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The International
Trademark System



Understanding Examination and Refusal Procedures at the EUIPO

Madrid System Webinar

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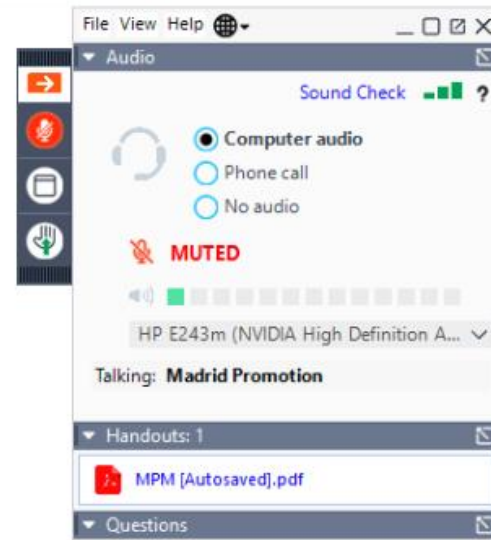
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Structure of the Webinar

- Presentation
- Questions and answers session at the end
- Presentation slides available for download
- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

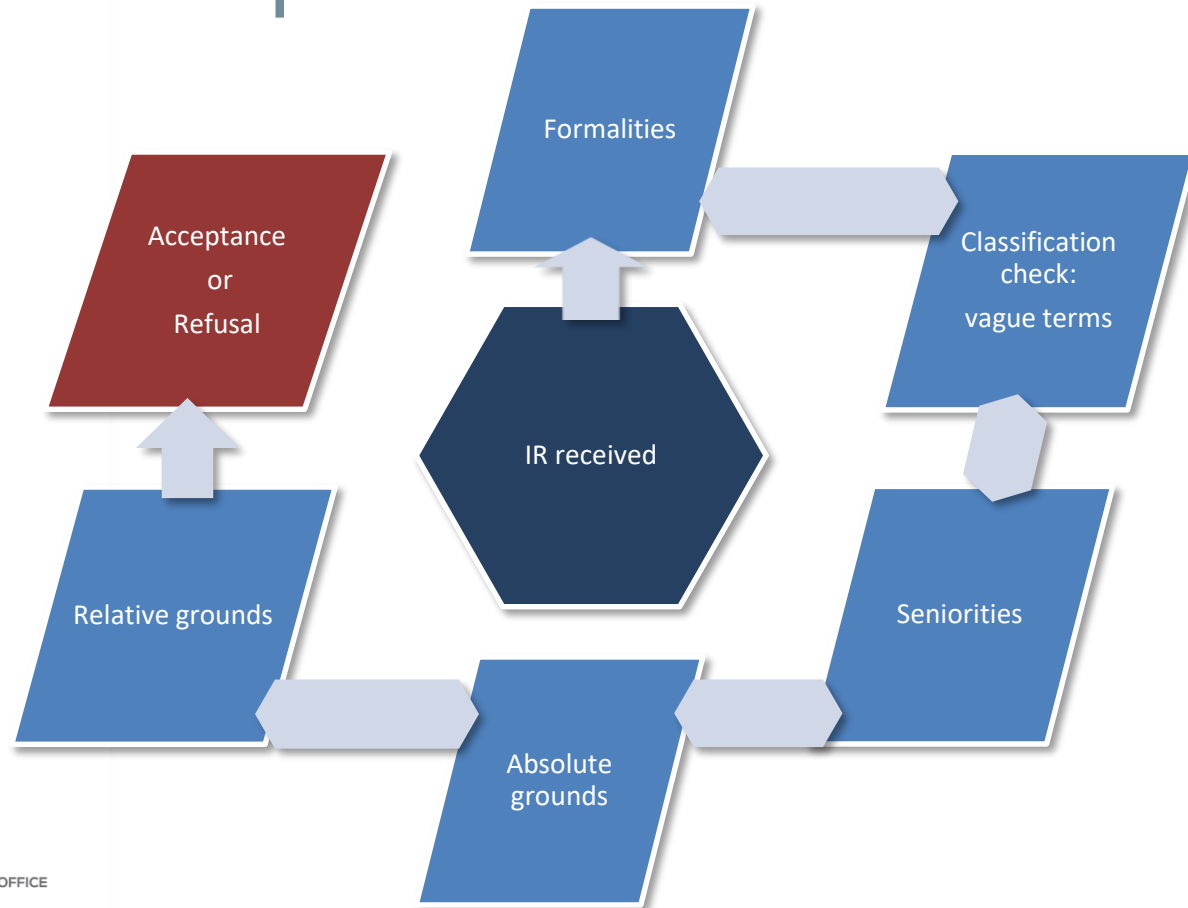
WIPO and the European Union

- Adhesion to the Madrid Protocol in 2004 (01/10/2004)
- Designation for the EU covers 27 countries and 23 languages
- Period of 18 months to notify refusals (Article 5(2)(b) of the Protocol)
- Individual fees required (Article 8(7)(a) of the Protocol)
- Division possible
- Mergers not available (Rule 27ter(2)(b) of the Regulations under the Protocol)
- <https://www.wipo.int/madrid/memberprofiles/information>

Content of the Webinar

- Examination of formal requirements/limited lists
- Examination of vague terms in list of goods and services
- Seniority claims
- Objections on absolute grounds for refusal
- Opposition proceedings
- Miscellaneous

Flowchart of procedure



IRs designating the EU

- Reception of international registrations designating the EU electronically (XML format)
- Republication in part M1 of the EUTM bulletin to open an opposition period
- No national number allocated to the IRs
- Designations identified by IR No. preceded by W0 for a first designation, W1 for a subsequent designation, etc. (ex.: W01194708 / W10868220)
- 18-month deadline to notify any provisional refusal to WIPO

Examination of formal requirements/limited lists

- If the European Union is designated, it is compulsory to indicate a second language before the Office of the European Union, among the 5 official languages (EN, FR, ES, DE, IT) and different from the 1st language
- collective/certification marks: the regulation of use must be submitted within 2 months from the notification date of the IR to the EUIPO. If not submitted a provisional refusal will be issued
- type of mark: the IRs are received without indication as to the type of mark (except word marks, 3D, colour as such or sound marks). EUIPO indexes the marks according to the representation and the description if available
