GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Table of Contents

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 1

Means of communication, time limits

Table of Contents

1 Introduction

This part of the Guidelines includes those provisions that are common to all proceedings before the Office in trade mark and design matters, except appeals.

In the interests of efficiency and in order to prevent parties encountering different practices, the Office applies procedural rules consistently.

Proceedings before the Office can be classified into two broad types: ex parte proceedings, which involve only one party, or inter partes proceedings, in which two or more parties are in conflict.

The first category comprises, in particular, applications for registration or renewal of a European Union trade mark (EUTM) or a registered Community design (RCD), transfer-related entries in the Register, licences, levy of execution or bankruptcy, insolvency proceedings, priority/seniority claims and conversion proceedings.

The second category includes opposition and cancellation proceedings (revocation or declaration of invalidity of a registered EUTM or an RCD).

2 Procedures for Filing and for Communication with the Office

Article 30 EUTMR
Articles 63 and 65 EUTMDR
Article 35 CDR
Articles 65 and 68 CDIR

Communications addressed to the Office can be submitted by electronic means, post or courier in proceedings relating to European Union trade marks and in addition by fax and personal delivery in proceedings relating to Community designs. Notifications issued by the Office can be made by electronic means (including fax), post, courier services or public notification.

An application for an EUTM must be filed directly with the Office.

An application for an RCD may be filed directly with the Office, or through a central industrial property office of a Member State or the Benelux Office for Intellectual Property.

E-filing is a recommended means of filing, to the extent that the system gives guidance to the applicant, thus reducing the number of potential deficiencies and speeding up the examination procedure. EUTMs filed through the Office's e-filing system are subject to a reduced fee. The Office also offers the possibility of an accelerated procedure known as Fast Track (for more details, please check the Office's website).

In the event of opting for filing by other means, the Office makes various forms available to the public, in all the official languages of the EU. With one exception, their use is not mandatory but strongly recommended. The exception is when filing an international application or subsequent designation under the Madrid Protocol, for which either the World Intellectual Property Organization's (WIPO) MM 2 or MM 4 form, or the Office's EM 2 or EM 4 form must be used.

Filing RCD applications by fax is not recommended, because the quality of the representation of the design may deteriorate during transmission or on receipt by the Office, and processing such applications may be delayed by up to one month. For further information on filing RCD applications by fax see the Guidelines for Examination of Applications for Registered Community Designs.

3 Notification and Communication of Documents

The EUTMDR and the CDIR distinguish between documents originating from the parties and addressed to the Office and notifications issued by the Office.

A document's date of notification or communication is the date on which that document, is received or is deemed to be received by the addressee (including the Office) (30/01/2014, C-324/13 P, Patrizia Rocha, EU:C:2014:60, § 43). Exactly when receipt is deemed to have taken place will depend on the method of notification or communication.

Any notification addressed to the representative will have the same effect as if it had been addressed to the person represented (Article 60(3) EUTMDR and Article 53 CDIR). Any communication addressed to the Office by a representative will be considered to have originated from the person he or she represents (Article 66 EUTMDR and Article 63 CDIR).

If a professional representative has been duly appointed, the Office will send all notifications solely to the representative (12/07/2012, T-279/09, 100% Capri, EU:T:2012:367; 25/04/2012, T-326/11, BrainLAB, EU:T:2012:202). 'Duly appointed' means that the representative is entitled to act as such and has been properly appointed, and that no general obstacle exists to preclude representation by that person, such as illicit representation of both parties in inter partes proceedings. Filing an authorisation is not required in order to receive Office notifications.

For further details see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

3.1 Communications to the Office in writing or by other means

Article 98(3) EUTMR

Articles 63 and 64 EUTMDR

Articles 65 to 67 CDIR

Decision No EX-19-1 of the Executive Director of the Office concerning communication by electronic means and Conditions of Use of the User Area

Decision No EX-17-6 of the Executive Director of the Office concerning technical specifications for annexes submitted on data carriers

3.1.1 By electronic means

The accepted means of electronic communication with the Office in procedures relating to EUTMs are:

1. the User Area, which is a secure electronic communications platform maintained by the Office that enables users to submit applications and other documents, receive notifications and documents sent by the Office, reply to such notifications and perform other actions,
2. fax.

However, fax is not an accepted means of communication for filing applications for the registration of an EUTM[3]. Nevertheless, exceptionally, where a technical malfunction prevents the applicant from filing through the User Area, an EUTM application submitted by fax will be deemed to have been received by the Office provided that the applicant resubmits, within three workings days of the original fax submission, the application for registration of an EUTM with the same content through the User Area together with a fax receipt clearly identifying the original fax submission. Failure to comply with these conditions will result in the original fax submission being deemed as not having been received.

In procedures relating to Community designs, the only accepted means of electronic communication with the Office is the User Area.

The time of receipt of applications, communications or documents submitted by electronic means is the local time in Alicante (Spain) when the receipt was validated.

Where a communication submitted by electronic means, including fax, is incomplete or illegible, or the Office has reasonable doubts as to the accuracy of the transmission, in accordance with Article 63(3) EUTMDR and Articles 67(3) and 66(2) CDIR, it will advise the sender and invite it to retransmit the communication or to submit a signed original of the document in question to the Office by post or any other available means within a specified deadline. If the retransmission is complete, the date of receipt will be

3 Applicable as of 01/01/2018.

considered to be the date of the first transmission, except for the purposes of establishing a filing date for an application. Otherwise, the Office will not take the transmission into account or will consider only the received and/or legible parts (04/07/2012, R 2305/2010-4, Houbigant / PARFUMS HOUBIGANT PARIS et al.).

For further information on the filing date, see the Guidelines, Part B, Examination, Section 2, Formalities and the Guidelines for Examination of Applications for Registered Community Designs.

3.1.2 By post or courier service

Documents sent by post or courier service should be sent to the Office's official address.

Documents sent by post or courier service must bear an original signature. If a document sent to the Office is not signed, the Office will invite the party concerned to do so within a specific deadline. If the document is not signed within that time, the application or request will be declared inadmissible, or the document will not be taken into account, as the case may be.

The date of receipt is the date on which the Office receives the communication irrespective of when it was placed in the mail or postal system. The time of receipt is the local time in Alicante (Spain).

For further information on copies of the documents submitted in inter partes proceedings, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.2, Substantiation; and the Guidelines for Examination of Design Invalidity Applications, paragraph 4.1, Exchange of communications.

3.1.3 Annexes to communications

In EUTM proceedings, any documents or other items of evidence submitted by the party must be contained in an annex to the submission, be numbered, be accompanied by an index with a short description of each item of evidence together with the number of pages, if applicable, and the page number where it is mentioned in the submission.

During the proceedings stage (i) when the evidence is not structured in numbered annexes; (ii) no index is sent (this meaning, when the required content of the index is not identifiable in any form); or (iii) when, on its own motion or after it being questioned by the other party, the Office finds it justified, in particular when it considers that the failure to comply with the relevant requirements significantly impairs the Office's or the other party's ability to review and assess the documents or items of evidence submitted and to understand the relevance of the same, a deficiency will be raised. A deficiency will not be raised if the content of the annexes is included in the text of the observations.

Annexes to communications may be submitted on data carriers.

In inter partes proceedings, unless submitted by electronic means, any supporting documents, including any annexes or other evidence must be submitted in duplicate,

with one copy to be sent to the other party. Exceptions to this rule are all paper documents (such as loose sheets of evidence) up to and including size A3. However, any other item of evidence (larger than A3 or not on paper, e.g. CDs, DVDs, USB sticks, product samples) that has been submitted to the Office by post or courier must come with a second copy. If no second copy is provided, in proceedings relating to EUTMs, these documents or items of evidence will not be taken into account, whereas in inter partes proceedings relating to Community designs, the Invalidity Division may invite the party to file a second set within a specified deadline.

3.1.4 Signature

Article 63(1) EUTMDR Article 65(1) CDIR

Applications and other communications to the Office must be signed by the sender.

If the application or other communication is filed by electronic means, the indication of the sender's name is deemed to be equivalent to a signature. In proceedings related to European Union trade marks this also covers fax communications as they are electronic means of communication (see above in paragraph 3.1.1). In proceedings related to Community designs, as fax is a sui generis means of communication (see above in paragraph 3.1.1), the indication of the sender's name is not sufficient and the fax communication must also be signed.

If an application or other communication is not signed, the Office will invite the party concerned to correct the deficiency. If it is not remedied within the set time limit, the application will be rejected or the communication not taken into account.

For joint requests submitted in one single submission by electronic means in inter partes proceedings, the indication of the sender's name is deemed to be equivalent to its signature; however, the other party's signature must be presented in order for the request to be acceptable.

3.2 Notification by the Office

Article 94(2) and Article 98 EUTMR Articles 56 to 62 EUTMDR Article 41(1) and Articles 47 to 53 CDIR Decision No EX-18-4 of the President of the Office concerning public notification Decision No EX-19-1 of the Executive Director of the Office concerning communication by electronic means

Written communications from the Office to the party or parties to proceedings will be 'notified'. A document is considered to be notified when it has been received or is deemed to have been received by the addressee, irrespective of whether the addressee has been advised of this. Consequently, the date of notification of a document is the date on which that document is made accessible to or has reached the addressee, and not the date on which it was sent or the date on which the person to whom it was addressed actually learned of the notification. However, exactly when receipt is deemed to take place will depend on the method of notification.

The Office can choose freely the most appropriate means of notification, apart from public notification, although some means of notification require the party's prior consent.

In practice, the Office will always opt to notify by electronic means, if the party has previously accepted this means of communication, whenever feasible.

If the proper notification procedure has been followed, the document is deemed to have been notified, unless the recipient can prove that it either did not receive the document at all, or received it late. If this is proved, the Office will re-notify the document(s) Conversely, where the proper notification procedure was not followed, the document will still be considered notified if the Office can prove that the document actually reached the recipient (13/01/2011, T-28/09, Pine Tree, EU:T:2011:7, § 32).

Any communication or notification from the Office will indicate the department or division of the Office and the name(s) of the official(s) responsible. These documents have to be signed by the official(s) or, if not, bear the Office's printed or stamped seal.

3.2.1 Notification by electronic means

3.2.1.1 Notification via the User Area

The User Area offers the option of receiving all communications from the Office electronically. If the user selects this option, the Office will send all notifications through the User Area, unless this is impossible for technical reasons.

The document is deemed to have been notified on the fifth calendar day following the day on which the document is placed in the user's inbox irrespective of whether the recipient actually opened and read it.

3.2.1.2 Notification by fax

Where the party has not previously signed up for communication via the User Area, the Office may use notification by fax if the party has indicated a fax number, the exception being notifications that include colour elements.

Notification by fax will be deemed to have taken place on the date on which the recipient's fax receives it. The Office keeps fax logs so that it can prove the transmission time and content. In the absence of any evidence to the contrary or information that casts doubt on the correct transmission of the notification, the date of receipt of a fax may be established by the Office transmission report (13/01/2011, T-28/09, Pine Tree, EU:T:2011:7, § 32).

3.2.2 Notification by post or courier

The procedure for notification by post or courier will depend on the nature of the document notified.

Decisions subject to a deadline for appeal, summonses and other documents as determined by the Executive Director of the Office will be notified by courier service or registered post, in both cases with advice of delivery.

All other notifications can be sent either by courier service or registered post, with or without advice of delivery, or by ordinary post. If the recipient's address is not in the EEA or the addressee has not appointed a professional representative, the Office will send the document by ordinary post.

Notification will be deemed to have taken place 10 days after the document was posted. The recipient can only rebut this presumption by proving that it did not receive the document or that it received it later. Indications giving rise to reasonable doubt about correct receipt are considered to be sufficient proof (25/10/2012, T-191/11, Miura, EU:T:2012:577, § 34). In the event of a dispute, the Office must establish that the notification reached its destination or establish the date on which it was delivered to the addressee.

Notification by registered letter will be deemed to have been effected even if the addressee refuses to accept the letter.

3.2.3 Public notification by public notice

Public notification will be used for all notifications where the addressee's address is unknown or where a notification by post has been returned to the Office after at least one failed attempt.

This relates primarily to post returned to the Office by the Post Office marked 'not known at this address' and post that has not been claimed by the addressee.

Public notifications will be published on the Office's website. The document will be deemed to have been notified one month after the day on which it was posted on the internet.

4 Time Limits Specified by the Office

Article 101 EUTMR Articles 67 to 69 EUTMDR Articles 56 to 58 CDIR

Time limits before the Office can be divided into two categories:

- those laid down by the EUTMR, EUTMDR, EUTMIR, CDR or CDIR, which are therefore mandatory;
- those specified by the Office, which are therefore not mandatory and can be extended under certain circumstances.

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. They are a matter of public policy and rigorous compliance with them is necessary to ensure clarity and legal certainty.

The regulations provide three measures that mitigate the rigorous application of the principle of strict observance of time limits (deadlines), depending on whether they are still running or have expired.

If the time limit is still running, the party may request an extension of the time limit pursuant to Article 68 EUTMDR and Article 57(1) CDIR.

In RCD proceedings, if the time limit has expired, the party that has missed it can request restitutio in integrum (pursuant to Article 67 CDR), which requires meeting formal and substantive requirements (such as showing all due care).

In EUTM proceedings, if the time limit has expired, the party that has missed it has two possible courses of action: it can either seek continuation of proceedings (pursuant to Article 105 EUTMR), which only requires meeting certain formal requirements, or it can request restitutio in integrum (pursuant to Article 104 EUTMR), which requires meeting formal and substantive requirements (such as showing all due care).

Additional information is provided under paragraphs 4.4 and 4.5 below.

4.1 Length of the time limits specified by the Office

Regarding EUTM proceedings, with the exception of the time limits expressly specified in the EUTMR, EUTMDR, or EUTMIR, the time limits specified by the Office may not be less than one month or longer than six months.

Regarding RCD proceedings, with the exception of the time limits expressly specified in the CDR or CDIR, the time limits specified by the Office, when the party concerned has its domicile or its principal place of business or an establishment within the EU may not be less than one month or longer than six months. When the party concerned does not have its domicile or principal place of business or an establishment within the EU, the time limits may not be less than two months or longer than six months.

The general practice is to grant two months.

For further information, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

4.2 Expiry of time limits

Where the Office sets a time limit in a notification, the 'relevant event' is the date on which the document is notified or deemed notified, depending on the rules governing the means of notification.

Where a time limit is expressed in months, it will expire in the relevant subsequent month on the same day as the day on which the 'relevant event' occurred.

For example, if the Office sets a two-month time limit in a communication that is notified by fax on 28 June, the time limit will expire on 28 August. It is immaterial whether the 'relevant event' occurred on a working day, a holiday or a Sunday; that is relevant only for the expiry of the time limit.

Where the relevant subsequent month has no day with the same number or where the day on which the event occurred was the last day of the month, the time limit in question will expire on the last day of that month. A two-month time limit specified in a notification on 31 July will therefore expire on 30 September. Similarly, a two-month time limit set in a notification on 30 June will expire on 31 August.

The same applies to time limits expressed in weeks or years.

Any time limit will be deemed to expire at midnight on the final day (local time in Alicante (Spain)).

A time limit that expires on a day on which the Office is not open for receipt of documents or on which ordinary post is not delivered in the locality in which the Office is located (Saturdays, Sundays and public holidays) will be extended to the first working day thereafter. For this purpose, the Executive Director of the Office determines the days on which the Office is closed before the start of each calendar

year. The extension is automatic but it applies only at the end of the time limit (12/05/2011, R 924/2010-1, whisper power (fig.) / WHISPER).

In the event of a general interruption to the postal service in Spain or to the Office's connection to authorised electronic means of communication, any time limit that expires during that period will be extended to the first working day after the period of interruption. These periods will be determined by the Executive Director of the Office; the extension will apply to all parties to the proceedings.

In the event of an exceptional occurrence (strike, natural disaster, etc.) causing a disruption to the running of the Office or a serious impediment to its communication with the outside world, time limits may be extended for a period determined by the Executive Director of the Office.

4.3 Extension of time limits

In ex parte proceedings before the Office, if a request is made for an extension before the time limit expires, then a further period should be allowed, depending on the circumstances of the case, but not exceeding six months.

For the rules applicable to the extension of time limits in inter partes proceedings (i.e. where there are two or more parties involved, such as in opposition, invalidity and/or revocation proceedings), see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, and the Guidelines for Examination of Design Invalidity Applications.

As a general rule the first request for an extension that is received in time will be considered appropriate and will be granted for a period of two months (or less if requested). However, any subsequent request for an extension of the same time limit will be refused unless the party requesting it can explain and justify the 'exceptional circumstances' that (a) prevented it from carrying out the required action during the previous two periods (i.e. the original time limit plus the first extension) and (b) still prevent the requester from carrying it out, so that more time is needed.

Examples of justifications that can be accepted:

- 'Evidence is being gathered from distribution channels/all our licensees/our suppliers in several Member States. So far, we have gathered documents from some of them but, due to the commercial structure of the company (as shown in the document enclosed), we have only recently been able to contact the rest.'
- 'In order to show that the mark has acquired distinctiveness through use we started carrying out market research at the beginning of the period (on date X). However, the fieldwork has only recently been concluded (as shown in the enclosed documents); consequently, we need a second extension in order to finish the analysis and prepare our submissions to the Office.'
- 'Death' is also considered an 'exceptional circumstance'. The same applies to serious illness, provided that no reasonable substitution was available.
- Finally, 'exceptional circumstances' also include 'force majeure' situations. 'Force majeure' is defined as a natural and unavoidable catastrophe that interrupts the

expected course of events. It includes natural disasters, wars and terrorism, and unavoidable events that are beyond the party's control.

Where a request is filed for an extension to an extendable time limit before this time limit expires and is not accepted, the party concerned will be granted at least one day to meet the deadline, even if the request for an extension arrives on the last day of the time limit.

4.4 Continuation of proceedings

Article 105 EUTMR

Continuation of proceedings is not available in RCD proceedings.

The expressions 'further processing' and 'continuation of proceedings' have the same meaning.

Article 105 EUTMR provides for the continuation of proceedings where time limits have been missed but excludes various time limits laid down in certain articles of the EUTMR.

The excluded time limits are the following:

- those laid down in Article 104 EUTMR, avoiding double relief for the same time limits;
- those referred to in Article 139 EUTMR, that is to say, the three-month period within which conversion must be requested and the conversion fee paid;
- the opposition period and the time limit for paying the opposition fee laid down in Article 46 EUTMR;
  None of the other time limits during the opposition procedure are referred to in Article 105 EUTMR and, therefore, they are not excluded from further processing. Consequently, the Office will grant further processing for:
  - the time limit under Article 146(7) EUTMR to translate the notice of opposition;
  - the time limit under Article 5(5) EUTMDR to remedy deficiencies that affect the admissibility of the opposition;
  - the time limits for the opponent to substantiate its opposition under Article 7 EUTMDR;
  - the time limit laid down in Article 8(2) EUTMDR for the applicant to reply;
  - the time limit under Article 8(4) EUTMDR for the opponent to reply;
  - the time limits for any further exchange of arguments, if allowed by the Office (07/12/2011, R 2463/2010-1, Pierre Robert / Pierre Robert (fig.);
  - the time limit under Article 10(1) EUTMDR for the applicant to request that the opponent prove use of its earlier mark;
  - the time limit under Article 10(2) EUTMDR for the opponent to submit proof of use of its earlier mark;
  - the time limit under Article 10(6) EUTMDR to translate proof of use.

- those laid down in Article 32, Articles 34(1), 38(1), 41(2) and 53(3), Article 68 and Article 72(5) EUTMR, and the time limits laid down by the EUTMIR for claiming, after the application has been filed, seniority within the meaning of Article 39 EUTMR.

Article 105 EUTMR does not exclude any of the time limits that apply in proceedings for revocation or declaration of invalidity.

The party seeking continuation of proceedings must make the request, for which a fee is charged as established in Annex I of the EUTMR, within two months of the expiry of the original time limit and complete the omitted act by the time the request for continuation is received. A request for an extension of time does not constitute the completion of the 'omitted act'.

There can be no extension or continuation of the two-month deadline. There is no substantive requirement to be fulfilled such as when requesting restitutio in integrum.

If the Office accepts the request for continuation of proceedings, the consequences of having failed to observe the time limit will be deemed not to have occurred. If a decision has been taken between the expiry of that time limit and the request for the continuation of proceedings, the department competent to decide on the omitted act will review the decision and, where completion of the omitted act itself is sufficient, take a different decision. If, following the review, the Office concludes that the original decision does not need to be altered, it will confirm that decision in writing.

4.5 Restitutio in integrum

A party to proceedings before the Office may be reinstated in its rights (restitutio in integrum) if, in spite of all due care required by the circumstances having been taken, it was unable to meet a time limit vis-à-vis the Office, provided that the failure to meet the time limit had the direct consequence, by virtue of the provisions of the regulations, of causing the loss of any right or means of redress.

For further information see the Guidelines, Part A, General Rules, Section 8, Restitutio in Integrum.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 2

General principles to be respected in the proceedings

Table of Contents

1 Adequate Reasoning

Articles 94 to 97 and 109 EUTMR Articles 62 to 65 and 70 CDR Article 38 CDIR

Office decisions will be in writing and will state the reasons on which they are based. The reason for this is twofold: to explain to interested parties why the measure was taken so that they can protect their rights, and to enable the Courts of the European Union to exercise their power to review the legality of the decision (12/07/2012, T-389/11, Guddy, EU:T:2012:378, § 16; 22/05/2012, T-585/10, Penteo, EU:T:2012:251, § 37, as well as the case-law cited; 27/06/2013, T-608/11, Instruments for writing, EU:T:2013:334, § 67).

