

***GUIDELINES FOR EXAMINATION IN THE  
OFFICE FOR HARMONIZATION IN THE  
INTERNAL MARKET (TRADE MARKS AND  
DESIGNS)***

***EDITOR'S NOTE AND GENERAL  
INTRODUCTION***

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## 1 Subject Matter

Council Regulation No 40/94 of 20 December 1993, as amended and codified in Council Regulation No 207/09 of 26 February 2009 (CTMR), established, in parallel with the national systems, a Community trade mark system with the aim of eliminating one of the main obstacles to the development of the single European market. Council Regulation No 6/02 of 12 December 2001 (CDR) did the same for Community designs. Hitherto, the law governing the registration and use of trade marks or designs had been exclusively national and made it difficult for the same trade mark or design to be used throughout the European Union.

The Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM or the Office), established in Alicante, is responsible for the registration of Community Trade Marks (CTM) and Registered Community Designs (RCD). These registrations provide uniform trade mark and design protection throughout the European Union.

The Office deals with registration procedures (including the examination of applications for absolute grounds for refusal and, where an opposition has been raised regarding a CTM application, for relative grounds for refusal), maintains the public registers of these rights and decides on applications for those rights, once registered, to be declared invalid. The Office's Guidelines cover practice in all these areas.

## 2 Objective of the Guidelines

The purpose of the Guidelines on CTMs and the Guidelines on RCDs is to improve the coherence, predictability and quality of the Office's decisions. The Guidelines are designed to bring together, systematically, the principles of practice derived from the jurisprudence of the European Court of Justice, the case-law of the Office's Boards of Appeal, the decisions of the Office's Operations Department and the outcome of the Office's Convergence Programmes with EU IP offices. They provide a unique source of reference on Office practice with regard to CTMs and RCDs and are intended to be of practical use both to Office staff in charge of the various procedures and to users of the Office's services.

The Guidelines have been drawn up to reflect Office practice in the most frequent scenarios. They contain only general instructions, which have to be adapted to the particularities of a case. They are not legislative texts and, therefore, are not of a binding nature. Both the parties involved and the Office must, where necessary, refer to the CTMR, the CDR, and their respective Implementing Regulations, the Fee Regulations, Commission Regulation (EC) No 216/96 of 05/02/1996 laying down the rules of procedure of the Boards of Appeal and, finally, the interpretation of these texts handed down by the Boards of Appeal and the Court of Justice of the European Union, including the General Court of the European Union.

As case-law is evolving constantly, the Guidelines will also evolve. They will be adapted to reflect developments in Office practice on a yearly basis by means of an ongoing revision exercise (see point 3 below).

### 3 Guidelines Revision Process

As the sole source of reference on Office practice with regard to CTMs and RCDs, the Guidelines are available in all official EU languages. They are revised by the cross-departmental Knowledge Circles of the Office in a cyclical and open process: 'cyclical' because practice is updated on a yearly basis by looking at the case-law of the preceding year and taking into account operational needs and the outcome of convergence initiatives, and 'open' because external stakeholders are involved in defining that practice.

The involvement of national offices and user associations not only benefits the quality of the Guidelines, but is also expected to facilitate convergence, that is, the process of exploring common ground on issues where there are diverging practices. Making the Guidelines available in all EU languages will raise awareness of Office practice amongst Member States and users and make differences in practice easier to identify.

The yearly work is split into two 'work packages': Work Package 1 (WP1) runs over a twelve-month period each year from January to December, and Work Package 2 (WP2) over a twelve-month period each year from July to June.

The process involves the following phases:

a. Initiation of update by stakeholders

Having been made aware of the Office's revision plans, in particular what is to be revised and when, the national offices and user associations are welcome to submit comments before January (for WP1) and before July (for WP2). Comments not received on time will be taken into consideration during the next cycle or may be submitted during phase c.

b. Preparation of the draft Guidelines by the Office

During this phase, the draft Guidelines are produced by the Office's Knowledge Circles. The process starts each year in January (for WP1) and July (for WP2). Feedback and comments submitted in advance from users are taken into consideration. The three steps of the process – analysis, drafting and discussion – must be completed in a timely manner. Analysis involves the Knowledge Circles extracting trends from the preceding year's case-law, studying the conclusions of the convergence projects and taking into consideration the comments received from the Office's users and internal stakeholders. As the next step, the Knowledge Circles draft the guidelines. Finally, the texts are discussed amongst the various units and departments of the Office.

