



SOUTHEAST ASIA

# The EUTM registration procedure

Sophia BONNE  
Jakarta /13<sup>th</sup> August 2018

[www.ipkey.eu](http://www.ipkey.eu)



Funded by the European Union



Directed by the European Commission, IP KEY is implemented by the  
European Union Intellectual Property Office (EUIPO)



# IPKey

SOUTHEAST ASIA



[www.ipkey.eu](http://www.ipkey.eu)



Funded by the European Union



Directed by the European Commission, IP KEY is implemented by the  
European Union Intellectual Property Office (EUIPO)

# The EUTM registration procedure

---



Sophia BONNE  
/Jakarta/13th August 2018

1. **A unitary protection**
2. For trade marks
3. The registration procedure
4. Use in business
5. Other IP rights
6. Some figures





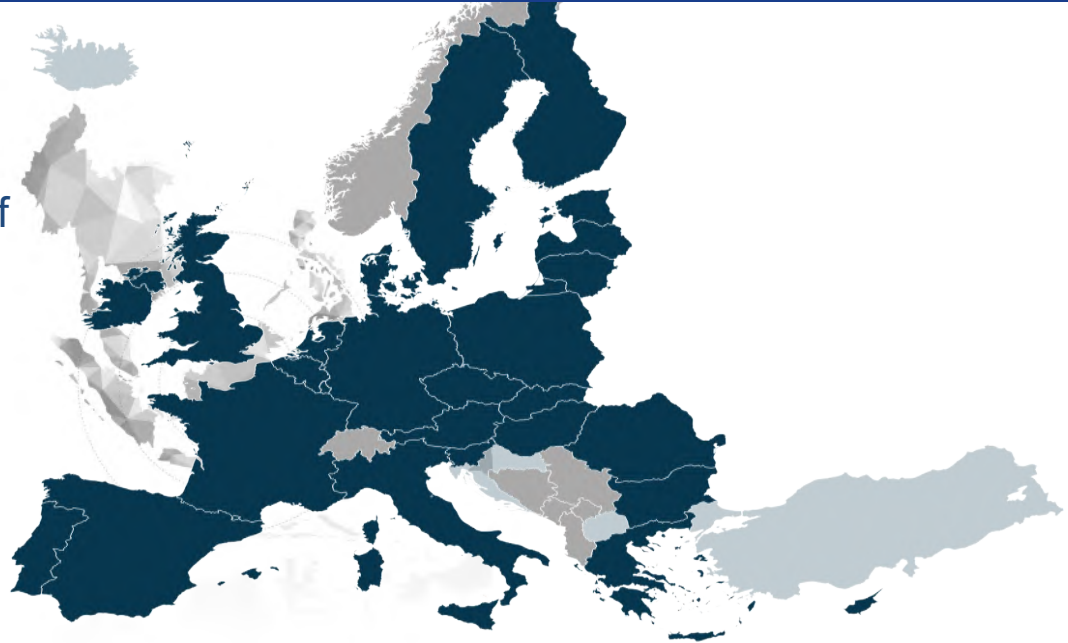
## A unitary protection



## A unitary protection

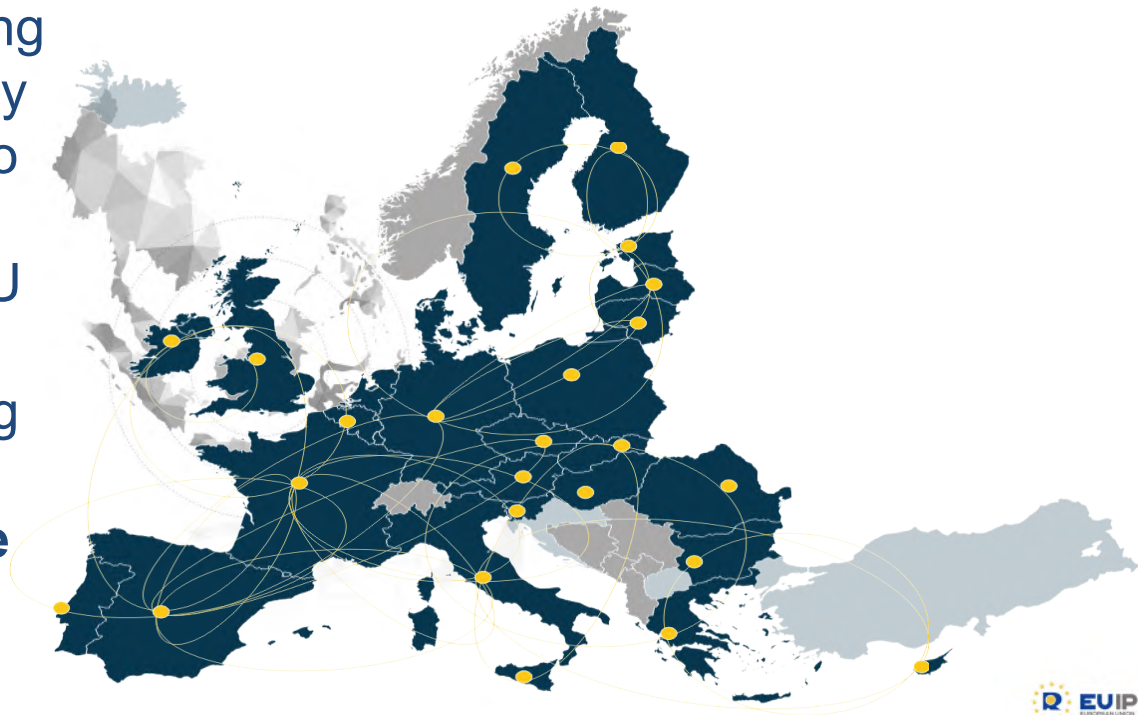
The **EUTM** is a **centralized** system that gives **unitary** protection in **all** of the **28** Member States of the European Union.

The **EUTM** exists in parallel with the national and international trade mark protection in the EU.



