

Feedback form for comments on the draft Guidelines

User Association/National Office	International Trademark Association (INTA)
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Contributor (name & position)	NONTRADITIONAL MARKS COMMITTEE
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B Section 4. Absolute Grounds for Refusal – Article 7(1)(e)
Page of the document	p.79
Issue(s) you wish to comment on	The addition of the words "or some other characteristics" as a ground for refusal for exclusion from registration of signs.
Suggestion for text	Very little explanation is provided (apart from some examples such as the sound of a motorcycle engine for a sound mark), and the guidelines say that there is no case law on what "another characteristic" means. It would be good to assuage some concerns around this wording by confirming that it will be applied restrictively (e.g. not to word marks).
Contributor (name & position)	GEOGRAPHICAL INDICATIONS COMMITTEE
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B, EXAMINATION, SECTION 4, ABSOLUTE GROUNDS FOR REFUSAL, ARTICLES 7(1)(j) EUTMR
Page of the document	37
Issue(s) you wish to comment on	2.10 Art 7(1)(j) EUTMR: Comments on the exhaustive nature of the EU system of protection
Suggestion for text	<p>The guidelines take it for granted that the mentioned EU regulations are exhaustive in nature, whereas according to the General Court, the Regulation on the protection of geographical indications for wines is not exhaustive (see Case T-659/14 Instituto dos Vinhos do Douro e do Porto, IP v OHIM — Bruichladdich Distillery - PORT CHARLOTTE). Similarly, one could consider that the EU systems for PDOs / PGIs for spirit drinks are not exhaustive.</p> <p>Therefore, with the exception of agricultural products and foodstuffs, and, in the future, of aromatised wines, it does not follow from the existence of the mentioned EU Regulations that national legislation referred to in Article (1)(j) EUTMR is limited to the area of non-agricultural PDOs/PGIs not covered by the mentioned EU Regulations. This has only been clarified with regard to agricultural products and foodstuffs.</p> <p>By analogy, as regards international agreements concluded by Member States only, INTA respectfully disagrees with the interpretation that they are applicable only for non-agricultural products.</p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B, EXAMINATION, SECTION 4, ABSOLUTE GROUNDS FOR REFUSAL, ARTICLES 7(1)(j) EUTMR
Page of the document	50/51
Issue(s) you wish to comment on	2.10.3.5 The exploitation of the reputation of PDOs/PGIs
Suggestion for text	<p>The EU Trade Mark Regulation does not exclude the case of an exploitation of the reputation of a PDO/PGI from absolute grounds examination. Thus, it is problematic if the guidelines state that basically such examination will not take place by simply referring to the possibility of filing opposition against a trademark exploiting the reputation of a PDO/PGI.</p> <p>While INTA sees that for practical reasons, extending the absolute grounds examination to such cases, the Office should endeavour to carry out a full examination. This means that in obvious cases of exploitation of the reputation of a PDO/PGI with reputation, a trademark application should be rejected on absolute grounds.</p>
Contributor (name & position)	GEOGRAPHICAL INDICATIONS COMMITTEE
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B, EXAMINATION, SECTION 4, ABSOLUTE GROUNDS FOR REFUSAL, ARTICLES 7(1)(j) EUTMR
Page of the document	51
Issue(s) you wish to comment on	2.10.3.6. Limits to the scope of protection
Suggestion for text	<p>INTA welcomes the explanations relating to the following limits to the scope of protection:</p> <ul style="list-style-type: none"> - where a PDO/PGI contains a part that is considered generic, or commonly used in trade, the part of the PDO/PGI that is considered generic (protection does not extend to the generic or common element) - where a PGI/PDO coincides with family names, when used in combination with other elements.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B, EXAMINATION, SECTION 4, ABSOLUTE GROUNDS FOR REFUSAL, ARTICLES 7(1)(j) EUTMR
Page of the document	60/61
Issue(s) you wish to comment on	2.10.5.1 PDOs/PGIs protected at national level in an EU Member State
Suggestion for text	<p>The Court of Justice has stated that the EU system of protection for PDOS/PGIs for agricultural products and foodstuffs laid down in the EU Regulation is exhaustive in nature.</p> <p>Due to a divergence in text, the analogous approach of the Office is problematic. Accordingly, the GC takes a different approach with regard to wines (see Case T-659/14 Instituto dos Vinhos do Douro e do Porto, IP v OHIM — Bruichladdich Distillery (PORT CHARLOTTE)).</p> <p>The EU system of protection with regard to wines, and spirits, does not necessarily override and replace national protection.</p> <p>Apart from the question of exhaustive nature of the different EU regulations, the draft guidelines indicate that in lack of a database for national PDOs/PGIS operated by OHIM or the Commission, the Office will principally rely on observations by third parties.</p> <p>INTA observes that such examination practice would not be in compliance with the Office's obligation to carry out a full examination on absolute grounds. Taking into account practical difficulties, the Office should at least endeavour to take national PDOs/PGIs into account where accessible.</p>
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Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B, EXAMINATION, SECTION 4, ABSOLUTE GROUNDS FOR REFUSAL, ARTICLES 7(1)(j) EUTMR
Page of the document	63
Issue(s) you wish to comment on	2.10.5.2 c) The geographical indication is protected under an international agreement signed only by Member States
Suggestion for text	<p>As stated above (comments on 2.10.5.1), The EU system of protection with regard to wines and spirits, does not necessarily override and replace national protection. Therefore, international agreements signed only by Member States relating to wines or spirits need to be taken into account in the Office's absolute grounds examination.</p> <p>Moreover, as far as the draft guidelines indicate that in lack of a database for PDOs/PGIS protected under an international agreement on a national level, the</p>