However, if the Office does not respond to all the arguments raised by the parties, this does not necessarily infringe the duty to state reasons (11/06/2014, T-486/12, Metabol, EU:T:2014:508, § 19; 28/01/2014, T-600/11, Carrera panamericana, EU:T:2014:33, § 21; 15/07/2014, T-576/12, Protekt, EU:T:2014:667, § 78; 18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 15).

It is sufficient that it sets out the facts and legal considerations of fundamental importance in the context of the decision (18/01/2013, T-137/12, Vibrator, EU:T:2013:26, § 41-42; 20/02/2013, T-378/11, Medinet, EU:T:2013:83, § 17; 03/07/2013, T-236/12, Neo, EU:T:2013:343, § 57-58; 16/05/2012, T-580/10, Kindertraum, EU:T:2012:240, § 28; or 10/10/2012, T-569/10, Bimbo Doughnuts, EU:T:2012:535, § 42-46, 08/05/2014, C-591/12 P, Bimbo Doughnuts, EU:C:2014:1273).

The Office can use facts that are a matter of common knowledge as a basis for its reasoning. Well-known facts are those that are very likely to be known by anyone or may be learnt from generally accessible sources or those that are very likely to be known by anyone with general practical experience of marketing consumer goods and in particular by the consumers of those goods.

The Office is not required to prove the accuracy of these well-known facts and, therefore, it is not obliged to give examples of such practical experience; it is up to the party concerned to submit evidence to refute it (20/03/2013, T-277/12, Caffè Kimbo, EU:T:2013:146, § 46; 11/07/2013, T-208/12, Rote Schnürsenkelenden, EU:T:2013:376, § 24; 21/02/2013, T-427/11, Bioderma, EU:T:2013:92, § 19-22; 08/02/2013, T-33/12, Medigym, EU:T:2013:71, § 20, 25; 07/12/2012, T-42/09, Quadratum, EU:T:2012:658, § 73; 19/09/2012, T-231/11, Stoffmuster, EU:T:2012:436, § 51).

2 The Right to Be Heard

Articles 94 to 97 and 109 EUTMR Article 62 CDR

The defence's right to be heard is a general principle of EU law, according to which a person whose interests are appreciably affected by a decision addressed to him or her by a public authority must be given the opportunity to make his or her point of view known. In accordance with that principle, the Office may base its decision only on matters of fact or of law on which the parties have been able to set out their views. Consequently, where the Office gathers facts to serve as a basis for its decision, it is obliged to notify the parties of those facts in order that the parties may submit their views on them (07/11/2014, T-567/12, Kaatsu, EU:T:2014:937, § 50-51 and case-law cited therein).

The right to be heard covers all the matters of fact or law and evidence that form the basis for the decision.

The Office will take legal issues into account, irrespective of whether or not they have been pleaded by the parties. For examination, it will examine the facts on its own motion; however, in opposition, cancellation and design invalidity proceedings, it will restrict its examination of facts, evidence and arguments to those provided by the parties. Nevertheless, this restriction does not prevent the Office from taking additional well-known facts into consideration.

While the Office must rule on each head of claim (10/06/2008, T-85/07, Gabel, EU:T:2008:186, § 20), it is not required to give express reasons for its assessment in respect of each and every piece of evidence submitted or arguments put forward, where it considers that evidence or arguments to be unimportant or irrelevant to the outcome of the dispute (15/06/2000, C-237/98 P, Dorsch Consult v Council and Commission, EU:C:2000:321, § 51).

The right to be heard does not apply to the final position to be adopted. Therefore, the Office is not bound to inform the parties of its legal opinion before issuing a decision and thus afford them the opportunity to submit their observations on that position or even to submit additional evidence (09/07/2014, T-184/12, Heatstrip, EU:T:2014:621, § 37; 14/06/2012, T-293/10, Colour per se, EU:T:2012:302, § 46 in fine; 08/03/2012, T-298/10, Biodanza, EU:T:2012:113, § 101; 20/03/2013, T-277/12, Caffè Kimbo, EU:T:2013:146, § 45-46).

Changing circumstances arising in the course of the proceedings (e.g. if during opposition proceedings the earlier right on which the opposition was based lapses because it is not renewed or is declared invalid) will also be taken into account and the parties will be informed accordingly.

3 Other General Principles of EU Law

The Office must respect the general principles of EU law, such as equal treatment and sound administration (24/01/2012, T-260/08, Visual Map, EU:T:2012:23; 23/01/2014, T-68/13, Care to care, EU:T:2014:29, § 51; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 73).

For reasons of legal certainty and of sound administration, there must be a stringent and full examination of all applications in order to prevent trade marks and designs from being improperly registered. That examination must be undertaken in each individual case (23/01/2014, T-68/13, Care to care, EU:T:2014:29, § 51).

The lawfulness of the Office's decisions must be assessed solely on the basis of EU regulations, as interpreted by the European Union judicature. Accordingly, the Office is not bound either by its previous decision-making practice or by a decision given in a Member State, or indeed a third country, that the sign/design in question is registrable as a national mark/design (23/01/2014, T-513/12, Norwegian getaway, EU:T:2014:24, § 63). This is true even if the decision was adopted in a country belonging to the linguistic area in which the word sign in question originated (16/05/2013, T-356/11, Equipment, EU:T:2013:253, § 7).

However, in the light of the principles of equal treatment and sound administration, the Office will take into account the decisions already taken in respect of similar applications and must carefully consider whether it should decide in the same way or not (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 74-75; 27/02/2014, T-225/12, LIDL express, EU:T:2014:94, § 56; 23/01/2014, T-68/13, Care to care, EU:T:2014:29, § 51; 12/12/2013, T-156/12, Oval, EU:T:2013:642, § 28).

Moreover, the principle of equal treatment and sound administration must be applied in a manner that is consistent with the principle of legality, according to which a person may not rely, in support of his or her claim, on an unlawful act committed in another procedure (23/01/2014, T-68/13, Care to care, EU:T:2014:29, § 51; 12/12/2013, T-156/12, Oval, EU:T:2013:642, § 29; 02/05/2012, T-435/11, UniversalPHOLED, EU:T:2012:210, § 38; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 76-77).

4 Means of Taking Evidence

Articles 96 to 97 EUTMR
Articles 49 to 55 EUTMDR
Articles 64 to 65 CDR
Articles 42 to 46 CDIR
Decision No EX-99-1 of the President of the Office of 12/01/1999 as amended by Decision No EX-03-2 of the President of the Office of 20/01/2003

In any proceedings before the Office, evidence may be taken. The means for taking evidence are listed in Article 97 EUTMR, Article 51 EUTMDR, Article 65 CDR and Article 43 CDIR, although that list is not exhaustive.

The means of evidence are as follows:

- hearing the parties,
- requests for information,
- the production of documents and items of evidence,
- hearing witnesses,
- opinions by experts,
- sworn or affirmed statements in writing or statements having a similar effect under the law of the State in which they are drawn up,
- inspection.

Some of these means, such as requests for information, statements in writing and, in particular, the submission of documents and items of evidence, will be used more frequently than others. Hearing the parties, witnesses or experts, and inspections are used only exceptionally.

The Office will decide which of these means to use but will use them only when necessary for examining the file.

If the Office refuses a request to take evidence, an appeal can only be made together with the appeal against the final decision.

The procedure followed by the Office varies depending on the means of taking evidence proposed.

4.1 Written evidence

When taking evidence, the Office will confine itself to written evidence in most cases. This is the least costly, simplest and most flexible means of taking evidence.

The Office will therefore give preference to the submission of documents and items of evidence. However, other possible written means of taking evidence include not only a

request for information or statements in writing that have been sworn or affirmed or have a similar effect thereto under the law of the State in which they are drawn up, but also opinions by experts, which may consist solely of a written report.

The Regulations make no provision for any special procedure or formality. Therefore, the Office's general rules of procedure apply.

In EUTM proceedings, any documents or other items of evidence submitted by one party must be contained in an annex to the submission, be numbered, and be accompanied by an index, a short description of each item of evidence together with the number of pages, if applicable, and the page number of the submission where it is mentioned. In inter partes proceedings, unless submitted by electronic means, any supporting documents, including annexes or other evidence must be submitted in two copies (for further information see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits). The written evidence will be communicated to the other party as soon as possible, and the Office may set the other party a time limit of, in principle, 2 months to reply.

A deficiency will be raised during the proceedings stage (i) when the evidence is not structured in numbered annexes; (ii) when no index is sent (that is to say, when the required content of the index is not identifiable in any form); or (iii) when, on its own motion or after being questioned by the other party, the Office finds it justified, in particular when it considers that the failure to comply with the relevant requirements significantly impairs the Office's or the other party's ability to review and assess the documents or items of evidence submitted and to understand the relevance of the same. A deficiency will not be raised if the content of the annexes is included in the text of the observations.

Any such deficiency may be overcome by structuring the evidence in numbered annexes, or submitting an index identifying the content of the annexes, as applicable.

Where the deficiency is not remedied within the period specified by the Office, and where it is still not possible for the Office to clearly establish to which ground or argument a document or item of evidence refers, that document or item will not be taken into account.

The Office will base its decision only on reasons on which both sides have had an opportunity to submit observations, and will identify those items of evidence not taken into account due to not fulfilling the requirements of Article 55 EUTMDR.

No such specific provisions as to the format of document or items of evidence exist for RCD proceedings. Therefore, documents or items of evidence submitted by one party will be communicated to the other parties as soon as possible, and the Office may set the other parties a time limit of, in principle, 2 months to reply.

For further information on oral proceedings, see paragraph 5 below.

4.2 Oral evidence and inspections

This refers to evidence taken in oral proceedings, such as hearing the oral evidence of parties, witnesses or experts, or carrying out inspections.

Only in exceptional cases will the Office decide to hear oral evidence, in particular because of the cumbersome nature of the procedure, which is liable to protract the proceedings, and because of the cost, which will have to be borne by the unsuccessful party in inter partes proceedings or, in some cases, by both parties.

If the Office invites one of the parties to give evidence orally, it will advise the other parties accordingly so that they can attend.

Similarly, when the Office summons an expert or a witness to a hearing, it will advise the parties concerned. These may be present and put questions to the person giving evidence.

4.3 Specific means of evidence

4.3.1 Commissioning of experts by the Office

Opinions by experts will be used only as a last resort because they involve substantial costs and protract the proceedings.

It is up to the Office to decide whether or not to commission an expert's opinion, who to appoint as expert and what form the opinion should take. However, the Office does not maintain a list of experts because it uses experts as a means of taking evidence only by way of exception.

The terms of reference of the expert include:

- a precise description of their task;
- the deadline for submitting their opinion;
- the names of the parties to the proceedings;
- details of any costs to be reimbursed by the Office.

The expert opinion must be submitted in the language of the proceedings or accompanied by a translation into that language. A copy of any written opinion, and of the translation if needed, must be submitted to the parties. If the Office considers the report sufficient, and if the parties accept this form of report, it will in principle be used only in its written form.

The submission of an oral report or the hearing of oral evidence given by the expert will therefore be at the Office's discretion.

The parties can object to an expert on the grounds of incompetence or a conflict of interest, or because the expert was previously involved in the dispute or is suspected of partiality. No refusal may be based on the appointed expert's nationality. If a party objects to the expert, the Office will rule on the objection. The grounds that may be

cited for objecting to an expert are the same as those for objecting to an examiner or Board of Appeal member pursuant to Article 169 EUTMR and Article 44(4) CDIR.

4.3.2 Affidavits

Sworn or affirmed statements in writing or statements having a similar effect under the law of the State in which the statement is drawn up are equally admissible as evidence if submitted by a party.

In order for a statement to be considered sworn or affirmed, it must be understood by the parties that making a false statement would be considered a criminal offence under the law of the Member State in which the document was drawn up. Where that is not the case, the document will be considered simply as any other written document or statement (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 32 and the case-law cited therein).

The evidential value of an affidavit is relative (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 33). In assessing the evidential value of such a document, the Office will consider first and foremost the credibility of the account it contains. It will then take account, in particular, of the person who produced the document, the circumstances in which it came about, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42 and the case-law cited therein; 18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 26). Affidavits containing detailed and concrete information and/or that are supported by other evidence have a higher probative value than very general and abstractly drafted statements.

The mere fact that affidavits from third parties are made according to a predetermined draft provided by the interested party (parties) does not in itself affect their reliability and credibility, and does not call into question their probative value since the veracity of their contents is certified by the signatory (16/09/2013, T-200/10, Avery Dennison, EU:T:2013:467, § 73).

4.3.3 Inspections

Only in very exceptional circumstances will the Office carry out an inspection in situ. If it does decide to carry out an inspection, it will take an interim decision to that end, stating the means by which it intends to obtain evidence (in the present case, an inspection), the relevant facts to be proved, and the date, time and place of the inspection.

The date fixed for the inspection must allow the party concerned sufficient time to prepare for it. If the inspection cannot take place for any reason, the proceedings will continue based on the evidence on file.

5 Oral Proceedings

Articles 96 to 97 EUTMR
Articles 49 to 55 EUTMDR
Articles 64 to 65 CDR
Articles 42 to 46 and 82 CDIR

Article 96 EUTMR and Article 64 CDR provide that the Office may hold oral proceedings.

Any unofficial contacts such as telephone conversations will not be considered to constitute oral proceedings within the meaning of Article 96 EUTMR and Article 64 CDR.

The Office will hold oral proceedings either on its own initiative or at the request of any party to the proceedings only when it considers these to be absolutely necessary. This will be at the Office's discretion (20/02/2013, T-378/11, Medinet, EU:T:2013:83, § 72 and the case-law cited therein; 16/07/2014, T-66/13, Flasche, EU:T:2014:681, § 88). In the vast majority of cases it will be sufficient for the parties to present their observations in writing.

5.1 Summons to oral proceedings

Where the Office has decided to hold oral proceedings and to summon the parties, the period of notice may not be less than one month unless the parties agree to a shorter period.

Since the purpose of any oral proceedings is to clarify all outstanding points before the final decision is taken, the Office, in its summons, should draw the parties' attention to the points that need to be discussed in order for the decision to be taken.

Where the Office considers it necessary to hear oral evidence from the parties, witnesses or experts, it will take an interim decision stating the means by which it intends to obtain evidence, the relevant facts to be proven and the date, time and place of the hearing. The period of notice will be at least one month, unless the parties concerned agree to a shorter period. The summons will provide a summary of this decision and state the names of the parties to the proceedings and details of the costs, if any, that the witnesses or experts may be entitled to have reimbursed by the Office.

The Office may also offer the possibility of taking part in the oral proceedings by video conference or other technical means.

If required, and in order to facilitate the hearing, the Office may invite the parties to submit written observations or to submit evidence prior to the oral hearing. The period

fixed by the Office for receiving these observations must allow sufficient time for them to reach the Office and then be forwarded to the other parties.

The parties may likewise submit evidence in support of their arguments on their own initiative. However, if this evidence ought to have been produced at an earlier stage of the proceedings, the Office will decide whether these items of evidence are admissible, taking account of the principle of hearing both parties, where appropriate.

5.2 Language of oral proceedings

Oral proceedings will be in the language of the proceedings unless the parties agree to use a different official EU language.

The Office may communicate in oral proceedings in another official EU language and it may, upon prior written request, authorise a party to communicate in another official EU language provided that simultaneous interpretation of the communication into the language of proceedings can be made available. The costs of providing simultaneous interpretation will be paid by the party making the request or by the Office as the case may be.

5.3 Course of the oral proceedings

Oral proceedings before the examiners, the Opposition Division and the department in charge of the Register will not be public.

Oral proceedings, including the delivery of the decision, will be public before the Cancellation/Invalidity Division and the Boards of Appeal, insofar as the department before which the proceedings are taking place does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

If a party who has been duly summoned to oral proceedings does not appear before the Office, the proceedings may continue without them.

If the Office invites a party to give evidence orally, it will advise the other parties accordingly so that they can attend.

Similarly, when the Office summons an expert or a witness to a hearing, it will advise the parties concerned. These may be present and put questions to the person giving evidence.

At the end of the oral proceedings the Office will allow the parties to present their final pleadings.

5.4 Minutes of oral evidence and of oral proceedings

Article 53 EUTMDR Article 46 CDIR

Minutes of the taking of oral evidence and of oral proceedings will be confined to the essential elements. In particular, they will not contain the verbatim statements made nor be submitted for approval. However, any statements by experts or witnesses will be recorded so that at further instances the exact statements made can be verified.

Where oral proceedings or the taking of evidence before the Office are recorded, the recording will replace the minutes.

The parties will receive a copy of the minutes.

5.5 Costs of taking evidence in oral proceedings

The Office may make the taking of evidence conditional upon a deposit by the party requesting it. The amount will be fixed by the Office based on an estimate of the costs.

The witnesses and experts summoned or heard by the Office will be entitled to reimbursement of expenses for travel and subsistence, including an advance. They will also be entitled to compensation for loss of earnings and payment for their work.

The amounts reimbursed and the advances for expenses are determined by the Executive Director of the Office and are published in the Office's Official Journal. For details, see Decision No EX-99-1 of the President of the Office of 12/01/1999 as amended by Decision No EX-03-2 of the President of the Office of 20/01/2003.

Where the Office decides to adopt means of taking evidence that require oral evidence from witnesses or experts, the Office will bear the cost of this. However, where one of the parties has requested oral evidence, then that party will bear the cost, subject to a decision on the apportionment of costs in inter partes proceedings.

6 Decisions

6.1 Contents

Article 94 EUTMR
Article 62 CDR
Articles 38 to 41 CDIR

Office decisions will be reasoned to such an extent that their legality can be assessed at the appeal stage or before the General Court or Court of Justice.

The decision will cover the relevant points raised by the parties. In particular, if there are different outcomes for some goods and services of the EUTM application or registration concerned, the decision will make clear which of the goods and services are refused and which are not.

The name or names of the person(s) who took the decision will appear at the end of the decision.

At the end of the decision, there will also be a notice advising of the right to appeal.

Failure to include this notice does not affect the legality of the decision and does not affect the deadline for filing an appeal.

6.2 Apportionment of costs

Article 105(5), Article 109 and Annex I A(33)EUTMR
Article 33 EUTMDR
Article 70 CDR
Articles 37 and 79 CDIR
Article 24 of the Annex to the CDFR

‘Costs’ comprise the costs incurred by the parties to the proceedings, chiefly (i) representation costs and costs for taking part in oral hearings (‘representation costs’ means the costs for professional representatives within the meaning of Article 120 EUTMR and Article 78 CDR, not for employees — not even those from another company with economic links); and (ii) the opposition, cancellation or invalidity fee.

‘Apportionment of costs’ means that the Office will decide whether and to what extent the parties have to reimburse each other. It does not involve the relationship with the Office (fees paid, the Office’s internal costs).

In ex parte proceedings, there is no decision on costs, nor any apportionment of costs. The Office will not reimburse any fees paid (the exceptions are Article 33 EUTMDR and Article 37 CDIR, refund of the appeal fee in certain cases, and Article 105(5) EUTMR, refund of the fee for continuation of proceedings if the application is not granted).

Decisions on costs, or the fixing of costs, are limited to opposition, cancellation and design invalidity proceedings (including the ensuing appeal proceedings or proceedings before the GC and CJEU).

If a decision is given in inter partes proceedings, the Office will also decide on the apportionment of costs.

The decision will fix the costs to be paid by the losing party/parties. The losing party will bear the fees and costs incurred by the other party that are essential to the proceedings. No proof that these costs were actually incurred is required.

If both parties fail on one or more heads or if reasons of equity so dictate, the Office may determine a different apportionment of costs.

If the contested EUTM application, EUTM or RCD is withdrawn or surrendered, or the opposition, request for cancellation or application for a declaration of invalidity is withdrawn, the Office will not decide on the substance of the case, although it will normally take a decision on costs. The party terminating the proceedings will bear the fees and costs incurred by the other party. Where the case is closed for other reasons, the Office will fix the costs at its discretion. This part of the decision can be enforced in simplified proceedings in all Member States of the EU once it becomes final.

In no case will the decision on costs be based on hypothetical assumptions about who might have won the proceedings if a decision on substance had been taken.

Furthermore, within one month of the date of notification fixing the amount of the costs, the party concerned may request a review. This request must state the reasons on which it is based and must be accompanied by the corresponding fee.

For further information see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 5.5 and the Guidelines on Examination of Design Invalidity Applications.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 3

Payment of fees, costs and charges

Table of Contents

1 Introduction

Articles 178 to 181 and Annex I EUTMR
Article 6 CDIR
Article 6 CDFR

The specific regulation on the payment of fees and charges in European Union trade mark (EUTM) matters is laid down in Articles 178 to 181 and Annex I EUTMR. The full list of fees can be found on the Office website.

Similarly, for registered Community designs (RCDs), in addition to the provisions contained in the basic CDR and in the CDIR, there is a specific regulation on the fees payable to the Office (CDFR). This regulation was amended in 2007 following the accession of the European Union to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

Finally, the Executive Director of the Office is empowered to lay down charges that may be payable to the Office for services it may render and to authorise methods of payments in addition to those explicitly provided for in the EUTMR and the CDFR.

