European Union Trade Mark Regulation

Article-by-Article Commentary

Bearbeitet von

Edited by Dr. Gordian N. Hasselblatt, List of Authors: Vladimir Anohin, Emmanuel Baud, Michel Béjot, Anne Bekema, Matthias Berger, Wolter Wefers Bettink, Alexandra Bismarck, Héloïse Bock, Rudolf Böckenholt, Thies Bösling, Andrej Bukovnik, Louise Carey, Claus Barrett Christiansen, Lee Curtis, Magnus Dahlman, Frank Dittschar, Julia Dönch, Dr. Andreas Ebert-Weidenfeller, Dr. Egon Engin-Deniz, Edouard Fortunet, Blas Alberto Gonzalez Navarro, Simon Gray, Antje Gruneberg, Steffen Hagen, Alexis Hallemans, Dr. Michal Havlík, Tom Heremans, Sven Jacobs, Andrea Jaeger-Lenz, Philipp Kapff, Urmas Kauler, David Kipping, Mariusz Kondrat, Peter Kru?liak, Dr. Áron László, Dr. Andrea Lensing-Kramer, Jorge Llevat, Manuel Lopes Rocha, Inga Lukauskiene, Thomas Manderla, Ruxandra Manea, Daniel Marschollek, Dr. Mary-Rose McGuire, Dr. Carsten Menebröcker, Dr. Max W. Mosing, Iliana Muhibian, Prof. Dr. Axel Nordemann, Eirini Panopoulou, Kim Parviainen, Tanja Rajic, Eckhard Ratjen, Dr. Luigi A. Sansone, Grigoris Sarlidis, Gregor Schneider, Tom Scourfield, Dr. (hab.) Ewa Skrzyd?o-Tefelska, Dr. Dirk Smielick, Dimitris Spiliotis, Dr. Gabriela Staber, Sabine Stamm, Sabine Stier, Tankred Thiem, Valeska Töbelmann, Julian Varbanov, Raluca Vasilescu, Gregor Vos, Dr. Francesca Warrington, Reda ?aboliene, and Mateusz ?uk

Auflage 2018. Buch. XXVII, 1784 S. Hardcover (In Leinen)
 ISBN 978 3 406 71510 5
 Format (B x L): 16,0 x 24,0 cm

Recht > Handelsrecht, Wirtschaftsrecht > Gewerblicher Rechtsschutz > Markenrecht

Zu <u>Leseprobe</u> und <u>Inhaltsverzeichnis</u>

schnell und portofrei erhältlich bei



Die Online-Fachbuchhandlung beck-shop.de ist spezialisiert auf Fachbücher, insbesondere Recht, Steuern und Wirtschaft. Im Sortiment finden Sie alle Medien (Bücher, Zeitschriften, CDs, eBooks, etc.) aller Verlage. Ergänzt wird das Programm durch Services wie Neuerscheinungsdienst oder Zusammenstellungen von Büchern zu Sonderpreisen. Der Shop führt mehr als 8 Millionen Produkte.

Index (of Part A - Commentary)

Introductory note

References in the following are not to page numbers, but to the article of the Regulation (referred to by the number of the provision, in bold) and the margin number of the chapter.

Absolute admissibility requirements

- agent's mark 46 43
- earlier non-registered mark 46 44
- earlier rights that are not earlier 46 46 et seq.
- earlier trade mark registration or application with reputation 46 40
- earlier well-known trade mark 46 41
- identification of contested EUTM 46 38
- identification of earlier mark or right 46 39

Absolute grounds for invalidity 59 1 et seq.

- acquired distinctiveness after registration 59 34
 et sea
- assessment of invalidity by EUIPO 59 2
- bad faith filing 59 7 et seq.; 209 36 see also Bad faith
- burden of proof 59 33
- no intention to use 59 13
- relevant date 59 6

Abstract colour mark 8 170 et seq.

Acquiescence 61 1 et seq.

- burden of proof of acquiescence 61 10
- consequences of acquiescence 61 12
- Intervening rights 16 8, 11
- knowledge transferred 61 8
- limitation in consequence of acquiescence 61 1 et seq.
- limitation of EUTM rights 61 1 et seq.
- prohibition of use of EUTM 137 25; 138 7
- requirements for limitation 61 3 et seq.

Acquired distinctiveness

- claim to acquired distinctiveness 7 335
- goods and services 7 339
- Intervening rights 16 10, 11
- means of evidence 7 348
- perception as trade mark 7 346
- proof of investments 7 348
- proof of market share 7 348
- refusal of registration absolute grounds 7 322 et seqq.
- relevant point in time 7 340
- relevant territory 7 343
- survey and opinion polls 7 348
- third-party statements 7 348
- unitary character 7 343 see also Principle of unity

Action for a (negative) declaratory judgment jurisdiction of 'domicile courts' 125 17 et seq.

Action for declaration of non-infringement 124

Action for infringement

- EU collective marks 80 1

Action for reasonable compensation 124 12 Actionable decisions

- appeal before the General Court 72 14

Actions against decisions on appeals 72

- appeal before the Court of Justice 210, 230 see there
- appeal before the General Court 122, 159 see there
- two-tier proceeding 72 7

Actions and counterclaims 124 4

Administration of Trade Marks and Legal Division

- decision leading to an entry 162 4
- decision outside its competence 162 8
- decision taken by a single member 162 11
- EUTM Register 162 1
- function of a fall-back unit 164 1
- general 162
- list of professional representatives 162 5
- Operations Support Department 162 2
- responsibilities 162 3 et seq.

Administrative Instructions

- International Registration of trade mark 182 2 et seqq.

Admissibility of counterclaim proceedings 128 7 et seg.

Admissibility of opposition 46 28 et seq.

- absolute admissibility requirements see there
- identification of grounds 46 49
- notice of opposition 46 29
- optional indications 46 63 et seq.
- relative admissibility requirements see there
- revision and changes of procedural practice 46
 28

Admittal of conversion with respect to registered EUTM or IR designating the EU

request for application of national procedures
 139 12 et seqq.

Advertising by resellers 9 261; 15 59

Advertising function of trade mark 9 261, 268,

272, 283 et seq.; 58 27 Advertising slogan

- assessment criteria 7 249
- distinctive character 7 250
- requirements 7 250

Aesthetic complementarity

- likelihood of confusion 8 81

Agency mark 69

Alteration of registration 54 1 et seq.

- content of application for alteration 54 5
- fee 54 6
- publication 54 8

Alteration of the BoA's decision 72 126 Ambiguous and contradictory description 4 57 Amendment of classification and addition of classes 33 7

Amendment of regulations governing use of EU collective mark 79 1 et seq.; 81 5

Anchor claim 122 10

Ancillary claims 122 14; 124 9

Animated sign

- refusal of registration - absolute grounds 7 333

Annulment of the BoA's decision 72

Another characteristic 4 3; 7 113 et seqq., 119 See also Shape marks

Appeal

- actions against decisions on appeals see there
- decisions in respect to appeals see there
- decisions subject to appeals see there
- examination of appeals see there
- form of appeal see there
- person entitled to appeal of to be parties to appeal proceedings see there
- revision of decisions in ex partes cases see there
- revision of decisions in inter partes cases see there
- time limit for appeal see there

Appeal against decisions of the BoA 8 10; 70 8; 72 14

Appeal before the Court of Justice 72 163

- actionable decisions 72 163
- applicants 72 164
- costs 72 223 see Costs of appeal before Court of Justice
- cross appeal 72 193
- decisions of the Court of Justice see Court of
- formal requirements 72 189
- grounds of appeal 72 169
- intervener 72 168
- language 72 199
- legal aid 72 230other parties 72 167
- parties 72 164
- proceedings see Proceedings before the Court of Iustice
- representation 72 190
- term for appeal 72 179

Appeal before the General Court 72

- actionable decisions 72 14
- adverse effect of decision 72 17
- applicant 72 23
- application 72 65 see Application for appeal before the General Court
- Costs 72 141 see Costs of appeal
- decision of the General Court see General Court
 decision
- defendant 72 26
- determination of relevant language 72 100
- evidence not presented before the BoA 72 43
- facts introduced for the first time 72 42
- grounds of appeal 72 49
- language of proceedings in ex partes 72 101

- language of proceedings in inter partes cases 72 102
- legal aid 72 159
- legal successor 72 33
- legal transfer of rights 72 36
- matters in dispute 72 40
- parties 72 23
- proceedings before the General Court see there
- qualified intervener 72 27
- representation 72 95
- restriction of the specification 72 47
- term for an appeal 72 56 see also Term for filing an appeal
- universal succession 72 34

Appeal manifestly inadmissible or unfounded 72

Applicable law 17 1, 3

Applicants without legal personality 3 10, 25 et seq.

Application fee

- amount 32 15
- deadline for payment 32 21
- means of payment 32 17
- receipt of payment 32 17

Application for a declaration of invalidity 63 1 et seq.

- avoidance of duplication of proceedings 63 21
- content of application 63 18 et seq.
- examination of the application see there
- fee 63 11 et seq.
- interested parties 63 7 et seq. language 63 13 et seq.
- requirements 63 11 et seq.

Application for appeal before the General Court
 consequences of non-compliance with formal requirements 72 91

- facts and pleas in law 72 72
- formal requirements 72 79
- forms of order sought 72 66
- signature 72 77

Application for EUTM 30

- conversion into national application see Conversion into national trade mark application
- exhibition priority see there
- filing of application see there
- language of application see Language of application for EUTM
- language of inter partes proceedings 146 46 et seq.
- language of opposition proceedings 146 19 et
- priority see there
- publication and entries in the EUTM Register see there
- registration see Registration of EUTM
- requirements for applicants 3 10 et seq.

Application for identical trade mark

- right of priority 34 12 et seq.

Application for inspection of files 114 40 et seq.

Application for revocation 63 1 et seq.

- avoidance of duplication of proceedings 63 21 et seq.
- content of application 63 18 et seq.
- examination of the application see there
- fee 63 11 et seq.
- interested parties 63 7 et seq.
- language 63 13 et seq.; 114 43 et seq.
- requirements 63 11 et seq.

Application for revocation or invalidity

- language 146 35

Application of Regulation 1215/2012

- applicable provisions 122 6 et seq.
- counterclaim 122 15 et seq.
- general 122 1 et seq.
- non-applicable provisions 122 5
- place of jurisdiction for a joinder of defendants see there
- related actions 122 18 et seq.

Armorial bearings, flags and other State emblems

- concerning goods and services 7 163
- criteria for assessment 7 166 et seq.
- emblem as single element of a mark 7 167
- graphic conformity 7 169
- Paris Convention 7 160 et seq.
- WIPO 7 165

Assessment of descriptiveness 7 66 et seq.

Assessment of distinctive character 8 175 et seq.

Assessment of shape marks 7 102 et seq.

- Audit and control 174 1

 appointment and accountability of internal auditor 174 1
- auditing of accounts 176 4
- Court of Auditors 153 6
- discharge procedure 1767 A
- external audit 153 175
- OLAF 175 2 et seq.
- responsibilities of internal auditor 174 3

Aural comparison

similarity of signs 8 131 et seq.

Automatic extension of EUTMs 209 5

Auxiliary staff at EUIPO 143 6

Average consumer 7 15

Average consumer's perspective re shape marks 7 57, 114

Award of costs in inter partes proceedings 109 1

- decision on costs 109 10 et seq. see Decision on costs before EUIPO
- historic development 109 9
- proceedings where award of costs is possible 109 1
- relevant period 109 32 et seg.
- type of costs 109 2 et seq.

Bad faith see also Good faith

- absolute ground for invalidity 6 10; 7 149
- agent's mark 46 24
- assessment of individual case 14 61
- bad faith defence 14 13
- bad faith filing 59 8 et seq.
- character 58 10 et seq.

- concept 59 14 et seq.
- filing 59 8 et seq.
- genuine use 18 45
- nefarious agent 8 250 et seq.
- transfer 20 21 et seq.

Balanced budget 172 6

Bankruptcy 27 21 et seq.

Basic fee see also Fees

- fees for international application 108 2

Binding effect of registration 6 11 et seq.

- colour mark 6 14
- limitations 6 15 et seq.
- three-dimensional mark 6 14

Blurring see also Dilution

Boards of Appeal 165 - appeal against decisions of the BoA see there

- comment by the Executive Director 165 3
- exclusion of examiners or members 166 12; 169 4, 7
- general 165
- Grand Board 165 15
- grounds for exclusion of examiners or members 169 4
- grounds of objection against examiners or members 169 7
- incompatibility rules 166 14
- independence of members 166 17
- mediation 165 24
- President of the BoAs 165 8; 166 20
- procedural principles 169 1
- procedure of appointment 166 3
 - Registrar 165 12
- Registry of the BoA 165 12
- removal from office 166 12

- Single Member Board 165 21

structure 165 4

Bona fide acquisition 20 28; 22 14; 27 2, 8 et seq. Brexit

consequences for EUTMs 1 11 et seq.

Budget Committee 154 2; 155 4; 171 1 et seqq.

- composition and sessions 171 4, 9
- decision taking 171 14
- financial provisions 177 1 et seq.
- Financial Regulation 177 3
- powers 171 11
- rules of procedure 171 3, 14

Budget of EUIPO 171 1 et seqq.; 172 6

- balanced budget 172 6
- Budget Committee see there
- Financial Regulation 173 1
- preparation 173 3
- revenue and expenditure 172 2
- structure 172 2

Cancellation Division 163

- composition 163 6
- decision by a single member 163 12
- exclusion of examiners 163 11
- responsibilities 163 1

Cancellation proceedings

- language 146 35 et seq.
- use of EUTM 18 64

Capacity to act before EUIPO 3

Category of trade mark

- ambiguous and contradictory description 4 57
- indication of the category of trade mark 4 56
- obligatory indication 4 56
- re-categorisation 4 59

Cease-and-desist claim

- application of Regulation 1215/2012 122 12 et seq.
- infringement action 124 9

Ceased applications and registrations

- inspection of files 114 10

Central attack

- central attack rule 139 8
- effects of transformation 204 9
- Madrid Protocol 182 5; 183 5; 197 1 et segg.
- reporting obligations 184 21
- request for application of national procedures
 130 8
- request for transformation 204 2 et seq.

