

# ARTICLE 7(3) EUTMR: CLAIMING ACQUIRED DISTINCTIVENESS

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## Outline of the presentation

- **Legal background**
- **Notions of ‘principal’ and ‘subsidiary’ claim**
- **When and how to file a claim under Article 7(3) EUTMR**



## Legal background

Pursuant to **Article 7(1) EUTMR**, the Office will refuse those trademarks that are:

- **(b)** Devoid of any distinctive character
- **(c)** Descriptive
- **(d)** Customary in the current language or in the practices of trade

Unless, in accordance with **Article 7(3) EUTMR**, they have **acquired distinctive character through use** in relation to the goods and/or services for which registration is sought.

Acquired distinctiveness will only be examined following an **explicit claim** from the applicant in that sense.

## Legal background

### Before the legal reform

- Acquired distinctiveness through use (Article 7(3) EUTMR) could be claimed:
  - During the absolute grounds **examination** in the first instance
  - For the first time before the **Board of Appeal**

### The legal reform entered into force on 1 October 2017

- Introducing some **changes** to the claim of Article 7(3) EUTMR
- Applicable to **all applications filed from 1 October 2017** and international registrations for which the designation of the EU was made on or after 1/10/2017

## Legal background



- No changes in the Basic Regulation (Article 7(3) EUTMR)
- But the Implementing and Delegated Acts introduce **changes** on 7(3) claims:
  - **Article 2(2) EUTMIR:**
    - Two types of claims (**principal** or a **subsidiary**)
    - Determines the point in time when an Article 7(3) claim can be validly made
  - **Article 27(3)(a) EUTMDR** states that, in the future, a claim under **Article 7(3) EUTMR cannot be raised for the first time at the appeal stage.**
- No changes as regards the assessment of the evidence

## Legal background

### Benefits of the legal reform for the users:

- Guarantees a **double degree of examination** of acquired distinctiveness at the **administrative stage**
  - Before the legal reform, the assessment of an Article 7(3) claim made for the first time before the Board of Appeal could not be appealed before EUIPO.
  - Since 1 October 2017, the claim of Article 7(3) EUTMR must be examined first by the Examiner. Then, this first decision can always be appealed before the Board of Appeal.

## Notions of 'principal' and 'subsidiary' claim

### Principal claim

Applicant requests EUIPO to:

- decide on **both** inherent distinctiveness **and** acquired distinctiveness in the **same** decision

**One** single decision



### Subsidiary claim

Applicant requests EUIPO to :

- **First** decide on **inherent** distinctiveness and
- Only when such decision is **final**, the Office takes a **second** decision on **acquired** distinctiveness

**Two** decisions

## Notions of ‘principal’ and ‘subsidiary’ claim

*Irrespective of whether the claim is made as ‘principal’ or ‘subsidiary’:*

- The claim on acquired distinctiveness will come into play **only if the mark is not inherently distinctive.**
- If the mark is found inherently distinctive, the trade mark will be registered without a decision on acquired distinctiveness.
- The type of claim has no impact on the outcome of the assessment of inherent distinctiveness.



## When to file a claim under Article 7(3) EUTMR

Article 7(3) EUTMR claims can **only** be submitted **during the examination proceedings**.

- The possibility to claim acquired distinctiveness for the first time before the Board of Appeal is now expressly forbidden by Article 27(3)(a) EUTMDR.
- Such belated claim will be dismissed.

## When to file a claim under Article 7(3) EUTMR

### PRINCIPAL CLAIM

### SUBSIDIARY CLAIM

- When filing the **application**
- or **After** the application was filed,
- but not later than in the **reply** to the first objection letter.



