GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

- *1 Introduction*
- *Examination of applications for registered Community designs*
- *Examination of design invalidity applications*
- *Parts shared with current trade mark practice*
- *Editor's note and general introduction*
- *Part A General rules*
- *Part B Examination*
- *Part E Register operations*

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

1 Introduction

Obsolete

The Office's current trade mark and design practice is reflected in a series of Guidelines that are intended to be of practical use both to Office staff in charge of the various procedures and to users of the Office's services.

The Office issues a revision of the Guidelines on a yearly basis. See the Guidelines, Editor's Note and General Introduction, paragraph 3 , for further information about the revision process of the Office's Guidelines.

The Office's Guidelines are the main point of reference for users of the European Union trade mark system and the Community design system, and for professional advisers who want to ensure they have the latest information on our examination practices.

They have been drawn up to reflect our Office practice in the most frequent scenarios. They contain general instructions, which have to be adapted to the particularities of a case.

Therefore, the Office's Guidelines are not legal acts, but self-imposed rules of conduct adopted by an administrative decision.

The Guidelines on EU trade marks and the Guidelines on registered Community designs that are currently in force were adopted by the Executive Director on 22/03/2022 (Decision No EX-22-1), and entered into force on 31/03/2022.

The Office's Guidelines can be accessed in the five working languages of the Office (English, French, German, Italian and Spanish), through either a clean or a track-changed version. In the online version of the Guidelines, the track-changed version is visible via the 'show modification' function, which highlights the changes made compared to the previously adopted edition of the Guidelines.

Track-changed versions of new editions of the Office's Guidelines will also be translated and made available online in the other eighteen EU languages after they became available in the five working languages of the Office.

For previous editions of the Guidelines, please visit the Repository .

Obsolete

GUIDELINES FOR EXAMINATION OF REGISTERED COMMUNITY DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Examination of applications for registered Community designs

Obsolete

Obsolete

1 Introduction

1.1 Purpose of the Guidelines

The Guidelines explain how, in practice, the provisions of the Community Design Regulation ([1]) (CDR), the Community Design Implementing Regulation ([2]) (CDIR), and the Fees Regulation ([3]) (CDFR) are applied by the Office's Operations Department from receipt of an application for a registered Community design (RCD) up to its registration and publication.

The Office has no competence with regard to **unregistered** Community designs.

The purpose of the Guidelines is to ensure consistency among the decisions taken by the Operations Department and to ensure a coherent practice in file handling. These Guidelines are merely a set of consolidated rules setting out the line of conduct that the Office itself proposes to adopt, which means that, to the extent that those rules comply with the legal provisions of a higher authority, they constitute a self-imposed restriction on the Office, in that it must comply with the rules that it has itself laid down. However, these Guidelines cannot derogate from the CDR, the CDIR or the CDFR, and it is solely in the light of those regulations that the applicant's capacity to file an application to register a Community design must be assessed.

The Guidelines are structured to follow the sequence of the examination process, with each section and subsection constituting a step in the registration proceedings from receipt of the application up to registration and publication. The general principles (see paragraph 1.2 below) should be kept in mind throughout the whole examination process (see the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings).

1.2 General principles

Obsolete

1 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs amended by Council Regulation No 1891/2006 of 18 December 2006 amending Regulations (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs.

2 Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community Designs amended by Commission Regulation (EC) No 876/2007 on 24 July 2007 amending Regulation (EC) No 2245/2002 implementing Council Regulation (EC) No 6/2002 on Community designs following the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs.

3 Commission Regulation (EC) No 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs amended by Commission Regulation (EC) No 877/2007 of 24 July 2007 amending Regulation (EC) No 2246/2002 concerning the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) following the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs.

1.2.1 Duty to state reasons

The decisions of the Office must state the reasons on which they are based (Article 62 CDR). The reasoning must be logical and it must not lead to internal inconsistencies.

The Office will apply the principles as explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 1, Adequate reasoning.

1.2.2 Right to be heard

The decisions of the Office will be based only on reasons or evidence on which the applicant has had an opportunity to present its comments (Article 62 CDR, second sentence).

The Office will apply the principles as explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 2, The right to be heard.

1.2.3 Compliance with time limits

Applicants must respond to the Office's communications within the time limits set by those communications.

The Office will apply the principles explained in the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

Any written submission or document that has not been received within the time limits set by the Office is late. The same applies to supplementary materials attached only to the confirmation copy of a letter that was itself sent on time, where this confirmation mail arrives after the expiry of the time limit. This is irrespective of whether such materials are specifically mentioned in the initial letter.

The Office may disregard facts or evidence that the applicant does not submit in due time (Article 63(2) CDR).

For calculation of time limits see Article 56 CDIR.

An applicant's request to extend a time limit has to be made before expiry of that time limit (Article 57(1) CDIR).

As a general rule, a first request to extend a time limit will be granted. Further extensions will not be granted automatically. Reasons in support of any further request for extension must be submitted to the Office. The request for extension of the time limit must indicate the reasons why the **applicant** cannot meet the deadline. Obstacles faced by the parties' **representatives** do not justify an extension (05/03/2009, C-90/08 P, Corpo livre, EU:C:2009:135, § 20-23).

Obsolete

The extension cannot result in a time limit longer than 6 months (Article 57(1) CDIR). The applicant is informed about any decision as to the extension.

Applicants failing to observe the time limits run the risk that their observations may be disregarded, which may result in a loss of rights. In such a case, the applicant may file a request for *restitutio in integrum* (Article 67 CDR; see also the Guidelines, Part A, General Rules, Section 8, *Restitutio in Integrum*). However, applicants are reminded that, unlike in the case of European Union trade marks, the CDR does not provide for the possibility of requesting a continuation of proceedings.

1.2.4 Scope of the examination carried out by the Office

When examining an application for a Community design, the Office will examine the facts of its own motion (Article 63(1) CDR).

The examination procedure is kept to a minimum, that is, mainly an examination of the formalities. However, the following grounds for non-registrability set out in Article 47 CDR must be examined *ex officio* by the Office:

1. whether the subject matter of the application corresponds to the definition of a design as set forth in Article 3(a) CDR; and
2. whether the design is contrary to public policy or accepted principles of morality.

Where one of these two grounds is applicable, the procedure explained below in paragraph 4 will apply.

Other protection requirements are not examined by the Office. A Community design that has been registered in breach of the protection requirements referred to in Article 25(1)(a) to (g) CDR is liable to be invalidated if an interested party files a request for a declaration of invalidity (see the Guidelines for Examination of Design Invalidity Applications).

1.2.5 User-friendliness

One of the fundamental objectives of the CDR is that the registration of Community designs should present the minimum cost and difficulty to applicants, so as to make it readily available to any applicant, including small and medium-sized enterprises and individual designers.

To that end, examiners are encouraged to contact the applicant or, if a representative has been appointed (see paragraph 2.5 below), its representative, by telephone, to clarify issues arising from the examination of an application for a Community design, either before or after an official deficiency letter is sent.

Obsolete

2 Filing an Application with the Office

2.1 Introduction

There are two ways of applying for registration of a Community design, that is, (i) either via a direct filing, with the Office or with the central industrial property office of a Member State or, in Benelux countries, with the Benelux Office for Intellectual Property (BOIP) (Article 35 et seq. CDR) or (ii) via an international registration filed with the International Bureau of the World Intellectual Property Organization and designating the European Union (Article 106a et seq. CDR).

This section will deal with direct filings. The examination of the formalities relating to international registrations designating the European Union will be explained in paragraph 12 below.

2.2 Form of the application

2.2.1 Different means of filing

An application for a registered Community design may be filed directly with the Office by e-filing, post or personal delivery. It may also be filed at the central industrial property office of a Member State or, in Benelux countries, at the BOIP (Article 35 CDR).

E-filing is the strongly recommended means of filing since it can guarantee accurate quality of the design representation, and the system gives guidance to the applicant, thus reducing the number of potential deficiencies and speeding up the examination procedure.

For filings other than e-filing, use of the form provided by the Office (Article 68(1)(a) CDIR) is not mandatory but is recommended (Article 68(6) CDIR) in order to facilitate the processing of the application and avoid errors.

Fax is expressly identified as a means of communication in all procedures relating to Community designs in Article 47(2)(d) CDIR and Article 51 CDIR, however pursuant to Article 2 of Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means, due to technical limitations and malfunctions affecting the reliability and uninterrupted functioning of communications by fax that lie beyond the Office's control, **fax can no longer be offered and will no longer be used**, as a means of communication in procedures before the Office.

To facilitate resubmission in the event of a malfunction during the electronic transmission of an application, communication or other document through the specific

Obsolete

e-operation or e-filing in the User Area, the Office will make two electronic back-up alternatives available:

1. an upload solution located in the Communications section of the User Area; this is a general upload platform that allows documents to be attached and sent to the Office;
2. a file-sharing solution outside the User Area; the Office will provide the account holder with access to a secure file-sharing location where the document(s) in question can be uploaded.

Technical details on the accessibility and functionality of both back-up alternatives are available in the Conditions of Use of the User Area.

2.2.2 E-filing

A registered Community design can be filed via the Office's website (https://euipo.europa.eu/ohimportal/en/rcd-apply-now), which also allows for the accelerated procedure (Fast Track) (see paragraph 2.7.1 below).

Where a communication is sent to the Office by electronic means, the indication of the sender's name will be deemed to be equivalent to the signature (see paragraph 6.1.3 below).

2.2.3 Applications sent by post or personal delivery

Applications can be sent by ordinary post or private delivery service to the Office at the following address:

European Union Intellectual Property Office

Avenida de Europa, 4

03008 Alicante

SPAIN

Applications can also be handed in personally at the Office's reception. See Decision No EX-18-5 of the Executive Director of the Office of 3 September 2018 concerning the hours the Office is open to receive submissions by personal delivery relating to registered Community designs, for further information.

2.3 Content of the application

2.3.1 Minimum requirements

The application must satisfy all the mandatory requirements set out in Articles 1 (Content of the application), 3 (Classification and indication of products), 4 (Representation of the design) and 6 (Fees for the application) CDIR.

Obsolete

The application must be signed by the applicant. The name of the signatory must be indicated and the authority of the signatory must be specified (see paragraph 6.1.3 below).

2.3.2 Additional requirements

Additional requirements apply where the applicant selects one of the following options: a multiple application is filed (Article 2 CDIR), specimens are filed (Article 5 CDIR), a priority or an exhibition priority is claimed (Articles 8 and 9 CDIR), or where the applicant chooses to be, or must be, represented (Article 77 CDR).

2.3.3 WIPO DAS

As of 11/07/2020, the Office is a participating office in the World Intellectual Property Organization Digital Access Service (WIPO DAS), which is an electronic system allowing priority documents and similar documents to be securely exchanged between participating IP offices.

The system enables applicants and offices to meet the requirements of the Paris Convention for the certification of priority documents, allowing them to be exchanged in an electronic environment.

Using the EUIPO as **Office of First Filing**, when filing their application electronically (see paragraph 2.2.2 above) applicants may request that their application be registered in the WIPO DAS system. The Office will register the application in WIPO DAS by providing the mandatory data elements in the registration request, including:

- IP type,
- priority office code,
- priority application number,
- priority application filing date,
- access code.

By checking the box to request the inclusion of the application in WIPO DAS, the applicant will automatically receive the access code, which they can then cite when claiming priority from the application in subsequent filings before other offices party to the WIPO DAS system.

2.4 Language of the application

The application may be filed in any of the official languages of the European Union (language of filing, or first language) (Article 98(1) CDR; Article 1(1)(h) CDIR).

In addition to the language of filing, the applicant must indicate a second language, which must be a language of the Office, that is to say, English (EN), French (FR), German (DE), Italian (IT) or Spanish (ES). The second language must be different from

Obsolete

the language of filing. The second language serves as a potential language for invalidity proceedings. The choice of first and second language cannot be changed once filed.

If the language that the applicant has selected as the first language is one of the five languages of the Office, then this will be used as the correspondence language.

Only where the language selected as the first language is not one of the five Office languages can the applicant indicate that they want the correspondence language to be the second language. This request can be made on the application form by ticking the relevant box or can be requested later, either by explicit request, or implicitly by sending a communication to the Office in the second language.

This language regime applies throughout the application procedure until registration.

As the choice of languages also affects the determination of the language in invalidity proceedings after the registration, applicants are advised to note that the language regime for designs is not identical to the language regime for the European Union trade mark (see the Guidelines on Examination of Design Invalidity Applications for more information on the language regime in invalidity proceedings, paragraph 3.3).

2.5 Representatives

Where the applicant does not have its domicile or its principal place of business or a real and effective industrial or commercial establishment within the European Economic Area (EEA), it must be represented by a representative in all proceedings before the Office other than in filing an application.

The representative has to be indicated in the application. If this requirement is not complied with, the applicant will be requested to appoint a representative within a time limit of 2 months. Where the applicant does not comply with the request, the application is rejected as inadmissible (Article 77(2) CDR; Article 10(3)(a) CDIR).

For more information on representation, please refer to the Guidelines, Part A, General Rules, Section 5, Professional Representation.

2.6 Date of receipt, file number and issue of receipt

2.6.1 Applications filed through national offices (intellectual property office of a Member State or Benelux Office for Intellectual Property (BOIP))

If a Community design application is filed at the central industrial property office of a Member State or at the BOIP, it will have the same effect as if it had been filed with the Office on the same day, provided that it is received by the Office within 2 months of the

Obsolete

date it was filed at the national office or, as the case may be, the BOIP (Article 38(1) CDR).

If the Community design application does not reach the Office within this 2-month time limit, it will be deemed to have been filed on the date that it is received by the Office (Article 38(2) CDR).

Where the Community design application is received shortly after the expiry of this 2-month period, the examiner will check *ex officio* whether this time limit is to be extended under one of the conditions provided for in Article 58(4) CDIR. This may have to be assumed due to exceptional occurrences (e.g. natural disasters, strikes, pandemics) interrupting the proper functioning of the Office or, as the case may be, of the respective national offices / the BOIP.

2.6.2 Applications received directly by the Office

The date of receipt is the date on which the application reaches the Office. This date may not coincide with the 'date of filing' where the requirements for such a date to be allocated are not met (see paragraph 3 below).

For Community design applications filed through the Office's User Area (e-filing), the system immediately issues an automatic electronic filing receipt, which contains the date of receipt and the file number. The applicant should keep this receipt.

Where the application is sent by post personal delivery, the applicant will not receive the confirmation of receipt or file number until the Office issues its first communication (see paragraph 2.7 below).

For further information on communications to the Office, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

2.7 Registration or examination report

2.7.1 Registration

If the application for a Community design satisfies all requirements for registration, it will normally be registered within **10 working days**.

The registration of an application complying with all requirements may, however, be delayed where the products in which the design is intended to be incorporated, or to which it is intended to be applied, were not indicated by reference to the list of products included in DesignClass (see paragraph 6.1.4.2), the product indication database on the Office's website. In such a case, the indication of the products may have to be sent for translation into the official languages of the European Union (see paragraph 6.1.4.4 below).

Obsolete

An application complying with all registration requirements can be registered within **two working days** if the following conditions for the accelerated procedure (Fast Track) are met (for possible modifications of these conditions please consult the Office's website):

- the application is filed electronically (e-filing) using the four-step form;
- both the indication of product(s) and its/their classification are made using DesignClass (see paragraph 6.1.4.4 below);
- priority documents, where a priority is claimed, are already available in WIPO DAS and are identified by a WIPO DAS code, or included with the e-filing application (not required when the earlier filing is with the Office);
- no exhibition priority is claimed;
- the representative, if any, is registered in the Office's database and indicates the respective identification number in the form;
- fees are to be debited from a current account with the Office or paid by credit card.

2.7.2 Examination report and informal communication on possible deficiencies (preliminary examination report)

Where a deficiency has been detected in the application, the examiner will issue an examination report summarising the irregularities noted and giving a time limit for the applicant to remedy them.

Before sending such an examination report, the examiner can send an informal communication, called a 'preliminary examination report', highlighting some potential deficiencies and aimed at speeding up the examination procedure. This informal communication informs the applicant that the examination procedure is pending due to any of the following circumstances.

2.7.2.1 Priority claims and supporting documents

As of 12/09/2020, the Office is a participating office in WIPO DAS, which is an electronic system allowing priority documents and similar documents to be securely exchanged between participating IP offices.

The system enables applicants and offices to meet the requirements of the Paris Convention for the certification of priority documents, allowing them to be exchanged in an electronic environment.

Where the application claims the priority of one or more previous applications registered in WIPO DAS, the applicant must provide the relevant details, namely, the file number, filing date and country of the previous application together with the WIPO DAS access code in the pertinent fields in the application form, or within 3 months of either the filing date or the priority claim[4], as the case may be, in order for the Office to access and download those priority documents, as **Office of Second Filing**.

Obsolete

4 This was a fast track change added after the consultation period for the 2022 edition of the guidelines

Where the application claims the priority of one or more previous applications that are not available in WIPO DAS by providing relevant details but without submitting a copy thereof, or claims priority from an exhibition without submitting a certificate thereof, the applicant may still submit a copy within 3 months of the filing date (Articles 42 and 44 CDR; Articles 8(1) and 9(1) CDIR; see paragraph 6.2.1.1 below).

In such circumstances, the examiner will inform the applicant that examination of the application will be put on hold until the missing copy of the previous application(s) or exhibition certificate is submitted. Examination will proceed **3 months** after the filing date, unless a copy of the previous application(s) or exhibition certificate (see paragraph 6.2.1.2 below), or a declaration that the priority claim is withdrawn, is received earlier.

2.7.2.2 Priority claims made subsequent to filing

The priority of one or more previous applications or of an exhibition may still be claimed within 1 month of the filing date, by submitting the declaration of priority, stating the file number, date and country of the previous application (Article 42 CDR; Article 8(2) CDIR; see paragraph 6.2.1.1 below), or the name of the exhibition and the date of first disclosure of the product (Article 44 CDR; Article 9(2) CDIR; see paragraph 6.2.1.2 below), and by providing the WIPO DAS access code where available (Decision No EX-20-7 of the Executive Director of the EUIPO of 11 September 2020 on the formal requirements of priority claims relating to registered Community designs; see paragraph 6.2.1.1 below).

Where the applicant states in the application its intention to claim such priority, the examiner will inform the applicant that the examination of the application will be put on hold until the missing information is submitted. The examination will proceed **1 month** after the filing date, unless a declaration of priority, or a declaration that the priority claim is withdrawn, is received earlier.

Where the applicant does not state its intention to claim priority, the examination of the application will proceed as normal. Any priority claims received within 1 month of the filing date will be examined upon receipt, even if this is after registration. However, the Office will not issue a new registration certificate including a priority claimed after registration; instead, applicants may obtain an extract from the Register with updated data including the priority (see paragraph 10.3 below).

2.7.2.3 Payment of fees

All necessary fees relating to an application must be paid at the time when the application is submitted to the Office (Article 6 CDIR; see paragraph 8 below).

Lack of payment or unidentified payment

Where the application has not yet been linked with a payment of the corresponding fees, the examiner will inform the applicant that the examination will proceed as soon as the payment has been identified and linked to this specific application.

Obsolete

If the applicant does not respond to the Office's communication, and no payment has been made or identified, a deficiency letter will be sent.

Lack of funds

Where the full amount of the fees relating to the application cannot be debited from the current account due to insufficient funds, the examiner will inform the applicant that the examination will begin as soon as the current account has been credited with the missing amount.

If the applicant does not respond to the Office's communication, and the payment remains incomplete, a deficiency letter will be sent.

The above also applies to credit card payments where the transaction fails due to reasons not attributable to the Office. In such cases, the applicant will have to use another method of payment.

For more information on the payment of fees, see paragraph 8 below.

2.7.2.4 Multiple applications and requests for partial deferment

For filings other than e-filings, where a multiple application contains a request for deferment in respect of **some** designs (see paragraph 6.2.5 below), the examiner will send the applicant a summary of the application containing a representation of the first view of each design to be published without delay. The applicant will be requested to confirm the correctness of this summary within 1 month. In the absence of any reply or contrary instruction from the applicant, the examination will proceed on the basis of the information on file.

3 Allocation of a Filing Date

The date on which a document is 'filed' is the date of receipt by the Office rather than the date on which the document was sent (Article 38(1) CDR and Article 7 CDIR).

Where the application has been filed at the central industrial property office of a Member State or at the BOIP, the date of filing at that office will be deemed the date of receipt by the Office, unless the application reaches the Office more than 2 months after such date. In this case, the date of filing will be the date of receipt of the application by the Office (Article 38 CDR).

Pursuant to Article 36(1) CDR, the allocation of a filing date requires that the application contains at least:

1. a request for registration of a Community design;
2. information identifying the applicant; and
3. a representation of the design suitable for reproduction pursuant to Article 4(1)(d) and (e) CDIR or, where applicable, a specimen (Article 10 CDIR).

If the application does not meet any of these requirements, the Office will notify the applicant of the deficiency, and give the applicant 2 months from receipt of the notification to remedy that deficiency.

Obsolete

If deficiencies are remedied within the time limit set by the Office, the date on which all the deficiencies are remedied will determine the date of filing, unless specified differently below (Article 10(2) CDIR).

If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as a Community design application. The file will be closed by a decision of the examiner and the applicant will be notified. The examiner will notify the Finance Department that a refund of any fees paid should be made to the applicant (Article 10(2) CDIR).

Payment of fees is not a requirement for allocating a filing date. It is, however, a requirement for registration of the application (see paragraph 8 below).

3.1 Request for registration

A request for registration is filed where the applicant has used e-filing, or has completed (at least partly) the application form provided by the Office or has used its own form (see paragraph 2.2 above).

3.2 Information identifying the applicant

For the purpose of allocating a filing date, the information identifying the applicant does not have to satisfy all the requirements set out in Article 1(1)(b) CDIR (see paragraph 6.1.1 below). It is enough that the surname and forename(s) of natural persons or the corporate name of legal entities is supplied, along with an address for service or any other data communication link that allows the applicant to be contacted. If the Office has given the applicant an identification number, it is sufficient to mention that number together with the applicant's name.

3.3 Representation of the design suitable for reproduction

3.3.1 General requirements

The representation of the design must consist of a graphic or photographic reproduction of the design, either in black and white **or** in colour (Article 4(1) CDIR).

Irrespective of the form used for filing the application (e-filing or paper), the design must be reproduced on a **neutral background** and **must not be retouched** with ink or correcting fluid.

It must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Community Designs Register and for publication in the *Community Designs Bulletin* (Article 4(1)(e) CDIR).

Obsolete

The Court of Justice has held that before the application for registration can obtain a date of filing, it must contain a representation that enables the matter for which protection is sought to be identified. It is not possible to interpret the CDR as allowing an application for registration to be considered validly filed when it does not enable the design for which registration is sought to be clearly identified (05/07/2018, C-217/17 P, Becher, EU:C:2018:534, § 59).

In addition, for applications filed electronically, it must meet the technical requirements of Article 9 of Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means.

Drawings, photographs (except slides), computer-made representations or any other graphical representation are accepted, provided they are suitable for reproduction, including on a registration certificate in paper format. On the basis of the current legislation set out in Article 36(5) CDR and Article 4 CDIR, 3D computer-animated design generating motion simulation can only be considered as an additional technical means of viewing the design and does not replace conventional static views. CD-ROMs and other data carriers are not accepted.

3.3.2 Neutral background and elements external to the design

The background in a view is considered neutral as long as the design shown in this view is clearly distinguishable from its environment without interference from any other object, accessory or decoration, whose inclusion in the representation could cast doubt on the protection sought (16/04/2012, R 2230/2011-3, Webcams, § 11-12).

In other words, the requirement of a neutral background demands neither a 'neutral' colour nor an 'empty' background. Instead, what is decisive is that the design stands out sufficiently clearly from the background to remain identifiable (13/09/2017, R 1211/2016-3, Tavoli, § 61).

The Office and a number of European Union intellectual property offices have agreed on a Common Practice under the European Trade Mark and Designs Network (CP6).

3.3.2.1 Background colours, contrast and shadows

In accordance with that Common Practice (CP6), the following aspects should be taken into consideration when assessing if a background is neutral: colour, contrast and shadow. The examples given below in relation to these aspects are taken from the Common Practice (CP6), which also lists additional examples.

A single or predominant colour in a background is always acceptable if it stands out against the colours of the design.

Examples of an acceptable single or predominant background colour

Obsolete

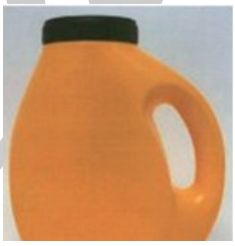
Austrian lapsed design **No 1747/1999**	**RCD No 2 333 484-0001**

Examples of an unacceptable single or predominant background colour

CP6 example	**CP6 example**

Graduating colour or more than one colour in a background is acceptable provided the design is clearly distinguishable.

Examples of an acceptable graduating colour and more than one colour in a background

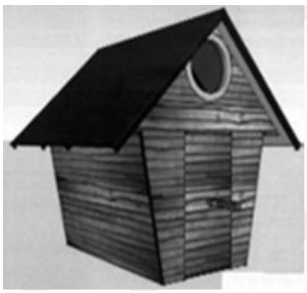
RCD No 1 387 476-0001	**French design** **No 955805-0005**
	

As for contrast, all features of the design should be clearly visible. The contrast is considered insufficient when the background colour and the design are similar and melt partly into each other, with the result that not all parts of the design contrast sufficiently with the background (i.e. it is not clear where the product finishes and the background

Obsolete

starts). Sometimes, a darker background can help when the design is clear or pale and vice versa.

Example of sufficient contrast with background

Benelux design No 38895-00


Examples of insufficient contrast with background

Portuguese lapsed design **No 420-0006**	**CP6 example**	**Portuguese lapsed design** **No 00023465-0001**

Shadows or reflections are acceptable as long as all of the design features remain visible.

Shadows or reflections are unacceptable when the subject of protection of the design, in any of the submitted views, cannot be determined in an unambiguous way. This can occur when there is limited colour contrast with the design or when the shadows do not allow all the features of the design to be appreciated, for example because they interfere with, or hide parts of, the design or distort the contour of the design.

Examples of acceptable shadows or reflections

Danish design **No 2013 00069**	**CP6 example**

Obsolete

Examples of unacceptable shadows or reflections

CP6 example	**CP6 example**

3.3.2.2 Elements external to the design

Views should not include external and foreign matter, except when their inclusion does not cast any doubt on the protection sought and serves only an illustrative purpose.

For example, the inclusion of a hand in the following design serves the purpose of illustrating how the product in which the design is incorporated will be used (even though the way of use does not form part of the design's subject-matter of protection). As a human hand is not eligible for design protection (see paragraph 4.1.7 below) the subject matter of the design is clear.

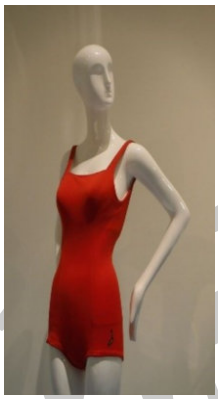
RCD No 1 627 233

Obsolete

Likewise, when the background shows the context in which the design will be used, and the design itself uses visual disclaimers such as colour shading (see paragraph 5.4.3 below) allowing for the features for which protection is sought to be clearly perceptible, the subject matter of the design is clear.

RCD No 2 513 598 'Luggage carriers for cycles'

However, the following examples are not acceptable as they contain elements that are external to the design, such as a dressmaker's mannequin in the first design, and hand tools and other elements in the second, making the subject matter of protection unclear.

RCD No 5 631 504	RCD No 4 154 086
 This photo by unknown author is licensed under CC BY-SA	

Obsolete

3.3.2.3 Examination

Of the seven views allowed for representing a design (Article 4(2) CDIR), those that do not have a neutral background or that contain elements external to the design, will be objected to.

The examiner will issue a deficiency lettergiving the applicant 2 months to remedy by:

- withdrawing the views concerned (which will not form part of the Community design); or
- submitting new views on a neutral background; or

- amending the views objected to so that the design is isolated from its background. This latter option will make use of visual disclaimers (see paragraph 5.4 below).

If the applicant withdraws the deficient view(s) within the time limit set by the Office, the date of receipt of the original application will be recorded as the date of filing for the views that are not deficient.

If the applicant submits new or amended views within the time limit set by the Office, the date of receipt of these views will be recorded as the date of filing of the design.

If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application in accordance with Article 46(2) and Article 36(1)(c) CDR and Article 10(1)(c) CDIR. The file will be closed by a decision of the examiner and the applicant will be notified. The examiner will notify the Finance Department that a refund of any fees paid should be made to the applicant (Article 10(2) CDIR).

3.3.3 Designs retouched with ink or correcting fluid

The design must not be retouched with ink or correcting fluid (Article 4(1)(e) CDIR).

Representations visibly retouched with ink or correcting fluid will be objected to and refused for the purpose of allocating a filing date.

3.3.3.1 Examination

The examiner will use a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views concerned (which will not form part of the Community design); or
- submitting new views.

If the applicant withdraws the deficient view(s) within the time limit set by the Office, the date of receipt of the original application will be recorded as the date of filing for the views that are not deficient.

If the applicant submits new views within the time limit set by the Office, the date of receipt of these views will be recorded as the date of filing of the design.

If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application in accordance with Article 46(2) and Article 36(1)(c) CDR and Article 10(1)(c) CDIR. The file will be closed by a decision of the examiner and the applicant will be notified. The examiner will notify the Finance Department that a refund of any fees paid should be made to the applicant (Article 10(2) CDIR).

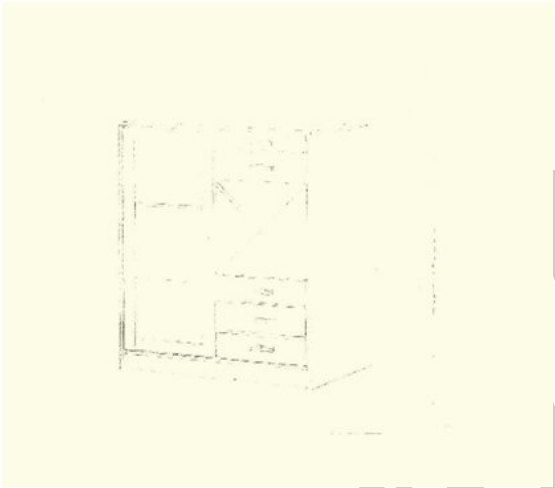
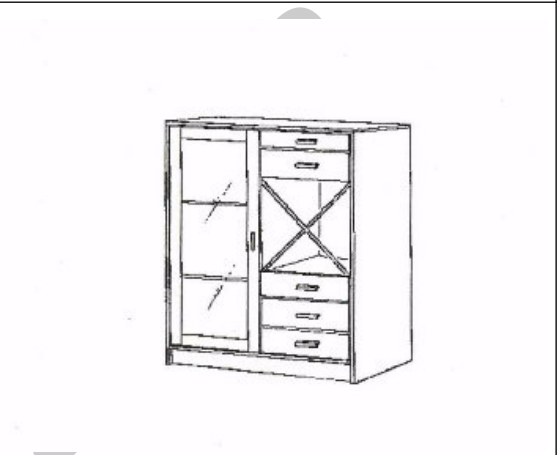
Obsolete

3.3.4 Quality

In accordance with Article 4(1)(e) CDIR, the design must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Community Designs Register and for direct publishing in the *Community Designs Bulletin*.

Poor quality views are those that do not allow the details of the design to be clearly distinguished.

Examples

Poor Quality	**Sufficient Quality**
	

Poor quality views are also those that do not allow the design to be reduced or enlarged.

Examples

Poor quality	Sufficient Quality

3.3.4.1 Examination

Where the design is not of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views concerned (which will not form part of the Community design); or
- submitting new views.

If the applicant withdraws the deficient view(s) within the time limit set by the Office, the date of receipt of the original application will be recorded as the date of filing for the views that are not deficient.

If the applicant submits new views within the time limit set by the Office, the date of receipt of these views will be recorded as the date of filing of the design.

If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application in accordance with Article 46(2) and Article 36(1)(c) CDR and Article 10(1)(c) CDIR. The file will be closed by a decision of the examiner and the applicant will be notified. The examiner will notify the Finance Department that a refund of any fees paid should be made to the applicant (Article 10(2) CDIR).

The requirement that the design must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished, for publication purposes, applies equally to all applications, irrespective of the means of filing.

Applications sent by e-filing, however, raise specific issues.

Obsolete

E-filing

For e-filing, the terms and conditions determined by the Office must be adhered to (see Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means as well Article 9 for the technical requirements of RCD applications).

Low-resolution attachments are likely to be objected to due to their insufficient quality for reproduction and publication purposes where enlargement of the views to a size of 8 cm by 16 cm causes the details of the design to be blurred.

Where the electronic filing is incomplete or illegible the Office will issue a formal notification requesting the applicant to resend the application within **2 months**. If the deficiencies concern the filing date requirements pursuant to Article 10(1) CDIR, the date on which all deficiencies are remedied determines the date of filing (Article 10(2) CDIR in combination with Article 67(3) CDIR).

If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application in accordance with Article 46(2) and Article 36(1)(c) CDR and Article 10(1)(c) CDIR. The file will be closed by a decision of the examiner and the applicant will be notified. The examiner will notify the Finance Department that a refund of any fees paid should be made to the applicant (Article 10(2) CDIR).

Where it is clear that the electronic filing was deficient due to technical problems attributable to the Office, with the result that one or more views do not correspond to those originally submitted by the applicant, the Office will allow the resubmission of the affected views. The original filing date via e-filing will be retained, provided that there is no other deficiency affecting the filing date.

3.3.5 Specimens

The graphic or photographic reproduction of the design can be substituted by a specimen of the design provided the following cumulative conditions are met:

- the application relates to a two-dimensional design; and
- the application contains a request for deferment (Article 36(1)(c) CDR; Article 5(1) CDIR).

In the event of a multiple application, the substitution of the representation by a specimen may apply only to some of the designs, provided these designs are two-dimensional and are subject to a request for deferment (see paragraph 6.2.5 below).

A specimen is usually a sample of a piece of material such as textile, wallpaper, lace, leather, etc.

Specimens must not exceed 26.2 cm x 17 cm in size, 50 g in weight or 3 mm in thickness. They must be capable of being stored and unfolded (Article 5(2) CDIR).

Five samples of every specimen must be filed; in the case of a multiple application, five samples of the specimen must be filed for each design (Article 5(3) CDIR).

Obsolete

The application and the specimen(s) must be sent in a single delivery either by post or personal delivery. A date of filing will not be accorded until both the application and the specimen(s) have reached the Office.

Where the applicant submits a specimen relating to an application that does not relate to a two-dimensional design or that does not contain a request for deferment, the specimen is not admissible. In that case, the date of filing will be determined by the date on which the Office receives a suitable graphic or photographic reproduction of the design, provided the deficiency is remedied within 2 months of receipt of the Office's notification (Article 10(2) CDIR).

In principle, the specimen will be kept on file indefinitely (Decision No EX-13-4 of the President of the Office of 26 November 2013 concerning the keeping of files).

Where a representation of the design has been replaced by a specimen in accordance with Article 5 CDIR, the applicant must file a graphic or photographic reproduction of the design at the latest 3 months before the 30-month deferment period expires, or at the latest 3 months before the requested date of publication (Article 15(1)(c) CDIR; see paragraph 6.2.5.3 below).

If the holder fails to file a graphic or photographic representation the Office will issue a deficiency letter. If the holder fails to remedy the deficiency the design will be deemed from the outset not to have had the effects specified in the Regulation.

4 Examination of the Substantive Requirements

The Office carries out an examination of the substantive protection requirements, which is limited to two grounds for non-registrability.

An application will be refused if the design does not correspond to the definition set out in Article 3(a) CDR or if it is contrary to public policy or to accepted principles of morality (Article 9 CDR).

4.1 Compliance with the definition of a design

A 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation (Article 3(a) CDR).

A 'product' means any industrial or handicraft item, including, inter alia, parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs (Article 3(b) CDR).

Whether the product claimed is actually made or used, or can be made or used, in an industrial or handicraft manner will not be examined.

Whether a design discloses the appearance of the whole or a part of a 'product' will be examined in the light of the design itself, insofar as it makes clear the nature of the

Obsolete

product, its intended purpose or its function, and of the indication of the products in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) CDR).

The following examples, albeit non-exhaustive, illustrate the Office's practice.

4.1.1 Blueprints, plans for houses or other architectural plans and interior or landscape designs

Blueprints, plans for houses or other architectural plans and interior or landscape designs (e.g. gardens) will be considered 'products' for the purpose of applying Article 7(1) CDR and will be accepted only with the corresponding indication of *other printed matter* in Class 19-08 of the Locarno Classification.

An objection will be raised if the product indicated in an application for a design consisting of a blueprint of a house is *houses* in Class 25-03 of the Locarno Classification. This is because a blueprint does not disclose the appearance of a finished product such as a house.

4.1.2 Colours per se and combinations of colours

A single colour may of course be an element of a design, but on its own it does not comply with the definition of a design because it does not constitute the 'appearance of a product'.

Combinations of colours may be accepted if it can be ascertained from the contours of the representation that they relate to a product such as, for instance, a logo or a graphic symbol in Class 32 of the Locarno Classification.

4.1.3 Icons, graphic user interfaces and the like

Designs of screen displays and icons, graphic user interfaces and other kinds of visible elements of a computer program are eligible for registration (see Class 14-04 of the Locarno Classification).

4.1.4 Mere verbal elements

Mere words per se and sequences of letters (written in standard characters in black and white) do not comply with the definition of a design because they do not constitute the appearance of a product.

The use of fanciful characters and/or the inclusion of a figurative element, however, render(s) the design eligible for protection either as a logo/graphic symbol in Class 32 of the Locarno Classification or as the ornamental representation of a part of any product to which the design will be applied.

Obsolete

4.1.5 Music and sounds

Music and sounds per se do not constitute the appearance of a product and, therefore, do not comply with the definition of a design.

