

Recent Amendments to Trade Mark Examination Guidelines

EUIPO

TM5/INTA Sixth Joint Workshop
Marianna KONDAS
2 May 2022

Changes implemented in the EU Trade Mark Guidelines for Examination

- Entered into force on 31 March 2022

PART A : General Rules

- Section 5 renamed: All general information on parties in one place
- Employee representatives: Broader definition of real and effective industrial or commercial establishment in the EEA (also for International Applications)
- Obvious errors in the dictum of a decision – Possible correction instead of revocation

PART A : General Rules

- AG decisions will be publicly available irrespective of whether they become final
- Reminder on Data carriers: No encrypted files
- New scenarios where the submission of duplicate copies is now a remediable deficiency
- Implementation of sanctions in case of misuse of User Area credentials

PART B: Examination

- Further guidance on how unclear or imprecise terms can be amended or reclassified
- Update of the Section on Absolute Grounds for Refusal to reflect CP11
- Having ‘a certain resonance’ becomes a key factor in the assessment of distinctiveness for sound marks

PART C: Opposition

- ❖ Under the Section on Likelihood of Confusion:
 - ✓ Update of the text to reflect CP11, namely the particularities concerning the comparison of motion, multimedia and sound marks
 - ✓ Development of guidance on the conceptual comparison of signs with common elements perceived as personal names or consisting of single letters and the global assessment of LOC in those scenarios
 - ✓ Additional clarifications concerning aesthetic complementarity

PART C: Opposition

- ❖ Under the Section on Unauthorised filing by agents of the TM proprietor :
 - ✓ in line with MINERAL MAGIC case, the application of Article 8(3) EUTMR is not limited to “identical marks and identical G&S” cases => Further clarification on the relationship between the marks and between the goods and services.
 - ✓ Article 8(3) EUTMR may still apply when the agreement between the parties concerns only a territory outside the European Union

PART E : Register Operations

- Clarification on when a transfer resulting from the implementation of a national authority becomes relevant before the EUIPO

Geographical Indications (GIs):

- Simplification and flexibility on the wording of limitations when the goods applied for are covered by a protected GI
- Clarification on how GIs can appear in the lists of goods and services – never as generic terms



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