



# Overview of the 2023 Edition of the Guidelines

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## Speakers:

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*\* This document contains the answers to questions submitted by the audience during the webinar that could not be answered during the live session.*

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## Questions and answers – Overview of The 2023 Edition of the Guidelines

### Are there any new guidelines on registering domain names as a trade mark?

**There is no new content in the Guidelines on domain names.**

Nevertheless, **the guidelines do currently cover this question** under [Section 4 Absolute grounds for refusal, Chapter 3 Non-distinctive trade marks \(Article 7\(1\)\(b\) EUTMR\), 2 Word Elements](#):

***Top level domain** endings, such as **‘.com’**, only indicate the place where information can be found on the internet and thus cannot render a descriptive or otherwise objectionable mark registrable.*

*Therefore, [www.books.com](#) is as objectionable for printed matter as the term ‘books’ alone. This was confirmed by the General Court in its judgment of 21/11/2012, [T-338/11](#), [PHOTOS.COM](#), [EU:T:2012:614](#), § 22, where it was stated that the element ‘.com’ is a technical and generic element, the use of which is required in the normal structure of the address of a commercial internet site.*

*Furthermore, it may also indicate that the goods and services covered by the trade mark application can be obtained or viewed online, or are internet related. Accordingly, the element in question must also be considered to be devoid of distinctive character in respect of the goods or services concerned.*

## Questions and answers – Overview of The 2023 Edition of the Guidelines

With regard to Article 47(2), does the change affect the calculation of proof of use dates for national registrations resulting from the conversion of an EUTM but not yet registered for 5 years? What if a new EUTM claims seniority from an earlier national right and this is an essential aspect for the opposition proceedings?

If an earlier ‘converted’ national mark has not been **registered** for 5 years at the relevant point in time, there is no requirement to prove use.

The change introduced following the General Court’s judgment of 23/11/2022 in case T-515/21, EUPHYTOS/EUPHIDRA concerns the calculation of the 5-year period for proving the genuine use of an earlier mark in opposition proceedings (and, possibly, in invalidity proceedings in the case of a ‘second’ relevant period): the relevant law for calculating the 5-year period is the law that applies on the **filing date of the contested EUTM**.

Concerning your second question, the change has no impact vis-à-vis a seniority claim, whether it refers to the earlier EUTM invoked as a basis of the opposition (or, possibly, of the invalidity action) or to the contested EUTM.

**For more information on the topic, please refer to the Guidelines**, e.g. [Part C, Section 1 Opposition Proceedings, 5. Procedure related to the request for proof of use, 5.1.2 Earlier mark registered for not less than 5 years \(mark outside the ‘grace period’\)](#)

## Questions and answers – Overview of The 2023 Edition of the Guidelines

*Res Judicata* - let's say a US applicant filed an EUTM on 1/1/2022, and then filed the same trade mark with the same goods on 1/6/2022 without claiming priority; however, a 3rd party filed a similar trade mark on 1/5/2022. When assessing the right of the EUTM filed by the US applicant on 1/6/2022, will you consider its date to be that of the first application filed in the US?

We assume that the **scenario above presupposes that the third party opposes the EUTM. In that case, no, the EUIPO will not consider the date of the US mark when determining what right is 'earlier' for the purposes of an opposition.** In the context of *inter partes* proceedings before the EUIPO, if a priority is not claimed, the relevant date to determine whether an EUTM is earlier than another EUTM is the filing date.

In the example given, the marks in conflict are, on the one hand, the third party's EUTM filed on 01/05/2022 and, on the other, the US company's EUTM filed on 01/06/2022. Where no priority is claimed, the third party's EUTM will be the earlier mark and it would be irrelevant that the US company owns a previous identical mark.

**For more information on the topic, please refer to the Guidelines, e.g.**

[Part C Opposition Proceedings, 2 Notice of Opposition, 2.4 Admissibility check, 2.4.1.2 Identification of earlier marks or rights](#)

## Questions and answers – Overview of The 2023 Edition of the Guidelines

Is it possible to file a new application for invalidity based on the same earlier right if the first application was withdrawn during the suspension period (without any decision of the EUIPO)?

