

User Association/ National Office	International Trademark Association (INTA)
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Contributor (name & position)	INTA Europe and Central Asia Subcommittee of the Nontraditional Trademarks 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 2 FORMALITIES
Page of the document	Page 5
Issue(s) you wish to comment on	2.2. Where a European Union trade mark application can be filed Paragraph 2.2 says that filing by fax is not accepted while Chapter 6 “signature” (on page 10) refers to applications filed by fax. The contradiction should be prevented by allowing filing by fax.
Suggestion for text	The applicant files the application for an EUTM directly with the Office. EUTM applications may be sent to the Office electronically (e.g through e-filing), by fax , by post or by a private delivery service.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Examination Section 2, Formalities Chapter 5, Goods and Services
Page of the document	Page 9
Issue(s) you wish to comment on	Clause 5.2 - Specific formality deficiency for e-filing, says: “Lists of goods and services filed as an attachment to the e-filing application, or filed separately on the same day , will not be considered to comply with the terms and conditions concerning electronic communication with and by the Office.” The wording could be misunderstood as if the filing done separately on a later day than the e-filing date could be acceptable.
Suggestion for text	

	Lists of goods and services filed as an attachment to the e-filing application, or filed separately even on the same day , will not be considered to comply with the terms and conditions concerning electronic communication with and by the Office.
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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Examination Section 2, Formalities Chapter 9.2.2 – Applicants for collective marks
Page of the document	Pages 15-16
Issue(s) you wish to comment on	The Guidelines in 9.2.2 require that the internal structure of the applicant must be that of an association, as well as existing as an entity in itself. There is no requirement in the Paris Convention regarding the internal structure of the association. Association is not defined but essentially an applicant is an association if it has members. It is not clear what is required in terms of the internal structure. Since limited companies may be associations, this additional wording seems unnecessary and confusing.
Suggestion for text	It should be necessary simply that the applicant is an association.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Examination Section 2, Formalities Chapter 10 - Mark Type
Page of the document	Page 18
Issue(s) you wish to comment on	In this section (and throughout), there is a requirement that for figurative, shape, position, pattern etc. marks, an indication of colour may not be given. Where colour may be perceived differently it is desirable that the applicant is able to specify if it should wish to, the particular colour element as this may form a fundamental part of the mark – e.g. product packaging comprising both shape and colour. It is unlikely that a JPEG uploaded can guarantee the precise colour in which rights are claimed. We are not clear as to the reason for prohibiting an indication of the correct colour and think this should be revisited. This is a theme which then applies for the specific types of mark, later in the document e.g. Figurative marks at 10.2 page 20. As from October 1, 2017, the Office does not require any mark description or indication of colour for hologram marks, as the representation of the trade mark alone defines the


	<p>subject matter of the registration. However, a mark description or indication of colour may be used to assist in interpretation of the mark.</p>
<p>Suggestion for text</p>	<p>We recommend deleting the prohibition on colour indications throughout.</p> <p>In particular, page 19: When figurative, shape, position, pattern, motion, multimedia marks, holograms or ‘other’ marks are to be registered in colour, a coloured reproduction of the mark must be filed with the application; (it is not necessary to make any no indication of the colour(s) appearing in the trade mark or of any colour code must be made). <u>However, an indication of colour may be used to assist in interpretation of the trade mark.</u></p> <p>Page 20, 10.2 - Figurative Marks, Paragraph 1. As from 01/10/2017, the Office does not accept <u>require</u> any mark description or indication of colour for figurative marks, as the representation of the trade mark alone defines the subject matter of the registration. Therefore, the Office will delete any mark description and/or colour indication. <u>However, a mark description or indication of colour may be used to assist in interpretation of the trade mark.</u></p> <p>Page 23, 10.3- Shape Marks: As from 01/10/2017, the Office does not accept <u>require</u> any mark description or indication of colour for shape marks, as the representation of the trade mark alone defines the subject matter of the registration. Therefore, the Office will delete any mark description and/or colour indication. <u>However, a mark description or indication of colour may be used to assist in interpretation of the trade mark.</u></p> <p>Page 25, 10.4 Position Marks As from 01/10/2017, the Office does not accept <u>require</u> any indication of colour for position marks, as the representation of the trade mark alone must define the subject matter of the registration. Therefore, the Office will delete any colour indication. <u>However, a mark description or indication of colour may be used to assist in interpretation of the trade mark.</u></p> <p>Page 27, 10.5 Pattern Marks As from 01/10/2017, the Office does not accept <u>require</u> any indication of colour for pattern marks as the representation of the trade mark alone defines the subject matter of the registration. Therefore, the Office will delete any colour indication. <u>However, a mark description or indication of colour may be used to assist in interpretation of the trade mark.</u></p> <p>Page 27, 10.6 Colour Marks However, as from 01/10/2017, any indication of colours in words that is not part of the mark description is not required cannot be accepted and will be deleted by the Office. <u>but may be used to assist in interpretation of the mark.</u></p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Examination Section 2, Formalities Chapter 10 - Mark Type
Page of the document	Page 20
Issue(s) you wish to comment on	Last paragraph of chapter 10: “Amendment of the description is not possible after registration.” We fail to understand the rationale behind this restriction. What if it helped to amend the description as part of an opposition or infringement proceedings, provided that the amendment did not alter the nature of the mark and accorded to the representation? Provided that the description does not attempt to extend the scope of protection, then a further clarification (in the form of a restriction) should be possible – in the same way as a restriction of a specification.
Suggestion for text	Delete the wording. Amendment of the description is not possible after registration.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Examination Section 2, Formalities Chapter 10 - Mark Type
Page of the document	Page 19
Issue(s) you wish to comment on	Paragraph 2 says the following: “A trade mark shall be represented in any appropriate form using generally available technologies as long as it can be reproduced on in the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor. The representation cannot be replaced by a description of the mark but the description must accord with the representation”. It is unclear if the description is compulsory.
Suggestion for text	“The representation cannot be replaced by a description of the mark but the description, when given, must accord with the representation”.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Examination Section 2, Formalities Chapter 10 - Mark Type
Page of the document	Page 25
Issue(s) you wish to comment on	Clause 10.4 Position marks “As the representation should by itself clearly define the size and position of the position mark...” The guidelines include a requirement that the representation should by itself clearly define the size and position of the position mark. However, the size may vary considerably. If for example the position mark comprised the colour yellow on the inside wheel hub cap of an agricultural vehicle – the vehicle could be a small quad bike type size or a huge combine harvester and the size would vary, even though the position would not. The size cannot therefore be defined other than by the proportion relative to the product to which the position mark is applied.
Suggestion for text	We recommend deleting the reference to the size from the guidelines.










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Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B EXAMINATION, SECTION 2 FORMALITIES
Page of the document	27-29
Issue(s) you wish to comment on	10.6 Colour marks Article 49(2) EUTMR Article 3(3)(f) EUTMIR [...] The colours are arranged in a uniform and predetermined manner when at least the ratio and the relative position of the colours are shown in the representation. [...] Examples of acceptable colour marks (for formalities' purposes) [...]

Examples of acceptable colour marks (for formalities' purposes)	
<p>EUTM 9 045 907</p> <p>Description: The mark consists of the combination of the colours red, black and grey as applied to the exterior surfaces of a tractor, namely red as applied to the bonnet, roof and wheel arches, light and dark grey as applied to the bonnet in a horizontal stripe and black as applied to the front bonnet grill, chassis and vertical trim — as depicted in the illustrative representation attached to the application</p>	
<p>The additional requirement of showing the relative position of the colours is neither imposed upon trademark owners in the new Implementing Regulation nor in the case law of the CJEU. The Office should not set stricter requirements for colour marks as are necessary for other types of marks as it is bound by the principle of proportionality. Additionally, the Office cannot add additional requirements which were not imposed by the legislator.</p> <p>If the representation contains other elements, such as words, it is not a colour mark per se but a figurative mark. The Office does not indicate how it intends to deal with those marks containing words or figurative elements in case of invalidity proceedings. There are a number of colour per se marks registered with words in colours. We refer to the statistics according to which 47% of all colour marks fall into that category.</p> <p>The application 9 045 907 was filed as a position mark and not a colour per se mark. This example shows the approach taken by the Office to convert colour per se marks for two colours into position marks which does not follow from the Heidelberger Bauchemie judgment.</p> <p>We also had concerns about the case law which refers to “systematic arrangement”, and “predetermined and uniform way”.</p>	
<p>Suggestion for text</p>	<p><i>A colour mark is a trade mark that consists exclusively of a single colour without contour or a combination of colours without contours. What is protected is the shade of colour(s). <u>and, in the case of more than one colour, the ratio and position of the various colours, which must be systematically arranged by being associated in a predetermined and uniform way (judgments of 24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 33; 14/06/2012, T-293/10, Colour per se, EU:T:2012:302, § 50).</u></i></p> <p><i>The representation of a colour mark must consist of a representation of the colour or colours without contours in one single JPEG file in the case of e-filed applications or on one single A4 sheet in the case of paper-filed applications. <u>Where there is more than one colour, a reproduction must be submitted that shows the systematic arrangement of the colour combination in a uniform and predetermined manner.</u></i></p>