However, the graphical representation of a musical composition, in the form of musical notation, would qualify as a design, if applied for as, for example, *other printed matter* in Class 19-08 or *graphic symbols* in Class 32 of the Locarno Classification.

4.1.6 Photographs

A photograph per se constitutes the appearance of a product and, therefore, complies with the definition of a design, irrespective of what it discloses. The indication of the product can be *writing paper, cards for correspondence and announcements* in Class 19-01, *other printed matter* in Class 19-08 of the Locarno Classification, or any product to which the design will be applied.

4.1.7 Living organisms

Living organisms are not 'products', that is, industrial or handicraft items. A design that discloses the appearance of plants, flowers, fruits etc. in their natural state will, in principle, be refused. Even if the shape at issue deviates from that of the common corresponding living organism, the design should be refused if nothing suggests prima facie that the shape is the result of a manual or industrial process (18/02/2013, R 595/2012-3, GROENTE EN FRUIT, § 11).

RCD application No 1 943 283-0001	

However, no objection will be raised if it is apparent from the representation that the product does not show a living organism or if the indication of the product specifies that the product is artificial (see, in particular, Class 11-04 of the Locarno Classification).

Obsolete

4.1.8 Teaching materials

Teaching materials such as graphs, charts, maps, etc. can be representations of products in Class 19-07 of the Locarno Classification.

4.1.9 Concepts

A design application will be refused where the representation is of a product that is simply one example amongst many of what the applicant wishes to protect. An exclusive right cannot be granted to a 'non-specific' design that is capable of taking on a multitude of different appearances. This is the case where the subject matter of the application relates, inter alia, to a concept, an invention or a method for obtaining a product.

4.2 Public policy and morality

The Office will apply the concepts of public policy and morality as explained in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 7, Trade marks contrary to public policy or acceptable principles of morality (Article 7(1)(f) EUTMR).

4.3 Objections

Where an objection is raised by the examiner in respect of one of the two above grounds for non-registrability, the applicant will be given the opportunity to withdraw or amend the representation of the design or to submit its observations within 2 months (Article 47(2) CDR, Article 11 CDIR).

If the objection relates to compliance with the definition of a design and if this objection can be overcome by amending the indication of the products in which the design is intended to be incorporated or to which it is intended to be applied, the examiner will propose such an amendment in the communication to the applicant.

Where the applicant opts to submit an amended representation of the design, this representation will be admissible provided that 'the identity of the design is retained' (Article 11(2) CDIR). The date of receipt of the original application will remain as the date of filing.

Maintenance in an amended form will, therefore, be limited to cases in which the removed or disclaimed features are so insignificant in view of their size or importance that they are likely to pass unnoticed.

Features can be disclaimed by making use of the visual disclaimers referred to in paragraph 5.3 below.

Obsolete

Where the applicant fails to overcome the grounds for non-registrability within the time limit, the Office will refuse the application. If those grounds concern only some of the designs contained in a multiple application, the Office will refuse the application only insofar as those designs are concerned (Article 11(3) CDIR).

5 Additional Requirements Regarding the Representation of the Design

The purpose of the graphic representation is to disclose the features of the design for which protection is sought. The graphic representation must be self-contained in order to determine with clarity and precision the subject matter of the protection afforded by the registered Community design to its holder. This rule is dictated by the requirement of legal certainty.

In accordance with the Common Practice (CP6), use of aspect views of the design is recommended.

Aspect views are defined under the Common Practice (CP6) as showing the design from certain directions (angles), and encompass the following: perspective view(s), front view, top view, right side view, left side view, back view and bottom view. See the following examples (for all but a bottom view).

RCD No 2 325 456-0001						

For the purpose of filing a design, it is sufficient to file only one aspect view. However, other (non-traditional) types of view, in particular exploded views (see paragraph 5.3.2 below) and sectional views (see paragraph 5.3.5 below), cannot be filed on their own.

Applicants are reminded that the requirements concerning the format of the representation of the design may vary according to how the application is filed (e.g. e-filing, paper, use of a specimen). These requirements are set out in Articles 4 and 5 CDIR, and the technical requirements for applications filed electronically are listed in Article 9 of the Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means.

The following instructions supplement the requirements regarding the quality of the reproduction and the neutral background (see paragraph 3.3 above). For general quality recommendations for representations filed in the form of drawings or photographs, please consult the Common Practice (CP6). ([5])

5 https://www.tmdn.org/network/converging-practices.

Obsolete

The following instructions apply to all designs, irrespective of how the application was filed.

Even where a representation of the design has been replaced by a specimen in accordance with Article 5 CDIR (see paragraph 3.3.5 above), the applicant must file a graphic or photographic reproduction of the design at the latest 3 months before the 30-month deferment period expires, or at the latest 3 months before the requested date of publication (Article 15(1)(c) CDIR; see paragraph 6.2.5.3 below).

Any deficiency found in an application and relating to one of the requirements in this section will have no bearing on the granting of a filing date. However, if the deficiencies are not remedied within the time limit set by the Office in its examination report, the application will be refused (Article 46(3) CDR). If the deficiencies concern only some of the designs contained in a multiple application, the Office will refuse the application only insofar as those designs are concerned (Article 11(3) CDIR).

Once a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid by an applicant (Article 13 CDIR).

5.1 Number of views

A maximum of seven different views can be filed in order to represent the design (Article 4(2) CDIR). The views may be plan, in elevation, cross-sectional, in perspective or exploded. Only one copy of each view should be filed.

For applications other than e-filings, each of the views must be numbered by the applicant in Arabic numerals separated by a dot, the first numeral being the number of the design, the second being the number of the view. For instance, the sixth view of the second design of a multiple application must be numbered ‘2.6’.

In cases where more than seven views are provided, the Office will disregard any of the extra views for registration and publication purposes (27/10/2009, R 571/2007-3, Frames for cycles or motorcycles, § 13), although they will remain in the file. The Office will take the views in the consecutive order in which they have been numbered by the applicant (Article 4(2) CDIR).

Where a reproduction comprises less than seven views and the views are not numbered, the examiner will number the views according to the sequence given in the application.

The examiner will not change the order of the views as appearing in the application, or their orientation.

5.2 Consistency of the views

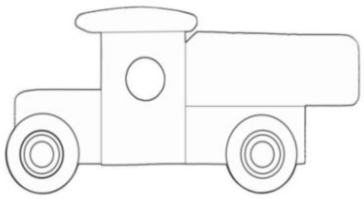
The examiner will check whether the views relate to the same design, that is, to the appearance of one and the same product or of its parts.

Obsolete

It is the applicant's responsibility to submit a correct and complete application (including representations of the design). The Office is not entitled to remedy any deficiencies in respect of incongruent views once the Community design is registered and published (03/12/2013, R 1332/2013-3, Adapters, § 14 et seq.).

5.2.1 Combination of several means of visual representation

Regarding the combination of several means of visual representation, it is recommended, in accordance with the Common Practice (CP6), that a design be represented using only one visual format (e.g. a drawing or a photograph). Therefore, the following combination of a drawing and a photograph depicting a vehicle toy, as shown in the Common Practice (CP6), is considered unacceptable and thus should not be filed.

CP6 Example	
	

Where different visual formats are used, each must clearly relate to the same design and be consistent when comparing the features disclosed.

When the different visual formats show aspects that are inconsistent with one another, they are not considered to represent the same design. A combination of a drawing and a photograph will usually reveal inconsistencies between representations in different visual formats.

In the following example of a chair design, the seat is flat in the drawing but arched in the photograph. The backrests are also of a different shape.

Invented example	**RCD No 1 282 099-0013**

Obsolete

The same may apply when the graphic representation indicates features other than contour lines, such as surface features that are not consistent with the corresponding features in the photographic representation.

The Office therefore strongly recommends that applicants wishing to use different visual formats file each one as a separate design (e.g. one design consisting of drawings only, the other of photographs); these can also be combined in a multiple application.

Where the use of different visual formats leads to an inconsistency of views showing more than one design, the examiner will isue a deficiency letter giving up the applicant 2 months to remedy by:

- withdrawing the views representing other designs;
- provided 'unity of class' can be maintained (see paragraph 7.2.3 below), converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- if 'unity of class' cannot be maintained, converting its application into separate applications, and paying the corresponding fees.

If the applicant withdraws the inconsistent view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

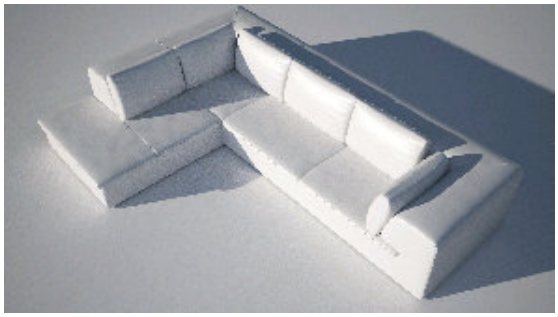
5.2.2 Views relating to more than one design

Views relate to more than one design when there are different embodiments of the same concept, or when the lines used to identify the design or the disclaimers used to disclaim certain features are not used consistently throughout the views.

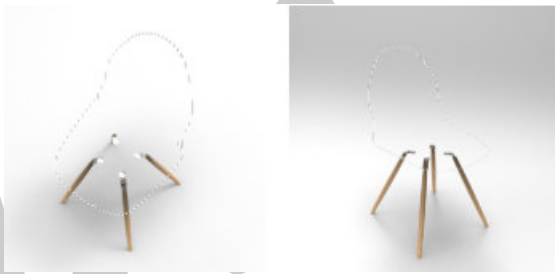
Different embodiments of the same concept cannot be grouped in a single application because each embodiment is a design on its own. It should not be confused with sets of articles (see paragraph 5.3.7 below).

Different embodiments of the same concept are considered to be different designs.

Obsolete



Lines and disclaimers must be consistent throughout all the views.

Inconsistent disclaimer	**Consistent disclaimer**
	

Where the application contains different embodiments or where the use of lines or visual disclaimers leads to an inconsistency of views showing more than one design, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views representing other designs;
- provided 'unity of class' can be maintained (see paragraph 7.2.3 below), converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- if 'unity of class' cannot be maintained, converting its application into separate applications, and paying the corresponding fees.

If the applicant withdraws the inconsistent view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

Obsolete

5.2.3 Colours

The representation of the design may be submitted **either** in black and white (monochrome) **or** in colour (Article 4(1) CDIR).

Representations combining black and white views with colour views will be objected to due to their inconsistency and the resulting legal uncertainty as to the protection sought.

The same reasoning applies where identical features of a design are represented in different colours in the various views. Such an inconsistency suggests that the application relates to more than one design (31/03/2005, R 965/2004-3, Bandmaß, § 18-20; 12/11/2009, R 1583/2007-3, Bekleidung, § 9-10).

Where the use of different colours leads to an inconsistency of views showing more than one design, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views representing other designs;
- provided 'unity of class' can be maintained (see paragraph 7.2.3 below), converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- if 'unity of class' cannot be maintained, converting its application into separate applications, and paying the corresponding fees.

If the applicant withdraws the inconsistent view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

Obsolete

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

However, as an exception to the above principle, the same features of a design can be represented in different colours in the various views if the applicant submits evidence, within the time limit set by the Office to remedy the deficiency, that the change of colours at different points in time, while the product is in use, is one of the relevant features of the design, as in the example below (RCD No 283 817-0001, courtesy of ASEM Industrieberatung und Vermittlung).

RCD No 283 817-0001	

Where the representation is in colour, the registration and publication will also be in colour (Article 14(2)(c) CDIR).

5.3 Specific requirements for the different types of views

5.3.1 Alternative positions

Designs with alternative positions are of an appearance that can be modified into various configurations without adding or removing any parts.

These designs have predefined stages of use that each correspond to an alternative position.

In accordance with the Common Practice (CP6), views showing different configurations of the design are acceptable provided no parts have been added or deleted.

The alternative positions of the movable or removable parts of a design must be shown in separate views.

The example below of an acceptable representation of a design with alternative positions is taken from the Common Practice (CP6), which also lists additional examples.

RCD No 588 694-0012	

In some cases, different configurations may result in different products, such as the bag that can be converted into a towel.

Croatian design No D20110100		

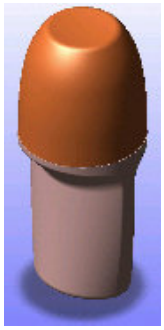
Obsolete

5.3.2 Exploded views

Exploded views are views where parts of a product are shown disassembled, to clarify how the parts fit together.

Exploded views must be combined with at least one view representing the assembled product. In these views, all the product's parts must be shown disassembled in a separate single view. The disassembled parts must be shown in close proximity and in order of assembly.

The example below of an acceptable representation of a design with an assembled and an exploded view is taken from the Common Practice (CP6), which also lists additional examples.

RCD No 1 847 468-0003	
	

Where there is no view showing the assembled product, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by submitting such a view showing the assembled product for which protection is sought. The new view should not contain features that were not included in the original representation of the design. The original filing date will be retained.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

5.3.3 Views magnifying part of the design

Magnified views show one part of an overall design on an enlarged scale.

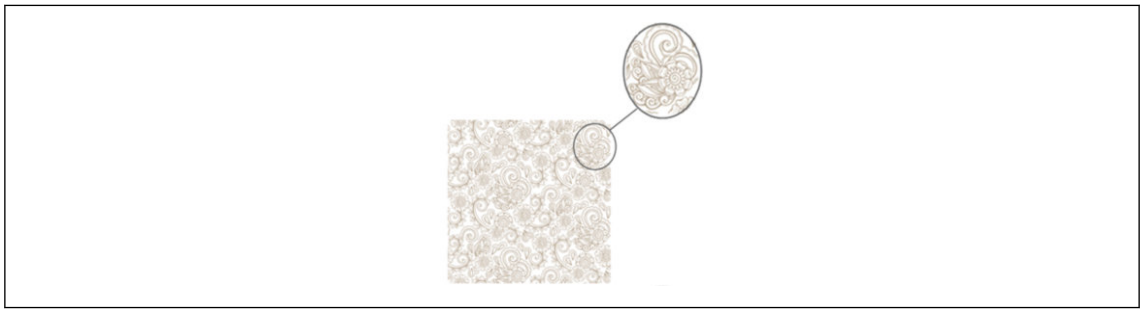
A single magnified view is acceptable provided that the magnified part is already visible in one of the other views submitted.

The view that shows the magnified part of the design must be presented in a separate single view.

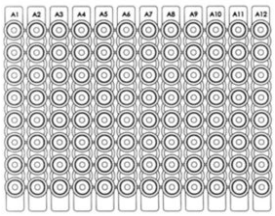
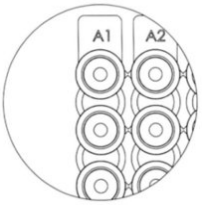
Example of an unacceptable magnified view filed as one view

CP6 example

Obsolete



Example of an acceptable magnified view filed as a separate view

RCD No 19 113 690-0002	
	

Where the magnified view is filed within another view, the examiner will issue a deficiency letter inviting the applicant to submit the view showing the magnification separately, which should not contain features that were not included in the original representation of the design. The original filing date will be retained.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

5.3.4 Partial views

A partial view is a view showing part of a product in isolation. A partial view can be magnified.

Partial views must be combined with at least one view of the assembled product (the different parts need to be connected to each other).

Example of an acceptable assembled view, filed together with partial views

RCD No 2 038 216-0001			
Assembled view	**Partial view**	**Partial view**	**Partial view**

Obsolete

Where all the views disclose different detailed parts, **without showing these parts connected to each other**, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views representing other designs;
- provided 'unity of class' can be maintained (see paragraph 7.2.3 below), converting its application into a multiple application in which the inconsistent view(s) form separate design(s) and paying the corresponding fees;
- if 'unity of class' cannot be maintained, converting its application into separate applications, and paying the corresponding fees.

If the applicant withdraws the deficient view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

5.3.5 Sectional views

Sectional views are cutaway portions that complement aspect views by illustrating a feature or features of the product's appearance, such as contour, surface, shape or configuration.

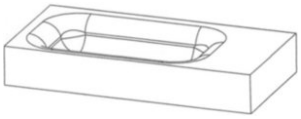
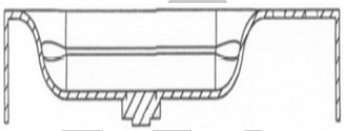
In accordance with the Common Practice (CP6), representations with technical indications, such as axial lines or sizes (dimensions), numbers, etc., are not acceptable. The sectional view should be an unambiguous view of the same design. Sectional views should not be submitted without other traditional views, such as aspect views.

The following are examples agreed in the context of the Common Practice (CP6) of sectional views, which must be filed together with other traditional views, such as aspect views.

Spanish design No I0152702-D

Obsolete

Aspect view	Sectional view

Benelux design No 38478-0002	
Aspect view	**Sectional view**
	

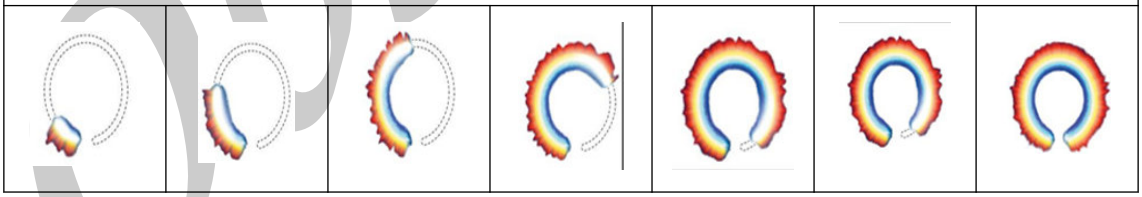
Obsolete

5.3.6 Sequence of snapshots (animated designs)

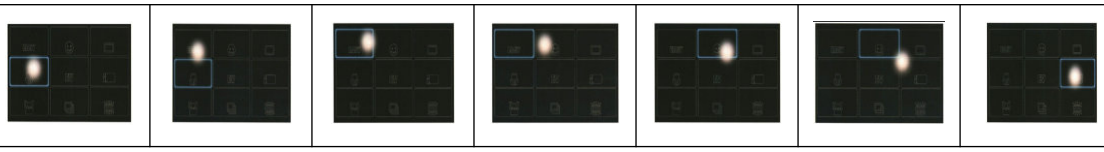
Snapshots are a short sequence of views used to show a single animated design at different specific moments in time, in a clearly understandable progression.

This applies to, for example:

- an animated icon (design consisting of a sequence)

RCD No 2 085 894-0014						
						

- an animated graphical user interface (design of an interface)

RCD No 1 282 388-0031						
						

In principle, according to the Common Practice (CP6), all views of an animated icon or graphical user interface need to be visually related, which means that they must have features in common. It is the applicant's responsibility to order the views in such a way as to give a clear perception of the movement/progression.

5.3.7 Sets of articles

A set of articles is a group of products of the same kind that are generally regarded as belonging together and are so used. See the example below.

RCD No 938 709-0001

Sets of articles should not be confused with variations of a design. Different embodiments of the same concept cannot be grouped in a single application because each embodiment is a design on its own. See paragraph 5.2.2. Views relating to more than one design, above.

The difference between a complex product and a set of articles is that, in contrast to a complex product, the articles of a 'set of articles' are not mechanically connected.

A set of articles can be a 'product' in itself within the meaning of Article 3 CDR. It can be represented in a single design application if the articles making up this set are linked by **aesthetic and functional complementarity** and are, in normal circumstances, sold together as one single product, like a chess board and its pieces, or sets of knives, forks and spoons.

It must, however, be clear from the representation that protection is sought for a design resulting from the combination of the articles making up the set, and not for each article separately.

Applicants must submit, among the seven views allowed, at least one view showing the set of articles in its entirety.

Where there is no view showing the set of articles in its entirety, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- Withdrawing the views representing other designs;

Obsolete

- provided ‘unity of class’ can be maintained (see paragraph 7.2.3 below), converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- if ‘unity of class’ cannot be maintained, converting its application into separate applications, and paying the corresponding fees.

If the applicant withdraws the deficient view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

5.3.8 Repeating surface patterns

Where the application concerns a design consisting of a repeating surface pattern, the representation of the design must disclose the complete pattern and a sufficient portion of the repeating surface (Article 4(3) CDIR) in order to show how this pattern is infinitely multiplied.

Where there is no indication in the application that the design consists of a repeating surface pattern, the Office will assume that this is not the case and will not request a sufficient portion of the repeating surface.

If additional views represent the pattern applied to one or more specific products for illustrative purposes, the applicant must make sure that the shape of such products is not claimed as part of the design by using any method referred to under paragraph 5.4 below.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

RCD 6 574 695-0004

Obsolete

5.3.9 Typographic typefaces

Where the application concerns a design consisting of a typographic typeface, the representation of the design must consist of a string of all the letters of the alphabet, upper case and lower case, and of all the Arabic numerals, as well as of a text of five lines produced using that typeface, all in 16-pitch font (Article 4(4) CDIR).

RCD 1 038 103-0002

ABCDEFGHIJKLMNOPQRSTUVWXYZ
abcdefghijklmnopqrstuvwxyz
1234567890
ßÄÖÜäöü !"$%&/()=?@€

Uptat nibh eu faciduismod tie doluptat deliquat alissequisim inim.
Met augueros eugait in et volor summy nullaoreet,
veliquisim quisissecte dolum volenim auguerit, conulput eugiamc
oreros nim vel illamconsed magna facin vel ulputat veniamet,
corerat. Nis autet la eummod dit prate delit accumsan henisl delit.

Where the application does not include a text of five lines using the typeface concerned (Article 4(4) CDIR), the applicant will be requested to submit such a text or to accept a change in the indication of products to ‘set of characters’ in Class 18-03 of the Locarno Classification.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) CDR and Article 11(3) CDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 13 CDIR).

Obsolete

5.4 Use of visual disclaimers to exclude features from protection

Neither the CDR nor the CDIR provides rules for the possibility of including in the application a statement that the applicant disclaims any exclusive right to one or more features disclosed in the views.

Use of a description within the meaning of Article 36(3)(a) CDR is not appropriate in this regard since a description 'shall not affect the scope of protection of the design as such' according to Article 36(6) CDR (see paragraph 6.2.2 below). Moreover, only an indication that a description has been filed is published, not the description as such (Article 14(2)(d) CDIR).

Disclaimers must therefore be apparent from the representation of the design itself.

In accordance with the Common Practice (CP6), visual disclaimers indicate that protection is not being sought, and registration has not been granted, for certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected. This can be achieved:

- by excluding with broken lines, blurring or colour shading the features of the design for which protection is not sought; or
- by including the features of the design for which protection is sought within a boundary, thus making it clear that no protection is sought for what falls outside the boundary.

Under the Common Practice (CP6), the offices agreed on the general recommendation that graphic or photographic representations showing only the claimed design are preferred. However, visual disclaimers can be used when the graphic or photographic representation of the design contains parts of the product for which no protection is sought. In these cases, the disclaimer must be clear and obvious; the claimed and disclaimed features must be clearly differentiated.

To be accepted, when the design is represented by more than one view, the visual disclaimer must be shown consistently in all the views where it appears.

Where a disclaimer is used, broken lines are recommended. Only when broken lines cannot be used due to technical reasons (e.g. when they are used to indicate stitching on clothing or patterns, or when photographs are used), can other disclaimers be used, such as colour shading, boundaries or blurring.

In accordance with the Common Practice (CP6), in an application for registration of a Community design, the following visual disclaimers will be allowed (see paragraphs 5.4.1 to 5.4.4 below).

Obsolete

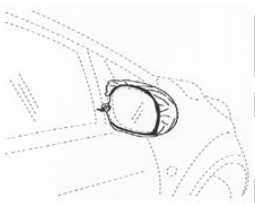
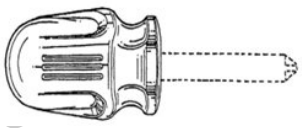
5.4.1 Broken lines

Broken lines consist of a trace made up of dots or dashes (or a combination of both), and are used to indicate that no protection is sought for features shown using the interrupted trace.

A visual disclaimer consisting of broken lines will usually be combined with continuous lines.

To be accepted, the features for which protection is not sought should be clearly indicated with broken lines, whereas the parts for which protection is sought should be indicated with continuous lines.

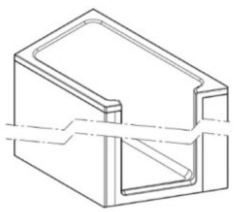
The following are examples agreed in the context of the Common Practice (CP6) for correctly applied broken lines.

RCD **No 30 606-0005**	**Benelux design** **No 38212-0001**	**Hungarian design** **No D9900409-0001**
		

In cases where broken lines are a feature of the design (such as stitching on clothing), this must be clear from the representation. In such cases, it may be helpful to file, for example, a magnified view.

In cases where broken lines are a feature of the design and a part of the design needs to be disclaimed, any of the other visual disclaimers can be used, such as colour shading, blurring or boundaries.

For ease of illustration, broken lines may also illustrate separations, indicating that the precise length of the design is not claimed (indeterminate length).

RCD No 2 509 430-0001


Obsolete

In view of the Common Practice (CP6), the Office does not recommend using broken lines to indicate portions of the design that are not visible in that particular view, that is to say, non-visible lines.

5.4.2 Blurring

Blurring is a type of visual disclaimer that consists in obscuring the features for which protection is not sought in the drawings or photographs of a design application.

Blurring may only be accepted when the features for which protection is sought are clearly distinguishable from the disclaimed (blurred) features.

The following is an example agreed in the context of the Common Practice (CP6) of correctly applied blurring.

RCD No 244 520-0002

5.4.3 Colour shading

Colour shading is a type of visual disclaimer that consists in using contrasting tones to sufficiently obscure the features for which protection is not sought in the drawings or photographs of a design application.

With colour shading, the features for which protection is sought must be clearly perceptible, whereas the disclaimed features must be represented in a different tone and so as to appear blurred or imperceptible.

The following are examples agreed in the context of the Common Practice (CP6) for correctly applied colour shading.

RCD No 910 146-0004	**International registration DM/078504**

Obsolete

Further examples of Office practice.

RCD No 1 469 530-0001	RCD No 5 295 680-0009

5.4.4 Boundaries

Boundaries are a type of visual disclaimer used in drawings or photographs of a Community design application to indicate that no protection is sought for the features not contained within the boundary.

The following are examples agreed in the context of the Common Practice (CP6) for correctly applied boundaries.

RCD No 2 182 238-0002	RCD No 1 873 688-0003

Obsolete

In order to be accepted, the features for which protection is sought should be clearly indicated/represented within the boundary, whereas all the features outside the boundary are considered to be disclaimed and therefore not protected.

Due to the risk of including more than just the design within the boundary, boundaries must be used carefully in drawings/photographs. The following are examples of incorrectly applied boundaries.

CP6 example	CP6 example

Obsolete

5.5 Explanatory text, wording or symbols

No explanatory text, wording or symbols may be displayed in the views.

For paper filings only the indication ‘top’ or the name or address of the applicant may appear (Article 4(1)(c) CDIR).

Where words, letters, numbers and symbols (such as arrows) are **clearly** not part of the design, the examiner may cut them from the views using the specific IT tool available for this. If the examiner is not able to cut them out for technical reasons, the applicant will be requested to send in clean views or to withdraw the deficient ones.

Where the words, letters, numbers, etc. are part of the design (graphical symbol), the design is acceptable.

Verbal elements displayed in the representation that are part of the design will be keyed in and entered in the file. Where several verbal elements are displayed, the examiner will only take into account the most prominent one.

5.6 Amending and supplementing views

As a matter of principle, the representation may not be altered after the application has been filed. The submission of additional views or the withdrawal of some views will therefore not be accepted (Article 12(2) CDIR), unless expressly allowed or required by the Office (see paragraphs 3.3, 4.3 and 5.3 above).

In particular, the views initially filed may not be replaced with better-quality ones. The representations examined and published will be those that the applicant provided in its original application.

The submission of amended or additional views, where allowed, must be made by electronic communication via the Office's website (not by email) in JPEG format (for further information on other formats and technical requirements, see: https://euipo.europa.eu/ohimportal/en/attachments), or by post.

6 Additional Elements that an Application Must or May Contain

6.1 Mandatory requirements

In addition to the requirements for the grant of a filing date (see paragraph 3 above), the application must properly identify the applicant and, if applicable, its representative (Article 1(b) and (e) CDIR), specify the two languages of the application (Article 1(h) CDIR), contain a signature (Article 1(i) CDIR) and indicate the products in which the design is intended to be incorporated or to which it is intended to be applied (Article 1(d) CDIR).

Even after a date of filing has been granted, the examiner will issue an objection if a deficiency with regard to any of the above requirements is noted in the course of examining the Community design application (Article 10(3)(a) CDIR).

6.1.1 Identification of the applicant and its representative

Pursuant to Article 1(b) CDIR, an application will be objected to if it does not contain the following information regarding the applicant: its name, address and nationality and the State in which it is domiciled or, if the applicant is a legal entity, in which it has its seat or establishment.

The Office strongly recommends indicating the state of incorporation for US companies, where applicable, in order to differentiate clearly between different owners in its database. If the Office has given the applicant an identification number, it is sufficient to mention that number together with the applicant's name.

Where the application is filed in the name of more than one applicant, the same requirement applies to each one.

Names of natural persons must give both the family name and the given name(s). The names of legal entities must be given in full (statutory name) and only its legal form may be abbreviated in a customary manner, for example, PLC, S.A. If the legal form is not specified or is incorrectly indicated, a deficiency letter requesting this information

Obsolete

will be issued. If the missing or correct legal form is not given, the application will be rejected.

If the applicant does not have a representative, it is highly recommended that an indication be given of telephone numbers and details of other data-communication links, such as email.

The address should contain, if possible, the street, street number, city/town or state/ county, postal code and country. A PO box does not constitute a place of business unless it can be proven, for example, by submitting an extract of the company register, which would indicate the company's official address.

The applicant should indicate only one address but, if there are several, the first one listed will be recorded as the address for service, unless the applicant specifically designates a different one.

If the applicant has appointed a representative, the application must indicate the name of that representative and the address of its place of business. If an appointed representative has been given an identification number by the Office, it will be sufficient to mention that number together with the representative's name.

If the representative has more than one business address or if there are two or more representatives with different business addresses, the application must indicate which address is to be used as the address for service. Where no such indication is made, the address for service will be taken to be the first address mentioned.

6.1.2 Specification of the languages

The application may be filed in any of the official languages of the European Union (language of filing) (Article 98(1) CDR; see paragraph 2.4 above). The language of the application form does not affect the language of the application. It is the language of the text entered by the applicant that is decisive. The language of filing will be the first language of the application.

The applicant must indicate a second language, which must be an Office language, that is, English (EN), French (FR), German (DE), Italian (IT) or Spanish (ES).

The second language must be different from the language of filing.

The two-letter ISO (International Organization for Standardization) codes for identifying languages may be used in the box provided in the application form.

6.1.3 Signature

The application must be signed by the applicant (Article 1(i) CDIR). Where there is more than one applicant, the signature of one of them will be sufficient.

If an application is filed electronically, it is sufficient for the name and authority of the signatory to be indicated.

Obsolete

6.1.4 Indication of products

6.1.4.1 General principles

Pursuant to Article 36(2) CDR, an application for a Community design must indicate the products in which the design is intended to be incorporated or to which it is intended to be applied. Pursuant also to Article 1(1)(d) CDIR and Article 3(3) CDIR, the indication of products must be worded in such a way as to indicate clearly the nature of the products and to enable each product to be classified in only one class of the Locarno Classification, preferably using the terms appearing in the list of products set out therein, or in DesignClass (see below).

In addition to only being capable of being classified in a single class, for administrative purposes the indication of product must be worded sufficiently clearly so as to be able to be classified in a single subclass.

Neither the product indication nor the classification affects the scope of protection of a Community design as such (Article 36(6) CDR). A registered Community design confers on its holder the exclusive right to use the relevant design in all types of products, and not only in the product indicated in the application for registration (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 93).

Classification serves exclusively administrative purposes, in particular allowing third parties to search the registered Community design databases (Article 3(2) CDIR).

Applicants do not themselves have to classify the products in which their design is intended to be incorporated or to which it is intended to be applied (Article 36(3)(d) CDR). This is, however, highly recommended in order to speed up the registration procedure (see paragraph 6.2.3 below).

The considerations that follow only refer to single design applications. As far as multiple design applications are concerned, the ‘unity of class’ requirement applies (see paragraph 7.2.3 below).

6.1.4.2 The Locarno Classification and DesignClass

The Locarno Classification is an international classification for industrial designs. It exists in two official languages, namely French and English. Its structure and contents are adopted and amended by the Committee of Experts from the countries party to the Locarno Agreement. The Classification is administered by the World Intellectual Property Organization (WIPO).

The Office’s DesignClass web tool, based on the Locarno Classification, helps users search the harmonised product indications database for product indications that best match the products for which they want to register a design. The harmonised product indications database follows the same structure of classes and subclasses as the Locarno Classification. It contains not only the Locarno product indications but also many more that are accepted by the EU Member State IP offices and the Office. The

Obsolete

database is updated regularly with every new edition of the Locarno Classification approved by the Committee of Experts.

To speed up and simplify the registration procedure, it is highly recommended that products be indicated using the terms listed in DesignClass.

Using the terms listed in DesignClass obviates the need for translations and thus prevents long delays in the registration procedure. Using these product terms whenever possible will improve the transparency and searchability of the registered Community design databases.

6.1.4.3 How to indicate products

More than one product can be indicated in the application.

When more than one product is indicated in the application, the products do not have to belong to the same class of the Locarno Classification, unless several designs are combined in a multiple application (Article 37(1) CDR; Article 2(2) CDIR; see paragraph 7.2.3 below).

Each class and subclass of the Locarno Classification and DesignClass has a 'heading'. The class and subclass headings give a general indication of the fields to which the products belong.

In any event, the product(s) must be indicated in such a way as to allow classification in both the relevant class and subclass of the Locarno Classification (Article 1(2)(c) CDIR).

The use of terms listed in the heading of a given class of the Locarno Classification is not per se excluded, but it is not recommended. Applicants should **not** choose generic terms referred to in the heading of the relevant class (e.g. *articles of clothing and haberdashery* in Class 2), but instead select terms listed in the heading of the subclass (e.g. *garments* in subclass 02-02) or more specific terms from among those listed in the subclasses of the class in question (e.g. *jackets* in subclass 02-02).

Where the product indication does not allow classification in a subclass, the examiner will determine the relevant subclass by reference to the product disclosed in the graphical representation (see paragraph 6.2.3.1 below). For example, where an application contains as a product indication the term *furnishing* in Class 6 of the Locarno Classification, the examiner will assign a subclass by taking account of the design itself insofar as it makes clear the nature of the product, its intended purpose or its function. If the design clearly discloses the appearance of a bed, the examiner will assign the subclass 06-02 and change the product indication to *beds*.

The use of adjectives in product indications is not per se excluded, even if such adjectives are not part of the alphabetical list of products of the Locarno Classification or DesignClass (e.g. ***electric** tools for drilling* in subclass 08-01, or ***cotton** pants* in subclass 02-02). However, it may cause delays in processing the application where a translation of the adjective into all the EU languages is required.

Obsolete

6.1.4.4 *Ex officio* change of indication

Product terms not listed in the Locarno Classification or DesignClass

Where an applicant uses terms that are not in the Locarno Classification or DesignClass, the examiner will, in straightforward cases, substitute *ex officio* the wording used by the applicant with an equivalent or more general term listed in the Locarno Classification or DesignClass. The purpose of this is to avoid having to translate terms into all the EU languages, which would result in delays in processing the application.

For instance, where an applicant chooses the term *running trainers* (assuming it is not listed in the Locarno Classification or DesignClass) to indicate the products in which the design will be incorporated, the examiner will change this indication to *running shoes* (assuming it is listed therein).

Even though the product indication does not affect the scope of protection of a Community design as such, the examiner will refrain from replacing the terms chosen by the applicant with more specific terms.

Products and their parts

Where a design represents the appearance of one part of a product, and that product as a whole is indicated in the application (e.g. an application for the design of a knife handle specifies that the products in which the design will be incorporated are *knives* in subclass 08-03), the examiner will replace that product indication by the indication *product(s) X (part of -)*, provided both the part in question and the product as a whole belong to the same class of the Locarno Classification.

Where a design represents the appearance of a product as a whole, but only a part of that product is indicated in the application (e.g. an application for the design of a knife specifies that the products in which the design will be incorporated are *knife handles*), the examiner will raise an objection and will suggest either disclaiming the part not indicated (in which case a new filing date must be accorded) or replacing that product indication by the product term for the whole product (in which case the original filing date may be kept but the design's subject matter of protection will remain to be determined on the basis of the representation as filed). If the applicant does not reply within the time limit, the examiner will *ex officio* replace the applicant's product indication with the suggestion made.

Where a design represents a set of products, and these products are indicated in the application (e.g. an application for the design of a set of dishes specifies that the products in which the design will be incorporated are *dishes* in subclass 07-01), the examiner will replace that indication by *product(s) X (set of -)*.

Ornamentation

Where the design represents ornamentation for a given product, and only that product as a whole is indicated in the application, the examiner will replace that product indication by the indication *product(s) X (ornamentation for -)*. The product will thus be classified under Class 32-00 of the Locarno Classification.

Obsolete

Where the product indication is *ornamentation* and the design does not limit itself to representing ornamentation but also discloses the product to which the ornamentation is applied, or part of that product, without its contours being disclaimed, the examiner will raise an objection and will suggest either disclaiming that part (in which case a new filing date must be accorded) or replacing the indication *ornamentation* with the product indication for the product disclosed (in which case the original filing date may be kept but the subject matter for which the design is protected will have to be determined on the basis of the representation as filed). If the applicant does not reply within the time limit set, the product indication will be changed *ex officio* in accordance with the Office's proposal.

This may lead to an objection where a multiple application combines a number of such designs applied to products that belong to different classes of the Locarno Classification (see paragraph 7.2.3 below).