In particular, the applicant was threatened by the other party and therefore decided to withdraw the application for invalidity

**When an application for invalidity is withdrawn** (or, in general, when it is not adjudicated on the merits), **the applicant for invalidity can file a subsequent application** on the basis of the same right that was invoked in the previous application to the extent that the ‘scope’ of the subsequent application (e.g. in terms of legal grounds and goods and services invoked) is the same or falls within the scope of the first application.

For the sake of completeness, the reasons behind the withdrawal of the first application are irrelevant when deciding to consider the second application admissible.

**For more information on the topic, please refer to the following section of the Guidelines:**

**Part D Cancellation, Section 1 Cancellation Proceedings, 2.5 Admissibility Check:**

[2.5.1.3 Res judicata \[Article 63\(3\) EUTMR\]](#)

[2.5.1.4 Subsequent applications based on other rights that could have been invoked in support of the first application \[Article 60\(4\) EUTMR\]](#)

## Questions and answers – Overview of The 2023 Edition of the Guidelines

I have a question about the recordal of filing date for designs: as I understand it, the filing date of a design will be the date on which EUIPO receives the official fee; will this also apply for an EUTM?

During the webinar we explained that **although the payment of the fee does not affect the filing date in designs** (Article 38 CDR establishes that the filing date is the date on which the requirements of Article 36(1) are complied with), **the EUIPO will not begin examining the application until the fee has been paid.**

**The only change** has been to clarify in the guidelines that **examination will not begin until the fee has been paid, even though payment does not affect the filing date.**

**There is no change for EUTMs**, which do require the payment of the fee for a filing date to be accorded (see Article 32 EUTMR)



## Questions and answers – Overview of The 2023 Edition of the Guidelines

If possible, may I know the difference between the continuation of proceedings and *restitutio in integrum*? 1/2

**Both continuation of proceedings** (Article 105 EUTMR) **and restitutio in integrum** (Article 104 EUTMR) **are measures that can be applied when one party to the proceedings at the EUIPO has missed a deadline.**

**Continuation of proceedings is not available for RCD proceedings.**

**As a main difference**, *restitutio in integrum* only applies when there is a loss of rights or a loss of means of redress for the party and the party can prove that it missed the time limit in spite of having taken all due care.

For continuation of proceedings, there is no need to file a reasoned request or evidence of due care. Basically, continuation of proceedings allows you, within a certain period, to ‘pay’ to remedy a missed deadline.

A summary of requirements is given below and the complete list of deadlines can be found in the Guidelines (links below).

## Questions and answers – Overview of The 2023 Edition of the Guidelines

If possible, may I know the difference between the continuation of proceedings and *restitutio in integrum*? 2/2

### Requirements for continuation of proceedings:

- **Deadline:** 2 months from expiry of the missed time limit;
- **Fee:** EUR 400 (refundable if continuation is not granted);
- **Written request** (online form) in the language of proceedings.

### Requirements for *restitutio in integrum*:

- **Deadline:** 2 months from removal of the obstacle to compliance and not later than 1 year from the expiry of the missed time limit;
- **Fee:** EUR 200 (non-refundable);
- **Reasoned written request** (online form) in the language of proceedings where it must be proved that the party was unable to comply with the time limit in spite of **all due care** required by the circumstances;
- **Omitted act** must be carried out with the request.

For further information and for the list of time limits where these measures can be applied, see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits, paragraphs [4.4 Continuation of proceedings](#) and [4.5 Restitutio in integrum](#) and [Section 8, Restitutio in integrum](#)

## Questions and answers – Overview of The 2023 Edition of the Guidelines

### Is Palladio case law applicable to design invalidity proceedings also?

The General Court's judgment rendered on 15/09/2021 in [T-207/20](#), PALLADIUM HOTELS & RESORTS (fig.) / Grand hotel palladium, specifically **concerns the interpretation of Article 60(4)EUTMR** which is a provision regarding the **declaration of invalidity of EUTMs based on relative grounds**.

There is no *res judicata* for designs invalidity decisions rendered by the [EUIPO](#).

An application for a declaration of invalidity is inadmissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a **Community design court** and has acquired the authority of a final decision (Article 52(3) CDR). Where this is the case, the invalidity applicant will be invited to comment on the finding before the application is rejected. The invalidity fee is non-refundable.

However, a final decision taken by the [EUIPO](#) between the same parties and having the same subject matter and cause of action is not equivalent to a judgment issued by a Community design court regarding the effects laid down in Article 52(3)CDR (17/05/2018, T-760/16, Fahrradkörbe, EU:T:2018:277, § 29-34).