Certificate of Registration 46 107; 51

Certification Mark

- action for infringement 90 3
- characteristics to be certified 84 11
- conditions of use, sanctions 84 20
- content requirements 84 8
- conversion 93 1
- definition 83 13
- fees 83 48
- general 83 1; 84 1
- grounds for invalidity 92 1
- grounds for revocation 91 1 et seqq.
- observations by third parties 86 1 et seq.
- ownership 83 28
- persons authorised to use the mark 84 9
- procedural aspects 83 39
- refusal 85 1 et segq.
- sign and distinguishing capacity 83 19
- specific function 83 20
- testing methods, supervision system 84 17
- transfer 89 1
- use 87 1 et seq.

Change of parties in opposition proceedings 46 84 et seq.

- change of names 46 94
- change of representatives 46 95
- transfer of contested EUTM application 46 92 et seq.
- transfer of earlier EUTM 46 85 et seq.
- transfer of earlier national registrations 46 88 et seq.

Characteristics as result of function 7 102 Choice of language by agreement between the parties

- appeal proceedings 146 62
- application for EUTM 146 52 et seq.
- filing EUTM application 146 7
- inter partes proceeding 146 62

Civil actions on basis of more than one trade mark 136 1 et seq.

- infringement actions 136 8 et seq.
- simultaneous actions 136 8 et seq.

- simultaneous and successive civil actions 136 1 et seq.
- successive actions 136 12 et seq.

Claim for damages

- licensing 25 27

Claim to compensation

EU collective marks 80 2

Claim to prohibition 130 3, 5 et seq.

Claiming priority 35 1 et seq. see also Priority

- copy of previous application 35 4 et seq.
- requirements 35 4 et seq.
- time limit for producing copy of previous application 35 5
- translation of previous application 35 9

Claims by individuals against EUIPO regarding refunding of fees 108 8 et seq

Claims for damages 17 2, 3

Classification 33 1 et seq.

- amendment of classification and addition of classes 33 7
- goods made from certain base materials 33 60 et seq.
- Guidelines for Examination of European Union Trade Marks 33 5
- imprecise service indications 33 65 et seq.
- machines 33 63 et seq.
- mandatory formal requirements for application

41 6

- new taxonomy 33 41 et seq. see also Taxonomy for classification
- Nice classification see there
- punctuation 33 9
- retail and wholesale services 33 69 et seq.
- use of adverbs 33 10

Coercive measures to enforce prohibition 130 14 et seq.

Coexistence

- Intervening rights 16 1, et seq., 13

Coexistence of trade marks on the market

distinctiveness 8 233 et seq. see also there
 Collective mark

- action for infringement 50 1 et seqq.
- amendment of regulations governing use of the mark 79 1 et seq.
- applicable provisions of EUTMR 74 29 et seq.
- capability of distinguishing goods or services 74 7 et seq.
- capability of distinguishing the goods and services of the mambers of the association 74 7
- claim to compensation 80 2
- collision with younger individual trade mark 74 31 et seq.
- content of regulation governing its use 75 3 et seq.
- conversion into national application 74 36
- deadline to submit regulation governing its use
 75.2
- determination in the application 74 6
- grounds for invalidity 82 1 et seq.
- grounds for revocation 81 1 et seq.
- inherent registrability 74 30
- nature 74 5

- nature of a collective mark 745
- no different standard 8 58
- observations by third parties 77 1
- persons entitled to bring action for infringement 80 1
- possible applicants 74 9 et seq.
- priority and seniority 74 35
- refusal of application 76 1 et seq.
- regulation governing its use 75 1 et seq.
- relationship to PGI/PDO 7 192
- use of marks 78 1 et seqq.

Colour mark

- colour composition 7 305, 313
- distinctiveness required 7 309
- importance 7 304
- public interest 7 309
- refusal of registration 7 311
- registrability 7 306, 314
- representation of the trade mark 31
- two or more colours 7 308

Colours 4

- formless and shapeless combination of two or more colours 4 41
- single colour 4 38

Combination of words 7 58

Commercial establishment

- proprietor of trade mark 5 5 et seq.

Commission Proposal (1980) 1 42 et seq.

Common name

- revocation 58 19 et seq.

Common Regulations on International Registration of trade mark 182 7 et seq.

Communications to EUIPO 2 11; 100 1 et seq.

- annexes 100 16 et seq.
- general purpose 100 2
- post or courier 100 14 et seq.
- scope 100 5
- telecopier communication 100 10 et seq.
- types of communication 100 6 et seq.
- user area 100 7 et seq.

Companies and legal entities

- jurisdiction of 'domicile courts' 125 8

Comparison of goods and services

- likelihood of confusion 8 56 et seq.

Comparison of signs

- conceptual comparison see there
- identity and similarity 9 87; 155
- phonetic comparison see there
- rule of interdependence see there
- visual comparison see there

Complementary fees for international application 184 18

Compound marks

- distinctive character 7 64 see also there

Compulsory enforcement measures

- registration 27 20

Concept of distinctiveness 4 12; 9 321

Concept of evocation 7 207 et seq.

Concept of functional continuity 66 6; 70 5, 9, 12; 71 2; 95 36

Conceptual comparison

- basic principle 8 144; 9 214

- semantic content of figurative elements 8 154;
 9 228
- semantic content of parts of words 8 151; 9 221
- semantic content of words 8 149; 9 215
- similarity of signs 8 144 et seq.

Conditions of Employment EUIPO 143 3 et seq.

Confidential documents

- inter partes proceedings 114 33
- restriction of access to files 114 25 et seq.
- special interest in confidentiality 114 25

Confidentiality

- oral proceedings 96 10

Confusion see Likelihood of confusion

Connectivity

- Application of Regulation 1215/2012 122 8, 11

Consumer of goods and services see also Identification of relevant consumer

- identification of relevant consumer 9 57 see also there
- relevant consumer 9 55

Consumer protection

- prohibition of use of EUTM 137 1 et seq.
- rights conferred by EUTM 9 24

Contact information EUIPO 2 17

Content of application

- date of filing see there
- information on applicant 31 8
- list of goods or services to be registered 31 12
- representation of the trade mark see there
- request for registration 31 6

Content of application for inspection of files 114 41 et seq.

Content of files 114 7 et seq.

- ceased applications and registrations 114 10

EUTM applications 114 7

IRs designating the EU 114 9

notes and guidelines 114 11

registered EUTMs 114 8 Continuation of proceedings 105 1 et seq.

- effect 105 17
- excluded time limits 105 14 et seq
- historical development 105 2 et seq
- omitted act 105 8
- other remedies 105 18
- procedure 105 10 et seq
- purpose 105 1
- requirements 105 4 et seq
- time limit 105 7

Contract staff at EUIPO 143 7

Conversion

- partial conversion 139 17 et seqq.

Conversion fee 202 15

Conversion in case of international registration 202 1 et seq.

- conversion fees 202 15
- conversion of direct EUTM 202 2
- conversion of international registration designating the EU 202 3 et seq.
- conversion procedure 202 8

Conversion into national trade mark application 139 1 et seqq.

- admittal of conversion 139 12 et seqq.

- admittal of conversion with respect to EUTM application 139 13 et seq.
- admittal of conversion with respect to registered EUTM or IR designating the EU 139 15 et seq.
- conversion proceedings see there
- conversion request see there
- effects of conversion 139 52 et segg.
- exclusion of conversion 139 20 et seqq. see also Exclusion of conversion
- formal requirements see Formal requirements for conversion
- partial conversion 139 17 et seqq.
- request for application of national procedures see there
- timelines for conversion request see there

Conversion proceedings 140 11 et seqq.; 141 9 et seqq.

- appeal proceedings 140 21
- deficiencies which can be remedied 140 16 et seqq.
- examination procedure 140 14 et seqq.
- object of examination 140 14
- other shortcomings 140 19 et seq.
- parties to proceedings 140 12 et seq.

Conversion proceedings at designated office 141 9 et seqq.

- proceedings at national office 141 9 et seqq.
- proceedings at WIPO 141 12 et seqq.
- regarding accession states 141 16

Conversion request see conversion into national trade mark application

- addressee 140 1
- conversion proceedings see there
- EUTM Bulletin 140 23
- EUTM Register 140 22- 1
- fee for conversion application 140 9
- identification of subject list of goods and services 140 8
- identification of target Member State 140 7
- indication of grounds 140 5
- language 140 6
- mandatory formal requirements 140 3 et seqq.
- publication 140 22 et seqq.
- submission to EUIPO 140 4
- transmission to designated office 140 25 et segg.

Cooling-off period 46 66 et seq.

- duration 46 66 et seq.
- expiry 46 73 et seq.
- extension 46 69 et seq.
- settlement after cooling-off period 46 78 et seq.
- settlement during cooling-off period 46 75et seq.
- suspension 46 81

Corrections of errors and manifest oversights 102 1 et seq.

- correction of decisions 102 3 et seq.
- correction of errors in registration 102 6

Correspondence language

- application for EUTM 146 11 et seq.

Costs before EUIPO 109 et sea.

- award of costs in inter partes proceedings see there
- decision on costs 109 39 et seq. see Decision on costs in proceedings before EUIPO
- evidence on costs 109 69 et seq.
- non-inter partes proceedings 109 36 et seq.

Costs essential to the proceedings 109 55

Costs of appeal before Court of Justice 72 223 et seqq.

- following a decision on the merits 72 224
- following other end of proceedings 72 227
- taxation of costs 72 228

Costs of appeal before General Court 72 141 et seqq.

- following a decision on the merits 72 142
- following other end of proceedings 72 152
- taxation of costs 72 156

Costs of representation 109 62 et seq., 70

- by more than one representative 109 67 et seq.

Costs of witnesses and experts 109 61

Costs to be compensated 109 53 et seq.

- costs essential to the proceedings 109 55
- costs of representation 109 62 et seq., 70
- costs of representation by more than one representative 109 67 et seq.
- costs of witnesses and experts 109 61
- historical development 109 53
- limits and caps of costs to be compensated 109
 56 et seq.
- parties not represented by a representative 109 58 et seq.
 - travel expenses of a representative 109 60

Counterclaim 18 9; 128 1 et seq.

- admissibility 128 7 et seq.
- Application of Regulation 1215/2012 122 15 et seq.
- effects of a decision 128 29 et seq.
- general 128 1 et seq.
- grounds for counterclaim 128 16 et seq.
- jurisdiction 128 4 et seq.
- legal nature 128 3
- nature of decision of EUIPO 128 12 et seq.
- notification of EUIPO 128 23 et seq.
- notification of proprietor of trade mark 128 21 et seq.
- permissibility 128 4 et seq.
- procedure 128 21 et seq.
- provisional and protective measures 131 21
- stay of proceedings 128 26 et seq.

Counterclaims for revocation of a declaration of invalidity 124 13

Court of Auditors 153 6; 176 4

Court of Justice

appeal see Appeal before the Court of Justice
 Court of Justice – decision

- appeal manifestly inadmissible or unfounded
 72
- consequences of judgment 72 220
- correction of errors in its judgment 72 222
- discontinuance of action 72 212
- judgment 72 215

Cross appeal before the Court of Justice 72 193 Database on the comparison of goods and services

- likelihood of confusion 8 61

Date of filing 32 43 1 et seq.

- allocation of filing date 43 2 et seq.
- effect 43 1
- receipt of application documents 32 3
- receipt of payment of the application fee 32 12 see also Application fee
- remedies of deficient filing documents 32 8
- right of priority 34 11 see also Priority

Debranding and co-branding 15 52

Deceptive trade mark

- enlargement 209 26
- non-deceptive use 7 156
- refusal of registration absolute grounds 7 154

Decision on costs in proceedings before EUIPO 109 10 et seq.

- appeal 109 82 et seq. see Appeal against decision on costs in proceedings before EUIPO award of costs 109 10
- costs to be compensated see there
- currency 109 42
- decision on substance 109 21 et seq.
- discretion of EUIPO 109 24
- enforcement 110 1 et seq. see Enforcement of decisions on costs
- exceptions to general principle 109 18 et seq.
- fees and costs to be compensated 109 51 et seq.
- general 109 39 et seq.
- general principle 109 16 et seq.
- information to bear own costs 109 29
- no fixing of costs 109 43
- reasons of equity 109 20, 23
- request for an award of costs 109 11 et seq.
- request on fixing the costs 109 45 et seq.
- restriction of application 109 18 et seq.
- review 109 72 et seq. see Review of decision on costs in proceedings before EUIPO
- settlement on costs 109 26 et seq.
- translation costs 109 30

Decisions in respect of appeals 71 2 et seq.

- BoA's decision-making process 71 15 et seq.
- competences 71 8 et seq.
- fee 71 19
- form and content 71 18
- remitting the case 71 12 et seq.
- suspensive effect 71 20

Decisions of EU trade mark courts

- recognition and enforcement of judgments 122 24 et seq.

Decisions subject to appeal 60 1 et seq., 9 et seq. suspensive effect 60 15

Declaration of division 56 3 et seq.

- content 56 6
- fee 56 7 et seq.
- form, language and filing 50 17 et seq.
- remedy of deficiencies 50 20 et seq.
- requirements 50 15 et seqq.

