

# **PRIORITY RIGHTS DOCUMENTS**

**User Friendly Summary** 

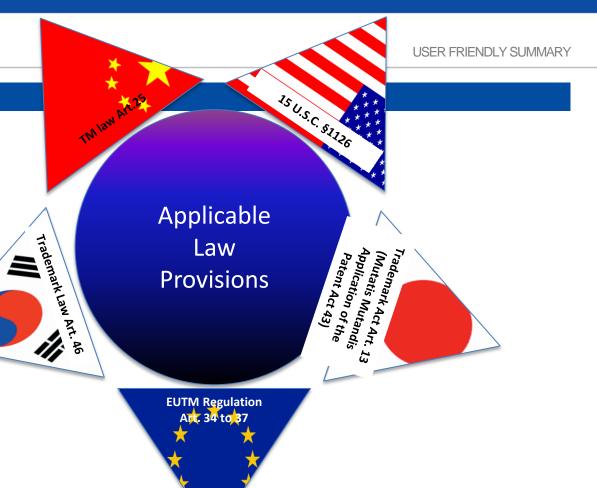




Law Implementing Law Guidelines Fees Declaration of claiming priority Priority Declaration Priority Examination

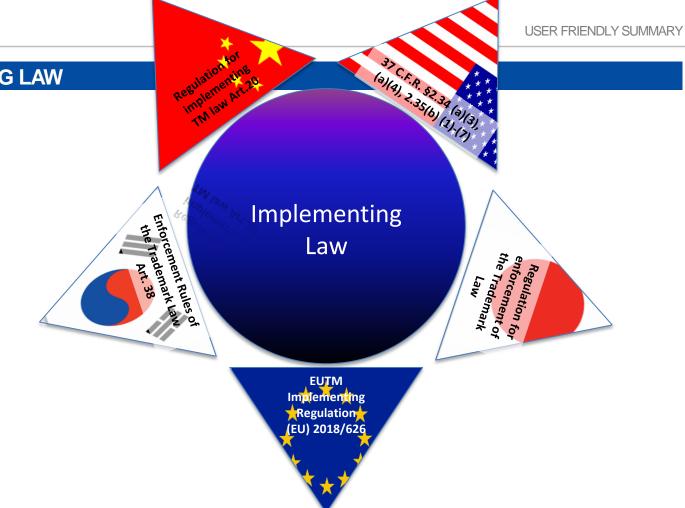








# 2. IMPLEMENTING LAW





# **GUIDELINES**

Trademark Manual of (TNIEP) 58806 1(c)40 1003.1003.08 1(c)40 and 1008.1005.1004 1008.1005.1005.1004 USER FRIENDLY SUMMARY

TM Examniation

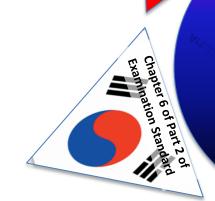
Manual

Trademarks Guidelines for

Examination

Formalities

Law



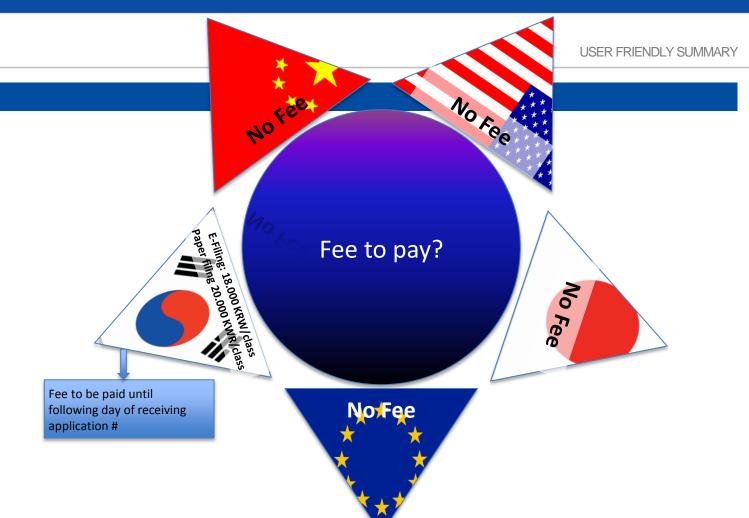
Art.20

# Guidelines

**Part B Examination** Section 2 Formalities **Chapter 11** (Convention) priority



**FEES** 





# 5. DECLARATION OF CLAIMING PRIORITY



when supporting documents are filed on same date as TM application

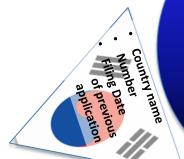
### Declaration not necessary when previous application filing receipt is provided, containing all required info (see next slide)