The differences between fees, costs and charges are as follows.

- Fees must be paid to the Office by users for the filing and handling of trade mark and design proceedings; the fee regulations determine the amounts of the fees and the ways in which they must be paid. Most of the proceedings before the Office are subject to the payment of fees, such as the application fee for an EUTM or an RCD, renewal fees, etc. Some fees have been reduced to zero (e.g. registration fees for EUTMs, transfers for EUTMs).
  The amounts of the fees have to be fixed at such a level as to ensure that the revenue is in principle sufficient for the Office's budget to be balanced (see Article 178 EUTMR), in order to guarantee the full autonomy and independence of the Office. The Office's revenue comes principally from fees paid by the users of the system.

  Rights of the Office to the payment of a fee are extinguished after 4 years from the end of the calendar year in which the fee fell due (Article 108 EUTMR).
- Costs refer to the costs of the parties in inter partes proceedings before the Office, in particular for professional representation (for trade marks see Article 109 EUTMR and Articles 18 and 27 EUTMIR; for designs see Articles 70 to 71 CDR and Article 79 CDIR). Decisions in inter partes cases can contain, where necessary, a decision on fees and costs of the professional representatives, and must fix the amount. The decision on costs may be enforced once the decision has become final, pursuant to Article 110 EUTMR.
- Charges are fixed by the Executive Director of the Office for any services rendered by the Office other than those specified in Annex I EUTMR (Article 178 EUTMR).

The amounts of the charges laid down by the Executive Director will be published in the Official Journal of the Office and can be found on the website under decisions of the Executive Director. Examples are the charges for mediation in Brussels or for certain publications issued by the Office.

2 Means of Payment

Article 179(1) EUTMR Article 5 CDFR Communication No 2/97 of the President of the Office of 03/07/1997

All fees and charges must be paid in euros. Payments in other currencies are not valid, do not create rights and will be reimbursed.

Fees payable to the Office may not be paid to or via national offices.

The admissible means of payment are, in most cases, bank transfers, debits from the current accounts held at the Office, and (for certain online services only) debit or credit cards. Cash payments at the Office's premises and cheques are no longer accepted (03/09/2008, R 524/2008-1, Teamstar / TeamStar).

The Office cannot issue invoices. However, the Office will provide a receipt when requested to do so by the user.

2.1 Payment by bank transfer

Money may be sent to the Office by means of transfer. A fee is not deemed to be paid if the order to transfer is given after the end of the time limit. If the fee is sent before the time limit but arrives after its expiry, under specific conditions the Office may consider the fee has been duly paid (see paragraph 4.1 below).

2.1.1 Bank accounts

Payment by bank transfer can only be made to one of the Office's bank accounts. For details on these accounts, refer to the 'Fees and Payment' section of the Office's website (https://euipo.europa.eu/ohimportal/en/fees-and-payments).

Concerning bank charges, it is important to make sure that the entire amount reaches the Office without any deductions.

2.1.2 Details that must accompany the payment

Article 179(2) and (3) EUTMR Article 6 CDFR

The payment of a fee and indication of the nature of the fee and the procedure to which it refers does not substitute the other remaining formal requirements of the procedural act concerned. For example, the payment of the appeal fee and the indication of the number of the contested decision is not sufficient for filing a valid notice of appeal (31/05/2005, T-373/03, Parmitalia, EU:T:2005:191, § 58; 09/09/2010, T-70/08, Etrax, EU:T:2010:375, § 23-25).

When the information supplied is insufficient to enable the payment to be allocated properly, the Office will specify a time limit within which the missing information must be provided, failing which the payment will be considered not to have been made and the sum will be reimbursed. The Office receives thousands of payments a day and incorrect or insufficient identification of the file can lead to considerable delays in processing procedural acts.

The following data must be included in the transfer form with the payment:

- number of the proceedings (e.g. EUTM number, opposition number, RCD number, etc.);
- payer's name and address or Office ID number;
- nature of the fee, preferably in its abbreviated form.

In order to deal with payments by bank transfer swiftly, and bearing in mind that only a limited number of characters may be used in the 'sender' and 'description' fields, filling in these fields as follows is highly recommended.

If the user selects bank transfer as the payment method, the system will provide an identifier for the payment in the receipt. It is recommended that the application number and identifier of the payment (e.g. 1639EDH2) be indicated in the bank transfer to help the Office identify the payment. This will help ensure that applications are treated in a timely manner.

Description field

- Use the codes listed in the tables below, e.g. EUTM instead of: 'Application Fee for a European Union Trade Mark'.
- Remove initial zeros in numbers and do not use spaces or dashes since they use up space unnecessarily.
- Always start with the EUTM or RCD number, e.g. EUTM 3558961.
- If the payment is for more than one trade mark or design, only specify the first and last one, e.g. EUTM 3558961-3558969, and then send a fax with the full details of the trade marks or designs concerned.

Description codes

The following codes (or a combination thereof) are to be used, along with the payment identifier code, to assist in identifying the payment:

Description	Code	Example
Payment to current account	CC + account number	CC1361
If the owner or the representative has an ID number	OWN + ID number, REP + ID number	REP10711
Number of the trade mark or the design	EUTM, RCD + number	EUTM 5104422 RCD 1698
A short nickname of the EUTM or RCD		'XYZABC' or 'bottle shape'
The payment identifier		1632EDH2
Operation code: Application fee for EUTM or RCD International application fee Renewal fee Opposition fee Cancellation fee Appeal Recordal Transfer Conversion Inspection of files Certified Copies	EUTM, RCD INT RENEWAL OPP CANC APP REC TRANSF CONV INSP COPIES	OPP, REC, RENEWAL, INSP, INT, TRANSF, CANC, CONV, COPIES, APP

Examples

Payment Object	Example of Payment Description
Application fee (EUTM = European Union trade mark)	EUTM 5104422 XYZABC; 1632EDH2
Renewal (EUTM)	EUTM 509936 RENEWAL; 1632EDH2
Payment to current account No 1361	CC1361
Recordal of a licence for an EUTM	EUTM 4325047 REC LICENCE OWN10711

Sender field

Examples for address

Address	Example
Payer's name	John Smith
Payer's address	58 Long Drive
Payer's city and postcode	London, ED5 6V8

- Use a name that can be identified as a payer, applicant (owner or representative) or opponent.
- For the payer's name, use only the name without abbreviations, such as DIPL.-ING. PHYS., DR, etc.
- Use the same form of identification for future payments.

2.2 Payment by debit or credit card

Decision No EX-17-7 of the Executive Director of the Office concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges Annex I A EUTMR Article 5(2) CDFR

Payment by debit or credit card is not yet available for all of the Office's fees. Only certain online services can be paid by debit or credit card, provided that payment is made in the context of an act performed via the User Area. The relevant online tool (e.g. e-filing) will indicate when a fee can be paid by credit or debit card. In particular, debit or credit cards cannot be used to pay charges referred to in Article 178(1) EUTMR and Article 3 CDFR or for filling up a current account.

Debit or credit card payments allow the Office to make the best use of its own automatic internal systems, so that work on the file can start more quickly.

Debit or credit card payments are immediate (see paragraph 4.2 below) and are therefore not allowed for making delayed payments (payments to be made within 1 month from the filing date).

Debit or credit card payments require some essential information. The information disclosed will not be stored by the Office in any permanent database. It will only be kept until it is sent to the bank. Any record of the form will only include the debit or credit card type plus the last four digits of the debit or credit card number. The entire debit or credit card number can safely be entered via a secure server, which encrypts all information submitted.

2.3 Payment by the Office current account

Decision No EX-17-7 of the Executive Director of the Office concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges

It is advisable to open a current account at the Office, as for any request that is subject to time limits, such as filing oppositions or appeals, the payment will be deemed to have been made on time, even if the relevant documentation for which the payment was made (e.g. a notice of opposition) is submitted on the last day of the deadline, provided that the current account has sufficient funds (see paragraph 4.3 below) (07/09/2012, R 2596/2011-3, Stair Gates, § 13-14). The date on which the current account is actually debited will usually be later, but payment will be deemed to have been made on the date on which the request for a procedural act is received by the Office, or as otherwise convenient for the party to the proceedings, in accordance with Article 8 of Decision No EX-17-7.

If the person (either party to the proceedings or the representative) that has filed the application or the respective procedural act is the holder of a current account with the Office, the Office will automatically debit the current account, unless instructions to the contrary are given in any individual case. In order for the account to be correctly identified, the Office recommends clearly indicating the Office ID number of the holder of the current account with the Office.

The system of current accounts is an automatic debiting system, meaning that upon identification of such an account, the Office may, according to the development of the procedures concerned and insofar as there are sufficient funds in the account, debit all fees and charges due within the limits of the aforementioned procedures, and a payment date will be accorded each time without any further instructions. The only exception to this rule is made when the holder of a current account who wishes to exclude the use of their current account for a particular fee or charge informs the Office thereof in writing. In this scenario, however, the holder of the account may change the method of payment back to payment by current account at any time before the expiry of the payment deadline.

The absence of an indication or the incorrect indication of the amount of the fee does not have any negative effect, since the current account will be automatically debited with reference to the corresponding procedural act for which the payment is due.

If there are insufficient funds in a current account, the holder will be notified by the Office and given the possibility to replenish the account with sufficient funds to allow for the payment of the fees concerned and of the administrative charge, which is 20 % of the total of the late fee. The administrative charge must not in any event exceed the maximum of EUR 500 or the minimum of EUR 100.

If the holder does replenish the account, the payment of the fee will be deemed to have been received on the date the relevant document in relation to which the payment was

made (for instance a notice of opposition) is received by the Office. If payment concerns the replenishment of a current account, it is sufficient to indicate the current account number.

Where the current account is replenished to cover only part of the amount due, the debit will be made, without exceptions, in the following order:

1. the administrative charges will be debited first; then,
2. if there are several fees or charges pending, the debit will be made in chronological order, taking into account the date when the fees were due, and only where the complete fee can be debited.

Where the current account is not replenished to cover all of the administrative charges and fees concerned on time, the payment will be deemed not to have been made and any rights depending on the timely payment will be lost.

The Office provides current account holders with access to their current account information over a secure internet connection. The account holder can view, save or print account movements and pending debits online via the User Area of the Office's website.

Payment of a fee by debiting a current account held by a third party requires explicit written authorisation. Payment is considered effective on the date the Office receives the authorisation. The authorisation must be given by the holder of the current account and must state that the account can be debited for a specific fee. If the holder is neither the party nor their representative, the Office will check whether there is such authorisation. Where the Office has reason to doubt the existence of such authorisation, it will, where time permits, invite the party concerned to submit the authorisation to debit the third party's account before the time limit for payment expires. The party requesting payment of a fee by debiting a third party's current account must submit the authorisation to the Office in order to allow the account to be debited.

A current account can be opened at the Office either by emailing a request to fee.information@euipo.europa.eu or by initiating an e-Action in the User Area.

The minimum amount required to open a current account is EUR 1 000.

Once an account has been opened, the Office reserves the right to close a current account by written notification to the holder, in particular where it deems that the use made of the current account was not in accordance with the terms and conditions laid down in Decision EX-17-7, or when it is determined that there has been a misuse of the account. Misuse could be considered in situations such as systematic lack of funds, repeated misuse of third-party authorisations or multiple accounts, non-payment of administrative charges, or situations where the actions of the account holder have led to an excessive administrative burden on the Office. For more details on closure, reference is made to Article 13 of Decision EX-17-7.

3 Time of Payment

Article 178(2) EUTMR

Article 4 CDFR

Fees must be paid on or before the date on which they become due.

If a time limit is specified for a payment to be made, then that payment must be made within that time limit.

Fees and charges for which the regulations do not specify a due date will be due on the date of receipt of the request for the service for which the fee or the charge is incurred, for example, a recordal application.

4 Date on which Payment is Deemed to be Made

Article 180(1) and (3) EUTMR

Article 7 CDFR

Decision No EX-17-7 of the Executive Director of the Office concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges

The date on which a payment is deemed to be made will depend on the method of payment.

4.1 Payment by bank transfer

When the payment is made by transfer or payment to an Office bank account, the date on which payment is deemed to have been made is the date on which the amount is credited to the Office bank account.

4.1.1 Late payment with or without surcharge

A payment that is received by the Office after expiry of the time limit will be considered to have been made in due time if evidence is submitted to the Office that the person who made the payment (a) duly gave an order, within the relevant period for payment, to a banking establishment to transfer the amount of the payment, and (b) paid a surcharge of 10 % of the total amount due (up to a maximum amount of EUR 200). Both conditions must be fulfilled in accordance with the judgment of 12/05/2011, T-488/09, Redtube, EU:T:2011:211, § 38, and decision of 10/10/2006, R 203/2005-1, BLUE CROSS MEDICARE / BLUE CROSS.

The same is not true for the late payment of the surcharge. If the surcharge is late, the entire payment is late and cannot be remedied by the payment of a 'surcharge on the surcharge' (07/09/2012, R 1774/2011-1, LAGUIOLE (fig.), § 12-15).

The surcharge will not be due if the person submits proof that the payment was initiated more than 10 days before expiry of the relevant time limit.

The Office may set a time limit for the person who made the payment after the expiry of the time limit to submit evidence that one of the above conditions was fulfilled.

For more information on the consequences of late payment in particular proceedings, see the relevant parts of the Guidelines. For example, the Guidelines, Part B, Examination, Section 2, Formalities, deals with the consequences of late payment of the application fee, while the Guidelines, Part C, Opposition, Section 1, Procedural Matters, deals with the consequences of late payment of the opposition fee.

4.1.2 Evidence of payment and of the date of payment

Article 180(4) EUTMR Article 63 CDR Article 7(4) CDFR

Any means of evidence may be submitted, such as:

- a bank transfer order (e.g. SWIFT order) bearing stamps and the date of receipt from the bank involved;
- an online payment order sent via the internet or a printout of an electronic transfer, provided it contains information on the date of the transfer, on the bank it was sent to, and an indication such as 'transfer done'.

In addition, the following evidence may be submitted:

- acknowledgement of receipt of payment instructions by the bank;
- letters from the bank where the payment was effected, certifying the day on which the order was placed or the payment was made, and indicating the procedure for which it was made;
- statements from the party or its representative in writing, sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.

This additional evidence is only considered sufficient if supported by the initial evidence.

This list is not exhaustive.

If the evidence is not clear, the Office will send a request for further evidence.

If no evidence is submitted, the procedure for which the payment was made is deemed not to have been entered.

In the event of insufficient proof, or if the payer fails to comply with the Office's request for the missing information, the latter will consider that the time limit for payment has not been observed.

The Office may likewise, within the same time limit, request the person to pay the surcharge. In the event of non-payment of the surcharge, the deadline for payment will be considered not to have been observed.

The fee or charges or the part thereof that have been paid will be reimbursed since the payment is invalid.

Article 24 EUTMIR Article 81(2) CDIR

Language of the evidence: the documents may be filed in any official language of the EU. Where the language of the documents is not the language of the proceedings, the Office may require that a translation be supplied in any Office language.

4.2 Payment by debit or credit card

Article 16 of Decision No EX-17-7 of the Executive Director of the Office concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges

Payment by credit or debit card is deemed to have been made on the date on which the related filing or request is successfully completed via the User Area and if the money actually reaches the Office's account as a consequence of the credit or debit card transaction, and is not withdrawn at a later date. If, when the Office attempts to debit the credit or debit card, the transaction fails for some reason, payment is considered not to have been made. This applies even when the payer was not responsible for the failure of the transaction.

4.3 Payment by current account

Article 8 of Decision No EX-17-7 of the Executive Director of the Office concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges

If the payment is made through a current account held with the Office, Decision No EX-17-7 of the Executive Director provides that the date on which the payment is deemed to be made is fixed in order to be convenient for the party to the proceedings. For example, for the application fee for an EUTM, the fees will be debited from the current account on the day of receipt of the application. However, the account holder may instruct the Office to debit its account on the last day of the one-month time limit

provided for payment. Likewise, upon renewal, the fees for renewal (including the class fees) are debited on the day of receipt of the request, unless the account holder requests otherwise.

If a party withdraws its action (opposition, cancellation request, appeal, renewal application) before the end of the time limit to make the payment, fees due to be debited on expiry of the time limit to pay the fee will not be debited from the current account and the action will be deemed not to have been filed.

5 Refund of Fees

Article 108, Article 179(3) and Article 181 EUTMR Articles 6(2) and 8(1) CDR Article 30(2) CDIR

The refund of fees is explicitly provided for in the Regulations. Refunds are given by means of bank transfer or through current accounts with the Office, even when the fees were paid by debit or credit card.

As a general rule, if a declaration that is subject to the payment of a fee has been withdrawn before or on the day the payment is deemed to have been made, the fee will be refunded.

5.1 Refund of application fees

Article 49(1) EUTMR Articles 10, 13 and 22 CDIR

In the event of the withdrawal of an EUTM application, fees are not refunded except if a declaration of withdrawal reaches the Office:

- (in the case of payment by bank transfer) before or at the latest on the same day as the amount actually entered the bank account of the Office;
- (in the case of payment by debit or credit card) on the same day as the application containing the debit or credit card instructions/details;
- (in the case of payment by current account, and where the holder explicitly requested the application fee to be debited on the last day of the one-month time limit provided for payment or, where later written instruction has been given to immediately debit the current account) before or at the latest on the same day on which that instruction was received.

Where the basic application fee has to be refunded, any additional class fees paid will be refunded as well.

The Office will only refund additional class fees on their own where they have been paid in excess of the classes indicated by the applicant in the EUTM application and where such payment was not requested by the Office or where, upon examination of the classification, the Office concludes that additional classes have been included that were not required in order to cover the goods and services contained within the original application.

As regards designs, if there are deficiencies that affect the filing date, that is, the filing date is not granted due to those deficiencies, and those deficiencies are not remedied by the time limit granted by the Office, the design(s) will not be dealt with as a Community design and any fees paid will be refunded. However, under no circumstances will the fees be refunded if the design applied for has been registered.

5.2 Refund of the opposition fee

Articles 5(1), 6(5) and 7(1) EUTMDR

If an opposition is deemed not entered (because it was filed after the 3-month time limit), or if the opposition fee was not paid in full or was paid after the expiry of the opposition period, or if the Office refuses protection of the mark ex officio pursuant to Article 45(3) EUTMR, the Office must refund the fee (see Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 5.4, Fee refund).

5.3 Refund of the fee for an application for revocation or for a declaration of invalidity

Article 15(1) EUTMDR

If an application for revocation or for declaration of invalidity is deemed not to have been entered because the fee was not paid within the period specified by the Office, the Office must refund the fee, including the surcharge (see Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings, paragraph 2.3, Payment).

5.4 Refund of fees for international marks

Decision No ADM-11-98 of the President of the Office related to the regularisation of certain reimbursements of fees

For information on the different scenarios where a refund may be applicable in processes relating to international applications and registrations where the EUIPO is the office of origin and/or designated office, see the Guidelines, Part M, International Marks.

5.5 Refund of appeal fees

Provisions regarding the refund of appeal fees are dealt with under Article 33 EUTMDR and Article 35(3) and Article 37 CDIR.

5.6 Refund of renewal fees

Article 53(8) EUTMR Article 22(5) CDIR

Fees that are paid before the start of the first 6-month time limit for renewal will not be taken into consideration and will be refunded.

Where the fees have been paid, but the registration is not renewed (i.e. where the fee has been paid only after the expiry of the additional time limit, or where the fee paid amounts to less than the basic fee and the fee for late payment/late submission of the request for renewal, or where certain other deficiencies have not been remedied), the fees will be refunded.

Where the owner has instructed the Office to renew the mark, and subsequently either totally or partially (in relation to some classes) withdraws the instruction to renew, the renewal fee will only be refunded:

- if, in the case of payment by bank transfer, the Office received the withdrawal before or at the latest on the same day as the amount actually entered the bank account of the Office;
- if, in the case of payment by debit or credit card, the Office received the withdrawal before or on the same day as receiving the debit or credit card payment;
- if, in the case of payment by current account, and where the holder explicitly requested the fee to be debited on the last day of the 6-month time limit provided for payment, and the Office received the withdrawal within the 6-month time limit for renewal or, where written instruction was given to debit the current account immediately, before or at the latest on the same day that the Office received the instruction.

For further information, see the Guidelines, Part E, Register Operations, Section 4, Renewal.

5.7 Refund of insignificant amounts

Article 181 EUTMR

Article 9(1) CDFR

Article 18 of Decision No EX-17-7 of the Executive Director of the Office concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges

A fee will not be considered settled until it has been paid in full. If this is not the case, the amount already paid will be reimbursed after the expiry of the time limit allowed for payment, since in this case the fee no longer has any purpose.

However, insofar as it is possible, the Office may invite the person to complete payment within the time limit.

Where an excess sum is paid to cover a fee or a charge, the excess will not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. Insignificant amounts are fixed at EUR 15 by Decision No EX-17-7.

6 Fee Reduction for an EUTM Application Filed by Electronic Means

Annex I A(2) EUTMR

Decision No EX-19-1 of the Executive Director of the Office concerning communication by electronic means

According to Annex I A(2) EUTMR, the basic fee for an application for an individual mark may benefit from a reduction if the application has been filed by electronic means. The applicable rules and procedure for such an electronic filing may be found in Decision No EX-19-1 of the Executive Director of the Office in conjunction with the Conditions of Use of the User Area as established in Decision No EX-19-1.

