GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part B

Examination

Section 2

Formalities

Table of Contents

1 Introduction....230

2 Filing of Applications....232

2.1 Applicants....232

2.2 How a European Union trade mark application can be filed....232

3 The Fees....233

3.1 Fees in general....233

3.2 Basic fee deficiency....233

3.3 Class fee deficiency....234

3.4 Fee refunds upon withdrawal....234

4 Filing Date....234

4.1 Filing date requirements....234

4.1.1 Fees....235

4.1.2 Request....235

4.1.3 Applicant....236

4.1.4 Representation of the mark....236

4.1.5 List of goods and services....239

4.2 Filing date receipt....239

4.2.1 Applications filed through the Office's User Area....239

4.2.2 Applications filed by other means....239

5 Goods and Services....239

5.1 Classification....239

5.2 Specific filing date deficiency and e-filing applications....240

6 Languages/Translations....241

6.1 First and second languages....241

6.2 The correspondence language....242

6.3 The reference language for translations....243

6.4 Non-translatable elements....243

6.5 Restriction of goods and services....244

7 Applicant, representative and address for correspondence....245

7.1 Applicant....245

7.2 Representative....245

7.3 Change of name/address..... 245
7.4 Transfer of ownership..... 246
8 Kind of mark..... 246
8.1 Individual marks..... 246
8.2 Collective marks..... 246
8.2.1 Character of collective marks..... 247
8.2.2 Applicants for collective marks..... 247
8.2.3 Regulations governing use of collective marks..... 247
8.2.3.1 Content of the regulations of use..... 247
8.2.3.2 Examination of formalities relating to the regulations of use..... 249
8.3 Certification marks..... 249
8.3.1 Character of certification marks..... 249
8.3.2 Applicants for certification marks..... 249
8.3.3 Regulations governing use of certification marks..... 250
8.3.3.1 Content of the regulations of use..... 250
8.3.3.2 Examination of formalities relating to regulations of use of certification marks..... 252
8.4 Changes of kind of mark..... 252
9 Representation, description and type of mark..... 253
9.1 Representation..... 253
9.1.1 Transparent elements or white elements..... 255
9.1.2 Dotted lines..... 256
9.2 Description..... 259
9.3 Mark type..... 260
9.3.1 Word marks..... 260
9.3.2 Figurative marks..... 261
9.3.3 Shape marks..... 263
9.3.4 Position marks..... 266
9.3.5 Pattern marks..... 267
9.3.6 Colour marks..... 268
9.3.7 Sound marks..... 270
9.3.8 Motion marks..... 272
9.3.9 Multimedia marks..... 274
9.3.10 Hologram marks..... 276
9.3.11 Other marks..... 277
9.3.11.1 Tracer marks..... 277
9.3.11.2 Smell/olfactory and taste marks..... 278

9.3.11.3 Tactile marks....278
9.3.12 Correction of mark type....279
9.3.12.1 General rules....279
9.3.12.2 Examples of recurring mark type deficiencies....279
10 Series marks....281
11 Priority....282
11.1 Formal requirements....282
11.1.1 Claiming priority....283
11.1.2 Priority documents....283
11.1.3 Language of previous application....284
11.1.4 Formal priority requirements not satisfied....284
11.2 Substantive requirements for priority claims....284
11.2.1 Principle of first filing....285
11.2.2 Triple identity....286
11.2.2.1 Identity of the marks....286
11.2.2.2 Identity of the goods and services....287
11.2.2.3 Identity of the owner....287
11.2.3 Substantive priority requirements not satisfied....288
11.3 Examples of priority claims....288
11.3.1 First filing....288
11.3.2 Comparison of the marks....289
11.3.3 Comparison of the goods and services....295
11.3.4 Priority claims based on series marks....296
11.3.5 Claiming priority for marks represented in a different format....296
11.3.5.1 Claiming the priority of an earlier national filing for an EUTM application....297
11.3.5.2 Claiming the priority of an earlier EUTM filing for a national application....297
12 Exhibition Priority....297
13 Seniority....298
13.1 Harmonised seniority information....299
13.2 Seniority examination – formal requirements....299
13.3 Seniority examination – identity of the marks....301
13.4 Goods and services....304
13.5 Treatment of seniority examination deficiencies....304
14 Transformation....304
15 Amendments to the EUTM Application....305

15.1 Amendments to the representation of the mark..... 305

16 Conversion..... 307

1 Introduction

Every European Union trade mark (EUTM) application must abide by certain formality rules. The purpose of these Guidelines is to lay down Office practice in relation to those rules.

MANDATORY FORMALITY REQUIREMENTS

A filing date will only be accorded once all the five requirements below have been fulfilled.

- Request for registration
- Applicant's details
- Representation of the mark
- List of goods and/or services
- Payment of basic fee

There are other mandatory requirements, but these will not affect the filing date.

4.1.2 Request on page 235	Submit a request for the registration of an EUTM. This can be done by using the form 'Application for a European Union trade mark'.
Applicant	Provide details to identify the applicant.
Trade mark representation	The representation of the mark (e.g. verbal, figurative, shape, etc.) must be submitted in any of the accepted formats.
List of goods and/or services	A list of goods and/or services must be submitted.
Fees	The basic fee must be paid within one month, and any additional class fee(s) if applicable.
Languages	A first language must be indicated (an official language of the EU) and a second language (English, French, German, Italian or Spanish).
Type of mark	The type of mark must be chosen: word mark, figurative mark, shape mark, etc.
Kind of mark	The kind of mark must be indicated: individual, collective, or certification mark. A regulation governing use of the mark when it is a collective or certification mark will have to be submitted within 2 months of the filing date.
Signature	The application form must be signed.

OPTIONAL CLAIMS AND INDICATIONS

Priority claim	If the applicant has filed, for the first time, a previous trade mark within 6 months before filing the EUTM, priority can be claimed from that earlier mark. The previous trade mark must be the first filing of the same mark, by the same applicant and have some goods or services in common. Priority can be claimed with the EUTM application or in a separate communication filed on the same date as the EUTM application by indicating the number, date and country of the previous application and, where applicable, submitting the required documents.
Exhibition priority claim	If the goods/services were displayed at a *Bureau International des Expositions (*'BIE')-recognised exhibition under the mark as filed, exhibition priority can be claimed within 6 months of the first display. Exhibition priority can be claimed with the EUTM application or in a separate communication filed on the same date as the EUTM application. The name of the exhibition and the date of first display of the goods or services must be indicated, and a certificate issued at the exhibition by the responsible authority submitted, and this must be accompanied by an identification of the actual use of the mark, duly certified by the authority.
Seniority claim	If the applicant has a previously registered mark in an EU Member State that is identical to the EUTM application and it covers goods and/or services that are identical to or contained within those for which the earlier trade mark has been registered, seniority can be claimed with the EUTM application [or at a later stage].
Translations	When submitting the list of goods and/or services, a translation can be provided into the second language.

Correspondence language	When the first language is not one of the five Office language (English, French, German, Italian or Spanish), the second language can be chosen to be used as a correspondence language with the Office.

2 Filing of Applications

2.1 Applicants

Article 5 EUTMR

For information **on who may be an applicant,** see the Guidelines, Part A, Section 5, paragraph 1, Introduction — Parties to the Proceedings and Principle of Representation and paragraph 3, Identification of Parties to the Proceedings.

2.2 How a European Union trade mark application can be filed

Article 30(1) and Article 100 EUTMR

Article 63(1) EUTMDR

Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means

Applications for an EUTM can only be filed directly with the Office.

EUTM applications may be filed electronically, by post or by courier. The Office offers the possibility of an accelerated procedure known as ‘Fast Track’ for applicants who file through the Office’s User Area (for more details please check the Office’s website).

3 The Fees

Article 31(2), Article 32, Article 41 and Articles 179 and 180 and Annex I EUTMR

Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges.

3.1 Fees in general

For the application of an EUTM the following fees are applicable.

Trade Mark	Basic Fee (including one class)	Fee for a second class	Fee for each additional class
Individual mark	EUR 1 000	EUR 50	EUR 150
Individual mark filed electronically	EUR 850	EUR 50	EUR 150
Collective mark	EUR 1 800	EUR 50	EUR 150
Collective mark filed electronically	EUR 1 500	EUR 50	EUR 150
Certification mark	EUR 1 800	EUR 50	EUR 150
Certification mark filed electronically	EUR 1 500	EUR 50	EUR 150

The fee must be paid in euros. Payments made in other currencies are not valid.

For more information on fees, see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

3.2 Basic fee deficiency

If the basic fee is not paid within 1 month of the date the Office received the application, the provisional filing date will be lost (see paragraph 4, Filing Date).

However, the filing date can be maintained if evidence is submitted to the Office that the person who made the payment (a) duly gave an order within the relevant period to a banking establishment to transfer the amount of the payment, and (b) paid a surcharge of 10 % of the total amount due (up to a maximum of EUR 200).

The surcharge will not be due if the person submits proof that the payment was initiated more than 10 days before expiry of the 1-month time limit.

3.3 Class fee deficiency

Where the application covers more than one class of goods and/or services, an additional class fee is payable for each additional class.

- Where the fee payment made or the amount covered by the current account is less than the total sum of fees due for the classes selected in the application form, a deficiency letter will be issued, setting a 2-month time limit for payment of the remaining amount. If the outstanding payment is not received within the specified time limit, the application will be deemed to be withdrawn for the classes not covered by the fee paid. In the absence of other criteria to determine which classes are intended to be covered by the amount paid, the Office will take the classes in the order of the classification (starting with the lowest class number).
- Where additional class fees become payable following the rectification of a classification deficiency, a deficiency letter will be issued, setting a 2-month time limit for payment. If payment is not received within the time limit specified, the application will be deemed to have been withdrawn for those classes resulting from the reclassification not covered by the fees actually paid. In the absence of other criteria to determine which classes are intended to be covered by the amount paid, the Office will take the classes in the order of the classification (starting with the lowest class number).

3.4 Fee refunds upon withdrawal

On withdrawal of the EUTM application, the application fee (basic and class fees) will only be refunded in certain circumstances.

For more information on this, see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

4 Filing Date

Articles 4, 31, 32 and 41 EUTMR

4.1 Filing date requirements

A filing date is accorded where the application fulfils the following requirements:

- the application is a request for the registration of an EUTM;
- the application contains information to identify the applicant;

- the application contains a representation of the trade mark that satisfies the requirements set out in Article 4(b) EUTMR;
- the application contains a list of goods/services;
- the basic fee has been paid within 1 month of filing the application.

If any of the above requirements are not met on the date of filing, a deficiency letter will be sent requesting that the applicant submit the missing item within 2 months of the notification of the deficiency letter. This time limit is not extendable. If the deficiency is not remedied, the EUTM application will not be treated as an application for an EUTM ('deemed not filed') and all fees already paid will be reimbursed. If the missing information is submitted within the time limit set in the deficiency letter, the filing date will be changed to the date on which all mandatory information is complete, including the payment.

After the date of filing, only minor corrections may be made to the application pursuant to Article 49(2) EUTMR (e.g. **a correction** in the name or address, as explained further in Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation, paragraph 11, Correction of the name and address).

See also section 2 Filing of Applications

See also paragraph 4.2.1, Applications filed through the Office's User Area.

4.1.1 Fees

Articles 31(2) and 41(3) and (5) EUTMR

The basic fee and, where appropriate, class fees, must be paid within 1 month of the filing of the application. Where the fee is not paid within 1 month the Office will issue a deficiency letter (see paragraph 3.2, Basic fee deficiency, and paragraph 5.2, Specific filing date deficiency and e-filing applications).

4.1.2 Request

Article 31(1)(a) EUTMR Article 65(1)(a) EUTMDR Article 2(1)(a) EUTMIR

The application must contain a request for the registration of an EUTM.

It is strongly recommended that the EUTM application is filed using the Office's e-filing form, available in the official languages of the European Union.

4.1.3 Applicant

Articles 31(1)(b) and 41(1)(b) EUTMR

Article 2(1)(b) EUTMIR

For information **on the elements identifying the EUTM applicant, including the name, legal form and address,** see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation, paragraph 3, Identification of Parties to the Proceedings.

4.1.4 Representation of the mark

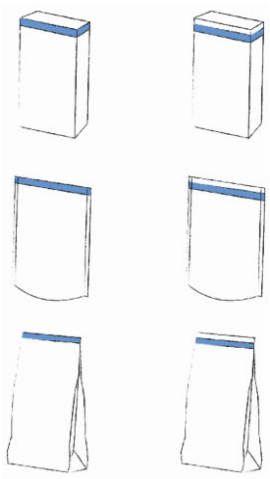
Article 4, Article 31(1)(d) and Article 31(3) EUTMR

Article 2(1)(d) and Article 3 EUTMIR

The application must contain a representation of the mark that allows to determine the clear and precise subject matter of the protection requested in accordance with Article 4(b) EUTMR. For further information on the different types of marks, please see paragraph 9.

The representation will not be considered clear and precise where the representation of the mark (either filed on an A4 sheet or in a JPEG file) contains various versions of the same figurative sign (series / serial mark). In those cases, a filing date deficiency will be issued and the applicant will be invited to submit a new representation showing a single mark. The filing date will be the date when the amended representation is received by the Office.

Examples

Representation No 1	Representation No 2	Explanation	EUTM No
		The Office sent a filing date deficiency letter to the applicant as the representation initially submitted ('representation 1') shows different positions on the good. The EUTM applicant changed the representation to 'representation 2' and a filing date was consequently granted to the application.	EUTM No 17 883 541

Representation	Explanation	EUTM No
	Five views that do not all show the same object.	EUTM No 6 910 021

Representation	Explanation	EUTM No
	Including text in addition to the representation of the mark is not allowed (text below the photo of the bottle).	EUTM No 7 469 661
	The first and third bottles show two different perspectives of the same bottle, both with a grey lid. The second bottle has a blue lid, and is therefore a different object to the first and third bottles. The fourth image is completely different, showing two bottle tops and a label. Of the four perspectives, only the first and third are views of the same object. Furthermore, including text in addition to the representation of the mark is not allowed.	EUTM No 9 739 731
	The first four images and the sixth image show the same shape mark from different perspectives. However, the fifth image is inconsistent with the others in that it shows a different shape mark, as it has been manipulated. Views of an object in a different state (e.g. open v closed) are not considered to be the same mark.	EUTM No 13 324 363

4.1.5 List of goods and services

Article 31(1)(c) and Article 33 EUTMR

Article 2(1)(c) EUTMIR

In order for a filing date to be accorded, there must be a list of goods and services.

