



Frequently Asked Questions (FAQ)
on Common Practice

**CP11: NEW TYPES OF MARKS:
EXAMINATION OF FORMAL
REQUIREMENTS AND GROUNDS FOR
REFUSAL**

APRIL 2021

CP11 FREQUENTLY ASKED QUESTIONS

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1 THE COMMON PRACTICE

1.1 General

1.1.1 *What is the purpose of this Common Practice?*

Before this convergence project was launched, there was an absence of established practice among the EU Member States' Intellectual Property Offices (MS IPOs) regarding the filing requirements and examination standards for new types of trade mark, namely sound, motion, multimedia and hologram marks. Taking advantage of the lack of practice regarding these topics, the Common Practice was created to prevent future misalignments, multiplicity of practices and legal uncertainty caused as a consequence of the elimination of the graphical representation requirement from the EU Trade Mark Directive. The Common Practice sets out agreed principles and will serve as a reference document for IPOs, User Associations (UAs), applicants, opponents and representatives, thereby enhancing legal certainty.

1.1.2 *Has the Common Practice taken into account EU case-law?*

Given that the CP11 Common Practice concerns the criteria for the examination of formal requirements and grounds for refusal and invalidity of new types of mark and the new ways of representing them, there is an absence of practice in this area and a lack of relevant case-law. Nevertheless, any relevant European, national and regional case-law, as well as decisions that may be applicable, were analysed and used as a reference and inspiration for both the principles and the examples in the document.

1.2 Scope

1.2.1 *Which are the new types of mark that are included in the scope of the Common Practice? Why?*

Sound, motion, multimedia and hologram marks are the only new types of mark that are included in the scope of the Common Practice. The reason for not including other non-traditional marks, such as position, pattern, shapes, etc. is that these have not been affected by the elimination of the graphical representation requirement. In accordance with the legal reform, only the aforementioned marks can be represented using different and new means of representation, such as audio/video files.

1.2.2 *Does the Common Practice deal with how new types of mark would be filed and registered with the Madrid System?*

No. Even though the Common Practice aims to establish general principles for the examination of formal requirements for sound, motion, multimedia and hologram marks, the particular implications these types of mark may have in a national jurisdiction, and their interoperability with the Madrid system, are excluded from the scope of the document.

1.2.3 *Why does the Common Practice refer to the examination of relative grounds for refusal but exclude the assessment of likelihood of confusion from the scope?*

Although there are many factors that may have an impact on the global appreciation of likelihood of confusion, such as the dominant components, enhanced or acquired distinctiveness, the degree of attention of the relevant public, coexistence, market conditions, family of marks, etc., it is not the objective of the Common Practice to determine what all those factors are, nor the criteria for their assessment, nor the interdependency between them. Consequently, in terms of relative grounds, the Common Practice's scope is limited to that of the essential aspects of the assessment of likelihood of confusion, which is the comparison of signs from the visual, aural and conceptual perspectives.

1.2.4 *If 'distinctiveness' and 'dominance of elements' in the mark are out of scope, why does the Common Practice refer to these aspects?*

Even though 'distinctiveness' and 'dominance of elements' in the mark are out of the scope of the Common

Practice, they are referred to within the document strictly for the purposes of carrying out a realistic comparison of the signs (e.g. when, in the assessment, the document highlights that a melody is considered distinctive, or conversely, that a movement is banal). The use of such terms within the document does not mean that the Common Practice seeks to define or harmonise existing definitions.

1.2.5 When the Common Practice mentions ‘traditional trade marks’, to which types of trade marks does it refer?

It refers only to word marks, purely figurative marks and composite marks (combination of verbal and figurative elements).

1.3 Principles of the Common Practice: examination of formal requirements

1.3.1 Is there any document where the definitions and means of representation for sound, motion, multimedia and hologram marks can be found?

Yes. The MS IPOs and EUIPO agreement on common definitions and means of representation for the new types of trade mark can be found in the ‘*Common Communication on the representation of new types of trade marks*(¹)’ (hereinafter, ‘CCNTM’).

