

## **COMMON COMMUNICATION**

# **EVIDENCE IN TRADE MARK APPEAL PROCEEDINGS: FILING, STRUCTURE AND PRESENTATION OF EVIDENCE, AND THE TREATMENT OF CONFIDENTIAL EVIDENCE**

**APRIL 2021**

## 1 BACKGROUND

The Intellectual Property Offices of the European Union Intellectual Property Network<sup>(1)</sup> continue to collaborate in the context of converging trade mark and design practices. They have now agreed on an additional Common Practice/Common Recommendations document on trade marks with the aim of providing general principles regarding evidence in trade mark appeal proceedings, in particular, its types, means, sources and identification of relevant dates, as well as its structure and presentation, and the treatment of confidential evidence.

This Common Practice/Common Recommendations document is made public through this Common Communication with the purpose of further increasing transparency, legal certainty and predictability for the benefit of examiners, internal and external appeal bodies and users alike.

This Common Practice/Common Recommendations document delivers a set of guiding, non-binding principles regarding evidence in trade mark appeal proceedings. The following issues are **in scope**:

- types of evidence and their admissibility at the stage of appeal proceedings;
- means and sources of evidence, including its genuineness, veracity and reliability;
- establishing the relevant date of evidence;
- ways to present evidence: structure and presentation, including acceptable formats, size and volume, index of annexes and templates; and
- confidentiality of evidence.

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

- assessment of the probative value of evidence;
- language related issues;
- description of legal constraints preventing implementations;
- updating the guidelines;
- the following means of evidence: oral evidence, inspections, opinions by experts and requests for information;
- trade mark infringement proceedings before courts;
- circumstances in which the appeal bodies and MS IPOs should allow third parties or other administrative bodies/courts to access confidential evidence/data filed during the proceedings; and
- personal data related matters, except anonymisation.

## 2 THE COMMON PRACTICE

The following text summarises the key messages and the main statements of the principles of the Common Practice/Common Recommendations. The complete text can be found in Annex 1.

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<sup>(1)</sup> including internal appeal bodies in IPOs, which are a part of the Network

## PRINCIPLES OF THE COMMON PRACTICE/ COMMON RECOMMENDATIONS

### GENERAL CONCEPTS

#### ***Evidence; Admissibility of evidence at the stage of appeal proceedings***

The preliminary chapter outlines general concepts, identifies four types of evidence and considers their admissibility at the appeal proceedings stage. It provides a common terminology – a common language – to define types of evidence that aligns with EU case-law and provides a framework of common understanding. Those definitions serve only as guidance, in particular for the parties and their representatives, producing greater transparency and predictability, especially at the EU level, in proceedings before the EUIPO's BoA. It is also recommended, only if applicable under the pertinent national law, for other appeal bodies to use those definitions. This chapter also presents recommendations on factors that may be taken *in favour* (e.g. if the evidence is likely to be relevant for the outcome of the case) or *against* (e.g. if the party is knowingly employing delaying tactics or demonstrating manifest negligence) the admissibility of evidence in appeal proceedings.

### MEANS AND SOURCES OF EVIDENCE

#### ***The production of documents and items of evidence; Online evidence: sources, reliability and presentation; Genuineness, veracity and reliability of evidence, and criteria for its assessment***

The first main chapter of the Common Practice/Common Recommendations document provides information in the form of a non-exhaustive list of the means of evidence which may be submitted in trade mark proceedings. Additionally, a table with a summary of the most common types of trade mark cases and the aim of filing evidence is included in this chapter. The chapter also contains a comprehensive section offering guidance on the sources, reliability and presentation of online evidence, covering electronic databases and website archives, editable and non-editable websites, website analytics, social media, video- and photo-sharing websites, hyperlinks and URL addresses, e-commerce platforms, apps, metadata as well as factors that can affect accessibility to information on the internet. It offers a harmonised approach to online evidence that aligns with and extends the Common Practice - *Criteria for assessing disclosure of designs on the internet* and, as a result, offers greater transparency and predictability in addition to guidance on presenting these kinds of evidence. Finally, this chapter addresses some factors that should be taken into consideration while assessing the genuineness and veracity of evidence.

### ESTABLISHING THE RELEVANT DATE OF EVIDENCE

#### ***Documentary evidence: establishing the date of documents; Online evidence: tools to determine the relevant date; The period and timing of a market survey***

This chapter offers guidance on undated, or unclearly dated documentary evidence, as well as a non-exhaustive list of tools which can help to determine the date when particular evidential content was published on the internet. In this context, the following tools can be used: search engines and website archiving services, computer-generated timestamps or forensic software tools. Recommendations in this regard are aligned with the Common Practice - *Criteria for assessing disclosure of designs on the internet*. The final matter in this chapter provides guidance on the period and timing of a market survey.

## WAYS TO PRESENT EVIDENCE

### ***Presentation of evidence: acceptable formats, size and volume; Structure of the evidence; Structure of market surveys; Templates***

In its first section, this chapter addresses how evidence should be presented in all types of filings, paper filings (including filings of any physical items), electronic/e-filings, fax filings and via data carriers. Further, it presents special requirements for printouts and screenshots and refers to the size and volume of evidence. Moreover, this section includes a summary table: *A full overview of all accepted formats to submit evidence in trade mark appeal proceedings*, which is based on the practice of internal and external appeal bodies. This could be a valuable resource for users and their representatives when filing in a specific or in multiple jurisdictions. The second section makes recommendations on the structure of the index of annexes and informs about the consequences of submitting non-structured evidence. In addition, for ease of reference for users, parties and their representatives, an index of annexes template has been created and included as Annex 1 to the Common Practice/Common Recommendations. The extensive third section at the heart of this chapter provides detailed information and recommendations on best practices concerning the structure of market surveys. It contains guidance on how to design and conduct a market survey to be submitted as evidence in trade mark proceedings, as well as a checklist, which can be used by appeal bodies and MS IPOs as a support tool to assess the content and standard to which market surveys should correspond. Finally, this chapter presents proposals for the minimal standards of content for affidavits and witness statements, discussed and agreed by different EU stakeholders.

## CONFIDENTIALITY OF EVIDENCE

### ***The scope of the confidentiality request; Acceptable ways and point in time to claim confidentiality; Criteria for assessing the confidentiality request; Treatment of confidential data in files and decisions; Treatment of personal data, health related personal data and sensitive data in files and decisions (anonymisation)***

This chapter offers recommendations on how and when confidentiality should be claimed, including the matter of scope, point in time, acceptable ways and justification of the confidentiality request. It also provides a harmonised approach to its assessment. It explains that the term 'confidentiality of evidence/data' refers to business and trade secrets and other confidential information. In addition, the relevant national rules and, if applicable, national case-law defining those concepts should also be taken into account. Furthermore, this chapter provides practical guidance on the treatment of confidential data by appeal bodies and MS IPOs in their files and decisions (both online and offline), taking into account that some appeal bodies or MS IPOs do not publish their decisions or evidence online and, therefore, recommendations included in that section should be used only in applicable cases. Finally, this chapter provides advice on what can be anonymised in appeal bodies' or MS IPOs' files and decisions (both online and offline) and explains whether this should be done upon an explicit request or *ex officio*.

## 3 IMPLEMENTATION

As has been the case in previous Common Practice publications, the Common Practice/Common Recommendations will take effect within three months of the date of publication of this Common Communication.

However, the range of active stakeholders and the scope and applicability of the Common

Practice/Common Recommendations mean that a greater degree of flexibility is required if they are to generate value and utility for appeal bodies, IPOs and users. Therefore, a new option, namely selective implementation, has been introduced. IPOs<sup>(2)</sup> can choose to implement either the whole Common Practice/Common Recommendations (total implementation) or specific chapters or subchapters (selective implementation), which can mitigate the legal constraints impeding implementation faced by some IPOs. As external appeal bodies cannot be bound by a Common Practice, this document provides a set of recommendations which they can apply and adopt where they are considered to add value and be of benefit.

Further details on the implementation of this Common Practice/Common Recommendations (or part(s) thereof) are available in the link below.

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

### 3.1. IMPLEMENTING OFFICES

List of implementing offices, implementation date, implemented chapters/subchapters and implementation practice: [LINK TO TABLE](#)

**(\*) If there is a discrepancy between the translation of the Common Communication and the Common Practice documents in any of the official languages of the European Union and the English version, the latter will prevail.**

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<sup>(2)</sup> including their internal appeal bodies





**COMMON PRACTICE CP12**  
**EVIDENCE IN TRADE MARK APPEAL PROCEEDINGS:**  
**COMMON RECOMMENDATIONS ON FILING,**  
**STRUCTURE AND PRESENTATION OF EVIDENCE,**  
**AND THE TREATMENT OF CONFIDENTIAL EVIDENCE.**

APRIL 2021

The document presents a series of recommendations to serve as guidance for EUIPN stakeholders and provides general guidelines on practice related to evidence submitted to internal and external appeal bodies, and Member State IP offices, allowing each to adopt the recommendations they consider useful and applicable in their first or second instance role.

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## 1 INTRODUCTION

### 1.1 Objective of this document

This Common Practice document aims to identify general principles regarding evidence in trade mark appeal proceedings, in particular, its types, means, sources and identification of relevant dates, as well as its structure and presentation, and the treatment of confidential evidence. It contains a set of **non-binding recommendations** on the above matters.

The CP12 Common Practice primarily serves as a reference for:

- appeal bodies<sup>(1)</sup>;
- parties to the trade mark appeal proceedings as well as their representatives; and
- User Associations (hereinafter UAs).

As in many aspects the Common Practice deals with evidence in trade mark proceedings in general, its potential applicability may go beyond appeal proceedings. It may therefore be used in wider contexts including but not limited to first instance trade mark proceedings<sup>(2)</sup>.

It will be made widely available and will be easily accessible, providing a clear and comprehensive explanation of the principles on which the new Common Practice is based.

Although evidence will always be assessed on a case-by-case basis, the principles outlined in this Common Practice may serve as useful guidance for all the stakeholders mentioned above. Therefore, the document at hand makes no attempt to impose practice on independent appeal bodies nor to introduce legislative amendments for its implementation. It merely aims to provide recommendations, allowing appeal bodies to adopt and apply the elements they find beneficial, as they cannot be bound by a Common Practice.

### 1.2 Background

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 (TMD), which aims 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. More specifically for CP12, Recital 9 TMD indicates the importance of also laying down general principles that approximate procedural rules.

Based on this legislative framework, in June 2016, the Management Board 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

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<sup>(1)</sup> Internal appeal bodies within the MS IPOs and external appeal bodies, including Courts acting as external appeal bodies in trade mark cases and Administrative Bodies/Committees.

<sup>(2)</sup> As such, the European Union Intellectual Property Office (hereinafter EUIPO), Benelux, and Member States' Intellectual Property Offices (hereinafter collectively referred to as MS IPOs) may also find benefit in applying any of the recommendations contained within the Common Practice document that they consider appropriate and of value.

potential new harmonisation initiatives. The project analysed the trade mark and design practices of IP offices 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 IP offices, 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 fifth project launched by the Management Board, and the 12th overall. CP12 — Evidence in Trade Mark Appeal Proceedings: filing, structure and presentation of evidence, and the treatment of confidential evidence was recommended for launch as a result of the fourth cycle of convergence analysis.

### **CP12 — Evidence in Trade Mark Appeal Proceedings: filing, structure and presentation of evidence, and the treatment of confidential evidence.**

Given the requirement for Member States to introduce revocation and invalidity proceedings before their IP offices by January 2023, the proposal for a convergence initiative in this area had become increasingly relevant. MS IPOs' increased competencies might lead to more disputes at both first and appeal instances, and therefore a cooperation initiative to harmonise approaches would not only support MS IPOs, but also foster the exchange of best practices with external appeal bodies and provide an increased degree of clarity and certainty for users.

Following expressions of interest from appeal bodies and MS IPOs, the results of a detailed questionnaire on trade mark appeal proceedings were analysed at a meeting of appeal bodies, comprising representatives from over 30 EU and non-EU appeal bodies and UAs, in the EUIPO in February 2018.

The outcomes of the Meeting were, firstly, a recognition that an approximation of appeal bodies' systems and practices may benefit stakeholders in the European IP Network (EUIPN), and secondly, recommendations as to which areas of appeal proceedings were found to be most suitable for a convergence initiative and of most potential practical benefit for EUIPN stakeholders.

Those recommendations were channelled to the Convergence Analysis Working Group, who presented CP12 as a project proposal to the Liaison Meeting in October 2018, where it was acknowledged and subsequently adopted by the EUIPO Management Board in November 2018.

CP12 developed on the basis that its stakeholders and potential beneficiaries are not only appeal bodies but also include a much wider range of IP professionals and rights holders. While it complements the work done in CP10 on harmonising approaches to evidence drawn from the internet regarding designs, the content and recommendations of the CP12 Common Practice should not be regarded as requirements. As such, while neither binding nor universally applicable, they do provide additional information, guidance and advice to IP offices in their first instance roles and to users of the EUIPN and their representatives.

Moreover, CP12 is helping to foster a framework that strengthens relations between the various appeal bodies of the MS IPOs and of the EUIPO. It enhances predictability for trade mark rights holders when dealing with appeal proceedings before the EUIPO and the national offices' Boards of Appeal; offers users better aligned, effective and transparent dispute resolution proceedings; and strengthens compatibility and interaction between EU and national trade mark systems.

### **1.3 Practice scope**

This Common Practice delivers a set of guiding, non-binding, principles regarding evidence in trade mark appeal proceedings.

The following issues are in scope of the CP12 Common Practice:

- types of evidence and their admissibility at the stage of appeal proceedings;
- means and sources of evidence, including its genuineness, veracity and reliability;
- establishing the relevant date of evidence;
- ways to present evidence: structure and presentation, including acceptable formats, size and volume, index of annexes and templates;
- confidentiality of evidence.

The following issues are out of scope of the CP12 Common Practice:

- assessment of the probative value of evidence;
- language related issues;
- description of legal constraints preventing implementations;
- updating the guidelines;
- the following means of evidence: oral evidence, inspections, opinions by experts and requests for information;
- trade mark infringement proceedings before courts;
- circumstances in which the appeal bodies and MS IPOs should allow third parties or other Administrative Bodies/Courts to access confidential evidence/data filed during the proceedings;
- personal data related matters, except anonymisation.

## **2 GENERAL CONCEPTS**

Definitions of evidence presented in the subchapters below apply to all chapters of the CP12 Common Practice.

### **2.1 Evidence**

For the purpose of the CP12 Common Practice, the term 'evidence' relates to different sources of information, which may be used to establish and prove facts in trade mark proceedings.

### **2.2 Admissibility of evidence at the stage of appeal proceedings**

As a general rule, parties should not submit their evidence for the very first time at the stage of appeal proceedings, in particular, if this evidence was known and available at the time of first instance proceedings. However, in practice such situations may occur for different reasons.

The case-law of the Court of Justice of the European Union has elaborated a number of circumstances in which evidence is to be either admitted or rejected in the course of appeal proceedings. Therefore, it is necessary to categorise and order the situations in which an appeal body may accept evidence which is outside of the normal procedural time frame. Such categorisation requires a lexical framework in order to create a common understanding of the situations that arise most frequently and which are of most practical value.

Bearing in mind the above, based on settled EU case-law<sup>(3)</sup>, the Common Practice presents four types of evidence that have been distinguished and defined as well as circumstances that may be taken into account regarding their admissibility at the appeal proceedings stage.

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<sup>(3)</sup> 14/05/2019, in joined cases T-89/18 and T-90/18, *Café del Sol and CAFE DEL SOL*, EU:T:2019:331, § 41-42; 21/07/2016, C-597/14 P, *EUIPO v Grau Ferrer*, EU:C:2016:579, § 26-27; 26/09/2013, C-610/11 P, *Centrotherm*, EU:C:2013:593, § 86-88; 18/07/2013, C-621/11 P, *FISHBONE*, EU:C:2013:484, § 30; see also: Opinion of Advocate General Campos Sánchez-Bordona of 05/12/2017, C-478/16 P, *GROUP Company TOURISM & Travel*, EU:C:2017:939, § 60.

### **New evidence**

Evidence unknown or not available during the first instance proceedings and which is subsequently submitted for the very first time at the stage of appeal proceedings. It has no link with other previously submitted evidence.

### **First time evidence**

Evidence known and available during the first instance proceedings but not submitted at that stage. It is, however, submitted for the very first time at the stage of appeal proceedings.