## Questions and answers – Overview of The 2023 Edition of the Guidelines

What is the article number for the newly introduced article related to transfers?

**There is no new legal article on transfers.**

However, in the Guidelines a new section was introduced regarding parallel proceedings which may have an effect on the transfer and which are, therefore, checked by the EUIPO, e.g. insolvencies.

**See to this regard** Part E Register Operations, Section 3 EUTMs and RCDs as objects of property, Chapter 1 Transfer, [Point 4.4.4 Proceedings affecting the transfer](#).

## Questions and answers – Overview of The 2023 Edition of the Guidelines

**On conversion: if the territory of reference is the EU because the earlier trade mark is an EUTM but, in deciding, the Examiners take as reference only the consumer, for example who speaks Italian, the conversion can be done in European countries with the exception of Italy, correct?**

### 1. Absolute grounds for refusal

Yes, the principle is correct for absolute grounds for refusal. Article 140(4) EUTMR establishes that if the EUIPO or an EU trade mark court has refused the EU trade mark application or has declared the EU trade mark invalid on **absolute grounds** by reference to the language of a Member State, conversion shall be excluded under Article 139(2) for all the Member States in which that language is one of the **official languages**.

### 2. Relative grounds for refusal

When the opposition is based on an earlier EUTM, the challenged application is refused for the entire EU if the opposition succeeds, even if the decision focuses on a certain language. In this scenario conversion is excluded (see Article 140(4) second sentence EUTMR).

However, where an EUTM application or IR designating the EU has been refused in an opposition based on an **earlier national trade mark** in a specific Member State, conversion will not take place in respect of that Member State.

When the opposition is based on a number of earlier rights from different Member States but the final decision rejects the EUTM application or the IR designating the EU on the basis of only **one** of those earlier rights, conversion may be requested for the remaining Member States. For example, if an opposition based on a French, an Italian, and an Irish national right is successful with regard to the Irish national right, and if there is no analysis of the other earlier rights, conversion will not take place for Ireland, but may take place for Italy and France (and all other Member States) (16/09/2004, [T-342/02](#), Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, [T-194/05](#), Teletch International, EU:T:2006:124).

## Questions and answers – Overview of The 2023 Edition of the Guidelines

**If an EUTM application is rejected on the basis of an earlier EUTM with a focus on a specific part of the public - let's say the German-speaking public, can the application be converted into national mark applications in countries other than Germany?**

When the opposition is based on an earlier EUTM, the challenged application is refused for the entire EU if the opposition succeeds, even if the decision focuses on a certain language. In this scenario conversion is excluded (see Article 140(4) second sentence EUTMR).

However, where an EUTM application or IR designating the EU has been refused in an opposition based on an **earlier national trade mark** in a specific Member State, conversion will not take place in respect of that Member State.

When the opposition is based on a number of earlier rights from different Member States but the final decision rejects the EUTM application or the IR designating the EU on the basis of only **one** of those earlier rights, conversion may be requested for the remaining Member States. For example, if an opposition based on a French, an Italian, and an Irish national right is successful with regard to the Irish national right, and if there is no analysis of the other earlier rights, conversion will not take place for Ireland, but may take place for Italy and France (and all other Member States) (16/09/2004, [T-342/02](#), Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, [T-194/05](#), Teletch International, EU:T:2006:124).

## Questions and answers – Overview of The 2023 Edition of the Guidelines

Some other IP offices are considering B&W marks as only affording protection to the mark in B&W

**During the webinar, reference was made to a clarification included in the Guidelines regarding earlier marks claimed as colour marks where the representation is in B&W.**

It was clarified that, for these marks, a representation in B&W is considered acceptable for admissibility and substantiation purposes if that representation contains a clear indication of the colours in words in the language of the proceedings or generally recognised colour codes (such as Pantone, Hex, RAL, RGB or CMYK) and their distribution within the mark (e.g. using arrows).

This clarification does not relate to the scope of protection afforded to B&W marks by national offices.