LONDON



NEW YORK



TOKYO



MOSCOW

## How to file a claim under Article 7(3) EUTMR

**Principal      Subsidiary**

- ❖ **‘Tick’ in E-filing**
- ❖ **Declaration**
- ❖ **Observations in reply to first objection letter**



## How to file a claim under Article 7(3) EUTMR

# E-filing/application (EUTMs)

### I want to claim

*Optional*

▶ Priority

+ Add priority

▶ Seniority

+ Add seniority

▶ Exhibition

+ Add Exhibition

▶ IR Transformation

+ Add IR Transformation

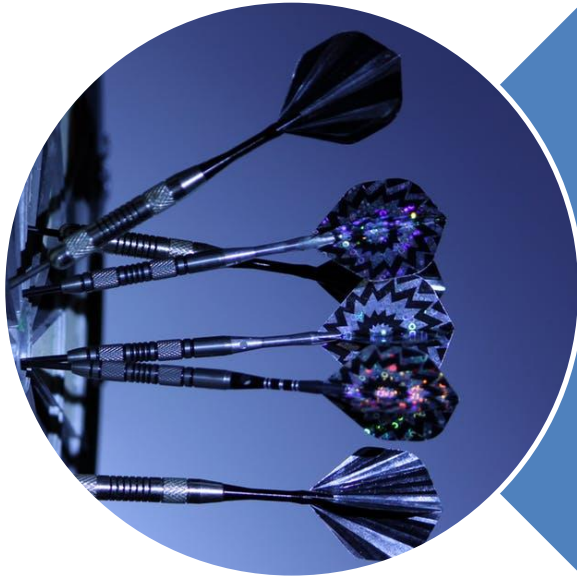
The sign has acquired distinctive character through use ⓘ

#### Indication of claim

Principal ⓘ

Subsidiary ⓘ

## How to file a claim under Article 7(3) EUTMR



If the claim is made by separate declaration or in reply to the objection letter, it has to be **clear and precise**, indicating whether it is principal or subsidiary.

## How to file a claim under Article 7(3) EUTMR: unacceptable claims



### APPLICANT:

#### Wording such as:

*If the objection is maintained the applicant reserves the right to file evidence/requests more time to file evidence.*



### APPLICANT:

In reply to the objection letter provides evidence of use/arguments on 7(3) EUTMR but the type of claim is not clearly and precisely indicated.



### OFFICE:

1. Issues a deficiency letter
2. Gives **2 months** to clarify the type of claim + submit evidence if the claim is principal.
3. If **no reply** is received, it will be understood that **no claim** was made.

## When to file a claim under Article 7(3) EUTMR

### CHANGES IN THE TYPE OF CLAIM

➤ **PRINCIPAL** → **SUBSIDIARY?**

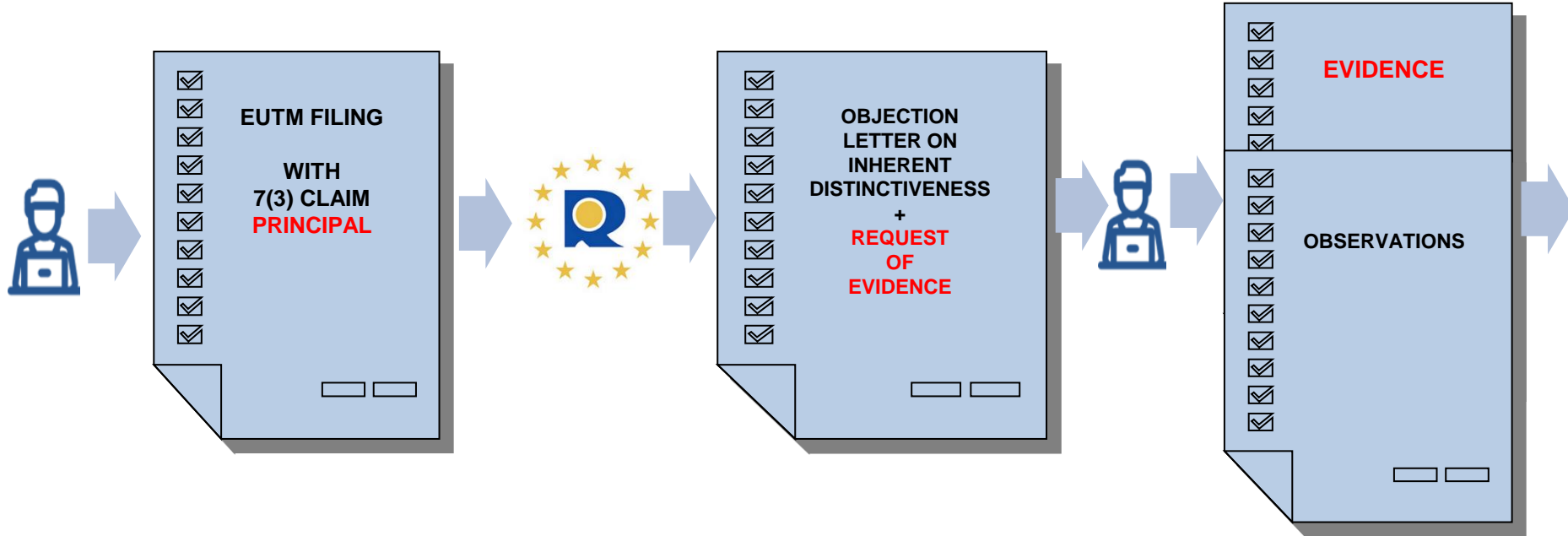
**YES**  
provided that the request for change is made no later than in the reply to the first objection letter.