1.3.2 Based on the definition of a ‘sound mark’ established in the CCNTM, what signs can be registered as a sound mark?

Following the definition of sound marks established in the CCNTM, any sign containing one or more sounds, regardless of the kind of sound contained in it (e.g. verbal elements perceived in the sound, a sound in nature, sounds of animals, a melody, etc.) can be registered as a sound mark.

1.3.3 What are the necessary requirements for a graphically represented sound mark to be considered clear and precise?

In line with the Court of Justice of the EU’s ‘Shield Mark’ judgment (27/11/2003, C-283/01, Musical notation, EU:C:2003:641), an accurate representation of a musical notation must include all those elements that are necessary to determine its clear and precise subject matter of protection. Those requirements are satisfied where the sign is represented by a staff divided into measures (bars) and showing, in particular, a clef and all the musical notes that are necessary to reproduce the melody.

This means that an applicant can obtain the registration of a sound mark represented by a musical notation without the need to indicate the tempo or speed of the melody and/or the instrument(s) used to reproduce the melody.

1.3.4 Are the requirements established in the Shield Mark case an open or closed list when referring to an accurate musical notation?

The requirements established in the Shield Mark case are a closed list. After analysing the Court of Justice of the EU’s ‘Shield Mark’ judgment (27/11/2003, C-283/01, Musical notation, EU:C:2003:641), it was agreed that it only refers to the tempo in relative terms, that is the proportional duration between the different notes of the melody, which includes rests, silences, etc. However, that judgment does not mention the tempo in absolute terms, that is the speed of the melody (usually measured in beats per minute) nor the instrument that is used to reproduce the melody. Therefore, those elements cannot be considered as necessary requirements for a graphically represented sound mark to be considered clear and precise.

(¹) https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/who_we_are/common_communication/commo_n_communication_8/common_communication8_en.pdf

1.3.5 *If the tempo or speed of the melody and/or the instrument(s) are not necessary requirements to be indicated in a sound mark represented graphically to be considered clear and precise, why should they be indicated by the applicant?*

Even though the tempo or speed of the melody and the instrument(s) are optional elements to be indicated in a graphically represented sound mark, they play an important role when it comes to the assessment of identity in a priority claim or in a relative grounds proceeding. More concretely, the absence of those elements in a graphically represented sound mark will mean the rejection of a priority claim when the file formats of the filings are not identical. Additionally, such absence might also have an impact on the assessment of the relative grounds for refusal and invalidity when the assessment of the identity of the subject matter or its comparison involves graphically represented sound marks.

1.3.6 *Based on the definition of a ‘motion mark’ established in the CCNTM, what can be registered as a motion mark?*

Following the definition of a motion mark established in the CCNTM, this type of mark is not restricted to signs depicting movement. A sign may also be qualified as a motion mark if it is capable of showing a change in the position of the elements (for instance, a sequence of stills), a change of colour or a change of elements, understood as the replacement of one image by another.

1.3.7 *What is the role of the description accompanying a motion mark when it is represented by a sequence of still images?*

The description accompanying a motion mark represented graphically is not mandatory. However, if added it may serve to clarify the duration, repetitions and the speed of the motion/movements, and the necessary elements to clearly understand the movement of the mark. It is important to bear in mind that, when examining a priority claim involving two motion marks represented in different formats (video file versus sequence of still images), such a description explaining the cited elements may play an important role since its absence may result in a refusal. Additionally, such absence might also have an impact on the assessment of the relative grounds for refusal and invalidity when the assessment of the identity of the subject matter or its comparison involves graphically represented motion marks.

1.3.8 *Based on the definition of a ‘multimedia mark’ established in the CCNTM, what can be registered as a multimedia mark?*

Following the definition of multimedia marks established in the CCNTMs, any sign consisting of a combination of visual and audio elements should be classified as a multimedia mark.

