The 2023 EUIPO Guidelines

The latest edition of the Guidelines entered into force on 31 March 2023. It was approved by the Executive Director of the Office on 24 March 2023 by means of Decision No **EX-23-2**.

A summary of the main items that have changed is set out below.

TRADE MARK PRACTICE

Part A, General rules

Section 1 Means of communication, time limits

3.1.4 Data Carriers

The Guidelines incorporate Decision No EX-22-7 of 29 November 2022. This decision updates the rules for annexes sent to the Office **on data carriers**. It aligns the rules with those relating to eCommunication (the User Area).

Decision No EX-22-7 applies to **data carriers** sent together with written submissions. It does not apply to submissions via the User Area. Users are strongly encouraged to file submissions through the User Area since it is the safest and fastest means of communication. In particular, the User Area automatically detects whether a file format is acceptable or not.

The Guidelines highlight that the Office does not accept (i) compressed file formats and (ii) fillable PDF forms and PDF files that include added objects or added text, highlighted text or arrows. It is possible to convert a fillable PDF into a static PDF file by using a PDF converter (a built-in feature of some print programs).

The Guidelines also make it clear that if the type of data carrier is not acceptable or if the annexes on the data carrier do not meet the technical specifications, the Office will deem the evidence **not to have been filed and will not invite the party to overcome** the deficiency (Article 6(a) Decision No EX-22-7).

This approach strikes a balance between the interests of various users, in particular in *inter partes* proceedings, and mitigates the risk of users abusing the system by deliberately filing formally defective evidence to obtain extra time. Thus, it safeguards against proceedings being delayed unnecessarily.

If a party misses a deadline due to non-compliance with ED Decision No EX-22-7, the usual remedies such as continuation of proceedings may apply.

4.2 Expiry of time limits

The Guidelines clarify that an 'actual interruption of the Office's connection to admitted electronic means' that would give rise to extending time limits under Article 101(3) EUTMR and Article 58 CDIR requires that the Office's electronic communication (including all back-up options) be

disrupted for at least 6 consecutive hours during the same working day. For shorter interruptions, the Office will not extend the time limits under those provisions.

Section 2 General principles to be respected in the proceedings

1 Adequate reasoning

The definition of 'well-known facts' has been reviewed following an analysis of the case-law. Well-known facts are now defined as 'those that are likely to be known by anyone or that may be learnt from generally accessible sources'.

Section 6 Revocation of decisions, cancellation of entries in the register and correction of errors

This section has been entirely restructured. It sets out the various proceedings for remedying errors: in decisions of the Office, in the EUTM Register or in the EUTM Bulletin. It clarifies the differences between these proceedings'

- **Revocation**

  Article 103 EUTMR provides for the cancellation of entries in the Register and revocation of decisions containing obvious errors attributable to the Office. It applies to those errors that (i) undermine the operative part of the decision or entry in the Register; **and** (ii) require a new substantive assessment or analysis of the issues.

- **Correction**

  Article 102 EUTMR allows corrections to decisions and entries in the Register for registered EUTMs. It applies to obvious errors that do not require a new substantive assessment or analysis of the issues. Article 44(3) EUTMR applies the same principle to corrections of errors in EUTM applications (not registrations).

Revocation under Article 103 EUTMR annuls a decision and replaces it with a new appealable decision whereas correction of errors under Article 102(1) EUTMR does not affect the validity of a decision and so does not open a new appeal period.

This section contains two changes of practice:

- revocation under Article 103 EUTMR applies to both procedural errors **and** errors in the substantive analysis;
- if a decision is corrected under Article 102 EUTMR, the corrigendum is published in the Office's eSearch case-law database.

The most frequent situations when the Office revokes a decision, cancels an entry in the Register or corrects an error have been added as examples.

Section 7 Revision

This section has been entirely restructured. It clarifies the:

- competences of the department that took the first instance decision;
- competences of the Boards of Appeal;
- deadlines for revision;
- different procedural steps;
- content of both the revision decision on rectification and the new substantive decision.