Declaration of invalidity see application for a declaration of invalidity

Declaration of surrender 57 6

- as to merits 127 1 et seq.
- counterclaim 124 13; 128 3, 5, 7 et seq., 26
- defence plea of applicant 47 3
- indicative use 14 20 et segg.
- legal defence 130 11
- limitation of effects 14 14 et seqq.
- national defence 47 34
- own name use see there
- plea of invalidity 127 5 et seq.
- referential use see there
- request for substitution of grounds 72

Defensive registration 47 33

Deficiencies 41 23 et seq.

- deficiency letter 41 24
- re class fees 41 27 - re date of filing 41 25
- re normative requirements 41 26

Delegated acts

power to adopt 208 3 et seq.

Delegation of powers 48 1 et seq.; 208 4 et seq. Delgated acts

- procedure to adopt 208 4, 6, 9

Deputy Executive Director of EUIPO 157 11 Descriptive indications

- assessment of descriptiveness 7 73 et seg.
- combination of words 7 85
- geographical name 7 79 et seq.
- misspelling 7 88 et seq.
- neologism 7 87
- non-exhaustive list 7 77

omission 7 88

- one-word mark 7 85
- referring to specific goods and services 7 70 et seq., 72, 74
- Refusal of registration absolute grounds 7 66 et sea.
- relevant public perception 7 71, 72
- sound-alikes 7 89
- symbols replacing letters 7 90

Designation of origin see Geographical indication Determination of goods and services

likelihood of confusion 8 66

Determination of need for representation

- representation 119

Dfeiciencies 41 23 et seq.

- deficiency letter 41 24
- re class fees 41 27
- re date of filing 41 25
- re normative requirements 41 26

Dictionary 12 1 et seqq. see Reproduction of EUTM in dictionaries

Dilution 9 284 et seqq., 351 see also Blurring

- denigration or discrediting use 14 55
- disclaimer in examination procedure 42 31 et
- refusal to register due to misleading character

Disclaimer

disclaimer in examination procedure 42 31 et seq.

Discontinuance of action 72

appeal before the Court of Justice 72

Discretion of EUIPO 95 23 et seq.

- exceptions and re-exceptions 95 27 et seq.
- functional continuity 95 36
- general rule 95 24 et seq.
- regarding award of costs 109 14

Dishonest use test 14 41 et seqq.

- assessment criteria 14 59 et seqq.
- cases of dishonest use 14 46 et seqq.
- comparative advertising 14 45
- deliberate attempt to avail oneself of another mark and to create confusion 14 57
- denigration or discrediting use 14 54 et seq.
- false impression of commercial connections 14
 49
- inapplicability of exception rule 14 62 et segg.
- objective test 14 66
- Paris Convention 14 44
- presentation of replica or imitation 14 56
- requirements and definitions 14 42 et seqq.
- taking unfair advantage of distinctive character or reputation 14 51 et seqq.

Distinctive character see also Distinctiveness

- abstract distinctiveness 7 43 et seq. see Distinctive character
- acquired distinctiveness 7 335 et seq. see there
- advertising slogans 7 249 et seq. see there
- compound marks 7 64 see also there
- decisiveness of overall impression 7 59 et seq.
- examination 7 56
- family of trade marks
- figurative mark 7 262 et seq. see there
- lack of distinctive character 7 52 et seq.
- minimum distinctiveness 7 55
- illimitum distinctiveness / 33
- referring to specific goods and services 7 54
- relevant public perception 7 54
- reputation
- shape marks 7 291 et seq.
- trade mark with reputation see there
- uniform criteria 7 57 et seq.

Distinctiveness

- assessment of distinctive character 8 175 et seq.
- coexistence of trade marks on the market 8 233 et seq.
- enhanced distinctiveness 8 186 et seq.
- likelihood of confusion 8 173 et seq.
- position mark see there
- relevant goods 8 201
- relevant point in time 8 200
- threshold for coexistence of trade marks 8 242
- weak distinctive character 8 103 et seq., 109

Distinctiveness of an element 9 114

- distinctive graphic elements as dominant 8 101 et seqq., 128; 9 122
- elements retaining independent distinctive role
 9 129 see there
- non-distinctive elements as dominant 9 125

- non-distinctive elements as negligible 9 116
- non-distinctive elements as non-negligible

Division of the application 50 1 et seqq.

- admissibility 56 3 et seq.
- date of recording and effect of the divisional application 50 25 et seqq.
- declaration of division 56 3 et seq. see there
- during opposition proceedings 50 10
- during other specific periods 50 11
- fee 50 24
- file date yet not granted 50 12
- inadmissibility 50 8 et seq.
- opposition period not over 50 13 et seq.

Divisional transfer 20

Documents related to exclusion or objection 114 20 et seq.

Documents relating to settlement negotiations 114 35 et seq.

Domicile

- jurisdiction of 'domicile courts' 125 6 et seq.
- proprietor of trade mark 5 5 et seq.
- representation 119

Dominant and negligible elements

- basic principles 9 94
- distinctive graphic elements as dominant 9 122
- distinctiveness of an element 9 114
- elements retaining independent distinctive role
 9 129 see there
- identity and similarity between signs 9 87
- non-distinctive elements as dominant 9 125
 non-distinctive elements as negligible 9 116
- position associated with other factors 9 104
- position of the element 9 104

Dominant character

- descriptive elements 8 107 m.E. 103
- independent distinctive role 8 110
- trade mark consisting of verbal and figurative elements 8 108

Double identity

- blurring in double identity cases 8
- definition 8 8
- identical goods or services 8 32 et seq.
- identical signs 8 26 et seq.
- infringement in double identity cases 9 283 et seqq., 378; 136 10
- refusal relative grounds 8 23 et seq.
- Relevant consumer 9 55requirements 8 23
- Double recovery 25 9, 35, 46, 50

Double transfer 27 10

Double transfer 27 10

Draft decisions and opinions

- restriction of access to files 114 23

Due cause defence 9 356

Due time

- no term set 95 22
- restrictions relating to submission outside due time 95 18 et seq.
- term set 95 21

Duration of registration 52 1 et seq. Duty of care 54 34; 104 45 et seq.

applicant or trade mark proprietor 104 48 et seq.

- clerical staff 104 56
- representative 104 53 et seq.
- restitutio in integrum 104 l et seq.

Earlier rights

prohibition of use of EUTM 137 9 et seq.; 138

Earlier trade mark

- definition 89, 14
- meaning of 'earlier' 8 19
- types of rights 8 15 et seq.

Economic connections 119 11 et seq.; 120 63, 68 Effects of an EUTM 17 1

Effects of EUTM

- exhaustion of the rights conferred by EUTM see there
- limitation see Limitation of effects of EUTM
- rights conferred by EUTM see there
- TM registered in the name of an agent or representative *see there*

Effects of lacking registration of transfer 20 25, 28, 26

Effects of surrender 57 11 et seq.

Elements retaining independent distinctive role

- condition of non-negligibility of the element 9
 138
- corrective subprinciple to the concept of dominant element 9 132
- expansion beyond identity of common elements
 9 147
- expansion beyond well-known marks and company names 9 135
- independent distinctive role 9 129

Emblems or escutcheons of public interest

- elements of a compound mark 7 181
- modifications of underlying emblem 7 179
- Olympic symbol 7 182
- Red Cross 7 182
- refusal of registration absolute grounds 7 178 et seq.

Empirical facts 97 18

Employee representation 119 11

Enforcement Directive 25

- claim for damages 25 46
- standing to sue 25 34

Enforcement of decisions on costs 110 1 et seq.

- competent authority 110 17
- declaration of enforceability 110 10 et seq.
- finality of decision requirement 110 8
- non-inter partes proceedings 110 2
- order for enforcement 110 11 et seq.
- settlement on costs 110 9
- suspension of enforcement 110 7, 19
- territorial scope 110 3
- translation of decision 110 16

Enforcement procedure see Levy of execution Enlargement

- automatic extension of EUTMs 209 5
- grandfathering clause 209 6 et seq.
- seniority 209 29 et seq.

Entering an appearance without contesting jurisdiction

- Jurisdiction of 'domicile courts' 125 19, 21

Entry of surrender in the register 57 13 eSearch Plus 112 1 et seq.

Establishment

- jurisdiction of 'domicile courts' 125 9 et seq.
- representation 119 8

Estoppel

universal succession 27 19

EU certification mark see Certification Mark EU collective marks see Collective mark EUIPO

- capacity to act before EUIPO 3 1 et seq.
- communication with EUIPO 211
- contact information 2 17
- EU agency 27
- legal capacity in the Member States 142 3
- legal personality 27; 1422
- legal personality of applicant 3 10 et seq.
- legal status 142 1 et seq.
- management see EUIPO management
- name, logo and seat 2 1 et seqq.
- parties without legal personality 3 10 et seq.
- production of evidence 3 8
- representation 142 4
- staff see Staff of EUIPO
- tasks 29

EUIPO Manual Concerning Examination of Classification of Goods and Services 33 5

EUIPO - management

- Deputy Executive Director(s) 157 11 see also
 'Deputy Executive Director of EUIPO
 - Executive Director 157 1 see also 'Executive

Director of EUIPO

list of professional representatives 2 13; 116 15;
 120 9; 157 3; 162 1, 5

management board 153 1 et seqq.

powers of Executive Director 157 5

European Insolvency Regulation 19 40; 24 2, 7

European Union Trade Mark Regulation (EUTMR)

- principle of autonomy 1 65 et seq.
- principle of co-existence 1 77 et seq.
- principle of unity 1 81 et seq.
- proposals for a revision 1
- registration principle 1 64; 6 1 et seq.
- study by the Max Planck Institute (2011) 1 55 et seq.
- territorial scope of protection 1 93 et seq.
- Trade Mark Directive 1 49 et seq.

EUTM

- definition 41,4
- obtaining 6 1 et seqq.
- persons who can be proprietor 5 1 et seq. see
 Proprietor of trade mark
- signs 4 5 see Signs of which an EUTM may consist

EUTM applications

inspection of files 114 7

EUTM as object of property

- application as object of property 3 35; 6 7, 9, 19, 23; 28
- compliance with national standards 18 1 et seq.
- insolvency proceedings see there

- joint proprietors 18 49 et seg.
- levy of execution see there
- licensing see there
- rights in rem see there
- scope of application of EUTMR 18 24 et seq.
- transfer of EUTM see there

EUTM Bulletin 116 1 et seqq., 2 et seq.

- conversion request 140 23
- correction of errors 116 5
- date of publication 116 3
- designated courts 123 6
- designation 123 3
- EUTM applications 116 7
- EUTM court 123 1 et seq.
- EUTM registrations 51 9; 116 8
- EUTM renewal 116 10
- form 116 2
- function 123 1
- IR designating the European Union 116 13
- jurisdiction prior to designation 123 5 et seq.
- language 116 4
- later entries 116 9
- recognition and enforcement of judgments 122
- request for conversion into national trade mark application 116 11
- restititio in integrum 116 12
- structure 116 6 et seq.

EUTM court - applicable law 129 1 et seq.

- general 129 1 et seq.
- national substantive law 129 8 et seq.
- rules of procedure see Rules of procedure before European Union trade mark court
- substantive law 129 5 et seg.

EUTM court - specific rules on related actions 132 1 et seg.

- counterclaims for revocation of for a declaration of invalidity 132 4, 9 et seq.
- general 132 1
- infringement actions 132 5
- related actions 132 3 et seq.
- stay of proceedings 132 13 et seq.

EUTM Register

- competence to administer 27 13
- conversion request 140 22
- forwarding details to national office 140 26
- function 20 28

EUy collective marks

grounds for revocation 81 1 et seq.

Evaluation and Review EUTMR 210 1 et seq. Examination as to absolute grounds for refusal 42 1 et seq.

- disclaimer see Disclaimer in examination proce-
- examination procedure see there
- rights of the applicant 42 34 et seq.

Examination of appeals 70 1 et seq.

- concept of functional continuity 70 5, 9
- defendant's right to raise new arguments 70 30
- nature of examination 70 3 et seq.
- new evidence before the BoA 70 36 et seq.

- oral hearing before the BoA 70 41 et seq.
- procedure before the BoA 70 1 et seq., 17 et
- Rules of Procedure 70 17 et sea.

Examination of applications for registration 41

- absolute grounds for refusal see Examination as to absolute grounds for refusal
- examination of the conditions of filing see there

Examination of opposition 18 5

- form and content of request for use 47 7 et seq.
- genuine use see there
- language of proceedings 47 18 et seq.
- means of evidence 47 15 et seq.
- reaction by EUIPO 47 10 et seq.
- request for proof of use by the applicant 47 3 et sea.
- scope 47 1 et seq.
- submission of proof of use by opponent 47 13
- time for request for use 47 5

Examination of the application 18 7; 64 1 et seq.

- actions by EUIPO 64 1 et seq.
- decision by EUIPO 64 20 et seq.
- non-use 64 19
- proof of use 64 14 et seq.
- relevant criteria 64 10 et seg.

Examination of the conditions of filing 41 1 et

- application requirements 41 3 et seq.
- consequences of deficiencies 41 23 et seq.
- mandatory formal requirements 41 6 et seq. see Mandatory formal requirements for application
- optional formal requirements 41 17 et seq. see Optional formal requirements
- payment of class fee 41 22
- priority and seniority 41 28 et seq.
- requirements for the date of filing 41 4

Examination procedure 42 3 et segg.