	<p><i>An example of where the colours are arranged in a uniform and predetermined manner, <u>would include</u> when at least the ratio and the relative position of the colours are shown in the representation.</i></p> <p><i>However, as from 01/10/2017, any indication of colours in words that is not part of the mark description <u>is not required</u>cannot be accepted and will be deleted by the Office. <u>but may be used to assist in interpretation of the mark.</u></i></p> <p><i>If the representation contains other elements, such as words, it is not a colour mark <u>per-se</u> but a figurative mark. For information on correction of mark type, see paragraph 10.13 below.</i></p>
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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Examination Section 2, Formalities Chapter 10 - Mark Type
Page of the document	Page 29, Clause 10.7 Sound marks
Issue(s) you wish to comment on	The first paragraph says: <i>A sound mark is defined as a trade mark consisting exclusively of a sound or combination of sounds. Therefore, trade marks combining sounds with, for example, movement do not qualify as sound marks and should be applied for as multimedia marks (see paragraph 10.13 below)</i>
Suggestion for text	<i>A sound mark is defined as a trade mark consisting exclusively of a sound or combination of sounds. Therefore, trade marks combining sounds with, for example, movement do not qualify as sound marks per-se and should be applied for as multimedia marks (see paragraph 10.13 below)</i>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B EXAMINATION, SECTION 4 ABSOLUTE GROUNDS FOR REFUSAL, CHAPTER 2 EUTM DEFINITION, ARTICLE 7 (1) (A) EUTMR
Page of the document	5-8

Issue(s) you wish to comment on	2.2 Colour marks (the whole text)										
	<p>We believe that for reasons of legal certainty and the legitimate expectations of its owners, colour per se marks filed prior to 01 October 2017 which contain a description that explains the use of the colours on a specific product but without showing such use in the representation shall be deemed to meet the requirements of representation.</p> <p>Example of signs that are acceptable: (including or not the description):</p> <table border="1" data-bbox="451 516 1438 1759"> <thead> <tr> <th data-bbox="451 516 1211 583">Sign</th> <th data-bbox="1211 516 1438 583">Case No.</th> </tr> </thead> <tbody> <tr> <td data-bbox="451 583 1211 953">  <p><i>Description: The mark consists of the colour combination of yellow and black (samples of which colours are shown on the attached sheet) when yellow is applied to the visible surfaces of the clamshell of a power tool and black is applied to the visible surfaces of inserts and additions to the clamshell.</i></p> <p><i>Indication of colour: Yellow and black.</i></p> </td> <td data-bbox="1211 583 1438 953"> EUTM 1222561 </td> </tr> <tr> <td data-bbox="451 953 1211 1323">  <p><i>Description of the mark: Blue text on a grey background, in particular a metallic grey background, and mid to dark blue text with the colour tone Pantone 648 C. The ratio between the colours is: blue 5% and grey 95%.</i></p> <p><i>Indication of colour: Blue, grey.</i></p> </td> <td data-bbox="1211 953 1438 1323"> EUTM 5741525 </td> </tr> <tr> <td data-bbox="451 1323 1211 1650">  <p><i>Description of the mark: The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw.</i></p> <p><i>Indication of colour: Orange (RAL 2010), grey (RAL 7035).</i></p> </td> <td data-bbox="1211 1323 1438 1650"> EUTM 7472723 </td> </tr> <tr> <td data-bbox="451 1650 1211 1759"></td> <td data-bbox="1211 1650 1438 1759"></td> </tr> </tbody> </table> <p>We have significant concerns about this section. The case law is clear that colour combinations per se are acceptable. We consider that the proposed language in this section prohibits a colour combination per se and makes a colour-combination harder to</p>	Sign	Case No.	 <p><i>Description: The mark consists of the colour combination of yellow and black (samples of which colours are shown on the attached sheet) when yellow is applied to the visible surfaces of the clamshell of a power tool and black is applied to the visible surfaces of inserts and additions to the clamshell.</i></p> <p><i>Indication of colour: Yellow and black.</i></p>	EUTM 1222561	 <p><i>Description of the mark: Blue text on a grey background, in particular a metallic grey background, and mid to dark blue text with the colour tone Pantone 648 C. The ratio between the colours is: blue 5% and grey 95%.</i></p> <p><i>Indication of colour: Blue, grey.</i></p>	EUTM 5741525	 <p><i>Description of the mark: The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw.</i></p> <p><i>Indication of colour: Orange (RAL 2010), grey (RAL 7035).</i></p>	EUTM 7472723		
Sign	Case No.										
 <p><i>Description: The mark consists of the colour combination of yellow and black (samples of which colours are shown on the attached sheet) when yellow is applied to the visible surfaces of the clamshell of a power tool and black is applied to the visible surfaces of inserts and additions to the clamshell.</i></p> <p><i>Indication of colour: Yellow and black.</i></p>	EUTM 1222561										
 <p><i>Description of the mark: Blue text on a grey background, in particular a metallic grey background, and mid to dark blue text with the colour tone Pantone 648 C. The ratio between the colours is: blue 5% and grey 95%.</i></p> <p><i>Indication of colour: Blue, grey.</i></p>	EUTM 5741525										
 <p><i>Description of the mark: The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw.</i></p> <p><i>Indication of colour: Orange (RAL 2010), grey (RAL 7035).</i></p>	EUTM 7472723										

	<p>register than a single colour (this seems counter intuitive as two (or more) colours must be inherently more distinctive than one colour).</p> <p>A single colour mark per se covers a single colour “in every conceivable form” and in any number of “variations”. Accordingly, a colour combination per se cannot be deemed unacceptable “in every conceivable form” or because there are “too many different variations”.</p> <p>We also disagree with the interpretation of the EUIPO of the case law of the Court of Justice in Heidelberger Bauchemie. The judgment does not say that both the position and the ratio of the colours need to be indicated. This is not clear from the decision and is subject to the proceedings of Red Bull v. EUIPO in cases T-101/15 and T-102/15 and should not be pre-decided in the present Guidelines. Moreover, it does not reflect the past practice and Guidelines of the Office. Over 46% of all colour marks filed with the office were filed with an indication of percentages as shown in the attached overview. The Office has accepted a number of marks in the past with such ratio references – list attached for reference purposes.</p> <p>Example 8 298 499 is confusing as the real description reads: Description of the mark: <i>The trademark consists of the colours green: Pantone 368C; anthracite: Pantone 425C; orange: Pantone 021C, as shown in the illustration; the colours are applied to a basic component of the exterior of vehicle service stations (petrol stations) in the ratio green 60%, anthracite 30% and orange 10%, creating the impression of a green and anthracite-coloured petrol station (green predominating) with small orange accents. Indication of colour: Green, Pantone 368C, anthracite, Pantone 425C,</i></p> <p>Application 9 045 907 was filed as a position mark (Other) and not a colour per se mark. This example shows the approach taken by the Office to convert colour per se marks for two colours into position marks which does not follow from the Heidelberger Bauchemie judgment.</p> <p>Registration No. 7472723 was considered valid by the Office in its recent decision of 29 November 2016 in case of cancellation action No 11122 C.</p>
Suggestion for text	<p>“(ii) Trade marks consisting exclusively of a combination of colours (without contours) require:</p> <ul style="list-style-type: none"> • a reproduction of the colour combination that shows the systematic arrangement of the colour combination in a uniform and predetermined manner (mandatory); • a reference to a generally recognised colour code (mandatory); • a description detailing the systematic arrangement of the colours <u>in a uniform and predetermined manner</u> (optional). <p>• For colour combinations, the new EUTMIR implements the case law according to which the representation ‘must be systematically arranged by associating the</p>

