

2023 Edition of the EUIPO Guidelines: Overview of main changes

14 March 2023

Kelly BENNETT - Legal Department, EUIPO
María Luisa ARANDA - Legal Department, EUIPO
Katarina KOMPARI - Legal Department, EUIPO
Antje SÖDER - Legal Department, EUIPO
Lina LAPINSKAITE - Legal Department, EUIPO
Maria Luce CAPOSTAGNO - Legal Department, EUIPO
Susana PALMERO - Legal Department, EUIPO (Moderator)

Introduction

The Office's current trade mark and design practice is reflected in a series of structured Guidelines that are intended to be of practical use both to Office staff in charge of the various procedures and to users of the Office's services.

Introduction

IP Knowledge Circles – cross departmental

IP KC AG & EP

IP KC G&S

IP KC Register

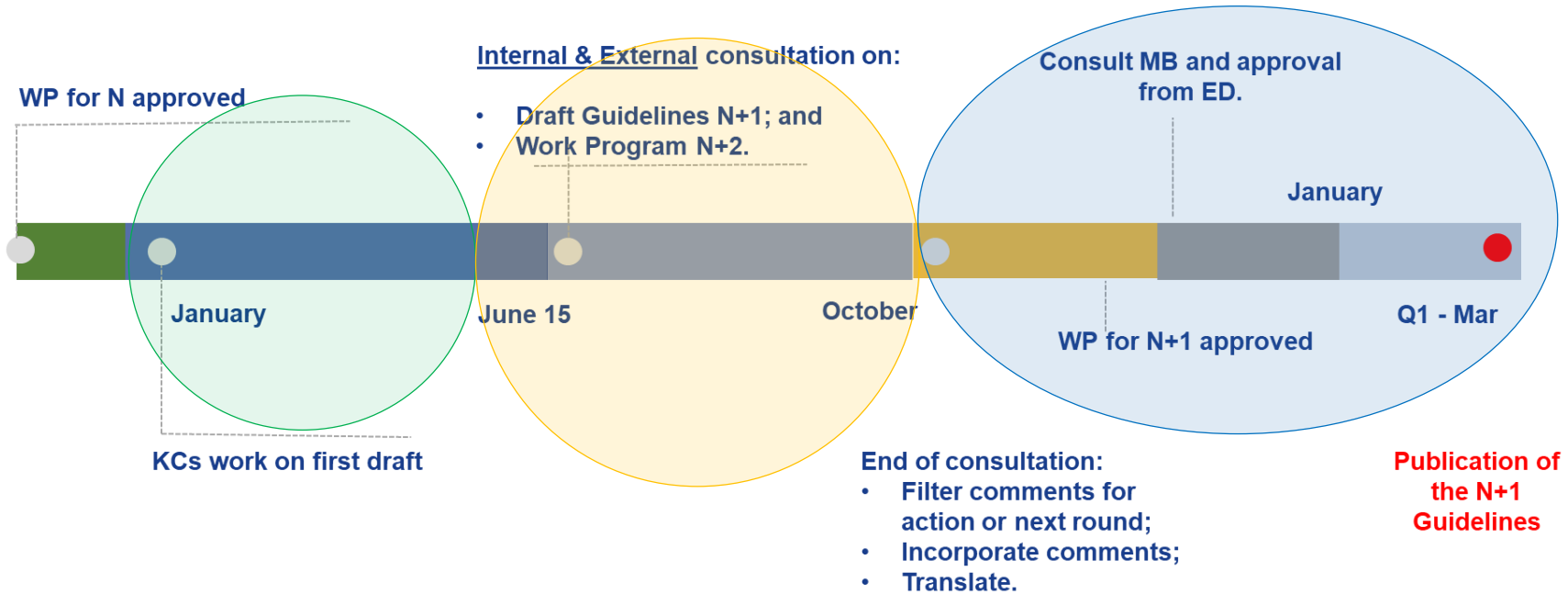
IP KC RG

IP KC Designs

**IP KC GIs and
Collective
Rights**

Introduction

'Normal' Guidelines Revision Calendar - 16 months



Nov > Dec > Jan > Feb > Mar > Apr > May > Jun > Jul > Aug > Sep > Oct > Nov > Dec > Jan > Feb > Mar > Apr