➤ **SUBSIDIARY** → **PRINCIPAL?**

**YES**  
provided that the request for change is made no later than in the reply to the first objection letter.

## What to expect when a *principal* claim has been filed?

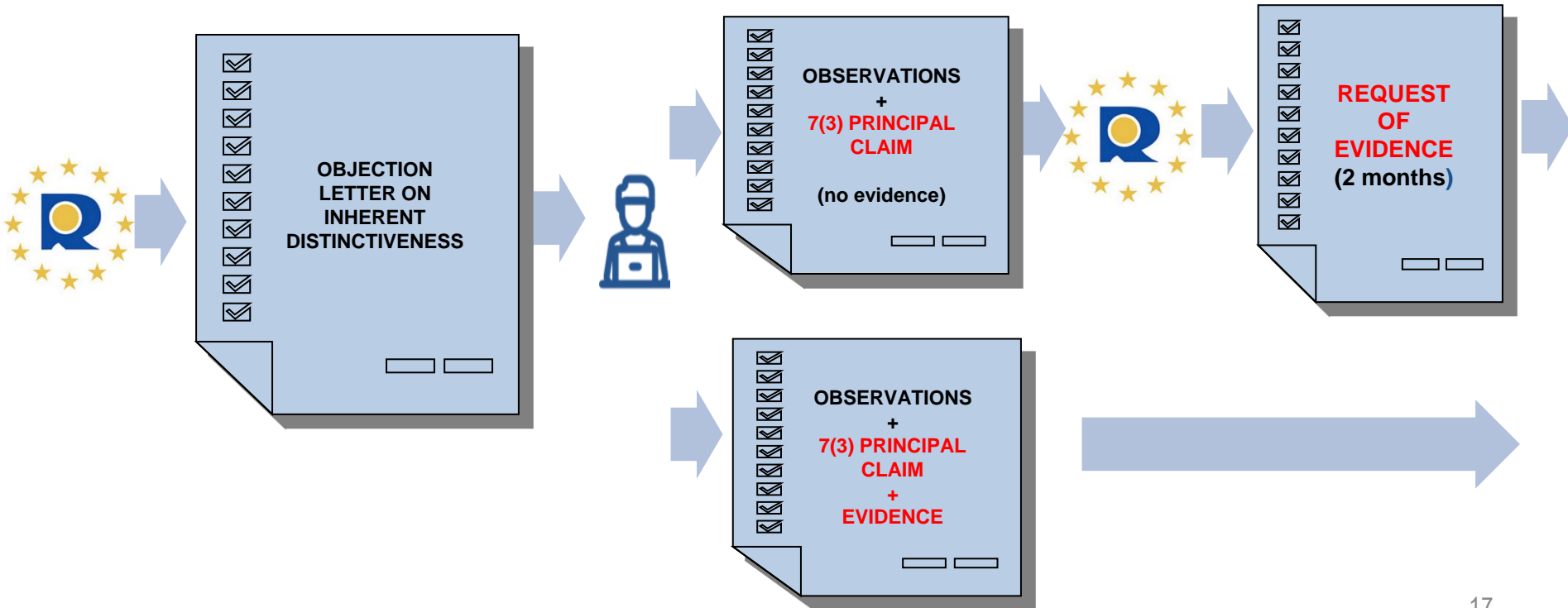
If the applicant opts for the principal claim at the time of application