The same reasoning applies to the following product indications in Class 32 of the Locarno Classification: *graphic symbols and logos, surface patterns*.

Obvious mismatch

Since one of the main objectives of the product indication and classification is to enable the Community Designs Register to be searchable by third parties, where the product indication clearly does not match the product as disclosed in the representation of the design, the examiner will replace that product indication with the correct one.

Notification of the *ex officio* change of indication

Provided there is no deficiency, the examiner will register the Community design(s) and notify the holder of the registration of the *ex officio* change of product indication.

Where the holder objects to such *ex officio* change, it can apply for correction of the corresponding entry in the Register (see paragraph 11.1 below) and request that the original terms used in the application be maintained, provided there are no issues concerning the clarity and precision of these terms or their classification (Article 20 CDIR).

6.1.5 Long lists of products

More than one product can be indicated in an application.

However, in order to ensure that the Community Designs Register remains searchable, where the product indication contains more than five products the examiner will suggest that the applicant limit the number of products to a maximum of five and select products accordingly; the examiner may also suggest which products should be selected.

If, within the time limit indicated in the examiner's communication, the applicant expresses its wish to maintain the original list of products, the examination will proceed on the basis of that list. If the applicant does not respond within the time limit or expressly agrees with the examiner's suggestion, the examination will proceed on the basis of the product indication as suggested by the examiner.

Obsolete

6.1.6 Objections to product indications

Where the examiner raises an objection, the applicant will be given 2 months to submit its observations and remedy the deficiencies noted (Article 10(3) CDIR).

The examiner may invite the applicant to specify the nature and purpose of the products in order to allow proper classification, or may suggest product terms from DesignClass in order to assist the applicant.

If the deficiency is not remedied within the time limit, the application will be rejected (Article 10(4) CDIR).

6.1.6.1 No product indication

An objection will be raised where the application gives no indication of the products concerned (Article 36(2) CDR). However, if an indication can be found in the description or in the priority document, the examiner will record this as the product indication (21/03/2011, R 2432/2010-3, KYLKROPP FÖR ELEKTRONIKBÄRARE, § 14).

6.1.6.2 Deficient product indication

As noted above, the indication of products must be worded in such a way as to indicate clearly the nature of the products and enable each product to be classified in accordance with the Locarno Classification (Article 3(3) CDIR). Therefore, the examiner will also object to the product indication if it does not enable each product to be classified in only one class and subclass of the Locarno Classification.

This will be the case where the indication is too vague or ambiguous to allow the nature and purpose of the products in question to be determined, for example, *merchandise*, *novelty items*, *gifts*, *souvenirs*, *home accessories*, *electric devices*, etc.

This will also be the case where the indication concerns a service rather than a product, for example, *sending or processing of information*.

6.2 Optional elements

An application may contain a number of optional elements, as listed in Article 1(1)(f) and (g) CDIR and Article 1(2) CDIR, that is,

- a priority or exhibition priority claim;
- a description;
- an indication of the Locarno Classification of the products contained in the application;
- the citation of the designer(s);
- a request for deferment.

Obsolete

6.2.1 Priority and exhibition priority

6.2.1.1 Priority

General principles

An application for a Community design may claim the priority of one or more previous applications for the same design or utility model in or for any state party to the Paris Convention or to the Agreement establishing the World Trade Organization, or in or for another state with which there is a reciprocity agreement (Article 41 CDR; Article 8 CDIR). This 'Convention priority' is of 6 months from the date of filing of the first application.

The effect of the right of priority is that the date of priority counts as the date of filing of the application for a registered Community design for the purpose of Articles 5, 6, 7 and 22, Article 25(1)(d) and Article 50(1) CDR (Article 43 CDR).

If the priority of the same previous application is claimed for all designs of a multiple application, the 'Same priority for all designs' box should be ticked in the (paper) application form.

Any filing that is equivalent to a standard national filing under the domestic law applicable to it will be recognised as giving rise to the right of priority. A standard national filing means any filing that is suitable for establishing the date on which the application was filed in the country concerned, whatever the subsequent outcome of that application (Article 41(3) CDR).

The Office is a participating office in WIPO DAS, which is an electronic system allowing priority documents and similar documents to be securely exchanged between participating IP offices.

The system enables applicants and offices to meet the requirements of the Paris Convention for the certification of priority documents, allowing them to be exchanged in an electronic environment.

As **Office of Second Filing**, the Office accepts priority claims by way of reference in the fields provided for that purpose, namely, the file number, filing date and country of the previous application together with the WIPO DAS access code. This allows the priority document registered in WIPO DAS to be requested by the Office for immediate download.

Priority may be claimed either when filing the Community design application or within 1 month of the filing date. During this month, the applicant must submit the declaration of priority and indicate the file number as well as the date on which and the country in which the previous application was made (Article 8(2) CDIR).

Where there is no indication of the claim in the application, the submission of priority documents, or WIPO DAS access code[6], within 1 month of the filing date will be construed as a declaration of priority.

Obsolete

Unless it is expressly indicated in the application that a priority claim will be made subsequently, the application will be examined without delay and, if no deficiency is found, will be registered without waiting 1 month for any potential declaration of priority. If a declaration of priority is validly filed after registration of the Community design application, a corresponding entry will subsequently be made in the Register.

Formal requirements

At the examination stage, the Office will only examine whether all **formal requirements** are met.

The formal requirements are:

- priority claim must be filed together with the Community design application or within 1 month of the filing date (Article 8(2) CDIR);
- file number, filing date and country of previous application must be indicated when claiming priority (Article 1(1)(f) CDIR);
- priority documents must be submitted:
  - by providing the WIPO DAS access code at the time of filing via e-filing or within 3 months of either the filing date or, as the case may be, receipt of the priority claim[7]
  - OR by submitting a copy of all priority documents within 3 months of either the filing date or, as the case may be, receipt of the priority claim along with, where applicable, translations thereof (Article 8 CDIR). The priority document must consist of a copy of the entire previous application or registration, emanating from the authority that received it, stating the filing date of that application. The priority document may be filed in the form of an original or as an accurate photocopy. If the original document contains a representation of the design in colour, the photocopy must also be in colour (Decision No EX-20-7 of the Executive Director of the EUIPO of 11 September 2020 on the formal requirements of priority claims relating to registered Community designs).

Where the priority of a previous registered Community design is claimed, the applicant must indicate the number of the previous application and its date of filing. No additional information or document is required (Decision No EX-20-7 of the Executive Director of the EUIPO of 11 September 2020 on the formal requirements of priority claims relating to registered Community designs).

The Office will then publish the priority claim ‘as claimed’, meaning that the Office will not confirm the validity of the priority claim.

Language of previous application

If the language of the previous application is not one of the languages of the European Union, the examiner will invite the applicant to file a translation of the first or second language of the RCD application within 2 months (Article 42 CDR).

For the purpose of examining the formal requirements, the examiner will only verify that the information allowing the examiner to check the file number, date and country of the

6 This was a fast track change added after the consultation period for the 2022 edition of the guidelines
7 This was a fast track change added after the consultation period for the 2022 edition of the guidelines

Obsolete

previous application has been translated. However, the applicant must also file a translation of the remaining parts concerning the substantive requirements which, where necessary, will be examined during *inter partes* proceedings; this is also in the interests of third parties when inspecting the validity of the priority claim.

Formal priority requirements not satisfied

At the filing stage, the Office will limit itself to verifying whether the formal requirements listed above relating to a priority claim are satisfied (Article 45(2)(d) CDR).

Where remediable deficiencies are found, the examiner will request that the applicant remedy them within 2 months.

If the deficiencies are not remedied in due time or cannot be remedied, the Office will inform the applicant of the rejection of the priority claim and of the possibility of requesting a formal (i.e. appealable) decision on that rejection (Article 46(1) and (4) CDR; Article 40(2) CDIR).

If the deficiencies that are not remedied concern only some of the designs contained in a multiple application, the priority claim will be rejected in respect only of the individual designs concerned (Article 10(8) CDIR).

Substantive requirements

The **substantive requirements** to be met under Article 41 CDR for a priority claim to be considered valid will be examined not at the filing stage but, where necessary, during *inter partes* proceedings, and will be based on the copy of the priority documents submitted. **It is, therefore, the responsibility of the Community design applicant to submit a copy of the priority documents and, where applicable, translations thereof at the filing stage,** to allow the priority claim to be examined substantively when required during *inter partes* proceedings.

The requirements that refer to the substance of the priority claims are:

- previous application must be a first filing;
- previous application must concern a design or a utility model;
- Community design must relate to the ‘same design or utility model’;
- proprietor must be the same;
- priority must be claimed within 6 months of filing the first application;
- previous application must have been filed in a country where a right of priority can arise.

A priority claim in respect of the contested RCD will be examined *ex officio* by the Invalidity Division during invalidity proceedings when the outcome of the invalidity case depends on whether priority was validly claimed.

If the priority claim does not satisfy all of the substantive requirements, the holder concerned will be invited to make observations within the time limit set by the Office. If the validity of the priority claim cannot be verified, the priority cannot be taken into account for the purpose of the proceedings concerned. The decision on the priority claim can only be appealed together with the final decision on the invalidity proceedings.

Obsolete

The previous application is a first filing

As a matter of principle, the previous application must be a first filing. The Invalidity Division will therefore check that the priority document does not refer to priority being claimed in respect of an even earlier application.

As an exception, a subsequent application for a design that was the subject of a previous first application and has been filed in or for the same state, will be considered as a first application for the purpose of determining priority, provided that, at the date of filing of the subsequent application, the previous application had been withdrawn, abandoned or refused without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The previous application may not thereafter serve as a basis for claiming a right of priority (Article 41(4) CDR).

The previous application concerns a design or a utility model

The priority of a previous design or utility model application may be claimed, including that of a previous Community design or an international design registration.

Many national laws do not provide for the protection of utility models, for example the laws of the United States of America. In the European Union, utility models can be registered in, inter alia, the Czech Republic, Denmark, Germany, Spain, Italy, Hungary, Austria, Poland, Portugal, Slovakia and Finland. Utility models can be also be registered in Japan.

A priority claim based on a previous **patent** application will in principle be rejected. However, the priority of an international application filed under the Patent Cooperation Treaty (PCT) can be claimed, since Article 2 of the PCT defines the term ‘patent’ in a broad sense that covers utility models.

A priority claim can be based on a previous application filed with the United States Patent and Trademark Office (USPTO) only if the subject matter of the previous application relates to a ‘design patent’, not a ‘patent’.

The Community design relates to the ‘same design or utility model’

The subject matter of the previous application must be identical to that of the corresponding Community design, without the addition or deletion of any features.

According to Article 5(2) CDR, the subject matter is considered to be identical if the Community design and the previous application for a design right or a utility model differ only in details that can be qualified as ‘immaterial’.

The identity of the subject matter may not be affected when, on account of diverging formal requirements, the representation of the design as shown in the previous application has to be altered in order to be filed as a Community design (15/05/2013, ICD No 8 683).

The proprietor is the same

Priority can be claimed by the applicant of the first application or its successor in title. In the latter case, the first application must have been transferred prior to the filing date of the Community design application, and documentation to this effect must be submitted.

Obsolete

The right of priority as such may be transferred independently of the first application. Priority can therefore be accepted even if the holders of the Community design and the previous application are different, provided that evidence of assignment of the priority right is submitted. In this case, the execution date of the assignment must be prior to the filing date of the Community design application.

Subsidiary or associated companies of the applicant are not considered to be the same legal entity as the Community design applicant itself.

Priority is claimed within 6 months of filing the first application

The Invalidity Division will examine whether the date of filing allocated to the Community design is within 6 months of the filing date of the first application. Community design applicants should note that the date of **filing** allocated by the Office may not always correspond to the date of **receipt** of the Community design application.

The priority right claimed must always be a previous application, which, for this very reason, cannot bear the same date as the Community design application.

The previous application was filed in a country where a right of priority can arise

The 'convention priority' right is a right limited in time, which is triggered by the first regular filing of a design. A regular national filing is any filing that is 'adequate to establish the date on which the application was filed in the country concerned, whatever the subsequent fate of the application' (Article 4A(3) Paris Convention). It may be claimed during the 6 months following the first filing, provided the country of first filing was a party to the Paris Convention or to the Agreement establishing the World Trade Organisation (WTO), or a country with a reciprocity agreement (see Article 34(5) to (7) EUTMR **–** publication on reciprocity by the Commission).

The states and other entities mentioned below, inter alia, are not members of any of the relevant conventions. Nor do they benefit from reciprocity agreements. Therefore, priority claims based on filings in these countries will be **rejected**.

Independent states (not party to the Paris Convention, WTO or reciprocity agreement):

Afghanistan (AF)

Aruba (AW)

Cook Islands (CK)

Eritrea (ER)

Ethiopia (ET)

Kiribati (KI)

Marshall Islands (MH)

Micronesia (FM)

Nauru (NR)

Palau (PW)

Somalia (SO)

Tuvalu (TV)

Obsolete

Other entities (not party to the Paris Convention, WTO or reciprocity agreement):

Abkhazia (GE-AB)

American Samoa (AS)

Anguilla (AI)

Bermuda (BM)

Cayman Islands (KY)

Falkland Islands (FK)

Guernsey (GG)

Isle of Man (IM)

Jersey (JE)

Montserrat (MS)

Pitcairn Islands (PN)

Saint Helena (SH)

Turks and Caicos Islands (TC)

British Virgin Islands (VG)

6.2.1.2 Exhibition priority

Obsolete

General principles

The effect of exhibition priority is that the date on which the design was displayed at an officially recognised exhibition is deemed to be the date of filing of the application for a registered Community design for the purposes of Articles 5, 6, 7 and 22, Article 25(1)(d) and Article 50(1) CDR (Article 43 CDR).

The applicant can claim exhibition priority within 6 months of the first display. Evidence of the display must be filed (Article 44(1) and (2) CDR).

Exhibition priority cannot extend the 6-month period of 'Convention priority' (Article 44(3) CDR).

Claiming exhibition priority

Similar to 'Convention priority' (see paragraph 6.2.1.1 above), exhibition priority can be claimed either when filing a Community design application or subsequently. Where the applicant wishes to claim exhibition priority after having filed an application, the declaration of priority, indicating the name of the exhibition and the date of first display of the product, must be submitted within 1 month of the filing date (Article 9(2) CDIR).

The applicant must, within 3 months of the filing date or receipt of the declaration of priority, provide the Office with a certificate issued at the exhibition by the responsible authority. This certificate must state that the design was disclosed at the exhibition, specify the opening date of the exhibition and, where first public use did not coincide with the opening date of the exhibition, the date of first public use. The certificate must

be accompanied by identification of the actual disclosure of the product in which the design is incorporated, duly certified by the authority (Article 9(1) and (2) CDIR).

Priority can only be granted where the application for a Community design is filed within 6 months of first display at an exhibition recognised for this purpose, namely a world exhibition within the meaning of the Convention relating to International Exhibitions signed in Paris on 22/11/1928. These exhibitions are rare and Article 44 CDR does not cover display at other, national or international, exhibitions. The exhibitions can be found on the website of the Paris 'Bureau International des Expositions': http://www.bie-paris.org/site/en/.

Deficiencies

The Office will limit itself to verifying whether the following requirements of an exhibition priority claim have been satisfied (Article 45(2)(d) CDR), that is,

- whether the filing date of the Community design falls within the 6-month period following the first display of the product;
- whether priority was claimed when filing the application or within 1 month of the filing date;
- whether the application or the subsequent declaration of priority gives details of the name of the exhibition and the date of first display of the product;
- whether the exhibition was a world exhibition within the meaning of the Convention relating to International Exhibitions of 22/11/1928;
- whether the certificate issued at the exhibition by the responsible authority was submitted in due time;
- whether the proprietor named in this certificate is the same as the applicant.

Where remediable deficiencies are found, the examiner will request the applicant to remedy them within a time limit no shorter than the 3-month time limit for submitting the certificate referred to above.

If the deficiencies are not remediable or are not remedied in due time, the Office will inform the applicant of the loss of the priority right and of the possibility of requesting a formal (i.e. appealable) decision on that loss (Article 46(1) and (4) CDR; Article 40(2) CDIR).

If the deficiency concerns only some of the designs contained in a multiple application, the right of priority will be lost in respect only of the individual designs concerned (Article 10(8) CDIR).

Obsolete

6.2.2 Description

The application may include a description not exceeding 100 words explaining the representation of the design or the specimen (see paragraph 3.3.5 above). The description must relate only to those features that appear in the reproductions of the design or the specimen. It may not contain statements concerning the purported novelty or individual character of the design or its technical value (Article 1(2)(a) CDIR).

Apart from these requirements, the Office will not examine whether the description accords with the representation of the design or the specimen.

The description does not affect the scope of protection of a Community design as such (Article 36(6) CDR; 21/06/2017, T-286/16, Toilettensitze (Teil von -), EU:T:2017:411, § 44). It cannot substitute visual disclaimers to exclude features from protection (see paragraph 5.4 above).

The description may, however, clarify the nature or purpose of some features of the design in order to avoid a possible objection. For instance, where different views of the same design display different colours, thus raising doubts as to consistency between them (see paragraph 5.2.3 above), the description may explain that the colours of the design change when the product in which this design is incorporated is in use.

Descriptions submitted after the date of filing of the application will not be accepted.

The Register will include a mention that a description has been filed, but the description as such will not be translated or published. However, the description will remain part of the administrative file of the application and will be open to public inspection by third parties under the conditions set out in Article 74 CDR and Articles 74 and 75 CDIR.

6.2.3 Indication of the Locarno Classification

6.2.3.1 General principles

The applicant may itself identify the classification, in accordance with the Locarno Classification, of the products indicated in the application (see paragraph 6.1.4 above).

If the applicant provides a classification, the products must be grouped in accordance with the classes of the Locarno Classification, each group being preceded by the number of the relevant class, and presented in the order of the classes and subclasses (Article 3 CDIR).

Use of the harmonised database of product indications (Locarno product indications and those accepted by EU-based IP offices and the EUIPO), which can be consulted through DesignClass when filing an RCD application online, will accelerate the examination procedure. The harmonised database of product indications is integrated into the EUIPO's design e-filing application.

Since classification is optional, no objection will be raised if the applicant does not submit a classification or does not group or sort the products as required, provided that no objection is raised with regard to the indication of products (paragraph 6.1.6 above). If no such objection is raised, the examiner will classify the products *ex officio* according to the Locarno Classification.

Where the applicant has indicated only the main class and no subclass, the examiner will assign the subclass that appears suitable in view of the design shown in the representation. For instance, where a design application indicates *packaging* in Class 9 of the Locarno Classification, and the design represents a bottle, the examiner will

Obsolete

assign subclass 09-01 (the heading of which is *bottles, flasks, pots, carboys, demijohns, and containers with dynamic dispensing means*).

Where the applicant has given the wrong classification, the examiner will assign the correct one *ex officio*.

Products that combine different elements so as to perform more than one function will be classified in as many classes and subclasses as the number of purposes served. For instance, the product indication *refrigerating boxes with radios and CD players* will be classified under Classes 14-01 (*equipment for the recording or reproduction of sounds or pictures*), 14-03 (*communications equipment, wireless remote controls and radio amplifiers*) and 15-07 (*refrigeration machinery and apparatus*) of the Locarno Classification.

6.2.3.2 Multiple applications and the requirement of `unity of class'

If the same product indication applies to all designs contained in a multiple application, the relevant box ‘Same indication of product for all designs’ should be ticked in the (paper) application form and the field ‘Indication of product’ left blank for the subsequent designs.

Where several designs other than ornamentation are combined in a multiple application, the application will be divided if the products in which the designs are intended to be incorporated or to which they are intended to be applied belong to more than one class of the Locarno Classification (Article 37(1) CDR); Article 2(2) CDIR; see paragraph 7.2.3 below).

6.2.4 Citation of the designer(s)

The application may include:

1. a citation of the designer(s), or
2. a collective designation for a team of designers, or
3. an indication that the designer(s) or team of designers has/have waived the right to be cited (Article 18 CDR; Article 1(2)(d) CDIR).

The citation, the waiver and an indication regarding the designer(s) are merely optional and are not subject to examination.

If the designer or the team of designers is the same for all designs applied for in a multiple application, this should be indicated by ticking the box ‘Same designer for all designs’ in the (paper) application form.

Since the right to be cited as the designer is not limited in time, the designer’s name can also be entered into the Register after registration of the design (Article 69(2)(j) CDIR).

Obsolete

6.2.5 Request for deferment

6.2.5.1 General principles

The applicant for a registered Community design may, **when filing the application**, request that its publication be deferred for **30 months** from the date of filing or, if a priority is claimed, from the date of priority (Article 50(1) CDR).

Where no deficiency is found, the Community design will be registered. The information published in Part A.2 of the *Community Designs Bulletin* consists of the file number, date of filing, date of entry in the Register, registration number, name and address of the holder, and name and business address of the representative (if applicable). No other particulars, such as the representation of the design or the indication of products, are published (Article 14(3) CDIR).

Nevertheless, third parties may inspect the entire file if they have obtained the applicant's prior approval or if they can establish a legitimate interest (Article 74(1) and (2) CDR).

In particular, there is a legitimate interest where an interested person submits evidence that the holder of the registered Community design whose publication is deferred has taken steps with a view to invoking the right against them.

No registration certificate will be made available as long as the publication of a design is deferred. However, the holder of the design registration subject to deferment may request a certified or uncertified extract from the register, containing the representation of the design or other particulars identifying its appearance (Article 73(b) CDIR), for the purpose of invoking its rights against third parties (Article 50(6) CDR). For more information on obtaining certified extracts from the register, see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files.

The procedure described in this section does **not** apply to international registrations designating the European Union (see paragraph 12 below).

6.2.5.2 Request for deferment

Deferment of publication must be requested in the application (Article 50(1) CDR). Subsequent requests will not be accepted, even if received on the same day.

Applicants should be aware that designs can be registered and accepted for publication within two working days and even sometimes on the day that the application is received (see paragraph 2.7.1 above). If, by mistake, an application does not contain a request for deferment, the application should be withdrawn in order to prevent publication. Given the speed of the registration and publication processes, this should be done **immediately** after filing. The applicant should also contact an examiner on the day of the withdrawal.

A request for deferment of publication may concern only some of the designs of a multiple application. In this case, the designs to be deferred must be clearly identified

Obsolete

by ticking the box 'Request for deferment of publication' on the (paper) form or the box 'Publication to be deferred' (e-filing) for each individual design.

The applicant must pay a fee for deferment of publication along with the registration fee (see paragraph 8 below). Payment of the publication fee is optional at the filing stage.

6.2.5.3 Request for publication

When applying, or at the latest **3 months before the 30-month period expires**, the applicant must comply with what are known as the 'publication request requirements' (Article 15 CDIR), by:

- paying the publication fee for the design(s) to be deferred (see paragraph 8);
- in cases where a representation of the design has been replaced by a specimen in accordance with Article 5 CDIR (see paragraph 3.3.5 above), filing a representation of the design in accordance with Article 4 CDIR (see paragraph 5 above);
- in the case of a multiple registration, clearly indicating which of the designs among those identified for deferment are to be published or surrendered, or for which designs deferment is to be continued, as the case may be.

Where the Community design holder notifies the Office, **any time before 27 months have expired**, of its wish to have the design(s) published ('request for anticipated publication'), it must specify whether publication should take place as soon as technically possible (Article 16(1) CDIR) or when the 30-month deferment period expires. Where there is no specific request from the applicant, the designs will be published when the deferment period expires.

If the holder, despite a previous request for publication, decides that the design should not be published after all, it must submit a written request for surrender well before the design is due to be published. Any publication fees already paid will not be refunded.

6.2.5.4 Observation of time limits

Community design holders should be aware that the Office will not issue reminders regarding the expiry of the 27-month period before which the publication request requirements must be complied with. It is therefore the applicant's responsibility to make sure that the time limits are observed.

Particular attention must be paid where a priority date was claimed either at the time of filing or afterwards, since this priority date will determine the time limits applicable to deferment. Moreover, the time limits applicable to deferment may differ for each of the designs of a multiple registration, if different priority dates are claimed for each individual design.

Where the time limit for complying with 'the publication request requirements' is not met, thus resulting in a loss of rights, the Community design holder may file a request for *restitutio in integrum* (Article 67 CDR; see also the Guidelines, Part A, General Rules, Section 8, *Restitutio in Integrum*).

Obsolete

6.2.5.5 Deficiencies

Deficiencies at the examination stage

If the information contained in the application is contradictory (e.g. the deferment fee has been paid, but the applicant has not ticked the box 'Request for deferment of publication') or inconsistent (e.g. the amount of the deferment fees paid for a multiple application does not correspond to the number of designs to be deferred), the examiner will issue a deficiency letter asking the applicant to confirm that deferment is requested and, where applicable, for which specific design(s) of a multiple application, and/or to pay the corresponding fees.

Deficiencies relating to the 'publication request requirements'

If, 27 months after the filing date or priority date of the Community design registration, the holder has failed to comply with the 'publication request requirements', the examiner will issue a deficiency letter giving 2 months for the deficiencies to be remedied (Article 15(2) CDIR).

Where a deficiency concerns the payment of publication fees, the applicant will be requested to pay the correct amount plus fees for late payment (i.e. EUR 30 for a design and, in the case of a multiple application, 25 % of the fees for publication for each additional design; Article 15(4) CDIR; Articles 8 and 10 of the Annex to the CDFR).

Applicants should be aware that the time limit set by the examiner cannot be extended beyond the 30-month period of deferment (Article 15(2) CDIR).

If deficiencies are not remedied within the set time limit, the registered Community design(s) to be deferred will be deemed from the outset not to have had the effects specified in the CDR (Article 15(3)(a) CDIR).

The examiner will notify the holder accordingly, after the 30-month period of deferment has expired.

In the case of a 'request for anticipated publication' (see paragraph 6.2.5.3 above), failure to comply with the publication request requirements will result in the request being deemed not to have been filed (Article 15(3)(b) CDIR). The publication fee will be refunded if it has already been paid. Where there are still more than 3 months before the 27-month period expires, the holder may, however, submit another request for publication.

Where the deficiency concerns a payment that is insufficient to cover the publication fees for all the designs that are to be deferred in a multiple application, including any fees for late payment, the designs not covered by the amount paid will be deemed from the outset not to have had the effects specified in the CDR. Unless the holder made it clear which designs were to be covered by the amount paid, the examiner will take the designs in consecutive numerical order (Article 15(4) CDIR).

Publication after deferment

Obsolete

Where there are no deficiencies or deficiencies have been overcome in due time, the registration will be published in Part A.1 of the *Community Designs Bulletin*.

The holder may request that only some of the designs of a multiple application are published.

Mention will be made in the publication of the fact that deferment was originally applied for and, where applicable, that a specimen was initially filed (Article 16 CDIR).

7 Multiple Applications

7.1 General principles

A multiple application is a request for the registration of more than one design within the same application. Each of the designs contained in a multiple application or registration is examined and dealt with separately. In particular, each design may, separately, be enforced, be licensed, be the subject of a right *in rem*, a levy of execution or insolvency proceedings, be surrendered, renewed or assigned, be the subject of deferred publication or be declared invalid (Article 37(4) CDR).

Multiple applications are subject to specific registration and publication fees, which vary in proportion to the number of designs (see paragraph 8 below).

7.2 Formal requirements applying to multiple applications

7.2.1 General requirements

All the designs in a multiple application must have the same owner(s) and the same representative(s) (if any).

The number of designs contained in a multiple application is unlimited. The designs need not be related to one another or be otherwise similar in terms of appearance, nature or purpose. The designs must, however, meet the 'unity of class' requirement (see paragraph 7.2.3, below).

The number of designs should not be confused with the 'number of views' that represent the designs (see paragraph 5.1 above).

Applicants must number the designs contained in a multiple application consecutively, using Arabic numerals (Article 2(4) CDIR).

A suitable representation of each design contained in a multiple application must be provided (see paragraph 5 above) and an indication given of the product in which the design is intended to be incorporated or to be applied must be given (Article 2(3) CDIR, see paragraph 6.1.4 above).

Obsolete

7.2.2 Separate examination

Each of the designs contained in a multiple application is examined separately. If a deficiency concerning some of the designs contained in a multiple application is not remedied within the time limit set by the Office, the application will be refused only insofar as those designs are concerned (Article 10(8) CDIR).

The decisions on the registration or refusal of the designs contained in a multiple application will all be taken at the same time.

Even if some of the designs in a multiple application already comply with both the substantive and formal requirements, they will not be registered until any deficiencies affecting other designs have been remedied or the designs in question have been refused by the decision of an examiner.

7.2.3 The `unity of class' requirement

7.2.3.1 Principle

As a rule, **all the product(s) indicated for the designs** contained in a multiple application **must be classified in only one of the 32 Locarno classes.**

As an exception, the indication *ornamentation* or *product(s) X (ornamentation for -)* in Class 32-00 can be combined with indications of products belonging to another Locarno class.

7.2.3.2 Products other than ornamentation

The products indicated for each design in a multiple application may differ from those indicated for others.

However, except in cases of *ornamentation* (see paragraph 7.2.3.3 below), any products that are indicated for each and every design of a multiple application must belong to the same class of the Locarno Classification (Article 37(1) CDR; Article 2(2) CDIR). This ‘unity of class’ requirement is considered to be complied with even if the products belong to different subclasses of the same class of the Locarno Classification.

For instance, a multiple application is acceptable if it contains one design with the product indication *motor vehicles* (Class 12, subclass 08) and one design with the product indication *vehicle interiors* (Class 12, subclass 16). This is an example of two designs in different subclasses but in the same class, namely Class 12 of the Locarno Classification.

An objection would, however, be raised if, in the above example, the products indicated were *motor vehicles* (Class 12, subclass 08) and *lights for vehicles*, since the second term belongs to Class 26, subclass 06 of the Locarno Classification. The examiner

Obsolete

would then require the multiple application to be divided, as explained under paragraph 7.2.3.4 below.

A multiple application cannot be divided unless there is a deficiency affecting the 'unity of class' requirement (Article 37(4) CDR).

7.2.3.3 Ornamentation

Ornamentation is a decorative element capable of being applied to the surface of a variety of products. It can take the form of a pattern, including a moulding, engraving or carving in which the design stands out from a flat surface.

Although ornamentation is, in itself, a product within the meaning of the Locarno Classification (Class 32), its primary purpose is to constitute one of the features of other products. Therefore, representations of ornamentation should not include the product to which it will be applied, or they should disclaim the product (see paragraph 5.4 above).

A multiple application can therefore combine designs for ornamentation with designs for products such as those to which the ornamentation will be applied, provided that all the products belong to the same class of the Locarno Classification.

For some designs, the indication *ornamentation* or *product(s) X (ornamentation for)* in Class 32 of the Locarno Classification is neutral and therefore ignored for the purpose of examining whether the product indication for the remaining designs meets the 'unity of class' requirement.

The same reasoning applies to the following product indications in Class 32 of the Locarno Classification: *graphic symbols, logos* and *surface patterns*.

For example, a multiple application is acceptable if it combines designs for *ornamentation* or *china (ornamentation for)* in Class 32 with designs representing pieces of a tea set for *china* in Class 7, subclass 01. However, if, in addition, *linen (table -)* were indicated as a product for one of the designs in the same multiple application, an objection would be raised as this product belongs in Class 6, subclass 13 of the Locarno Classification, that is, a different class.

Where the applicant has indicated the product as *ornamentation* or *product(s) X (ornamentation for)*, the examiner will prima facie examine whether it is really for ornamentation by looking at the design in question. Where the examiner agrees that it is for ornamentation, the product will be classified in Class 32.

Where the examiner does not agree that the design is for ornamentation, the examiner will replace that product indication with the correct one on the grounds of an obvious mismatch between the products indicated and the design (see paragraph 6.1.4.4 above).

Where the representation of the design is not limited to ornamentation itself but also discloses the product to which such ornamentation is applied, without the contours of this product being disclaimed, the examiner will raise an objection and will suggest replacing the indication *ornamentation* with the product indication for the product

Obsolete

disclosed and the classification must be amended accordingly (see paragraph 6.1.4.4 above).

This may lead to an objection where a multiple application combines a number of such designs applied to products that belong to different classes of the Locarno Classification.

7.2.3.4 Deficiencies

Where a multiple application combines a number of designs applied to products that belong to different classes, or to more than one class of the Locarno Classification, a deficiency will be raised.

For example, let us assume that three designs representing cars are combined in one multiple application, and the product indication for each design is *motor cars* (subclass 12-08) and *scale models* (subclass 21-01).

The examiner will issue an objection and request the applicant to:

- delete some of the product indications so that the remaining products can be classified in only one Locarno class; or
- divide the application into two multiple applications for each of the Locarno classes concerned, and pay the corresponding additional fees; or
- divide the application into three single applications for each design concerned, and pay the corresponding additional fees.

In some cases, it will not be possible to delete product indications, for example where a given product must be classified in two or more classes on account of the plurality of purposes it serves (see paragraph 6.2.3.1 above).

The applicant will be invited to comply with the examiner's request within 2 months and pay the total amount of fees for all applications resulting from the division of the multiple application or to delete some products in order to meet the 'unity of class' requirement.

The total amount to be paid is calculated by the examiner and notified to the applicant in the examination report. The examiner proposes the most cost-effective option between dividing the multiple application into as many applications as Locarno classes concerned or as many applications as designs concerned.

Where the applicant does not remedy the deficiencies in due time, the multiple application is refused **in its entirety**.

Obsolete

8 Payment of Fees

8.1 General principles

Community design applications are subject to various fees, which the applicant must pay **at the time of filing** (Article 6(1) CDIR), including the registration fee and the

publication fee or, where the application includes a request for deferment of the publication, the deferment fee.

In the case of multiple applications, additional registration, publication or deferment fees must be paid for each additional design. If payment was not made when filing the application, late payment fees must also be paid.

In the case of deferment, applicants can, when filing, choose to pay not only the registration and deferment fee, but also the publication fee.

For the fee payable with respect to an international application designating the European Union see paragraph 12.1.2.4 below.

8.2 Currency and amounts

Fees must be paid in euros. Payments in other currencies are not accepted.

The fees for filing an application are as follows.

Registration fees

Single design or first design in a multiple application	EUR 230
2nd to 10th design in a multiple application	EUR 115 per design
11th+ design in a multiple application	EUR 50 per design

Publication fees

Single design or first design to be published in a multiple application	EUR 120
2nd to 10th design to be published in a multiple application	EUR 60 per design
11th+ design to be published in a multiple application	EUR 30 per design

Deferment fees (where deferment of publication is requested)

Single design or first design with deferment of publication in a multiple application	EUR 40
2nd to 10th design with deferment of publication in a multiple application	EUR 20 per design

Obsolete

11th+ design with deferment of publication in a multiple application	EUR 10 per design

Example of fees due for the filing of a multiple application where the publication of only some designs is to be deferred

Design number	Deferment	Registration fee	Publication fee	Deferment fee
xx xxx xxx-0001	Yes	EUR 230	-	EUR 40
xx xxx xxx-0002	Yes	EUR 115	-	EUR 20
xx xxx xxx-0003	No	EUR 115	EUR 120	-
xx xxx xxx-0004	No	EUR 115	EUR 60	-
xx xxx xxx-0005	No	EUR 115	EUR 60	-

If, after registration, publication is requested for design xxxxxxxx-0001, this will in effect be the fourth design to be published and the publication fee will be EUR 60.

8.3 Means of payment, details of the payment and refunds

The means of payment, the details to accompany the payment and the conditions for a refund of fees paid are explained in the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

Fees are refunded when the application is withdrawn or refused without a filing date having been granted (application 'not dealt with as a Community design application').

The Office also refunds amounts paid that are insufficient to cover the registration and publication (or deferment) fees for the design or at least one design of a multiple application.

9 Withdrawals and Corrections

9.1 Introduction

The applicant may at any time during the examination withdraw an application for a registered Community design or, in the case of a multiple application, withdraw some of the designs contained in the multiple application. Corrections are allowed only in some specific situations.

Obsolete

Any correction or change to the Register and/or publication, that is after the design has been registered by the examiner, must be dealt with in accordance with paragraph 11 below.

9.2 Withdrawal of the application

Prior to registration the applicant may at any time withdraw an application for a Community design or, in the case of a multiple application, withdraw some of the designs contained in the multiple application (Article 12(1) CDIR). The examiner will send confirmation of the withdrawal.

The 'date of withdrawal' is the date on which the Office receives the request for withdrawal.

Requests for withdrawal must be submitted in writing and include:

- the file number of the application for a registered Community design or, where the request for withdrawal is submitted before an application number has been allocated, any information enabling the application to be identified, such as the reference number of the applicant/representative and/or the provisional file number referred to in the automatic receipt for applications filed via the e-filing system;
- in the case of a multiple application, an indication of which design(s) the applicant wants to withdraw if not all are to be withdrawn; and
- the name and address of the applicant and/or, if applicable, the name and address of the representative.

Fees will only be refunded if no filing date has been granted, except where the amount of fees paid by the applicant is insufficient to cover the fees relating to registration and publication (or deferment as the case may be) for the design, or for at least one design of a multiple application.

Requests for withdrawal received by the Office on or after the date of registration of the design will be dealt with as requests for surrender (see paragraph 11.2.2 below).

Requests for withdrawal received by the Office on the filing date of the design application will be accepted even if the design is registered that same day.

9.3 Corrections to the application

9.3.1 Elements subject to correction

Only the name and address of the applicant or the representative, errors of wording or of copying, or obvious mistakes may be corrected, at the request of the applicant (Article 12(2) CDIR). Corrections in the name and address are not to be confused with a change of name, or a transfer (see the Guidelines Part E Register operations, Section 3 EUTMs and RCDs as objects of property, Chapter 1 Transfer).