### **Supplementary/additional evidence**

Evidence submitted in the appeal proceedings which supplements, strengthens or clarifies evidence that has been previously adduced in due time during first instance proceedings. For example, evidence submitted in reply to the arguments of the other party concerning evidence submitted before the first instance.

### **Belated evidence**

Any evidence received after the deadline set during the appeal proceedings.

However, it should be stressed that the abovementioned categories i.e. *New evidence*, *First time evidence* and *Supplementary/additional evidence*, may have been submitted late, indicating that there may be an overlap between the aforementioned definitions.

The definitions above present common terminology regarding types of evidence and alignment with EU case-law. They can only serve as guidance, for the parties and their representatives, producing greater transparency and predictability, especially at the EU level — in the proceedings before the EUIPO's BoA. However, only if applicable under the pertinent national law, it is also recommended for other appeal bodies to use the definitions at hand.

### **Recommendations:**

- appeal bodies, where possible and applicable, are encouraged to use the definitions of types of evidence outlined above;
- regarding the admissibility of evidence at the stage of appeal proceedings, the following circumstances can be taken into account:
  - (a) factors that may be taken into account *in favour* of the admissibility of evidence in appeal proceedings:
    - 1) if this evidence is likely to be relevant for the outcome of the case;
    - 2) if the evidence has not been produced in due time for a valid reason, which may be understood *inter alia* as one of the following situations where:
      - evidence is merely supplementing relevant evidence that had already been submitted in due time;
      - evidence is filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal;
      - evidence has recently come to light or was not otherwise previously available.
  - (b) factors that may be taken into account *against* the admissibility of evidence in appeal proceedings:
    - 1) if the party is knowingly employing delaying tactics or demonstrating manifest negligence;
    - 2) if the acceptance of the evidence would lead to an unreasonable delay in the proceedings.
- regardless of the type of evidence, if an appeal body admits the evidence, the other party's right to respond/be heard should always be respected.

The recommended admissibility criteria are not binding and do not impact the treatment of the evidence in appeal bodies, which always retain discretion to admit any type of evidence, at any time, in accordance with their national law as well as the circumstances of a particular case.

### **3 THE COMMON PRACTICE**

#### **3.1 Means and sources of evidence**

In trade mark proceedings before the appeal bodies and MS IPOs different means of evidence may be submitted. Some of these means will be used more frequently than others. Therefore, as guidance for UAs, the parties and their representatives a non-exhaustive list of means of evidence has been created and included in the CP12 Common Practice. Additionally, a table showing what filing aims to prove in the most common types of trade mark cases is presented below.

Furthermore, the volume of evidence drawn from the internet, given the current and future growth of online trading and marketing, is likely to increase enormously in the coming years. That is why this chapter also provides recommendations and insights on online evidence, its sources, reliability and presentation.

Lastly, it presents factors that may influence the genuineness, veracity and reliability of all types of evidence, including online evidence.

##### *3.1.1 The production of documents and items of evidence*

In general, parties may freely choose the evidence that they wish to submit before the appeal bodies and MS IPOs. Therefore, as a form of example, the following means of evidence may be filed in trade mark proceedings:

##### *3.1.1.1 Invoices and other commercial documents*

In this section, the following documents can be found:

- audit reports;
- inspection reports;
- annual reports;
- company profiles, taxation documents, financial statements, documents confirming the amount invested by the rights holder in promoting or advertising the mark (advertising investment figures and reports) and similar documents showing *inter alia* economic results, volume of sales, turnover or market share;
- invoices, orders and delivery notes, including documents confirming that orders for the relevant goods or services have been made through the rights holder's website by a certain number of customers in the relevant period and territory;
- documents confirming that the rights holder gave consent prior to the use of the mark (for example: use by licensees);
- documents confirming the existence of a direct or indirect relationship between the parties to the proceedings prior to the filing of the mark, for example a pre-contractual, contractual or post-contractual (residual) relationship;
- documents confirming the value associated with the mark, including the extent to which the mark is exploited through licensing, merchandising and sponsorship;
- records of successful enforcement, for example delimitation and co-existence agreements in trade mark cases.

##### *3.1.1.2 Catalogues, advertisements and publicity*

This section includes:

- catalogues;
- advertising and promotional materials, including price lists and offers as well as advertising reach and spend;
- printouts of webpages, online shops, company websites, website archives, internet (website) traffic and analytics, TV spots and video/audio files, etc.;
- business correspondence and business cards;
- materials from fairs and conferences.

#### 3.1.1.3 Publications

Including:

- articles, press notes and other publications in newspapers, magazines and other printed materials;
- extracts from guides, books, encyclopedias, dictionaries, scientific papers etc.

#### 3.1.1.4 Samples

This would include:

- packages, labels, tags and samples of the goods or their photographs.

#### 3.1.1.5 Official and public documents

Such documentation would encompass:

- decisions of courts or administrative authorities;
- decisions of appeal bodies and MS IPOs;
- certificates and letters issued by courts or administrative authorities, including appeal bodies and MS IPOs, as well as chambers of commerce and industry;
- lists of applications filed or registrations obtained by the rights holder together with extracts from the official registers (official databases) or their certificates;
- hyperlinks <sup>(4)</sup> and URL addresses <sup>(5)</sup> to the corresponding records in official databases;
- lists of applications filed or registrations obtained by third parties, company names and domain names containing the relevant mark or its elements together with extracts from the official registers (official databases).

#### 3.1.1.6 Witness statements

Featuring:

- witness statements.

#### 3.1.1.7 Sworn or affirmed statements

These include:

- sworn or affirmed statements in writing or statements having a similar effect under the law of the state in which they are drawn up.

#### 3.1.1.8 Market surveys

Featuring:

- market surveys and opinion polls.

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<sup>(4)</sup> A reference to information that the user can directly go to either by clicking, tapping, or hovering over the hyperlink. A hyperlink can be a whole document or a link to a specific element within a document.

<sup>(5)</sup> URL (Uniform Resource Locator): A specific reference to a web resource, which can be found on the World Wide Web. URLs are commonly used to reference web pages (http), file transfers (FTP), e-mails (mailto), database access (JDBC), and other applications.



### 3.1.1.9 Extracts from social media

This would include material drawn from:

- blogs;
- forums;
- social media platforms;
- social media analytics.

### 3.1.1.10 Other documents

In this section, the following documents can be found:

- certifications, rankings, and awards;
- documents confirming that an application for a trade mark has diverted from its initial purpose and has been filed speculatively or solely with a view to obtaining financial compensation;
- acceptance of cease and desist requests.

The above list (3.1.1.1 — 3.1.1.10) is only indicative and does not reflect the relative importance or probative value of evidence. It is also **non-exhaustive**, thus, any other evidence, which is relevant to the particular case, can be submitted by the party and taken into account by the appeal bodies or MS IPOs. The matter of assessment of any evidence always remains at their discretion.

### 3.1.1.11 Aim of filing evidence

In general, there is no limitation stating that certain facts may only be established and proved by specific means of evidence. That is why the means of evidence listed above may be submitted in various types of cases. However, for the purpose of this document, a table with a summary of the most common types of trade mark cases and aim of filing evidence is presented below.

It should be stressed that the column 'Aim of filing evidence' applies to the parties (including third parties to the proceedings, for example when filing observations) and their representatives, not the appeal bodies or MS IPOs.

Further, as the relevant date/period of time is an important factor regarding evidence in all types of cases indicated below, it should always be taken into account by the parties to the proceedings and their representatives. It is not recommended to file evidence regarding dates outside the relevant time period unless the party explains its influence on the factual position at the relevant date/period of time (see also subchapter 3.2).

Legal concepts/ Types of cases	Aim of filing evidence
Acquired distinctiveness	To demonstrate that a mark has acquired a distinctive character, in the relevant geographical area, in relation to the goods or services for which registration is requested or for which the mark is registered, following the use which has been made of it <sup>(6)</sup> .
Enhanced distinctiveness	To demonstrate that a mark has obtained enhanced distinctiveness, in the relevant geographical area, as a consequence of the use which has been made of it <sup>(7)</sup> . The evidence of enhanced distinctiveness acquired through use should also refer to the relevant goods and services.
Reputation	To demonstrate that a mark is known by a significant part of the public concerned, in the territory in which reputation is claimed, for the relevant

<sup>(6)</sup> Article 4(4) and 4(5) of the EU Trade Mark Directive No 2015/2436; Article 7(3) and Article 59(2) of the EU Trade Mark Regulation No 2017/1001.

<sup>(7)</sup> 12/03/2008, T-332/04, Coto D'Arcis, EU:T:2008:69, § 50.

	goods or services covered by that trade mark. The relevant factors are, for example, the market share held by the trade mark; the intensity, geographical extent and duration of its use; and the size of investment made by the undertaking in promoting it <sup>(8)</sup> .
Well-known mark	To demonstrate that a mark is well known in the Member State(s) concerned, in the sense in which the words 'well known' are used in Article 6bis of the Paris Convention <sup>(9)</sup> . The mark should be well known in the relevant sector of the public for the particular goods and services <sup>(10)</sup> .
Proof of use/ Genuine use	To demonstrate that within a specific period the proprietor has put the trade mark to genuine use in the Member State(s) in connection with the relevant goods or services in respect of which it is registered <sup>(11)</sup> . The evidence should consist of indications concerning the place, time, extent and nature of use of the trade mark <sup>(12)</sup> .
Non-distinctive mark	To demonstrate that the trade mark is devoid of any distinctive character <sup>(13)</sup> . Such distinctiveness can be assessed only by reference, first, to the goods or services for which registration is sought or the trade mark is registered and, second, to the relevant public's perception of that sign <sup>(14)</sup> , in the relevant territory.
Descriptive mark	To demonstrate that a trade mark consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services for which registration is sought or the trade mark is registered <sup>(15)</sup> , in the relevant territory.
Customary sign or indication	To demonstrate that a trade mark consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade for the goods or services for which registration is sought or the trade mark is registered <sup>(16)</sup> , in the relevant territory.
Deceptive mark	To demonstrate that a trade mark is of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service <sup>(17)</sup> specified, for which registration is sought or the trade mark is registered, in the relevant territory.
Generic mark (revocation proceedings)	To demonstrate that as a result of acts or inactivity of the proprietor a trade mark has become the common name in the trade, in the relevant territory, for a product or service in respect of which it is registered <sup>(18)</sup> .

<sup>(8)</sup> 14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 22-27; 10/05/2007, T-47/06, NASDAQ, EU:T:2007:131, § 51-52.

<sup>(9)</sup> Article 5(2)(d) of the EU Trade Mark Directive No 2015/2436; Article 8(2)(c) and Article 60 of the EU Trade Mark Regulation No 2017/1001; see also: 22/11/2007, C- 328/06, Alfredo Nieto Nuño v Leonci Monlleó Franquet, EU:C:2007:704.

<sup>(10)</sup> Even though the terms 'well known' and 'reputation' denote distinct legal concepts, there is a substantial overlap between them. Thus, in practice, the threshold for establishing whether a trade mark is well known or enjoys reputation will usually be the same, given that in both cases the assessment is principally based on quantitative considerations regarding the degree of knowledge of the mark among the public.

<sup>(11)</sup> Article 16 of the EU Trade Mark Directive No 2015/2436; Article 18 of the EU Trade Mark Regulation No 2017/1001.

<sup>(12)</sup> 05/10/2010, T-92/09, STRATEGI, EU:T:2010:424, § 41.

<sup>(13)</sup> Article 4(1)(b) of the EU Trade Mark Directive No 2015/2436; Article 7(1)(b) and Article 59(1)(a) of the EU Trade Mark Regulation No 2017/1001.

<sup>(14)</sup> 12/07/2012, C-311/11 P, WIR MACHEN DAS BESONDERE EINFACH, EU:C:2012:460, § 24.

<sup>(15)</sup> Article 4(1)(c) of the EU Trade Mark Directive No 2015/2436; Article 7(1)(c) and Article 59(1)(a) of the EU Trade Mark Regulation No 2017/1001.

<sup>(16)</sup> Article 4(1)(d) of the EU Trade Mark Directive No 2015/2436; Article 7(1)(d) and Article 59(1)(a) of the EU Trade Mark Regulation No 2017/1001.

<sup>(17)</sup> Article 4(1)(g) of the EU Trade Mark Directive No 2015/2436; Article 7(1)(g) and Article 59(1)(a) of the EU Trade Mark Regulation No 2017/1001.

<sup>(18)</sup> Article 20(a) of the EU Trade Mark Directive No 2015/2436; Article 58(1)(b) of the EU Trade Mark Regulation No 2017/1001.

Bad faith	To demonstrate conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices <sup>(19)</sup> .
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The above table should also be regarded as **non-exhaustive**.

**Recommendations:**

- Different types of evidence may be submitted in the proceedings by parties to establish the same fact. A global examination of these items of evidence implies that these should be assessed in light of each other. Even if some items of evidence are not conclusive, they may contribute to establishing the relevant fact when examined in combination with other items.

*3.1.2 Online evidence: sources, reliability and presentation*

For the purpose of this Common Practice, online evidence should be understood as evidence extracted from the internet. In light of the growing role of e-commerce, social media and other online platforms in business it is logical that, as a general rule, online evidence should be accepted as a valid means of evidence <sup>(20)</sup>.

However, the nature of the internet can make it difficult to establish the actual content available on the internet and the date or period of time this content was in fact made available to the public. Websites are easily updated and most of them do not provide any archive of previously displayed material, nor do they display records which enable members of the public to establish precisely what was published and when. Therefore, the problem of the ‘reliability’ of online evidence arises.

It should be stressed that this subchapter draws on the recommendations of the CP10 Common Practice — *Criteria for assessing disclosure of designs on the Internet* <sup>(21)</sup>. Although some of such recommendations could also apply to other IP rights or evidence in terms of methodology used to assess it, some adaptation to the specificities of trade marks may be necessary and recommendable.

*3.1.2.1 Electronic databases*

In order to substantiate, for example, an earlier trade mark application or registration (its existence, validity, scope of protection etc.) in proceedings the party should provide the appeal bodies and MS IPOs with evidence of its filing or registration. Therefore, it is recommended that extracts from the relevant online databases are filed.

Extracts from databases should always be accepted if their origin is an official database, as explained below in the recommendations.

Furthermore, apart from providing physical evidence of substantiation, in cases where evidence concerns the filing or registration of the earlier rights, the party may instead formally rely on a direct hyperlink or URL address to the official databases indicated below (further details in 3.1.2.8 subchapter: *Hyperlinks and URL addresses*).

**Recommendations:**

- extracts from online databases should be accepted if their origin is either the official database of one of the MS IPOs or the official databases maintained by EU institutions and bodies or international

<sup>(19)</sup> Opinion of Advocate General Sharpston of 12/03/2009, C-529/07, Lindt Goldhase, EU:C:2009:148, § 60.

<sup>(20)</sup> 06/11/2011, T-508/08, Representation of a loudspeaker, EU:T:2011:575, § 75.

<sup>(21)</sup> [https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/News/cp10/CP10\\_en.pdf](https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/News/cp10/CP10_en.pdf)

- organisations (e.g. the EUIPO's 'eSearch Plus' or WIPO's 'Madrid Monitor' <sup>(22)</sup>).
- extracts from 'TMview' should also be accepted <sup>(23)</sup> as evidence concerning international registrations and trade marks applied for or registered with the participating offices, as long as they contain the relevant data.
- when the extract from an official database does not contain all the required information, the party should supplement it with other documents from an official source showing the missing information.
- as regards figurative trade marks, the representation of the mark should appear on the same page of an extract and, if it does not, an additional official document/page showing the image should be filed. This can be from the database itself (which reproduces the image on a separate page that, when printed or saved as PDF, for example, includes an identification of the source) or from another official source (such as its publication in the official bulletin).

### 3.1.2.2 Website archives

Website archiving services are the process of collecting portions of the World Wide web to ensure the information is preserved in an archive for future researchers, historians and the public. Furthermore, website archives, such as 'WayBack Machine'<sup>(24)</sup>, enable users to see archived cached versions of web pages across time. The content of the website archives includes indications of dates.

#### **Recommendations:**

- printouts retrieved from website archives, such as 'WayBack Machine', may be considered as reliable types of online evidence <sup>(25)</sup>;
- however, it is recommended that printouts from website archives, such as 'WayBack Machine', are corroborated by other evidence from alternative sources, where it is reasonably possible to obtain such other evidence.

