

EU TRADE MARKS: Best Practices, Registration Insights, and Key Case Law

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Agenda

1. EU, EUIPO & EU trade marks
2. The process of filing
3. Examination & registration process
4. Resources
5. Absolute grounds for refusal
6. Key Case Law
7. Main takeouts



EU, EUIPO & EU trade marks



EU single market

EU, EUIPO & EUTMs

ALL MEMBER STATES OF THE EUROPEAN UNION

One single registration procedure fee

Unitary character = all or nothing

Complements national &
international systems

FILING FEES - How much?

Individual marks

Basic fee :	€ 1.000
Basic fee by electronic filing:	€ 850

Collective / certification marks

Basic fee :	€ 1.800
Basic fee by electronic filing:	€ 1.500
Fee for 2 nd class of G&S:	€ 50
Fee for 3 rd class and up:	€ 150

The process of filing

HOW TO FILE – best practices



By e-filing

- 
- Regular Track



By post or courier delivery

Main conditions for 



Individual mark



Goods and Services
Harmonised Database
(HDB); prompt payment



No search requests



No deficiencies

TM | class

The process of filing

HOW TO FILE – best practices



By e-filing

- 
- Regular Track

EUTM Easy Filing

EUTM Filing

Representatives

- ✓ Appoint a representative

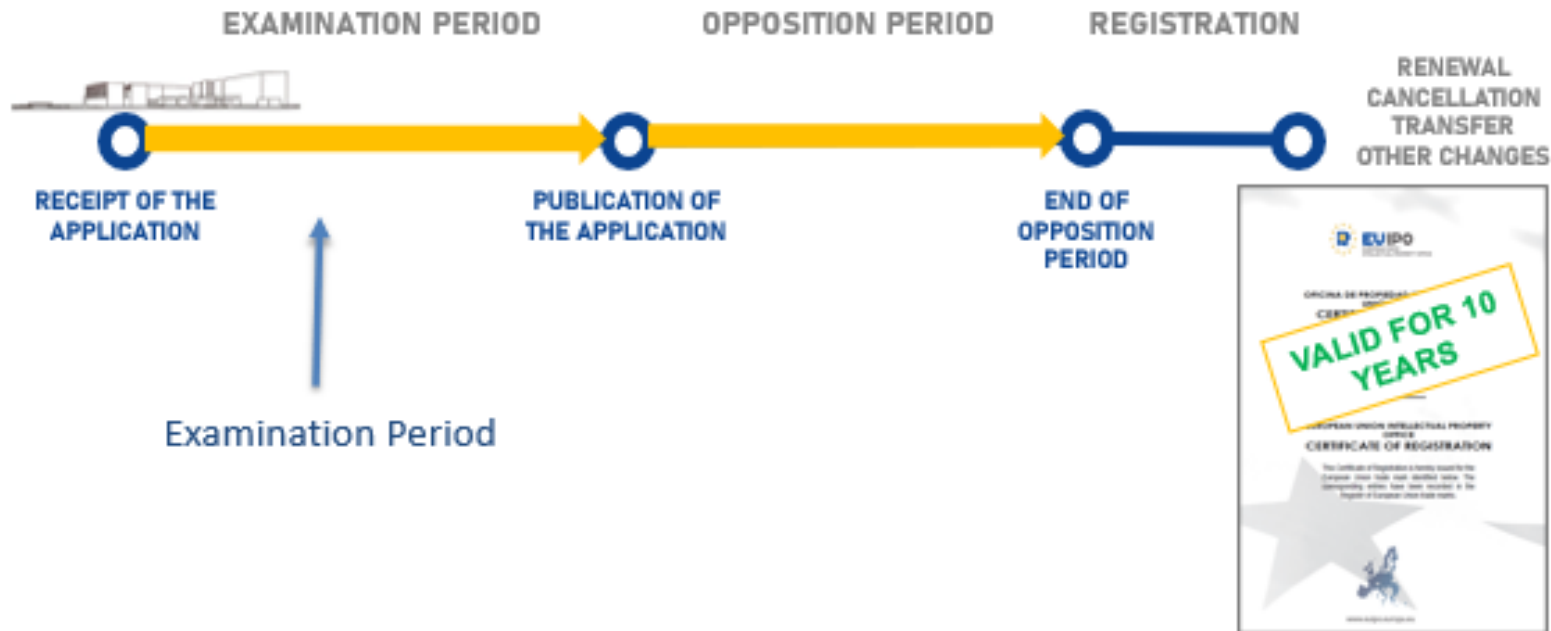
Claims

- ✓ Claim priority, seniority and make other types of claims

International trade marks

- ✓ Possibility of international trade mark transformation and exhibition priority claim

