

## **Priorities for decision takers – Practical aspects**

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## Structure

**Legal basis**

**Paris Convention**

**First filing (or is it?)**

**Examples**



**See Guidelines for Examination, Part B, Formalities**

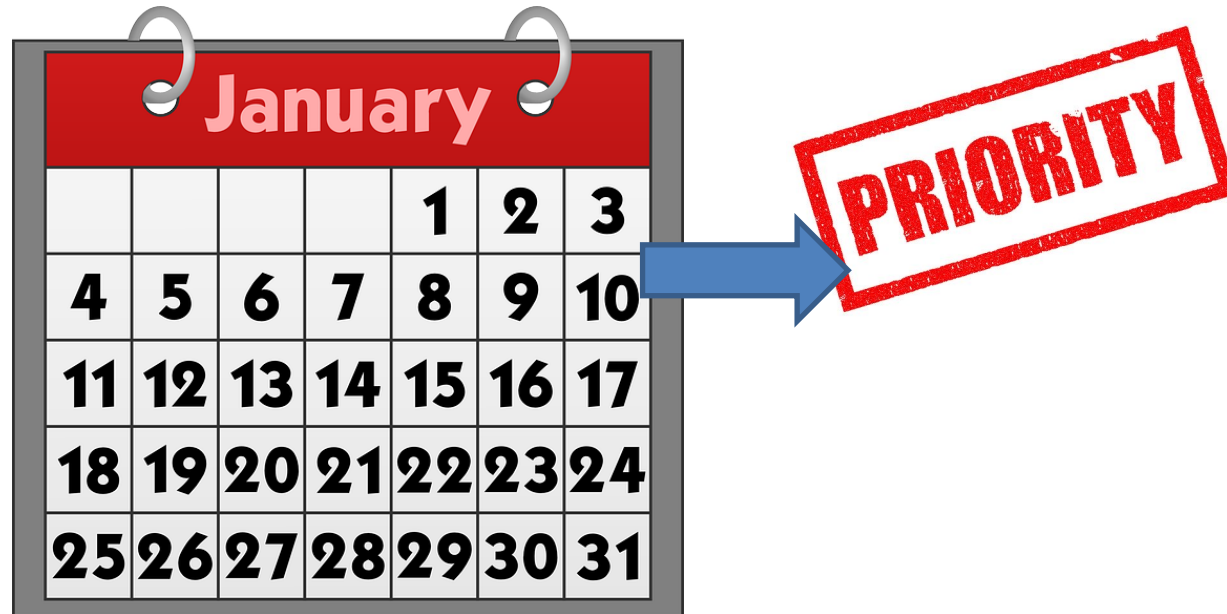
## Legal Basis

- **Articles 34, 35, 36 and 41 EUTMR**
- **Article 4 EUTMIR**
- **Decision EX-17-3 of the Executive Director of the Office - requirements of a priority claim**



## Priorities

Date of priority counts as the date of filing for the purposes of establishing earlier rights (inter partes proceedings)



## Article 4, Section A of the Paris Convention

A regular national filing is any filing that is ‘adequate to establish the date on which the application was filed in the country concerned, whatever the subsequent fate of the application’ (Article 4A(3) Paris Convention).



Filing date



## Article 34 EUTMR

A person who has duly filed an application for a trade mark in or in respect of any *State party to the Paris Convention* or to the *Agreement establishing the World Trade Organisation*, or his successors in title, shall enjoy, for the purpose of filing an EU trade mark application for the **same trade mark** in respect of **goods or services** which are identical with or contained within those for which the application has been filed, a right of priority during a period of six months from the date of filing of the first application.