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	Office will principally rely on observations by third parties, again, such examination practice would not be in compliance with the obligation to carry out a full examination on absolute grounds. Taking into account practical difficulties, the Office should at least endeavour to take national PDOs/PGIs into account where accessible.
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Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B, EXAMINATION, SECTION 4, ABSOLUTE GROUNDS FOR REFUSAL, ARTICLES 7(1)(I) EUTMR
Page of the document	72
Issue(s) you wish to comment on	2.12.5 International Agreements
Suggestion for text	The draft guidelines indicate that in lack of a database for TSGs protected under international agreements, the Office will principally rely on observations by third parties. Again, such examination practice would not be in compliance with the obligation to carry out a full examination on absolute grounds, and the Office should at least endeavour to take such TSGs into account in its absolute grounds examination.
Contributor (name & position)	OHIM SUBCOMMITTEE OF TRADEMARK OFFICE PRACTICES COMMITTEE
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, section 4 – Absolute Grounds for Refusal - Chapter 2.13.3, Situations covered by Article 7(1)(m) EUTMR
Page of the document	101 (point 4)
Issue(s) you wish to comment on	The proposed text does not refer to the situation where the specification of a EUTM application includes “live plants”. It is not clear in this specific case whether the exclusion of the plant varieties of the same species as those protected by the registered plant variety denomination would be sufficient to overcome the refusal.
Suggestion for text	4. The EUTM application includes plant varieties of the same species as, or of species closely related to, those protected by the registered plant variety denomination. In case the specification includes general terms such as for example “live plants”, the exclusion of the plant varieties of the same species as those protected by the registered plant variety denomination will be accepted by the Office.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, section 4 Absolute Grounds for Refusal -Chapter 2.13.3.1, Registered plant variety denominations
Page of the document	101 (second paragraph from the bottom) [referring to version with track changes]
Issue(s) you wish to comment on	<p>“Pursuant to Article 19(1) of Regulation (EC) No 2100/94, plant variety rights expire after 25 years, or 30 years in the case of varieties of vine and tree species.”</p> <p>The term of expiration under Regulation (EC) No 2100/94 falls at the end of the relevant year which is different than in case of trademarks. Thus, INTA suggests to change the paragraph to follow the above mentioned regulation.</p>
Suggestion for text	Pursuant to Article 19(1) of Regulation (EC) No 2100/94, plant variety rights expire at the end of 25 th calendar year, or 30 th year, in the case of varieties of vine and tree species, following the year of grant.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part C, Chapter 2.5.1, Time of Use – Oppositions filed on or after entry into force
Page of the document	22 (first paragraph) [referring to version with track changes]
Issue(s) you wish to comment on	<p>With respect to IRs designating the EU, the Guidelines only speak of the “date of the registration or, as the case may be, the date of subsequent designation”.</p> <p>However, Article 42(2) EUTM refers to “during the five-year period preceding the date of filing or the date of priority of the EU trade mark application”.</p> <p>There is no apparent reason not to take into account the priority date in the case of IRs designating the EU. The text should be amended to clarify that the situation is identical, mutatis mutandis, for IR designations.</p>
Suggestion for text	<p>For oppositions filed against international registrations designating the EU, the opponent’s mark is under the use obligation if, on the date of registration <u>or priority (where applicable, and whichever is earlier)</u> or, as the case may be, on the date of subsequent designation of the Union in the international registration, it has been registered for not less than five years.</p> <p>(underlined text to be amended)</p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 1 Procedural Matters
Page of the document	P.23
Issue(s) you wish to comment on	Even though art. 8.4(a) EUTR refers exclusively to “person”, the word “persons” might be understood only as “natural persons”. The text should be amended to make it clear that also legal entities duly authorised are entitle to bring oppositions.
Suggestion for text	To be amended as follows: “If the notice of opposition is based on the grounds of Article 8(4a) EUTMR, it may be filed by persons or entities authorised...”