### 3.1.2.3 Editable websites

In general, the reliability of information taken from editable websites, such as 'Wikipedia' or 'Acronym Finder' should not be called into question by the mere fact that users have the possibility of adding new entries<sup>(26)</sup>. However, content/information taken from editable websites, such as 'Wikipedia' or 'Acronym Finder', may be considered as lacking certainty<sup>(27)</sup>. In such a case, it is advisable that other evidence corroborates such information.

It should also be noted that the matter of reliability of editable websites, in particular 'Wikipedia', needs to be taken into consideration in the light of evolving case-law and technical developments.

#### **Recommendations:**

- use of editable and collective internet dictionaries, encyclopedias or databases, such as 'AcronymFinder' or 'Wikipedia', as a reference base should be made with due consideration for the need for such information to be accompanied by supporting or corroborating evidence;
- if the party to the appeal proceedings wishes to disprove the information on editable websites, such as 'Wikipedia' and 'Acronym Finder', it is advisable that additional documents or evidence be

<sup>(22)</sup> The 'short' version of the extract being sufficient as long as it contains all the necessary information, but the extended or long version of the WIPO extract being preferable as it contains all the individual indications for each designated country, including the Statement of Grant of Protection.

<sup>(23)</sup> 06/12/2018, T-848/16, Deichmann SE v EUIPO, EU:T:2018:884, § 61 and 70.

<sup>(24)</sup> An online digital archive that captures, manages and searches for digital content on the world wide web and on the internet.

<sup>(25)</sup> For example: 19/11/2014, T-344/13, FUNNY BANDS, EU:T:2014:974, § 30-31 (regarding 'WayBack Machine').

<sup>(26)</sup> 25/09/2018, T-180/17, EM, EU:T:2018:591, § 77.

<sup>(27)</sup> 29/11/2018, T- 373/17, LV BET ZAKŁADY BUKMACHERSKIE, EU:T:2018:850, § 98.

- submitted<sup>(28)</sup>;
- as an alternative to internet databases such as ‘Acronym Finder’, the use of a given abbreviation by a number of traders or relevant consumers in the appropriate field on the internet should be sufficient to substantiate actual use of the abbreviation.

#### 3.1.2.4 Non-editable websites

Printouts from non-editable websites should contain reference to the dates and places where, for example, the relevant goods were marketed or where the relevant material (such as promotional material presented on printouts etc.) was used<sup>(29)</sup>.

#### **Recommendations:**

- In principle there is no need to file corroborating evidence when submitting printouts or screenshots<sup>(30)</sup> from non-editable websites (unless contradicted or opposed, or where relevant data is missing, or where evidence is drawn from non-editable websites owned by the interested parties).

#### 3.1.2.5 Website analytics (website traffic, reporting and statistics)

The use of screenshots to establish the existence of a website does not establish the intensity of the alleged commercial use of the rights relied on. This may be shown by, *inter alia*, a certain number of visits to the site, the emails received via the site or the volume of business generated<sup>(31)</sup>. A high ranking in terms of visitors can help, for example, to establish that a particular mark, which is repeated in the name of party’s website<sup>(32)</sup> or otherwise prominently appears on such website, has acquired distinctive character through use in the countries concerned.

Other forms of communication or interaction with the website can also be taken into account.

Further, website (including social media) analytics reports can be helpful in the case of evidence regarding, in particular, online paid campaigns.

#### **Recommendations:**

- Website traffic<sup>(33)</sup> can be a factor to consider, for example, in cases regarding genuine use, acquired distinctiveness or reputation. Various options exist to measure website traffic, such as page views<sup>(34)</sup>, a page hit<sup>(35)</sup> and a session<sup>(36)</sup>, which may also be quantified by the use of web/website analytics or similar tools.
- It is advisable that a party file a full, not partial, website analytics report. However, as a minimal standard, the party should file the report presenting: the date range, number of users (e.g. users, new users, new visitor and returning visitor), their territorial/geographical location, average session

<sup>(28)</sup> 25/09/2018, T-180/17, EM, EU:T:2018:591, § 78.

<sup>(29)</sup> 12/09/2007, T-164/06, BASICS, EU:T:2007:274, § 50.

<sup>(30)</sup> A digital image created by capturing part or all of the information displayed on a digital display screen (e.g. computer screen, television or mobile device) at a particular moment.

<sup>(31)</sup> 19/11/2014, T-344/13, FUNNY BANDS, EU:T:2014:974, § 29.

<sup>(32)</sup> 14/12/2017, T-304/16, BET 365, EU:T:2017:912, § 66.

<sup>(33)</sup> The amount of data sent and received by visitors to a website.

<sup>(34)</sup> A visit to a page on a specific website. If the visitor reloads a page, this counts as an additional page view. If the user navigates to a different page and then returns to the original page, this will count as another page view.

<sup>(35)</sup> A single file request in the access log of a web server. A request for an HTML page with three graphic images will result in four hits in the log: one for the HTML text file and one for each of the graphic image files.

<sup>(36)</sup> An unspecified period of time within which a user is connected to a specific website, either continuously or intermittently. Intermittent connection is included in the definition of a session in order to discount the possibility of multiple, deliberate disconnections and reconnections designed to inflate the number of page views to a site.

duration and bounce rate<sup>(37)</sup>.

- If the relevant product or service has a subpage the party should also provide an analytics report on/including this subpage.
- When assessing availability of the mark or goods and services on the internet, it is recommended to take into account tagging systems, hashtags and links between search terms and images of the relevant content across different internet platforms<sup>(38)</sup>.
- The 'popularity' indicators on social media platforms can also be taken into account while assessing availability of the relevant content, such as the number of people reached, views, clicks for the post(s), reactions, comments, shares, followers and 'likes'.
- In the case of submitting printouts or screenshots from social media platforms presenting content with 'likes', views, followers etc., the party should also file an analytics report from the social media platform showing the territorial/geographical origin of the users providing 'likes', views, follows etc. (see also subchapter 3.1.2.6). If relevant, it is also advisable to show more information about the users such as gender, age etc., if it can be extracted by a party from a given social media platform or its analytics tool.

#### 3.1.2.6 Social media

Social media should be understood as: applications, programmes and websites on computers or mobile devices that enable people to communicate and share information on the internet, such as blogs and social networking websites.

Some of the key features of social media are that its content is created by users and that the dissemination of information might be very fast and extensive. Furthermore, some social media services provide the possibility to retrieve historical information or even search for content. In other cases, the content might only be available for a short period of time.

On the other hand, it is known that social media pages themselves create a significant volume of information that cannot be controlled or altered by the owner of the account or page, e.g. the date of creation of the account or information on the modification of the account/page name. Therefore, it may be considered as coming from a third party.

Lastly, it should be noted that the recommendations below could be applicable not only to the types of websites mentioned above but also to other websites not specifically addressed in the Common Practice.

#### **Recommendations:**

- Extracts from social media can be treated as independent sources<sup>(39)</sup> insofar as they include information created by the platforms themselves, which cannot be controlled or altered by the owner of a page/account. Such information may include, for example, the date of creation of the account or information on the modification of the account/page name.
- However, bearing in mind that some social media content can be changed or enhanced, it is recommended that evidence including 'likes', followers, views etc. should be corroborated by other evidence, in particular, where applicable, sales figures relevant to the trade mark and territory in question.
- The evidence taken from a social media website should be presented by creating a printout or a screenshot of the relevant information presented therein.
- The evidence submitted should display a clear image of the relevant content (mark, goods and

<sup>(37)</sup> A measure of single-page sessions where a user visits a website and leaves without any further interaction (presented in %).

<sup>(38)</sup> A group of technologies that are used as a base upon which other applications, processes or technologies are developed. In personal computing, it is the basic hardware (computer) and software (operating system) on which software applications run.

<sup>(39)</sup> 24/10/2017, T-202/16, coffeeinn, EU:T:2017:750, § 51.



services etc.), the date of its publication and the URL address, as well as its relevance to the relevant subject/party. Moreover, as described in the website analytics subchapter above, printouts or screenshots from social media platforms should be filed together with analytics reports, which also show the territorial/geographical origin of the users providing 'likes', views, follows etc. (see also subchapter 3.1.2.5).

- In the case of filing evidence concerning influencer marketing, the party should provide the main information regarding a particular influencer, for example, the geographical location of said influencer and the related advertising spend, as it may be relevant for assessing the evidence. It should also show results of a followers campaign, for example, by presenting the volume of sales on a country by country basis made via a dedicated influencer URL address or code.
- The information regarding the purpose and the main characteristics of the social media website in question could be relevant for assessing the availability of content.

#### 3.1.2.7 *Video and photo sharing websites*

The relevant content in trade mark proceedings may be disclosed by sharing images and videos on the internet.

In terms of the relevant date, it shall be either the date when:

- an image or video has actually been viewed; or
- it has been made available for viewing or downloading e.g. on an online platform.

This information can be obtained through analytics reports. Further details are described in subchapters 3.1.2.5 and 3.1.2.6 above.

While an image would normally be represented in a printout or a screenshot, the way to present the evidence contained in the video might vary. It could be the video itself submitted as evidence (e.g. as a file) or only captures of the relevant part(s) where the content in question is presented.

It should be stressed that submitting only a hyperlink or URL address of the video would not be sufficient, as its contents might be removed or altered. It must be accompanied by printouts or screenshots of the relevant content contained in that video.

#### **Recommendations:**

- When the video itself is submitted, information on when and where the video was made available to the public (e.g. evidence such as printouts of the video being posted on social media sites or when the video has appeared as an advertisement on a website) should be provided.
- When submitting the video, it is recommended to indicate the exact moment [minute(s), second(s)] the mark, goods and services or other relevant content are visible in the video.
- When there is no other date indicating publication of a particular content on the internet, the comments made by users could serve as evidence, provided that they are dated and appear to be credible.
- The information on the source where images or videos are contained should be provided.
- It is advisable to present additional information or an analytics report on the number of views actually received by the video (e.g. provide evidence such as printouts from a video sharing website), the date range and territorial/geographical origin of the viewers. If relevant, it is also advisable to show more information about the viewers such as gender, age etc. if it can be extracted from a certain platform or its analytics tool.

#### 3.1.2.8 *Hyperlinks and URL addresses*

With a limited number of exceptions, hyperlinks or URL addresses per se cannot be considered as sufficient

evidence. They should be supplemented with additional evidence. This is because the information accessible through a hyperlink or URL address might later be altered or removed. Moreover, it may be difficult to identify the relevant content (the mark, date of publication, etc.).

**Recommendations:**

- The use of a direct hyperlink or URL address to the official database of one of the MS IPOs, the official databases maintained by EU institutions and bodies or international organisations should be accepted (as described in subchapter 3.1.2.1 above). However, in the case that the party relies on this kind of online evidence, it should explicitly declare it and the online source should be clearly identified.
- With the exception of the hyperlinks and URL addresses to the databases above, when the URL address or a hyperlink is submitted, a printout or a screenshot of the relevant information contained therein should also be provided.

It should be stressed that even if the parties formally declare and use a direct hyperlink or URL address to the official database, as described above, it should be their obligation to check that the online sources reflect the most accurate and up to date relevant information.

Moreover, where the party still submits physical evidence without formally revoking its previous declaration of using a hyperlink or URL address, in the event there is a contradiction between the online evidence and the physical evidence, the most recent up to date evidence should prevail.

**3.1.2.9 E-commerce platforms**

Many current websites are dedicated to various forms of e-commerce, such as online retailing, online auctions and online market places.

In terms of the relevant date, e-commerce platforms<sup>(40)</sup> very often indicate the date when, for example, the particular product bearing a mark (or services offered under this mark) was first available for sale. This information contained in printouts or screenshots can be relevant when establishing *inter alia* proof of use or acquired distinctive character through use.

Moreover, the specific product or service reference, for example a name or a code, might be useful when linking the information on that product/service to that contained in other evidence (e.g. the date of first sale).

Evidence originating from e-commerce platforms might have evidential value even in the absence of the trade mark or goods/services' representation, provided that an identifying reference number can be linked to the particular mark, good or service.

However, it should be noted that some e-commerce platforms would maintain the same 'available from' date and even the same reference number to the new versions of a product/service, which might include or be offered under a different mark.

**Recommendations:**

- It is advisable that the party includes printouts of the reviews that users have left after purchasing the product or ordering the service on a particular e-commerce platform, as this information might be useful for establishing the relevant date of content publication.
- A specific reference identifying the relevant product or service can serve as a link between the

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<sup>(40)</sup> E-commerce (Electronic commerce) platforms: internet platforms that facilitate online transactions of goods and services through means of the transfer of information and funds over the internet.

information displayed on the e-commerce platform (e.g. product bearing the mark etc.) and that contained in the other evidence (e.g. date of sale).

#### 3.1.2.10 Apps

A considerable part of online activity entails the use of applications (Apps)<sup>(41)</sup>, e.g. online retail sales, online auctions, social networking, instant messaging, etc. Therefore, this medium is also taken into account in this subchapter.

It should be observed that some websites also have an app version<sup>(42)</sup>.

In terms of publication of relevant content on the internet, Apps and websites can provide that same relevant content (i.e. date, trade mark, goods and services etc.) in a relatively similar manner. Therefore, the main difference between Apps and websites lies not in the content itself, but in the means of presenting the relevant information.

Proving publication of relevant content in Apps that do not have a website version can be burdensome, in particular because of:

- the difficulty in obtaining proof that relevant content has been published through an app when the information displayed is temporary and might not be retrievable after a certain period of time;
- the limited capability of website archiving services to capture historical data from Apps;
- the limited possibility to create a printout version of the information displayed in Apps.

#### **Recommendations:**

- when Apps also have a website version, it is advisable to extract the relevant information from the website;
- if a website version is not available, a screenshot from a mobile device can be used as evidence;
- when the relevant information is presented in a screenshot obtained from an app, the date when the screenshot was taken will be assumed to be the date of publication of the relevant content, unless an earlier relevant date can be established from the content of the screenshot itself or any other supporting evidence;
- when assessing evidence of publication of relevant content deriving from certain Apps (e.g. those used for shopping, social media, etc.), the information regarding the purpose and the main characteristics of the app in question may be relevant for assessing the evidence.

#### 3.1.2.11 Metadata

The evidence of publication of the relevant content on the internet can be constructed through analysing metadata<sup>(43)</sup> (or EXIF data<sup>(44)</sup>, see indication 'C' in example 2 below) embedded, for instance, within images, videos and websites. For example, an image may include information about itself, such as the author, the date created or modified or the location it was taken (see indications 'A', 'B' and 'C' in examples 1 and 2 below).

There are different ways to obtain metadata. Depending on the device (such as a smart phone or a digital camera) and where the relevant file is saved, it may be possible to access the metadata either by simply

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<sup>(41)</sup> A program or group of programs that is designed for the end user. These include database programs, media players, word processors, web browsers, spreadsheets and other applications. They are designed to carry out coordinated functions, tasks, or activities.

<sup>(42)</sup> App (mobile) version: A type of application software designed to run on a mobile device, such as a smartphone or tablet computer, which are frequently aimed to provide users with similar services to those accessed on PCs.

<sup>(43)</sup> The data used to describe a certain item's (e.g. photo, image, video or e-book) content.


<sup>(44)</sup> EXIF (Exchangeable image file format) data: a standard that specifies the formats for images, sound, and ancillary tags used by digital cameras (including smartphones), scanners and other systems handling image and sound files recorded by digital cameras.

selecting the ‘information’ option on the image itself or by using more specialised software (i.e. metadata viewers). The type of metadata that can be extracted depends on how the device stored the file and its capabilities.

*Metadata extracted from digital camera photo*

Basic Image Information	
Target file: Alicante_EUIPO6.JPG	
Camera:	Olympus VG170
Lens:	4.7 mm (Max aperture f/2.8) (shot wide open)
Exposure:	Auto exposure, Creative (Slow speed), 1/1,000 sec, f/2.8, ISO 80
Flash:	Auto, Did not fire
Date:	<b>December 1, 2018 11:41:04AM</b> (timezone not specified) (3 months, 10 days, 20 hours, 14 minutes, 12 seconds ago, assuming image timezone of US Pacific) <b>A</b>
File:	<b>4,288 x 3,216 JPEG (13.8 megapixels)</b> 3,192,982 bytes (3.0 megabytes)
Color Encoding:	<b>WARNING:</b> Color space tagged as sRGB, without an embedded color profile. Windows and Mac browsers and apps treat the colors randomly. <small>Images for the web are most widely viewable when in the sRGB color space and with an embedded color profile. See my <a href="#">Introduction to Digital-Image Color Spaces</a> for more information.</small>

Extracted 640 x 480 74-kilobyte "MakerNotes:PreviewImage" JPG Displayed here at 70% width (1/91 the area of the original)




Click image to isolate; click this text to show histogram


A

Example 1

*Metadata extracted from a smart phone image*



Camera	
Make	ZTE
Model	ZTE BLADE V7
Exposure	1/391
Aperture	2.2
Focal Length	3.5 mm
ISO Speed	115
Flash	No Flash

Location	
	
Latitude	38.314113 North
Longitude	0.517572 West
Altitude	98 m Above Sea Level

A

B

GPS data

EXIF	
DateTimeOriginal	2019:02:19 15:45:02
CreateDate	2019:02:19 15:45:02

C

Example 2

**Recommendations:**

- When metadata is submitted as evidence, it is recommended to provide information explaining how it was obtained, what kind of information was extracted and from which source it was taken.