## A unitary protection

A part from applying for a EUTM directly at EUIPO, it is also possible by designating the EU as a whole – for a EUTM –when filing an international application **via the WIPO.**



## A unitary protection : Benefits

The **EUTM** has the following benefits:



- one application in any of the official EU languages online
- one registration fee = protection in 28 Member States
- exclusive right conferred to the owner at a reasonable cost.
- one set of procedures in one office
- valid for 10 years and can be renewed indefinitely.



## A unitary protection

The basic fee for a EUTM using the on-line application on the EUIPO website is:

**850 EURO.**



## Registering an EUTM: fees

EU TRADE MARKS FEES					
TYPE OF MARK	FIRST CLASS		EXTRA CLASSES		
	PAPER	E-FILING	SECOND	THIRD	ADDITIONAL
INDIVIDUAL	1000	850	50	150	150
RENEWAL	1000	850	50	150	150
COL/CERT	1800	1500	50	150	150
REN. COL/CERT	1800	1500	50	150	150

## Overview

1. A unitary protection
2. **For trade marks**
3. The registration procedure
4. Use in business
5. Search Tools
6. Other IP rights
7. Some figures



## What is a trade mark?

- A sign
- Capable of distinguishing one undertaking from another
- Capable of being represented
- Functions: origin (also advertising, investment)
- Effects: rights, limits, 'obligations'



*Coca-Cola*



FUJITSU

**Microsoft®**

## Definition

### ➤ EUTM: any signs, in particular

#### ➤ Words (including personal names)

#### ➤ Designs

#### ➤ Letters

#### ➤ Numerals

#### ➤ Colours

#### ➤ Shape of the goods

#### ➤ Shape of the packaging of goods

#### ➤ Sounds

### Article 4

#### Signs of which an EU trade mark may consist

An EU trade mark may consist of any signs, in particular words or of the packaging of goods, or sounds, provided that such sign

- (a) distinguishing the goods or services of one undertaking from those of other undertakings
- (b) being represented on the Register of European Union trade marks in a manner enabling the public to determine the clear and precise subject matter of the protection conferred by the trade mark





## Trade mark types: registration

### ➤ Registered

16.6.2017

EN

Official Journal of the European Union

L 154/1

#### REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL

of 14 June 2017

on the European Union trade mark

(codification)

(Text with EEA relevance)

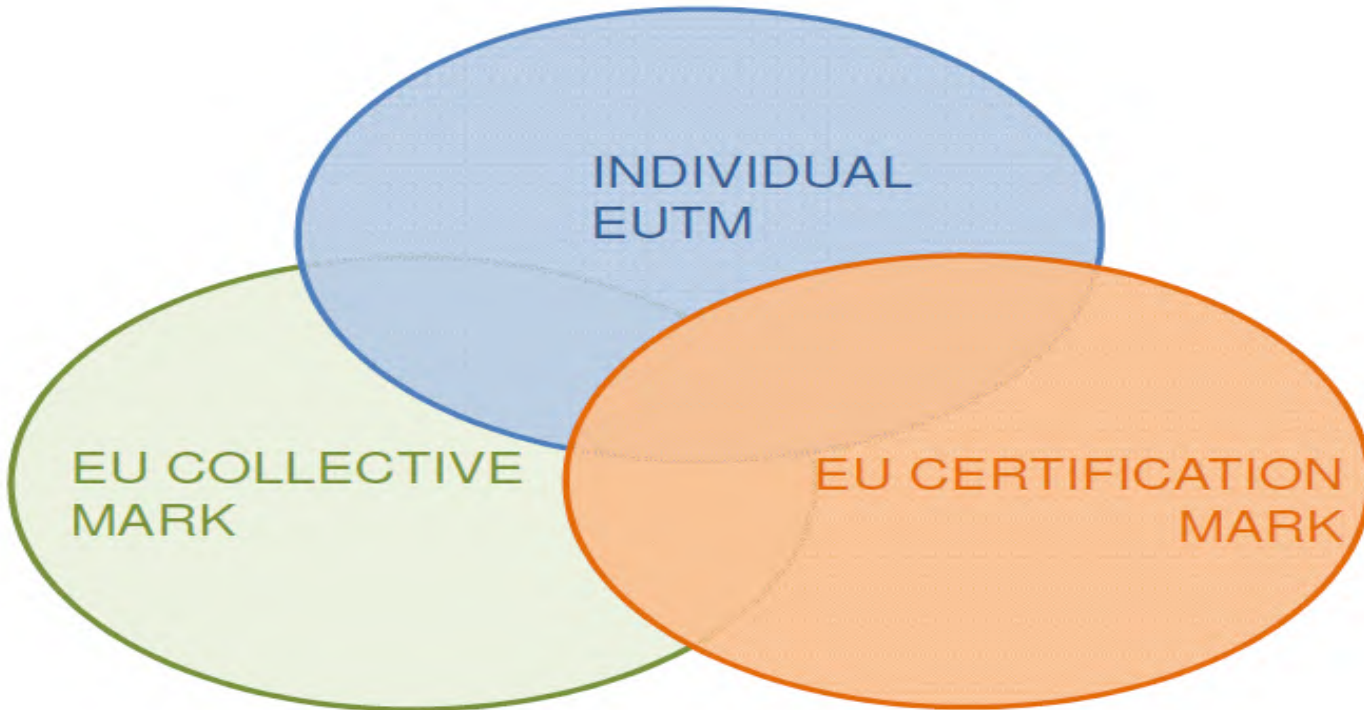
- (9) The rights in an EU trade mark should not be obtained otherwise than by registration, and registration should be refused in particular if the trade mark is not distinctive, if it is unlawful or if it conflicts with earlier rights.