To build their list of goods and services, applicants can select pre-approved terms from the Harmonised Database, which will be automatically accepted for classification purposes. Using these pre-approved terms will facilitate a smoother trade mark registration process.

For applications filed electronically, please see also paragraph 5.2.

4.2 Filing date receipt

4.2.1 Applications filed through the Office's User Area

For EUTM applications filed through the Office's User Area, the system immediately issues an automatic electronic filing receipt, which contains the provisional filing date. The applicant should keep this receipt and verify that all data, including the mark representation, corresponds to what was intended to be applied for. Corrections will only be accepted if they were requested on the same date the application was filed.

4.2.2 Applications filed by other means

When an application is received other than through the Office's User Area, a provisional filing date is accorded and the Office issues a receipt with this filing date. The filing date will be considered the date of receipt if the application fulfils the filing date requirements.

5 Goods and Services

5.1 Classification

Article 33(1) to (6) EUTMR

Every EUTM application must contain a list of goods and services as a condition for being accorded a filing date (see paragraph 4.1.5).

The list must be classified in accordance with the Nice Agreement and must be filed in the first language of the application.

The scope of protection defined by the original list of goods and services cannot be extended. If an applicant wants to protect additional goods or services after filing, a new application must be filed.

For further information on the classification of goods and services, please refer to the Guidelines, Part B, Examination, Section 3, Classification.

5.2 Specific filing date deficiency and e-filing applications

Article 31(3), Article 31(1)(c) and Articles 41 and 100 EUTMR.

Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means.

Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means, Annex I, Conditions of Use of the User Area.

E-filing applications are subject to Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means and the associated Annex I, covering the Conditions of Use of the User Area.

The list of goods and services must be entered in the text fields provided for that purpose.

Where the list of goods and services is filed totally or partially as an attachment to an e-filing application, or is filed separately, the application will not be considered as having been filed by electronic means and the corresponding higher fee for applications not filed by electronic means will apply.

In such cases, the Office will wait for the 1-month payment deadline to allow the applicant to pay the full basic fee and keep the original filing date. If the full basic fee is not paid at the end of that period, the Office will issue a filing date deficiency, requesting payment of the difference between the reduced basic fee for applications filed by electronic means and the standard basic fee, that is to say, EUR 150 for individual marks and EUR 300 for collective marks and certification marks within 2 months of the notification of the deficiency letter.

This time limit is not extendable. If the deficiency is not remedied, the EUTM application will be ‘deemed not filed’ and all fees already paid will be reimbursed. If the shortfall is paid within the set time limit, the filing date will be changed to the date on which the payment is complete (see paragraph 4.1, Filing date requirements, and especially, paragraph 4.1.1, Fees).

6 Languages/Translations

Articles 146 and 147 EUTMR

Article 2(1)(j) EUTMIR

An EUTM application may be filed in any of the official languages of the European Union. A second language must be indicated on the application form, which must be one of the five languages of the Office, namely English, French, German, Italian or Spanish.

A different language version of the application form from the language chosen as the first language may be used. However, the application form must be completed in that first language, including the list of goods and services and, where appropriate, the mark description.

6.1 First and second languages

All information on the application form must be in the first language; otherwise, a deficiency letter is sent. If the deficiency is not remedied within 2 months, the application will be rejected.

The second language serves as a potential language for opposition and cancellation proceedings. The second language must be different from the language selected as the first language. Under no circumstances can the choice of first and second language be changed once filed.

When filing the application, the applicant may choose to submit a translation into the second language of the list of goods and services and, where relevant, of any mark description. This is not a requirement because the Office arranges for translations. Moreover, if the list of goods and services is made up of terms that originate from the Harmonised Database there are translations available in all the relevant EU languages. If the applicant still insists on submitting its own translation, it is responsible for ensuring that the translation corresponds to the first language. It is very important for the applicant to ensure the accuracy of the translation as, in particular, the translation submitted by the applicant may be used as the basis for the translation of the application into all the remaining languages of the European Union (see paragraph 6.3, Reference language for translations). In the case of any discrepancy, the language version that prevails (authentic language) depends on whether the first language is one of the five Office languages or not. If the first language of the application is one of the five Office languages, the first language version prevails. If the first language of the application is not one of the five Office languages, the second language prevails.

If a translation of goods and services is supplied in the second language, the Office will not verify the accuracy of the translation itself. The same applies in respect of the mark description (where appropriate). If there is an obvious discrepancy between the two

languages because, for example, the applicant has only submitted a partial translation of the goods and services and/or of the mark description, a deficiency letter will be sent, requesting that the additional translations be submitted within 2 months from notification of the deficiency. If the applicant fails to submit the omitted translations, then all translations submitted by the applicant will be disregarded and the Office will proceed on the basis of the first language as if no translation had been submitted.

6.2 The correspondence language

The correspondence language is the language used in correspondence between the Office and the applicant in examination proceedings until registration of the mark.

If the language that the applicant has selected as the first language is one of the five languages of the Office, then this will be used by the Office as the correspondence language.

Only where the language selected as the first language is not one of the five Office languages can the applicant indicate that it wants the correspondence language to be the second language. This request can be made on the application form by ticking the relevant box or can be requested later, either by explicit request, or implicitly by sending a communication to the Office in the second language. However, such a request will be refused where the Office has already issued a deficiency or objection letter in the first language.

In cases where the applicant selects one of the five Office languages as the first language but then indicates that the second language is to be the correspondence language, the Office will change the correspondence language to the first language and inform the applicant.

Example		
First language selected	**Second language selected**	**Correspondence language selected**
French	English	English
The correspondence language will be changed to French.		

The only exception to this rule is where a declaration of withdrawal or restriction has been submitted in the second language (English in the above example). The confirmation to the applicant will be issued in the language in which the declaration has been filed (English in the above example). See also paragraph 6.5 Restriction of goods and services.

6.3 The reference language for translations

The list of goods and services is translated into the official languages of the EU. The source language for translations is defined as the reference language. This reference language will always be the language for classification.

1. If the first language of the application is one of the five Office languages, it will always be the reference language. It is the language designated as the authentic language pursuant to Article 147(3) EUTMR.
2. If the first language of the application is not one of the five Office languages **and** a translation into the second language has **not** been submitted, the first language will be the reference language.
3. If the first language is not one of the five Office languages **and** the applicant has submitted a translation of the goods and services in the second language, the reference language will be the second language because it is the one designated as the authentic language pursuant to Article 147(3) EUTMR and consequently prevails in the event of discrepancies between the different linguistic versions (see paragraph 6.1, First and second languages). In this scenario, the examination of the classification of the list of goods and/or services will be performed in the second language. When an objection (regarding classification or absolute grounds) results in an amendment of the list of goods and services, the applicant will be invited to submit both language versions of the new list:
   - if the applicant submits the amended list only in the second language, the amendment will be disregarded and the Office will refuse the goods and/or services to which an objection has been raised;
   - if the applicant submits the amended list in the first language only, the translation originally submitted by the applicant in the second language will be deleted and the list of goods and/or services will be translated by the Office into all the other EU languages including the second language.

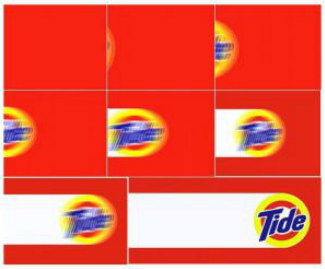
6.4 Non-translatable elements

Before requesting translation of an application, ‘non-translatable elements’, for instance verbal elements or colour codes, will be identified as such by putting them into inverted commas (“”), as agreed as a formatting rule with the Translation Centre for the Bodies of the European Union (CdT).

Example

Where the (acceptable) mark description refers to a verbal element of the mark, this element should not be translated.

Mark description	**Mark**

EUTM No 14 103 634 This is a motion mark in colour. It consists of eight pictures, sequencing the following movement: The “Tide” brand logo appears from the left-hand side with increasing speed, leaving behind it a white swoosh, until it stops when it reaches the right-hand side of the screen. Because of the movement and speed, the logo is blurred until it stops, at which point it appears well defined. The whole movement lasts 2.5 seconds.	
EUTM No 15 922 883 This is a motion trade mark in colour. The trade mark consists of the word “CHUBB” displayed in a series of colours. The series consists of the following order of colours: grey, purple, green, yellow, red, turquoise, orange, blue and pink. The word “CHUBB” is displayed in each of the colours in the series in turn. Each colour is displayed for approximately 10 seconds. When a sequence of the word “CHUBB” in the colours grey, purple, green, yellow, red, turquoise, orange, blue and pink has been completed, the sequence starts again from the beginning, with the word “CHUBB” being displayed first in the colour grey, as the first colour of the series, and then in each of the colours in the series in the same order as before. Again each colour is displayed for approximately 10 seconds.	

6.5 Restriction of goods and services

Articles 49(2) and 146(6)(a) EUTMR

For information on the restriction of goods and services and languages, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.2 and the Guidelines, Part A, General Rules, Section 4, Languages, paragraph 5.1.

7 Applicant, representative and address for correspondence

Articles 3, 5, 55, 119 and 120 EUTMR

Article 74 EUTMDR

Article 2(1)(b) and (e) EUTMIR

7.1 Applicant

For information **on the identifications elements of the EUTM applicant, including the name, legal form, and address,** see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation, paragraph 3, Identification of Parties to the Proceedings.

7.2 Representative

If the applicant has its domicile, principal place of business or a real and effective industrial or commercial establishment in the European Economic Area (EEA), there is no obligation for it to be represented.

If the applicant does not have its domicile, principal place of business or a real and effective industrial or commercial establishment in the EEA, regardless of its nationality, representation must be sought to act for it in all proceedings except the filing of the EUTM application and the payment of the application fee. Every representative in the sense of Article 120 EUTMR who files an application with the Office is placed on the Representative database and given an ID number. If the representative has been allocated an ID number by the Office, it is sufficient to indicate only that number and his or her name.

For more information on representation, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

7.3 Change of name/address

Article 55 and Article 111(3)(a) EUTMR

For information **on the change of name/address of the EUTM applicant**, including the name, legal form and address, see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation, paragraph 10, Change of name and address.

7.4 Transfer of ownership

Article 20(4) and (9) and Articles 28 and 111 EUTMR

Article 13 EUTMIR

EUTM registrations and applications may be transferred from the previous proprietor/ applicant to a new proprietor/applicant, primarily by way of assignment or legal succession. The transfer may be limited to some of the goods and/or services for which the mark is registered or applied for (partial transfer). At the request of one of the parties, a transfer will be entered in the Register and published.

For more information on the recording of transfers of ownership see the Guidelines, Part E, Register Operations, Section 3, EUTMs and EUDs as Objects of Property, Chapter 1, Transfer.

8 Kind of mark

The EUTMR distinguishes between three kinds of marks: individual, collective and certification. The Office's decisions and communications will identify collective or certification marks, as appropriate.

8.1 Individual marks

Article 5 EUTMR

An individual mark is a kind of trade mark that indicates the commercial origin of the protected goods and/or services. Any natural or legal person, or person equivalent to these persons under the national law applicable to them, including authorities established under public law, may be the proprietor of a European Union individual trade mark, irrespective of their nationality.

8.2 Collective marks

Articles 41(2) and Articles 74 to 76 EUTMR

Article 16 EUTMIR

For further information on collective marks, please see the Guidelines, Part B, Section 4, Chapter 15, EU Collective Marks.

8.2.1 Character of collective marks

A collective mark is a specific kind of mark, described as such when the mark is applied for, that indicates that the goods or services protected by that mark originate from members of an association, rather than from just one trader. Collective does not mean that the mark belongs to several persons nor that it designates/covers more than one country.

Collective marks may be used together with the individual mark of the producer of a given good or of the service provider. This allows members of an association to differentiate their own products and/or services from those of competitors.

For further information on the substantive requirements of EU collective marks, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 15, European Union Collective Marks.

8.2.2 Applicants for collective marks

Associations of manufacturers, producers, suppliers of services or traders that, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue or be sued, as well as legal persons governed by public law, may apply for a collective mark. The applicant must be either an association in a formal sense or have an internal structure of an associative nature (for example, Spanish 'Consejos Reguladores' are regulatory councils, which are governed by public law but are organised under the form of associations).

For further information on the ownership requirements of EU collective marks, please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 15, European Union Collective Marks.

8.2.3 Regulations governing use of collective marks

In addition to the information to be submitted when applying for an individual trade mark, applications for a European Union collective trade mark require the submission of regulations governing use of the mark.

The regulations governing use must be submitted within 2 months of the filing date of the application (Article 75(1) EUTMR).

The Office recommends use of its template, specifically created to guide applicants through the process of drafting the regulations governing use.

8.2.3.1 Content of the regulations of use

The regulations governing use referred to in Article 75 EUTMR must be set out in a stand-alone document and contain the obligatory information as required by Article 16 EUTMIR, namely:

1. the **name of the applicant**; (identical to the one given in the application form);
2. the **object of the association** or the object for which the legal person governed by public law is constituted;
3. the **bodies authorised to represent the association** or the said legal person (titles, such as director, association secretary; not personal names);
4. for associations, the **conditions for membership**; containing, when appropriate, the authorisation for others to become a member of the association when the mark designates the geographical origin of the goods and services and their goods and services originate in the geographical area concerned (Article 75(2) EUTMR) (regarding situations where authorisation is needed, see the Guidelines, Part B, Section 4, Absolute Grounds for Refusal, Chapter 15, European Union Collective Marks, Point 4.1, Article 74(2) EUTMR: geographical derogation);

   the rules concerning the conditions for membership must be specifically included in the regulations governing use; cross references to other documents are not sufficient;

5. the representation of the EU collective mark (**identical** to the sign applied for; no additional sign or possible variations of it should be reproduced except in the case of identical regulations of use filed by the same applicant in relation to other EU collective marks — all represented in the regulations of use);
6. the **persons authorised to use the mark**;

   authorisation to use the mark is conditional upon membership of the association; however, in addition to membership, there can be additional requirements which, if they exist, must be set out;

   the requirement to indicate the authorised persons can be met by referring to a general class of authorised person or by providing a specific list; such a list may be set out in the regulations of use or may be referenced by a hyperlink;

   reference to authorised users as ‘licensees’ is to be avoided as it wrongly implies that authorisation to use the mark derives from being a party to a contract whereas it derives from membership of the association and compliance with the regulations of use;

   non-members of the association cannot be authorised persons to use the mark, as this would contradict the definition of EU collective marks (Article 74(1) EUTMR);

7. where appropriate, the **conditions governing use of the mark** applied for, including sanctions (e.g. where the mark is to be placed on the goods, or where a minimum size of the mark in relation to the goods is to be respected);
8. the **goods or services** covered by the EU collective mark (**identical** to the list of goods and services of the application), including, where appropriate, any limitation further introduced (e.g. as a consequence of the application of Article 7(1)(j), (k) or (l) EUTMR).