Obsolete

Apart from the name and address of the applicant or representative, the following elements may be corrected at the applicant's request if they contain errors of wording or of copying or obvious mistakes:

- the date of filing, where the application was filed with the central industrial property office of a Member State or, in Benelux countries, with the BOIP, upon notification by the office concerned that an error regarding the date of receipt has been made;
- the name of the designer or team of designers;
- the second language;
- an indication of the product(s);
- the classification of the product(s) contained in the application;
- the country, date and number of the prior application where Convention priority is claimed;
- the name, place and date of the first exhibition of the design, where exhibition priority is claimed;
- the description.

9.3.2 Elements that cannot be corrected

As a matter of principle, the representation of the design(s) cannot be altered after the application has been filed (Article 12(2) CDIR). This also applies even if the altered representation is submitted on the same date. The submission of additional views or the withdrawal of any views at a later stage will not be accepted, unless expressly required or proposed by the Office (see paragraphs 5.3 and 5.6 above).

Where a request for correction amends the representation of the design(s), the applicant will be informed that its request is not acceptable. The applicant must decide whether it wishes to continue the registration process or to file a fresh application for which it will have to pay the applicable fees.

9.3.3 Procedure for requesting correction

A request for correction of the application must contain:

1. the file number of the application;
2. the name and address of the applicant;
3. where the applicant has appointed a representative, the name and business address of the representative;
4. an indication of the element of the application to be corrected and the corrected version of that element.

A single request may be made for correction of the same element in two or more applications belonging to the same applicant.

If all the requirements are met, the examiner will send confirmation of the correction.

For corrections and amendments see paragraph 11 below.

Obsolete

9.3.4 Deficiencies

Where a request for correction does not meet the above requirements and the deficiency found can be remedied, the examiner will invite the applicant to remedy the deficiency within 2 months. If the deficiency is not remedied in due time, the examiner will refuse the request for correction.

Requests for correction that would have the effect of amending the representation of the design(s) will be refused irremediably.

Descriptions submitted after the date of filing of the application are not accepted (see paragraph 6.2.2 above). Requests for correction that involve submitting a description for the first time after the date of filing of the application will therefore be refused.

10 Registration, Publication and Certificates

10.1 Registration

Once examination of grounds for non-registrability and formalities is completed, the examiner must ensure that all the particulars referred to in Article 14 CDIR have been provided (particulars that are mandatory for the applicant and that must be indicated in the application are in bold type):

1. the filing date of the application;
2. the file number of the application and of each individual design included in a multiple application;
3. the date of publication of the registration;
4. **the name, address and nationality of the applicant and the state in which it is domiciled or has its seat or establishment**;
5. **the name and business address of the representative**, other than an employee acting as representative in accordance with the first sentence of Article 77(3) CDR; where there is more than one representative, only the name and business address of the first-named representative, followed by the words 'et al.', will be recorded; where an association of representatives is appointed, only the name and business address of the association will be recorded;
6. **the representation of the design**;
7. **an indication of the product(s)** by name, preceded by the number(s) of and grouped according to the class(es) and subclass(es) of the Locarno Classification;
8. particulars of priority claims pursuant to Article 42 CDR;
9. particulars of exhibition priority claims pursuant to Article 44 CDR;
10. the citation of the designer or team of designers or a statement that the designer or team of designers has waived the right to be cited;
11. **the language in which the application was filed and the second language** indicated by the applicant pursuant to Article 98(2) CDR;

Obsolete

12. the date of registration of the design in the Register and the registration number;
13. a mention of any request for deferment of publication pursuant to Article 50(3) CDR, specifying the date of expiry of the period of deferment;
14. a mention that a specimen has been filed pursuant to Article 5 CDIR;
15. a mention that a description was filed pursuant to Article 1(2)(a) CDIR;
16. a mention that the representation of the design contains a verbal element.

Once all the particulars in the checklist are on file, the examiner will check whether all the applicable fees have been paid.

Where no deficiency is found, the application is registered.

10.2 Publication

All registered Community designs are published in the *Community Designs Bulletin*, which is published in electronic format only, on the Office's website.

However, international registrations designating the European Union are published by WIPO (*Hague Express Bulletin*) (see paragraph 12 below).

Unless an application contains a request for deferment of publication, publication will take place immediately after registration; publication is daily.

Where an application contains a request for deferment of publication, publication is made in Part A.2 of the *Community Designs Bulletin* and is limited to the following particulars: the design number, filing date, registration date and the names of the applicant and the representative, if any.

Where an application contains a request for deferment of publication for only some of the designs of a multiple application, only the designs for which deferment has not been requested are published in full.

10.3 Registration certificate

A registration certificate is issued after the registered Community design has been published in full (i.e. publication in Part A.1).

However, the Office does not issue registration certificates for international registrations designating the European Union (see paragraph 12 below).

Since 15/11/2010, registration certificates have been issued only as online e-certificates. Holders of Community design registrations are invited to download the certificate from the day after publication, using the 'eSearch plus' tool on the Office's website. No paper copy of the certificate of registration will be issued. However, certified or uncertified copies of the registration certificate may be requested.

The certificate contains all the particulars entered in the Community Designs Register at the date of registration. No new certificate is issued following changes made in the Register after the date of registration. However, an extract from the Register, which reflects the current administrative status of the design(s), may be requested. For more

Obsolete

information on obtaining certified extracts from the register, see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files.

A corrected certificate is issued after publication of a relative error detected in a design registration (Part A.3.2) or after publication of a relative error detected in a recordal (Part B.1.2). A relative error is an error attributable to the Office that modifies the scope of the registration.

11 Corrections and Changes in the Register and in the Publication of Community Design Registrations

11.1 Corrections

11.1.1 General principles

Only the name and address of the applicant, errors of wording or of copying, or obvious mistakes may be corrected, at the request of the applicant and provided that such correction does not change the representation of the design (Article 12(2) CDIR) (03/12/2013, R 1332/2013-3, Adapters, § 14 et seq.). There is no fee for such requests.

Where the registration of a design or the publication of the registration contains a mistake or error attributable to the Office, the Office will correct the error or mistake of its own motion or at the request of the holder (Article 20 CDIR). There is no fee for such requests.

A request for correction of mistakes made by the Office can only refer to the contents of the publication of the registration (Articles 49, 73 and 99 CDR and Articles 14 and 70 CDIR) and the entries in the Register (Articles 48, 72 and 99 CDR and Articles 13 and 69 CDIR).

Unless the Office itself made an error when publishing the representation of the design(s) (e.g. by distorting or truncating the representation), the holder will not be allowed to request the correction of its Community design if this has the effect of altering the representation (Article 12(2) CDIR) (03/12/2013, R 1332/2013-3, Adapters, § 14 et seq.).

Corrections will be made as soon as the mistake is detected, including, where necessary, years after the original entry in the Register.

11.1.2 The request for correction

According to Articles 12 and 19 CDIR, requests for the correction of mistakes and errors in the Register and in the publication of the registration must contain:

Obsolete

1. the registration number of the registered Community design;
2. the name and address of the holder as registered in the Register or the name of the holder and the identification number assigned to the holder by the Office;
3. where the holder has appointed a representative, the name and business address of the representative or the name of the representative and the identification number assigned to the representative by the Office; and
4. an indication of the entry in the Register and/or of the content of the publication of the registration to be corrected and the corrected version of the element in question.

A single request may be made for the correction of errors and mistakes in respect of two or more registrations belonging to the same holder (Article 19(4) CDIR and Article 20 CDIR).

If the requirements for such corrections are not fulfilled, the Office will inform the applicant of the deficiency. If the deficiency is not remedied within the 2 months specified by the Office, the request for correction will be refused (Article 19(5) CDIR and Article 20 CDIR).

Requests for the correction of mistakes or errors that are not entries in the Register and/or that do not concern the contents of the publication of registrations will be refused. Accordingly, requests for correction of the description explaining the representation of the design or the specimen will be refused.

Errors in the translation of the product indication into the official EU languages are considered attributable to the Office and will be corrected because the translations are considered as entries in the Register and as part of the contents of the publication of the registration, despite the fact that the translations are done not by the Office but by the Translation Centre for the Bodies of the European Union (Communication No 4/05 of the President of the Office concerning the correction of mistakes and errors in the Register and in the publication of the registration of Community designs).

In cases of doubt, the text in the Office language in which the application for a registered Community design was filed will be authentic (Article 99(3) CDR). If the application was filed in an official EU language other than one of the Office languages, the text in the second language indicated by the applicant will be authentic.

11.1.3 Publication of corrections

The holder will be notified of any changes in the Register (Article 69(5) CDIR).

Corrections will be published by the Office in Part A.3 of the *Community Designs Bulletin* and entered in the Register together with the date on which they were recorded (Article 20 CDIR and Article 69(3)(e) CDIR).

Where the mistake or error is attributable to the Office, the Office will, after publication of the mistake or error, issue the holder with a certificate of registration containing the entries in the Register (Article 69(2) CDIR) and a statement to the effect that those entries have been recorded in the Register (Article 17 CDIR).

Obsolete

In cases where the mistake or error is the holder's, a certificate of registration reflecting the corrected mistake or error will be issued only where no certificate has previously been issued. In any event, holders can always request the Office to issue an extract of the Register (in certified or simple form) to reflect the current status of their design(s). For more information on obtaining certified extracts from the register, see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files.

11.2 Changes in the Register

11.2.1 Introduction

This paragraph describes the changes in the Community Designs Register, as follows:

- surrender of a Community design with or without deferment, in particular partial surrender;
- changes in the name and/or address of the applicant/holder and/or of the representative, before registration of the Community design (i.e. before issue of the notification of registration);
- changes in the name and address of the holder and/or of the representative, where applicable, for a Community design with deferred publication that has not been published yet;
- recordal of transfers;
- recordal of licences.

11.2.2 Surrender of the registered Community design

11.2.2.1 General principles

A Community design may be surrendered by the holder at any time after registration. A surrender must be declared to the Office in writing (Article 51 CDR).

However, a request for renunciation of an international design designating the European Union must be filed with, and recorded by, the International Bureau (see Article 16 Geneva Act and paragraph 12.2.2.5 below) ([8]).

Surrender can also be declared for only some of the designs contained in a multiple registration (Article 27(1)(d) CDIR).

The effect of a declaration of surrender begins on the date on which the surrender is entered in the Community Designs Register, without any retroactive effect (Article 51(1) CDR). However, if a Community design for which publication has been deferred is surrendered, it will be deemed from the outset not to have had the effects specified in the CDR (Article 51(2) CDR).

8 The Hague Agreement Concerning the International Registration of Industrial Designs, Geneva Act of 02/07/1999.

Obsolete

A registered Community design may be partially surrendered provided that its amended form complies with the requirements for protection, and the identity of the design is retained (Article 51(3) CDR). Partial surrender will therefore be limited to cases in which the features removed or disclaimed do not contribute to the novelty or individual character of a Community design, in particular:

- where the Community design is incorporated in a product that constitutes a component part of a complex product, and the features removed or disclaimed are invisible during normal use of this complex product (Article 4(2) CDR); or
- where the features removed or disclaimed are dictated by a function or for the purposes of interconnection (Article 8(1) and (2) CDR); or
- where the features removed or disclaimed are so insignificant in view of their size or importance that they are likely to go unnoticed.

The surrender will be entered in the Register only with the agreement of the proprietor of a right entered in the Register (Article 51(4) CDR). Persons having a registered right include the holders of a registered licence, the proprietors of a registered right *in rem*, the creditors of a registered levy of execution or the authority competent for a registered bankruptcy or similar procedures.

In the case of licences registered in the Community Designs Register, the surrender of a Community design is entered in the Register only upon receipt of evidence that the rights holder has informed licensee(s) of the surrender accordingly. The surrender is entered in the Register 3 months after the date on which the Office obtains proof that the holder has informed licensee(s) of the surrender accordingly, or earlier if proof is obtained of the licensee's(licensees') consent to the surrender (Article 51(4) CDR; Article 27(2) CDIR).

Where a claim relating to the entitlement to a registered Community design has been brought before a court pursuant to Article 15 CDR, the surrender is entered in the Register only with the agreement of the claimant (Article 27(3) CDIR).

11.2.2.2 Formal requirements for a declaration of surrender

The proprietor must declare the surrender to the Office in writing. The general rules for communication with the Office apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits).

The declaration of surrender may be filed in the language used for filing the application or in the second language.

However, when the declaration of surrender is filed using the form provided by the Office pursuant to Article 68 CDIR, according to Article 80(c) CDIR, the form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

A declaration of surrender must contain the particulars referred to in Article 27(1) CDIR:

1. the registration number of the registered Community design;
2. the name and address of the holder;

Obsolete

3. the name and business address of the representative, where appointed;
4. an indication of the designs for which the surrender is declared in the case of multiple registrations;
5. a representation of the amended design in accordance with Article 4 CDIR in the case of partial surrender.

If a declaration of surrender does not contain all the particulars listed above and does not fulfil all the above requirements the Office will notify the holder of the deficiencies and request that they be remedied within the prescribed time limit. Where the deficiencies are not remedied within the time limit, the surrender will not be entered in the Register and the Community design holder will be informed thereof in writing (Article 27(4) CDIR).

11.2.3 Changes in the name and/or address of the applicant/ holder and/or its representative

The Community design holder may request a recordal of the change of name or address in the Register by submitting a written request to the Office. Recordals of changes of name and/or address are free of charge.

The request for a recordal of a change of name or address in respect of an international design designating the European Union must be filed with the International Bureau (see Article 16 Geneva Act).

For the differences between a change of name and a transfer, see the Guidelines for Examination, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer.

A single request may be made for a change of name or address in respect of two or more registrations belonging to the same holder.

A request for a change of name or address by a Community design holder must contain:

1. the registration number of the Community design;
2. the holder's name and address as recorded in the Register or the holder's identification number;
3. an indication of the holder's name and address as changed;
4. the name and business address of the representative, where appointed.

If the above requirements are not fulfilled, the Office will send a deficiency letter. If the deficiency is not remedied within the specified time limit, the Office will refuse the request (Article 19(5) CDIR).

Changes of name and address for Community design applicants in connection with applications for Community designs are not entered in the Register but must be recorded in the files kept by the Office concerning Community design applications (Article 19(7) CDIR).

Changes in the holders of Community design registrations are published in Part B.2.2 of the *Community Designs Bulletin*, while transfers of rights are published in Part B.2.1.

Obsolete

Changes in the representatives are published in Part B.9 of the Community Designs Bulletin.

11.2.4 Transfers

A Community design registration may be transferred by the holder, and transfers are recorded upon request in the Register. However, the request for recording a transfer in respect of an international design designating the European Union must be filed with the International Bureau (see Article 16 Geneva Act).

The legal provisions contained in the CDR, CDIR and CDFR in respect of transfers correspond to the provisions in the EUTMR and EUTMIR respectively (see the Guidelines for Examination, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer).

The legal principles and procedure for the recordal of trade mark transfers apply *mutatis mutandis* to Community designs with the following particularities.

11.2.5 Licences

11.2.5.1 General principles

Community design registrations may be licensed by the holder and the licences recorded upon request in the Register. The provisions of the CDR and CDIR dealing with Community design licences (Articles 27, 32 and 33, and Article 51(4) CDR; Articles 24 and 25, and Article 27(2) CDIR) are almost identical to those in the EUTMR and EUTMIR (see the Guidelines for Examination, 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).

The legal principles and procedure for the recordal of licences in respect of European Union trade marks apply *mutatis mutandis* to Community designs (Article 24(1) CDIR) with the following particularities.

11.2.5.2 Registered Community designs

There is no use requirement in Community design law. Therefore, the issue of whether use by a licensee is use with the consent of the rights holder does not arise.

The CDR and CDIR require an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied (see paragraph 6.1.4 above). The recordal of a partial licence for only some of the products in which the design is intended to be incorporated or applied to is not possible.

Any limitations of the scope of the licence will therefore be disregarded by the Office, and the licence will be registered as if there were no such limitations.

Obsolete

11.2.5.3 Multiple applications for registered Community designs

An application for a registered Community design may take the form of a multiple application combining several designs (Article 37 CDR).

Each design contained in a multiple application may be licensed independently of the others (Article 24(1) CDIR).

11.2.5.4 Fees

The fee of EUR 200 for the recordal, transfer or cancellation of a licence applies per design, not per application, with a ceiling of EUR 1 000 if multiple requests are submitted in the same application (points 18 and 19 of the Annex to the CDFR).

Example 1

From a multiple application for 10 designs, 6 designs are licensed to the same licensee. The fee for registering the licences is EUR 1 000, provided that

- all six licences are included in a single registration request, or
- all the relevant requests are submitted on the same day.

The request may indicate that, for three of these six designs, the licence is an exclusive one, without this having any impact on the fees to be paid.

Example 2

From a multiple application for 10 designs, 5 designs are licensed to the same licensee. A licence is also granted for another design not contained in that multiple application. The fee is EUR 1 000, provided that:

- all six licences are included in a single registration request, or that all the relevant requests are submitted on the same day, and
- the holder of the Community design and the licensee are the same in all six cases.

11.2.6 Entitlement proceedings

Registered Community designs may be the subject of entitlement proceedings and subsequent changes in ownership (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, entitlement proceedings or similar proceedings).

Obsolete

12 International Registrations

This part of the Guidelines deals with the particularities of examining international registrations designating the European Union that result from applications filed with the International Bureau of the World Intellectual Property Organization (hereinafter referred to as ‘international registrations designating the EU’ and ‘the International

Bureau') under the Geneva Act of 02/07/1999 of the Hague Agreement Concerning the International Registration of Industrial Designs.

The following general overview merely serves to set the framework for the Office's role in the examination of international registrations designating the EU. It is therefore limited in scope and the rules and practices issued by WIPO in relation to international registrations prevail. A full review of the Hague System and how to apply under it can be found directly at https://www.wipo.int/hague/en/.

12.1 General overview of the Hague System

12.1.1 The Hague Agreement and the Geneva Act

The Hague Agreement is an international registration system that makes it possible to obtain protection for designs in a number of states and/or intergovernmental organisations, such as the European Union or the African Intellectual Property Organization, by means of a **single** international application filed with the International Bureau. Under the Hague Agreement, a single international application replaces a whole series of applications that, otherwise, would have had to be filed with different national intellectual property offices or intergovernmental organisations.

The Hague Agreement consists of two separate international treaties: the Hague Act (1960) and the Geneva Act (1999). Each Act has a different set of legal provisions, which are independent of one another.

International registrations designating the European Union are governed by the Geneva Act.

12.1.2 Procedure for filing international applications

12.1.2.1 Particularities

Unlike the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, the Geneva Act neither allows nor requires an international registration to be based on a previously filed Community or national design.

This means that the Office can only be a 'designated office', not an 'office of origin'. **International applications must therefore be filed directly with the International Bureau** (Article 106b CDR).

Furthermore, neither the Geneva Act nor the CDR provides procedures for transforming an international registration designating the EU into a Community or national design application(s) or for converting an international registration designating the EU into national design applications(s) of EU Member States and into designations of contracting parties to the Hague System, or for replacing Community or national

Obsolete

design registrations by an international registration designating the contracting party in question. Nor does the Geneva Act provide for the possibility of Subsequent Designation of the EU.

The Geneva Act and the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement (CR) contain specific rules, which may differ from those applicable to 'direct filings' of Community designs, that is, applications filed directly with the Office or via the central industrial property office of a Member State or, in Benelux countries, the BOIP (see paragraph 2.2.1 above). These specific rules relate, in particular, to i) entitlement to file an international application, ii) the contents of an international application, iii) fees and iv) publication and deferment of publication.

12.1.2.2 Entitlement to file an international application

To be entitled to file an application for international registration under the Geneva Act, an applicant must satisfy at least one of the following conditions:

1. be a national of a Contracting Party or a Member State of an intergovernmental organisation that is a Contracting Party, such as the European Union or the African Intellectual Property Organization, *or*
2. have a domicile or a habitual residence in the territory of a Contracting Party, *or*
3. have a real and effective industrial or commercial establishment in the territory of a Contracting Party.

12.1.2.3 Contents of an international registration designating the EU

The applicant can choose to file the international application in **English, French or Spanish** (Rule 6(1) CR) and electronically through the electronic filing (e-filing) interface available on the WIPO website (www.wipo.int/hague/en/e-filing.html) or using the official form available on the WIPO website (www.wipo.int/hague/en/forms/).

No prior national or regional application or registration is required.

An international application may include **up to 100 different designs**. All designs must, however, belong to the same class of the International Classification for Industrial Designs (the Locarno Classification).

It must, in particular, contain a reproduction of the industrial designs concerned, together with the designation of the contracting parties where protection is sought.

12.1.2.4 Fees for international registrations designating the EU

Three types of fees must be paid for an international application designating the European Union, namely: ([9])

- a basic fee;
- a publication fee;

9 See www.wipo.int/hague/en/fees. See www.wipo.int/hague/en/fees

Obsolete

- an individual designation fee, that is, EUR 62 per design, converted into Swiss francs (Article 106c CDR; Article 1a to the Annex of the CDFR; Rule 28 CR).

12.1.2.5 Publication and deferment of publication of international registrations designating the EU

As a general rule, publication in the *International Designs Bulletin* takes place 6 months after the international registration date.

An international application designating the EU may contain a request that the international registration be published immediately.

Where immediate publication is requested, publication will take place as soon as the necessary technical preparations have been carried out after the registration of the industrial design.

An international application may contain a request that publication of the design, or of **all** the designs contained in a multiple application, be deferred. The Geneva Act does not allow deferment of publication to be requested for only some of the designs contained in a multiple application (Article 11 Geneva Act).

The period of deferment of publication for an international application designating the European Union is 30 months from the filing date or, where priority is claimed, the priority date. The application will be published at the end of this 30-month period unless the holder submits a request for earlier publication to the International Bureau (Article 11 Geneva Act).

The procedure described in paragraph 6.2.5 above does **not** apply as the Office is not responsible for publishing international registrations designating the European Union.

12.2 The role of the International Bureau

When it receives an international application, the International Bureau checks that it complies with the prescribed **formal** requirements, such as those described under paragraphs 12.1.2.2 and 12.1.2.3 above, as well as those relating to the quality of the reproductions of the design(s), priority claims and the payment of the required fees. The applicant is informed of any deficiency, which must be corrected within the prescribed time limit of 3 months, failing which the international application is considered to be abandoned. All communications must be sent to the International Bureau.

Where an international application complies with the prescribed formal requirements, the International Bureau records it in the International Register and (unless deferment of publication has been requested (see paragraph 12.1.2.5 above)) publishes the corresponding registration in the *International Designs Bulletin*. Publication takes place electronically on the **WIPO** website and contains all relevant data concerning the international registration, including a reproduction of the design(s).

Obsolete

The International Bureau does not examine the novelty or individual character of the design and it is therefore not entitled to reject an international application on this, or any other, substantive ground.

The International Bureau notifies the international registration to all designated offices, which then have the option of refusing protection on substantive grounds.

The following changes, which may affect an international registration, may be recorded in the International Register:

1. change in name and address of the holder;
2. change in the ownership of the international registration (in respect of all or some of the designated contracting parties and/or in respect of all or some of the industrial designs);
3. renunciation of all the industrial designs, in respect of any or all of the designated contracting parties; and
4. limitation of some only of the industrial designs, in respect of any or all of the designated contracting parties.

A request for the recording of such changes **must be presented to the International Bureau** on the relevant official form and must be accompanied by the prescribed fees. Information concerning such changes is recorded in the International Register and is published in the Bulletin for the information of third parties.

12.3 The role of the Office as designated office

12.3.1 General overview

This section explains how international registrations designating the EU are dealt with by the Office from notification by the International Bureau through to the final decision to accept or refuse the designation of the European Union.

One of the main features of the Hague System lies in the possibility for the Office to refuse protection, in the territory of the EU, to an international registration designating the EU that does not fulfil the substantive conditions of protection provided for by its domestic legislation.

Such refusal, however, may not be issued on the grounds of non-compliance with formal requirements, since such requirements are to be considered as already having been satisfied following the examination carried out by the International Bureau.

Any refusal of protection by the Office must be notified to the International Bureau within 6 months from the publication of the international registration designating the EU on the WIPO website. Any refusal of protection will have effect for the entire territory of the EU.

In the event of a refusal, the applicant has the same remedies as he or she would have had if he or she had filed the application in question directly with the Office. The ensuing procedure takes place solely before the Office; an appeal against a refusal

Obsolete

must be submitted by the holder to the Boards of Appeal, within the time limit and in accordance with the conditions set out in the CDR and CDIR. The International Bureau is not involved in this procedure.

A refusal may be withdrawn, totally or partially. Such a withdrawal may also take the form of a statement to the effect that protection is granted to the industrial designs, or some of the industrial designs, that are the subject of the international registration designating the EU.

The main roles of the Office as designated office are:

- receipt of the information on the international registration designating the EU;
- examination of the grounds for non-registrability;
- examination of design invalidity applications against international registrations designating the EU.

It is important to note that priority may be claimed at the time of the international application only. The examination of the formal requirements of the priority claim for international applications is carried out by the International Bureau. The EUIPO does not examine priority or request supporting documents for international registrations designating the EU. Any document received by the Office will be archived with no effect on the grant of protection but may be relied upon in *inter partes* proceedings.

12.3.2 Receipt of the information on the international registration designating the EU

Communications between the Office and the International Bureau are by electronic means (Article 47(3) CDIR).

12.3.3 Grounds for non-registrability

Once the international registration designating the EU has been notified to the Office by the International Bureau, the rules laid down under Title XIa CDR and Article 11a CDIR (Examination of grounds for refusal) apply (Article 106a(1) CDR).

12.3.3.1 Compliance with the definition of a design, public policy and morality

An international registration designating the EU may not be refused on the grounds of non-compliance with **formal** requirements, since such requirements are to be considered as already satisfied following examination by the International Bureau.

The Office limits its examination to the two grounds for non-registrability (Article 11a CDIR). An international registration designating the EU will be refused if a design does not correspond to the definition in Article 3(a) CDR or if it is contrary to public policy or accepted principles of morality (Article 9 CDR) (see paragraph 4 above).

The examination of grounds for non-registrability for international registrations designating the EU will be carried out as if the design(s) had been applied for directly

Obsolete

with the Office. The time limits and other general procedural aspects governing the said examination are the same as those that apply in the case of design applications filed directly with the Office (see paragraphs 1.2.3 and 4.3 above).

12.3.3.2 Time limits

The Office must inform the International Bureau of any refusal of protection within **6 months** of publication of the international registration on the WIPO website (Article 11a(1) CDIR).

A provisional refusal must be reasoned and state the grounds on which refusal is based, and the holder of the international registration designating the EU must be given an opportunity to be heard (Article 106e(1) and (2) CDR).

Thus, within 2 months of the date of receipt of the notification of provisional refusal by the international registration holder, the latter will be given the opportunity to renounce the international registration for the EU (for all the designs in the registration), to limit the international registration to one or some of the designs for the European Union or to submit observations (Article 11a(2) CDIR).

The International Bureau will forward the notification of provisional refusal to the holder (or to its representative before WIPO if applicable). The holder must reply directly to the Office or, if applicable, through its representative (see paragraph 12.3.3.4 below).

For time-limit extensions, see paragraph 1.2.3 above.

12.3.3.3 Languages

An international application must be filed in English, French or Spanish (Rule 6(1) CR). The recording and publication of the international registration will indicate the language in which the international application was received by the International Bureau (Rule 6(2) CR). In practice, this language can be identified from the product indication (INID code 54): the first language used in the product indication is the language in which the international application was received by the International Bureau. The indications given in the other two languages are translations provided by the International Bureau (Rule 6(2) CR).

The language in which the international application was received by the International Bureau will be the first language of the EU designation and will therefore become the language of the examination proceedings (Article 98(1) and (3) CDR).

In all communications with the International Bureau, the Office will therefore use the language in which the international registration was filed.

If the holder wishes to communicate with the Office in a different Office language, it must supply a translation into the language in which the international registration was filed within 1 month of the date of submission of the original document (Article 98(3) CDR; Article 81(1) CDIR). If no translation is received within this time limit, the original document is deemed not to have been received by the Office.

Obsolete

12.3.3.4 Professional representation

In principle, the holder does not need to appoint a representative before the EUIPO. Holders outside the EEA are, however, required to be represented further to a provisional refusal (see the Guidelines, Part A, General Rules, Section 5, Professional Representation , and Articles 77 and 78 CDR).

If a non-EEA holder has appointed a representative before WIPO who also appears in the database of representatives maintained by the EUIPO, this representative will automatically be considered to be the holder's representative before the EUIPO.

If representation is mandatory under Article 77(2) CDR (see paragraph 2.5 above), where a non-EEA holder has not appointed a representative or has appointed a representative before WIPO who does not appear in the database of representatives maintained by the EUIPO, any notifications of provisional refusal or objection will contain an invitation to appoint a representative in compliance with Articles 77 and 78 CDR.

Where the holder has a WIPO representative **within** the EU who does not appear in the database of representatives maintained by the EUIPO, the EUIPO will inform this representative that if they wish to represent the holder before the EUIPO, they must specify the basis of their entitlement (i.e. whether they are a legal practitioner or professional representative within the meaning of Article 78(1)(a) or (b) or Article 78(4) CDR or an employee representative within the meaning of Article 77(3) CDR (see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation).

If the holder fails to appoint a representative within the specified time limit, the Office will refuse protection of the international registration (Article 11a(4) CDIR).

12.3.3.5 Renunciation and limitation

Where the holder renounces the entire international registration in the EU or limits it to one or some of the designs for the European Union, it must inform the International Bureau by way of recording procedure in accordance with Article 16(1)(iv) and (v) of the Geneva Act. The holder can inform the Office by submitting a corresponding statement (Article 11a(6) CDIR).

12.3.3.6 Grant of protection

Where the Office finds no grounds for refusing protection or where a provisional refusal is withdrawn, the Office must inform the International Bureau accordingly without delay.

12.3.3.7 Refusal

Where the holder does not renounce the international registration for the EU, does not limit it to one or some of the designs, does not submit observations that satisfy the Office within the specified time limit, or does not withdraw the application, the Office will

Obsolete

confirm its decision refusing protection for the international registration. If the refusal concerns only some of the designs contained in a multiple international registration, the Office will refuse the latter only insofar as those designs are concerned (Article 11(3) CDIR).

There is no legal provision in the CDR or CDIR allowing an applicant to request an amendment of the design in order to overcome an objection concerning an international registration. However, an applicant may renounce the designation of the European Union by addressing WIPO directly, which will then notify the Office.

The holder of the international registration has the same remedies available to it as it would have had if it had filed the design(s) in question directly with the Office. The ensuing procedure takes place solely at Office level. An appeal against a decision to refuse protection must be submitted by the holder to the Boards of Appeal within the time limit and in accordance with the conditions set out in Articles 55 to 60 CDR and Articles 34 to 37 CDIR (Article 11a(5) CDIR). The International Bureau is not involved in this procedure at all.

Once the decision to refuse or accept the international registration designating the EU is final, a final notification will be sent to the International Bureau, indicating whether the design(s) has/have been finally refused or accepted.

Where the final refusal relates to only some of the designs contained in a multiple application, the notification to the International Bureau will indicate which designs have been refused and which have been accepted.

12.4 Effects of international registrations

If no refusal is notified by the Office within 6 months of the publication of the international registration on the WIPO website, or if a notice of preliminary refusal is withdrawn, the international registration will, from the date of registration granted by the International Bureau, as referred to in Article 10(2) Geneva Act (Article 106a(2) CDR), have the same effect as if it had been applied for with, and registered by, the Office.

12.5 Invalidity applications against international registrations designating the EU

International registrations designating the EU can be subject to invalidity proceedings under the same conditions and procedural rules as ‘direct filings’ of Community designs (Article 106f CDR; see the Guidelines for Examination of Design Invalidity Applications). An application for a declaration of invalidity must be filed with the Office and clearly identify the international registration number including the contested design within a multiple registration. The contested design within a multiple registration can be clearly identified by indicating the views and the view numbers in which the contested design is registered or by adding an extension number of the particular design to the registration number. Since the language of filing of an international registration

Obsolete

designating the EU is necessarily an Office language, an application for a declaration of invalidity against such an international registration must be filed in this language (see paragraph 12.3.3.3 above).

The Office will notify the holder or their representative directly of any request for a declaration of invalidity. Where a non-EEA holder has not appointed a representative or has appointed a representative before WIPO who does not appear in the database of representatives maintained by the EUIPO, the Office will communicate with the holder directly and invite them to appoint a representative who can act before the Office. The holder must reply directly to the Office or, if applicable, through a representative who is on the Office's list in accordance with Article 78 CDR (see paragraph 2.5 above).

Where the Office declares the effects of an international registration invalid in the territory of the European Union, it must inform the International Bureau of its decision as soon as the latter becomes final (Article 106f(2) CDR; Article 71(3) CDIR).

12.6 Changes affecting international registrations

The International Register is kept at WIPO.

The procedures governing the renewal of international registrations and recordals of changes of name, transfers, renunciation or limitation of certain designs, registration for any or all of the designated contracting parties, or limitation of the registration to certain designs are dealt with by the International Bureau (see the Guidelines, Part E, Register Operations, Section 4, Renewal, paragraph 13; Articles 16 and 17 Geneva Act; Article 22a CDIR).

The EUIPO will not process requests for renewal or payments of renewal fees.

13 Enlargement and the Registered Community Design

This section discusses the rules relating to the accession of new Member States to the European Union and the consequences thereof for applicants for, and holders of, registered Community designs.

Ten new Member States joined the European Union on 01/05/2004 (the Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Slovenia and Slovakia), two on 01/01/2007 (Bulgaria and Romania) and one on 01/07/2013 (Croatia), bringing the number of Member States up to 28.

Article 110a CDR contains provisions relating to enlargement as regards registered Community designs. These provisions were inserted in the CDR when the EU was enlarged in 2004 and remain applicable for successive enlargements. The only modification to the text of the CDR is the addition of the names of the new Member States.

Obsolete

As far as registrability and validity of Community designs are concerned, the effects of the enlargement of the European Union on registered Community design rights are the following.

13.1 The automatic extension of the Community design to the territories of the new Member States

Pursuant to Article 110a(1) CDR, the effects of all Community design rights filed before 01/05/2004, 01/01/2007 or 01/07/2013 extend automatically to the territories of the Member States that acceded on those dates (Article 110a(1) CDR).

Extension is automatic in the sense that there are no administrative formalities and no extra fees. Moreover, it cannot be opposed by the Community design holder or any third party.

13.2 Other practical consequences

13.2.1 Filing with national offices

As from the enlargement date, Community design applications may also be filed through the industrial property office of the new Member State.

13.2.2 Professional representation

As from the accession date, applicants (as well as other parties to proceedings before the Office) that have their seat or domicile in a new Member State no longer need to be represented by a professional representative. As from the accession date, professional representatives from a new Member State may be entered on the list of professional representatives maintained by the Office pursuant to Article 78 CDR, and may then represent third parties before the Office.

13.2.3 First and second language

Since 01/01/2004 there have been nine new official EU languages, namely Czech, Estonian, Hungarian, Latvian, Lithuanian, Maltese, Polish, Slovak and Slovenian. A further two languages (Bulgarian and Romanian) were added on 01/01/2007 ([10]) and a further one (Croatian) on 01/07/2013.

These languages may be used as the first language only for Community design applications filed on or after the accession date concerned.

10 For Irish, see paragraph 2.4.

Obsolete

13.2.4 Translation

Community design applications with a filing date prior to the accession date, or existing Community design registrations, will neither be translated into, nor republished in the language of the new Member State(s). Community design applications filed after the accession date will be translated and published in all official EU languages.

13.3 Examination of grounds for non-registrability

The Office limits its examination of the substantive protection requirements to only two grounds for non-registrability (Article 47(1) CDR). An application will be refused if the design does not correspond to the definition given in Article 3(a) CDR or if it is contrary to public policy or to accepted principles of morality (Article 9 CDR) (see paragraph 4 above).

An application for a registered Community design cannot be refused on the basis of any of the grounds for non-registrability listed in Article 47(1) CDR if these grounds become applicable merely because of the accession of a new Member State (Article 110a(2) CDR).

Whether a Community design is in conformity with Article 3 CDR or complies with public order and accepted principles of morality is normally assessed without reference to any particular national or linguistic context.

However, where a Community design contains a word element that is offensive in a language that, as a result of the accession of a new Member State, becomes an official language of the European Union after the date of filing, the ground for non-registrability provided for under Article 9 CDR does not apply.

13.4 Immunity against cancellation actions based on grounds for invalidity that become applicable merely because of the accession of a new Member State

13.4.1 General principles

Community designs filed or registered before 01/05/2004, 01/01/2007 or 01/07/2013 will not be cancelled on the basis of grounds for invalidity that exist in one of the Member States acceding to the European Union on those dates if the ground for invalidity only became applicable as from the accession date in question (Article 110a(3) CDR). This is an expression of the need to respect acquired rights.

Not all grounds for invalidity set out in Article 25(1) CDR may become ‘applicable merely because of the accession of a new Member State’.

Obsolete

13.4.1.1 Grounds for invalidity that are applicable independently of the enlargement of the EU

The accession of a new Member State has no effect on the applicability of the following four grounds for invalidity. Article 110a(3) CDR therefore does not offer any protection against their application to Community designs filed before 01/05/2004, 01/01/2007 or 01/07/2013 respectively.

Non-visibility and functionality

The non-visibility of a Community design applied to a part of a complex product and the restrictions applying to features of a design that are solely dictated by technical function or the requirements of interconnection are grounds for invalidity that must be evaluated on the basis of the design itself and not of a factual situation that exists in any given Member State (Article 25(1)(b) CDR in conjunction with Articles 4 and 8 CDR).

Novelty and individual character

Under normal circumstances, lack of novelty or individual character of a Community design will not be affected by enlargement of the EU (Article 25(1)(b) CDR in conjunction with Articles 5 and 6 CDR).

The disclosure of a design prior to the filing or priority date of a Community design can destroy the latter's novelty or individual character, even if such disclosure took place in a country before the date of its accession to the EU. The sole requirement is that such disclosure could 'reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community' (Article 7(1) CDR).

