



# Protection and Examination of Trade Marks in the EU.

## Recent trends

REBECCA SANTANA DAVIES |  
BARBADOS | 27.01.2020



CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

[www.caripi-hub.com](http://www.caripi-hub.com)

## The Characteristics of the EUTM

The **EUTM** is a **centralized** system that gives **unitary** protection **in all** of **the 28** Member States of the European Union.

The **EUTM** exists in parallel with the national and international trade mark protection in the EU.



## The Characteristics of the EUTM

The **EUTM** has the following characteristics:

- **one application in any of the official EU languages**
- **one set of fees in**
- **one currency (Euro)**
- **one set of procedures in one office**
- **on-line application possible at [www.euipo.europa.eu](http://www.euipo.europa.eu)**



## The Characteristics of the EUTM

An EUTM can only be filed directly with the Office (EUIPO)

- E-filing
- By post
- Or by a private delivery service
- Fax :no longer possible as of 01/01/2018 ( deemed not to have been received)

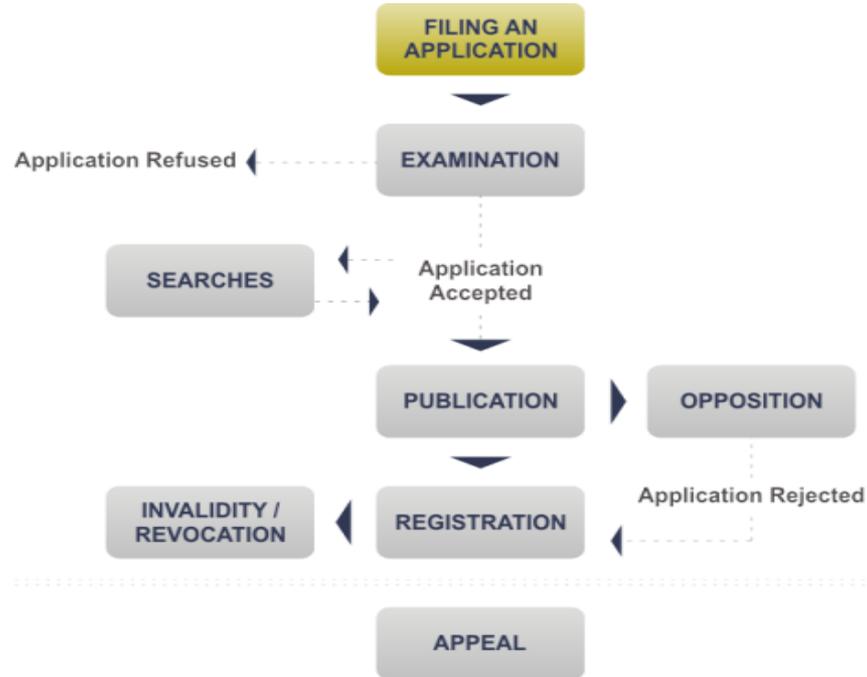
# EUTM Registration Procedure

## Procedure



# EUTM Registration Procedure

## APPLICATION



## EUROPEAN UNION TRADE MARK APPLICATION

A trade mark application must contain

- ✓ A **representation** of the mark
- ✓ A list of the **goods** and **services**
- ✓ Information identifying the **applicant**



# EUTM Registration Procedure

## EXAMINATION



- ✓ Formalities
- ✓ Classification
- ✓ What **CAN** be a TM?
- ✓ What **CANNOT** be a TM?

# EUTM Registration Procedure

## CLASSIFICATION GOODS AND SERVICES

**A description of goods/services must be sufficiently clear and precise.**

- Understood from natural and usual meaning

### **Identifying the market sector:**

- Consumers and/or sales channels
- Skills and know-how to be used/produced
- Technical capabilities to be used/produced



# EUTM Registration Procedure

## CONCEPT OF PRIORITY

- Date of priority counts as date of filing of the EUTMA
- Principles established in the Paris Convention
- Limited in time and triggered by the first filing
  - Priority may be claimed during following six months

## EUTM Registration Procedure

### CONCEPT OF PRIORITY: PREVIOUS RIGHTS

- Acceptable:
  - priority claim of a previous EUTM
  - priority claim of filing equivalent to national filing
- Unacceptable:
  - priority claim of a previous international registration

## EUTM Registration Procedure

### CONCEPT OF PRIORITY: REQUIREMENTS

- Marks must be identical
- Goods/services must be identical
- Same proprietor
- Priority claim is to be filed together with EUTM application
- Previous application must be a **first filing**

## FILING DATE

Once the EUTM application has been filed

- A provisional **filing date** is accorded
- A receipt is issued

The filing date becomes definitive when the **application fee** has been paid.

## WHAT CAN BE A TRADE MARK - KIND OF MARK

### At EUIPO you can register

- **Individual mark**

Distinguish the goods and services of **one particular undertaking** from those of another.