1.3.9 *Can an audiovisual file that includes a black or white screen combined with a sound be considered a multimedia mark?*

Yes. The fact that an audiovisual file contains a black or white screen combined with a sound does not preclude the mark from being classified as a multimedia mark. This is because the file would still fulfil the formal requirements established by the CCNTM, that is, the combination of image and sound. Nevertheless, it should be borne in mind that the fact that a black or white screen combined with a sound can be qualified as a multimedia mark does not imply that the sign contained in it will overcome the absolute grounds for refusal established in Article 4 TMD.

1.3.10 *Based on the definition of a ‘hologram mark’ established in the CCNTM, what can be registered as a hologram mark?*

Following the definition of a hologram mark established in the CCNTM, any sign consisting of elements with holographic characteristics should be classified as a hologram mark. In this regard, a hologram is an image that changes its appearance when looked at from different angles. For instance:

1. A hologram can be a physical flat structure that uses light diffraction to create visual images.
2. A hologram can be a digital projection or visualisation of an object displayed via *light field displays*.

1.3.11 Which features may be included in the holographic characteristics of a hologram mark?

Holographic characteristics may include some of the following features:

- image swapping effect; image morphing effect;
- three-dimensional volume effect, e.g. image appears to emerge;
- three-dimensional deep effect, e.g. image appears to have depth;
- rotating and/or moving three-dimensional elements in digital holograms;
- digitally visualised effects, e.g. on LED display.

1.3.12 What has to be shown when the hologram mark is represented in a series of sequential still graphic or photographic images?

The images must display all the views from different angles that are necessary to sufficiently identify the holographic effect in its entirety, particularly its height, width, depth and/or morphing effects of the three-dimensional image.

1.3.13 Can a sign containing elements with holographic characteristics and other background elements, such as platforms, frames, hands, etc., be registered as a hologram mark?

Yes. A sign can be registered as a hologram mark even if its representation includes background elements, such as platforms, frames, hands, etc., provided that it contains verbal and/or figurative elements with holographic characteristics. However, it should be borne in mind that, when the hologram mark includes such background elements, they will form part of the scope of protection of the relevant mark.

1.3.14 Can a description be added to accompany the representation of a sound, motion, multimedia and/or hologram mark?

The CCNTM, agreed by all the MS IPOs and the EUIPO, only refers to the possibility of adding a description to one of the new types of trade mark analysed in the CP11 Common Practice, namely, 'motion marks'. However, the fact that the CCNTM does not refer to the possibility of adding a description to other types of trade mark does not preclude the possibility that some IPOs may also accept them. In any event, if added, it should be noted that the description has to be in accordance with the representation of the trade mark and must not contradict the representation of the mark or extend its scope.

1.3.15 Taking into account that image files are an acceptable means for representing sound, motion and figurative marks, can a musical notation or a sequence of still images be registered as a figurative mark?

Yes. If the application does not contain any other information indicating that the applicant's intention was to apply for another type of trade mark, the mark will be accepted according to the type of trade mark selected by the applicant, for example, a figurative mark, provided that the representation of the mark complies with the legal requirements for that specific type. In these cases, the scope of protection and the subject matter of the trade mark will vary according to the type of mark accepted.

1.3.16 Can a priority claim be accepted when the two filings are for different types of trade mark?

Yes. Although the filings are for different types (e.g. 'other mark' versus 'multimedia mark'), a priority claim may be accepted provided that both filings have an identical subject matter.

1.3.17 Will the format in which the marks are represented have an impact on the outcome of a priority claim?

No. The outcome of a priority claim will be the same regardless of the format in which the filings are represented.

1.3.18 What are the elements that should be indicated in a graphically represented sound mark in order to accept a priority claim where the other filing is represented by an audio file?

The musical notation must indicate the Shield mark case requirements (27/11/2003, C-283/01, Musical notation, EU:C:2003:641), that is, a staff divided into measures (bars) and showing, in particular, a clef and all the musical notes that are necessary to reproduce the melody, **as well as** the tempo, understood as the speed of the melody and the instrument(s) used to reproduce it (optional elements).