*3.1.2.12 Factors that can affect accessibility to information on the internet*

When presenting online evidence the following restrictions should also be taken into consideration:

- passwords and payments;
- top-level domain<sup>(45)</sup>;
- searchability<sup>(46)</sup>;
- geo-blocking<sup>(47)</sup>.

Searchability and Geo-blocking matters are presented in the CP10 Common Practice - *Criteria for assessing disclosure of designs on the internet*. A number of other recommendations are presented below.

**Recommendations:**

- In general, neither restricting access to a limited circle of people by password protection, nor requiring payment for access should prevent printouts or screenshots from such secured websites or Apps from being submitted as evidence. Nevertheless, the availability of relevant content might depend on the specific circumstances of a particular case.
- Top-level domains, in principle, should not affect the possibility to find a mark or other relevant content on the internet. However, they could serve as an indication as to which consumers were more likely to access a certain website. For instance, if a top-level domain were that of an EU Member State, it would be more likely that the consumers in that Member State or more generally in the EU could have become aware of the content on such a webpage, taking also into account the language used.

*3.1.3 Genuineness, veracity and reliability of evidence, and criteria for its assessment*

For the purpose of the CP12 Common Practice, the genuineness and veracity of evidence should mean that it is not falsified, subsequently amended, altered or forged.

In general, each item of evidence is given an appropriate weighting according to its probative value. Therefore, it should be stressed again that the recommendations below do not concern the assessment of the probative value of the evidence. They only present a common approach to the prior steps – i.e. elements that can be analysed in order to initially check whether the evidence at hand is genuine.

**Recommendations:**

- While assessing the genuineness and veracity of evidence, account should be taken of, *inter alia*:
  - (i) the person from whom the evidence originates and the capacity of the person giving the evidence or its source (i.e. the origin of the evidence);
  - (ii) the circumstances of its preparation;
  - (iii) to whom it is addressed;

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<sup>(45)</sup> The last segment of a domain name, or the part that follows immediately after the 'dot' symbol. There are a limited number of predefined suffixes, which represent a top-level domain. Examples of top-level domains include: .com — commercial businesses;.gov — government agencies;.edu — educational institutions.

<sup>(46)</sup> The possibility to find a website by entering search terms in a search engine browser or through other means.

<sup>(47)</sup> A form of security used on email, web or any other Internet servers to restrict access to content based on the user's geographical location. The user's location is determined by checking their IP address (country) or range of addresses that are considered undesirable or hostile.

(iv) whether it seems from the content to be sensible, sound and reliable<sup>(48)</sup>.

- Evidence bearing a date or other elements added afterwards (e.g. hand-written dates on printed documents) may give reason to doubt its genuineness and veracity;
- Examination of all items of evidence should also include checking whether there are any inconsistencies between the items of evidence submitted.

### 3.2 Establishing the relevant date of evidence

When assessing evidence, it is important to establish the date of the document or item of evidence. Furthermore, appeal bodies and MS IPOs as well as parties to the proceedings should take into account the relevant date/period of time and its importance in particular proceedings (for example in the case of demonstrating the proof of use, acquired distinctiveness or reputation). However, proving the relevant date might sometimes raise a number of issues, for example, where there is no date indicated in the evidence or when dealing with online evidence.

Therefore, this chapter addresses the matter of establishing the relevant date of evidence in the case of: documents and samples, online evidence and market surveys.

#### 3.2.1 Documentary evidence: establishing the date of documents

As explained in subchapter 3.1.1 of CP12 Common Practice, different means of evidence may be filed by a party to establish the same fact. Further, a global examination of these items of evidence implies that they should be assessed in light of each other.

As a general rule, in the case of documents, printed media, audited annual reports etc. they should bear a clear date. If not, the party should file additional evidence. This is also the case if it is common in a particular market sector for the samples of the goods themselves not to bear indications of time. In most cases, photos of physical samples or specimens themselves would need supporting evidence to determine a relevant date.

#### **Recommendations:**

- the date of evidence should be apparent from the evidence itself;
- material submitted without any indication of date may, in the context of an overall assessment, still be relevant and taken into consideration in conjunction with other items of evidence, filed by the party, that are dated<sup>(49)</sup>.

#### 3.2.2 Online evidence: tools to determine the relevant date

The previous chapter on the means and sources of evidence addresses *inter alia* aspects to be taken into consideration when dealing with different online sources.

In turn, this subchapter (3.2.2) provides a **non-exhaustive list of tools** which can help to determine the date when particular content has been published on the internet.

In this context, the following tools can be used to determine the relevant date:

- search engines and website archiving services;
- computer-generated timestamps;
- forensic software tools.

<sup>(48)</sup> 15/12/2005, T-262/04, Three-dimensional trade mark in the shape of a lighter, EU:T:2005:463, § 78; 25/04/2018, T-312/16, CHATKA, EU:T:2018:221, § 50.

<sup>(49)</sup> 17/02/2011, T-324/09, FRIBO, EU:T:2011:47, § 33.



However, using the abovementioned tools by the parties to the proceedings and their representatives is **not mandatory**. Other options (for example, notary certificate) or online tools may be used by the party to the proceedings or its representative. The matter of their assessment always remains at the discretion of the appeal bodies and MS IPOs.

The recommendations below are based on CP10 Common Practice — *Criteria for assessing disclosure of designs on the internet*.

#### 3.2.2.1 *Dates provided by search engines and website archiving services*

The date of disclosure can be established using the relevant data provided by search engines<sup>(50)</sup> and website archiving services.

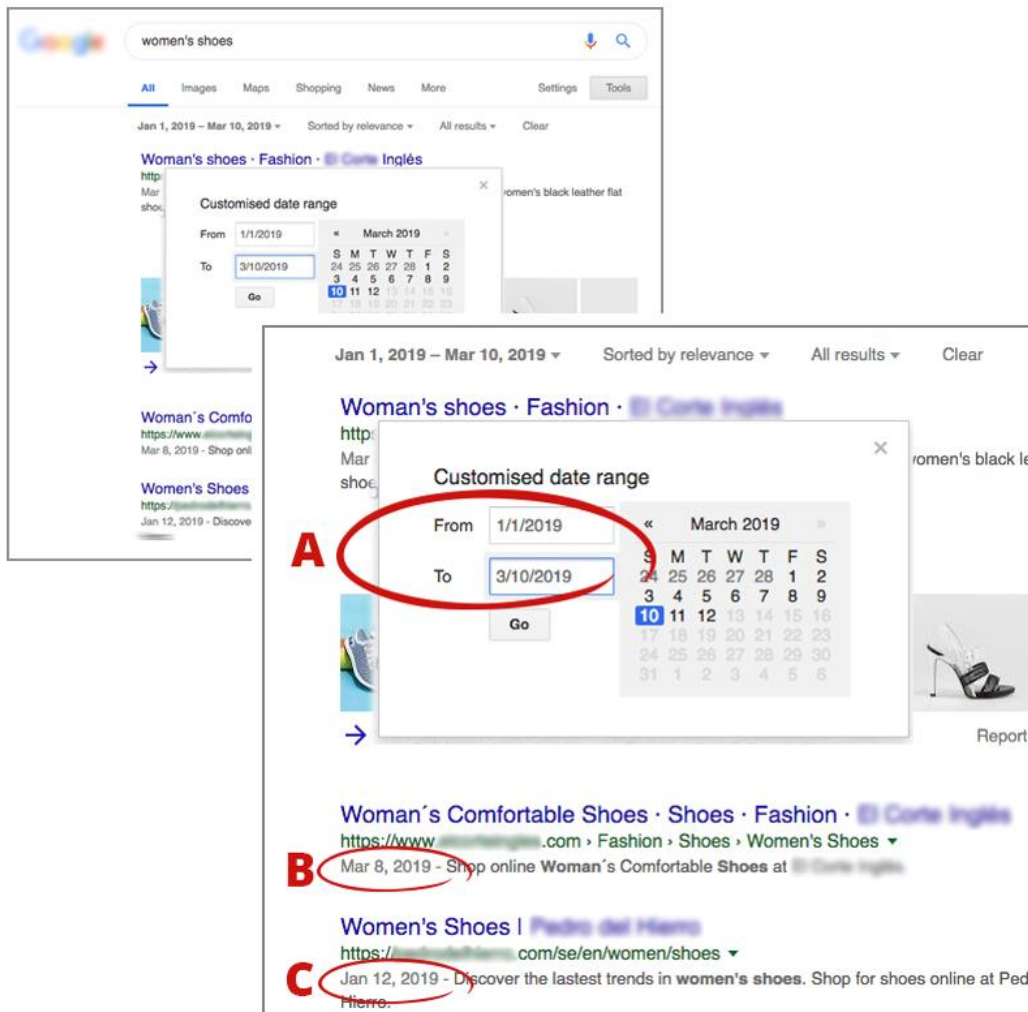
Search engines allow users to search for the information within a specific time frame (see indication 'A' in example 3 below)<sup>(51)</sup>. The results obtained may constitute a preliminary indication as to when the respective content was available online.

However, in order to prove publication of a particular content, the relevant date should be corroborated by further information, ideally the dates contained in the contents of the particular websites listed in the search results.

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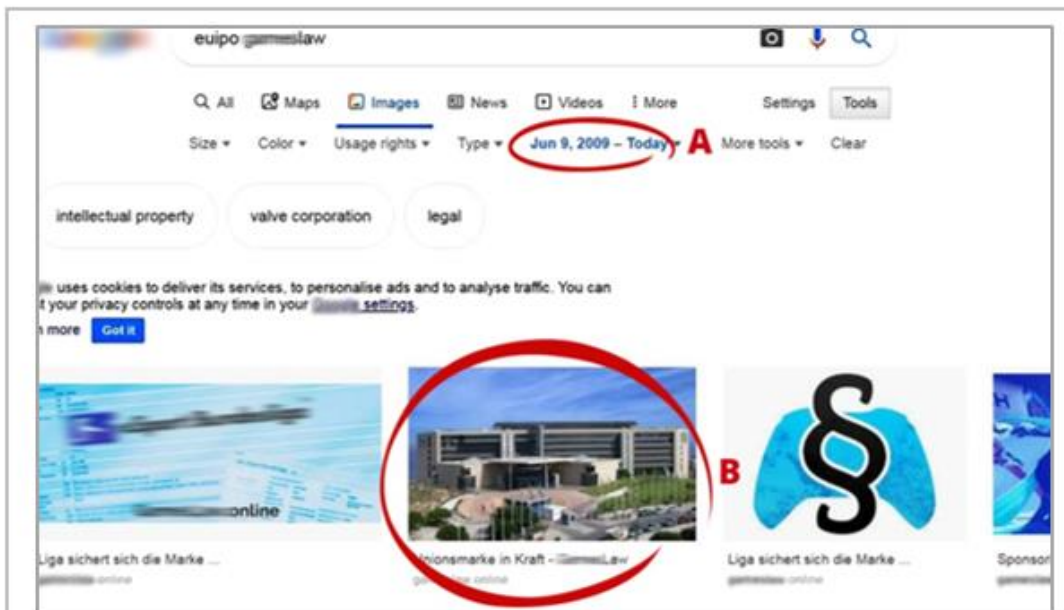
<sup>(50)</sup> Computer programs that search for information containing particular keyword(s) on the internet.

<sup>(51)</sup> Some search engines temporarily cache — or store information — regarding website content. This is done through a program called a 'web crawler', which scans the internet, visits every website it can and stores information (such as the publication or creation date of the site or its contents) about those webpages in an index.

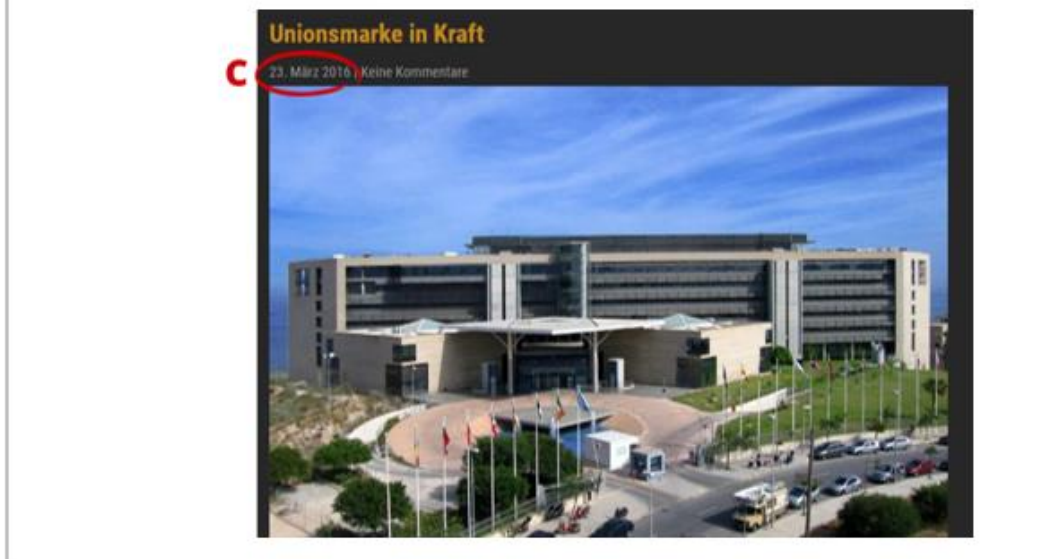


**Example 3**

Due to the limitations mentioned below, search engines should be relied on with caution. First, when searching within a period of time (see indication 'A' in example 4), the date obtained might not necessarily be the date when the relevant content was published (see indication 'C' in example 4), but the date the tool cached or captured the particular website (see indication 'B' in example 4). Secondly, the contents of a website showing relevant information/content might not relate to the date shown, but to the most recent version of that website.



When you enter the corresponding website containing the picture, you discover that the date of disclosure of the image is 23 March 2016.



#### Example 4

On the other hand, website archiving services (such as the 'WayBack Machine') can serve as a valuable tool for proving the date of publication of particular content on the internet.

They provide access to archived websites or parts thereof as they appeared at a certain point in time ('captures') (see indication 'A' in example 5 below). Moreover, website archives also provide the possibility to view and navigate them.

Nevertheless, when assessing the evidence obtained from website archiving services the following aspects should be taken into account:

- Limited access to website content. For example, it might not be possible to archive password-protected content or website owners might block archiving systems from accessing its contents (i.e. Robot Exclusion<sup>(52)</sup>).
- Incomplete or partial archiving of the website content.
- Content removal. Website owners have a right to request removal of the archived content.
- Sporadic updates. Websites are not archived every time they are updated or changed, but only when web crawlers<sup>(53)</sup> visit them. This, in turn, depends on the website's popularity.

The image shows a screenshot of a Wikipedia page for 'Ford Model T' and its corresponding Wayback Machine archive. The Wayback Machine interface displays a bar chart showing the number of snapshots taken from 2001 to 2019. A red circle highlights a specific snapshot taken on January 1, 2015, at 05:41:03. Another red circle highlights the year 2015 on the bar chart, with a large red letter 'A' next to it, indicating a specific point of interest in the archive history.

Example 5

**Recommendations:**

- the outcome of searches using search engine services should be relied on with caution;
- it is important to take into account that, when navigating the archived website, separate parts of the website might relate to different dates;
- for the purposes of proving publication of relevant content on the internet, it is advisable to use website archiving services instead of search engine services;
- in order to prove publication of a particular content on the internet, the relevant date should be corroborated by further evidence.

<sup>(52)</sup> A standard used by websites to communicate with web crawlers and other web robots. Robot Exclusion informs the web robot on which areas of a website should not be processed or scanned.

<sup>(53)</sup> An internet bot that systematically browses the world wide web, typically for web indexing.

### 3.2.2.2 Computer-generated timestamp information

An electronic timestamp<sup>(54)</sup> assigns an exact time to a file, a message, a transaction, an image etc., giving evidence that the content existed at a point in time.