Funded by the European Union



## Trade mark types: purpose



## Collective and certification marks

- **Collective marks**



- **Certification marks**



## Trade mark types: representation

				
<b>Word</b>	<b>Figurative</b>	<b>Shape</b>	<b>Colour</b>	<b>Sound</b>
				
<b>Position</b>	<b>Pattern</b>	<b>Motion</b>	<b>Multimedia</b>	<b>Hologram</b>

## Article 3(3) EUTMIR: SPECIFIC TRADE MARK TYPES

### Figurative

火瀑

No description

No colour claim  
WYSIWYG

### Shape



Definition expanded,  
includes appearance

No description

New formats:  
3D modeling CAD





## Article 3(3) EUTMIR: SPECIFIC TRADE MARK TYPES

### Colour marks



The indication of recognised colour codes remains compulsory

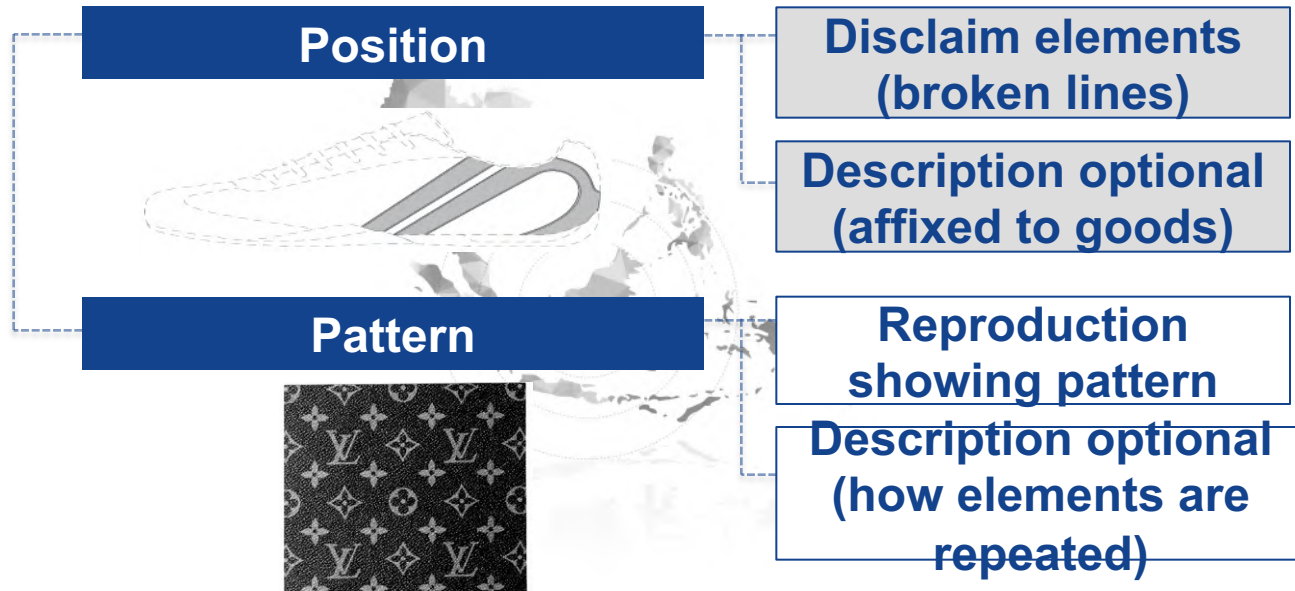
#### Colour Combinations:

The reproduction must show the systematic arrangement of the colours

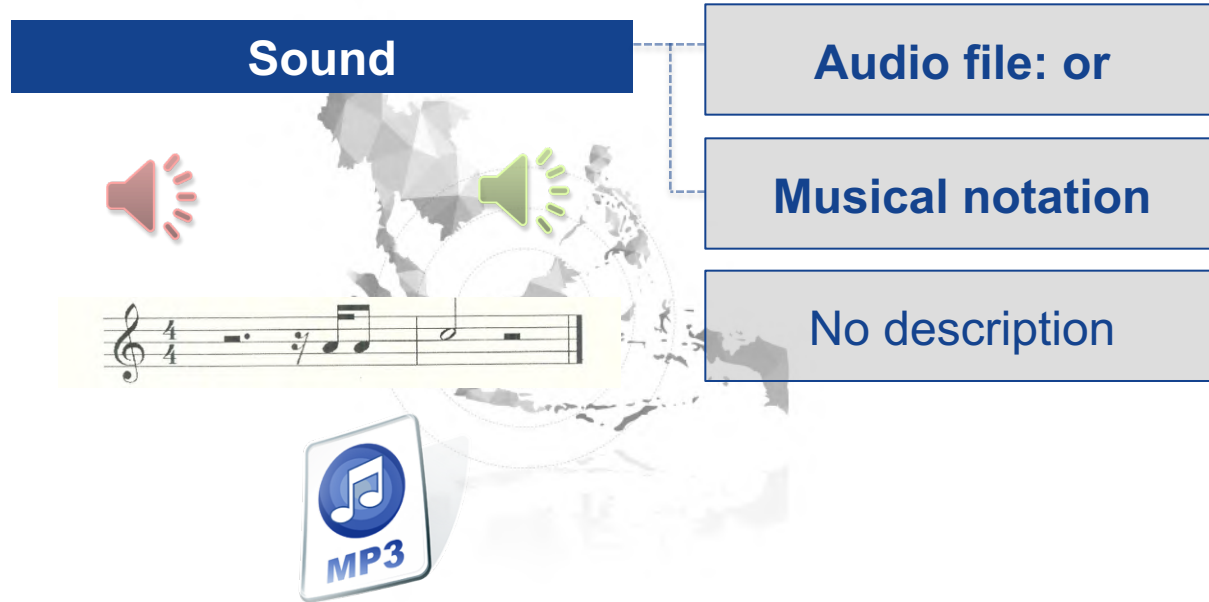
A description may be filed detailing the systematic arrangement further