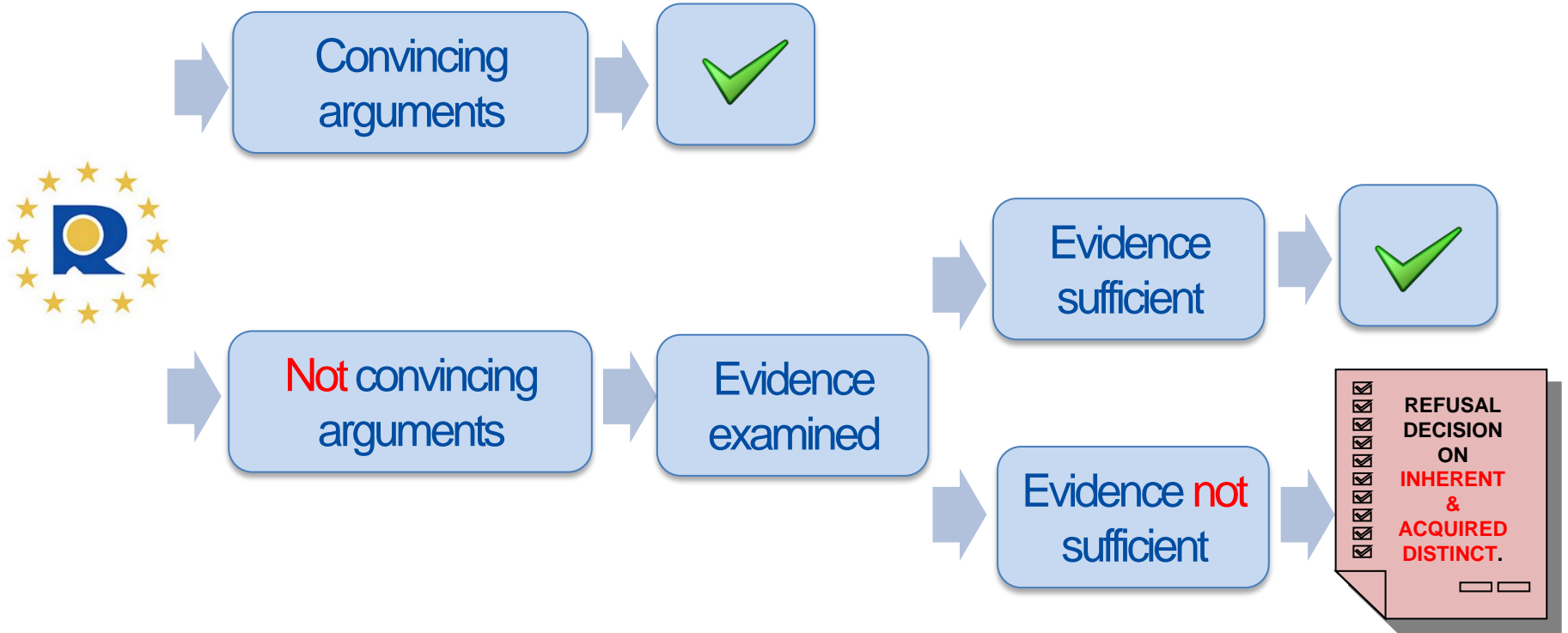


## What to expect when a *principal* claim has been filed?

If the applicant opts for the principal claim in response to the first objection



## What to expect when a *principal* claim has been filed?



## What to expect when a *principal* claim has been filed?

The refusal decision can be appealed:

- On inherent distinctiveness
- On acquired distinctiveness

The decision finding the trade mark acceptable according to Article 7(3) EUTMR but devoid of inherent distinctiveness cannot be appealed.

