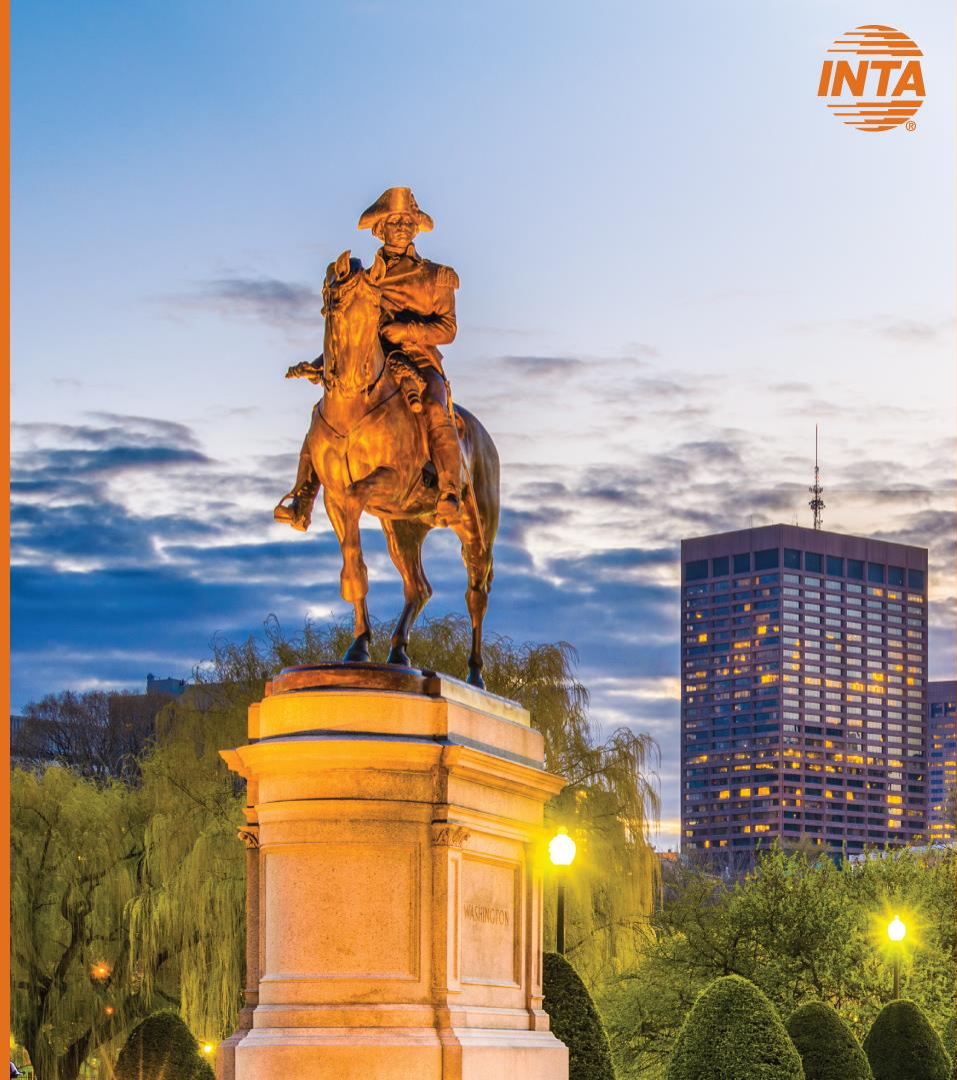


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Boston, Massachusetts | May 18–May 22, 2019



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INTA ANNUAL MEETING

Boston, May 2019

Cristina BERCIAL-CHAUMIER
Managing partner CASALONGA ALICANTE

La passion de la propriété
industrielle depuis 1867

CASALONGA 

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Abolishing Graphical Representation Requirement

Legal changes - Legislative Package

- ❖ EUTM Regulation 2017/1001 of the European Parliament and of the council of 14 June 2017 on the European Union trade mark
- ❖ EU Trademark Directive No. 2015/2436



❖ EU Trademark Directive No. 2015/2436 - Article 3 :

