

CP11: Questionnaire for User Associations - Formal Examination of new types of marks

QUESTIONNAIRE FOR USER ASSOCIATIONS

The project aims to harmonise the practice in the examination of formal requirements and grounds for refusal of new types of marks in order to prevent misalignments, multiplicity of practices and legal uncertainty as a consequence of different solutions being found to unprecedented issues. For the purposes of this questionnaire and this convergence project (CP11), the concept of new types of trade marks refers to sound, motion, multimedia and hologram marks.

The overview of all responses will serve as a basis for discussions by the CP11 Working Group.

The following questionnaire includes general questions and questions related to the **formal examination** of new types of marks. According to the general principle as established by the Court of Justice of the European Union, the criteria for examining formal requirements and absolute grounds for refusal should be the same for all types of marks. While fully respecting this principle, the new types of marks bring scenarios which have not yet been discussed. Therefore, the project aims to identify and address the following issues:

- Impact on the type of mark when elements of different types of marks are combined in the representation and those elements could be perceived as pertaining to one specific type of mark.
- Discrepancies between the type of mark indicated and the description of the mark in the application.
- Discrepancies between the representation and the description of the mark in the application.
- Discrepancies between the type of mark indicated in the application and its representation.
- The examination of priority claims where at least one of the marks concerned belongs to a new type.

The documents prepared for the CP11 Working Group, as well as the minutes of the CP11 Working Group meeting may contain reference to the replies provided, and will be shared with MS IPOs, European IPOs and the user representatives in the EUIPO User Group.

It is assumed in all cases below that the English-speaking public is the relevant public, and **GERIVAN** does not have any particular meaning.

BASIC QUESTIONS

Please indicate the User Association that you represent: International Trademark Association (INTA)

Please write your answer here:

Please indicate your name and email address (in case clarification is needed regarding any of your answers):

Carolina Oliveira, INTA Policy Officer – Europe, and staff Liaison for INTA EUIPO Subcommittee at coliveira@inta.org

Please write your answer here:

GENERAL QUESTIONS

1. Please indicate if there is any case law from any jurisdiction that you consider relevant to any issue on formal examination of sound, motion or hologram marks.

You may upload it as a Word document in its original language or in English if you have the document translated (please highlight the relevant paragraphs). Should you experience any problems, please email the file to irene.MARUGAN@euipo.europa.eu

Please upload at most one file

Kindly attach the aforementioned documents along with the survey.

Please kindly note that we have not identified any relevant national case law on issues connected with the formal examination of sound, motion or hologram marks so far.

2. Please indicate which of the following you would expect to carry more weight in the case of conflict or discrepancy between them:

Please choose **only one** of the following:

Type of mark

Description of the mark

Representation of the mark

Make a comment on your choice here:

First of all, while sometimes it may be helpful to the applicant to make an indication of a trademark type, we believe that such an indication should be regarded as no more than a description.

In line with Implementing Regulation (EU) 2018/626, we consider that the description is not mandatory, while the type of mark selected for protection might not always be the proper choice for protection. Indeed, the Implementing Regulation provides a clear language and priority order between the indication, description and representation in Recital 5:

“Regulation (EU) 2017/1001 no longer requires the representation of a mark to be graphic, as long as it enables the competent authorities and the public to determine with clarity and precision the subject matter of protection. It is therefore necessary, in order to ensure legal certainty, to clearly affirm that **the precise subject matter of the exclusive right conferred by the registration is defined by the representation**. The representation should, where appropriate, be complemented by an indication of the type of the mark concerned. It may be complemented by a description of the sign in appropriate cases. Such an indication or description should accord with the representation.”

According to Implementing Regulation (EU) 2018/626, the description and indication of the type of mark are optional (given the references to “should” and “may”, instead of “shall”). This is also confirmed in Article 3(3) and Article 3(3)(d) and (e) for example.

The only request of the legislator is that any indication or description accord with the representation.

Therefore, it is clear that the representation of the mark should be given more weight in case of a conflict or when analyzing dissimilarities, than the description or even the indication.

IMPACT ON THE TYPE OF MARK WHEN ELEMENTS OF DIFFERENT TYPES ARE COMBINED

Impact on the type of mark when elements of different types of marks are combined in the representation

3. Please indicate the type of mark that you would expect to be acceptable for a sound file consisting of a human voice clearly reproducing one or more words, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Comment: since even if the human voice is reproducing words, it could be the type of voice, amplitude or a particular reproduction of the sound that is what is desired to be protected. See for example Yahoo! Yoddle sound mark.

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

4. Please indicate the type of mark that you would expect to be acceptable for a video file consisting of an image of one or more words that are moving on the screen, without any other visual elements nor sound, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark

Reasoning: The mark cannot be a multimedia mark because there is no sound and under the Office's Guidelines a multimedia mark is defined as a trade mark consisting of, or extending to, the combination of image and sound. The term 'extending to' means that the mark may also include words, figurative elements, labels, etc. in addition to the image and sound

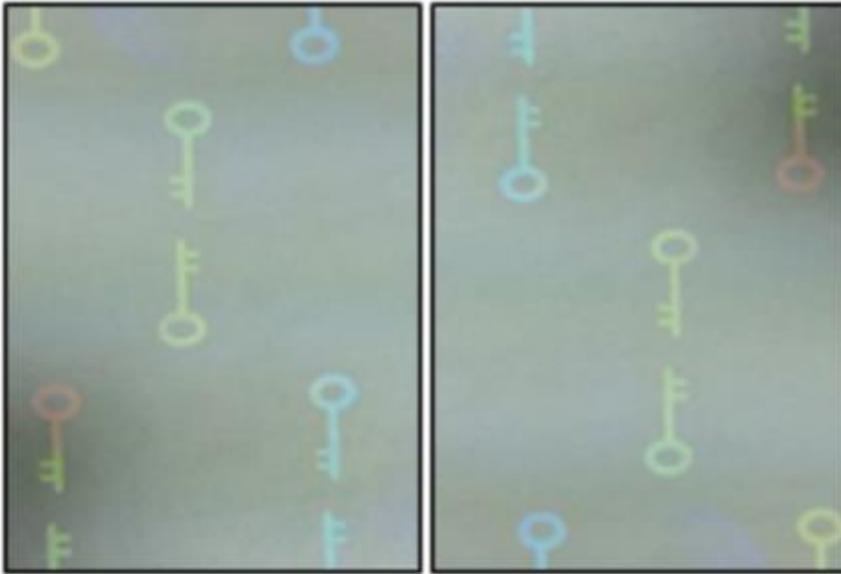
Multimedia mark.

