

EU trade mark
welcome kit
for entrepreneurs in Japan



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Introduction

The objective of this 'Welcome kit' is to raise Japanese small and medium-sized enterprises' awareness of the European Union Trade Mark (EUTM) and the requirements to obtain it. Given the increase of borderless businesses and global online markets, small and medium-sized enterprises (SMEs) with little knowledge of intellectual property (IP) need to learn how they can quickly obtain IP rights in overseas markets.

This kit is designed to help Japanese SMEs understand the EUIPO's examination requirements and thus communicate more effectively with their European lawyers to secure trade mark protection in the internal market of Europe. For this reason, we have provided a summarised overview of the main issues that affect SMEs.

It should be noted that this kit is not intended to replace the EUIPO Guidelines.

In order to prepare an accurate and detailed EUTM application, besides consulting this Welcome kit, Japanese applicants are encouraged to seek legal advice from their European representatives and to refer to the latest edition of the EUIPO Guidelines. These are publicly available on the EUIPO website: www.euiipo.europa.eu.

1

Features

1.1 Reasons for registering an EUTM

Where to register?

In the EU, you can choose from the following options to register a trade mark, depending on the needs of your business.

- **National level**, via the national EU IP offices (sometimes including regional level registration in the case of Belgium, the Netherlands and/or Luxembourg, via [BOIP](#)).
- **EU-wide** protection (all EU Member States) via the EUIPO.
- **International** registration via [WIPO](#).

These systems are complementary and work in parallel with each other.

1. The **European route** means applying for an EUTM, which will provide you with protection in all the EU Member States. Accordingly, it may be the right option for you if you seek protection in several Member States. An online application costs EUR 850 and is filed in just one language. When the EUIPO receives your application, it is processed and examined. Once registered, your trade mark can be renewed indefinitely every 10 years.
2. If you just want protection in one EU Member State; perhaps where your business is based at the moment, or where you want to trade, then a national-level trade mark or regional trade mark may be more suitable. You can file a national trade mark application directly at the relevant national IP office. This is the **national route**.
3. If you want protection in Belgium, the Netherlands and/or Luxembourg, you can apply to the [Benelux Office of Intellectual Property \(BOIP\)](#), the only regional-level IP office in the EU, for trade mark protection in those three Member States. This is a **regional route**.
4. The final route to protection in the EU is the **international route**. You can use your national, regional or EU trade mark application to expand your protection internationally to any country that is a signatory to the Madrid Protocol.

Benefits of registering a European Union trade mark

- A single registration — filed online, in one language — is valid in all the EU Member States. Administratively, it is easier and more efficient to maintain a single trade mark registration.
- The EU trade mark gives its owner an exclusive right in all the current and future EU Member States at a reasonable cost. Furthermore, genuine use in one EU Member State may be sufficient to protect an EUTM in all the Member States from cancellation on the grounds of non-use.
- You can enforce your trade mark in a market of almost 500 million consumers. The EUTM system offers trade mark owners a unified system of protection throughout the European Union with the filing of a single application.

Questions



What would happen in the event of any future enlargement of the European Union?

If another country joins the European Union, any EU trade mark registered or applied for before the accession of the new country will be automatically extend to the new Member State without any examination or fees.



Is it possible to integrate a national trade mark into a new EUTM application?

No. They will co-exist. However, you can claim the seniority of your national mark and allow it to lapse without losing your rights to the extent that both marks cover identical goods and services.



Can an EU trade mark be converted into a national trade mark?

Yes, an EUTM can be converted into a national or regional trade mark with the exception of the territory(ies) where the obstacle to registration at EU level was raised by the EUIPO.



1.2 Checklist

Your strategy

Does it fit into your overall IP portfolio strategy?

If you have a registered trade mark in Japan, have you checked the major differences between the EUTM system and the Japanese trade mark system in advance?

European Union trade mark

Is it distinctive and not descriptive? Assessing a mark may vary by country (27 Member States) and language (23 languages).

Have you checked whether the mark, or a similar one, already exists? (applicants are advised to consult [TMview](#), the EUIPO's online database with over 107 million trade marks from 77 IP offices).