	<p>colours concerned in a predetermined and uniform way', where the Court of Justice stated that the mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', did not exhibit the qualities of precision and uniformity necessary to comply with the requirement of graphic representation contained at that time in Article 4 EUTMR (judgment of 24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 33-34);</p> <p>If a combination of colours without contours is not systematically arranged in a uniform and predetermined manner, too many different variations would be possible and this would not allow the competent authorities and economic operators to know the precise scope of the protection claimed by the mark.</p> <p>The colours are arranged in a uniform and predetermined manner when at least the ratio and the relative position of the colours are provided in the application.</p> <p><i>The addition (optional) of a description can only 'detail' the systematic arrangement of the colours and thus only serve explanatory purposes. As the trade mark's scope of protection is exclusively determined by the representation itself, a description can neither add further information regarding the scope of protection nor extend the latter (Article 3(2) EUTMIR). In addition, a lack of accord between the representation and the description leads to a lack of clarity and precision of the mark (Article 3(2) EUTMIR)."</i></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 Chapter 2, EUTM Definition
Page of the document	Page 13-14
Issue(s) you wish to comment on	<p>Clause 2.5.2 – Smell/Olfactory Marks says: <i>"However, it is currently not possible to represent smells in compliance with Article 4 EUTMR, as the subject matter of protection cannot be determined with clarity and precision with any available technology."</i></p> <p>While it is accepted that applications for smell marks are difficult and may be incredibly hard to register, they should not be prohibited as this is contrary to the position that smell marks can be protectable as a trademark. If the guidelines prohibit certain marks, examiners will automatically refer to the guidelines and give no possibility of registration. If it is not in the guidelines then at least the applicant has a chance to argue a case on any particular application. The guidelines would make it too prescriptive and rule out any chance. We would therefore recommend deleting this paragraph.</p>

Suggestion for text	<p><i>“However, it is currently not possible to represent smells in compliance with Article 4 EUTMR, as the subject matter of protection cannot be determined with clarity and precision with any available technology.”</i></p> <ul style="list-style-type: none"> • <i>“Representation and description in words</i> The requirements of representation are not unlikely to be satisfied by: <ul style="list-style-type: none"> o a graphic representation of the smell; o a description of the smell in words; o a combination of both (graphic representation and description in words).” <p>We would also recommend deleting this paragraph:</p> <p><i>“Currently, there is no technology that could make possible the representation of a smell mark on the Register in a legally accepted manner. Therefore, an application for a smell mark would be rejected under Article 7(1)(a) EUTMR.”</i></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 Chapter 2, EUTM Definition
Page of the document	Page 14
Issue(s) you wish to comment on	<p>2.5.3 Taste Marks, Paragraphs 2 and following of this clause say: <i>“However, it is currently not possible to represent a taste in compliance with Article 4 EUTMR as Article 3(9) EUTMIR specifically excludes the filing of samples and the subject matter of protection cannot be determined with clarity and precision <u>with any available technology.</u></i> <i>Therefore, an application for a taste mark would be rejected under Article 7(1)(a) EUTMR.</i> <i>With current technology, there is no way to represent this type of mark in a proper manner. The arguments mentioned above under paragraph 2.1. are applicable in a similar way for taste marks (decision of 04/08/2003, R 120/2001-2, The taste of artificial strawberry flavour (gust.)).”</i></p> <p>For the same reasons as for smell marks above, we would delete this in its entirety as it prohibits the ability to register taste marks, which is contrary to the position that taste marks can be protectable as a trademark (again it is accepted that taste marks may be incredibly hard to register, but they should not be prohibited entirely).</p>
Suggestion for text	

	<p>“ However, it is currently not possible to represent a taste in compliance with Article 4 EUTMR as Article 3(9) EUTMIR specifically excludes the filing of samples and the subject matter of protection cannot be determined with clarity and precision with any available technology.</p> <p>Therefore, an application for a taste mark would be rejected under Article 7(1)(a) EUTMR.</p> <p>With current technology, there is no way to represent this type of mark in a proper manner. The arguments mentioned above under paragraph 2.1. are applicable in a similar way for taste marks (decision of 04/08/2003, R 120/2001-2, The taste of artificial strawberry flavour (gust.)).”</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, CHAPTER 3 NON-DISTINCTIVE TRADE MARKS, ARTICLE 7 (1) (B) EUTMR
Page of the document	5-7
Issue(s) you wish to comment on	<p>4 Colour Marks 4.1 Single Colours (the whole text)</p> <p>We refer to our comments above regarding the interpretation of the Heidelberger Bauchemie judgment. The current wording would limit colour marks to position or pattern marks.</p>
Suggestion for text	<p>4 Colour Marks</p> <p>[...] For colour combinations, examination of distinctiveness should be based on the assumption that the colour combination in the way it is filed appears on the goods or their packaging, or in advertisements or promotional material for the services.</p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Section 4, Chapter 7

Page of the document	1
Issue(s) you wish to comment on	<p>Chapter 7 bears the title “Trade marks contrary to public policy and acceptable principles of morality”.</p> <p>Article 7(1)(f) EUTMR prohibits the registration of trade marks “which are contrary to public policy or to accepted principles of morality”.</p> <p>The conjunction “and” seems to require two cumulative conditions: trademarks must be (i) contrary to public policy, and (ii) contrary to acceptable principles of morality. However, these two conditions are not cumulative. Furthermore, the word “acceptable” adds a certain subjectivity to the principles of morality that apply to Article 7(1)(f).</p>
Suggestion for text	The title of Chapter 7 should be in line with the wording of Article 7(1)(f), i.e.: “Trade marks contrary to public policy and or accepted principles of morality”.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B Examination / Section 4 Absolute grounds for refusal / Chapter 8 Deceptive Trade Marks (Article 7(1)(g)) EUTMR
Page of the document	Pages 3 and 4
Issue(s) you wish to comment on	<p>Page 3: “An objection should, therefore, be raised, when the list of goods/services is worded in such a way that non-deceptive use of the trademark is impossible”.</p> <p>Page 4: “An objection should be raised, when the list of goods/services, worded in a detailed manner, contains goods/services for which non-deceptive use is impossible”.</p> <p>This wording appears to be too restrictive: a trademark should also be refused for deceptiveness when there is a sufficiently serious risk that the consumer will be deceived.</p>
Suggestion for text	<p>An objection should therefore be raised when the list of goods/services is worded in such a way that non-deceptive use of the mark is impossible, or there is a sufficiently serious risk that the consumer will be deceived.</p> <p>An objection should be raised, when the list of goods/services, worded in a detailed manner, contains goods/services for which non-deceptive use is impossible, or there is a sufficiently serious risk that the consumer will be deceived.</p>

Contributor (name & position)	INTA EUIPO Subcommittee of the 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	Chapter 9: Trade marks in conflict with flags and other symbols (Article 7(1)(h) and (i) EUTMR)
Page of the document	5
Issue(s) you wish to comment on	We recommend adding services to symbols.
Suggestion for text	<p>“These symbols are normally registered for products <u>and services</u> such as”</p> <p>“Official signs and hallmarks indicating control and warranty enjoy protection only for goods <u>and services</u> of the same...”</p>

Contributor (name & position)	INTA EUIPO Subcommittee of the Trademark Office Practices Committee
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Part/Section/Chapter of the Guidelines the comment(s) refer to	Chapter 9: Trade marks in conflict with flags and other symbols (Article 7(1)(h) and (i) EUTMR)
Page of the document	5
Issue(s) you wish to comment on	<p>Official signs and hallmarks.</p> <p>“These symbols are normally registered for products...”</p> <p>It is not clear where these symbols and hallmarks need to be register. On page 7 it says “Since state flags enjoy protection per se without the need of any registration at WIPO they are normally not found in the WIPO Article 6ter database PC”.</p>
Suggestion for text	“These symbols are normally registered with WIPO for products...”

