

## **INTA Comments on the draft Common Practice of project CP12 “Evidence in Trade Mark Appeal Proceedings: filing, structure and presentation of evidence, and the treatment of confidential evidence”**

**January 2020**

The International Trademark Association (INTA) appreciates the opportunity to contribute to the draft common practice of the CP12 project. INTA is pleased to participate in the CP12 Working Group. Without prejudice to further oral input that our representative may bring forward at the Working Group and Plenary meetings and further written comments at later stages of the project, we would like to provide the below input on certain aspects of the draft common practice. For convenience, the comments are structured per the common practice’s section to which they refer.

### **GENERAL COMMENTS / INTRODUCTION**

Considering that this common practice verses upon evidence submitted to independent appeal bodies in trademark appeal proceedings, we believe that it is fundamental to ensure that it remains flexible and intended to work as mere guidance and that it does not imply nor recommend any legislative amendments.

Against this backdrop, INTA welcomes the clarification under point 1.1 that the common practice makes no attempt to impose practice on independent Appeal Bodies but merely aims to provide guidance and recommendations. For full clarity and certainty, we suggest to add that no legislative amendments are intended, for instance, in the following sentence on page 5: *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.***

Further, we recommend that the outline of the practice scope under point 1.3 clarifies its non-binding nature by including the follow two highlighted words: “This Common Practice delivers a set of ***guiding, non-binding*** principles regarding evidence in trade mark appeal proceedings”.

As the scope of the common practice is limited to appeal proceedings, we believe that the reference to its use in first instance proceedings is unnecessary and confusing. We therefore recommend that the following sentence in page 5 be deleted: “*It goes without saying that it may also be used by the European Union Intellectual Property Office (hereinafter EUIPO), Benelux, and Member States’ Intellectual Property Offices (hereinafter collectively referred to as MS IPOs) in their first instance proceedings role*”.

### **3. THE COMMON PRACTICE**

#### **3.1.2 Online evidence: sources, reliability and presentation**

Reference to the CP10 common practice, page 15: “*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. The recommendations themselves may not be changed insofar as they refer to universal criteria applicable to both trade marks and designs. Nevertheless, some adaptation to the specificities of trade marks may be necessary and recommendable*". In our view, the wording of the second sentence may lead to misunderstandings with regard to the aim and scope of the CP10 recommendations. We would therefore suggest to simplify the section highlighted in bolt by replacing it with the following wording: "**Although some of such criteria could also apply to other IP rights or evidence providing methodology, some adaptation to the specificities of trademarks may be necessary and recommendable**".

### 3.1.2.2 Electronic archives

One of the recommendations under this sections is that "*Printouts retrieved from Wayback Machine may be considered as reliable types of online evidence*". We recommend against referring to a concrete tool and, instead, suggest describing the tool function (electronic or web archives in this case), as it was done in the CP10 common practice<sup>1</sup>. This is because commercial tools may change, disappear, and new ones may come to existence. As a common practice is intended to last over time, we recommend to add an expression like "**such as wayback machine**" in order to avoid referring to an existing concrete commercial tool at a given moment.

### 3.1.2.3 Editable websites

INTA suggests amending the first sentence of paragraph 3.1.2.3 of the common practice in line with the reasoning of EUIPO Cancellation Division No 14788C (January 11, 2019), i.e., noting that the reliability of information taken from editable websites, such as 'Wikipedia' or 'Acronym Finder', cannot be considered as a reliable source of information, as they can be amended by users and therefore these could only be considered relevant as far as they are supported by other pieces of independent concrete evidence. Whilst the conclusion will be the same as the one currently in the draft, the basis of the argument is more in line with the reality of the market and the Office's recent decision in this respect.

### 3.1.2.5 Website analytics (website traffic, reporting and statistics) and 2.6 Social media

We refer to the following sentences under these sections:

Website analytics, page 17: "*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'*".

Social media, page 18: "*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. Thus, it may be considered as coming from a third party*".

We recommend caution when relying on website analytics and social media as these are fast-changing realities that often can be easily manipulated. Website analytics are useful but not evidence of reputation on their own. On the other hand, the problem with 'popularity' indicators on social media platforms is not only that influencers on social media can disappear very quickly but

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<sup>1</sup> An example can be found in page 15 of the CP10 common practice: "*On the contrary, website archiving services (such as the "WayBack Machine") can serve as a valuable tool for proving the date of disclosure.*"

also that influencers can easily manipulate “popularity” (through bots or fake accounts)”. We thus recommend changing the above sentences in line with what is happening in reality and taking into account the possibility for account owners to generate fake followers and interactions.

### **3.3.3 Structure of market surveys**

This chapter contains recommendations on how a market survey should be designed and carried out in order to be submitted as evidence to the Appeal Bodies or national IP Offices. This topic was among the most intensively discussed during the latest CP12 workshop, in particular due to the fact that the draft common practice addresses it in great detail (including recommendations on the consumer sample size, methods of conducting the survey etc.). We believe that many aspects under this section are sensitive and, at this stage, may not gather enough consensus to be included in the common practice. Just as an example, the reference to the confidence level and margin of error of samples in page 42 is unclear to us. In this context, INTA takes no position on this section of the common practice, which should not be taken as an agreement with its contents. We reserve the right to provide oral and/or written comments about this section during the upcoming stages of the project.

INTA will continue actively supporting the discussions on the CP12 draft common practice, through its participation in the Working Group and by addressing additional requests for input. We hope you will find our comments useful. Should you wish to further discuss any of the points we have raised or additional issues, please contact H el ene Nicora, INTA Chief Representative Officer, Europe, at [hnicora@inta.org](mailto:hnicora@inta.org) and Carolina Oliveira, Policy Officer - Europe and Staff Liaison for INTA’s Designs Committee at [coliveira@inta.org](mailto:coliveira@inta.org).