Goods and services

Have you made a list of the goods you want to sell and/or the services you want to offer? Have you checked the validity of your list using the [Harmonised Database?](#)

1.3 Main similarities and differences in examination practice between the EU and Japan

	EUTM	Japanese trade mark system
Is presentation required?	People whose domicile, principal place of business or real and effective commercial establishment is not within the EEA (European Economic Area), should appoint a professional representative.	Someone who is not domiciled or resident in Japan (or whose place of business is not in Japan) is required to appoint a representative who is domiciled or resident in Japan. You can find a patent lawyer in Japan by using the 'Patent Attorney Navi': https://www.benrishi-navi.com/english/english1.php?search=2
Date of filing	The date of filing is subject to payment of the application fee within 1 month of filing the required documents.	The filing date is the date on which the application is submitted. However, if the application is not complete (i.e. it is lacking some required information), the filing date will be moved back to the date the deficiencies are resolved.
Scope of examination ex officio	Formalities, Classification, Absolute grounds.	Formalities, Classification, Absolute grounds, Relative grounds
Grounds for refusal	Absolute grounds are examined ex officio, third party observations are possible after publication, and before registration. Relative grounds for refusal are not examined ex officio – only when an opposition/cancellation is filed.	Substantive examination includes examination based on absolute grounds and on relative grounds. <i>*When a broad range of goods/services are described, verification of actual or planned use of the trade mark may be required.</i>
Identification of earlier rights that could conflict with the application	Search report	Ex officio examination of existing earlier rights and applications.
Disclaimer	✗	✗

	EUTM	Japanese trade mark system
Opposition	<p>Can be filed within 3 months of the publication date.</p> <p>Scope of grounds: Relative grounds for refusal.</p> <p><i>*The applicant can file a request for proof of use, requiring the opponent to prove that any earlier mark registered for more than 5 years has been genuinely used</i></p>	<p>Can be filed within 2 months of publication of the publication date of the Trademark Bulletin.</p>
Division of application/ registration	✓	✓
Duration of registration	10 years from the date of filing of the application.	10 years from the date of registration.
Term of renewal	<p>Within the 6-month period immediately prior to the expiration of the registration (and upon payment of the renewal fee); within the 6-month period immediately following expiration (and upon payment of an additional late fee).</p>	<p>Within the 6-month period immediately prior to the expiration of the registration (and upon payment of the renewal fee).</p> <p>Within the 6-month period immediately following the expiration (and upon payment of an additional late fee).</p>
Transfer	<p>An EU trade mark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.</p> <p>An assignment of the EU trade mark should be made in writing and requires the signature of the parties (except when it is the result of a judgment).</p> <p>Transfers do not affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for some territories.</p>	<p>Can be transferred by dividing it for each of the designated goods or services.</p> <p>Where trade mark rights are jointly owned, no joint owner may transfer their stake or establish a pledge on their stake without the consent of all the other joint owners.</p>
Use requirement	Non-use for more than 5 years following registration makes the trade mark registration vulnerable to cancellation.	Non-use for over 3 consecutive years makes the trade mark registration vulnerable to cancellation
Can you obtain consent from the owner of a conflicting mark to proceed to registration?	Not usually. If there is a dispute, the courts will decide.	<p>Yes, as of April 2024.</p> <p><i>*Concurrent registration of trade marks will be allowed under the condition that the prior registered trade mark holder consents to the registration, and that it will not cause confusion among consumers.</i></p>

1.4 Unique features

Seniority



What is the seniority of an earlier national mark and what is the main benefit of claiming seniority?



Applicants may already have registered trade marks in major trading countries such as Germany and France, and they may want to extend the scope of protection of these trade marks throughout Europe while preserving their prior rights in the individual Member States. The seniority of an earlier national or international trade mark registration can be claimed within 2 months of filing an EU trade mark, or any time after registration of an EUTM.

Thanks to the seniority claim, the owner of an EUTM can surrender the earlier trade mark or allow it to lapse, but they will still have the same rights as they would have had if the earlier trade mark had continued to be registered. In this way, they don't have to supervise the different Registers of their national marks and they don't have to renew them.

The right of priority is a different concept. This means that the date of priority counts as the date of filing of the EU trade mark application for the purposes of establishing which rights take precedence. An accepted seniority claim does not change the date of filing of the EU trade mark application.

Search reports



What is a search report?

The EUIPO does not refuse EUTM applications *ex officio* based on potential conflict with existing earlier rights.

However, search reports are sent to applicants identifying earlier EUTMs/applications that may conflict with their EUTM application. The search reports are for information purposes only and to give the applicant the opportunity to withdraw their EUTM application before it is published.

The search reports are included in the application fee but must be requested when filing the application or, for international applications, within a month of the notification date of the international registration by the WIPO.

The EU search report covers the following earlier rights:

1. EUTM applications with a filing date or priority date earlier than that of the application in question;
2. EUTMs already registered; and
3. prior international registrations (IR) designating the EU.

In addition, national search reports can be requested at the EUIPO from 5 national offices of the EU (the Czech Republic, Denmark, Hungary, Romania and Slovakia) for an additional fee of EUR 60.