- limited lists: if the designation is only for part of the goods and services of the IR's basic list, EUIPO examines that the limited list is not broadening the scope of protection.

Tips and tricks to avoid provisional refusals

- Designate 2nd language
- Submit Regulation of use within 2 months

Attention!

- Designate EUIPO representative if holder outside EEA and provisional refusal issued

Professional representation

Only required when the holder of the IR is from outside the EEA and a provisional refusal has been issued.

- Appointment of representative (complying with Art. 119 and 120 EUTMR) required only in case of provisional refusal. Representative before WIPO appointed in a file, if included in EUIPO representative database, shall become automatically representative before EUIPO
- For formalities and relative grounds issues: if no representative appointed it will lead to the total refusal of the IR (even if the provisional refusal is partial)
- For classification or absolute grounds issues, if the provisional refusal is partial, the objected terms will be refused and the IR may proceed for the remainder

Examination of vague terms in the list of goods and services

The classification is examined by WIPO.

- EUIPO practice is to examine only if vague terms are included in the specification. You can check all Terms lacking clarity and precision, as well as the General indications of Nice Classification class headings lacking clarity and precision.

Examination of vague terms in the list of goods and services (2)

- The Guidelines also provide a Classification Annex which contains additional terms that should be avoided because they lack clarity and precision, as well as notes on classification practice (including words or phrases that should not be used).

Examples:

- Machines in class 7
- Goods made of leather in class 18
- Repair and installation services in class 37
- Retail and wholesale services in class 35
- Electric and electronic goods/apparatus (any goods class)
- etc.

Examples (2):

- TM are not allowed in List of goods and services
- The sale of... it must be clarified if it is retail or wholesale services in relation to XXX
- Robots – specify what kind of, like industrial robots (cl 7) or smart robot toys (cl 28)
- GI´s need to be specified

Examples (3):

The Office will only object if the mention to GI or AOP is missing.

Recommended wording: directly indicate either GI or AOP in the IR.