It explains that when the department that took the first instance decision concludes that the conditions for rectifying the appealed decision are met, that department must take a decision repealing the appealed decision in its entirety ('decision on rectification') within 1 month of the Board of Appeal submitting the statement of grounds of the appeal to the first instance. That department will take a new decision on the merits either together with the decision on rectification or at a later stage, and the Board of Appeal will decide on the closure of the appeal.

Section 8 *Restitutio in integrum*

Following recent case-law, new examples of where the 'all due care' requirement has been fulfilled have been added (2.1).

This section now clarifies the differences between the EUTM and RCD language regimes regarding submission of evidence (3.8)

There is also new information on requests for *restitutio in integrum* that seek a reinstatement after a missed renewal deadline (3.13).

Part B Examination

Section 2 Formalities

4.1.4 Representation of the mark

The EUTMR does not allow for series/serial marks but sometimes applicants file a representation that contains various versions of the same figurative sign. When this happens, the Office will no longer consider that the sign applied for consists of the combination of all the versions of the sign. Instead, the Office will issue a filing date deficiency on the basis that the representation is not clear and precise. It will invite the applicant to submit a new representation showing a single mark and a filing date will be granted on the date the applicant files the new acceptable representation.

9.1.2 Dotted lines

A new paragraph clarifies the practice regarding ‘dotted lines’ in the representation of a mark.

There are three possible functions of ‘dotted lines’ in the representation:

i. stylistic/decorative elements;
ii. visual disclaimers of elements that do not form part of the sign (for example in position marks and shape marks);
iii. visual disclaimers of elements that *per se* do not form part of the subject matter of the trade mark but contribute to the overall impression of the mark by illustrating the particular manner in which variable elements interact with predetermined elements (e.g. placeholders).

The function of the ‘dotted lines’ can be clarified in the description, if a description is allowed for the mark type applied for. If not, various presumptions set out in the Guidelines are applicable. Examples have been added to illustrate this practice.

Section 3 Classification

5.4 Addition of classes

Examples have been clarified to better illustrate scenarios when an addition (transfer of an original term to a class which was not originally in the application) is acceptable and when it is unacceptable because it broadens the original scope of protection. These examples are followed by explanations highlighting the relevance of the class when defining the scope of protection originally applied for.

6 Annex

This Annex now further explains the Office’s practice on classification of brokerage services (6.12) and of the goods and services related to electricity and energy (6.26). The section on kits and sets (6.41) has been fully restructured and includes further guidance on how to classify kits or sets depending on their description, in particular, how to classify unspecified kits and sets. A new section has been added for reservations and booking services (6.59).

Subsection 6.25 is now called ‘Downloadable goods and virtual goods’. This reflects the new content of the section, which now includes the Office’s approach to classification of non-fungible tokens (NFTs), virtual goods and virtual services. It particularly states that:

- the term ‘virtual goods’ per se lack clarity and precision and must be further specified; when specified, such virtual goods are classifiable in Class 9;

- the term ‘non-fungible tokens (NFTs)’ as such is not acceptable and must further specify the item to which they relate; on the other hand, ‘minting of NFTs’ in Class 42 is acceptable given the nature of that service;

- services provided online or in virtual environments will be classified according to the underlying nature of the service, considering its impact on the real world; examples have been provided to illustrate the principle.

Section 4 Absolute grounds for refusal

Chapter 1 General principles

4 European criteria

This section now includes information on relevant languages and territories in absolute grounds examination.

The Guidelines explain the absolute grounds examination approach according to the status and understanding of different languages, and clarify when the Office indicates the relevant territories in its objection.

The link between languages and territories has been clarified. For English, the Guidelines explain that:

i. basic terms will be understood throughout the whole European Union;
ii. English is widely understood in some Member States;
iii. professionals in certain sectors will understand particular English terms.

Chapter 8 Deceptive trade marks (Article 7(1)(g) EUTMR)

The whole chapter has been restructured and updated in line with recent case-law and contains new examples to highlight the practice.

1 The deceptive character

The following general principles have been added.