1.3.19 Why will the lack of indication of optional elements (tempo/instrument) in a musical notation result in the refusal of a priority claim when the two sound marks are represented in different formats?

Taking into account that a priority claim involving two sound marks represented by means of an audio file will be rejected when they consist of the same melody but are reproduced at a different speed or played with different instrument(s), the outcome would have to be the same when the two sound marks are represented in different formats, that is, one with a musical notation and the other in an audio file.

Therefore, even though it is possible for an applicant to register a sound mark represented graphically without the indication of the tempo or speed of the melody and/or without the indication of the instrument(s) used to reproduce the melody, the consequence of not indicating them in the musical notation will imply a rejection when assessing a priority claim that involves such musical notation with another sound mark consisting of the same melody but represented by an audio file, since in the latter the tempo and the instrument(s) are already fixed.

1.3.20 Can a difference in the type of instrument (i.e. a piano and a grand piano or a classic guitar and an electric guitar), or the fact that two different musicians reproduce the melody, have an impact on the assessment of priority claims of a sound mark when they are represented in different formats?

The differences between a melody reproduced by a piano and the same melody reproduced by a grand piano, and the differences between a melody played by different musicians or in different styles should not be found prejudicial to conclude identity in a priority claim examination, as long as the Shield mark case requirements (27/11/2003, C-283/01, Musical notation, EU:C:2003:641), together with the optional elements, are indicated in the musical notation.

1.3.21 How can examiners determine the scope of protection of a sound mark represented in a musical notation?

When a sound mark is represented graphically by means of a musical notation, in order to know what the applicant intends to protect, it is necessary for the examiner to reproduce the melody for which protection is intended. This is especially relevant when examining the absolute and relative grounds for refusal and also when assessing a priority claim where at least one of the marks is a sound mark represented graphically.

1.3.22 When a priority claim involves two motion marks where the first filing is represented in a video file and the second filing in a sequence of still images, why can a description be required?

In those cases where the first filing is represented in a video file and the second filing is represented in a sequence of still images, and the complete movement of the motion mark cannot be clearly identified from the latter, a description can be requested from the applicant in order to explain the movement, duration, repetitions, etc. This request is only to ensure that the subject matter of both filings is identical; the

description requested will never extend the scope of protection of the mark.

1.4 Principles of the Common Practice: examination of absolute grounds for refusal

1.4.1 Will a consumer perceive a sound, motion, multimedia or hologram as an indication of commercial origin?

Consumers are accustomed to perceiving conventional types of trade mark such as word and figurative marks as indications of commercial origin. However, this is not necessarily the case when perceiving a sound, motion, multimedia or a hologram mark, since these may not necessarily be affixed to or used with the goods and/or services. For this reason, the Common Practice includes different subsections to address the consumer's perception when confronted with any of the new types of trade mark.

1.4.2 What is the purpose of the groups of sound and motion marks included in the Common Practice for the sake of analysis of consumer perception?

The purpose of the groups of sound and motion marks that have been included in the Common Practice is to facilitate and ensure the full comprehension of the differences that may appear when analysing the consumer's perception when confronted with different sounds and motions. In addition, it is important to keep in mind that these are non-exhaustive lists of groups, and that they should not be understood as a classification of the different types of sound marks or motion marks that can be filed.

1.4.3 Can a particular arrangement of different elements of sounds, such as lyrics, a specific melody, intonation and/or a specific way of singing render the mark distinctive as a whole despite containing non-distinctive/descriptive/generic verbal elements?

Yes. Despite containing non-distinctive/descriptive/generic verbal elements, if a particular arrangement of different elements of sounds is unusual and can be easily recognised by the consumer as an indication of commercial origin, then the sound mark can be considered distinctive as a whole.