8.2.3.2 Examination of formalities relating to the regulations of use

8.2.3.2.1 Regulations of use not submitted

If the regulations are not submitted with the application, a deficiency letter will be sent, setting a time limit of 2 months to submit them.

If the regulations are not submitted within this 2-month time limit, the application will be refused.

8.2.3.2.2 Regulations of use submitted but with deficiencies

If the regulations have been submitted but fail to specify the required information, as listed in paragraph 8.2.3.1, a deficiency letter will be sent, setting a time limit of 2 months to submit the missing information.

If the deficiency is not remedied within this 2-month time limit, the application will be refused.

For more details, please refer to the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 15, European Union Collective marks.

8.3 Certification marks

Article 41(2) and Articles 83 to 85 EUTMR Article 17 EUTMIR

For further information on certification marks, please see the Guidelines, Part B, Section 4, Chapter 16, EU Certification Marks.

8.3.1 Character of certification marks

An EU certification mark is an EU mark that is described as such when the mark is applied for and is capable of distinguishing goods or services that are certified by the proprietor of the mark in respect of material, mode of manufacture of the goods or performance of the services, quality, accuracy or other characteristics, **with the exception of geographical origin**, from goods and services that are not thus certified.

For further information on the substantive requirements of European Union certification marks, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 16, European Union Certification Marks.

8.3.2 Applicants for certification marks

Any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for EU certification marks, provided that such person does not carry on a business involving the supply of goods or services of the kind certified.

For further information on the substantive requirements of European Union certification marks, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 16, European Union Certification Marks.

8.3.3 Regulations governing use of certification marks

In addition to the information to be submitted when applying for an individual trade mark, applications for a European Union certification mark require the submission of regulations governing use of the mark.

The regulations governing use must be submitted within 2 months of the filing date of the application (Article 84(1) EUTMR).

The Office recommends use of its template, specifically created to guide applicants through the process of drafting the regulations governing use.

8.3.3.1 Content of the regulations of use

The regulations governing use referred to in Article 84 EUTMR must be set out in a stand-alone document and contain the obligatory information as required by Article 17 EUTMIR , namely:

1. the **name of the applicant** ;
2. a **declaration** that the applicant complies with the requirements laid down in Article 83(2) EUTMR , that is, a declaration by the applicant that it does not carry on a business involving the supply of goods and services of the kind certified;
3. the **representation** of the EU certification mark (**identical** to the sign applied for; no additional sign or possible variations of it should be reproduced except in the case of identical regulations of use filed by the same applicant in relation to other EU certification marks — all represented in the regulations of use);
4. the **goods or services** covered by the EU certification mark (**identical** to the list of goods and services of the application);
5. the **characteristics** of the goods or services to be certified by the EU certification mark, such as the material, mode of manufacture of the goods or performance of the services, quality or accuracy (taking into account that, according to Article 83(1) EUTMR , the geographical origin of the goods or services can never be listed as a characteristic);

   these characteristics must be clearly stated and may be described in general terms;

   all the goods and services that are claimed in the application must be able to be covered by the/a characteristic given in the regulations governing use. The characteristic must be coherent with the goods and services (e.g. it would make no sense to certify that *jewellery* cannot be sugar-free). The characteristic(s) must be clearly specified and explained in respect of each of the goods and services or at least for general category of goods and services;

   the certification scheme can be based on standards from official and/or private sources (e.g. EU regulations, DIN or ISO norms); in either case a reference to the

specific norms must be inserted in the regulations governing use together with a description in general terms of the same standards;

there is no need to detail or reproduce all technical aspects and specifications in the body of the regulations of use, it will suffice to refer to external sources and further documents by means of hyperlinks, even where they are not freely accessible online;

6. the conditions governing use of the EU certification mark, including sanctions;

   the regulations governing use need to include specific **conditions of use of the mark applied for** imposed upon the authorised user such as whether there are **fees** to be paid in connection with the use of the mark, etc. It is also mandatory to specify the appropriate **sanctions** that apply if these conditions are not respected.

7. the **persons authorised** to use the EU certification mark;

   the *authorised users* may be identified as follows:

   a. any person meeting the required standard of the characteristics being certified (point 5) and the conditions governing use (point 6);
   b. a specific category of persons linked to an open objective criteria;
   c. a list of authorised users included in the regulations governing use or accessible through a working internet link;

   these users should be referred to in the regulations governing use as **'authorised users'** but never as 'licensees', since a licensing agreement serves a different purpose to that of the regulations.

8. how the certifying body is to **test the characteristics** and **to supervise use** of the EU certification mark.

The regulations of use must include the **testing methods of the characteristics being certified** and the **supervision** system of the use of the mark by the owner of the certification mark. The testing methods and supervision, which must be clearly set out in the regulations of use, must be real and effective and are the responsibility of the owner of the certification mark.

The applicant/owner does not necessarily need to carry out the tests or supervise the conditions of use itself. In some cases, it might be necessary to cooperate with more specialised external testers and/or supervisors. However, the testing methods and supervision can never be transferred to the authorised user of the mark through a self-monitoring programme as this would not guarantee the correct functioning of the certification mark system.

The measures can relate to the methods, sampling and frequency of the testing and supervision, the qualification of the persons carrying out the tests and the supervision, and the 'triggers' for additional or enhanced tests or supervision measures.

8.3.3.2 Examination of formalities relating to regulations of use of certification marks

8.3.3.2.1 Regulations governing use not submitted

If the regulations are not submitted with the application, a deficiency letter will be sent, setting a time limit of 2 months to submit them.

If the regulations are not submitted within this 2-month time limit, the application will be refused.

8.3.3.2.2 Regulations governing use submitted but with deficiencies

If the regulations have been submitted but fail to specify the required information, as listed in paragraph 8.3.3.1, a deficiency letter will be sent, setting a time limit of 2 months to submit the missing information.

If the deficiency is not remedied within this 2-month time limit, the application will be refused.

8.4 Changes of kind of mark

When the EUTM application is not for an individual trade mark, the applicant must include a statement to the effect that the application is for the registration of an EU collective mark or an EU certification mark (Article 2(1)(i) EUTMIR) and it must fulfil the requirements of the corresponding kind of mark.

However, there might be circumstances under which the applicant, on the basis of Article 49(2) EUTMR can request a change of kind of mark because the kind selected upon application is **obviously** wrong. Where the request for such a change is accepted, the fee will be adapted accordingly.

Should the change requested be refused by the Office, the applicant will be informed and a time limit of 2 months will be set for observations.

Some examples of acceptable requests for change of kind of mark (provided there is no other indication in the file and that the applicant indeed meant to apply for the initially chosen kind of mark):

- a **natural person has** applied for a **collective mark**: the kind of mark can be changed to ‘individual’ since collective marks cannot be granted to natural persons;

  a legal person has applied for a collective mark/certification mark but **the regulations of use** submitted clearly support the change requested (if from the terminology used and/or the overall scheme reflected in the document is clear that it refers to another kind of mark, the change will be accepted);

- **the sign** contains an explicit reference to a 'collective mark' or 'certification mark': the kind of mark can be adjusted to indicate the reflected kind of mark;

- the sign contains a **PDO/PGI** and the mark has been applied as a certification mark: the kind of mark can be changed to ‘collective’ since, by nature, PDO/PGIs certify

the geographical origin of the goods and services and this kind of characteristic is banned from law for certification marks;

- the mark has been filed as a collective or certification mark and no regulations **of use** have been submitted: the kind of mark can be changed to 'individual'.

EU certification marks have existed since 01/10/2017, which is their earliest possible filing date. Consequently, changes of kind of mark to 'certification mark' are excluded in case of individual and collective trade marks filed before 01/10/2017.

The kind of mark will never be changed after registration, irrespective of when it was filed.

9 Representation, description and type of mark

9.1 Representation

Article 4, Articles 31, 41 and 49(2) EUTMR

Article 3(1), 3(2), 3(3), 3(5), 3(6) and 3(9) EUTMIR

Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means

The representation of the trade mark defines the subject matter of the registration. Therefore, protection will be granted to the mark as it is represented.

A trade mark may be represented in any appropriate form using generally available technologies as long as it can be reproduced on 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, when given, must accord with the representation.

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 no longer possible to indicate the colour(s) appearing in the trade mark or give any colour code, with two exceptions – first, when colours form part of the trade mark representation and are also indicated as an integral part of any description given, and, second, when colours are indicated for the sole purpose of claiming priority in other jurisdictions. However, indications provided in the context of claiming priority will neither be published, translated nor appear in the EUTM Register (see paragraph 11.3.5.2).

If the applicant fails to submit a representation that satisfies the requirements of Article 4(1)(b) EUTMR when filing the EUTM application, a deficiency will be notified to the effect that no filing date can be accorded (see paragraph 4).

Where (in cases other than e-filing) the application contains a representation of the mark without specifying the desired mark type, the Office will grant a filing date and, based on the representation submitted, accord the appropriate mark type where possible and inform the applicant in writing, setting a 2-month time limit for observations. If the representation is submitted but the Office cannot accord any mark type *ex officio,* a formality deficiency will be issued and the applicant will be requested to remedy such deficiency within 2 months.

Where the applicant has selected a mark type that does not correspond to the mark representation, the mark type will be corrected following the indications set out under paragraph 9.3.12.

As per Article 3(5) EUTMIR, where the representation is provided electronically, the Executive Director of the Office determines the format and size of the electronic files. See Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means.

In an application submitted through e-filing, reproductions of the mark using JPEG must be uploaded as a single JPEG file.

For those representations not provided electronically, Article 3(6) EUTMIR states that the trade mark must be reproduced on a single sheet of paper separate from the sheet on which the text of the application appears. The single sheet on which the mark is reproduced must contain all the relevant views or images and must not exceed DIN A4 size. A margin of at least 2.5 cm must be left all around.

The JPEG file or A4 sheet must contain only one representation of the mark as applied for and no additional information whatsoever (except the indication of the correct position of the mark where this is not obvious; see Article 3(6) and (7) EUTMIR). For shape marks, if various perspectives of the same shape are submitted, these perspectives must also be submitted as one JPEG file or on one A4 sheet.

When an application contains more than one JPEG or A4 sheet showing different marks, albeit very similar ones, the Office issues a deficiency letter, requesting the applicant to choose one mark from among the different variations. If the applicant wants to protect the others as well, it will have to file a new application for each of the other marks it wishes to register. When there is no response to the deficiency letter within the time limit set therein, the application will be rejected.

For more information on applications filed with more than one mark representation in one JPEG or on one A4 Sheet, such as series/serial marks, and filing date requirements, see paragraph 4.1.4 Representation of the mark.

According to Article 3(9) EUTMIR the filing of a sample or a specimen does not constitute a proper representation.

Finally, verbal elements consist of letters in the alphabet of any official EU language, and keyboard signs. Where a mark other than a word mark contains any such verbal

element that is visible from the representation, including non-graphical representations, it must be included in the ‘word element(s)’ field of the application form. This allows the mark to be searched for within the database and also forms the basis of the language check for marks that is carried out in all official languages of the EU.

9.1.1 Transparent elements or white elements

White is usually used as background in trade mark representations and is understood by the Office as such.

If, however, a white element of the trade mark would go unnoticed in the representation due to the background colour, the Office recommends that the mark be categorised as an ‘other’ type of trade mark, with an appropriate description. The same would apply if the trade mark consisted exclusively of white elements.

This option is limited to these exceptional cases in which, from the representation alone, it is not possible to rely on the principle of what you see is what you get.

Examples

	EUTM 18 706 578 Categorised as an ‘other mark’ and containing the following description: *the light grey colour is not part of the trade mark. This colour serves solely as background*.
The trade mark consists exclusively of white elements, so the background needs to be in a different colour in order to represent the trade mark. The description explains how the colour grey in the mark is to be understood and allows the trade mark to be identified.	

	EUTM No 17 914 208 Categorised as an ‘other mark’ and containing the following description: *The light grey colour is not part of the trade mark. This colour serves solely as background*
The trade mark contains black and white elements; the white elements would not be noticed on a usual white background, so this background needs to be in a different colour to distinguish the white elements. The description explains how the colour grey in the mark is to be understood and allows all the elements that form part of the trade mark to be identified.	

The same approach applies when the mark contains or consists of a transparent element.

	EUTM 18 285 005 Categorised as 'other' mark and containing the following description: *The grey areas are only used to represent the trade mark graphically. These grey areas represent transparent areas. The colour grey is not claimed as part of the trade mark.*

The trade mark contains a transparent element that forms part of the mark. The transparent elements need to be in a different colour in order to be noticeable.

The description clearly explains how the colour grey in the mark is to be understood and allows all the elements that form part of the trade mark to be identified.

9.1.2 Dotted lines

The legislation only mentions dotted lines as a visual disclaimer for one type of mark (position marks). However, this does not exclude the use of dotted lines for other types of mark or for other purposes provided that they do not undermine the capacity of the representation of the mark to enable the competent authorities and the public to determine the clear and precise subject matter of the protection afforded.

There are three possible functions of dotted lines in EUTM representations.

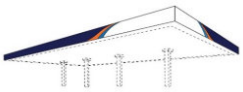
1. To represent stylistic/decorative elements. In this case, the dotted lines form part of the subject matter of the registration (for example, in a figurative mark).
2. To visually identify disclaimed elements. For example:
   a. disclaiming the goods on which a position mark is placed or affixed;
   b. disclaiming 3D ([6]) parts of a shape mark.
3. To visually disclaim elements that **per se** do not form part of the subject matter of the registration but do form part of the overall impression of the mark by illustrating the particular manner in which variable elements interact with predetermined elements (e.g. to indicate a 'placeholder' for letters or numbers that may vary).

