

**COMMON COMMUNICATION  
USE OF A TRADE MARK IN  
A FORM DIFFERING FROM  
THE ONE REGISTERED**

**OCTOBER 2020**

## 1. BACKGROUND

The Intellectual Property Offices of the European Trade Mark and Design Network continue to collaborate in the context of the Convergence Programme. They have now agreed on an additional Common Practice with regard to the use of trade marks in a form differing from the one registered with the aim of identifying general principles for assessing when the use of a trade mark in a form differing from the one registered alters its distinctive character and to provide guidance in this respect.

This Common Practice is made public through this Common Communication with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

The scope of the Common Practice is the assessment of the types of changes that can occur in the sign when used in a form differing from the one registered, namely when elements are added, omitted, modified or when these changes appear in combination.

The following issues are **out of scope** of the Common Practice:

- Types of marks other than word marks, purely figurative marks and composite marks, in particular, shape marks, position marks, pattern marks, colour marks and other non-traditional marks;
- Descriptions, colour claims and disclaimers. Although they might have an impact on the assessment, they are not taken into account for the purpose of this Common Practice as the signs are assessed based on the representations shown in the examples provided;
- Enhanced distinctive character through use (reputation, well-known character) and its impact on the assessment;
- Definition of genuine use and the MS IPOs' methodology in its examination;
- Definition of factors to be considered when assessing genuine use (i.e. place, time and extent of use);
- Means of evidence to be filed in order to prove genuine use of a sign (e.g. catalogues, invoices, price lists or surveys). The reasoning provided with all examples is based on the assumption that the representation of the sign as used in these examples is the only means/manner of use presented in the supporting evidence<sup>(1)</sup>;
- Procedural aspects related to opposition, revocation and/or invalidity;
- Description of legal constraints preventing implementations in particular MS IPOs;
- Linguistic issues (all examples are in English and it is assumed that they will be understood by the relevant public).

## 2. THE COMMON PRACTICE

The following text summarizes the key messages and main statements of the principles of the Common Practice. The complete text and all the illustrative examples used can be found in Annex 1 of this Common Communication.

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<sup>1</sup> The assessment of whether the sign as used constitutes an acceptable variation of its registered form must be based on the evidence provided by parties in the particular case.

### PRELIMINARY REMARK ON SIMULTANEOUS USE OF SEVERAL SIGNS

Signs are often used together with other signs in trade (e.g. to designate a sub-brand and/or a house mark or together with a company name). When several signs are used together but remain independent from each other and perform their distinguishing function as separate signs, the question of whether the distinctive character of the sign as registered has been altered does not even arise.

Simultaneous use of several signs (Class 33)	
Sign as registered	Sign as used

## PRINCIPLES OF THE COMMON PRACTICE:

### ASSESSMENT STEPS

***In the assessment of whether the sign as used constitutes an acceptable variation of its form as registered, the following steps should be taken:***

**STEP 1: Assessment of the Sign as Registered:** Assess the sign as registered by taking into account its distinctive and visually dominant elements.

**STEP 2: Assessment of the Differences in the Sign as Used and the Effect of the Changes:** Assess whether those elements that contribute to the distinctive character of the sign as registered are present and/or modified in the sign as used, in a direct (i.e. side-by-side) comparison of the two signs.

As regards the effect of changes, account must be taken of the greater or lesser degree of distinctive character of the sign as registered.

### ADDITIONS

***When an element is added to the sign as used and it is not considered to be simultaneous use of several signs, it constitutes an addition.***

#### Addition of Distinctive Elements

In principle, the addition of a distinctive element that interacts with the sign as registered in such a manner that it can no longer be perceived independently alters its distinctive character. This is the case both when the sign as registered is of average or of low distinctive character.

Alteration of the distinctive character of the sign as registered (Class 25)	
Sign as registered	Sign as used
No alteration of the distinctive character of the sign as registered (Class 25)	
Sign as registered	Sign as used
GERIVAN	

<p><b>Addition of Non-distinctive Elements and/or Elements of Low Distinctive Character</b></p> <p>In general, if the sign as registered is of average distinctiveness, the addition of non-distinctive elements or elements of low distinctive character does not alter its distinctive character, regardless of whether these elements are visually dominant or not.</p>	<table border="1"> <tr> <th colspan="2" style="background-color: #008000; color: white;">No alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;">GERIVAN</td> <td style="text-align: center;"></td> </tr> </table> <table border="1"> <tr> <th colspan="2" style="background-color: #008000; color: white;">No alteration of the distinctive character of the sign as registered (Class 3)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;">GERIVAN</td> <td style="text-align: center;"><b>BIO</b> GERIVAN</td> </tr> </table>	No alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used	GERIVAN		No alteration of the distinctive character of the sign as registered (Class 3)		Sign as registered	Sign as used	GERIVAN	<b>BIO</b> GERIVAN
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<p>When the sign as registered is of low distinctive character an alteration of its distinctiveness is more likely even if the addition concerns an element of low distinctive character.</p>	<table border="1"> <tr> <th colspan="2" style="background-color: #d9534f; color: white;">Alteration of the distinctive character of the sign as registered (Class 31)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;">FLAVOUR AND AROMA</td> <td style="text-align: center;">BAA-n&amp;&amp;-NAA FLAVOUR AND AROMA</td> </tr> </table>	Alteration of the distinctive character of the sign as registered (Class 31)		Sign as registered	Sign as used	FLAVOUR AND AROMA	BAA-n&&-NAA FLAVOUR AND AROMA						
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**OMISSIONS**

<p><b><i>The sign as registered is considered as a single unit. When an element present in the sign as registered is missing in the sign as used, it constitutes an omission.</i></b></p>													
<p><b>Omission of Distinctive Elements</b></p> <p>All the distinctive elements of the sign as registered contribute to its distinctive character. Therefore, the omission of one of those elements in the sign as used is likely to alter the distinctive character of the sign as registered, unless the omitted elements will be disregarded by the consumer due to their small size and/or position.</p>	<table border="1"> <tr> <th colspan="2" style="background-color: #d9534f; color: white;">Alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;">GERIVAN BUBBLEKAT</td> <td style="text-align: center;">BUBBLEKAT</td> </tr> </table> <table border="1"> <tr> <th colspan="2" style="background-color: #008000; color: white;">No alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;">GERIVAN <i>Bubblekat</i></td> <td style="text-align: center;">GERIVAN</td> </tr> </table>	Alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used	GERIVAN BUBBLEKAT	BUBBLEKAT	No alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used	GERIVAN <i>Bubblekat</i>	GERIVAN
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<p><b>Omission of Non-distinctive Elements and/or Elements of Low Distinctive Character</b></p> <p>If the sign as registered is of average distinctive character the omission of a non-distinctive element in the sign as used is not likely to alter the distinctive character of the</p>	<table border="1"> <tr> <th colspan="2" style="background-color: #008000; color: white;">No alteration of the distinctive character of the sign as registered (Class 3)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;"><b>BIO</b> GERIVAN</td> <td style="text-align: center;">GERIVAN</td> </tr> </table>	No alteration of the distinctive character of the sign as registered (Class 3)		Sign as registered	Sign as used	<b>BIO</b> GERIVAN	GERIVAN						
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<p>sign as registered. This may also generally be the case where the omitted element is of low distinctive character.</p>	<table border="1"> <tr> <th colspan="2" style="background-color: #008000; color: white;">No alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;"></td> <td style="text-align: center;"><b>GERIVAN</b></td> </tr> </table>	No alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used		<b>GERIVAN</b>
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<p>However, it cannot be excluded that the omission of an element of low distinctive character may result in a different outcome, particularly if the omitted element is visually dominant or interacts with other elements.</p>	<table border="1"> <tr> <th colspan="2" style="background-color: #d9534f; color: white;">Alteration of the distinctive character of the sign as registered (Class 30)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;">GERIVAN </td> <td style="text-align: center;">GERIVAN</td> </tr> </table>	Alteration of the distinctive character of the sign as registered (Class 30)		Sign as registered	Sign as used	GERIVAN 	GERIVAN
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<p>If the sign as registered is composed exclusively of elements of low distinctive character and/or of non-distinctive elements, the combination of which renders the sign as a whole registrable, the omission of one or more of these elements will generally alter the distinctive character of the sign as registered.</p>	<table border="1"> <tr> <th colspan="2" style="background-color: #d9534f; color: white;">Alteration of the distinctive character of the sign as registered (Class 31)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;"></td> <td style="text-align: center;"><b>BIO</b></td> </tr> </table>	Alteration of the distinctive character of the sign as registered (Class 31)		Sign as registered	Sign as used		<b>BIO</b>
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**MODIFICATION OF CHARACTERISTICS (e.g. typeface, size, colour, position)**