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 1 Procedural Matters
Page of the document	P.41
Issue(s) you wish to comment on	4.2.3.7. Entitlement to file the opposition Even though art. 8.4(a) EUTR refers exclusively to “person”, the word “persons” might be understood only as “natural persons”. The text should be amended to make it clear that also legal entities duly authorised are entitle to bring oppositions.
Suggestion for text	To be amended as follows: “4. Persons or entities authorised....”

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 1 Procedural Matters
Page of the document	P.41
Issue(s) you wish to comment on	4.2.3.7. Entitlement to file the opposition.- <u>Example</u> See comment above. In the fourth paragraph of the example, “entities” should also be included in addition to “persons”
Suggestion for text	To be amended as follows: “The same applies to persons or entities authorised...”

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 1 Procedural Matters
Page of the document	P.43
Issue(s) you wish to comment on	4.2.4.4. Protected designations of origin, protected geographical indications. In the explanations given under this subtitle, two different expressions are used on the one hand, “ <u>protected</u> designations of origins and <u>protected</u> geographical indications”; and on the other “designation of origin and geographical indication”. In order to be consistent, the same language should always be used. Moreover it will make it clear that “protected” does not mean “registered”.
Suggestion for text	To amend the wording in order to be consistent.

Contributor (name & position)	OHIM SUBCOMMITTEE OF TRADEMARK OFFICE PRACTICES COMMITTEE
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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 1 Procedural Matters
Page of the document	P.43
Issue(s) you wish to comment on	4.2.4.4. Protected designations of origin, protected geographical indications (first para.) In order to be coherent the expression “EU trade mark” should be changed for “EUTM”.
Suggestion for text	To amend the wording in order to be consistent.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 1 Procedural Matters
Page of the document	p.43
Issue(s) you wish to comment on	<p>4.2.4.4. Protected designations of origin, protected geographical indications (second para. in relation with fourth and fifth paras.)</p> <p>In the second paragraph, a list of 4 key elements that need to be proven is provided: “evidence of the <u>acquisition (1)</u>, <u>continued existence (2)</u> <u>scope of protection of the earlier right (3)</u> and entitlement <u>to prohibit the use (4)</u> of a subsequent trade mark.”</p> <p>However while analysing the content of the following two paragraphs it seems that such list should be amended in the following way:</p> <ul style="list-style-type: none"> - Acquisition should be changed for “entitlement” (the word acquisition is directly related to and evidenced by its “existence”)
Suggestion for text	To be amended as above proposed.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 1 Procedural Matters
Page of the document	P.43
Issue(s) you wish to comment on	<p>4.2.4.4. Protected designations of origin, protected geographical indications</p> <p>Reference to unregistered rights</p>
Suggestion for text	We question if the reference to unregistered rights is appropriate in this context since the wording of Article 8(4a) lists a registration amongst its requirements.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 4 – Rights under Articles 8(4) and 8(4a) EUTMR <ul style="list-style-type: none"> Article 8(4) CTMR, which restrictsEUTMR is the <u>scopeground</u> of <u>protection in</u> opposition <u>proceedings to against an EUTM application based on an</u> earlier non-registered trade marks andmark or other signssign used in the course of trade of more than mere local significance;
Page of the document	p.3
Issue(s) you wish to comment on	<ul style="list-style-type: none"> Article 8(4) CTMR, which restrictsEUTMR is the <u>scopeground</u> of <u>protection in</u> opposition <u>proceedings to against an EUTM application based on an</u> earlier non-registered trade marks andmark or other signssign used in the course of trade of more than mere local significance; <p>The expression “of more than mere local significance” has been deleted in this paragraph but it is still applicable and can be found later on in the text.</p>
Suggestion for text	To keep the expression : of more than mere local significance

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 4 – Rights under Articles 8(4) and 8(4a) EUTMR
Page of the document	p. 7
Issue(s) you wish to comment on	<p>3.2.3 Other signs used in the course of trade</p> <p>The expression “business identifiers” has been replaced by “signs used in the course of trade” whereas in the rest of the text “business identifiers” was replaced by “trade signs identifying commercial origin”</p>
Suggestion for text	To change the title into 3.2.3 Other trade signs identifying commercial origin

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part C / Section 2 / Chapter 2 – Comparison of Goods and Services
Page of the document	p.56
Issue(s) you wish to comment on	<p>Item 7.3 - It appears that there is a typo in the last sentence of this item. This is not an item amended under the current review process, so it seems that this has been overlooked in previous reviews. The current wording is:</p> <p>Too broad a protection would be given to retail services if similarity is found where the goods sold at retail are only highly similar or similar to the goods covered by the other mark.</p>
Suggestion for text	<p>Too broad a protection would be given to retail services if similarity is found where the goods sold at retail are only highly dissimilar or dissimilar to the goods covered by the other mark.</p> <p>OR</p> <p>Too broad a protection would be given to retail services if similarity is found where the goods sold at retail are only highly slightly similar or entirely dissimilar to the goods covered by the other mark.</p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 4 – Rights under Articles 8(a) and 8(4a) EUTMR
Page of the document	p.67 – UK – Passing off
Issue(s) you wish to comment on	The examples that were given in the old version of the guidelines and that were referring to passing off have not been added in the table in the new version. Such case law references would be useful.
Suggestion for text	To add the case law previously provided. Ideally, as we previously proposed: to add case law, when available, for each country, for each type of rights (see comments below).