- **Collective mark**

Distinguish the goods and services of a **group of companies** or members of an association

- **Certification mark**

Distinguish goods and services which are **certified by the proprietor** from goods and services not certified



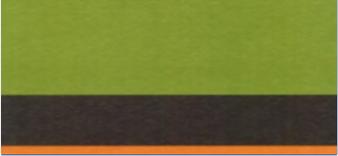
## The Characteristics of the EUTM

The basic fee for a EUTM using the on-line application on the EUIPO website is: **850 EURO.**

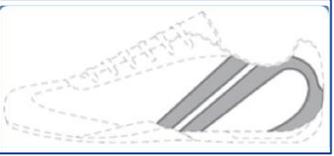
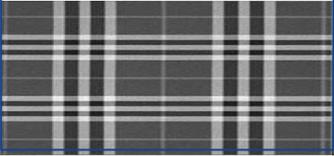
Trade Mark	Basic Fee (including one class)	Fee for a second class	Fee for each additional class
Individual mark	EUR 1 000	EUR 50	EUR 150
Individual mark filed electronically	EUR 850	EUR 50	EUR 150
Collective mark	EUR 1 800	EUR 50	EUR 150
Collective mark filed electronically	EUR 1 500	EUR 50	EUR 150
Certification mark	EUR 1 800	EUR 50	EUR 150
Certification mark filed electronically	EUR 1 500	EUR 50	EUR 150

The majority of the EUTM applications are registered within **6 months.**

## Trade Mark TYPES

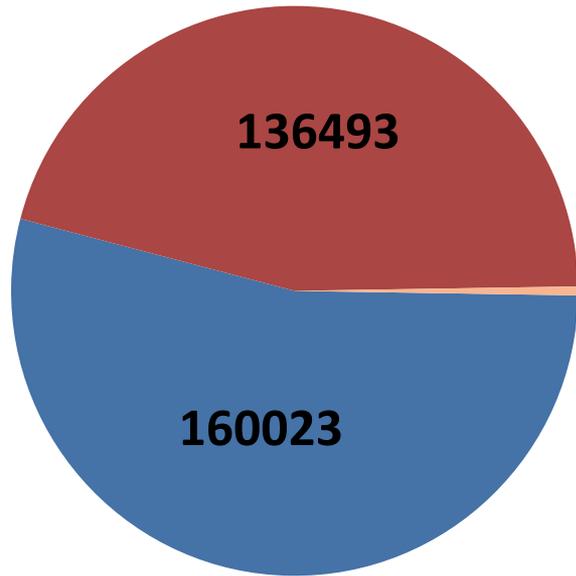
<b>WORD</b>	<i>Figurative</i>			
<b>Word</b>	<b>Figurative</b>	<b>Shape</b>	<b>Colour</b>	<b>Sound</b>

5 new TM types added

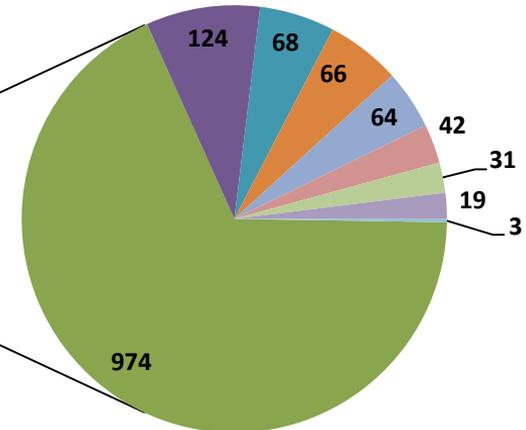
				
<b>Position</b>	<b>Pattern</b>	<b>Motion</b>	<b>Multimedia</b>	<b>Hologram</b>

## Volumes 01.10.2017 – 04.09.2019

# 297.907



# 1.391



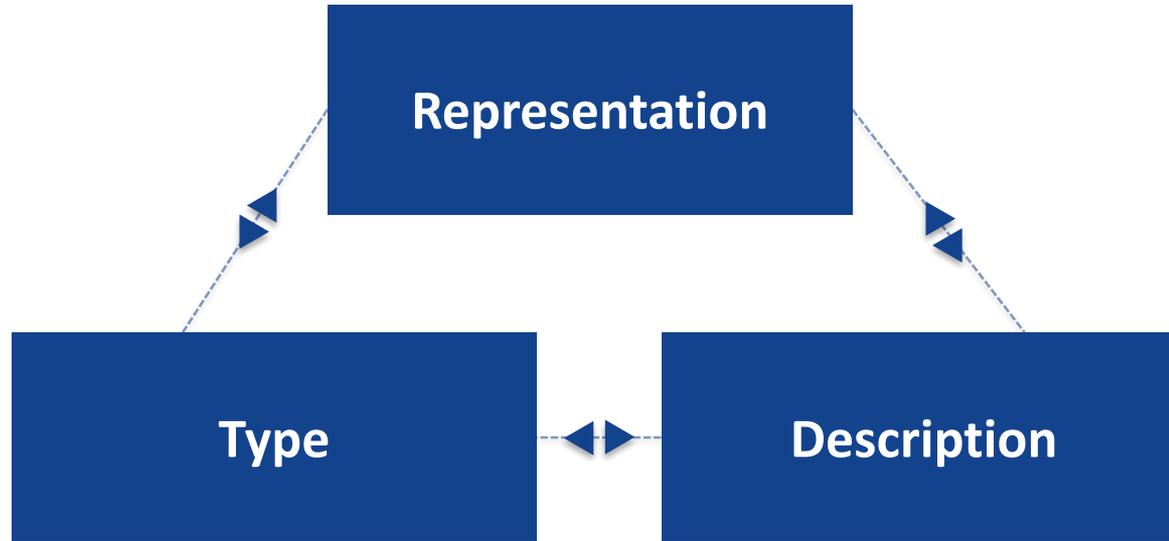
## REPRESENTATION OF EUTMs

### No requirement of graphic representation

**Article 3(1) EUTMIR** : Trade marks shall be represented:

- in any appropriate form using **generally available technology**,
- as long as the representation is **clear, precise, self-contained, easily accessible, intelligible, durable and objective**
- as to enable ... to determine with clarity and precision the subject-matter of the protection