Contributor (name & position)	INTA EUIPO Subcommittee of the Trademark Office Practices Committee
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Part/Section/Chapter of the Guidelines the comment(s) refer to	Chapter 9: Trade marks in conflict with flags and other symbols (Article 7(1)(h) and (i) EUTMR)
Page of the document	8
Issue(s) you wish to comment on	The texts on pages 7 and 8 talk about perception by the average consumer of an emblem. On top of page 8 the Spanish flag and the EU flag are shown without any explanation. The pictures do not seem to belong to the text.
Suggestion for text	We recommend considering to take away the flags and show a relevant example.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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	Chapter 9: Trade marks in conflict with flags and other symbols (Article 7(1)(h) and (i) EUTMR)
Page of the document	12
Issue(s) you wish to comment on	<p>The two last examples – the Canadian leaf and the EU flag -have no explanations and it is difficult to understand why they are not heraldic imitation.</p> <p>With respect to the EU flag for example it says on page 10 “it is not necessary for all the stars to be present in the EUTM applied for (judgment of 13/03/2014, T-430/12, European Network Rapid Manufacturing,)”, and on page 11 “The EUTM applied for consists of a circle of 12 stars, of which three are covered. It contains the most important element of the European flag. The adjective ‘European’ reinforces the link already established by the circle of stars.” It is therefore difficult to understand the acceptance of EUTM application 15 889 157.</p>
Suggestion for text	An explanation is needed as the decision otherwise seems contradictory.

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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 – Chapter 10, conflicts with geographical indications
Page of the document	Page 10, Other misleading indications and practices
Issue(s) you wish to comment on	At Point 3 Situation covered by EU Regulations the term "misuse" is missing (while it correctly appears at section 3.3).
Suggestion for text	We recommend adding the term misuse

Contributor (name & position)	INTA Geographical Indications Committee
Linguistic version the comments refer to	EN x 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- Chapter 10 (Trademarks in conflict with designations of origin and geographical indications) 3.3. EUTM consists of a misuse, an imitation or evocation of a PDO/DGI
Page of the document	14
Issue(s) you wish to comment on	The text “However, if the goods concerned are identical, this is an element in support of the likelihood of evocation” contains the term “likelihood of evocation” which should be changed to simply read “evocation” in order to avoid confusion with the term “likelihood of confusion”.
Suggestion for text	“However, if the goods concerned are identical, this is an element in support of likelihood of evocation”

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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 – Chapter 10, conflicts with geographical indications
Page of the document	Page 20 – Concept of Misuse
Issue(s) you wish to comment on	<i>“It is only if the Office has evidence (received, e.g. for example, via third party observations) that the trade mark is being used in connection to wine, which clearly does not comply with the specification of the PDO Rioja (for instance, i.e. it is produced in France), that the Office can argue that the trade mark is misusing the PDO.”</i> In our opinion that goes beyond the standard practice. Such misuse could constitute at most a ground for revocation, but not an Absolute Ground.
Suggestion for text	We recommend deleting any reference to misuse in trade (3 paragraphs).

Contributor (name & position)	EUIPO Subcommittee of the 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 Examination – Section 4 Absolute grounds for refusal – Chapter 10, conflicts with geographical indications
Page of the document	Page 21, other misleading indications and practices
Issue(s) you wish to comment on	We would suggest re-inserting the examples provided for on the Mont Saint Michel and the Queso Tetilla since they are good examples of misleading practices.

Suggestion for text	

Contributor (name & position)	INTA Geographical Indications Committee
Linguistic version the comments refer to	EN x 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	Chapter 10 (Trademarks in conflict with designations of origin and geographical indications) 4. Relevant Goods under EU Regulations
Page of the document	28
Issue(s) you wish to comment on	<p>4.1. Identical products “Importantly, the product covered by the PDO/PGI is the one specified in the description of the product in the Official Journal publication containing the application for registration. The DOOR database includes a link to this publication (C series). It should not be confused with the product class under which the DOOR database classifies the PDO/PGI.”</p> <p>The paragraph might not make it sufficiently clear where to find the correct goods listed in the PDO-PGI, especially for users unfamiliar with the DOOR database. This is the base of all the analysis on identity or comparable goods. It can also be reminded that there are other E.U. databases for other types of goods: E-BACCHUS, E-SPIRIT DRINKS, Register of geographical designations of Aromatized drinks based on wine products.</p>
Suggestion for text	We recommend adding a more precise wording.

Contributor (name & position)	INTA Geographical Indications Committee
Linguistic version the comments refer to	EN x 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	Chapter 10 (Trademarks in conflict with designations of origin and geographical indications) 4. Relevant Goods under EU Regulations.
Page of the document	29-33
Issue(s) you wish to comment on	4.2 Comparable products (the whole text)

Suggestion for text	To ease the understanding of the criteria of comparable good, specifically how to assess the link between the term used to designate the product (i.e. the trademark) and the product whose designation is protected, we recommend that the information be systematized to form a list of the commonly used standards to establish such a link, followed by examples of each standard. Moreover, the restrictive interpretation on comparable goods should be clarified from the beginning of the explanations.
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Contributor (name & position)	INTA 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 - CHAPTER 10 GEOGRAPHICAL INDICATIONS ARTICLE 7(1)(j) EUTMR
Page of the document	38
Issue(s) you wish to comment on	5.1 PDOs/PGIs protected at national level in an EU Member State "Currently, neither the Commission nor the Office keeps a database listing the PDOs/PGIs protected under national law for non-agricultural products. Given the inherent difficulty in identifying such PDOs/PGIs, the Office will in these cases rely principally on observations by third parties."
Suggestion for text	INTA reiterates that 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.
Contributor (name & position)	INTA 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 - CHAPTER 10 GEOGRAPHICAL INDICATIONS ARTICLE 7(1)(j) EUTMR
Page of the document	41
Issue(s) you wish to comment on	5.2 PDOs/PGIs from third countries "Given the inherent difficulty in identifying such PDOs/PGIs, the Office will in these cases rely principally on observations by third parties."
Suggestion for text	As stated above (comments on 5.1 PDOs/PGIs protected at national level in an EU Member State), 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 PDOs/PGIs from third countries into account where accessible.
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Contributor (name & position)	INTA 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 Chapter 11
Page of the document	7
Issue(s) you wish to comment on	There is an error in the inserted revised text, in the paragraph prior to the table,
Suggestion for text	Depending on the context in which these terms are used, they may or may not be associated with wine quality. As a consequence, when examining the sign, the Office will take into account in particular whether the relevant public will link the term in the sign with certain qualities or characteristics of the wine or not.

Contributor (name & position)	INTA 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 – Chapter 11, TTWs
Page of the document	Page 7, 3 Situations covered by art. 113(2)
Issue(s) you wish to comment on	We agree on the issue of the non-automatic protection, when the context clearly indicates that the reproduction of a TTW does not imply a misuse, and is not misleading. However, the example of NOBLE DRAGON could be, in our opinion, interpreted differently by a part of the public.
Suggestion for text	We recommend deleting the example on NOBLE DRAGON.

Contributor (name & position)	INTA EUIPO Subcommittee of the Trademark Office Practices Committee
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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 – Chapter 13, conflicts with earlier plant variety denominations
Page of the document	Page 3 Par. 1 – Art. 7(1)(m) EUTMR
Issue(s) you wish to comment on	<p>“Conflicts involving an EUTM application containing plant variety denominations which are not protected by Article 7(1)(m) should be examined under Article 7(1)(c) EUTMR (see below, paragraph 3.6).”</p> <p>Each of the grounds of refusal under Art. 7(1) is independent and must be examined separately. That said, either the proposed wording should be removed being redundant or that language is adapted to remind the general principles. Besides, this issue is addressed in par. 4.6.</p>
Suggestion for text	Conflicts involving an EUTM application containing plant variety denominations which are not protected by Article 7(1)(m) should be examined under all the criteria for assessing distinctiveness and descriptiveness provided under Article 7(1), including those likely to be more common in relation to plant varieties, such as Article 7(1)(a) EUTMR, Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(1)(d) EUTMR, Article 7(1)(g) EUTMR (see below, paragraph 3.6)

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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 – Chapter 13, conflicts with earlier plant variety denominations
Page of the document	Page 3 Par. 3 – Definition of plant variety denomination
Issue(s) you wish to comment on	<p>“Plant variety denominations are the generic designation of the variety which stays with the variety even after the termination of the CPVR (Article 17(3) CPVRR).”</p> <p>The relevant legislation does not associate the term “generic” with the plant variety denomination. The general principle would be that protectable varieties must be designated by a prescribed variety term, the use of which is obligatory and that becomes the “proper name”, the “birth name” of the plant variety.</p>
Suggestion for text	“Plant variety denominations are the generic prescribed designations of the varieties which stays with variety even and as such they remain associated with the respective varieties even after the termination of the CPVR (Article 17(3) CPVRR).”

