

**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⁽¹⁾;
- 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.

¹ 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>Addition of Non-distinctive Elements and/or Elements of Low Distinctive Character</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;">BIO 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 | BIO 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&&-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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| FLAVOUR AND AROMA | BAA-n&&-NAA FLAVOUR AND AROMA | | | | | | | | | | | | |

OMISSIONS





































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.




| <p>Omission of Distinctive Elements</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>Omission of Non-distinctive Elements and/or Elements of Low Distinctive Character</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;">BIO 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 | BIO 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;">GERIVAN</td> </tr> </table> | No alteration of the distinctive character of the sign as registered (Class 25) | | Sign as registered | Sign as used | | GERIVAN |
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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;">BIO</td> </tr> </table> | Alteration of the distinctive character of the sign as registered (Class 31) | | Sign as registered | Sign as used | | BIO |
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MODIFICATION OF CHARACTERISTICS (e.g. typeface, size, colour, position)

| <p style="text-align: center;">Word Marks</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;">GERIVAN</td> </tr> </table> | No alteration of the distinctive character of the sign as registered (Class 25) | | Sign as registered | Sign as used | GERIVAN | GERIVAN |
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| <p style="text-align: center;">Purely Figurative Marks</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>Composite Marks</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, the respective principles of the Common Practice apply.</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](#)