GUIDELINES FOR EXAMINATION

EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)

EDITOR’S NOTE AND GENERAL INTRODUCTION
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1 **Objective of the Guidelines**

The purpose of the Guidelines on EUTMs and the Guidelines on RCDs is to improve the coherence, predictability and quality of the Office’s decisions. The Guidelines are designed to bring together, systematically, the principles of practice derived from the jurisprudence of the European Court of Justice, the Case-Law of the Office’s Boards of Appeal, the decisions of the Office’s Operations Department and the outcome of the Office’s Convergence Programmes with EU IP offices. They provide a unique source of reference on Office practice with regard to EUTMs and RCDs and 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.

The Guidelines have been drawn up to reflect Office practice in the most frequent scenarios. They contain only general instructions, which have to be adapted to the particularities of a case. They are not legislative texts and, therefore, are not of a binding nature. Both the parties involved and the Office must, where necessary, refer to the EUMR, the CDR, and their respective Implementing Regulations, Commission Regulation (EC) No 216/96 of 05/02/1996 laying down the rules of procedure of the Boards of Appeal and, finally, the interpretation of these texts handed down by the Boards of Appeal and the Court of Justice of the European Union, including the General Court of the European Union.

As Case-Law is evolving constantly, the Guidelines will also evolve. They will be adapted to reflect developments in Office practice on a yearly basis by means of an ongoing revision exercise (see point 3 below).

2 **Guidelines Revision Process**

As the sole source of reference on Office practice with regard to EUTMs and RCDs, the current Guidelines are available in the five Office languages. Additionally, the Office will translate the Guidelines into the remaining official EU languages on a regular basis. They are revised by the cross-departmental Knowledge Circles of the Office in a cyclical and open process: ‘cyclical’ because practice is updated on a yearly basis by looking at the case-law of the preceding year and taking into account operational needs and the outcome of convergence initiatives, and ‘open’ because external stakeholders are involved in defining that practice.

The involvement of national offices and user associations not only benefits the quality of the Guidelines, but is also expected to facilitate convergence, that is, the process of exploring common ground on issues where there are diverging practices. Making the Guidelines available in all EU languages will raise awareness of Office practice amongst Member States and users and make differences in practice easier to identify.

The yearly work is split into two ‘work packages’: Work Package 1 (WP1) runs over a twelve-month period each year from January to December, and Work Package 2 (WP2) over a twelve-month period each year from July to June.

The process involves the following phases:

a. Initiation of update by stakeholders
Having been made aware of the Office’s revision plans, in particular what is to be revised and when, the national offices and user associations are welcome to submit comments before January (for WP1) and before July (for WP2). Comments not received on time will be taken into consideration during the next cycle or may be submitted during phase c.

b. Preparation of the draft Guidelines by the Office

During this phase, the draft Guidelines are produced by the Office’s Knowledge Circles. The process starts each year in January (for WP1) and July (for WP2). Feedback and comments submitted in advance from users are taken into consideration. The three steps of the process – analysis, drafting and discussion – must be completed in a timely manner. Analysis involves the Knowledge Circles extracting trends from the preceding year’s case-law, studying the conclusions of the convergence projects and taking into consideration the comments received from the Office’s users and internal stakeholders. As the next step, the Knowledge Circles draft the guidelines. Finally, the texts are discussed amongst the various units and departments of the Office.

c. Adoption of the Guidelines

In the last phase, the draft Guidelines are sent for translation into the Office languages. The texts and translations are circulated amongst the user associations and the EU IP offices with a view to receiving feedback before the next meeting of the Office’s Management Board (MB). After consulting the MB in accordance with Article 124(l) EUTMR and Article 101(b) CDR, the Executive Director adopts the updated Guidelines. The versions in the five Office languages together make up the official text, which is intended to be published in January (WP1) and July (WP2) of each year, respectively. In the event of discrepancies between different language versions, the text in the drafting language (English) will prevail. On a regular basis, the Guidelines will be translated into the remaining official languages of the European Union as a matter of courtesy and for transparency. These additional translations will be published on the Office’s website, and external stakeholders, whether national offices or user associations, will be free to submit feedback on their quality; any linguistic amendments made as a result of this informal feedback will be incorporated into the texts without any formal procedure.

d. Fast-track procedure

Where a major event has an immediate impact on Office practice (for example, certain judgments of the Court of Justice), the Office can amend the Guidelines in a fast-track procedure outside the normal time frame set out above. However, this procedure is the exception to the norm. As the process is cyclical, such changes will always be open to comments and revision in the following cycle.

3 Structure of the Guidelines

The items dealt with in WP1 and WP2, respectively, are set out below. In exceptional circumstances, certain elements of practice might be changed from one WP to another. Should such a change occur, it will be communicated to stakeholders.
Part A: General Rules

Section 1, Means of communication, time limits
Section 2, General principles to be respected in proceedings
Section 4, Language of proceedings
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

Section 1, Proceedings
Section 3, Classification
Section 4, Absolute Grounds for Refusal

Chapter 1, General principles
Chapter 8, Deceptive trade marks (Article 7(1)(g) EUTMR)
Chapter 10, Trade marks in conflict with designations of origin and geographical indications (Article 7(1)(j) EUTMR)
Chapter 11, Trade marks in conflict with traditional terms for wines (Article 7(1)(k) EUTMR)
Chapter 12, Trade marks in conflict with traditional specialities guaranteed (Article 7(1)(l) EUTMR)
Chapter 13, Trade marks in conflict with earlier plant variety denominations (Article 7(1)(m) EUTMR)
Chapter 15, European Union Collective marks
Chapter 16, European Union Certification marks