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 Examination – Section 4 Absolute grounds for refusal – Chapter 13, conflicts with earlier plant variety denominations
Page of the document	Page 4, Par. 4.1. – Art. 7(1)(m) EUTMR Registered Plant variety denominations
Issue(s) you wish to comment on	<p>“The search should extend to variety denominations registered for European Union Member States and non-member countries on the basis of Union legislation, national law or international agreements to which the Union or the Member State concerned is a party.”</p> <p>This is welcome but it is not clear what sources the examiners should rely on to carry out this search.</p>
Suggestion for text	We recommend clarifying the sources examiners should rely on to carry out the search.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 Examination – Section 4 Absolute grounds for refusal – Chapter 13, conflicts with earlier plant variety denominations
Page of the document	Page 6
Issue(s) you wish to comment on	<p>Par. 4.3. – Art. 7(1)(m) EUTMR - The EUTM application consists of, or reproduces in its essential elements, the plant variety denomination</p> <p>Clearly, the identification of a well-balanced notion of “essential elements” will be the key point in the application of this new ground of refusal.</p> <p>The guidance criteria “When dealing with word marks, all the elements have to be considered essential in principle. As to figurative marks, inter alia, the size and position of the different elements within the arrangement of the mark have to be analysed” appears too strict.</p> <p>As for the first example, the word ANTONIO as such is not an ‘essential’ part of the mark. The combined words ANTONIO MARIN are the distinctive element of the mark and such element is neither identical nor “reproduce” the earlier plant variety denomination ANTONIO. Since this is a new ground of refusal, we recommend this is treated with caution so example 1 could be removed since it would excessively broaden the application of this ground of refusal.</p> <p>In the 4th example, the image should be deleted since the example refers to an application for the word mark NORDIC PET. As in the first example, the sign applied for should be examined as a whole.</p>

	In other words, the meaning of ‘reproduce’ has to be clarified within this rule. If it means ‘contain’, the example could be appropriate, but if the meaning is ‘creating the same impression of...’ (thereby close to identity) etc., an application for NORDIC PET should not be refused.
Suggestion for text	We suggest reconsidering and replacing the examples commented above.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 Examination – Section 4 Absolute grounds for refusal – Chapter 13, conflicts with earlier plant variety denominations
Page of the document	Page 8
Issue(s) you wish to comment on	Par. 4.5 – Art. 7(1)(m) EUTMR Plant variety of the same or closely related species “Since none of the CPVO’s denominations protect a vegetable variety, there is no reason to object to that product category (i.e. fresh vegetables) and therefore no limitation to be proposed.” The wording is unclear.
Suggestion for text	“Since the CRIPPS denomination does not protect a vegetable variety, there is no reason to object to that product category (i.e. fresh vegetables) and therefore no limitation to be proposed.”

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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 – Chapter 13, conflicts with earlier plant variety denominations
Page of the document	Page 9
Issue(s) you wish to comment on	Par. 4.5. – Art. 7(1)(m) EUTMR Plant variety of the same or closely related species “On the other hand, despite being different genera, due to their morphological characteristics, Lactuca and Chicorium are considered closely related. Therefore, the objection should not only refer to the genus of the plant variety right Lactuca, but also to the genus Chicorium.”

	This approach would seem to require technical expertise. A more simple approach based on genera/species as explained in the foregoing text of the paragraph would be more appropriate.
Suggestion for text	

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B Examination – Section 4 Absolute grounds for refusal – Chapter 13, conflicts with earlier plant variety denominations
Page of the document	Page 11
Issue(s) you wish to comment on	<p>Par. 4.6. – Art. 7(1)(m) EUTMR Relationship with other EUTMR provisions</p> <p>“Article 7(1)(m) EUTMR refers to plant variety denominations of plant variety rights, namely plant breeders’ rights, registered by the competent national authority of one or more Member States of the European Union or of UPOV and by the Community Plant Variety Office, under the CPVRR. A variety denomination constitutes the generic designation of a certain plant variety, the name that all the undertakers on the market must use to refer to it.”</p> <p>Please refer to our above comments under page 3 Par. 3 – Definition of plant variety denomination.</p>
Suggestion for text	“Article 7(1)(m) EUTMR refers to plant variety denominations of plant variety rights, namely plant breeders’ rights, registered by the competent national authority of one or more Member States of the European Union or of UPOV and by the Community Plant Variety Office, under the CPVRR. A variety denomination constitutes the prescribed designation of a certain plant variety, the name that all the undertakers on the market must use to refer to it.”

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 EXAMINATION, SECTION 4 ABSOLUTE GROUNDS FOR REFUSAL, CHAPTER 14 ACQUIRED DISTINCTIVENESS THROUGH USE, ARTICLE 7 (3) EUTMR
Page of the document	6, 8, 9 and 14
Issue(s) you wish to comment on	<p>8.5 Manner of use</p> <p>In relation to combination colour per se marks, the use of the mark as described in the description or in the percentages indicated in the description or seen in the representation shall be considered as relevant use of the sign for the purpose of</p>

	<p>acquired distinctiveness (judgment of 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 36).</p> <p>In those circumstances the mark does not have to be used as merely shown in the representation as the registration is a colour per se mark not a figurative mark.</p>
Suggestion for text	<p>The Court of Justice in Heidelberger Bauchemie wanted to allow the registration of colour per se marks where either the percentages are clear or the distribution of the colours on a product. The Legislator deleted the requirement of a graphic representation for the purpose of filing a mark by means of Regulation 2015/2424 so in fact it would be enough to indicate the colours and indicate the percentages for which colour protection is claimed. The Implementing Regulation and the Guidelines cannot contradict this approach and must clearly recognise it.</p>

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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 – Chapter 15, Collective trademark
Page of the document	Page 4
Issue(s) you wish to comment on	<p>Applicable Provisions and Examination</p> <p>The following sentence was deleted: <i>“For EU collective marks conflicting with PGIs/PDOs, traditional terms for wine or traditional specialities guaranteed, the regulations governing the use of an EU collective mark should accurately reflect any limitation introduced to overcome such conflicts. For example, the regulations of use of the EU collective mark ‘XYZ Designation of Origin’ for ‘wines’ should accurately reflect the fact that they refer to the use of the trade mark for wines complying with the PDO ‘XYZ’.”</i></p> <p>We understand that this paragraph has been deleted probably because it is encompassed in the chapters 10, 11 and 12.</p>
Suggestion for text	For sake of clarity, the sentence could stay also here.

Contributor (name & position)	INTA 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 - CHAPTER 16 European Union Certification Marks
Page of the document	

Issue(s) you wish to comment on	<p>General Comments:</p> <p>The Draft Guidelines for Examination of European Union Certification Marks are generally consistent with certification mark practice in other jurisdictions, except for exclusion of marks which certify geographical origin of goods or services. In particular, the prohibition against the mark owner using the mark itself is a key principle of certification mark laws in other jurisdictions.</p> <p>The requirement for actually submitting a copy of the regulations of use varies among jurisdictions and raises the issue of whether any action by the owner may be required upon amendment or modification of such regulations during the term of the registration or upon renewal. Such a requirement could become quite burdensome, especially in industries where industry or public expectations are likely to evolve or governmental regulations may change such as communications technology protocols or even quality measures for hotels or restaurants. However, if the regulations of use, as filed, and those actually operational are not identical, this could possibly create more potentially troublesome issues than an obligation to keep the regulations, as publicly available at EUIPO, up to date.</p> <p>The problem of updating potentially may be mitigated by prescribing the requirements for certification in general terms or by referring to industry standards that may change while continuing to serve as the source of the registrant’s use requirements.</p> <p>These comments are directed to the sections of the Draft Examination Guidelines, which we believe may need to be clarified, especially with respect to potential interaction between the certification mark law and the protection of geographical indications as well as the preservation of the rights of potential registrants with regard to geographical associations other than those which may imply origin of the goods or services.</p>
Suggestion for text	
Contributor (name & position)	INTA 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 - CHAPTER 16 European Union Certification Marks 2.1 Definitions
Page of the document	Page 3
Issue(s) you wish to comment on	As further discussed in relation to Section 5, it may be helpful to further clarify that marks with geographical associations other than those that imply origin are not necessarily precluded from registration unless they are misleading. It is important to give equal