- The EUTMR provides for the rejection of deceptive marks not only as an absolute ground for refusal during examination proceedings but also after registration. It allows third parties to apply for deceptive marks to be revoked or declared invalid.

- The essential role of the trade mark cannot be performed when the information it contains is of such a nature as to deceive the public.

- Actual deceit or a sufficiently serious risk that the consumer will be deceived needs to exist.

- Even though Article 7(1)(g) EUTMR might apply to some goods or services falling within a broader category, this does not mean that an objection should be raised for that broad category. The Office will assume good faith on the part of the applicant as long as non-deceptive use of the EUTM is possible for other goods and services within the broader category.

- The average consumer is reasonably attentive and not particularly vulnerable to deception.

2 The test for deceptiveness

This new subsection explains the two cumulative criteria that must be met.

- The relevant public must recognise the sign as conveying a specific, clear and unambiguous message about the nature, quality or geographical origin (or other characteristic) of the goods and services. The message must be worded in such a way that non-deceptive use is impossible.

- The relevant public would rely on that message and purchase goods or services in the mistaken belief that they possess a certain characteristic which they cannot have (i.e. there is actual deceit or a sufficiently serious risk of being deceived).

Examples of deceptive and non-deceptive marks have been included to illustrate practice.

3 Categories of deceptiveness

This new subsection includes some specific categories of deceptiveness that frequently apply (quality and nature of the goods, geographical origin of the goods and official approval/endorsement), albeit these categories are not exhaustive.

4 Relation with other EUTMR provisions

This subsection has been amended to stress that the test for deceptiveness is considered *prima facie* to be the same in examination and post-registration actions, namely, revocation and invalidity based on absolute grounds.

Chapter 10 Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR)
Chapter 11 Trade marks in conflict with traditional terms for wines (Article 7(1)(k) EUTMR)v
Chapter 12 Trade marks in conflict with traditional specialities guaranteed (Article 7(1)(l) EUTMR)

Regulation (EU) 2021/2117 amended the four EU Regulations on agricultural geographical indications (GIs) (Regulation Nos (EU) 1151/2012, (EU) 1308/2013, (EU) 251/2014 and (EU) 2019/787) and entered into force on 7 December 2021. The changes following the amendment have been implemented **in both the chapters on GIs and traditional speciality guaranteed** (TSGs) and refer, in particular, to:

- references to Regulation No 251/2014 and to *aromatised wines*, which have been deleted as they are now categorised as a foodstuff product under Regulation No 1151/2012;

- the wording of provisions establishing the definition and protection of GIs and TSGs under Regulations No 1151/2012 and No 1308/2013.

In all the chapters on GIs TSGs and traditional terms for wine (TTWs), hyperlinks have been added to each GI name linking it to its respective entry in the GIview database.

The findings of the ECJ in the Champanillo *case*, C-739/19, were introduced as follows.

4.1 Use of a GI (direct or indirect use)

This subsection emphasises that the concept of use must be interpreted strictly so the concept of 'evocation' is not deprived of its usefulness, which would be contrary to the intention of the EU legislator.

4.1.1 Exploitation of the reputation of GIs

This subsection now stresses that GIs are considered to be inherently reputed because they offer a guarantee of quality due to their geographical provenance **by the mere fact of being registered**.

It also clarifies that the scope of *ex officio* assessment must be read in line with the mandate contained in the relevant provisions on the relationship of the different GI regulations with trade marks, which limit the refusal of trade marks to the grapevine products listed in Annex VII, Part II of the Regulation (EU) No 1308/2013 and to products of the same type. Therefore, the protection of GIs under all EU regulations in the context of AG for refusal examination cannot extend to all possible products.

4.2.2 Imitation/evocation

This subsection explains that the concept of 'evocation' does not require, as a prerequisite, that the product covered by the GI and the goods or services covered by the contested sign be identical or similar. What has to be found, through a global assessment of all the factors relevant to the case, is that the relevant public establishes **a sufficiently clear and strong link between the contested sign and the GI**.