c. Adoption of the Guidelines

In the last phase, the draft Guidelines are sent for translation into the Office languages. The texts and translations are circulated amongst the user associations and the EU IP offices with a view to receiving feedback before the next meeting of the Office's Administrative Board (AB). After consulting the AB in accordance with Article 126(4) CTMR and Article 101(b) CDR, the President adopts the updated Guidelines. The versions in the five Office languages together make up the official text, which is intended to be published in January (WP1) and July (WP2) of each year, respectively. In the event of discrepancies

between different language versions, the text in the drafting language (English) will prevail. Once adopted, the Guidelines will be translated into the remaining official languages of the European Union as a matter of courtesy and for transparency. These additional translations will be published on the Office's website, and external stakeholders, whether national offices or user associations, will be free to submit feedback on their quality; any linguistic amendments made as a result of this informal feedback will be incorporated into the texts without any formal procedure.

d. Fast-track procedure

Where a major external event has an immediate impact on Office practice (for example, certain judgments of the Court of Justice), the Office can amend the Guidelines in a fast-track procedure outside the normal time frame set out above. However, this procedure is the exception to the norm. As the process is cyclical, such changes will always be open to comments and revision in the following cycle.

## 4 Structure of the Guidelines

The items dealt with in WP1 and WP2, respectively, are set out below. In exceptional circumstances, certain elements of practice might be changed from one WP to another. Should such a change occur, it will be communicated to stakeholders.

### COMMUNITY TRADE MARK:

#### WP1

##### Part A: General Rules

Section 3, Payment of fees, costs and charges  
Section 5, Professional representation

##### Part B: Examination

Section 2, Formalities  
Section 4, Absolute Grounds for Refusal 7(1)(a)  
Section 4, Absolute Grounds for Refusal 7(1)(b)  
Section 4, Absolute Grounds for Refusal 7(1)(c)  
Section 4, Absolute Grounds for Refusal 7(1)(d)  
Section 4, Absolute Grounds for Refusal 7(1)(e)  
Section 4, Absolute Grounds for Refusal 7(3)

#### WP2

##### Part A: General Rules

Section 1, Means of communication, time limits  
Section 2, General principles to be respected in proceedings  
Section 4, Language of proceedings  
Section 6, Revocation of decisions, cancellation of entries in the Register and correction of errors  
Section 7, Revision  
Section 8, Restitutio in Integrum  
Section 9, Enlargement

##### Part B: Examination

Section 1, Proceedings  
Section 3, Classification  
Section 4, Absolute Grounds for Refusal 7(1)(f)  
Section 4, Absolute Grounds for Refusal 7(1)(g)  
Section 4, Absolute Grounds for Refusal 7(1)(h)+(i)  
Section 4, Absolute Grounds for Refusal 7(1)(j)+(k)  
Section 4, Collective marks

**Part C: Opposition**

Section 0, Introduction

Section 1, Procedural Matters

Section 2, Double identity and Likelihood of confusion

Chapter 1, General Principles and Methodology

Chapter 2, Comparison of Goods and Services

Chapter 3, Comparison of Signs

Chapter 4, Distinctiveness

Chapter 5, Dominant character

Chapter 6, Relevant public and degree of attention

Chapter 7, Other factors

Chapter 8, Global assessment

Section 6, Proof of Use

**Part D: Cancellation**

Section 1, Cancellation proceedings

**Part E: Register Operations**

Section 2, Conversion

Section 4, Renewal

Section 5, Inspection of files

Section 6, Other entries in the Register

Chapter 1, Counterclaims

**REGISTERED COMMUNITY DESIGN**

**WP1**

Examination of Design Invalidation Applications

**Part C: Opposition**

Section 3, Unauthorised filing by agents of the TM proprietor (Article 8(3) CTMR)

Section 4, Rights under Article 8(4) CTMR

Section 5, Trade marks with reputation Article 8 (5) CTMR

**Part D: Cancellation**

Section 2, Substantive provisions

**Part E: Register Operations**

Section 1, Changes in a registration

Section 3, CTMs as objects of property

Chapter 1, Transfer

Chapter 2, Licences

Chapter 3, Rights in rem

Chapter 4, Levy of execution

Chapter 5, Insolvency proceedings or similar proceedings

**Part M: International marks**

**WP2**

Examination of Applications for Registered Community Designs

Renewal of Registered Community Designs