	<p>regard to the provision of this section that the list of possible characteristics to be certified is non-exhaustive.</p> <p>Moreover, the meaning of “certified by the proprietor” is not explained in the draft. Certification will not necessarily be made directly by the owners. As certification can be complex and provided for in many different sectors, what is important is that the certification should be conducted under the control of the trademark owner.</p>
Suggestion for text	<p>We recommend clearly stating that marks with geographical associations that do not imply origin are not necessarily precluded from registration unless they are misleading.</p> <p>The proprietor of the certification mark does not necessarily have to provide the certification services itself. What matters is that the certification provided for must be conducted under its control / supervision.</p>
Contributor (name & position)	INTA Geographical Indications Committee and INTA EUIPO Subcommittee of the Trademark Practices Offices 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	<p>Part B Examination – Section 4 Absolute grounds for refusal - CHAPTER 16 European Union Certification Marks</p> <p>_3.1 Sign and distinguishing capacity</p>
Page of the document	Page 4
Issue(s) you wish to comment on	<p>1) This section suggests that the word mark CERTIFICATION or CERTIFIED could be unable to indicate compliance with the certifier’s standards. It would clarify this section to explain that, while these words alone, without any references to what characteristic is certified, could not properly function as certification marks, those terms could be included in a registrable mark when combined with other terminology referring to the certified characteristics, as shown by the example in Section 3.3. Inclusion of these words in a registrable mark could be helpful to avoid confusion with regard to the character of the mark (as described in 5.1.1 para 6 of the draft Guidelines).</p> <p>2) “Such a general capacity to function as a certification mark will only lack in exceptional circumstances”. This sentence would need to be further clarified.</p>
Suggestion for text	<p>1) We recommend clarifying that the terms CERTIFICATION or CERTIFIED are not prohibited but may require further inquiry or additional elements.</p> <p>2) “Such a general capacity to function as a certification mark will only lack in exceptional circumstances. Allusive or highly suggestive signs are likely to reach the threshold of distinctiveness, until the case law provides otherwise”.</p>

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 Examination / Section 4 Absolute grounds for refusal / Chapter 16 European Union certification marks
Page of the document	Page 5, 4 Specific requirement as regards ownership
Issue(s) you wish to comment on	<p>“The applicant has to file a declaration that it complies with this requirement”.</p> <p>This wording would suggest that a specific form / declaration will have to be provided. We believe that the above could be included within the regulation of use.</p>
Suggestion for text	
Contributor (name & position)	INTA 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	<p>Part B Examination – Section 4 Absolute grounds for refusal - CHAPTER 16 European Union Certification Marks</p> <p>5.1. Misleading as to the character or the meaning of the mark</p>
Page of the document	Page 6
Issue(s) you wish to comment on	<p>5.1. stipulates: “An EU certification mark application must be refused if the public is liable to be misled as regards the character [...] of the mark, in particular is if it likely to be perceived as something other than a certification mark under Article 85 EUTMR”.</p> <p>In 5.1.1. “Misleading as to the character of the mark” is further described.</p> <p>Tthe whole section 5.1.1. and the reference to misleading as to the character of the mark should be removed.</p> <p>Any trademark, provided it does not have to be refused on other absolute grounds, can be used as a certification mark, even the (invented) sign “ROBERTO CASAS CALZADOS”, if used by the trademark owner only as a certification mark. In such cases, the targeted trade circles will naturally perceive the mark as a certification mark, simply because the trademark owner is a certifying body. Many certification marks consist of signs merely referring to the name of their owner, the certifying body. Such trademarks could be excluded from protection by this provision.</p>

	Likewise, on the use of an individual trademark as a certification or collective trademark the recent judgement of the EUCJ, 8 June 2017, C-689/15 should be taken into account (explaining under which conditions this use can be considered as a ‘normal or ‘genuine’ use of the individual trademark).
Suggestion for text	An EU certification mark application must be refused if the public is liable to be misled as regards the character or the meaning of the mark, in particular is if it likely to be perceived as something other than a certification mark under Article 85 EUTMR” We recommend deleting 5.1.1. entirely.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 Examination / Section 4 Absolute grounds for refusal / Chapter 16 European Union certification marks
Page of the document	Page 7, 5.1.2 Misleading as to the meaning of the mark
Issue(s) you wish to comment on	“To conclude, the perception of the sign by the relevant consumer is decisive. This perception will depend, on the one hand, on the sign itself and, on the other hand, on the specification of the use of the mark as laid down in the regulations of use.” The relevant goods and services should also be taken into account.
Suggestion for text	“To conclude, the perception of the sign by the relevant consumer is decisive. This perception will depend, on the one hand, on the sign itself and, on the other hand, on the specification of the use of the mark as laid down in the regulations of use, and on the goods and services covered. ”

Contributor (name & position)	INTA 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 - CHAPTER 16 European Union Certification Marks 5.2 Certification of the geographical origin

Page of the document	Page 8
Issue(s) you wish to comment on	<p>This subsection concerns the circumstance where the mark itself does not imply geographical origin but the regulations of use refer to a geographical characteristic. However, contrary to the definition established by Article 83(1) EUTMR and Section 2.1 of the Draft Guidelines with regard to the exception to registrability based on certification of geographical origin, this subsection of Section 5.2 refers to “geographical origin or destination”. The addition of the concept of “destination” greatly expands the exception precluding registrability of marks that certify geographic origin.</p> <p>This language could be construed to prevent registration of the PSE logo shown as an example in Section 5.5.1. Such an interpretation could be detrimental to the ability of European makers of products or components destined for foreign markets to enforce against counterfeiters in Europe, for example.</p> <p>The final paragraph of Section 5.2 seems to state the correct rule that a mark should be registrable unless consumers will perceive both an indication of a “particular geographical place” and that the goods or services will be certified with respect to geographical origin. However, the ambiguity introduced by the aforementioned reference to “destination” needs to be clarified.</p> <p>As to Section 6 on examination of the general grounds of refusal: Although there is no doubt that the general grounds of refusal apply, these must be dealt with especially prudently with regard to certification marks. These marks, by their very nature, tend to precisely describe what they are certifying. Applying general grounds for refusal without keeping in mind the specific nature of these marks could eventually jeopardize the creation of these marks as such.</p>
Suggestion for text	We recommend deleting the reference to “destination”.
Contributor (name & position)	INTA 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 - CHAPTER 16 European Union Certification Marks 5.3.1. standard to be certified
Page of the document	8-9
Issue(s) you wish to comment on	1) 5.3.1. makes reference to “the public” within the sentence “The characteristics can be described in general terms with no need to specify the technical details (e.g. thermoresistance or airtightness of the goods) as long as the public can clearly and precisely understand which those characteristics are. “

	<p>In order to be in line with other provisions of trademark law, it would be expedient to refer to “the targeted trade circles” instead. In cases, e.g. where technical products, or B2B products are certified, it would not make sense to ask for the understanding of consumers, but that of industry professionals.</p> <p>2) “Where reference is made to long or complex technical specifications laid down in official or generally available sources, these references must also be clear and precise.” This provision may well be interpreted in a way that the applicant has to rephrase complex technical specifications to be easier to grasp. If interpreted in this sense, the provision would place an unacceptable burden on the applicant. This is true in particular in cases where the long or complex technical specification is included in standards by bodies other than the applicant, e.g. where they are included in legal provisions.</p> <p>3) 5.3.1. should be amended to include language which makes it clear that under the same European Union Certification Mark, a variety of goods may be certified, with varying characteristics for the different product categories. Otherwise, major certifying bodies would be excluded from securing trade mark protection for their certification marks.</p>
Suggestion for text	<p>We recommend:</p> <p>1) Replacing “the public” by “the targeted trade circles”</p> <p>2) Deleting the sentence “Where reference is made to long or complex technical specifications laid down in official or generally available sources, these references must also be clear and precise.”</p> <p>3) Including “A certification mark can cover a variety of products, with different characteristics to be certified, depending on the product category. In such case, for the regulation of use should specify the standards to be certified for the different types of products”, or similar language at the end of 5.3.1.</p>

