

OVERVIEW OF THE 2024 EDITION OF THE EUIPO TRADE MARKS GUIDELINES

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PROGRAMME

80'
Presentation

- Metaverse-related issues in EUTMs
- Evidence & Soft policy
- Other changes

10'
Questions and answers

1

METaverse-RELATED ISSUES IN EUTMs



TERMINOLOGY

Terminology

Virtual goods refer to **non-physical items** intended for **use** in the course of **trade in online and/or virtual environments**

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i) they may merely **depict** real-world goods



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ii) they may **emulate functions** of real-world goods



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i) they may merely depict real-world goods

ii) they may emulate functions of real-world goods

iii) they may represent items with **no equivalent in the real world**



Terminology

Virtual services may refer to:

Terminology

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i) **real-world services** that are **provided via** online and/or virtual environments



Terminology

Virtual services may refer to:

- i) real-world services that are provided via online and/or virtual environments

- ii) services developed for the virtual environment that **emulate a real-world service**



Terminology

Virtual services may refer to:

- i) real-world services that are provided via online and/or virtual environments
- ii) services developed for the virtual environment that emulate a real-world service
- iii) services developed for the virtual environment **without counterparts in the real world**



Terminology

Non-fungible tokens (NFTs)

cryptographic tool that uses a blockchain to create a unique, non-fungible digital asset which can be owned and traded

Intellectual Property Rights and Distributed Ledger Technology with a focus on art NFTs and tokenized art, point 2.1, page 13

Terminology

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Intellectual Property Rights and Distributed Ledger Technology with a focus on art NFTs and tokenized art, point 2.1, page 13

- work as **unique digital certificates** that can be used as a means of **recording an interest** of some kind in relation to **an item**;
- relate to an **item other than themselves**, in relation to which they perform a **function of authentication**;
- can be linked to **digital** or **physical** assets.



CLASSIFICATION

Classification of virtual goods

Virtual goods

Classification: digital content → **Class 9**

Classification of virtual goods

Virtual goods

Classification: digital content → **Class 9**

not the same function, purpose or nature as their real-world counterparts
(e.g. *virtual clothing* may ‘dress’ an avatar but not a human being)

Classification of virtual goods

Virtual goods

Description: needs clarity and precision

Classification of virtual goods

Virtual goods

Description: needs clarity and precision

Class 9: *virtual clothing*

Class 9: *downloadable virtual clothing*

Nice Classification alphabetical list, 2024

Classification of virtual goods in relation to GIs

Virtual goods and GIs

General principles:

- Protected GIs **cannot** be used in relation to virtual goods in Class 9
- **Virtual representations** of GI products do not comply with the relevant product specifications as they are **not physical items**

Classification of virtual goods in relation to GIs

Virtual goods and GIs

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 **Class 9: *Virtual tequila (GI)***

 **Class 9: *Virtual agave spirit drinks***

Classification of NFTs in relation to goods

Non-fungible tokens (NFTs)

Classification: according to what the NFT is linked to

Classification of NFTs in relation to goods

Class 9: *virtual handbags authenticated by NFTs*

Class 9:

- *downloadable digital image files authenticated by non-fungible tokens [NFTs]*
- *downloadable digital music files authenticated by non-fungible tokens [NFTs]*

Nice Classification alphabetical list, 2024

Classification of NFTs in relation to goods

Class 18: *handbags authenticated by NFTs*

Class 25: *clothing authenticated by non-fungible tokens [NFTs]*

Nice Classification alphabetical list, 2024

Classification of NFTs in relation to GIs

General principle: GIs cannot be used generically



Class 33: *Tequila' (GI) agave spirit drinks authenticated by an NFT*



Class 33: *Tequila authenticated by an NFT*

Classification of services for use in virtual environments

Virtual services

Classification: according to the nature and intended purpose of the service, considering its impact in the real world

Classification of services for use in virtual environments

Virtual services

General Remarks of the 12th Edition of the Nice Classification, 2024 version

Classification of services for use in virtual environments

Virtual services

General Remarks of the 12th Edition of the Nice Classification, 2024 version

‘The means by which a service is rendered **does not** in principle **affect** the classification of the service unless the **purpose** or **result** of this service **changes** due to its means or place of delivery’