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 4 – Rights under Articles 8(4) and 8(4a) EUTMR
Page of the document	p.39 to 68 Table on national rights
Issue(s) you wish to comment on	<p>The table refers to the applicable law of each country.</p> <p>There are already a few decisions from the Office and BOA referring to some of the applicable laws and possible type of rights; it would be very useful to have a reference to each existing case.</p>
Suggestion for text	To add case law, when available, for each country, for each type of rights.
Contributor (name & position)	GEOGRAPHICAL INDICATIONS COMMITTEE
Linguistic version the comments refer to	EN* DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	<p>Part C – Opposition – Section 4 5.2.1.2. Specificities of substantiation. 1st alinea and 5.3. Scope of protection of GI's “The provisions preventing registration of a trademark are not a basis for opposition under article 8(4a).”</p>
Page of the document	p. 27 and 31
Issue(s) you wish to comment on	<p>The draft OHIM Guidelines maintain the separation between the articles 13(1), article 103(2), article 16 and article 20(2) of the Foodstuffs, Wines, Spirit Drinks and Aromatised Wines Regulations respectively, on the one hand and articles 14, 102, 23 and 19 of these regulations respectively on the other hand. They set aside article 14 of the Foodstuffs Regulation or the corresponding text in other Regulations in oppositions. The Guidelines refer to the case law of the General Court in the cases ‘Bud’ and ‘Colombiano House’ where this position was confirmed.</p> <p>Whilst we do not put in question that the articles preventing for the registration of the trademarks in the corresponding regulations are not the basis for the opposition in a technical sense, we suggest that the provisions preventing the use (e.g. Article 13 of the Foodstuffs Regulation) should be read in conjunction with the rules on the relationship between trademarks and geographical indications (i.e. Article 14 in the case of the Foodstuffs Regulation and the corresponding provisions of the other regulations), to the extent that it contains limitations on the ability to challenge trademarks based on geographical indications which should be taken into account when applying Article 8(4a). Since Article 8(4a) is intended to implement the protection under provisions such as Article 14, there appears to be no reason to</p>

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	<p>construe Article 8(4a) in a way that it would prohibit registration even where Article 14 (or the equivalent provisions of the other regulations) would not be applicable.</p> <p>Recital 55 of the Foodstuffs regulation confirms <i>“the criteria by which subsequent trade marks should be refused or, if registered, invalidated on the ground that they conflict with a prior designation of origin or geographical indication should correspond to the scope of protection of designation of origin or a geographical indication laid down.”</i></p> <p>In the process of registering a designation of origin or a geographical indication it is possible that provisional protection is granted on national level, conferring already at that stage, before the application is assessed by the Commission, the right to prohibit the use of a subsequent trade mark.</p> <p>One could read the Guidelines as suggesting that this would allow for an opposition. However, in such situation a system of <i>coexistence</i> between the trademark right and the designation of origin or a geographical indication may apply under article 14(2) of the Foodstuffs Regulation. For such cases, it is specified in the Regulation that <i>“a trademark the use of which contravenes article 13(1) ... may continue to be used and renewed for that product notwithstanding the registration of a designation of origin or geographical indication ... In such cases, the use of the protected designation of origin or a geographical indication shall be permitted as well as use of the relevant trademarks”</i>.</p> <p>Article 14(2) of the Foodstuffs Regulation (coexistence) limits thus the scope of article 13(1) also where <i>use</i> of the trademark is concerned. Both provisions influence each other and should be read together. Setting aside article 14 of the Foodstuffs Regulation could prevent the solution of coexistence from taking effect. The same applies for corresponding provisions in the other Regulations.</p>
Suggestion for text	<p>The Guidelines should not exclude to consider article 14(2) of the Foodstuffs Regulation or corresponding provisions in other Regulations in opposition proceedings. The cited case law of the General Court did not concern specifically article 14(2) of the Foodstuffs Regulation.</p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part C – Opposition – Section 4 5.2.1.3. and 5.2.2. Exhaustive nature of the EU system of protection.
Page of the document	Page 28
Issue(s) you wish to comment on	<p>The Guidelines considers the EU system of protection of GI's for foodstuffs, wines and spirit drinks <i>is exhaustive in nature and supersedes national protection.</i></p> <p>The Court of Justice of the European Union has in fact decided that such an exhaustive character exists in respect of the EU regime on geographical indications for agricultural products and foodstuffs, as the draft text points out.</p>