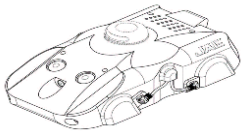
Where the type of mark has a description field, the **function that the dotted lines perform** can be clarified in the description.

Where there is no description field certain presumptions will be applied.

In particular, dotted lines in representation will be interpreted as follows by the Office.

6 As opposed to letters of figurative elements in the shape mark.

Type	Description	Role/treatment of dotted lines	Examples
Figurative	No	It is not possible to visually disclaim elements from a figurative mark by means of dotted lines and they will be treated as a **stylisation** of the mark and examined as such. If it is clear that the dotted lines have another function and the type of mark they suggest would not be accord with the representation, a formalities deficiency will be raised (e.g. the representation of the filling station).	 EUTM No 18 605 906  Figure 1: EUTM No 18 430 094

Shape	No	Visually disclaiming 3D parts of shape marks with dotted lines is in principle acceptable (sometimes these are technical/ functional parts). Even though applicants may seek protection for a shape mark by simply not including the disclaimed part in the representation, applicants may feel that this could lead to the trade mark being less effective, since the consumer might not recognise it as being part of the products they encounter (e.g. a shape mark for a USB stick that does not include the part that connects to the USB port would not be recognisable as a USB stick ([7])). Consequently, where the dotted lines are used in a manner that clearly distinguishes 3D parts of a shape mark, it is assumed that they function as visual disclaimers. However, verbal or numerical elements in dotted lines applied to/on the shape will be interpreted as being stylistic elements of the shape mark, and **not as visual disclaimers** (e.g. the letters JAE in the example).	 EUTM No 18 561 219

Other	Optional	Dotted lines can be used to visually disclaim elements that **per se** do not form part of the subject matter of the registration but that do form part of the overall impression by illustrating the particular manner in which the variable elements **interact with other predetermined elements** in the representation. The description should not make claims that go beyond the representation (e.g. phrases like 'any word' or 'all forms') because that would extend the scope of the representation.	 EUTM No 18 235 672

9.2 Description

Article 3(2), Article 3(3)(d) and (e), Article 3(3)(f)(ii), Article 3(3)(h) and Article 3(4) EUTMIR

The EUTMIR stipulates for which mark types a mark description may be submitted by the applicant and defines the content of the description. In this sense, descriptions are only allowed for position marks (Article 3(3)(d) EUTMIR), pattern marks (Article 3(3)(e) EUTMIR), colour combination marks (Article 3(3)(f)(ii) EUTMIR), motion marks (Article 3(3)(h) EUTMIR — although only where still images are used), and 'other' marks (Article 3(4) EUTMIR). The content of each description, where allowed, is further explained below under each of these mark types.

Where the mark description is not in line with the EUTMIR or does not accord with the representation, the Office will issue a deficiency asking the applicant to amend or delete it. Where there is a conflict or discrepancy between the representation and the

7 For an example showing the part of USB stick that goes into the PC, see Advocate General Mengozzi (14/09/2010,C-48/09 P, Lego brick, ECLI:EU:C:2010:41, § 73).

type and/or the description of the trade mark, the representation of the trade mark will always prevail and the description and/or type must be amended to accord with the representation.

Where goods and services are mentioned in the mark description field rather than in the field for goods and services, the Office will delete them from the mark description and, if the goods and services are not already covered in the specification, inform the applicant that it must add the goods and services.

This principle applies *mutatis mutandis* in all cases where necessary information on the mark is included in the wrong field of the application form.

After the mark has been filed, a mark description can be amended or added in order to submit more detailed information. However, such amendment must not alter the nature of the mark and must accord with the representation. Amendment of the description is not possible after registration (Article 54(1) EUTMR).

9.3 Mark type

Article 4, Article 7(1)(a), Articles 31 and 41 and Article 49(2) EUTMR Article 3(3) EUTMIR

The categorisation of marks serves a number of functions. Firstly, it establishes the legal requirements for each type of mark; secondly, it can help the Office and other economic operators to understand what the applicant is seeking to register; and finally, it facilitates searches in the Office database.

In the framework of the European Union Intellectual Property Network (EUIPN), the Office and a number of trade mark offices in the European Union have agreed on a Common Practice in relation to new types of marks: examination of formal requirements and grounds for refusal. They agreed on examples of acceptable representations of sound marks, motion marks, multimedia marks and hologram marks. Some examples are reproduced below, and further examples can be found in the Common Communication on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal (CP11).

The examples of mark types in these Guidelines are given only in the context of formalities' issues without prejudice to the outcome of the examination proceedings or to their scope of protection.

9.3.1 Word marks

A word mark is a typewritten mark with elements including letters (either lower or upper case), words (either in lower- or upper-case letters), numerals or standard typographic characters.

A word mark must be represented by submitting a reproduction of the sign in standard script and layout, without any graphic feature or colour. Standard layout is to be understood as written across a single line.

The Office accepts signs in the alphabet of any official EU language as a word mark. Any sign consisting of words from another alphabet will have to be filed as a figurative mark (see also paragraph 9.3.2 Figurative marks).

A mark consisting of text in non-standard layout, for instance written across more than one line, will not be categorised as a word mark, as these marks are considered to be figurative.

Examples of acceptable word marks (for formalities' purposes)	
EUTM No 6 892 351	europadruck24
EUTM No 6 892 806	TS 840
EUTM No 6 907 539	4 you
EUTM No 2 221 497	ESSENTIALFLOSS
EUTM No 631 457	DON'T DREAM IT, DRIVE IT
EUTM No 1 587 450	?WHAT IF!
EUTM No 8 355 521	ΕΙΔ ΕΛΛΗΝΙΚΟ ΙΝΣΤΙΤΟΥΤΟ ΔΙΑΤΡΟΦΗΣ (Greek)
EUTM No 8 296 832	Долината на тракийските царе (Cyrillic)

9.3.2 Figurative marks

A figurative mark is a mark consisting of:

- exclusively figurative elements;
- a combination of verbal and figurative or otherwise graphical elements;
- verbal elements in non-standard fonts;
- verbal elements in colour;
- verbal elements on more than one line;
- letters from non-EU alphabets;
- signs that cannot be reproduced by a keyboard;
- combinations of the above.

A figurative mark must be represented by submitting a reproduction of the sign, showing all its elements and, where applicable, its colour(s).

The representation may be submitted in one single JPEG file or on one single A4 sheet.

It is not possible to file a description or indication of colour for figurative marks. The representation of the trade mark alone defines the subject matter of the registration.

Examples of figurative marks (for formalities' purposes)	
EUTM No 1 414 366 Purely graphic element	
EUTM No 9 685 256 Purely graphic element	
EUTM No 4 705 414 Combination of graphic element and text in standard font	
EUTM No 9 687 336 Combination of stylised font and figurative elements	
EUTM No 4 731 725 Combination of stylised font and figurative elements	
EUTM No 9 696 543 Verbal element in stylised font	
EUTM No 2 992 105 Verbal elements in stylised font	

Examples of figurative marks (for formalities' purposes)	
EUTM No 9 679 358 Verbal elements in different fonts	FOOC FÜSSEN OUTLET CENTER
EUTM No 9 368 457 Verbal elements only, over more than one line	YVES ROCHER LIFTING BIO CULTURE BIO
EUTM No 9 355 918 Slogan in two different fonts, letters in different sizes, on more than one line	Heute handeln ist trendy
EUTM No 9 681 917 Mark represented in non-EU characters (Chinese characters)	火瀑

9.3.3 Shape marks

A shape mark is a mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or its appearance. The term 'extending to' means that shape marks cover not only shapes per se, but also shapes that contain other elements, such as word elements, figurative elements or labels.

The shape mark may be represented by either a graphic representation of the shape or a photographic reproduction. The meaning of a graphic representation is extended to comprise the use of new technology, thereby allowing the filing of computer-generated images or animated designs in file formats OBJ, STL and X3D, with a maximum size of 20 MB.

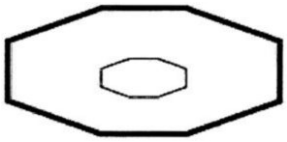
Where the EUTM application for a shape mark is intended to be used as the basis for an international application under the Madrid Protocol, the applicant should consider whether the contracting parties that it wishes to designate accept computer-generated images or animated designs. Consult the acceptable formats for representation of a mark before each Office.

Where the representation is not a computer-generated image, it may contain up to six perspectives of the same shape. The different views must be submitted in one single JPEG file or on one single A4 sheet. While different perspectives may be filed, a single view of the shape is sufficient where the shape to be protected can be ascertained from that single view.

Where an applicant files different perspectives of a three-dimensional object on more than one sheet of paper, a deficiency will be raised, setting a time limit for the applicant to indicate which one of the representations filed will be the representation of the EUTM application. Likewise, where a single JPEG file or a single A4 sheet consists of more than six perspectives of the same three-dimensional shape, a deficiency will be raised, setting a time limit for the applicant to remove the perspective(s) exceeding the maximum number allowed, provided that the amendment does not substantially change the mark as filed.

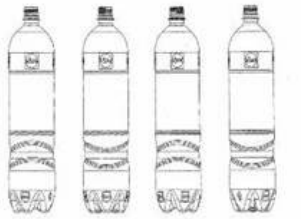
If no mark type is indicated and only one view has been submitted, from which it cannot be inferred that the sign consists of or extends to a 3D shape, the Office will treat the representation as a figurative trade mark.

Example



No mark type was selected for this sign. The Office will treat it as a figurative mark.

It is not possible to file a description or indication of colour for shape marks. The representation of the trade mark alone defines the subject matter of the registration.

Examples of acceptable representations of shape marks (for formalities purposes)	
EUTM No 4 883 096 Four different drawings of the same object	
EUTM No 4 787 693 Six photographs of the same object from different perspectives, with text	

Examples of acceptable representations of shape marks (for formalities purposes)	
EUTM No 30 957 Two photographs in colour showing different perspectives of the same object	
EUTM No 8 532 475 Six views in colour showing six different perspectives of the same object	
EUTM No 14 419 758 Combination of photographs and drawings showing the same object	
EUTM No 17 287 806 One view of the object	

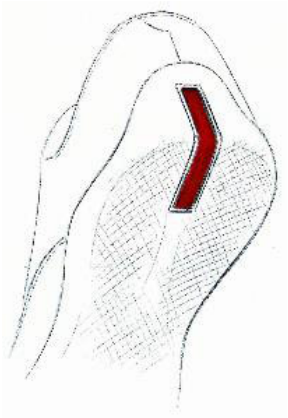
9.3.4 Position marks

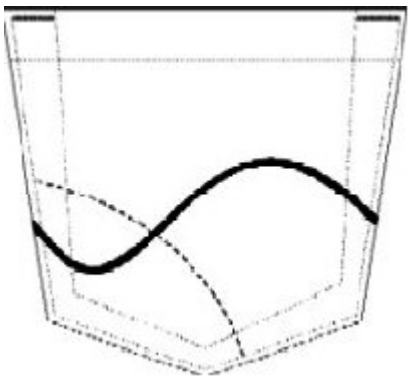
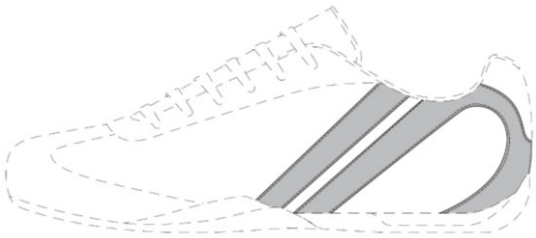
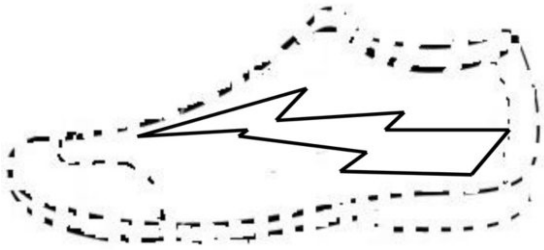
A position mark is a trade mark consisting of the specific way in which the trade mark is placed on or affixed to the product.

This type of mark must be represented by submitting a reproduction that identifies appropriately the position of the mark and its size or proportion with respect to the relevant goods. The representation may be submitted in one single JPEG file or on one single A4 sheet.

The representation should clearly define the position of the mark and its size or proportion with respect to the relevant goods. The elements that do not form part of the subject matter of the registration must be visually disclaimed, preferably by broken or dotted lines. A description that accords with the representation of the mark may be added to indicate how the sign is affixed to the goods. This cannot, however, serve as a substitute for a visual disclaimer. Colours, to the extent that they form an integral part of the description, may be indicated therein.

A description that infers that the position of the mark may vary with respect to the goods, for example 'The mark consists of [description of the device] applied to the outside of the goods', is not acceptable. In this case, the Office will notify a formality deficiency, requesting the applicant to amend or delete the description, as the position of the mark must be clearly defined with respect to the relevant goods.

Examples of acceptable mark description for position mark (for formalities' purposes)	
EUTM No 1 027 747 Mark type: Position mark Description: Red stripe placed longitudinally along an item of footwear partly covering the rear area of the sole and partly the rear area of the item of footwear. Any moulding seen on the sole or on the rear part of the item of footwear and/or production characteristics are not part of the trade mark.	

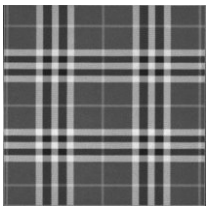
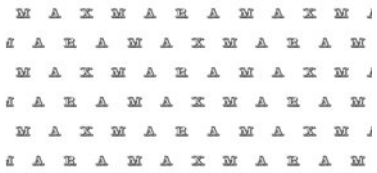
Examples of acceptable mark description for position mark (for formalities' purposes)	
EUTM No 6 900 898 Description: Two Curves Crossed in One Point Design inserted in a Pocket; the mark consists of a decorative stitching made of Two Curves Crossed in One Point Design inserted in a Pocket; one of the curves is characterised by an arched form, drawn with a fine stroke, while the second one is characterised by a sinusoidal form, drawn with a thick stroke; the unevenly broken lines represent the perimeter of the pocket to which the applicant makes no claim and which serves only to indicate the position of the mark on the pocket.	
EUTM No 8 586 489 Description: The trade mark is a position mark. The mark consists of two parallel lines positioned on the outside surface of the upper part of a shoe. The first line runs from the middle of the sole edge of a shoe and slopes backwards towards the instep of a shoe. The second line runs parallel with the first line and continues in a curve backwards along the counter of a shoe to the heel of a shoe and ends at the sole edge of a shoe. The dotted line marks the position of the trade mark and does not form part of the mark.	
EUTM No 17 473 621 Position mark without description	

9.3.5 Pattern marks

A pattern mark is a trade mark consisting exclusively of a set of elements that are repeated regularly.