Entitlement to the Community design

The fact that the holder is not entitled to the Community design as a result of a court decision is another ground for invalidity that is not affected by enlargement (Article 25(1)(c) CDR). Article 14 CDR does not impose any nationality requirement for the person claiming to be entitled to the Community design, nor does it require that the court decision originates from a court located in a Member State.

Improper use of one or more of the elements listed in Article 6*ter* of the Paris Convention

The invalidity ground of improper use of one or more of the elements listed in Article 6*ter* of the Paris Convention is not affected by enlargement of the EU either. There is no requirement for the sign of which use is prohibited to come from a Member State (Article 25(1)(g) CDR).

13.4.1.2 Grounds for invalidity resulting from enlargement of the EU

A Community design filed before 30/04/2004, 31/12/2006 or 30/06/2013 respectively cannot be invalidated on the basis of any of the five grounds for invalidity referred to below where any of these grounds becomes applicable as a result of the accession of a new Member State on those dates (Article 110a(3) CDR).

Obsolete

Conflict with a prior design right protected in a new Member State (Article 25(1)(d) CDR)

A Community design filed before the date of accession of a Member State cannot be invalidated on the basis of a conflict with an earlier design that has enjoyed protection in the new Member State since a date prior to the filing or priority date of the Community design but that was disclosed to the public at a later date.

Use of an earlier distinctive sign (Article 25(1)(e) CDR)

A Community design filed before the date of accession of a Member State cannot be invalidated on account of the use of a distinctive sign that has enjoyed protection in the new Member State since a date prior to the filing or priority date of the Community design.

Unauthorised use of a work protected under the copyright law of a Member State (Article 25(1)(f) CDR)

A Community design filed before the date of accession of a Member State cannot be invalidated on account of the non-authorised use of a work that has been protected by the copyright law of the new Member State since a date prior to the filing or priority date of the Community design.

Improper use of signs, emblems, coats of arms, other than those covered by Article 6*ter* of the Paris Convention (Article 25(1)(g) CDR)

A Community design filed before the date of accession of a Member State cannot be invalidated on account of the improper use of signs, emblems or coats of arms, other than those covered by Article 6*ter* of the Paris Convention, which are of particular public interest for the new Member State.

Public policy and morality

A Community design filed before the date of accession of a new Member State cannot be invalidated on account of being contrary to public policy or morality in the territory of the new Member State.

13.4.2 Effects of a priority claim

Community designs with a filing date on or after 01/05/2004, 01/01/2007 or 01/07/2013 respectively may be invalidated on the basis of the five grounds mentioned above.

This applies even if the priority date of the Community design in question precedes the relevant accession date. The priority right does not protect the Community design holder against any change in the law that is applicable to the validity of its design.

Obsolete

GUIDELINES FOR EXAMINATION OF REGISTERED COMMUNITY DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Examination of design invalidity applications

Obsolete

Obsolete

1 Purpose

The purpose of these Guidelines is to explain how, in practice, the provisions of the Community Design Regulation ([11]) (CDR), the Community Design Implementing Regulation ([12]) (CDIR), and the Fees Regulation ([13]) (CDFR) are applied by the Invalidity Division of the EUIPO from receipt of an application for a declaration of invalidity of a Community design (application) up to the point of closure of the invalidity proceedings. Their purpose is also to ensure consistency among the decisions taken by the Invalidity Division and to ensure coherent practice in the treatment of the files. These Guidelines are not intended to, and cannot, add to or subtract from the legal contents of the Regulations.

2 Introduction - General Principles Applying to Invalidity Proceedings

2.1 Duty to state reasons

The decisions of the Invalidity Division must state the reasons on which they are based (Article 62 CDR). The reasoning must be logical and it must not disclose internal inconsistencies.

The Invalidity Division will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 1, Adequate Reasoning.

Obsolete

11 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs amended by Council Regulation No 1891/2006 of 18 December 2006 amending Regulations (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs.

12 Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2001 on Community designs amended by Commission Regulation (EC) No 876/2007 of 24 July 2007 amending Regulation (EC) No 2245/2002 implementing Council Regulation (EC) No 6/2002 on Community designs following the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs.

13 Commission Regulation (EC) No 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registrations of Community designs amended by Commission Regulation (EC) No 877/2007 of 24 July 2007 amending Regulation (EC) No 2246/2002 concerning the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) following the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs.

2.2 Right to be heard

The decisions of the Invalidity Division will 'be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments' (Article 62 CDR).

The Invalidity Division will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 2, The right to be heard.

2.3 Scope of the examination carried out by the Invalidity Division

In invalidity proceedings, the examination carried out by the Invalidity Division is restricted to the facts, evidence and arguments provided by the parties (Article 63(1) CDR). This does not preclude the Invalidity Division from taking into consideration well-known facts (16/02/2017, T-828/14 & T-829/14 , Radiatori per riscaldamento, EU:T:2017:87, § 90; the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 1, Adequate Reasoning).

The Invalidity Division must weigh the facts, evidence and arguments, adjudicate on their conclusiveness, and thereafter draw legal inferences from them without being bound by the points of agreement between the parties. Alleged facts that are not supported by evidence are not taken into account (12/02/2018, R 459/2016-G , Dishes, § 26).

Facts, evidence and arguments are three different items not to be confused with each other. For instance, the date of disclosure of an earlier design is a fact. Evidence of that fact could be the date of publication of a catalogue showing the earlier design together with evidence proving that the catalogue had been made available to the public before the date of filing or the priority date of the contested Community design. The applicant's argument could be that the earlier design forms an obstacle to the individual character of the contested Community design given the similar overall impression it produces on the informed user. Whether a Community design lacks individual character or not is not a fact but a legal question to be decided by the Invalidity Division on the basis of the facts, evidence and arguments submitted by the parties.

Expert reports or expert opinions and other statements in writing fall within the means of evidence referred to in Article 65(1)(c) and (f) CDR. However, the fact that they are procedurally admissible does not automatically mean that the statement is credible and will serve as proof of the facts to be proven. Rather, such statements must be critically examined as to the accuracy and correctness of the information, as well as whether they come from an independent source and/or are fettered or supported by written information (09/03/2012, T-450/08 , Phials, EU:T:2012:117, § 26).

Moreover, the legal criteria for applying a ground for invalidity are naturally part of the matters of law submitted for examination by the Invalidity Division. A matter of law may

Obsolete

have to be ruled on by the Invalidity Division, even when it has not been raised by the parties, if it is necessary to resolve that matter in order to ensure correct application of the CDR. The Invalidity Division will thus examine *ex officio* such matters of law that can be assessed independently of any factual background for the purpose of allowing or dismissing the parties' arguments, even if they have not put forward a view on those matters (see, by analogy, 01/02/2005, T-57/03 , Hooligan, EU:T:2005:29, § 21). Such matters of law will include, inter alia, the definition of the informed user and the degree of freedom of the designer within the meaning of Article 6 CDR.

2.4 Compliance with time limits

The Invalidity Division may disregard facts or evidence that are not submitted in due time by the parties concerned (Article 63(2) CDR).

Parties are reminded that they must submit the facts and evidence on which they rely in due time and within the time limits set by the Invalidity Division. Parties that fail to observe the time limits run the risk that the evidence may be disregarded. Parties have no unconditional right to have facts and evidence submitted out of time taken into consideration by the Invalidity Division.

Where the Invalidity Division exercises its discretion under Article 63(2) CDR, it must state reasons why the late facts and evidence are admissible or not, taking into consideration whether the material that has been submitted late is, on the face of it, likely to be relevant to the outcome of the invalidity proceedings brought before it and, second, whether the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (13/03/2007,C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 42-44; 05/07/2017,T-306/16, Door handles, EU:T:2017:466, § 15-18).

If the time limit is still running, the party may request an extension of the time limit, pursuant to Article 57(1) CDIR (see paragraph 4.1.6 below).

For general information on time limits, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

3 Filing of an Application

3.1 Form of the application

The Office recommends filing an application by e-filing through the User Area on the Office's website.

For other means of filing an application (Article 52 CDR), the Office provides a form (Article 68(1)(f) CDIR) that can be obtained upon request. Its use is strongly recommended (Article 68(6) CDIR) in order to facilitate the processing of the application and avoid errors. The completed form must be submitted by the applicant to

Obsolete

the Office by the statutory means of communication. If an application, including supporting documents, is filed other than by e-filing, it should be submitted in duplicate, in order that one set of documents can be kept in the Office's archive while the other is sent to the holder without any loss of quality due to copying. If an application is submitted in one set only, the Invalidity Division may invite the applicant to file a second set within a period of 1 month, or 2 months if the applicant does not have its domicile or its principal place of business or an establishment within the European Union (Article 57(1) CDIR).

3.2 Scope of the application

In invalidity proceedings, the relief sought by the applicant can only be the declaration of invalidity of the contested Community design as registered (Article 25 CDR).

Where contested Community designs are part of a multiple registration, each design must be contested individually and identified by reference to its full registration number (Article 37(4) CDR) or the numbering stipulated for multiple international applications respectively. A single application (and a common statement of grounds) may concern more than one Community design of a multiple registration. In such a case, the fee for the application must be paid for each contested Community design. However, for the sake of clarity, the Office recommends that separate applications be filed for each contested Community design.

3.3 Language of proceedings

The language regime in design invalidity proceedings is not the same as that governing trade mark proceedings, as explained below.

The application for a declaration of invalidity must be filed in the language of proceedings, which is the language used for filing the application for registering the contested Community design (language of filing), provided the language of filing is one of the five languages of the Office (Article 98 CDR; Article 29 CDIR).

If the language of filing is not one of the five languages of the Office, the language of proceedings is the second language indicated in the application for the contested Community design (Article 98(4) CDR; Article 29(1) CDIR).

As regards international registrations designating the European Union, the language of proceedings is the language in which the international application was filed (English, French or Spanish). The first language used in the product indication (INID code 54 of the internationally agreed numbers for the identification of (bibliographic) data) is the language in which the international application was filed at the International Bureau. In case of doubt, applicants for a declaration of invalidity are advised to check the language of filing of the international registration with the International Bureau.

Where the application for a declaration of invalidity is not filed in the language of proceedings, the Invalidity Division will request that the applicant submit a translation

Obsolete

within a period of 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 (Article 30(1) CDIR).

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 on the agreement must reach the Office within a period of 2 months of receipt by the holder of the official communication sent after the completion of the admissibility examination, pursuant to Article 31(1) CDIR (see paragraph 3.14 below). Where the application for a declaration of invalidity was not filed in that language, the applicant must, on its own motion, submit a translation of the application in that language within 1 month of the date on which the Office was informed of the agreement (Article 98(5) CDR; Article 29(6) CDIR). If these legal requirements are not met, the language of proceedings will remain unchanged.

For the linguistic regime applicable to the supporting documents, see paragraph 3.10.2 below.

3.4 Identification of the applicant

The application must contain an indication of the name and address of the applicant (Article 28(1)(c)(i) CDIR).

Where the information given in the application does not make it possible to identify the applicant unambiguously, and the deficiency is not remedied within 2 months of the Invalidity Division's request in that regard, the application must be rejected as inadmissible (Article 30(1) CDIR).

3.5 *Locus standi* of the applicant

Any natural or legal person, as well as a public authority empowered to do so, may submit an application for a declaration of invalidity of a Community design to the Invalidity Division based on Article 25(1)(a) and (b) CDR (Article 52(1) CDR).

However, where the ground for invalidity is lack of entitlement to the RCD pursuant to Article 25(1)(c) CDR, infringement of an earlier right, within the meaning of Article 25(1)(d) to (f) CDR, or improper use of flags and other symbols, within the meaning of Article 25(1)(g) CDR, an application for a declaration of invalidity is admissible only if the applicant is entitled to the earlier right or is affected by use of the symbol, as the case may be (Article 52(1) CDR). Entitlement will be examined on the basis of the international, national or European Union law that governs the earlier right or symbol in question.

For substantiation of the applicant's entitlement, see paragraph 3.10.2 below.

Obsolete

3.6 Representatives

As a matter of principle, the rules governing representation in European Union trade mark proceedings apply *mutatis mutandis* to invalidity proceedings for Community designs (see the Guidelines, Part A, General Rules, Section 5, Professional Representation).

3.7 Identification of the contested Community design

An application for a declaration of invalidity must contain the registration number of the contested Community design and the name and address of its holder, as entered in the Register (Article 28(1)(a) CDIR).

Where the information given by the applicant does not make it possible to identify the contested Community design unambiguously, the applicant will be requested to supply such information within a period of 2 months. If the applicant does not comply with this request, the application will be rejected as inadmissible (Article 30(1) CDIR).

3.8 Lapsed or surrendered registrations

A Community design may be declared invalid even after the Community design has lapsed or has been surrendered (Article 24(2) CDR).

Where the contested Community design has lapsed or has been surrendered on or before the date of filing of the application for a declaration of invalidity, the applicant will be requested to submit evidence, within a period of 2 months, that it has a legal interest in the declaration of invalidity. Where the applicant does not comply with the request, the application is rejected as inadmissible and the fees are not refunded (Article 30(1) CDIR) (16/06/2011, ICD No 8 231).

For instance, legal interest is established where the applicant proves that the holder of the contested Community design has taken steps with a view to invoking rights under the contested Community design against it.

Where the contested Community design has lapsed or has been surrendered in the course of the invalidity proceedings, the applicant will be asked to confirm whether it maintains its application within a period of 2 months and, if so, to submit reasons in support of its request in order to obtain a decision on the merits of the case.

The cases above have to be distinguished from invalidity actions directed against a Community design, which, at the filing date of the application for invalidity, has already been declared invalid by a final decision. In these cases, the later invalidity action is inadmissible and the fees are non-refundable.

Obsolete

3.9 Res judicata

An application for a declaration of invalidity is inadmissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a **Community design court** and has acquired the authority of a final decision (Article 52(3) CDR). Where this is the case, the invalidity applicant will be invited to comment on the finding before the application is rejected. The invalidity fee is non-refundable.

However, a final decision taken by the **Office**, which was not ruled on in substance by the court in previous invalidity proceedings between the same parties and having the same subject matter and cause of action, is not equivalent to a judgment issued by a Community design court regarding the effects laid down in Article 52(3)CDR (17/05/2018,T-760/16, Fahrradkörbe, EU:T:2018:277, § 29-34).

3.10 Statement of grounds, facts, evidence and arguments

The application must include an indication of the grounds on which the application is based (Article 52(2) CDR; Article 28(1)(b)(i) CDIR) together with a reasoned statement explaining the facts, evidence and arguments in support of those grounds (Article 28(1)(b)(vi) CDIR).

3.10.1 Statement of grounds

Where the applicant uses the form provided by the Office (Article 68(1)(f) CDIR), the indication of the grounds relied on is made by ticking one or several boxes in the field 'Grounds'.

Where the applicant does not use the form provided by the Office, an indication of the relevant subsection of Article 25(1) CDR, such as 'ground of Article 25(1)(a) CDR', will be considered an indication of the grounds invoked.

The Invalidity Division will examine the application in light of all the grounds put forward in the reasoned statement explaining the facts, evidence and arguments, even if the corresponding boxes in the application form used to lodge the action were not ticked.

Where the application form, together with the reasoned statement explaining the facts, evidence and arguments, does not make it possible to identify unambiguously the ground(s) on which the application is based, the applicant will be requested to provide further specifications in this respect within a period of 2 months. Where the applicant does not comply with the request, the application will be rejected as inadmissible (Article 30(1) CDIR).

Grounds for invalidity, other than those specifically relied on in the application, will be considered inadmissible when subsequently put forward before the Invalidity Division.

Obsolete

The Office strongly recommends that all grounds for invalidity be put forward in one single application. Where separate applications are lodged against the same contested Community design and based on different grounds, the Invalidity Division may deal with them in one set of proceedings. The Invalidity Division may subsequently decide to no longer deal with them in this way (Article 32(1) CDIR).

3.10.2 Facts, evidence and arguments

In proceedings relating to a declaration of invalidity, the Office is restricted in its examination to the facts, evidence and arguments submitted by the parties and the relief sought (Article 63(1) CDR).

As a matter of principle, all facts, evidence and arguments relied on in support of an application for a declaration of invalidity must be submitted together with the application.

The applicant must submit the following facts, evidence and arguments in support of the ground(s) on which the application is based (Article 28(1)(b)(vi) CDIR) for the application to be deemed admissible (Article 30(1) CDIR) - each ground must be supported by its own set of facts, evidence and arguments.

- Where the applicant claims that the contested Community design **lacks novelty or individual character (Article 25(1)(b) CDR)**, the application must contain a representation of the earlier design(s) that could form an obstacle to the novelty or individual character of the contested Community design, as well as documents proving the existence of the earlier design(s) (Article 28(1)(b)(v) CDIR).

  Article 28(1)(b)(v) CDIR requires that evidence of the existence and identification of the earlier design(s) be filed together with the application for a declaration of invalidity (and no later), so that the holder of the contested design can, without delay, take a position on the merits of the action. For this reason, it is a condition for the admissibility of the application for a declaration of invalidity (Article 30(1) CDIR ; 21/09/2017, C-361/15 P & C-405/15 P Shower drains, EU:C:2017:720, § 65).

  For more information on the particulars proving disclosure the applicant must comply with, see paragraph 5.7.1 Disclosure of the earlier design .

- Where the applicant claims that the holder is **not entitled to the contested Community design (Article 25(1)(c) CDR**, the application must contain particulars showing that the applicant is entitled to the contested Community design by virtue of a court decision (Article 28(1)(c)(iii) CDIR).

- Where the applicant claims that the contested Community design is in conflict with **a prior design (Article 25(1)(d) CDR)**, the prior design right must be identified. The application must contain a representation of and particulars identifying the prior design, including evidence of any priority claims. Furthermore, the application must contain evidence proving that the applicant is entitled to invoke the prior design as a ground for invalidity (Article 28(1)(b)(ii) CDIR).

Obsolete

- Where the applicant claims that the contested Community design infringes an **earlier right**, namely that it makes unauthorised use of a **distinctive sign** **(Article 25(1)(e) CDR)** or a work protected by **copyright** in a Member State **(Article 25(1)(f) CDR)**, the application must contain a representation and particulars identifying the distinctive sign or the work protected by copyright. Furthermore, the application must contain evidence proving that the applicant is the holder of the earlier right in question (Article 28(1)(b)(iii) CDIR).

  Where the earlier right invoked under Article 25(1)(d) or (e) CDR is **registered**, a distinction is to be made depending on whether the earlier right is an RCD, an EUTM or a different type of protected right.

  - If the earlier right is an RCD or an EUTM, the applicant does not have to submit any documents — examination of the existence will be based on the data contained in the Office's database.
  - In all other cases, the applicant must provide the Office with evidence of the existence, validity and scope of protection of the earlier right. The following documents will be accepted: 1) certificates issued by the competent registration authorities; 2) extracts from the official databases of the competent registration authorities; 3) extracts from official bulletins of the competent registration authorities. In addition, the Office accepts, as evidence for national marks/ designs and international registrations, extracts obtained through the Office's *TMview* portal (https://www.tmdn.org/tmview/welcome) and *DesignView* portal (https://www.tmdn.org/tmdsview-web/#/dsview). Extracts generated through *TMview* reflect the information obtained directly from the competent registration authorities and therefore qualify as documents equivalent to filing or registration certificates from the competent registration authorities within the meaning of Article 7(2)(a) EUTMDR, provided that the extract contains all the relevant information (06/12/2018, T-848/16, V (fig.) / V (fig.) et al., EU:T:2018:884, § 59-61, 70). The same applies, *mutatis mutandis*, to extracts generated through *DesignView*.

    Applicants must carefully check that the relevant official online database is up to date and contains all the relevant information necessary to prove the validity and scope of protection of the earlier right invoked in the application for invalidity. When the extract from an official database or the database accessed online does not contain all the information required, the applicant must supplement it with other documents from an official source that show the missing information.

  Where an earlier right is **pending registration**, the applicant must complete the file by submitting evidence of actual registration of the earlier right relied upon once registered. Until that time it is sufficient to submit a copy of the application with the stamp of the receiving office. If necessary, prior to making a decision, the Office may suspend the invalidity proceedings until it has received evidence of registration (see paragraph 4.1.6.2).

Obsolete

Where the earlier right invoked under Article 25(1)(e) or (f) CDR is **unregistered**, this condition will be considered to be complied with for the purpose of examining the admissibility of the application, where the applicant submits evidence that the earlier distinctive sign or the earlier work protected by copyright law has been used or disclosed, as the case may be, under the applicant's name before the date of filing or the priority date of the Community design (see paragraphs 5.7.3 and 5.8.1 for substantiation of the proprietorship of the earlier right relied on under Article 25(1)(e) and (f) CDR).

- Where the applicant claims that the contested Community design makes improper use of any of the items listed in **Article 6 *ter* of the Paris Convention** or of badges, emblems and escutcheons other than those covered by Article 6 *ter* and which are **of particular interest in a Member State (Article 25(1)(g) CDR)** , the application must contain a representation and particulars of the relevant item, and particulars showing that the application is filed by the person or entity affected by the improper use (Article 28(1)(b)(iv) CDIR).

If the applicant fails to submit, together with the application, all the particulars listed above, the Office will issue a deficiency letter requesting the facts, evidence and arguments. If the applicant does not comply with this request, the application will be rejected as inadmissible in whole or in part (in relation the the particular ground(s), design(s) or right(s) invoked) under Article 30(1) CDIR .

Unless the Office has sent a deficiency letter pursuant to Article 30(1) CDIR, new evidence concerning the indication and reproduction of the earlier design(s) or right(s) can no longer be submitted. Additional particulars or new grounds of invalidity submitted after the filing of the application will be rejected as inadmissible to the extent that they would broaden the scope of the original application for a declaration of invalidity (05/02/2016, R 2407/2014-3, Kitchen utensils, § 21; 22/10/2009, R 690/2007-3, Chaff cutters, § 44 et seq.).

Where the evidence in support of the application is not filed in the language of proceedings, the applicant must, on its own motion, submit a translation of that evidence into that language within 2 months of the filing of such evidence (Article 29(5) CDIR). The question whether certain parts of the supporting documents may be considered irrelevant for the application, and therefore not translated, is a matter for the discretion of the applicant. In cases where a translation is not submitted, the Invalidity Division may disregard the text portions of the evidence that are not translated and base its decision solely on the evidence before it that has been translated into the language of proceedings (Article 31(2) CDIR).

Documents in support of an application should be listed in a schedule of annexes appended to the application itself. As best practice, the schedule of annexes should indicate, for each document annexed, the number of the annex (Annex A.1, A.2, etc.), a short description of the document (e.g. 'letter') followed by its date, the author(s) and the number of pages, and the page reference and paragraph number in the submission where the document is mentioned and its relevance is described.

Obsolete

The documents annexed to a submission must be paginated. This is to ensure that all pages of the annexes have been duly scanned and communicated to the other parties.

An assessment on the **substance** of the above facts, evidence and arguments is carried out by the Invalidity Division at a later stage when a decision is taken.

3.10.3 Admissibility in respect of one of the grounds or the earlier rights relied on

An application based on more than one ground for invalidity, or more than one earlier right, is admissible if and insofar as the requirements regarding admissibility are satisfied for at least one of those grounds, or in relation to at least one earlier right.

The Invalidity Division assesses the facts, evidence and arguments on the merits of the case at a later stage when a decision is taken. If such a decision declaring the invalidity of the design cannot be taken on the basis of the earlier rights and/or grounds on which the application for invalidity was found admissible, the invalidity applicant will be invited to remedy the deficiencies concerning the remaining earlier rights or grounds when necessary within a period of 2 months. Where the applicant does not comply with the request, the application will be rejected as inadmissible (Article 30(1) CDIR) insofar as it is based on the ground and/or earlier right.

Where the ground and/or earlier right is admitted, the holder will be invited to submit observations in that respect before the decision on substance is taken.

The decision on admissibility of the invalidity application can be appealed together with the final decision terminating the proceedings (Article 66(2) EUTMR).

3.11 Signing the application

The application for a declaration of invalidity must be signed by the applicant or its representative if it has one (Article 65(1) CDIR).

Where the signature is missing, the Invalidity Division will request the applicant to remedy the deficiency within 2 months. If the applicant does not comply with the request, the application will be rejected as inadmissible (Article 30(1) CDIR).

3.12 Means of filing

An application for a declaration of invalidity may be filed with the Office by e-filing through the User Area on the Office's website (Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means), by post or by personal delivery (Decision No EX-18-5 of the Executive Director of the Office of 3 September 2018 concerning the hours the Office is open to receive submissions by personal delivery relating to RCDs).

Obsolete

Fax is expressly identified as a means of communication in all procedures relating to Community designs in Article 47(2)(d) CDIR and Article 51 CDIR. However, pursuant to Article 2 of Decision No EX-20-9 of the Executive Director on communication by electronic means, **fax can no longer be offered and will no longer be used**, as a means of communication in procedures before the Office, due to technical limitations and malfunctions affecting the reliability and preventing the uninterrupted functioning of communications by fax (and that lie beyond the Office's control).

In the event of a malfunction during the electronic transmission of an application, communication or other document through the specific e-operation or e-filing via the User Area, the Office has made two electronic backup alternatives available:

1. an upload solution located in the Communications section of the User Area; this is a general upload platform that allows documents to be attached and sent to the Office.
2. a file-sharing solution outside the User Area; the Office will provide the account holder with access to a secure file-sharing location where the document(s) in question can be uploaded.

Technical details on the accessibility and functionality of both backup alternatives are available in the Conditions of Use of the User Area.

3.13 Payment of fees

For general rules on payments, see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

An application for a declaration of invalidity will be deemed not to have been filed until the fee has been paid in full (Article 52(2) CDR; Articles 28(2) and 30(2) CDIR). Therefore, before examining the admissibility of the application, the Office will first check that the fee has been received.

Where the Office finds that the fee has not been paid, it will request that the applicant pay the fee within a period of 2 months of receipt of the notification. If the applicant does not comply with the request, the application is deemed not to have been filed and the applicant is informed accordingly. If the required fee is paid after the expiry of the time limit specified, it will be refunded to the applicant (Article 30(2) CDIR).

In cases where the fee is received after the expiry of the time limit specified by the Office but the applicant provides proof that, within the time limit, it duly gave an order to a banking establishment to transfer the amount of the payment in a Member State, Article 7(3) CDFR will be applied, including the payment of a surcharge where applicable (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

The filing date of an application for a declaration of invalidity is not affected by the date of payment of the fee since Article 52(2) CDR does not provide for any consequence as regards the filing date of the application. When the fee is paid before the expiry of the time limit specified by Article 30(2) CDIR, the application is deemed to have been filed and the filing date will be the date the application was received by the Office.

Obsolete

As a general principle, the invalidity fee is an application fee due for the filing of the application regardless of the outcome of the proceedings. Therefore, it will not be refunded if the application is rejected as inadmissible or withdrawn in the course of proceedings.

3.14 Deficiencies

Where the Invalidity Division finds the application inadmissible and the deficiency is not remedied within the specified time limit, the Invalidity Division will issue a decision rejecting the application as inadmissible (Article 30(1) CDIR). The fee will not be refunded.

3.15 Communication to the holder

When the application for a declaration of invalidity is submitted via e-filing, the RCD holder receives automated information about the filing as a simple measure of organisational procedure.

The notification of an application for a declaration of invalidity, constituting the decision on the admissibility of an application for a declaration of invalidity, is issued to the RCD holder only after the application has been found admissible (Article 31(1) CDIR). This decision can be appealed together with the final decision (Article 55(2) CDR).

The decision on admissibility may, however, be withdrawn, in accordance with the general principles of administrative and procedural law, if irregularities are detected *ex officio* by the Office, within a reasonable time, or by the RCD holder in its first observations (Article 31(1) CDIR), and if the applicant for invalidity fails to remedy such irregularities within the time limit prescribed by the Office (Article 30 CDIR) (Article 68 CDR and, by analogy, 18/10/2012,C-402/11 P, Redtube, EU:C:2012:649, § 59).

Where the Invalidity Division does not reject the application as inadmissible, the application is communicated to the holder and a time limit of 2 months for submitting observations in response to the application is granted (see below under paragraph 4.1.1).

3.16 Participation of an alleged infringer

As long as no final decision has been taken by the Invalidity Division, any third party that proves that proceedings for infringement based on the contested Community design have been instituted against it can join as a party to the invalidity proceedings (Article 54 CDR; Article 33 CDIR).

The alleged infringer must submit its request to be joined as a party within 3 months of the date on which the infringement proceedings were instituted. Unless proof is submitted by the holder that another date should be retained in accordance with the

Obsolete

national law in question, the Invalidity Division will assume that proceedings are 'instituted' on the date of service of the action to the alleged infringer. The alleged infringer must submit evidence in respect of the date of service of the action.

Any third party that proves that (i) the rights holder of the Community design has requested that it cease an alleged infringement of the design and that (ii) the third party in question has instituted proceedings for a court ruling that it is not infringing the registered Community design (if actions for declaration of non-infringement of Community designs are permitted under national law) may also join as a party in the invalidity proceedings (Article 54 and Article 81(b) CDR).

The request to be joined as a party must be submitted in a written reasoned statement and will not be deemed to have been submitted until the invalidity fee has been paid. The rules explained above in paragraphs 3.1 to 3.13 will apply to the alleged infringer (Article 54(2) CDR; Article 33 CDIR).

4 Adversarial Stage of the Proceedings

4.1 Exchange of communications

4.1.1 Observations by the holder

4.1.1.1 Generalities

The holder's observations will be communicated to the applicant without delay (Article 31(3) CDIR).

Documents in support of observations should be listed in a schedule of annexes (see paragraph 3.10.2 above).

The holder should submit its observations (including supporting documents) in duplicate when not using e-filing (see paragraph 3.1 above).

Where the holder submits no observations within the 2-month time limit, the Invalidity Division will notify the parties that the written phase of the proceedings is closed and that it will take a decision on the merits on the basis of the evidence before it (Article 31(2) CDIR).

4.1.1.2 Request for proof of use of an earlier trade mark

A request for proof of use of an earlier trade mark during the period of 5 years preceding the date of the application for a declaration of invalidity may be submitted by the holder if the following cumulative conditions are complied with:

- the application is based on Article 25(1)(e) CDR;

Obsolete

- the earlier distinctive sign is a (European Union, international or national) trade mark having effect in the European Union that, on the date of the application for a declaration of invalidity, has been registered for not less than 5 years;
- the request for proof of use is submitted together with the holder's first submission in response to the application (12/05/2010,T-148/08, Instruments for writing, EU:T:2010:190, § 66-72; 27/06/2013,T-608/11, Instruments for writing, EU:T:2013:334, § 87; 15/11/2013,R 1386/2012-3, CINTURONES, § 21).

4.1.2 Translation of the holder's observations

Where the language of proceedings is not the language of filing of the contested Community design, the holder may submit its observations in the language of filing (Article 98(4) CDR; Article 29(2) CDIR). The Invalidity Division will arrange to have those observations translated into the language of proceedings, free of charge, and will communicate the translations to the applicant without delay.

4.1.3 Scope of defence

The holder's observations must include an indication regarding the extent to which it defends the contested Community design. Where the holder does not give such an indication, it is assumed that it seeks maintenance of the Community design in the form as originally registered, that is, in its entirety.

Where the holder requests that the Community design be maintained in an amended form, the request must include the amended form. The amended form must comply with the requirements for protection, and the identity of the Community design must be retained. 'Maintenance' in an amended form may include registration accompanied by a partial disclaimer by the holder or entry in the Register of a court decision or a decision by the Invalidity Division declaring the partial invalidity of the Community design (Article 25(6) CDR) (see paragraph 5.10 below).

The request to maintain the contested Community design in an amended form must be submitted during the invalidity proceedings and before the end of the written phase. The applicant will be given the opportunity to comment on whether the Community design in its amended form complies with the requirements for protection and whether the identity of the Community design is retained.

The decision on the maintenance of the Community design in an amended form will be included in the decision on the merits terminating the invalidity proceedings.

Obsolete

4.1.4 Reply by the applicant

4.1.4.1 Generalities

Where the parties' submissions allow the Invalidity Division to base its decision on the evidence before it, the Invalidity Division will notify the parties that the written phase of the proceedings is closed.

However, the applicant will be allowed to reply to the holder's observations within a time limit of 2 months (Article 53(2) CDR; Article 31(3) CDIR) in particular under the following circumstances:

- where the holder's observations contain new facts, evidence and arguments that are prima facie relevant for a decision on the merits; or
- where the holder requests to maintain the Community design in an amended form; or
- where the holder requested proof of use of the earlier trade mark relied on under Article 25(1)(e) CDR.

Any reply from the applicant will be communicated to the holder (Article 31(4) CDIR). Where the applicant's reply is considered admissible, the holder will be invited to submit a rejoinder (Article 53(2) CDR).

Where the applicant does not reply within the specified time limit, the Invalidity Division will notify the parties that the written phase of the proceedings is closed and that it will take a decision on the merits on the basis of the evidence before it (Article 31(2) CDIR).

The subject matter of the proceedings must be defined in the application (see paragraph 3.10 above). Reliance on additional earlier designs and/or rights is inadmissible when submitted at the belated procedural stage of the reply if the effect is to alter the subject matter of the proceedings (22/03/2019, R 1283/2018-3, Goggles (part of-), § 18; 05/02/2016, R 2407/2014-3, Kitchen utensils, § 21; 22/10/2009, R 690/2007-3, Chaff cutters, § 44 et seq.). The admissibility of additional facts, evidence and arguments relating to earlier designs and/or rights already referred to in the application is subject to the discretionary powers conferred on the Invalidity Division under Article 63(2) CDR (see paragraph 2.4 above).

The applicant should submit its reply in duplicate when not using e-filing (see paragraph 3.1 above).

4.1.4.2 Translation of the applicant's reply

Any reply of the applicant must be in the language of proceedings. Where the applicant has been invited to reply and its reply is not in the language of proceedings, the applicant must submit, on its own motion, a translation of its reply within 1 month of the date of the submission of the original reply (Article 81(1) CDIR). The Invalidity Division will not remind the applicant of its duty in this respect. Where the applicant submits the

Obsolete

translation on time, it will be communicated to the holder. Where the applicant does not submit the translation on time, its reply will be deemed not to have been filed.

4.1.4.3 Submission of evidence of use of an earlier trade mark

Where the applicant is requested to submit evidence of use of its earlier trade mark, it must submit such evidence (i) in connection with the goods or services in respect of which this trade mark is registered, and which the applicant cites as justification for its application and (ii) in respect of the period of 5 years preceding the date of the application for a declaration of invalidity, unless there are proper reasons for non-use. Such reasons for non-use must be substantiated.

Evidence of use of an earlier mark must fulfil **all** the cumulative conditions imposed by Article 10(3) EUTMDR, that is, indications concerning **the place, time, extent** and **nature** of use of the earlier trade mark for the goods and services for which it is registered and on which the application is based.

Where the language of the documents submitted by the applicant is not the language of the proceedings, the Invalidity Division may require that a translation be supplied in that language, within 1 month, or 2 months if the applicant does not have its domicile or its principal place of business or an establishment within the European Union (Articles 57(1) and 81(2) CDIR).

In the absence of proof of genuine use of the earlier trade mark (unless there are proper reasons for non-use), or in the absence of a translation if so required by the Invalidity Division, the application for a declaration of invalidity will be rejected to the extent that it was based on Article 25(1)(e) CDR.

When examining the evidence of use, the Invalidity Division will apply the principles explained in the Guidelines, Part C, Opposition, Section 7, Proof of Use.

4.1.5 End of exchange of observations

Where the parties' observations do not contain new facts, evidence or arguments that are prima facie relevant for a decision on the merits, and additional observations are not necessary, the Invalidity Division will inform both parties that the written proceedings are closed and that a decision will be taken on the basis of the evidence before it (Article 53(2) CDR).

Facts, evidence or arguments submitted after notification to the parties that the written phase of the procedure is closed will be considered inadmissible, save in exceptional circumstances, for example, where the evidence was unavailable at an earlier stage or where a fact came to light in the course of the proceedings (Article 63(2) CDR, see paragraph 2.4above).

Obsolete

4.1.6 Extension of time limits and suspension

4.1.6.1 Extension of time limits

Requests by any of the parties for an extension of a time limit determined by the Office must be submitted before the original time limit expires (Article 57(1) CDIR).

As a general rule, a first request for extension of a time limit will be granted. Further extensions will not be granted automatically. In particular, the Invalidity Division may make the extension of a time limit subject to the agreement of the other party or parties to the proceedings (Article 57(2) CDIR).

Reasons in support of any further request for extension must be submitted to the Invalidity Division. The request for an extension of the time limit must indicate the reasons why the **parties** cannot meet the deadline. Obstacles faced by the parties' **representatives** do not justify an extension (see, by analogy, 05/03/2009, C-90/08 P , Corpo livre, EU:C:2009:135, § 20-23).

Where a request for extension of an extendable time limit has been filed and received before the expiry of the time limit (30/01/2014, C-324/13 P, Patrizia Rocha, EU:C:2014:60), the party concerned will be granted at least 1 day, even if the request for extension arrived on the last day of the time limit.

The extension will not result in a time limit longer than 6 months (Article 57(1) CDIR). Both parties are informed about any extension.

For more information on time limits see Part A, General Rules, Section 1, Means of Communication, Time Limits .

4.1.6.2 Suspension

The Invalidity Division will suspend the proceedings on its own motion after hearing the parties, unless there are special grounds for continuing the proceedings, where it has been brought to the attention of the Invalidity Division that the validity of the contested Community design is already in issue on account of a counterclaim before a competent national court, and the national court does not stay its proceedings (Article 91(2) CDR).

The Invalidity Division may also suspend the proceedings when it is appropriate, in particular in the circumstances listed here.