## ART. 3 EUTMIR: REPRESENTATION PRINCIPLES



## Representation of EUTMs

Description

Accord with  
representation

Not extend scope

Position

Pattern

Colour combination

Motion

Other

## TYPES OF MARK / ACCEPTABLE FORMATS

Type of trade mark	Description possible	Format required
Word	No	N/A
Figurative	No	JPEG
Shape	No	JPEG; <b>OBJ</b> ; <b>STL</b> ; <b>X3D</b>
Position	Optional	JPEG
Pattern	Optional	JPEG
Colour (single)	No	JPEG
Colour (combination)	Optional	JPEG
Sound	No	JPEG; MP3 (max 2 Mb)
Motion	Optional	JPEG; <b>MP4</b> (max 20 Mb)
Multimedia	No	<b>MP4</b> (max 20 Mb)
Hologram	No	JPEG; <b>MP4</b> (max 20 Mb)
Other	Optional	JPEG

## Examples: SHAPE MARK

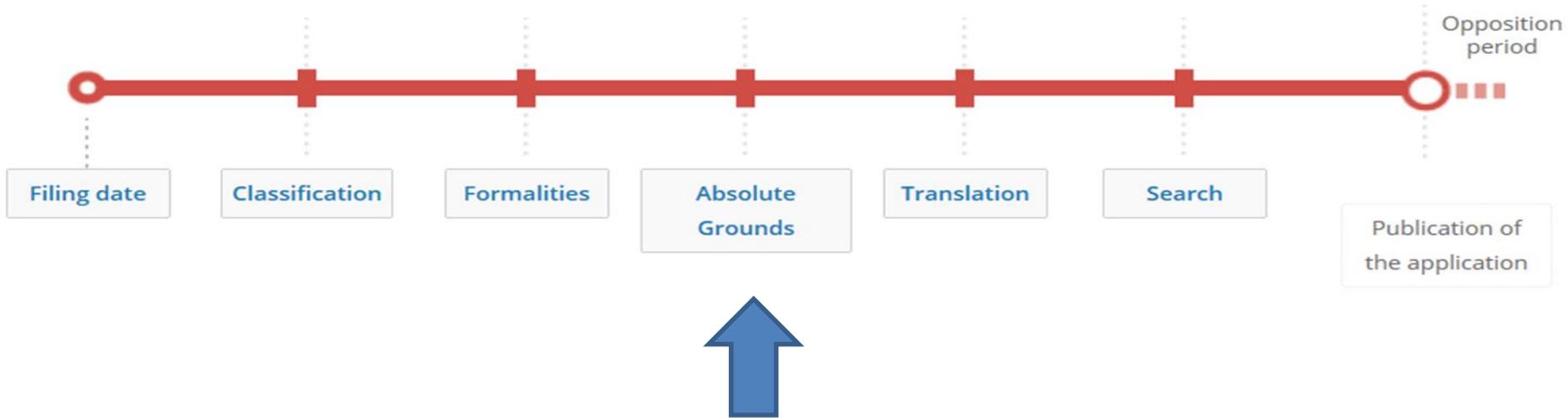
What is new?

The format - in addition to JPEG also **OBJ**; **STL**; **X3D** can be used:

[EUTM 18093647](#)

# EXAMINATION PROCEDURE

## ABSOLUTE GROUNDS



## Main conditions for registering a TM

Not against the public interest ('absolute grounds of refusal') such as

- Requirement of distinctiveness: ex.:  (milk and milk products)
- Not descriptive of g/s: ex.: 'creamy' (for dairy products)
- Not against public order:
- No flags/state emblems:

etc.



Flag of the United Kingdom



EUTM application: 13 169 313



## ACQUIRED DISTINCTIVENESS THROUGH USE – ARTICLE 7(3) EUTMR

- The applicant can request the Office to examine **acquired distinctiveness through use**.
- The applicant can make the claim as a **principal** or **subsidiary** one.

## ARTICLE (7)(1)(e) EUTMR

- Signs consisting **exclusively** in a shape or **another characteristic** shall be not registered
  - Resulting from the **nature** of the good;
  - Necessary to obtain a **technical result**; or
  - Gives **substantial value** to the good.

## Article 7(1)(e)(i) EUTMR



**‘natural’  
products**

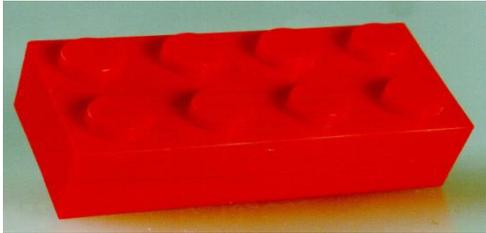


**‘regulated’  
products**



**inherent to the  
generic function**

## ARTICLE (7)(1)(e) (ii) EUTMR



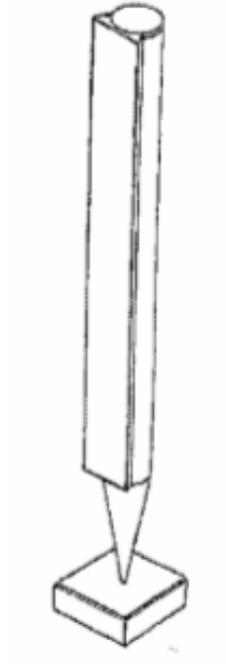
The shape of the brick consists exclusively in characteristics necessary to obtain a **technical result.**

## Article 7(1)(e)(ii) EUTMR



Article 7(1)(e)(iii) EUTMR

Case T-508/08



## PUBLIC POLICY AND MORALITY – ARTICLE 7(1)(f) EUTMR

- A trade mark against **public policy** or **morality** cannot be registered.
- Public policy comprises the laws and rules of the EU or of a Member State.