- acquired distinctiveness 42 21 et seq.
- dialogue with applicant 42 4 - evidence of use 42 24 et seq.
- general principles 42 3 et seq.
- irrelevance of earlier national registration 42 13
- irrelevant criteria see Irrelevant criteria in examination procedure
- objection letter 42 15
- objections on goods and services 42 11 et seq.
- reasoned objection 42 3
- timing of examination 42 18 et seq.
- timing of objection 42 20
- various grounds for refusal 42 14

Examiner 160

- responsibilities 160 1
- single examiner 160 7
- tasks 160 5
- 'one file, one examiner' 160 10

Exchange of publications 118 1 et seq.

- publication in paper form 118 2
- publications and data in electronic form 118 3

Excluded documents

- restriction of access to files 114 19 et seq.

Exclusion of conversion 139 20 et seqq.

- adverse effect for certain Member States 139 31 et seqq.
- declaratory effect for certain Member States 139 40 et seq.
- fragmented use in one Member State 139 28
- genuine use shown for individual Member State 139 27 et seqq.
- purpose 139 20
- qualitative and quantitative extent of genuine use 139 29
- request for application of national procedures 139 20 et seqq.
- revocation decision 139 23
- revocation on grounds of non-use 139 21
- sufficient evidence of use 139 30
- surrender of registered EUTM 139 24 et seqq., 38 et seq.
- withdrawal of EUTM application 139 34 et seqq.
- withdrawal or surrender of EUTM 139 33

Exclusion of examiners or members of BoA 161

- removal from office 163 11

Exclusive jurisdiction of EU trade mark courts 124 4 et seg.

Executive Director of EUIPO

- appointment 158 1
- disciplinary authority 158 3
- powers and duties of the Executive Director
 157 5
- term of office 158 4

Exhaustion of the rights conferred by EUTM 1 62; Annex I Art. 15 see also Exhaustion principle

Exhaustion principle 14 2, 37; 25

- advertising by resellers 15 59
- burden of proof 15 34
- claim subsequent to filing of an application 38
- consent of trade mark proprietor 15 19
- debranding and co-branding 15 51
- exhaustion of the rights conferred by EUTM 15
 1 et seqq.
- further commercialisation 15 39
- licensing 25 19, 24 et seq., 30
- marketing by trade mark proprietor 15 17
- officially recognised exhibition see there

Exhibition

- priority declaration 38 13

Exhibition priority

- put on the market 15 13
- reconditioning of goods 15 41
- refilling of re-usable branded containers 15 65
- removal of batch codes and product numbers
 15 54
- repackaging and relabelling 15 45
- requirements for claim 38 8
- territory 15 10
- time limit for claim 38 13

Expiration of EUTM registration 53 24 et seq.

- restitution in integrum 53 29 et seq.
- restoration 53 29 et seq.

Explorative evidence 97 20

Extensive protection

- link test see Link test
- types of injury see Extensive protection types of injury

Extensive protection - types of injury

- blurring see there
- tarnishment see there

Extent of jurisdiction of EU trade mark court 8 1 et seq.

- EU-wide jurisdiction 126 3 et seq.
- general 126 1
- limited jurisdiction 126 7 et seq.

External auditor 176 4

Fair competition

- balancing interest of trade mark proprietor and third parties 9 31, 270
- due cause 9 356
- general clause of fair competition 9 32
- justification of exclusive rights conferred by EUTM 9 24
- limitation of exclusive rights 9 18 et seqq.
- principle of co-existence 1 77 et seq.

Features and principles of EUTMR 1 64 et seq.

- principle of autonomy 1 65, 65 et seq. see also there
- principle of co-existence 1 77 et seq.
- principle of unity 1 81 see also there
- registration principle 1 64

Fee Calculation Sheet for international application 184 5

Fees see also Costs

- claims by individuals against EUIPO re refunding of fees 108 8 et seq
- inspection of files 114 46 et seq.

international fees 188 1

- international Registration of trade mark 182 2 et seqq.
- procedure before the EUIPO 108 2
- request for territorial extension 187 1 et segg.
- termination of obligation to pay fee 108 1 et seq.

Fees for international application 184 17 et seq.

- basic fee 184 18
- complementary fee 184 18
- Fee Calculation Sheet 184 6
- handling fee 184 17
- international fees 184 17
- online fee calculator 184 18
- supplementary fee 184 18

Figurative mark 4 25 et seqq.

- absolute grounds for refusal 7 258 et seq.
- banal figurative elements 7 272
- commonplace elements 7 266 et seq.
- definition 7 259
- descriptiveness 7 271
- geometric figures 7 265
- importance 7 258
- lack of originality 7 273
- pictograms 7 269
- referring to goods and services 7 261
- representation of the trade mark 31 26

- similarity of signs 8 128 et seq.
- typographical symbols 7 268

Filing an application 18 1 et seq.; 46 4 et seq.; 146 6 et seq.

- content of application see there
- e-filing 30 6
- filing by telecopier or telefax 30 11
- filing on paper 30 13
- filing via international registration 30 17
- filing via national office 30 16
- Guidelines of EUIPO 30 3
- language 46 18 et seq.
- need for classification see Classification
- notice of opposition 46 5
- opposition deadline 46 7
- opposition fee 46 8 et seq.
- right of priority 34 9 et seq.
- standing to oppose 46 11 et seq.

Filing of an international application 183 1 et

- basic mark 183 6 et seq.
- entitlement to file 183 2
- outgoing international applications 183 1 et
- task of EUIPO 183 1

Financial audit and control of EUIPO see Audit and control

Financial Regulation 173 1

Budget Committee 177 1 et seg.

Financial report by EUIPO 172 2

Form and contents of international application 184 4 et seqq.

- content 184 1 et segg.
- fees 184 1 et seqq. see also Fees for international application
- forwarding of requests to WIPO 184 20
- general 184 4 et segg.
- information required 184 4 et segg.
- language 184 15 et seq.
- notification of division of the basic mark 184
- official form 184 24

Form follows function re shape marks 7 104 Form of appeal 68 2 et seq.

- appeal fee 68 14 et seg.
- notice of appeal see there
- statement of grounds see there

Formal publicity

- register 27 3

Formal requirements for conversion 141 1 et

- application fee 141 5
- exception 141 4
- general principle 141 3
- indication of address for service 141 6
- proceedings at designated office 141 9 et seqq. see also Conversion proceedings at designated
- timeline to fulfil request 141 8
- translation requirement 141 7

Fragmented use in one Member State

- exclusion of conversion 139 28

Free movement of goods and services

- limitation of exclusive rights 1 39; 4 2; 9 26

Free transferability of EUTM

- divisional transfer 20 11
- general rule 20 9
- relevant test 20 10

Freedom of commerce

- limitation of exclusive rights 9 18 et segg.

Free-riding 14 51

Function theory

- limitation of exclusive rights 9 252 et seqq.
- relative grounds for refusal 8 7

Further appeal 133 1 et seq.

- appeal against decisions by European Union trade mark courts of first instance 133 3
- appeal against decisions by European Union trade mark courts of second instance 133 4
- general 133 1

General Court

- appeal see Appeal before the General Court
- decision 72 14
- judgment 72 122 see Judgment of the General Court

Generic name 12 1, 3, 6, 8

Genuine use 18 14 et seq.; 47 20 et seq.

- bad faith 18 45
- definition 47 20 et seq.
- extent of use 18 21 et seq.; 47 29
- justification of non-use 47 32 et seq.
- nature of use 47 30 et seq.
- place of use 47 26
- proof of use 18 39 et seq.
- proper reasons for non-use 18 44
- relevant period of non-use 18 14 et seq.
- standard of proof applied by EUIPO 47 22
- territory of use 18 16 et seq.
- time of use 47 27 et seq.
- use as a trade mark 18 28 et seq.
- use for registered purpose 18 34 et seq.
- 'defensive' registration 47 33

Genuine use (lack of)

- Intervening rights 16 8, 11

Genuine use shown for individual Member State

exclusion of conversion 139 27 et seqq.

Geographical indication see also Geographical indications for wines and spirits

- 'exception from the absolute ground for refusal
- in Art. 7 (1)(c) EUTMR 74 15 et seq.
- EU collective marks 74 15 et seq.
- exceptions for descriptive use 74 19
- protected geographical indications 7 Protected geographical indications
- protection on national level 74 27 et seq.
- registration with the European Commission 74 21 et seg.

Global assessment of similarity 8 202 et seq

- actual confusion 8 243
- length of sign 8 205
- method of purchase of goods 8 223 et seq.
- names and surnames 8 208 et seq.
- series marks 8 215
- specific marketing aspects 8 223 et seq.

Good faith see also Bad faith

- burden of proof 27 5
- consequences of revocation and invalidity 62 2 et sea.
- double transfer 27 16
- enlargement of the Union 8 17
- non-existence of licence 25 56
- presumption of good faith 59 33
- principle of legitimate expectation 107 8
- reliance of register 27 19
- restitution in integrum 104 19, 134, 137

Goods made from certain base materials

- classification 33 60 et seq.

Grand Board 70 18, 45 et seq.; 160 17; 165 4, 16 Grandfathering clause 209 6 et seq.

- enlargement of the Union 209 6 et seq.

Graphic elements offset by verbal elements 9 179 Grounds for exclusion of examiners or members of BoA 161 9; 163 11; 169 4

Grounds for revocation 18 6

Grounds of appeal

- appeal before the Court of Justice 72 169

Grounds of objection against examiners or members of BoA 169 7

Grounds of opposition 46 20 et seq.

- agent's mark 46 24
- earlier non-registered mark 46 25
- earlier signs used in the course of trade 46 26
- earlier trade mark registration or application
 46.21
- earlier trade mark registration or application with a reputation 46 22
- earlier well-known trade mark 46 23

Grounds to revoke EU collective mark 81 1 et

seq.

- amendment of regulations governing use of the mark 81 5
- failure to take reasonable steps against uses contrary to regulation 81 2 et seq.
- specific risk of deception 81 4

Guideline by WIPO as to international registration of trade mark 182 7 et seq.

Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs), Part C – opposition procedure 8 10

Gustatory mark

refusal of registration – absolute grounds 7 332
 Handling fee for international application 184

17

Hearing witnesses 97 53

Hologram 4 33

- refusal of registration 7 334

Identical goods or services 8 32 et seq.

Identical prefix 9 170

Identical signs 8 26 et seq.

Identical suffix 9 173

Identical word 9 160

Identification of relevant consumer see also Consumer of goods and services

- by territory or culture 9 71
- general principle 9 60

- specific sector 9 63

Identifying use defence 14 32

Identity and similarity between signs

- basic principles 9 73
- comparison of signs see there
- dominant and negligible elements 9 94 see
- overall impression of signs 9 94
- principle of interdependence 9 237

Implementation of procedures 159

- Administration of Trade Marks and Legal Division see there
- Boards of Appeal see there
- Cancellation Division see there
- competence to implement procedures 159 5
- examiners see there
- Opposition Divisions see there

Imprecise service indications

- classification 33 65 et seq.

Independent distinctive role 8 110 et seq.

Indicative use defence 14 20 et seqq.

descriptive use 14 25 et seqq.

- descriptive use 14 23 et seqq.

- indication of characteristics 14 22 et seqq.

Individual and protective provisional measures 131 7 et seq.

Infringement 17 2, 3

Infringement actions 124 7 et seq.

 civil actions on basis of more than one trade mark 136 8 et seq.

Infringement test

- factual assessment 9 34
- identity 9 73, 87
- identity and similarity between signs 9 87 see

identity, similarity and proximity between

goods and services 9 73

- international classification 9 80
- Nice Classification 9 80
- normative standards see Normative standards of EUTM infringement
- points of fact 9 34
- proximity 9 73, 344
- relevant consumer of goods and services 9 55 see Consumer of goods and services
- relevant goods and services 9 73
- similarity 9 73, 87
- trade mark with reputation 9 253, 341 see also there
- use of EUTM by third party 9 see Use of EUTM

Injunction claim 8 7

- before EUTM court 8 7

Injunctive relief 124 9

Insolvency proceedings 24 6

- European Insolvency Regulation 24 2, 7
- joint proprietors 24 13
- registration of insolvency procedure 24 14

Inspection of files 114 1 et seq.

- administrative cooperation 117 6
- application for inspection of files 114 40 et seq.
- content of application for inspection 114 41 et seq.

- content of files see there
- exchange of information 117 2 et seq.
- fees for inspection of files 114 46 et seq.
- general 114 l et seq.
- keeping of files 115 1 et seq.
- language of application for inspection 114 43 et seq.
- location of inspection 114 53
- means of inspection 114 50 et seq.
- online access to files 114 37 et seq.
- restriction of access see Restriction of access to files
- taking copies of file documents 114 52

Interim measures

- proceedings before the General Court 72 120
 Internal auditor
- appointment and accountability 174 1
- responsibilities 174 3

International classification see also Nice classification

- smells 4 45

International fees 188 1

- fees for international application 184 18
- International jurisdiction 125 1 et seq.
- general 125 1 et seq.
- jurisdiction of 'domicile courts' see there
- provisional and protective measures 131 12

International registration designating the EU

- conversion of direct EUTM 202 2
- conversion of international registration designating the EU 202 3 et seq.
- effect 190 1, 5 see also Effects of international registration designating the EU
- effects of first republication 190 6
- examination as to absolute grounds for refusal see there
- fees related to conversion 202 15
- indication of second language 190 2 et seqq.
- invalidation of the effects 198 1 et seq.
- opposition see Opposition related to international registration
- procedure of conversion 202 8
- publication see Publication of international registration
- replacement of EUTM 197 1 et seqq.
- search related to international registration designating the EU see there
- seniority claim see there
- time limit related to conversion 202 12
- transformation **204** 1 et seqq. see also Request for transformation
- use 203 1 et seq.