- Where the request for a declaration of invalidity is based on an earlier design or trade mark for which the registration process is pending, until a final decision is taken in those proceedings (Article 25(1)(d) and (e) CDR).
- Where the request for a declaration of invalidity is based on an earlier design, trade mark or other earlier right, the validity of which is challenged in administrative or in court proceedings, until a final decision is taken in those proceedings.
- Where the Invalidity Division receives a joint request for suspension signed by both parties with a view to reaching an amicable settlement (Article 31(5) CDIR).

Obsolete

- Where a number of applications for a declaration of invalidity have been filed relating to the same Community design, and where a preliminary examination reveals that the Community design may be invalid on the basis of one of these applications. The Invalidity Division will deal with this application first and may suspend the other invalidity proceedings (Article 32(2) CDIR).

The Invalidity Division has broad discretionary powers when deciding on the appropriateness of the suspension. The decision on the suspension must take into account the balance between the parties' respective interests, including the applicant's interest in obtaining a decision within a reasonable period of time (see, by analogy, 16/05/2011, T-145/08, Atlas, EU:T:2011:213, § 68-77).

The Invalidity Division will notify the parties of its decision to grant or refuse a suspension, giving reasons and explaining which factors it considers when exercising its discretion. Where the Invalidity Division decides not to grant the suspension, reasons may instead be given in the decision terminating the proceedings. Where a suspension is granted for a determined period, the Invalidity Division will indicate in its communication the date of resumption of the proceedings. The proceedings will resume the day after the expiry of the suspension.

Where a suspension is granted for an undetermined period, the invalidity proceedings will be resumed when the parties inform the Invalidity Division or when it has been brought to the attention of the Invalidity Division that the event that justified the stay has occurred, or ceased to exist, as the case may be. The date of resumption will be indicated in the communication of the Invalidity Division or, in the absence of such indication, on the day following the date of that communication.

Where the suspension was requested jointly by the parties, the period will always be 6 months regardless of the period requested by the parties. Any party can bring the suspension to an end ('opting out'). It is immaterial whether the other party disagrees with or has consented to it.

If one of the parties 'opts out', the suspension will end 2 weeks after the parties have been informed thereof. The proceedings will resume the day after.

Where a time limit was running at the time of the suspension, the party concerned will be given 2 months from the date of resumption of the proceedings to submit its observations.

4.1.7 Taking of evidence

The parties may submit evidence in the form of documents and items of evidence, opinions by experts and witnesses, and/or statements in writing, sworn or affirmed or having a similar effect under the law of the state in which the statement is drawn up (Article 65(1) CDR).

Where a party offers evidence in the form of witness statements or expert opinions, the Invalidity Division will invite the party to provide the statement of the witness or the

Obsolete

opinion of the expert in writing, except where a hearing is considered expedient (Article 65 CDR; Articles 43 and 46 CDIR).

For more information see the Guidelines Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 4, Means of taking evidence.

4.1.8 Oral proceedings

Oral proceedings may be held at the request of the Invalidity Division or of any of the parties (Article 64 CDR; Article 38(1) and Article 42 CDIR).

Where a party requests that they be held, the Invalidity Division enjoys broad discretionary powers as to whether oral proceedings are really necessary. A hearing will not be held when the Invalidity Division has before it all the information needed as a basis for the operative part of the decision on invalidity (13/05/2008, R 135/2007-3, Macchine da gioco automatiche, § 14).

The Invalidity Division will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 5, Oral proceedings.

4.2 Examination

4.2.1 Commencement of examination

The Invalidity Division begins with the examination of the application as soon as the parties are informed that the written phase of the procedure is closed and that no further observations can be submitted (Article 53 CDR).

4.2.2 Examination of the grounds for invalidity

The grounds for declaring a Community design invalid are listed exhaustively in Article 25 CDR. An application for a declaration of invalidity based on a ground other than those listed in the CDR (e.g. a claim that the holder was acting in bad faith when applying for the registered Community design) will be rejected as inadmissible as far as the ground in question is concerned (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 30-31).

Where the ‘Grounds’ box in the application form corresponding to Article 25(1)(b) CDR is ticked, the Invalidity Division will determine which specific ground or grounds is or are relied on by the applicant from the facts, evidence and arguments referred to in the reasoned statement of grounds.

The same applies to the ‘Grounds’ box in the application form corresponding to Article 25(1)(c), (d), (e), (f) or (g) CDR.

Obsolete

The Invalidity Division must examine an application in the light of all grounds put forward in the original statement of grounds, even if the corresponding boxes in the application form were not ticked. Therefore, where the applicant indicated in the statement of grounds that the contested Community design was 'not novel', that indication constitutes a valid statement of grounds even if the 'Grounds' box concerning the requirements of Articles 4 to 9 CDR was not ticked (02/08/2007, R 1456/2006-3, Saucepan handles, § 10).

The examination, however, will not be extended to grounds not relied on in the application. Where an applicant exclusively challenges, for instance, either the novelty or the individual character of a Community design, the Invalidity Division will examine the invoked ground only (14/03/2018, T-424/16, Footwear, EU:T:2018:136, § 47).

The applicant cannot raise new grounds for invalidity after the date of filing of the application (10/02/2016, R 1885/2014-3, Logos, § 15-19). However, the applicant may file another application for a declaration of invalidity based on different grounds.

Where the application can be upheld on the basis of one of several grounds put forward by the applicant, the Invalidity Division will not take a decision on the others (15/12/2004, ICD No 321). Where an application can be upheld on account of the existence of one of the earlier designs or rights relied on by the applicant, the remaining earlier designs or rights will not be examined (14/06/2011, T-68/10, Watches, EU:T:2011:269).

For the examination of the substantive requirements concerning the validity of a priority claim in the course of invalidity proceedings, see the Guidelines, Examination of Applications for Registered Community Designs, paragraph 6.2.1.1, Priority.

5 The Different Grounds for Invalidity

5.1 Not a design

According to Article 25(1)(a) CDR, a Community design may be declared invalid if the design does not correspond to the definition under Article 3(a) CDR. This would be the case where the views of the Community design are inconsistent and represent different products (other than forming a 'set of products', see Article 3 CDR and the Guidelines, Examination of Applications for Registered Community Designs, Additional requirements regarding the reproduction of the design, paragraph 5.3.7, Sets of articles), or where the graphical representation consists of mere representations of nature (landscapes, fruits, animals, etc.) that are not products within the meaning of Article 3(1)(b) CDR.

Obsolete

5.1.1 Living organisms

A design that discloses the appearance of a living organism in its natural state, in principle, has to be refused. Even if the shape at issue deviates from that of the common corresponding living organism, the design should be refused if nothing suggests prima facie that the shape is the result of a manual or industrial process (see, by analogy,18/02/2013, R 595/2012-3, GROENTE EN FRUIT, § 11).

RCD No 1 943 283-0001	

A Community design will not be declared invalid if it is apparent from the representation that the product does not show a living organism or if the indication of the product specifies that the product is artificial (see, in particular, Class 11-04 of the Locarno Classification).

5.1.2 Ideas and methods of use

The law relating to designs protects the appearance of the whole or a part of a product, but does not protect the underlying idea of a design (06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 72). Nor is the method of use or operation protected by a design (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 52).

5.2 Contrary to public policy or morality

According to Article 25(1)(b) CDR, a Community design may be declared invalid if it does not fulfil the requirements of Article 9 CDR.

The Office will apply the concepts of public policy and morality as explained in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal.

5.3 Lack of entitlement

According to Article 25(1)(c) CDR, a Community design may be declared invalid if, by virtue of a court decision, the rights holder is not entitled to the Community design under Article 14 CDR.

Obsolete

This ground may be invoked solely by the person who is entitled to the Community design under Article 14 CDR.

In the absence of a court decision, the Invalidity Division cannot declare the contested Community design invalid under Article 25(1)(c) CDR (11/02/2008, R 64/2007-3, Loudspeakers, § 15).

It is clear from the words 'by virtue of a court decision' in Article 25(1)(c) CDR that the Invalidity Division has no jurisdiction to determine who is entitled to a Community design under Article 14 CDR. Such jurisdiction belongs to any national court that is competent under Article 27 and Article 79(1) and (4) CDR in conjunction with Article 93 CDR.

5.4 Invisible component parts of complex products

Features of a Community design applied to, or incorporated in, a 'component part of a complex product', will be disregarded if they are invisible during normal use of the complex product in question (Article 4(2) CDR).

'Complex product' means a product that is composed of multiple components that can be replaced, permitting disassembly and reassembly of the product (Article 3(c) CDR). For instance, the visibility requirement does not apply to a Community design representing the appearance of a dustbin as a whole, since dustbins may be complex products as such, but not component parts of complex products (23/06/2008, ICD No 4 919).

'Normal use' means use by the end user, excluding maintenance, servicing or repair work (Article 4(3) CDR). 'Normal use' is the use made in accordance with the purpose for which the complex product is intended.

For instance, for safety reasons, an electrical connector is a component part that is normally incorporated in a casing in order to be shielded from any contact with potential users when a complex product, such as a train or an electric vehicle, is in operation. The fact that this component part of a complex product can theoretically be made visible when inserted in a transparent casing or cover constitutes a purely hypothetical and random criterion that must be disregarded (03/08/2009, R 1052/2008-3, Contacteurs électriques, § 42-53).

Where none of the features of a Community design applied to a component part (e.g. a sealing ring) is visible during normal use of the complex product (e.g. a heat pump system), the Community design will be invalidated as a whole (20/01/2015, T-616/13, Heat Exchanger Inserts, EU:T:2015:30, § 14-16).

However, Article 4(2) CDR does not require a component part to be clearly visible in its entirety at every moment of use of the complex product. It is sufficient if the whole of the component can be seen some of the time in such a way that all its essential features can be apprehended (22/10/2009, R 690/2007-3, Chaff cutters, § 21).

Obsolete

5.5 Technical function

Article 8(1) CDR provides that 'a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function'.

5.5.1 Rationale

The aim of Article 8(1) CDR is to prevent technological innovation from being hampered by the granting of design protection to features dictated solely by a technical function of a product (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 29).

It excludes protection for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31).

However, this does not mean that a design must have an aesthetic quality (recital 10 CDR).

The fact that a particular feature of a product's appearance is denied protection by Article 8(1) CDR does not mean that the whole design must be declared invalid pursuant to Article 25(1)(b) CDR. The design as a whole will be invalid only if **all the essential features** of the appearance of the product in question were solely dictated by its technical function (29/04/2010, R 211/2008-3, FLUID DISTRIBUTION EQUIPMENT, § 36).

5.5.2 Examination

It is the applicant's responsibility to prove any technical function invoked as a ground for invalidity.

The technical facts required for assessing Article 8(1) CDR may not be well known. It is thus the obligation of the party relying on these facts to submit them, as the examination carried out by the Invalidity Division is, in principle, restricted to the facts, evidence and arguments provided by the parties (Article 63(1) CDR).

The technical functionality of the features of a design may be assessed by taking account of patent documents describing the technical elements of the shape concerned. However, the drawing illustrating a patent cannot in itself, without further facts, evidence and arguments, establish the technical function of a contested Community design.

In order to determine whether the essential features of the appearance of the product into which the contested Community design will be incorporated are solely dictated by the technical function of the product, it is necessary to determine what the technical function of that product is. The relevant indication in the application for registration of

Obsolete

the design (Article 36(2) CDR) should be taken into account, but also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (see, by analogy, 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56).

Whether Article 8(1) CDR applies must be assessed on the basis of all the objective circumstances relevant to each individual case, and not from the perspective of the informed user, who may have limited knowledge of technical matters.

Such an assessment must be made, in particular, having regard to the design at issue, the objective circumstances dictating the choice of features of appearance of the product concerned, and/or information on its use or the existence of alternative designs that fulfil the same technical function, provided that the circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 36-37).

The choice of technical features for the contested design may also be based on considerations other than the need for the product concerned to fulfil its technical function, as when such features are arranged or combined in an arbitrary manner, which may result in an overall appearance or composition that is more than the sum of its technical features. As such, the contested design may not be solely dictated by its technical function. It is the contested design holder's obligation, relying on such considerations, to submit reliable evidence. In this regard, it is insufficient for the holder to refer to alternative designs to evidence the mere possibility of choice.

The information on its use may include the use made of the actual product that the design is applied to or incorporated into, as well as any information on its marketing.

5.6 Designs of interconnections

Features of a Community design are excluded from protection if they must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against another product so that either product may perform its function. If Article 8(2) CDR applies to **all the essential features** of the Community design, the latter must be declared invalid (20/11/2007, ICD No 2 970).

It is up to the applicant to prove that a Community design may be objected to on the basis of Article 8(2) CDR. The applicant must substantiate the existence of the product whose form and dimensions dictate those of the Community design and submit facts, evidence and arguments demonstrating the functions performed by the product and by the Community design individually and/or in combination.

As an exception, Article 8(2) CDR does not apply to a Community design that serves the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system (Article 8(3) CDR). It is up to the holder to prove that the Community design serves such a purpose.

Obsolete

5.7 Lack of novelty and individual character

5.7.1 Disclosure of earlier design

5.7.1.1 General principles

Challenging the validity of a Community design on account of its lack of novelty or individual character requires proof that the earlier design that is identical or that produces the same overall impression has been made available to the public before the date of filing of the application for registration or, if a priority is claimed, the date of priority (Article 7 CDR).

Disclosure of the earlier design is a preliminary step before deciding whether it is identical to the contested Community design or produces the same overall impression on the informed user (23/10/2018, T-672/17, Cot bumpers, EU:T:2018:707, § 30). Therefore, if it is not proven that the earlier design has been disclosed, the application for declaration of invalidity will be rejected insofar as it is based on Articles 5 and 6 CDR.

Assessing disclosure of an earlier design requires a two-step analysis. Firstly, the invalidity applicant must prove the event of disclosure, that is, that the invoked earlier design has been published following registration or otherwise or exhibited, used in trade or otherwise disclosed (see paragraph 5.7.1.2 below). Secondly, the holder of the contested Community design can claim that that event of disclosure should not be taken into consideration because either of the exceptions to disclosure provided in Article 7(1) CDR apply (see paragraph 5.7.1.3 below) (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 48; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 24; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 20).

Therefore, the earlier design will be considered as disclosed when at least one event of its disclosure is established and provided that none of the exceptions contained in Article 7(1) CDR apply.

Nevertheless, a disclosure must not be taken into consideration if a design has been made available to the public during the ‘grace period’ by the designer, his or her successor in title or a third person as a result of information provided or action taken by the former, or as a consequence of an abuse in relation to the designer or his or her successor in title as provided in Article 7(2) and (3) CDR (see paragraph 5.7.1.4 below).

5.7.1.2 Establishing the event of disclosure

For the purpose of establishing the event of disclosure the following aspects need to be taken into consideration:

1. The source of the design’s disclosure

Obsolete

In general, a design can be disclosed anywhere in the world (13/02/2014, C-479/12, “Athen” gazebo, EU:C:2014:75, § 33), including on the internet (see paragraph 5.7.1.5 below) and through various sources (e.g. by publishing in a catalogue, displaying in a trade fair, offering in an online store).

The evidence submitted must clearly identify the respective source of disclosure. It might also be important to submit any further information regarding that source, such as its purpose, targeted public, etc. (11/12/2019, R 311/2019-3, Hookahs, § 23).

2. The design invoked

The invoked earlier design should be identified and reproduced precisely and in its entirety (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 65).

The Invalidity Division is not required to determine through assumptions and deductions which designs among those represented in the evidence may be relevant in respect of the invalidity application (see paragraph 3.10.2 above). Moreover, the relevant features of the earlier design should be clearly displayed in the evidence. Where the views of the earlier design submitted do not enable its comparison with the contested Community design, this does not amount to a disclosure for the purpose of Article 7(1) CDR (10/03/2008, R 586/2007-3, Barbecues, § 22 et seq.).

For the purpose of Article 7 CDR, it is immaterial whether or not an earlier ‘design’ within the meaning of Article 3(a) CDR enjoys or enjoyed legal protection (as a design, trade mark, copyright work, patent, utility model or otherwise) (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 24).

3. The date when the design was disclosed

When assessing disclosure of the earlier design, it is crucial to establish the date when it was made available to the public. That date must be prior to the date of filing of the application for registration of the contested Community design or, if a priority is claimed, the date of priority.

The date of disclosure is when a product to which a design is applied, or in which it is incorporated, was made publicly available and not when the circles specialised in the sector concerned actually became aware of such disclosure.

It is enough that the disclosure took place at a point in time that can be identified prior to the filing date or priority date of the contested Community design even if the exact date of disclosure is unknown (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 34).

Neither the CDR nor the CDIR provides for any specific form of evidence required for establishing the event of disclosure. Article 28(1)(b)(v) CDIR only states that ‘documents proving the existence of those earlier designs’ must be submitted. Nor are

Obsolete

there any provisions as to any compulsory form of evidence that must be submitted. Article 65 CDR lists possible means of giving evidence before the Office, but it is clear from its wording that this list is not exhaustive ('shall include the following'). Accordingly, the evidence in support of the event of disclosure is a matter for the discretion of the applicant and, in principle, any evidence capable of proving the event could be accepted (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 21; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 21).

The Invalidity Division carries out an overall assessment of such evidence by taking account of all the relevant factors in the particular case. An event of disclosure cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 21-24; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 22).

A global examination of the items of evidence relating to the same earlier design implies that these items must be assessed in the light of each other. Even if some items of evidence are not conclusive in themselves, they may contribute to establishing the event of disclosure when examined in combination with other items (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 25, 30-45; 27/02/2018, T-166/15, Sacs pour ordinateurs portables, EU:T:2018:100, § 24; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 52; 17/05/2018, T-760/16, Fahrradkörbe, EU:T:2018:277, § 42, 45 and 50; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 22).

As regards 'statements in writing, sworn or affirmed', such as affidavits, as a matter of principle, they would not in themselves be sufficient to prove a fact such as the event of disclosure of an earlier design. They should be corroborated by additional evidence, in particular when they originate from the invalidity applicant itself or related persons (18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 29). In order to assess the evidential value of an affidavit, regard should be had first and foremost to the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 39-40). The Invalidity Division will apply the principles explained in the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 5.3.2.3, Declarations.

In the absence of any indications to the contrary, the authenticity of the evidence submitted is assumed. The mere possibility of manipulating the relevant information is not enough to raise doubts as to that authenticity. Therefore, the evidence presented would only be rejected in cases of serious and substantiated doubts (27/02/2018, T-166/15, Sacs pour ordinateurs portables, EU:T:2018:100, § 89-90; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 28-29).

Official publications

Publication of an earlier design in the bulletin of any intellectual property office worldwide constitutes an event of disclosure (21/05/2015, T-22/13 & T-23/13,

Obsolete

UMBRELLAS, EU:T:2015:310, § 37). The same applies where the publication concerns the appearance of a product in relation to any other kind of intellectual property right, such as trade marks (16/12/2010, T-513/09, Ornamentación, EU:T:2010:541, § 20) or patents (15/10/2015, T-251/14, Doors (parts of), EU:T:2015:780, § 22).

However, a document kept by an intellectual property office, which is available to the public only by means of an application for inspection of files, may not be considered to have become known in the normal course of business to the specialised circles in the sector concerned and therefore would not give rise to a disclosure of an earlier design within the meaning of Article 7 CDR (22/03/2012, R 1482/2009-3, INSULATION BLOCKS, § 39-43; 15/04/2013, R 442/2011-3, Skirting boards, § 26).

In order to prove the event of disclosure, the evidence must allow the date of publication to be established independently of the date of filing or the date of registration. Whether or not the publication takes place before registration or after is irrelevant (15/04/2013, R 442/2011-3, Skirting boards, § 24).

Moreover, the date of publication can be identified by the reference to the relevant INID code (internationally agreed numbers for the identification of (bibliographic) data).

Exhibitions

Exhibiting a design at a trade fair exhibition anywhere in the world generally constitutes an event of disclosure (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 67).

Evidence from trade fairs must clearly depict the earlier design. It is also important to link the evidence to the particular event. A list of participants, a plan of stands or even contractual details with organisers may contribute to proving the design's disclosure.

Use in trade

Use in trade is another example given in Article 7(1) CDR of an event of disclosure, irrespective of whether such use is made within or outside the European Union (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 68).

Disclosure of a design can be the result of use in trade even where there is no proof that the products in which the earlier design is incorporated have actually been produced or put on the market (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 36). It may be sufficient that the products were offered for sale in catalogues (22/10/2007, R 1401/2006-3, ORNAMENTACIÓN, § 25), imported from a country outside the European Union (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32) or were the object of an act of purchase between two European operators (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 30-45).

As regards the submission of catalogues as evidence of disclosure, although depending on the particular case it may be sufficient to submit only excerpts from their relevant parts (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 35), preferably catalogues should be provided in their entirety. Moreover, when combined or read in conjunction with other items of evidence, a catalogue can serve for establishing disclosure even in the absence of the evidence showing its distribution (27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 30-33).

Obsolete

5.7.1.3 Exceptions to disclosure

If the event of disclosure is duly established, there is a presumption that the earlier design has been disclosed within the meaning of Article 7(1) CDR (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 47; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 23; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 41).

Nevertheless, the holder of the contested Community design can refute this presumption by proving that any of the exceptions to disclosure provided in Article 7(1) CDR apply in respect of that event of disclosure.

Designs deemed not to have been made available to the public

Following Article 7(1) CDR a design will be deemed to have been made available to the public, except where the event of disclosure could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned operating within the European Union.

Therefore, the party challenging the disclosure must establish to the requisite legal standard, that the circumstances of the case could reasonably prevent the event of disclosure from becoming known to those specialised circles (15/10/2015, T-251/14, Doors (parts of), EU:T:2015:780, § 26; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 26; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 47; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 23).

When there is more than one event of disclosure (e.g. a design has been presented in a trade fair and offered for sale in an online shop), the presumption would have to be rebutted in respect of them all.

The presumption set out in Article 7(1) CDR applies irrespective of where an event of disclosure took place. It is therefore not limited to the territory of the European Union (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 27). The question whether events of disclosure outside the European Union could reasonably have become known to persons forming part of those circles is a question of fact. The answer to that question has to be assessed on the basis of the particular circumstances of each individual case (13/02/2014, C-479/12, “Athen” gazebo, EU:C:2014:75, § 34; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 55).

In the context of Article 7(1) CDR, what matters is whether the ‘circles specialised in the sector concerned’ have had an opportunity to have access to the design irrespective of the number that actually seized this opportunity and might have encountered the disclosed design. There is thus no quantitative threshold with regard to actual knowledge of the disclosure events (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 73).

It must be examined whether, on the basis of the facts to be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior

Obsolete

art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as its interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the products concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 56).

The 'sector concerned', within the meaning of Article 7(1) CDR, is not limited to that of the product in which the contested Community design is intended to be incorporated or applied (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 103). Moreover, Article 7(1) CDR lays down no restrictions relating to the nature of the activity of natural or legal persons who may be considered to form part of the 'sector concerned'. Consequently, apart from persons involved in creating designs and developing or manufacturing products based on those designs within the sector concerned, traders may also form part of the 'specialised circles' within the meaning of Article 7(1) CDR (see, by analogy, 13/02/2014, C-479/12, "Athen" gazebo, EU:C:2014:75, § 27).

Disclosure to a third person under explicit or implicit conditions of confidentiality

Making a Community design available to a third person under explicit or implicit conditions of confidentiality will not be deemed to constitute its disclosure (Article 7(1) CDR).

Therefore, disclosure of a design to a third party in the context of commercial negotiations is ineffective if the parties concerned agreed that the information exchanged should remain secret (20/06/2005, ICD No 172, § 22).

The burden of proving facts establishing confidentiality lies with the holder of the contested Community design (08/07/2020, T-748/18, Pneumatic power tools, ECLI:EU:T:2020:321, § 25).

5.7.1.4 Grace period

Article 7(2) CDR provides for a 'grace period' of 12 months preceding the date of filing or the priority date of the contested Community design. Disclosure of the Community design within such a period will not be taken into consideration if it was made by the designer or its successor in title.

As a matter of principle, the holder must establish that it is either the creator of the design upon which the application is based or the successor in title to that creator, failing which Article 7(2) CDR cannot apply (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 26-29).

Moreover, acts of disclosure made by a third person as a result of information provided or action taken by the designer or its successor in title are also covered by Article 7(2) CDR. This can occur, for instance, where a third party has made public a design copied

Obsolete

from the design for which protection is sought because that was previously disclosed within the grace period by the holder itself (02/05/2011, R 658/2010-3, LEUCHTVORRICHTUNGEN, § 37-39).

Article 7(2) CDR also provides for immunity against the loss of individual character pursuant to Article 6 CDR (02/05/2011, R 658/2010-3, LEUCHTVORRICHTUNGEN, § 40). The exception provided in Article 7(2) CDR may therefore apply where the previously disclosed design is either identical to the contested Community design within the meaning of Article 5 CDR, or the previously disclosed design does not produce a different overall impression.

The 'grace period' also applies where the disclosure of a design is the result of an abuse in relation to the designer or its successor in title (Article 7(3) CDR). Whether the disclosure is the result of fraudulent or dishonest behaviour will be assessed on a case-by-case basis in the light of the facts, arguments and evidence submitted by the parties (25/07/2009, R 552/2008-3, LECTEUR ENREGISTREUR MP3, § 24-27).

5.7.1.5 Specificities of design disclosures on the internet

A growing number of design disclosures happen on the Internet. For this reason, the Office and a number of European Union intellectual property offices have agreed on a Common Practice 'CP10 – Criteria for assessing disclosure of designs on the internet'.

The selected principles and recommendations set out in CP10 have been included in this section of the Guidelines. For further guidance, please consult the text of the Common Communication of CP10.

The following sections deal with the specificities of design disclosure on the internet.

Sources of disclosure on the internet

The internet provides for a number of possible sources for disclosure of a design.

Websites are among the most common sources of design disclosure on the internet, in particular those related to e-commerce and social media. Therefore, displaying a product on a website to which the design is applied or in which it is incorporated would generally constitute its disclosure.

Electronic mails can also qualify as sources of design disclosure, in particular those that aim to promote products and are sent to a large number of recipients (27/02/2018, T-166/15, Sacs pour ordinateurs portables, EU:T:2018:100, § 93).

Further, designs can be disclosed through mobile applications, file sharing, etc.

Establishing the relevant date of disclosure on the internet

The information available on websites that is relevant for disclosure (e.g. articles, videos, product reviews, sale offers) usually displays the date when it was published.

However, the relevant date may not be visible in the contents of a website. Instead, only the date when a printout is made would be displayed, and this is normally later than the date of filing of the application of the contested Community design or its date of priority.

Obsolete

Nevertheless, various tools are available on the internet that could be used to retrieve historic information on the particular website, including the date of the disclosure of the design. For instance, website archiving services (such as the 'WayBack Machine') can provide access to archived websites or parts thereof showing a design on a particular date in the past. The date when a website was archived would be considered as the date of disclosure, unless an earlier relevant date appears in its contents.

When several dates are displayed in the evidence, it must be clearly indicated by the party concerned which is the relevant date of disclosure, that is, the date relied on to prove the event of disclosure.

In the case of electronic mails, the date when they have actually been sent would normally be displayed in their details and thus would appear in a printout.

Means for presenting the evidence obtained on the internet

Disclosure of a design on the internet can be established by submitting various types of evidence, such as printouts, screenshots, images, videos and metadata.

Merely providing a link to content on the internet (e.g. URL address of a website) is not sufficient. The Office will not perform a search for that content. Moreover, the content may have been altered or removed.

Printouts from websites, or their screenshots, are the most common means of proving the disclosure of designs on the internet, in particular, on e-commerce platforms, private company websites, social media and online databases.

For the purpose of proving disclosure, a printout or a screenshot should show the full URL address of a website, the date when the design was published and the disclosed design. Moreover, the information regarding the purpose and the main characteristics of the website could be relevant for assessing whether the design has been made available to the public.

When a printout or a screenshot does not include all the relevant elements, missing information may be shown by providing additional evidence (27/02/2018, T-166/15, Sacs pour ordinateurs portables, EU:T:2018:100, § 61-63).

Moreover, user comments left on e-commerce platforms or in social media might also be relevant when assessing disclosure.

When submitting a printout of an electronic mail which contains the representation of a design as an attachment, the link between the printout of that electronic mail and the printout of the attachment should be proven.

Printouts and screenshots should not be modified manually, as this might have an effect on the credibility of this evidence (27/02/2018, T-166/15, Sacs pour ordinateurs portables, EU:T:2018:100, § 90).

Additionally, a design might be disclosed by the publishing of photos and videos on the internet that show a product to which the design is applied or in which it is incorporated.

Photos should be complemented with the information regarding the source of disclosure and the relevant date.

Obsolete

In the case of videos, a disclosure of a design should preferably be proved by submitting one or several screenshots displaying the exact time when that design appears in the video.

Finally, when photos and videos are submitted as evidence, metadata extracted from digital cameras could be obtained for proving the date and the location the photo or video was taken.

Exceptions to the availability to the public

Taking the global nature of the internet into account, in general, online content is available worldwide.

However, due to some restrictions, in particular as to the accessibility or searchability of the information on the internet, it might be considered that an event of disclosure of a design online could not reasonably have become known to the circles specialised in the sector concerned operating within the European Union.

For instance, when assessing an event of disclosure related to the publication of a design on a website, it might be necessary to assess whether that website was technically accessible and the relevant circles were actually able to find the prior art on the internet (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 61).

Unless the content is subject to restricted access in certain internal databases (e.g. used only by employees of a company), as a general rule, neither password nor payment requirements would be considered as precluding accessibility to the information published on the internet.

5.7.2 Assessment of novelty and individual character

A design will be protected as a Community design to the extent that it is new and has individual character (Article 4(1), Articles 5 and 6 CDR). The novelty and individual character of a Community design must be examined on its date of filing or, as the case may be, on its date of priority, in the light of the relevant earlier designs, which have been made available to the public pursuant to Article 7 CDR.

The Community design must be compared individually with each and every earlier design relied on by the applicant. Novelty and individual character of a Community design cannot be defeated by combining features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 69; 19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 23-35; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 23-24).

A combination of already disclosed features is therefore eligible for protection as a Community design, provided the combination, as a whole, is novel and has individual character.

Obsolete

In principle, subject to a number of exceptions detailed below, all the features of conflicting designs must be taken into consideration when examining novelty and individual character.

Point of reference for the comparison

The contested Community design is the point of reference when assessing novelty and individual character in the comparison with the earlier design.

Novelty and individual character, therefore, have to be assessed solely on the basis of the features disclosed in the contested design (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 87).

Consequently, if the contested Community design reproduces only certain aspect views, for instance the front view, a comparison is only made with the corresponding view of the earlier design. Any additional aspect views disclosed by the earlier design, such as the rear view, are disregarded.

The same principle applies when the contested Community design shows the appearance of only part of a product whereas the earlier design discloses the whole product.

However, in turn, when the contested Community design shows more features than the earlier design, its overall impression is determined by all of its features save for the exceptions outlined below.

Features dictated by a technical function and features of interconnection

Features that are solely dictated by a technical function and features that must necessarily be reproduced in their exact form and dimensions in order to allow interconnection with another product cannot contribute to the novelty and individual character of a Community design. Such features must therefore be disregarded when comparing the contested Community design with the relevant earlier designs (Article 8 CDR, see paragraph 5.5.1 above).

However, when features of a product serve a functional purpose without being solely dictated by the technical function within the meaning of Article 8 CDR, its features may constitute a differentiating factor to the extent that its features could be designed differently. For instance, a button operating the functions on an electronic wristband can be placed on the product in different ways and can have different shapes and sizes (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61).

Invisible features of component parts

Where the features of a Community design applied to a component part are only partially visible during normal use of the complex product, the comparison with the relevant earlier designs invoked must be limited to the visible parts (Article 4(2), see paragraph 5.4 above).

Clearly discernible features

Features of a Community design that are not clearly discernible in its graphical representation cannot contribute to its novelty or its individual character (Directive

Obsolete

98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, recital 11). Likewise, features of the earlier design that are not of sufficient quality to allow all the details to be discerned in the portrayal of the earlier design cannot be taken in consideration for the purpose of Articles 5 and 6 CDR (10/03/2008, R 586/2007-3, Barbecues, § 23-26).

Features of an earlier design can be supplemented by additional features that were made available to the public in different ways, for instance, first, by the publication of a registration and, second, by the presentation to the public of a product incorporating the registered design in catalogues. These representations must however relate to one and the same earlier design (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 25-30).

Disclaimed features

Features of a contested Community design that are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a contested Community design represented with broken lines, blurring, colour shading or boundaries or in any other manner making clear that protection is not sought in respect of such features (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 59-64).

For further guidance, see paragraph 5.4 (Use of visual disclaimers to exclude features from protection) in the guidelines regarding "Examination of Applications for Registered Community Designs" or consult the text of the Common Practice under the European Trade Mark and Designs Network (CP6).

In contrast, disclaimed features of an earlier registered design can be taken into account when assessing the novelty and individual character of a contested Community design under Article 25(1)(b) CDR because the earlier design is considered as a disclosure irrespective of the subject matter of protection as a Community design, and thus includes even the disclaimed features.

5.7.2.1 Novelty

A Community design will be considered to be new if it is not predated by an identical design disclosed pursuant to Article 7 CDR. Designs will be deemed to be identical if their features differ only in immaterial details (Article 5(2) CDR).

An earlier design incorporated in or applied to a product that is different from the one to which the later design relates is, in principle, relevant for the purposes of assessing the novelty (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 104).

There is identity between the Community design and an earlier design where the latter discloses each and every element constituting the former. A Community design cannot be new if it is included in a more complex earlier design (25/10/2011, R 978/2010-3, PART OF SANITARY NAPKIN, § 20-21).

However, the additional or differentiating features of the Community design may be relevant for deciding whether it is new, unless such elements are so insignificant that they may pass unnoticed.

Obsolete

An example of an immaterial detail is a slight variation in the shade of the colour pattern of the compared designs (28/07/2009, R 921/2008-3, NAIL FILES, § 25).

Another illustration is the display, in one of the two compared designs, of a label that is so small in size that it is not perceived as a relevant feature (08/11/2006, R 216/2005-3, CAFETERA, § 23-26), as in the following example.

Contested RCD No 5 269-0001 (view No 2)	**Earlier design (invented example)**

Obsolete

5.7.2.2 Individual character

A design will be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design that has been made available to the public before the date of filing of the application for registration or, if a priority is claimed, the date of priority (Article 6(1) CDR).

In assessing individual character, the degree of freedom of the designer in developing the design will be taken into consideration (Article 6(2) CDR).

It is apparent from these provisions that the assessment of the individual character of a Community design is the result, in essence, of a four-stage examination. This examination consists of **first** deciding upon the sector to which the products in which the design is intended to be incorporated or to which it is intended to be applied belong; **second** , the informed user of those products in accordance with their purpose and, with reference to that informed user, the degree of awareness of the prior art and the level of attention in the comparison, direct if possible, of the designs; **third** , the designer's degree of freedom in developing his or her design; and, **fourth** , the outcome of the comparison of the designs at issue, taking into account the sector in question, the designer's degree of freedom and the overall impressions produced on the informed user by the contested design and by any earlier design which has been made available to the public (10/09/2015, T-525/13 , Sacs à main, EU:T:2015:617, § 32; 13/06/2019, T-74/18 , Informationstafeln für Fahrzeuge, EU:T:2019:417, § 66).

The informed user

The concept of 'informed user' refers to a fictitious person (06/06/2019, T-209/18 , Kraftfahrzeuge / Kraftfahrzeuge, EU:T:2019:377, § 37).

The status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (22/06/2010, T-153/08 , Communications equipment, EU:T:2010:248, § 46; 09/09/2011, T-10/08 , Internal combustion engine, EU:T:2011:446, § 24; 06/06/2013, T-68/11 , Watch-dials, EU:T:2013:298, § 58).

The concept of 'informed user' lies somewhere between that of the average consumer applicable in trade mark matters, who need not have any specific knowledge, and the sectorial expert, who has detailed technical expertise. Without being a designer or a technical expert (and therefore without necessarily knowing which aspects of the product concerned are dictated by technical function, as found in 22/06/2010, T-153/08 , Communications equipment, EU:T:2010:248, § 48), the informed user is aware of the various designs that exist in the sector concerned, possesses a certain degree of knowledge with regard to the features that those designs normally include (20/10/2011, C-281/10 P , Metal rappers, EU:C:2011:679, § 53, 59; 22/06/2010, T-153/08 , Communications equipment, EU:T:2010:248, § 47; 06/06/2013, T-68/11 , Watch-dials, EU:T:2013:298, § 59).

In other words, the informed user is neither a designer nor a technical expert. Therefore, an informed user is a person that has some awareness of the existing designs in the sector concerned, without necessarily knowing which aspects of a product are dictated by a technical function.

The informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated (09/09/2011, T-10/08 , Internal combustion engine, EU:T:2011:446, § 25-27).

However, depending on the nature of the product in which the Community design is incorporated (e.g. promotional items), the concept of informed user may include, firstly, a professional who acquires such products in order to distribute them to the final users and, secondly, the final users themselves (20/10/2011, C-281/10 P , Metal rappers, EU:C:2011:679, § 54). The fact that one of the two groups of informed users perceives the designs at issue as producing the same overall impression is sufficient for a finding that the contested design lacks individual character (14/06/2011, T-68/10 , Watches, EU:T:2011:269, § 56).

As a result of his or her interest in the products concerned, the informed user, as a rule, shows a relatively high degree of attention when using them (24/10/2019, T-559/18 , Medizinische Pflaster, EU:T:2019:758 § 50). Unlike the average consumer in the field of trade marks for which the fact of being faced, for instance, with a fashion accessory may play a role in the consumer's level of attention, this fact is irrelevant when determining the level of attention of the informed user (21/05/2015, T-22/13 & T-23/13 , UMBRELLAS, EU:T:2015:310, § 50). Likewise, the mere fact of being faced with a particular design with some frequency does not make the informed user more or less attentive, as the user's level of attention is already, by its very nature, very high (29/04/2020, T-73/19, Wood splitting tools, EU:T:2020:157, § 75).