Classification of services for use in virtual environments

Class 41:

simulated travel services provided in virtual environments for entertainment purposes

Nice Classification alphabetical list, 2024

Terminology and Classification

Guidelines 2024

Part B Examination, Section 3 Classification, Point 4 List of goods and services

- **4.3.6 Geographical Indications in lists of goods and services**
- **4.4 Virtual goods, services in virtual environments and NFTs**



ABSOLUTE GROUNDS EXAMINATION

PART B, EXAMINATION, Section 4, ABSOLUTE GROUNDS FOR REFUSAL - Chapter 2, NON-DISTINCTIVE TRADE MARKS (Article 7(1)(b) EUTMR) - 2. Virtual goods and services in a virtual environment

ASSESSMENT OF DISTINCTIVENESS

of

EUTMs applied for

**VIRTUAL GOODS/SERVICES
in VIRTUAL ENVIRONMENTS**



OFFICE's PRACTICE

Absolute grounds (Article 7(1)(b) EUTMR)

- **GENERAL PRINCIPLES APPLICABLE** (*EUTM originating from a particular undertaking*)
- **COMMON SCENARIOS:**
 - virtual goods **depict** real-world goods
 - virtual goods that **depict and emulate** the functions of real-world goods
 - services in a virtual environment that **emulate** real-world services in a virtual environment
- *In principle,* REAL-WORLD goods/services - EQUIVALENT VIRTUAL goods/services in virtual environments ➡ **SAME ASSESSMENT**
- *However,* **CASE-BY-CASE ANALYSIS**



RELATIVE GROUNDS EXAMINATION

d.1

Comparison of virtual and real-world goods

Relatives grounds - Part C, Opposition, Chapter 2, Annex II - 5.9. Virtual goods versus real-world goods

Definition of virtual goods

The fact that virtual goods depict or emulate the functions of real-world goods **does not** make them **identical**. Similarity is not excluded.

Relatives grounds - Part C, Opposition, Chapter 2, Annex II - 5.9. Virtual goods versus real-world goods

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PRINCIPLES:

- **CANON factors** (29/09/1998, C-39/97, Canon, EU:C:1998:442)

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- **Inter partes proceedings:** the Office is restricted in its examination to the **facts, evidence and arguments provided by the parties**

Article
95(1)
EUTMR

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- **Inter partes proceedings:** the Office is restricted in its examination to the **facts, evidence and arguments provided by the parties**
- Even if the degree of similarity of the G&S is a matter of law, which must be assessed *ex officio*, this examination is restricted to '**well-known facts**'

Article
95(1)
EUTMR

d.2

Proof of use

Part C, OPPOSITION, Section 7, PROOF OF USE - Chapter 3. **Place** of use- 3.1 Use in the territory where the trade mark is protected

- **DISTINCTION** between **PLACE of SUPPLY/PROVISION** of the relevant goods/services and **PLACE of USE** of the mark
- **ADVERTISING** may be **OK if directed** at the **relevant public** of the **relevant territory to create/preserve an outlet** for those G/S in the EU (*irrespective of the fact that the relevant goods/services are supplied/provided outside the relevant territory*)*



GC, 13/07/2022, T-768/20, The standard (fig.)

[*see GL, PART C, Section 7, 6. **Nature** of use, 6.1 Use as a trade mark, 6.1.2 Use in the course of trade, 6.1.2.5 Use in advertising]

PART C, OPPOSITION, Section 7, PROOF OF USE - Chapter 6. Nature of Use - 6.1 Use as a trade mark, 6.1.2 Use in the course of trade, 6.1.2.2 Commercial activity versus promotional

- Use in connection with the **DIGITAL REPRESENTATION** of **REAL-WORLD GOODS** in **online/virtual environments** for **PROMOTING/FACILITATING** the **PURCHASE of the REAL-WORLD GOODS**



NO genuine use of **EQUIVALENT VIRTUAL GOODS**

- If the **VIRTUAL GOODS themselves** are offered with the intention of **CREATING/MAINTAINING** an outlet **FOR THOSE GOODS**