Example: Names of terrorist or criminal organisations



## DECEPTIVE TRADE MARKS – ARTICLE 7(1)(g) EUTMR

- Marks that may **deceive the public** will not be registered.
- The misleading character can be related to:
  - The nature
  - The quality
  - The geographical origin

Example: **LACTOFREE** is deceptive for 'lactose' products in class 5.

## ARTICLE 6TER of PARIS CONVENTION – ARTICLE 7(1)(h) EUTMR

- Marks which contain or consist of protected signs under **Article 6ter** of the Paris Convention shall be rejected.
- It includes
  1. State flags
  2. State symbols
  3. Intergovernmental organisations flags and symbols



## EMBLEMS OTHER THAN 6ter – ARTICLE 7(1)(i) EUTMR

- Marks including **badges, emblems or estucheons** other than those covered by Article 6ter shall be rejected,
- Unless the consent of the competent authority has been given

## GEOGRAPHICAL INDICATIONS – ARTICLE 7(1)(j) EUTMR

- Marks containing or evoking a **geographical indication** shall be rejected.

Borgoña is the Spanish translation of the French GI ‘Bourgogne’. This trade mark constitutes an evocation of the GI.



## ARTICLE 7(1)(k), (l) and (m) EUTMR

The legal reform introduced **3 new grounds** for refusal:

- Conflict with **traditional terms for wines**
- Conflict with **traditional specialities guaranteed**
- Conflict with an earlier **plant variety** denominations

## Language check

- The Office carries out a **language check** of the verbal elements of the mark in **all the official languages** of the EU.

*Importance of the goods and services:*

- A sign can be descriptive for some goods or services but distinctive for others.



28 countries  
23 languages

Special caution:

**CURVE** – Romanian/English

**CURVA** – Romanian/Spanish/Portuguese

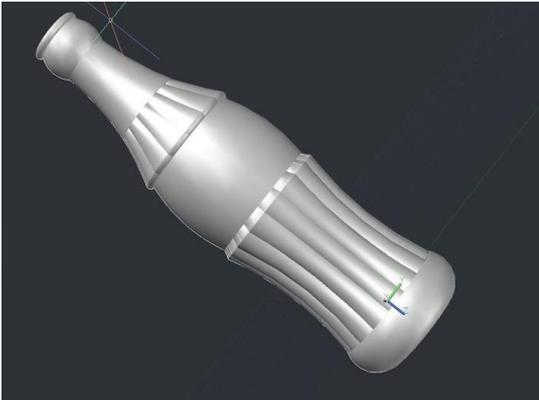
¿very rude?