Various services providing timestamps<sup>(55)</sup> are available. Some of them have the European Commission's recognition that they comply with the requirements of the Regulation (EU) No 910/2014<sup>(56)</sup>. Providers of those services can issue qualified electronic timestamps<sup>(57)</sup>.

The European list of qualified timestamp providers<sup>(58)</sup> is made available to the public by the European Commission.

A qualified timestamp issued by one Member State is recognised as such in all Member States. Furthermore, it is presumed to be accurate in the date and time it indicates and in the integrity of the data to which the date and time are bound<sup>(59)</sup>.

Timestamping can secure the content contained in a screenshot or a printout (see indications 'A' in examples 6 and 7 below) from the possibility of it being later amended or removed from its original source. Furthermore, this type of evidence is not subject to any territorial limitations.

When a timestamp is requested for a specific website, the service will provide a certificate verifying the timestamped content, such as the URL address and the date, all related to that website at the moment it was timestamped (see indication 'A' in example 7 and indications 'A' and 'B' in example 8 below).

Both static websites and browsing sessions can be timestamped.

When timestamping static websites, generally speaking, the timestamping service issues a digital certificate that features the content visible on a specific URL at a certain moment, specifying the exact date and time. This type of timestamp serves to guarantee that the screen capture submitted has not been modified, since the certificate, which is digitally signed and timestamped, includes the visual information provided by the URL and the HTML code as an attachment to the certificate.

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<sup>(54)</sup> Data in electronic form which binds other data in electronic form to a particular time establishing evidence that the latter data existed at that time (Article 3 (33) eIDAS Regulation). Some of the timestamping services are based on blockchain technology

<sup>(55)</sup> A sequence of characters or encoded information identifying when a certain event occurred, usually giving date and time of day.

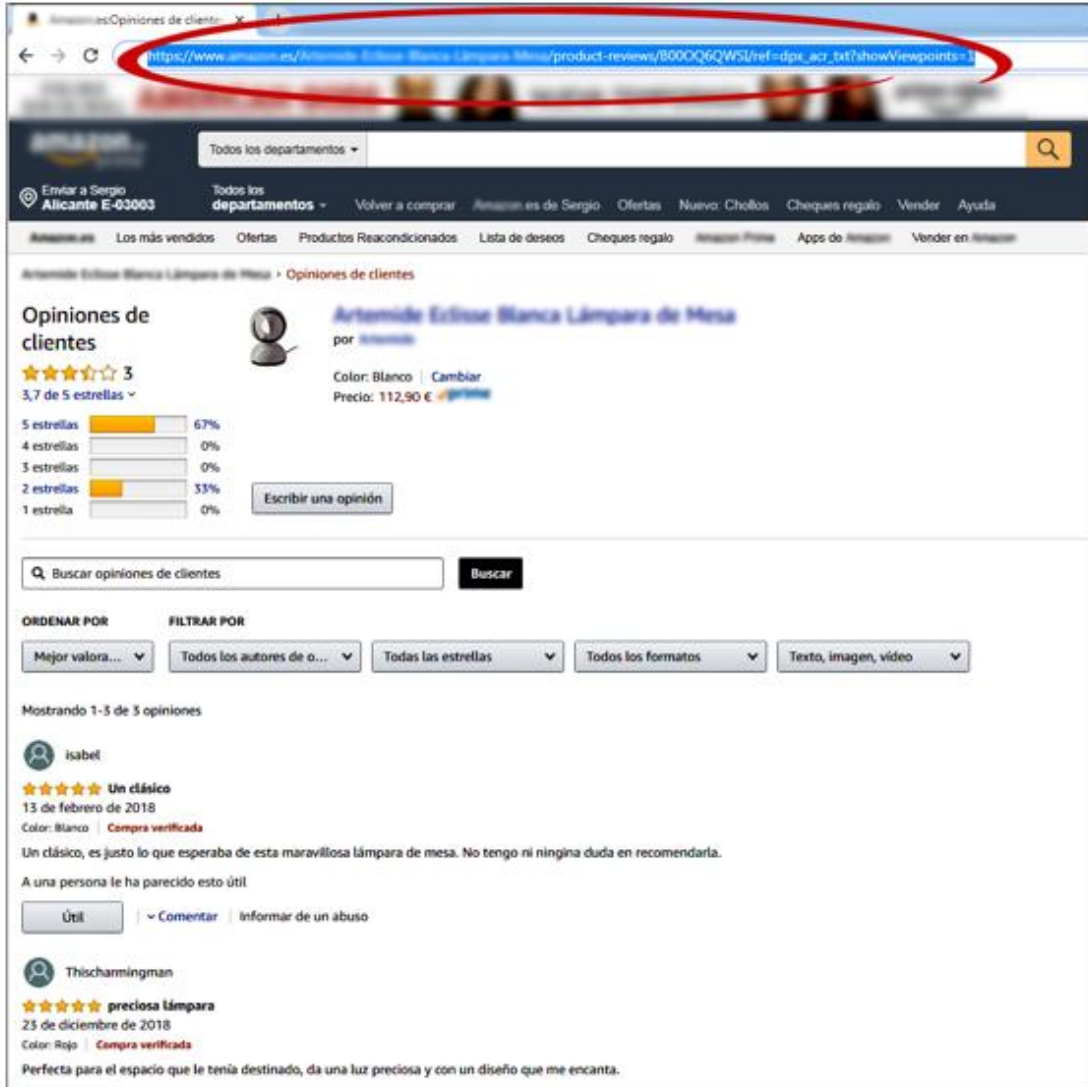
<sup>(56)</sup> Regulation (EU) No 910/2014 on electronic identification and trust services for electronic transactions in the internal market (eIDAS Regulation).

<sup>(57)</sup> An electronic timestamp that complies with certain requirements that are established in Article 42 of the eIDAS Regulation, namely, that it: a) links the date and time with the data so that the possibility of modifying the data without being detected is reasonably eliminated; b) is based on a temporary information source linked to Coordinated Universal Time (internationally managed unified system of atomic clocks that couples Greenwich Mean Time).

<sup>(58)</sup> Trusted list: <https://webgate.ec.europa.eu/tl-browser/#/> Qualified timestamp provider (Qualified trust service providers — QTSP): A trust service provider that provides and preserves digital certificates in addition to creating and validating electronic signatures. A trust service provider has been granted a supervisory status and is required in the EU and in Switzerland to regulate electronic signing procedures.

<sup>(59)</sup> Article 41 of the eIDAS Regulation.

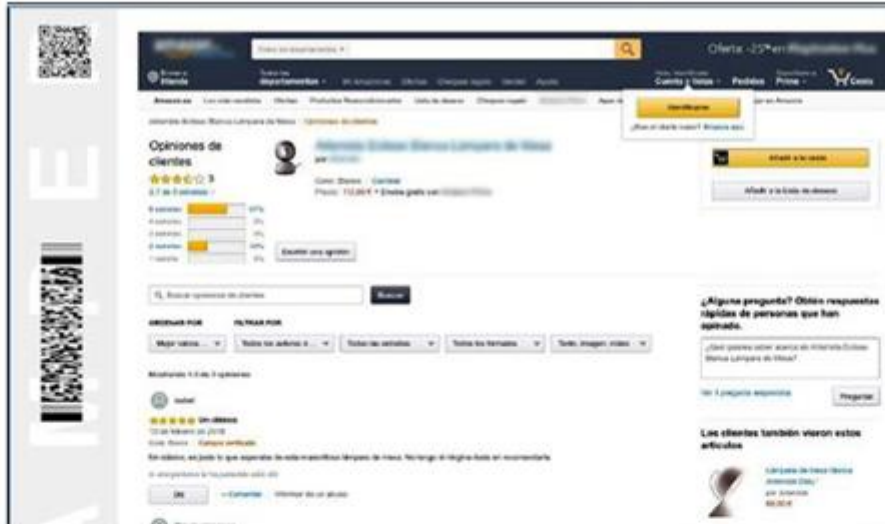
*Timestamping a static website*



**Example 6**  
Without timestamp



*Timestamping a static website: the certificate*



This is the information provided by the address [https://www.amazon.es/Artemide-Eclisse-Blanca-L%2F%2Fproduct-reviews/B00OQ6QWSI/ref=dpx\\_acr\\_txt?showViewpoints=1](https://www.amazon.es/Artemide-Eclisse-Blanca-L%2F%2Fproduct-reviews/B00OQ6QWSI/ref=dpx_acr_txt?showViewpoints=1), responding from IP address 216.137.57.191, when queried on Mar 15, 2019 6:32:25 PM (UTC) from the IP address 54.247.116.13.

The page source code (ref=dpx\_acr\_txt) has been included as attachment to this document.

User agent used on the query: Mozilla/5.0 (X11; Linux x86\_64) AppleWebKit/537.36 (KHTML, like Gecko) Chrome/59.0.3071.86 Safari/537.36

This query has been performed by [www.whostracker.com](http://www.whostracker.com) service from [www.whostracker.com](http://www.whostracker.com) Ltd. which records and digitally signs its result in this PDF document on Mar 15, 2019 6:32:25 PM (UTC)

System of web content certification developed by [www.whostracker.com](http://www.whostracker.com). Patented and released to allow its open use. Patent number: [www.whostracker.com](http://www.whostracker.com)

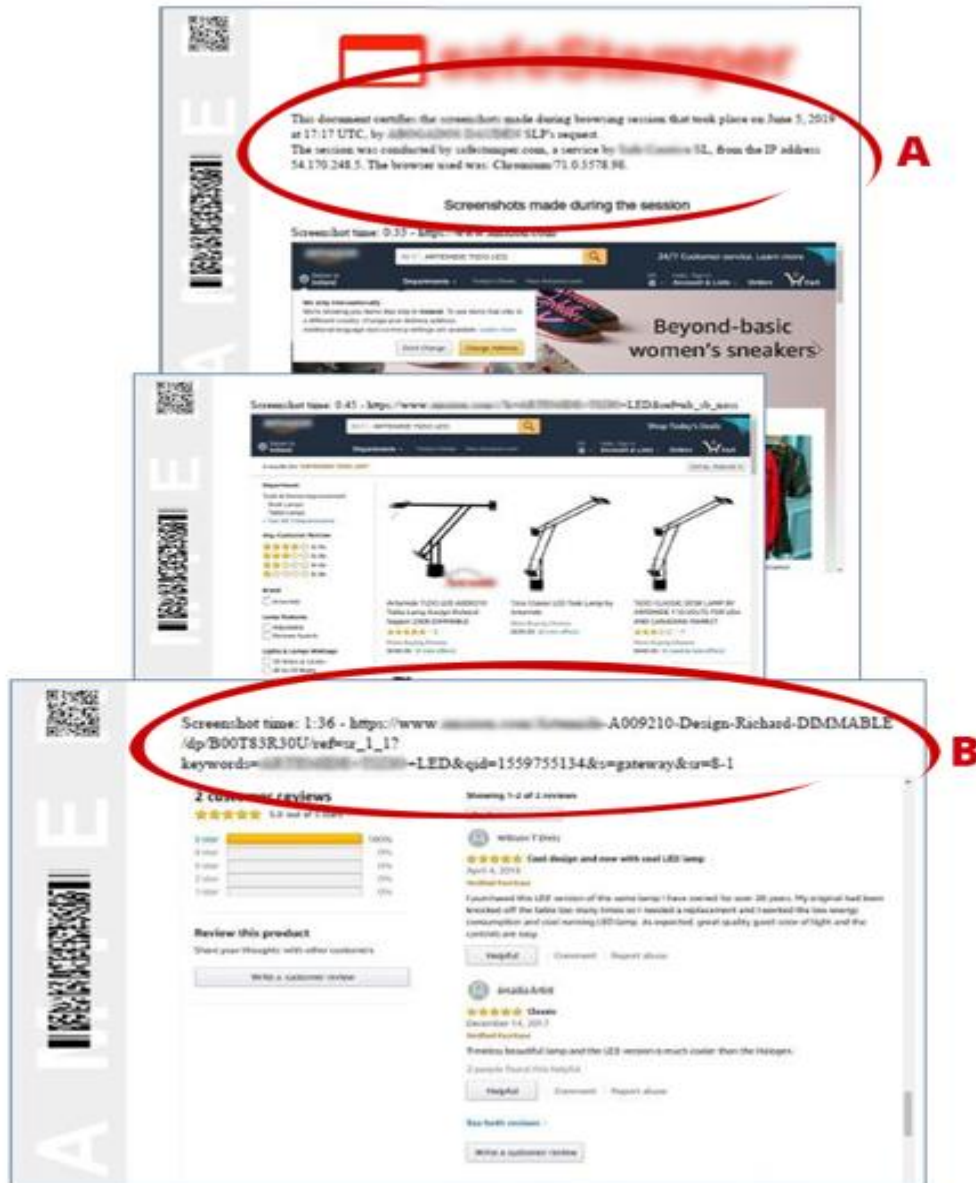
**A**



**Example 7**  
With timestamp

Timestamping browsing sessions (or 'dynamic webpages'), allows users to timestamp several screenshots or record a video of a web browsing session, which is certified through a signed and timestamped certificate that contains the video information and screenshots taken during the browsing session (see indications 'A' and 'B' in example 8 below).

*Timestamping a browsing session*



**Example 8**

**Recommendations:**

- it is advisable to use timestamping as a precautionary measure to secure the evidence of publication of particular content;
- when several steps are required to obtain the relevant evidence, it is advisable to timestamp the entire browsing session.

### 3.2.2.3 Forensic software tools

Forensic software tools<sup>(60)</sup> are used to acquire digital and computer-generated evidence. Some target non-expert users and are freely available on the internet.

These tools can be used, in particular, to extract information concerning the relevant date, which might be embedded in images, videos or the programming used to create a website (i.e. metadata). This data can be used for proving publication of particular content on the internet.

Forensic software tools can also be used to monitor social media capturing posts together with images.

#### **Recommendations:**

- When evidence is extracted using forensic software tools, it is recommended to provide information explaining the tool, how the information was obtained, what kind of information was extracted and from which content it was taken, as well as the date and time at which the information was obtained.

### 3.2.3 The period and timing of a market survey

With regard to market surveys, the question arises as to what the period of time reflected in the survey should be — the period before the filing date, at the moment of the proceedings, after the filing date, etc. Therefore, the party should take into consideration the recommendations indicated below.

#### **Recommendations:**

- The period of the survey should be relevant to the period when the cause of action arose as the survey would then be helpful to establish, for example, the recognition of a particular trade mark.

Nevertheless, a survey compiled some time before or after the relevant date could contain useful indications, although its evidential value can vary depending on whether the period covered is close to or distant from the relevant date<sup>(61)</sup>.

## 3.3 Ways to present evidence

Responsibility for putting evidence in order rests with the party to the proceedings. Furthermore, filing of evidence should be sufficiently clear and precise to enable the other party to exercise its right of defence and the appeal bodies or MS IPOs to perform their examination. Bearing in mind the above, the Common Practice includes recommendations on the presentation and structure of evidence, its acceptable formats, size and volume as well as an index of annexes.

It also contains guidance for UAs, parties and their representatives on how to design and conduct a market survey to be submitted as evidence in trade mark proceedings, as well as a checklist, which can be used by appeal bodies and MS IPOs as a decision support tool while dealing with the surveys.

Furthermore, the chapter presents a minimal standard for affidavits and witness statements.

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<sup>(60)</sup> Tools that help investigators retrieve evidence from computers and identify, preserve, recover and investigate the relevant information in line with digital forensic standards.

<sup>(61)</sup> For example: 12/07/2006, T-277/04, VITACOAT, EU:T:2006:202, § 38: '[...] it must be pointed out, first of all, that in order to have an unusually high level of distinctiveness as a result of the public's potential recognition of it, an earlier mark must, in any event, be familiar to the public on the filing date of the trade mark application or, as the case may be, on the priority date relied on in support of that application [...]. None the less, it is not in principle inconceivable that a survey compiled some time before or after that date could contain useful indications, although it is clear that its evidential value is likely to vary depending on whether the period covered is close to or distant from the filing date or priority date of the trade mark application at issue.'

### 3.3.1 *Presentation of evidence: acceptable formats, size and volume*

Bearing in mind certain differences between types of filings, for the purpose of this Common Practice, five groups of recommendations have been created for: (i) all types of filings (ii) paper filings, including filings of any physical items (iii) electronic/e-filings (iv) fax filings and (v) data carriers.

