



Frequently Asked Questions (FAQ)
on Common Practice

**CP12: EVIDENCE IN TRADE MARK APPEAL
PROCEEDINGS: FILING, STRUCTURE AND
PRESENTATION OF EVIDENCE, AND THE
TREATMENT OF CONFIDENTIAL EVIDENCE**

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1 THE COMMON PRACTICE

1.1 General

1.1.1 *What is the purpose of the CP12 Common Practice?*

The CP12 Common Practice delivers a set of guiding, non-binding recommendations regarding evidence in trade mark appeal proceedings. It makes no attempt to impose practice on independent appeal bodies nor to introduce legislative amendments for its implementation. The CP12 Common Practice 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.

1.1.2 *Has the CP12 Common Practice taken into account EU case-law?*

The relevant EU case-law was analysed and used as a reference for the recommendations outlined in the CP12 Common Practice.

1.2 General concepts of the Common Practice

[Evidence; Admissibility of evidence at the stage of appeal proceedings]

1.2.1 *What should an IPO do if it has legal constraints impeding its agreement with the four types of evidence in subchapter 2.2 Admissibility of evidence at the stage of appeal proceedings?*

The definitions in question present common terminology regarding types of evidence and are aligned with EU case-law. They only serve 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. However, other appeal bodies may use these definitions, but only if applicable under the pertinent national law. In the case of legal constraints, all IPOs are encouraged to implement the CP12 Common Practice partially (selective implementation). In this way, the recommendations in other chapters and subchapters can still serve as a guidance for IPOs and their users.

1.3 Principles of the Common Practice document

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]

1.3.1 *Is the list of means of evidence, presented in subchapters 3.1.1.1 – 3.1.1.10, exhaustive?*

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

1.3.2 *Considering that website analytics and archives, editable websites and social media (as well as other sources of online evidence) are fast-changing realities, will the CP12 Common Practice still remain up-to-date in a few years?*

The CP12 Common Practice is written with the greatest care to make it applicable, up-to-date and as 'future-proof' as possible. However, some matters – especially in the *Online evidence: sources, reliability and presentation* subchapter – need be taken into consideration in the light of evolving case-law and technical developments. Therefore, should any further case-law arise regarding the principles and recommendations stated in the CP12 Common Practice, the ECP4 sub-project, 'Maintenance of Common Practices', which was launched in September 2020, could analyse and study that case-law and decide whether or not it is necessary to adapt the relevant document to the newly issued case-law. The same rule should be applied to any technical developments which have impact on the recommendations included in the CP12 Common Practice. However, this maintenance can only start when the Common Practice has been implemented.

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]

1.3.3 *Is the use of tools (listed in subchapter 3.2.2 Online evidence: tools to determine the relevant date) mandatory in trade mark proceedings?*

The abovementioned chapter provides a non-exhaustive list of tools that can help to determine the date when particular evidential content was published on the internet. However, use of those 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 them. The matter of assessment always remains at the discretion of the appeal bodies and IPOs.

WAYS TO PRESENT EVIDENCE

[Presentation of evidence: acceptable formats, size and volume; Structure of evidence; Structure of market surveys; Templates]

1.3.4 *Why is e-filing, where available, the preferred means to submit evidence?*

The aim of the CP12 Common Practice is to be as inclusive as possible and not exclude existing practices. Therefore, it presents recommendations regarding all types of filings, namely: paper filings, including filings of any physical items, electronic/e-filings, fax filings and data carriers. What is important is that the party or its representative should always check in advance which types of filings are admitted by the relevant appeal body or IPO. For example, some may be paperless or not accept fax filings. However, considering that more and more actions in trade mark proceedings can be performed online and digitalisation is constantly altering traditional proceedings, it is highly possible that in the future more appeal bodies and IPOs might only accept e-filing. Therefore, e-filing seems to be the future. That is why, where available, e-filing remains the preferred means to submit evidence.

1.3.5 *Why is an indication of absolute numbers (between 1 000 to 2 000 consumers) included in the CP12 Common Practice in subchapter 3.3.3.2 Consumer sample (sampling method, sample size)?*

A sample size comprising between 1 000 to 2 000 consumers is included in the CP12 Common Practice **only as an example**. The aforementioned sample size 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. Therefore, the sample size should be determined based on a case-by-case assessment.