<p style="text-align: center;"><b>Word Marks</b></p> <p>In principle, the specific representation of the word mark, such as its representation in a particular typeface, stylisation, size, colours, or position, does not alter the distinctive character of the word mark as registered as long as the word remains identifiable as such in the form used.</p> <p>When the word mark is no longer identifiable the distinctive character of the sign as registered will be altered. This is also the case where the sign as registered is of low distinctive character.</p>	<table border="1"> <tr> <th colspan="2" style="background-color: #008000; color: white;">No alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr> <th style="background-color: #d9ead3;">Sign as registered</th> <th style="background-color: #d9ead3;">Sign as used</th> </tr> <tr> <td style="text-align: center;">GERIVAN</td> <td style="text-align: center;"><b>GERIVAN</b></td> </tr> </table>	No alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used	GERIVAN	<b>GERIVAN</b>
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<p style="text-align: center;"><b>Purely Figurative Marks</b></p> <p>In the case of purely figurative marks, distinctiveness derives from the figurative elements in a particular representation. Therefore, modification of the representation is likely to alter the distinctive character, unless it concerns characteristics which are not essential contributors to the distinctive character of the sign. In case of purely figurative marks of low distinctive character, even minor modifications to the mark may lead to an alteration of its distinctive character.</p>	<table border="1"> <tr style="background-color: #008000; color: white;"> <th colspan="2">No alteration of the distinctive character of the sign as registered (Class 9)</th> </tr> <tr style="background-color: #d9ead3;"> <th>Sign as registered</th> <th>Sign as used</th> </tr> <tr> <td style="text-align: center;"></td> <td style="text-align: center;"></td> </tr> <tr style="background-color: #d9534f; color: white;"> <th colspan="2">Alteration of the distinctive character of the sign as registered (Class 31)</th> </tr> <tr style="background-color: #d9ead3;"> <th>Sign as registered</th> <th>Sign as used</th> </tr> <tr> <td style="text-align: center;"></td> <td style="text-align: center;"></td> </tr> </table>	No alteration of the distinctive character of the sign as registered (Class 9)		Sign as registered	Sign as used			Alteration of the distinctive character of the sign as registered (Class 31)		Sign as registered	Sign as used		
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<p><b>Composite Marks</b></p> <p>In general, the more an element contributes to the distinctive character, the more a modification of such element is likely to alter the distinctive character of the sign.</p> <p>In cases where the distinctive character of the sign as registered essentially derives from:</p>													
<p>➤ its verbal elements - use of those elements in a different typeface, colour or size will not normally alter the distinctive character, unless the differences are so significant that they have an impact on the overall impression of the sign as registered.</p>	<table border="1"> <tr style="background-color: #008000; color: white;"> <th colspan="2">No alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr style="background-color: #d9ead3;"> <th>Sign as registered</th> <th>Sign as used</th> </tr> <tr> <td style="text-align: center;"></td> <td style="text-align: center;"></td> </tr> <tr style="background-color: #d9534f; color: white;"> <th colspan="2">Alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr style="background-color: #d9ead3;"> <th>Sign as registered</th> <th>Sign as used</th> </tr> <tr> <td style="text-align: center;"></td> <td style="text-align: center;"></td> </tr> </table>	No alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used			Alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used		
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<p>➤ the combination of verbal and figurative elements - these elements have to be respected;</p> <p>when the arrangement of such elements contributes to the distinctive character, the change of such an arrangement may alter the distinctive character of the sign as registered.</p>	<table border="1"> <tr> <th colspan="2" data-bbox="810 360 1372 427">Alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr> <th data-bbox="810 427 1098 461">Sign as registered</th> <th data-bbox="1098 427 1372 461">Sign as used</th> </tr> <tr> <td data-bbox="810 461 1098 645">  </td> <td data-bbox="1098 461 1372 645"> <p>BUBBLEKAT</p> </td> </tr> </table>	Alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used		<p>BUBBLEKAT</p>
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### COMBINATION OF CHANGES

<p>In practice, different types of changes may be combined in the sign as used.</p> <p>In general, where the changes concern a combination of addition, omission or modifications of characteristics, <b>the respective principles of the Common Practice apply.</b></p> <p>It should be assessed whether any of the changes alone would lead to the alteration of the distinctive character of the sign as registered while the rest of the changes have no decisive impact. If not, the effect of the combination of all changes must be assessed.</p>	<table border="1"> <tr> <th colspan="2" data-bbox="810 792 1372 860">No alteration of the distinctive character of the sign as registered (Class 33)</th> </tr> <tr> <th data-bbox="810 860 1098 893">Sign as registered</th> <th data-bbox="1098 860 1372 893">Sign as used</th> </tr> <tr> <td data-bbox="810 893 1098 1055">  </td> <td data-bbox="1098 893 1372 1055">  </td> </tr> <tr> <th colspan="2" data-bbox="810 1077 1372 1144">Alteration of the distinctive character of the sign as registered (Class 25)</th> </tr> <tr> <th data-bbox="810 1144 1098 1178">Sign as registered</th> <th data-bbox="1098 1144 1372 1178">Sign as used</th> </tr> <tr> <td data-bbox="810 1178 1098 1301">  </td> <td data-bbox="1098 1178 1372 1301">  </td> </tr> </table>	No alteration of the distinctive character of the sign as registered (Class 33)		Sign as registered	Sign as used			Alteration of the distinctive character of the sign as registered (Class 25)		Sign as registered	Sign as used		
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### 3. IMPLEMENTATION

As has been the case with previous common practices, this Common Practice will take effect within three months of the date of publication of this Common Communication. Further details on the implementation of this Common Practice are available in the table below.

Implementing Offices may choose to publish additional information on their websites.