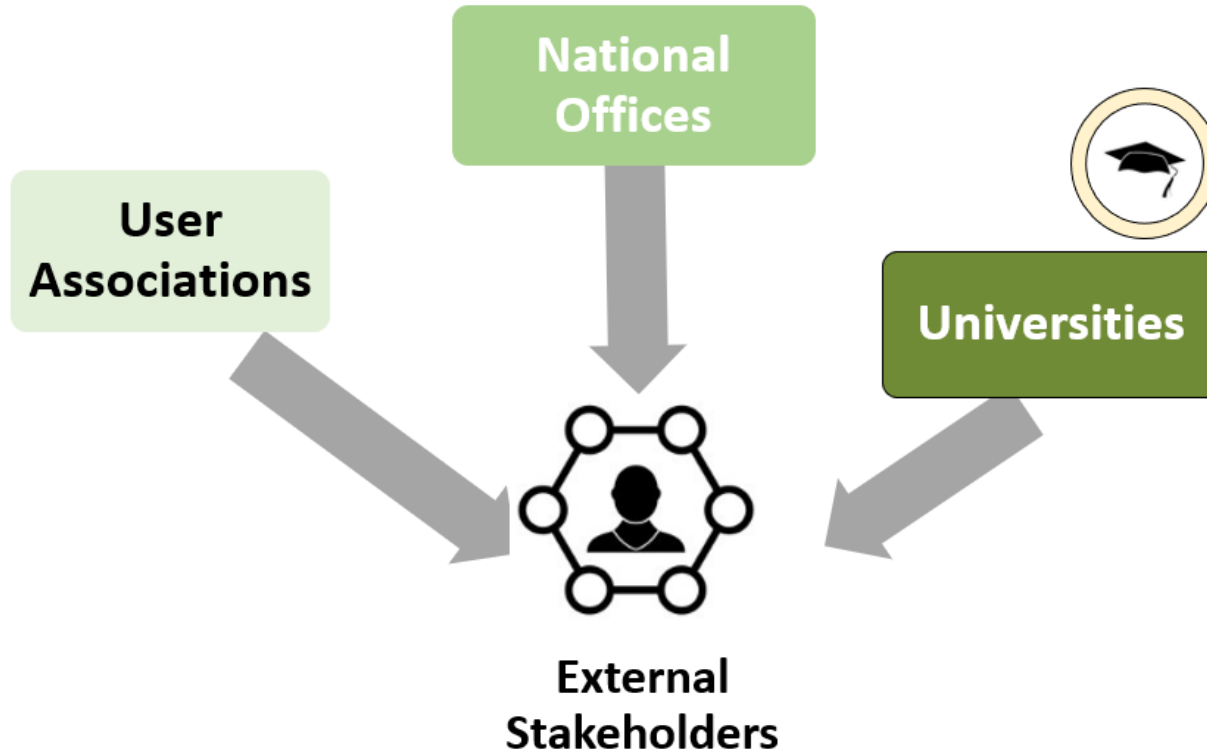
N-1

N

N+1

Introduction

Revision Cycle – Who?



1 General rules

Part A General rules

Section 01 Means of Communication, time limits



Section 06 Revocation of decisions, cancellation of entries in the register and correction of errors



Section 02 General principles to be respected in proceedings



Section 07 Revision



Section 03 Payment of fees, costs and charges



Section 08 Restitutio in integrum



Section 04 Language of proceedings












Section 09 Enlargement



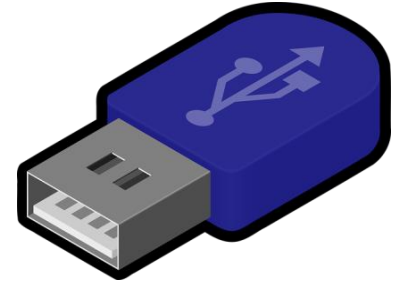
Section 05 Parties to the proceedings and professional representation



Data carriers

- ✓  Section 1 Means of communication, time limits
 -  1 Introduction
 -  2 Procedures for Filing and for Communication with the Office
 - ✓  3 Notification and Communication of Documents
 - ✓  3.1 Communications to the Office in writing or by other means
 -  3.1.1 By electronic means Via the User Area (electronic means)
 -  3.1.2 By post or courier service
 -  3.1.3 Annexes to communications
 -  3.1.4 Data carriers

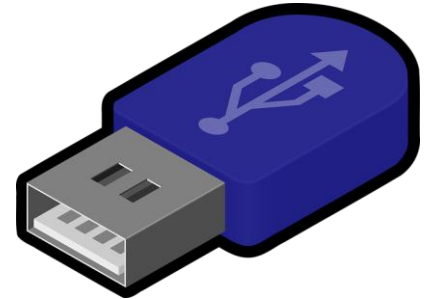
 **User area**
EUIPO's management tool



Decision No EX-22-7 of 29 November 2022 on technical specification submitted on data carriers

Data carrier:

- ✓ small portable storage devices, e.g., USB flash drives, pen drives, similar memory units
- ⊘ external hard drives, memory cards, CD ROMs, DVDs, other optical discs, magnetic data carriers



CHANGE OF PRACTICE !!

File formats:

- ✓ JPEG, MP3, MP4, standard/static PDF, TIFF, STL, OBJ, X3D
- ⊘ fillable PDF forms, PDF files that include added object (black-outs)
executable, compressed or encrypted formats CMYK colour mode or JPEG progressive images

Decision No EX-22-7 of 29 November 2022 on technical specification submitted on data carriers

Size:

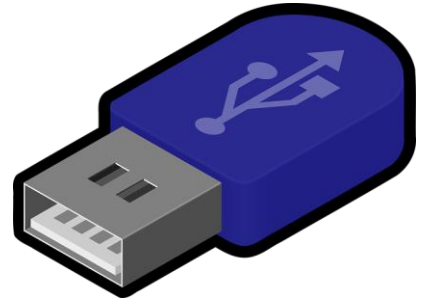
✓ 20 MB each file

Consequences:













No remedy!

CHANGE OF PRACTICE !!