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	<p>However, in respect of geographical indications for wines, the EU Court of First Instance (point 44-49) decided in its judgment of 18 November 2015 (case T-659/14, <i>Instituto dos vinhos do Douro e do Porto / OHIM and Bruichladdich Distillery Co. Ltd</i>) that under article 53, alinea 2, d) <i>juncto</i> article 8, alinea 4 of the CTM Regulation national legislation should still be regarded.</p>
Suggestion for text	<p>Taking into account this decision, the draft guideline needs to be reconsidered where it says that GIs protected under the laws of Member States may be a basis for opposition under article 8(4a) EUTMR only to the extent no uniform EU protection is in place for the given category of goods.</p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part C Opposition Section 4 Rights under Articles 8(4) and 8(4a)
Page of the document	pp.29-31
Issue(s) you wish to comment on	5.2.3 Geographical indications protected under international agreements
Suggestion for text	<p>We note that the section suggests applying Article 8(4a) beyond its actual wording (there is a reference to an application "by analogy") and question whether it is appropriate to give a broader interpretation to a ground of refusal than what is laid out in its actual wording. It may be more appropriate to allow for recourse to Article 8(4) in cases not covered by the wording of Article 8(4a) rather than to expand the scope of the latter article beyond its wording.</p>

Contributor (name & position)	GEOGRAPHICAL INDICATIONS COMMITTEE
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part D Cancellation Section 2 – Substantive provisions
Page of the document	pp. 19-20 Section 4.2.2.3 – Temporal scope of application
Issue(s) you wish to comment on	<p>Draft section 4.2.2.3 suggests that invalidity proceedings based on geographical indication rights under Article 8 are always to be based on Article 53(1)(d) in conjunction with Article 8(4a) and that those provisions are applicable regardless</p>