[LINK TO TABLE](#)

**COMMON PRACTICE  
USE OF A TRADE MARK IN  
A FORM DIFFERING FROM  
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**OCTOBER 2020**



## **CP8: USE OF A TRADE MARK IN A FORM DIFFERING FROM THE ONE REGISTERED**

<b>1</b>	<b>Introduction .....</b>	<b>1</b>
1.1	Objective of this document.....	1
1.2	Background .....	1
1.3	Practice Scope .....	3
<b>2</b>	<b>Case-law of the Court of Justice of the European Union .....</b>	<b>4</b>
<b>3</b>	<b>Simultaneous use of several signs.....</b>	<b>5</b>
<b>4</b>	<b>Principles of the Common Practice .....</b>	<b>6</b>
4.1	Key Concepts .....	6
4.1.1	Distinctiveness .....	7
4.1.2	Visual Dominance .....	7
4.1.3	Interactions .....	7
4.2	Assessment steps.....	7
4.2.1	Step 1: Assessment of the Sign as Registered .....	8
4.2.2	Step 2: Assessment of the Differences in the Sign as Used and the Effect of Changes.....	8
4.3	Additions.....	8
4.3.1	Addition of Distinctive Elements .....	8
4.3.2	Addition of Non-distinctive Elements and/or Elements of Low Distinctive Character .....	9
4.4	Omissions.....	11
4.4.1	Omission of Distinctive Elements .....	12
4.4.2	Omission of Non-distinctive Elements and/or Elements of Low Distinctive Character .....	13
4.5	Modification of Characteristics (e.g. typeface, size, colours, position) .....	15
4.5.1	Word Marks.....	15
4.5.2	Purely Figurative Marks .....	18
4.5.3	Composite Marks .....	19
4.6	Combination of changes .....	23

## **1 Introduction**

### **1.1 Objective of this document**

This Common Practice document aims to identify general principles for assessing when the use of a trade mark in a form differing from the one registered alters its distinctive character and to provide guidance in this respect. It serves as a reference for the EUIPO, Benelux Office for Intellectual Property, and Intellectual Property Offices of Member States (hereinafter collectively referred as 'MS IPOs'), User Associations, parties and representatives on the CP8 Common Practice.

It will be made widely available and will be easily accessible, providing a comprehensive explanation of the principles on which the new Common Practice is based. These principles are designed to be generally applied, and aim to cover the large majority of cases. Although alterations of the distinctive character will always be assessed on a case-by-case basis, the principles serve as guidance in order to facilitate that different MS IPOs come to a similar, predictable outcome when assessing the use of signs in forms differing from those registered.

Furthermore, the examples added to this document aim to illustrate the principles of the Common Practice. These examples should be looked at in connection with their reasoning and based on the assumptions on which they rest.

### **1.2 Background**

#### **European Cooperation**

In December 2015, the European Parliament and the Council adopted the EU trade mark reform package. The package contained two legislative instruments, namely Regulation (EU) No 2017/1001 (EUTMR) and Directive (EU) No 2015/2436 (EUTMD), which aim to further approximate the laws of the Member States relating to trade marks. Alongside new provisions on substantive and procedural matters, the texts established a stronger legal basis for cooperative work. Under the terms of Article 151 EUTMR, cooperation with the MS IPOs to promote convergence of practices and tools in the fields of trade marks and designs became a core task for the EUIPO; Article 152 EUTMR explicitly indicates that this cooperation should include the development of common examination standards and the establishment of common practices.

However, MS IPOs and User Associations had been actively cooperating since the creation of the European Union Trade Mark and Design Network (EUTMDN) in 2011, and had already produced concrete results in terms of greater transparency and efficiency. Under the umbrella of convergence, they had been working together to address major issues in trade mark and design practice, harmonising, first of all, examination standards in the area of trade mark classification, and subsequently branching out into the areas of absolute grounds, relative grounds and designs. These collaborative efforts produced two harmonised classification databases — the harmonised database of Goods and Services for trade marks and the harmonised database of Product Indications for designs — and five Common Practices:

- Common Practice on the general indications of the Nice class headings;
- Common Practice on the distinctiveness of figurative marks containing descriptive/non-distinctive words;

- Common Practice on the scope of protection of black and white marks;
- Common Practice on the impact of non-distinctive/weak components of marks in the examination of likelihood of confusion;
- Common Practice on the graphic representation of designs.

With its specific provisions codifying cooperation and convergence of practices into EU Law, the trade mark reform package consolidated the achievements of these harmonisation initiatives and provided a clear mandate for further progress.

Based on this legislative framework, in June 2016, the Management Board (MB) of the EUIPO agreed the launch of the European Cooperation Projects. Reflecting the different activities provided in the EUTMR, the projects were designed to build on past successes while at the same time improving processes and extending the reach of collaboration.

In the area of convergence, it included a project dedicated specifically to the identification and analysis of potential new harmonisation initiatives. The project analysed the trade mark and design practices of the MS IPOs in order to detect areas where divergence existed, and, through an evaluation of likely impact, feasibility of possible scope, existing legal constraints, levels of interest among users and practicality for MS IPOs, determine those areas where a Common Practice would be most beneficial for Network stakeholders. The analysis was carried out in cycles, with each cycle resulting in the recommendation for the launch of a new convergence project.

The Common Practice outlined in this document relates to the first convergence project launched by the MB, and the eighth overall. ‘CP8: *Use of a trade mark in a form differing from the one registered*’ was one of two projects recommended for launch as a result of the opening cycle of convergence analysis, which had centred on the Legal Reform and the impact of the new provisions introduced by the EUTMD.

### **CP8: Use of a trade mark in a form differing from the one registered**

The convergence analysis of this topic uncovered significant divergences between the practices of MS IPOs in relation to the assessment of genuine use when a trade mark is used in a form differing from the one registered.

The former Trade Mark Directive 2008/95/EC did not include an obligation for MS IPOs to provide opposition or cancellation proceedings, nor did it explicitly provide for non-use as a defence within such proceedings. Before entry into force of the EUTMD, only 15 MS IPOs assessed genuine use, the majority being in the context of revocation or invalidity proceedings.

Moreover, MS IPOs providing such assessment issued diverging decisions regarding the degree to which the trade mark owner could make variations without altering its distinctive character.

Such diverging practices created uncertainty among users seeking to protect their rights in different jurisdictions, and resulted in increased costs as they attempted to adapt their strategies to varying, and often conflicting, examination practices. Furthermore, the lack of unified practice on the subject had left the EU IP system out of touch with contemporary market realities, where trade mark owners are constantly adapting their trade marks to respond to evolving market trends.

Adoption of the new EUTMD had an important impact on practices in this area. Article 43 EUTMD introduced the obligation for all Member States to provide for administrative opposition proceedings before their offices by 14 January 2019, and Article 44 EUTMD rendered it compulsory to provide for non-use as a defence in opposition proceedings. Article 45 EUTMD introduced the obligation for all Member States to provide for administrative proceedings before their offices for revocation, on the basis of absence of genuine use, and invalidity by 14 January 2023, and Article 46 EUTMD rendered it compulsory to provide for non-use as a defence in proceedings seeking a declaration of invalidity. While these new provisions contributed significantly to increased legal certainty by imposing more uniform procedures, their upcoming entry into force meant that, at the time of convergence analysis, almost half of MS IPOs were facing the task of incorporating new proceedings and/or assessments into their examination practices.

Moreover, discrepancies in practice that had previously been detected among MS IPOs which assess genuine use may persist. Both Article 16(5)(a) EUTMD and Article 18(1)(a) EUTMR stipulate that: ‘the use of a trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered also constitutes use.’ The wording of these Articles, which is the same as in the former Directive, leaves open to interpretation the notion of ‘a form differing in elements which do not alter the distinctive character’. As this could be — and had been — interpreted differently according to the type of mark (word, figurative, composite) and/or nature of the changes (addition, omission, variation in colour, position, etc.) the assessment remained susceptible to largely subjective decision-making.