An additional factor was introduced as part of the test to assess the link between the contested sign and the GI. This factor is the 'reputation of the protected name beyond the inherent reputation, and the exploitation thereof'. The concept of 'evocation' establishes a wide-ranging protection that is intended to extend to all uses which take unfair advantage of the reputation enjoyed by the GI through association with it.

Some structural changes have been made to the text to enhance its clarity.

6.3 Relationship with other EUTMR provisions

More prominence has been given to the potential applicability of Article 58(1)(c) EUTMR when a registered trade mark **is used on the market** for goods which are not the products for which the limitation was indicated in the list of goods and/or services and which are not the genuine GI, TTW or TSG product.

Chapter 14 Acquired distinctiveness through use (Article 7(3) EUTMR)

6.2 Language area

In accordance with the changes implemented under Chapter 1 General principles - 4. European criteria (see above), this part on acquired distinctiveness has been updated. It clarifies the situation where the Office considers that an objection covers:

a) more Member States than set out in the objection letter; or
b) Member States where a language that is the basis of the objection is not an official language.

In these cases, the Office will inform the applicant before refusing an application for lack of evidence in relation to a) or b) and give the applicant a time limit to submit evidence.

Part C Opposition

Section 1 Opposition proceedings

2.4.2.2 Representation of earlier marks

The update clarifies that a representation that includes (i) the colours, either in words in the language of the proceedings or by generally recognised colour codes (such as Pantone, Hex, RAL, RGB or CMYK) and (ii) their distribution within the mark (e.g. by using arrows that clearly indicate to which element of the mark the specific colour applies) is considered a 'colour representation'.

5.1.2 Earlier mark registered for not less than 5 years (mark outside the 'grace period')

In opposition proceedings, following recent judgments of the General Court (23/11/2022, T-515/21, Euphytos / EuPhidra, EU:T:2022:722 and 01/03/2023, T-102/22, GOURMET, EU:T:2023:100), changes were implemented regarding the identification of the applicable provision for calculating the period for proof of genuine use of the earlier mark (the same changes were also introduced in Part C, Section 7, Proof of use, Subsection 4 Time of use).

5.1.4. Request made in a separate document

To comply with a more systematic approach, reference to *separate document requirement* in the context of proof of use was moved from paragraph 4.4.1 to this paragraph, which has been developed to specifically explain the practice on the request for proof of use. In addition, the main principles established in the Grand Board decision R 2142/2018-G, DIESEL SPORT have been implemented.

Section 2 Double identity and likelihood of confusion

Chapter 2 Comparison of goods and services

1.2.3 Conclusions to be drawn from the structure of the Nice Classification

This section was modified in light of the findings of the Juvederm case (06/10/2021, T-397/20, Juvederm, EU:T:2021:653, § x). It clarifies that while the Nice Classification was adopted for exclusively administrative purposes, the explanatory notes on the different classes are relevant in determining the nature and purposes of the goods and services involved. In particular, where the description of the goods and services in question is so general that it may cover various goods and services, the class chosen by the applicant at the time of filing can be taken into account for the purposes of interpretation or as a precise indication of the designation of the goods or services. On the contrary, where the specification clearly designates specific goods or services, the wording of the specification is decisive when determining the scope of protection.

2.1 General principles

Clarifications have been added to explain that the notion of a 'broad category of goods and services' (i.e. one that the Office cannot dissect *ex officio*) may encompass several terms and is not limited to single terms.

2.5 Practice on the use of general indications of the class headings

This section has been modified after the revision of the Common Communication on the Interpretation of scope of protection of Nice Class headings (CP2) (formerly, Implementation of 'IP Translator'). The text now reflects the updated information on the interpretation of the scope of protection of trade marks registered for entire Nice class headings by various IP offices, depending on whether the trade marks were filed before or after the IP Translator judgment, C-307/10, as well as after the legislative reform of the EUTMR and the Trade Mark Directive.

5.4.3 Non-alcoholic beverages (Class 32) versus Alcoholic beverages (except beers) (Class 33)

This section has been updated to reflect the findings of the Grand Board of Appeal in the Zoraya / Viña zoraya case, R 964/2020-G.