Obsolete

When the nature of the product in which the compared designs are incorporated makes it possible, the overall impression made by these designs will be assessed on the assumption that the informed user can make a direct comparison between them (18/10/2012, C-101/11 P & C-102/11 P , Ornamentación, EU:C:2012:641, § 54-55).

The degree of freedom of the designer

The designer's degree of freedom depends on the nature and intended purpose of the product in which the design will be incorporated, as well as on the industrial sector to which the product belongs. The Invalidity Division will take into account the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) CDR), as well as the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07 , Metal rappers, EU:T:2010:96, § 56).

The designer's degree of freedom in developing its design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (13/11/2012, T-83/11 & T-84/11 , Radiatori per riscaldamento, EU:T:2012:592, § 44).

In contrast, the designer's degree of freedom was not considered to be restricted in a number of cases (13/06/2019, T-74/18 , Informationstafeln für Fahrzeuge, EU:T:2019:417, § 79), in particular when the product into which the design is incorporated may vary considerably (21/11/2013, T-337/12 , Sacacorchos, EU:T:2013:601, § 36-39) and for instance come in any combination of colours, patterns, shapes and materials (05/07/2017, T-306/16 , Door handles, EU:T:2017:466, § 45-47).

Furthermore, the designer's degree of freedom is not affected by the fact that similar designs coexist on the market and form a 'general trend' or coexist on the registers of industrial property offices (22/06/2010, T-153/08 , Communications equipment, EU:T:2010:248, § 58; 01/06/2012, R 89/2011-3 , Sacacorchos, § 27).

The greater the designer's freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on an informed user. Conversely, the more the designer's freedom in developing the Community design is restricted, the more likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on the informed user (18/03/2010, T-9/07 , Metal rappers, EU:T:2010:96, § 67, 72). Therefore, if the designer enjoys a high degree of freedom in developing a design, this reinforces the conclusion that the designs that do not have significant differences make the same overall impression on an informed user (09/09/2011, T-10/08 , Internal combustion engine, EU:T:2011:446, § 33).

The factor relating to the designer's freedom cannot on its own determine the assessment of the individual character of a design. It only makes it possible to moderate the assessment of the individual character of the contested design, but does not determine how different the two designs have to be in order for one of them to have

Obsolete

individual character (10/09/2015, T-525/13 , Sacs à main, EU:T:2015:617, § 35; 04/07/2017, T-90/16 , Measuring instruments, apparatus and devices, EU:T:2017:464, § 38).

Furthermore, the designer's degree of freedom may vary as regards the different features of a design, and this must be taken into account when assessing to what extent individual features contribute to the design's overall impression.

The overall impression

Unless the designs compared include functional or invisible or disclaimed features (see paragraph 5.7.2 above), the two designs must be compared globally. That does not mean, however, that the same weight should be given to all the features of the designs compared.

First, the informed user uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended. The relative weight to give to the features of the designs compared may therefore depend on how that product is used. In particular, the role played by some features may be less important depending on their reduced visibility when the product is in use (22/06/2010, T-153/08 , Communications equipment, EU:T:2010:248, § 64-66, 72; 21/11/2013, T-337/12 , Sacacorchos, EU:T:2013:601, § 45-46; 21/05/2015, T-22/13 & T-23/13 , UMBRELLAS, EU:T:2015:310, § 97).

Second, when appraising the overall impression conveyed by two designs, the informed user will only give minor importance to features that are totally banal and common to the type of product in question and will concentrate on features that are arbitrary or different from the norm (18/03/2010, T-9/07 , Metal rappers, EU:T:2010:96, § 77; 28/11/2006, R 1310/2005-3 , galletas, § 13; 30/07/2009, R 1734/2008-3 , FORCHETTE, § 26 et seq.).

Third, similarities affecting features in respect of which the designer enjoyed a limited degree of freedom will have only minor importance in the overall impression produced by those designs on the informed user (18/03/2010, T-9/07 , Metal rappers, EU:T:2010:96, § 72).

Fourth, when familiar with a saturation of the prior art due to the density of the existing design corpus, the informed user may be more sensitive to even minor differences between the designs that may thus produce a different overall impression (13/11/2012, T-83/11 & T-84/11 , Radiatori per riscaldamento, EU:T:2012:592, § 81; 12/03/2014, T-315/12 , Radiatori per riscaldamento, EU:T:2014:115, § 87). In order to prove the actual impact of such saturation on the informed user's perception, the holder of the contested RCD must present sufficient evidence of the existing design corpus and its density at the date of filing of the contested RCD or its priority date (10/10/2014, R 1272/2013-3 , RADIATORI PER RISCALDAMENTO, § 36, 47; 09/12/2014, R 1643/2014-3 , Radiatori per riscaldamento, § 51).

To illustrate, it was held that RCD No 1 512 633-0001 created an overall impression different from that produced by the earlier design (RCD No 52 113-0001). In an area in which the designer's degree of freedom in developing his or her design is not limited by any technical or legal restraints, the General Court (GC) upheld the decision of the

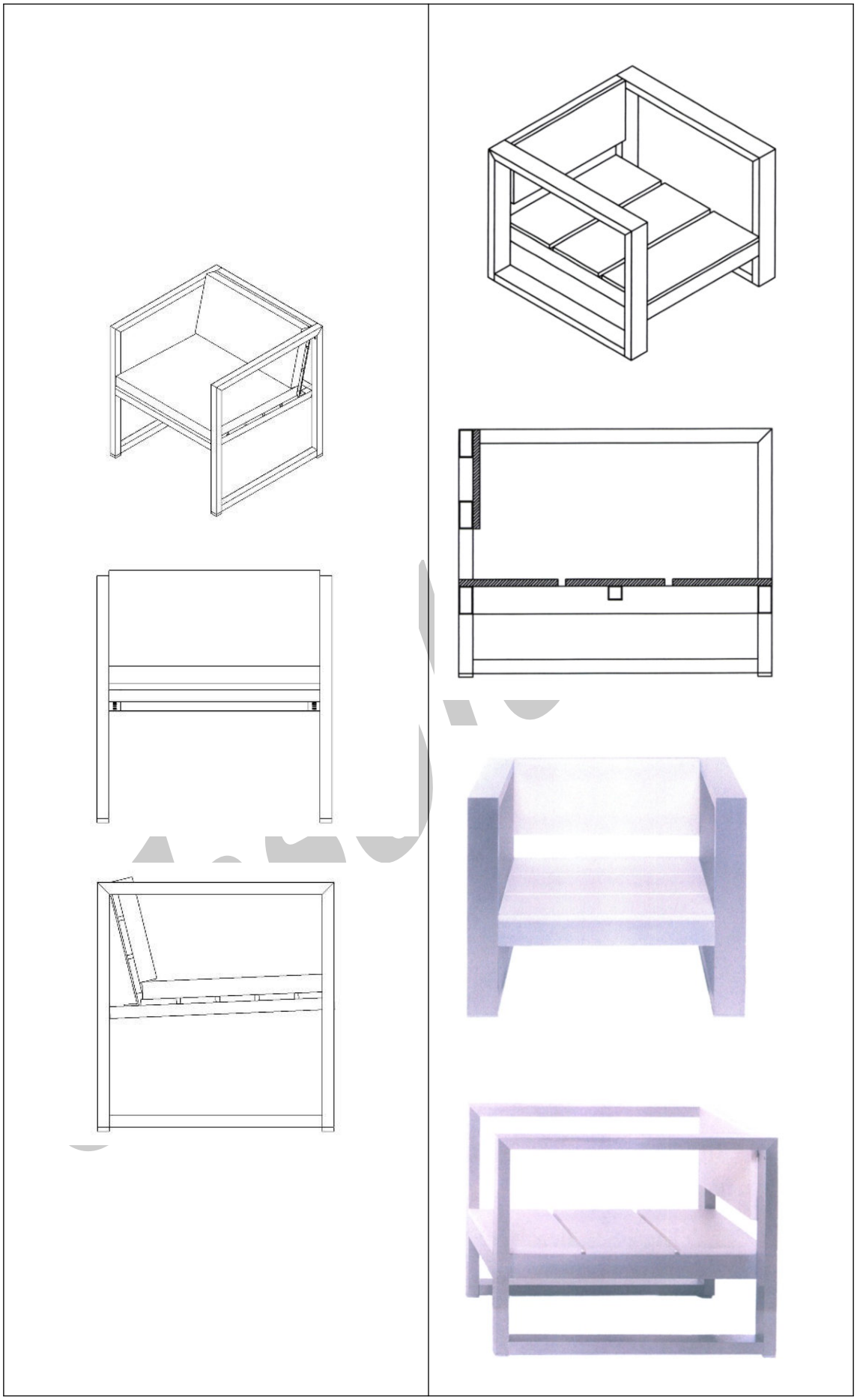
Obsolete

Board of Appeal, which had found that the differentiating features of the two designs below prevailed over their common points. In particular, the fact that the armchair of the earlier design has a rectangular rather than a square shape, that its seat is placed lower and that the arms are broader, was considered decisive in support of the conclusion that the contested RCD had individual character (04/02/2014, T-339/12 , Armchairs, EU:T:2014:54, § 23-37).

According to the GC, account must be taken of the difference between the designs at issue as regards the angle of the backrest and the seat of the armchair represented in the contested design, bearing in mind that the overall impression produced on the informed user must necessarily be determined in the light of the manner in which the product in question is used. Since an inclined backrest and seat will give rise to a different level of comfort from that of a straight back and seat (albeit that comfort does not constitute a feature of appearance), the use that will be made of that armchair by the circumspect user is liable to be affected thereby (04/02/2014, T-339/12 , Armchairs, EU:T:2014:54, § 30).

Contested RCD No 1 512 633-0001	**Earlier RCD No 52 113-0001**

Obsolete

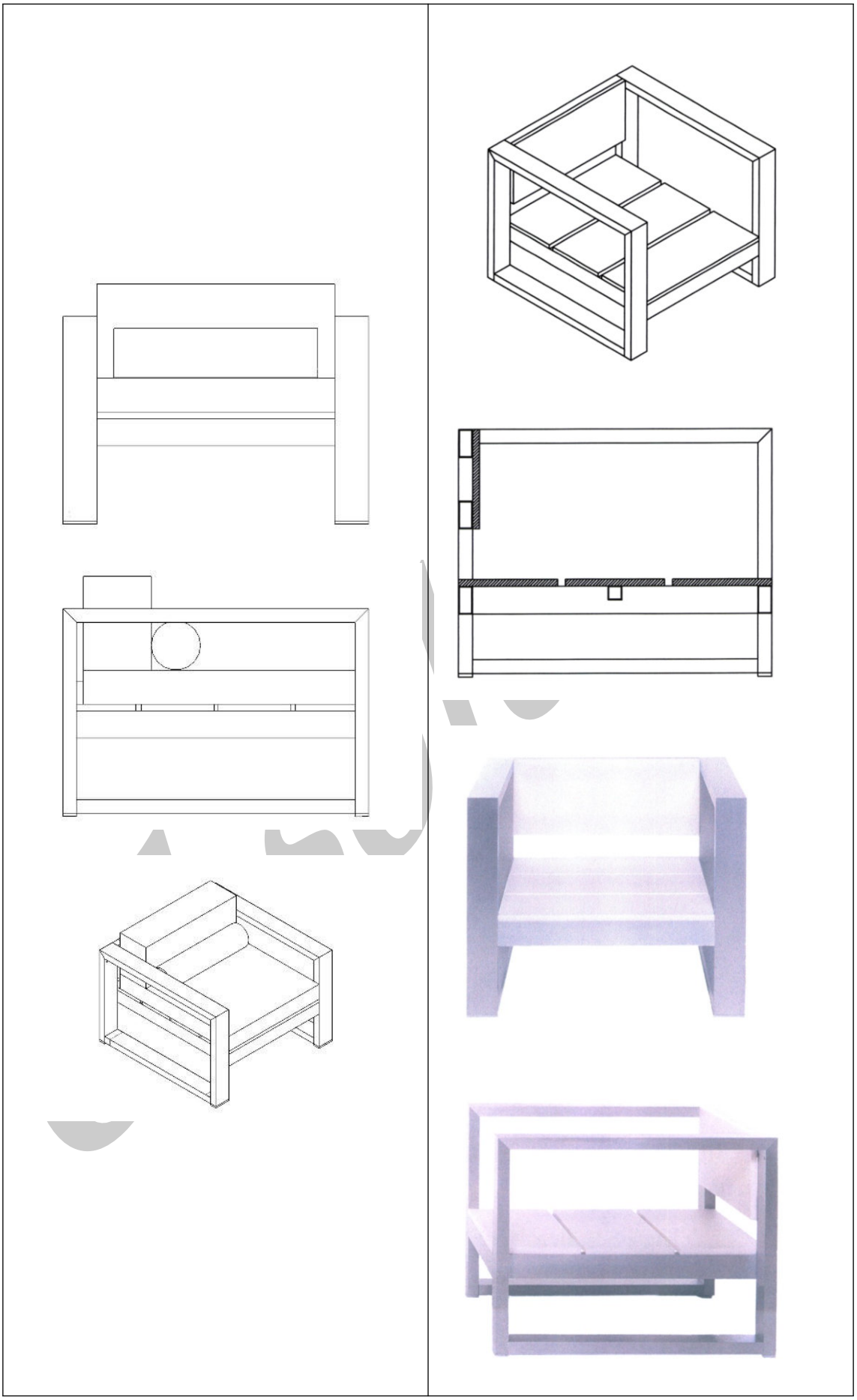


By contrast, the GC found that RCD No 1 512 633-0003 lacked individual character in respect of the same earlier design. It was held that the differentiating features between the designs, including the presence in the contested RCD of three cushions, were outweighed by their common characteristics (the rectangular shape, the flat back and seat, the seats positioned below the mid-section of the armchairs' structure, etc.) (04/02/2014, T-339/12 , Armchairs, EU:T:2014:55, § 44-60).

The GC confirmed the view taken by the Board of Appeal (27/04/2012, R 969/2011-3 , ARMCHAIRS) that the cushions are less important than the structure of the armchairs when assessing the overall impression caused by the designs because the cushions are not a fixed element but can be easily separated from the main product and because they are often sold and purchased separately, at a relatively low cost compared to that of the structure of an armchair. The informed user perceives the cushions as a mere optional accessory. They can hardly be considered to be 'a significant part of the design'. Consequently the overall impression produced by the designs at issue is dominated by the structure of the armchairs itself and not by the cushions, which could be regarded as secondary elements (04/02/2014, T-339/12 , Armchairs, EU:T:2014:54, § 37, 38).

Contested RCD No 1 512 633-0003	**Earlier RCD No 52 113-0001**

Obsolete



5.8 Conflict with a prior design right

Pursuant to Article 25(1)(d) CDR, a Community design will be declared invalid if it is in conflict with a prior design that has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date:

1. by a registered Community design or an application for such a design; or
2. by a registered design right of a Member State or by an application for such a right; or
3. by a design right registered under the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 02/07/1999, hereinafter referred to as 'the Geneva Act', which was approved by Council Decision 954/2006 and which has effect in the European Union, or by an application for such a right.

The purpose of Article 25(1)(d) CDR is to protect the holder of an earlier right that has not been made available to the public before the filing or priority date of the contested RCD and which, therefore, cannot be invoked as a prior design under Article 25(1)(b) CDR in conjunction with Articles 5 and 6 CDR.

Article 25(1)(d) CDR must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the designer's freedom in developing the Community design, the design does not produce a different overall impression on the informed user from that produced by the prior design relied on (18/03/2010, T-9/07 , Metal rappers, EU:T:2010:96, § 52; 21/04/2021, T-326/20 ; Beverage bottles, EU:T:2021:208, § 31).

When dealing with an application based on Article 25(1)(d) CDR, the Invalidity Division will therefore apply the same test as for the assessment of individual character under Article 25(1)(b) in conjunction with Article 6 CDR.

However, Article 25(1)(d) CDR is a relative ground for invalidity, where the contested RCD is to be assessed as possibly being in conflict with and falling within the scope of protection of another protected design right.

Therefore, pursuant to Article 25(1)(d) CDR, the features of the prior design right invoked must be appreciated within the limits of its scope of protection, as determined by its application or registration. This means that the prior design right is to be considered as applied for or as registered, excluding the features disclaimed, if applicable.

The Invalidity Division will assume that the prior design remains valid unless the holder submits proof that a decision that has become final declared the prior design invalid before the adoption of the decision (see, by analogy, 29/03/2011, C-96/09 P , Bud, EU:C:2011:189, § 94-95) (see paragraph 4.1.6.2).

Obsolete

5.9 Use of an earlier distinctive sign

A Community design will be declared invalid if a distinctive sign is used in a subsequent design, and the law of the European Union or the law of the Member State governing that sign confers on the holder of the sign the right to prohibit such use (Article 25(1)(e) CDR).

5.9.1 Distinctive sign and right to prohibit use

The notion of a 'distinctive sign' encompasses registered trade marks as well as all signs that can be relied on in the context of Article 8(4) and 8(6) EUTMR.

In accordance with the practice under Article 8(4) and 8(6) EUTMR, the applicant may also rely on provisions of national law on the prohibition of a later registration.

The applicant must establish only that it has a right to prohibit use of the subsequent Community design. It cannot be required to establish that such right has been exercised; in other words, that the applicant has actually been able to prohibit such use (see, by analogy, 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 191).

Where the earlier distinctive sign is a sign that can be relied on in the context of Article 8(4) and 8(6) EUTMR, the Invalidity Division will apply the corresponding law as explained in the Guidelines, Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR) and Part C, Opposition, Section 6, Geographical indications (Article 8(6) EUTMR).

5.9.2 Use in a subsequent design

The notion of 'use in a subsequent design' does not necessarily presuppose a full and detailed reproduction of the earlier distinctive sign in a subsequent Community design. Even though the Community design may lack certain features of the earlier distinctive sign or may have different additional features, this may constitute 'use' of that sign, particularly where the features omitted or added are of secondary importance and are unlikely to be noticed by the relevant public. It is enough that the Community design and the earlier distinctive sign be similar (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 50-52; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 23; 09/08/11, R 1838/2010-3, INSTRUMENTS FOR WRITING, § 43).

Where a Community design includes a distinctive sign without any disclaimer making clear that protection is not sought in respect of such feature, it will be considered that the Community design makes use of the earlier distinctive sign even if the latter is represented in only one of the views (18/09/2007, R 137/2007-3, Containers, § 20).

Obsolete

5.9.3 Substantiation of the application under Article 25(1)(e) CDR (earlier distinctive signs)

Where an application for invalidity is based on a right held in an earlier European Union trade mark or an international trade mark designating the EU, it is not necessary to submit the law and case-law relating to European Union trade marks in order to substantiate such earlier right under Article 8(1)(b) or Article 8(5) EUTMR; the same applies if the applicant invokes an earlier national registered mark or an international trade mark designating a Member State.

Where the earlier distinctive sign is a sign that could be relied on in the context of Article 8(4) and 8(6) EUTMR, an application must, pursuant to Article 28(1)(b)(vi) CDIR, contain particulars establishing the content of the EU or national law of which the applicant is seeking application including, where necessary, court decisions and/or academic writings (the principles established in the Guidelines, Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR) will apply).

5.9.4 Examination by the Invalidity Division

The examination is carried out in accordance with the law governing the earlier distinctive sign.

Where the earlier distinctive sign is a European Union trade mark, the Invalidity Division will apply the principles established in the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, and Section 5, Trade Marks with Reputation.

Where the earlier distinctive sign is a registered national trade mark, the Invalidity Division will apply the same principles (03/10/2017, T-695/15, Comfit boxes, containers, EU:T:2017:684, § 29).

For the purpose of applying these principles, the Invalidity Division will assume that the contested Community design or an element used in the contested design will be perceived by the relevant public as a sign capable of being used ‘for’ or ‘in relation to’ goods or services (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 107; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 39 and 42).

The Invalidity Division will examine for which goods the contested Community design is intended to be used (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 108). For the purpose of determining whether these goods and services are identical or similar, the Invalidity Division will take into account the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) CDR), and also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56; 07/11/11, R 1148/2010-3, PACKAGING, § 34-37).

Obsolete

Where the Community design is intended to be incorporated in two-dimensional 'logos', the Invalidity Division will consider that such logos may be applied to an infinite range of products and services, including the products and services in respect of which the earlier distinctive sign is protected (03/05/2007, R 609/2006-3, logo MIDAS, § 27).

Where the earlier distinctive sign is a sign that could be relied on in the context of Article 8(4) and 8(6) EUTMR, the Invalidity Division will apply the corresponding law as explained in the Guidelines, Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR) and Part C, Opposition, Section 6, Geographical indications (Article 8(6) EUTMR).

5.10 Unauthorised use of a work protected under the copyright law of a Member State

A Community design will be declared invalid if it constitutes unauthorised use of a work protected under the copyright law of a Member State (Article 25(1)(f) CDR).

5.10.1 Substantiation of the application under Article 25(1)(f) CDR (earlier copyright)

Apart from the elements mentioned under paragraphs 3.5 and 3.10.2 above, an application must, pursuant to Article 28(1)(b)(vi) CDIR contain:

- particulars establishing the content of the national law of which the applicant is seeking application including, where necessary, court decisions and/or academic writings (see, by analogy, 05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452; 23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52); and
- particulars showing that the applicant acquired the rights to the work protected under the copyright law relied on before the filing date or the priority date of the Community design (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 47); and
- particulars showing that the applicant satisfies the necessary conditions, in accordance with that law, to have the Community design invalidated or its use prohibited by virtue of its earlier right.

5.10.2 Examination by the Invalidity Division

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the holder of the copyright invoked and whether unauthorised use of a work protected by the copyright legislation of a Member State, as interpreted by the courts of that Member State, has occurred (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52; 17/10/2013, R 781/2012-3, CHILDREN'S CHAIRS, § 27, 43).

It should be noted that Article 25(1)(f) CDR does not apply to cases in which ownership of the Community design is contested, in particular when the invalidity applicant's

Obsolete

essential argument is that the Community design was created not by the registered holder but by the invalidity applicant or by its employee. The Office has no jurisdiction to determine which of the parties is the rightful owner of the contested Community design since such jurisdiction lies with national courts (11/02/2008, R 64/2007-3, Loudspeakers, § 18-19).

5.11 Improper use of flags and other symbols

A Community design will be declared invalid if it constitutes an improper use of any of the items listed in Article 6*ter* of the Paris Convention, or of badges, emblems and escutcheons other than those covered by the said Article 6*ter* that are of particular public interest in a Member State (Article 25(1)(g) CDR).

The items covered by Article 6*ter* are the following (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal):

- armorial bearings, flags, other emblems, official signs and hallmarks that belong to states and have been communicated to WIPO, although, in the case of flags, such communication is not mandatory;
- armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations that have been communicated to WIPO, with the exception of those already the subject of international agreements for ensuring their protection (see, for example, the Geneva Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces of 12/08/1949, Article 44 of which protects the emblems of the Red Cross on a white ground, the words 'Red Cross' or 'Geneva Cross', and analogous emblems).

Badges, emblems and escutcheons other than those covered by Article 6*ter* and which are of particular public interest in a Member State could include, for example, religious symbols, political symbols or symbols of public bodies or administrations such as provinces or municipalities.

5.11.1 Substantiation of the application under Article 25(1)(g) CDR (flags and other symbols)

Apart from the requirements mentioned under paragraphs 3.5 and 3.10.2 above, when an item that is not listed in Article 6*ter* is invoked, the application must, pursuant to Article 28(1)(b)(vi) CDIR, show that such item is of particular public interest in a Member State.

5.11.2 Examination by the Invalidity Division

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the person or entity affected by the use and whether the Community design

Obsolete

constitutes an improper use of one of the symbols covered by Article 25(1)(g) CDR as listed above.

5.12 Partial invalidity

According to Article 25(6) CDR, a registered Community design that has been declared invalid pursuant to any of the grounds under Article 25(1)(b), (e), (f) or (g) CDR may be maintained in an amended form, if in that form it complies with the requirements for protection, and the identity of the design is retained.

A request for maintenance in an amended form of a registered Community design must be made by the holder before the end of the written procedure. The request must include the amended form. The proposed amended form may consist of an amended representation of the Community design from which some features are removed or which makes clear by means, inter alia, of broken lines that protection is not sought in respect of such features. The amended representation may include a partial disclaimer not exceeding 100 words (Article 25(6) CDR; Article 18(2) CDIR).

The applicant will be given an opportunity to comment on whether the Community design in its amended form complies with the requirements for protection and whether the identity of the design is retained (see paragraph 4.1.4.1 above).

The identity of the Community design must be retained. Maintenance in an amended form will therefore be limited to cases in which the features removed or disclaimed do not contribute to the novelty or individual character of a Community design, in particular:

- where the Community design is incorporated in a product that constitutes a component part of a complex product, and the features removed or disclaimed are invisible during normal use of this complex product (Article 4(2) CDR); or
- where the features removed or disclaimed are dictated by a technical function or for the purposes of interconnection (Article 8(1) and (2) CDR); or
- where the features removed or disclaimed are so insignificant in view of their size or importance that they are likely to pass unnoticed.

The decision to maintain the Community design in an amended form will be included in the decision on the merits terminating the invalidity proceedings.

5.13 Grounds for invalidity that become applicable merely because of the accession of a new Member State

See the Guidelines, Examination of Applications for Registered Community Designs, paragraph 13, Enlargement and the Registered Community Design.

Obsolete

6 Termination of the Proceedings

6.1 Termination of proceedings without a decision on the merits

The invalidity proceedings are terminated without a decision on the merits when:

1. the applicant withdraws its application as a result of an amicable settlement or otherwise; or
2. the holder surrenders the Community design in its entirety and the applicant did not request the Office to adopt a decision on the merits of the case (Article 24(2) CDR; see paragraph 3.8 above); or
3. the contested Community design has lapsed and the applicant did not request the Office to adopt a decision on the merits of the case (Article 24(2) CDR; see paragraph 3.8 above); or
4. the Invalidity Division suspended a number of applications for a declaration of invalidity relating to the same registered Community design. These applications will be deemed to be disposed of once a decision declaring the invalidity of the Community design has become final (Article 32(3) CDIR).

The Invalidity Division informs the parties that the proceedings are terminated without a decision on the merits.

6.2 Decision on costs

6.2.1 Cases where a decision on costs is taken

If a decision on the merits of the case is taken, the decision on apportionment of costs is given at the end of the decision (Article 79(1) CDIR).

In all other cases, where the Invalidity Division closes the case without a decision on the merits, a separate decision on costs is issued unless the parties have agreed on the costs as outlined below.

6.2.2 Cases where a decision on costs is not to be taken

6.2.2.1 Agreement on costs

Whenever the parties inform the Invalidity Division that they have settled the invalidity proceedings with an agreement that includes the costs, the Invalidity Division will not issue a decision on costs (Article 70(5) CDR). The Invalidity Division will apply the

Obsolete

principles explained in the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 6.5.2.1, Agreement on costs.

If no indication is given as to whether the parties have agreed on the costs, the Invalidity Division will take a decision on costs at the same time as confirming the withdrawal of the application. If the parties inform the Invalidity Division that they have reached an agreement on costs after the withdrawal of the application, the decision on costs already issued will not be revised by the Invalidity Division. It is, however, left to the parties to respect the agreement and not to enforce the Invalidity Division's decision on costs.

6.2.2.2 Apportionment of costs

The general rule is that the losing party, or the party that terminates the proceedings by surrendering the Community design, maintaining it in an amended form or withdrawing the application, must bear the fees incurred by the other party as well as all costs incurred by it essential to the proceedings (Article 70(1) and (3) CDR).

If both parties lose in part, a 'different apportionment' has to be decided (Article 70(2) CDR). As a general rule, it is equitable for each party to bear its own costs.

Where a number of applications for a declaration of invalidity relating to the same registered Community design have been suspended, they are deemed to be disposed of once a decision declaring the invalidity of the Community design has become final. Each applicant whose application is deemed to have been disposed of will bear its own costs (Article 70(4) CDR). In addition, the Office will refund 50 % of the invalidity fee (Article 32(4) CDIR).

6.2.2.3 Fixing of costs

Recoverable costs regarding representation and fees

Where the costs are limited to representation costs and the application fee, the decision fixing the amount of costs will be included in the decision on the apportionment of the costs.

The amount which the winning party is entitled to claim is mentioned in Article 70(1) CDR and Article 79(6) and (7) CDIR.

As regards fees, the recoverable amount is limited to the invalidity fee of EUR 350 if the applicant wins.

As regards representation costs, the recoverable amount is limited to EUR 400. This applies both to the applicant and the holder insofar as represented in the invalidity proceedings by a professional representative within the meaning of Article 77 CDR. A winning party no longer represented by a professional representative at the time of taking a decision is also entitled to costs regardless of the stage of the proceedings when professional representation ceased. This is without prejudice to the need to appoint a professional representative where it is mandatory. The amount to be borne

Obsolete

by the losing party is always fixed in euros, regardless of the currency in which the winning party had to pay its representative.

Representation costs for employees, even from another company with economic connections, are not recoverable.

Other recoverable costs

Where the costs include expenses in relation to an oral hearing or the taking of evidence, the registry of the Invalidity Division will, on request, fix the amount of costs to be paid (Article 70(6) CDR). A bill of costs, with supporting evidence, must be attached to the request for the fixing of costs (Article 79(3) CDIR).

The amount of recoverable costs may be reviewed by a decision of the Invalidity Division on a reasoned request filed within 1 month of the date of notification of the awarding of costs (Article 70(6) CDR; Article 79(4) CDIR).

Fixing of costs after remittance of the case to the Invalidity Division for further prosecution

When the invalidity decision has been annulled, wholly or partly, and the case is remitted by the Boards of Appeal, the situation will be the following:

- The first decision (which was appealed) does not become final, not even as regards apportionment or fixing of costs.
- As regards the costs of the invalidity proceedings, one single decision on the apportionment and on the fixing of costs must be taken for the invalidity procedure as a whole.
- As regards the costs of the appeal procedure, it has to be ascertained whether the Boards adjudicated on them. The notion of 'winning party' has to be applied to the outcome of the appeal proceedings, with the result that the decision can be different for the two instances. The amount of reimbursable representation costs for the appeal procedure is EUR 500, which applies in addition to the representation costs for the invalidity proceedings.

6.3 Correction of mistakes and entry in the Register

6.3.1 Correction of mistakes

In Invalidity Division decisions, only linguistic errors, errors of transcription and obvious mistakes may be corrected. They will be corrected by the Invalidity Division, acting of its own motion or at the request of an interested party (Article 39 CDIR).

Obsolete

6.3.2 Entry in the Register

The date and content of the decision on the application or any other termination of proceedings will be entered in the Register once it is final (Article 53(3) CDR, Article 69(3)(q) CDIR).

7 Other procedural issues

7.1 Change of parties

As regards the rules on **transfer and invalidity proceedings, change of name, change of representative** and **interruption of the proceedings due to death or legal incapacity of the applicant or its representative** in the course of invalidity proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 7.5 Change of parties (transfer, change of name, change of representative, interruption of proceedings), as the rules are applicable *mutatis mutandis* to RCDs and RCD proceedings.

8 Appeal

8.1 Right to appeal

Any party to invalidity proceedings has the right to appeal against a decision that affects it adversely. A decision that does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal. Any written communication of such a decision will include a notice that the decision may be appealed within 2 months from the date of receipt of the notification of the decision. Appeals have suspensive effect (Article 55 CDR).

Obsolete

GUIDELINES FOR EXAMINATION OF REGISTERED COMMUNITY DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Parts shared with current trade mark practice

Obsolete

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Editor's note and general introduction

Obsolete

Obsolete

1 Subject Matter

The European Union Intellectual Property Office (EUIPO or the Office), established in Alicante, is responsible for the registration of European Union trade marks (EUTM) and registered Community designs (RCD) under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 and Council Regulation No 6/02 of 12 December 2001. These registrations provide uniform trade mark and design protection throughout the European Union.

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

2 Objective of the Guidelines

The Guidelines on EUTMs and the Guidelines on RCDs exist to improve the coherence, predictability and quality of Office decisions. The Guidelines are designed to bring together, systematically, the principles of practice derived from the jurisprudence of the European Court of Justice, the case-law of the Office's Boards of Appeal, the decisions of the Office's Operations Department and the outcomes of the Office's convergence programmes with EU IP offices.

As case-law evolves, so the Guidelines also evolve. They are adapted to reflect developments in Office practice on a yearly basis by means of an ongoing revision exercise (see paragraph 3 below).

3 Guidelines Revision Process

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

Involving national offices and user associations not only benefits the quality of the Guidelines, but also facilitates convergence, that is, the process of exploring common ground on issues where there may be diverging practices. Making the Guidelines

Obsolete

available in all EU languages will raise awareness of Office practice among Member States and users and make differences in practice easier to identify.

The process involves the following phases:

1. Preparation of the draft Guidelines by the Office
   During this phase, the draft Guidelines are produced by the Office's Knowledge Circles. The three steps of this phase — analysis, drafting and discussion — must be completed in a timely manner. Analysis involves the Knowledge Circles extracting trends from the preceding year's case-law, studying the conclusions of the convergence projects and taking into consideration the comments received in previous years from the Office's users and stakeholders. As the next step, the Knowledge Circles draft the Guidelines. Finally, the texts are discussed within the Knowledge Circles, where representatives of the Office's various units and departments are represented.
2. Consultation of stakeholders
   Once the drafts have been prepared, they are sent simultaneously for consultation to the external stakeholders, national offices and user associations, and internal stakeholders. During a period of at least 3 calendar months, stakeholders have the opportunity to study the drafts and submit their comments and suggestions. At the end of the consultation phase, the Knowledge Circles process the feedback received and implement them into the drafts. The Knowledge Circles can choose to accept or reject a comment, take it on board for the next revision cycle, or mark it as out of scope. A list of outcomes is published annually on the Office's website, containing the outcome of each comment received.
3. Adoption of the Guidelines
   In this phase, the draft Guidelines are sent for translation into the Office languages. After consulting the MB in accordance with Article 153(1)(l) EUTMR and Article 101(b) CDR, the Executive Director adopts the updated Guidelines. The versions in the five Office languages together make up the official text, which is intended to be published in the first quarter of each year. In the event of discrepancies between different language versions, the text in the drafting language (English) will prevail. On a regular basis, the Guidelines will be translated into the remaining official languages of the European Union. These additional translations will be published on the Office's website, and external stakeholders, whether national offices or user associations, will be free to submit feedback on their quality; any linguistic amendments made as a result of this informal feedback will be incorporated into the texts without any formal procedure.
4. Fast-track procedure
   In certain circumstances (e.g., a Court of Justice judgment that has immediate impact on Office practice) the Office can amend the Guidelines in the fast-track procedure outside of the normal time frame outlined above. However, this procedure is the exception to the norm.

Obsolete

4 Structure of the Guidelines

The items dealt with in the Guidelines are set out below.

Introduction

Editor's Note and General Introduction

EUROPEAN UNION TRADE MARKS

Part A: General Rules

Section 1: Means of Communication, Time Limits

Section 2: General Principles to be Respected in the Proceedings

Section 3: Payment of Fees, Costs and Charges

Section 4: Language of Proceedings

Section 5: Parties to the Proceedings and Professional Representation

Section 6: Revocation of Decisions, Cancellation of Entries in the Register and Correction of Errors

Section 7: Revision

Section 8: *Restitutio in Integrum*

Section 9: Enlargement

Part B: Examination

Section 1: Proceedings

Section 2: Formalities

Section 3: Classification

Section 4: Absolute Grounds for Refusal

Chapter 1: General Principles

Chapter 2: EUTM Definition (Article 7(1)(a) EUTMR)

Chapter 3: Non-Distinctive Trade Marks (Article 7(1)(b) EUTMR)

Chapter 4: Descriptive Trade Marks (Article 7(1)(c) EUTMR)

Chapter 5: Customary Signs or Indications (Article 7(1)(d) EUTMR)

Chapter 6: Shapes or Other Characteristics that Result from the Nature of the Goods, are Necessary to Obtain a Technical Result or give Substantial Value to the Goods (Article 7(1)(e) EUTMR)

Chapter 7: Trade Marks Contrary to Public Policy or Acceptable Principles of Morality (Article 7(1)(f) EUTMR)

Chapter 8: Deceptive Trade Marks (Article 7(1)(g) EUTMR)

Chapter 9: Trade Marks in Conflict with Flags and Other Symbols (Article 7(1)(h) and (i) EUTMR)

Obsolete

Chapter 10: Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR)

Chapter 11: Trade Marks in Conflict with Traditional Terms for Wines (Article 7(1)(k) EUTMR)

Chapter 12: Trade Marks in Conflict with Traditional Specialities Guaranteed (Article 7(1)(l) EUTMR)

Chapter 13: Trade Marks in Conflict with Earlier Plant Variety Denominations (Article 7(1)(m) EUTMR)

Chapter 14: Acquired Distinctiveness Through Use (Article 7(3) EUTMR)

Chapter 15: European Union Collective Marks

Chapter 16: European Union Certification Marks

Part C: Opposition

Section 0: Introduction

Section 1: Opposition Proceedings

Section 2: Double Identity and Likelihood of Confusion

Chapter 1: General Principles

Chapter 2: Comparison of Goods and Services

Chapter 3: Relevant Public and Degree of Attention

Chapter 4: Comparison of Signs

Chapter 5: Distinctiveness of the Earlier Mark

Chapter 6: Other Factors

Chapter 7: Global Assessment

Section 3: Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR)

Section 4: Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR)

Section 5: Trade Marks with Reputation (Article 8(5) EUTMR)

Section 6: Geographical Indications (Article 8(6) EUTMR)

Section 7: Proof of use

Part D: Cancellation

Section 1: Cancellation Proceedings

Section 2: Substantive Provisions

Part E: Register Operations

Section 1: Changes in a Registration

Section 2: Conversion

Section 3: EUTMs and RCDs as Objects of Property

Obsolete

Chapter 1: Transfer

Chapter 2: Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings

Section 4: Renewal

Section 5: Inspection of Files

Section 6: Other Entries in the Register

Chapter 1: Counterclaims

Part M: International Marks

REGISTERED COMMUNITY DESIGNS

Examination of Applications for Registered Community Designs

Examination of Design Invalidity Applications

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Obsolete

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 1

Means of communication, time limits

Obsolete

Obsolete

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

Decision No EX-18-5 of the Executive Director of the Office of 3 September 2018 concerning the hours the Office is open to receive submissions by personal delivery relating to Registered Community Designs

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 personal delivery in proceedings relating to Community designs. Notifications issued by the Office can be made by electronic means, 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

Obsolete

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.