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	<p>of the filing or priority date of the EUTM and even in respect of trademarks registered at the time of the entry into force of the Amending Regulation.</p> <p>We believe, to the contrary, that Article 53(1)(d)/Article 8(4a) must not be applied in relation to EUTM registrations existing at the entry into force of the Amending Regulation nor to other EUTMs that, albeit still pending at the entry into force, could not have been challenged based on Article 8(4a) in the context of the registration proceedings. Challenges to registrations should only be possible based on the grounds of refusal applicable during the registration proceedings, based on which Article 53(1)(c)/Article 8(4) (instead of Article 53(1)(d)/Article 8(4a)) would be the accurate basis for a challenge against an EUTM registered at the time of entry into force of the Amending Regulation.</p> <p>The requirements of Article 53(1)(c) (in conjunction with Article 8(4)) and Article 53(1)(d)(in conjunction with Article 8(4a) are not identical. There will be situations when the GI holders would not have been in a position to succeed in an action based on Article 53(1)(c)/Article 8(4) but would be successful under the new provision (Article 8(4a)).</p> <p>The position taken in draft section 4.2.2.3 would mean that EUTMs that have been perfectly registerable when they were filed, did not incur in any prohibition of refusal under the applicable law and were therefore legitimately acquired, including marks that have already been registered and may have been on the register for many years, could be challenged on grounds of refusal that did not exist at their priority or not even at the time of registration. This would be tantamount to an expropriation of existing trademark rights that had been acquired in a fully legitimate manner and thus a fundamental right violation. We recall that the European Court of Human Rights has recognized (Judgment of the Grand Chamber of 11 January 2007 on application 73049/01, Anheuser-Busch v. Portugal) that trademark rights, including relating to a trademark application, are protected property under the European Convention of Human Rights.</p> <p>The position taken in 4.2.2.3 cannot be justified by the indication that Article 53.1(d)/Article 8(4a) are a "continuation" of the protection previously afforded under Article 53.1(c)/Article 8(4) since again, those provisions do not have identical requirements. Furthermore, this interpretation cannot be justified either by an absence of a transitory provision. To the contrary, particularly in the absence of an express rule, it cannot be assumed that the EU legislator had intended to expropriate legitimately acquired vested rights. The new legal rules must be interpreted in line with the European Union's fundamental rights obligations.</p> <p>We recall that Article 53(1)(c) and (d) are not the only relevant provisions on the conflict between EUTMs and geographical indications and that where an EUTM was registered contrary to the applicable provisions relating to absolute grounds of refusal under Article 7 (which include protection for geographical indications), reliance can also be made on Article 52.</p> <p>Finally, we suggest clarifying that there should be an effect of res judicata for decisions on the merits between the same parties and based on the identical GIs for opposition and invalidity proceedings as it would again be unreasonable and</p>