## Article 3(3) EUTMIR: SPECIFIC TRADE MARK TYPES

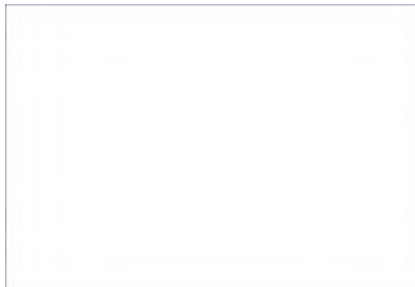


## Article 3(3) EUTMIR: SPECIFIC TRADE MARK TYPES



## Article 3(3) EUTMIR: SPECIFIC TRADE MARK TYPES

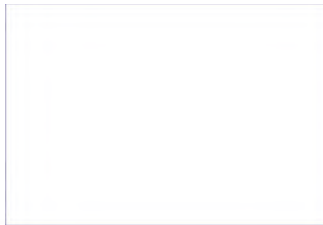
### Motion



**Video file or  
still images**

**For still images:** a description  
explaining the sequence

### Multimedia



**Audio-visual file**

**No description**



## Article 3(3) EUTMIR: SPECIFIC TRADE MARK TYPES

### Hologram



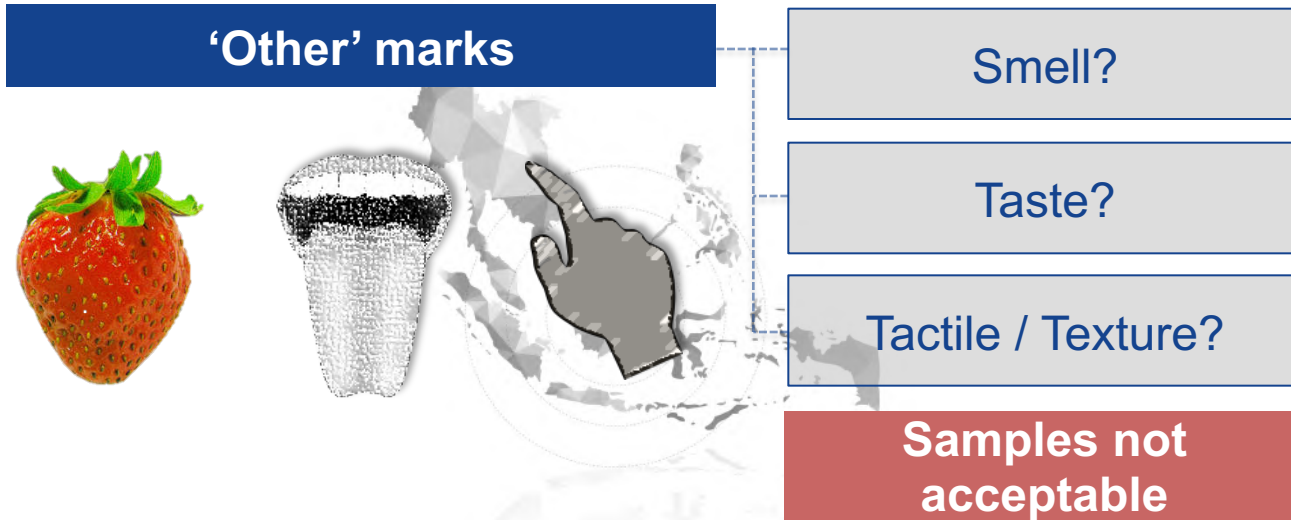
**Video file**, graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety

**No description**





## Article 3(3) EUTMIR: SPECIFIC TRADE MARK TYPES



## Overview

- 
1. A unitary protection
  2. For trade marks
  - 3. The registration procedure**
  4. Use in business
  5. Other IP rights
  6. Some figures



## Registering an EUTM: procedure

# Procedure



# Registering an EUTM: Application

## APPLICATION



The screenshot shows the EUIPO online application form for a trade mark. The browser address bar displays <https://euipo.europa.eu/tm/efiling/wizard.htm?execution=e1.s1>. The page title is 'Apply for a trade mark online'. The navigation bar includes links for Home, Trade marks, Designs, Law & practice, Learning, and About EUIPO. The main content area is titled 'Trade mark details' and includes a progress bar with five steps: 1. Trade mark details (active), 2. Goods and services, 3. Similar trade mark(s), 4. Your details, and 5. Confirm and pay. The 'Trade mark details' section includes a 'Languages' section where the user has selected 'English' as the first language and a dropdown for the second language. Below this is a 'Type of mark' section with two options: 'Word mark' (represented by a large 'A') and 'Figurative mark' (represented by a blue hexagon). The 'Word mark' option is selected. The 'Figurative mark' option includes a description: 'A figurative mark is represented using pictures, graphics or images: a figurative mark does not contain words or letters.' On the right side of the page, there is a fee table:

Basic fee	850,00 €
Extra Class Fee	0,00 €
Total classes	0
<b>Total fee</b>	<b>850,00 €</b>

Below the fee table are buttons for 'Reset application form' and 'Print'. A 'fast track' logo is also visible on the right side of the page.

## Registering an EUTM: Examination

### EXAMINATION



✓  
✓  
✓  
✓

**Formalities**

**Classification**

What **CAN** be a TM?

What **CANNOT** be a TM?



