
GUIDELINES FOR EXAMINATION

EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)

Editor's note and general introduction

Obsolete

Table of Contents

1 Subject Matter.....	6
2 Structure of the Guidelines.....	7
Annex 1.....	10
Annex 2.....	14

Obsolete

1 Subject Matter

The process for updating the Trade Mark Regulation (Council Regulation (EC) No 207/2009, which sets out the rules applicable to European Union trade marks and to the Office), has now come to an end.

Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (Amending Regulation¹) was published on 24 December 2015 and entered into force on 23 March 2016. It forms part of the European Union trade mark reform legislative package, which also included [Directive \(EU\) 2015/2436 of the European Parliament and of the Council of 16 December 2015](#), recasting Directive 2008/95/EC of the European Parliament and of the Council.

Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark — codifying the amendments to Council Regulation (EC) No 207/2009 — was published on 14 June 2017 and entered into force on 1 October 2017. It is referred to as ‘the EUTMR’ throughout the Guidelines, which also follow the new numbering of the Articles resulting from the codification.

The Amending Regulation also provided that the European Commission would pass new secondary legislation to complement and further develop its provisions. This has been done by means of two separate acts, Commission Delegated Regulation (EU) 2018/625 (EUTMDR) and Commission Implementing Regulation (EU) 2018/626 (EUTMIR), both of which entered into force on 14 May 2018².

The new secondary legislation repealed Commission Regulations (EC) No 2868/95 and No 216/96 from 1 October 2017. However, it is appropriate to continue to apply specific provisions of those Regulations to certain proceedings that had been initiated before 1 October 2017 until their conclusion. Consequently, both the EUTMDR and the EUTMIR contain detailed transitional provisions that set out when the new procedural rules apply to proceedings.

Annex 1 sets out all of the transitional provisions for the EUTMDR and the EUTMIR, and Annex 2 includes a table of the corresponding legislation indicating where the new rules may be found.

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

¹ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

² These acts repealed Commission Regulations (EU) 2017/1430 and (EU) 2017/1431, which had been in force from 1 October 2017 to 14 May 2018. The principal change was to allow the EUTMDR and EUTMIR to cross-refer directly to Regulation (EU) 2017/1001.

The Guidelines are normally revised by the Office in a cyclical and open process. The work is split into two annual 'work packages': Work Package 1 (WP1), which runs over a twelve-month period from January to December; and Work Package 2 (WP2), which runs over a twelve-month period from July to June.

As some parts of the EUTMR, as well as the EUTMDR and the EUTMIR, take effect from 1 October 2017, and given the important scope of the revision required, an ad hoc revision process of the Guidelines was also necessary, since their 'natural' revision cycle did not coincide with the date on which the new regulatory framework was planned to take effect.

The Office has therefore taken the opportunity to proceed with an exceptional full revision of the entire Guidelines, including not only the new provisions, but also the changes corresponding to the regular WP2.

As usual, the EUIPO also invited its stakeholders to submit comments on the draft Guidelines. Following the consultation process, the updated Guidelines were submitted to the Members of the EUIPO Management Board for written consultation, in order that they could subsequently be adopted by the Executive Director.

The updated Guidelines come into effect at the same time as the entry into force of the new secondary legislation (01/10/2017), and they will also be translated into the other official EU languages.

2 Structure of the Guidelines

The items dealt with in the Guidelines are set out below.

Introduction

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

Chapter 1: General Principles

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 or Acceptable Principles of Morality (Article 7(1)(f) EUTMR)

Chapter 8: Deceptive Trade Marks (Article 7(1)(g) EUTMR)

Chapter 9: Trade Marks in Conflict with Flags and Other Symbols (Article 7(1)(h) and (i) 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 14: Acquired Distinctiveness Through Use (Article 7(3) EUTMR)

Chapter 15: European Union Collective Marks

Chapter 16: European Union Certification 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(6) EUTMR

Section 5: Trade Marks with Reputation (Article 8(5) EUTMR)

Section 6: Proof of Use

Part D: Cancellation

Section 1: Proceedings

Section 2: Substantive Provisions

Part E: Register Operations

Section 1: Changes in a Registration

Section 2: Conversion

Section 3: EUTMs and RCDs as Objects of Property

Chapter 1: Transfer

Chapter 2: Licences, Rights in Rem, Levies of Execution, 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