In order to be considered an application for an EUTM filed by electronic means in the sense of Annex I A(2) EUTMR, the applicant has to insert all the goods and/or services to be covered by the application directly into the Office tool. Consequently, the applicant must not include the goods and/or services in an annexed document or submit them by any other means of communication. If the goods and/or services are annexed in a document or submitted to the Office by any other means of communication, the application will not be considered as having been filed by electronic means and may not benefit from the corresponding fee reduction.

7 Decisions on Costs

Article 109 EUTMR Article 1(k), Articles 18 and 27 EUTMIR

7.1 Fixing of costs

The decision fixing the amount of costs includes the lump sum provided in Article 27 EUTMIR for professional representation and fees (see above) incurred by the winning party, independently of whether they have actually been incurred. The fixing of the costs may be reviewed in specific proceedings pursuant to Article 109(7) EUTMR.

7.2 Enforcement of the decision on costs

Article 110 EUTMR

The Office is not competent for enforcement procedures. These must be carried out by the competent national authorities.

7.2.1 Conditions

The winning party may enforce the decision on costs, provided that:

- the decision contains a decision fixing the costs in their favour;
- the decision has become final;
- the decision bears the order of the competent national authority.

7.2.2 National authority

Each Member State will designate a single national authority for the purpose of verifying the authenticity of the decision and for appending the order for the enforcement of Office decisions fixing costs. The Member State must communicate its contact details to the Office, to the Court of Justice and to the Commission (Article 110(2) EUTMR).

The Office publishes such designations in its Official Journal.

7.2.3 Proceedings

1. The interested party must request the competent national authority to append the enforcement order to the decision. For the time being, the conditions on languages of the requests, translations of the relevant parts of the decision, fees and the need

for a representative depend on the practice of the individual Member States and are not harmonised but are considered on a case-by-case basis.

The competent authority will append the order to the decision without any other formality beyond the verification of the authenticity of the decision. As to wrong decisions on costs or fixing of costs, see paragraphs 7.3 below.

2. If the formalities have been completed, the party concerned may proceed to enforcement. Enforcement is governed by the rules of civil procedure in force in the territory where it is carried out (Article 110(2) EUTMR). The enforcement may be suspended only by a decision of the Court of Justice of the European Union. However, the courts of the country concerned have jurisdiction over complaints that enforcement is being carried out in an irregular manner (Article 110(4) EUTMR).

7.3 Apportionment of costs

In inter partes proceedings, the Opposition Division, the Cancellation Division and the Boards of Appeal take, where necessary, a decision on the apportionment of costs. Those costs include in particular the costs of the professional representatives, if any, and the corresponding fees. For further information relating to the apportionment of costs in opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters. Regarding cancellation proceedings, see the Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings, paragraph 4.3.4, Decision on apportionment of costs. Where the decision contains obvious mistakes as regards the costs, the parties may ask for a corrigendum (Article 102(1) EUTMR) or a revocation (Article 103 EUTMR), depending on the circumstances (see the Guidelines, Part A, General Rules, Section 6, Revocation of Decisions, Cancellation of Entries in the Register and Correction of Errors).

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 4

Language of proceedings

Table of Contents

1 Introduction

Article 146 EUTMR
Articles 25 and 26 EUTMIR
Article 24 EUTMIR
Article 98 CDR
Articles 80, 81 and 83 CDIR

There are five Office languages: English, French, German, Italian and Spanish. However, an application for a European Union trade mark (EUTM) or registered Community design (RCD) may be filed in any of the official EU languages. The EUTMR and the CDR lay down rules for determining and using the language of proceedings. These rules may vary from one set of proceedings to another, in particular depending on whether the proceedings are ex parte or inter partes.

This section deals only with the horizontal provisions common to all types of proceedings. The exceptions for particular types of proceedings are dealt with in the corresponding sections of the Guidelines.

2 From Filing to Registration (Excluding Opposition)

Article 146 EUTMR
Article 98 CDR

EUTM and RCD applications may be filed in any of the official EU languages.

A second language must be indicated from among the five languages of the Office.

During the proceedings, the applicant may use:

- the first language;
- the second language, at its discretion, if the first language is not an Office language.

The Office uses:

- only the first language if it is an Office language;
- the first language if it is not an Office language, following the CJEU 'Kik' judgment (09/09/2003, C-361/01 P, Kik, EU:C:2003:434), unless the applicant has declared its consent in writing for the Office to use the second language, in which case the Office proceeds accordingly. Consent to use of the second language must be given for each individual file; it may not be given for all existing or future files.

This language regime applies throughout the application and examination procedure until registration, except for oppositions and ancillary requests (see following paragraphs).

3 Opposition and Cancellation

Article 146(7) EUTMR Article 3 EUTMDR

An opposition or request for cancellation (application for revocation or declaration of invalidity) may be filed:

- at the discretion of the opponent/applicant for cancellation in the first or second language of the EUTM application if the first language is one of the five languages of the Office;
- in the second language if the first language is not an Office language.

This language becomes the language of proceedings for the opposition or cancellation proceedings unless the parties agree to a different one (from among the official EU languages).

An opposition or request for cancellation may also be filed in any of the other Office languages, provided that within 1 month of expiry of the opposition period or within 1 month of filing the application for cancellation, the opponent/applicant for cancellation files a translation into a language that is available as a language of proceedings.

4 Design Invalidity

Article 98(4) and (5) CDR Article 29 and Article 30(1) CDIR

An application for a declaration of invalidity may be filed:

- in the first language of the RCD if the first language is one of the five languages of the Office;
- in the second language if the first language is not an Office language.

This language becomes the language of proceedings for the invalidity proceedings.

The parties to the invalidity proceedings may agree on a different language of proceedings provided it is an official language of the European Union. Information as regards the agreement must reach the Office within 2 months after the holder has been notified of the application. Where the application was not filed in that language, the applicant must file a translation of the application in that language within 1 month of the date when the Office was informed of the agreement.

Where the application is not filed in the language of proceedings, the Invalidity Division will notify the applicant to file a translation within 2 months of the date of receipt of the notification. Where the applicant does not comply with the request, the application will be rejected as inadmissible.

For the linguistic regime applicable to the supporting documents filed in invalidity proceedings, see the Guidelines on Examination of Design Invalidity Applications, paragraph 3.9.2.

5 Other Requests

5.1 Before registration (excluding opposition)

Article 146(6) EUTMR Article 80(a) CDIR

During the period from filing to registration, any request, application or declaration that is not concerned with the examination of the application as such but that starts an ancillary procedure (e.g. inspection of files, registration of a transfer or licence, request for conversion, declaration of division for an EUTM or RCD) may be filed in the first or second language, at the discretion of the applicant or third party. That language then becomes the language of proceedings for those ancillary proceedings. This applies irrespective of whether or not the first language is an Office language.

5.2 After registration (excluding cancellation and design invalidity)

Article 146(6) EUTMR Article 80(b) CDIR

Any request, application or declaration filed after the EUTM or RCD has been registered must be submitted in one of the five Office languages.

Example: after an EUTM has been registered, the EUTM proprietor may file a request for the registration of a licence in English and, a few weeks later, file a request for renewal in Italian.

6 Invariable Nature of the Language Rules

The Regulations allow certain choices to be made from among the available languages in the course of the proceedings (see above) and, during specified periods, a different

language to be chosen as the language of proceedings for opposition, cancellation and design invalidity. However, with those exceptions, the language rules are invariable. In particular, the first and second languages may not be amended in the course of the proceedings.

7 Translations and their Certification

Article 146(10) EUTMR Articles 24 to 26 EUTMIR Article 83 CDIR

The general rule is that where a translation of a document is required, it must reach the Office within the time limit set for filing the original document. This applies unless an exception to this rule is expressly provided in the Regulations.

The translation must identify the document to which it refers and reproduce the structure and contents of the original document. The party may indicate that only parts of the document are relevant and limit the translation to those parts. However, the party does not have discretion to consider irrelevant any parts that are required by the Regulations (for example, when proving the existence of an earlier trade mark registration in opposition proceedings).

In the absence of evidence or indications to the contrary, the Office will assume that a translation corresponds to the relevant original text. In the event of doubt, the Office may require the filing, within a specific period, of a certificate that the translation corresponds to the original text. If the required certificate is not submitted, the document for which the translation had to be filed will be deemed not to have been received by the Office.

8 Non-compliance with the Language Regime

If the language regime is not complied with, the Office will issue a deficiency letter, unless otherwise provided in the Regulations. Should the deficiency not be remedied, the application or the request will be refused.

For more information on language regimes for particular types of proceedings the corresponding sections of the Guidelines should be consulted.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 5

Professional representation

Table of Contents

1 Introduction — Principle of Representation

Articles 119 and 120 EUTMR
Article 7(b) EUTMIR
Articles 77 and 78 CDR
Article 62 CDIR

Persons having their domicile or their principal place of business or a real and effective industrial or commercial establishment within the European Economic Area (EEA), which consists of the European Union (EU) and Iceland, Liechtenstein and Norway, are not required to be represented in any proceedings before the Office in either trade mark or design matters (see paragraph 3.1.1 below).

Natural persons not domiciled in or legal persons that do not have their principal place of business or a real and effective industrial or commercial establishment in the EEA must be represented by a representative based within the EEA, unless appointment of a representative is not mandatory (see paragraph 3.1 below for any exceptions to the general rule). See paragraph 3.2.1 below on the consequences of not appointing a representative, when representation is mandatory, once the EUTM application has been filed.

Representatives in the sense of Articles 119 and 120 EUTMR may be domiciled in the EEA.

As regards registered Community design (RCD) proceedings, according to Articles 77 and 78 CDR, the relevant territory for establishing the obligation to be represented and the place where the representative must be based in the sense of Article 78 CDR is the EU. However, following the judgment in the Paul Rosenich case (13/07/2017, T-527/14, PAUL ROSENICH, EU:T:2017:487), the Office deems the EEA to be the relevant territory, with the result that the considerations previously applied to the EEA in trade mark matters now also apply to designs.

In principle, representatives do not need to file an authorisation to act before the Office unless the Office expressly requires it, or where, in inter partes proceedings, the other party expressly requests it.

Where a representative has been appointed, the Office will communicate solely with that representative.

For further information on specific aspects of professional representation during proceedings before the Office in relation to international marks, please see the Guidelines, Part M, International Marks.

The first part of this Section (paragraph 2) defines the different types of representatives.

The second part of this Section (paragraphs 3 to 6) deals with the appointment of representatives or failure to do so and the authorisation of representatives.

2 Who May Represent

Article 119(3) and Article 120(1)(a) and (b) EUTMR
Article 74(8) EUTMDR
Article 77(3) and Article 78(1)(a) and (b) CDR
Article 62(9) CDIR

In all Member States of the EEA, representation in legal proceedings is a regulated profession and may only be exercised under particular conditions. The terminology of Article 120 EUTMR encompasses different categories of representative under the heading 'Professional representatives'. In proceedings before the Office, the following categories of representative are distinguished.

Legal practitioners (Article 120(1)(a) EUTMR and Article 78(1)(a) CDR) are professional representatives who, depending on the national law, are always qualified to represent third parties before national offices (see paragraph 2.2 below).

Other professionals (Article 120(1)(b) EUTMR and Article 78(1)(b) CDR) need to comply with further conditions and need to be included on a specific list maintained by the Office for this purpose (the Office's list of professional representatives). Amongst these, two further groups need to be distinguished: those who may represent only in RCD proceedings ('designs list') and those who may represent in both EUTM and RCD proceedings (see paragraph 2.3 below). The Office refers to these other professionals collectively as 'professional representatives'.

Several legal practitioners and professional representatives may be organised in entities called 'associations of representatives' (Article 74(8) EUTMDR; Article 62(9) CDIR) (see paragraph 3.4.3 below).

The final category of representatives is made up of employees acting as representatives for the party to proceedings before the Office (Article 119(3) EUTMR, first alternative; Article 77(3) CDR, first alternative) (see paragraph 2.4.1 below) or employees of economically linked legal persons (Article 119(3) EUTMR, second alternative; Article 77(3) CDR, second alternative) (see paragraph 2.4.2 below).

Employees are to be distinguished from legal representatives under national law (see paragraph 2.5 below).

2.1 Database of representatives

All persons that identify themselves as representatives for or employees of individual parties to proceedings before the Office and that fulfil the requirements provided by the

regulations are entered into the database of representatives and obtain an ID number. The database has a double function, providing all relevant contact details under the specific ID number for any type of representative as well as the public information on the Office's list of professional representatives or designs list.

All representatives, including associations of representatives, must indicate the category of representative to which they belong, their name and their address in accordance with Article 2(1)(e) EUTMIR and Article 1(1)(e) CDIR.

A representative may have several IDs. For example, associations of representatives may have different IDs for different official addresses (to be distinguished from different correspondence addresses, which can be identified under a single ID; see the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration). Individual representatives may have one ID as an employee representative and a different ID as a legal practitioner in their own right.

A legal practitioner cannot, in principle, appear in the database as an 'Office professional representative', since they do not need to be admitted by the Office. The Office, therefore, almost invariably refuses requests from legal practitioners to be entered on the list of Office professional representatives. The only exception is where a professional representative on the list is also a legal practitioner and such dual qualification is allowed under national law.

The database of professional representatives is available online. In the database, representatives are identified as: association, employee, lawyer (legal practitioners), and professional representative. Internally, the latter category is divided into two subcategories: type 1 consists of design attorneys exclusively entitled to represent in RCD matters under Article 78 CDR and type 2 of trade mark and design attorneys under Article 120 EUTMR.

2.2 Professional representation by legal practitioners

Article 120(1)(a) EUTMR Article 78(1)(a) CDR

A legal practitioner is a professional representative who is automatically and without any further formal recognition allowed to represent third parties before the Office provided that they meet the following three conditions:

1. they must be qualified in one of the Member States of the EEA;
2. they must have their place of business within the EEA; and
3. they must be entitled, within that State, to act as a representative in trade mark and/or design matters.

2.2.1 The term ‘legal practitioner’

Directive 98/5/EC of the European Parliament and of the Council defines the term ‘lawyer’ (i.e. legal practitioner). The professional titles are identified in the column ‘Terminology for legal practitioner’ in Annex 1 of this Section.

2.2.2 Qualification

The requirement to be qualified in one of the Member States of the EEA means that the person must be admitted to the bar or be admitted to practise under one of the professional titles identified in Annex 1 pursuant to the relevant national rules. The Office will not verify this unless there are serious doubts in this regard.

2.2.3 Nationality and place of business

There is no requirement as to nationality. Therefore, the legal practitioner may be a national of a state other than one of the Member States of the EEA.

The place of business must be in the EEA. A post office box address does not constitute a place of business. The place of business need not necessarily be the only place of business of the representative. Furthermore, the place of business may be in a Member State of the EEA other than the one in which the legal practitioner is admitted to the bar. However, legal practitioners who have their sole place of business outside the EEA are not entitled to represent before the Office even when they are admitted to practise in one of the Member States of the EEA.

Where an association of representatives, such as a law firm or a law office, has several places of business, it may perform acts of representation only under a place of business within the EEA, and the Office will only communicate with the legal practitioner at an address within the EEA.

2.2.4 Entitlement to act in trade mark and/or design matters

The entitlement to act as a representative in trade mark and/or design matters in a state must include the entitlement to represent clients before the national industrial property office of that state. This condition applies to all Member States of the EEA.

Legal practitioners referred to in Article 120(1)(a) EUTMR and Article 78(1)(a) CDR who fulfil the conditions laid down in this Article are automatically entitled as of right to represent their clients before the Office. This basically means that if a legal practitioner is entitled to act in trade mark and/or design matters before the central industrial property office of the Member State of the EEA in which they are qualified, they will also be able to act before the Office. Legal practitioners are not entered on the list of professional representatives to which Article 120(2) EUTMR and Article 78(1)(b) and (c) CDR refer, because the entitlement and the special professional qualifications referred to in those provisions relate to persons belonging to categories of professional

representatives specialising in industrial property or trade mark matters, whereas legal practitioners are by definition entitled to be representatives in all legal matters.

If a legal practitioner (lawyer) who has already been attributed an identification number as a lawyer requests entry on the list, the number will be maintained but the status will be changed from 'lawyer' to 'professional representative'. The only exception is where a professional representative on the list is also a legal practitioner and is allowed, under national law, to act in both contexts.

Annex 1 gives a detailed explanation of the specific rules for most of the countries. The information contained in this Annex has been provided by the national industrial property office of each State, and any clarifications as regards its accuracy should therefore be addressed to the national industrial property office in question. The Office would appreciate being informed of any inconsistencies.

2.3 Professional representatives admitted and entered on the lists maintained by the Office

Article 120(1)(b) and Article 120(2) EUTMR Article 78(1)(b) CDR

The second group of persons entitled to represent third parties professionally before the Office are those persons whose names appear on one of the two lists of professional representatives maintained by the Office: the Office's list of professional representatives and the designs list.

For this category of professional representatives, the entry on the Office's list of professional representatives or designs list entitles them to represent third parties before the Office. A representative who is entered on the Office's list of professional representatives, referred to in Article 120(1)(b) EUTMR, is automatically entitled to represent third parties in design matters according to Article 78(1)(b) CDR and will not be entered on the special list of professional representatives in design matters ('designs list').

If a person on the list maintained under Article 120(1)(b) EUTMR requests entry on the designs list maintained for professional representatives authorised to act exclusively in Community design matters under Article 78(1)(c) and (4) CDR, the request will be rejected.

The designs list is intended only for professional representatives who are entitled to represent clients before the Office in design matters but not trade mark matters.

Annex 2 gives a detailed explanation of the specific rules for most of the countries. The information contained in this Annex has been provided by the national industrial property office of each State, and any clarifications as regards its accuracy should therefore be addressed to the national industrial property office in question. The Office would appreciate being informed of any inconsistencies.

Entry on the lists is subject to a request being completed and signed individually by the person concerned, using the form established for this purpose by the Office (which can be accessed online at: https://euipo.europa.eu/ohimportal/en/forms-and-filings).

In order to be entered on the list, three requirements must be fulfilled.

1. The representative must be a national of one of the Member States of the EEA.
2. They must have their place of business within the EEA.
3. They must be entitled under national law to represent third parties in trade mark matters before the national industrial property office. To that end they must provide a certificate attesting this from the national industrial property office of a Member State of the EEA.

2.3.1 Entitlement under national law

The conditions for entry on the Office's list of professional representatives and the designs list depend on the legal situation in the Member State of the EEA concerned.

Article 120(2)(c) EUTMR Article 78(1)(b) CDR

In a large number of Member States of the EEA, entitlement to represent third parties before the national office in trade mark matters is conditional upon possession of a special professional qualification (Article 120(2)(c) EUTMR, first alternative; Article 78(4)(c) CDR, first alternative). Therefore, in order to be entitled to act as a representative, the person must have the required qualification. In other Member States of the EEA, there is no such requirement for a special qualification, that is to say, representation in trade mark matters is open to anybody. In this case, the person involved must have regularly represented third parties in trade mark or design matters before the national office concerned for at least 5 years (Article 120(2)(c) EUTMR, second alternative; Article 78(4)(c) CDR, second alternative). A subcategory of this category of Member States of the EEA consists of those States that have a system officially recognising a professional qualification to represent third parties before the national office concerned even though such recognition is not a prerequisite for the exercise of professional representation. In this case, persons so recognised are not subject to the requirement of having regularly acted as a representative for at least 5 years.

Please refer to Annex 1 for the countries where special professional qualifications are required.

2.3.1.1 First alternative — special professional qualifications

Where, in the Member State of the EEA concerned, entitlement is conditional upon having special professional qualifications, persons applying to be entered on the list must have acquired this special professional qualification.

If the person confirms that they work for two different associations of representatives or from two different addresses, then they can have two different numbers attributed, but only the first ID number will be published in the Official Journal. It is also possible to have two different numbers, one as a lawyer and one as an Office professional representative where such a dual qualification is allowed under national law (which is not the case, for example, in Belgium and France).

2.3.1.2 Second alternative — 5 years' experience

Where, in the Member State of the EEA concerned, the entitlement is not conditional upon possession of special professional qualifications, persons applying to be entered on the list must have regularly acted as professional representatives in trade mark or design matters for at least 5 years before a central industrial property office of a Member State of the EEA.

It is possible for the Executive Director of the Office to grant an exemption from this requirement (see paragraph 2.3.4 below).

2.3.1.3 Third alternative — recognition by a Member State of the EEA

Persons whose professional qualification to represent natural or legal persons in trade mark and/or design matters before the central industrial property office of one of the Member States of the EEA is officially recognised in accordance with the regulations laid down by that State will not be subject to the condition of having exercised the profession for at least 5 years.

2.3.2 Nationality and place of business

Article 120(2) and (4) EUTMR Articles 78(4) and 78(6) CDR

A professional representative requesting to be entered on the list must be a national of a Member State of the EEA and must have his or her place of business or employment in the EEA. Entitlement to act as a representative in other Member States of the EEA, and professional experience obtained therein, can only be taken into account within the scope of Article 120(2)(c) EUTMR and Article 78(4)(c) CDR. It is possible for the Executive Director of the Office to grant an exemption from this requirement (see paragraph 2.3.4 below).

