



2022 Edition of the EUIPO Guidelines: Focus on Relative Grounds

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PROGRAMME

25'
Presentation

GUIDELINES 2022:
KC RG
&
Inter Partes Proceedings

Questions and answers:
12 April 2022

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OUTLINE OF GL SECTIONS CHANGED

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Part C: Opposition

- Section 0, Introduction
- Section 1, Opposition Proceedings
- Section 2, Double identity and Likelihood of confusion
 - Chapter 1, General Principles
 - Chapter 2, Comparison of Goods and Services
 - Chapter 3, Relevant public and degree of attention
 - Chapter 4, Comparison of signs
 - Chapter 5, Distinctiveness of the earlier mark
 - Chapter 6, Other factors
 - Chapter 7, Global assessment

GL SECTIONS CHANGED

- Section 3: Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR)
- Section 4: Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR)
- Section 5: Trade marks with reputation (Article 8(5) EUTMR)
- Section 6, Geographical indications (Article 8(6) EUTMR)
- Section 7, Proof of Use

Part D: Cancellation

- Section 1, Cancellation proceedings
- Section 2: Substantive provisions

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**Part C, Opposition, Section 2,
*Double identity and likelihood of confusion***

Part C, Opposition, Section 2, *Double identity and likelihood of confusion*



Chapter 4 - Comparison of Signs

- **MOTION, MULTIMEDIA and SOUND MARKS**
- **PERSONAL NAMES**
- **SINGLE LETTERS**

Part C, Opposition, Section 2, *Double identity and likelihood of confusion*

Chapter 4 - Comparison of Signs, 3. Similarity between signs, 3.4 Comparison of signs

➤ **MOTION, MULTIMEDIA and SOUND marks (CP11)**

- **Visual** comparison (**NEW** paragraphs 3.4.1.8; 3.4.1.9)
- **Phonetic** comparison (**NEW** paragraphs 3.4.2.5; 3.4.2.6; 3.4.2.7)
- **Conceptual** comparison (3.4.3.8; and **NEW** paragraphs 3.4.4.9; 3.4.4.10; 3.4.4.11)



Part C, Opposition, Section 2, *Double identity and likelihood of confusion*

➤ PERSONAL NAMES

Chapter 4 - Comparison of Signs, 3. Similarity between signs, 3.4 Comparison of signs

- Semantic content (3.4.3.4)
- How to compare from the conceptual perspective (3.4.4.8):
NEW!

+

Chapter 7, Global assessment, 7.2. (Specific cases) Names

- 7.2.1 Personal names (6 scenarios: from 7.2.1.1 to 7.2.1.6)

Part C, Opposition, Section 2, *Double identity and likelihood of confusion*

Examples (Chapter 4 - Comparison of Signs)

- *First name versus first name and surname – overlap in the **first name***

Earlier sign	Contested sign	Case No
		18/09/2017, T-86/16 , ANA DE ALTUN (fig.) / ANNA (fig.) et al., EU:T:2017:627

- *Overlap in the **surname***

Earlier sign	Contested sign	Case No
MARSHALL		08/11/2017, T-271/16 , Thomas Marshall Garments of Legends (fig.) / MARSHALL et al., EU:T:2017:787

Part C, Opposition, Section 2, *Double identity and likelihood of confusion*

Examples (Chapter 7, Global assessment)

- First name versus first name and surname – overlap in the **first name***

Earlier sign	Contested sign	Case No
CHIARA	 CHIARA FERRAGNI	08/02/2019, T-647/17 , CHIARA FERRAGNI (fig.) / Chiara

- First name and surname versus first name and surname – overlap in the **surname***

Earlier sign	Contested sign	Case No
ANTONIO FUSCO	ENZO FUSCO	01/03/2005, T-185/03 , EU:T:2005:73

Earlier sign	Contested sign	Case No
MISS ROSSI	SISSI ROSSI	01/03/2005, T-169/03 ,

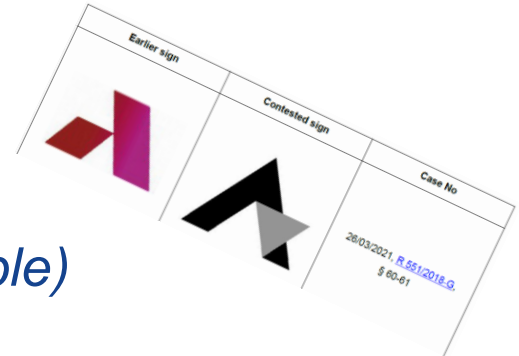
Part C, Opposition, Section 2, *Double identity and likelihood of confusion*

Chapter 4 - Comparison of Signs, 3. Similarity between signs, 3.4 Comparison of signs

➤ SINGLE LETTERS

- **Visual** comparison (3.4.1.7, *new example*)
- **Phonetic** comparison (3.4.2.4, *new example*)
- **Conceptual** comparison:
 - **Semantic content** (3.4.3.6)
 - **How to compare from a conceptual point of view** (3.4.4.12)

NEW!