However, it should be stressed that e-filing, where available, remains the preferred means to file submissions and evidence. Furthermore, the party or its representative should always check in advance which types of filings are admitted by the relevant appeal body or MS IPO. For example, some may be paperless or not accept fax filings.

#### 3.3.1.1 *All types of filings*

Only those items of evidence which are mentioned in a submission and referred to in an index of annexes should be filed as annexes.

The submitting party should consider the following key aspects of a structured presentation of evidence regarding all types of filings.

#### **Recommendations:**

- Evidence should be contained in annexes to a submission, which should be numbered consecutively, for example: Annex 1, Annex 2 etc.
- Each annex should be clearly differentiated, e.g. by being introduced by a specific cover page or being marked Annex 1, Annex 2 etc. on the top of the first page of evidence.
- Each submission of written evidence (i.e. within each annex), if possible, should be paginated.
- Evidence should be accompanied by an index of annexes (described in subchapter 3.3.2.1 below).
- The party should include within its submissions an explanation as to what each item of evidence presents or intends to prove.
- Each reference in the submission to the filed evidence should state the relevant annex number as given in the index of annexes (described in subchapter 3.3.2.1 below).
- Additionally, if the party refers to evidence enclosed in a different submission it should be clearly indicated (e.g. Annex 3 to the Statement of Grounds).
- If required, the date and signature should be included on each page or submission of evidence, according to the procedure of each appeal body or MS IPO.
- If several trade marks, goods and services or dates are displayed in a single item of evidence, the relevant information should be clearly indicated.
- If originals contain colour elements of relevance to the file (for example a registration certificate<sup>(62)</sup> or evidence of genuine use), evidence should be filed in colour.

Parties to the appeal proceeding should carefully consider how much evidence they need to file to establish and prove the relevant facts. They should carefully select evidence filed in proceedings in view of both its quantity and quality and rationally assess the amount of evidence and its evidential value. Therefore, parties to the proceedings should take into consideration the points below.

#### **Recommendations:**

- if only a part of the evidence — for example, the front cover and a few pages inside — is relevant in a particular case, the party should file only the relevant pages/parts;
- however, upon request, a full/complete version of the evidence should be provided.

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<sup>(62)</sup> 25/10/2018, T-359/17, ALDI, EU:T:2018:720, § 45-57; 27/03/2019, T-265/18, Formata, EU:T:2019:197, § 48-53.

### 3.3.1.2 Paper filings, including physical items

In the case of a paper filing, the following indications are recommended.

#### **Recommendations:**

- If the documentation (evidence) is sent in different packages, an indication of the total number of annexes, number of packages and identification of the annexes contained in each package should be included on the front page of the index of annexes.
- The use of plain DIN-A4 sheets in preference to other formats or devices for all the documents submitted, including separators between annexes or enclosures, is advisable. Nevertheless, readability of evidence should be considered in each case. Therefore, there might be specific types of evidence (e.g. posters) where a bigger format (e.g. DIN-A1 sheet) is more appropriate.
- Original documents should not be sent. Rather a copy (if relevant, in colour) should be made and sent as an annex.
- The sending of physical specimens, samples etc. should be avoided wherever possible. Rather, a picture of them should be taken, which should be printed (if relevant, in colour) and sent as a document (an annex).
- If a party to the proceedings sends pictures of physical specimens/samples it should include all views relevant to the particular case by taking photos of each side of the sample and then of details such as the mark, language, dates or names of countries that may appear on it. Where possible, labels that are an element of the sample concerned should also be photographed separately on a flat, horizontal surface.
  - If applicable, the second copy for forwarding to the other party should be clearly identified.
  - If applicable, the second set of colour elements should be included for sending to the other party.

There is also a possibility to file evidence recorded on data carriers. This topic is described below in subchapter 3.3.1.5

### 3.3.1.3 E-filings

If a party files evidence electronically (via e-filing), it should bear in mind the following recommendations.

#### **Recommendations:**

- No second copy should be sent via e-filing. However, if required by an appeal body or MS IPO, a paper copy should be filed within a set deadline.
- File size restrictions depend on the technical limits and capabilities of each appeal body or MS IPO.

Furthermore, since the annexes (evidence) must be sent as files, the following should be taken into account by the party.

#### **Recommendations:**

- The annexes (evidence) should be contained in one or more files separate from the file containing the submission.
- A file may contain one or several annexes. It should not be obligatory to create one file per annex. However, it is recommended that annexes be added in ascending numerical order when they are filed, and that they be sufficiently clearly named (as described below).
- The files should include names, ideally identifying their content as clearly as possible (for example: Annex 1, Annex 2, Annexes 1 to 6, Annex 1 to 3 Invoices etc.).

The name length restriction for the above files depends on the technical limits and capabilities of each

appeal body or MS IPO.

#### 3.3.1.4 Fax filings

If a party files evidence by fax, it should bear in mind the following recommendations.

##### **Recommendations:**

- If a large amount of documentation (evidence) is submitted in different batches, an indication of the total number of annexes, number of batches and identification of the annexes contained in each batch should be indicated on the front page of the index of annexes.
- No second copy should be sent by fax. However, if required by an appeal body or MS IPO, a paper copy should be filed within a set deadline.

#### 3.3.1.5 Data carriers (DVDs, CD ROMs, USB Flash Drives, etc.) and other acceptable formats

Where e-filing is not available or the file size of the submitted evidence exceeds the technical capabilities of a given e-filing tool, only then should data carriers be filed.

If a party to the proceedings does file evidence using data carriers such as USB Flash Drives etc., it should follow the recommendations on files as annexes presented in subchapter 3.3.1.3 above.

In exceptional cases where a very large number of files are submitted on data carriers, evidence should be organised in sub-folders and a separate sub-folder should be created per annex (evidence), rather than filing everything in one single large folder. These sub-folders should include names (reflecting the annex they contain), ideally identifying their content as clearly as possible.

This document also presents *A full overview of all accepted formats to submit evidence in trade mark appeal proceedings*<sup>(63)</sup>, which is based on the practice of internal appeal bodies of MS IPOs and external appeal bodies and/or Courts acting as external appeal bodies in trade mark proceedings from Member States. The gathered data should be beneficial for UAs, as well as parties and their representatives.

The acceptance of the formats below by the appeal bodies is without prejudice to the acceptance of other formats in the future, for example, as a result of technological developments.

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<sup>(63)</sup> Data collected in October 2019.



Acceptable format of evidence	Paper	CD-ROMs	DVDs	USB flash drivers	External hard drives	Memory cards	Other optical discs	MP3 via e-filing/e-appeal	MP4 via e-filing/e-appeal	Physical specimens/samples
AT	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
BG	✓	✓	✓	✓	✓	✓		✓	✓	✓
BX										
CY	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
CZ	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A
DE	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
DK	✓			✓						✓
EE	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
ES	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
EUIPO	✓	✓	✓	✓				✓	✓	✓
FI	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
FR	✓	✓	✓	✓	✓	✓	✓			✓
GR	✓	✓	✓	✓	✓		✓			✓
HR	✓									
HU		✓	✓	✓				✓	✓	✓
IE	✓	✓	✓	✓	✓	✓	✓			✓
IT	✓	✓	✓							
LV	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
LT	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
MT										
PL	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
PT	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
RO	✓	✓	✓	✓	✓	✓	✓			✓
SE										
SI	✓	✓	✓	✓	✓	✓	✓			✓
SK	✓	✓	✓					✓	✓	✓
UK										

It should be stressed that although data carriers are recognised formats to submit evidence to the relevant appeal bodies and MS IPOs as indicated above, not all file formats contained within them may be accepted. Therefore, evidence recorded on data carriers is acceptable in the formats indicated and admitted by each appeal body or MS IPO individually.

Some guidance on file formats may be found in the *Common Communication on the representation of new types of trade marks*<sup>(64)</sup>. It presents a full overview of the accepted electronic file formats for the representation of all types of trade marks by each MS IPO.

#### **Recommendations:**

- As a minimal standard, submissions via CD ROMs, DVDs or USB Flash Drives should be accepted by appeal bodies.

<sup>(64)</sup> [https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/about\\_euipo/who\\_we\\_are/common\\_communication/common\\_communication\\_8/common\\_communication8\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/who_we_are/common_communication/common_communication_8/common_communication8_en.pdf)

### 3.3.1.6 *Printouts and screenshots: special requirements*

This subchapter draws on the conclusions and recommendations of the CP10 Common Practice — *Criteria for assessing disclosure of designs on the internet*.

Further, the following recommendations are applicable to all websites and Apps from which printouts are made or screenshots are taken.

It should be stressed that, as with other evidence, printouts or screenshots should not be manually modified (with the exception of pagination), for example, by adding the date of publication of the relevant content or the source.

#### **Recommendations:**

- Printouts and screenshots attached as evidence should contain information on:
  - the source from where the content was taken (e.g. URL address);
  - the relevant date;
  - the relevant content (e.g. the mark, goods and services etc.).
- When a printout or screenshot does not include all of the relevant information, it is recommended that parties submit additional evidence providing the missing elements (e.g. if the date in the relevant post including the mark is missing, comments, remarks or shares made on social media or catalogues published on commercial or retail sites may provide such information).
- In the case that the source (e.g. an URL address) is not fully visible in a printout or a screenshot it is recommended that additional evidence be provided.
- In relation to printouts, it is important to make a distinction between the printing date<sup>(65)</sup> of the document (printout) and the date when relevant content was published on the internet. The printing date will be assumed to be the date of publication of the content, unless an earlier relevant date can be established from the URL address, the contents of the document itself or any other evidence.
- When the relevant information is presented in a screenshot the date when the screenshot was taken will be assumed to be the date of publication of the relevant content, unless an earlier relevant date can be established from the content of the screenshot itself or any other supporting evidence.
- A printout or screenshot can also have the date when it was embedded, depending on the type of computer and/or device used. This date can be relevant for publication of particular content on the internet.

### 3.3.2 *Structure of the evidence*

Recommendations listed in this subchapter should be applied to all submitted evidence regardless of whether they are submitted physically, on data carriers, by electronic means or via fax.

#### 3.3.2.1 *Index of annexes*

As mentioned above, to facilitate a clear and precise presentation of evidence it should be contained in annexes to a submission. Furthermore, a party to the proceedings should create and file to the appeal body or MS IPO, together with its evidence, the index of annexes.

The index of annexes should be filed together with submissions and comply with the recommendations below.

#### **Recommendations:**

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<sup>(65)</sup> Date provided by the computer when the content from a website is 'printed out' (whether it is a hard/paper copy or in PDF format). This date is displayed on the top or bottom of the relevant page(s).

- Submissions should include an index (i.e. the index of annexes) indicating, for each item of evidence annexed, the following information:
  - the number of the annex;
  - a short description of the evidence and, if applicable, the number of pages;
  - the page number of the submission where the evidence is mentioned<sup>(66)</sup>;
  - if applicable, a particular item of evidence should be kept confidential (which means that the party has submitted a reasoned request for confidentiality regarding this evidence, and it should be marked as confidential and kept as such).
- The corresponding indication of the decision subject to appeal or a file number (depending on the stage of appeal proceedings) should be included at the top of the index of annexes;
- If applicable, in the case of fax filings, the first page of the index of annexes should clearly indicate whether the annexes/evidence submitted contain colour elements of relevance to the file;
- It is also advisable, but not mandatory, that the submitting party indicates, in the index of annexes, which specific parts of a document (evidence) it relies upon in support of its arguments.

For ease of reference for parties, their representatives and UAs, an index of annexes template has been created and enclosed as **Annex 1** to this Common Practice.

#### 3.3.2.2 *Non-structured evidence: consequences*

Where some of the conditions described in the chapter at hand are not met, the appeal body or MS IPO may invite the party to remedy the deficiency. The time limits (deadlines) which should be met to remedy the deficiency depend on the procedure of each appeal body or MS IPO and they should be indicated in the letter of deficiency.

#### **Recommendations:**

A deficiency should be raised where at least one of the following scenarios occurs:

- the evidence is not contained in annexes to a submission (this may be the case when the submissions or the index make reference to evidence, which is not attached to them — except in situations where the time limits to submit evidence have already expired);
- annexes are not numbered consecutively;
- pages in the annexes are not paginated;
- there is no index of annexes filed together with the submissions;
- the index does not indicate, for each document or item of evidence annexed:
  - the number of the annex;
  - a short description of the evidence and, if applicable, the number of pages;
  - the page number of the submission where the evidence is mentioned.

In the event that only the index of annexes is missing or deficient or a single annex is deficient, the party should only send the new index or annex.

If the deficiency is not remedied within the time limit set, acceptance remains at the discretion of the appeal body or MS IPO in question.

#### 3.3.3 *Structure of market surveys*

This chapter contains a set of recommendations on how to design and conduct a market survey that can be submitted to the appeal bodies or MS IPOs as evidence in trade mark proceedings<sup>(67)</sup>. This could aid

<sup>(66)</sup> Article 55(2) of Commission Delegated Regulation (EU) No 2018/625.

<sup>(67)</sup> Nevertheless, certain appeal bodies or MS IPOs may have specific rules on the admissibility of market surveys which may require parties to seek permission to adduce this type of evidence. Further, in some EU jurisdictions surveys may be designed in conjunction

the search for necessary common elements for a survey.

According to well-established practices at the EU level, market surveys are usually submitted as evidence to prove acquired distinctiveness or reputation of a trade mark. However, the recommendations can also be applied to other types of market surveys in trade mark proceedings.

#### 3.3.3.1 Requirements for a survey provider

In principle, surveys should be conducted by independent research institutes, companies or other independent experts. Given the complexity of such types of market surveys, the experts commissioned to conduct them should have relevant knowledge and/or experience. There is a consensus among experts that it is better to consult a specialised survey company instead of a generalist company. A specialised survey company/institution has a better understanding of the purpose of the survey and hence can better and more reliably structure and conduct the survey and interpret the results. Nevertheless, the choice of the survey expert/institution remains at the discretion of the parties.

The submitted survey report should not be rejected solely on the grounds that the expert/institution that performed the survey is not a known/international/large organisation, provided that all key elements of the survey report are properly defined and explained, and the survey methodology meets industry standards. These key elements may include: relevant universe, description of the sample, method of gathering responses, set of questions asked and end results.

To confirm *inter alia* the reliability of the results of a market survey it is recommended to provide relevant information about the professional background of the expert(s)<sup>(68)</sup>/research institute or company which undertook the survey.

#### 3.3.3.2 Consumer sample (sampling method, sample size)

The sample must be indicative of the entire relevant public and must be selected randomly<sup>(69)</sup>. It should be designed in such a way that the number and profile of the interviewees (at least in terms of gender, age, region/geographical spread, educational level, occupation and background) is representative of the different kinds of potential consumers of the goods and/or services in question.

The matter of how to determine whether a survey is representative is a major issue in practice. Therefore, it may be useful to consider what 'representative' means in connection with sampling. Since it is impossible to interview an entire population or every consumer/ relevant professional in a particular case, a sample should be drawn. The sample is a much smaller group of a manageable size. It is planned in such a way that it faithfully matches the composition of the entire group to be investigated; ideally, the sample should be an exact miniature version of the 'universe' to be researched.

The way to achieve representativeness is by applying a scientific sampling procedure, i.e. either the 'random'<sup>(70)</sup> or 'quota'<sup>(71)</sup> sampling method<sup>(72)</sup> or another scientific method that also renders representative

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with, or approved by, the appeal body or MS IPO.

<sup>(68)</sup> This can be a copy of the expert's CV or the company profile; a list of their publications on market surveys; information that the expert participated in relevant conferences as a speaker; membership of professional associations, etc.

<sup>(69)</sup> 29/01/2013, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 88.

<sup>(70)</sup> The random method provides that the sample is randomly selected from the population on the basis of systematic criteria. The main principle of random sampling is that each element of the universe has the same (predictable) chance of being selected as an element of the sample.

<sup>(71)</sup> The quota sampling attempts to design the sample as a miniature model that reflects the sociodemographic structure of the respective universe as closely as possible by setting targets for the composition of the sample, e.g. in terms of gender, age, regional distribution and occupation, based on statistics from other sources. Interviewers are required to interview a certain number of people who have certain sociodemographic characteristics or combinations of characteristics so that the structure of the sample corresponds to that of the universe.

<sup>(72)</sup> In both cases (random and quota sampling), the data must be weighted if the structure of the sample (e.g. with regard to age or

samples. These methods choose respondents systematically and actively, generate a random selection, and result in an appropriate/representative sample.