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	affect existing priority rights if EUTM proprietors could see themselves confronted with a case based on the identical rights against which they had successfully defended themselves in the past.
Suggestion for text	The applicable regime (Article 53(1)(d)/Article 8(4a) or Article 53(1)(c) /Article 8(4)) should be determined according to whether at the opposition deadline for the EUTM at issue, Article 8(4a) or Article 8(4) was the applicable basis for a challenges based on geographical indications. In no case should it be possible to rely on the new provisions of Article 53(1)(d)/Article 8(4a) in respect of EUTMs registered at the time of entry into force of the Amending Regulation. In addition, it would also be unfair to the EUTM owner to be subject to an action based on Article 53(1)(d)/Article 8(4a) when the EUTM application had still been pending at the time of entry into force of the Amending Regulation, but the opposition period had already expired. For example, there may be trademarks applied various years ago and subject to unjustified third party oppositions which only achieve registration after the entry into force of the Amending Regulation, but which would have been registered for a considerable time already if it had not been for unjustified third party challenges.
Contributor (name & position)	OHIM SUBCOMMITTEE OF TRADEMARK OFFICE PRACTICES COMMITTEE
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part E Register Operations, Section 6 Other entries in the register, Chapter 1 Counterclaims
Page of the document	p.4
Issue(s) you wish to comment on	<p>The recordal applicant (the CTMEEUTM or CD court or one of the parties in the counterclaim proceedings) must:</p> <p>indicate and submit:</p> <ul style="list-style-type: none"> • the date on which the counterclaim was filed; • <u>quote</u> the number of the CTMEEUTM or RCD concerned; • an indication of state whether the request is for revocation or for declaration of invalidity; • if the recordal applicant is one of the parties, <u>submit</u> official confirmation from the CTMEEUTM or CD court that has thewith authority to take the judgmentrule on the counterclaim, including, where possible, the case or reference number from the court. <p>The word "indicate" should be moved to the start of the first bullet point.</p>
Suggestion for text	<p>[...] must</p> <ul style="list-style-type: none"> - <u>Indicate</u> ... - <u>Quote</u> ... <p>[...]</p>

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Contributor (name & position)	OHIM SUBCOMMITTEE OF TRADEMARK OFFICE PRACTICES COMMITTEE
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Guidelines for Examination in the Office, Part E Register Operations, Section 6 Other entries in the register, Chapter 1 Counterclaims
Page of the document	p.4
Issue(s) you wish to comment on	<p>The recordal applicant (the CTMEUTM or CD court or one of the parties in the counterclaim proceedings) must indicate and submit:</p> <ul style="list-style-type: none"> • a copy of the judgment, together with confirmation from the CTMEUTM or CD court that the judgment has become final; • <u>indicate</u> the date on which the judgment became final; • <u>quote</u> the number of the CTMEUTM or RCD concerned; • an indication of state whether the request is for revocation or for declaration of invalidity; • in the event of partial cancellation or invalidity, <u>indicate</u> the list of goods and services affected by the judgment, if relevant. <p>The word 'submit' should be moved to the start of the first bullet point.</p>
Suggestion for text	<p>[...] must</p> <ul style="list-style-type: none"> - <u>Submit</u> ... - indicate ... <p>[...]</p>