Extension of DL by ED (Art. 101(3) EUTMR and 58 CDIR) – 6 h

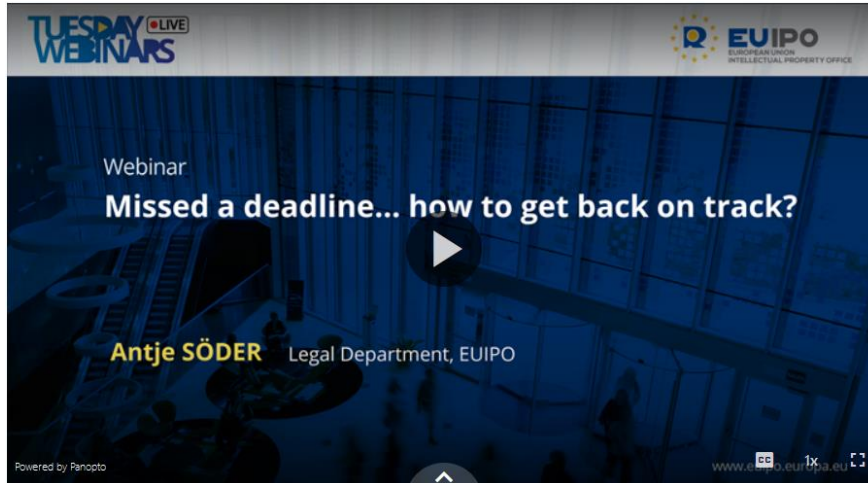
- ✓  Section 1 Means of communication, time limits
 -  1 Introduction
 -  2 Procedures for Filing and for Communication with the Office
 - >  3 Notification and Communication of Documents
 - ✓  4 Time Limits Specified by the Office
 -  4.1 Length of the time limits specified by the Office
 -  4.2 Expiry of time limits
 -  4.3 Extension of time limits
 -  4.4 Continuation of proceedings
 -  4.5 Restitutio in integrum

 **User area**
EUIPO's management tool

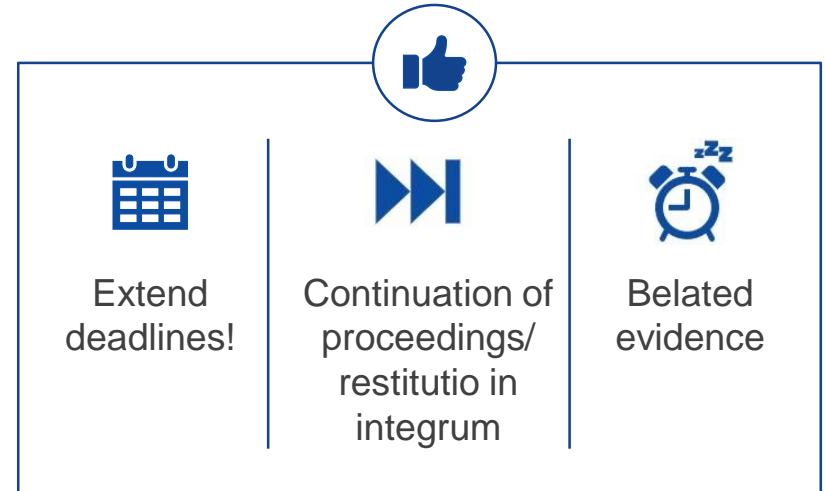


6 h

Recommendations!



<https://euiipo.europa.eu/knowledge/course/view.php?id=4910>



Part A General rules

Section 01 Means of Communication, time limits



Section 06 Revocation of decisions, cancellation of entries in the register and correction of errors



Section 02 General principles to be respected in proceedings



Section 07 Revision



Section 03 Payment of fees, costs and charges



Section 08 Restitutio in integrum



Section 04 Language of proceedings



Section 09 Enlargement



Section 05 Parties to the proceedings and professional representation



Definition well-known facts



**CHANGE OF
PRACTICE !!**



Likely to be known by anyone
Learnt from generally
accessible sources



Part A General rules

Section 01 Means of Communication, time limits



Section 06 Revocation of decisions, cancellation of entries in the register and correction of errors



Section 02 General principles to be respected in proceedings



Section 07 Revision



Section 03 Payment of fees, costs and charges



Section 08 Restitutio in integrum



Section 04 Language of proceedings



Section 09 Enlargement



Section 05 Parties to the proceedings and professional representation



Part A General rules

Section 01 Means of Communication, time limits



Section 06 Revocation of decisions, cancellation of entries in the register and correction of errors



Section 02 General principles to be respected in proceedings



Section 07 Revision



Section 03 Payment of fees, costs and charges



Section 08 Restitutio in integrum



Section 04 Language of proceedings



Section 09 Enlargement



Section 05 Parties to the proceedings and professional representation



Revocation versus correction



Revocation decisions/ Cancellation registrations (Art. 103 EUTMR)

- new analysis
- new appeal
- 1 year



Correction decisions/registrations (Art. 102 EUTMR)

- no new analysis
- no new appeal period
- no DL



Correction Publication EUTMA (Art. 44(3) EUTMR)

- applications only

Revocation versus correction



Revocation decisions/ Cancellation registrations (Art. 103 EUTMR)

- new analysis
- new appeal
- 1 year

**CHANGE OF
PRACTICE !!**

obvious error

does not allow the operative part of that decision or that entry to be maintained without a new analysis

not limited to procedural errors, obvious distortion of facts, obvious error on substance (T-160/20, Marina Yachting)

Revocation versus correction



Correction decisions/registrations (Art. 102 EUTMR)

- no new analysis
- no new appeal period
- no DL

**CHANGE OF
PRACTICE !!**

obvious formal mistakes affecting form not
scope/substance of decision

no wording other than the corrected wording
could be intended

errors not justifying revocation; e.g.
incongruous elements in dictum (some
examples changed from revocation to
correction)

no new analysis/decision
no new appeal period
no deadline

Part A General rules

Section 01 Means of Communication, time limits



Section 06 Revocation of decisions, cancellation of entries in the register and correction of errors