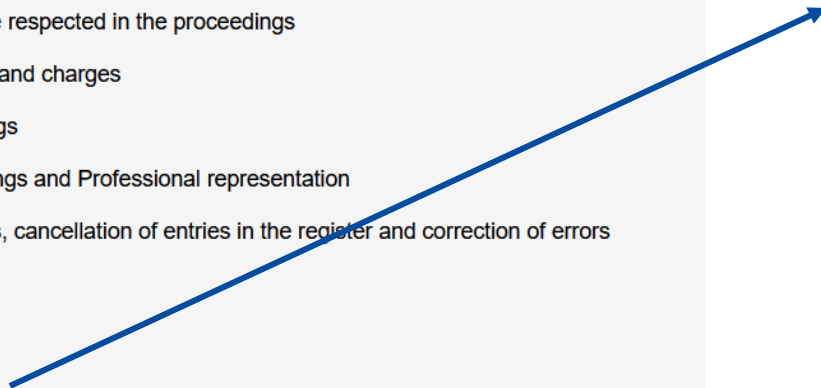
YES genuine use for **VIRTUAL GOODS**

2 EVIDENCE & SOFT POLICY

- **1 Introduction**

- + Editor's note and general introduction
- × Part A General rules
 - + Section 1 Means of communication, time limits
 - + Section 2 General principles to be respected in the proceedings
 - + Section 3 Payment of fees, costs and charges
 - + Section 4 Language of proceedings
 - + Section 5 Parties to the Proceedings and Professional representation
 - + Section 6 Revocation of decisions, cancellation of entries in the register and correction of errors
 - + Section 7 Revision
 - + Section 8 Restitutio in integrum
 - + Section 9 Enlargement
- + Part B Examination
- + Part C Opposition
- + Part D Cancellation
- + Part E Register operations
- + Part M International marks

NEW
Section 10 - Evidence



Concept



Merging sections - sources



Soft Policy



Structure



Structure



How to submit evidence

2.1 General requirements / recommendations

2.2 Specific requirements *inter partes*

2.3 Confidentiality

How to submit evidence – General recommendations



**Art. 55(2)
EUTMDR**



Index

Annexes

- numbered consecutively through all Annexes
- description/name
- submission/index shall refer to the same
- data carriers



Deficiencies

<u>Annex No.</u>	<u>Description</u>	<u>Pages</u>	<u>Page where the evidence is mentioned</u>
<u>Annex 1</u>	<u>Survey 2021</u>	<u>1 - 30</u>	<u>Observations, page 1</u>
<u>Annex 2</u>	<u>Catalogues 2022</u>	<u>31 - 45</u>	<u>Observations, page 5</u>

How to submit evidence – General recommendations



8 points of do's and don't's!

1. limit submissions to items that are relevant to the case
2. number each batch, show the total pages in each batch
3. photographs instead of physical specimens
4. no original documents or items
5. items sent by mail must not be stapled, bound, folders
6. if several TMs, G&S, dates in one item, submission should indicate which information is relevant and why
7. if colour is relevant, evidence should be in colour
8. if different earlier marks, grounds, classes, long lists of goods and services, explain which issue each item supports (e.g Annex A-D for proof of use of mark x for good y)

How to submit evidence

2.1 General requirements / recommendations

2.2 Specific requirements *inter partes*

2.3 Confidentiality

How to submit evidence

2.1 General requirements / recommendations

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Structure



How to submit evidence – general recommendations



Formal requirements: type and number of the proceedings, document title, number of pages in the document, date the document was sent to the Office

Example: ‘the statutory declaration submitted to the Office on 12/12/2020 in opposition proceedings B 123 456, together with exhibits 1 to 8, consisting of 200 pages’

Best practice: References via a **separate document or separate section** at the beginning of the observations.



Data carriers – special rules !



Translations !