Can a search be carried out by the applicant before filing an application to find out whether or not a similar mark has already been registered?

Earlier trade marks could pose a threat to your application. While applicants can obtain search reports, these reports are only informative and are not intended to cover all the possible earlier rights with which a conflict could arise. You can search yourself for registered trade marks using two different online EUIPO databases: eSearch plus and TMview. These online databases allow users to search for availability and are both available to users free of charge.



2

Proceedings

2.1 Examination process

The actions taken by the EUIPO during the examination period almost occur simultaneously, by different examiners, each specialised in the subject. Once all the steps have been completed, the trade mark is published. The progress of applications can be followed online by accessing [eSearch plus](#). This EUIPO database is publicly available, allowing applicants to consult the status of their applications themselves.

An 'Owner ID number' is assigned automatically to each applicant. This number will also be published together with your address details. It is important that your details are up to date so you can receive notifications, for example, concerning 'Renewals'.

The EUIPO examination workflow



Filing date: Does the trade mark application contain the mandatory and basic information required: a request for application, a correctly identified owner, a clear representation of the mark and a list of goods and services. Payment of the basic fee must also be made within a month of the filing date.

Formalities: Details of the application are reviewed to make sure that everything is as it should be; the signature, languages, owner and/or representative data, priority and/or seniority claims.

Classification: Classification: The goods and services are reviewed to see if they have been correctly classified and their nature has been clearly indicated (see chapter 3.1).

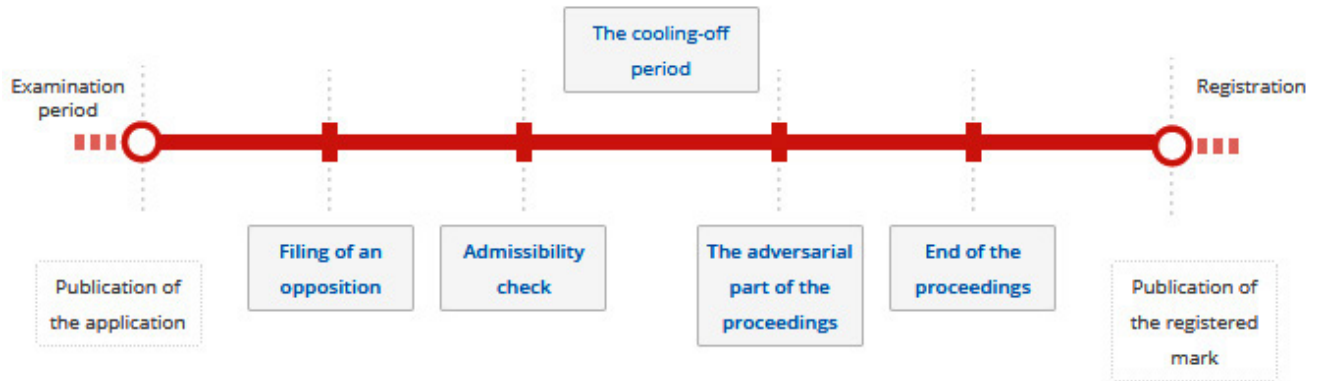
Absolute grounds: The trade mark is analysed to see whether it is distinctive and not descriptive (see chapter 3.2).

If an application is refused, it is still possible to convert the EU trade mark application into national registrations in those territories not affected by the refusal.

From the date of publication, third parties who believe your trade mark should not be registered due to a conflict with their earlier right have 3 months to file an opposition.



The EUIPO does not examine Relative Grounds by its own motion.



Opposition period: 3 months

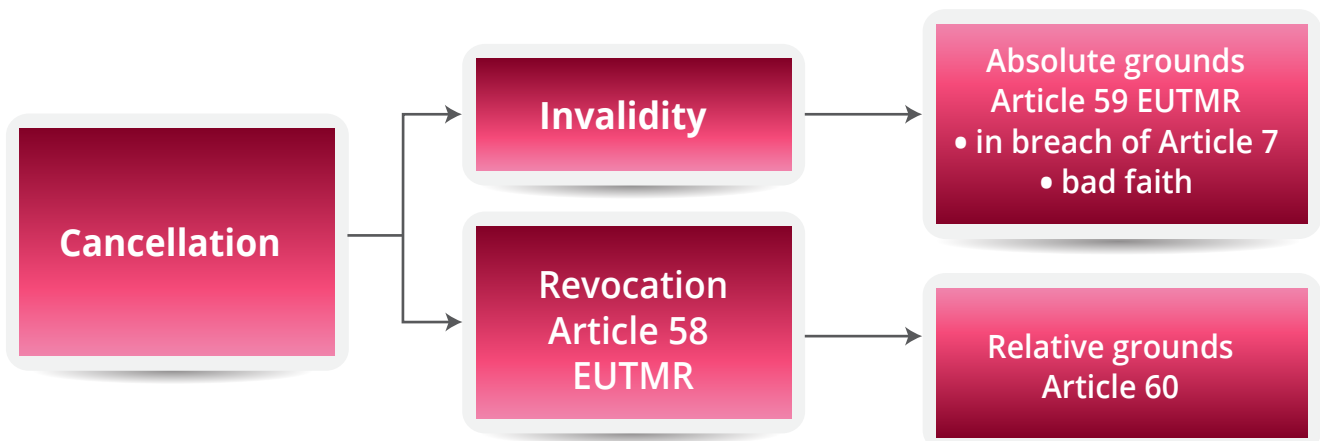
Cooling-off period: 2 months that can be extended to a maximum of 24 months.