## EXAMPLES OF RECENT FILINGS



## Article 3(3)(c) EUTMIR – Shape mark

### Shape



**Definition expanded, includes appearance**

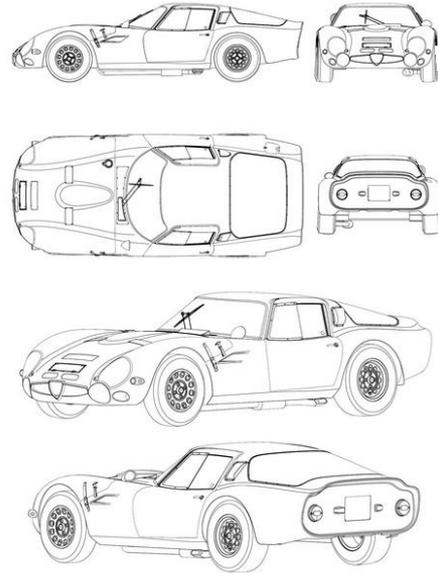
**No description**

**New formats:  
3D modelling CAD**

## Article 3(3)(c) EUTMIR – Shape mark: REGISTERED vs. REFUSED



**EUTM 17 670 142**  
Classes: 33  
Status: **Registered**



**REFUSED**

**EUTM 17 788 886**  
Classes: 12, 28  
Status: **Refused** (lack of distinctiveness)  
Appeal pending

## Article 3(3)(c) EUTMIR – Shape mark: REGISTERED



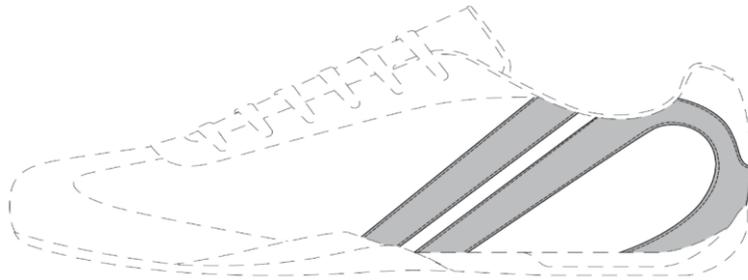
**EUTM 17 754 284**

**Classes: 4, 35, 36, 37, 39, 43**

**Status: Registered**

## Article 3(3)(d) EUTMIR - Position mark

### Position



*Visual disclaimer to exclude certain characteristics (broken, dotted lines)*

**Description optional  
(how affixed to goods)**

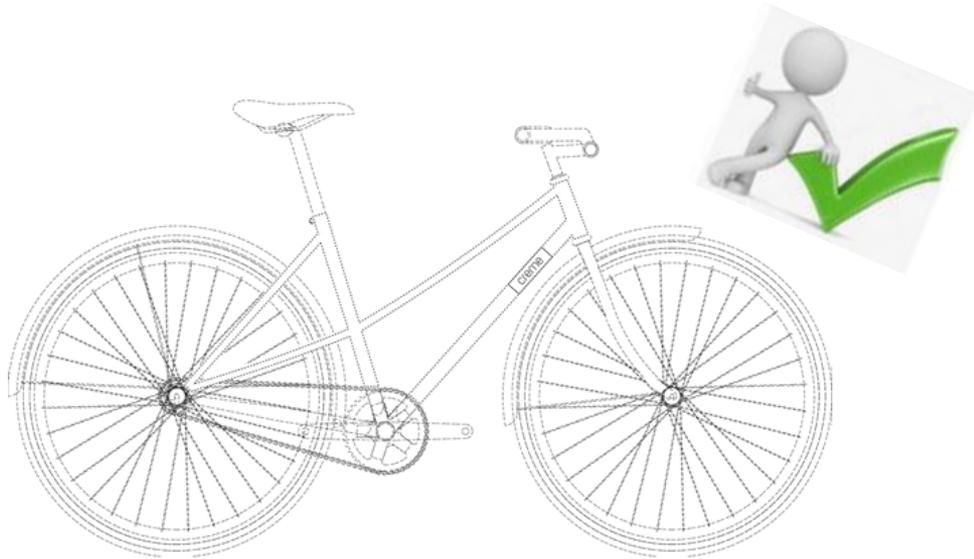
## Examples: POSITION MARK

EUTM 018015719

Refused under 7(1)(b)



## Article 3(3)(d) EUTMIR - Position mark: REGISTERED vs. REFUSED



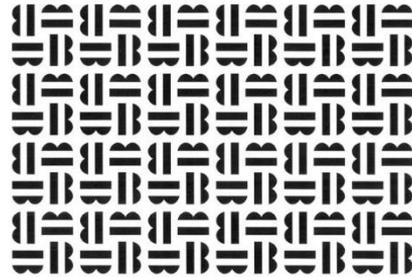
**EUTM 17 366 634**  
Classes: 12  
Status: **Registered**



**EUTM 17 935 217**  
Classes: 25  
Status: **Refused**

## Article 3(3)(e) EUTMIR - Pattern mark

### Pattern



Reproduction showing the pattern of repetition

**Description optional**  
(details how elements are repeated)

Article 3(3)(e) EUTMIR - Pattern mark: **OBJECTED. WITHDRAWN**



**EUTM 17 427 386**  
Classes: 18, 24, 25  
Status: **Objected.**  
**Withdrawn**

## Example of a registered Pattern mark

EUTM 018069909



## Article 3(3)(f) EUTMIR - Colour mark

Colour



Indication of recognised colour codes compulsory

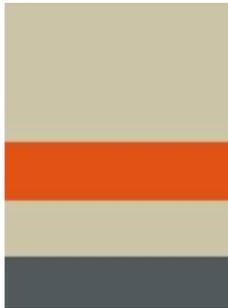
The reproduction must show the **systematic arrangement**

*A description* may detail the systematic arrangement further

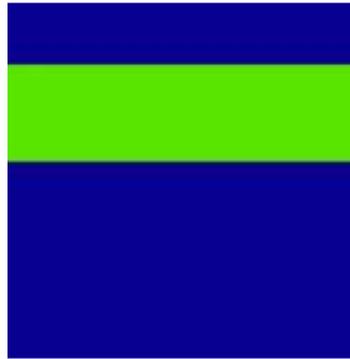
## Systematic Arrangement of Colour Combinations



Example 1



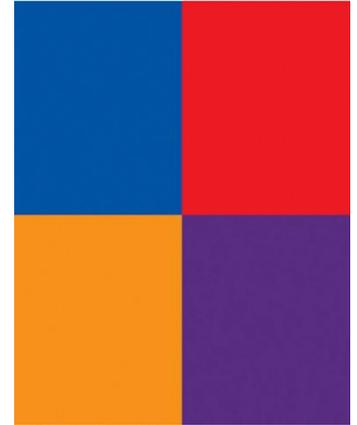
Example 2



Example 3



Example 4



Example 5  
**Objected** for  
candy

## Means of Representation

**OPTION 1:  
ABSTRACT ARRANGEMENT  
WITHOUT DESCRIPTION**



**OPTION 3:  
ADD  
DESCRIPTION**



**OPTION 2:  
THE COLOURS ARE SHOWN AS  
THEY APPEAR ON THE GOODS**

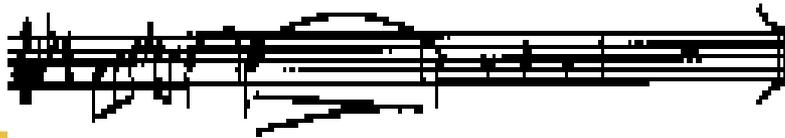


## Article 3(3)(g) EUTMIR – Sound mark

Sound



**EUTM 7 214 083**  
Classes: 12, 35, 38  
Status: Registered



Audio file  
or

Musical notation

No description

## Article 3(3)(g) EUTMIR – Sound mark

**EUTM 17 700 361**



Classes: 3, 9, 16, 25, 28, 35, 41, 43 (advertisement products, e.g. clothing, games, cosmetic products, advertisement and education materials).