This type of mark must be represented by submitting a reproduction showing the pattern of repetition in one single JPEG file or on one single A4 sheet.

The representation of the pattern mark may be accompanied by a description detailing how its elements are repeated regularly. Such description must accord with the representation and not extend its scope. Colours, to the extent that they form an integral part of the description, may be indicated therein.

Examples of acceptable pattern marks (for formalities' purposes)	
EUTM No 15 602	
EUTM No 7 190 929	
EUTM No 17 865 439	

9.3.6 Colour marks

Article 49(2) EUTMR

Article 3(3)(f) EUTMIR

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) and, in the case of more than one colour, the systematic arrangement of the colours in a predetermined and uniform way (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).

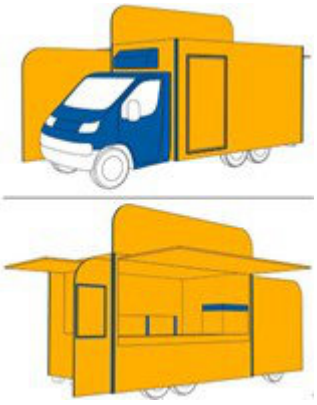
The representation of a colour mark must consist of a representation of the colour or colours without contours in one single JPEG file or on one single A4 sheet. Where there is more than one colour, the reproduction must show the systematic arrangement of the colour combination.

It is mandatory to file a reference to a generally recognised colour code, such as Pantone, Hex, RAL, RGB or CMYK. Where the colour code(s) clearly do(es) not correspond to the representation, the Office will issue a deficiency.

If the colour code has not been indicated in the application, the Office will notify the deficiency, allowing two months for the information to be submitted. If the colours are indicated in words instead of colour codes in the relevant field of the application form for the indication of colours, the Office will remove such colour indications and issue a deficiency letter asking the applicant to indicate the colour codes accordingly.

A description detailing the systematic arrangement of the colours is merely optional and references to colours in words in the mark description are accepted.

If the representation contains other elements, such as words, it is not a colour mark per se but a figurative mark. For information on correction of the mark type, see paragraph 9.3.12.

Examples of acceptable colour marks (for formalities' purposes)	
EUTM No 2 346 542 03/05/2017, T-36/16, GREEN STRIPES ON A PIN, EU:T:2017:295 Colour indication: RAL 9018; NCS S 5040G5OY + RAL 9018 1 : 4; NCS S 5040G5OY + RAL 9018 2 : 3; NCS S 5040G50Y + RAL 9018 3 : 2; NCS S 504050Y + RAL 9018 4 : 1: NCS S 5040G50Y. Description: none	
EUTM No 1 7917 895 Colour indication: RAL:5017; RAL:1028. Description: The colour mark comprises the colours traffic blue and melon yellow for the exterior of a sales vehicle, namely melon yellow for the long and frontal sides of the sales area, roof and side panels on one long side, folding shutters on one long side and the rear frontal side, and traffic blue for the driving cab, corner profiles, edges of the roof and side panels, rectangular frame on one long side and on one side panel, the hood on the frontal side and strips on the counter.	

Examples of acceptable colour marks (for formalities' purposes)	
EUTM No 17 972 757 No description provided (Colour indication: PANTONE 376, PANTONE Process Black C)	
EUTM No 17 407 586 Description: The trade mark consists of three horizontal bars (from top to bottom): blue ('Pantone 273C'), green ('Pantone 370C'), blue ('Pantone 273C'). The bars have the following height ratios: blue 17.62 %, green 27.1 %, blue 55.24 % (from top to bottom). Colour indication: PANTONE:273C; PANTONE:370C.	
EUTM No 19 087 423 Colour indication: PANTONE:7548; PANTONE:7758; PANTONE:390; PANTONE:368; PANTONE:3529.	

9.3.7 Sound marks

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 9.3.12).

A sound mark must be represented by submitting either an audio file reproducing the sound or an accurate representation of the sound in musical notation.

The audio file must be in MP3 format and its size cannot exceed two megabytes. Office requirements do not allow the sound to stream or loop. Attachments that do not comply with these criteria will be deemed not to have been filed.

An audio file may be submitted only in e-filings. The Office will not accept an electronic sound file separately from the application.

Where the EUTM application for a sound mark is intended to be used as the basis for an international application under the Madrid Protocol, the applicant should consider whether the contracting parties that it wishes to designate accept audio files. Consult the acceptable formats for representation of a mark before each designated Office.

Musical notations may be submitted in one single JPEG file or on one single A4 sheet. 'Accurate musical notation' means that the representation must include all the elements necessary to determine its clear and precise subject matter of protection. The tempo or speed of the melody and the instrument(s) are optional elements to be indicated.

If the applicant submits both an audio file and musical notations, it will be asked to choose which of the two it wishes to retain. If the applicant submits an audio file and a representation of a sonograph, the sonograph will be removed from the file by the Office.

It is not possible to file a description for sound marks. The representation of the trade mark alone defines the subject matter of the registration.

Some examples of acceptable sound marks are also provided by the Common Communication on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal (CP11).

Example of acceptable sound marks	
EUTM No 6 596 258 Musical notation including musical directions	
EUTM No 17 818 329	
EUTM No 17 700 361 Voice saying 'Barca'	Link
EUTM No 17 672 932 Six notes on a piano	Link
EUTM No 17 572 173 Two notes on a keyboard followed by a whizzing sound	Link
CP11 example 'Gerivan' sung	Link

Example of acceptable sound marks	
CP11 example Random melody	Link

9.3.8 Motion marks

A motion mark is defined as a trade mark **consisting of, or extending to**, a movement or a change in the position of the elements or of the colours of the mark. Trade marks combining movement with sounds do not qualify as motion marks and should be applied for as multimedia marks (see paragraph 9.3.12). The term '**extending to**' means that, in addition to the movement itself, the mark may also include words, figurative elements, labels, etc.

A motion mark must be represented by submitting either a video file or a series of still sequential images showing the movement or change of position. The video file must be in MP4 format and may not exceed 8 000 Kbps (kilobytes per second) and 20 MB.

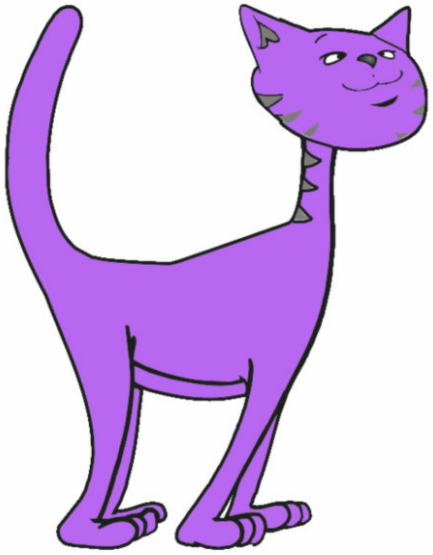
A video file may be submitted only when e-filing. The Office will not accept a video file separately from the application.

Where the EUTM application for a motion mark is intended to be used as the basis for an international application under the Madrid Protocol, the applicant should consider whether the contracting parties that it wishes to designate accept video files. Consult the acceptable formats for representation of a mark before each designated Office.

The number of images is practically unlimited as long as they all fit in one single JPEG file or on one single A4 sheet. The still images may be numbered and/or accompanied by a description explaining the sequence.

The representation of the motion mark may be accompanied by a description. Such description must accord with the representation and not extend its scope. Colours, to the extent that they form an integral part of the description, may be indicated therein, as may the duration, repetitions and the speed of the motion/movement.

Example of motion marks	
EUTM No 5 338 629 Description: the mark is an animated sequence with two flared segments that join in the upper-right portion of the mark. During the animation sequence, a geometric object moves up adjacent to the first segment and then down adjacent to the second segment, while individual chords within each segment turn from dark to light. Stippling shown in the mark is for shading only. The entire animated sequence lasts between 1 and 2 seconds.	
EUTM No 17 279 712 A round green shape rotating on a black background	 Link
EUTM No 17 894 400 The words 'WIN WIN' represented with changing letter sizes	 Link

Example of motion marks	
CP11 example 'Gerivan' bounce	GERIVAN Link
CP11 example Cat changing colour	 Link

9.3.9 Multimedia marks

A multimedia mark is defined as a trade mark **consisting of, or extending to**, the combination of image and sound. The term '**extending to**' means that the mark may also include words, figurative elements, labels, etc. in addition to the image and sound.

A multimedia mark can only be represented by submitting an audiovisual file containing both the image and the sound and can therefore only be filed via e-filing. The Office will not accept an audiovisual file separately from the application. The audiovisual file must be in MP4 format and may not exceed 8 000 Kbps (kilobytes per second) and 20 MB.

Where the EUTM application for a multimedia mark is intended to be used as the basis for an international application under the Madrid Protocol, the applicant should consider

whether the contracting parties that it wishes to designate accept audiovisual files. Consult the acceptable formats for representation of a mark before each designated office.

It is not possible to file a mark description or indication of colour for multimedia marks. The representation of the trade mark alone defines the subject matter of the registration.

The presence of a black or white screen in the file combined with a sound does not preclude the mark from being classified as a multimedia mark, and neither does the partial absence of sound combined with an image.

Example of multimedia marks	
EUTM No 17 635 293 Moving characters 'UOC' on a blue background accompanied by a musical tone, moving across to be completed with the words 'Universitat Oberta de Catalunya'.	 Link
EUTM No 17 411 315 A hat, the band of which is stuffed with bank notes, moving slowly backwards to reveal a blue and white ball, all accompanied by a drum roll.	 Link
CP11 example 'Gerivan' sung, with word appearing.	 Link

9.3.10 Hologram marks

A hologram mark is defined as a trade mark consisting of elements with holographic characteristics. Therefore, a hologram is an image that changes its appearance when looked at from different angles.

1. A hologram can be a physical flat structure that uses light diffraction to create visual images. Its flat surface, under proper illumination, appears to contain a three-dimensional image or other visual effects. In this case, a three-dimensional effect is actually a two-dimensional visual effect that is perceived by human brains as three-dimensional.
2. A hologram can be a digital projection or visualisation of an object displayed via light field displays. Through them, three-dimensional objects and object compositions can be visualised and seen as such. These lifelike images can be seen but not touched.

A hologram mark must be represented by submitting either a video file or a graphic or photographic reproduction containing the views necessary for sufficiently identifying the holographic effect in its entirety.

The video file must be in MP4 format and may not exceed 8 000 Kbps (kilobytes per second) and 20 MB. A video file may be submitted only via e-filing. The Office will not accept a video file separately from the application.

The number of views is unlimited as long as they all fit in one single JPEG file or on one single A4 sheet.

Where the EUTM application for a hologram mark is intended to be used as the basis for an international application under the Madrid Protocol, the applicant should consider whether the contracting parties that it wishes to designate accept video files. Consult the acceptable formats for representation of a mark before each designated Office.

It is not possible to file a description or indication of colour for hologram marks, as the representation of the trade mark alone defines the subject matter of the registration.

Example of hologram marks

CP11 example 'Gerivan' rotating	 Link

9.3.11 Other marks

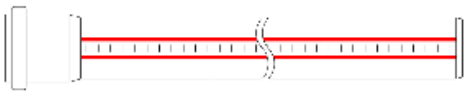
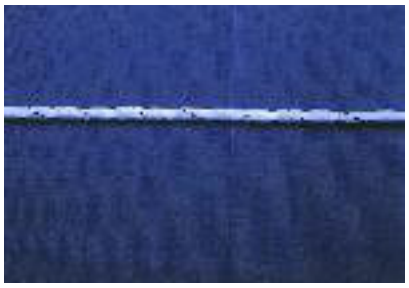
'Other' marks are marks that are not covered by Article 3(3) EUTMIR. 'Other' marks must comply with the requirements for representation as stipulated in Article 3(1) EUTMIR and may be accompanied by a mark description, for example to specify what is meant by 'other'.

The mark description must accord with the representation and confirm that the mark type cannot be identified under the mark types mentioned above. If the description does not coincide with the representation, the Office will request that the applicant amend or delete it. Colours, to the extent that they form an integral part of the description, may be indicated therein.

Some examples of 'other' marks are discussed below.

9.3.11.1 Tracer marks

Tracer marks are coloured lines or threads applied to certain products, and are popular in the textile industry. Other examples are coloured lines on hoses or cables. The mark description could indicate that the mark is a 'tracer mark'.

Examples of acceptable tracer marks and descriptions (for formalities' purposes)	
EUTM No 7 332 315 Description: The trade mark consists of a pipe, tube or extruded profile with continuous thin black horizontal lines set at an equal distance apart on the exterior of the pipe, tube or extruded profile, between two parallel red lines running along the length of the pipe, tube or extruded profile.	
EUTM No 3 001 203 Description: Golden band incorporated into a light-coloured functional band, in particular a lead band, for curtains, drapes, table covers and similar goods as an identifying marking.	

9.3.11.2 Smell/olfactory and taste marks

Smell/olfactory or taste marks are currently not acceptable. This is because the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (Article 3(1) EUTMIR), and the current state of technology does not allow these types of marks to be represented in such way. Furthermore, the EUTMIR does not recognise the submission of samples or specimens as suitable representation. A mark description cannot replace the representation, because a description of a smell or taste is neither clear, precise nor objective (12/12/2002, C-273/00, Sieckmann, EU:C:2002:748, § 69-73; 04/08/2003, R 120/2001-2, THE TASTE OF ARTIFICIAL STRAWBERRY FLAVOUR (gust.)). Therefore, any application for an olfactory or taste mark will not be treated as an application for an EUTM ('deemed not filed') by the Office since it would not comply with the requirements for obtaining a filing date.

9.3.11.3 Tactile marks

Tactile marks are currently not acceptable. These are marks where protection is sought for the tactile effect of a certain material or texture, for instance indications in braille alphabet or the specific surface of an object. However, taking into account the requirement under Article 4 EUTMR that the trade mark must be represented on the register in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor, it is not possible with currently available technology to deduce the 'tactile feeling' claimed with certainty from the existing formats of representation (27/05/2015, R 2588/2014-2,

EMBOSSED PATTERN ON A SMOOTH BOTTLE SURFACE (al.)). Furthermore, the EUTMIR does not recognise the submission of samples or specimens as suitable representation. Therefore, any application for a tactile mark will not be treated as an application for an EUTM ('deemed not filed') by the Office since it would not comply with the requirements for obtaining a filing date.

