Some guidance would be useful in light of the new tasks the EU IP Offices will assume when implementing the new Trade Marks Directive.

18. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice in this area?

The variety of practices among the EU IP Offices will be difficult to handle.

Different degrees of distinctiveness

19. Do you think that the practices of the EU IP Offices regarding the following **degrees of distinctiveness** are harmonised? [Trade marks with enhanced distinctiveness]

No [2]

19. Do you think that the practices of the EU IP Offices regarding the following **degrees of distinctiveness** are harmonised? [Well-known marks]

No [2]

19. Do you think that the practices of the EU IP Offices regarding the following **degrees of distinctiveness** are harmonised? [Trade marks with reputation]

No [2]

19.a What are the main problems that you face because of the divergence of practices in the EU IP Offices in this area?

(In case your answer was 'No' or 'I don't know' in question 19)

The practices are not harmonized in general, although certain aspects are.

There is a lack of legal certainty. There are divergences regarding the assessment and criteria determining distinctiveness.

For instance, the threshold in Spain is low - simple web print outs and unsupported sales figures are sufficient to prove or support a reputation claim.

19.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 19)

Yes [A1]

19.b Do you think that agreeing on a Common Practice among the EU IP Offices in this area would be beneficial for the users?

(In case your answer was 'No' or 'I don't know' in question 19)

[Comment]

For instance, a common practice on enhanced distinctiveness would be useful in Spain. It should be noted that in the Spanish Patent and Trademark Office's application official forms, there is no box to inform that you are claiming enhanced distinctiveness. Therefore, you can only argue enhanced distinctiveness once the Office issues a provisional refusal. There is not sufficient guidance on the kind of evidence to provide.

20. Do you foresee any difficulties that we could face during the discussions to reach a Common Practice in this area?

National jurisprudence should be taken into account as well.

Final Questions

21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 1]
Three-dimensional marks, sound marks, motion marks, multimedia marks and hologram marks [A10]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 2]
Technical solutions for filing and searching marks: 3D, sound, motion, multimedia and hologram marks [A8]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 3]
Use of a trade mark in a form differing from the one registered [A2]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 4]
Impact of dominant components when assessing likelihood of confusion [A6]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 5]
Three-dimensional trade marks containing verbal and/or figurative elements [A7]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 6]
Different degrees of distinctiveness: trade marks with enhanced distinctiveness, well-known marks and trade marks with reputation [A1]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 7]
Position marks, pattern marks, colour per-se marks and tracer marks [A9]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 8]
Generic or misleading marks as different grounds for revocation [A5]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 9]
Collective marks [A4]
21. Please rank, by order of preference, the following topics to launch a Convergence Project: [Rank 10]
Guarantee or certification marks [A3]
22. Are there any other topics on which you think it would be interesting to launch a Convergence Project?
<p>The following topics could be subject to a Convergence Project:</p> <ul style="list-style-type: none"> •Non-registered trademarks: <p>The practices of the EU IP Offices regarding non registered trademarks are not uniform. The rules and conditions governing acquisition of rights under the relevant national law vary from simple use to use having acquired a reputation.</p> <p>It should be interesting to exchange on the consequences of this different national protection under the light of art 8.4 Trade Mark Regulation, which grants the owners of non-registered marks the possibility of preventing the registration of an EUTM application where the non-registered trademark would succeed in preventing use of that EUTM application under the relevant national law.</p> <p>As regards to a project on nontraditional marks:</p> <ul style="list-style-type: none"> •Some countries may need organization, financial and human resources to achieve Common Practices. It would be useful to have part of the project focusing on how this might be achieved as it will also highlight the divergences that need overcoming. •Technology differences across the IP offices are acting as a bar at present. Minimum technical requirements could be agreed and national offices could be supported in reaching them. •Education of IP offices and examiners in relation to nontraditional marks is necessary, especially regarding what is registrable. •Another project should look at the implementation of the agreed Common Practice at national level.

23. Please write here any additional comments that you consider relevant for this analysis:

While INTA strongly supports the objective of harmonization of practices across the EU, it is essential that any Guidelines or Common Practice do not result in pushing for the lowest denominator, at the detriment of trademark users. There should also be space left for a case-by-case assessment, and any guidelines/Common Practice should be flexible enough to adapt to new technologies as required in time. Above all, users should be consulted and involved at all stages of any convergence project.

We also note that the formulation of questions on harmonization, such as questions 1 and 3, was slightly confusing for our membership. Were the questions about harmonization of technical requirements, of the law or the practices? Which practices had to be compared: the EUIPO's practice vs. the other national offices? Or all the office's practices among themselves?