Adversarial stage: 2 months to the opponent + 2 months to the applicant, time limits may be extended.

All opposition decisions are published online and all adversely affected parties have a right to [appeal](#).

Where an opposition has been successful, it is still possible to [convert \(IP bridge\)](#) your EU trade mark into national registrations, provided no conflicts exist.

A registered EU trade mark can also be cancelled (revoked or declared invalid), if an application for revocation or for a declaration of invalidity is launched against the mark. If a revocation is successful, the EUTM will be deemed not to have had effect from the date of application for revocation. If an invalidity claim is successful, the registered EU trade mark is removed from the Register with retroactive effect.



2.2 Appeal

Q

Who can file an appeal?

Anyone who is adversely affected by a decision can file an appeal. Appealing a trade mark-related decision costs EUR 720 and should be done within 2 months of the date of notification of the decision.

A

Q

Time limit of an appeal

A distinction must be made between the 'Notice of appeal' and the 'Statement of grounds'. The defendant can file a response within 2 months of the date of notification of the appellant's statement of grounds.

A



Decisions of the Boards of Appeal / General Court

The Boards' decisions may be subject to an appeal, within 2 months of the notification of the decision, before the [General Court](#). All judgments of the General Court may be appealed to the Court of Justice of the European Union (for matters of law only).

2.3 Principle of representation

The appointment of a representative is mandatory for parties to proceedings before the EUIPO whose domicile or principal place of business, or real and effective industrial or commercial establishment is not in the EEA (European Economic Area, that is, the EU Member States, Norway, Iceland and Lichtenstein). This obligation exists for all proceedings before the EUIPO. An application can be filed for an EUTM, but for any other proceedings, a representative needs to be appointed⁽¹⁾.



Can a European company in a trading relationship with a Japanese company be a representative?

Yes, but only if there are valid economic connections⁽²⁾.



When an applicant based in Japan is a party in proceedings before the EUIPO, they can also be represented by an employee, even if that employee does not work directly for them. This is particularly relevant for legal persons with a legal address **outside the EEA** since representation is mandatory for them. These non-EEA legal persons may be represented by an employee in the following two scenarios.

1. Legal persons with a legal address **outside the EEA**, but with a real and effective industrial or commercial establishment within the EEA, may be represented before the EUIPO by an employee of this EEA-based establishment.

The represented legal person must show that even though their legal address is outside the EEA, they also have a real and effective industrial or commercial establishment in the EEA (e.g. by proving that they own or control a branch, agency or other kind of commercial establishment (including subsidiaries) in the EEA that can be considered a natural extension of the non-EEA legal person).

2. Legal persons with a legal address outside the EEA may be represented by an employee of another legal person within the EEA provided that both legal persons are economically connected.

Firstly, the legal person must show that the other legal person exists within the EEA; secondly, that there is a sufficiently strong economic connection between the represented party and the EEA-based legal person; and thirdly, that the employee representative truly works for the EEA-based legal person.

Economic connections only exist when there is economic dependence between the two legal persons, either in the sense that the party to the proceedings is dependent on the employer of the employee concerned, or vice versa.

⁽¹⁾ The same applies to international registrations designating the EU.

⁽²⁾ [Parties to the Proceedings and Professional representation](#)

This economic dependence may exist for example:

- either because the two legal persons are members of the same group; or
- because of management control mechanisms⁽³⁾.

However, the following do not establish economic links:

- a connection by virtue of a trade mark licensing agreement;
- a contractual relationship between two enterprises aimed at mutual representation or legal assistance;
- a mere supplier/client relationship, for example, based on an exclusive distribution or franchising agreement.



What happens if representation is mandatory but the representative appointed is unacceptable?