**EUTM 17 277 864**



Classes: 9, 38 (electronic communications apparatus and services)  
Ground for refusal: Article 7(1)(b) : **‘too long (39 seconds) and complex’**



**EUTM 17 889 555**



Class 12 (Electrically operated scooters)  
7(1)(b)EUTMR : **‘perceived as a mere burst engine noise’**



## Article 3(3)(g) EUTMIR – Sound mark: UNDER APPEAL

EUTM 17 912 475



**APPEAL**

R 0530/2019-1

Classes: 6, 29, 30, 32, 33 (all related to ‘beverages, drinks’)  
Grounds for refusal: Article **7(1)(b)**EUTMR

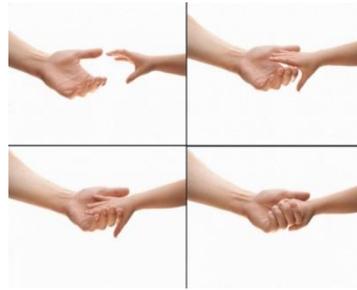
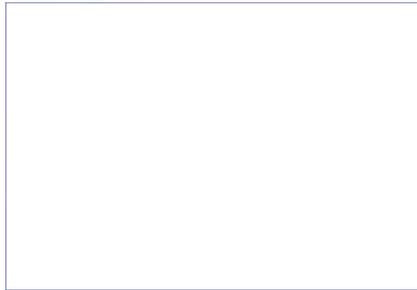
- ‘sound that one hears when opening cans of effervescent drinks (which will be associated also in case of non-carbonated drinks)’

**BoA Decision of 24.07.2019: REFUSAL CONFIRMED**

- ‘non-distinctive: it does not deviate significantly from the sound normally available in this context (sound too close to the normal sound that is heard when a can containing a sparkling drink is opened)’

## Article 3(3)(h) EUTMIR – Motion mark

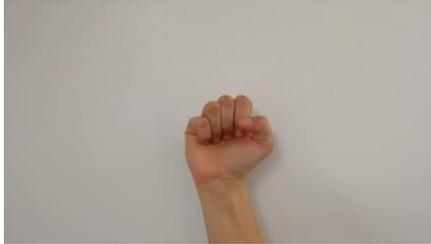
### Motion



**Video file**  
(MP4 format, max 8 000 Kbps, 20 MB)  
**or**  
**still sequential images**  
(single JPEG or single A4)

For **still images**:  
a description explaining the sequence

## Article 3(3)(h) EUTMIR – Motion mark: REGISTERED



### EUTM 17 902 876

Classes: 35, 36, 44, 45 (fund raising, medical care, advertising campaigns with the aim of promoting awareness).



**WIN  
WIN**

### EUTM 17 894 400

Classes: 9, 16, 35, 41 (software, advertising, marketing and promotional services).



Motion mark: REGISTERED



## Examples: MOTION



EUTM 017794281

## Examples: MOTION

EUTM 017279712



## Article 3(3)(h) EUTMIR – Motion mark: REFUSED

EUTM 17 280 215



EUTM 17 280 249



EUTM 17 280 264



EUTM 17 280 281



Classes: 9 (loudspeakers, television apparatus, projectors)  
Grounds for refusal: Article 7(1)(b)EUTMR

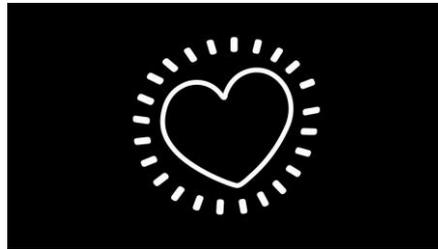


**REFUSED**

- **‘Perceived as instruction for operation/activation of the goods (sensor technology, which uses gestures for activating functions for the goods); Sign language (‘open/unlock’; ‘light – increase light intensity’; ‘switch off’; ‘close’)’**
- **Highlighting of positive and advanced aspects of the products in question;**