Hologram mark

Other mark

None of the above, please elaborate

5. Please indicate the type of mark that you would expect to be acceptable for a pattern with holographic effect, and please briefly elaborate on the criteria or reasoning behind your answer, if any: (see example below)



Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark
- Sound mark
- Motion mark
- Multimedia mark
- Hologram mark**

Reasoning: since the holographic effect (changing of images following the change of viewers' perspective / angle of viewing) should be the main element desired to be protected.

Other mark

None of the above, please elaborate

6. Please indicate the type of mark that you would expect to be acceptable for the image below, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Musical notation of a song including lyrics

The image shows four staves of musical notation for the song "Happy Birthday to You". The notation is in treble clef with a key signature of one flat (Bb) and a 3/4 time signature. The lyrics are written below the notes. Chords are indicated above the staff: F, C7, F, Bb, F/C, C7, and F.

Hap - py birth - day to you! Hap - py
birth - day to you! Hap - py
birth - day dear (John - ny) Hap - py
birth - day to you!

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark.

Reasoning: Even if the musical notation contains lyrics, given the non-distinctive character of the lyrics, the resulting sounds are the main element desired for protection.

Motion mark

Multimedia mark

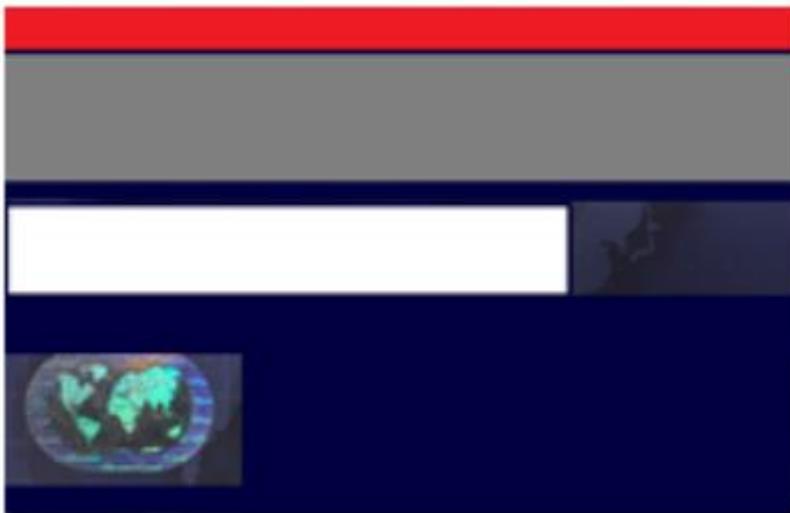
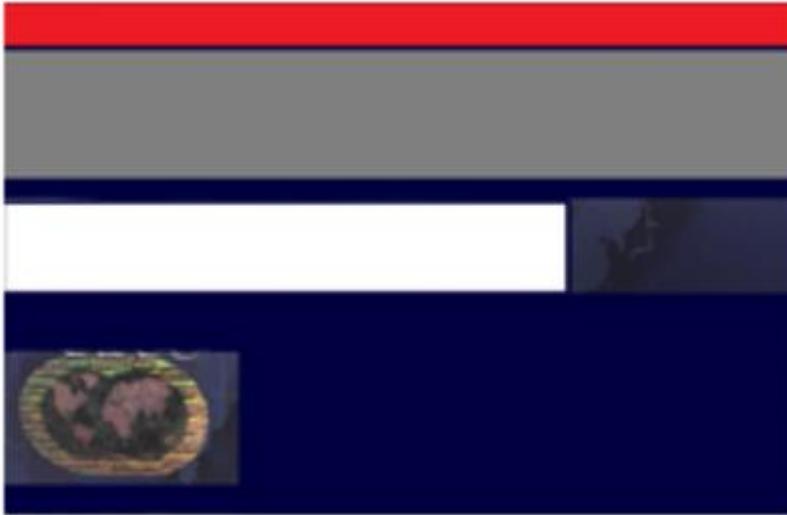
Hologram mark

Other mark

None of the above, please elaborate

7. For the example below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

A photographic reproduction of a credit card containing a small hologram in the bottom left - two pictures of the card, showing the holographic effect



Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark

Sound mark

Motion mark

Multimedia mark

Hologram mark

Reasoning: since the holographic effect (change of images based on different angles of viewing) is the element for which protection is sought and all other elements of the image might be considered as lacking distinctiveness and/or functional.

Other mark

None of the above, please elaborate

8. For the mp4 below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

<https://www.youtube.com/watch?v=K7ARyfh1vMk>

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark

Multimedia mark

Reasoning: since it is a video containing a combination of images and animations and/or interactive content.

Hologram mark

Other mark

None of the above, please elaborate

9. For the mp4 below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

https://www.youtube.com/watch?v=AJN_7uKXBWM

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark

Multimedia mark.

Reasoning: since it is a video containing a combination of images, sound (although not distinctive) animations and/or interactive content.

Hologram mark

Other mark

None of the above, please elaborate

10. For the mp3 below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

A mp3 consisting exclusively of the phonetic reproduction of words

<https://www.youtube.com/watch?v=U7B1g0XIZp0>

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark.

Reasoning: Given that the sound file contains the non-distinctive word “premium”, we believe it is the resulting sound or pronunciation which is the main element desired for protection.

- Motion mark
- Multimedia mark
- Hologram mark
- Other mark
- None of the above, please elaborate

11. For the mp4 below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

A still figurative image

<https://www.youtube.com/watch?v=wzXWCKVnt2o>

Please choose all that apply and provide a comment:

Word mark

Figurative mark.

Reasoning: Even if the image is contained in a video, it still remains a still image and thus protection cannot only be claimed for the image itself.

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark

- Multimedia mark
- Hologram mark
- Other mark
- None of the above, please elaborate

12. For the mp4 below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

A piece of cloth with a pattern

<https://www.youtube.com/watch?v=0jjiWmE-7Sk>

Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark.**

Reasoning: Even if the pattern is contained in a video, the main element that is subject of protection is the pattern. In this case the video might be used to determine the limits of protection.

- Colour mark
- Sound mark
- Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

13. For the mp4 below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Mp4 showing a rotating 3D object

<https://www.youtube.com/watch?v=S61palnExl0>

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark.

Reasoning: The main element desired to be protected is the shape, while the purpose of the 3D representation of the mark is to determine the limits of protection.