**For more information on that separate topic, see [Common Practice on Scope of Protection of Black and white B&W\) Marks](#).**

[Part C, Section 1, Opposition proceedings, 2. Notice of opposition, 2.4 Admissibility check, 2.4.2 Relative admissibility requirements, 2.4.2.2 Representation of earlier marks](#)

[Part C, Section 1, Opposition proceedings, 4. Adversarial Stage, 4.2 Substantiation, 4.2.3 Trade mark registrations or applications that are not EUTMs, 4.2.3.6 Verification of the evidence](#)

## Questions and answers – Overview of The 2023 Edition of the Guidelines

Reassessment on the inherent distinctiveness of the EUTM during its life cycle after the limitation (between publication and registration) or partial surrender of good and services (limitation after registration). Shouldn't the EUIPO remain vigilant of the compliance of Article 7 EUTMR requirements every time they receive a request for limitation or partial surrender of the list of goods and services covered by the EUTM application/registration?

The EUIPO examines the distinctiveness of an EUTM only within the mandate given by the EUTM Regulation: this is, either,

- i) before registration (Article 42(1) EUTMR) or
- ii) when there is an invalidity action based on Article 7(1)(b) EUTMR (Article 59(1)(a) EUTMR).

Where a limitation is deemed acceptable, it is registered without re-examining the distinctiveness of the mark.

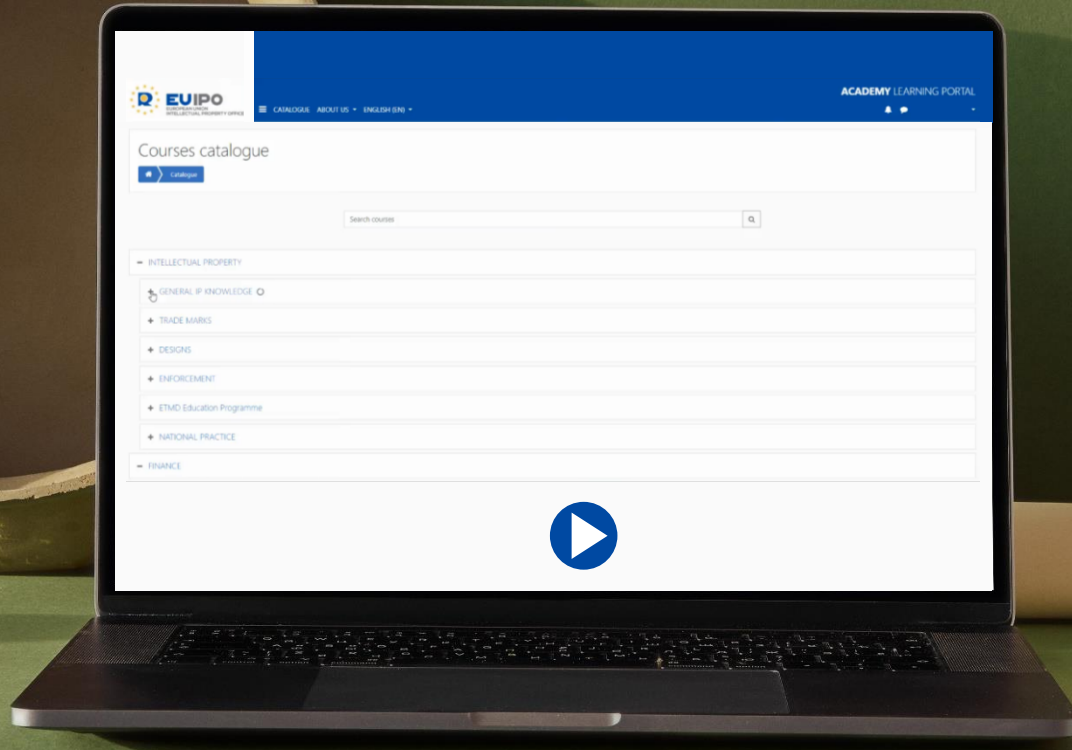
The EUIPO would raise an objection for lack of distinctiveness even in those cases where the mark lacks distinctiveness for only some of the goods or services included in a broader category. Therefore, since a limitation cannot widen the list of goods and services, it cannot impact the examination of the distinctiveness of a mark. There should never be any distinctiveness issue due to a limitation.

Should the lack of distinctiveness become obvious following a limitation, **the possible actions depend on the step of the life cycle of the mark:**

- before registration of the mark (even after publication), the EUIPO can raise an objection;
- after registration, the mark can be cancelled upon request by a third party.



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