Examination & registration process



Examination & registration process

Filing date requirements: five conditions (Art. 31 EUTMR)



Request for an EUTM



Identification of the applicant



Representation of the mark



List of goods and services



Application fee paid

Examination & registration process

Persons



Applicants from outside EEA
must appoint a representative
VALID for EUIPO



Legal form



Address



Applications must be signed

Examination & registration process

Kinds of marks



INDIVIDUAL



COLLECTIVE



CERTIFICATION

Types of marks

WORD	<i>Figurative</i>			
Word	Figurative	Shape	Colour	Sound
				
Position	Pattern	Motion	Multimedia	Hologram

Examination & registration process

Languages

FIRST LANGUAGE

ANY OFFICIAL LANGUAGE OF THE EU

SECOND LANGUAGE

ONE OF THE 5 LANGUAGES OF THE OFFICE

Examination & registration process

Classification of goods and services



Clear and precise identification of goods and services:
Article 33(2) EUTMR)



Scope of protection needs to be understood



Nice Classification (HDB)



According to their function or purpose

Resources

AcronymFinder

GIview

Regulations

CPVO

Guidelines

TMview

Internet
searches

 eSearch plus
EUIPO's Database access

 eSearch Case Law

INN

dictionaries

encyclopaedias

TMclass

6ter

Resources – EUIPO databases



Pesquisa nas bases de dados de PI

[eSearch plus](#) →

[Jurisprudência eSearch](#) →

[TMview](#) →

[TMclass](#) →

[Ver todas as pesquisas](#) →

Resources - Guidelines

Welcome to our new website. Help us

Search IP databases

[eSearch plus](#) →

[eSearch Case Law](#) →

[TMview](#) →

[TMclass](#) →

[View all searches](#) →

Apply for IP

[Apply for trade marks](#) →

[Apply for designs](#) →

[Geographical indications Info](#) →

[Guidelines](#) →

[User Area](#) →

Guidelines

The EUIPO's current trade mark and design practice is reflected in a series of guidelines for examination that are intended to help both our users and our staff in charge of the various procedures.



Trade mark guidelines

Guidelines for examination of European Union trade marks

[Go to the EUIPO guidelines](#) ↗



Design guidelines

Guidelines for examination of registered designs at EU level

[Go to the EUIPO guidelines](#) ↗

Absolute grounds for refusal

Main absolute grounds for refusal (1):

- Descriptiveness
- Lack of distinctiveness
- Customary signs

} Acquired distinctiveness
through use





Absolute grounds for refusal

Main absolute grounds for refusal (2):

- Shapes or Other Characteristics that Result from the Nature of the Goods, are Necessary to Obtain a Technical Result or give Substantial Value to the Goods
- Trade marks contrary to public policy or acceptable principles of morality
- Deceptive marks
- Trade Marks in conflict with flags and other symbols
- Trade Marks in conflict with GIs and other protected terms for food, drink, craft or plant variety denominations

Convergence of Practices

CP3

<p>1.</p> <p> <i>Flavour and aroma</i> <i>Flavour and Aroma</i> Flavour and aroma Flavour and Aroma </p>	<p> F.A.O.A. <i>FlavOur and ArOma</i> </p> 
<p>2.</p> <p> Flavour and aroma Flavour and aroma Flavour and aroma Fla vour and aroma </p>	<p> Flavour and Aroma Flavour and Aroma Flavour and Aroma </p> 
<p>3.</p> <p> Fresh sardine Fresh sardine Fresh Sardine FRESH SARDINE </p> 	<p> Fresh Sardine Fresh sardine </p> 

Key Case Law

ECO ‘ecological’ (24/04/2012, T-328/11,
EcoPerfect, EU:T:2012:197, § 25;
15/01/2013, T-625/11, EcoDoor,
EU:T:2013:14, § 21)

GREEN ‘environmentally friendly’
(27/02/2015, T-106/14, Greenworld,
EU:T:2015:123, § 24);

EUTM 018309662



(13/07/2022, T-641/21,
BioMarkt,
EU:T:2022:446, § 30-44)

Absolute grounds for refusal

EUTM application 018747549 refused:

‘GREEN POWER TECHNOLOGIES’ (word)

- Descriptive for electrical energy, distribution of renewable energy, etc.
- Non-distinctive idem

AND

- Deceptive for ‘Electrical energy from non-renewable sources’ in Class 4.