In view of the above, the convergence analysis determined that the transposition of the above-mentioned provisions into national laws, and subsequent increase in application of the provisions regarding genuine use, made this topic a priority for convergence. It identified the need to harmonise the practice of those MS IPOs that already assessed proof of use and create an aligned practice for those MS IPOs that will start assessing genuine use.

In this respect, the CP8 project was launched in October 2017 with the objective of establishing a set of common criteria and principles for assessing when changes in the sign as used lead to an alteration of the distinctive character of the sign as registered, and when they do not.

### **1.3 Practice Scope**

This Common Practice delivers a set of principles and examples on the use of a trade mark in a form differing from the one registered by taking into account the impact of additions, omissions, and modifications of characteristics on the distinctive character of registered word marks, purely figurative marks and composite marks (combination of verbal and figurative elements).

The following issues are out of scope of the Common Practice:

- Types of marks other than word marks, purely figurative marks and composite marks, in particular, shape marks, position marks, pattern marks, colour marks and other non-traditional marks.
- Descriptions, colour claims and disclaimers. Although they might have an impact on the assessment, they are not taken into account for the purpose of this Common Practice as the signs are assessed based on the representations shown in the examples provided.

- Enhanced distinctive character through use (reputation, well-known character) and its impact on the assessment.
- Definition of genuine use and the MS IPOs' methodology in its examination.
- Definition of factors to be considered when assessing genuine use (i.e. place, time and extent of use).
- Means of evidence to be filed in order to prove genuine use of a sign (e.g. catalogues, invoices, price lists or surveys). The reasoning provided with all examples is based on the assumption that the representation of the sign as used in these examples is the only means/manner of use presented in the supporting evidence <sup>(1)</sup>.
- Procedural aspects related to opposition, revocation and/or invalidity.
- Description of legal constraints preventing implementations in particular MS IPOs.
- Linguistic issues (all examples are in English, and it will be assumed that they will be understood by the relevant public).

## **2 Case-law of the Court of Justice of the European Union**

Pursuant to Article 16(5)(a) EUTMD, the use of a trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered also constitutes genuine use, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor.

As confirmed by the Court of Justice of the European Union (the Court), the purpose of this provision is to avoid imposing a requirement of strict conformity between the form in which the mark is used in trade and the form in which the trade mark was registered, thus allowing the proprietor of a trade mark, in the commercial exploitation of the sign, to make variations in the sign which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50; 18/07/2013, C-252/12, Specsavers, EU:C:2013:497, § 29). Therefore, it is not necessary to find the sign as used in strict conformity with the sign as registered and a certain flexibility is allowed as long as variations of the sign as registered do not alter its distinctive character. This must be assessed on a case-by-case basis.

The Court has also established that the obligation to use the trade mark which was registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade, where the sign used in trade differs from the form in which it was registered only in insignificant respects, such that the two signs can therefore be regarded as broadly equivalent (10/12/2015, T-690/14, Vieta, EU:T:2015:950, § 31; 12/03/2014, T-381/12, Palma Mulata, EU:T:2014:119, § 26; 10/06/2010, T-482/08, Atlas Transport, EU:T:2010:229, § 30). The Court further mentioned that a finding that the distinctive character of the mark as registered has been altered requires an assessment of the distinctive and dominant character of the added elements, carried out on the basis of the intrinsic qualities of each of those elements, as well as of the relative position of the various elements within the arrangement of the mark (see, to that effect, judgments of 15/07/2015, T-215/13, LAMBDA (λ), EU:T:2015:518, § 28; 24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 36, 40; 10/06/2010, T-482/08, Atlas Transport, EU:T:2010:229, § 31).

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<sup>(1)</sup> The assessment of whether the sign as used constitutes an acceptable variation of its registered form must be based on the evidence provided by parties in the particular case.

The Court has held that account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the earlier (registered) mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the goods and services within the sign as used. The reverse is also true (13/09/2016, T-146/15, DARSTELLUNG EINES VIELECKS (fig.), EU:T:2016:469, § 29).

Moreover, the Court has confirmed that the condition of genuine use of a registered trade mark may be satisfied where a registered trade mark is used in conjunction with or as a part of another mark, as long as the differences resulting from the form in which the mark is used do not change the distinctive character of the trade mark as registered (see to that effect judgments of 18/07/2013, C-252/12, Specsavers, EU:C:2013:497, § 31; 18/04/2013, C-12/12, Colloseum Holding, EU:C:2013:253, § 36).

Finally, the Court referred to situations where several signs are used simultaneously in an autonomous way and therefore, the sign as registered is perceived independently within that combination. The situation is not, in this case, that the sign as registered is used in a form different to the one in which it was registered, but that several signs are used simultaneously (see, to that effect, judgments of 08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 33, 34; 06/11/2014, T-463/12, MB, EU:T:2014:935, § 43;).

### **3 Simultaneous use of several signs**

In view of the above-mentioned case-law on signs that are used simultaneously and before examining the principles of the Common Practice, the following must be taken into consideration.





Signs are often used together with other signs in trade (e.g. to designate a sub-brand and/or a house mark or together with a company name). That use does not fall within the ambit of 'alteration of distinctive character of the sign as registered'. When several signs are used together but remain independent from each other and perform their distinguishing function as separate signs, the question of whether the distinctive character of the sign as registered has been altered does not even arise.

Whether the signs will be perceived independently or as forming part of one and the same sign must be determined on the basis of a global assessment, taking into account various factors, such as:

- the characteristics of the signs themselves (dominant and distinctive elements; their respective position; use in a different size, typeface or colour; presence or absence of syntactical or grammatical connections, etc.);
- the way the signs are presented in the evidence of use and the context of use (trade sector concerned, nature of the signs i.e. company names, house marks, product-line identifiers, sub-brands etc.);
- specific evidence capable of establishing that the signs are perceived independently by the consumers.



Examples:

Simultaneous use of several signs			
Sign as registered	Sign as used	Goods and services	Reasoning
		Class 33: Wine	The sign as registered is used together with another distinctive sign indicating the name of the winery — Bubblekat Winery. In the wine sector, it is common to use the product name and the winery name together on the label. The sign as registered will be perceived independently in the sign as used.
GERIVAN	GERIVAN by BUBBLEKAT Ltd.	Class 25: Clothing, footwear and headgear	The sign as registered, GERIVAN, is used together with a company name, BUBBLEKAT Ltd. The sign as registered will be perceived independently in the sign as used.
		Class 5: Pharmaceutic al products	The sign as registered, MAPALVAM, is used together with another distinctive sign, i.e. house mark. In the pharmaceutical sector it is common that the product name appears together with the house mark. The sign as registered will be perceived independently in the sign as used.

## 4 Principles of the Common Practice

This chapter introduces the types of changes that can occur in the sign when used in a form differing from the one registered, namely when elements are added, omitted, modified or when these changes appear in combination.

For the assessment of these changes, and whether they constitute an alteration of the distinctive character of the sign as registered, certain principles need to be applied. These principles are set out below together with key concepts and assessment steps.

### 4.1 Key Concepts

To ensure a harmonised and consistent application of the principles of the Common Practice, a common understanding of certain key concepts, which are important to assess whether variations of the sign as registered alter its distinctive character, is necessary.