## Classification

- Nice Classification: 45 classes
- No list of goods & services = **NO filing date**
- Correct classification = ensures the right scope of protection
- Correct classification = avoids unnecessary conflicts
- Terms have to be clear and precise.
- Examples

Machines ✗

Machines for crushing stone ✓

Clothing, footwear, headgear ✓

Treatment of materials ✗

Treatment of wool ✓

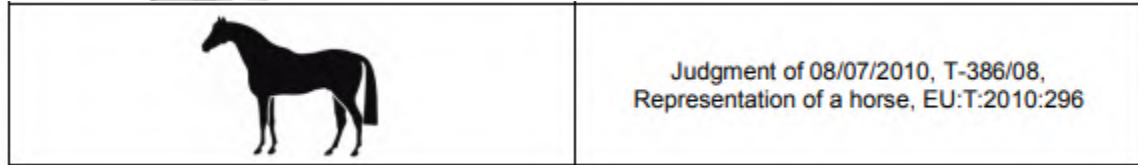


## Reasons for refusal: absolute grounds

- **Grounds listed in Article 7(1) EUTMR**
  - Only one is sufficient to refuse an EUTM
  - Each one is independent and examined separately
  - In only part of the EU.
- For example, it suffices for a refusal if the trade mark is descriptive, or lacks distinctive character, in any one of the official languages of the EU (judgment of 03/07/2013, T-236/12, Neo, EU:T:2013:343, § 57).
- **Proof of acquired distinctiveness through use**

## Reasons for refusal: absolute grounds

- **Non- distinctive: “MORE THAN JUST A CARD”**
- **Descriptive:**
  - **Verbal: Judgment of 13/06/2012, T-534/10, Hellim, EU:T:2012:292**
  - **Figurative :**
- **Public policy/morality:**

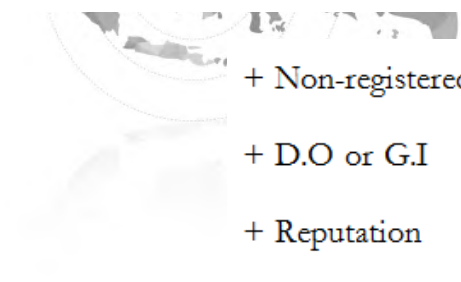


## Reasons for rejection: relative grounds

### *Article 8*

#### **Relative grounds for refusal**

1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:
  - (a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;
  - (b) if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.



+ Non-registered trade mark

+ D.O or G.I

+ Reputation

## Reasons for rejection: relative grounds

Case C-251/95,  
'Sabèl',



Case C-39/97,  
'Canon',

Canon vs Cannon



Case C-342/97, 'Lloyd'

Lloyd vs Loint's



## EXAMPLES OF REGISTERED MARKS





## EXAMPLES OF REGISTERED MARKS

# UNIVERSAL



# MULTI



- 
1. A unitary protection
  2. For trade marks
  3. The registration procedure
  4. **Use in business**
  5. Other IP rights
  6. Some figures



## Value of a brand

Google

**\$302 billion**

Apple	\$300 billion
Amazon	\$207 billion
Microsoft	\$200 billion
Tencent	\$178 billion
Facebook	\$162 billion
Visa	\$145 billion
McDonalds	\$126 billion
Alibaba	\$113 billion
AT&T	\$106 billion



Source: BrandZ™ Top  
 100 Most Valuable Global  
 Brands 2018

### RECORD VALUE RISE PUSHES BRANDZ™ GLOBAL TOP 100 TO \$4.4 TRILLION



















With an increase of 21 percent, the BrandZ™ Global Top 100 Brands added a record \$748 billion in value, to reach \$4.4 trillion in total value, an increase of \$2.9 trillion since 2006.



Source: BrandZ™ / Kantar Millward Brown (including data from Bloomberg)

## How do Intellectual Property Rights contribute to create economic value?

### CONTINENTAL EUROPE TOP 10

Rank	Brand	Category	Country of Origin	Global Top 100 Rank	Brand Value 2018 \$ Million	Brand Value 2017 \$ Million	Brand Value % Change 2018 vs. 2017
1		Technology		17	55,366	45,194	+23%
2	 Deutsche Telekom	Telecom Providers		25	41,499	38,493	+8%
3	 Louis Vuitton	Luxury		26	41,138	29,242	+41%
4	 HERMÈS PARIS	Luxury		39	28,063	23,416	+20%
5		Apparel		42	26,860	25,135	+7%
6	 L'ORÉAL PARIS	Personal Care		44	26,107	23,899	+9%
7	 Mercedes-Benz	Cars		46	25,684	23,513	+9%
8		Cars		47	25,624	24,559	+4%
9	 movistar	Telecom Providers		53	22,824	22,002	+4%
10		Luxury		54	22,442	13,548	+66%

Source: BrandZ™ / Kantar Millward Brown (including data from Bloomberg)

BrandZ™ Top 100  
Most Valuable Global  
Brands 2018

Category Brand Value  
Year-on-Year Change










**+15%**

Continental Europe Top 10  
Total Brand Value

**\$315.6 billion**

## How do Intellectual Property Rights contribute to create economic value?

### ASIA TOP 10

Rank	Brand	Category	Country of Origin	Global Top 100 Rank	Brand Value 2018 \$ Million	Brand Value 2017 \$ Million	Brand Value % Change 2018 vs. 2017
1	<b>Tencent 腾讯</b>	Technology		5	178,990	108,292	+65%
2	<b>Alibaba Group 阿里巴巴集团</b>	Retail		9	113,401	59,127	+92%
3	<b>中国移动 China Mobile</b>	Telecom Providers		21	46,349	56,535	-18%
4	<b>ICBC 中国工商银行</b>	Regional Banks		22	45,853	31,570	+45%
5	<b>SAMSUNG</b>	Technology		33	32,191	24,007	+34%
6	<b>BECK'S</b>	Alcohol		34	32,113	16,983	+89%
7	<b>TOYOTA</b>	Cars		36	29,987	28,660	+5%
8	<b>Baidu 百度</b>	Technology		41	26,861	23,559	+14%
9	<b>中国平安 PINGAN</b>	Insurance		43	26,141	17,260	+51%
10	<b>HUAWEI</b>	Technology		48	24,922	20,388	+22%

Source: BrandZ™ / Kantar Millward Brown (including data from Bloomberg)

BrandZ™ Top 100  
Most Valuable Global  
Brands 2018

Category Brand Value  
Year-on-Year Change

**+42%**

Asia Top 10  
Total Brand Value

**\$556.8 billion**



Funded by the European Union



## How do Intellectual Property Rights contribute to create economic value?

### Indonesia 100 2018 The most valuable Indonesian brands of 2018

Rank				Brand Value  (USD \$ Millions)		Brand rating		
2018	2017	Logo	Name	Country	2018	2017	2018	2017
1 	1		Telkom Indonesia		5,168	4,335	AAA	AAA-
2 	2		Sampoerna		3,460	3,813	AA-	AA
3 	3		BRI		3,164	2,557	AAA-	AA+
4 	5		BCA		2,349	1,896	AAA	AAA
5 	6		Mandiri		2,229	1,887	AAA-	AAA-
6 	-		Pertamina		2,028	-	AA-	-
7 	4		Gudang Garam		1,907	2,251	AA-	AA
8 	7		BNI		1,296	1,156	AAA-	AA+
9 	9		Indosat Ooredoo		741	844	AA-	AA
10 	8		Dji Sam Soe		630	859	A	AA



## Ongoing asset











What is the oldest trademark on record that is still in use?