1.3.6 *Why does the CP12 Common Practice recommend not to combine test protocols when surveying on acquired distinctiveness and reputation?*

Recommendations regarding separate test protocols presented in the CP12 Common Practice should be treated as the best practice/recommended methodology for conducting surveys and can serve as useful guidance for all stakeholders. It should be borne in mind that *reputation* and *acquired distinctiveness* require different degrees of 'proof' across the EU. Consequently, in practice the mixing of protocols is unlikely as survey professionals keep them separate, avoiding possible confusion and minimising the risk that the obtained results do not fully support the conclusions reached. Nevertheless, evidence will always be assessed on a case-by-case basis and the final decision remains at the discretion of the relevant appeal bodies and IPOs.

1.3.7 *Should users and survey experts only use questions presented in the ‘three-step test approach’ regarding acquired distinctiveness and reputation (in subchapter 3.3.3.4 Structure and wording of the survey questionnaire)?*

The three-step approach presented in the CP12 Common Practice is one of several possibilities to present the structure of a market survey. The few example questions used under those steps cannot comprise a complete set of questions for actual use in a survey, they are only indicative. The number and, in particular the wording of the questions should always be defined by a survey expert on a case-by-case basis, and must be adapted to the specific factual, economic and cultural context in question.

1.3.8 *What is the checklist included in subchapter 3.3.3.5?*

The checklist may be used by appeal bodies and IPOs as a support tool to assess the content and standard to which market surveys should correspond. It may also be helpful for users and survey providers to check what can be required by the relevant bodies.

1.3.9 *Does the checklist in subchapter 3.3.3.5 include binding content and a standard to which market surveys should correspond?*

The checklist, like the whole CP12 Common Practice, includes guidance and a set of best, non-binding recommendations. It constitutes only a support tool for the appeal bodies and IPOs. Therefore, assessment of the content and standard of a market survey remains at the discretion of the relevant appeal body or IPO.

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)]

1.3.10 *Is it possible, under the CP12 Common Practice, to request confidentiality against the other party in inter partes proceedings?*

The CP12 Common Practice does not provide for parties to keep evidence or data confidential with regard to the other party and/or its representative in *inter partes* proceedings.

1.3.11 *Why does the CP12 Common Practice exclude the possibility of claiming confidentiality also at a later stage, not only when the evidence is submitted?*

Although there are some appeal bodies and IPOs which allow parties to claim confidentiality until the end of the trade mark proceedings, the CP12 Common Practice aims to provide recommendations based on best practice. Regarding the point in time to claim confidentiality, the recommendation is that the party should indicate that evidence is confidential or contains confidential parts when submitting it. The later the confidentiality request is submitted, the more difficult it is to ensure the confidentiality of evidence, in particular, in the case of online databases with case files.

1.3.12 *What if some appeal bodies or IPOs do not publish their decisions or evidence online?*

The CP12 Common Practice aims to cover the practices of the appeal bodies and IPOs that publish their decisions and/or evidence and those that do not. Therefore, if some appeal bodies or IPOs do not publish them online, CP12 will simply not be used in this regard. The aim is to be as inclusive as possible and not exclude accepted practice. Moreover, considering that digitalisation is altering traditional proceedings, it is highly possible that in the future more appeal bodies and IPOs might find this part of the document useful.

2 METHODOLOGY

2.1 How were appeal bodies, IPOs and UAs involved in the project?

The CP12 Common Practice results from the collective input from stakeholders who took part in several meetings, responded to questionnaires and provided feedback on the draft publications. In response to 3

publications on the EUIPN website, the CP12 Common Practice generated more than 100 separate contributions from IPOs, appeal bodies, UAs, legal experts and academics, all of which shaped the final version of the document. Furthermore, several questionnaires were sent to appeal bodies (internal and external) and IPOs at different stages of the project. These efforts were also backed by electronic correspondence, calls and videoconferences with appeal bodies, IPOs and UAs to guarantee that any concerns expressed could be considered, analysed and discussed in the corresponding meetings (Working Groups, Workshops, Extended Working Group, etc.). Therefore, the outcome of the CP12 project is not the result of work by a narrow group of legal specialists, it is the result of broad communication between all EU IP Network stakeholders who recognise its potential value.