International Registration of trade mark

- 7 et seq. common regulations, administrative instructions etc. 145
- Administrative Instructions 182 19
- filing of an international application see there
- form and contents of international application see there
- general 182 2
- guideline by WIPO 182 7 et seq.
- international fees 188 1

- Madrid Agreement 182 3 et seq.
- Madrid Protocol 182 5 et seq.
- Madrid system 182 2 et seqq.
- recordal in the files and in the register 185 2 et seq.
- request for territorial extension see there
- Schedule of Fees 182 7 et seq.

Intervener

- appeal before the Court of Justice 72 168
- costs 72 146, 160
- cross claims 72 110
- intervention before Court of Justice 72 168
- qualified intervener 72 27
- representation 72 97
- right to appeal 72 164
- right to request language 72 200

Intervening right of the proprietor of a later registered trade mark

- Acquisition 16 1 et seq.
- As a consequence of acquiescence 16 8, 11
- Coexistence 16 13
- Express consent 16 6
- Lack of genuine use 16 8, 11
- Later acquired distinctiveness 16 10, 11
- Later EU trade mark 16 4 et seq.
- Later national trade mark 16 11 et seq.
- No relative grounds for invalidity 16 5, 11
- Previous application or counterclaim for invalidity 16 7

Intervening rights 16 1 et seq.

Invalidity of EU collective mark 82 1 et seq. Invalidity of EUTM

- absolute grounds see Absolute grounds for invalidity
- application for a declaration of invalidity see there
- consequences 62 2 et seq.
- limitation in consequence of acquiescence see also Acquiescence
- relative grounds see Relative grounds for invalidity
- retroactive effect 62 4 et seq.

Invalidity or revocation of EUTM

- seniority of national trade mark 39 23 et seq.

Investment function of trade mark 9 268

Invoking several rights of priority 34 22 et seq. IR designating the European Union

- EUTM Bulletin **116** 13

Irrelevant criteria in examination procedure 42 6 et seq.

- double meaning 42 10
- factual monopoly 42 9
- need to keep free 42 8
- term not used 42 7

IRs designating the EU

- inspection of files 114 9

Joined cases

- proceedings before the General Court 72

Joint proprietors 18 49 et seq.

Judgment by default 72 140

Judgment of the General Court

- alteration of the BoA's decision 72 126

- annulment of the BoA's decision 72 124
- appeal manifestly inadmissible or unfounded 72 133
- consequences 72 131
- discontinuance of action 72 136
- formal requirements 72 130
- judgment by default 72 140
- reformatio in pejus 72 129
- rejection of appeal 72 123

Jurisdiction of EU trade mark court 124 1 et seq.

- action for declaration of non-infringement 124 10 et seq.
- action for reasonable compensation 124 12
- actions and counterclaims 124 4
- ancillary claims 124 9
- counterclaims for revocation of for a declaration of invalidity 124 13
- exclusive jurisdiction 124 4 et seq.
- general 124 1 et seq.
- infringement actions 124 7 et seq.
- injunctive relief 124 9
- proceedings on the merits 124 1
- provisional and protective measures 124 2

Jurisdiction of national courts other than EU trade mark courts 134 1 et seq.

- general 134 l et seq.
- obligation to treat trade mark as valid 127 3
- other disputes concerning EUTM 134 3 et seq.
- subsidiary international jurisdiction of Spanish courts 134 6

Jurisdiction of 'domicile courts' 125 5 et seq.

- action for a (negative) declaratory judgment
 125 17 et seq.
- companies and legal entities 125 8
- domicile 125 6 et seq.
- entering an appearance without contesting jurisdiction 125 19, 24
- establishment 125 9 et seq.
- natural persons 125 7
- place where infringement was committed 125
 13 et seq.
- prorogation 125 19, 20 et seq.
- seat of EUIPO 125 11

Jurisdiction ratio materiae

provisional and protective measures 131 11
 Jurisdiction regarding counterclaim 128 4 et seq.
 Justification of exclusive rights conferred by

- balancing interest of trade mark proprietor and third parties 9 31, 270
- consumer protection 9 24
- fair competition 9 26

Lack of due course 8

Lack of non-negligible graphics 9 188

Language of appeal proceedings 146 56 et seq. Language of application for EUTM 146 1 et seq.

- appeal proceedings 146 56 et seq.
- application for revocation or invalidity 146 35
- cancellation proceedings 146 35 et seq.
- choice of language by agreement between the parties 146 52 et seq.

- consequences of deficiencies 146 16 et seq., 28 et seq., 41 et seq.
- correspondence language 146 11 et seq.
- filing EUTM application 146 6 et seq.
- general 146 1
- history 146 2
- language of inter partes proceedings 146 19 et seq.
- language of opposition proceedings 146 19 et seq.
- language of proceedings for the examination of application 146 11 et seq.
- language of supporting documents 146 14 et seq., 25 et seq., 37 et seq.
- language regime 146 3
- languages of EUIPO 146 4 et seq.
- oral proceedings 146 61 et seq.
- translation requirements 146 46 et seq.

Language of application for inspection of files 114 43 et seq.

Language of inter partes proceedings

- appeal before the General Court 72
- application for EUTM 146 19 et seq.

Language of opposition proceedings

- application for EUTM 146 19 et seq.

Language of proceedings for the examination of application

- application for EUTM 146 11 et seq.

Language of proceedings in ex partes appeal cases before the General Court 72 101

Language of supporting documents

application for EUTM 146 14 et seq., 25 et seq., 37 et seq.

Languages of EUIPO

application for EUTM 146 4 et seq.

Legal aid 72

- appeal before the Court of Justice 72 230

Legal personality of applicant 3 10 et seq.

Legal successor in appeal cases before the General Court 72 33

Legal transfer of rights in appeal cases before the General Court 72 36

Levy of execution 23

- admissibility 23 4
- enforcement procedure 23 8
- free transferability 23 1
- jurisdiction of courts 23 2, 8
- registration of enforcement procedure 23 10
- relevant test 23 5

Licensing 25

- autonomous concept 25 8
- claim for damages 25 46
- delineation between contractual and trade mark infringement 25 24
- double recovery 25 35
- Enforcement Directive 25 35
- framework of EUTM licences 25 3
- licence contracts 25 12
- practical relevance 25 1
- registration of licences 25 53
- right to licence 25 17
- standing to sue 25 34

Likelihood of confusion 8 40 et sea.

- aesthetic complementarity 8 81
- comparison of goods and services 8 56 et seq.
- comparison of signs 8 97 et seq. see Similarity of signs
- considering the relevant market 8 78
- criteria 8 45 et seq.
- database on the comparison of goods and services 8 61
- degree of similarity needed 8 75
- determination of goods and services 8 68 et
- distinctiveness 8 173 et seq. see also Distinc-
- dominant character 8 106 et seq. see also Dominant character
- global assessment and appreciation 8 203 et seq. see also Global assessment of similarity
- high similarity of goods offset by weak similarity of signs 9 297
- high similarity of signs offset by weak similarity of goods 9 306
- infringement in form of likelihood of confusion
- interpretation 8 43
- likelihood of association 8 44
- likelihood of licensing 8 80
- Nice Classification and class headings 8 59 et
- relevant approach of EUIPO 8 54 et seq.
- relevant facts and law 8 50
- relevant point of time 8 52
- relevant public and degree of attention 8 89 et
- relevant territory 8 48 et seg.
- role of distinctiveness 9 311
- role of family of earlier marks 9 307
- role of relevant consumer 9 333
- rule of interdependence 9 297
- similarity factors 8 72 et seq., 85 et seq.
- weak similarity of goods offset by high similarity of signs 9 302
- weak similarity of signs offset by high similarity of goods 9 300

Limitation of effects of EUTM 14 1 et seqq.

- defences 14 14 et segg.
- dishonest use test 14 41 see there
- indicative use defence 14 20 see there
- legal concept 14 1 et seqq.
- own name use defence 14 16 see there
- preconditions 14 10 et seqq.
- public interest rule 14 4
- referential use defence 14 31 see there
- relevance for other provisions 14 6 et segg.

Limitation of exclusive rights

- earlier rights 9 19
- fair competition 9 22
- free movement of goods and services 9 21
- freedom of commerce 9 21
- function theory 9 23
- non-commercial activity 9 20

List of professional representatives 120 9

- Administration of Trade Marks and Legal Division 159 14; 162 12; 166 14
- Executive Director of EUIPO 157 3
- Official Journal 116 15

Local staff at EUIPO 143 8

Location of inspection of files 114 53

Machines classification 33 63

Madrid Agreement 1 24 et seqq.; 182 3 et seq. Madrid Protocol

- accession of EU 1 24 et seg.
- divisional application 50 5
- duration of registration 52 2 et seq.
- general principles of representation 119 8
- request for application of national procedures
- withdrawal, restitution and amendment of the application 50 5
- 'earlier trade mark' 8 15

Madrid system 182 2 et segq.

Management Board

- chairmanship 157
- chairperson 155 1 et seqq.
- composition 156 see also Management Board composition
- creation and powers see Management Board creation and powers
- election and composition 154 1
- meetings see Management Board meetings
- observers 154 6 secretariat 156 5

Management Board - creation and powers

- adoption of reserve lists 153 4; 166 6
- advisory power 153 4
- EUIPO Guidelines 153 4
- general 153
- power to request information 153 11
- power to veto or block 153 11
- powers 153 4 et seq.
- Management Board meetings 156
- meeting at request of the Commission 156 2
- notice of convocation 156 1
- participation of EUIPO 156 5
- participation of observers 156 7
- voting 156 10

Mandatory formal requirements for application

- classification 41 12
- entitlement 41 6
- language 41 9
- list of goods and services 41 12
- name and address of applicant 41 7
- name and address of representative 41 8
- representation of the mark 41 13
- signature 41 10

Matters in dispute in appeal cases before the General Court 72 40

Means of inspection of files 114 50 et seq.

Means of notification by EUIPO

- deposit in post box 98 27
- electronic communication 98 14 et seq.
- hand delivery 98 27
- postal service 98 22 et seq.

- public notification 98 27
- telecopier communication 98 20 et seq.

Means of taking evidence before EUIPO 97 38 et

- hearing the parties 97 41 et seq.
- hearing witnesses 97 55 et seq.
- opinion by experts 97 52 et seq.
- production of documents and items of evidence 97 46 et seq.
- request for information 97 43 et seq.
- sworn or affirmed statement in writing 97 58 et

Mediation before the BoA 165

Memorandum on the Creation of a European Trade Mark 1 33 et seq.

Misspelling 7 88 et seq.

Movement sign

- refusal of registration - absolute grounds 7 333

Music sign 7 316 et seq.

National courts 12 13

National experts at EUIPO 143 10

National law 17 1, 3

Nationality of proprietor of trade mark 5 7 Natural persons in jurisdiction of 'domicile courts' 125 7

Negative contents of rights conferred by EUTM

Negative publicity of register 19 43; 27 1 Neologism 7 87

Nice Classification 8 59 et seq. see also International classification

- Convergence Programme 33 33 et seq.
- filing an application 33 14 et seq.
- goods or services 31
- infringement test 9 80
- likelihood of confusion 8 59 et seq.
- Nice classification and class headings 8 59 et seq.; 33 14 et seq.
- non-exhaustive class headings 33 16 et seq.
- 'means-what-it-says' approach 33 19

Nice Classification and class headings 8 59 Non-registered and used-earlier rights

- acquisition of right prior to EUTM 8 315
- corporate names 8 297
- domain names 8 298
- geographical indications 8 326 et seq.
- kinds of signs 8 290 et seq.
- more than mere local significance 8 304 et seq.
- non-registered trade mark 8 291 et seq.
- other business identifiers 8 294
- passing-off 8 301 et seq.
- principle of coexistence 8 281
- principle of equivalence 8 280
- rights arising from signs relied of 8 316
- signs used in the course of trade 8 287 et seq.
- titles 8 300
- trade names 8 295

Non-registrability in part of the Union

- conversion into national trade mark application
- definition of 'part of the Union' 7 39

- uniform effect of EUTM 7 32
- 'all-or-nothing'-rule 7 33

Normative standards of EUTM infringement 9

- double identity case 9 283
- likelihood of confusion see there
- trade mark function theory see there
- use affecting trade mark function 9 258

Notes and guidelines

- inspection of files 114 11

Notice of appeal

- content 68 5 et seq.
- language 68 6
- role of registrar 68 35

Notice of renewal 53 2 et seq.

Notification by EUIPO 98 1 et seq.

- general purpose 98 2
- irregularities 98 28 et seq.
- meaning 98 7 et seq.
- means of notification 98 11, 14 et seq. see Means of notification by EUIPO
- scope 98 6
- types of notification 98 11 et seq.

Notification of loss of rights 99 1 et seq.

Observations by third parties 45 1 et seq.

- enclosure of supporting evidence 45 10
- grounds of observation 45 15
- language of the observation 45 6 et seq.
- legal consequences 45 16 et seq.
- observations occurring in a notice of opposition 45 8 et seq.
 - standing to submit observations 45 4
- submission of the observation 45 5 et seq.
- timing 45 11 et seq.

Official Journal 116 1, 14 et seq.

publication of equivalent right of priority 34 30

relevant public holidays 72

Officially recognised exhibition 38 3 et seq.

- definition 38 4
- notification by EUIPO 38 6

OLAF 175 2 et segg.

Olfactory mark

- refusal of registration 7 322
- registrability 7 322
- representation of the trade mark 31
- requirements 7 322 One-word mark 7 85

Online access to files 114 37 et seq.

Online fee calculator

- fees for international application 184 18

Opinion by experts 97 55 et seq.

Opposition 46 1 et seq.