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Part C: Opposition, Section 3

Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR)

Part C, Opposition, Section 3, *Article 8(3) EUTMR*)



C-809/18P MINERAL MAGIC

4. Conditions of Application, 4.5 Relationship between the marks and between the goods and services

4 sub-paragraphs:

- Article 8(3) applies beyond identical signs and **G/S**
- Assessment of similarity: taking into account the **objective** pursued by Article 8(3) EUTMR and in a **combined assessment**

Part C, Opposition, Section 3, *Article 8(3) EUTMR*)

4. Conditions of Application, 4.1.3 Territorial scope of the agreement between the agent and the principal

- Even if only a **territory outside the European Union**, Article 8(3) EUTMR may still apply.



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**Part C: Opposition, Section 4,
*Non-registered trade marks and other signs
used in the course of trade (Article 8(4)
EUTMR)***

Part C, Opposition, Section 4, *Article 8(4) EUTMR*

Content of FORMER SECTION 4

Rights under Article 8(4) and 8(6) EUTMR :

- CURRENT **Section 4** *Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR)*
- NEWLY INTRODUCED **Section 6** *Geographical indications (Article 8(6) EUTMR)*



ONLY STRUCTURAL, NO CHANGES TO CONTENT!

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**Part C: Opposition, Section 5,
*Trade marks with reputation (Article 8(5)
EUTMR)***

Part C, Opposition, Section 5, *Article 8(5) EUTMR*)



SIMPLIFICATION + NEW EXAMPLES

3. *Conditions of Application*

3.1 *Earlier mark with reputation*

- *Proof of reputation - Burden of proof (3.1.4.2)*
- *Means of evidence - Evidence of a presence and activity on the Internet (3.1.4.4) **NEW!***

3.2 *Similarity* of the *signs*

3.3 *Link* between the signs

3.4. *Risk of injury*

- 3.4.1 *Protected subject matter*
- 3.4.2 *Assessment of the risk of injury*
- 3.4.3.1 *Taking unfair advantage of distinctiveness or repute*
- 3.4.4 *Proving the risk of injury*





Part C: Opposition, Section 7, *Proof of use*

Part C, Opposition, Section 7, *Proof of use*



- **NEW INTERNAL STRUCTURE/NUMBERING**
- Main changes as to **NATURE OF USE** (now under *Paragraph 6*)



6.2 Use of the mark as registered or of a variation thereof (CP8):

- **6.2.1 Use in the form as registered - SIMULTANEOUS USE OF INDEPENDENT MARKS**
- **6.2.2 Use in a FORM DIFFERENT FROM THE ONE REGISTERED (Art. 18(1)(a)EUTMR)**
- **6.2.3 MODIFICATION of OTHER CHARACTERISTICS**

Part C, Opposition, Section 7, *Proof of use*

- 6.2.1 Use in the form as registered - **SIMULTANEOUS USE OF INDEPENDENT MARKS**

Mark as registered	Mark as used	Case No
		Invented example (CP8)

Mark as registered	Mark as used	Case No
		13/09/2016, DARSTELLUNG EINES VIELECKS (fig.), EU:T:2016:469 T-146/15

Part C, Opposition, Section 7, *Proof of use*

6.2.2 Use in a **FORM DIFFERENT FROM THE ONE REGISTERED** (Art.18(1)(a)EUTMR)

1) **Elements** of the registered mark contributing to the **distinctive character**

2) **Differences** and their **impact**
(taking into account the inherent distinctive character of the mark as registered)




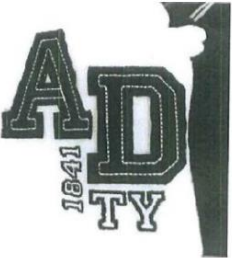
- **ADDITIONS**
(6.2.2.1)
- **OMISSIONS**
(6.2.2.2)



- non dist.
- weakly dist.
- distinct.

Part C, Opposition, Section 7, *Proof of use*

6.2.3 MODIFICATION of OTHER CHARACTERISTICS

Mark as registered	Mark as used	Case No
AD-1841-TY	(i)  (ii) 	10/10/2017, T-233/15 , 1841, EU:T:2017:714

Mark as registered	Mark as used	Case No
DRINKFIT		12/12/2014, T-105/13 , TrinkFix, EU:T:2014:1070



Part C, Section 1: *Opposition Proceedings*
Part D, Section 1: *Cancellation Proceedings*

Part C, *Opposition Proceedings*



More **CLEAR STRUCTURE** and **WORDING**

2.4 Admissibility check (consequences of inadmissibility; extent of the admissibility check; appeal)

4.2.4.3 Non-registered trade mark or another sign used in the course of trade (what opponent must specify and prove)

Part D, *Cancellation Proceedings*



To **MIRROR** changes in **Opposition Proceedings** part

2.5 Admissibility check (absolute and relative admissibility requirements)

3.2 Substantiation (admissibility check of other rights in the course of the proceedings; submission of applicable national law)

Speaker presentation



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