### USER FRIENDLY SUMMARY

TM U.S. Application suspended until foreign registration is submitted



USER FRIENDLY SUMMARY



# Required Information

Country of pl

application

Date

Filing Date Serial number

application of previous

Number Filing Date

Country name

of previous application

Country

File number • Date • Country • \_ of previous (application)

The number can also be filed together with the copy of previous application.



VES

May the applicant claim the priority of More Than One previous application?

YES 🕇

# YES

YES



USER FRIENDLY SUMMARY

# **PRIORITY DECLARATION**

owing the TM and designated goods ied copy requi **KES** 

Certin

**Obligation to** file a Copy of **Previous TM** application ?

except if Examiner

Certified copy

YES

<sup>required</sup>

NO if required information is available on Previous **Application IP Office** Website



Obligation to file a copy of Previous TM Registration?

VES

n/a

as alternative to copy of a

YES

Submission of previous TM registration copy possible when required info is not available at previous TM IP Office Website



USER FRIENDLY SUMMARY

Registration required

<sup>JP T</sup>M <sup>application</sup>

from filing date of Within 3 months

perfected under paris

Convention Art. 6.

# **PRIORITY DECLARATION**

When to submit the copy of previous TM application/ registration?

Within 3 months From Filme Date

Within

13 months from

filing date of Korea

of Chinese TM

application

When required: Within 3 months from filing date of **EU TM application** 



Obligation to Translate priority documents?

k K

YES

Translated into English

YES

(when required) Translated into EU TM application chosen language #1 or #2 (chosen amongst 23 EUIPO languages)



certified copy, with If not together with month from exam notification

with certified coor TogetherIsame

> When **Translated** documents must be submitted?

If not together with

from the notification.

overseas <sup>res</sup>identsj month (2 months for

Certified copy, within 1

If not together with

certified copy, within 6

months from Examiner

If not together with certified copy, within 2 months from Examiner notification



ZO

Notarization of priority documents requirement?

NO

No



Paper or Electronic

paper

Requested format of Priority Documents?

Electronic format

Paper format

Paper or Electronic



Ar Web or S or Dar a

Are IP Offices Website print-outs or Screen shots or Database extracts acceptable?

NO

≷O



When Priority documents are not submitted: will the TM Examiner look for them online?

ZO

NO

No



- Priority claim not filed in writing
- Number, date or country of previous application is missing
- Priority docs or translations are not submitted before deadline

Formality reasons that trigger refusal of priority claim? USER FRIENDLY SUMMARY

- Priority claim filed after 6 months
- Number, date or country of previous application is missing
  - Priority claim filed beyond 6 months deadline
  - Name of country or filing date of previous application is missing
  - Priority claim is not submitted as requested

- Priority claim filed beyond 6 months deadline
- Priority docs are not submitted as requested



- Priority claim filed after 6 months
- Number, date or country of previous application is missing
- Priority docs are not submitted as requested



appli

Icountry name cation are incol

date

number

Details of previous

In which situations the examiner will invite the applicant to make amendments on formalities?

Obvious mistakes

either appl. <sup>number</sup>or

country name)

obvious error lone of

 Obvious errors •Rectifiable 🕇 formal requirements 🕇



2 1 months as fror examiner's notification

What is the time limit for the Applicant to remedy formality issue?

NIA

6 months as from examiner's notification

from the notification

I month (2 months for overseas residents)

2 months as from examiner's notification



USER FRIENDLY SUMMARY

# May the declaration of Priority claim be withdrawn?

VES

YES

So





### USER FRIENDLY SUMMARY

Same Mark

Same Owner All US application

Goods and services

Good or service At least 1 Same Same Applicant Same Mark

must be

encompassed by

foreign registration

# **PRIORITY EXAMINATION**

Previous • application is a first filing

What are the substantial requirements assessed by the Office?