- admissibility see Admissibility of opposition
- amended applications 46 27
- change of parties see Change of parties in opposition proceedings
- cooling-off period see there
- Division see there
- examination see Examination of opposition
- filing an opposition see there
- grounds of opposition see there

- international registration see International registration designating the EU
- multiple opponents 46 82
- multiple oppositions 46 96 et seq.
- procedure see Opposition procedure
- substantiation of the opposition 46 100

Opposition and infringement proceedings

- seniority of national trade mark 39 20 et seq.
- use of EUTM 18 61 et seq.

Opposition Divisions 161

- composition 161 5
- decision by single member of the 161 10
- exclusion of examiners 161 9
- responsibilities 161 1

Opposition procedure 8 4 et seq.

- absolute grounds of refusal 8 22
- deadline 8 13
- entitled to file 8 11
- Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs), Part C – Opposition 8 10
- International registration designating the European Union 8 10
- Restriction of access to confidential documents 114 34
- target 8 12
- trade mark application 8 12

Opposition related to international registration 46 117 et seq.; 196 1

- Confirmation of Total Provisional Refusal 196
- decision on the opposition 196 16 et seq.
- equality of treatment 196 2
- fees 196 18 et seq.
- general 1961
- language 1967 A H H H
- opposition period 196 4 et seq.
- procedure 196 3 et seqq.
- professional representation 196 6
- provisional refusal 196 14
- Statement of Grant of Protection Following a Provisional Refusal 196 17
- suspension of proceedings 196 15

Opting back

request for application of national procedures
 139 9

Optional formal requirements 41 17 et seq.

- description of the mark 41 18
- disclaimer 41 21
- information about means of communication 41
 20
- signed authorization of representative 41 19

Oral hearing before the BoA 68 28; 70 41 et seq. Oral proceedings

- language 146 61 et seq.
- proceedings before the General Court 72

Oral proceedings before EUIPO 96 1 et seq.

- confidentiality 96 10
- costs 96 16 et seq.
- decision 96 15
- discretionary 96 5
- general purpose 96 2

- language 96 13
- minutes 96 14
- public session **96** 10
- summons 96 11 et seq.

Order for information in provisional and protective measures 131 10

Order for performance in provisional and protective measures 131 6

Ordering seizure or surrender of goods in provisional and protective measures 131 8

Overriding legitimate interest

 Restriction of access to confidential documents 114 30 et seq.

Own name use defence 14 16 et seqq.

- functioning as name or address 14 to be deleted
- own address definition 14 19
- own name definition 14 17 et seq.

Owner of EUTM 68 et seq.

- agency mark 6 9

Partial conversion

 request for application of national procedures 139 17 et seqq.

Pattern mark

- definition 7 278
- refusal of registration 7 278

Periodical publications 116 1 et seq.

- EUTM Bulletin see there
- Official Journal 116 14 et seq.

Permissibility of plea for counterclaim 128 4 et

Person entitled to appeal or to be parties to appeal proceedings 67 2 et seq.

- cross appeals 67 23 et seq.
- joinder of appeal proceedings 67 22 et seq.
 - other parties as of right 67 20
- person who can invoke priority 34 7 et seq.
- persons entitled to appeal 67 2 et seq.
- requirement to be adversely affected 67 10 et seq.
- requirement to be party to the first-instance proceedings 67 6 et seq.

Phonetic comparison

- basic principle 8 131; 9 203
- initial syllable 9 205
- inversion of syllables 9 206
- mathematical signs 9 211
- pronunciation 9 208

Place of jurisdiction for a joinder of defendants 122 8 et seq.

- anchor claim 122 10
- ancillary claims 122 14
- cease-and-desist claim 122 13
- connectivity **122** 8, 11

Place where infringement was committed

jurisdiction of 'domicile courts' 125 13 et seq.
 Plea relating to revocation or invalidity 127 4 et

- admissibility 127 5
- provisional and protective measures 131 20
- restricted plea 127 6 et seq.

Position mark

- definition 7 279
- distinctiveness 7 282
- refusal of registration 7 282
- requirements 7 281

Preparation of budget 173 3

Preserving evidence

provisional and protective measures 131 9

President of EUIPO 1 58 see Executive Director of

President of the BoA 165 8

Presumption of validity 18 8; 127 1 et seq.

- general 127 1 et seq.
- plea relating to revocation or invalidity see there

Principal place of business

- proprietor of trade mark 5 5 et seq.
- representation 119 11

Principle of autonomy 17 1, 3, 4

Principle of equal treatment 8 246

- likelihood of confusion 8 43
- opposition related to international registration
- procedure before the EUIPO 107 6
- refusal of registration absolute grounds 7 31

Principle of equivalence 8 278

- free transferability 19 1; 20 1
- honest concurrent usage 14 47

Principle of morality 7 35

- examiner's judgement 7 146
- signs contrary to morality 7 144

Principle of priority see also Priority

- absolute grounds for refusal 7 22, 199
- earlier trade mark 8 255
- exceptions 8 250 et seq.
- trade mark filed by agent 8 250 et seq.
- uniform effect of EUTM 7 32 et seq.

Principle of unity 1 82 et seq.

- equal effect throughout the Union 1 88 et seq.
- limitations and exceptions 1 91 et seq.
- territorial scope 1 90
- unitary character of EUTMs 1 82 et seq.; 7 343;

Principle of 'reasonable period of time' in procedures before the EUIPO 107 9

Principles of

- autonomy 1 65 et seq.
- coexistence 1 77 et seq.; 8 281
- equal treatment see Principle of equal treatment
- equality 5 8; 8 43
- equivalence see Principle of equivalence
- legal certainty 107 7
- legitimate expectation 107 8
- morality see Principle of morality
- priority see Principle of priority
- private autonomy 19 9, 30, 31 et seqq.
- public policy 7 142 et seq.
- representation 3 4
- sound administration 7 31; 8 246
- speciality 9 284
- territoriality 1 93 et seq.; 15 10; 19 26, 26
- uniform application 8 43

- Union Priority 34 4
- Unity see Principle of unity

Priority 34 1 et seq. see also Right of priority

- claiming priority see there
- claiming seniority of national trade mark 39 1 et seq. see Seniority of national trade mark
- conversion 202 6
- date of filing 32
- effect 36 1 et seq.
- enlargement 209 13 et seq., 25 et seq.
- equivalence with national filing 37 2
- exhibition priority see there
- language of priority documents 146 15
- Madrid Protocol 182 5
- persons entitled to provoke priority 34 7 et seq.
- publication and entry in the Register 147 3
- request for application of national procedure 139 5 et seq.
- right of priority see there
- standard of evidence and burden of proof 97
- transformation 204 1, 5 et seq., 9
- unitary character of EUTM 37 1

- Privileges and immunities 144 1 et seq.
- contractual liability of EUIPO 145 2
- EUIPO's archives 144 4
- general 144 1
- jurisdiction regarding contractual liability of EUIPO 145 3
- jurisdiction regarding non-contractual liability of EUIPO 145 10
 - liability of EUIPO 145 1 et seq.
 - non-contractual liability of EUIPO 145 4 et
 - privileges and immunities of EUIPO 144 3 et seq. see also Privileges and immunities of EUIPO staff
- privileges and immunities of third parties 144
- vicarious liability 145 9

Privileges and immunities of EUIPO staff

- liability 144 9
- relocation and residence 144 10
- taxation 144 11

Procedural law 175

Procedure before EUIPO

- claims by individuals against EUIPO regarding refunding of fees 108 8 et seq
- continuation of proceedings 105 1 et seq. see
- Costs see Costs before EUIPO
- discretion of EUIPO 95 23 et seq. see also there
- disputes as to fees 108 4
- ex partes proceedings 95 4
- examination ex officio 95 1, 5 et seq.
- examination of facts by EUIPO 95 1 et seq.
- exchange of publications see there
- fees 108 2
- inspection of files see there
- notification 98 1 et seq. see Notification by **EUIPO**

- oral proceedings 96 1 et seq. see Oral proceedings before EUIPO
- periodical publications see there
- principle of equal treatment 107 6
- principle of legal certainty 107 7
- principle of legitimate expectation 107 8
- principle of 'reasonable period of time' 107 9
- procedural principles generally recognised in the EU 107 4
- Register of EUTM 111 1 et seq. see there
- representation see there
- restitutio in integrum see there
- restrictions in inter partes proceedings 95 4, 9 et sea.
- restrictions relating to relief sought 95 14 et seg.
- restrictions relating to submission outside due time 95 18 et seg. see also Due time
- revocation of a decision 103 1 et seq. see also Revocation of a decision by EUIPO
- right to be heard 107 10 et seq
- statement of reasons on which EUIPO's decisions are based see there
- taking of evidence 97 1 et seq. see also Taking of evidence before EUIPO
- termination of obligation to pay fees 108 1 et seq.

Procedure regarding counterclaim 128 21 et seq. Proceedings before the Court of Justice 72 201 Proceedings before the General Court 72 105

- interim measures 72 120
- joined cases 72 118
- oral proceedings 72 112
- written proceedings 72 106

Proceedings on the merits 124 1

Production of documents and items of evidence 97 46 et seq.

Production of evidence before EUIPO 3 8 Professional employees

- representation 119 1 et segg.

Professional representation 120

- general 120 1
- general representation 120 9
- place of business 120 5
- professional representation other than legal practitioner see there
- qualified legal practitioner 120 4
- removal from list 120 19
- to the extent entitled to act as representative in trade mark matters 120 8

Professional representation other than legal practitioners

- duration of service 120 10
- professional qualifications 120 12

Prohibition of use of EUTM 137

- acquiescence 137 25; 138 7
- prior rights applicable to particular localities
 138
- prohibition to use 137 28
- trade marks 137 12
- unregistered trade marks and other signs 137
 13

Prohibitory order in provisional and protective measures 131 7 et seq.

Property see EUTM as object of property

Proprietor of trade mark 5 1 et seq.

- commercial establishment 5 5 et seq.domicile 5 5 et seq.
- Member State of Paris Convention or WTO 5 8
- nationality 5 7
- need for representation 5 5
- principle place of business 5 5 et seq.

Prorogation in jurisdiction of 'domicile courts' 125 19, 20 et seq.

Protected designations of origin 7 Protected geographical indications

Protected geographical indications 7 188 et seq.

- historical background 7 193
- Reg. (EU) 1151/2012 7 211 et seq.
- Reg. (EU) 1308/2013, (EU) 251/2014 and (EC)110/2008 7 199 et seq.

Provisional and protective measures 124 2; 131 1 et seq., 3 et seq., 7

- counterclaim 131 21
- definition 131 4
- disputes concerning the infringement of a EU trade mark 131 2
- general 131 1
- individual provisional measures 131 7 et seq.
- international jurisdiction 131 12
- jurisdiction ratio materiae 131 11
- order for information 131 10order for performance 131 6
- ordering seizure or surrender of goods 131 8
- plea relating to revocation or invalidity 131 20
- preserving evidence 131 9
- procedure for recognition and enforcement
 131 24 et seq.
- prohibitory order 131 7 et seq.
- protective measure 131 7
- recovery of damages 131 8
- scope of jurisdiction 131 19

Provisional refusal if opposition related to international registration 196 14

Public perception 7 15

Publication and entries in the EUTM Register 147 1 et seq., 2

- authoritative language in doubtful cases 147 12 et seq.
- content 147 3
- conversion request 140 22 et seqq.
- corrections of errors in translation 147 5 et seq.
- entries in the EUTM Register 147 7 et seq.
- entries relating to changes regarding mark 147
 11
- entries relating to trade mark 147 10
- European Union Trade Mark Bulletin 147 4
- general 147 1
- language of publication 147 2

Publication of international registration 190 1

- effects of first republication 190 6
- first republication 190 6
- formalities examination by EUIPO 190 3
- general 190 1

- procedure following first republication 190 6
- second republication 190 7 et seqq.

Publication of the application 44 1

Punctuation in classification 33 9

Qualified intervener in appeal cases before the General Court 72

Qualitative and quantitative extent of genuine

- exclusion of conversion 139 29

Reconditioning of goods 15 41

Recordal of transfers 20 25

Recovery of damages in provisional and protective measures 131 8

Reference work 12 1, 3, 5-8, 10

Referential use defence 14 31 et seqq.

- inapplicability 14 40
- indication of the intended purpose 14 34 et seqq. See also Identifying use defence
- necessity of the indicative reference 14 39
- preconditions 14 34 et seqq.
- spare parts and servicing business 14 35 et segg.
- types of indicative reference 14 38

Refilling of re-usable branded containers 15 65 Reformatio in pejus 72 129

Refusal of application for EU collective mark 76

- cure of non-compliance regarding Regulation
- public liable to be misled 76 4

Refusal of registration 7 1 et seq.

- absolute grounds see Refusal of registration absolute grounds
- non-registrability in part of the Union see there
- reform proposals see there
- 'all-or-nothing'-rule 7 33

Refusal of registration - absolute grounds

- agricultural products and foodstuffs 7 211
- armorial bearings, flags and other State emblems see there
- colour mark see there
- customary indications 7 93 et seq.
- deceptive trade mark 7 154 et seq.
- descriptive indications see there
- effect of national decisions 7 29 et seq.
- emblems or escutcheons of public interest 7 178 et seq.
- examination ex officio 7 24 et seq.
- examination stringent and full 7 26, 68
- exhaustive enumeration 7 9 et seq.
- figurative mark see there
- geographical indications for wines and spirits see there
- olfactory mark see there
- pattern mark see there
- position mark see there
- principle of equal treatment 7 31
- principle of sound administration 7 31
- public interest 7 5 et seq.
- reference to the relevant public 7 15 et seq.
- relevant point in time 7 19 et seq.
- shape marks 7 102 et seq. see also there

- signs which cannot constitute a trade mark 7
 42 et seq.
- sound mark see there
- specific goods and services 7 12 et seq.
- tactile mark see there
- taste mark 7 326 et seg.
- three-dimensional mark see there
- tracer mark see there

Refusal to register transfer due to misleading character 20 2

Refusal - relative grounds 8 1 et seq.