Section 02 General principles to be respected in proceedings



Section 07 Revision



Section 03 Payment of fees, costs and charges



Section 08 Restitutio in integrum



Section 04 Language of proceedings



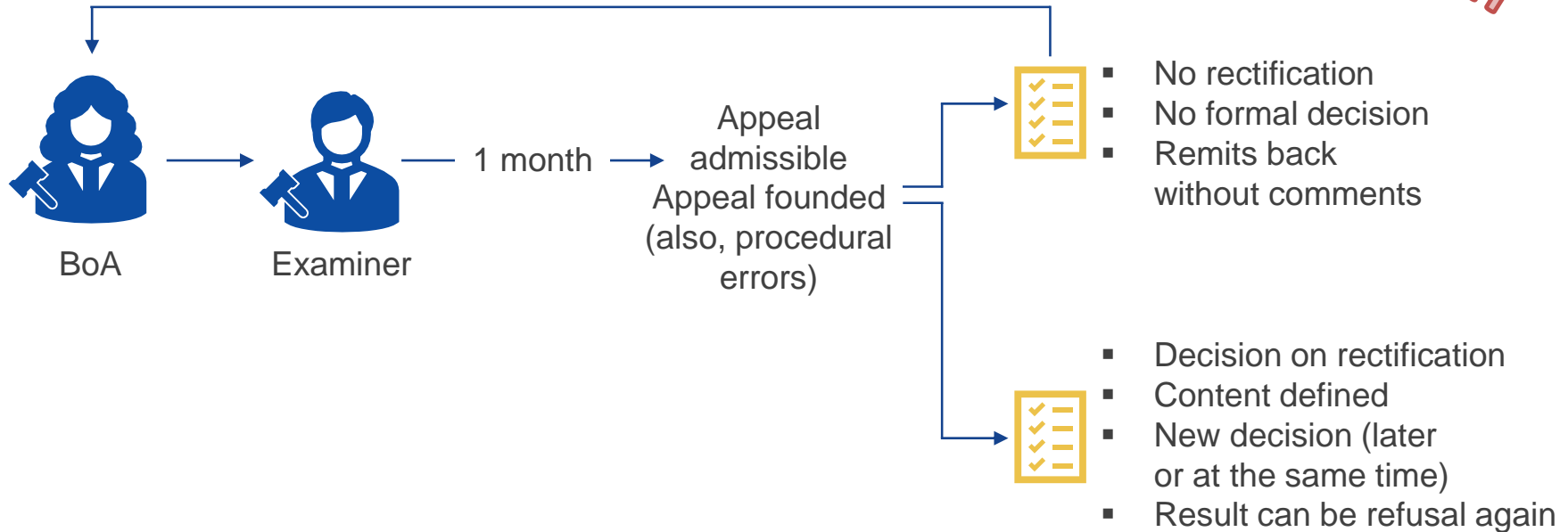
Section 09 Enlargement



Section 05 Parties to the proceedings and professional representation



Revision – ex parte (Art. 69 EUTMR, Art. 58 CD)



Revision – ex parte (Art. 69 EUTMR, Art. 58 CD)



Content of the Decision on rectification:

1. reasons that justify the rectification of the initial decision,
2. statement that the initial decision (i.e. the appealed decision) is deemed to have been repealed;
3. statement establishing procedural situation :
 - decision on merits at later stage and that decision on rectification can only be appealed together with the later decision on the merits;
 - or
 - new decision on the merits replacing the initial decision is adopted, and a statement that an appeal can be filed within 2 months;
4. design proceedings: order to reimburse the appeal fee.

Part A general rules

Section 01 Means of Communication, time limits



Section 06 Revocation of decisions, cancellation of entries in the register and correction of errors



Section 02 General principles to be respected in proceedings



Section 07 Revision



Section 03 Payment of fees, costs and charges



Section 08 Restitutio in integrum



Section 04 Language of proceedings



Section 09 Enlargement








Section 05 Parties to the proceedings and professional representation










Restitutio in integrum (Art. 104 EUTMR, Art. 67 CDR)



-  Exceptional circumstances only
-  No obligation to inform parties
-  Different language regime for RCD
-  New examples
-  New part on renewals (parties, deadline, combined requests, different time limits)

Recap



-  Data carriers (new ED decision)
-  Time limits (extensions, webinar)
-  Definition well known facts
-  Account holders
-  Recovation/correction
-  Revision
-  Restitutio in integrum

2 Examination

Part B: Examination

Section 2: **FORMALITIES**

Section 3: **CLASSIFICATION**

Section 4: **ABSOLUTE GROUNDS FOR REFUSAL**

Part B: Examination

Section 2: **FORMALITIES**

- Multiple figurative representations
- Dotted lines

Section 3: **CLASSIFICATION**

Section 4: **ABSOLUTE GROUNDS FOR REFUSAL**

1. Multiple Figurative Representations

CHANGE OF PRACTICE !!

4.1.4 Representation of the mark; 10 Series Marks; 10.1 Multiple figurative representations

- EUTMR does **not allow** for **series / serial marks**
- Changes:
 - ✓ If representation of applied sign contains **various versions** of **same figurative sign** ...
 - **Not** regarded anymore as a **combination** of **all the versions** of the sign
 - **Deficiency on filing date** (representation **not clear & precise** – **Art. 4(b) EUTMR**)
 - ✓ Invitation to **submit** a **new representation** showing a **single mark**
 - ✓ When new **acceptable** representation is filed → a **new filing date** will be **granted**

2. Dotted lines

MODIFICATION

9.1.2 Dotted lines

- Clarification of practice ‘**dotted lines**’ with **intro** of **new paragraph**
- If **description** allowed for type mark applied → function ‘dotted lines’ can be clarified there
- **Functions of ‘dotted lines’ in the representation:**
 - ✓ Stylistic / decorative elements
 - ✓ Visual disclaimers in *position marks* and *shape marks*
 - ✓ Visual disclaimers of **elements** that **per se** do **not form part of the TM subject matter** ...
BUT of the **overall impression of the mark**, by illustrating the particular manner in which variable elements interact with predetermined elements (e.g., **placeholders**).
- **New illustrative examples**

Part B: Examination

Section 2: FORMALITIES

Section 3: **CLASSIFICATION**

- Virtual goods, NFTs and services provided online or in a virtual environment
- ANNEX: Clarifications

Section 4: ABSOLUTE GROUNDS FOR REFUSAL

Part B, Section C, Classification

New

ANNEX. 6.25 *Downloadable goods and virtual goods*

- Virtual goods
- Non-fungible tokens (NFTs)
- Services provided online or in virtual environments



Definitions
Principles
Examples



Part B, Section C, Classification

Virtual goods



Definition: Non-physical items for use in online and/or virtual environments.