« *A Trademark should be represented in **a manner which enables the competent authorities and the public to determine the clear and precise subject matter of protection***»

❖ EUTM Regulation (EU) 2017/1001 - Article 4 (b) :

“being represented on the Register of European Union trade marks (‘the Register’), **in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor**”

(OPEN DEFINITION)

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- *Possibility of accepting new types of trade marks*, filed in formats not previously provided for by national or regional systems.
- It will *make the representation of certain already acceptable types of trade marks easier and more accurate* (sounds, motion marks and holograms).
- The **graphical representation** requirement **no longer applies** when submitting a trade mark application as from October 1st, 2017.
- The result is a **‘what you see is what you get’** system, which aspires to make the trade mark entries on the EUTM Register *clearer, more accessible* and *easier to search for*.

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EUTM Implementing Regulation No. 2018/626 (Article 3)

| | | | |
|---|---|--|---|
|  Word mark |  Figurative mark |  Figurative mark containing word elements |  Shape mark |
|  Shape mark containing word elements |  Colour per se |  Sound mark |  Multimedia mark |
|  Position mark |  Motion mark |  Pattern mark |  Hologram mark |
|  Other | | | |



❖ Trademarks Directive No. 2015/2436

No indications were provided in the Directive on:

- ✓ Definitions of the new types of marks
- ✓ Requirements of the specific representation and other filing requisites
- ✓ The specific value given to the indication of the type of mark or its description



Risk of different types of trade marks being accepted by different offices, which may apply different definitions and impose different representation requirements.





Common Communication on the representation of new types of marks

To support the transposition of the Directive to coordinate the action by the EUIPO and national IP Offices to prevent discrepancies.

- ✓ *Types of trade marks* that the IP Offices of EU Member States plan to accept
- ✓ *Definitions and means of representation* for the new types of trade marks
- ✓ *Acceptable electronic file formats* for sound, motion, multimedia and hologram marks
- ✓ **Regularly updated reflecting the developing positions of the MS, (ALIVE)**

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| Type of trade mark | Description required? | Format required |
|----------------------|---------------------------------|----------------------|
| Word | No | N/A |
| Figurative | No | JPEG |
| Shape | No | JPEG OBJ STL X3D |
| Position | Optional (previously mandatory) | JPEG |
| Pattern | Optional | JPEG |
| Colour (single) | No | JPEG |
| Colour (combination) | Optional (previously mandatory) | JPEG |
| Sound | No | JPEG MP3 (max 2 Mb) |
| Motion | Optional (previously mandatory) | JPEG MP4 (max 20 Mb) |
| Multimedia | No | MP4 (max 20 Mb) |
| Hologram | No | JPEG MP4 (max 20 Mb) |

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THE EUIPO GUIDELINES

Part B Examination

Section 2: Formalities

9. Mark Type

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

<https://euipo01app.sdlproducts.com/819173/720197/trade-mark-guidelines/10-----9-mark-type>

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THE EUIPO GUIDELINES

Description

A description may be filed in some cases as an option (position, pattern, colour and motion).

The representation **cannot be replaced by a description** of the mark but *the description, when given, must be in line with the representation.*

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How were non-traditional Marks filed before October 1, 2017 ?



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ACCEPTED TRADEMARKS

Considered to meet the graphical representation requirement.

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eSearch plus
The EUIPO's **Search** engine

the smell of fresh cut grass

Search

Advanced search

EUTM file information

Back to search results 1 of 1

THE SMELL OF FRESH CUT GRASS

000428870

Certificate

Set alert

Print

Timeline



Actions and communications

EUTM

Appeals

Information

Cancellation

Trade mark information

| | | | |
|-----------------------|---------------------------------|--------------------------|----------------------|
| Name | THE SMELL OF FRESH CUT GRASS | Filing date | 11/12/1996 |
| Filing number | 000428870 | Registration date | 11/10/2006 |
| Class | EUTM | Expiry date | 11/12/2006 |
| Date of receipt | 11/12/1996 | Designation date | |
| Type | Other | Filing language | Dutch |
| Nature | Individual | Second language | English |
| Nice classes | 28 (Nice Classification) | Application reference | GIQ10165 |
| Vienna Classification | 96.01 (Vienna Classification) | Trade mark status | Registration expired |
| | | Acquired distinctiveness | No |

Graphic representation

The smell of fresh cut grass

Goods and services

English (en)

28 Tennis balls.

Description

English (en)

Description
Colour The mark consists of the smell of fresh cut grass applied to the product.