- application for the declaration of invalidity 8 6
- double identity 8 23 et seg. see Double identity
- earlier trade mark see there
- extensive protection see there
- identity 88
- likelihood of confusion see there
- non-registered and used-earlier rights see there
- opposition procedure see there
- trade mark filed by agent see there

Register

- bona fide acquisition 27 8
- concept of negative publicity 27 2
- double transfer 27 10
- formal publicity 27 3
- registration formalities 27 13
- registration of bankruptcy 27 21
- registration of compulsory enforcement measures 27 20
- right in rem 27 2

strong registration system 27 1

transfer of EUTM 27 10

Register of EUTM 111 1 et seq. – changes to be registered 111 5

- content 111 1, 4, 4 et seq.

corrections of mistakes and errors 111 11 et seq.

- entries in the Register 111 4 et seq.
- eSearch Plus 112 1 et seq.
- inspection of files 114 8
- receipt of conversion request 111 5
- refusal of registration see there
- request for changes of names or addresses 111
 7 et seq.
- structure 111 6 et seq.

Registrar of the BoA 165 12

Registration formalities 27 13

Registration of EUTM 6 1 et seq.; 51

- agency mark 6 9
- alteration of registration see there
- application as title of property 6 7
- binding effect see Binding effect of registration
- Certificate of Registration 51
- colour mark 6 14
- division of the registration 56 1 et seq.
- duration see Duration of registration
- effect on legal existence 6 5
- effects 51 8
- EU Trade Mark Bulletin 51 1 et segg.
- non-registered trade mark 6 3
- ownership of EUTM 68
- prerequisite for acquisition of EUTM 61,5

- publication 51 9
- refusal see Refusal of registration
- registration fee 66
- registration procedure 6 6
- renewal see there
- requirements 51 3
- territorial reach 64
- three-dimensional mark 6 14

Registration of insolvency procedure 24 14

Registration of licences 25 53

Registration of transfer 20 25

- effect 20 35
- effects of lacking registration 20 25
- formalities 20 21
- infringement proceedings 20 30 et seq.
- recordal of transfers 20 25
- service of documents 20 38
- time-limits 20 27

Registration principle 1 64; 6 1 et seq.

Registration procedure 41 et seq.

- division of the application see there
- examination of application see Examination of application for registration
- observations by third parties and opposition 45 et seq. see Observations by third partie and, further see Opposition
- publication of the application 44 1
- search see there
- withdrawal, restriction and amendment of the application see there

Registry of the BoA 165 12

Rejection of appeal 72 123 Relative admissibility requirements

- company name rights 46 61
- dates 46 53
- goods and services 46 57 et seq.
- inadmissible opposition 46 62
- indication of the opponent 46 59 et seq.
- representation of earlier mark or sign 46 54 et

Relative grounds for invalidity 60 1 et seq.

- consent to registration 60 14 et seq.
- copyright 60 10
- facts to be examined 60 16
- grounds as in opposition proceedings 60 2 et seg
- other earlier rights 60 6 et seq.
- other industrial property rights 60 12
- right to a name and personal portrayal 60 8 et

Relevant consumer see also Identification of relevant consumer

Removal of batch codes and product numbers

Renewal 53 1 et seg.

- notice of renewal 53 2 et seq.
- renewal period 53 1
- request for renewal see there
- restitutio in integrum 53 4
- restitution in interim 53 3

Renewal period 53 1

Renewal proceedings

- use of EUTM 18 60

Repackaging and relabeling 15

Replica or imitation 14 56 see also Dishonest use test

Representation

- appeal before the Court of Justice 72 190
- appeal before the General Court 72 95
- costs to be compensated *see there*
- determination of need for representation 119 4
- domicile 119 6
- employee representation 119 11
- establishment 119 8
- for matters other than filing EUTM application 119 2
- general principles 119 1
- meaning of European Union 119 9
- need for representation 5 5
- principal place of business 119 7
- professional employees 119 15
- professional representation see there

Representation of the trade mark

- colour marks 31 37
- figurative marks 31 26
- general rules 31 15
- indication of type of trade mark 31 20
- olfactory marks 31 47
- principal place of business 119 7 see also there
- sound marks 31 42
- three-dimensional marks 31 28

word marks 31 24 Reputation

- distinctive character of trade mark

Request for an award of costs 109 11 et seq. Request for application of national procedures

139 1 et segg.

- admittal of conversion 139 12 et segg.
- admittal of conversion with respect to EUTM
- application 139 13 et seq.
- admittal of conversion with respect to registered EUTM or IR designating the EU 139 15 et seq.
- central attack 139 8
- exclusion of conversion 139 20 et seqq.
- legal concept 139 1 et seqq.
- Madrid Protocol 139 6
- opting back 139 9
- partial conversion 139 17 et segg.
- trade mark portfolio strategy 139 10
- unitary effect of EUTM 139 1

Request for renewal 53 8 et seq.

- deficiencies 53 23
- expiration of EUTM registration 53 24 et seq. see also there
- fees 53 14 et seq.
- requirements 53 8 et seq.

Request for territorial extension 187 1 et seq.

- examination by EUIPO 187 18 et segg.
- fees 187 22
- form and contents 187 1 et seq.
- International Register 187 10
- language 187 14 et seqq.
- official form 187 6, 16

- operative scope 187 13
- period of protection 187 12
- procedure 187 2

Request for transformation 204 2 et seq.

- application fee 204 7
- central attack 204 1 et seq., 9 et seq.
- effects of transformation 204 9 et seq.
- examination by EUIPO 204 6
- examination for absolute grounds of refusal 204 8
- opposition 2048
- prerequisites 204 2 et seq.
- procedure 204 4 et seq.

Restitutio in integrum 104 1 et seq.

- competent department 104 129 et seq.
- consequences for applicant in case of inadmissibility 104 132 et seq.
- consequences for third parties in case of inadmissibility 104 134 et seq.
- decision 104 128 et seq.
- EUTM Bulletin 116 12
- expiration of EUTM registration 53 29 et seq.
- explicitly excluded time limits 104 35 et seq.
- general principles 104 5 et seq.
- legal remedies 104 141 et seq.
- remedies for the applicant 104 144
- remedies for third parties 104 145 et seq.
- renewal 53 4
- scope of application 104 24 et seq.
- scope of interpretation 104 6
- substantive requirements 104 42 et seq. see also Restitutio in integrum – substantive requirements
- time limits 104 24 et seq.

Restitutio in integrum, -substantive requirements

- absence of instructions 104 77
- absence of the representative 104 67
- computerised renewal reminder system 104 70
- control mechanism regarding employees 104
- corruption or loss of data 104 71
- courier service 104 76, 86 et seq.
- delivery services 104 86 et seq.
- double control system for time limits 104 68
- duty of care 104 45 et seq.
- duty of care of applicant or trade mark proprietor 104 48 et seq.
- duty of care of clerical staff 104 56
- duty of care of representative 104 53 et seq.
- employees 104 81 et seq.
- error by EUIPO 104 95 et seq.
- errors in calculation 104 60
- excess of work 104 74
- human errors 104 73
- illness of key person 104 75
- inaccurate information by EUIPO 104 97
- IT and software issues 104 71, 98
- legal errors 104 61
- move of representative's office 104 72
- reasons 104 42 et seq.
- redirect incoming faxes to mailbox 104 78
- role of paralegal 104 79

Restitutio in integrum - formal requirements

- applicant 104 106 et seq.
- evidence 104 126
- fee 104 102 et seq.
- form 104 99
- language 104 100 et seq.
- statement of grounds 104 123 et seq.
- time limits 104 108 et seq. see also Time limits for restitutio in integrum

Restitutio in interim

- renewal 53 3

Restoration 53 29 et seq.

Restriction of access to confidential documents

- documents relating to settlement negotiations 114 35 et seq.
- inter partes proceedings 114 33 et seq.
- opposition proceedings 114 34
- overriding legitimate interest 114 30 et seq.
- special interest in confidentiality 114 26 et seq.
- trade of business secret 114 27

Restriction of access to files 114 12 et seq.

- confidential documents 114 25 et seq. see also Restriction of access to confidential documents
- documents related to exclusion or objection 114 20 et seq.
- draft decisions and opinions 114 23
- excluded documents 114 19 et seq.
- unpublished applications 114 12 et seq.

Retail and wholesale services classification 33 69 et seq.

Review of decision on costs in proceedings before EUIPO 109 72 et seq., 82 et seq.

- inadmissibility 109 77
- joint proceeding against trade mark 109 100
- object of review 109 73
- oral proceedings 109 79
- partial failure of appellant 109 93
- reasons for request of review 109 78
- remittal by BoA 109 94
- scope of decision of BoA 109 89
- settlement on costs 109 98
- time limit 109 75
- withdrawal of appeal 109 96
- withdrawal of application for trade mark 109
 97

Revision of decisions in ex partes cases 69 1 et

revision procedure 69 5 et seq.

Revocation 58 1 et seq.

- acts of inactivity of the proprietor 58 28 et seq.
- application for revocation see there
- common in the trade 58 23 et seq.
- common name 58 19 et seq.
- consequences 62 2 et seq.
- EU collective marks 81 1 et seq.
- geographical scope 58 34
- limited goods or services 58 44
- principles 58 1 et seq.
- retroactive effect 62 4 et seq.revocation for non-use 58 9 et seq.
- trade mark liable to mislead the public 58 35 et seq.

- trade mark that has become a common name 58 16 et sea.

Revocation decision

- exclusion of conversion 139 23

Revocation of a decision by EUIPO 103 1 et seq.

- consequences 103 21
- error or mistake 103 5 et seq.
- errors of transcription 103 7
- general purpose 103 2
- linguistic error 103 7
- manifest oversights 103 7
- obvious error 103 6
- procedure 103 8 et seq. see Revocation procedure of EUIPO
- requirements 103 5 et seq.

Revocation on grounds of non-use

exclusion of conversion 139 21

Revocation procedure of EUIPO 103 8 et seq.

- ex partes proceedings 103 14 et seq.
- inter partes proceedings 103 17 et seq.
- term 103 11

Right conferred by EUTM 9

- EUTM proprietor 9 23
- exclusive rights 9 14 et seqq.
- infringement test see there
- justification 9 24 et seq. see Justification of exclusive rights conferred by EUTM
- justification on grounds of consumer protection 9 24
- limitations of exclusive rights 9 18 see also
- negative contents 9 14
- positive contents 9 16
- principle of acquiescence 9 36
- right to use 9 16

Right in rem 22

- administrative fee for recordal 26 6 et seqq.
- changes to be recorded 111 5
- characteristic performance 19 9
- compulsory enforcement 23 1
- EUTM as security interest 22 5
- formal requirements 22 15
- grant of right in rem 22 5
- licence 25 2
- non-Member State beneficiary 22 10
- register 27 2, 10
- registrability 22 13
- registration fee 108 2
- registration of security interests 22 13
- requirements for enforcement 22 15
- residence of non-Member States 22 10
- right entered into the Register 57 13
- right to use 22 9
- subsequent transfer of trade mark 20
- validity test 22 31

Right of priority 34 1 et seq. see also Priority

- application for identical trade mark 34 12 et
- date of filing 34 11
- exceptions 34 5 et seq.
- filing an application 34 9 et seq.

- filing an application outside PC or WTO 34 29
- first filing in PC or WTO state 34 10
- invoking several rights of priority 34 23 et seq.
- legal successor 34 8
- person who can invoke priority 34 7 et seq.
- prerequisites 34 7 et seq.
- principle of Union Priority 34 4
- right of privacy 97 20
- time limit for claiming priority 34 25 et seq.
- time rank 34 3

Right to be heard before EUIPO 94 17 et seq.

- decision based on reasons or evidence 94 21 et
- legal opinion and legal basis 94 26 et seq.
- scope 94 19 et seg.

Right to be heard in procedure before the EUIPO 107 10 et seq

Right to licence 25 17

Right to privacy

- oral proceedings 96 10
- taking evidence 97 20

Right to use

- exhaustion 15 3
- geographical name description 74 19
- licence 25 2, 3, 8 et seq., 11
- right to usufruct 22 9 et segg.

Right to usufruct 22 9 et segg.

Rubic's Cube 7 120 et seq.

Rule of interdependence

likelihood of confusion 9 297

phonetic similarity offset by visual and concep-

tual difference 9 246

TM with reputation 9 343

visual and phonetic similarity offset by conceptual difference 9 240

visual difference offset by phonetic and conceptual difference 9 248

Rules of procedure before EU trade mark court 129 11 et seq.

- applicability 129 11
- national rules of procedure 129 13

Sanctions by EU trade mark court 130 1 et seq.

- claim to prohibition 130 3, 5 et seq.
- coercive measures to enforce prohibition 130 14 et seq.
- general 130 1 et seq.
- kind of sanctions 130 4 et seq.

Schedule of Fees of international registration of trade mark 182 7 et seq.

Scope of application of EUTMR 18 24 et seq. Scope of jurisdiction in provisional and protective measures 131 19

Search 43 1 et seq.

- date of filing see there
- fee

Seat of EUIPO

- jurisdiction of 'domicile courts' 125 11

Security interest see Right in rem

Seniority claim 1 62; 8 313; 74 35

- entry in register 111 4 et seq.
- establishing priority 8 20

- examination of requirements 41 35 et seq.
- filing 30 8
- non-observance of time limit 104 27

Seniority date

- divisional registration 56 11
- duration of registration 52 1
- enlargement of the Union 209 29 et seq.
- new application 50 26

Seniority examination by EUIPO 39 28 et seq.; 41 28 et seq.