Structure



Types of evidence



Online evidence



Affidavits



Opinion polls and market surveys



Audits



Annual reports on economic results and company profiles



Invoices and other commercial documents



Certifications, rankings and awards



Promotional materials and publications



Oral evidence

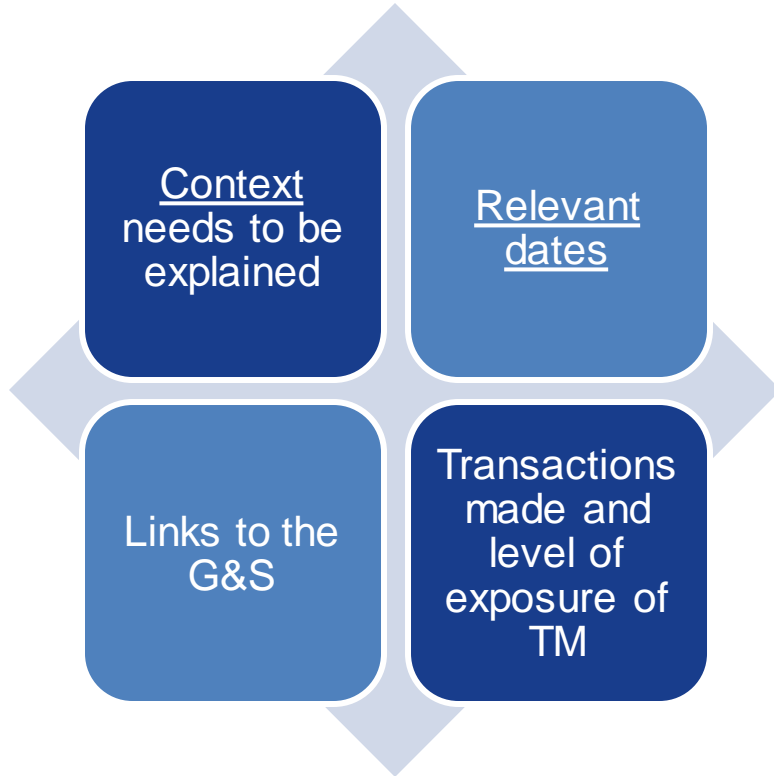


Commissioning of expert opinions by the Office



Inspections in situ carried out by the Office

Online evidence



Affidavits

Evidential value
assessed in
light of EU law

- 28/03/2012, T-214/08, Outburst
- 07/06/2005, T-303/03, Salvita
- 12/2014, T-278/12, PROFLEX
- 18/11/2015, T-813/14, Case for a portable computer
- 02/03/2022, T-1/21, Furniture



Surveys

**The Office
will consider**

- survey provider
- target public, sample size
representation of results
- method used, set of
questions, circumstances
under which the survey
was carried out
- dates