Principles:

- The term *per se lacks clarity and precision* → goods must be specified
- Class 9

Non-fungible tokens (NFTs)



Definition:

- A *cryptographic tool* that uses a blockchain to create a unique, non-fungible digital asset which can be owned and traded.
- Used as *unique digital certificates* to record an interest of some kind in *relation to an item*

Principle: The term *not acceptable* → the asset must be specified

Services provided online or in virtual environments



Principle: Classified according to the *underlying nature* of the service, taking into account its *impact in the real world*.

Part B, Section C, Classification

Clarification

ANNEX

- **6.12 Brokerage:**
→ definition, explanations as to why *brokerage* is proper to Class 36
- **6.26 Electricity and energy**
→ terms *retail or wholesale of energy or of electricity* not acceptable
- **6.41 Kits and sets**
→ guidance on how to classify *unspecified* kits and sets: scenarios with examples

Part B: Examination

Section 2: FORMALITIES

Section 3: CLASSIFICATION

Section 4: **ABSOLUTE GROUNDS FOR REFUSAL**

- Languages and relevant territories for objections
- Deceptive trade marks

Languages and Relevant Territories for Objections (i)

New !!

Chapter 1: General Principles; **‘4. European Criteria’**

- **Glossary** to define expressions used for different languages
- **Approaches** explained on **different ‘types’ of languages** in examination
- **Clarifications:**
 - Indication of **languages** in objections; and
 - indication of **relevant territories** (GC: **ONLY** when support is necessary)
- Territorial consequences of objections/refusals → **clarification** of link **‘languages - territories’**
 - ✓ **EN** **Basic terms** understood **throughout whole EU**
 - ✓ It is **widely** understood in **some MS**
 - ✓ Some **professionals** understand **certain terms**
 - ✓ **EN** → At least **Baltic MS** (Court)

Languages and Relevant Territories for Objections (ii)

Update !!

Chapter 14: Acquired Distinctiveness Through Use
(Article 7(3) EUTMR); **6.2 Language Area**

- **Alignment** with prior **new Point 4. European criteria.**
- **Clarification:**
 - ✓ If Office considers an objection covers:
 - **more MS** than **originally mentioned**
 - **MS** where a **language is not official**
 - it will inform the applicant **before** the application refusal (**ONLY** if necessary)
 - ✓ The **moment** Office informs applicant depends on:
 - **type** of AD claim (**principal or subsidiary**)
 - **point in time** of AD claim
 - ✓ Office will ensure applicant has **necessary knowledge** to file **evidence** for **all relevant territory/-ies**

Deceptive Trade Marks (i)

FULLY UPDATED !!

Chapter 8: Deceptive Trade Marks (Article 7(1)(g) EUTMR)

- Clarification of **test of deceptiveness** in line w/ **recent case-law**.

After publication GLs draft, on **29/06/2022** Judgement **T-306/20 La Irlandesa 1943 (fig.)**

↳ **NEW!!** included as it **confirms** practice

- New **examples** to highlight practice + whole **chapter re-structured** as follows:
 1. **The deceptive character**. Principles:
 - ✓ EUTMR provides for protection against deceptive marks in **AG + Cancellation**
 - ✓ **Function** cannot be performed when mark is deceptive
 - ✓ **Actual deceit** or a **sufficiently serious risk** must exist
 - ✓ Good faith when **non-deceptive use** is **possible** for **other G/S w/in broader category**
 - ✓ Average consumer: reasonably attentive + **not vulnerable to deception**

Deceptive Trade Marks (ii)

2. **The test of deceptiveness.** Two cumulative criteria must be met:
 - ✓ **Sign** conveys a **specific, clear and unambiguous message** re: the *nature, quality or geo origin of the G/S*, worded in such a manner that **non-deceptive use is impossible**.
 - ✓ Relevant public **relies on message + purchase G/S** in the **mistaken belief** that **they possess a characteristic which they cannot have** (**actual deceit / sufficient serious risk**)

Examples of **deceptive** and **non-deceptive** marks.
3. **Categories of deceptiveness.** Nature, quality, geo origin G/S; Official approval (**non-exhaustive**)
4. **Relation with other EUTMR provisions** → **test of deceptiveness** is *prima facie* **the same** in **examination** and in some **post registration actions** (revocation + invalidity based on AG)

3 GIs and Collective Rights

GIs

C-783/19, CHAMPANILLO

REGULATION (EU) 2021/2117 AMENDING GIs REGULATIONS

09/09/2021, C-783/19, Champanillo

PART B, SECTION 4, Chap. 10, TMs in conflict with GIs (Art. 7(1)(j) EUTMR)
PART C, SECTION 6, Geographical indications (Art. 8(6) EUTMR)

Findings of Champanillo case:

- strict interpretation of **concept of use** [4.1 Use of a GI (direct or indirect use)]
- **evocation does not require similarity or identity** of goods covered by the GI and contested G/S [3.1.2 Evocation, imitation, misuse and misleading practices]
- **reputation beyond the GI's inherent reputation** is one of the factors in the global assessment of evocation [4.2.2 Imitation/evocation].