Examples of possible provisional refusals.

- Champagne, Scotch, Whisky

The expressions should be reworded to read:

- “Champagne” (GI) wine, “Scotch Whisky” (GI) Whisky.

Examples (4):

- Olives stuffed with feta cheese in sunflower oil would be objected to be reworded:
 - Olives stuffed with feta (GI) cheese in sunflower oil

The Office will add ex -officio inverted commas in these cases: (AOP included)

- Vin d'appellation d'origine protégée Champagne
- Vin d'appellation d'origine protégée “Champagne”

Seniority claim

- A specific mechanism foreseen in the EUTM regulation
- It allows the holder to consolidate his rights through the seniority claim for identical earlier EU member states national/regional registered trade mark
- It can be claimed by the proprietor of an **IDENTICAL** earlier national/regional registered trade mark in a EU Member State or registered under the Madrid Protocol and having effect in a EU Member State.

Seniority claim (2)

- The holder designates the EU and **at the same time** claims seniority of earlier identical trade marks before WIPO by using the MM17 form. It is governed by Article 191 EUTMR, Rule 9 (5) (g) (i) and Rule 21 bis of the Regulations under the Protocol.
- **After the acceptance** of the EU designation according to Article 192 EUTMR and Article 32 EUTMIR by filing directly at EUIPO the seniority claim request.

Seniority claim (3)

A valid seniority claim must contain:

- EU Member State in which earlier right is registered
- Filing date of relevant registration
- Registration number

Seniority claim (4)

Examination of seniority claims : What does the EUIPO check?

- It should be an **earlier** right
- The marks should be identical
- Trademark **registered** and **in force** in a EU Member State **at the moment of the EU designation** of the IR if seniority claimed at the same time of the EU designation
- Trademark **registered** and **in force** in a EU Member State **at the moment of the reception at EUIPO of seniority claim request** if claimed after acceptance of the EU designation.

Seniority claim (5)

- If seniority claim **accepted** by the EUIPO: IP offices and WIPO are informed
- If irregularities: Deficiency letter sent with a 2 months time limit to remedy.
- If no reply or deficiency cannot be remedied: **Loss of seniority right** if seniority was claimed together with EU designation or **Refusal of seniority right** if seniority was claimed after the acceptance of the EU designation.

Objections on absolute grounds for refusal (Art. 7 EUTMR)

- Marks that are not clear and precise
- Devoid of any distinctive character
- Descriptive trademarks
- Customary signs or indications
- 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

Objections on absolute grounds for refusal (Art. 7 EUTMR) (2)

- Trademarks contrary to public policy or acceptable principles of morality
- Deceptive trademarks
- Trademarks in conflict with flags and other symbols