#### 4.1.1 Distinctiveness

According to settled case-law, distinctiveness of a trade mark means that the sign serves to identify the goods and/or services for which the trade mark is registered as originating from a particular undertaking, and thus to distinguish those goods and/or services from those of other undertakings<sup>(2)</sup>.

Distinctiveness must be assessed by reference to the relevant goods or services and to the consumer's perception of the sign.

It is necessary to distinguish between (i) the analysis of the distinctive character of the sign as registered as a whole, and (ii) the analysis of the distinctive character of the different elements of the sign.

#### 4.1.2 Visual Dominance

For the purpose of this document, visual dominance refers to the visual impact of the elements of a sign i.e. if one element is visually outstanding compared to the others in the sign. This is primarily determined by its position, size and/or use of colours (to the extent that they affect its visual impact). In this context, the assessment of visual dominance does not apply to word marks.

If elements are likely to be disregarded by the consumer due to their size and/or position, they do not play a role in the assessment.

#### 4.1.3 Interactions

The interactions between the elements in the sign may play a role when assessing if the sign as registered maintains its distinctive character when used<sup>(3)</sup>.

Elements within the sign interact when they are positioned, combined or interlinked so as to give the impression of a single unit. Such an impression may also result from a conceptual interaction when a conceptual unit (a new concept) is created.

### 4.2 Assessment steps

In the assessment of whether the sign as used constitutes an acceptable variation of its form as registered, the following steps should be taken:

Step 1: Assess the sign as registered by taking into account its distinctive and visually dominant elements.

Step 2: Assess the differences in the sign as used and the effect of the changes.

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<sup>(2)</sup> See to that effect, judgments of 29/04/2004, joined cases C-468/01 P to C-472/01 P, *Tabs (3D)*, EU:C:2004:259, § 32.

<sup>(3)</sup> See to that effect, judgment of 15/07/2015, T-215/13, *LAMBDA (λ)*, EU:T:2015:518, § 29.

#### 4.2.1 Step 1: Assessment of the Sign as Registered

The first step is to establish which elements contribute to the distinctive character of the sign as registered.

In the case of a sign consisting of a single element, it is the sign itself that carries its distinctive character. In the case of a sign consisting of several elements, this assessment requires an analysis of the distinctive and visually dominant character of its elements, based on the intrinsic qualities of each and their relative position within the arrangement of the sign, as well as their interactions<sup>(4)</sup>.

#### 4.2.2 Step 2: Assessment of the Differences in the Sign as Used and the Effect of Changes

Once those elements that contribute to the distinctive character of the sign as registered have been identified and the degree of their distinctiveness determined, it should be established whether they are present and/or modified in the sign as used, in a direct (i.e. side by side) comparison of the two signs.

At this point, an assessment of the added, omitted or modified elements should be made, based on the intrinsic qualities and the relative position of the various elements within the arrangement of the sign<sup>(5)</sup>, and their interactions. The overall impression produced by the signs must also be taken into account.

As regards the effect of changes, account must be taken of the greater or lesser degree of distinctive character of the sign as registered. In general, signs of an average degree of distinctiveness, will be less influenced by changes. Conversely, signs of a low distinctive character (usually signs that are mainly or exclusively composed of elements of low distinctiveness) are, in general, more prone to an alteration of their distinctive character<sup>(6)</sup>.

### 4.3 Additions

For the purpose of this document, when an element is added to the sign as used, and it is not considered to be simultaneous use of several signs, it constitutes an addition. The impact of the addition in relation to the distinctive character of the sign as registered must be assessed.

#### 4.3.1 Addition of Distinctive Elements

In principle, the addition of a distinctive element that interacts with the sign as registered in such a manner that it can no longer be perceived independently alters its distinctive character. This is the case both when the sign as registered is of average or of low distinctive character.


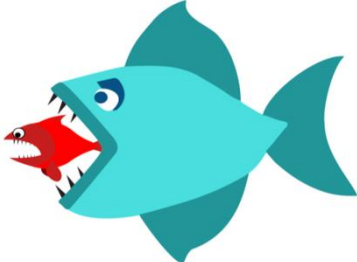
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<sup>(4)</sup> See to that effect, judgment of 24/11/2005, T-135/04, *Online Bus*, EU:T:2005:419, § 36.

<sup>(5)</sup> See to that effect, judgments of 15/07/2015, T-215/13, *LAMBDA (λ)*, EU:T:2015:518, § 28; 21/11/2005, T-135/04, *Online Bus*, EU:T:2005:419 § 36.

<sup>(6)</sup> See to that effect, judgment of 13/09/2016, T-146/15, *DARSTELLUNG EINES VIELECKS (fig.)*, EU:T:2016:469, § 29.

Examples:

Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
		Class 25: Clothing, footwear and headgear	The sign as registered is used with a distinctive figurative element (blue fish) in such a manner that a single unit and a new concept is created in the sign as used (the big fish eating the small one). Such a change alters the distinctive character of the sign as registered.
ICE	BREAKING THE ICE	Class 25: Clothing, footwear and headgear	The sign as registered is used in combination with other distinctive verbal elements. These elements interact in such a manner that a new concept is created. Therefore, the distinctive character of the sign as registered is altered.

No alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
GERIVAN		Class 25: Clothing, footwear and headgear	Assuming that this is not considered to be a case of use of several signs simultaneously (see chapter 3), the added figurative element does not interact with the sign as registered and is perceived independently within the sign as used. Therefore, the distinctive character of the sign as registered is not altered.

#### 4.3.2 Addition of Non-distinctive Elements and/or Elements of Low Distinctive Character




In general, if the sign as registered is of average distinctiveness, the addition of non-distinctive elements or elements of low distinctive character does not alter its distinctive character<sup>(7)</sup>, regardless of whether these elements are visually dominant or not.

<sup>(7)</sup> See to that effect, judgment of 13/09/2016, T-146/15, DARSTELLUNG EINES VIELECKS (fig.), EU:T:2016:469, § 31.

Examples:

No alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
GERIVAN	<b>SUPER GERIVAN</b>	Class 25: Clothing, footwear and headgear	GERIVAN is used with a non-distinctive verbal element, SUPER, which only qualifies GERIVAN. The added non-distinctive element does not alter the distinctive character of the sign as registered.
	<b>SUPERGERIVAN</b>		
GERIVAN	GERIVAN VISION	Class 5: Medical eye drops	GERIVAN is used with a descriptive word, VISION. The added non-distinctive element does not alter the distinctive character of the sign as registered.
GERIVAN		Class 25: Clothing, footwear and headgear	GERIVAN is used with a non-distinctive geometric shape background. The added non-distinctive element does not alter the distinctive character of the sign as registered.
GERIVAN	WWW.GERIVAN.COM	Class 25: Clothing, footwear and headgear	GERIVAN is used with a non-distinctive domain indicator. The added non-distinctive elements do not alter the distinctive character of the sign as registered <sup>(8)</sup> .
BUBBLEKAT	BUBBLEKAT PARIS	Class 25: Clothing, footwear and headgear	BUBBLEKAT is used with a non-distinctive geographical term, PARIS. The added non-distinctive element does not alter the distinctive character of the sign as registered.
GERIVAN		Class 25: Footwear	GERIVAN is used with a non-distinctive figurative element representing shoes, which, despite being visually dominant, does not alter the distinctive character of the sign as registered.