Claim must be made by ٠ an eligible person

Same App Same Mark At least 1 same

same Trademark

ഹ

tleast 1 same E

or service

tood or service

Claim must be based on • the earliest application filed in the first country

Same Mark Same Applicant At least 1 same good or service



USER FRIENDLY SUMMARY

# At the examination stage

immediatelyatter

application documents submission of

or proceed ocurrents

# When is substantial examination carried out by the Office ?

If application under

At the examination

Stage

Paris Art. 6-Quinquies

during examination of

No examination during filing 🔶 stage 🔶 but during 'inter-partes' and restricted to (inter-partes) proceedings



# IES

date of priority S If claim 81

included in the ublehed application

> Is priority information published; if so, what?

VES

Nothing if claim is

Branted.

refused

bulletin if claim is and the registration

3.

of the claim

Particulars

the filing bulletin,

Particulars of the claim: "claimed","abandoned" 📩 or "refused

- Foreign registration #, date, country name, expiration date, renewal date
- Foreign priority claim "Yes", application #, filing date Filing and current basis for each class of G&S, incl. priority under Paris Art.6-Quinquies "Currently 44E yes" mention where applicable



May the TM application and the previous application be of different types shape, etc...?

if Marks can be onsidered identical

VES

IGenerally NO

<sup>considered identical</sup>

if Marks can be

YES

YES if Marks can be considered identical



tes if

Goods & Servi are identical

YES

May the TM application and the previous application be of different types certification mark?

> YES when compatibility exist

NO

Goods & Services are if applicant, Marks and

VES

identical

Compatibility exists between collective and certification marks. No compatibility between a) individual and b) collective/certification marks



In assessing the marks, will the Office consider any colour indication in the original application, or details such as Capital letters, accents, punctuation, in one or two words, etc...?

IES

Applicant seeks resistration under Art. 6-Quinquies

YES



In assessing the Trademarks, will the Office check on the Goods & Services ?

> in inter parter proceedings)

IES

Applicant seeks resistration under Art. 6-Quinquies

YES



Will the Office consider Goods & Services Synomymous terms?

YES

USER FRIENDLY SUMMARY

Applicant seen osris Art. 6-Quinquies

YES



Unless if Obvious error in previous Trademark, Or Unless difference in Offices classification practice Will the Office consider Goods & Services Identical terms in different Classes?

Inprint

VES

USER FRIENDLY SUMMARY

Unless if Obvious error in previous Trademark, or unless previous Trademark country does not follow Nice Classification Or Unless difference in Offices classification practice

Unless if Obvious error in previous Trademark,

In principle NO

unless previous Trademark country does not follow Nice Classification

or

Paris Art. 6-Quinquies



USER FRIENDLY SUMMARY

# **PRIORITY EXAMINATION**

Must TM applicant be the same as previous TM applicant/Owner?

successors in the

including successors in ti

or in law

VES

successors in title or in law including 7 ĒS

VES

FS including 📩 successors in title or in law



Imust be earlier than Th When applicant is different from previous TM applicant/owner, can an assignment of priority be accepted?

be earlier the application

ES.

(múst be eár<u>lier</u> than M application

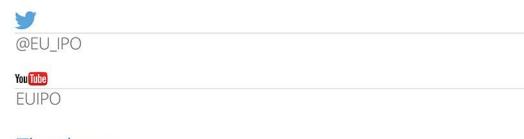
USER FRIENDLY SUMMARY

Paris Art. 6-Quinquies

YES



www.euipo.europa.eu



Thank you



Presentation		
Status	DRAFT / APP	
Approved by owner	-	
Authors	- CG	Christophe GIMENEZ
	-	
Contributors	-	
	-	

Revision history				
Version	Date	Author	Description	
0.1	DD/MM/YYYY			
0.1	DD/MM/YYYY			
0.1	DD/MM/YYYY			