1.4.4 What other document should be taken into account when assessing distinctiveness of motion, multimedia and/or hologram marks that contain non-distinctive/descriptive/generic verbal and/or figurative elements?

When assessing distinctiveness of motion, multimedia and hologram marks containing non-distinctive/descriptive/generic verbal and/or figurative element(s) the CP3 Common Principles ⁽²⁾ should be taken into account.

1.4.5 Can a particular movement render a motion mark that contains non-distinctive/descriptive/generic verbal or figurative elements distinctive as a whole?

Yes. But only if the particular movement is unusual and striking in itself or creates an unusual and striking visual impact.

1.4.6 Would it be possible for a multimedia mark consisting of a combination of both non-distinctive/descriptive/generic image(s) and sound(s) to be considered distinctive?

Yes. When the multimedia mark contains both non-distinctive/descriptive/generic image(s) and sound(s), it could be possible that such a combination would render the multimedia mark distinctive as a whole when applied for certain goods and/or services.

⁽²⁾ <https://www.tmdn.org/network/documents/10181/278891cf-6e4a-41ad-b8d8-1e0795c47cb1>

1.4.7 Does the holographic effect have an impact on the distinctiveness of a hologram mark?

Given that the registration of a hologram as a trade mark is a relatively new matter, it is too soon to be certain of the impact that a holographic effect could have on the distinctiveness of a mark. In this regard, the Common Practice leaves open the possibility of a particular holographic effect to be sufficient to render a mark distinctive as a whole, when added to a non-distinctive/descriptive/generic verbal and/or figurative element(s).

1.4.8 Does the applicant obtain exclusive rights for the non-distinctive/descriptive/generic verbal and/or figurative element(s) of a new type of trade mark that has been considered distinctive as a whole, due to, for instance, the existence of a particular arrangement of elements of sounds or a particular movement?

No. The distinctive character lies in the sign as a whole and therefore the scope of protection is limited to the overall composition of the mark, and not to the descriptive/non-distinctive verbal and/or figurative element on its own. Therefore, in those cases the applicant will not obtain exclusive rights for the non-distinctive/descriptive verbal and/or figurative element(s) of the mark.

1.5 Principles of the Common Practice: examination of relative grounds for refusal

1.5.1 Considering that some marks may be represented by different means of representation (e.g. sound marks in musical notation or MP3 file), will the format in which the marks are represented have an impact on the outcome of the comparison of a new type of mark from the visual, aural and/or conceptual point of view?

No. The outcome of the visual, aural and/or conceptual comparison will be the same regardless of the format in which the marks are represented.

1.5.2 What is the purpose of the 'Preliminary remarks' table in Part C – Examination of relative grounds for refusal?

The Preliminary remarks table includes several assumptions applicable to all the examples included in that part of the Common Practice. The table has been included to ensure a harmonised understanding and application of the principles in all the examples.

1.5.3 Why is identity not assessed in Part C, Examination of relative grounds for refusal?

Part A, Section 3, Examination of priority claims of the Common Practice already addresses the concept of identity when it mentions that 'a sign will be considered identical with a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer'.

Taking the above into consideration as well as the General Court of the EU's judgment of 20/02/2013, T-378/11, Medinet, EU:T:2013:83⁽³⁾, it was agreed to reference the concept of identity set out in Part A of the Common Practice, in order to avoid repetition and to ensure identity in the context of relative grounds was still addressed.

1.5.4 Why is the comparison between two sound, motion and hologram marks when they are represented in different formats not addressed in Part C, Examination of relative grounds for refusal?

Considering that Part A, Examination of formal requirements, of the Common Practice addresses the outcome of a priority claim that involves two sound, motion and hologram marks that are represented in

⁽³⁾ This judgment establishes that, if a concept is used in different provisions of a legal measure, it must, for reasons of coherence and legal certainty, and particularly if it is to be interpreted strictly, be presumed to mean the same thing, irrespective of the provision in which it appears.

different formats, and that the outcome of the assessment is the same regardless of the format, it was decided not to include any reference in Part C on how to carry out the visual, aural and conceptual comparison of such marks represented in different formats. The reason was to avoid repetition and make the document more user friendly and easy to read.