- Registered in Czechoslovakia in 1859  
Owned by Plzeňský Prazdroj, a. s.

- Small renewal cost
- Asset can continue to add large value



List of results

	Graphic representation	Trade mark name	Trade mark ...	Designated ...	Application number	Registration number
		Pilsner Beer	SK	SK	6649	111602
		PILSENER BEER	CZ	CZ	6649	111602
			CA	CA	1507-00	TMDA359
		BOCEGA	GB	GB	UK000000000043	UK000000000043
		Bodege	GB	GB	UK000000000041	UK000000000041
		RL	GB	GB	UK000000000048	UK000000000048
		BOCEGA	GB	GB	UK000000000042	UK000000000042
		RL	GB	GB	UK000000000044	UK000000000044
		BOCEGA	GB	GB	UK000000000044	UK000000000044
		The Coffee Mill	GB	GB	UK000000000052	UK000000000052

## What to register?

What should I register?

Name, logo, slogan/phrase, colour, sub brands, a combination?



Trade mark	
(350)	<u>NIKE</u>
(210)/(260)Application number	000278028
Trade mark	
(350)	<u>JUST DO IT</u>
(210)/(260)Application number	000514984

	
trade mark name	
Application number	000277517

Separate applications will give better protection:

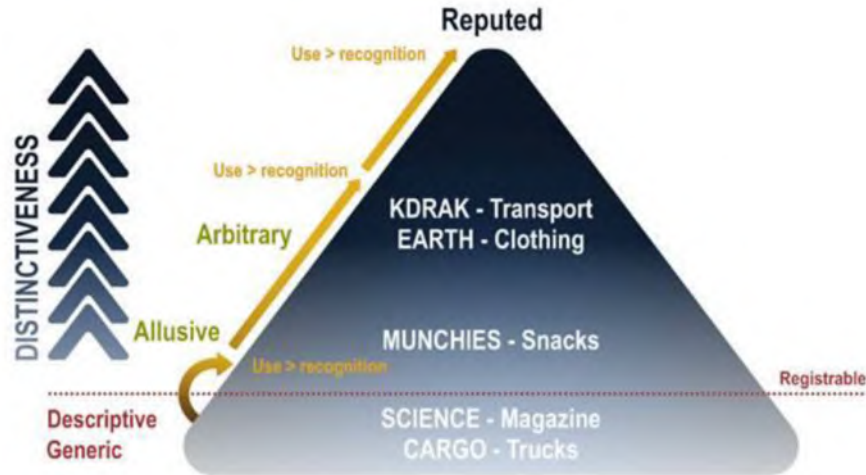


Funded by the European Union

What is most important to my business?

## Absolute grounds

- Make sure the sign complies with requirements
- Later: the stronger, the better



## Overview

1. A unitary protection
2. For trade marks
3. The registration procedure
4. Use in business
5. Search Tools
- 6. Other IP rights**
7. Some figures



## IP working together

☐ **000015610 - LOUIS VUITTON**

[+ info](#)



**eSearch Plus**  
 No preview

### Trade mark information

Trade mark number **000015610**  
 Type **Word**  
 Filing date **01/04/1996**  
 Registration date **16/03/1998**  
 Nice Classification **16, 18, 25**  
 Trade mark status **Registered**  
 Basis **EUTM**  
 Reference

### Owner information

Owner ID number **6708**  
 Owner name **LOUIS VUITTON  
 MALLETIER**

### Representative information

Representative ID num...  
 Representative name

### Last publication

28/06/2016 **C.1.3**

☐ **002533489-0007 - LOUIS VUITTON PARIS LV**

[+ info](#)



### Design information

Design number **002533489-0007**  
 Filing date **08/09/2014**  
 Locarno class number **03.01**  
 Indication of the product **Caskets**  
 Design status **Registered and fully  
 published (A.1.)**  
 Reference **18975/EM**

### Owner information

Owner ID number **6708**  
 Owner name **LOUIS VUITTON MALLETIER**

### Representative information

Representative ID number **55664**  
 Representative name **S  verine Gatti**



Funded by the European Union



## IP working together



**dyson**

IP rights work together to benefit the company

- Patent for technology
- Seen as innovative and builds reputation
- Trademark protects investment in reputation
- Brand allows reputation to transfer to other industries
- Attractive designs registered



Funded by the European Union



## Geographical Indication and trade mark protection



### Goods and services

English (en) ▼

29 Manchego cheese in accordance with the specifications of the protected designation of origin 'Queso Manchego'; Milk products based on cheese in accordance with the specifications of the protected designation of origin 'Queso Manchego'.