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark

Multimedia mark

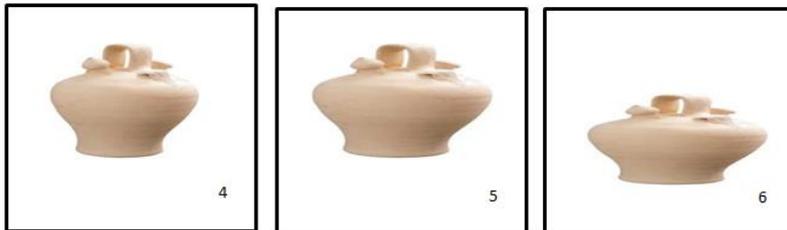
Hologram mark

Other mark

None of the above, please elaborate

14. For the image below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Jpeg showing a change in the shape of a three-dimensional object



Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark.

Position mark

Pattern mark

Colour mark

- Sound mark
- Motion mark
- Multimedia mark
- Hologram mark
- Other mark

None of the above, please elaborate.

Reasoning: These are several different trademarks

15. For the mp4 below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Mp4 showing a change in the shape of a three-dimensional object

<https://www.youtube.com/watch?v=3qwIVajzszE>

Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark.
- Position mark
- Pattern mark
- Colour mark
- Sound mark
- Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate.

Reasoning: These are several different trademarks

16. For the mp4 below, please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Mp4 showing the shape of a ball

<https://www.youtube.com/watch?v=LsuHWu0Whos>

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark.

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark.

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark:

Reasoning: because the representation consists of a musical notation

Motion mark

Multimedia mark

Hologram mark

Other mark

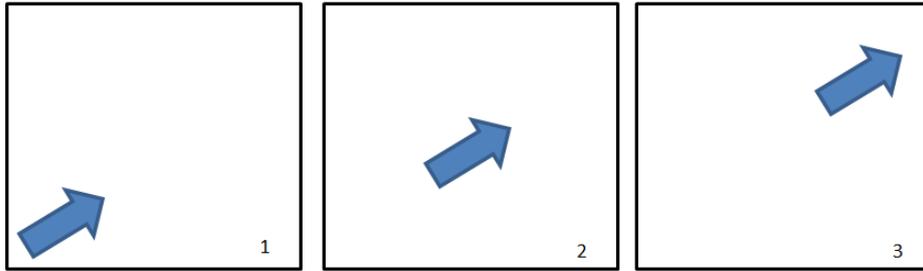
None of the above, please elaborate

18. Please indicate the type of mark that you would expect to be acceptable and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: sequence of still images

Type of mark selected by the applicant: Motion mark

Description: The image shows an arrow moving gradually from the bottom left to the top right, where the whole movement lasts 3 seconds, together with the sound of three piano notes: A, B and C, played 1 second each



Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark
- Sound mark
- Motion mark:**

Reasoning: the representation, description and type of mark are not consistent because the sound cannot be perceived in the representation. Therefore we believe that it has been correctly indicated as motion mark by the applicant because the representation should prevail.

- Multimedia mark
- Hologram mark
- Other mark

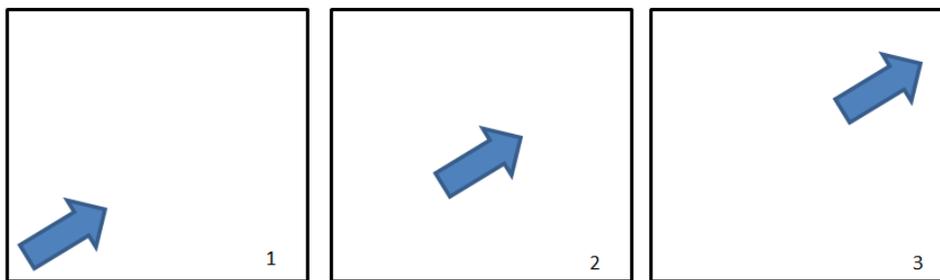
None of the above, please elaborate

19. Please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: sequence of still images

Type of mark selected by the applicant: Figurative mark

Description: the motion of a blue arrow changing its position gradually from the bottom left to the top right, where the whole movement lasts 3 seconds



Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark:

Reasoning: We believe that the applicant's choice (figurative mark) is not consistent with the representation and the description.

- Multimedia mark
- Hologram mark
- Other mark
- None of the above, please elaborate

20. Please indicate the type of mark that you would expect to be acceptable and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 including a still image of a word together with the phonetic reproduction of that word

Type of mark selected by the applicant: Multimedia mark

Description: Image of the word "WORD" [*partial description*]

https://www.youtube.com/watch?time_continue=2&v=PXU4XlvxIE4

Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark
- Sound mark:**

Reasoning: the image is not in motion. There is simply an image combined with a sound.

- Motion mark
- Multimedia mark:
- Hologram mark
- Other mark
- None of the above, please elaborate

DISCREPANCIES BETWEEN THE REPRESENTATION AND THE DESCRIPTION OF THE MARK

Discrepancies between the representation and the description of the mark in the application

21. Please indicate the actions that you could expect to be taken in the situation below (e.g. the description removed *ex officio*, clarification requested from the applicant, an objection letter sent to the applicant):

Representation: musical notation

Type of mark selected by the applicant: Sound mark

Description: musical notation of Für Elise (Beethoven)



Please write your answer here: **The description is not correct. Since it is not mandatory for sound marks, the applicant should be invited to remedy the**

irregularity. If he fails to do so, the description should be deleted, and should not have no impact on the protection of the mark.

22. Please indicate the actions that you could expect to be taken in the situation below (e.g. the description removed *ex officio*, clarification requested from the applicant, an objection letter sent to the applicant):

Representation: mp3 containing 4 seconds of piano

Type of mark selected by the applicant: Sound mark

Description: barking dog

<https://www.youtube.com/watch?v=en0QovhFYNU>

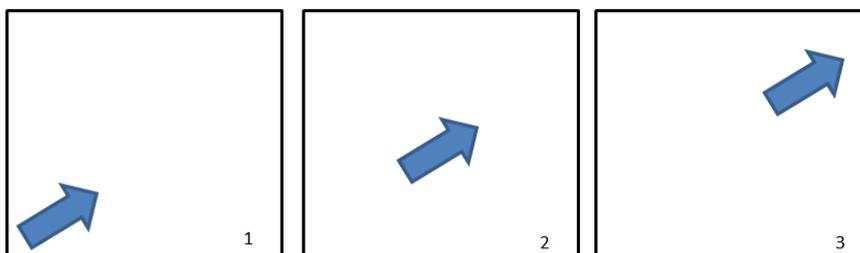
Please write your answer here: **An objection letter should be sent to the applicant inviting him to remedy the irregularity, failing which the description should be deleted.**