## Article 3(3)(i) EUTMIR - Multimedia mark

Multimedia



**EUTM 17 868 267**  
Classes: 35, 38, 42, 45  
Status: **Registered**



**Audio-visual file**  
(MP4 format, max 8 000 Kbps, 20 MB)

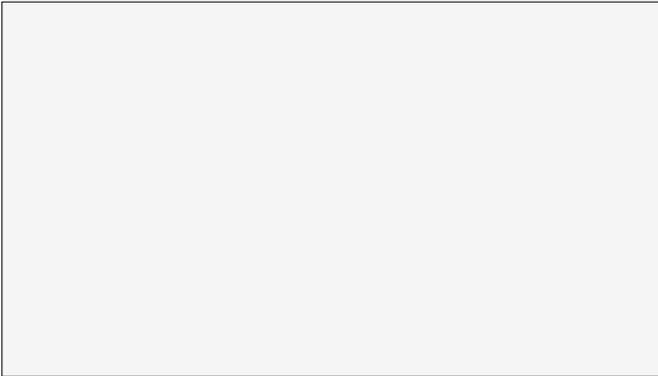
**No description**

## Examples: MULTIMEDIA

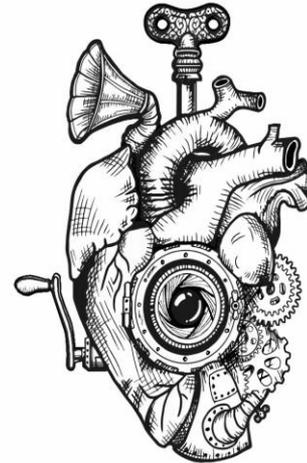


EUTM 017411315

## Article 3(3)(i) EUTMIR - Multimedia mark: REGISTERED



**EUTM No 17941596**  
Class 25



**EUTM 17 279 704**  
Class 45

## Examples: MULTIMEDIA



EUTM 017451816

## Article 3(3)(i) EUTMR - Multimedia mark: APPEAL PENDING

**EUTM 17889338**

**R-2024/2018-5**



Classes: 9, 36, 38, 41 and 42 (software, computerised financial services, access to platforms on the Internet, programming and software design)

Grounds for refusal: Article 7(1)(b)EUTMR

- **'mere sequence of amounts in Euro that the consumers will not perceive as an indication of origin'**

**REFUSED**

**APPEAL**

## Article 3(3)(i) EUTMR - Multimedia mark: APPEAL PENDING

EUTM 17 931 246



Classes: 9, 28 and 41 (software, game machines, online gaming services)  
Grounds for refusal: Article 7(1)(b)EUTMR

- **‘Just a promotional slogan, conveying positive characteristics of the G/S, namely that these will allow for a significant price reduction;**
- **The further elements (device, sound) are not able to provide the sign with a sufficient distinctive character’**

## Article 3(3)(i) EUTMIR - Multimedia mark



**EUTM 17 282 203**  
Classes 9, 28, 41  
Status: **under  
examination**

## Article 3(3)(j) EUTMIR: Hologram mark

### Hologram



**Video file,**  
graphic or photographic reproduction,  
containing the views necessary for  
sufficiently identifying the holographic  
effect in its entirety

**No description**

## Article 3(3)(j) EUTMIR: Hologram mark: REGISTERED



**EUTM 17 993 401**

Class 9: Access control and alarm monitoring systems, accessories for virtual reality, accessories for watches, alarm sensors, audio speakers, batteries, phone covers, etc.

## Art. 3(4) EUTMIR: OTHER MARKS (Unspecified)

### “OTHER” MARKS



Smell?

Taste?

Texture?

**Samples not acceptable**

(4) Where the trade mark is not covered by any of the types listed in paragraph 3, its representation shall comply with the standards set out in paragraph 1 and may be accompanied by a description.

## Art. 3(4) EUTMIR – Other marks: Tracer marks: REFUSED



### EUTM 17 932 932

Classes: 6 (Metal elevator ropes, partially sheathed with a plastic sleeve)

**Description:** *The sign identifies elevator ropes made of metal strands, in which one strand is continuously encased in red plastic material.*

Status: **Application refused - Article 7(1)(b) EUTMR:**

- ‘public accustomed to red-silver ropes: not an indication of origin’;
- ‘public interested in the question of whether such ropes are durable and do not rust and how much weight you can hang on them; such goods are not bought because of their decoration value’.

## Art. 3(4) EUTMIR – Other marks: Tracer marks: UNDER EXAMINATION



**EUTM 17 938 135**

Classes: 22 (Tension belts for tarpaulin spanners)

**Description:** *The key thread mark identifies straps for truck tarpaulin spanners with an ongoing, lengthy-facing line, which is a blue line, which is uniformly dashed, in the middle of the belt.*

Status: **Application under examination**

## Art. 3(4) EUTMIR – Other marks: Tracer marks: UNDER EXAMINATION



### EUTM 17 983 831

Classes: 22 (Non-metallic ropes and non-metallic cordage)

**Description:** *The Trade Mark consists of a black yarn incorporated in a strand of the rope throughout the length thereof so that the black yarn is exposed at intervals on the surface of the rope. The black yarn is used as an identifying marker of the Applicant's goods.*

Status: **Application under examination**

Interested in more examples?

Have a look here:

- <https://euipo.europa.eu/ohimportal/en/trade-marks-examples#>

## DEFICIENCIES

In case the Office finds a deficiency in the application

- The applicant is **notified**
- He has **two months** to remedy to the deficiency and/or submit observations