## Formal Requirements – Article 35 EUTMR



**At examination stage, the Office only checks formal requirements are met (claim not validity) .**

- **priority claim filed with EUTM application (or same day);**
- **number, date and country of the previous application;**
- **availability of official online sources to verify, or documents and translations.**

**within 3 months of the filing date!**

## Substantive Requirements – Article 34 EUTMR



Validity only examined **a posteriori** in inter partes proceedings, **if necessary** to ascertain

- 1) **Earlier mark**
- 2) **Admissibility of request of proof of use**
- 3) **To calculate the five-year period**



## Substantive Requirements– Article 34 EUTMR


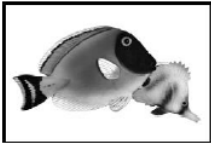


- Triggered by first regular filing of a TM
- Claimed in first six months following first filing (provided country party to Paris Convention OR agreement establishing World Trade Organisation OR a country with a reciprocity agreement)
- Priority claim of an IR not acceptable due to principle of first filing - can only be based on relevant basic mark.
- ID TM, G&S, OWNER



# Substantive Requirements for Priority Claims – Article 34 EUTMR

- **ID TM, G&S, OWNER**

Triple identity

Examples of acceptable priority claims	
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 



EUTM application (figurative mark)



Priority claim (figurative mark)



## Substantive Requirements for Priority Claims – Article 34 EUTMR

- ID TM, **G&S**, OWNER

Triple identity

**G&S of the EUTM must be covered by the G&S of first filing**

- **Synonyms**
- **Overlap**
- **Inclusion in broader category**

## Substantive Requirements for Priority Claims – Article 34 EUTMR

- ID TM, G&S, **OWNER**

Triple identity

Applicant of first application or successor in title  
Change of name since first filing



Subsidiaries or associated companies



## Substantive Requirements for Priority Claims – Article 34 EUTMR

- Triggered by first regular filing of a TM
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## First Filing Principle



**(i) no priority claim made on prior application(s)**

**(ii) no seniority claim made for the EUTM application relates to a mark that has a filing date prior to that of the application(s) from which priority is claimed**

**(iii) EUTM application was filed no later than 6 months following the date of filing of the earlier application(s).**

**If priority of more than one earlier application is claimed, the goods and/or services covered by each of those applications must be different.**

## Paris Convention

[https://www.wipo.int/freepublications/en/intproperty/611/wipo\\_pub\\_611.pdf](https://www.wipo.int/freepublications/en/intproperty/611/wipo_pub_611.pdf)

### Right of priority can only be based on the first application

designed to avoid a chain of successive claims of priority for the same subject, follows from Article 4 C(2) (...period of priority starts from the date of filing of the first application) and from Article 4 C(4), where, under exceptional circumstances, a subsequent application is considered to be "the first application, of which the filing date shall be the starting point of the period of priority." It is therefore not possible, after filing an application for a patent or for the registration of a trademark, etc., in one country of the Union, to base a right of priority on a later application for the same subject in the same or in another such country. However, an earlier filing in a country not belonging to the Union will not count."

## First Filing – R2219/2018-4 MONACO/MONACOR OF 22/06/2019

The earlier and the contested mark were both IRs designating the EU; the contested mark has the priority of its basic application.

Oposition Division should have considered the applicant's arguments concerning the priority of the earlier mark being ineffective; it was not the first national deposit.

*The trade mark from which priority is claimed is not the first filing within the meaning of Article 4c (2) PC. .. the priority period shall be 6 months from the date of the first deposit.*





## First Filing – R2219/2018-4 MONACO/MONACOR OF 22./06/2019

Exception: Article 4c (4) PC, a ‘second’ deposit is to be considered as being a ‘second’ deposit if the ‘first’ deposit was abandoned without being published and without rights to it. This means that in all other cases a ‘second’ deposit cannot claim priority.

Exception does not apply as the German trade marks, which relate to this case as ‘first’ deposit, were registered, published, have also been renewed and are in force.

Result: Earlier mark not earlier



## First Filing example

### Opposition not admissible

- Contested mark's priority date earlier than the 'earlier mark' .
- Priority date based on four Chinese marks (each for different classes).
  
- Opponent then submitted evidence of four more Chinese marks (triple identity) thus the contested mark's priority claim had to be considered partially ineffective.

Proceedings re-opened and parties informed that the proceedings would continue given that evidence demonstrated that the priority claim was only valid for certain contested goods and services.

Opposition continues for contested marks for which priority not valid.





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Thank you

<b>Presentation</b>	<b>Priorities – Practical Aspects</b>	
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<b>Approved by owner</b>	-	
<b>Authors</b>	-	
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	-	

Revision history			
Version	Date	Author	Description
0.1	November 2019	VP	Examiners meeting
0.2	February 2020		Updated for webinar
0.3	27 March 2020		Final