Invoices



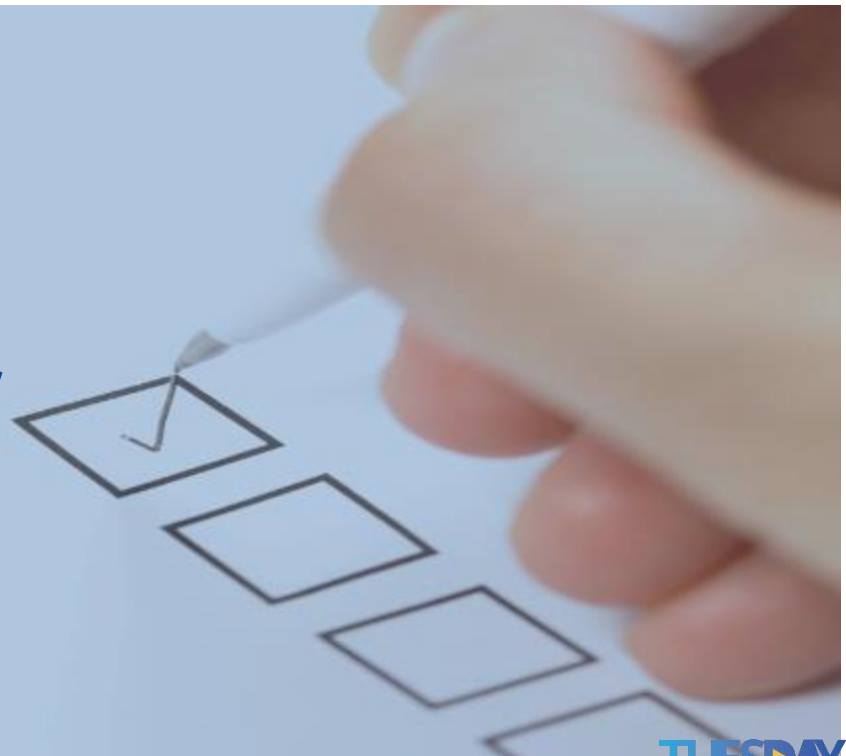
Codes



Exemplary character



Addressee/territory



Structure



Evidence – Best practice



Avoid being late – extension



Distinction between supplementary and new facts or evidence



If entirely new evidence consider continuation



If supplementary evidence: show the link to the evidence already provided; table



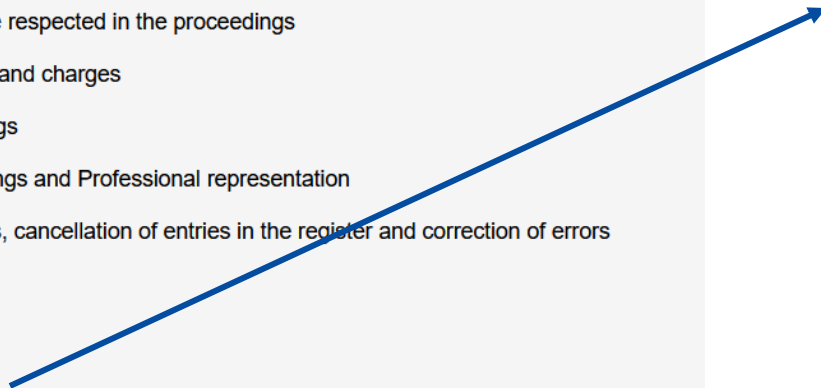
Discretionary power



- **1 Introduction**

- + Editor's note and general introduction
- × Part A General rules
 - + Section 1 Means of communication, time limits
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- + Part E Register operations
- + Part M International marks

NEW
Section 10 - Evidence



Classification

Restrictions/Amendments – co-existence?



Cancellation

Provide, at the beginning of an invalidity application, **skeleton argumentation** giving a short overview of their case which should be concise, focused and include:

- **The legal issues in brief;**
- **A summary of the arguments and the essential facts.**

Facilitates more efficient proceedings to the benefit of all parties and ensures that all material arguments are dealt with.



Costs & Equity

A **different apportionment of costs** can, however, be justified for **reasons of equity**. This may be the case where the application was **restricted in such a limited way** that it would clearly not overcome the extent of the opposition but would lead to unjustly prolonged proceedings.



Equally applicable to revocation or invalidity where the action is on the whole successful but only one or two G&S remain registered.

Costs

...proceedings before the Office should be effective, efficient and expedient

the Office may decide on a different apportionment of costs in **exceptional cases** in which the behaviour of a party was **clearly abusive**, resulting in **unnecessary complications** and/or **delaying** the proceedings.

- disregarding rules and Office guidance on effective, efficient and expedient proceedings **in a manner that requires considerable extra time and work** from the other party or the Office;
- **blatantly** ignoring a party's **bona fide** attempts at friendly settlement (or other alternative means of resolving the dispute) where there is **no justification** or underlying reasons **for not responding** (albeit negatively).



3 OTHER CHANGES

R 1508/2019 - G – ZARA – Conversion 139, 140 EUTMR



Case scenario



EUTM revoked due
to non-use



Conversion
Article 139(2)(a)
EUTMR

2. Conversion shall not take place:

- (a) where the rights of the proprietor of the EU trade mark have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the EU trade mark has been put to use which would be considered to be genuine use under the laws of that Member State;

Guidelines **obsolet**

- 1 Introduction
- + Editor's note and general introduction
- + Part A General rules
- + Part B Examination
- + Part C Opposition
- + Part D Cancellation
- x **Part E Register operations**
 - + Section 1 Changes in a registration
 - x **Section 2 Conversion**
 - 1 Introduction
 - + 2 Conversion of EUTMs and IRs Designating the EU
 - 3 Valid EUTM Application as a Condition for Conversion
 - x **4 Grounds Precluding Conversion**
 - **4.1 Revocation on the grounds of non-use**
 - 4.2 Ground for refusal limited to a Member State or exter
 - 4.3 Withdrawal/surrender after a decision has been renc
 - 4.4 Competence to decide on grounds precluding conve
 - + 5 Formal Requirements for the Request for Conversion
 - + 6 Examination by the Office
 - 7 Effects of Conversion
 - + Section 3 EUTMs and RCDs as objects of property
 - + Section 4 Renewal
 - + Section 5 Inspection of files
 - + Section 6 Other entries in the register
- + Part M International marks