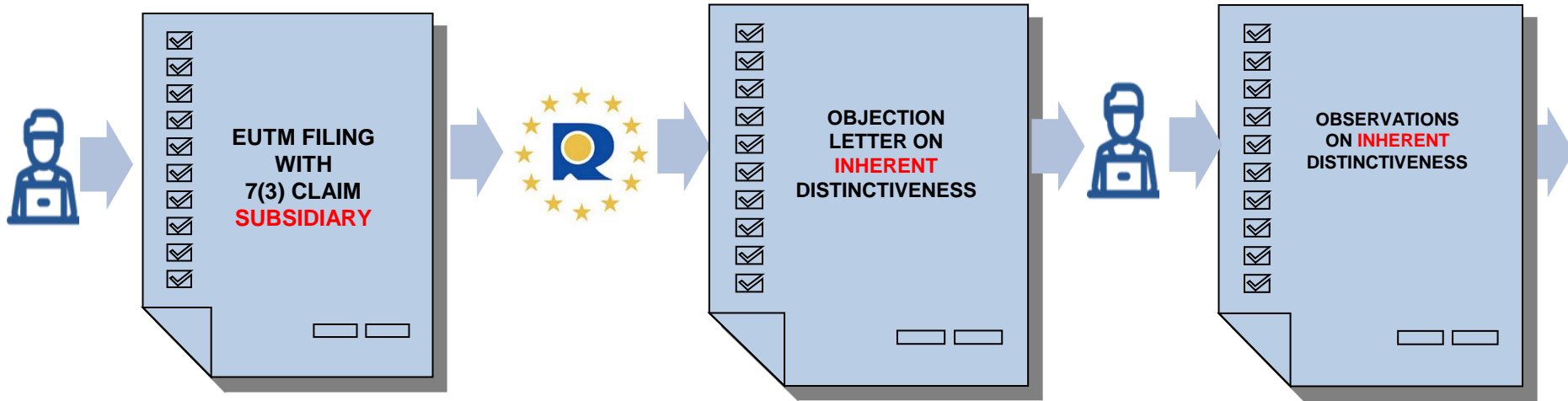
## What to expect when a *subsidiary* claim has been filed?

When the claim has been indicated as a **subsidiary** one, the examination of the application will be divided in two phases:

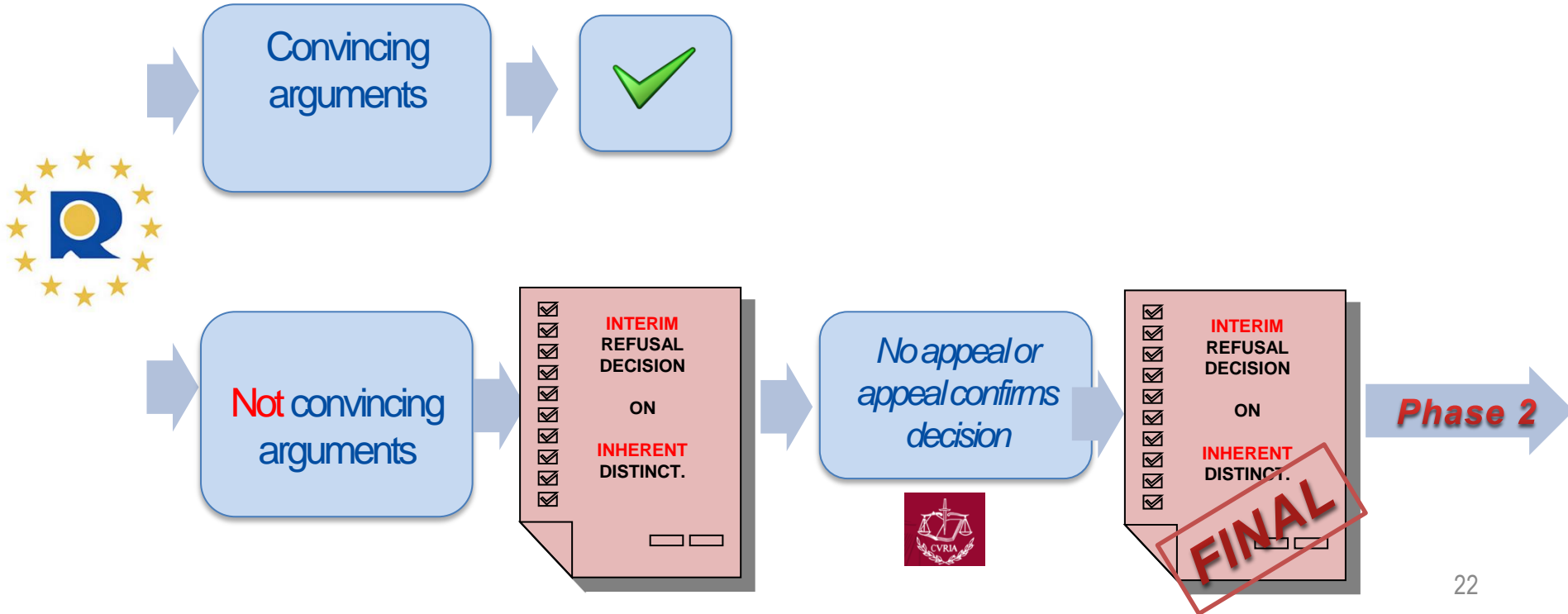
- **First** the Office will **decide only on the inherent distinctiveness** of the sign.
- If the sign is found devoid of distinctiveness –and only once such decision has become final – the Office will **subsequently deal only with the claim of acquired distinctiveness**.

