

Newsalert

IP, TMT & Data Protection Department

Use of a trademark in a form differing from the one registered: the common position of the European Intellectual Property Offices

On October 15, 2020, the common practice "**CP8 - Use of a trademark in a form differing from the one registered**" was published simultaneously by the intellectual property offices of each Member State, concerning the use of trademarks in a form different from the one in which they were registered (hereinafter, the "**Common Practice**"). The Common Practice was drafted by EUIPN (European Union Intellectual Property Network) - an organization that brings together national and regional IP offices of the European Union, the EUIPO, international partners and customers of the Office to build a stronger IP network in the European Union.

The issue addressed by the Common Practice is relevant especially with reference to the legal procedure of revocation on grounds of non-use of the trademark. The latter is expressed in the Italian law (art. 24 and 26 of the Italian Industrial Property Code, "**CPI**") and in the European law (art. 18 and 54 of the Regulation 2017/1001 on the European Union Trademark). In particular, the legislation provides for the revocation of a trademark that is not genuinely used within five years from registration or whose use is suspended for an uninterrupted period of five years. It should be specified that the non-use does not determine, per se, the forfeiture, the latter must be requested by a third party with an action before an intellectual property office or before the competent court.

The relevant Italian and European regulations provide that the use of the trademark in a modified or different form, even if not registered, which does not alter the distinctive character of the trademark as registered, is considered material. Hence the importance of the Common Practice, which provides useful indications in order to decide whether the use of the trademark in a modified form alters its distinctive character causing as a consequence its irrelevance in order to prevent the revocation for non-use of signs already registered. In fact, it is frequent, in company practice, to proceed with modifications, updating, revisions of the trademarks actually used, and it is equally important to consider the consequences of such modifications on the registered signs in order to proceed with correct management choices regarding the trademark portfolio in order to preserve its topicality and effectiveness.

The CP8 project that led to the publication of the Common Practice is part of the European Cooperation Projects oriented to the identification and analysis of potential new harmonization initiatives. The Common Practice is the result of consultations and contributions presented by stakeholders over the last two years, as well as the fruitful collaboration of the working group, composed of experts from national and regional EU intellectual

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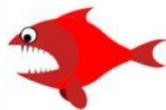
property offices and user associations. This project was launched in October 2017 with the aim of identifying a set of **common criteria and principles** to assess when changes in the sign used lead to an alteration of the distinctive character of the registered sign and when, on the contrary, they do not.

The Common Practice analyzes the impact of additions, omissions and changes in characteristics, as well as combinations of these changes, on the distinctive character of word marks, purely figurative marks and composite marks of word and figurative elements. With reference to the possible changes that a registered trademark may undergo in the course of its use, a detailed list of cases is provided showing when the variation suffered by the trademark may cause, for example, the alteration of the distinctive character and, consequently, lead to a non-use of the trademark as registered.

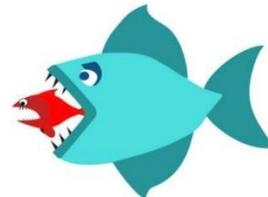
For the purposes of the above evaluation, the Common Practice suggests to proceed in two steps: (i) to consider the registered sign with reference to its distinctive and visually dominant elements, determining which elements contribute to the distinctive character of the sign in question; and (ii) once these elements have been identified, it is necessary to establish whether these elements recur in the actual use made of the sign, making a direct comparison between the two versions and evaluating the differences in the use of the sign and the effect of the changes made.

In the case shown below, for example, the sign as recorded is used with a distinctive figurative element (blue fish) so that in the sign as used a single unit is created and a new concept is created (the big fish eating the small one). Such a change alters the distinctive character of the sign as registered.

Sign as registered



Sign as used



On the contrary, in the case indicated below, assuming that it is not a case of using several signs at the same time, the added figurative element does not interact with the sign as recorded and is perceived independently within the sign as used. Therefore, the distinctive character of the sign as registered is not altered.

Sign as registered

GERIVAN

Sign as used



GERIVAN

With reference to the implementation of the Common Practice, a table has been published indicating, for each Member State, the date of implementation and whether the Common Practice will be applicable to proceedings in progress at the date of implementation or only to proceedings initiated after that date. As far as **Italy** is concerned, the chosen approach foresees that the Common Practice will be applicable only to procedures started after the date of implementation scheduled for **January 15, 2021**.

In conclusion, even if the alterations of the distinctive character will always need to be assessed on a case-by-case basis, the principles outlined in the Common Practice will most likely constitute guidelines that will facilitate the harmonization of the practical application of such judgements by the intellectual property offices

of the different Member States, ensuring that they arrive at a similar and predictable result when called upon to assess the use of signs in forms other than those recorded. In view of the fact that actions for revocation for non-use may also be dealt with before the Courts, it will be necessary, eventually, to evaluate how the Common Practice will affect judicial decisions.

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