1.5.5 Does the pronunciation of the verbal element contained in a sound mark or in the sound of a multimedia mark have any impact on the aural comparison of such marks between them or with other types of marks?

Yes. The pronunciation of the verbal element in a sound or a multimedia mark is already fixed and, therefore, the way in which it is reproduced in the mark has to be taken into account. However, in the case of a word mark (or another type of mark containing written verbal elements), the pronunciation of the verbal element will depend on the rules of pronunciation of the relevant public. For this reason, if the verbal element in the sound mark or in the sound of the multimedia mark is sung, such marks will be aurally similar to a certain extent to marks which contain the same element in written form, whereas if it is spoken with normal intonation following the rules of pronunciation of the relevant public, then the marks could be considered aurally at least highly similar.

1.6 Examples in the Common Practice

1.6.1 Are the examples in the Common Practice taken from real trade mark applications?

No. Since it could be either beneficial or harmful to the corresponding owners or applicants, using real examples in the Common Practices involving either national or EU trade marks has been avoided. Instead, real cases are used as inspiration to create clear-cut examples that can serve to illustrate the principles, conclusions and recommendations included in the document.

1.6.2 Why does the Common Practice include examples in which sound and motion marks are represented graphically if the conventional ways of representing those types of marks are out of the scope of the CP11 project?

The objective of including such examples is to provide examiners and users with clear guidance on:

- the consequences of selecting a concrete type of mark when filing a trade mark using a means of representation which is valid for more than one type of mark. By way of example, even though a musical notation in an image file is a valid means of representing a sound mark, this can also be accepted as a figurative mark and, therefore, if the applicant selects figurative mark, and no other information indicates that the intention was to apply for another type of trade mark, the protection offered by the registration will not cover the sound.
- the outcome of a priority claim that involves two sound, motion, or hologram marks represented by different means of representation (e.g. graphically represented and audio/video file).

1.6.3 Should it be understood that the examples included in Part A of the Common Practice can be registered as trade marks because they do not fall under any of the grounds for refusal of Article 4(1) TMD?

No. The examples in Part A of the Common Practice are included to illustrate the corresponding principles included in Part A regarding the examination of formal requirements of the new types of trade mark, but do not necessarily fulfill the requirements for absolute grounds for refusal of Article 4(1) TMD.

1.6.4 Should it be understood that the examples included in Part B of the Common Practice that do not fall under a concrete ground for refusal mean that they cannot fall under any other grounds for refusal of Article 4(1) TMD?

The fact that the examples do not fall under the concrete ground for refusal that they are illustrating does not mean that those examples do not fall under any other grounds for refusal. For instance, the fact that an

example is considered clear and precise may not necessarily imply that it will be considered distinctive according to Article 4(1)(b) TMD. Likewise, the fact that an example is considered non-descriptive does not imply that it will be considered inherently distinctive.

1.6.5 The Common Practice includes three tables with a text explaining hypothetical hologram marks instead of including real representations of hologram marks. What is the reason behind this?

With regard to the examples illustrating the principles related to hologram marks, the initial intention was to create an example for each part of the Common Practice. However, the fact that holograms need a physical surface or structure to be seen makes them difficult to create and less malleable for modification. This situation hindered the creation of more examples as for the rest of the marks.

In this regard, instead of leaving the principles contained in Part B. Subsection 3.5.3 Non-distinctive hologram marks, and Section 4.5 Descriptive hologram marks, without suitable examples, there was a common agreement to include verbal wordings explaining how a hologram would have to be depicted. This wording aims to illustrate for the readers of the Common Practice, at least to some degree, the principle behind the relevant sections, and to help both the users and the examiners to understand the principles.

1.6.6 Why do some examples include the degree of similarity, particularly, the wording 'to a certain extent'? What does it mean?