The EUIPO will issue a deficiency letter. If the deficiency is not remedied, the representative will be removed from the application and the applicant will be invited to appoint another representative.



Other types of representative

In all the Member States of the EEA, representation in legal proceedings is a regulated profession and may only be exercised under particular conditions. In proceedings before the EUIPO, the following categories of representative are also distinguished.

Legal practitioners

Professionals who, depending on the national law, are fully entitled to represent third parties before national offices.

Professional representatives

Representatives who need to comply with further conditions and need to be included on a specific list maintained by the EUIPO for this purpose.



How do I appoint a professional representative?

A list of professional representatives is publicly available on the EUIPO website, in the 'eSearch plus' section. You should contact them directly and check their availability. This process is not automatic.



⁽³⁾ 22/09/2016, T 512/15, SUN CALI (fig.), EU:T:2016:527, § 33 et seq.

2.4 Payment

The basic fee is due within a month of the date the application is received by the EUIPO.

- The basic fee for an electronic application which covers one class is EUR 850.
- The fee for the second class of goods and services is EUR 50.
- The fee for three or more classes is EUR 150 for each class.

[Link to the list of fees](#)



3

Examination

This chapter highlights certain examination characteristics. For more information, please refer to the EUIPO Guidelines which are available on the website at: www.euipo.europa.eu.

3.1 Classification

Q

What is classification?

Every EUTM application must contain a list of goods and services as a condition for a filing date to be accorded. The list must be classified in accordance with the Nice Classification, with each class represented by a class heading (goods from Classes 1 to 34, and services from Classes 35 to 45).

It is very important to apply for the classes of goods and services that match your business' current and future interests because it will have a direct influence on the protection of your EU trade mark.

Applicants are advised to consult TMclass at: <http://tmclass.tmdn.org/ec2/>, which contains pre-approved terms from the Harmonised Database. These terms are automatically accepted for classification purposes and therefore guarantee a smoother trade mark registration process.

A



How to avoid mistakes in classification?



1. Use of correct punctuation

- ▶ Commas [,] separate items within the same category or expression. Goods subject to retail services should always be separated by commas (e.g. retail in relation to clothing, footwear, headgear in Class 35).
- ▶ Semicolons [;] separate independent expressions (e.g. milk; cheese; sour cream).

2. Avoid using terms and expressions that lack clarity and precision (e.g. the 11 general indications of the Nice class headings and other terms considered lacking clarity and precision).

Not a clear and precise term	Example of a clear and precise term
Machines (Class 7)	Agricultural machines (Class 7) Machines for processing plastics (Class 7) Milking machines (Class 7)
Goods in precious metals or coated therewith (Class 14)	Works of art of precious metal (Class 14)
Goods made from paper and cardboard (Class 16)	Filtering materials of paper (Class 16)

For more examples, see the Guidelines, Part B, Examination, Section 3, Classification, Chapter 4, List of goods and services, paragraph 4.3.1).

- ▶ Qualifiers such as 'the like,' 'ancillary,' 'associated goods,' 'and related goods' and 'etc.' are also not acceptable (e.g. cosmetics and associated goods).
- ▶ 'Parts and Fittings' and 'Components and Accessories' are generally **not recommended**, except for some rare exceptions, such as: Class 12 Parts and fittings for motor vehicles, Class 15 Musical accessories, Class 19 Building components made of wood.

3. Use of namely/in particular

'Namely' or 'being,' limit protection to the specific goods named. The terms 'in particular,' 'including,' 'especially' or 'mainly' only show one example of the goods. Examples:

Examples of Title	Explanation on the Scope of Title
Dairy products, namely cheese and butter	Limited to cheese and butter;
Dairy products, in particular cheese and butter	Indicates all types of dairy products, such as cheese and butter;
Clothing, all being underwear	Limited to underwear;
Clothing, including underwear	Indicates all types of clothing including underwear;

Further details on classification can be found in the Guidelines, Part B, Examination, Section 3, Classification.



What is Fast Track and what is the main benefit of using the Harmonised Database in classification?

At the EUIPO, applicants have the opportunity to get their applications examined and published faster if they are compliant with the 'Fast Track' conditions.



1. It is faster (published in half of the time or less).
2. It is safer: choosing terms already accepted by the EUIPO / EU IP offices from the Harmonised Database (HDB) reduces deficiencies (errors).

An application that is compliant with the Fast Track conditions is automatically placed on this track, so applicants do not have to submit an additional application for this.



How can I comply with the Fast Track conditions?



You need to select the goods and services your trade mark will cover from the HDB.



You need to pay upfront: our examiners can only start examining the application once payment has been completed.