Chapter 2, EUTM definition (Article 7(1)(a) EUTMR)
Chapter 3, Non-Distinctive trade marks (Article 7(1)(b) EUTMR)
Chapter 4, Descriptive trade marks (Article 7(1)(c) EUTMR)
Chapter 5, Customary signs or indications (Article 7(1)(d) EUTMR)
Chapter 6, Shapes or other characteristics with an essentially technical function, substantial value or resulting from the nature of the goods (Article 7(1)(e) EUTMR)
Chapter 7, Trade marks contrary to public policy and acceptable principles of morality (Article 7(1)(f) EUTMR)
Chapter 9, Trade marks in conflict with flags and other symbols (Article 7(1)(h) and (i) EUTMR)
Chapter 14, Acquired distinctiveness through use (Article 7(3) EUTMR)

Part C: Opposition

Section 0, Introduction
Section 1, Procedural Matters
Section 2, Double identity and Likelihood of confusion

Chapter 1, General Principles
Chapter 2, Comparison of Goods and Services
Chapter 3, Relevant public and degree of attention
Chapter 4, Comparison of signs
Chapter 5, Distinctiveness of the earlier mark
Chapter 3, Unauthorised filing by agents of the TM proprietor (Article 8(3) EU TMR)
Chapter 4, Rights under Article 8(4) EU TMR
Chapter 5, Trade marks with reputation Article 8 (5) EU TMR
Editor's Note and General Introduction

Chapter 6, Other factors
Chapter 7, Global assessment

Section 6, Proof of Use

Part D: Cancellation
Section 1, Cancellation proceedings

Section 2, Substantive provisions

Part E: Register Operations
Section 2, Conversion
Section 4, Renewal
Section 5, Inspection of files
Section 6, Other entries in the Register

Chapter 1, Counterclaims

Part M: International marks

REGISTERED COMMUNITY DESIGN

WP1
Examination of Design Invalidity Applications

WP2
Examination of Applications for Registered Community Designs

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1 Subject Matter

OHIM's practices are reflected in the Guidelines on Trade Mark Practice and the Guidelines on Designs practice.

They are revised by the cross-departmental Knowledge Circles of the Office in a cyclical and open process. The yearly work is normally split into two ‘work packages’: Work Package 1 (WP1) runs over a twelve-month period each year from January to December, and Work Package 2 (WP2) over a twelve-month period each year from July to June.

The process to update the existing Trade Mark Regulation (Council Regulation (EC) No 2017/2009 which sets out the rules applicable to EU trade marks and to the Office) is coming to an end.

The changes brought about by the Legislative Reform affect a number of areas of OHIM's practice. In consequence, the Guidelines have to be revised accordingly, so that their content is fully aligned with the new legislative framework.

The time of entry into force of the New Regulation and the important scope of the revision required, recommend following an ad hoc process since the ‘natural’ revision cycle of the Guidelines does not coincide with the date on which the new regulatory framework is foreseen to take effect. Such ad hoc process is independent of the standard Work Packages, which will run in parallel to cater for the normal updates in parts of the Guidelines that are not affected by the legislative changes.

As is done at the standard revision of the Guidelines, OHIM has decided to involve its stakeholders in the submission of comments to the draft Guidelines related to the Legislative Reform. The Guidelines affected by the LR will be published for comments. Following the consultation process, the updated Guidelines will be submitted to the Members of the OHIM Administrative Board for written consultation in order for the President to subsequently adopt them.

Once adopted, the Guidelines will enter into force simultaneously with the new Regulation. They will then be translated into the other official EU languages.

2 Structure of the Guidelines

The items dealt with the guidelines are set out below.

Editor’s note and general introduction

EUROPEAN UNION TRADE MARKS

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: 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
- Section 1: Proceedings
- Section 2: Formalities
- Section 3: Classification
- Section 4: Absolute grounds for refusal and European Union collective marks
  - Absolute grounds for refusal Article 7(1)(a) to 7(1)(e) EUTMR, Acquired distinctiveness
  - Absolute grounds for refusal Article 7(1)(f) to 7(1)(m) EUTMR, Collective marks

Part C: Opposition
- Section 0: Introduction
- Section 1: Procedural matters
- Section 2: Double identity and likelihood of confusion
  - Chapter 1: General principles
  - Chapter 2: Comparison of goods and services
  - Chapter 3: Relevant public and degree of attention
  - Chapter 4: Comparison of signs
  - Chapter 5: Distinctiveness of the earlier mark
  - Chapter 6: Other factors
  - Chapter 7: Global assessment
- Section 3: Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR)
- Section 4: Rights under Article 8(4) and 8(4a) EUTMR
- Section 5: Trade marks with reputation (Article 8(5) EUTMR)
- Section 6: Proof-of-use

Part D: Cancellation
- Section 1: Cancellation proceedings
- Section 2: Substantive provisions

Part E: Register Operations
- Section 1: Changes in a registration
- Section 2: Conversion
- Section 3: EUTMs as objects of property
  - Chapter 1: Transfer
  - Chapter 2: Licences
  - Chapter 3: Rights in rem
  - Chapter 4: Levy of execution
  - Chapter 5: Insolvency proceedings or similar proceedings
- Section 4: Renewal
- Section 5: Inspection of files
- Section 6: Other entries in the register
  - Chapter 1: Counterclaims

Part M: International marks

REGISTERED COMMUNITY DESIGNS

Examination of Applications for Registered Community Designs

Renewal of Registered Community Designs

Examination of Design-Invalidity Applications