Although the general approach in Part C of the Common Practice is to mention in the reasoning only if the marks are 'similar' or 'dissimilar' from each perspective (visual, aural, conceptual), in some of the examples it was very complicated to find a common agreement without mentioning the degree of similarity. Since some MS IPOs found specific examples similar to a low degree whereas, for others, the degree of similarity was higher (including average and high), the expression '*similar to a certain extent*' was included instead of deleting valuable examples.

The relevant wording, as stated in the preliminary remarks that apply to all the examples included in Part C, means that the signs are similar but not necessarily to a high or average degree.

1.6.7 Why is the expression of 'at least highly similar' used in some of the examples included in Part C?

The expression 'at least highly similar' is used to mean that the marks can be aurally identical or at least highly similar. This was agreed as a compromise between the MS IPOs because, for some, it is not possible for two such marks to be aurally identical due to the differences in the types of mark.

2 Methodology

2.1 How were IPOs and UAs involved in the project?

Different questionnaires about the examination of formal requirements, absolute and relative grounds for refusal of new types of trade mark were sent out to the MS IPOs, non-EU IPOs and UAs to collect and analyse their replies.

Furthermore, at several stages of the project, the draft Common Practice was published to get feedback from all the interested parties to guarantee that any concerns expressed could be considered, analysed and discussed by the Working Group members in the corresponding meetings (Working Groups, workshops, etc.). Additionally, when a meeting was not preceded by a publication, external consultations took place, in which the document was circulated among different stakeholders in order to collect feedback to be addressed and discussed during those meetings.

2.2 When an MS IPO decides to implement, what effect will the Common Practice have on its past/ongoing/future proceedings?

Each implementing MS IPO provides information about their implementation date and whether the Common Practice will apply to trade mark proceedings (examination/opposition/cancellation) pending on the implementation date and/or initiated after this date. This information is included in the Common Communication document.

2.3 Can non-EU IPOs implement the Common Practice?

Yes. Non-EU IPOs are welcome to implement the Common Practice. The more implementing Offices there are, the wider the reach of the Common Practice and, therefore, the more efficient and transparent the respective IP systems for users and Offices.

2.4 Can an MS IPO implement the Common Practice at any time?

Yes. All MS IPOs are strongly encouraged to implement the Common Practice, regardless of their participation and contribution to the project. Full Network-wide convergence is dependent on the number of implementing Offices. Therefore, the more implementing MS IPOs there are, the closer we will be to fulfilling that goal. More implementing Offices means a wider reach of the Common Practice and thus greater legal certainty, transparency and efficiency of IP practices across the EU.

2.5 Can the MS IPOs opt-out of the Common Practice?

MS IPOs implement the practice on a voluntary basis. Any MS IPO that opts out of the Common Practice, even partially, will not be considered an implementing Office. The only exception to this rule is if an MS IPO cannot fully implement the Common Practice due to unavoidable legal constraints. In this case, the MS IPO can still be considered an implementing Office on the understanding that they fully implement the Common Practice as soon as the legal constraints are removed.

2.6 What is the difference between the Common Communication and the Common Practice documents?

Through the Common Communication, the MS IPOs inform users about the implementation of the respective Common Practice in their Offices. In this document, the proceedings and concrete dates on which the Common Practice will be implemented are included after confirmation from the respective MS IPOs. Additionally, it contains a summary of the key principles and examples of the Common Practice document. It is published simultaneously by the MS IPOs and the EUIPO on their respective websites.

The Common Practice is the result of the agreement reached between the EUIPO, MS IPOs and UAs on the general principles regarding the concrete topic of the project.

2.7 What would happen if, for instance, there is a judgment/decision regarding the principles stated in a Common Practice?

Should there be any case-law regarding the principles stated in a Common Practice, the ECP4 sub-project, 'Maintenance of Common Practices', which was launched in September 2020, could analyse and study that case-law and decide whether or not it is necessary to adapt the relevant document to the newly issued case-law.