- ▶ Although some applications may comply with the Fast Track conditions at the time of filing, this situation may change during the examination process, namely if deficiencies are found.

For more information on the full Fast Track conditions, visit our dedicated web page.



3.2 Absolute grounds for refusal



What are the frequent reasons for refusal on absolute grounds?

The frequent reasons for absolute grounds refusal include non-distinctive trade marks (Article 7(1)(b) EUTMR) and descriptive trade marks (Article 7(1)(c) EUTMR).

Therefore, applicants should pay attention to whether their mark falls under any of these grounds before submitting a trade mark application.

For a full list of absolute grounds for refusal, please consult the relevant section in the EUIPO Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal.



Distinctiveness

The distinctiveness of a trade mark, within the meaning of Article 7(1)(b) EUTMR, means that the sign serves to identify the goods and/or services for which registration is sought as originating from a particular undertaking, and thus to distinguish those goods and/or services from those of other undertakings. A minimum degree of distinctiveness is sufficient to prevent the absolute ground for refusal provided for in Article 7(1)(b) EUTMR from being applied.



Are there any examples of non-distinctive word marks?



Word element

Words that are so frequently used that they have lost any capacity to distinguish goods and services (e.g. BIO).

Terms merely denoting a particular positive or appealing quality or function of the goods and services (e.g. PERFECT).

Slogans

Advertising slogans are objectionable when the relevant public might only perceive them as a mere promotional formula (Article 7(1)(b) EUTMR), for example, 'THIS IS PERFECT FOR YOU'.

However, they can be distinctive when they are seen as more than a mere advertising message, for example, because they:

- constitute a play on words;
- introduce elements that are imaginative, surprising or unexpected;
- trigger a cognitive process or require an interpretative effort;
- the shape of the goods are distinctive, despite the use of non-distinctive words on them.



Descriptiveness

A sign must be refused as descriptive if it has a meaning that will be immediately perceived by the relevant public as providing information about the goods and services applied for. This is the case where the sign provides information about the quantity, quality, characteristics, purpose, kind and/or size of the goods or services, among other things.

If a mark is descriptive, it is also non-distinctive. Terms that are only suggestive or allusive are however accepted. The relationship between the term and the goods and services must be sufficiently direct and specific⁽⁴⁾.



Are there any examples of descriptive trade marks?



- **Word marks**

Word marks that merely consist of information about the characteristics of the goods and services (for example: 'CONTINENTAL' for live animals), including combination words of descriptive elements (e.g. 'CLEARWIFI').

Figurative marks are those that consist of or contain non-standard characters, stylisation, layout, a graphic feature or colour (Article 3(3)(b) EUTMIR). They include marks that consist exclusively of figurative elements or of a combination of verbal and figurative elements.

Where a figurative mark consists exclusively of a basic, natural figurative element that is not significantly different from a true-to-life portrayal that serves to indicate the kind, intended purpose or other characteristic of the goods or services, it should be objected to under Article 7(1)(c) EUTMR as descriptive of a characteristic of the goods or services in question.

- **Non-distinctive examples**

	08/07/2010, T-385/08, Hund, EU:T:2010:295
	08/07/2010, T-386/08, Pferd, EU:T:2010:296

In these cases, the Court held that for goods in Classes 18 and 31, the depiction of a dog or horse, respectively, serves to indicate the type of animal for which the goods are intended.



• **Assessment of the figurative threshold**

Where a figurative mark consists of a combination of a descriptive verbal element and figurative element(s), the question to be considered is whether the stylisation and/or the graphical features of a sign are sufficiently distinctive for the sign to act as a badge of origin.

In the framework of the European Union Intellectual Property Network (EUIPN), the EUIPO and a number of trade mark offices in the European Union have agreed on a Common Practice in which the figurative element renders sufficient distinctive character to the mark (also referred to as Convergence Project 3 or CP3 Practice) or see the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Descriptive trade marks (Article 7 (1)(c) EUTMR), paragraph 4, Figurative threshold.

• **Distinctive examples**

The following examples passed the threshold of distinctiveness due to the figurative features in the mark.

word elements	
figurative elements	
combination of word and figurative elements	



What is the baseline for absolute grounds for refusal?

The reference base is the ordinary understanding of the relevant public of the word in question that can be corroborated by dictionary entries, examples of uses of the term found on internet websites, or that may clearly follow from the ordinary understanding of the term.





What languages are considered in examination?

Absolute grounds for refusal are interpreted based on a common European standard.

It is however sufficient to refuse an application from registration if a ground for refusal pertains to only part of the EU. A trade mark will be refused if it is descriptive or lacks distinctive character in any of the official languages of the EU.