2.3.3 Certificate

Article 120(3) EUTMR Article 78(5) CDR

Fulfilment of the abovementioned conditions laid down in Article 120(2) EUTMR and Article 78(4) CDR must be attested by a certificate provided by the national office concerned. Some national offices issue individual certificates while others provide the Office with block certificates. They send regularly updated lists of professional representatives entitled to represent clients before their office (Communication No 1/95 of the President of the Office of 18/09/1995, OJ OHIM 1995, p. 16). Otherwise, the person concerned must accompany his or her request with an individual certificate (which can be accessed online at https://euipo.europa.eu/ohimportal/en/forms-and-filings).

2.3.4 Exemptions

Article 120(4) EUTMR Article 78(6) CDR

The Executive Director of the Office may, under special circumstances, grant exemption from the requirement to be a national of a Member State of the EEA and from the requirement of having regularly represented in trade mark matters for at least 5 years, provided that the professional representative submits proof that he or she has acquired the required qualification in another way. This power is of a discretionary nature.

Exemptions from the requirement for 5 years' experience are limited to where a qualification to act as a representative in trade mark matters acquired in another way has already been valid for the equivalent period.

For example, this comprises cases where the professional representative, before becoming an industrial property agent, was personally responsible for trade mark operations within a company without having acted before the national office concerned. The experience must have been acquired in a Member State of the EEA.

2.3.5 Procedure for entry on the list

Article 120(3) EUTMR Article 78(5) CDR

Entry on the list is confirmed by notification of a positive decision, which contains the indication of the ID number attributed to the professional representative. Entries on the

Office's list of professional representatives or designs list are published in the Official Journal of the Office.

If any of the requirements for entry on the list are not fulfilled, and after the applicant has been given the opportunity to reply to the Office's deficiency notification to that effect, a rejection decision will be issued unless the applicant remedies the said deficiency. The party concerned may file an appeal against this decision (Article 66(1) and Article 162 EUTMR; Article 55(1) CDR).

Professional representatives may obtain an additional copy of the decision free of charge. The files relating to requests for entry on the Office's list of professional representatives or designs list are not open to public inspection.

2.3.6 Amendment of the list of professional representatives

2.3.6.1 Deletion

First alternative — upon own request

Article 120(5) EUTMR Article 78(7) CDR Article 64(1) and (6) CDIR

The entry of a professional representative on the Office's list of professional representatives or designs list will be deleted at the request of that representative.

The deletion will be entered in the files kept by the Office. The notification of deletion will be sent to the representative, and the deletion will be published in the Official Journal of the Office.

Second alternative — automatic deletion from the list of professional representatives

Article 75(1) EUTMDR Article 64(2) and (5) CDIR

The entry of a professional representative in the Office's list of professional representatives or designs list will be deleted automatically:

1. in the event of the death or legal incapacity of the professional representative;
2. where the professional representative is no longer a national of a Member State of the EEA; however, the Executive Director of the Office may still grant an exemption under Article 120(4)(b) EUTMR;
3. where the professional representative no longer has a place of business or employment in the EEA; or
4. where the professional representative is no longer entitled to represent third parties before the central industrial property office of a Member State of the EEA.

Where a professional representative changes from a design attorney to a trade mark attorney, he or she will be removed from the designs list and entered on the Office's list of professional representatives.

The Office may be informed of the above events in a number of ways. In case of doubt, the Office will, prior to deletion from the list, seek clarification from the national office concerned. It will also hear the professional representative, in particular where it is possible that he or she may be entitled to remain on the list on another legal or factual basis.

The deletion will be entered in the files kept by the Office. The decision of the deletion will be notified to the representative and the deletion will be published in the Official Journal of the Office. The party concerned can lodge an appeal against this decision (Decision 2009-1 of the Presidium of the Boards of Appeal of 16 June 2009 regarding instructions to parties in proceedings before the Boards of Appeal).

2.3.6.2 Suspension of the entry on the list

Article 75(2) EUTMDR Article 64(3) CDIR

The entry of the professional representative on the Office's list of professional representatives or designs list will be suspended on the Office's own motion where his or her entitlement to represent natural or legal persons before the national industrial property office of a Member State of the EEA has been suspended.

The national industrial property office of the Member State of the EEA concerned must, where aware of any such events, promptly inform the Office thereof. Before taking a decision to suspend the entry, which will be open to appeal, the Office will inform the representative and give him or her an opportunity to comment (Decision 2009-1 of the Presidium of the Boards of Appeal of 16 June 2009 regarding instructions to parties in proceedings before the Boards of Appeal).

2.3.7 Reinstatement in the list of professional representatives

Article 75(3) EUTMDR Article 64(4) CDIR

A person whose entry has been deleted or suspended will, upon request, be reinstated in the list of professional representatives if the conditions for deletion or suspension no longer exist.

A new request must be submitted in accordance with the normal procedure for obtaining an entry on the list of professional representatives (see paragraph 2.2 above).

2.4 Representation by an employee

Article 120(3) EUTMR Articles 1(j) and 74(1) EUTMDR Article 77(3) CDR Article 62(2) CDIR

Natural or legal persons whose domicile, principal place of business or real and effective industrial or commercial establishment is in the EEA may act before the Office through a natural person employed by them ('employee').

A natural person whose domicile is outside the EEA cannot designate an employee representative in the EEA.

Employees of the abovementioned legal persons may also act on behalf of other legal persons who have economic connections with the first legal person (25/01/2012, R 466/2011-4, FEMME LIBRE / FEMME, § 10) (see paragraph 2.4.2 below). This applies even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the EEA (see paragraph 2.4.2 below). Where a legal person from outside the EEA is represented in this way, it is not required to appoint a professional representative within the meaning of Article 120(1) EUTMR and Article 78(1) CDR, as an exception to the rule that parties to the proceedings domiciled outside the EEA are obliged to appoint a professional representative.

Article 65(1)(i) EUTMDR Article 68(1)(i) CDIR

On the forms made available by the Office, the employee signing the application or request must indicate his or her name, tick the checkboxes relating to employees, and fill in the field reserved for professional representatives on p. 1 of the form or the sheet with details relating to professional representatives.

The name(s) of the employee(s) will be entered in the database and published under 'representatives' in the EUTM Bulletin.

2.4.1 Employees acting for their employer

Article 119(3) EUTMR Article 74(1) EUTMDR Article 77(3) CDR Article 62(2) CDIR

Where employees act for their employer, this is not a case of professional representation under Article 120(1) EUTMR or Article 78(1) CDR. As such, Article 109(1) EUTMR is not applicable for the apportionment and fixing of costs in inter partes proceedings (17/07/2012, T-240/11, MyBeauty (fig.) / BEAUTY TV et al., EU:T:2012:391, § 15 et seq.).

Natural or legal persons party to proceedings before the Office may act through their employees.

In EUTM matters no authorisation needs to be submitted, unless the Office or any party to the proceedings requests it. However, in RCD matters, Article 77(3) CDR establishes that the signed authorisation is a compulsory requirement for insertion in the file. No other requirements, for example that the employees be qualified to represent third parties before national offices, need be met.

The Office will not generally verify whether there actually is an employee relationship with the party to the proceedings, but may do so where it has reason to doubt that an employment relationship exists, such as when different addresses are indicated or when one and the same person is nominated as the employee of different legal persons.

2.4.2 Representation by employees of a legal person with economic connections

Article 119(3) EUTMR Article 77(3) CDR

Employees of legal persons may represent other legal persons provided that the two legal persons have economic connections with each other. Economic connections in this sense exist when there is economic dependence between the two legal persons, either in the sense that the party to the proceedings is dependent on the employer of the employee concerned, or vice versa. This economic dependence may exist:

- either because the two legal persons are members of the same group; or
- because of management control mechanisms (22/09/2016, T-512/15, SUN CALI (fig.), EU:T:2016:527, § 33 et seq.).

However, the following are not sufficient to establish economic connections:

- a connection by virtue of a trade mark licensing agreement;
- a contractual relationship between two enterprises aimed at mutual representation or legal assistance;
- a mere supplier/client relationship, for example, on the basis of an exclusive distribution or franchising agreement.

Where an employee representative wishes to rely on economic connections, he or she must tick the relevant section in the official form, and indicate his or her name and the name and address of the employer. It is recommended that the nature of the economic connection be indicated, unless it is evident from the documents submitted. The Office will not generally make any enquiries in this regard, unless it has reason to doubt that economic connections exist. In this case, the Office may ask for further explanation and, where necessary, documentary evidence.

2.5 Legal representation and signature

Legal representation refers to the representation of natural or legal persons through other persons in accordance with national law. For example, the president of a company is the legal representative of that company.

In the case that a natural person is acting as a legal representative, this should be indicated underneath the signature(s), the name(s) of the individual person(s) signing and the person's(persons') status, for example, 'president', 'chief executive officer', 'gérant', 'procuriste', 'Geschäftsführer' or 'Prokurist'.

Other examples of legal representation according to national law are cases where minors are represented by their parents or by a custodian, or a company is represented by a liquidator. In these cases, the person actually signing must demonstrate his or her capacity to sign even though no authorisation is required.

It should be borne in mind, however, that a legal person addressing the Office from outside the EEA must be represented by a professional representative within the EEA, unless appointment of a representative is not mandatory (see paragraph 3.1 below for any exceptions to the general rule). See paragraph 3.2.1 below on the consequences of not appointing a representative, when representation is mandatory, once the EUTM application has been filed.

3 Appointment of a Professional Representative

3.1 Conditions under which appointment is mandatory

Subject to the exception outlined in paragraph 2.4 above, the appointment of a professional representative is mandatory for parties to proceedings before the Office that do not have their domicile or their principal place of business, or a real and effective industrial or commercial establishment in the EEA. This obligation exists for all

proceedings before the Office, except for the filing of an application for an EUTM or an RCD, an application for renewal of an EUTM or an RCD, and an application for inspection of files.

The same applies to international registrations designating the EU. For further information on this point, please see the Guidelines, Part M, International Marks.

3.1.1 Domicile and place of business

The criterion for mandatory representation is domicile or place of business or commercial establishment, not nationality. For example, a French national domiciled in Japan has to be represented, but an Australian national domiciled in Belgium does not have to be. The Office will determine this criterion with respect to the address indicated. Where the party to the proceedings indicates an address outside the EEA, but relies on a place of business or establishment within the EEA, it must give the appropriate indications and explanations, and any correspondence with that party will have to be made to the address in the EEA. The criterion of the principal place of business or real and effective industrial or commercial establishment is not fulfilled where the party to the proceedings merely has a post office box or an address for service in the EEA, nor where the applicant indicates the address of an agent with a place of business in the EEA. A subsidiary is not a real and effective industrial or commercial establishment since it has its own legal personality. Where the party to the proceedings indicates an address within the EEA as its own address, the Office will not investigate the matter further unless exceptional reasons give rise to some doubt.

For legal persons, the domicile is determined in accordance with Article 65 TFEU. The actual seat or main domicile must be in the EEA. It is not sufficient that the law governing the company is the law of a Member State of the EEA.

3.1.2 The notion of 'in the EEA'

Article 119(2) EUTMR

In applying Article 119(2) EUTMR, the relevant territory is the territory of the EEA, which comprises the EU and the countries of Iceland, Liechtenstein and Norway.

Article 77(2) CDR

For RCDs, the notion of 'in the EEA' also applies. The relevant territory for establishing the obligation to be represented and the place where the representative must be based pursuant to Article 78 CDR is also the EEA (13/07/2017, T-527/14, PAUL ROSENICH, EU:T:2017:487).

3.2 Consequences of non-compliance when appointment is mandatory

Article 120(1) EUTMR Article 78(1) CDR

Where a party to proceedings before the Office is in one of the situations described under paragraph 3.1, but has failed to appoint a professional representative within the meaning of Article 120(1) EUTMR or Article 78(1) CDR in the application or request, or where compliance with the representation requirement ceases to exist at a later stage (e.g. where the representative withdraws), the legal consequences depend on the nature of the proceedings concerned.

3.2.1 During registration

Articles 31(3) and 119(2) EUTMR Article 10(3)(a) CDIR

Where representation is mandatory and the applicant fails to designate a professional representative in the application form, the examiner will invite the applicant to appoint a representative as part of the formality examination pursuant to Article 31(3) EUTMR, first sentence, or Article 10(3)(a) CDIR. Where the applicant fails to remedy this deficiency, the application will be refused.

The same course of action will be taken where the appointment of a representative ceases to exist later during the registration process, up until any time before actual registration, that is to say, even within the period between publication of the EUTM application and registration of the EUTM.

Where a specific ('secondary') request is introduced on behalf of the applicant during the registration process, for example a request for inspection of files, a request for registration of a licence or a request for restitutio in integrum, the appointment of a representative need not be repeated, but the Office may in case of doubt request an authorisation. The Office will in this case communicate with the representative on file, and the representative for the recordal applicant, where different.

3.2.2 During opposition

For EUTM applicants, the preceding paragraphs apply where appointment of a representative is mandatory. The procedure to remedy any deficiencies relating to representation will take place outside the opposition proceedings. Where the applicant fails to remedy the deficiency, the EUTM application will be refused, and the opposition proceedings will be terminated.

Article 2(2)(h)(ii) and Article 5(5) EUTMDR

As regards the opponent, any initial deficiency relating to representation is a ground for inadmissibility of the opposition. Where representation is mandatory pursuant to Article 119(2) EUTMR and the notice of opposition does not contain the appointment of a representative, the examiner will invite the opponent to appoint a representative within a 2-month time limit pursuant to Article 5(5) EUTMDR. If the deficiency is not remedied before the time limit expires, the opposition will be rejected as inadmissible.

When a representative resigns, the proceedings continue with the opponent itself if it is from the EEA. If the opponent is from outside the EEA, the Office will issue a deficiency inviting the opponent to appoint a representative. If the deficiency is not remedied, the opposition will be rejected as inadmissible.

When there is a withdrawal, change or appointment of a representative during opposition proceedings, the Office will inform the other party of the change by sending a copy of the letter and of the authorisation (if submitted).

3.2.3 Cancellation

Article 12(1)(c)(ii) and Article 15(4) EUTMDR

In cancellation proceedings, the above paragraphs concerning the opponent apply mutatis mutandis to the applicant for revocation or declaration of invalidity of an EUTM.

Where an EUTM proprietor from outside the EEA is no longer represented, the examiner will invite it to appoint a representative. If it does not do so, procedural statements made by it will not be taken into account, and the cancellation application will be dealt with on the basis of the evidence that the Office has before it. However, a registered EUTM will not be cancelled simply because an EUTM proprietor from outside the EEA is no longer represented.

3.3 Appointment of a representative when not mandatory

Where the party to the proceedings before the Office is not obliged to be represented, they may nevertheless, at any time, appoint a representative within the meaning of Article 119 or 120 EUTMR and Articles 77 and 78 CDR.

Where a representative has been appointed, the Office will communicate solely with that representative (see paragraph 4 below).

3.4 Appointment/replacement of a representative

3.4.1 Explicit appointment/replacement

Article 74(7) EUTMDR Article 1(1)(e) and Article 62(8) CDIR

A representative is normally appointed in the official Office form initiating the procedure involved, for example, the application form or the opposition form. More than one representative (up to a maximum of two) may be appointed by ticking the appropriate box 'multiple representatives' and giving the necessary details for each of the additional representatives.

A representative may also be appointed in a subsequent communication. In the same way, a representative may also be replaced at any stage of the proceedings.

The appointment must be unequivocal.

It is strongly recommended that the request for registration of an appointment of a representative be submitted electronically via the Office's website (e-recordals).

An application to record an appointment must contain:

- the registration or application number of the EUTM/RCD registration or application;
- the new representative's particulars;
- the signature(s) of the person(s) requesting the recordal.

When the application does not comply with the above, the recordal applicant will be invited to remedy the deficiency. The notification will be addressed to the person who filed the application to record the appointment of the representative. If the recordal applicant fails to remedy the deficiency, the Office will reject the application.

Where a representative has been appointed, the notification will be sent to the party that submitted the application to register the appointment, that is to say, to the recordal applicant. Any other party, including the previous representative in the case of a replacement when he or she is not the recordal applicant, will be informed of the appointment in a separate communication only once the appointment has been registered.

When the application relates to more than one proceeding, the recordal applicant must select a language for the application that is common to all proceedings. If there is no common language, separate applications for appointment must be filed. For more information on the use of languages see the Guidelines, Part A, General Rules, Section 4, Language of Proceedings.

If there is no representative in the proceedings, a communication made in respect of a particular procedure (e.g. registration or opposition), accompanied by an authorisation signed by the party to the proceedings, implies the appointment of a representative.

This also applies where a general authorisation is filed in the same way. For information about general authorisations, see paragraph 5.2 below.

If there is already a representative in the proceedings, the person represented has to clarify whether the former representative will be replaced.

3.4.2 Implicit appointment

Submissions, requests, etc. filed on behalf of the parties by a representative (hereafter the 'new' representative) other than the one who appears in our register (hereafter the 'old' representative) will initially be accepted.

The Office will then send a letter to the 'new' representative inviting him or her to confirm his or her appointment within 1 month. The letter will include a warning that if the representative does not reply within the time limit, the Office will assume that he or she has not been appointed as representative.

If the 'new' representative confirms his or her appointment, the submission will be taken into account and the Office will send further communications to the 'new' representative.

If the 'new' representative does not reply within 1 month or confirms that he or she is not the 'new' representative, the proceedings will go on with the 'old' representative. The submission and the answer from the 'new' representative will not be taken into account and will be forwarded to the 'old' representative for information purposes only.

In particular, when the submission leads to the closure of proceedings (withdrawals/ limitations), the 'new' representative must confirm his or her appointment as representative so that the closure of proceedings or the limitation can be accepted. In any case, the proceedings will not be suspended.

3.4.3 Associations of representatives

Article 74(8) EUTMDR Article 62(5) CDIR

An association of representatives (such as firms or partnerships of lawyers or professional representatives or both) may be appointed rather than the individual representatives working within that association.

This must be indicated accordingly, with only the name of the association of representatives to be indicated, and not the names of the individual representatives working within that association.

The appointment of an association of representatives automatically extends to any professional representative who, subsequent to the initial appointment, joins that association of representatives. Conversely, any representative who leaves the association of representatives automatically ceases to be authorised under that association. Providing the Office with the names of the representatives of whom the

association consists is neither required nor recommended. However, it is strongly recommended that any changes and information concerning representatives leaving the association be notified to the Office. The Office reserves the right, if justified under the circumstances of the case, to verify whether a given representative actually works within the association.

Article 120(1) EUTMR Article 74 EUTMDR Article 78(1) CDR Article 62 CDIR

The appointment of an association of representatives does not depart from the general rule that only professional representatives within the meaning of Article 120(1) EUTMR and Article 78(1) CDR may perform legal acts before the Office on behalf of third parties. Thus, any application, request or communication must be signed by a physical person possessing this qualification. The representative must indicate his or her name underneath the signature. He or she may indicate his or her individual ID number, if given by the Office, although it is not necessary to obtain an individual ID number, as the association ID number prevails.

3.4.4 ID numbers

On any form and in any communication sent to the Office, the representative's address and telecommunication details may, and preferably should, be replaced by the ID number attributed by the Office, together with the representative's name. Not only Office professional representatives entered on the list maintained by the Office (see paragraph 2.2 above), but also legal practitioners and associations of representatives, will have such ID numbers. Furthermore, where representatives or associations of representatives have several addresses, they will have a different ID number for each of those addresses.

The ID number can be found by consulting any of the files of the representative in question on the Office's website: www.euipo.europa.eu.

4 Communication with Representatives

Article 60(1) and (3) and Article 66 EUTMDR Article 53(1) and (3) and Article 63 CDIR

Where a representative has been appointed within the meaning of Article 119 or 120 EUTMR and Article 77 or 78 CDR, the Office will communicate solely with that representative.

Any notification or other communication addressed by the Office to the duly authorised representative will have the same effect as if it had been addressed to the person represented.

Any communication addressed to the Office by the duly authorised representative will have the same effect as if it originated from the person represented.

In addition, if the person represented itself files documents with the Office while being represented by a duly authorised representative, these documents will be accepted by the Office as long as the person represented has its domicile or principal place of business or a real and effective industrial or commercial establishment in the EEA. Otherwise, the documents submitted will be rejected.

Article 60(2) EUTMDR Article 53(2) CDIR

A party to the proceedings before the Office may appoint several representatives, in which case each of the representatives may act either jointly or separately, unless the authorisation given to the Office provides otherwise. The Office, however, will as a matter of course communicate only with the first-named representative, except in the following cases:

- where the applicant indicates a different address as the address for service in accordance with Article 2(1)(e) EUTMIR and Article 1(1)(e) CDIR;
- where the additional representative is appointed for a specific secondary procedure (such as inspection of files or opposition), in which case the Office will communicate with this representative during the course of this specific secondary procedure.

Article 119(4) EUTMR Articles 60(1) and (2) and 73(1) EUTMDR Article 61(1) CDIR

Where there is more than one applicant, opponent or any other party to proceedings before the Office, a common representative may be expressly appointed.

Where a common representative is not expressly appointed, the first applicant named in the application that is domiciled in the EEA, or its representative if appointed, will be considered to be the common representative.

If none of the applicants are domiciled in the EEA, they are obliged to appoint a professional representative; therefore, the first named professional representative appointed by any of the applicants will be considered to be the common representative.

