

Scenery from a Highland hilltop

Trade Marks - New Legislations & New Practices

New Types of Trade marks at the EUIPO

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Abstract

The presentation consists of an **overview of EUIPO's examination and decision making practice** on 'new types' of trade marks, after almost two years from the conclusion of the Trade Mark Legislative Reform. With the new rules the requirement of the graphic representation was abolished from the definition of the EU trademark (Article 4 EUTMR) and new definitions, as well as new representation requirements, were introduced by the Implementing Regulation for all the different types of trademarks that can be filed under the new rules (Article 3 EUTMR).

The subject will be introduced by presenting the **new provisions** and the main novelties they bring about, and by reporting on general **filing trends** since the entry into force of the new rules.

The main part of the presentation focuses on the particularities of **Sound, Motion, Multimedia, Hologram and 'Other'** marks, that is, the trademark types most impacted by the new provisions, and on the legal issues that they raise in absolute and relative grounds examination.

First, **detailed statistics** will be provided per type of mark by giving up to date figures for applications filed, withdrawn, refused, under examination, opposed and registered.

Then, **examples from decisions** taken by EUIPO instances so far will be given, with a view to illustrating the most interesting patterns in the examination of these types of marks.

For each identified type the most typical refusals on absolute grounds will be presented, with particular regard to the grounds and reasons applied by the examiner. Any pending appeal proceedings will be cited. Refusals will be contrasted by a selection of marks that made it to registration, in order to mark possible differences or inconsistencies in the assessment. Finally, a short overview of opposition proceedings currently pending against new types will be given, with emphasis on the new issues they raise, in particular as concerns the comparison of the signs.

To complete the picture, a few words will be said about the progress of **Convergence Project No 11**, which was launched in 2018 to reach common practice principles on the examination of formalities and grounds for refusal of new types of marks across the EU. Reference will be made to the activities carried out so far and to the objectives expected from the next phases.

The aim of the presentation is not only to give an overview of the Office's practice and to highlight the direction that the examination seems to be following so far, but also to stimulate reflections and encourage a debate on the **novel issues** that arise from the adaptation of existing principles, based on concepts that were established for traditional trade marks, to the challenges brought about by the creation of new and untested trade mark types.