All the EU national languages are considered in examination.

As regards other languages (regional languages and non-EU languages) an application will also be refused if it is if it is descriptive or lacks distinctive character in a language understood by a non-negligible part of the relevant public in at least part of the European Union.

In order to identify whether there is a non-negligible part of the relevant public who understand a term which is not in an official language of the EU, a case-by-case analysis of the factual situation must be made, namely (i) cultural, linguistic and historical circumstances, (ii) geographical proximity, (iii) existence of non-negligible minorities in the EU, (iv) adduced figures or studies, etc. Only commonly used words will be considered to be understood, unless proven otherwise.



Abbreviations and acronyms



When are abbreviations and acronyms considered descriptive?

Abbreviations of descriptive terms are in themselves descriptive if they are used in that way, and the relevant public, whether general or specialised, recognises them as being identical to the full descriptive meaning (). The mere fact that an abbreviation is derived from a descriptive term is not sufficient.

A mark will be objected to if the descriptive meaning is evident at first sight (e.g. 'Multi Markets Fund MMF' / 'The Statistical Analysis Corporation — SAC').

However, if the meaning will not be immediately perceived, the acronym is distinctive (e.g. 'The Organic Red Tomato Soup Company — ORTS').



⁽⁵⁾ 13/06/2014, T 352/12, FLEXI, EU:T:2014:519.



If your application is refused, is it possible to convert it into a national registration?

If your application is refused as descriptive in only one or certain countries on absolute grounds or due to an opposition based on a right valid in only certain countries, it is still possible to apply to convert your EU trade mark application into a national registration in those Member States where no conflict exists. For example, if an absolute ground for refusal is raised in relation to the English-speaking public, conversion would not be possible in Ireland or Malta.



What is the difference between absolute and relative grounds for refusal?

Absolute grounds for refusal are examined ex officio by the EUIPO (with the exception of bad faith, which is an absolute ground for invalidity only) and third parties' observations may be taken into account. Absolute grounds can be based on lack of distinctive character, generic trade marks, exclusions based on shape or other characteristics.

Relative grounds for refusal are not examined ex officio and have to be raised by the interested parties through opposition and invalidity actions.



3.3 Relative grounds for refusal



What are the most common relative grounds for refusal?

1. Article 8(1)(b) EUTMR — likelihood of confusion

The concept of likelihood of confusion refers to situations where:

- I. the public directly confuses the conflicting trade marks, that is to say, mistakes one for the other;
- II. the public makes a connection between the conflicting trade marks and assumes that the goods/services in question are from the same or economically linked undertakings (likelihood of association).

2. Trade marks with reputation

Article 8(5) EUTMR grants protection for registered trade marks not only as regards identical/similar goods/services but also in relation to dissimilar goods/services without requiring a likelihood of confusion.

The following conditions need to be met for Article 8(5) EUTMR to apply:

- the earlier mark enjoys a reputation in the relevant territory;
- the signs are identical or similar;
- and the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark (cogent arguments to prove any unfair advantage, tarnishment or dilution must be provided).

The opponent must furnish evidence to support their claim, in particular regarding the reputation of their earlier mark.

For a full list of relative grounds for refusal, please consult the relevant section of the EUIPO Guidelines, Part C, Opposition.





How is the degree of distinctiveness of the earlier mark defined in relative grounds for refusal?

The distinctiveness of the earlier mark as a whole is assessed. At least a certain degree of distinctiveness needs to be acknowledged. The degree of distinctiveness of the earlier mark should be taken into account in the context of the global assessment of the likelihood of confusion.



- I. The more distinctive the earlier mark, the greater the likelihood of confusion. The same criteria that are used to determine distinctiveness in absolute grounds apply when assessing the degree of distinctiveness of the marks.
- II. Earlier marks with a highly distinctive character because of the reputation they possess on the market, enjoy broader protection than marks that are less distinctive. When claiming enhanced distinctiveness, the opponent must furnish evidence that proves that the earlier mark is known by a significant part of the public concerned.



How does the EUIPO assess the likelihood of confusion?

Likelihood of confusion is assessed by taking the following factors into account:

- comparison of the goods and services (please consult the EUIPO Similarity Tool for concrete examples);
- relevant public and degree of attention;
- comparison of the signs;
- distinctiveness of the earlier mark;
- any other relevant factors;
- the global assessment of the likelihood of confusion.



Marks with a high degree of distinctiveness because of the reputation they possess on the market enjoy broader protection than marks that are less distinctive.



What is considered in the comparison of the goods and services?