Regulation (EU) 2021/2117 Amending GIs Regulations

PART B, SECTION 4, Chap. 10-12, TMs in conflict with GIs and TSGs (Art. 7(1)(j) and (l) EUTMR)
PART C, SECTION 6, Geographical indications (Art. 8(6) EUTMR)

[Regulation \(EU\) 2021/2117](#) amended EU Regulations on agricultural GIs. Changes in GLs:

- Deletion of references to **aromatised wines (now categorised as a foodstuff)**
- Update of provisions on **definition and protection of GIs and TSGs.**

4 Relative Grounds and Inter Partes Proceedings

Relative Grounds and Inter Partes Proceedings

PART C - OPPOSITION

Section 1: **OPPOSITION PROCEEDINGS**

Section 2: **DOUBLE IDENTITY AND LOC**

Section 7: **PROOF OF USE**

PART D - CANCELLATION

Section 1: **CANCELLATION PROCEEDINGS**

PART C – OPPOSITION

Section 1: OPPOSITION PROCEEDINGS

- Notice of Opposition
- Adversarial Stage
- Request for POU

Section 2: DOUBLE IDENTITY AND LOC

- Chapter 2: Comparison of Goods & Services
- Chapter 5: Distinctiveness of the Earlier Mark

Section 7: PROOF OF USE

Part C, Opposition, Section 1, Opposition Proceedings

Clear and Consistent

2. Notice of opposition, 2.4 Admissibility check, 2.4.2 Relative admissibility requirements, 2.4.2.2 Representation of earlier marks

If colour mark  a representation **in colour** is to be submitted

However, if a representation **in black & white** indicating:

- **colours** in **words** in the **language of the proceedings** or generally recognised **colour codes** (such as Pantone, Hex, RAL, RGB or CMYK)
- their **distribution within the mark** (e.g. using **arrows**)



EQUIVALENT to a 'representation in colour' (*Article 2(2)(f)EUTMDR*)



Part C, Opposition, 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

Representation **in colour** from an official source is to be submitted

However, if the official source provides a representation **in black & white** indicating:

- **colours in WORDS**
(to be **translated** in the **language of the proceedings**)
- +
- their **distribution within the mark** (e.g. using **arrows**)



generally recognised
COLOUR CODES
(such as Pantone, Hex,
RAL, RGB or CMYK)
EQUIVALENT
to colours in
WORDS

Part C, OPPOSITION and Part D, CANCELLATION

Change of practice

Proof of genuine use: calculation of the 'Relevant period' in oppositions / invalidity proceedings

- LEGAL BACKGROUND
- PRACTICE UNTIL NOW
- NEW PRACTICE
- WHY THIS CHANGE

Proof of GENUINE USE: calculation of the ‘relevant period’

- LEGAL BACKGROUND

Article 47(2)EUTMR (OPPOSITIONS)

*If the applicant (of the contested mark) so requests, the **opponent** is to furnish **proof** that, **during the 5year period preceding the date of filing or the date of priority* of the EU trade mark application**, the **earlier mark** has been put to **genuine use** in the EU/MS in connection with the G/S in respect of which it is registered, provided that the earlier mark has at that date been registered for not less than five years.*

** Before the LR, Article 42(2)Reg. 207/2009: ...during the period of 5years preceding the date of **publication** of the CTM application*

Proof of GENUINE USE: calculation of the ‘relevant period’

- LEGAL BACKGROUND

Article 64(2)EUTMR (INVALIDITY)

*If the proprietor (of the contested mark) so requests, the **invalidity applicant** is to furnish **proof** that, during the period of 5 years preceding the date of the application for a declaration of invalidity, the earlier mark has been put to genuine use in the EU/MS in connection with the G/S in respect of which it is registered, provided that the earlier mark has at that date been registered for not less than 5 years (1st relevant period).*



*If, **at the date on which the EU trade mark application was filed (or at its priority date)***, the earlier mark had been registered for not less than five years, the **invalidity applicant** is to furnish proof that, **in addition**, the **conditions** set out in **Article 47(2)** were satisfied at that date (2nd relevant period).*

* Before the LR, Article 57(2)Reg. 207/2009: ...at the date on which the **CTM application** was **published**

Proof of GENUINE USE: calculation of the ‘relevant period’

- PRACTICE UNTIL NOW



Calculation based on the **DATE OF FILING** of the OPPOSITION (or of the INVALIDITY APPLICATION)

- If **OPPO/INV.** filed **on/after 23.03.2016**  **EUTMR applicable**
POU = 5years preceding the **date of FILING** or the **date of PRIORITY** of the **contested EUTM**
- If **OPPO/INV.** filed **before 23.03.2016**  **CTMR applicable** (Reg.207/2009 or Reg. 40/94)
POU = 5years preceding the date of **PUBLICATION** of the **contested CTM**

Proof of GENUINE USE: calculation of the 'relevant period'

- NEW PRACTICE 

Calculation based on the **DATE OF FILING** of the CONTESTED MARK

- If CONTESTED MARK filed **on/after 23.03.2016**  **EUTMR applicable**
POU = 5years preceding the date of **FILING** or the date of **PRIORITY** of the **contested EUTM**
- If CONTESTED MARK filed **before 23.03.2016**  **CTMR applicable** (Reg.207/2009 or Reg. 40/94)
POU = 5years preceding the date of **PUBLICATION** of the **contested CTM**