Contributor (name & position)	INTA 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 C – Section 4 – Rights under Article 8(4) and 8(6) EUTMR, Article 5: Article 8(6) EUTMR – the Protection of Geographical Indications GIs as grounds for oppositions
Page of the document	Pages 25-34
Issue(s) you wish to comment on	Art. 8(4a) EUTMR no longer applies to GIs. GIs as ground for oppositions are now regulated under the new ground of Article 8(6).
Suggestion for text	The amendments to the Guidelines regarding this issue are limited to replacing all references to art. 8(4a) with references to new Article 8(6). At page 30 there is a welcome

	<p>clarification adding the possibility of making reference to an online source recognized by the Office according Article 7(4) EUTMDR to prove the registration of the GI under the laws of the Member States.</p> <p>However, both for GIs covered by the EU Regulations and for GIs protected under the laws of Member States, the Opponent needs to prove its entitlement and its right of action against unauthorized use based mainly on national documents. Such documents may be long and they need to be filed in the language of the proceedings. In order to simplify the filing of such evidence and save costs for Opponents, INTA would welcome a further clarification in the Guidelines to confirm that a partial translation of documents limited to the relevant content, would be accepted. Such addition may follow at the end of paragraphs 5.2.1.2 and 5.2.2. of the Guidelines.</p>
Contributor (name & position)	INTA 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 C OPPOSITION SECTION 4 - RIGHTS UNDER ARTICLES 8(4) AND 8(6) EUTMR 5.3 Scope of protection of GIs (about "reputation")
Page of the document	33
Issue(s) you wish to comment on	<p>As far as "reputation" is concerned, there have been decisions on opposition proceedings where according to the Office the "reputation" of a GI should be expressly invoked in the Notice of Opposition (see in particular OPPOSITION No B 2 629 858: "<i>The second alternative for protection under Article 103 of Regulation No 1083/2013 is that there is 'any direct or indirect commercial use of the protected name' (Article 103(2)(a), header) and that 'such use exploits the reputation of the geographical indication' (Article 103(2)(a)(ii)). The Opposition Division observes that that second condition is to be understood in the same way as Article 8(5) EUTMR, namely as a protection of a reputation or goodwill in a sign against acts of unfair exploitation of that reputation. This provision cannot be invoked, as the opponent failed to claim a reputation of its earlier sign in the notice of opposition. The only relevant indications in the notice of opposition were that the earlier sign is an appellation of origin and the quotation of the text of Article 8(4)."</i>)</p> <p>Since the exploitation of the reputation of a PDO/PGI is expressly encompassed in the scope of protection accorded to PDOs/PGIs pursuant to Articles 13(1)(a), 103(2)(a)(ii), 16(a) and 20(2)(a)(ii) of the Foodstuffs, Wines, Spirit Drinks and Aromatised Wines Regulations, if the opposition is based on these provisions through Article 8(4a) EUTMR of Regulation No 207/2009 (now Article 8(6) EUTMR, INTA understands that there is no need to invoke the reputation of the concerned PDO/PGI in the Notice of Opposition. INTA respectfully requests that the EUIPO clarify this issue.</p>
Suggestion for text	

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 C: Chapter 4: Rights under Articles 8(4) and 8(6) EUTM
Page of the document	35 to 64
Issue(s) you wish to comment on	We regret the deletion of the Table of non-registered rights which could be invoked under Article 8(4) EUTM, as it was useful for the users to have a preliminary idea of the countries in which use may provide rights and the main conditions.
Suggestion for text	We recommend inserting this table again.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 C. SECTION 5. TRADEMARKS WITH REPUTATION
Page of the document	15
Issue(s) you wish to comment on	3.1.2.6 Reputation acquired as part of another mark There is a missing “does”.
Suggestion for text	Reputation proven for a complex sign refers to that sign as such and not a particular element alone. As an example, the reputation acquired by a figurative mark may, but does not automatically benefit a word mark with which it is subsequently used.

Contributor (name & position)	EUIPO Subcommittee of the 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 C. SECTION 5. TRADEMARKS WITH REPUTATION
Page of the document	36 and 37
Issue(s) you wish to comment on	The paragraph is not clear.
Suggestion for text	

	In addition, such evidence may give useful indications of the kind of goods covered, the form in which the mark is actually used and the kind of image the opponent is trying to create for its brand. For example, if the evidence shows that the earlier registration for which reputation is claimed covers a device, but that in fact this device is used in combination with a verbal element, it would not be correct to accept that the device itself has a reputation. Rather, it should be assessed whether the reputation extends to the device. For that purpose , it is important to assess whether the device plays an independent and distinctive role in the product get-up or on the evidence in question.
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Contributor (name & position)	INTA EUIPO Subcommittee of the 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	1. PART C OPPOSITION, SECTION 6 PROOF OF USE
Page of the document	47-48
Issue(s) you wish to comment on	<p>2.7.3.3 Other alterations Acceptable alterations (...) <i>Colour marks</i> <i>Colour marks are marks consisting of one or more colours per se. Where the mark is a colour combination, the registration must indicate the proportion of each colour and specify how they will appear.</i> <i>Colour marks must be used with the colours as registered. Insignificant variations in the colour shade and strength will not alter distinctive character.</i></p> <p>In relation to combination colour per se marks, the use of the mark as described in the description or in the percentages indicated in the description or seen in the representation shall be considered as genuine use of the sign (judgment of 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 36). In those circumstances the mark does not have to be used as merely shown in the representation as the registration is a colour per se mark not a figurative mark.</p>
Suggestion for text	See comment above concerning acquired distinctiveness which also applies here.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 D, Cancellation, Section 1, Proceedings- Introduction- General Outline of Cancellation proceedings
Page of the document	Page 4
Issue(s) you wish to comment on	The terms “ <i>restrictions of the contested EUTM</i> ” have been deleted at the last paragraph of this page 4.
Suggestion for text	Whilst it is true that said restrictions are not strictly “procedural rules”, the clarification that this restriction is possible during invalidity proceedings is positive and it should be kept either in this paragraph or in some other item within the Guidelines.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 D, Cancellation, Section 1, Proceedings- 2.5.1.8. Identification of the Grounds
Page of the document	Page 12
Issue(s) you wish to comment on	The clarification that requests for revocation and invalidity against a EUTM must be filed separately, even if filed by the same applicant, is welcome.
Suggestion for text	

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 D, Cancellation, Section 1, Proceedings – 2.6. Notification of the Application
Page of the document	19
Issue(s) you wish to comment on	Term (now two months) granted to the EUTM proprietor to file a first reply to the application.
Suggestion for text	The term of three months was preferable, in particular in revocation actions where it is time consuming to retrieve the relevant evidence on use across different jurisdictions.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 D, Cancellation, Section 1, Proceedings – 3.1. Completion of the Application
Page of the document	21

Issue(s) you wish to comment on	Indication on the rounds of observations generally granted to the parties.
Suggestion for text	It is useful to clarify that the trademark proprietor may request evidence of use from the cancellation applicant and refrain from presenting any arguments until such evidence has been submitted.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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	Paragraph 2.3.3 (Relevant public)
Page of the document	9
Issue(s) you wish to comment on	<p>The last sentence in this paragraph (discussing whether a term has become generic) reads as follows:</p> <p><u>“Depending on the circumstances of the case it might be sufficient that the sellers of the finished product do not inform their customers that the sign has been registered as a trade mark or offer their customers assistance, which includes an indication of the origin of goods for sale.”</u></p> <p>“Depending on the circumstances of the case it might be sufficient....” may have been added to make sure that careless trademark uses by sellers do not <i>automatically</i> result in a finding of genericness.</p> <p>Therefore, it might be helpful to add additional language indicating that actions of trademark owners/sellers are merely one factor to consider. A suggestion for alternative wording is set forth below.</p>
Suggestion for text	“Depending on the circumstances of the case, <u>and when other factors also indicate that a term has become the common name of goods</u> , it might be sufficient....”