9.3.12 Correction of mark type

9.3.12.1 General rules

If the mark type indicated in the application contradicts the representation submitted, or if no mark type is given, **and it is obvious** from the representation which mark type contained in Article 3 EUTMIR the applicant intended to apply for, the Office will correct the mark type and inform the applicant, giving them a 2-month time limit for observations. If there is no response, the correction made by the Office is considered accepted by the applicant. If the applicant disagrees with the amendment, the Office will restore the original mark type indicated; however, the application may then be rejected if the subject matter for which protection as a trade mark is sought is not clear and precise.

Likewise, if the mark type indicated contradicts the representation submitted, or if no mark type is given, and **it is not obvious** which mark type the applicant intended to apply for, a deficiency will be issued and a time limit of 2 months set to remedy the deficiency. If the deficiency is not remedied, the EUTM application will be refused.

The Office cannot accept any request for the mark type of a mark with a filing date before 01/10/2017 to be changed to one of the new mark types defined as of that date in the EUTMIR (Article 39(2)(a) EUTMIR).

9.3.12.2 Examples of recurring mark type deficiencies

9.3.12.2.1 Word marks

Where the mark type chosen is 'word', but the mark is actually a 'figurative' mark, such as in the examples in paragraph 9.2 (representation on several lines, stylised font, etc.), the Office will correct the mark type and update the figurative image in the system. The Office will send a letter to the applicant, informing them of the amendment and setting a 2-month time limit for observations. If the applicant does not reply within the time limit, the amendment will be deemed to have been accepted. If the applicant files observations objecting to the amendment, and the Office disagrees with the observations, the mark type will be changed back to 'word' mark, but the application will be rejected.

9.3.12.2.2 Figurative marks

If no mark type has been indicated at all and the mark is clearly figurative in accordance with the examples given above, the mark type is inserted by the Office and the applicant is informed accordingly.

Sometimes ‘figurative’ marks in colour are erroneously filed as ‘colour marks’. Furthermore, the differences in typology of the miscellaneous marks within the EU Member States may lead to a mark type deficiency, in particular with regard to marks combining a word and a figurative element. In such cases, the Office will correct the mark type to ‘figurative’ and inform the applicant, setting a 2-month time limit for observations.

Example 1

A **figurative** mark applied for as a **colour** mark.

The Office will change the mark type from **colour** to **figurative** and send a letter confirming the amendment. If the applicant disagrees, they may submit observations. If the Office disagrees with the observations, it will restore the original indication of mark type, but the application will then be rejected. If, however, there is no response within the time limit, the change of mark type will be considered as accepted and the application will proceed.

Example 2

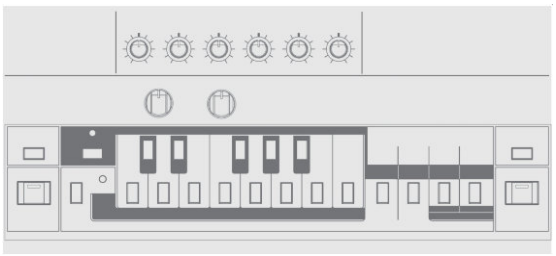
The following marks were applied for as mark type ‘other’.

EUTM No 9 328 121	
EUTM No 9 323 346	

When the applicant has chosen the mark type ‘other’, instead of ticking ‘figurative’, and has added, in the explanatory field of the ‘other mark’, terms like ‘text and logo’, ‘marque semi-figurative’, ‘marca mixta’, ‘Wort-Bild-Marke’, or even ‘colour’ (because its mark contains elements in colour), but the mark applied for is clearly a figurative trade mark as defined above, the Office will change the mark type from **other** to **figurative** and send a letter to the applicant, informing them of the amendment and giving 2 months for observations to be filed. If the applicant does not reply within the 2-month time limit, the change of mark type will be deemed to have been accepted and the application will proceed. If the applicant files observations objecting to the amendment, and the Office disagrees with the observations, the Office will restore the original indication of mark type, but the application will then be rejected.

Example 3

The applicant chose the mark type ‘shape’ when applying for the following mark.

EUTM No 18 016 159	

According to Article 3(3)(c) EUTMIR, a shape mark is a mark consisting of a three-dimensional shape, including containers, packaging, the product itself or their appearance. In the absence of any three-dimensional effect, the Office categorised the mark as figurative and informed the applicant thereof.

9.3.12.2.3 Pattern marks

Filed as a figurative mark	**Representation of sign**
EUTM No 17 418 121 The applicant accepted the Office's proposal to change the mark type to 'pattern mark'.	

10 Series marks

Unlike some national systems, the EUTMR does not allow for series/serial marks. When an applicant wants protection for the different versions of a trade mark, a separate EUTM application must be filed for each version.

For more information on applications filed with more than one mark representation in one JPEG or on one A4 sheet, such as series / serial marks, and filing date requirements, see paragraph 4.14, Representation of the mark.

11 Priority

Articles 34, 36 and 41 EUTMR

Article 4 EUTMIR

Decision EX-17-3 of the Executive Director of the Office of 18/09/2017 concerning the formal requirements of a priority claim for a European Union trade mark or a seniority claim for a European Union trade mark or a designation of the European Union under the Madrid Protocol.

The effect of the right of priority is that the date of priority will count as the date of filing of the European Union trade mark application for the purposes of establishing which rights take precedence in *inter partes* proceedings.

The principles of priority were first laid down in the Paris Convention for the Protection of Industrial Property of 20/03/1883, which has been revised several times and was last amended in 1979. Article 4 of this Convention — with regard to trade marks — corresponds to Article 34 EUTMR.

A priority claim of a previous EUTM is acceptable if that EUTM was granted a filing date. A priority claim of an international registration is not acceptable. This is because the principle of first filing applies (Article 34(4) EUTMR — see paragraph 11.2.1), and the priority claim can only be based on the relevant basic mark.

The applicant may claim the priority of one or more previous trade mark applications, namely a national (or Benelux) application filed in or for a state party to the Paris Convention, a Member of the WTO, or a state for which the Commission has confirmed reciprocity, or an EUTM application. See paragraph 11.2.1, 'Principle of first filing', for information on applications that claim the priority of more than one earlier application.

Any filing that is equivalent to a regular national filing under the domestic law applicable to it will be recognised as giving rise to the right of priority.

It is possible to claim both priority and seniority based on the same prior application/ registration, provided that the requirements are met.

11.1 Formal requirements

Article 35 EUTMR lays down the formal requirements for priority claims. At the examination stage, the Office will only examine whether all **formal requirements** are met.

The formal requirements are:

- priority claim filed together with the EUTM application;
- number, date and country of the previous application;

- availability of official online sources to verify the priority data, or submission of priority documents and translations, where applicable.

11.1.1 Claiming priority

Priority may be claimed together with the EUTM application or in a separate communication filed on the same date as the EUTM application.

The file number, together with the date and country, of the previous application must be indicated when claiming priority.

The claim may be implicit, such that the submission of the priority documents with the application or in a separate communication filed on the same date as the EUTM application will be construed as a declaration of priority. Simple filing receipts containing the **country, number** and **date** of the earlier application(s) are accepted.

It must be taken into account that the Office will publish the priority claim 'as filed', meaning that the Office will not confirm the validity of the priority claim.

11.1.2 Priority documents

The documentation in support of the priority claim must be filed within 3 months of the filing date. However, following Decision EX-17-3 of the Executive Director of the Office, if the priority documents are not submitted with the application or are not complete, the Office will check whether the relevant information, namely the number, filing date and country, the name of the applicant or proprietor, the representation of the mark and the list of goods and services of the earlier trade mark application in respect of which priority is claimed, is available on the website of the central industrial property office of the country of first filing.

Only in the case that the information of the priority claim cannot be found on such website, the Office will send a letter to the applicant, requesting that the priority documents, that is to say, a copy of the previous application, be submitted. The applicant will be given a time limit of 2 months to remedy the deficiency; as a rule, this time limit will not be extended. Usually, the deficiency letter will be issued before expiry of the original time limit for submitting the priority documents (3 months from the filing date of the EUTM application). In this case, the 2-month deficiency time limit will be calculated from the date of expiry of the original time limit for the submission of the priority documents.

Certified copies are not necessary. However, simple filing receipts that do not contain all the necessary information for examining the priority claim (e.g. containing only class numbers for the goods and services of the prior application and not the full text version indicating all the goods and services) are not acceptable.

If the mark concerned is in colour, colour photocopies must be submitted for the earlier application(s).

11.1.3 Language of previous application

If the priority information available on an office website or the priority documents submitted are not in one of the languages of the European Union, the Office will invite the applicant to file a translation into the first or second language of the EUTM application. The translation should cover all the relevant information mentioned under paragraph 11.1 and 11.2.

11.1.4 Formal priority requirements not satisfied

If the priority claim is filed after the date of application of the EUTM and/or the priority claim or the priority documents fail to satisfy any of the other formal requirements, the applicant will be invited to remedy the deficiency or make observations within the time limit set by the Office.

If there is no response, or if the deficiencies are not remedied within the time limit set, the Office will notify the loss of rights to the applicant and set a 2-month time limit during which the applicant may request a formal, appealable decision on the loss of rights.

If the applicant formally requests a decision within the time limit, the Office will issue a formal decision on the loss of rights.

11.2 Substantive requirements for priority claims

The requirements that refer to the substance of the priority claims are covered by Article 34 EUTMR and relate to the 6-month period, the condition of a first regular filing and triple identity (same owner, same mark and same goods and services).

The substantive requirements under Article 34 EUTMR will not be examined at the filing stage but during *inter partes* proceedings, where necessary, and will be restricted to the extent of the *inter partes* proceedings.

The substantive requirements of the priority claim will be examined when the outcome of the opposition or cancellation case depends on whether priority was validly claimed, which is in the following situations.

- In order to assess whether the trade mark on which the opposition (or invalidity request) is based is an ‘earlier mark’ or ‘earlier right’ within the meaning of Article 8(2) to (4) and (6) EUTMR. Determining the validity of the priority claim of the contested EUTM or earlier mark will be necessary when the relevant date of the earlier mark (its filing date or priority date) falls between the date of the claimed priority and the date of the filing of the contested EUTM. This will be assessed when the admissibility of the action based on that earlier right is determined.
- In order to assess the admissibility of the request for proof of use (whether the earlier mark is subject to use or not). The assessment of the priority claim of the contested EUTM is necessary for determining the admissibility of the request for proof of use in *inter partes* proceedings when the 5 years from registration of the

earlier right falls between the priority date of the contested mark and its filing date. Such examination does not preclude the re-assessment of substantive requirements in respect of the priority claim at the decision-taking stage if this is relevant for the outcome of the case.

- In order to determine the period of use. It will always be necessary to examine priority in order to calculate the 5-year period to which proof of use must relate.

11.2.1 Principle of first filing

The 'convention priority' right is a time-limited right triggered by the first regular national filing of a trade mark. A regular national filing is any filing that is 'adequate to establish the date on which the application was filed in the country concerned, whatever the subsequent fate of the application' (Article 4A(3) Paris Convention). It may be claimed during the 6 months following the first filing, provided the country of first filing was a party to the Paris Convention (PC) or to the Agreement establishing the World Trade Organisation (WTO), or a country with a reciprocity agreement (see Article 34(5) to (7) EUTMR — publication on reciprocity by the Commission).

The states and other entities listed below, inter alia, are not members of any of the relevant conventions. Nor do they benefit from reciprocity agreements. Therefore, priority claims based on filings in these countries will be **rejected**.

Independent states (not party to the PC, WTO or a reciprocity agreement):

- Aruba (AW)
- Cook Islands (CK)
- Eritrea (ER)
- Marshall Islands (MH)
- Micronesia (FM)
- Nauru (NR)
- Palau (PW)
- Somalia (SO)
- Tuvalu (TV).

Other entities (not party to the PC, WTO or a reciprocity agreement):

- Abkhazia (GE-AB)
- American Samoa (AS)
- Anguilla (AI)
- Bermuda (BM)
- Cayman Islands (KY)
- Falkland Islands (FK)
- Isle of Man (IM)
- Jersey (JE)
- Montserrat (MS)
- Pitcairn Islands (PN)
- Saint Helena (SH)
- Turks and Caicos Islands (TC)
- British Virgin Islands (VG).

The previous application must be a first regular filing and cannot have the same date as the EUTM application. The Office will therefore check (i) that there was no priority claim made on the prior application(s) and (ii) that no seniority claim for the EUTM application relates to a mark that has a filing date prior to that of the application(s) from which priority is claimed.

The Office will also check that the EUTM application was filed no later than 6 months after the filing date of the earlier application(s).

Where priority of more than one earlier application is claimed, the goods and/or services covered by each of those applications must be different in order to comply with the principle of first filing. For examples, please see paragraph 11.3.1.

11.2.2 Triple identity

The Office will check that the EUTM application and the priority documents contain the same mark, refer to the same applicant and have all relevant goods or services in common.

11.2.2.1 Identity of the marks

The Office and a number of trade mark offices of the European Union have agreed on a common practice under the European Trade Mark and Design Network concerning the identity of trade marks filed in black and white and/or greyscale as compared with those filed in colour (Common Communication on the Common Practice on Scope of Protection of Black and White ('B&W') Marks (CP4)). The offices consider that the Common Practice Note issued is a reflection of the current case-law that a trade mark filed in black and white and/or greyscale is, for the purposes of assessing priority, not identical to the same mark filed in colour unless the differences in colour or shades of grey are so insignificant that they could go unnoticed by the average consumer (19/01/2012, T-103/11, Justing, EU:T:2012:19, § 24; 20/02/2013, T-378/11, Medinet, EU:T:2013:83; 09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199). **An insignificant difference between two marks is one that a reasonably observant consumer will perceive only upon examining the marks side by side**.

The principle described above applies to all cases where marks are compared for the purpose of priority claims. In relation to word marks, the mark applied for will in most cases be deemed to be the same as the earlier mark where there is a difference only in respect of typeface or where one mark is in upper case letters and the other in lower case. Furthermore, a difference in punctuation or the addition of a space separating two words will not usually prevent the marks from having identity (09/10/2012, R 797/2012-2, WATER JEL, 15/07/1998, R 10/1998-2, THINKPAD).