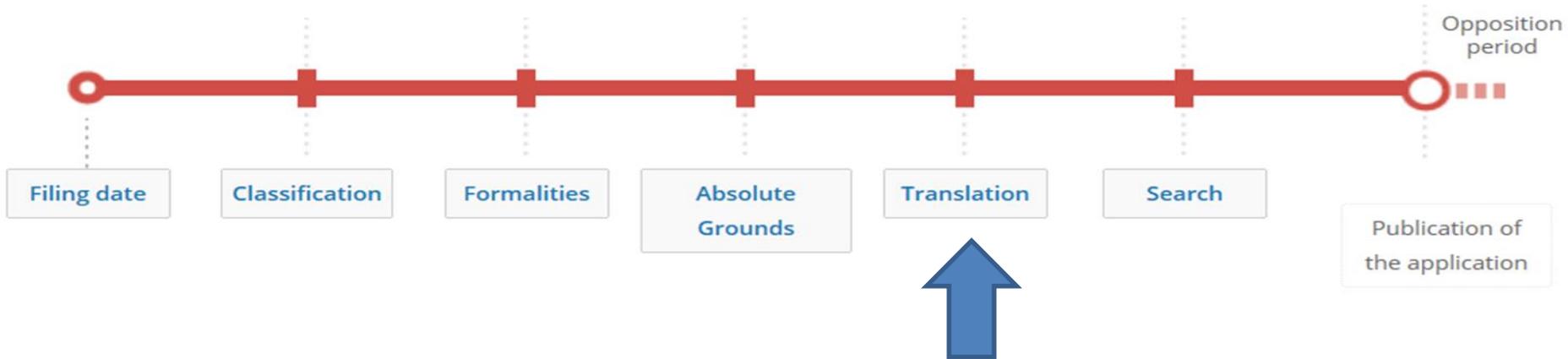
## DEFICIENCIES

If the applicant does not remedy to the deficiency

- The application is **rejected**.
- The decision can be **appealed** within two months from the date of notification (EUR 720)

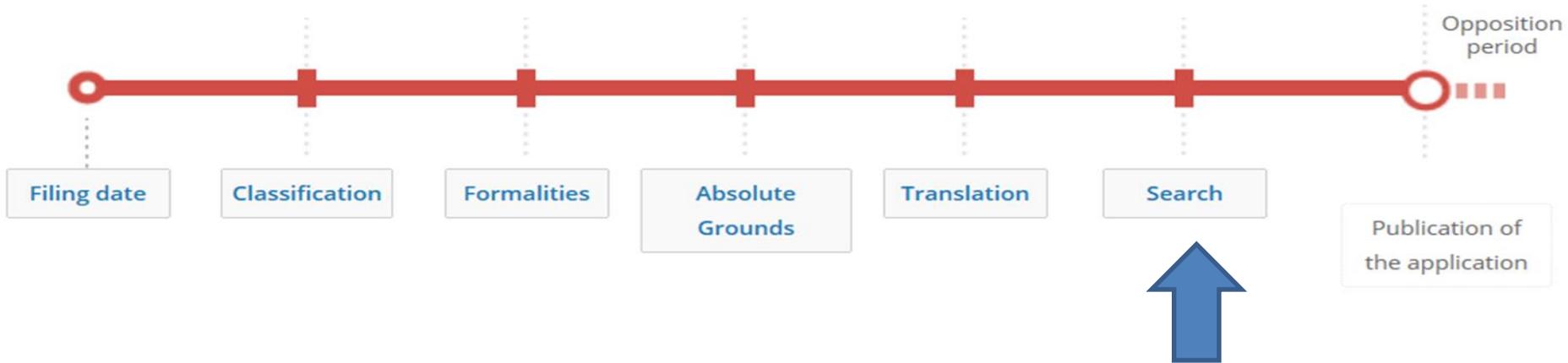
## EXAMINATION PROCEDURE

# TRANSLATION



# EXAMINATION PROCEDURE

## SEARCH



## SEARCH

- The Office carries out a search in the EUTM database for **identical and/or similar marks**.
- The results are sent to the applicant before we publish the trade mark application.
- Owners of previously registered trade marks or trade mark applications quoted in the report are informed as well about the application
- This is called a '**surveillance letter**'.
- The results of both search reports and surveillance letters are for **information only**.

## PUBLICATION

In case there is no deficiency, the **application is published**.

The **opposition period** starts running from the publication date.



## THIRD PARTY OBSERVATIONS

- **Third parties can submit observations** on the existence of an **absolute ground** for refusal
  - Within the opposition period (3 months from the date of publication)
  - When an opposition has been filed, before the final decision has been taken
  - They must be submitted in one of the EUIPO languages (EN, FR, ES, IT, DE)
  
- The Office may reopen the examination of absolute grounds

## OPPOSITIONS AGAINST 'NEW' TYPES'

### SIX OPPOSITIONS PENDING

- All directed against MOTION marks
- All based on traditional marks (i.e. word, figurative)
- All grounded on Article 8(1)(a) and (b)EUTMR

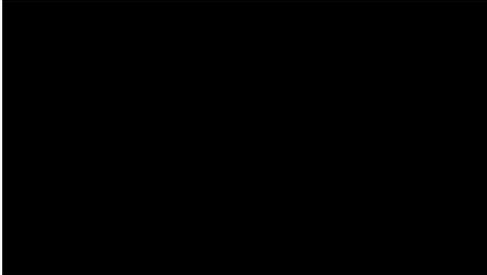
## OPPOSITIONS AGAINST 'NEW' TYPES': some examples

### B 3059889 and B 3058800

Earlier Rights	Contested EUTM 17906814
<p data-bbox="537 525 691 579"><b>AUDI</b></p>  <p data-bbox="484 801 765 834">AUDITEL</p>	

## OPPOSITIONS AGAINST 'NEW' TYPES'

### B 3071595

Earlier UK Trademark	EUTMA 17961198
 <p data-bbox="432 874 720 904">9, 16, 28, 35, 38, 41</p>	 <p data-bbox="1018 874 1761 907">9, 28, 41 (<i>software, game machines, online gaming</i>)</p>

# Registration



## EUTM Registration Procedure

**EUTMs are valid for 10 years and may be renewed indefinitely**

# EUTM Registration Procedure

## APPEAL





THANK YOU  
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