2.2 How can IPOs implement the CP12 Common Practice?

The range of active stakeholders and the scope and applicability of the CP12 Common Practice mean that a greater degree of flexibility is required if it is to generate value and utility for appeal bodies, IPOs and UAs. Therefore, a new option, namely selective implementation, has been introduced. Internal appeal bodies and IPOs can choose to implement the whole Common Practice (total implementation) or choose specific chapters or subchapters (selective implementation), which can mitigate any legal constraints impeding implementation faced by some internal appeal bodies and IPOs. Furthermore, IPOs have to inform the EUIPO about the chapters or subchapters that they will implement. This decision is reflected in a table with a summary about the implementation in each IPO, which is included in the CP12 Common Communication.

As external appeal bodies cannot be bound by a Common Practice, the CP12 document provides a set of recommendations which they can apply and adopt where they are considered to add value and be of benefit.

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

Each implementing office will provide information in the Common Communication document about their implementation date and whether the Common Practice will apply to trade mark proceedings pending on the implementation date and/or initiated after this date, together with the decision as to whether the whole CP12 Common Practice will be implemented (total implementation) or only specific chapters/subchapters (selective implementation).

2.4 What is the difference between the CP12 Common Communication and the CP12 Common Practice?

Through the Common Communication, the IPOs inform users about the implementation of the CP12 Common Practice (or part(s) of it) in their Offices. In this document, the proceedings and concrete dates on which the Common Practice will be implemented, as well as the chapters or subchapters which will be implemented, are included after confirmation by the respective IPOs. Additionally, it contains a summary of the key recommendations presented in the Common Practice document. It will be published simultaneously by the MS IP Offices and the EUIPO on their respective websites.

On the other hand, the Common Practice is the result of the agreement reached between the EUIPO, internal and external appeal bodies, MS IPOs and UAs on the general principles regarding the concrete topic of the project.

2.5 Can an IPO implement the Common Practice at any time?

Yes. All IPOs are strongly encouraged to implement the CP12 Common Practice, regardless of their participation and contribution to the project. Full Network-wide convergence is dependent on the number of implementing Offices. Therefore, the more implementing IPOs there are, the closer we will be to fulfilling

that goal. More implementing Offices means a wider reach of the Common Practice and thus greater legal certainty, transparency and efficiency of IP practices across the EU.

2.6 Can non-EU IPOs implement the Common Practice?

Yes. Non-EU IPOs are welcome to implement the CP12 Common Practice. The more implementing Offices there are, the wider the reach of the Common Practice and, therefore, the more efficient and transparent the respective IP systems for users and Offices.

2.7 Can the IPOs opt-out of the Common Practice?

IPOs implement the practice on a voluntary basis. There is a possibility to implement only suitable (for each IPO) parts of the CP12 Common Practice (selective implementation) or to reject (opt-out of) the whole CP12 Common Practice. Any IPO that opts out of the Common Practice will not be considered an implementing Office. However, if the IPO decides to implement only some parts of the CP12 Common Practice, it can still be considered an implementing Office.

2.8 What happens if there are legal constraints in the national law? Does it mean that the CP12 Common Practice is not applied at all?

If there are legal constraints, it is still possible for IPOs to implement the CP12 Common Practice partially (selective implementation). Considering the broad scope of the CP12 Common Practice, some parts can still be used as guidelines for the bodies dealing with evidence. Legal constraints in one aspect or area do not prevent IPOs from using CP12 in any or all other areas.

2.9 Who is able to make use of the CP12 Common Practice?

The CP12 Common Practice serves as a reference for appeal bodies (internal appeal bodies within the IPOs and external appeal bodies, including courts acting as external appeal bodies in trade mark cases and administrative bodies/committees.), UAs and parties to trade mark appeal proceedings as well as their representatives. As in many aspects CP12 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. As such, IPOs may also find benefit in applying any of the recommendations in the Common Practice document that they consider appropriate and of value.

2.10 What would happen if, for instance, there is a judgment/decision against the principles stated in the CP12 Common Practice?

Should any further case-law arise regarding the principles and recommendations stated in the CP12 Common Practice, the ECP4 sub-project, 'Maintenance of Common Practices', which was launched in September 2020, could analyse and study that case-law and decide whether or not it is necessary to adapt the relevant document to the newly issued case-law. However, this maintenance can only start when the Common Practice has been implemented.