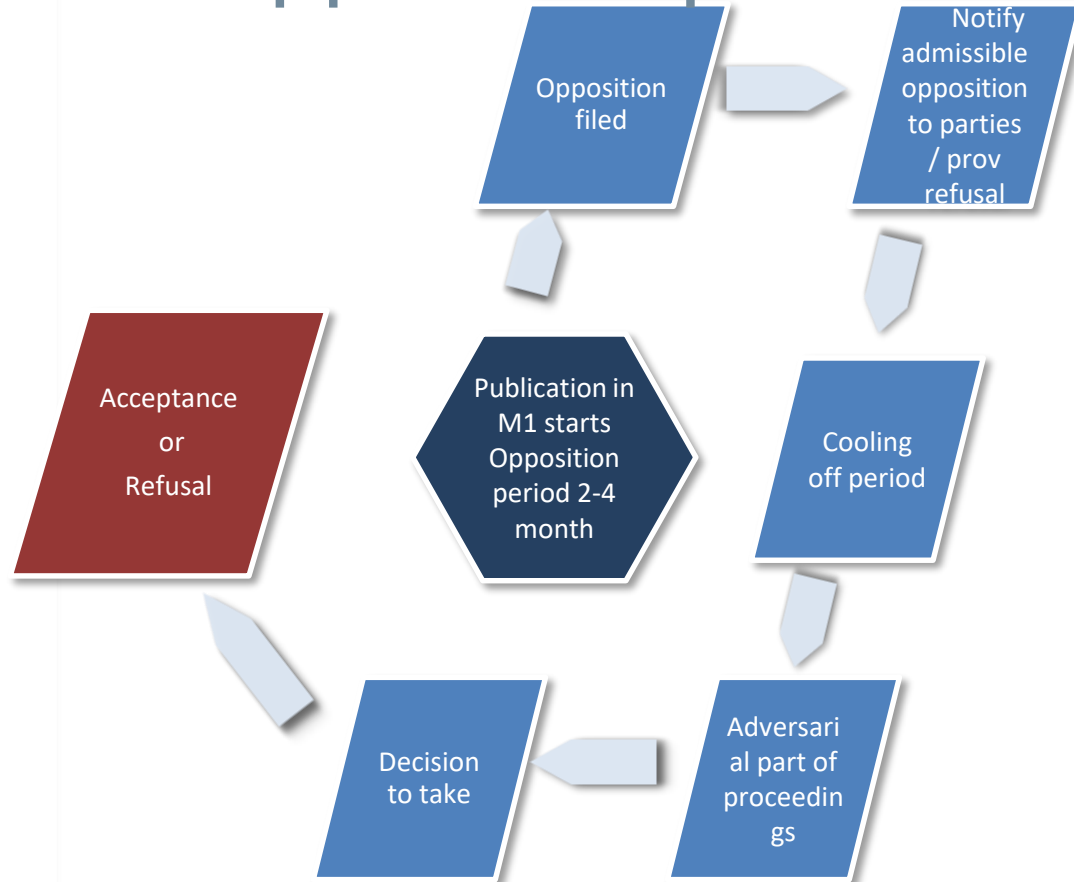
Objections on absolute grounds for refusal (Art. 7 EUTMR) (3)

- Trademarks in conflict with geographical indications
- Trademarks in conflict with traditional terms for wines
- Trademarks in conflict with traditional specialities guaranteed
- Trademarks in conflict with earlier plant variety denominations

Opposition proceedings

- No examination ex-officio of relative grounds
- Three-month opposition period starts from 2nd to 4th month after republication in part M1 of the EUTM bulletin
- No declaration under Art. 5(2)(c) of the Protocol **(possible notification of refusals based on an opposition after the 18-month time limit)**
- Opposition procedure suspended if ex-officio provisional refusal also issued

Flowchart of opposition procedure



Upon receipt of the opposition

- The IR holder or its representative before the WIPO, if any, even if located outside the EU is immediately informed, he can access the electronic file of the IR designating the EU including the opposition notice at <https://euipo.europa.eu/eSearch/> and he is informally advised of the need to appoint a representative before the Office if the IR holder is located outside the EEA.
- Identical procedure than for oppositions against EUTMs (except limitations, renunciations of the designation)

Example

- Opposition received on 04/05/2022 – Holder outside EEA
- Receipt sent to the Holder or WIPO representative on 06/05/2022: giving an informal time limit to appoint a rep. before EUIPO – Deadline 06/06/2022
- No rep. appointed: on 14/06/2022 provisional refusal on relative grounds sent to WIPO and notification of admissible opposition sent to the parties

Example (2)

- Cooling-off period and date to appoint a representative will end on 14/08/2022
- the time limit for the opponent to substantiate the earlier rights expires on 14/10/2022
- the time limit for the applicant to submit his observations in reply will expire on 14/12/2022.

Time limits

- Two months from issuance of the provisional refusal by EUIPO.
 - Except for submission of the regulation of use for certification/collective marks
- Extension of time limit possible for 2 months up to 6 months

Time limits (2)

- Continuation of proceedings possible (similarly to direct EUTMs): Within 2 months of the expiry of the unobserved time limit, provided that the omitted act has been carried out and the fees are paid. (art. 105 EUTMR)
- Appeal period within 2 months of the final refusal (sent to the IR holder if no representative has been appointed, if applicable)

Limitations / Renunciation

- Limitations filed before EUIPO only possible if a provisional refusal has been issued. They will be examined and if they do not comply with our practice the office will raise a deficiency. The limitation must be acceptable in a whole.