<sup>(8)</sup> Provided that the evidence of use shows use of the domain name as indicator of the commercial origin of the goods and services.

GERIVAN		Class 33: Wine	GERIVAN is used on a wine label of low distinctive character, which is rather standard. Such an addition does not alter the distinctive character of the sign as registered.
GERIVAN	<b>BIO</b> <b>GERIVAN</b>	Class 3: Laundry Preparations	GERIVAN is used with a non-distinctive verbal element, BIO, which despite being visually dominant, does not alter the distinctive character of the sign as registered.
	<i>Everyday Clothing Concept</i> 	Class 25: Clothing, footwear and headgear	The addition of elements of a low distinctive character, EVERYDAY CLOTHING CONCEPT, although visually dominant, does not alter the distinctive character of the sign as registered.

When the sign as registered is of low distinctive character, an alteration of its distinctiveness is more likely, even if the addition concerns an element of low distinctive character.

Example:

Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
FLAVOUR AND AROMA	BAA-n&d-NAA FLAVOUR AND AROMA	Class 31: Fruits	The sign as registered is of low distinctiveness. The added element BAA-naa-NAA, which is also of low distinctiveness, is placed at the beginning and interacts with the sign as registered by creating a new concept. Such changes alter the distinctive character of the sign as registered.

#### 4.4 Omissions





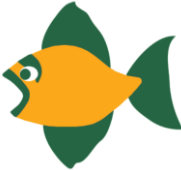
As a starting point, the sign as registered is considered as a single unit. When an element present in the sign as registered is missing in the sign as used, it constitutes an omission. The impact of the omission on the distinctive character of the sign as registered must be assessed.



#### 4.4.1 Omission of Distinctive Elements

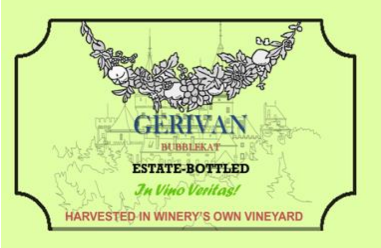
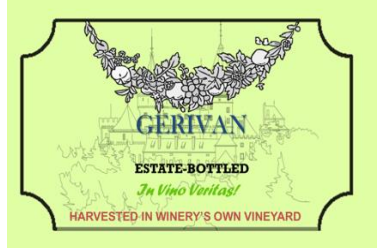
All the distinctive elements of the sign as registered contribute to its distinctive character. Therefore, the omission of one of those elements in the sign as used is likely to alter the distinctive character of the sign as registered.

Examples:

Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
GERIVAN BUBBLEKAT	BUBBLEKAT	Class 25: Clothing, footwear and headgear	The sign as registered is composed of two distinctive verbal elements, GERIVAN and BUBBLEKAT. Both of them equally contribute to the distinctive character of the sign as registered. Therefore, the omission of one of those elements results in an alteration of the distinctive character.
 <b>Bubblekat</b>	<b>Bubblekat</b>	Class 25: Clothing, footwear and headgear	The sign as registered is composed of two distinctive elements, Bubblekat and the depiction of a stylised fish. Both of them equally contribute to the distinctive character of the sign as registered. The omission of one of those elements results in an alteration of the distinctive character.
 <b>Bubblekat</b>		Class 25: Clothing, footwear and headgear	The sign as registered is composed of two distinctive elements, the depiction of a stylised fish and a verbal element, Bubblekat. Both of them equally contribute to the distinctive character of the sign as registered. The omission of one of those elements results in an alteration of the distinctive character.
		Class 25: Clothing, footwear and headgear	The sign as registered is composed of two distinctive elements, the depiction of a stylised tree and a fish. Both of them equally contribute to the distinctive character of the sign as registered. The omission of one of those elements results in an alteration of the distinctive character.

In cases where the elements in the sign as registered will be disregarded by the consumer due to their small size and/or position, their omission in the sign as used will not alter the distinctive character of the sign as registered.


Examples:


No alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
<p><b>GERIVAN</b></p> <p><i>Bubbleray</i></p>	<p><b>GERIVAN</b></p>	Class 25: Clothing, footwear and headgear	The distinctive character of the sign as registered is not altered as the omitted element will be disregarded by the consumer due to its small size and position.
		Class 33: Wine	The distinctive character of the sign as registered is not altered as the omitted element will be disregarded by the consumer due to its small size and position.

#### 4.4.2 Omission of Non-distinctive Elements and/or Elements of Low Distinctive Character

If the sign as registered is of average distinctive character, the omission of a non-distinctive element in the sign as used is not likely to alter the distinctive character of the sign as registered. This may also generally be the case where the omitted element is of low distinctive character.


Examples:

No alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
<p><b>BIO</b></p> <p><b>GERIVAN</b></p>	<p><b>GERIVAN</b></p>	Class 3: Laundry Preparations	The distinctive character of the sign as registered derives from the distinctive verbal element, GERIVAN. The omission of the non-distinctive element BIO, despite being visually dominant, does not alter the distinctive character of the sign as registered.
<p><b>SUPER GERIVAN</b></p>	<p><b>GERIVAN</b></p>	Class 25: Clothing, footwear and headgear	The distinctive character of the sign as registered derives from the distinctive verbal element, GERIVAN. SUPER is non-distinctive, therefore its omission does not alter the distinctive character of the sign as registered.
	<p><b>GERIVAN</b></p>	Class 25: Clothing, footwear and headgear	The distinctive character of the sign as registered derives from the distinctive verbal element, GERIVAN. The omission of

			the non-distinctive geometric shape background does not alter the distinctive character of the sign as registered.
<b>The Fence</b>	<b>Fence</b>	Class 9: Mobile phones	The distinctive character of the sign as registered mainly derives from the distinctive word, 'Fence'. The omission of the article (the) does not alter the distinctive character of the sign as registered.
 <b>GERIVAN</b>	<b>GERIVAN</b>	Class: 30 Coffee	The distinctive character of the sign as registered derives from the distinctive verbal element, GERIVAN. The omission of the non-distinctive figurative element depicting a coffee bean, despite being visually dominant, does not alter the distinctive character of the sign as registered.

However, it cannot be excluded that the omission of an element of low distinctive character may result in a different outcome, particularly if the omitted element is visually dominant or interacts with other elements.



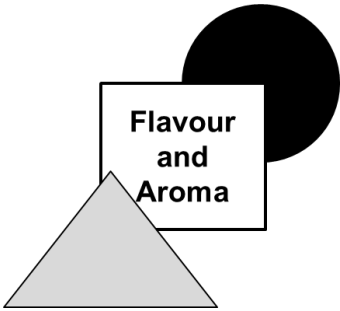

Examples:

Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
	<b><i>Bubblekat</i></b>	Class 9: Credit Card	The distinctive character of the sign as registered derives from the distinctive verbal element, BUBBLEKAT, and the other elements in the sign. These other elements, despite being of low distinctive character, interact and are visually dominant due to their size and prominent position. The omission of these dominant elements alters the distinctive character of the sign as registered.
<b>GERIVAN</b> <b>AROMA</b>	<b>GERIVAN</b>	Class 30: Coffee	The distinctive character of the sign as registered derives from the combination of the distinctive word, GERIVAN, and the element AROMA, presented in a stylised typeface, which adds some distinctiveness to that verbal element. Moreover, the latter element, despite being of low distinctive character, appears in a size which visually dominates the sign as registered. The omission of such a dominant element

			alters the distinctive character of the sign as registered.
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If the sign as registered is composed exclusively of elements of low distinctive character and/or of non-distinctive elements, the combination of which renders the sign as a whole registrable, the omission of one or more of these elements will generally alter the distinctive character of the sign as registered.