Proof of GENUINE USE: calculation of the ‘relevant period’

- WHY THIS CHANGE



T-515/21, 23.11.2022, EUPHYTOS/EUPHIDRA, §§37-39
[and **T-102/22**, 01.03.2023, GOURMET, §§16-20]

- the relevant provisions in the **EUTMR/CTMR** concerning **calculation** of the **relevant period/s** in **POU** are **SUBSTANTIVE rules**
- in the case of **applications for invalidity** (and **oppositions**), the **FILING DATE** of APPLICATION FOR REGISTRATION of the **CONTESTED TRADE MARK** is **decisive** for the identification of the **applicable substantive law**

Part C, Opposition, Section 1, Opposition Proceedings

Coherent and Complete

5. Procedure related to the **request for proof of use**, 5.1.4. Request made in a **separate document**

Separate document requirement (in POU): **NOW HERE!**

[from paragraph 4.4.1. *Restrictions, withdrawals and requests for proof of use to be filed by way of a separate document*]

+

CONTENT (in line with **Grand Board decision R 2142/2018-G, DIESEL SPORT**):

- **separate document = separate submission** or **separate annex** of a submission
- e-comm: **specific e-action ‘Request proof of use’** via User Area
[or e-action **‘Submit observations’** - as a separate annex of a submission clearly indicating ‘Annex X: REQUEST for POU’]

Part C – Opposition

Section 1: OPPOSITION PROCEEDINGS

Section 2: **DOUBLE IDENTITY AND LOC**

- Chapter 2: Comparison of Goods & Services
- Chapter 5: Distinctiveness of the Earlier Mark

Section 7: PROOF OF USE

Part C, Section 2, Chapter 2 Comparison of Goods and Services

Change of Practice

▪ 5.4.4. *Provision of food and drinks vs food and drinks*

→ Case law:

- a *low degree of similarity* can be generally found
- when compared to *mere basic ingredients, not consumed as such* → *in principle, similarity unlikely*

Part C, Section 2, Chapter 2 Comparison of Goods and Services

Clarifications

- **2. Identity. 2.1. General principles**
 - Notion of ‘**broad category**’ is not limited to a single term
- **1.2.3 Conclusions to be drawn from the structure of the Nice Classification**
 - **Case law**: relevance of the Nice Classification (*class number* and *explanatory notes*)
- **2.5 Practice on the use of general indications of the class headings**
 - Scope of protection of national trade marks containing the Nice class headings: **updated**

Part C – Opposition

Section 1: **OPPOSITION PROCEEDINGS**

Section 2: **DOUBLE IDENTITY AND LOC**

- Chapter 2: Comparison of Goods & Services
- Chapter 5: Distinctiveness of the Earlier Mark

Section 7: **PROOF OF USE**

Part C, Opposition, Section 2, Double identity and LOC

Consistent

5. Distinctiveness of the earlier mark, 2. Assessment of distinctiveness of the earlier mark, 2.2 Examination of **inherent distinctiveness of the Earlier Mark**, 2.2.1 General principles

Office's practice as to earlier mark's **inherent distinctiveness**:
non-descriptive/not non-distinctive = NORMAL degree



- Reference to **highly original, unusual** or **unique** character of the earlier mark: DELETED
- NEW CASE-LAW: if **no conceptual link** mark-relevant G/S, **NOT automatically HIGH** degree of **inherent distinctiveness**

Part C – Opposition

Section 1: **OPPOSITION PROCEEDINGS**

Section 2: **DOUBLE IDENTITY AND LOC**

- Chapter 2: Comparison of Goods & Services
- Chapter 5: Distinctiveness of the Earlier Mark

Section 7: **PROOF OF USE**

Part C, Opposition, Section 7, Proof of Use

Clear and Case-law

6. Nature of use, 6.3 Use in connection with the registered G/S, 6.3.2 Relevance of the Classification

Use actually proven = genuine use for the registered G/S ?

ROLE played by the **NICE CLASSIFICATION** (class numbers and explanatory notes nature and purpose of G/S): 

- **general terms** in the same class
- similar categories of **G/S classified in different classes** (*specific purpose*)
- but, ***in exceptional cases***, the **term** for which the mark is registered **clearly** identifies **G/S** belonging to **a different class: actual wording is DECISIVE**

EXAMPLES
from recent
CASE-LAW

Part D – Cancellation

Section 1: CANCELLATION PROCEEDINGS

Part D, Cancellation, Section 1, Cancellation Proceedings

New!

2 Applications for cancellation, 2.5 Admissibility check, 2.5.1 Absolute admissibility requirements, 2.5.1.3 **Res judicata** (Article 63(3) EUTMR)

NOW HERE!

[from Section 2, Substantive Provisions, Chapter 5]

+

CONTENT (more complete **EXPLANATIONS** and **EXAMPLES**):

- **Final decision** on the **substance** (15.09.2021, T-207/20, *Palladium Hotels & Resorts (fig.)/Grand hotel Palladium*)
- Same **subject matter** and **cause of action**
- Same **parties**

Part D, Cancellation, Section 1, Cancellation Proceedings

New!

2 Applications for cancellation, 2.5 Admissibility check, 2.5.1 Absolute admissibility requirements, 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**)

T-207/20, 15.09.2021, PALLADIUM HOTELS & RESORTS (fig.)/Grand hotel palladium implemented:

- **INADMISSIBLE:** any subsequent application for invalidity filed by the proprietor of an earlier right referred to in Article 60(1) or (2) EUTMR or by its successor in title, where such an application is **based on OTHER EARLIER RIGHTS** that **could have been claimed** in the first proceedings **but were not**;
- **ADMISSIBLE:** any subsequent application for invalidity based on the **SAME EARLIER RIGHT** that was invoked in the course of a previous action which was **not adjudicated on the merits**.