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 1CHANGES IN A REGISTRATION/ 1.3.1
Page of the document	5
Issue(s) you wish to comment on	However, when the declaration of surrender is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may be used in any of the official languages of the Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

Suggestion for text	We believe that the wording of this paragraph is unclear.
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Contributor (name & position)	INTA EUIPO Subcommittee of the 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 1CHANGES IN A REGISTRATION/2.2.1
Page of the document	9
Issue(s) you wish to comment on	However, when the application for the registration of an alteration of the mark is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may be used in any of the official languages of the Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.
Suggestion for text	We believe the wording of this paragraph is unclear.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 1/ 6.3
Page of the document	19
Issue(s) you wish to comment on	Chapter 6 includes the provisions of post-registrations seniority claim. The wording should be amended to clarify that these provisions are specified for this particular request of “ post registration ” seniority claim.
Suggestion for text	<p>“6.3.1 Form and languages. (...) however, when the post-registration seniority claim is filed (...)</p> <p>“6.3.2. Fees. There is no fee for an application for a post-registration seniority claim.”</p> <p>“6.4 Examination. Post-registration seniority may only be claimed....”</p> <p>“6.6 Cancellation of post-registration seniority claims. The EUTM proprietor may at any time request the cancellation of the post-registration seniority claim....”</p>

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 1/ 3.1
Page of the document	9 section 3.1
Issue(s) you wish to comment on	The application for the registration of a transfer for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.
Suggestion for text	The application for the registration of a transfer for an EUTM registration must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 1/3.1
Page of the document	9
Issue(s) you wish to comment on	“However, when the application for the registration of a transfer is filed using the form provided by the Office pursuant to Article 65(1)(e) EUTMDR or Article 68 CDIR, the form may be used in any of the official languages of the Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.”
Suggestion for text	We believe this paragraph is unclear.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 1/8
Page of the document	24
Issue(s) you wish to comment on	All applications for registration of to recording a change in ownership should be submitted on form MM5 either: <input checked="" type="checkbox"/> directly to the International Bureau by the registered holder, on record or <input checked="" type="checkbox"/> through the office of the registered holder or through the office of a contracting party in respect of which the transfer is granted, or

	<input checked="" type="checkbox"/> through the office of the new proprietor (transferee).
Suggestion for text	If an IR covers for example China and the EU, can the application be filed through the Chinese Office for both designations?

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 2/1.6
Page of the document	9
Issue(s) you wish to comment on	The last sentence “c) <i>The Office strongly recommends that liquidators withdraw, surrender or transfer EUTM’s subject to insolvency proceedings prior to the final winding up</i> ”, has been deleted. We consider that such a recommendation complies with the aim of keeping the registry updated, and provide information to third party (effects vis-a vis third parties).
Suggestion for text	“c) The Office strongly recommends that liquidators duly inform the Office on the withdrawal , surrender or transfer EUTM’s subject to insolvency proceedings prior to the final winding up”.

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 2/2,4,1
Page of the document	11 (EN track version)
Issue(s) you wish to comment on	In some cases the pledge is granted by a number of pledgees. According to national legislation even one pledgee is entitled to apply for the registration of the pledge, and there are some jurisdictions where the national registry for pledges request the office to register it (such as it happens in Spain with the registry of movable assets).
Suggestion for text	The Office should clarify that there is no need for all the pledgees to jointly request the application for the registration and should also include the national authorities as letter d) of lists of applicants.

Contributor (name & position)	INTA EUIPO Subcommittee of the Trademark Office Practices Committee
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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 3/Chapter 2/2,4,6
Page of the document	13
Issue(s) you wish to comment on	Paragraph b) and the last paragraph of page 13 are redundant (both analyze the case where the evidence is submitted in one of the official languages of the EU).
Suggestion for text	The following wording should be deleted because it is duplicated “Where the supporting documents are submitted in an official language of the EU, the Office may require a translation into the language of the proceedings.” And the following wording should be added at the end of paragraph b) “The Office will set a time limit for submission of the translation and if the translation is not submitted within that time limit, the document will not be taken into account and will be deemed not to have been submitted.”

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 2/2.5.2
Page of the document	15
Issue(s) you wish to comment on	In the second paragraph a reference to insolvency proceeding should also be made.
Suggestion for text	“Where the application for registration of the licence, right in rem, levy of execution <u>or insolvency proceedings</u> is signed by the representative that has already been designated...”

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 2/2.5.2
Page of the document	15
Issue(s) you wish to comment on	The last paragraph is redundant with the end of last paragraph of page 14. Therefore we proposed to delete it, as the last one in page 14 is more complete.
Suggestion for text	To delete “For additional specific formalities requirements that concern only licences and rights in rem please see the special provisions below (paragraphs 4.3. and 4.4 for licences and paragraph 5.2 for rights in rem”

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 2/3
Page of the document	15
Issue(s) you wish to comment on	The correspondent national authority (registry or court) should be have also the right to cancel or modify the registration.
Suggestion for text	To amend the first paragraph by adding the following: “ The registration of a licence, a right in rem, a levy of execution or insolvency proceedings will be cancelled or modified at the request <u>of the correspondent national authority or court as well as</u> at the request of an interested party....”

Contributor (name & position)	INTA EUIPO Subcommittee of the 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 3/Chapter 2/3.2
Page of the document	16 (EN track version)
Issue(s) you wish to comment on	The information contained in that paragraph on the persons that can request the modification or cancellation of the registration, has already been given in the first paragraph of point 3. We suggest taking that information out of point 3 and place it in point 3.2 as a clarification to the existing paragraph.
Suggestion for text	“Request for the cancellation or modification of a registration may be filed by the same personas who can file application for registration (se paragraph 2.4.1. above). <u>For the avoidance of doubt, the registration of a licence, a right in rem, a levy of execution or insolvency proceedings will be cancelled or modified at the request of the correspondent national authority or court as well</u> as at the request of an interested party....”

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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 3/Chapter 2/3.5.2
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Issue(s) you wish to comment on	In the first paragraph a reference to the specific formalities of levies of execution and insolvency proceeding should also be mentioned.
Suggestion for text	“ Additionally, specific formalities requirements apply to licences (see paragraph 4.3. and 4.4. below), to rights in rem (see paragraph 5.2 below), levies of execution (see paragraph 6.1 below) and insolvency proceedings (see paragraph 7.1 below) ”

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part E/Section 3/Chapter 2/3.5.2
Page of the document	21
Issue(s) you wish to comment on	If the request for registration has been filed by a competent authority (as for instance it happens in Spain with the Registry of movable assets in regards as to pledges of EUTM owned by Spaniards or non EU members) the Office should also communicate the registration of the cancellation or modification of the registration.
Suggestion for text	“Registration of the cancellation or modification of a licence, a rights in rem, a levy of execution or insolvency proceedings will be communicated to all the parties concerned including, when applicable, to the correspondent authorities. ”

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part E/Section 3/Chapter 2/3.6, 4.5, 6.2 and 7.2
Page of the document	21 and 27 and 33 and 34
Issue(s) you wish to comment on	The Office is kindly requested to explain the rationale behind not publishing in the EUTM Bulletin the creation, cancellation or modification of registrations on EUTM applications.
Suggestion for text	Clarifications should be included.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part E/Section 3/Chapter 2/5.1.1
Page of the document	28
Issue(s) you wish to comment on	The Office requests proof of licence but not proof of right in rem, when it is clearly a very complicated situation that affects rights of third parties and is subject to a very specific legislation (with a number of requirements) in a number of the member States.

	Therefore considering the vis-a-vis effects of publication and recording of registrations, we strongly encourage the Office to request proof of the right in rem.
Suggestion for text	The Office should request proof of the right in rem.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part M / International Marks / section 2.2
Page of the document	13
Issue(s) you wish to comment on	The last paragraph of page 13 does not provide for a specific term to remedy the deficiencies of a territorial extension request. <i>“If the request for territorial extension.....to remedy the deficiencies found within a time limit fixed by the Office.”</i> This is probably because applicants of subsequent designations can decide to postpone the effects of subsequent designations. However, for consistency, a term should be provided.
Suggestion for text	<i>“If the request for territorial extension does not comply with the requirements outlined above, the Office will invite the applicant to remedy the deficiencies found providing a term of at least one month from the notification of the deficiency by the Office.”</i>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part M / International Marks / section 4.4.2
Page of the document	40
Issue(s) you wish to comment on	Reference to the Madrid Agreement may be removed here as it is no longer applicable.
Suggestion for text	In accordance with Article 4bis of the Madrid Agreement and the Madrid Protocol, the holder may request the EUIPO to take note in its Register of the international registration that replaces an EUTM