Trade mark guidelines

[2](#) > [4 Grounds Precluding Conversion](#)

Show modifications



4.1 Revocation on the grounds of non-use

[Article 139\(2\)\(a\) EUTMR](#)

The first reason for precluding conversion is when the rights of the EUTM proprietor or IR holder have been revoked on the grounds of non-use.

Conversion will not take place where the rights of the EUTM proprietor or of the IR holder have been revoked on the grounds of non-use, unless the EUTM or IR has been put to use that would be considered genuine use under the laws of the Member State for which conversion is requested.

No subsequent allegations by the applicant for conversion regarding the substance of the case will be allowed. For instance, if the EUTM was revoked for non-use, the applicant for conversion cannot plead before the Office that it is able to prove use in a particular Member State.

This is because the Office is not in a position to assess use of an EUTM based on the laws of the individual EU Member States.

However, [Article 139\(2\)\(a\) EUTMR](#) may apply when the owner of the revoked EUTM submits, together with a request for conversion, evidence from an official source, such as a national judgment, establishing genuine use of the mark pursuant to the laws of the Member State for which conversion is requested. However, conversion is allowed only if the following requirements are met:

- the representation of the trade mark in the evidence (e.g. national judgment) and the registered EUTM must be identical;
- the goods and services for which use was found at national level must be covered by the revoked EUTM (see also [paragraph 6.2.7](#) below);
- the relevant period of use in the revocation proceedings before the Office and the period for which use was established in the evidence (e.g. national judgment) must coincide or at least overlap to a certain extent.

Parent topic: [4 Grounds Precluding Conversion](#)

Part B, EXAMINATION, Section 3 CLASSIFICATION - Chapter 5.2, Objections

New title: *Incorrectly classified terms and objections*

Obviously incorrectly classified terms

- Office **may reclassify** to proper class **without** issuing an objection if:
 - goods or services **obviously** belong to a different class **AND**
 - the application **already covers** the correct class



The applicant **may submit observations**

- In **other** cases: **no change**
 - objection will be raised

**PART B, EXAMINATION, Section 4, ABSOLUTE GROUNDS FOR REFUSAL, Chapter 14,
ACQUIRED DISTINCTIVENESS THROUGH USE (Article 7(3)EUTMR) - 6. Territorial aspects**

To support a claim for acquired distinctiveness in EU:

it might **NOT** be necessary to have **PHYSICAL STORES IN ALL** the relevant **MEMBER STATES** if consumers awareness by other means, for example:

- **ONLINE PRESENCE** and **ONLINE ADVERTISING** on the **INTERNET** and/or **SOCIAL MEDIA**
- **SHOPS** located in **POPULAR TOURIST AREAS** or **AIRPORTS**



19/10/2022, T- 275/21, Louis Vuitton Malletier v EUIPO - Wisniewski

(Représentation d'un motif à damier II)

**PART C, OPPOSITION, Section 2, DOUBLE IDENTITY and LIKELIHOOD OF CONFUSION-
Chapter 2, Article 8(1)EUTMR - 2.3 Article 8(1)(a) and (b) EUTMR: Two distinct sets of conditions**

It explains the **change of practice** (*introduced as of 31.5.2023*) following the General Court judgment rendered in



T- 349/22, 01.02.2023, HACKER/HACKER SPACE

[Old practice: different specific conditions, but if **Art. 8(1)(a)EUTMR was the **only ground** invoked and there was **no identity** ➡ **ASSESSMENT** under **Art. 8(1)(b)EUTMR**]**

Article 8(1) EUTMR

Article 8(1) EUTMR refers to **TWO DISTINCT** sets of conditions:



Article 8(1)(a)EUTMR
does **NOT** include
Article 8(1)(b)EUTMR

Article 8(1)(b)EUTMR
INCLUDES
Article 8(1)(a)EUTMR

from the **NOTICE OF OPPOSITION**

(including documents *within the 3-month OPPO period*):

- Art. 8(1)(a)EUTMR - the only ground: **NO ASSESSMENT** under Art. 8(1)(b)EUTMR
- Art. 8(1)(b)EUTMR - the only ground: **ALSO ASSESSMENT** under Art. 8(1)(a)EUTMR

New Common Communications on Common Practices: LINKS

- **PART B, EXAMINATION, Section 4, ABSOLUTE GROUNDS FOR REFUSAL, Chapter 7, Trade marks contrary to public policy or acceptable principles of morality (Article 7(1)(f) EUTMR): Common Communication on Common Practice in relation to TRADE MARKS CONTRARY TO PUBLIC POLICY OR ACCEPTED PRINCIPLES OF MORALITY (CP14)**
- **PART D, CANCELLATION, Section 2, SUBSTANTIVE PROVISIONS, Chapter 3, Absolute grounds for invalidity, 3.3 Bad faith (Article 59(1)(b) EUTMR): Common Communication on Common Practice TRADE MARK APPLICATIONS MADE IN BAD FAITH (CP13)**



<https://www.tmdn.org/#/practices>

GIs for craft and industrial products



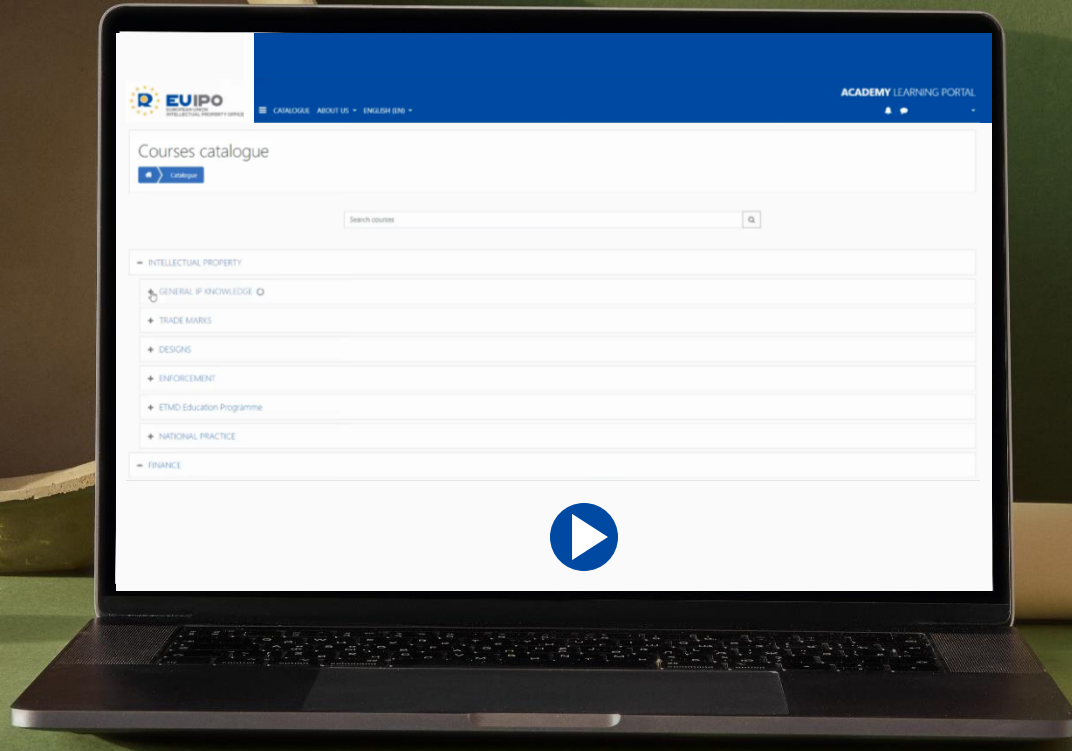
NEW Regulation (EU) 2023/2411

1 December 2025

Full implementation in future editions!



Keep in touch with the EUIPO Academy





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THANK YOU