Examples:





Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
		Class 31: Cat food	The distinctive character of the sign as registered derives from the combination of non-distinctive and low distinctive elements, namely Bio and the stylisation of the letter O resembling a cat. The combination of both elements renders the sign as a whole registrable. Therefore, the omission of one of the elements alters the distinctive character of the sign as registered.
		Class 30: Coffee	The distinctive character of the sign as registered derives from the combination of simple geometric shapes and descriptive words. The combination of such elements renders the sign as a whole registrable. Therefore, the omission of some of these elements alters the distinctive character of the sign as registered.





## 4.5 Modification of Characteristics (e.g. typeface, size, colours, position)

### 4.5.1 Word Marks

In principle, the specific representation of the word mark, such as its representation in a particular typeface, stylisation, size, colours, or position, does not alter the distinctive character of the word mark as registered as long as the word remains identifiable as such in the form used.

Examples:


No alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
GERIVAN		Class 25: Clothing, footwear and headgear	The sign as registered is used in colour and remains identifiable as such in the form used. Therefore, such use does not alter the distinctive character of the sign as registered.
GERIVAN			
GERIVAN		Class 25: Clothing, footwear and headgear	The sign as registered is used in a particular typeface which is not outstanding and remains identifiable as such in the form used. Therefore, the use in such a typeface does not alter its distinctive character.
GERIVAN BUBBLEKAT	GERIVAN BUBBLEKAT	Class 25: Clothing, footwear and headgear	The distinctive verbal elements are identifiable as such in the form used despite the change in their position. Such a change does not alter the distinctive character of the sign as registered.
GERIVAN BUBBLEKAT	BUBBLEKAT GERIVAN	Class 25: Clothing, footwear and headgear	The distinctive verbal elements, despite being used in an inverse order, do not create a new concept and remain identifiable in the form used. Such a change does not alter the distinctive character of the sign as registered.
GERIVAN		Class 25: Clothing, footwear and headgear	The change in size of the letters G and N does not lead to a new concept and the sign as registered remains identifiable as such in the form used. Therefore, such use does not alter the distinctive character of the sign as registered.

BIO GERIVAN		Class 3: Laundry Preparations	The sign as registered, BIO GERIVAN, is composed of two verbal elements, Bio and Gerivan. Despite changes in the position, size and colour of the element BIO, the sign as registered remains identifiable as such in the form used. Therefore, such use does not alter the distinctive character of the sign as registered.
GERIVAN		Class 25: Clothing, footwear and headgear	The sign as registered is identifiable as such in the form used. The change of typeface (use in a slightly stylised form) and colour does not alter its distinctive character.
GERIVAN BUBBLEKAT		Class 25: Clothing, footwear and headgear	The distinctive verbal elements are identifiable as such in the form used. The change of colour, size and position does not alter its distinctive character.
GERI		Class 25: Clothing, footwear and headgear	The sign as registered is identifiable as such in the form used. The stylisation is not outstanding and does not alter its distinctive character.

When the word mark is no longer identifiable as such, for example, due to use of the word in an outstanding stylisation or due to modifications of characteristics that change the meaning of the verbal element (e.g. where the inverse order of the verbal elements leads to a different meaning or where a graphically highlighted part of the verbal element has a meaning of its own), the distinctive character of the sign as registered will be altered.

This is also the case where the sign as registered is of low distinctive character.

Examples:

Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
GERIVAN		Class 25: Clothing, footwear and headgear	The sign as registered is no longer identifiable as such in the form used, as it is illegible. Therefore, the distinctive character of the sign as registered is altered.
LOVE YOUNG	YOUNG LOVE	Class 25: Clothing, footwear and headgear	Although both verbal elements of the sign as registered are present in the sign as used, their use in an inverse order changes the meaning of the sign as registered. Therefore, the distinctive character is altered.
BUBBLEKAS	BUBBLEMAS	Class 25: Clothing,	The change of the letter 'K' to 'M' does not allow the





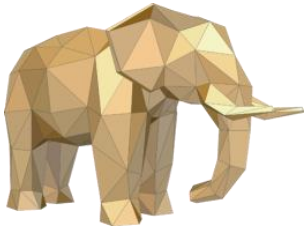





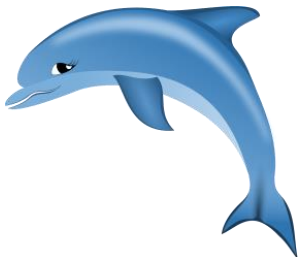



		footwear and headgear	identification of the sign as registered in the form as used. Therefore, the distinctive character of the sign as registered is altered.
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#### 4.5.2 Purely Figurative Marks

In the case of purely figurative marks, distinctiveness derives from the figurative elements in a particular representation. Therefore, modification of the representation is likely to alter the distinctive character of the sign as registered, unless it concerns characteristics (e.g. colour, shape) which are not essential contributors to the distinctive character of the sign.

Examples:

No alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
		Class 9: Software	The distinctive character of the sign as registered derives from the particular representation of a mountain in brown. As the colour brown does not essentially contribute to the distinctive character of the sign as registered, its change to grey does not alter the distinctive character of the sign as registered.
		Class 25: Clothing, footwear and headgear	The distinctive character of the sign as registered derives from both the representation of a dolphin and the colour combination of magenta and white. The inversion of colours in the example, which maintain the same contrast, does not alter the distinctive character of the sign as registered.
		Class 25: Clothing, footwear and headgear	The distinctive character of the sign as registered derives from the particular representation of the elephant in light brown. Use of the elephant in a different position does not constitute a significant change, and therefore such change does not alter the distinctive character of the sign as registered.

Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
		Class 31: Bananas	The distinctive character of the sign as registered derives only from the particular representation of the banana in pink (fantasy colour). The use of the banana in its natural colour (yellow) alters the distinctive character of the sign as registered.
		Class 9: Software	The distinctive character of the sign as registered derives from the particular representation of the dolphin in true-to-life colours. The change of such colours to those resembling black and white zebra stripes is striking for dolphins and constitutes a significant change. Such use alters the distinctive character of the sign as registered.
		Class 25: Clothing, footwear and headgear	Although the concept of an elephant in the sign as registered is maintained in the sign as used, the modifications of the representation, namely the shape, the position and stylisation of the elephant are significant enough to alter the distinctive character of the sign as registered.









In case of purely figurative marks of low distinctive character, even minor modifications to the mark may lead to an alteration of its distinctive character.

#### 4.5.3 Composite Marks





In composite marks, in principle, both the verbal and the figurative elements contribute to the distinctive character of the sign, at least to a certain extent. In general, the more an element contributes to the distinctive character, the more a modification of such element is likely to alter the distinctive character of the sign.

In cases where the distinctive character of the sign as registered essentially derives from its verbal elements, use of those elements in a different typeface, colour or size will not normally alter the distinctive character (see section 4.5.1. above), unless the differences are so significant that they have an impact on the overall impression of the sign as registered.