5 Designs

Designs

Examination of applications for registered Community designs

Examination of design invalidity applications

Designs

Examination of applications for registered Community designs

Clarifications



[8.1 Payment of fees]

A paragraph is added to clarify that the Office will not begin examining the application, and therefore will not accord a filing date, until the fee has been paid.



11.2.3 Changes in the name and/or address of the applicant/holder and/or its representative or in the citation of the designer or team of designers

The requirements for adding or deleting a designer or team of designers from the Register are provided

Designs

Examination of design invalidity applications

Change of Practice



[3.10.3 Admissibility in respect of one of the grounds or the earlier rights or prior designs relied on and 4.2.2 Examination of the grounds for invalidity]

Following an error identified by Stakeholder Quality Assurance Panels (SQAP) auditors during the SQAP audit, these topics have been completely revised to clarify when it is necessary to reopen admissibility proceedings. In particular, a **CHANGE OF PRACTICE** is introduced when novelty “and/or” individual character is claimed as grounds for invalidity: the admissibility examination will ensure that the scope of the application is clear and invite the applicant to clarify whether both grounds are invoked and which prior designs are relevant with respect to each of the grounds.

Designs

Examination of design invalidity applications

Clarifications



[5.5 Technical function; 5.5.1 Rationale; 5.5.2 Examination;]

The topic of Technical Function has been updated in its entirety.



[5.7.2 Assessment of novelty and individual character; 5.7.2.2 Individual character]

- Point of reference for the comparison
- Features dictated by a technical function and features of interconnection
- Individual character.

6 Register Operations

Register Operations

Section 2: **CONVERSION**

Section 3, chapter 1: **TRANSFER**

Conversion



Calculation DL when subsidiary claim
of acquired distinctiveness



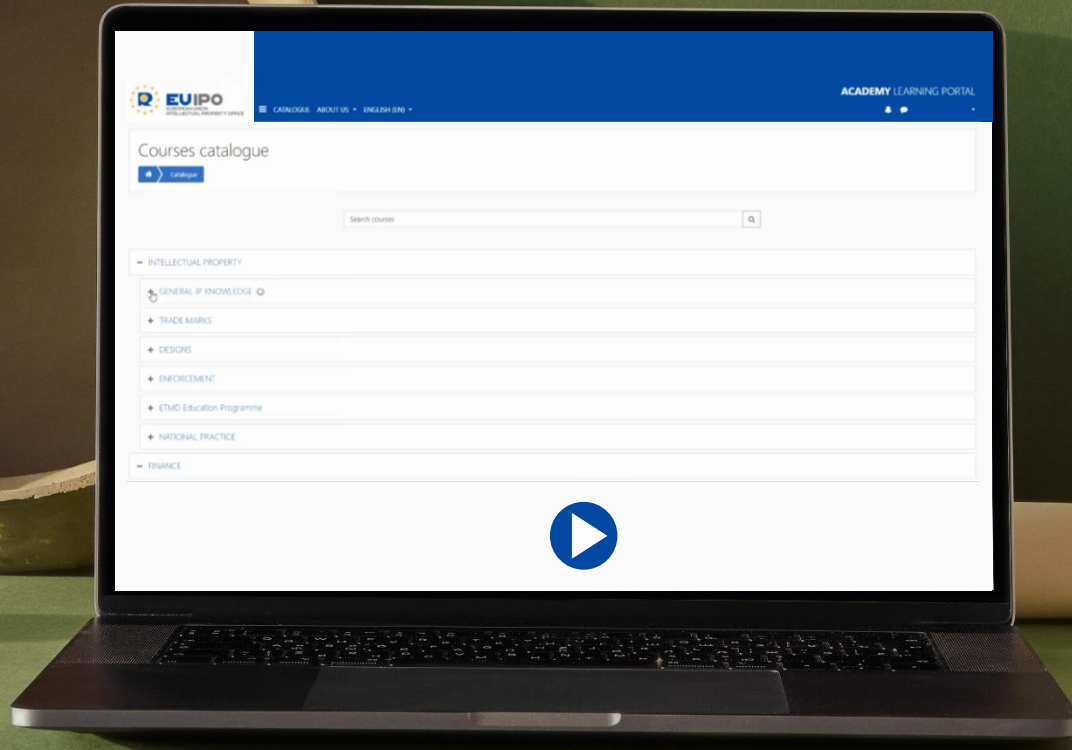
R 1241/2020 Nightwatch –
currently no change of practice

Transfer





Keep in touch with the EUIPO Academy



Kelly BENNETT - Legal Department, EUIPO
María Luisa ARANDA - Legal Department, EUIPO
Katarina KOMPARI - Legal Department, EUIPO
Antje SÖDER - Legal Department, EUIPO
Lina LAPINSKAITE - Legal Department, EUIPO
Maria Luce CAPOSTAGNO - Legal Department, EUIPO
Susana PALMERO - Legal Department, EUIPO (Moderator)



EUIPO

EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

www.euiipo.europa.eu



[@EU_IPO](https://twitter.com/EU_IPO)



[EUIPO](https://www.linkedin.com/company/euiipo)



[EUIPO.EU](https://www.facebook.com/EUIPO.EU)

THANK YOU

**TUESDAY
WEBINARS**