5.4.4 Provision of food and drinks versus food and drinks

Following the trend in the Court's case-law, the Office accepted that a low degree of similarity can generally be found between foodstuffs and drinks, on the one hand, and services for providing food and drinks, on the other. However, the section clarifies, that, in principle, such similarity is unlikely when the provision of food and drinks is compared to basic cooking ingredients that are not eaten by themselves.

Section 6 Geographical indications (Article 8(6) EUTMR)

2.4 Specifics of substantiation

This paragraph has been moved to clarify that the substantiation details in this section refer to EU GIs, GIs protected under the laws of Member States and under international agreements.

3.1 Situations covered by the EU Regulations

Changes in this section emphasise the legal basis for assessing non-comparable goods and services under Article 8(6) EUTMR.

3.1.2 Evocation, imitation, misuse and misleading indications and practices

This section takes into account the findings of the Champanillo case (09/09/2021, C-739/19, Champanillo, EU:C:2021:713) and states that:

- evocation applies to both goods and services and it does not require similarity or identity of goods covered by the GI and contested goods or services;

- the extent of the GI's reputation, especially if it goes beyond the inherent reputation and its potential exploitation, is to be taken into account in the global assessment of evocation.

As in previous chapters of Part B, Examination, changes arising from Regulation (EU) 2021/2117 have been implemented throughout this entire section and hyperlinks have been included with each GI name mentioned linking it to its respective entry in the GIview database.

Section 7 Proof of use

6.3.2 Relevance of the Classification

This paragraph now clarifies the role played by the Nice Classification when assessing whether the proven use for certain goods/services can be considered genuine use for the registered goods/services. It also now contains reference to recent case-law supporting the main principles to be considered in this assessment.

Part D Cancellation

Section 1 Cancellation Proceedings

2.5.1.3 *Res judicata* (Article 63(3) EUTMR)

This part has been restructured (*res judicata* is now entirely under Cancellation proceedings, since it is directly linked to the admissibility of the action) and revamped (e.g. more in-depth explanations regarding the requirements and new examples from recent case-law).

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)

The new text implements the principles set out in the Palladium judgment (15/09/2021, T-207/20, PALLADIUM HOTELS & RESORTS (fig.) / Grand hotel palladium, EU:T:2021:587). That judgment interpreted Article 60(4) EUTMR for the first time. This section explains that any subsequent application filed by the proprietor of an earlier right referred to in Article 60(1) or (2) EUTMR or by its successor in title based on **other earlier rights that could have been claimed in the first proceedings but were not** will be rejected as inadmissible.

On the contrary, Article 60(4) EUTMR cannot be applied when the new application for invalidity is based on the **same earlier right that was invoked in the course of a previous action which was not adjudicated on the merits**. Otherwise, there would be an overlap between the application of Article 60(4) EUTMR and of Article 63(3) EUTMR (*res judicata*) depriving Article 63(3) EUTMR of any useful effect.

Section 2 Substantive provisions

2.2.1 Burden of proof

This new paragraph refers to recent relevant case-law which confirms that the revocation applicant is not required to support its application for revocation based on non-use with substantiated submissions.

4.4 Non-use of the earlier mark

In the area of invalidity proceedings, following recent judgments of the General Court (23/11/2022, T-515/21, Euphytos / EuPhidra, EU:T:2022:722 and 01/03/2023, T-102/22, GOURMET, EU:T:2023:100) , changes were implemented regarding the identification of the applicable provision for calculating the period for proof of genuine use of the earlier mark.

Part E Register operations

Section 2 Conversion

5.1.2 Start of time limit in other cases

This part now contains a clarification on subsidiary claims of acquired distinctiveness under Article 7(3) EUTMR and Article 2(2) EUTMIR. It explains that the deadline for requesting conversion does not start to run until a decision on the subsidiary claim of acquired distinctiveness becomes final.