Examples of when the distinctive character of the sign as registered essentially derives from its verbal elements:



No alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
		Class 25: Clothing, footwear and headgear	The distinctiveness of the sign as registered essentially derives from the distinctive verbal elements, GERIVAN and BUBBLEKAT. The change of colour from light green to blue and red are not so significant as to have an impact on the overall impression of the sign as registered.
		Class 25: Clothing, footwear and headgear	The distinctiveness of the sign as registered essentially derives from the distinctive verbal element, GERIVAN. The change of the colour of the background and the verbal element from black to white and vice versa, maintaining the same contrast, is not so significant as to have an impact on the overall impression of the sign as registered. Therefore, such a change does not alter the distinctive character of the sign as registered.
		Class 25: Clothing, footwear and headgear	The distinctiveness of the sign as registered essentially derives from its verbal element, GERIVAN. The verbal element is used in a different typeface, which does not differ so significantly as to have an impact on the overall impression of the sign as registered. Therefore, such a change does not alter the distinctive character of the sign as registered.
		Class 32: Mineral Water	The distinctiveness of the sign as registered essentially derives from its verbal element, GERIVAN, as the representation of a mountain may allude to the characteristics of the goods. The changes in the typeface, position and size of the distinctive verbal element are not so significant as to alter the distinctiveness of the sign as registered.



		<p>Class 25: Clothing, footwear and headgear</p>	<p>The distinctiveness of the sign as registered essentially derives from its verbal element, GERIVAN. The changes in the size and the shade of green of the first and the last letters are not so significant as to have an impact on the overall impression of the sign as registered. Therefore, such changes do not alter the distinctive character of the sign as registered.</p>
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Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
		<p>Class 25: Clothing, footwear and headgear</p>	<p>The distinctiveness of the sign as registered essentially derives from its verbal element GERIVAN. The change of the typeface to one which makes the verbal element illegible constitutes a significant difference between the sign as used and its registered form.</p>
		<p>Class 32: Mineral Water</p>	<p>The distinctiveness of the sign as registered derives from its verbal element, GERIVAN, as the representation of a mountain may allude to the characteristics of the goods. The use of the verbal element, split into GERI and VAN, leads to significant differences that have an impact on the overall impression of the sign as registered. The change in colour of both the figurative and the verbal elements reinforces the conclusion.</p>

For composite marks in which the distinctive character essentially derives from its figurative elements, modifications of the representation of those elements are more likely to alter the distinctive character of the sign as registered, unless they concern characteristics (e.g. stylisation, layout or colour) which are not essential contributors to the distinctive character of the sign (see section 4.5.2. above).





Examples of when the distinctive character of the sign as registered essentially derives from its figurative elements:

No alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
		Class 25: Clothing, footwear and headgear	The distinctiveness of the sign as registered derives essentially from its figurative element depicting a brown mountain, as 'Best quality!' will be perceived as descriptive. As the colour brown does not essentially contribute to the distinctive character, its change to light brown as well as its position does not alter the distinctive character of the sign as registered.

Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
<p><b>FLAVOUR AND AROMA</b></p>	<p>FLAVOUR AND AROMA</p>	Class 30: Coffee	The distinctiveness of the sign as registered derives from the particular typeface/graphic stylisation of the verbal elements, as the verbal elements themselves are non-distinctive. The only distinctive aspect of the sign as registered disappears in the form used. Therefore, the use of such verbal elements in a standard typeface alters the distinctive character of the sign as registered.
		Class 25: Clothing, footwear and headgear	The distinctiveness of the sign as registered derives essentially from the representation of a brown mountain, as 'Best quality!' will be perceived as descriptive. The modification of the depiction of the mountain is so significant as to alter the distinctiveness of the sign as registered.

When the distinctive character of the sign derives from both the verbal and figurative elements (including their characteristics such as stylisation, layout or colour), these elements have to be respected. When the arrangement of such elements contributes to the distinctive character, the change of such an arrangement may alter the distinctive character of the sign as registered.

Examples of when the distinctive character of the sign derives from the verbal and figurative elements:

Alteration of the distinctive character of the sign as registered			
Sign as registered	Sign as used	Goods and services	Reasoning
		Class 30: Coffee	The distinctiveness of the sign as registered derives from both the verbal element, which will be perceived as GER, and a figurative element depicting geometrical shapes. In the form used the verbal element GER is replaced by GERI, which appears in a standard typeface, and the figurative element disappears completely. Such changes alter the distinctive character of the mark as registered.
		Class 25: Clothing, footwear and headgear	The distinctiveness of the sign as registered derives from both the verbal elements, BUBB and LEKAT, and their particular stylisation. In the form used, the verbal elements BUBB and LEKAT appear as one word and in a standard typeface. Such changes alter the distinctive character of the mark as registered.

#### 4.6 Combination of changes

In practice, different types of changes may be combined in the sign as used.

Four types of combinations can be identified:

- Combination of changes that involves omitting certain elements of the sign as registered and adding other elements.
- Combination of changes that involves modifying certain characteristics of the sign as registered and adding other elements.
- Combination of changes that involves omitting certain elements of the sign as registered and modifying certain characteristics of the elements that remain.
- Combination of changes that involves omitting certain elements of the sign as registered, modifying certain characteristics of the elements that remain and adding other elements.

In general, where the changes concern a combination of addition, omission or modifications of characteristics, **the respective principles of the Common Practice apply**. Therefore,













changes affecting distinctive elements will generally lead to an alteration of the distinctive character of the sign as registered, while those affecting non-distinctive elements or elements of a low distinctive character are less likely to alter the distinctive character of the sign as registered.

In the case of a combination of changes it should be assessed whether any of the changes alone (e.g. the omission of an element) would lead to the alteration of the distinctive character of the sign as registered while the rest of the changes have no decisive impact.







If no such single change leads to the alteration of the distinctive character of the sign as registered, the effect of the combination of all changes must be assessed. It may be the case that only the accumulation of changes would lead to an alteration of distinctive character.

The examples below illustrate cases where changes to non-distinctive elements or elements of a low degree of distinctiveness do not alter the distinctive character:

No alteration of the distinctive character of the sign as registered		
Sign as registered	Sign as used	Goods and services
		Class 25: Clothing, footwear and headgear
		Class 25: Clothing, footwear and headgear
		Class 33: Wine
		Class 25: Clothing, footwear and headgear



		Class 9: Software
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The examples below illustrate cases where changes to a distinctive element or elements of a low degree of distinctiveness alter the distinctive character:

Alteration of the distinctive character of the sign as registered		
Sign as registered	Sign as used	Goods and services
Sign as registered is of an <b>average degree of distinctiveness</b> :		
<b>Main change:</b> Addition of a distinctive element		
		Class 25: Clothing, footwear and headgear
		Class 25: Clothing, footwear and headgear
<b>Main change:</b> Modification of a distinctive element		
		Class 25: Clothing, footwear and headgear

		<p>Class 25: Clothing, footwear and headgear</p>
<p><b>Main change:</b> Omission of a distinctive element</p>		
<p>GVL GERI VAN LYR</p>		<p>Class 25: Clothing, footwear and headgear</p>
<p>Sign as registered is of a <b>low degree of distinctiveness</b>:</p>		
<p><b>Main change:</b> Modification of the main contributor to the distinctive character (typeface/stylisation)</p>		
<p>FLAVOUR AND AROMA Superior quality</p>		<p>Class 30: Coffee</p>
		<p>Class 31: Bananas</p>
	<p>FRESH SARDINE</p>	<p>Class 29: Sardines</p>

**Main change:** Omission of elements of low distinctive character and/or of non-distinctive elements (combination of which renders the sign as a whole registrable)

		Class 30: Bakery
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