The Office will also check the mark type of the earlier application, because a different mark type may mean that the EUTM application is different from the earlier mark. For example, a figurative mark is not the same as a shape mark or a position mark. However, a word mark can be considered to be the same as a figurative mark if standard type is used in the figurative mark (see the examples in paragraph 11.3.2).

The Office and a number of trade mark offices of the European Union, in the framework of the European Union Intellectual Property Network, have agreed on a Common Practice (CP11) in relation to the examination of formal requirements and grounds for refusal of new types of marks (sound, motion, multimedia and hologram marks).

Following CP11, two trade marks will be considered as identical for the purpose of examination of priority claims if the subject matter of protection and the trade mark are the same, regardless of the format of the representation, for example, a sound mark first filed in musical notations and the second filing in electronic format. Additionally, priority may be accepted when the second filing is a different type of trade mark but has identical subject matter. Concrete examples of examining priority claims of new types of marks can be found in the Common Communication on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal (CP11).

Regarding the kinds of marks (individual, collective and certification) that can be indicated in an application and taking into account the disparities of national legislations, the Office will disregard a priority claim between different kinds of mark **only** where there is an incompatibility between the kinds of mark. Whereas compatibility might exist between collective and certification marks, compatibility is excluded between individual marks and collective/certification marks.

11.2.2.2 Identity of the goods and services

The Office will check that all goods or services of the EUTM application that are relevant in *inter partes* proceedings are covered by the goods and services of the first filing.

11.2.2.3 Identity of the owner

Priority can be claimed by the applicant of the first application or its successor in title. In the latter case, the transfer must have taken place prior to the filing date of the EUTM application, and documentation to this effect must be submitted. The right of priority as such may be transferred independently of whether or not the first application as a whole is transferred. Priority can therefore be accepted even if the owners of the EUTM application and the earlier right are different, provided that evidence of the assignment of the priority right is produced; in this case, the execution date of the assignment must be prior to the filing date of the EUTM application.

Subsidiary or associated companies of the applicant are not considered to be the same as the EUTM applicant.

Where the applicant of the first application states that it has changed its name since the first filing, and files the EUTM application under its new name, the applicant is considered to be the same person.

For the distinction between a change of name and a transfer, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and EUDs as Objects of Property, Chapter 1, Transfer.

11.2.3 Substantive priority requirements not satisfied

If the priority claim does not satisfy any of the above substantive requirements, the applicant will be invited to make observations within the time limit set by the Office.

If the priority right could not be proved or appeared to be unacceptable, the priority right would be refused. The outcome of the full examination would be reflected in the final decision on the opposition or cancellation proceedings.

11.3 Examples of priority claims

11.3.1 First filing

In the example below, the priority claim of more than one earlier application is acceptable because the goods covered by each of those earlier applications are different and therefore the principle of first filing is met.

First filing	Country	Goods/services	EUTM filed	Goods/services
6 April	**Italy**	*Perfumes*	11 September	*Perfumes, bags, clothing*
9 May	**Germany**	*Bags*		
23 May	**Spain**	*Clothing*		

In the example below, the two earlier trade mark applications were filed for exactly the same goods. The priority claim based on the Greek application has to be rejected since the trade mark was applied for in Spain first; thus the Greek application is no longer a first filing.

First filing	Country	Goods/services	EUTM filed	Goods/services
6 April	Spain	*Cheese, wine*	4 October	*Cheese, wine*
7 April	Greece	*Cheese, wine*		

In the example below, priority cannot be claimed from a first filing in Somalia, since Somalia is not a party to the Paris Convention or the World Trade Organisation and has no reciprocity agreement confirmed by the EU Commission. Therefore, the first filing in Italy is the one considered for the priority claim; the other filing cannot be taken into consideration.

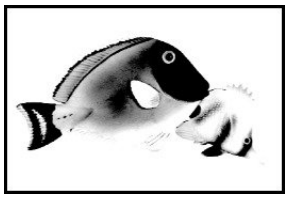
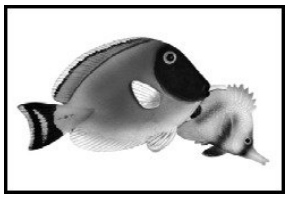
First filing	Country	Goods/services	EUTM filed	Goods/services
5 April	Somalia	*Cars, T-shirts*	2 October	*Cars, T-shirts*
7 July	Italy	*Cars, T-shirts*		

11.3.2 Comparison of the marks

The examples below cover acceptable and unacceptable priority claims for formalities' purposes where the identity of the marks is assessed. As explained under paragraph 11.2.2.1, only 'insignificant differences' between the EUTM application and the mark invoked under the priority claim will be accepted, that is to say, differences that are not considered to alter the meaning, pronunciation and visual impact of the marks.

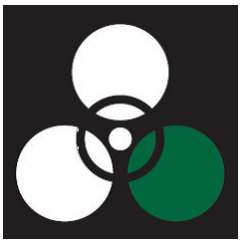
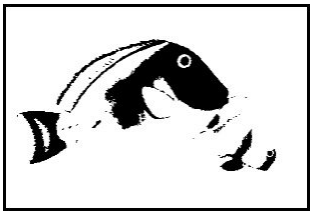
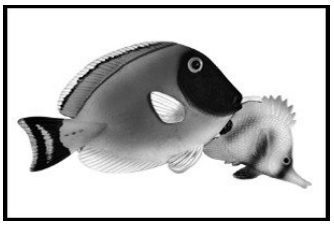
The Common Communication on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal (CP11) provides further examples of priorities of sound, motion, multimedia and hologram marks.

Examples of signs considered identical	
EUTM application (word mark) EVAL	Priority claim (word mark) **EVAL**
EUTM application (word mark) Luna	Priority claim (word mark) *Luna*
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 

Examples of signs considered identical	
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 

Examples of non-identical signs	
EUTM application (colour mark) ■	Priority claim (colour mark) ■
EUTM application (word mark) Chocolate Dream	Priority claim (word mark) Chocalate Dream

Examples of non-identical signs	
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 

Examples of non-identical signs	
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 
EUTM application (figurative mark) 	Priority claim (figurative mark) 

Further examples for word marks			
First trade mark	**EUTM application**	**considered identical**	**considered not identical**
Word mark Percy & Reed	Word mark Percy + Reed		**X**
Word mark Percy & Reed	Word mark Percy and Reed		**X**
Word mark Percy & Reed	Word mark **Percy & Reed**	**X**	
Word mark Percy & Reed	Word mark Percy & REED	**X**	

Further examples for word marks			
Word mark Percy & Reed	Word mark PERCY & REED	**X**	
Word mark Percy & Reed	Word mark *Percy & Reed*	**X**	
Word mark POPEYE	Word mark POPeye	**X**	
Word mark POPEYE	Word mark PopEye	**X**	
Word mark POPEYE	Word mark POP-EYE	**X**	
Word mark POPEYE	Word mark POP EYE	**X**	
Word mark POPEYE®	Word mark POPEYE	**X***	
Word mark POPEYE	Word mark POPEYE!?		**X**
Word mark POPEYE	Word mark POPEYES		**X**
Word mark **POPEYE**	Word mark **POPEYE·**	**X**	
Word mark JOSÉ RAMÓN	Word mark JOSE RAMON	**X**	
Word mark SKAL	Word mark SKÅL		**X**
*The symbols ™ and ® are not considered parts of the mark.			

Examples for identity between figurative signs as compared to word marks			
First trade mark	**EUTM application**	**considered identical**	**considered not identical**
Word mark Percy & Reed	Figurative mark Percy & Reed (figurative mark in standard type face)	**X**	
Word mark Percy & Reed	Figurative mark Percy & Reed (words distributed over several lines)		**X**
Word mark Percy & Reed	Figurative mark Percy **&** Reed (colour claim)		**X**

Further examples for figurative marks			
First trade mark	**EUTM application**	considered identical	considered not identical
			**X**
			**X**
 ®		**X***	

Further examples for figurative marks
*The symbols ™ and ® are not considered parts of the mark.

For examples of identical and non-identical signs when claiming seniority that would also be considered identical or non-identical signs regarding priority claims, see paragraph 13.3.

11.3.3 Comparison of the goods and services

The first example below is the most usual situation: the prior application corresponds fully to the EUTM application.

First filing	Country	Goods and services	EUTM filed	EUTM goods and services
5 April	UK	*Hats, shoes*	1 October	*Hats, shoes*

In the next example, both priority claims can be accepted since application number XY 1234 is the first filing with respect to *cars* and application number XY 1235 is the first filing with regard to *airplanes*.

First filing	Country	JP application No	Goods and services	EUTM filed	EUTM goods and services
5 April	Japan	XY 1234	*Cars*	2 October	*Cars, airplanes*
5 April	Japan	XY 1235	*Airplanes*		

In the next example, the priority claim concerns *hats* and *shoes*, which are common to the first filing and the EUTM application. No priority will apply with respect to *bags*.

First filing	Country	Goods and services	EUTM filed	EUTM goods and services
5 April	USA	*Cars,* ***hats, shoes***	1 October	***Hats, shoes****, bags*

In the last example, priority is claimed for first filings in France, Canada and China. The EUTM application has been filed within 6 months of each of the first filings and the priority claims will be accepted, although the Canadian application does not constitute a first filing for *hats* (as *hats* appear in the French application, which was filed before the Canadian one). Comparing the dates and the lists of goods and services of the three priorities, the priority claims will be accepted.

First filing	Country	Goods and services	EUTM filed	EUTM goods and services
5 April	France	***Hats***, *shoes*	5 October	*Hats, shoes, cars, beer, wine, telecommunication services*
6 April	Canada	*Cars,* ***hats****, beer*		
7 April	China	*Wine, telecommunication services*		

11.3.4 Priority claims based on series marks

A series of trade marks refers to a number of trade marks that resemble each other in material details and differ only in terms of non-distinctive character. Whereas the EUTMR does not allow for the filing of series marks, some national offices (e.g. the United Kingdom, Australia) do, and such a series of marks filed in one single application can contain numerous very similar marks. When the first filing consists of a series mark, two or more slightly different mark representations will be seen. The priority claim is acceptable with regard to the one reproduction that is identical to that of the mark applied for as an EUTM.

Examples of priority claims based on series marks		
First filing	**EUTM**	**Priority claim acceptable**
Series of marks Pulse Cafe Pulse Cafe	Pulse Cafe	Yes
Series of marks Café@Home CAFÉ@HOME Café@Home *CAFÉ@HOME*	CAFÉ@HOME	Yes

11.3.5 Claiming priority for marks represented in a different format

Issues may arise from the different formal requirements relating to the representation of marks at the various intellectual property offices around the world when claiming priority for, or on the basis of, an EUTM application.

The Common Communication on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal (CP11) provides examples concerning sound, motion, multimedia and hologram marks. For more details, see also paragraph 11.2.2.1 Identity of the marks.

11.3.5.1 Claiming the priority of an earlier national filing for an EUTM application

It may happen that an applicant wishing to claim the priority of a previous national filing represented graphically (e.g. by musical notes) files an EUTM application representing the mark in an electronic format (e.g. mp3 for a sound mark). In principle, the different method of representation is not an obstacle for accepting the priority claim so long as the earlier filing represents the same trade mark, albeit in a different format, and provided that the format used to represent the earlier filing is recognised by the Office. In the case of any discrepancy between the subject matter of the representations, the priority will be refused for that reason, not because of the different formats.

Furthermore, some national IP offices do not allow more than four representations to be filed for shape or other marks. If an EUTM application claims the priority of such a first filing, and six (or more, in the case of 'other' marks) depictions/perspectives of the mark are filed with the EUTM application, the marks in question will still be considered identical if the representations of the first filing coincide with part of what was sent for the EUTM application and if the object is undoubtedly the same.

11.3.5.2 Claiming the priority of an earlier EUTM filing for a national application

As regards priority claims on the basis of an EUTM application, applicants should be aware of the possible non-acceptance by a particular national office of the format of representation used for filing with the Office. The Office cannot certify the concordance of the EUTM filing with that of a later national filing represented in a different format.

As regards colour indications, some countries require an indication of colour in writing for claiming priority. For this purpose, applicants may list colours in an optional field of the application form. That indication will not be part of the EUTM application, will not be examined and will not be published or reflected in the Register. Nevertheless, it will be part of the dossier for the purposes of file inspections and the applicant may thus obtain certification of such colour indications as filed.

12 Exhibition Priority

Article 38 EUTMR Article 5 and Article 7(g) EUTMIR

Exhibition priority entails claiming as a priority date for the EUTM application the date on which the goods or services covered by the EUTM application were displayed at an officially recognised exhibition under the mark as filed. The applicant can claim

exhibition priority within 6 months of the first display. Evidence of the display must be filed.

Like 'convention priority', exhibition priority can be claimed either in the application or subsequent to the filing of the EUTM application but still on the same day. The claim must include the name of the exhibition and the date of first display of the goods or services.

Within 3 months of the date of submitting the declaration of priority, the applicant must submit to the Office a certificate issued at the exhibition by the responsible authority. This certificate must state that the mark was in fact used for the goods or services, and indicate the opening date of the exhibition and, where the first public use did not coincide with the opening date of the exhibition, the date of first public use. The certificate must be accompanied by an identification of the actual use of the mark, duly certified by the authority.

Priority can only be granted where the application for an EUTM is filed within 6 months of the first display at an exhibition recognised for this purpose, namely a world exhibition within the meaning of the Convention Relating to International Exhibitions of 22/11/1928. These exhibitions are very rare and Article 33 EUTMR does not protect display at other, national, exhibitions. The exhibitions can be found on the website of the Paris *Bureau International des Expositions*: http://www.bie-paris.org/site/en/.

As is the case for convention priority, the substantive requirements for exhibition priority will not be examined at the filing stage but during *inter partes* proceedings, where necessary, and will be restricted to the extent of the *inter partes* proceedings (to that effect, see paragraph 11.2).

The claim may be implicit. Where there is no indication of the claim in the application, the submission of the exhibition priority documents on the same date as the filing date of the EUTM application will be construed as a declaration of priority.