Absolute grounds for refusal

EUTM application 018524371 refused:

- Descriptive
- Non-distinctive

AND

- Misleading (certification mark)



Key Case Law

eSearch Case Law

From To Language

Case number Case name Text search

Recent BoA decisions Recent GC/CJ judgments

Advanced search

eSearch Case Law

[Basic search](#)

Trade mark decisions | Design decisions | National court judgments | Preliminary rulings

Add search criteria from below

Decision information

- IP right
- Text search
- Trade mark name
- Trade mark number
- Language
- Norms

Application information

Examination

Opposition

Cancellation

Boards of Appeal

General Court/Court of Justice

Search criteria

Decision/judgment date

and decision type Examination decisions Opposition decisions

Cancellation decisions Board of Appeal decisions

GC/CJ judgments

and IP right

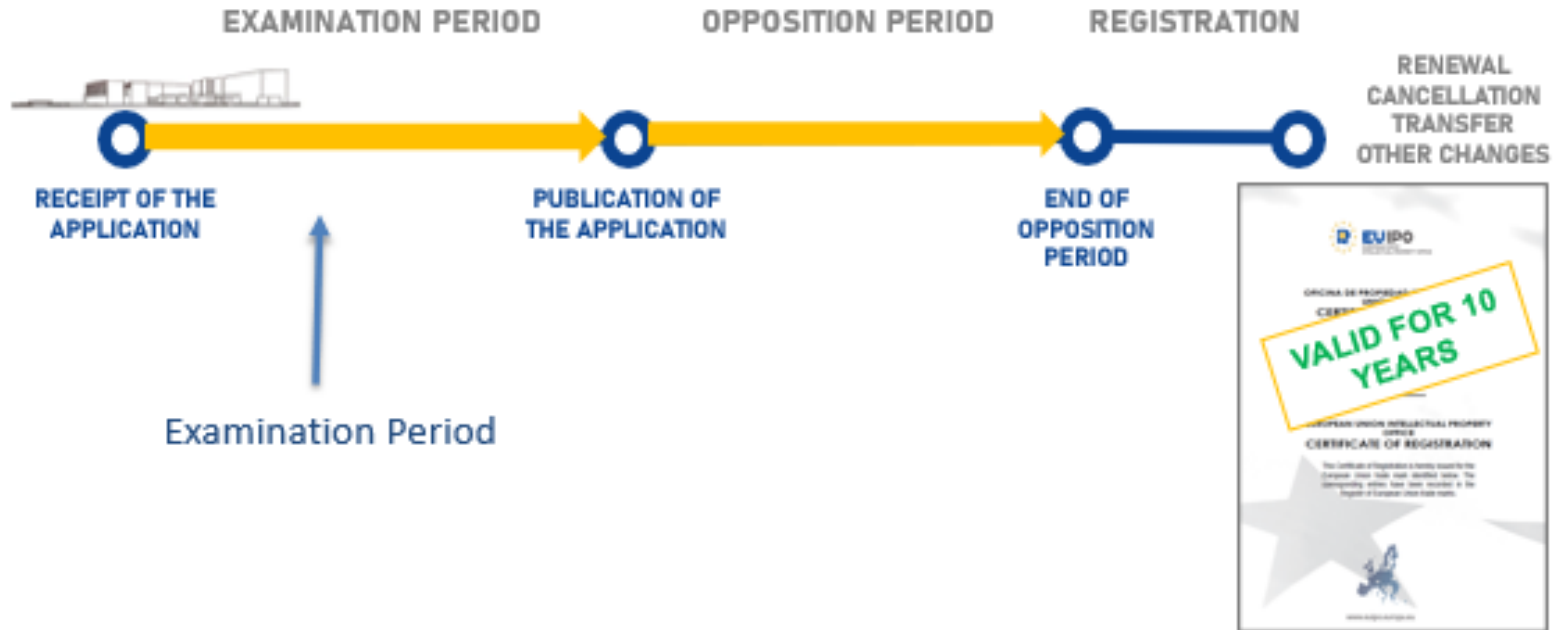
and Text search

and Language

Sort results by

Search for decisions of the EUIPO and judgments of the General Court, Court of Justice and national courts. [Learn how](#)

Examination & registration process



can be valid forever

Main takeouts

EUTM: 1 filing, 1 fee, unitary protection for the whole EU internal market

The process of filing is easy & fast

An EUTM can be examined & published within few days

Valid EUIPO representative

There are plenty of online free resources to assist you

Contact us!

GENERAL INFORMATION

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Monday to Friday: 08.30-18.30, except on [official holidays](#).

After-hours emergency contact number

Only to be used in the event of technical issues ahead of an impending deadline

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Monday to Friday: 18.30-23.59, except on [official holidays](#).



Q & A



THANK YOU!



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THANK YOU