Depending on the goods and services in question, the relevant consumers may be defined not only by territory but also by division into various groups: (1) general public (the consumers of general, publicly available goods and services demanded by anyone), (2) or a specific group of consumers within the general public (e.g. persons who buy equipment which serves a certain purpose that is not relevant for all consumers in the general public, e.g. motorcycle helmets, golf equipment, products for the care of contact lenses, diapers for babies etc. which are clearly of use only for a specific, typically smaller segment of the general public) or (3) professionals (the consumers of specific goods and services normally not intended for the general public).

A sample size comprising, for example, between 1 000 to 2 000 consumers could be considered as sufficient for the general public and general goods and services. However, the sample size may comprise a lower number of consumers depending on the Member State population (relevant public) in question, countries' specificities and the field of goods and services. It therefore follows that for professionals and more specialised/specific goods and services a significantly smaller sample size could be representative and of evidential value as long as it is selected strictly at random. Compared to the total population, users of specific goods or services and professional groups are generally more homogeneous, and their responses show much less divergence.

Therefore, the representativeness of a sample does not depend on a large number of interviewees.

The lower the margin of error<sup>(73)</sup>, the greater the level of certainty that the survey is reliable and representative<sup>(74)</sup>.

To summarise, the following should be addressed in a survey report:

- a clear indication of the relevant public;
- whether the relevant 'consumer' in a particular case is the general public, a specific group or professional circles;
- a clear explanation of how the sample was designed and selected, and which scientific method was used (quota, random or other);
- relevant statistical data (tables) should be provided, including information on distribution of the population in terms of, at least, region, age, gender, educational level, occupation, etc.;
- an unambiguous explanation of what the size of the sample for a particular case was and an explanation that it is representative;
- any percentage mentioned in a survey should also be explained (whether it corresponds to the total amount of interviewees or only to those who replied).

### 3.3.3.3 *Method of conducting the survey (face-to-face, telephone, online etc.)*

There are no methods or channels which are obligatory, and several different ways of conducting surveys

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gender) deviates significantly from the sociodemographic target structure of the respective universe. In the weighting process, persons who are underrepresented in the sample receive a higher weighting factor ( $> '1'$ ), i.e. they are included to a greater extent in the evaluation, while those who are overrepresented receive a correspondingly lower weighting factor ( $< '1'$ ). This ensures that the sample reflects the structure of the respective universe accordingly.

<sup>(73)</sup> **The margin of error** expresses the maximum expected difference between the true population parameter and a sample estimate of that parameter. To be meaningful, the margin of error should be qualified by a probability statement (often expressed in the form of a confidence level). In statistics, **the confidence level** indicates the probability with which the estimation of the location of a statistical parameter (e.g. an arithmetic mean) in a sample survey is also true for the population.

<sup>(74)</sup> For example: If we choose a confidence level of 95 % and a margin of error of 5 %, we will be sure of the result with a  $\pm 5$  % chance of error and 95 % confidence that the chosen sample is representative of the entire population. A 95 % confidence level with a 5 % margin of error is a sampling approach generally accepted as being representative.

can be distinguished, each with their advantages and disadvantages. Common interview modes are face-to-face interviews, by telephone, and online interfaces (mostly in the form of so-called online access panels).

The method and circumstances in which the respondents are interviewed has a direct impact on the quality and reliability of the results of the survey. It is important to provide an explanation of the method chosen to conduct a survey in the survey report, otherwise the reliability of the survey can be brought into question.

The method of conducting a survey should be chosen by taking into account:

- (1) the relevant public and the number of potential respondents;
- (2) the need to demonstrate a test object (a sign, product packaging) to the interviewees;
- (3) the possibilities to ensure the traceability of the answers (that one person responds only once, and that the answers cannot be changed by the respondent retrospectively);
- (4) the need to create such conditions that the respondents answer spontaneously (e.g. limited time for answering the questionnaire, no possibility to consult the internet/other sources of information).

The appropriate method of conducting a survey should be chosen by a survey expert on a case-by-case basis.

With regard to online surveys, it should be clearly demonstrated in the survey report that the consumer sample is representative and the respondents provided their answers in a controlled environment. In the case of online panels, the respondents should be randomly selected from the members of the panel. The respondents should pass a screening process that ensures that they are actually members of the relevant public. A controlled analysis frame helps later to guarantee the relevancy of the results (i.e. if a respondent interrupted the survey for whatever reason, his/her answers would be excluded).

To summarise, the following should be addressed in a survey report:

- information on the method of gathering responses (method of conducting a survey) applied; and
- an explanation of why it was chosen as appropriate in a particular case.

#### 3.3.3.4 *Structure and wording of the survey questionnaire*

It is important in each case to design an objective test approach broken down to a set of neutral questions that correspond to the purpose of the survey. The questions asked cannot be leading ones<sup>(75)</sup>. Double barrelled questions should be avoided (survey questions should not be compound but should instead focus on one topic) - the questionnaire should be simple and concise.

The probative value of the surveys depends on the way in which the questions are formulated. A survey may consist of a combination of closed-ended<sup>(76)</sup> and open-ended questions<sup>(77)</sup>. It should be taken into account whether the appropriate type of question was selected in view of the survey objective<sup>(78)</sup>.

It is advisable not to use the same uniform test or questionnaire for different types of surveys. On the contrary, for each type of survey different questionnaires and test patterns should be used.

Given their different purposes, it is recommended not to combine test protocols, for example when surveying on acquired distinctiveness or on reputation, into one test or to conduct both types of test within the same survey interview or with the same respondent.

<sup>(75)</sup> 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 79.

<sup>(76)</sup> Closed-ended questions can be answered with 'Yes'/'No'/'Maybe' or they have a limited set of possible answers (such as: 'A', 'B', 'C').

<sup>(77)</sup> Open-ended questions are questions that allow someone to give a free-form answer.

<sup>(78)</sup> Some examples of suggestive questions may be found in: 15/12/2005, T-262/04, Three-dimensional trade mark in the shape of a lighter, EU:T:2005:463, § 83-86; 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 79.



As regards the wording and structure of the questionnaires, the following is recommended:

- The survey should use clearly structured questions which follow the same order and format for all interviewees.
- The language of these questions should be clear and concise.
- The questions asked should not be leading and should not direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put forward.
- The questions should be formulated in such a way as to obtain spontaneous answers.
- Open and unaided questions should usually be given more weight.
- Exact answers and not an abbreviation, summary or digest of the answer should be recorded.
- Answers such as ‘yes’, ‘no’ or ‘I don’t know’ are simple and the easiest to understand and measure. For this to happen closed questions are needed, although sometimes it is relevant to fix a scale and to know more about the consumer’s opinion or preferences: in such cases, open questions are needed.
- A complete list of questions included in the questionnaire should be disclosed.
- The totality of all answers given to the survey should be disclosed.
- The instructions given to interviewers should also be disclosed.

Since market surveys are often submitted as evidence to prove acquired distinctiveness or reputation, this Common Practice provides general guidance on the ‘three-step test approach’ that can be useful especially for parties to the proceedings and their representatives.

However, it should be stressed that the particular number and wording of the questions should be always defined by a survey expert on a case-by-case basis.

### Acquired distinctiveness

The three-step test essentially aims at determining respondents’ ability **to spontaneously recognise** a particular test object <sup>(79)</sup>, sometimes among a number of others <sup>(80)</sup>, in connection with a certain type of product or service (recognition) as coming from only one specific commercial source.

Such a question structure constitutes a filtering mechanism, enabling measurement of the degree of distinctiveness deriving from the share of persons who exclusively attribute the test object to only one specific source of commercial origin.

Only positive answers move the interviewee to the next question. Consequently, a number of the interviewees will be lost at each step.

The second step of the test is the decisive one as it determines the share of persons who, because of the mark, attribute the test object in the context of the specific goods or services as originating from only one single undertaking.

The third step is constructed as an additional cross-check; it is not necessary that answers are correct or that the respondents are able to actively and correctly name that particular undertaking. However, the impact of negative or incorrect or guessed answers on the distinctiveness should be considered at this stage. In essence, the first two closed-ended questions determine the degree of acquired distinctiveness, whereas the third open-ended question can be considered an additional factor strengthening such distinctiveness while not being a determinative factor.

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<sup>(79)</sup> Some examples of questions may be found in: BoA decision, 18/04/2018, in case R 972/2017-2, § 6, appealed to the GC, 10/10/2019, T-428/18, mc dreams hotels Träumen zum kleinen Preis!, EU:T:2019:738, § 71 (action dismissed).

<sup>(80)</sup> 15/12/2005, T-262/04, Three-dimensional trade mark in the shape of a lighter, EU:T:2005:463, § 84.

### Step 1

- **Awareness**
- Awareness of the sign in relation to the pertinent type of products or services claimed
- Closed-ended questions
- The following questions could be used, but could naturally be adapted to the specific factual, economic and cultural context in question: 'Do you know sign X\*/any of these signs X Y Z etc\*\*'. in relation to good Z?/'Have you seen this colour/any of these colours used on X before?'
- Possible answers: 'yes', 'no', 'maybe'
- \*Please see footnote #79 above
- \*\*Please see footnote #80 above

### Step 2

- **Exclusive attribution to only one single commercial source**
- Only those who answer 'yes' or 'maybe' at step 1
- Establishing recognition of the sign as pertaining to a single undertaking
- Closed-ended questions
- The following questions could be used, but could naturally be adapted to the specific factual, economic and cultural context in question: 'Do goods with sign X derive only from a single undertaking or from different ones?/'Do the products bearing this colour (1) come from a particular company; (2) come from a number of different companies; (3) tell you nothing at all?'
- Possible answers: 'from one company', 'from different companies', 'tells me nothing'

### Step 3

- **Level of identification of that source (most often by name) by means of a control question**
- Only for those who answer 'from one particular company' at stage 2
- Identification of that undertaking either by name or other description
- Open-ended question
- The following questions could be used, but could naturally be adapted to the specific factual, economic and cultural context in question: 'What is the name of the undertaking? Can you name this particular company?'

## Reputation

Surveys measuring reputation of a mark must, in essence, focus on establishing the level of **active recall** among consumers. For measuring reputation, open-ended questions that require active knowledge and unaided formulation of answers by the respondents themselves are appropriate.

From a legal point of view, we are assessing if a trade mark can benefit from a larger scope of protection due to the degree of 'recall' of the interviewee i.e. direct and immediate association or more descriptive information provided.

It is recommended to formulate the questions in a manner which allows the respondents to provide any spontaneous responses. These freely-worded responses are then analysed using a category system (coding key).

The recommended structure of the questionnaire also comprises three steps.

At step one, the question should be designed to measure the spontaneous awareness of the sign/signs.

At step two, the respondents should be asked to describe what they know about the sign, what they associate with it. Respondents must formulate their descriptions themselves, without the aid of any pre-worded response categories. The relevant percentage for clarifying the legal issue at hand is determined based on the share of respondents who are familiar with the mark and, at the same time, are able to accurately describe the pertinent kinds of goods or services provided by the trade mark owner.

The legally decisive finding, 'active knowledge', is obtained via the question asked at step two. It presupposes awareness, as measured by the question at step one, at an individual level.

At step three, some optional questions may be asked to determine respondents' opinion in detail for further analysis (e.g. as to the characteristics of the goods and services, particular interest of the consumers in certain goods and services, etc.).

The following structure illustrates this approach:

### Step 1

- **Spontaneous awareness of the mark without mentioning the related type of goods or services**
- The following questions could be used, but could naturally be adapted to the specific factual, economic and cultural context in question: 'Do you know this sign/any of these signs?'/ 'Among these signs could you please choose those that you have seen before, or seem familiar to you, or are completely unfamiliar to you?'

### Step 2

- **Verified awareness**
- Correct associations as to the kind of goods or services involved (active knowledge via unaided associations by active, unaided description of the related products/services or other correct information that comes to mind (open-ended question).
- The following questions could be used, but could naturally be adapted to the specific factual, economic and cultural context in question: 'What can you tell me about it/this one?'/ 'Regarding the signs that you have seen before or seem familiar to you, what do you know about each of them, what do they refer to?'

### Step 3

- **Additional optional questions to obtain information for further analysis**
- e.g. on the characteristics of the goods or services themselves or on the reputation of the manufacturer of the good or service, or other indicator questions
- Additionally, the group of persons interested in purchasing the relevant goods or services might be determined.
- The following questions could be used, but could naturally be adapted to the specific factual, economic and cultural context in question: 'Do you think that the products that are sold under this logo are of high quality, or do they tend to be of average quality, or are they below average in terms of quality?'/ 'How much are you personally interested in this specific type of good or service? Would you say you are very interested, somewhat interested, or not at all interested?'

### 3.3.3.5 Checklist: a support tool to assess the content and standard of a survey

In principle, the checklist below may be used by appeal bodies and MS IPOs as a support tool to assess the content and standard to which market surveys should correspond.

<b>Index</b>	<b>Question</b>	<b>Answer</b>
<b>Means of evidence provided</b>		
1	Is the survey part of a larger set of evidence presented or is it the sole element?	Part of a set of evidence / Sole evidence
<b>Purpose of the survey</b>		
2	Is the purpose of the survey clearly indicated?	Yes / No
<b>Requirements for a survey expert/institution</b>		
3	Has the study been conducted by an independent expert/institution?	Yes / No
4	Is there evidence that the expert/institution has relevant qualifications and/or experience?	Yes / No
A 'no' to any of these questions may lead to the survey being dismissed, as the results may be considered unreliable. The matter remains at the discretion of the appeal bodies and MS IPOs.		
<b>Relevant market and extrapolation</b>		
5	Has the relevant public to be surveyed been clearly defined?	Yes / No
6	Is the relevant public to be surveyed the same as the market in which the trade mark is used and/or the rights holder is operating?	Yes / No
7	Depending on the mark, and nature of the goods and the services, has the survey been conducted across the territory of the EU/ specific Member State?	Yes / No
8	Has a territorial extrapolation been made <sup>(81)</sup> ? If yes, has the basis for the extrapolation been explained in the submissions?	Yes / No
As a general recommendation, questions 5, 6 and 7 should be answered 'yes', and due care should be given to the answer to question 8 in order to assess the reliability of the survey as evidence. The matter remains at the discretion of the appeal bodies and MS IPOs.		
<b>Consumer sample</b>		
9	Has the design of the sample population been clearly and fully explained?	Yes / No
10	Has the minimal recommended sample size been established and reached?	Yes / No
11	Has a sufficiently reliable confidence level of the sample and a specific margin of error been given?	Yes / No
12	Have statistical tables and raw data been provided?	Yes / No
A 'no' answer to any of these questions may lead to the survey being dismissed as unreliable. The matter remains at the discretion of the appeal bodies and MS IPOs.		
<b>Method of conducting survey</b>		
13	Is there a description of how the respondents were interviewed and how the survey was carried out (face-to-face <sup>(82)</sup> , telephone, online, etc.) and, if applicable, by whom?	Yes / No
14	Is there a clear description of the results and/or an explanation on how the results have been evaluated?	Yes / No
15	Have copies of interviewer instructions and questions been provided? These may extend to include validation results, code books and indications on the	Yes / No

<sup>(81)</sup> This is applicable if the survey intends to cover more than one Member State. This concept is presented, for example, in: 25/07/2018, in joined cases C-84/17 P, C-85/17 P and C-95/17 P, Three-dimensional mark representing the shape of a four-fingered chocolate bar, EU:C:2018:596, § 80-83; 24/02/2016, T-411/14, Shape of a contour bottle without fluting, EU:T:2016:94, § 80.