## Domain names

Domain names seen as most important by SMEs

**Trade mark**

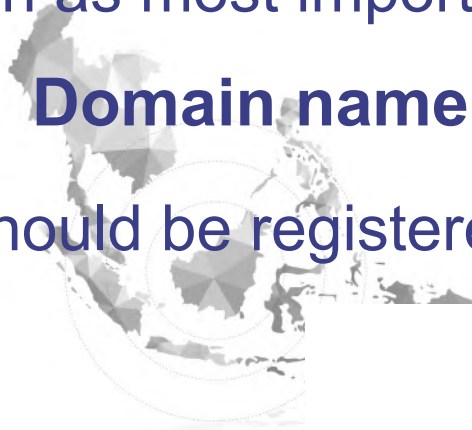
**Domain name**

**Company name**

All important and should be registered

Potential issues

- Cyber squatting
- Misleading invoices
- Errors



Google

www.itscrap.com



www.expertsexchange.com|

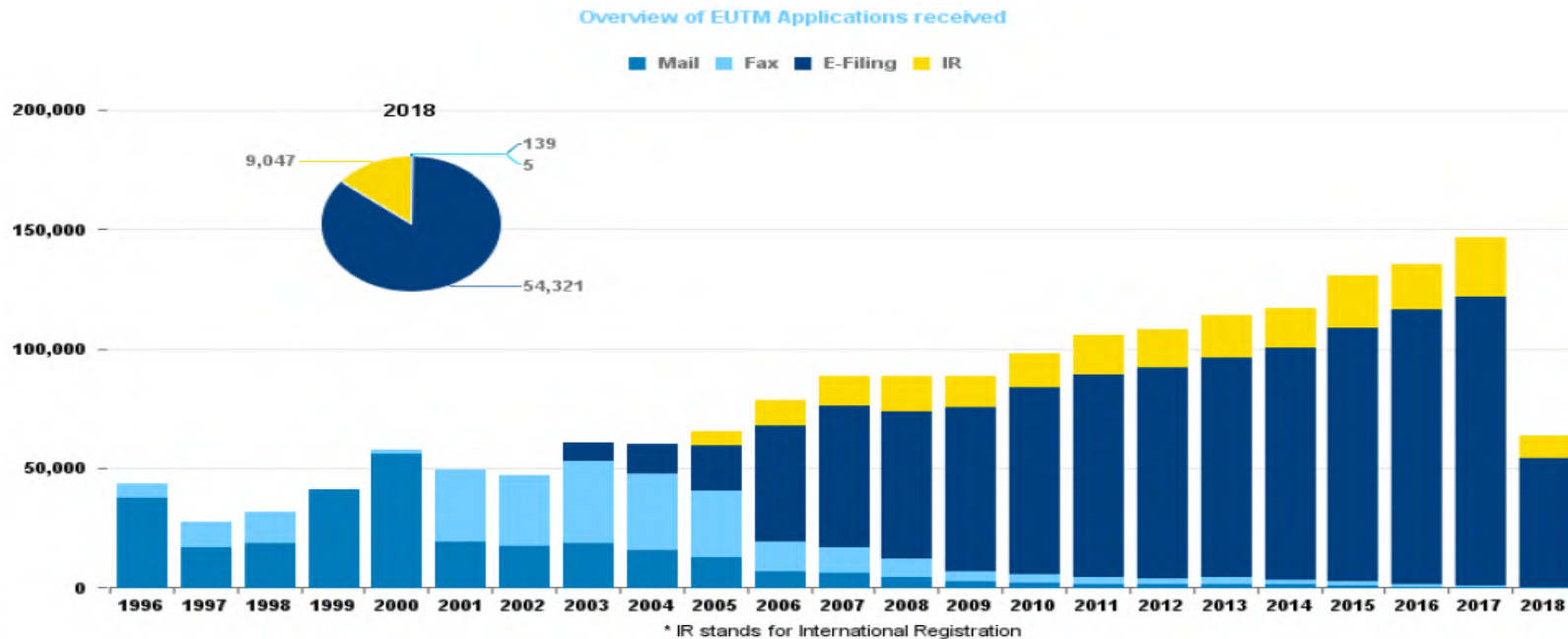


## Overview

1. A unitary protection
2. For trade marks
3. The registration procedure
4. Use in business
5. Search Tools
6. Other IP rights
- 7. Some figures**