## What to expect when a *subsidiary* claim has been filed?

### Phase 1

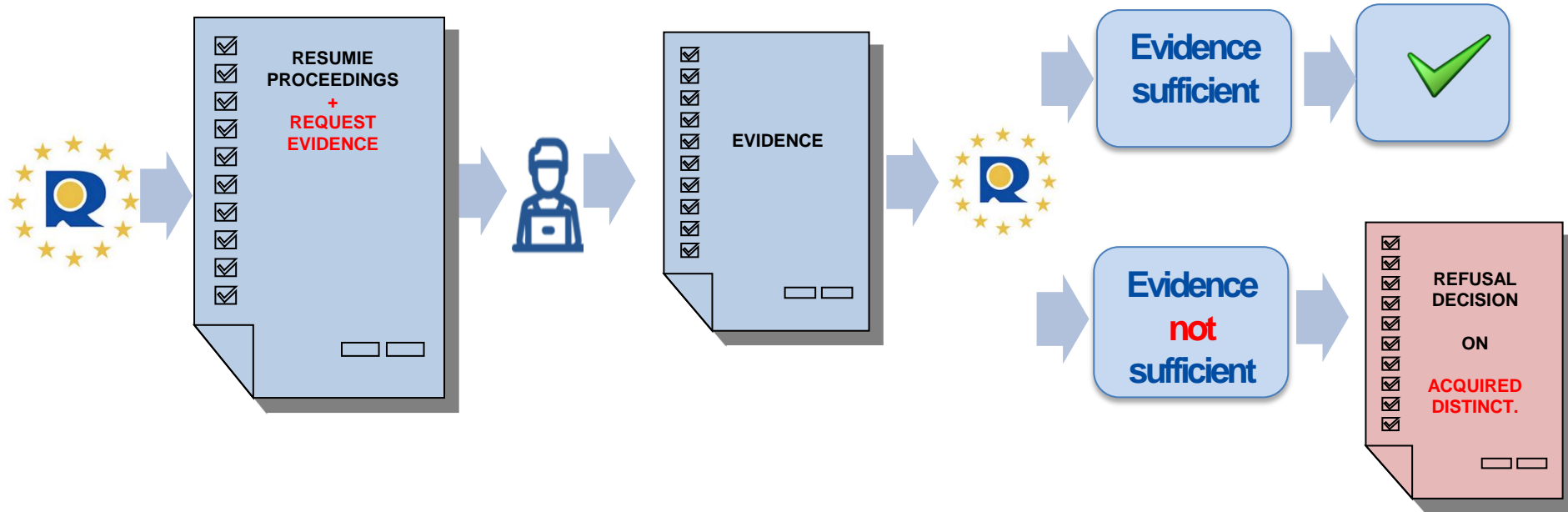


## What to expect when a *subsidiary* claim has been filed?



## What to expect when a *subsidiary* claim has been filed?

### Phase 2



## Principal or subsidiary?

It is up to the applicant to decide whether the claim of acquired distinctiveness shall be examined as principal or subsidiary

Various factors have to be taken into account, such as:

- The speed of registration proceedings
- The difficulties in gathering evidence
- The importance of having a separate decision on the inherent distinctiveness



LANGUAGES

THANK YOU!

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