Limitations / Renunciation (2)

- Limitations requested before WIPO will be examined by the office and if they do not comply with our practice a Declaration that limitation has no effect will be sent to WIPO. The limitation must be acceptable in a whole. There is no appeal possible, and a new limitation must be filed.
- Renunciation of the EU designation must be filed through WIPO (no direct withdrawal possible).

Acceptance of the designation

- All accepted designations are republished in part M.3.1 of our Bulletin >> starting point of the five years use period from which the registration may be invoked against an infringer.
- If no ex officio refusal issued and no opposition received
- Statement of Grant of Protection sent automatically to WIPO (no certificate of registration)

Grant of protection or refusal of the designation

- If one or more provisional refusals issued
- Final decision of total refusal is sent to WIPO, **OR**
- Statement of Grant of Protection (total/partial) is sent to WIPO once all proceedings are completed and appeals exhausted

Conversion of IRs designating the EU

- Conversion is the process of turning a European Union trademark (EUTM) application or registration into one or more national applications if the EUTM faces a registrability problem
- into national trademark applications in one, several or all of the Member States;

Conversion of IRs designating the EU (2)

- into subsequent designations of one or more Member States under the Madrid Agreement or Protocol ('opting back'), provided that the Member State was a party to either Treaty, not only at the time of the request for conversion, but also on the date of the designation of the EU;

Conversion of IRs designating the EU (3)

- into national trade mark applications for some Member States and subsequent designations for other Member States. The same Member State may only be selected once.
- NOTE: The “opting back” formula is not possible for Malta as it is not a member of the MP

Grounds for conversion:

- the IR designating the EU has been finally refused by the Office ([Article 78\(5\)\(b\) and \(c\) EUTMDR](#), [Article 33\(2\)\(b\) and \(c\) EUTMIR](#));
- the IR has been invalidated by the EUIPO or an EUTM court ([Article 198 EUTMR](#), [Article 34 EUTMIR](#));
- where a renunciation of the designation of the EU has been recorded in the International Register (Rule 25(1)(a)(iii), Rule 27(1) Regulations under the Protocol);
- where the Office is informed by WIPO that the IR has not been renewed for the EU, provided that the grace period for renewal is over (Rule 31(4)(b) Regulations under the Protocol);
- where the partial or total cancellation of the IR has been recorded in the International Register (Rule 25(1)(a)(v), Rule 27(1) Regulations under the Protocol);
- where a limitation of the list of goods and services for the EU has been recorded in the International Register (Rule 25(1)(a)(ii), Rule 27(1) Regulations under the Protocol) (see [paragraph 6.2.7](#) below and also [Guidelines, Part M, International Marks, Section 3, The EUIPO as Designated Office, paragraph 3.8, Limitations of the list of goods and services](#));⁽¹⁾

Corrections

- Further to a notification of correction from WIPO the examination might be reopened in case of a substantial modification (change of date, amendment of mark representation, addition of a new class(es))
- Where necessary, examination reopened / further republication for opposition purposes.
- Possible impact on open examination/ opposition procedures.

A few Statistics for 2021

- IRs designating the EU: ca. 29.000
- Deficiencies on formalities: 0,4%
- Deficiencies on vague terms: 8,6%
- Deficiencies on seniority claims: 10.38%
- Deficiencies on AG: 5,2%
- Oppositions received: 6,2%

Legal Texts

- European Union trade mark regulation
- European Union trade mark delegated regulation
- European Union trade mark implementing regulation
- EUIPO guidelines (Part A, B, C, E, M)



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October 5, 2021

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Panasonic provides a wide range of products and services that are used in consumers' daily lives worldwide. These include home appliances, the electronic components used in them, housing and various services.



With more than a hundred years of experience, the company has been thoroughly committed to creating a better life for its users under the brand slogan of "A Better Life, A Better World".

Over the years, Panasonic introduced several business brands to achieve further growth and greater brand value in each area of business. In 2008, the corporation changed its name from the Matsushita Electric Industrial Co., Ltd to the Panasonic Corporation, consolidating its brand identity.

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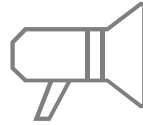


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