The Office will address all notifications to the common representative.

5 Authorisation

Articles 119(3) and 120(1) EUTMR
Article 74 EUTMDR
Articles 77(3) and 78(1) CDR
Article 62 CDIR

In principle, professional representatives do not need to file an authorisation to act before the Office. However, any professional representative (legal practitioner or Office professional representative entered on the list, including an association of representatives) acting before the Office must file an authorisation for insertion in the files if the Office expressly requires this or, where there are several parties to the proceedings in which the representative acts before the Office, if the other party expressly asks for this.

In such cases, the Office will invite the representative to file the authorisation within a specific time limit The letter will include a warning that if the representative does not reply within the time limit, the Office will assume that he or she has not been appointed as representative and proceedings will continue directly with the party. Where representation is mandatory, the party represented will be invited to appoint a new representative and paragraph 3.2 above applies. Any procedural steps, other than the filing of the application, taken by the representative will be deemed not to have been taken if the party represented does not approve them within a period specified by the Office.

An authorisation must be signed by the party to the proceedings. In the case of legal persons, it must be signed by a person who is entitled, under the applicable national law, to act on behalf of that person.

Simple photocopies of the signed original may be submitted, including by fax. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them.

Authorisations may be submitted in the form of individual or general authorisations.

5.1 Individual authorisations

Article 120(3) EUTMR
Article 65(1)(i) and Article 74 EUTMDR
Article 78(5) CDR
Article 62 and Article 68(1)(i) CDIR

Individual authorisations may be made on the form established by the Office pursuant to Article 65(1)(i) EUTMDR and Article 68(1)(i) CDIR. The procedure to which the authorisation relates must be indicated (e.g. 'concerning EUTM application number 12345'). The authorisation will then extend to all acts during the lifetime of the ensuing EUTM. Several proceedings may be indicated.

Individual authorisations, whether submitted on the form made available by the Office or on the representative's own form, may contain restrictions as to its scope.

5.2 General authorisations

Article 120(1) EUTMR
Article 65(1)(i) and Article 74 EUTMDR
Article 78(1) CDR
Article 62 and Article 68(1)(i) CDIR

A 'general authorisation' authorises the representative, the association of representatives or the employee to perform all acts in all proceedings before the Office, including, but not limited to, the filing and prosecution of EUTM applications, the filing of oppositions and the filing of requests for a declaration of revocation or invalidity, as well as in all proceedings concerning RCDs and international marks. The authorisation should be made on the form made available by the Office, or a form with the same content. The authorisation must cover all proceedings before the Office and may not contain limitations. For example, where the text of the authorisation relates to the 'filing and prosecution of EUTM applications and defending them', this is not acceptable because it does not cover the authority to file oppositions and requests for a declaration of revocation or invalidity. Where the authorisation contains such restrictions, it will be treated as an individual authorisation.

5.3 Consequences where authorisation expressly requested by the Office is missing

If representation is not mandatory, the proceedings will continue with the person represented.

If representation is mandatory, paragraph 3.2 above will apply.

6 Withdrawal of a Representative's Appointment or Authorisation

A withdrawal or change of representative may be brought about by an action taken by the person represented, the previous representative or the new representative.

6.1 Action taken by the person represented

Article 74(4) EUTMDR Article 62(5) CDIR

The person represented may at any time revoke, in a written and signed communication to the Office, the appointment of a representative or the authorisation granted to them. Revocation of an authorisation implies revocation of the representative's appointment.

Article 74(5) EUTMDR Article 62(6) CDIR

Any representative who has ceased to be authorised will continue to be regarded as the representative until the termination of that representative's authorisation has been communicated to the Office.

Where the party to the proceedings is obliged to be represented, paragraph 3.2 above will apply.

6.2 Withdrawal by the representative

The representative may at any time declare, by a signed communication to the Office, that they withdraw as a representative. The request must indicate the number of the proceedings (e.g. EUTM/RCD number, opposition, etc.). If the representative declares that representation will be taken over by another representative as from that moment,

the Office will record the change accordingly and correspond with the new representative.

7 Death or Legal Incapacity of the Party Represented or Representative

7.1 Death or legal incapacity of the party represented

Article 74(6) EUTMDR Article 62(7) CDIR

In the event of the death or legal incapacity of the authorising party, the proceedings will continue with the representative, unless the authorisation contains provisions to the contrary.

Article 106(1) EUTMR Article 59(1) CDIR

Depending on the proceedings, the representative will have to apply for registration of a transfer to the successor in title. However, in the event of the death or legal incapacity of the applicant for, or proprietor of, an EUTM, the representative may apply for an interruption of proceedings. For more information on interrupting opposition proceedings following the death or legal incapacity of the EUTM applicant or its representative, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters.

In insolvency proceedings, a liquidator, once nominated, will assume the capacity to act on behalf of the bankrupt person and may — or (in the case of mandatory representation) must — appoint a new representative, or else confirm the appointment of the existing representative.

For more information on insolvency proceedings, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 2, Licences, Rights in Rem, Levies of Execution, Insolvency Proceedings or Similar Proceedings.

7.2 Death or legal incapacity of the representative

Article 106(1) and (2) EUTMR Article 72(2) EUTMDR Article 59(1)(c) and Article 59(3) CDIR

In the event of the death or legal incapacity of a representative, the proceedings before the Office will be interrupted. If the Office has not been informed of the appointment of a new representative within a period of 3 months after the interruption, the Office will:

- where representation is not mandatory, inform the authorising party that the proceedings will now be resumed with them;
- where representation is mandatory, inform the authorising party that the legal consequences will apply, depending on the nature of the proceedings concerned (e.g. the application will be deemed to have been withdrawn, or the opposition will be rejected), if a new representative is not appointed within 2 months of the date of notification of that communication (28/09/2007, R 48/2004-4, PORTICO / PORTICO, § 13, 15).

Annex 1

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Austria	Rechtsanwalt	Lawyers are fully entitled.	Patentanwalt	Notaries may represent third parties before the Austrian central industrial property office because of their special professional qualification. Therefore, notaries may apply to be entered on the list of professional representatives.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Belgium	Avocat, Advocaat, Rechtsanwalt	Lawyers are fully entitled but a person cannot be a lawyer and a professional representative at the same time.	In Dutch: Merkengemachtigde In French: Conseil en Marques/Conseils en propriété industrielle In German: Patentanwalt	Any person having an address in the EEAmay represent clients in IP matters. The entitlement is not conditional upon the need for special professional qualifications; persons applying to be entered on the list must have regularly acted as professional representatives for at least 5 years before a central industrial property office of a Member State.
Bulgaria	Адвокат/Практикуващ Право Advokat/Praktikuvasht Pravo	Lawyers are not entitled.	Spetsialist po targovski marki/ Spetsialist po dizayni Специалист по търговски марки/Специалист по дизайни	Special professional qualification is required. The Bulgarian Patent Office is able to certify that someone has acted as representative for 5 years.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Croatia	Odvjetnik	Lawyers are fully entitled.	Zastupnik Za Žigove	Special professional qualification is required. The 'authorised representative' is the person who passed an exam for TM representatives before the Croatian Office.
Czech Republic	Advokát	Lawyers are fully entitled.	Patentový zástupce	The Czech Republic has a two-part examination. Persons who have passed part B (trade marks and appellation of origin) may act as representatives in this field and hence be entered on the list in Article 120 EUTMR. Patent attorneys, who have passed both parts of the examination, are entitled to represent applicants in all procedures before the Office.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Cyprus	Δικηγόρος Dikigoros	Only lawyers are entitled.	nihil	Not relevant.
Denmark	Advokat	Lawyers are fully entitled.	Varemaerkefuldmaegtig	The entitlement is not conditional upon the need for special professional qualifications; persons applying to be entered on the list must have regularly acted as professional representatives for at least 5 years before a central industrial property office of a Member State.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Estonia	Jurist, Advokaat	Lawyers are not entitled unless dually qualified as IP agents.	Patendivolinik	The examination consists of two independent parts: on the one hand, patents and utility models and, on the other, trade marks, designs and geographical indications. Both types of representatives are 'patendivolinik'. Persons who have only passed the patents part of the examination may not be entered on the list of Article 120 EUTMR. Entry on the list is open to persons who have passed the trade marks, industrial designs and geographical indications part.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Finland	Asianajaja, Advokat	Lawyers are fully entitled.	In Finnish: Tavaramerkkiasiamies In Swedish: Varumaerkesombud	As from 1 July 2014, the Finnish Patent Office will issue certificates to those professional representatives who comply with the conditions laid down in Article 120(2) EUTMR for entry in the list of professional representatives.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
France	Avocat	Legal practitioners are entitled but a person cannot be a lawyer and a professional representative at the same time.	Conseil en Propriété Industrielle (marques et modèles) ou juriste.	INPI maintains two different lists: The Liste des Conseils en propriété industrielle and the Liste des Personnes qualifiées en Propriété industrielle . Only persons on the Liste des Conseils en propriété industrielle are entitled to represent third parties before the French Patent Office. Therefore, only these persons are entitled to be on the Office's list of professional representatives.
Germany	Rechtsanwalt	Lawyers are fully entitled.	Patentanwalt	A 'Patentassessor' is not qualified to act as a professional representative, but may act as an employee representative.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Greece	Δικηγόρος — Dikigoros	Only lawyers are entitled.	nihil	Not relevant.
Hungary	Ügyvéd	Attorneys-at-law are fully entitled but legal advisers or notaries are not allowed to act as legal practitioners in procedures relating to industrial property matters. Therefore, they may not be entered on the Office's list of professional representatives.	Szabadalmi ügyvivő	A special professional qualification is required to be a patent attorney. Patent attorneys are entitled to represent clients in all procedures before the Office. Therefore, they may apply to be entered on the Office's list of professional representatives.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Iceland	Lögfræðingur (Lawyer), Lögmaður (Attorney-at-Law), Héraðsdómslögmaður (District Court Attorney), Hæstaréttarlögmaður (Supreme Court Attorney)	Both Trade Mark and Design Acts have provisions concerning representation of foreign applicants (see Article 35 of the Icelandic Trade Mark Act No 45/1997 and Article 47 of the Icelandic Design Act No 46/2001). No requirements are, however, made by law or regulation with regard to education, experience or special qualifications of representatives/agents.	Umboðsmaður	No special qualification is required, but usually, representatives/agents are European patent attorneys or representatives from specialised firms where employees have gained knowledge and experience in patent, trade mark and design matters. A person whose professional qualifications to represent natural or legal persons in trade mark and/or design matters before the Icelandic Patent Office are officially recognised in accordance with the regulations laid down by that State will not be subject to the condition of having exercised the profession for at least 5 years.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Ireland	Barrister, Solicitor	Lawyers are fully entitled.	Trade mark agent	The person has to be entered in the Register of TM Agents.
Italy	Avvocato	Lawyers are fully entitled.	Consulenti abilitati/Consulenti in Proprietà Industriale	The person has to be entered in the Register of 'Consulenti in Proprietà Industriale' ('Albo') kept by the Bar ('Consiglio dell'Ordine') and the register communicated to the Italian trade mark and patent office ('UIBM').
Latvia	Advokāts	Lawyers can only represent clients whose permanent residence is in the European Union. Clients whose permanent residence is not in the EU have to be represented by a professional representative.	Patentu pilnvarotais/Preču zīmju aģents/Profesionāls patentpilnvarotais	There is a trade mark examination. Clients whose permanent residence is not in the EU have to be represented by a professional representative. Notaries cannot act as representatives by right.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Liechtenstein	Rechtsanwalt	Lawyers are fully entitled.	Patentwalt	Special professional qualification is required.
Lithuania	Advokatas	Lawyers can only represent clients whose permanent residence is in the European Union. Clients whose permanent residence is not in the EU have to be represented by a professional representative.	Patentinis patikėtinis	Clients whose permanent residence is not in the EU have to be represented by a professional representative. Notaries cannot act as representatives by right.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Luxembourg	Avocat/Rechtsanwalt	Lawyers are fully entitled but a person cannot be a lawyer and a professional representative at the same time.	In French: Conseil en Marques/Conseils en propriété industrielle In German: Patentanwalt	Any person having an address in the EEA may represent clients in IP matters. The entitlement is not conditional upon the need for special professional qualifications; persons applying to be entered on the list must have regularly acted as professional representatives for at least 5 years before a central industrial property office of a Member State.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Malta	Avukat, Prokuratur Legali	Lawyers are fully entitled.		Anyone with a legal background, including notaries, can act as a trade mark agent. No documentary proof of the qualification of legal practitioners acting as trade mark agents is required.
Norway	Advokat, Advokatfullmektig	Legal practitioners are fully entitled. If the legal practitioner acts as an attorney-at-law no power of attorney is necessary. If the legal practitioner acts as an employee of a company a power of attorney is necessary, even if the employee is an attorney-at-law.	n/a	Entitlement is not conditional upon the need for special professional qualifications; persons applying to be entered on the list must have regularly acted as professional representatives for at least 5 years before a central industrial property office.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Poland	Adwokat, radca prawny	Lawyers are fully entitled for EUTM matters, but not for RCD matters.	Rzecznik Patentowy	The representative has to be on the list of patent attorneys maintained by the Polish Patent Office.
Portugal	Advogado	Lawyers are fully entitled.	Agente Oficial da Propriedade Industrial	5 years' experience or special qualifications. A notary is not a legal practitioner and, therefore, may apply to be entered on the list.
Romania	Avocat	Lawyers are not fully entitled.	Consilier în proprietate industrială	In Romania, three lists are maintained. Representatives are required to have special qualifications or 5 years' experience and be a member of a national chamber. A special professional qualification is required to be a professional representative.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Slovakia	Advokát, Komerčný Pravnik	Lawyers are fully entitled.	Patentový zástupca	In Slovakia, legal practitioners (‘advokáts’) listed in the Slovak BAR Association may act as representatives before the Industrial Property Office of the Slovak Republic.
Slovenia	Odvetnik	Lawyers are fully entitled.	Patentni zastopnik	Legal practitioners who are not entered in the Slovenian register as patent/trade mark agents are not allowed to represent parties before the Office. Notaries are not entitled by right.
Spain	Abogado	Lawyers are fully entitled.	Agente Oficial de la Propiedad Industrial	Entry on the list is conditional upon an examination.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Sweden	Advokat	Lawyers are fully entitled.	Patentombud	Entitlement is not conditional upon the need for special professional qualifications; persons applying to be entered on the list must have regularly acted as professional representatives for at least 5 years before a central industrial property office of a Member State.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
Netherlands	Advocaat	Lawyers are fully entitled but a person cannot be a lawyer and a professional representative at the same time.	Merkengemachtigde	Any person having an address in the EEA may represent clients in IP matters. The entitlement is not conditional upon the need for special professional qualifications; persons applying to be entered on the list must have regularly acted as professional representatives for at least 5 years before a central industrial property office of a Member State.

Country	National terminology for legal practitioner	Entitlements/specific rules for representing clients in trade mark and design matters	National terminology for person with the special qualification — patent/trade mark/design attorney (the Office PROF REP)	Entitlements/specific rules for representing clients in trade mark and design matters
United Kingdom	Barrister, solicitor, registered trade mark attorney	Lawyers are fully entitled.		Entitlement is not conditional upon the need for special professional qualifications; persons applying to be entered on the list must have regularly acted as professional representatives for at least 5 years before a central industrial property office of a Member State.

Annex 2

The list below shows the countries where a title exists for a person who is only entitled to represent in design matters. If the country is not on the list it means that the relevant entitlement also covers trade mark matters and so this person would not be on the special designs list.

COUNTRY	Design Attorney
Czech Republic	Patentový zástupce (the same denomination as trade mark agent)
Denmark	Varemaerkefuldmaegtig
Estonia	Patendivolinik
Finland	Mallioikeusasiamies/, Mönsterrättsombud
Ireland	Registered Patent Agent
Italy	Consulente in brevetti
Latvia	Patentpilnvarotais dizainparaugu lietas
Romania	Consilier de proprietate industriala
Sweden	Varumaerkesombud
United Kingdom	Registered patent agent

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 6

Revocation of decisions, cancellation of entries in the register and correction of errors

Table of Contents

1 Revocation of Decisions and Cancellation of Entries in the Register

Article 103 EUTMR Article 70 EUTMDR

Under certain conditions a decision taken by the Office can be revoked or an entry in the Register cancelled. This part of the Guidelines deals with the practical aspects of revocation/cancellation under Article 103 EUTMR; it does not apply to registered Community designs (RCDs).

The revocation procedure can be initiated either by a party to the proceedings or by the Office on its own motion.

A decision can only be revoked by another decision. The same applies to cancellations of entries in the Register.

1.1 Obvious errors attributable to the Office

A decision must be revoked or an entry in the Register cancelled when it contains an obvious error attributable to the Office. The wording 'obvious error' covers substantial procedural violations and the obvious distortion of facts. It does not contain errors of substance, where no revocation is possible.

A decision/entry contains an obvious error where there has been an error in the proceedings (usually when an essential procedural step was omitted) or where the decision/entry ignores a procedural action taken by the parties. The decision/entry is incorrect if the procedure established by the Regulations has not been followed correctly.

The following is a non-exhaustive list of examples of obvious errors requiring revocation.

- The EUTM is registered despite having previously been withdrawn.
- The opposition has been found admissible even though some admissibility requirements were not met (18/10/2012, C-402/11 P, Redtube, EU:C:2012:649).
- The EUTM is registered despite a deficiency in the payment of the application fees.
- The EUTM is registered despite a successful opposition.
- The EUTM's refusal on absolute grounds is notified before expiry of the time limit given to the applicant to send observations in reply to the objection, or ignoring the observations the applicant filed on time. (Where the applicant has responded within the time limit, the examiner can continue dealing with the application, for example by issuing a decision, and is not required to wait until expiry of the time limit set in the objection letter.)

- The EUTM is refused on absolute grounds, ignoring a valid request from the applicant for the opportunity to submit evidence of acquired distinctiveness (Article 7(3) EUTMR).
- The EUTM is refused on absolute grounds, ignoring the evidence of acquired distinctiveness duly submitted.
- The EUTM is refused by the Opposition Division, ignoring an unprocessed request for proof of use or without dealing with the issue of proof of use.
- The EUTM is registered despite a pending opposition.
- The opposition is rejected on the basis of lack of proof of use but:
  - the opponent was not expressly given a time limit for submitting proof of use;
  - proof of use was filed on time and was overlooked.
- The opposition decision was rendered while the proceedings were suspended or interrupted or, more generally, while a time limit for one of the parties was still running.
- Any breach of the right to be heard (observations not forwarded to the other party when that party should have been given a time limit to reply pursuant to the Regulation or the Office's practice).
- When closing a file due to a limitation of the contested EUTM application or a withdrawal, the Office has issued a decision on costs, overlooking an agreement on costs between both parties that was on file at the time.
- A transfer of ownership was entered in the Register despite insufficient evidence of the transfer.

Whether or not these errors were a result of human error or of the incorrect functioning of an IT tool is immaterial.

The effect of the revocation of a decision or of the cancellation of an entry in the Register is that the decision or entry is deemed never to have existed. The file is returned to the procedural stage it was at before the erroneous decision or entry was made.

1.2 Who decides on revocation/cancellation?

Decisions on revocation/cancellation are made by the department or unit that made the entry or took the decision, and can be appealed under Article 66(2) EUTMR.

1.3 Procedural aspects

1.3.1 Assessment

The Office must verify, firstly, whether the decision or entry contains an obvious error; secondly, whether more than 1 year has passed since notification of the decision or entry in the Register; and, thirdly, whether there has been an appeal against the decision/entry in the Register.

1. Nature of the error. It must be verified whether the decision or entry contains an obvious error. For further information, see paragraph 1.1 above.
2. One year. It must first be established whether more than one year has passed since notification of the decision or entry in the Register.
   Article 103(2) EUTMR provides that revocation/cancellation must be effected within one year of the date on which the erroneous decision was taken or the erroneous entry was made in the Register, after consultation with the parties to the proceedings and any proprietor of rights to the EU trade mark in question that are entered in the Register. The revocation/cancellation is deemed 'effected' on the date of notification of the decision on revocation/cancellation, regardless of any appeal.

   As revocation/cancellation is not possible after one year, any request for revocation/cancellation received after the time limit will be rejected as inadmissible. Furthermore, even if a request has been received within that time limit, any pending proceedings for revocation/cancellation will be terminated and the request rejected upon expiry of the one-year period, irrespective of the reason why the proceedings for revocation/cancellation could not be concluded on time. In light of the fixed and equitable time limit, those adversely affected must inform the Office about the obvious error identified without any delay, particularly where an adverse party may be involved who needs to be consulted. In any event, irrespective of the time remaining of the one year, the Office will always initiate the procedure for revocation/cancellation if it becomes aware of an obvious error to be corrected, and will do its utmost to conduct an expedient procedure to conclude on time.
3. Decision/entry against which an appeal is pending. An appeal filed against a decision containing an obvious error is not an obstacle to revocation. Article 103(4) EUTMR provides that the appeal proceedings will become devoid of purpose upon revocation of an erroneous decision. The department competent to decide on the revocation will inform the Boards of Appeal promptly if it is considering a revocation/cancellation and also inform them of the outcome of its deliberations (i.e. the intention to revoke and the final decision on revocation).