Contributor (name & position)	OHIM SUBCOMMITTEE OF TRADEMARK OFFICE PRACTICES COMMITTEE
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Part E, Section 4 – RENEWAL, Chapter 5.4.3 and 5.5.5 (“Transitional arrangements”)
Page of the document	9/10 and 12 [referring to version with track changes]
Issue(s) you wish to comment on	<p>The Office suggests that the “old law” (i.e. the current unamended Regulation 207/2009 and Rule 30(2) CTMIR) applies to all CTMs where the six-month period for renewal started to run before the entry into force of the Amending Regulation. This would mean applying the current higher renewal fees and the “end of the month” renewal rule to all EU trademarks for which the six-month pre-renewal period had commenced before 23 March 2016.</p> <p>INTA considers that there is no legal basis for continuing to apply the old law (Article 47 CTMR and Rules 29, 30 CTMIR) to renewals made after the entry into force of the Amending Regulation. Indeed, in the absence of any transitional</p>

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provision, the law is meant to enter into force on the day prescribed in it. New provisions on renewals are not covered by any transitional period: Article 1 No. 45 (replacing Article 47 of the Regulation) and Article 2 No. 9 (deleting Title IV, i.e. Rules 29 and 30, from Regulation 2869/95) also enter into force 90 days from publication.

The “basic six-month period for renewal” marks the six months prior to the due date for renewal but is not as such the “due time” for the renewal. The due time for the renewal is, under the old law, the end of the month during which the registration expires, and under the new law, the expiry date.

There is no need for specific transitional provisions. Below are three examples to illustrate the consequences of the new law on the renewal of EU trademarks:

1). The CTM expiry date is during Month 2, the CTM has to be renewed by the end of Month 2. The new law enters into force in Month 3.

The law to be applied is the law in force at the date at which renewal is due, including the fees. Accordingly, the old law applies if the renewal is submitted and the fees are paid before the expiry date. If the EUTM is renewed during the six-month grace period following the due date for renewal (in our example: 29 February 2016), the fees initially owed plus a 25% surcharge are payable. This does not change if the late renewal request is filed after entry into force of the Amending Regulation: INTA considers “the fees” in Article 47(3) 3rd sentence EUTMR as meaning “the fees originally owed”, i.e. the fees under the old law in this example.

2). The EUTM expiry date is after 23 March 2016

Here, the new law applies both to the date at which the renewal must be effected and as regards the fees payable. There is no basis in the law for applying the old law to the renewal made in this scenario. At the time the renewal is due, the old law will have been abolished, and the new law will have entered into effect. Renewal must be made by the date of expiry (not the end of the month). There is no legal basis for charging more than the new renewal fees. The only exception is provided in Article 47(3) of the new law: renewal requests made after the date of expiry, and within six months from that, are subject to a late renewal fee calculated on the basis of the fees as laid down in Annex I to the Amending Regulation.

The only scenario that requires some adaptation is this one:

3). The CTM expiry date is between 1 and 23 March 2016

Here, the renewal is in theory due under the old law by the end of March. Under the new law, renewal would have been due at the date of expiry, but at that time, the new law was not yet in force.

It is suggested that in this scenario, CTM / EUTM owners should be able to choose whether they wish to renew under the old or under the new law. The new law enters into force on 23 March 2016. So CTM owners are free to renew by submitting the request and paying the (old) fees by this date. After 23 March 2016, they can opt for “late renewal” – as under the new law renewal after the expiry date, even during the same month, is already late, and pay the (new) renewal fees

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	<p>plus a 25% surcharge. Normally, renewal fees will be lower even with the surcharge, so the Office is not to expect significant complaints about that – and the application of the new law would be (a) by the letter of the law and (b) smooth.</p> <p>In this way, the lack of transitional provisions in the Amending Regulation would be addressed in an appropriate, practical and legally compliant manner, rather than creating a cut-off date for which there is no basis in the law, as the current draft of the Guidelines do.</p> <p>If the current draft is put in practice, we anticipate that multiple law suits are likely to happen relating to the renewal charges levied by the Office.</p>
Suggestion for text	None specifically. INTA recommends that the Office reconsider the draft Guidelines.