23. Please indicate the actions that you could expect to be taken in the situation below (e.g. the description removed *ex officio*, clarification requested from the applicant, an objection letter sent to the applicant):

Representation: sequence of still images (see below)

Type of mark selected by the applicant: Motion mark

Description: The image shows an arrow moving gradually from the bottom left to the top right, where the whole movement last 3 seconds and backwards for another 3 seconds



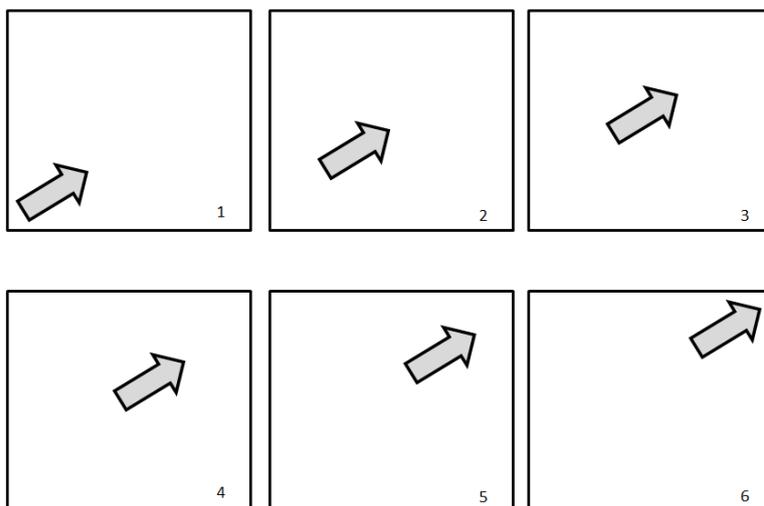
Please write your answer here: **An objection letter should be sent asking that either the representation is completed or that the sentence and backwards for another 3 seconds is deleted from the description.**

24. Please indicate the actions that you could expect to be taken in the situation below (e.g. the description removed *ex officio*, clarification requested from the applicant, an objection letter sent to the applicant):

Representation: sequence of still images (see below)

Type of mark selected by the applicant: Motion mark

Description: The image shows an arrow moving in circles



Please write your answer here:

An objection should be sent on the reason of the discrepancy between the description and the representation.

In the absence of a response, the representation should prevail. This should be explicitly clarified upfront to the applicant.

25. Please indicate the actions that you could expect to be taken in the situation below (e.g. the description removed *ex officio*, clarification requested from the applicant, an objection letter sent to the applicant):

Representation: mp4 showing a white screen together with the sound of crickets

Type of mark selected by the applicant: Multimedia mark

Description: crickets in the grass of a small garden

https://www.youtube.com/watch?v=MeLpwqLc_vU

Please write your answer here: **In our opinion, the mark is a sound mark. An objection should be issued in respect of the type of mark and the description.**

DISCREPANCIES BETWEEN THE TYPE OF TRADE MARK INDICATED AND THE REPRESENTATION OF THE MARK

Discrepancies between the type of trade mark indicated and the representation of the mark in the application

26. Please indicate the type of mark that you would expect to be acceptable and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: musical notation

Type of mark selected by the applicant: Sound mark

Description: No description



Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark
- Sound mark:**

Reasoning: there is no need to provide a description. The fact that the musical notation is represented in different colors should have no influence on the determination of the type of mark.

- Motion mark
- Multimedia mark
- Hologram mark
- Other mark
- None of the above, please elaborate

27. Please indicate the type of mark that you would expect to be acceptable and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp3 file containing a melody with sung words

Type of mark selected by the applicant: Other mark

Description: No description

<https://www.youtube.com/watch?v=Ulqhi4YxydE>

Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark

Sound mark

Comment: An objection should be sent to the applicant asking to amend the type of mark as sound mark

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

28. Please indicate the type of mark that you would expect to be acceptable and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 with melody and lyrics, and the image shows the written lyrics in standard typeface

Type of mark selected by the applicant: Other mark

Description: No description

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark:

Comment: we believe that as only the melody is heard and there are no motion elements, the type of mark should be amended to sound mark.

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

29. Please indicate the type of mark that you would expect to be acceptable ,and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp3 sound file consisting exclusively of verbal elements

Type of mark selected by the applicant: Other mark

Description: No description

https://www.youtube.com/watch?v=a3-YMbxw_3g

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Pattern mark

Colour mark

Sound mark:

Comment: We believe that a musical notation should be considered as a sound mark. However the Office could issue an objection asking the applicant to confirm whether the sign applied for is a sound mark or a figurative mark

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

31. Please indicate the type of mark that you would expect to be acceptable , and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp3 with a sound of water

Type of mark selected by the applicant: Multimedia mark

Description: No description

https://www.youtube.com/watch?time_continue=2&v=ogsitaWz9zU

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark:

Comment: we believe that the type of mark should be amended to a sound mark since the sign is exclusively a sound.

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

32. Please indicate the type of mark that you would expect to be acceptable and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp3 with a repeating sound

Type of mark selected by the applicant: Pattern mark

Description: No description

<https://www.youtube.com/watch?v=yzbY371tj0E>

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark:

Comment: we believe that the type of mark should be amended to a sound mark since the sign is exclusively a sound.

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

33. Please indicate the type of mark that you would expect to be acceptable and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 showing a white screen with a melody

Type of mark selected by the applicant: Sound mark

Description: No description

<https://www.youtube.com/watch?v=oYD55QC9ZYo>

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark:

Comment: we believe that the type of mark selected by the applicant is correct.

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

34. Please indicate the type of mark that you would expect to be acceptable , and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 video showing musical notation and the melody

Type of mark selected by the applicant: Sound mark

Description: No description

<https://www.youtube.com/watch?v=9eTVICuQVI4>

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark:

Comment: we believe that the type of mark selected by the applicant is correct.

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

35. Please indicate the type of mark that you would expect to be acceptable , and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 showing exclusively the word "WORD" (with no movement)

Type of mark selected by the applicant: Motion mark

Description: No description

https://www.youtube.com/watch?v=HMJXo83bj_Q

Please choose all that apply and provide a comment:

Word mark

Comment: the sign appears to be a word mark since it has no other element allowing to classify it as another type of mark

- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark
- Sound mark
- Motion mark
- Multimedia mark
- Hologram mark
- Other mark
- None of the above, please elaborate

36. Please indicate the type of mark that you would expect to be acceptable and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 showing a shape, changing colour, without any sound

Type of mark selected by the applicant: Multimedia mark

Description: No description

<https://www.youtube.com/watch?v=qztREg40gR8>

Please choose all that apply and provide a comment:

- Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark:

Comment: In our opinion, this could not be multimedia because there is no sound. It could possibly be a motion mark if the change of color is considered equivalent to a movement.