- content of seniority claim 39 29
- deficiencies 39 34
- supporting evidence 39 33

Seniority of national trade mark 39 1 et seq.

- claim after registration of EUTM 40 1 et seq.
- content of claim after registration of EUTM 40
- definition of seniority 39 4 et seq.
- implicit claim 39 11
- invalidity or revocation of EUTM for which seniority is claimed 39 23 et seq.
- lapse of claimed seniority 39 27
- opposition proceedings 39 20 et seq.
- prerequisites for claiming seniority 39 8 et seq.
- procedural aspects 39 20 et seq.
- relevant time 39 19
- seniority examination by EUIPO see there
- supporting evidence for claim after registration of EUTM 40 6
- time limit for claim after registration of EUTM 40 1 et seq.
- triple identity criterion see there

Service of documents 20

Settlement on costs 109 26 et seq.; 110 9

- after cooling-off period 46 78 et seq
- discontinuance of proceedings 72
- documents relating to settlement negotiations 114 19, 35
- during cooling-off period 46 75 et seq.
- enforcement 110 9
- invitation by EUIPO 63 5; 64 8
- review of decision on costs in proceedings before EUIPO 109 98
- withdrawal of appeal 72 109 96

Shape marks

- assessment of shape marks 7 102 et seq.
- average consumer's perspective 7 294
- distinctive character 7 293 et seq.
- hybrid shape 7 130
- protected by patents 7 121
- protection under design law 7 131
- refusal of registration absolute grounds 7 102 et seq.
- shape giving substantial value 7 131 et seq.
- shape necessary to obtain a technical result 7 119 et seq.
- shape resulting from the nature of the goods 7 116 et seq.
- signs consisting exclusively of shape of goods 7 110 et seq.
- suitable for protection 7
- 'form follows function' 7 104

Shape necessary to obtain a technical result 7 119 et seq.

Shape resulting from the nature of the goods 7 116 et seq.

Sieckmann criteria 4 14, 22; 7 48; 31 47

Signs consisting exclusively of shape of goods 7 110 et seq.

Signs contrary to public policy

- assessment as a whole 7 150
- assessment criteria 7 143 et seq.
- European Convention of Human Rights 7 145

Signs of which a EUTM may consist 4

- colours 4 37 see there
- definition 41
- design of a retail store 4 55
- distinctiveness 4 11 see also there
 - eligible signs 4 22
- figurative elements 4 26
- graphical representation 4 13
- hologram 4 33
- indication of the category of trade mark 4 56 see also Category of trade mark
- moving image 4 34
- numerals 4 24
- position 451
- requirements for registrability 4 4
- scents 4 45
- shapes 4 33
- Sieckmann criteria see there
- single letters 4 24
- sound 4 42
- taste 4 46
- touch 4 50
 - words and word combinations 4 24

Signs which cannot constitute a trade mark 7 42

- distinctiveness 7 43 et seq. see also Distinctive character
- graphic representation 7 47 et seq.
- lack of distinctive character 7 52 et seq.

Similarity factors

- likelihood of confusion 8 72 et seq., 85 et seq.
- relationship between similarity factors 8 85 et seq.
- specific sectors of the economy 8 88

Similarity of signs

- abstract colour mark 8 170 et seq.
- aural comparison 8 131 et seq.
- categories of objective comparison 8 98
- conceptual comparison 8 144 et seq.
- figurative mark 8 129 et seq.
- likelihood of confusion 8 97 et seq.
- objective comparison 8 98
- sound and smell mark 8 168
- three-dimensional mark 8 164 et seq.
- visual comparison 8 120 et seq.
- word mark 8 121 et seq.

Simultaneous actions

 civil actions on basis of more than one trade mark 136 8 et seq.

Single Member Board 165 21

Sound and smell mark

- similarity of signs 8 168

Sound mark

- graphical representability 7 316 et seq.
- importance 7 316
- music sign see also there
- representation of the trade mark 31 42

Sound-alikes 7 89

Spare parts and servicing business

- double identity
- exhaustion of rights conferred by EUTM 15 8
- referential use defence 14 2, 35 et seqq.
- types of indicative reference 14 38

Special advisers at EUIPO 143 9

Staff of EUIPO 143 1 et seq.

- appointing authority members of the BoA 143

- auxiliary staff 143 6
- categories of servants 143 4 et seq.
- Conditions of Employment 143 3 et seq.
- contract staff 143 7
- general 143 1
- liability against EUIPO 145 11
- local staff 143 8
- members of the BoA 143 13
- national experts 143 10
- President 143 13
- privileges and immunities see there
- special advisers 143 9
- Staff Regulations 143 2
- temporary staff 143 4 et seq.

Staff Regulations EUIPO 143 2

Standard of evidence 97 23 et seq.

Statement of grant of protection following a

provisional refusal opposition related to international registration

196 17

Statement of grounds 68 19 et seq.

- content 68 20 et seq.
- language 68 20
- oral hearing before the BoA 68 28
- time limit 68 19

Statement of reasons on which EUIPO's decisions are based 94 1 et seq.

- decision by EUIPO 94 5 et seq.
- form of decision 94 29 et seq.
- in ex partes proceedings 94 12 et seq.
- in inter partes proceedings 94 15 et seq.
- right to be heard before EUIPO 94 17 et seq.
 see also there
- statement of grounds 94 7 et seq.

Study by the Max Planck Institute (2011) 51 Substantial value see Shape marks

Substantiation of the opposition 46 99 et seq.

- marks filed by an agent or representative 46
- marks with a reputation 46 113
- non-registered nark or other sign used in the course of trade 46 115
- proof of existence and validity of earlier right 46 102 et seq.
- proof of renewal 46 110

- sanction against opponent 46 115
- translation of evidence and trade mark registration 46 107 et seg.
- well-known marks 46 112

Successive actions

 civil actions on basis of more than one trade mark 136 12 et seg.

Sufficient evidence of use

- exclusion of conversion 139 30

Supplementary fee

- fees for international application 184 18

Surrender of EUTM 57 1 et seq.

- conversion 57 15 et seq.
- declaration of surrender 57 6
- effects 57 11 et seq.
- entry in the register 57 13
- exclusion of conversion 43 et seq.; 139 24 et seqq.
- object of surrender 57 1 et seq.
- other pending proceedings 57 20 et seq.
- surrender by the proprietor 57 4 et seq.

Suspension of enforcement 110 18

Suspension of proceedings

 opposition related to international registration 196 15

Suspensive effect 60 15

- decisions in respect of appeals 71 20

Sworn or affirmed statement in writing 97 55 et

Symbols replacing letters 7 90

Tactile mark

distinctiveness 7 329

- refusal of registration see there

Taking copies of file documents 114 52

Taking of evidence before EUIPO 97 1 et seq.

- bearing on decision 97 15

- burden of proof 97 27 et seq.
- empirical facts 97 18
- evidence 97 11 et seq.
- explorative evidence 97 20
- facts 97 13
- facts known to EUIPO 97 17
- means of taking evidence 97 38 et seq. see also Means of taking evidence before EUIPO
- need for evidence 97 16 et seq.
- procedure for taking evidence 97 65 et seq.
- right of privacy 97 20
- standard of evidence 97 23 et seq.

Tarnishment

degradation 14 55

Taste mark 4 49; 7 326; 31 47

- refusal of registration 7 332

Taxation of costs 72 156; 228

Taxonomy for classification 33 41 et seq.

- class scopes 33 50 et seq.
- composition 33 44 et seq.
- hierarchy of classes 33 46 et seq.

Technical Result see Shape marks Temporary staff at EUIPO 143 4 et seq.

Term for appeal

- appeal before the Court of Justice 72 179
- appeal before the General Court 72 56

Term for filing an appeal 72

- calculation of deadlines 72 57
- consequences of failure 72 62
- date of delivery of the decision 72 56
- form of transmission of appeal 72 60

Termination of obligation to pay fee 108 1 et

Three-dimensional mark

- Binding effect of registration 6 14
- representation of the trade mark 31 28; 41 13
- similarity of signs 8 164 et seq.

Time limit for appeal 68 1, 29

- calculation 68 29 et seq.
- restitution in integrum 68 37
- statement of grounds 68 19

Time limits 101 1 et seq.

- calculation 101 13 et seq.
- duration 101 5 et seq.
- extension 101 8 et seq.
- general purpose 101 2
- interruption 101 16 et seq.
- scope 101 4

Time limits for restitutio in integrum 104 108 et

- absolute bar 104 116 et seq.
- completion of omitted act 104 115, 119 et seq.
- non-payment of renewal fee 104 118
- renewals 104 118
- time limit for filing the application 104 108 et

Timelines for conversion request 139 46 et seqq.

- commencement of term with respect to EUTM applications 139 47
- commencement of term with respect to registered EUTM or IR designating the EU 139 48
- starting point 139 46 et seqq.

Tracer mark 7 277

Trade Mark Directive

- enactment 1 49 et seq.
- scope 1 49

Trade mark filed by agent

- misuse 8 252 et seq.
- opposition procedure 8 255 et seg.
- priority principle 8 250 et seq.
- requirements for opposition 8 257 et seq.

Trade mark function theory

- advertising function 9 261, 268, 272, 283; 58 27

investment function 9 261, 268, 272, 283 Trade mark liable to mislead the public

revocation 58 35 et seq.

Trade mark portfolio strategy procedures

request for application of national 139 10

Trade mark registered in the name of an agent or representative

- absence of proprietor's authorization 21 20
- agent definition 21 12
- application filed in the name of the agent 21 19
- object of application 21
- possible justification by agent or representative
- prohibition on the use 13 21
- proprietor of a trade mark 21 7

- proprietor definition 21 7
- relationship 21 12
- relevant point in time for relationship 21 17
- representative definition 21 12
- trade mark definition 21 9
- transfer of a trade mark 21
- use not authorized by proprietor 21 26

Trade mark with reputation

due cause 9 356

Trade of business secret documents

Restriction of access to confidential 114 27

Trademark infringement 12 13

Traditional specialties guaranteed 7 229 et seq.

Traditional terms for wine 7 226 et seq.

Transfer of EUTM 20 1 et segg.

- concept of transfer 20 4
- formal requirements 20 21
- presumption of business transfer to include EUTM 20 17
- principle of free transferability 20 1 see also Free transferability of EUTM
- refusal to register transfer due to misleading character 20 7
- register 27 6, 8 et seqq.
- registration of transfer see there

Translation Centre of the Bodies of the EU 147 5; 148 1 et sea.

- EuIPO in-house translation resources 148 4 et seq.
- general 148 1

scope of activities 148 2

Translation costs 109 30

Translation requirements in application for EUTM 146 46 et seq.

Transparency

- access to documents 149 1 et seq.
- access to documents, procedure 149 3 et seq.
- access to documents, scope 149 2

Travel expenses of a representative 109 60

Triple identity criterion 39 12 et seq.

- full personal identity 39 13 et seq.
- identity of goods and/or services 39 17 et seq.
- identity of sign 39 15 et seq.

Unfair competition 17 4

Unitary effect of EUTM 139 1

Universal succession

- appeal before the General Court 72 34
- lack of estoppels 27 19

Unpublished applications

- restriction of access to files 114 12 et seq.

Use of a EU collective mark 78 1 et seq.

Use of a mark subject of international registration 203 1 et seq.

Use of adverbs in classification 33 10

Use of EUTM 18 1 et seq.

- checklist for use requirements 18 13
- denigration or discrediting use 14 54 et seq.
- fragmented use in one Member State 139 28
- genuine use see Genuine use of trade mark
- genuine use shown for individual Member State 139 27 et segg.
- relevance for cancellation proceedings 18 63

- relevance for opposition and infringement proceedings 18 60 et seq.
- relevance for proceedings and registration 18
- relevance for renewal 18 59
- revocation on grounds of non-use 139 21
- use in different form 18 46 et seq.
- use in relation to goods and services 9 48, 360;
- use in the course of trade 8 7, 28; 9 40; 14 12; 47 31: 137 21
- use on the internal market 9 44
- use requirements 18 10 et seq.
- use solely for export 18 54
- with consent of proprietor 18 56 et seq.
- without consent of EUTM proprietor 9 36

Validity test 22 31

Verbal elements offset by graphic elements 9 183 Visual comparison

- general principle 8 120; 9 159
- graphic elements offset by verbal elements 9 179
- identical prefix 9 170
- identical suffix 9 179
- identical word 9 160
- lack of non-negligible graphics 9 188
- similarity of signs 8 120 et seq.
- verbal elements offset by graphic elements 9
- Weak distinctive character 8 103 et seq.

Withdrawal

- award of costs by EUIPO 109 23 et seq.
- date of filing 42 40
- EUTM Bulletin 116 7
- fees wrongly paid or withheld 108 8
- historical development 49 3 et seq.
- impact 49 7 et seq., 14 et seq.
- meaning 49 5 et seq.
- of national trade mark application 34 11
- partial withdrawal of action 72 47
 - refund of opposition fees 109 35
 - registration 42 40; 46 77; 49 7
- registration procedure 6 6
- repayment of fees 109 2
- settlement during cooling-off period 46 76
- withdrawal of appeal 109 96
- withdrawal of the opposition 49 13; 72 138, 213; 109 23, 34

Withdrawal, restriction and amendment of the application 49 1 et seq.

- amendment 49 14 et seq.
- exclusion of conversion 139 34 et seqq.
- procedure 49 24
- publication of the EUTM 49 17 et seq.
- restriction 49 11 et seq.
- withdrawal 49 7 et seq.

DIE FACHBUCHHANDLUNG

representation of the trade mark 31 24 similarity of signs 8 121 et seq.

Written proceedings

proceedings before the General Court 72 106