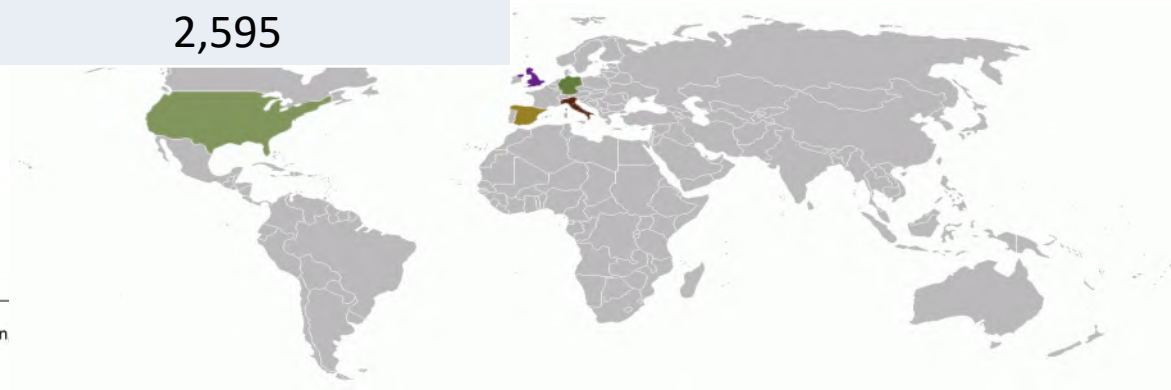


## EUTM APPLICATIONS RECEIVED (1996-2018)



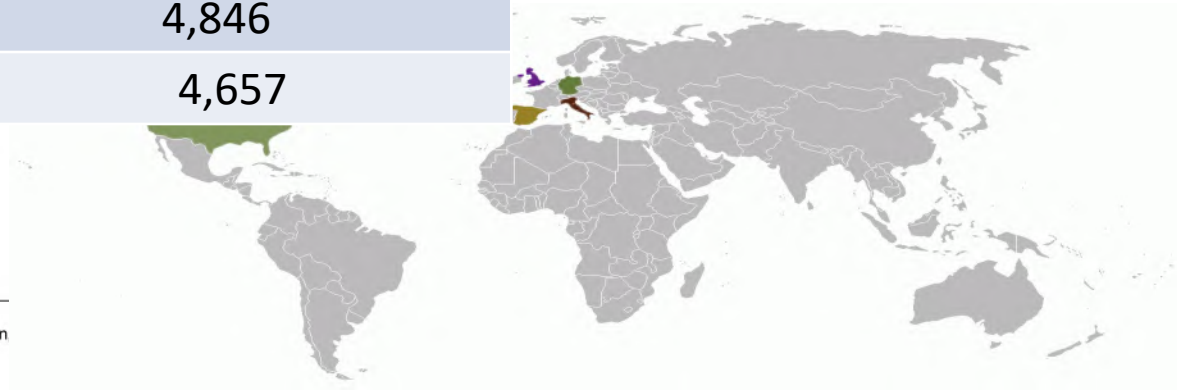
## 2017 EUTM applications

Country	EUTMs filed
1. Germany	21,858
2. USA	16,644
3. China	12,192
4. Italy	11,305
5. UK	11,120
14. Belgium	2,595



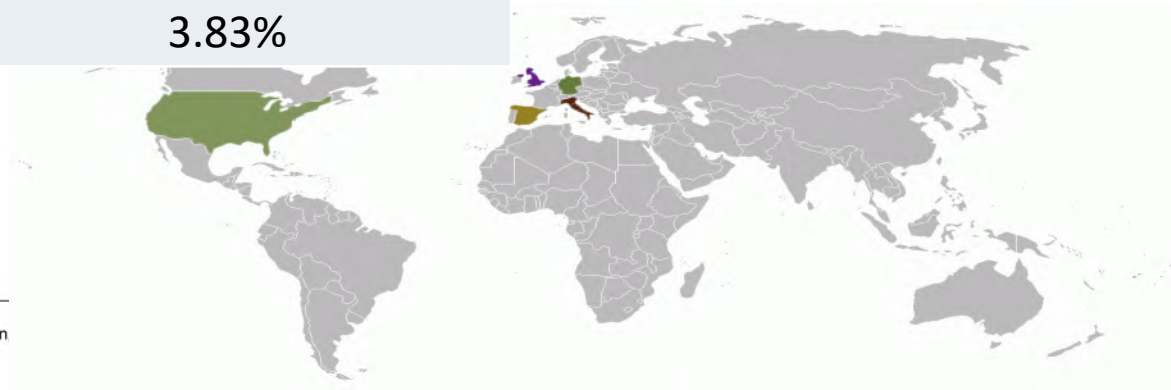
## 2018 EUTM applications (until 5/2018)

Country	EUTMs filed
1. Germany	9,205
2. USA	6,478
3. Italy	6,198
4. China	5,537
5. UK	4,846
13. SPAIN	4,657



## Languages EUTM applications (until 5/2018)

Language	Percentage
1. English	45.84%
2. German	14.01%
3. Italian	8.89%
4. French	7.82%
5. Spanish	7.81%
6. Dutch	3.83%



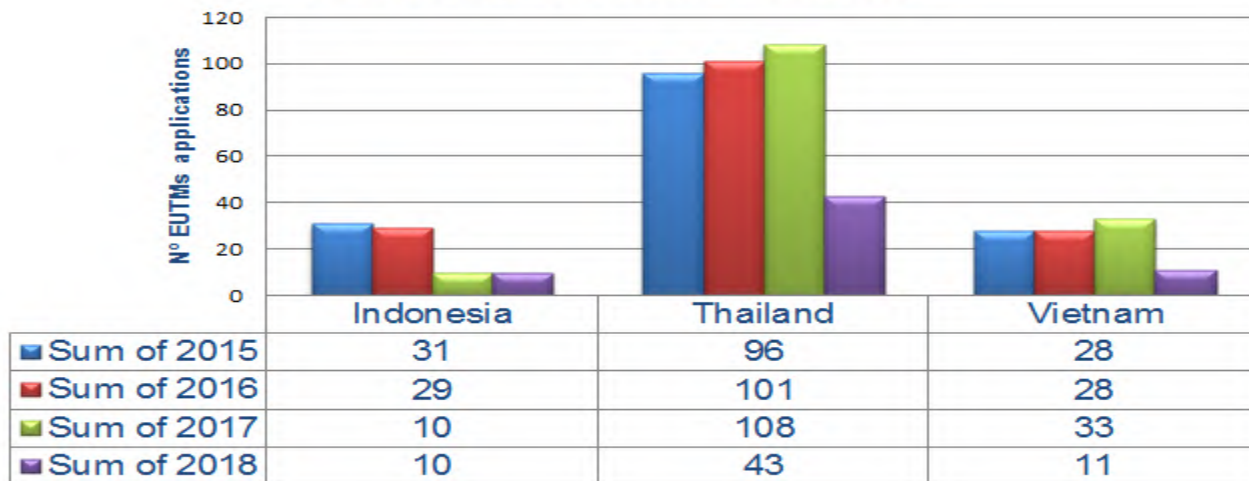


## EUTM applications – 10 most common Nice classes in 2018

Top Nice Codes	EUTMAs related to this Class	% against received EUTMAs
9	5,332	10.43
35	4,745	9.28
42	3,257	6.37
41	2,798	5.47
16	1,582	3.09
25	2,380	4.66
05	1,99	3.32
03	1,644	3.22
38	1.269	2.48
36	1,340	2.62

## Indonesia, Thailand and Vietnam – EUTM applications from 2015 to 05/2018

**EUTM Applications evolution**



Presentation		
Status	DRAFT / APPROVED	
Approved by owner	-SB	Sophia BONNE
Authors	-	
	-	
Contributors	-	
	-	

Revision history			
Version	Date	Author	Description
0.1	DD/MM/YYYY		
0.1	DD/MM/YYYY		
0.1	DD/MM/YYYY		



# THANK YOU

 @IPKey\_EU