Generally speaking, two items are defined as being similar when they have some characteristics in common. The following factors should be taken into account (the 'Canon' factors):

- nature,
- intended purpose,
- method of use,
- complementarity,
- competition.

Additional factors

- distribution channels,
- relevant public,
- the usual origin of the goods/services.

Please consult the EUIPO Similarity Tool for more concrete examples.



How does the EUIPO compare trade marks in opposition proceedings?



If the signs are not identical, it must be determined whether they are similar or dissimilar. A global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by them, bearing in mind their distinctive and dominant components.



In principle, the comparison will lead to a finding on the degree of similarity in every aspect that may be decisive for the outcome of the decision. Even for identical goods and/or services, a similarity may not be sufficient in itself to lead to a likelihood of confusion. The degrees of similarity are specified by the EUIPO as either low, average or high.

A coincidence in an element with a low degree of distinctiveness will not normally on its own lead to a finding of likelihood of confusion. However, there may be likelihood of confusion if the other components of the mark are of a lower (or equally low) degree of distinctiveness or have an insignificant visual impact and the overall impression of the marks is therefore similar. There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.

The EUIPO follows the principles established by Common Practice 5 of the European Union Intellectual Property Network (Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)).

Examples

- The low degree of distinctiveness of the common component has been sufficient to refuse the opposition.

NO LOC	LOC
<p>MORELUX vs. INLUX (Class 44: Beauty treatments)</p>	<p>COSMEGLOW vs. COSMESHOW (Class 3: Cosmetics)</p>
 <p>(Class 9: Credit cards)</p>	 <p>(Class 43: Holiday accommodation services)</p>

- A non-distinctive common component has been sufficient to refuse the opposition

NO LOC	LOC
<p>BUILDGRO vs. BUILDFLUX (Class 19: Building materials Class 37: Construction services)</p>	<p>TRADENERGY vs. TRACENERGY (Class 9: Solar energy collectors for electricity generation)</p>
 <p>(Class 36: Financial services)</p>	 <p>(Class 9: Solar energy collectors for electricity generation)</p>



Are there any risks after registration?

The rights of the proprietor of an EU trade mark can be revoked (from the date of the request), or an EU trade mark can be declared invalid (with retroactive effect).

Revocation claims are usually based on the absence of genuine use (see the 'use requirement'), while invalidity claims are usually based on absolute and relative grounds.



Can a trade mark in Chinese characters be registered and protected in the EU?

Signs represented in alphabets other than the Latin, Greek or Cyrillic alphabets are considered figurative trade marks. However, this does not mean that the semantic content of these signs will not be taken into consideration. When comparing these marks to other marks aurally, they will not be pronounced.



4

Effects of Change

This chapter presents recent changes or measures that have been taken or major revisions of the Guidelines that can impact users.

4.1 Extension of time limits

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How can I get an extension of the time limits?

In *ex parte* proceedings as well as in inter partes proceedings (where there are two or more parties involved) the requests for extension have to be made before the time limits expire. For more information on this, see the Guidelines, Part C, Opposition, Section 1, Means of communication, time limits, Chapter 4, Time limits specified by the Office, paragraph 3, Extension of time limits.

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. Compliance with them is necessary to ensure clarity and legal certainty.

However, when certain type of exceptional circumstances arise, such as the COVID 19 pandemic and the war in Ukraine, or earthquakes and tsunamis in Japan, the Executive Director may adopt a decision to extend the deadlines.

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4.2 Annual changes to the Guidelines



How does the EUIPO classify virtual goods?

There is a subsection (4.4) in the Guidelines called 'Virtual goods' which includes the EUIPO's approach to the classification of non-fungible tokens (NFTs), virtual goods and virtual services. It particularly states that:



- the term 'virtual goods' per se lacks clarity and precision and must be further specified; when specified, 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; though, 'minting of NFTs' in Class 42 is acceptable given the nature of that particular service;
- services provided online or in virtual environments will be classified according to the underlying nature of the service and considering their impact on the real world; examples have been provided to illustrate the principle.



The Guidelines are updated annually. The links included in the text may lead to an old version of the Guidelines marked as 'Obsolete'. In these instances, please select the latest edition from the menu bar at the top.

The screenshot shows the EUIPO Trade mark guidelines website. The top navigation bar includes a search box, a dropdown menu for 'Trade mark guidelines', and a dropdown menu for 'Edition 2021'. A green box highlights the 'Edition 2021' dropdown, and a yellow arrow points from a 'Edition 2022' label above to it. The main content area displays the title 'Trade mark guidelines' and the section '4.2 Assessment of the figurative threshold'. The text below the section title discusses the presence of figurative elements and the EUIPO's approach to registration as an EUTM.





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