<sup>(82)</sup> If yes, where? At home, in a shop etc.?

	range of response options open to respondents.	
16	Were the same questions put in the same order to all the respondents?	Yes / No
17	Is there information on how <sup>(83)</sup> , and via which means, the sign was presented to the interviewees? Was the sign shown to the respondents in the same way as it appears in the application or as registered <sup>(84)</sup> ?	Yes / No
<p>If any of these answers is 'no', then the survey may be dismissed as unreliable. The matter remains at the discretion of the appeal bodies and MS IPOs. However, if the answer is 'no' to the question "<i>Was the sign shown to the respondents in the same way as it appears in the application or as registered</i>", then further information/examination should be provided/conducted. The matter remains at the discretion of the appeal bodies and MS IPOs.</p>		
<b>Types of questions</b>		
18	Is there a copy of the exact wording of the questions provided?	Yes / No
19	Are there any leading questions in the questionnaire?	Yes / No
20	Has the survey been conducted in such a way as to identify the mark, product(s) or service(s) in question?	Yes / No
<p>The survey should only be admitted if the structure of the questions is adhered to (answer 18 is 'yes'), the questions are not leading (answer 19 is 'no') and the mark/product(s)/service(s) has been identified (answer 20 is 'yes'). However, the matter remains at the discretion of the appeal bodies and MS IPOs. Moreover, regarding question 18, it is important to note that different questionnaire structures should be followed depending on the purpose of the survey — as explained in the subchapter '<i>Structure and wording of the survey questionnaire</i>' above.</p>		
<b>Managing bias and errors</b>		
21	Is there a description of additional measures taken to further reduce errors and bias, e.g. control tests?	Yes / No
22	Was any previous survey carried out for the relevant product/service in the given sector in the territory in question?	Yes / No
<p>The survey should contain a section where the researcher demonstrates having evaluated possible bias and error during the entire process of design, execution and reporting phases of the survey (answer 21 is 'yes').</p>		

### 3.3.4 Templates

Written statements are often submitted in trade mark proceedings. Therefore, the Common Practice presents proposals for affidavits and witness statements' minimal standard of content. They can be beneficial for UAs, parties to the proceedings as well as their representatives, and help them to produce and submit such evidence in trade mark proceedings. Furthermore, it might support decision-making processes of appeal bodies or MS IPOs as it creates a minimal standard for statements discussed and agreed among different EU stakeholders. However, assessment of this evidence always remains at the discretion of the appeal bodies and MS IPOs.

#### 3.3.4.1 Affidavits

It is advisable that the following elements are included in affidavits <sup>(85)</sup>:

- a) place and date;
- b) title of the document;
- c) full name of the affiant/declarant;

<sup>(83)</sup> For example: the interviewer only showed the word/sign to the interviewees without saying it (10/10/2012, T-569/10, BIMBO DOUGHNUTS, EU:T:2012:535, § 72-73).

<sup>(84)</sup> 19/06/2019, T-307/17, Figurative mark representing three parallel stripes, EU:T:2019:427, § 133-137; 10/11/2014, T-402/02, Figurative mark representing the form of a twisted wrapper (shape of a sweet wrapper), EU:T:2004:330, § 88; 10/11/2004, T-396/02, Shape of a sweet, EU:T:2004:329, § 66.

<sup>(85)</sup> Only applicable if Member States' legal system includes the concept of 'affidavit'.



- d) ID number or other national identification number of the affiant/declarant;
- e) occupation of the affiant/declarant;
- f) affiant/declarant's family, professional or personal relation, affiliation, collaboration or common business interests with the parties to the dispute; if applicable, if the statement is made in a professional, business or other occupational capacity, the address at which the affiant/declarant works, the position he/she holds and the name of the firm or employer;
- g) acknowledgement recognising the purpose of the statement;
- h) declaration/statement of specific facts, without any legal assessments or opinions;
- i) statement of truth;
- j) if applicable, the number of sheets attached to the affidavit;
- k) signature.

It should be stressed that the above list is only indicative and does not influence the importance or probative value of affidavits. It is **non-exhaustive**, thus, any other elements which are relevant (or even required under national law) to the appeal bodies or MS IPOs should be added.

#### 3.3.4.2 *Witness statements*

It is advisable that the following elements are included in witness statements <sup>(86)</sup>:

- a) place and date;
- b) title of the document;
- c) full name of the witness;
- d) ID number or other national identification number of the witness;
- e) occupation of the witness;
- f) witness' family, professional or personal relation, affiliation, collaboration or common business interests with the parties to the dispute; if applicable, if the statement is made in a professional, business or other occupational capacity, the address at which the witness works, the position he/she holds and the name of the firm or employer;
- g) acknowledgement recognising the purpose of the statement;
- h) statement of specific facts, without any legal assessments or opinions;
- i) statement of truth;
- j) if applicable, the number of sheets attached to the statement;
- k) signature.

It should be stressed that the above list is only indicative and does not influence the importance or probative value of witness statements. It is **non-exhaustive**, thus, any other elements which are relevant (or even required under national law) to the appeal bodies or MS IPOs should be added.

### 3.4 Confidentiality of evidence

This Common Practice does not concern the General Data Protection Regulation No 2016/679 (hereinafter GDPR) or other acts regarding this subject — aside from the matter of anonymisation of natural persons' personal data and health related personal data <sup>(87)</sup> in files and decisions (see below subchapter 3.4.5.).

The term 'Confidentiality of evidence/data' in this chapter refers to business and trade secrets <sup>(88)</sup> and other confidential information <sup>(89)</sup> (e.g. information about business partners, suppliers and customers, sensitive

<sup>(86)</sup> Only applicable if Member States' legal system includes the concept of written 'witness statement'.

<sup>(87)</sup> In the meaning described in Article 4 GDPR, including special categories of personal data (sensitive data) as described in Article 9 GDPR.

<sup>(88)</sup> In the meaning described in Article 2 of the Directive (EU) No 2016/943 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure; based on Article 39 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).

<sup>(89)</sup> Can be understood as information other than trade secrets, insofar as its disclosure would significantly harm a person or undertaking and the interests liable to be harmed by disclosure should be worthy of protection. Inspiration can be taken from the jurisprudence of the EU courts, e.g. 12/10/2007, T-474/04, EU:T:2007:306, § 65.

economic information such as turnover or sales figures, market research or planned strategies as well as business plans). In addition, the relevant national rules and, if applicable, national case-law defining the above concepts should also be taken into account.

Appeal bodies and MS IPOs should protect parties' and third parties' (e.g. witnesses) confidential and personal data, which can be included in the submitted evidence and then found in the case files or decisions. Furthermore, under the condition that either an explicit request or a reasoned confidentiality request has been filed or if the appeal body or MS IPO considers *ex officio* that evidence contains health related personal data or sensitive data (see subchapters 3.4.1 - 3.4.5), they should exempt the aforementioned data from publication.

The party to the proceedings should always inform the appeal body or MS IPO that it is filing confidential evidence, which should be marked as confidential and kept as such. In specific circumstances, a party may also request confidentiality of evidence submitted by another party.

Bearing in mind the above, the chapter at hand presents some recommendations on the request for confidentiality, its justification and assessment as well as treatment of confidential data by appeal bodies and MS IPOs in their files and while publishing their decisions. In addition, some recommendations on anonymisation are presented below.

#### 3.4.1 *The scope of the confidentiality request*

For the purpose of this document, we should distinguish between two situations: (i) keeping evidence/data confidential vis-à-vis third parties and (ii) keeping evidence/data confidential with regard to the other party in *inter partes* proceedings.

Each party involved in *inter partes* proceedings should always have a right to defend itself. Therefore, as a general rule, the party (or its representative) should have access to all material, including evidence, submitted by the other party to the appeal proceedings.

If one of the parties requests certain data to be kept confidential, it should clearly indicate whether this should be vis-à-vis third parties or also towards the other party to the proceedings, in order that appeal bodies and MS IPOs may take further appropriate steps in this matter.

#### **Recommendations:**

- the party, in its submission or confidentiality request, should clearly indicate whether the evidence filed should be kept confidential vis-à-vis third parties or also from the other party to the proceedings;
- if the appeal bodies and MS IPOs receive evidence with a confidentiality request vis-à-vis the other party in *inter partes* proceedings, the party (sender) requesting complete confidentiality should be informed, for example in the form of a deficiency letter, that it may choose between:
  - (i) accepting disclosure of this evidence to the other party and/or its representative, but maintaining its confidentiality for third parties; or
  - (ii) submitting this evidence in a way that avoids revealing the parts of the document or data that the party considers confidential (such as by redacting/blacking out the relevant parts); or
  - (iii) withdrawing the item of evidence.

Lastly, it should be stressed that the circumstances in which the appeal bodies or MS IPOs may allow **third parties or other administrative bodies/courts** to access confidential evidence/data submitted during the proceedings remain out of the scope of the CP12 Common Practice.

### 3.4.2 *Acceptable ways and point in time to claim confidentiality*

In general, confidentiality is claimed in relation to trade secrets and other confidential information<sup>(90)</sup>. However, data/information that is already known outside the undertaking, association, group etc. and has been made publicly available **should not be considered** as trade secrets or otherwise as being confidential.

In order to claim confidentiality, a party to the proceedings should present a reasoned request together with the evidence containing confidential data.

#### **Recommendations:**

- The party should indicate that evidence is confidential or contains confidential parts while submitting it.
- The party should also justify its confidentiality claim (as described in subchapter 3.4.3. below) while submitting the evidence, which should be marked and kept as confidential.
- A confidentiality request should not be made in reference to data which is already known outside the undertaking, association, group etc. and is publicly available.
- The confidential evidence should be identified by clearly indicating the annex numbers (which contain confidential data) as well as indicating which parts of the evidence<sup>(91)</sup> are to be kept confidential and why the attached evidence or a part thereof is confidential (as described in subchapter 3.4.3. below).
- An indication of whether confidentiality has been requested should also be provided in the index of annexes, next to the relevant evidence (as described in subchapter 3.3.2.1 above).
- The confidentiality request itself should be limited to the general nature of the confidential data or information<sup>(92)</sup> and should be made accessible to the parties that are entitled to have access to the files. Therefore, it should not be marked as confidential and the party or its representative should not include confidential data in its confidentiality request. However, any attachments (evidence) thereto may be labelled/marked as confidential and excluded from access to files or publication.

### 3.4.3 *Criteria for assessing the confidentiality request*

The assessment of whether given evidence contains trade secrets or other confidential information/data has to be made on a case-by-case basis, also taking into consideration the rules established by national law<sup>(93)</sup>. However, when assessing the request for confidentiality, any special interest<sup>(94)</sup> put forward by the requestor in keeping certain data confidential should be taken into account by appeal bodies and MS IPOs, including the impact which the granting or rejection of the confidentiality request could have on the requesting party.

#### **Recommendations:**

- The party should provide justification in support of its confidentiality claim — in particular, it should have expressly invoked, and sufficiently justified, a special interest in keeping the information/data confidential. However, it is recognised that some information/data is often considered confidential, for example price lists for distributors or client lists. Therefore, indicating the sensitivity and confidentiality of such information/data should be considered sufficient justification.
- If a special interest in keeping certain information/data confidential is invoked, the appeal bodies and MS IPOs should check whether it is sufficiently justified.

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<sup>(90)</sup> Defined in the introduction of this section of the Common Practice (footnote 88 and 89).

<sup>(91)</sup> Not applicable if the entire evidence is to be kept confidential.

<sup>(92)</sup> An example of general information on confidential data or information: 'data on price lists for distributors or client lists, which are relevant for the current business strategy/commercial relations'.

<sup>(93)</sup> Please see the definition of the term 'confidentiality of evidence/data' in the introduction of this section of the Common Practice.

<sup>(94)</sup> The special interest should be due to the confidential nature of the evidence/data, for example, its status as business and trade secrets, or any other interest (in keeping certain data confidential) recognised by EU or national law or case-law.

- If confidentiality is claimed **with an explanation** that justifies the confidential nature or status of the information/data, the confidentiality claim should be upheld.
- If confidentiality is claimed with **no explanation** or indication of any special interest, or without any attempt to justify the confidential nature or status of the information/data, the appeal body or MS IPO may raise a deficiency. If the deficiency is not remedied the appeal body or MS IPO should lift the confidentiality if the decision is final without further communication.
- If confidentiality is claimed **with an explanation that is insufficient** to justify the confidential nature or status of the information/data, the appeal body or MS IPO should raise a deficiency. If the deficiency is not remedied the appeal body or MS IPO should lift the confidentiality if the decision is final without further communication. If the deficiency is remedied the confidentiality claim should be upheld.

#### 3.4.4 Treatment of confidential data in files and decisions

As a general rule, it is advisable that the decisions of appeal bodies and MS IPOs are made available (offline/online) for the information and consultation of the general public and in the interest of transparency and predictability. However, some parts of the decisions may be exempted from publication on the grounds of confidentiality.

Furthermore, confidential data should be marked and kept as such in files. Therefore, some specific means may be applied to ensure this occurs.

There are several means that the appeal bodies and MS IPOs may use to safeguard the confidentiality of data.

Since some appeal bodies or MS IPOs do not publish their decisions or evidence online, recommendations below should be used only in applicable cases.

#### **Recommendations:**

It is advisable that in the case of:

##### Business and trade secrets and other confidential information

###### a) In files (online and offline)

- these should be exempted from online file access only upon explicit request (see subchapter 3.4.2 — 3.4.3) filed by the party;
- online access should be blocked to any evidence marked as confidential without examining whether it actually contains any confidential data;
- if applicable, if a third-party requests access to evidence which is not available via the online file access, the appeal body or MS IPO examines that request on an individual basis in accordance with its practice or the relevant legal provisions.

###### b) In decisions (online and offline)

- In the case of a confidentiality request, the data should be described in such a general manner that it does not contain any business and trade secrets or other confidential information.
- Where a decision necessarily contains business and trade secrets or other confidential information, that confidential data should be exempted from publication by redacting the relevant part(s). Two different versions of the decision should be kept: a complete version for notification to the parties (which is kept confidential) and a redacted version for publication.

##### Amicable settlement of disputes

- All evidence referring to a friendly settlement during opposition, cancellation, appeal proceedings or mediation should be considered confidential and in principle not open to online file access or publication.

#### 3.4.5 *Treatment of personal data, health related personal data and sensitive data in files and decisions (anonymisation)*

As an example, the following information may be anonymised, in accordance with applicable law, in appeal body or MS IPO decisions or judgments: name and identification number of natural persons.

#### **Recommendations:**

##### *I. Personal data:*

###### a) In files (online and offline)

- this should be exempted from online file access only upon explicit request filed by the party;
- if applicable, if a third-party requests access to evidence which is not available via the online file access, the appeal body or MS IPO examines that request on an individual basis in accordance with its practice or the relevant legal provisions.

###### b) In decisions (online and offline)

- Any party to the proceedings may request the removal of any personal data included in the decision. Therefore, it may be exempted from publication.

##### *II. Health related personal data and sensitive data<sup>(95)</sup>*

###### a) In files (online and offline)

- The appeal body or MS IPO should examine *ex officio* whether evidence contains health related personal data or sensitive data and, if that is the case, should exempt it from online file access. Therefore, this data should be exempted from online file access even without a specific request.

###### b) In decisions (online and offline)

- The health-related personal data and sensitive data should be exempted from publication by redacting the relevant part(s). Two different versions of the decision should be kept: a complete version for notification to the parties (which is kept confidential) and a redacted version for publication.

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<sup>(95)</sup> As described in Article 9 GDPR.

## 4 ANNEX 1

TEMPLATE

Decision subject to appeal/file number:..... (please indicate)  
Annexes contain colour elements: YES/NO (only in the case of fax filings)

### THE INDEX OF ANNEXES

**Documents and items of evidence filed physically, electronically,  
using data carriers or by fax**

Annex No	A short description of the annex <sup>(1)</sup>	Number of pages <sup>(2)</sup>	Page number of the submission where the evidence is mentioned	Confidentiality request <sup>(3)</sup>	<b>Optional</b> Which specific parts of a document (evidence) the submitting party relies on in support of its arguments
1.	Letter, 10/12/2017, from Mr Green to Mrs Smith	3	p. 2	Yes	
2.	25 invoices, Jan. 2017–Jun. 2018, NewCo Ltd	60	p. 7		
3.	40 invoices, Jan. 2016 – Jun. 2018, ABC Ltd	50	pp. 15-16		
4.	Affidavit, 24/08/2018, Mrs Green, CEO of NewCo Ltd	1	pp. 17-18	Yes	
5.	Article by Dr Blue published 12/12/2017 in GO magazine 4/2017: 'Confusing brand X with Y', addressing the inherent distinctiveness of brand X	23	p. 30		p. 12
6.	Printout 01/01/2019 of webpage www.webpage1.com	5	p. 41		
7.	Video showing (at running time 00:07:42) use of EU trade mark X No 123 456 789 at the <i>Exhibition of Consumer Products 2018</i> (file 'vid1.mp4' submitted on USB flash drive)	N/A	p. 45		00:07:42

<sup>(1)</sup> A short description of the annex intended to give the reader a clear understanding of the nature of the document or item of evidence. For example, the title or subject matter of the document or item of evidence i.e. 'letter'/licence agreement concerning trade mark X/'extract', its date, author, addressee, parties etc.

<sup>(2)</sup> Also, each annex, if possible, should be paginated.

<sup>(3)</sup> If a confidentiality request has been submitted and this item of evidence should be marked as confidential and kept as such, please put: YES. If not: please leave a blank space. The justification for the confidentiality request should be given while submitting the confidential data.