EUTM Registration No. 012438628

SOUND MARK IN THE NAME OF TWENTIETH CENTURY FOX FILM CORPORATION in classes 9, 38 and 42

<https://euipo.europa.eu/eSearch/#details/trademarks/012438628>



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EU Trademarks refused

Considering non compliant with the graphical representation requirement.

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EU Trademarks refused

Olfactory mark

The smell of ripe strawberry



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EUTM Application No. 011923778

**SOUND MARK IN THE NAME OF JAGUAR LAND ROVER LIMITED
in Classes 9, 12 and 35**

<https://euipo.europa.eu/eSearch/#details/trademarks/011923778>

7(1)(b)EUTMR – lack of distinctive carácter

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NON TRADITIONAL TRADEMARKS FILED AFTER OCTOBER 1, 2017

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EUTM APPLICATIONS ACCEPTED

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Motion mark: EUTM Registration No.017934434 in the name of Sanofi

75%CHOLESTEROL 55%ACTIVITY 100%WEIGHT 21%INFO
75%PROFILE



<https://euipo.europa.eu/eSearch/#details/trademarks/017934434>

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Multimedia: EUTM Registration
017931243 Jerryopot \$\$\$ in the name of
ZITRO IP S.à.r.l



<https://euipo.europa.eu/eSearch/#details/trademarks/017931243>

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**Motion mark: EUTM Registration No.
017894840**

**The future is exciting. Ready ? in the name of
Vodafone**



<https://euipo.europa.eu/eSearch/#details/trademarks/017894840>

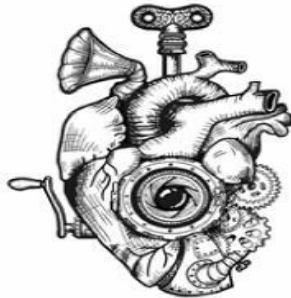
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- **EUTM Registration No17279704**

<https://euipo.europa.eu/eSearch/#details/trademarks/017279704>



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EUTM APPLICATIONS REFUSED

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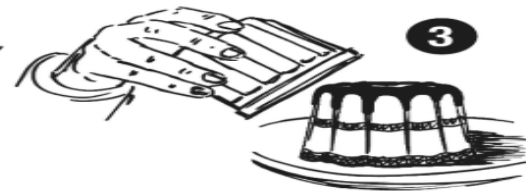
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EUTM application 17852187

graphic representation with description
in class 30 (desserts)

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4 Motion marks in the name of Bang & Olufsen

in class 9 (loudspeakers, television apparatus, projectors)



➤ **EUTM No 017280215** (*video*)

<https://euipo.europa.eu/eSearch/#details/trademarks/017280215>



➤ **EUTM No 017280249** (*video*)

<https://euipo.europa.eu/eSearch/#details/trademarks/017280249>



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➤ **EUTM No 017280264** (*video*)

<https://euipo.europa.eu/eSearch/#details/trademarks/017280264>



➤ **EUTM No 017280281** (*video*)

<https://euipo.europa.eu/eSearch/#details/trademarks/017280281>



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**Sound mark: EUTM Application No.
009199175 in class 9, 38 and 41**

REFUSED

7(1)(b) EUTMR

<https://euipo.europa.eu/eSearch/#details/trademarks/009199175>

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**Sound mark: EUTM Application No.
017889555 (refused under 7(1)(b)
EUTMR) Piaggio & Co. S.p.a (class 12)**

<https://euipo.europa.eu/eSearch/#details/trademarks/017889555>

REFUSED

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- Motion mark: EUTM No 017350901 in the name of NetEnt Product Services Ltd. Classes 9 & 41

REFUSED



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**THANK YOU VERY MUCH
FOR YOUR ATTENTION**