Examination of Design Invalidation Applications

Annex 1

Transitional Provisions

EUTMDR

<p>Article 82</p> <p>Entry into force and application</p> <p>1. This Regulation shall enter into force on the twentieth day following that of its publication in the Official Journal of the European Union.</p> <p>2. It shall be applicable from the date of entry into force referred to in paragraph 1, subject to the following exceptions:</p>	
<p>a) Articles 2 to 6 shall not apply to notices of opposition entered before 1 October 2017;</p>	<ul style="list-style-type: none"> • Notice of opposition • Languages in oppositions • Admissibility of oppositions • Commencement of the adversarial part
<p>b) Articles 7 and 8 shall not apply to opposition proceedings, the adversarial part of which started before 1 October 2017;</p>	<ul style="list-style-type: none"> • Substantiation and examination of oppositions • Online substantiation • Belated evidence
<p>c) Article 9 shall not apply to suspensions made before 1 October 2017;</p>	<ul style="list-style-type: none"> • Multiple oppositions
<p>d) Article 10 shall not apply to requests for proof of use made before 1 October 2017;</p>	<ul style="list-style-type: none"> • Proof of use in oppositions • Belated evidence
<p>e) Title III shall not apply to requests for amendment entered before 1 October 2017;</p>	<ul style="list-style-type: none"> • Amendment of the application
<p>f) Articles 12 to 15 shall not apply to applications for revocation or for a declaration of invalidity or requests for assignment entered before 1 October 2017;</p>	<ul style="list-style-type: none"> • Application for revocation/invalidity • Languages revocation/invalidity • Admissibility revocation/invalidity
<p>g) Articles 16 and 17 shall not apply to proceedings, the adversarial part of which started before 1 October 2017;</p>	<ul style="list-style-type: none"> • Substantiation revocation/Invalidity • Examination on the merits revocation/invalidity • Suspension of pending revocation invalidity actions
<p>h) Article 18 shall not apply to suspensions made before 1 October 2017;</p>	<ul style="list-style-type: none"> • Multiple applications for revocation or for a declaration of invalidity

i) Article 19 shall not apply to requests for proof of use made before 1 October 2017;	<ul style="list-style-type: none"> • Proof of use for revocation
j) Title V shall not apply to appeals entered before 1 October 2017;	<ul style="list-style-type: none"> • Appeals
k) Title VI shall not apply to oral proceedings initiated before 1 October 2017 or to written evidence where the period for its presentation started before that date;	<ul style="list-style-type: none"> • Oral proceedings and structure and presentation of evidence
l) Title VII shall not apply to notifications made before 1 October 2017;	<ul style="list-style-type: none"> • Notifications by the Office
m) Title VIII shall not apply to communications received and to forms made available before 1 October 2017;	<ul style="list-style-type: none"> • Written communications and forms
n) Title IX shall not apply to time limits set before 1 October 2017;	<ul style="list-style-type: none"> • Time limits and extensions
o) Title X shall not apply to revocations of decisions taken or entries in the Register made before 1 October 2017;	<ul style="list-style-type: none"> • Revocation of a decision
p) Title XI shall not apply to suspensions requested by the parties or imposed by the Office before 1 October 2017;	<ul style="list-style-type: none"> • Suspension of proceedings
q) Title XII shall not apply to proceedings interrupted before 1 October 2017;	<ul style="list-style-type: none"> • Interruption of proceedings
r) Article 73 shall not apply to EU trade mark applications received before 1 October 2017;	<ul style="list-style-type: none"> • Appointment of a common representative
s) Article 74 shall not apply to representatives appointed before 1 October 2017;	<ul style="list-style-type: none"> • Authorisations
t) Article 75 shall not apply to entries on the list of professional representatives made before 1 October 2017;	<ul style="list-style-type: none"> • Amendment of the list of professional representatives
u) Title XIV shall not apply to designations of the EU trade mark made before 1 October 2017.	<ul style="list-style-type: none"> • Procedures concerning the international registration of marks