Section 3 EUTMs and RCDs as objects of property

Chapter 1 Transfer

4.4.4 Proceedings affecting the transfer

Following the judgement in the Marina yachting case (22/09/2021, T-169/20, Marina yachting, EU:T:2021:609), a new paragraph on proceedings affecting the transfer has been introduced. It clarifies that the examination of the formal requirements for registering a transfer must take into account facts that may have implications for the legality of that registration, including the existence of insolvency proceedings at national level.

Part M International marks

2 The EUIPO as Office of Origin

This section has been updated to reflect that, as of 1 February 2023, WIPO accepts digital representations of the basic mark in international registrations. This has an impact on users who might now use an EUTM filed electronically as a basic mark in an international application. Applicants are advised to consider whether the contracting parties that they wish to designate accept the corresponding type of file. There is now a link to where applicants can find this relevant information (WIPO IP portal).

This change is also reflected in Part B Examination, Section 2 Formalities, Subsection 9.3 Mark type where, depending on the mark type, applicants were previously warned that electronic files were not considered acceptable mark representations under the Madrid System.

DESIGN PRACTICE

Examination of applications for registered Community designs

2.7.2.1 Priority claims and supporting documents

This part now explains the fast-track change of practice implemented in 2022 whereby the Office now allows WIPO DAS to be cited for supporting documents, even **after** filing.

5.3.5 Sectional views

The consequence of not submitting an aspect view and only a sectional view is explained. The Office will raise a deficiency and the filing date will only be retained if the aspect view submitted to remedy the deficiency contains no new features.

5.3.9 Typographic typefaces

This now clarifies that the requirements for typographic typefaces may be submitted in separate views.

6.1.1 Identification of the applicant and its representative

The contents of this topic have been deleted and instead there is a cross-reference to the Guidelines Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 3, Identification of parties to the proceedings.

6.2.1.1 Priority

This part now explains the fast-track change of practice implemented in 2022 whereby the Office now allows WIPO DAS to be cited for supporting documents, even **after** filing. It also clarifies that priority can be claimed from design patents as well.

6.2.1.2 Exhibition priority

The list of potential deficiencies has been deleted as these are already identified in the requirements of the previous paragraphs. There is a cross-reference to paragraph 6.2.1.1. Priority, for the examination process.

8.1 General principles

A paragraph has been 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

This paragraph now provides requirements for adding citations or waivers of a designer or team of designers from the Register.

12.3.3 Grounds for non-registrability

This paragraph now clarifies that the 2-month deadline for a holder to renounce its designation of the EU starts from the date on which the Office notifies WIPO of the provisional refusal.

Examination of design invalidity applications

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

These topics have been completely revised to clarify when it is necessary to reopen admissibility proceedings. The following change of practice is introduced when novelty and/or individual

character are claimed as grounds for invalidity: the admissibility examination will ensure that the scope of the application is clear and the Office will invite the applicant to clarify whether both grounds are invoked, and which prior designs are relevant for each of the grounds.

5.5 Technical function

This topic has been updated in its entirety to provide additional guidance in light of the case-law. This section refers to technical function in the context of Article 8(1) CDR. It sets out the principles:

- the three-step analysis carried out by the Office,
- the burden of proof of functionality
- the type of evidence that can be submitted.

The section ends by explaining the different defences open to the holder.

5.7.2 Assessment of novelty and individual character

The **point of reference for the comparison** has been complemented with further explanations on when the contested design contains more or fewer features than the earlier design.

Under **features dictated by a technical function and features of interconnection** it is explained that when features serve a functional purpose without the design being solely dictated by technical function, Article 8(1) CDR does not apply. Instead any limitation to the designer's freedom will be weighed up in the global assessment of the overall impression.

5.7.2.2 Individual character

This paragraph now explains how to define **the products at issue** and that the **informed user** is to be defined in relation to that product. It is explained that the **degree of freedom of the designer** may be restricted where features serve a purely functional purpose and how this degree of freedom is weighed in the assessment of **the overall impression**.

5.8 Conflict with a prior design right

This paragraph now clarifies when the Office will request evidence of continued validity of the earlier registered design on which an invalidity action is based, and when it is up to the holder to submit evidence that a prior design is no longer valid.