1.3.2 Distinction between where only one party and where more than one party is affected

The procedure where only one party is affected is described in paragraph 1.3.2.1 below. Examples are when the Office duly receives third-party observations that raise doubts but the EUTM application is not blocked and continues to registration; and where an EUTM application is registered although the application fee has not been paid.

Errors that concern incorrect handling of the files after a decision has been taken, for example where an EUTM application is registered despite having been refused on absolute grounds, affect only one party — the applicant.

If revocation of a decision is likely to affect more than one party, the procedure described in paragraph 1.3.2.2 below must be followed. For example, more than one

party is affected by the revocation of a decision in opposition proceedings where the Office overlooked a request for proof of use.

Errors that concern incorrect handling of the files after an opposition decision has been taken, such as where the entire EUTM application is rejected but is still registered, are considered to affect both the applicant and the opponent.

Errors in registering a transfer of ownership also affect more than one party. While the procedure for recordal is essentially ex parte, the Office will determine if more than one party is affected for the purposes of the procedure for cancellation of the erroneous entry: the new owner, the old owner and the third party that should have been entered in the Register, as the case may be.

1.3.2.1 Procedures when only one party is affected

Error found by the Office

If the Office itself finds that an error has been made, it informs the party of its intention to revoke the decision/cancel the entry and sets a time limit of one month for observations. The letter must state the reasons for the revocation/cancellation.

If the party agrees or does not submit any observations, the Office revokes the decision/cancels the entry.

If the party does not agree to revocation or cancellation, a formal decision has to be taken, which is subject to the usual requirements described in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 6.

Error notified by affected party

If the party adversely affected by an error informs the Office in writing of the error, there is no need to ask for observations. In these cases, it must be determined whether revocation/cancellation is justified and possible. If so, the decision or entry in the Register is revoked/cancelled. If the Office finds that there are no reasons for revocation/cancellation or it is no longer possible, it informs the party accordingly, giving appropriate reasons.

1.3.2.2 Procedure when more than one party is affected

Error found by the Office

If the Office itself finds that an error has been made, it informs both parties of its intention to revoke the decision/cancel the entry and sets a time limit of one month for observations.

If the parties agree or do not submit any observations in reply, the Office revokes the decision/cancels the entry.

If the party that benefited from the error does not agree to the revocation/cancellation, a reasoned decision has to be taken, which is subject to the usual requirements described in the Guidelines, Part A, General Rules, Section 2, General Principles to be

Respected in the Proceedings, paragraph 6. There is no need to hear the party adversely affected by the error if the Office adopts a decision in its favour.

Error notified by one of the parties

If the party adversely affected by an error informs the Office in writing of the error, it must be determined whether revocation/cancellation is justified and possible. If so, the Office notifies the party that benefited from the error (the other party) of its intention to revoke/cancel and sets a time limit of one month for observations (sending a copy of the notification to the first party for information purposes).

If the other party agrees or does not submit any observations in reply, the Office revokes the decision/cancels the entry.

If the other party does not agree to revocation or cancellation, a reasoned decision has to be taken, which is subject to the usual requirements described in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 6. There is no need to hear the party adversely affected by the error (the first party) if the Office adopts a decision in its favour.

For example, where an opponent that has seen its opposition upheld and the EUTM application rejected informs the Office that the EUTM application has nevertheless been registered, the applicant must be informed and invited to submit observations. The entry will be cancelled regardless of whether the applicant agrees or does not reply.

If the party that benefited from the error informs the Office in writing, it must be determined whether revocation/cancellation is justified and possible. If so, the party adversely affected by the error must be informed accordingly. As revocation/ cancellation will be to the latter's advantage, the decision can be revoked or the entry cancelled at the same time as the letter is sent (to both parties). There is no need for the party that benefited from the error to submit observations, as its letter informing the Office of the error can be taken as its agreement to revocation/cancellation. Likewise, there is no need to hear the party adversely affected, as a decision is made in its favour.

For example, where an applicant informs the Office that its EUTM application has been registered despite being rejected in an opposition, the entry in the Register must be cancelled. There is no need to hear either the applicant (who benefited from the error) or the opponent (who was adversely affected by it).

Finally, once a revocation or cancellation has become final, it must be published if a wrong entry in the Register has already been published.

If the Office finds that, despite information received from either party, there are no reasons to revoke a decision/cancel an entry or it is no longer possible, it informs the parties accordingly, giving appropriate reasons (and forwarding the original request to the other party for information purposes).

2 Correction of Errors in Decisions and Other Notifications

Article 102(1) EUTMR

2.1 Correction of linguistic errors, errors of transcription and manifest oversights in decisions

2.1.1 General remarks

According to Article 102(1) EUTMR, the Office will correct any linguistic errors or errors of transcription and manifest oversights in its decisions. It is apparent from the wording that the only legitimate purpose of corrections made on the basis of this provision is to correct spelling or grammatical errors, errors of transcription or errors that are so obvious that nothing other than the wording as corrected could have been understood. However, when the error affects the dictum of a decision, only revocation is possible, and then only if all the conditions are met. When fixing of costs is part of the dictum of the decision it can be corrected only by revocation.

The distinction between revocation under Article 103 EUTMR and correction under Article 102(1) EUTMR is that revocation annuls a decision, whereas the correction of errors does not affect the validity of the decision and does not open a new appeal period.

2.1.2 Procedural aspects

2.1.2.1 Time limit

As there is no time limit for the correction of linguistic errors, errors of transcription and manifest oversights in decisions, such errors can be corrected any time.

2.1.2.2 Assessment

It must be verified whether the error to be corrected is a linguistic error, an error of transcription or a manifest oversight — in other words, that it does not fall rather within the scope of ‘obvious errors’ that can only be corrected through revocation pursuant to Article 103 EUTMR.

It results from the nature of the errors and oversights that can be corrected pursuant to Article 102 EUTMR that an appeal filed against a decision is not an obstacle to correction of the decision by the first instance department that adopted it. Nevertheless, the relevant department will inform the Boards of Appeal promptly if it is considering a correction and will also inform them of the outcome of its deliberations (i.e. whether any

correction has been made) with a view to it being taken into account in the appeal proceedings.

2.1.2.3 Procedure

Linguistic errors, errors of transcription and manifest oversights in decisions are corrected by sending a corrigendum to the affected party/parties. The accompanying letter must briefly explain the corrections.

Once the correction has been made, the Office makes sure that the changes are reflected in the decision as published in the Office's database.

The date of the decision remains unchanged after correction. Therefore, the time limit for appeal is not affected.

2.2 Correction of errors in notifications other than decisions

Errors in notifications other than decisions can be remedied by sending a corrected notification indicating that the latter replaces and annuls the one previously sent.

3 Correction of Technical Errors in Registering a Trade Mark or Publishing the Registration

Articles 44, 102, 111 and 116 EUTMR

Article 44(1) EUTMR states that EUTM applications that have not been refused on absolute grounds must be published.

Articles 44(3) and (4) EUTMR refer to the correction of mistakes and errors in the publication of the application.

Article 102 EUTMR refers to mistakes and errors in the registration of an EUTM or in any entry made in the Register in accordance with Article 111(2) and (3) EUTMR or a Decision of the Executive Director pursuant to Article 111(4) EUTMR, and to errors in the publication of those entries in the Register.

The main difference between the correction of an entry in the Register pursuant to Article 102 EUTMR and the cancellation of an entry in the Register pursuant to Article 103 EUTMR is that the former relates to only one part of the publication, whereas the latter cancels the whole entry in the Register.

Where there is an error attributable to the Office, the latter corrects it either of its own motion (where the Office itself has become aware of the error) or at the proprietor's request.

Corrections of errors in EUTM applications that do not require republication of the application for opposition purposes are published in Section B.2 of the Bulletin. Corrections pursuant to Articles 44(3) and (4) EUTMR that do require republication of

the application for opposition purposes are published in Section A.2. However, republication will only be required if the initial publication published a more limited list of goods and services. For more information on the effect of republication on pending opposition proceedings, see the Guidelines, Part C Opposition, Section 1, Procedural Matters, paragraph 6.1.2.

In all cases, the affected party/parties is/are notified of the corrections.

The following are examples of errors that can be corrected (Article 102 EUTMR).

- The EUTM has been published for one class fewer than applied for.
- The sign 'x' was applied for and the publication refers to the sign 'y', or the list of goods and services published is wrong.
- The EUTM has been registered without taking into consideration a limitation.

Corrections of errors in registered EUTMs that do not require republication for opposition purposes are published in subsection B.4.2 of the Bulletin. Corrections pursuant to Article 102 EUTMR that require republication of part of the application for opposition purposes are published in subsection A.2.1.2.

Republication for opposition purposes will always be required where a correction involves changes to the representation of the mark or a broadening of the list of goods and services already published. For other corrections, republication must be decided on a case-by-case basis.

Corrections to entries in the Register must be published pursuant to Article 102(3) and Article 116(1)(a) EUTMR. Corrections of relative errors in an entry in the Register are published in subsection B.4.2 of the Bulletin. All the examples listed above (of corrections and of revocation/cancellations) require publication.

No corrections need to be published pursuant to Article 102 EUTMR when the initial publication was in the wrong section of the Bulletin. The legal effect of the publication under Article 11(1) EUTMR remains the same regardless of whether the publication is made in Part B.1 or Part B.2 of the Bulletin'.

Time limit. There is no time limit for corrections pursuant to Article 102 or Article 44(3) and (4) EUTMR. They can be made at any time once the error has been detected.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 7

Revision

Table of Contents

1 General Principles

Article 69 EUTMR Article 58 CDR

Pursuant to Article 69 EUTMR in European Union trade mark (EUTM) cases and Article 58 CDR in registered Community design (RCD) cases, revision is only available in ex parte cases, that is to say, those that involve only one party.

Revision can be granted where an appeal has been lodged against a decision for which the Boards of Appeal are competent pursuant to Article 66 EUTMR and Article 55 CDR.

It is the responsibility of the Boards of Appeal to decide on an appealed decision. The Board sends the appealed decision back to the department that took the decision in order for it to be revised. This enables the first-instance decision taker to rectify the decision if the appeal is admissible and well founded.

The purpose of revision is to avoid the Boards of Appeal ruling on appeals against decisions for which a need for rectification has been recognised by the division that took the decision.

If the division of the Office whose decision is appealed considers the appeal to be admissible and well founded, it must rectify its decision.

If the decision is not rectified within 1 month following receipt of the statement of grounds of appeal, the appeal must be remitted to the Boards of Appeal without delay and without comment as to its merits.

Since revision requires a pending appeal, it is not available where an appeal has been withdrawn before the 1-month time limit for revision has expired and a decision on revision has not yet been taken.

2 Revision of Decisions in Ex Parte Cases

2.1 Procedures where revision is available

Articles 69 and 159 EUTMR Articles 58 and 102 CDR

Where revision is available, the Registrar of the Boards of Appeal sends the appeal documents.

The division concerned examines whether revision may be granted.

Revision may only be granted where the appeal is admissible and well founded.

2.2 Verification whether the appeal is admissible

Articles 66 to 68 EUTMR
Articles 21(1) and 23(1) EUTMDR
Articles 55 to 57 CDR
Articles 34(1) and 35(2) CDIR

The competent division must be satisfied that the appeal is admissible, that is to say, that it complies with the requirements laid down in Articles 66 to 68 EUTMR or Articles 55 to 57 CDR, and Article 21(1) EUTMDR or Article 34(1) CDIR, as well as with all other requirements to which Article 23(1) EUTMDR or Article 35(2) CDIR refer.

2.3 Verification whether the appeal is well founded

The competent division has to verify whether the appeal is 'well founded' within the context of the scope of the appeal.

An appeal will be 'well founded' within the meaning of Article 69 EUTMR and Article 58 CDR where the competent division finds that the appealed decision was not taken in accordance with the legal provisions under the EU Regulations. This covers cases of obvious procedural error or manifest errors on substance on the part of the Office.

The relevant date for assessing whether the appeal is 'well founded' is that on which the competent division took the appealed decision.

Revision will not be granted when the appellant attempts to remedy deficiencies for the first time before the Boards of Appeal, for example, by submitting new arguments or supporting documents.

2.4 Decision not to grant revision

Article 69(2) EUTMR
Article 58(2) CDR

When the competent division concludes that the conditions for granting revision are not met, and at the latest upon expiry of the 1-month time limit provided for in Article 69(2) EUTMR and Article 58(2) CDR, the competent division must remit the case to the Boards of Appeal without any comment or statement.

When the competent division remits the case without comments, no decision has to be taken to refuse revision.

2.5 Decision to grant revision

Article 69(2) and Article 75 EUTMR Article 33 EUTMDR Article 58(2) CDR Articles 37 and 38 CDIR

If the competent division concludes that revision will be granted, the rectified decision must be issued within 1 month following receipt of the statement of grounds of the appeal in order to comply with the time limit set in Article 69(2) EUTMR and Article 58(2) CDR. This is irrespective of the date on which the rectified decision is deemed to have been notified according to the form of notification.

For more information on notification by the Office, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.2.

2.5.1 Contents of the decision

Decisions to grant the revision will fall within one of the following categories:

- those where the outcome of the revision leads to the reopening of the proceedings;
- those where the outcome of the revision results in a new decision being issued on the merits of the case.

2.5.1.1 Reopening the proceedings

Article 66(2) EUTMR Article 33 EUTMDR Article 55(2) CDR Article 37 CDIR

Where the revision process identifies a need to reopen the proceedings — for example, a request for an extension of time was overlooked — revision must be granted and the first instance must issue a decision to grant the revision and reopen the proceedings from the point in time where the procedural mistake took place.

The rectified decision must contain:

- a decision to grant the revision, stating the reasons on which it is based;

- a decision to deem the initial decision not to have been rendered;
- a decision to reopen the proceedings and identification of the future actions to be carried out in the file;
- an order that the appeal fee will be refunded (Article 33 EUTMDR, Article 37 CDIR).

Following the rectified decision, the proceedings will be reopened as set out in the decision, and any relevant time limits will be set for the party concerned.

The decision to grant revision can only be appealed together with the final decision (Article 66(2) EUTMR and Article 55(2) CDR).

2.5.1.2 A new decision on the merits

Article 33 EUTMDR Article 37 CDIR

Where the revision process identifies that a new decision on the merits can be taken immediately without the need for the proceedings to be reopened — for example, if evidence of acquired distinctiveness was on file but was not addressed in the appealed decision — revision will be granted and the competent division must issue a rectified decision.

The rectified decision must contain:

- a decision to grant the revision, stating the reasons on which it is based;
- a new decision on the merits of the case, replacing the initial decision;
- an order that the appeal fee will be refunded (Article 33 EUTMDR, Article 37 CDIR);
- an indication of the time limit to appeal the rectified decision.

2.6 Communication of the decision

Once revision is granted, the competent division must inform the Registrar of the Boards of Appeal accordingly.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 8

Restitutio in integrum

Table of Contents

1 General Principles

Article 104 EUTMR Article 67 CDR

Parties to proceedings before the Office may have their rights reinstated (restitutio in integrum) if they were unable to meet a time limit vis-à-vis the Office despite taking all due care required by the circumstances, provided that the failure to meet the time limit had the direct consequence, by virtue of the provisions of the Regulations, of causing a loss of rights or loss of means of redress (28/06/2012, T-314/10, Cook's, EU:T:2012:329, § 16-17).

Observing time limits is a matter of public policy, and granting restitutio in integrum can undermine legal certainty. Consequently, the conditions for the application of restitutio in integrum have to be interpreted strictly (19/09/2012, T-267/11, VR, EU:T:2012:446, § 35).

Restitutio in integrum is only available upon application to the Office and is subject to the payment of a fee.

If the party is represented, the representative's failure to take all due care is attributable to the party that he or she represents (19/09/2012, T-267/11, VR, EU:T:2012:446, § 40).

2 Criteria for Granting Restitutio in integrum

There are two requirements for restitutio in integrum (25/04/2012, T-326/11, BrainLAB, EU:T:2012:202, § 36):

1. that the party has exercised all due care required by the circumstances; and
2. that the non-observance (of a deadline) by the party has the direct consequence of causing the loss of a right or means of redress.

2.1 The condition of 'all due care required by the circumstances'

Rights will be re-established only under exceptional circumstances that cannot be predicted from experience (13/05/2009, T-136/08, Aurelia, EU:T:2009:155, § 26) and are therefore unforeseeable and involuntary.

a) Examples of where the 'all due care' requirement has been fulfilled

In principle, failure to deliver by the postal or delivery service does not involve any lack of due care by the party concerned (25/06/2012, R 1928/2011-4, SUN PARK HOLIDAYS / SUNPARKS). However, it is up to the parties' representative at least to

find out in advance from the delivery company what the usual delivery times are (for example, in the case of letters sent from Germany to Spain in the decision of 04/05/2011, R 2138/2010-1, YELLOWLINE / Yello).

The degree of due care that the parties must demonstrate in order to have their rights re-established must be determined in the light of all the relevant circumstances. Relevant circumstances may include a relevant error made by the Office and its repercussions. Thus, even though the party concerned has failed to take all due care, a relevant error by the Office may result in the granting of restitutio in integrum (25/04/2012, T-326/11, BrainLAB, EU:T:2012:202, § 57, 59).

Circumstances such as natural disasters and general strikes are regarded as fulfilling the requirement for all due care.

b) Examples of where the 'all due care' requirement has NOT been fulfilled

Errors in the management of files caused by the representative's employees or by the computerised system itself are foreseeable. Consequently, due care would require a system for monitoring and detecting any such errors (13/05/2009, T-136/08, Aurelia, EU:T:2009:155, § 18).

'The exceptional workload and organisational strains to which the applicants claim they were subject as a result of the entry into force of Regulation No 40/94 are irrelevant in that connection' (20/06/2001, T-146/00, Dakota, EU:T:2001:168, § 62).

An erroneous calculation of the time limit does not constitute an exceptional event that cannot be predicted from experience (05/07/2013, R 194/2011-4, PAYENGINE / SP ENGINE).

An error by the Renewals Department Manager, who monitors staff performance daily, does not constitute an exceptional event (24/04/2013, R 1728/2012-3, LIFTING DEVICES (PART OF-)).

The absence of a key member of the Accounts Department cannot be regarded as an exceptional or unforeseeable event (10/04/2013, R 2071/2012-5, STARFORCE).

A clerical error in entering a deadline cannot be regarded as an exceptional or unforeseeable event (31/01/2013, R 265/2012-1, KANSI / Kanz).

A misunderstanding of the applicable law may not, as a matter of principle, be regarded as an 'obstacle' to compliance with a time limit (14/06/2012, R 2235/2011-1, KA).

Delay by the owner in providing instructions is not an exceptional event (15/04/2011, R 1439/2010-4, SUBSTRAL NUTRI+MAX / NUTRIMIX).

Financial problems at the proprietor's business, its closure and the loss of jobs cannot be accepted as reasons preventing the proprietor from being able to observe the time limit to renew its European Union trade mark (31/03/2011, R 1397/2010-1, CAPTAIN).

Legal errors by a professional representative do not warrant restitutio in integrum (16/11/2010, R 1498/2010-4, REGINE'S / REGINA DETECHA, CH.V.D (fig.)). The deletion of a deadline by an assistant is not unforeseeable (28/06/2010, R 268/2010-2, ORION).

2.2 Loss of rights or means of redress caused directly by failure to meet the time limit

Article 104(1) EUTMR

Failure to meet the time limit must have had the direct consequence of causing the loss of rights or means of redress (15/09/2011, T-271/09, Romuald Prinz Sobieski zu Schwarzenberg, EU:T:2011:478, § 53).

Articles 47(2), 95(2) and 96(1) EUTMR Article 7, Article 8(1) to (4), (7) and (8), Article 14 and Article 17(1) and (2) EUTMDR

This is not the case where the Regulations offer procedural options that parties to proceedings are free to use, such as requesting an oral hearing, requesting that the opponent prove genuine use of its earlier mark, or applying for an extension of the cooling-off period, pursuant to Article 7 EUTMDR. The cooling-off period itself is not subject to restitutio in integrum either because it is not a time limit within which a party must perform an action.

Article 38(1), Articles 41 and 42, and Article 155(1) EUTMR

However, restitutio in integrum does apply to the late response to an examiner's notification of provisional refusal if the application is not rectified by the time limit specified because in this case there is a direct relationship between failure to meet the time limit and possible refusal.

Restitutio in integrum is also available for the late submission of facts and arguments and late filing of observations on the other party's statements in inter partes proceedings if and when the Office refuses to take them into account as being filed too late. The loss of rights in this case involves the exclusion of these submissions and observations from the facts and arguments on which the Office bases its decision. (In principle, the Office will disregard any statements filed in inter partes proceedings after the deadline has passed.)

3 Procedural Aspects

Article 104(2) EUTMR
Article 65(1)(i) EUTMDR
Article 67(2) CDR
Article 68(1)(g) CDIR

3.1 Proceedings to which restitutio in integrum applies

Restitutio in integrum is available in all proceedings before the Office.

This includes proceedings under the EUTMR and proceedings concerning registered Community designs under the CDR. The respective provisions do not differ materially.

Restitutio in integrum is available in ex parte proceedings, inter partes proceedings and appeal proceedings.

For restitutio in integrum in relation to the missed time limit for lodging an appeal and in relation to revision, see the Guidelines, Part A, General Rules, Section 7, Revision.

3.2 Parties

Article 104 EUTMR
Article 67 CDR

Restitutio in integrum is available to any party to proceedings before the Office.