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

37. Please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 with no sound showing a simple arrow moving upwards

Type of mark selected by the applicant: Multimedia mark

Description: No description

<https://www.youtube.com/watch?v=0M7FVCpEAXo>

Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark
- Sound mark

Motion mark:

Comment: In our opinion, this could not be multimedia because there is no sound. It could possibly be a motion mark given that there is a simple arrow moving upwards

- Multimedia mark
- Hologram mark
- Other mark
- None of the above, please elaborate

38. Please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 showing a holographic effect and sounds

Type of mark selected by the applicant: Hologram mark

Description: No description

<https://www.youtube.com/watch?v=okouEh3x0UU>

Please choose all that apply and provide a comment:

- Word mark
- Figurative mark
- Shape mark
- Position mark
- Pattern mark
- Colour mark
- Sound mark
- Motion mark
- Multimedia mark**

Comment: the trademark is a combination of hologram, movement and sound. Therefore, it would qualify as a multimedia mark.

- Hologram mark
- Other mark:
- None of the above, please elaborate

39. Please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: one .jpg with a photographic reproduction where the holographic effect is not visible in its entirety

Type of mark selected by the applicant: Hologram mark

Description: No description



Please choose all that apply and provide a comment:

Word mark

Figurative mark

Comment: The sign appears to be composed by figurative elements with the use of colors. Therefore, we believe it should be a figurative mark.

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark

Multimedia mark

Hologram mark

Other mark

None of the above, please elaborate

40. Please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: mp4 (hologram of a turtle)

Type of mark selected by the applicant: Motion mark

Description: No description

<https://www.youtube.com/watch?v=b8cfbsFLGZU>

Please choose all that apply and provide a comment:

Word mark

Figurative mark

Shape mark

Position mark

Pattern mark

Colour mark

Sound mark

Motion mark

Multimedia mark

Hologram mark

Comment: In our opinion, the background and the hand holding the hologram card are not part of the trademark, the trademark is the hologram depicted on the card.

Other mark

None of the above, please elaborate

41. Please indicate the type of mark that you would expect to be acceptable, and please briefly elaborate on the criteria or reasoning behind your answer, if any:

Representation: 2 photographs of a hologram

Type of mark selected by the applicant: Hologram mark

Description: No description



Please choose all that apply and provide a comment:

Word mark

Figurative mark

Comment: we cannot perceive the hologram. It looks more like a figurative mark to us.

Shape mark

Position mark

Pattern mark

Colour mark

- Sound mark
- Motion mark
- Multimedia mark
- Hologram mark
- Other mark
- None of the above,

PRIORITY CLAIMS

Issues specific to new types of marks for examination of priority claims when at least one is of the new types of trade marks (regardless of the proceeding within which the assessment of identity takes place)

Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing)

42. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Motion mark, represented with sequence of still images



Second filing: Motion mark, represented with mp4

<https://www.youtube.com/watch?v=m97vqvUbUUk>

Please choose **only one** of the following:

Yes X

No

Make a comment on your choice here:

Both the series of still sequential images as well as the MP4 format are considered acceptable formats for motion marks.

When comparing both representations, the second filing appears to correspond to what is shown in the first filing and does not include any additional elements.

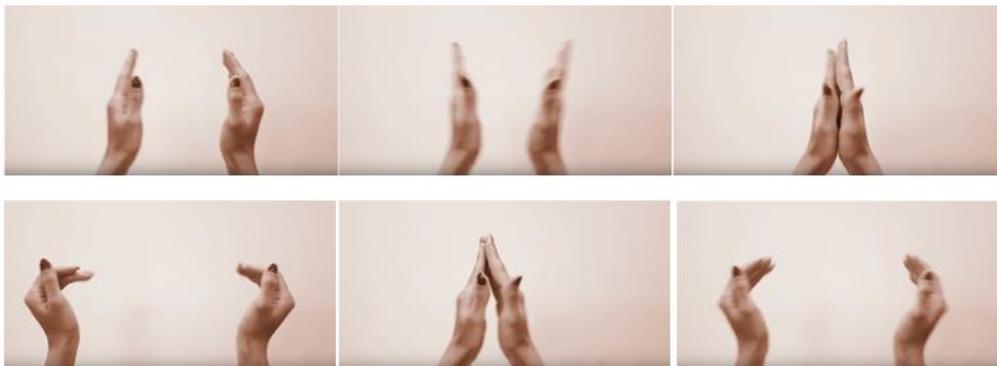
It could be argued, however, that the still images of the first filing do not show the full movement. More images would have to be added to make clear that the sequence of images corresponds to the movement of the hands in the video and thus render the two representations "identical".

43. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Motion mark, represented with mp4

<https://www.youtube.com/watch?v=m97vqvUbUUK>

Second filing: Motion mark, represented with sequence of still images



Please choose **only one** of the following:

Yes X

No

Make a comment on your choice here:

See preceding comment.

44. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Motion mark, represented with sequence of still image



Second filing: Motion mark, represented with mp4

<https://www.youtube.com/watch?v=5EqxAITXhO8>

Please choose **only one** of the following:

Yes X

No

Make a comment on your choice here:

The content of both the series of illustrations and the mp4 file appear to be the same. In particular, the content of the mp4 file is not a set of continuous movements as under question 43 but is also made up of a series of individual shots.

The sequence of still images clear represents the content of the video. All the changes in the stylization of the letters is corresponded by the images that appear in the video. There are no additional elements that could put this finding into question.

45. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Motion mark, represented with mp4

<https://www.youtube.com/watch?v=5EqxAITXhO8>

Second filing: Figurative mark



Please choose **only one** of the following:

- Yes
- No X

Make a comment on your choice here:

The second filing is a figurative mark which does not include a movement or a change in the position of the marks' elements in its scope of protection. We believe that when comparing the marks, the representation of the figurative mark would have to be considered as a whole and not divided up into its different elements.

46. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Figurative mark represented image



Second filing: Motion mark represented with mp4

<https://www.youtube.com/watch?v=5EgxAITXhO8>

Please choose **only one** of the following:

Yes

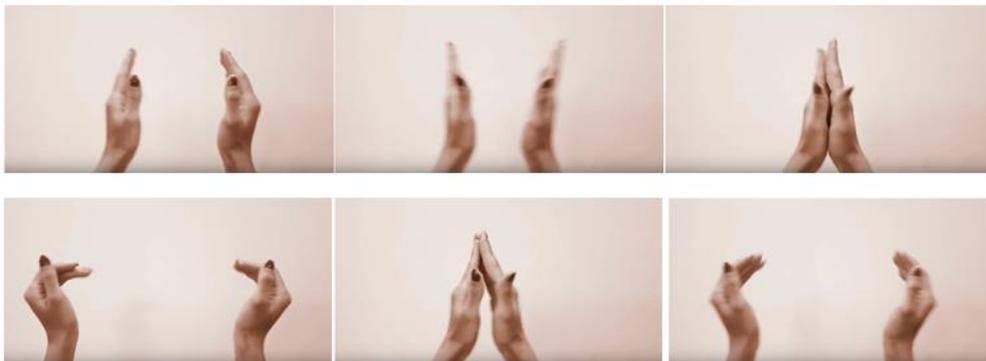
No X

Make a comment on your choice here:

The first filing is a figurative trademark that should be analyzed as a whole and that in no case represents a dynamic sequence where different elements appear/change. On the contrary, the second filing is a motion mark which protection is related to the sequence created by their different elements when appearing and changing. The same considerations made in the preceding comment apply.

47. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Motion mark represented with sequence of still images



Second filing: Multimedia mark (sound + motion)

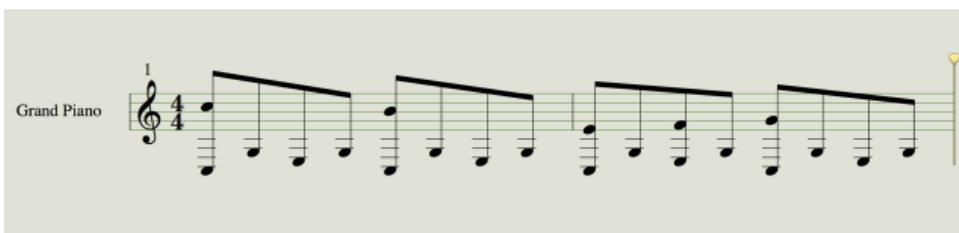
<https://www.youtube.com/watch?v=G0g-cO7MYIE>

Please choose **only one** of the following:

Yes

No X

Second filing: Sound mark, represented with musical notation



Please choose **only one** of the following:

Yes X

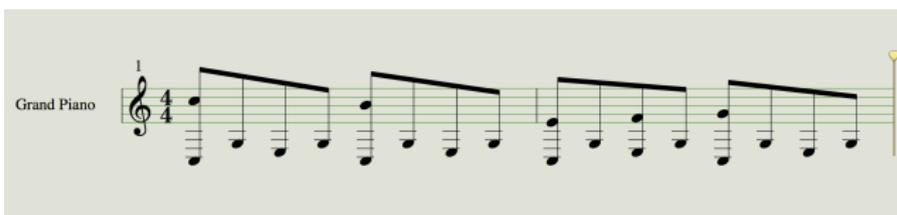
No

Make a comment on your choice here:

It is assumed that there is a coincidence between the melody and the music notation. However it would appear that the scope of protection of the musical notation may be broader as it may be played by different instruments or in different manners. There may be problems concerning the question on how to determine that the mp3 exactly represents the notation filed as for this it may be necessary to consult with professional musicians.

50. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Sound mark represented with musical notation



Second filing: Multimedia mark

<https://www.youtube.com/watch?v=sEbqXDWV8B4>

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

The filings concern two different types of marks. The content of the multimedia mark with its image must be considered as a whole and clearly goes considerably beyond the scope of the sound mark. Therefore, the marks cannot be considered identical.

51. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Sound mark, voice singing “GERIVAN”

<https://www.youtube.com/watch?v=Gmuuh9JoK6E>

First filing: Motion mark, GERIVAN

<https://www.youtube.com/watch?v=bsWlr8ftndk>

Second filing: Multimedia mark (sound + motion)

<https://www.youtube.com/watch?v=9ATKNqUmKsc>

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

First filing is mentioned twice, however the answer is “No” regardless of which one is the first filing.

52. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Multimedia mark (sound + motion)

<https://www.youtube.com/watch?v=9ATKNqUmKsc>

Second filing: Sound mark, voice singing “GERIVAN”

<https://www.youtube.com/watch?v=Gmuuh9JoK6E>

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

With regards to the difference in the types of marks and the additional element of motion in the first filing, the preceding comments apply. The second filing only includes sound (not images) and, therefore, we consider that those discrepancies would be sufficient to refuse the priority. Moreover, in our view, it cannot be argued that the sound mark is contained in an identical manner as a whole in the multimedia mark and that therefore the applicant with regard to this element should be able to rely on the priority of the multimedia-mark.

53. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Multimedia mark (sound + motion)

https://www.youtube.com/watch?time_continue=2&v=bsWlr8ftndk

Second filing: Motion mark, GERIVAN

<https://www.youtube.com/watch?v=Gmuuh9JoK6E>

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

The first filing as a multimedia mark is in fact not “multimedia” as it contains only images and no sound. The second filing is not a “motion mark” as it contains no images but only sound. Regardless of the type of mark it was filed under, they cannot be considered identical.

54. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Sound mark, containing word elements

https://www.youtube.com/watch?v=a3-YMbxw_3g

Second filing: Multimedia mark, containing word elements

<https://www.youtube.com/watch?v=PXU4XlvxE4>

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

The marks are not identical as whereas the first filing only contains sound, the second filing also contains visual word elements.

55. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Figurative mark

The image shows the word "GERIVAN" written in a bold, black, hand-drawn font. Below the word is a thick, black, curved underline that spans the width of the word.

Second filing: Motion mark, GERIVAN

<https://www.youtube.com/watch?v=bsWlr8ftndk>

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

These are different types of marks; the scope of protection of the second filing is different from the first filing as it contains a change of colors and the movement. If, according to the common practice, two figurative marks in black and white versus in color are not considered identical, neither can the above.

The differences are noticeable and, therefore, the priority should not be accepted.

56. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Sound mark, containing word elements

https://www.youtube.com/watch?v=a3-YMbxw_3g

Second filing: Other mark, containing word elements (The IPO of second filing does not allow sounds which include word elements to be registered as “Sound marks”)

https://www.youtube.com/watch?v=a3-YMbxw_3g

Please choose **only one** of the following:

Yes X

No

Make a comment on your choice here:

The trademarks appear to be sound marks, regardless of the fact that the second trademark is mentioned as “other mark”.

57. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Other mark, containing word elements (The IPO of first filing does not allow sounds which include word elements to be registered as “Sound marks”)

https://www.youtube.com/watch?v=HMJXo83bj_Q

Second filing: Sound mark, containing word elements

https://www.youtube.com/watch?v=a3-YMbxw_3g

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

The first filing has no sound, just the word "word" is present. The other sign is just a sound with no image, it is a sound mark.

58. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Other mark, containing word elements

https://youtu.be/HMJXo83bj_Q

Second filing: Figurative mark, containing word elements

WORD

Please choose **only one** of the following:

Yes X

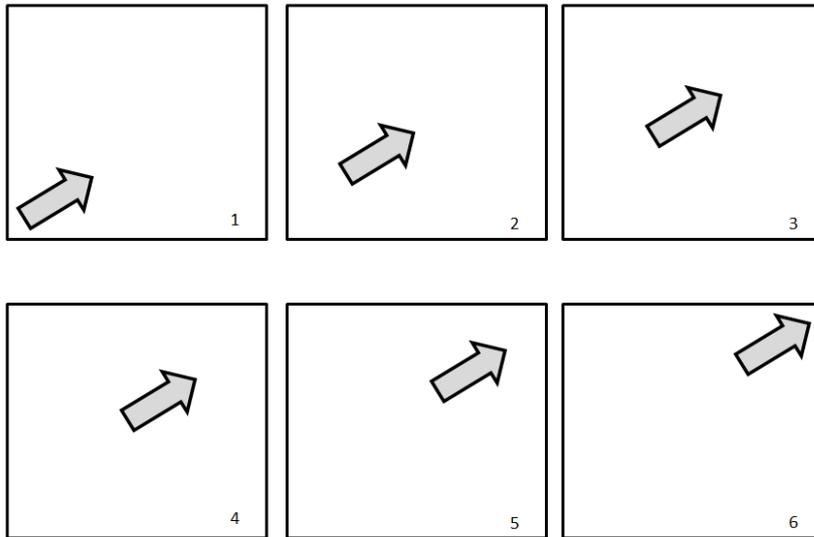
No

Make a comment on your choice here:

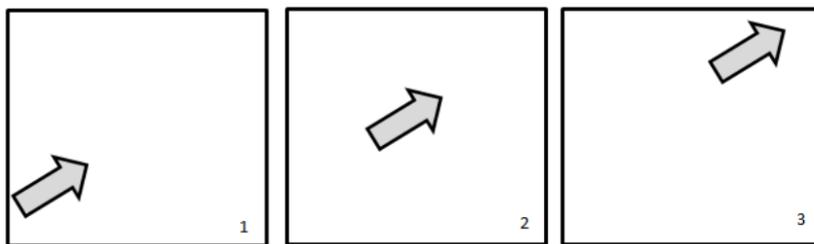
Regardless of the classification of the mark as a word mark or other mark, the content of the marks is identical. Priority should therefore be accepted.

59. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Motion mark, represented with a sequence of 6 still images (in one single .jpg)



Second filing: Motion mark, represented with a sequence of 3 still images (in one single .jpg)



Please choose **only one** of the following:

Yes

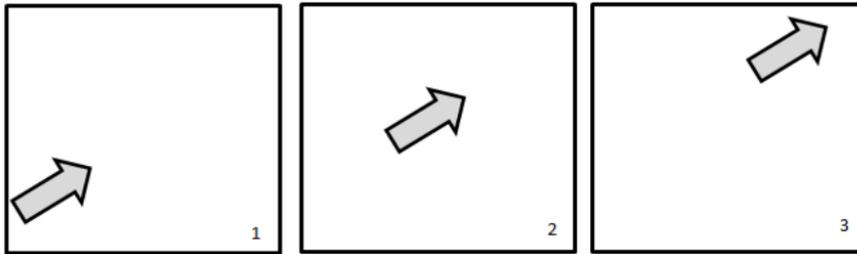
No X

Make a comment on your choice here:

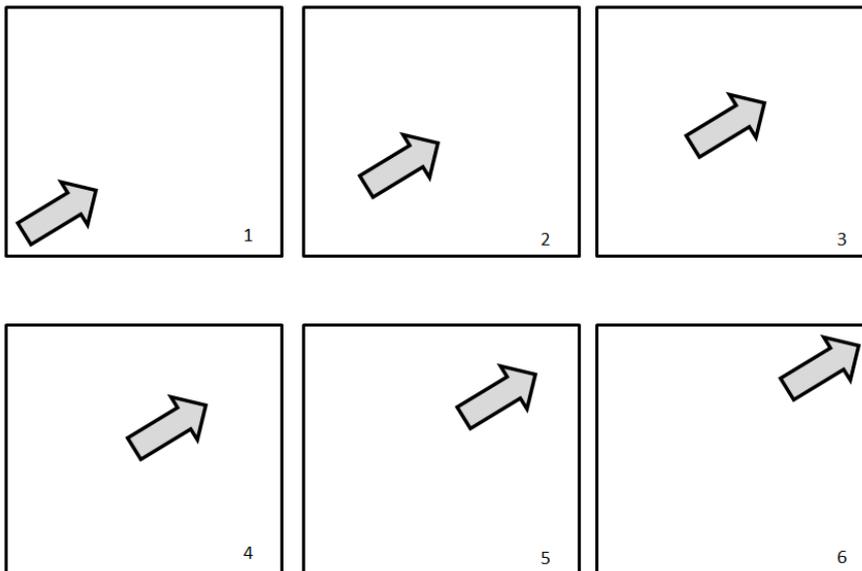
The position of all the arrows shown in the second filing is different to that of the first filing. Even though the general movement may be considered similar, e.g. the starting point of the second arrow is further up than that of the first filing, the marks cannot be considered identical.

60. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Motion mark, represented with a sequence of 3 still images (in one single .jpg)



Second filing: Motion mark, represented with a sequence of 6 still images (in one single .jpg)



Please choose **only one** of the following:

Yes

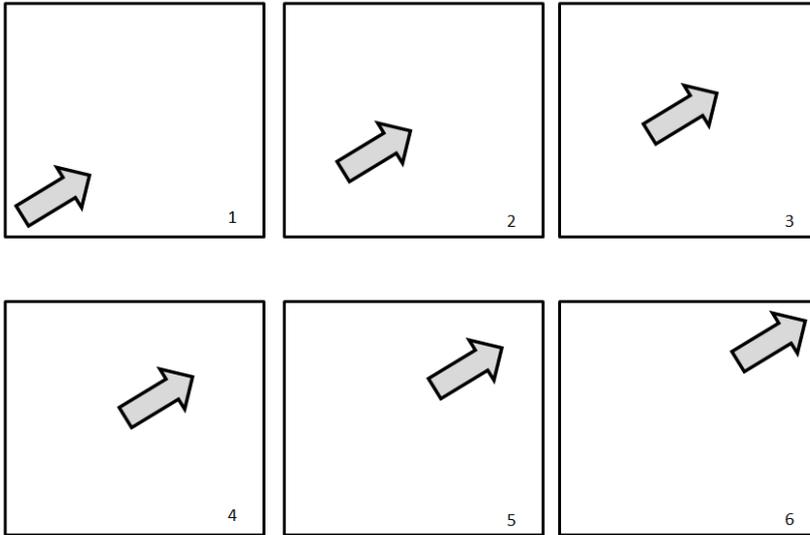
No X

Make a comment on your choice here:

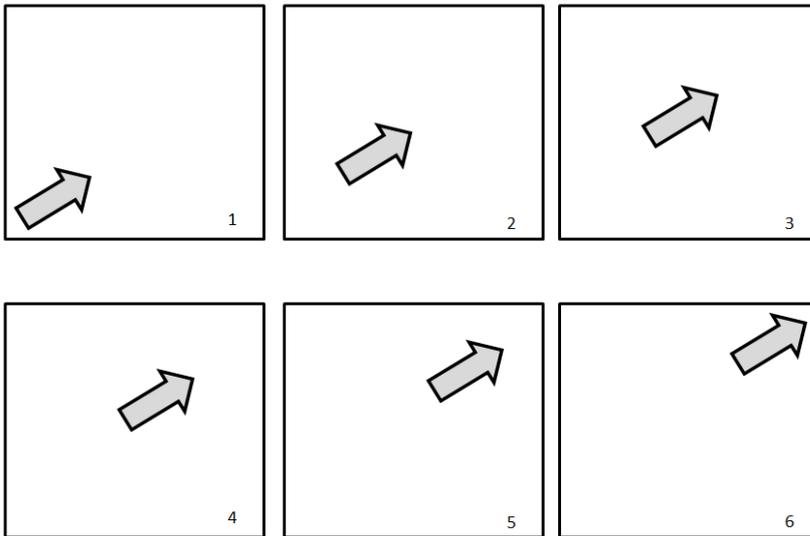
See preceding comment.

61. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Motion mark, without description



Second filing: Motion mark, with description



Description: a grey coloured arrow moves gradually from the bottom left to the top right, where the whole movement lasts 3 seconds.

Please choose **only one** of the following:

Yes X

No

Make a comment on your choice here:

The description is not relevant.

62. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Multimedia mark, consisting of an mp4 with white screen and a sound

https://www.youtube.com/watch?v=MeLpwqLc_vU

Second filing: Sound mark consisting of an mp3 containing the same sound

<https://www.youtube.com/watch?v=doUKFp1p4W4>

Please choose **only one** of the following:

Yes X

No

Make a comment on your choice here:

This is in line with our response to question 25, where we indicated that the trademark (which is here the first filing) is a sound mark.

63. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Multimedia mark, consisting of an image of bananas and a voice saying “bananas”

<https://www.youtube.com/watch?v=wUHlMrNwOa8>

Second filing: Motion mark, consisting of an image of bananas (no sound)

<https://www.youtube.com/watch?v=QGYdHP6EbhM>

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

Also in this case the type of trademark corresponding to the first filing (multimedia) is particularly relevant, given that its elements are the image, the movement and the sound. Given that the sound is not present in the second filing, we consider that the second filing would not be identical to the first one.

64. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Sound mark consisting of 5 “beeps”

Second filing: Sound mark consisting of 6 “beeps”

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

The second filing is made up of one additional element compared to the first filing. Even though the beeps in themselves may be identical, the content of the first filing cannot be considered identical to any other number of “beeps”. Taking into account that both are sound marks, the fact that one of them has an additional beep is particularly relevant given that all the components of the trademarks should be analyzed in this case.

65. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Other mark, consisting of an image and a sound

<https://www.youtube.com/watch?v=G0g-cO7MYIE>

Second filing: Multimedia mark (same image and sound)

<https://www.youtube.com/watch?v=G0g-cO7MYIE>

Please choose **only one** of the following:

Yes

No

Make a comment on your choice here:

The content of the marks appears identical and therefore priority should be accepted.

66. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Other mark, consisting of a video recording

<https://www.youtube.com/watch?v=WCGRW4J7csQ>

Second filing: Motion mark (same image)

<https://www.youtube.com/watch?v=WCGRW4J7csQ>

Please choose **only one** of the following:

Yes X

No

Make a comment on your choice here:

In our opinion the priority should be accepted given that the trademarks are identical.

67. Please indicate if you would expect the prior mark of first filing (first filing) to be considered identical to the mark for which the priority is claimed (second filing):

First filing: Sound mark, piano melody

<https://www.youtube.com/watch?v=hfLHyOT6rPw>

Second filing: Sound mark, violin melody

<https://www.youtube.com/watch?v=pX4ldF-ITX8>

Please choose **only one** of the following:

Yes

No X

Make a comment on your choice here:

The sound of the violin and the piano cannot be considered identical. In our view, the sound mark of the first filing not only protects the melody but all aspects of the filing, including the instrument the melody is played with.

FINAL CONSIDERATIONS

68. What are the main issues that you foresee for users in relation to examination of formal requirements of new types of marks?

Please write your answer here:

It may be difficult for the user to determine the scope of protection of the mark it files and to determine which of the new types of marks is best suited for the intended protection. This is the case in particular where several elements are combined as e.g. in a multimedia mark. We believe that guidelines would be an essential tool for applicants of such filings.

There might be an additional difficulty in comparing sound marks where one is represented by a musical notation (which does not clarify the music instrument that should be used) and the other is represented by an mp3 file. The scope of protection of the musical notation may be broader as it may be played by different instruments or in different manners. There may be problems concerning the question on how to determine that the mp3 exactly represents the notation filed as for this it may be necessary to consult with professional musicians.

69. Do you foresee any risks related to the agreement of a Common Practice on examination of formal requirements of new types of marks?

Please write your answer here:

No, we do not see any risks. On the contrary, we believe it would be extremely helpful as a guide to applicants, and since legal clarity and harmonization in that fields are awaited by businesses to further explore the possibility of protecting new types of trademarks