Transitional Provisions

EUTMIR

<p>Article 39</p> <p>Entry into force and application</p> <ul style="list-style-type: none"> 1. This Regulation shall enter into force on the twentieth day following that of its publication in the Official Journal of the European Union. 2. It shall apply from the date of entry into force referred to in paragraph 1, subject to the following exceptions: 	
<p>a) Title II shall not apply to applications for an EU trade mark entered before 1 October 2017 as well as to international registrations for which the designation of the Union was made before that date;</p>	<ul style="list-style-type: none"> Content of the application Representation of the trade mark Types of mark Priority
<p>b) Article 9 shall not apply to EU trade marks registered before 1 October 2017;</p>	<ul style="list-style-type: none"> Certificate of registration
<p>c) Article 10 shall not apply to requests for alteration entered before 1 October 2017;</p>	<ul style="list-style-type: none"> Content of the request for alteration of a registration
<p>d) Article 11 shall not apply to declarations of division entered before 1 October 2017;</p>	<ul style="list-style-type: none"> Declaration of the division of a registration
<p>e) Article 12 shall not apply to requests for the change of name or address entered before 1 October 2017;</p>	<ul style="list-style-type: none"> Content of a request for the change of the name or address of the proprietor
<p>f) Title IV shall not apply to applications for registration of a transfer entered before 1 October 2017;</p>	<ul style="list-style-type: none"> Transfer
<p>g) Title V shall not apply to declarations of surrender entered before 1 October 2017;</p>	<ul style="list-style-type: none"> Surrender
<p>h) Title VI shall not apply to applications for EU collective marks or EU certification marks entered before 1 October 2017 as well as to international registrations for which the designation of the Union was made before that date;</p>	<ul style="list-style-type: none"> EU collective marks and EU certification marks
<p>i) Title VII shall not apply to costs incurred in proceedings initiated before 1 October 2017;</p>	<ul style="list-style-type: none"> Costs
<p>j) Title VIII shall not apply to publications made before 1 October 2017;</p>	<ul style="list-style-type: none"> Periodical publications

k) Title IX shall not apply to requests for information or inspection entered before 1 October 2017;	<ul style="list-style-type: none"> • Administrative cooperation
l) Title X shall not apply to requests for conversion entered before 1 October 2017;	<ul style="list-style-type: none"> • Conversion
m) Title XI shall not apply to supporting documents or translations entered before 1 October 2017;	<ul style="list-style-type: none"> • Languages and translations
n) Title XII shall not apply to decisions taken before 1 October 2017;	<ul style="list-style-type: none"> • Organisation of the Office
o) Title XIII shall not apply to international applications, notifications of facts and decisions on invalidity of the EU trade mark application or registration on which the international registration was based, requests for territorial extension, seniority claims, notification of ex officio provisional refusals, notifications of invalidation of the effects of an international registration, requests for conversion for an international registration into a national trade mark application and applications for transformation of an international registration designating the Union into an EU trade mark application entered or made before 1 October 2017, as the case may be.	<ul style="list-style-type: none"> • Procedures concerning the international registration of marks

Annex 2

The following may be of particular interest as it provides an indication of the corresponding legislation where the new rules may be found.

New rules on	Apply to	
<ul style="list-style-type: none"> • Content of the EUTM application • Representation of the EUTM • Types of mark • Priority 	Applications for an EUTM entered on or after 01/10/2017.	EUTMIR
<ul style="list-style-type: none"> • Certificate of registration 	EUTMs registered on or after 01/10/2017.	EUTMIR
<ul style="list-style-type: none"> • Languages and translations 	Supporting documents or translations entered on or after 01/10/2017.	EUTMIR
<ul style="list-style-type: none"> • Substantiation and examination of oppositions/invalidity • Online substantiation • Belated evidence 	Proceedings for which the adversarial part started on or after 01/10/2017.	EUTMDR
<ul style="list-style-type: none"> • Appeals 	Appeals entered on or after 01/10/2017.	EUTMDR
<ul style="list-style-type: none"> • Structure and presentation of evidence 	Where the period for presentation of the evidence started on or after 01/10/2017.	EUTMDR
<ul style="list-style-type: none"> • Notifications by the Office and communication with the Office 	Notifications and communication made on or after 01/10/2017.	EUTMDR
<ul style="list-style-type: none"> • Suspension of proceedings 	Suspensions requested or imposed by the Office on or after 01/10/2017.	EUTMDR