The time limit must have been missed by the party concerned or its representative.

3.3 Time limit for national offices to forward an application to the Office

Articles 35(1) and 38(2) CDR

The time limit of 2 months for transmission of a Community design application filed at a national office has to be observed by the national office and not by the applicant and is consequently not open to restitutio in integrum.

Under Article 38(2) CDR, late transmission of a Community design application has the effect of postponing the date of filing to the date the Office actually receives the relevant documents.

3.4 Time limits excluded from restitutio in integrum

Article 104(5) EUTMR

Article 67(5) CDR

In the interests of legal certainty, restitutio in integrum is not applicable to the following time limits.

Articles 41(1) and 67(5) CDR

Article 8(1) CDIR

- The priority period, which is the 6-month time limit for filing an application claiming the priority of a previous design or utility model application pursuant to Article 41(1) CDR. However, restitutio in integrum does apply to the 3-month time limit for providing the file number of the previous application and filing a copy of it, as specified in Article 8(1) CDIR.

Articles 46(1) and (3) and 104(5) EUTMR

- The time limit for filing an opposition pursuant to Article 46(1) EUTMR, including the time limit for paying the opposition fee referred to in Article 46(3) EUTMR.

Article 104(2) and (5) EUTMR

Article 67(2) and (5) CDR

- The time limits for restitutio in integrum itself, namely:
  - a time limit of 2 months for filing the application for restitutio in integrum as from the removal of the cause of non-compliance;
  - a time limit of 2 months from the date for completing the act that was omitted;
  - a time limit of 1 year for filing the application for restitutio in integrum as from expiry of the missed time limit.

Article 105 EUTMR

- The time limit for requesting continuation of proceedings pursuant to Article 105 EUTMR, including the time limit for paying the fee referred to in Article 105(1) EUTMR.

Article 72(5) EUTMR

- The 2-month time limit to file an appeal against the decision of the Boards of Appeal before the General Court (08/06/2016, T-583/15, DEVICE OF THE PEACE SYMBOL, EU:T:2016:338).

3.5 Effect of restitutio in integrum

Granting restitutio in integrum has the retroactive legal effect that the time limit that was not met will be considered to have been met, and that any loss of rights in the interim will be deemed never to have occurred. If the Office has taken a decision in the interim based on failure to meet the time limit, that decision will become void, with the consequence that, once restitutio in integrum is granted, there is no longer any need to lodge an appeal against such a decision of the Office in order to have it removed. Effectively, restitutio in integrum will re-establish all the rights of the party concerned.

3.6 Time limits

Articles 53(3) and 104(2) EUTMR Articles 13(3) and 67(2) CDR

Applicants must apply to the Office in writing for restitutio in integrum.

The applicant must make the application within 2 months of the removal of the cause of non-compliance and no later than 1 year after expiry of the missed time limit. Within the same period, the act that was omitted must be completed. The date when the cause of non-compliance is removed is the first date on which the party knew or should have known about the facts that led to the non-observance. If the ground for non-compliance was the absence or illness of the professional representative dealing with the case, the date on which the cause of non-compliance is removed is the date on which the representative returns to work. If the applicant fails to submit a request for renewal or to pay the renewal fee, the 1-year time limit starts on the day on which the protection ends, and not on the date the further 6-month time limit expires.

If the application for restitutio in integrum is filed late, it will be rejected as inadmissible.

3.7 Fees

Article 104(3) and Annex I (22) EUTMR Article 67(3) CDR Annex, point 15 CDFR

The applicant must also pay the fee for restitutio in integrum within the same time limit (see paragraph 3.6 above). If the applicant does not pay the fee by expiry of the time limit, the application for restitutio in integrum will be deemed not to have been filed.

In the event the application is deemed not to have been filed due to late or insufficient payment of the fee or because it was filed in relation to a time limit that is excluded

from restitutio in integrum (see paragraph 3.4 above), any fee paid (including late or insufficient fees) will be refunded.

However, once the application for restitutio in integrum has been deemed to have been filed, the fee will not be refunded if the request for restitutio in integrum is later withdrawn, rejected as inadmissible or rejected on the grounds of the substance of the claim (i.e. if the 'all due care' requirement is not fulfilled, see paragraph 2.1. above).

3.8 Languages

Article 146 EUTMR Article 98 CDR Article 80 CDIR

The applicant must submit the application for restitutio in integrum in the language, or in one of the languages, of the proceedings in which the failure to meet the time limit occurred. For example, in the registration procedure, this is the correspondence language indicated in the application; in the opposition procedure, it is the language of the opposition procedure; and in the renewal procedure, it is any of the Office's five languages.

If the wrong language is used, or if a translation into the correct language is not submitted on time, the application for restitutio in integrum will be rejected as inadmissible.

3.9 Particulars and evidence

Articles 97 and 104 EUTMR Articles 65 and 67 CDR

In its application for restitutio in integrum the applicant must state the grounds on which the application is based and set out the facts on which it relies. As granting restitutio in integrum is essentially based on facts, it is advisable for the requesting party to submit evidence by means of sworn or affirmed statements. Statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence (16/06/2015, T-586/13, Gauff THE ENGINEERS WITH THE BROADER VIEW (fig.) / Gauff et al., EU:T:2015:385, § 29).

Moreover, the act that was omitted must be completed, together with the application for restitutio in integrum, at the latest by the time limit for submitting that application. A request for extension of the time limit will not be accepted as the 'omitted act'.

If the grounds on which the application is based, and the facts on which it relies are not submitted, the application for restitutio in integrum will be rejected as inadmissible. The same applies if the omitted act is not completed.

3.10 Competence

Article 104 EUTMR Article 67 CDR

The division or department competent to decide on the act that was omitted (i.e. responsible for the procedure in which failure to meet the deadline occurred) is responsible for dealing with applications for restitutio in integrum.

3.11 Publications

Articles 53(5), (7) and (8), and 104(7), Articles 111(3)(k) and (l) and 116(1)(a) EUTMR Article 67 CDR Article 22(4) and (5), Article 69(3)(m) and (n) and Article 70(2) CDIR

The EUTMR and CDR provide for a mention of the re-establishment of rights to be published in the Bulletin. This mention will be published only if the failure to meet the time limit that gave rise to the application for restitutio in integrum has actually led to publication of a change of status of the EUTM or RCD application or registration, because only in such a case would third parties be able to take advantage of the absence of such rights. For example, the Office will publish a mention that restitutio in integrum has been granted if it published a mention that registration had expired due to failure to meet the time limit for paying the renewal fee.

In the event of such a publication, a corresponding entry will also be made in the Register.

No mention of receipt of an application for restitutio in integrum will be published.

3.12 Decision, role of other parties in restitutio in integrum proceedings

Articles 66 and 67 EUTMR

The applicant for restitutio in integrum is the sole party to the restitutio in integrum proceedings, even where failure to meet the time limit occurred in inter partes proceedings.

The decision on restitutio in integrum will be taken, if possible, in the decision terminating the proceedings. If, for specific reasons, the Office makes an interim decision on the application for restitutio in integrum, it will generally not allow a separate appeal. The applicant for restitutio in integrum can appeal the refusal of its request for restitutio in integrum together with an appeal against the decision terminating the proceedings.

The decision to grant restitutio in integrum cannot be appealed.

The other party to inter partes proceedings will be informed both that restitutio in integrum has been requested and about the outcome of the proceedings. If restitutio in integrum is actually granted, the other party's only means of redress is to initiate third-party proceedings (see paragraph 4 below).

4 Third-Party Proceedings

Article 104(6) and (7) EUTMR Article 67 CDR

A third party who, in the period between the loss of rights and publication of the mention of the re-establishment of rights,

- has, in good faith, put goods on the market or supplied services under a sign that is identical or similar to the EUTM, or
- in the case of a Community design, has, in good faith, put on the market products in which a design included within the scope of protection of the RCD is incorporated or to which it is applied,

may bring third-party proceedings against the decision re-establishing the rights of the applicant, proprietor or holder of the EUTM or RCD.

This request is subject to a 2-month time limit, which starts:

- on the date of publication, where publication has taken place;
- on the date on which the decision to grant restitutio in integrum took effect, where publication has not taken place.

The Regulations do not contain any provisions governing this procedure. The department or unit that took the decision to re-establish the rights is responsible for third-party proceedings. The Office will conduct adversarial inter partes proceedings, which means that it will hear both parties before taking a decision.

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 9

Enlargement

Table of Contents

1 Introduction

This section discusses the rules relating to the accession of new Member States to the European Union and the consequences for holders of European Union trade marks. Both absolute and relative grounds are dealt with in this section.

Article 209 EUTMR contains the relevant provisions relating to enlargement and European Union trade marks. These provisions were introduced into the Regulation pursuant to the 2004 enlargement process (at that time Article 147a CTMR) and have remained unchanged during successive enlargement processes. The only modification in the text of the Regulation is the addition of the names of the new Member States.

A table in Annex 1 lists the new Member States with their accession dates and official languages.

2 Rules Concerning Examination

2.1 Automatic extension of EUTMs to new Member States

Article 209(1) EUTMR lays down the basic rule of enlargement, which is that all existing EUTM applications and registered EUTMs are automatically extended to the new Member States without any kind of additional intervention by the European Union Intellectual Property Office, any other body or the holders of the rights concerned. There is no need to pay any extra fees or complete any other administrative formality. The extension of existing EUTM applications or EUTMs to the territories of new Member States ensures that these rights have equal effect throughout the EU and complies with the fundamental principle of the unitary character of the EUTM.

2.2 Pending EUTM applications

Article 209(2) EUTMR enshrines an important transitional provision, according to which EUTM applications pending on the accession date may not be refused on the basis of any absolute ground for refusal if this ground becomes applicable merely because of the accession of a new Member State (‘grandfathering clause’). In practice, this means that if an EUTM application is non-distinctive, descriptive, generic, deceptive or contrary to public policy or morality in the language or in the territory of a new Member State, it will not be refused if its filing date is before this State’s accession date.

For applications filed after the accession date the grounds for refusal of Article 7(1) EUTMR apply also for the new Member State. This is the case even when the EUTM application has a priority date that is earlier than the relevant accession date. The priority right does not protect the EUTM applicant against any change in the law relevant to its application. Therefore, examiners have to apply the same examination

criteria as for all the other official languages of the EU. This means that the examiner also has to check whether the EUTM application is descriptive, etc. in the new Member State.

However, this principle should be applied with caution as it merely means that the criteria for applying Article 7(1) EUTMR should not be made stricter as a result of the accession of new Member States. The inverse conclusion that terms that are descriptive in a language or in the territory of a new Member State may, in any event, be registered for EUTM applications filed prior to the accession date will not always be correct. For example, descriptive terms from new Member States' languages may have entered the customary languages of existing Member States or be widely known in them (e.g. vodka), and geographical indications may already have to be refused as descriptive terms (e.g. Balaton or Tokaj). Consideration must also be given to geographical indications already protected in the new Member States and to protection arising from EU legislation or bilateral treaties between the new Member States and the EU or existing Member States.

More precisely, the grounds for refusal of Article 7(1)(f) and (g) EUTMR, relating to marks contrary to public policy or morality and deceptive marks respectively, are only affected by this provision insofar as the deceptiveness or breach of public morality is due to a meaning that is only understood in a language of a new Member State. The Office interprets Article 7(1)(f) EUTMR in accordance with EU-wide criteria, irrespective of the relative levels of morality in different countries of the EU.

Finally, the provision of Article 209(2) EUTMR does not affect the grounds for refusal of Article 7(1)(e) or (i) EUTMR: the former relates to signs consisting exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, the shape, or another characteristic, which is necessary to obtain a technical result or the shape, or another characteristic, which gives substantial value to the goods, and the latter relates to badges and emblems not protected by Article 6ter of the Paris Convention but of particular public interest.

2.3 Distinctiveness acquired through use

According to Office practice, distinctiveness acquired through use (Article 7(3) EUTMR) must exist on the EUTM filing date and subsist until its registration date. Where an applicant for an EUTM application filed before the accession date is able to demonstrate that acquired distinctiveness existed at the filing date, Article 209(2) EUTMR precludes an objection based on the ground that it is not distinctive through use in the new Member States. Therefore, the applicant does not have to prove acquired distinctiveness in the new Member States.

2.4 Bad faith

The Office will consider the filing of an EUTM application as having been made in bad faith if it was made prior to the accession date for a term that is descriptive or otherwise

not eligible for registration in the language of a new Member State for the sole purpose of obtaining exclusive rights to a non-registrable term or for otherwise objectionable purposes.

This has no practical effect during the examination stage, as bad faith does not constitute an absolute ground for refusal and, consequently, the Office has no authority to object ex officio. The Office will exercise its duties in respect of 'bad faith filings' only when a request for a declaration of invalidity is filed (Article 59(1)(b) EUTMR). The national offices of the new Member States are equally determined to act against bad faith in the context of enlargement. EUTM applicants should, therefore, bear in mind that, even if there are no grounds for refusal during the registration procedure, their EUTM registrations may be contested at a later date on the basis of Article 59(1)(b) EUTMR.

2.5 Conversion

Conversion of an EUTM application into national trade mark applications for new Member States may be requested as from the accession date of those States. Conversion is also possible when a converted EUTM has a filing date prior to the accession date. However, in the case of a new Member State, the converted application will have the effect of an earlier right under national law. National law in new Member States has enacted provisions equivalent to Article 209 EUTMR providing that extended EUTMs have the effect of earlier rights in the new Member States only with effect from the accession date. In practice, this means that the 'conversion date' in a new Member State cannot be earlier than that State's accession date.

Taking Croatia's accession as an example, this means that even if a converted EUTM has a filing date of 01/05/2005, in Croatia the conversion date will not be 01/05/2005 but 01/07/2013, that is to say, Croatia's accession date.

The date of enlargement does not trigger a new 3-month time limit for requesting conversion under Article 139(4) EUTMR.

2.6 Other practical consequences

2.6.1 Professional representation

As from the accession date of a new Member State, applicants (as well as other parties to proceedings before the Office) with their seat or domicile in that State need no longer be represented by a professional representative. As from the accession date of a new Member State, professional representatives from that State may be entered on the list of professional representatives maintained by the Office pursuant to Article 120 EUTMR and may then represent third parties before the Office.

2.6.2 First and second language

As of the accession date of a new Member State (see Annex 1), the official language(s) of that State may be used as the first language for EUTM applications filed on or after that date.

2.6.3 Translation

EUTM applications with a filing date prior to the accession date of a new Member State and existing EUTM registrations will neither be translated into nor republished in the language of that State. EUTM applications filed after the accession date of a new Member State will be translated into and published in all official languages of the EU.

2.6.4 Seniority

Seniority may be claimed from a national trade mark that was registered before the accession of the new Member State in question or even before the creation of the European Union. The seniority claim may, however, only be made after the accession date. The mark registered in the new Member State must be 'earlier' than the EUTM. As an extended EUTM has, in the new Member State, the effect of an earlier right as from the accession date, the seniority claim only makes sense when the earlier national mark has a filing or priority date prior to the accession date.

Example 1 The same person files an EUTM application on 01/04/1996 and a national trade mark application in Romania on 01/01/1999. After 01/01/2007 (Romania's date of accession), the seniority of the Romanian national trade mark application may be claimed.

Example 2 The same person owns an international registration designating the EU on 01/01/2005 and subsequently designating Romania on 01/01/2006. After 01/01/2007, the seniority of that Romanian designation may be claimed even though the designation itself is later than the IR designating the EU. This is because the extended EUTM takes effect from the accession date of the new Member State (in this case 01/01/2007).

2.6.5 Search

The national offices of a new Member State may carry out searches (Article 43(2) and (3) EUTMR) as from that State's accession date. Only EUTM applications with a filing date on or after the accession date are sent to national offices for a search.

3 Rules Concerning Oppositions and Cancellations

1. According to Article 209(4)(b) EUTMR, an EUTM application cannot be opposed or declared invalid on the basis of a national earlier right acquired in a new Member State prior to that State's accession date.

However, EUTM applications filed on or after the accession date are not subject to this 'grandfathering clause' and may be rejected upon opposition, or declared invalid, on account of an earlier national right existing in a new Member State, provided that the earlier right is 'earlier' when the two filing or priority dates are compared.

2. An exception to this (transitional) rule is contained in Article 209(3) EUTMR regarding oppositions. An EUTM application filed within the 6 months preceding the accession date may be challenged by an opposition based on a national right existing in a new Member State at the date of the accession, provided that this right
   - has an earlier filing or priority date, and
   - was acquired in good faith.
3. The filing date and not the priority date is the decisive element for determining when an EUTM application can be opposed on the basis of an earlier right in a new Member State. In practice, the abovementioned provisions have the consequences illustrated in the following examples with reference to the accession of Croatia (01/07/2013).
   a. An EUTM application filed before 01/01/2013 (the priority date is irrelevant in this context) cannot be opposed or declared invalid on the basis of a national earlier right in a new Member State under any circumstances.
   b. An EUTM application with a filing date between 01/01/2013 and 30/06/2013 (i.e. during the 6 months prior to the date of accession), may be opposed by a Croatian trade mark, provided that the filing or priority date of the Croatian trade mark is earlier than the filing or priority date of the opposed EUTM application and the national mark was applied for in good faith.
   c. An EUTM application with a filing date of 01/07/2013 or later may be opposed or declared invalid on the basis of a trade mark registered in Croatia if that mark has an earlier filing or priority date under the normal rules. Acquisition in good faith is not a condition. This applies to all national marks and earlier non-registered rights filed or acquired in a new Member State prior to accession.
   d. An EUTM application with a filing date of 01/07/2013 or later but with a priority date before 01/07/2013 may be opposed or declared invalid on the basis of a national trade mark registered in Croatia if that mark has an earlier filing or priority date under the normal rules.

      This transitional exception is limited to the right to file an opposition and does not include the right to file an application for cancellation based on relative grounds. This means that once the abovementioned period of 6 months has expired without an opposition having been lodged, the EUTM application cannot be challenged any more by an opposition or by an application for a declaration of invalidity.
4. According to Article 209(5) EUTMR, the use of an EUTM with a filing date prior to the date of accession of a new Member State, may be prohibited pursuant to Articles 137 and 138 EUTMR on the basis of an earlier national trade mark registered in the new Member State where the latter has a filing or priority date prior to the date of accession and was registered in good faith.

   The above provision also applies to:

- applications for national marks filed in new Member States, provided that they have subsequently been registered;
- unregistered rights acquired in new Member States falling under Article 8(4) or Article 60(2) EUTMR with the proviso that the date of acquisition of the right under national law replaces the filing or priority date.

5. Where an opposition is based on a national registered mark or other right in a new Member State, whether or not that right may validly be invoked as a ground for opposition against an EUTM application depends on whether the opposition is well founded and is not an issue of admissibility.
6. The acquisition in good faith of the earlier national mark is presumed. This means that, if good faith is questioned, the other party to the proceedings (the applicant for the opposed EUTM application in the case of Article 209(4) EUTMR or the owner of the registered EUTM in the case of Article 209(5) EUTMR) must prove that the owner of the earlier national right obtained in a new Member State acted in bad faith when filing the national application or otherwise acquiring the right.
7. Article 209 EUTMR does not contain any transitional provisions concerning the use requirement (Articles 18 and 47 EUTMR). In opposition proceedings, the obligation to make genuine use of the mark arises when the applicant for the opposed EUTM application requests that the opponent prove use of the earlier mark pursuant to Article 47(2) and (3) EUTMR and Article 10 EUTMDR. Issues relating to enlargement could arise regarding the time and place of use of the earlier mark.
   Two cases can be distinguished.

   a. The earlier mark is a national mark registered in a new Member State
      In this case, the opponent must prove genuine use of the earlier mark. This situation can only arise in the context of an opposition directed either against an EUTM application with a filing date after the date of accession or against an EUTM application filed within the period of 6 months preceding the date of accession.

      The earlier national mark must have been put to genuine use in the territory in which it is protected during the 5 years preceding the date of publication of the opposed EUTM application. In this regard, it is immaterial whether the use relates to a period during which the State concerned was already a Member State of the European Union. In other words, the proof of use may also relate to a period prior to the date of accession (in the case of Croatia before 01/07/2013).
8. The earlier mark is an EUTM
   Where the owner of the earlier EUTM can prove use only in the territory of a new Member State or several new Member States, since the obligation of use relates to the period of 5 years preceding the date of publication of the opposed EUTM application, use in a new Member State (or several new Member States) can only be taken into account if the State concerned was a Member State of the European Union at the date of publication of the opposed EUTM application (Article 47(2) EUTMR requires use 'in the Union'). Before their accession dates, the new States do not constitute 'Member States of the Union'; therefore, it is not possible to prove use 'in the Union'.

Therefore, the 5-year period should be counted only from the relevant date of accession.

1. There are no particular transitional problems relating to the opposition proceedings. The right pursuant to Article 146(8) EUTMR to choose a language that is not one of the five languages of the Office as the language of the proceedings applies as from the date of accession in respect of the other official languages of the European Union.

Annex 1

Member States	Accession date	Languages
Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Slovenia and Slovakia.	01/05/2004	Czech, Estonian, Greek, Latvian, Lithuanian, Hungarian, Maltese, Polish, Slovak and Slovenian
Bulgaria and Romania	01/01/2007	Bulgarian and Romanian
Croatia	01/07/2013	Croatian