13 Seniority

Article 39 EUTMR

Article 6 and Article 7(h) EUTMIR

Decision EX-17-3 of the Executive Director of the Office of 18/09/2017 concerning the formal requirements of a priority claim for a European Union trade mark or a seniority claim for a European Union trade mark or a designation of the European Union under the Madrid Protocol

The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, that applies for an identical trade mark for registration as an EUTM in respect of goods or services that are identical to or contained within those for which the earlier trade mark has been registered, may

claim for the EUTM application the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

Seniority has the sole effect that, where the proprietor of an EUTM surrenders the earlier trade mark for which seniority has been claimed or allows it to lapse, the proprietor will be deemed to continue to have the same rights as it would have had if the earlier trade mark had continued to be registered.

This means that the EUTM application represents a consolidation of earlier national registrations. If an applicant claims seniority for one or more earlier registered national marks and the seniority claim is accepted, the applicant may decide not to renew the earlier national registration(s) but still be in the same position as if the earlier trade mark(s) had continued to be registered in those Member States.

Seniority under Article 39 EUTMR must be claimed with the application or within 2 months of the filing date of the EUTM application. The documents in support of the claim must be submitted within 3 months of the claim. The seniority claim may be implicit. If the applicant sends only the documents concerning the earlier registrations within 2 months of the filing date of the EUTM application, the Office will construe this as a seniority claim concerning these earlier registrations.

Seniority may be claimed not only for earlier national registrations, but also for an international registration with effect in an EU country. No seniority claim is possible, however, for an earlier EUTM registration or local registrations, even if the territory is part of the European Union (e.g. Gibraltar).

The examination of seniority claims is limited to the formal requirements and to the identity of the marks. The other substantive requirements (same owners and same goods and services) will be examined during *inter partes* proceedings, where necessary, and will be restricted to the extent of those *inter partes* proceedings.

13.1 Harmonised seniority information

In order to be able to manage seniorities properly, it is recommended that all seniority entries in the system have the same format as that used in the databases of the national offices.

13.2 Seniority examination – formal requirements

A valid claim must contain the following indications:

1. the Member State or Member States of the EU in or for which the earlier mark for which seniority has been claimed is registered;
2. the filing date of the relevant registration;
3. the number of the relevant registration;
4. the goods or services for which the mark is registered.

The proprietor is not required to file a copy of the registration if the required information is available online. If the copy of the registration is not submitted, the Office will first search for the necessary information on the relevant website and only if the information is not available there will send the proprietor a deficiency letter to request a copy. The copy of the relevant registration must consist of a copy (a simple photocopy will suffice) of the registration and/or renewal certificate or extract from the Register, or an extract from the relevant national gazette, or an extract or printout from an official database. Extracts and printouts from private databases are not accepted. Examples of extracts that are not accepted are DEMAS, MARQUESA, COMPUSERVE, THOMSON, OLIVIA, PATLINK, COMPUMARK and SAEGIS.

Seniority may only be claimed for an earlier **registration**, not for an earlier application.

The Office must check both that the earlier mark was registered at the time the EUTM application was filed and that the earlier registration had not lapsed at the time the claim was made.

If the earlier registration had lapsed at the time the claim was made, seniority cannot be claimed, even if the relevant national trade mark law provides for a 6-month 'grace' period for renewal. While some national legislation allows for a grace period, if the renewal is not paid, the mark is considered to be not registered from the day it was due for renewal. Therefore, the claim is not acceptable, unless the applicant shows that it has renewed the earlier registration(s).

The seniority claimed for the EUTM will lapse if the earlier trade mark in respect of which seniority is claimed is declared to be invalid or revoked. If the earlier trade mark has been revoked, the seniority will lapse, provided that the revocation took effect prior to the filing date or priority date of the European Union trade mark (Article 39(4) EUTMR).

In the context of an **enlargement** of the EU, the following details have to be borne in mind. Where a national trade mark of, or an international registration with effect in, a new Member State was registered before the seniority claim is made, **seniority may be claimed even though the priority, filing or registration date of the EUTM** to which the seniority claim relates **predates the priority, filing or registration date of the national mark/IR with effect in the new Member State**. This is because the EUTM at issue only has effect in the new Member State from the date of accession. The national trade mark/IR with effect in the new Member State for which seniority is claimed is therefore 'earlier' than the EUTM within the sense of Article 39 EUTMR, **provided** that the national trade mark/IR with effect in the new Member State enjoys a priority, filing or registration date **prior to the accession date**.

Examples of acceptable seniority claims for new Member States			
EUTM No	**Filing date**	**Seniority claim country**	**Filing date of earlier right**
2 094 860 TESTOCAPS	20/02/2001	Cyprus	28/02/2001

Examples of acceptable seniority claims for new Member States			
2 417 723 PEGINTRON	19/10/2001	Hungary	08/11/2001
352 039 REDIPEN	02/04/1996	Bulgaria	30/04/1996
7 073 307 HydroTac	17/07/2008	Croatia	13/10/2009

Explanation: In all cases, although the filing date of the EUTM application is earlier than the filing date of the mark for which seniority is claimed, as all countries concerned acceded to the European Union after the filing date of the EUTM application (i.e. on 01/05/2004 for Cyprus and Hungary, on 01/01/2007 for Bulgaria and on 01/07/2013 for Croatia), and it is from that date that the EUTM application has protection in those Member States, seniority can be claimed for the national marks filed in those Member States prior to their dates of accession.

If the claim to seniority is in order, the Office will accept it and — once the EUTM application has been registered — inform the relevant central industrial property office(s) of the Member State(s) concerned.

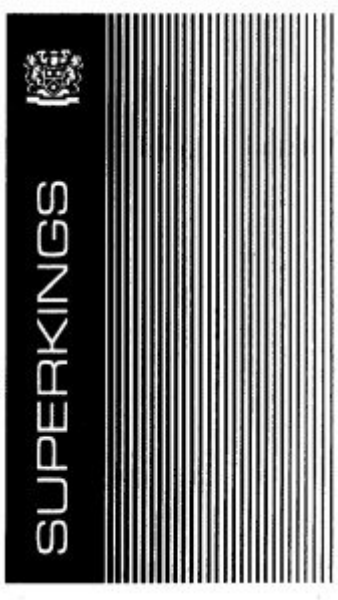
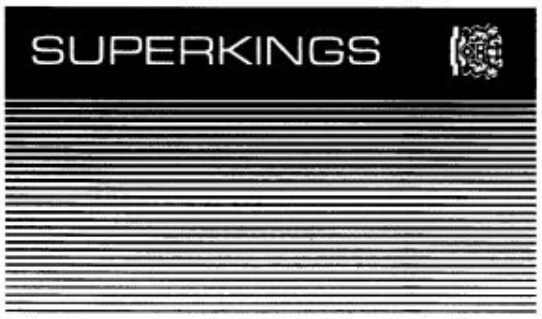
Seniority can also be claimed after the EUTM is registered under Article 40 EUTMR. For further details, see the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration.

13.3 Seniority examination – identity of the marks

As regards the triple-identity requirement (same owner, same mark, same goods and services), it is for the applicant to ensure that these requirements are met. The Office will examine only whether the marks are the same.

The comparison of the representations of the mark for the purposes of seniority claims is the same as that for priority claims detailed in paragraph 11.2.2.1.

Examples of signs considered identical	
EUTM application **(word mark)** **CELOTAPE**	**Seniority claim** **(word mark)** **Celotape**
EUTM application **(word mark)** **Daisys Gingerbread**	**Seniority claim** **(word mark)** **Daisy's Gingerbread**

EUTM registration (figurative mark) 	**Seniority claim (figurative mark)** 
EUTM application **(word mark)** **CULTILENE**	**Seniority claim** **(series of marks)** CULTILENE Cultilène

Examples of signs considered non-identical	
EUTM application No 9 817 735 **(figurative mark)** 	**Seniority claim** **(figurative mark)** 

Examples of signs considered non-identical	
EUTM application **(word mark)** **Great changes in education PLC**	**Seniority claim** **(word mark)** **Grate changes in education PLC**
EUTM application No 8 786 485 **(figurative mark)** 	**Seniority claim** **(figurative mark)** 
EUTM application No 14 061 881 **(figurative mark)** 	**Seniority claim** **(figurative mark)** 
EUTM application No 18 128 227 **(figurative mark)** 	**Seniority claim** **(combined mark)** 

For examples of identical and non-identical signs when claiming priority, which would also be considered identical or non-identical signs regarding seniority claims, seeparagraph 11.3.2.

13.4 Goods and services

Applicants may claim seniority for only some of the goods and services of the earlier registration(s). Effectively, the claim to seniority will be valid to the extent that there is an overlap between the goods and services of the EUTM application and the registration relied on. The applicant is not required to specify those goods and services, but may simply claim 'seniority for all the goods that are found in the earlier mark to the extent that they are also found in the EUTM application' (generic seniority claim).

13.5 Treatment of seniority examination deficiencies

If the claim is not valid, the earlier registration is not identical to the EUTM application, the seniority is claimed out of time (i.e. more than 2 months after the filing of the EUTM application) or the seniority documents are not acceptable and the relevant information cannot be found online, the Office will issue a deficiency letter.

If the deficiencies are not remedied within the time limit set by the Office, the applicant will be notified in writing of the loss of rights. At the same time the applicant will be informed that it can ask for a formal decision within 2 months of the notification.

If the applicant formally requests a decision within the time limit, the Office will issue a formal decision on the rejection of the seniority claim.

14 Transformation

Transformation is a legal feature introduced in the Madrid Protocol to soften the consequences of the 5-year dependency period between the international registration and the basic mark. In the event that the international registration designating the EU is cancelled at the request of the office of origin in respect of all or some of the goods and services, the holder of the international registration may file an EUTM application for the registration of the same mark in relation to the goods and services that have been cancelled. That application will be treated as if it had been filed on the date of the international registration or the subsequent designation of the EU and will enjoy the same priority, if any. For more details on transformation, see the Guidelines, Part M, International Marks.

15 Amendments to the EUTM Application

Article 49 EUTMR

Article 11 EUTMDR

The applicant may at any time withdraw its EUTM application or restrict the list of goods and services covered by it. Other changes are only contemplated to correct certain mistakes.

Any change requested on the same day of filing of the EUTM application will be accepted.

This part of the Guidelines will only describe Office practice concerning amendments to the mark representation. For further details on withdrawal or restrictions, see the Guidelines, Part B, Examination, Section 1, Proceedings and, for restrictions specifically, the Guidelines, Part B, Examination, Section 3, Classification.

Once an application has been filed in colour, it is not possible to amend it to one that is not in colour (25/08/2010,R 1270/2010-4, Prüfköpfe (3D)). The applicant's only option is to file a new application.

15.1 Amendments to the representation of the mark

The Office's practice on amendments to the mark representation is very strict. The two conditions for allowing a change to a mark once filed are **cumulative**:

- the mistake must be obvious, **and**;
- the amendment must not substantially change the mark as filed.

Even if the amendment is not a substantial one, if the mistake is not obvious, the Office will not accept the amendment.

In cases where the desired positioning of a mark is not obvious, the representation of the mark must indicate the correct position by adding the word 'top' to the reproduction of the sign.

In cases where the desired positioning of a mark is not obvious (e.g. a mark containing a verbal element is filed in a vertical position) and there is no indication of the intended positioning in the application, the applicant will be allowed to amend the position of the mark upon request. This is because the unusual positioning of the mark will be considered an obvious mistake.

If a priority or seniority claim is filed at the same time as the EUTM application, an obvious error may be proven by comparing the 'correct' mark in the claim with the mark on the EUTM application. However, if the priority or seniority claim is filed after the EUTM application, no evidence from these claims can be taken into account.

If the mistake is obvious, the mark must then be assessed according to the next criterion, namely whether the requested change substantially alters the mark as filed.

Example of an acceptable amendment (for formalities' purposes)	
EUTM No 546 010 Mark filed as 'TOPFLOW'	Proposed change 'TOP FLOW'
In the application form, the applicant claimed priority for the mark 'TOP FLOW', meaning that it was obvious that a typographical error had been made. The amendment was not considered to be a substantial alteration of the mark as the addition of a space between the words 'TOP' and 'FLOW' does not alter the meaning and pronunciation of the mark, and the visual impact of the amendment is low (05/08/2002, R 851/1999-2, TOPFLOW).	
EUTM No 18 437 494 EUTM as filed 	Proposed change 
The applicant filed the mark representation without noticing the small mouse cursor on the top right side. They submitted a new representation requesting the substitution and claiming that the mouse cursor did not form part of the mark. The Office accepted the change considering it an obvious error that did not change the mark substantially.	

Examples of unacceptable amendments (for formalities' purposes)	
EUTM No 321 109 Mark filed as 'RANIER'	Proposed change 'RAINIER'
This change is not allowed as the correction shows the addition of another letter 'I', which would substantially change the mark as filed. 'RANIER' and 'RAINIER' are two different words.	
EUTM No 6 013 668 Mark filed as 'ELECTROLITIC BOLUS'	Proposed change 'ELECTROLITYC BOLUS'
This change is not allowed as the correct English spelling for this word is 'ELECTROLYTIC'. Consequently, the mark as filed had one erroneous letter whilst the amendment proposal would have two erroneous letters. This would substantially alter the mark and is therefore unacceptable.	

In the case of figurative elements, only elements of minor importance can be amended; this will be dealt with on a case-by-case basis. Giving a 'fresh look' to a figurative mark (which is a frequent practice in the industry in order to adapt the appearance of a figurative mark to current design and fashion trends from time to time) is not allowed.

Examples of unacceptable amendments (for formaities' purposes)	
EUTM No 6 538 524 EUTM as filed 	Proposed change 
The applicant filed a priority claim with the EUTM application, which showed that the first filing consisted of a single representation of the mark. In addition, the EUTM application contained a mark description that described the single representation and not the two images that had been filed. Therefore, the mistake was considered to be obvious. The amendment request was, however, rejected as the amendment would substantially change the mark from that which was filed.	

Notwithstanding the aforementioned principles and examples, any alteration of the mark that would be allowable after registration will also be allowable in respect of an EUTM application.

Regarding alterations of a registered EUTM, please refer to the Guidelines, Part E, Register operations, Section 1, Changes in a registration.

16 Conversion

Articles 139(1) and 140(1) EUTMR

Article 22(f) EUTMIR

The applicant for an EUTM application or proprietor of a registered EUTM may request the conversion of its EUTM application or registered EUTM. For more information on conversion see the Guidelines, Part E, Register Operations, Section 2, Conversion.