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; 25/04/2021, 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 .

Obsolete

3.1 Communications to the Office in writing or by other means

Article 98(3) EUTMR

Article 55(2), (3) and (4) EUTMDR, and Articles 63 and 64 EUTMDR

Articles 65 to 67 CDIR

Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means

Decision No EX-20-10 of the Executive Director of the Office of 22 December 2020 on technical specifications for annexes submitted on data carriers

Fax is expressly identified as a means of communication in all procedures relating to Community designs in Article 47(2)(d) CDIR and Article 51 CDIR, however, pursuant to Article 2 of Decision of the Executive Director No 20-9 on communication by electronic means, due to technical limitations and malfunctions affecting the reliability and preventing the uninterrupted functioning of communications by fax (and that lie beyond the Office's control), **fax can no longer be offered and will no longer be used**, as a means of communication in procedures before the Office.

3.1.1 By electronic means

The accepted means of electronic communication with the Office in **procedures relating to EUTMs and Community designs** is 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.

Nevertheless, exceptionally, where a technical malfunction prevents the applicant from filing through the User Area, an **EUTM or RCD application** submitted by one of the alternative electronic back-up measures available (see below) will be deemed to have been received by the Office provided that the applicant resubmits, within three working days of the original submission, the application for registration of an EUTM or RCD (with the same content) through the User Area, together with the confirmation of receipt clearly identifying the original submission. Failure to comply with these conditions will result in the original submission being deemed as not having been received. For further information on the submission of an **application for renewal of an EUTM or RCD** by one of the alternative electronic back-up measures available, see the Guidelines, Part E, Register Operations, Section 4, Renewal, paragraph 7.

To facilitate resubmission, in the event of a malfunction during the electronic transmission of an application, communication or other document through the specific e-operation or e-filing in the User Area, the Office will make two alternative electronic back-up measures available:

Obsolete

1. an upload solution located in the Communications section of the User Area; this is a general upload platform that allows documents to be attached and sent to the Office.
2. a file-sharing solution outside the User Area; the Office will provide the account holder with access to a secure file-sharing location where the document(s) in question can be uploaded.

Technical details on the accessibility and functionality of both these alternative back-up measures are available in the Conditions of Use of 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.

A series of e-operations (e-filings, e-actions and other e-operations) can be carried out via the User Area. These are accessible after logging into the User Area through the 'Dashboard' or the 'Online Services' sections of the account.

In addition, in certain *inter partes* proceedings, when both parties are registered users of the User Area they can file joint requests that are validated (signed) electronically by the two parties.

If an account holder uses one of the standard e-operations in the User Area to file a submission, that e-operation will prevail over any other statement or observation made by the account holder through other means on the same day, provided that the Office does not receive a withdrawal of the e-operation on the same day (see paragraph 3.1.6) for same day withdrawals).

Where a communication submitted by electronic means, 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 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.

For further information on the User Area, and in particular on the proper use of the user account, please see paragraph 4(b) of the Conditions of use of the user area, annexed to Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means.

3.1.2 By post or courier service

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

Obsolete

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 (28/09/2016, T-400/15; CITRUS SATURDAY / CITRUS, EU:T:2016:569, § 25; 15/03/2011, T-50/09, Dada & Co / kids, EU:T:2011:90, § 67). 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, Opposition Proceedings, 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

Pursuant to Article 55 EUTMDR, any documents or other items of evidence submitted by the party in EUTM proceedings 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.

In *inter partes* proceedings

- annexes submitted by electronic means do not need to be submitted in duplicate;
- annexes submitted by post or courier consisting of paper documents (such as loose sheets of evidence) up to and including size A3 do not need to be submitted in duplicate;
- annexes submitted by post or courier consisting of paper documents larger than A3 or not on paper (e.g. data carriers, physical items of evidence such as product samples) must be submitted in duplicate, with one copy to be sent to the other party.

Where in *inter partes* proceedings relating to EUTMs, a copy is required but not provided, the annexes in question will not be taken into account. However, in *inter partes* proceedings relating to Community designs, the Invalidity Division may invite the party to file a duplicate within a specified deadline.

Obsolete

For further information on items of evidence to be submitted in *inter partes* proceedings for the purpose of establishing use, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 5.3.2.1, Means of evidence, Principles.

In addition to the requirements of Article 55(2) EUTMDR, the Office recommends that the following key aspects of a structured presentation be taken into account in order to facilitate the processing and handling of the files:

1. to ensure a manageably sized file, parties should limit their submissions to items of evidence that are relevant to the case and to the ground/argument in question;
2. if the documentation is sent in different batches, each batch submitted should clearly indicate the total number of batches (including the total number of pages and the number of pages in each batch);
3. for physical specimens such as containers, packaging, etc. a photograph may be taken and submitted instead of the item itself and a duplicate (unless the electronic content of the item is relevant, as in the case of a data carrier);
4. where original documents or items are sent to the Office by mail, they should not be stapled, bound or placed in folders;
5. all items sent in duplicate for forwarding to the other party should be clearly identified; however, where the original is submitted to the Office by electronic means, no second copy needs to be sent.

Data carriers

Annexes to communications may be submitted on data carriers.

The Office considers data carriers to be small portable storage devices such as USB flash drives, pen drives or similar memory units. External hard drives, memory cards, CD ROMs, DVDs and other optical discs, as well as magnetic data carriers of any kind are excluded.

For information on acceptable file formats, file sizes, file structure, file names and the consequences of non-compliance with these technical specifications, see Decision No EX-20-10 of the Executive Director of the Office of 22 December 2020 on technical specifications for annexes submitted on data carriers.

The only acceptable file formats are those listed in the abovementioned decision, namely JPEG and JPG, MP3, MP4, PDF, TIFF, and for 3D models, STL, OBJ and X3D. Files submitted in an executable file format (EXE) are not accepted, nor are those in any encrypted format, even if the resulting executed or unencrypted file is in one of the acceptable file formats.

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.

Obsolete

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.

Where a submission or supporting document has to be signed, the signature must be accompanied by the name of the physical person signing and, if the signature is on behalf of a legal person (company), it must also include an indication of the role of the physical person in the company or their authority as signatory (e.g. Chief Executive Officer, President). The Office identification number (ID) may optionally also be indicated if available. If any of these identification elements are missing from the signature, the Office may issue a deficiency requesting the missing element(s). If a submission is not signed at all, the Office will invite the party concerned to correct the deficiency.

If a deficiency is notified, and 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.

3.1.5 Confidentiality

Article 114(4) EUTMR Article 72(c) CDIR

A party may, upon submitting a document or at a later stage, request that all or part of a document be kept confidential, as long as no request for an inspection of files is pending.

The party concerned must have expressly invoked, and sufficiently justified, a special interest in keeping the document confidential. For further details on invoking confidentiality and special interest, and on the examination process of confidential information, see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files, paragraph 5.1.3. Alternatively, the party may submit evidence in such a way that avoids revealing parts of the document or information that the party considers confidential, as long as the parts of the document submitted contain the required information. For example, where contracts or other documents are submitted as evidence, certain information may be blacked out before being submitted to the Office, or certain pages may be omitted altogether.

In principle, documents of a personal nature such as passports or other identification documents, which are submitted in particular as evidence in relation to requests for transfer, evidence of 'health data', which is submitted in particular as evidence in relation to restitutio in integrum or as supporting evidence for extension requests, and bank account extracts, which may, for example, be attached to applications and requests as evidence of fee payment, because of their inherent personal nature,

Obsolete

confidentiality vis à vis any third parties is justified, and, in principle, overrides any third-party interest.

In *inter partes* proceedings, one of the parties might request the Office to keep certain documents confidential even vis-à-vis the other party in the proceedings. Although the Office can keep documents confidential vis-à-vis third parties (inspection of files), it can under no circumstances keep them confidential vis-à-vis the other party in *inter partes* proceedings. For further details concerning confidentiality in *inter partes* proceedings see the Guidelines, Part C, Opposition Proceedings, Section 1, Opposition Proceedings, paragraph 4.4.4.

3.1.6 Withdrawal of communications

Submissions become effective upon receipt by the Office, provided that the Office does not receive a withdrawal of the submission on the same day. This means that a submission will only be annulled if a letter withdrawing its submission reaches the Office on the same day it was received.

3.1.7 References made to documents or items of evidence in other proceedings

Article 115(3) EUTMR

Article 64(2) EUTMDR

Article 76 CDIR

Decision No EX-20-5 of the Executive Director of the Office of 15 June 2020 concerning the keeping of files

Decision No EX-20-10 of the Executive Director of the Office of 22 December 2020 on technical specifications for annexes submitted on data carriers

The Office may receive observations from a party to the proceedings in which they refer to documents or evidence submitted in other proceedings, for instance, referencing evidence that has already been submitted in one opposition in another opposition.

Such references are acceptable when the party clearly identifies the documents they are referring to. They must indicate the following:

(1) the number and the type of file;

(2) the title of the document;

(3) the number of pages of the document;

(4) the date the document was sent to the Office.

For example, ‘the statutory declaration that was submitted to the Office on dd/mm/yyyy in opposition proceedings B XXX XXX, together with exhibits 1 to 8, consisting of XX pages’.

Obsolete

If the original documents or evidence referred to are physical items of evidence (including data carriers) or paper documents exceeding A3 size, and this evidence is not available in the Office's electronic file, the party referring to this material must, pursuant to Article 64(2) EUTMDR, submit by post or courier a second copy for transmission to the other party within the original time limit (see paragraph 3.1.3). If the party does not submit a copy, they will be invited to submit a second copy for transmission to the other party. If the party refers to all or some of the annexes provided previously on a data carrier, they must submit a copy of the annexes in question with the same content as the originals but complying with the current file sizes and format restrictions and recorded on an admissible type of data carrier (as detailed in Decision No EX-20-10).

A general reference to documents or evidence submitted in other proceedings will not be accepted. In such a situation the party making general reference to other documents or evidence may be invited to specify further within a given time limit. The party will be informed that this time limit granted by the Office must only be used to provide the clear and precise indication of the documents or evidence referred to. If not specified within this time limit, the reference to these documents or evidence will not be taken into account.

The parties should be aware that material submitted in other proceedings and not kept in electronic format may have been destroyed pursuant to Article 115(3) EUTMR. In this case, the party will be invited to submit the original evidence again (original and copy for transmission to the other party). If the material referred to was on a data carrier that has since been destroyed, the new data carrier must have the same content as the original one, and must also comply with, inter alia, the current file sizes and format restrictions and be recorded on an admissible type of data carrier (as detailed in Decision No EX-20-10).

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 Executive Director of the Office of 3 September 2018 concerning public notification

Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on 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

Obsolete

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. In practice, the Office will always opt to notify by electronic means, whenever available.

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

The User Area is the sole platform through which the Office will issue notifications by electronic means, and account holders may not opt-out of this means of receiving electronic communications from the Office as long as the User Area account remains active. This applies equally to new and existing user account holders, including those who may have previously opted-out under the former rules as set out in Article 3(1) of Decision of the Executive Director No EX-19-1. The Office will therefore send all notifications through the User Area, unless this is impossible for technical reasons.

The date on which the document is placed in an account holder's inbox will be recorded by the Office and mentioned in the User Area. The document is deemed to have been notified on the fifth calendar day following the day on which the document is placed in the account holder's inbox, irrespective of whether the recipient actually opened and read it.

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.

Obsolete

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 be able to establish that the notification reached its destination or the date on which it was delivered to the addressee. In this regard, the Office must establish that it had created the conditions for the document to be notified to arrive within the sphere of influence of the addressee. A distinction must be drawn between, first, the transmission of a document to the addressee, which is required for due notification, and, secondly, effective knowledge of that document, which is not required for the notification to be regarded as due notification. Existence of a valid notification to the addressee is in no way conditional on its having actually been brought to the notice of the person competent to deal with it under the internal rules of the entity addressed (22/11/2018, T-356/17, RoB, EU:T:2018:845, § 31-32, and the case-law cited therein).

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.

Obsolete

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. A notification issued by electronic means is deemed to have been notified on the fifth calendar day following the day on which the document is placed in the account holder’s inbox (see paragraph 3.2.1 above) and a notification

Obsolete

issued by post or courier is deemed to have been notified on the tenth day after it was posted (see paragraph 3.2.2 above).

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.

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, 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.

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)).

In the event a time limit is missed, there is no provision requiring the Office to inform a party of the procedures available to it under Articles 104 and 105 EUTMR, nor, a fortiori, is it incumbent on it to advise that party to pursue any particular legal remedy. Therefore the principle of sound administration is not violated by the Office for not informing of the means for rectifying a late submission (04/05/2018, T-34/17, SKYLEADER (fig.), EU:T:2018:256, § 43)

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.

Obsolete

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, Opposition Proceedings, 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 equal to the original term (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.

Obsolete

The **excluded** time limits are the following:

- those laid down in Article 104 EUTMR (*restitutio in integrum*) and Article 105 itself (continuation of proceedings), in order to avoid double relief for missing the same time limit;
- 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 ;
- those laid down in Article 32 (payment of the application fee), Articles 34(1) (right of priority), 38(1) (right of exhibition priority), 41(2) (period to remedy filing deficiencies) and 53(3) (period for renewal), Article 68 (appeal) and Article 72(5) EUTMR (appeal before the Court of Justice), 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 .

However, none of the time limits in **opposition proceedings** (other than the time limit for filing an opposition and paying the applicable fee, as mentioned above) are excluded. Consequently, continuation of proceedings is available for missing:

- 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.

Furthermore, 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. There is no substantive requirement to be fulfilled such as when requesting *restitutio in integrum*; i.e. there is no need to justify the missing of the time limit.

- Request to be submitted **within two months of the expiry of the original time limit**
  The two months available for submitting a request for continuation of proceedings is an **objective** time limit and it is **non-extendable**. Consequently, unlike in the case of

Obsolete

restitutio in integrum, it is irrelevant when the reason of non-compliance with the original time limit has been removed or when the party became aware of missing the original time limit.

The request is deemed to be received only once the applicable fee has been paid (400 EUR).

Once a request for continuation of proceedings has been **granted**, the time limit is deemed to be observed and the opportunity of continuation of proceedings is exhausted. Hence, any **subsequent** request for a continuation of proceedings for the same time limit is, by definition, inadmissible, even if submitted within the time remaining of the two months available for submitting such a request. Conversely, where the initial request for continuation of proceedings is **rejected**, a **subsequent** request for continuation of proceedings will be accepted if it is submitted within the time remaining of the two months available for submitting such a request (and the other requirements are also complied with, i.e. the fee is paid and the omitted act is carried out).

- Omitted act must be carried out **together with the request**
  The omitted act must be carried out together with the request. The Office also accepts if the omitted act is carried out **before submission of the request**, so long as the request is made within the two months of the expiry of the original time limit.

  However, if the omitted act is carried out **after the submission of the request**, the request for continuation of proceedings will be rejected as inadmissible. This is so even in the case where the omitted act is carried out subsequent to the request, but still within the time remaining of the two months open for such a request.
- Omitted act must be **carried out**
  The party requesting continuation of proceedings must perform the procedural act whose time limit it missed (e.g. submit evidence in support of the opposition, request proof use, submit observations in reply to the opposition). If the omitted act is not carried out, the request will be rejected as inadmissible. A request for an extension of time cannot substitute the completion of the omitted act.

  The verification of the admissibility of the request does not entail an examination of whether the submission complies with the **substantive** legal requirements of the omitted act. Therefore, notwithstanding that a request for continuation of proceedings may have been found admissible and the relevant fees charged, the submission for 'carrying out the omitted act' may be found not to comply with the **substantive legal requirements** of the act concerned. Therefore, parties should prepare their submissions completing the omitted act with utmost care so that the request for continuation of proceedings could serve its purpose.

  Examples:

  - in the case of missing the time limit for **substantiation of the opposition**, if together with the request for continuation of proceedings the party submits documents with the purpose of substantiating the opposition, the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted. However, that evidence may be found to be

Obsolete

insufficient to substantiate the opposition later in the course of its **substantive** examination;

- in the case of missing a time limit for **submitting proof of use** in opposition proceedings, if together with the request for continuation of proceedings the party submits documents with the purpose of proving genuine use, the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted. However, that evidence may be found to be insufficient to prove genuine use later in the course of its **substantive** examination;
- in the case of missing a time limit for **requesting proof of use** in opposition proceedings, if together with the request for continuation of proceedings the party submits a properly formulated request for proof of use (i.e. unambiguous, unconditional and submitted in a separate document, in compliance with the formal requirements laid down in Article 10(1) EUTMDR), but the earlier mark is not yet subject to the requirement of use (thus does not satisfy the **substantive** requirement of Article 47(2) or (3) EUTMR), the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted, however, the request for proof of use will be rejected.

However, the **formal** requirements of the omitted act must be complied with in order for the omitted act to be considered as duly **introduced** and, thus, 'carried out'.

Example:

- in the case of missing a time limit for **requesting proof of use** in opposition proceedings, if under a separate heading **within** the request for continuation of proceedings (i.e. not in a separate document as required by Article 10(1) EUTMDR) the party requests proof of use, the request for proof of use will not be considered to have been **introduced**, and thus, the omitted act will not be considered to have been 'carried out'. The request for continuation of proceedings will be rejected as inadmissible.

- Outcome of the request

  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.

  If the Office **rejects** the request for continuation of proceedings, the fee will be refunded, or if not yet debited from the party's current account, it will not be charged (Article 105(5) EUTMR). However, as stated above, the party may introduce a new request if there is still time remaining of the two months open for such a request.

Obsolete

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*.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 2

General principles to be respected in the proceedings

Obsolete

Obsolete

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:2014:305).

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:2012:445, § 51).

Where a party argues that the circumstances of the proceedings are comparable to a previous Office decision, and the Office departs from the position taken in said decision, this needs to be addressed and particular explanations may be required (see the Guidelines, Part A, General Rules, Section 2, General principles to be respected in

Obsolete

the proceedings, Paragraph 3, Other General Principles of EU Law in relation to the principle of sound administration).

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.

Obsolete

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 comparable cases and must carefully consider whether it should decide in the same way or not (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509, § 61 and 66; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 74-75).

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).

Obsolete

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

Obsolete

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.

Obsolete

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.

Neither Article 78(1)(b) EUTMR nor Article 51 EUTMDR impose any obligation on the Office to summon witnesses to oral proceedings where requested by either party. In particular, oral proceedings are not normally necessary where the parties have been able to present their legal and factual arguments in writing.

Where oral proceedings are requested, it is for the requester to explain why the oral testimonies would be more apt to attest the truth of the facts alleged or why it was not able to provide those testimonies in writing or in any other form (18/01/2018, T-178/17, HYALSTYLE, EU:T:2018:18, § 15 to 24).

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

Obsolete

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

Obsolete

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.

Obsolete

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.

Obsolete

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.

Obsolete

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).

Obsolete

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, Opposition Proceedings, paragraph 6.5 and the Guidelines on Examination of Design Invalidity Applications.

6.3 Public availability of decisions

Article 113 EUTMR

Decision No EX-21-4 of the Executive Director of the Office of 30 March 2021 on the Register of EU trade marks, the Register of Community designs, the database of proceedings before the Office, and on the case-law database.

To promote convergence of practices, the Office maintains a case-law database, making publicly available Office decisions defined by the EUTMR, the CDR and the legislative acts adopted pursuant to them, as well as judgments of national and EU courts in intellectual property matters.

Obsolete

For reasons of transparency and in the interest of the public, the Office makes its decisions publicly available upon their notification, irrespective of the fact whether the decisions have become final. This includes making decisions publicly available following the examination of an EUTM application upon their notification, although the EUTM application may remain unpublished following its refusal or a withdrawal of the EUTM application (see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 4, Publication). It also includes decisions even if they are annulled at a later stage, or if they do not become final for any other reason.

The Office's decisions will be kept in the database. Requests for removal of decisions from the database will be refused.

However, before the publication of an RCD pursuant to Article 49 or Article 50(4) CDR, public availability of Office decisions is subject to the restrictions laid down in Article 50(2) and (3) CDR and Article 14(3) CDIR. These include RCD applications refused before reaching registration, and registered RCDs subject to deferment of publication. In both cases the disclosure of content is subject to the restrictions in the aforementioned articles.

Making such decisions publicly available in the database is not to be confused with their entry in the register. The outcome of the decisions is recorded in the EUTM or RCD registers only once they are final.

The judgments and decisions are made available in their original language. Official translations are published where available. The case-law database may contain unofficial translations, where indicated, or may facilitate automatic machine translations for information purposes only.

The case-law database is accessible free of charge on the Office's website through the tool eSearch Case Law.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 3

Payment of fees, costs and charges

Obsolete

Obsolete

1 Introduction

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

The specific rules on the payment of fees and charges in European Union trade mark (EUTM) matters are 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 above 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 172(2) and recital 39 of the 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 (recital 37 of the EUTMR).

  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).

Obsolete

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.

The payment of a fee and indication of the nature of the fee and the procedure to which it refers does not dispense with the obligation to meet the other remaining formal requirements of the procedural act concerned unless expressly established in the EUTMR, the CDR and the secondary legislative acts (e.g. for renewals). 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).

2 Means of Payment

Article 179(1) EUTMR

Article 5 CDFR

Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges

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

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).

Obsolete

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

Every payment must indicate the name of the person making the payment and must include the information the Office needs to immediately identify the payment's purpose.

1. Name

   Regarding **the name of the person making the payment**, the sender's full name must be included in the sender field of the bank transfer.

2. Purpose

   Regarding the **payment's purpose**, the description field of the bank transfer must include the information needed to immediately identify the payment's purpose.

Additionally, it is recommended that contact details be provided either in the sender field or in the description field. This allows the Office to contact the person making the payment should this be necessary.

The Office provides users with a single **payment transaction code**. If a party selects 'bank transfer' as the payment method when filling out an online e-filing form in the User Area, the system will provide a unique eight-digit payment transaction code in the filing receipt. The first two digits stand for the current year, the next five digits are a mix of numbers and letters and the last is a control number (e.g. 2139EDH2).

It is highly recommended to put the payment transaction code in the description field of the bank transfer, preferably at the beginning. This field should also include the nature of the fee, for instance the type of proceedings in abbreviated form (see examples below), and the application or file number. Following these **two crucial items**, other information can be included, such as the name of the party or representative (when different from the person making the payment) and their Office ID number.

Properly filling in the name and description fields in the bank transfer will ensure that the Office identifies the payment correctly and deals with the applications or procedural acts in a timely manner. Since these fields have character limits, it is recommended to use abbreviations where possible and avoid excessive use of spaces or initial zeros in numbers.

The following are suggested abbreviations (or a combination thereof) for the most common transactions before the Office subject to a fee, and can be used, along with the payment transaction code, to assist in identifying the payment:

Obsolete

Description	Abbreviation
Application fee for EUTM or RCD	EUTM, RCD
International application fee	IA
Renewal fee	REN
Opposition fee	OPP
Cancellation fee	CANC
Appeal	R
Recordal	REC
Conversion	CONV
Inspection of files	IOF
Current Account	CA
Owner ID number	OWN ID
Representative ID number	REP ID

For example, when paying for an EUTM filing where a payment code has been provided (2132EDH2), the EUTM application number appears on the receipt (184583674) and it is filed by a Representative that has an ID with the Office (ID 1024891), the preferred description would be '**2132EDH2 EUTM 184583674 REP ID1024891**'.

Another example, where a Representative (ID 1024891) is making a payment to replenish a current account held with the Office (account No 6361), as there would be no individual payment transaction code, the preferred description would be '**CA6361 REP ID 1024891**'.

Incorrect or insufficient information identifying the file the payment is linked to can cause considerable delays in processing the applications or procedural acts.

When the information supplied is **insufficient for the Office to establish the purpose of the payment**, the Office will contact the person making the payment (if they provided their contact details), and specify a time limit within which the missing information must be provided, failing which the payment will be deemed not to have been made and the sum will be reimbursed (if the sender provides the necessary bank details).

Where there is **contradictory information** in the description field identifying more than one file or proceeding, the Office will contact the sender (if they provided their contact details), and specify a time limit for them to clarify which of the files the payment should be linked to. In the absence of clarification, the payment will in principle be considered to be for the file **identified in first place** in the payment description field. For example, a payment of EUR 850 for an EUTM application with two payment transaction codes (e.g. '**2132EDH2, 2141KHG1, EUTM**') in the description field, each relating to a

Obsolete

different EUTM filing. Where the party does not reply to the Office's letter, the payment will be linked to the EUTM application first identified, namely, in the example, the one with the payment transaction code '**2132EDH2**'.

2.2 Payment by debit or credit card

Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021 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

Most online services can be paid for by debit or credit card, provided that payment is made for a service requested through the User Area. However, payment by debit or credit card is not yet available for all of the Office's fees. 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-21-5 of the Executive Director of the Office of 21/07/2021 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,

Obsolete

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-21-5 of the Executive Director of the Office of 21/07/2021 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges.

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.

Obsolete

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. 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. The authorisation must reach the Office before payment is due. Payment will be considered effective on the date the Office receives the authorisation.

If the holder is neither the party nor their representative, the Office will check whether such authorisation exists. Where the authorisation is not on file, the Office will inform the party concerned. In the absence of the submission of the holder's authorisation on time, that is, before payment is due, the party's request to debit the fee will be disregarded by the Office.

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 No EX-21-5 of the Executive Director of the Office of 21/07/2021 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges, 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 No EX-21-5 of the Executive Director of the Office of 21/07/2021 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges.

Obsolete

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-21-5 of the Executive Director of the Office of 21/07/2021 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.

Obsolete

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, Opposition Proceedings, 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 24 EUTMIR
Article 63 CDR
Article 81(2) CDIR
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.

Obsolete

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

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

Articles 16 and 17 of Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021 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 any reason, payment is considered not to have been made. This applies in all cases where the transaction fails.

4.3 Payment by current account

Article 8 of Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021 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-21-5 of the Executive Director of the Office of 21/07/2021 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges 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 on the same day it was submitted, or before the end of the time limit to make the payment, the fee (where applicable) will not be debited from the current account. See paragraphs 5.1 and 5.6 below on the specific conditions for refund of application and renewal fees where payment is made by current account, and Guidelines, Part A, Section 1, Means of Communication, paragraph 3.1.6, Withdrawal of submissions).

Obsolete

5 Refund of Fees

Article 108, Article 179(3) and Article 181 EUTMR

Articles 6(2) and 8(1) CDFR

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.

Where a fee is to be refunded, the refund will be made to the party directly or to the representative on file (if one is appointed) at the time the refund is made. Refunds will not be made to the original payee where this person is no longer on file.

5.1 Refund of application fees

Article 32 and 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 1-month time limit provided for payment or, where later written instruction has been given to immediately debit the current account within that month) before or at the latest on the same day on which the payment is due to be debited.

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

In all the above scenarios, a filing date will not be assigned to the EUTM application.

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

Obsolete

were not required in order to cover the goods and services contained within the original application.

As regards **designs**, if a withdrawal is received before a filing date has been granted, 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, Opposition Proceedings, paragraph 6.4, 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.

Obsolete

5.5 Refund of appeal fees

Article 33 EUTMDR Article 35(3) and Article 37 CDIR

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(7) 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 filed a request for renewal of an EUTM and subsequently either totally or partially (in relation to some classes) withdraws the renewal request, 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 later written instruction was given to debit the current account immediately, before or at the latest on the same day that the payment is due to be debited.

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

Obsolete

5.7 Refund of insignificant amounts

Article 181 EUTMR

Article 9(1) CDFR

Article 18 of Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021 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-21-5 of the Executive Director of the Office of 21/07/2021 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges.

6 Fee Reduction for an EUTM Application Filed by Electronic Means

Annex I A(2) EUTMR

Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on 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-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means in conjunction with the Conditions of Use of the User Area as established in this decision.

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.

Obsolete

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

Obsolete

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 paragraph 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, Opposition Proceedings, paragraph 6.5, Decision on the apportionment of costs. 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).

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 4

Language of proceedings

Obsolete

Obsolete

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.

Pursuant to Article 146(6) EUTMR and Article 80(c) CDIR, when a request is filed using a form provided by the Office pursuant to Article 65 EUTMDR and Article 68 CDIR, the form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

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 (first language). The language of the proceedings will be the language used for filing the application.

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

The second language serves as a potential language for opposition, cancellation and design invalidity proceedings. The second language must be different from the language selected as the first language. The choice of first and second language cannot be changed once the application has been filed.

Obsolete

If the language that the applicant has selected as the first language is one of the five languages of the Office, then this will be used by the Office as the correspondence language.

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

For more information on the linguistic regime and translations for EUTM examination, including the possibility of changing the correspondence language, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 6.

3 Opposition and Cancellation

Article 146(5), (7) and (8) 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.

For more information on the linguistic regime and translations for supporting documents in opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraphs 2.3 and 4.3, and for cancellation proceedings see the Guidelines, Part D, Cancellation, Section 1, Proceedings, paragraphs 2.4 and 3.3.

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:

Obsolete

- 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 about the agreement must reach the Office within 2 months of the official communication sent after the completion of the admissibility examination pursuant to Article 31(1) CDIR.

Where the application for a declaration of invalidity was not filed in that language, the applicant must, on its own motion, file a translation of the application in that language within 1 month of the date when the Office was informed of the agreement. If these legal requirements are not met, the language of proceedings will remain unchanged.

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 65 EUTMDR

Article 24 EUTMIR

Article 68, Article 80(a) and (c), and Article 81 CDIR

Unless otherwise provided, 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. restriction of the list of goods or services, 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 of the respective EUTM or RCD application, 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.

Obsolete

For example, where the first language of the EUTM application is Bulgarian, and the second language is German, a request for transfer of ownership of the EUTM application can be filed in either Bulgarian or German.

Supporting evidence (if needed) may be in any of the official EU languages. However, if it is not in the language of the proceedings, the Office may require a translation into the language of the proceedings or into a language of the Office (RCD proceedings only).

For more information on the linguistic regime and translations concerning Register operations please see the respective sections in the Guidelines in Part E, Register Operations.

5.2 After registration (excluding cancellation and design invalidity)

Article 146(6) EUTMR Article 65 EUTMDR Article 24 EUTMIR Article 68 and Article 80(b) and (c), and Article 81 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.

Furthermore, post-registration requests concerning the same registered EUTM or RCD do not necessarily have to be submitted in the same language. For 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 and/or a transfer of ownership request in French. The only requirement is that the requests are submitted in one of the five Office languages.

Supporting evidence (if needed) may be in any of the official EU languages. However, if it is not in the language of the proceedings, the Office may require a translation into the language of the proceedings or into a language of the Office (RCD proceedings only).

For more information on the linguistic regime and translations concerning Register operations, please see the respective sections in the Guidelines in Part E, Register Operations.

Obsolete

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.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 5

Parties to the Proceedings and Professional representation

Obsolete

Obsolete

1 Introduction - Parties to the Proceedings and Principle of Representation

Articles 3, 5, 119 and 120 EUTMR
Article 7(b) EUTMIR
Articles 14, 52, 77 and 78 CDR
Article 62 CDIR

Any natural or legal person, including authorities established under public law, may be the proprietors of a European Union trade mark (EUTM) and, in general, may be parties to the proceedings before the Office. The only exceptions are certain limitations on the ownership of collective and certification marks (please see the Guidelines, Part B, Section 4, Absolute grounds for refusal, Chapters 15 and 16, on collective and certification marks respectively).

In principle, the right to a registered Community design (RCD) will vest in the designer or its successor in title. However, a legal person may also hold a registered Community design and be party to the proceedings before the Office.

Companies or firms and other legal bodies shall be regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts, and to sue and be sued.

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 5.1.1 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 5.1 below for any exceptions to the general rule). See paragraph 5.2.1 below on the consequences of not appointing a representative, when representation is mandatory, once the EUTM or RCD application has been filed.

Representatives in the sense of Articles 119 and 120 EUTMR must have a place of business or employment in the EEA.

As regards 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,

Obsolete

with the result that the considerations previously applied to the EEA in trade mark matters 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.

The first part of this section (paragraphs 2 and 3) deals with the identification of all parties to the proceedings before the Office.

The second part of this section (paragraph 4) sets out the different types of representatives.

The third part of this section (paragraphs 5 to 9) deals with the appointment of representatives or the failure to do so, and the authorisation of representatives.

The final part of this section (paragraphs 10 and 11) deals with changes and corrections in names and addresses of parties in pre-registration stages. For further information on changes in registrations, please see the Guidelines, Part E, Section 1, Changes in a registration and the Design Guidelines on Examination of applications for registered Community designs, paragraph 11.

2 Parties to proceedings before the Office

Article 112(1) EUTMR

Article 7 of Decision No EX-21-4 of the Executive Director of the Office of 30 March 2021 on the Register of EU trade marks, Register of Community designs, the database of proceedings before the Office, and on the case-law database.

This section of the Guidelines deals with the general provisions on parties to the proceedings. For information on the parties' entitlements in the different procedures before the Office, please see the rules in the relevant sections of these Guidelines. For example, for further information on:

- persons entitled to own EUTM Collective marks and EUTM certification marks, see the Guidelines, Part B, Section 4, Absolute Grounds for Refusal, Chapter 15 Collective Marks, Paragraph 2; and the Guidelines, Part B, Chapter 16 Certification marks, Paragraph 4;
- specific aspects of persons entitled to file an opposition, see the Guidelines, Part C, Section 1, Opposition Proceedings, Paragraph 2.4.2.6;
- specific aspects of persons entitled to file an application for cancellation, see the Guidelines, Part D, Section 1 Proceedings, Paragraph 2.1;
- specific aspects of persons entitled to file an application for international application based on an EUTM (EUIPO as Office of origin), see the Guidelines, Part M, International Marks, Paragraph 2.1.3.1;

Obsolete

- specific aspects of persons entitled to file an application for the declaration of invalidity of a RCD, see the Guidelines, Examination of Design Invalidity Applications, Paragraph 3.5;

All persons that identify themselves as parties to proceedings before the Office are entered into the Office's database and are allocated an identification (ID) number. The ID number can be viewed in the Office's eSearch plus tool available on the Office's website.

The Office encourages parties to always use their ID number to import existing details instead of manually inserting the address and/or any other contact details on any form or in any communication to the Office as this leads to less errors. However, the ID number cannot replace the party's name where it needs to appear on any form or communication.

3 Identification of parties to the proceedings

Article 3 EUTMR

Article 2(1)(b) EUTMIR

Article 1(1)(b) CDIR

Decision No EX-21-4 of the Executive Director of the Office of 30 March 2021 on the Register of EU trade marks, the Register of Community Designs, the database of proceedings before the Office, and on the case-law database.

EUTM and RCD applicants are identified pursuant to the criteria laid down in Article 2(1)(b) EUTMIR and Article 1(1)(b) CDIR respectively. This criteria applies, *mutatis mutandis*, to all parties to proceedings before the Office (e.g. opponents, applicants for revocation or for a declaration of invalidity, applicants for registration of a transfer).

The information required to identify a party is:

- name;
- address;
- the country of domicile if a natural person, or the country in which it is domiciled or has its seat or an establishment if a legal entity.

In an application for an RCD, natural persons must also indicate their nationality.

If the party to the proceedings has previously been allocated an ID number by the Office, it is sufficient to indicate the ID number and the party's name.

Where there are multiple parties to the proceedings, the same identification requirements are required for each one of them.

All of the data identified in the following paragraphs, i.e. 3.1 Name, 3.2 Address and 3.3 Other contact details, will be kept in the database indefinitely (pursuant to Article 112(5) EUTMR and Articles 7(2) and 10(2) and (3) of Decision No EX-21-4). However, the party concerned can request the removal of any personal data from the database

Obsolete

18 months after the expiry of the EUTM, RCD or international trade mark designating the EU, or the closure of the relevant *inter partes* procedure.

Where the name and legal address of a party, or their professional representative, are recorded in the EUTM or RCD Registers, they will be kept indefinitely (pursuant to Article 111(9) EUTMR, Article 69 CDIR, and Article 3(8) Decision No EX-21-4). For information on what data appears in the EUTM and RCD Registers, please see Annex I and II of Decision No EX-21-4.

3.1 Name

3.1.1 Natural persons

Names of **natural persons** must include the person's first name(s) and surname(s) as they appear in official personal identification documents (example: John Steven Smith instead of J.S.Smith).

Where the name provided appears to be that of a physical person but the party has indicated that they are a 'legal entity' and filled in the legal form section with an indication which is not a legal form as such (such as free professional, freelance, sole proprietorship, etc.), the Office will send a notification of a deficiency. If the applicant fails to reply, the Office will change the type of person from 'legal entity' to 'natural person'.

For example, 'John Smith', identified as being a legal entity with the legal form 'freelance', will be changed to a natural person and the legal form deleted.

A natural person may provide any business or trading name as an optional indication in addition to their legal name. For example, natural person 'John Smith trading as Smithy's' is acceptable. See paragraph 3.1.2 for more information on the use of business or trading names.

3.1.2 Legal entities

Names of **legal entities** must be indicated by their official designation (full statutory name) and include the legal form of the entity (if applicable), which may be abbreviated in a customary manner (for example, S.L., S.A., Ltd, PLC). The company's national identification number may also be specified.

Legal entities may provide their business or trading names as an optional indication **in addition to** their official designation (typically indicated by using the legal name followed by 'trading as' or 'acting as' in the title). However, business or trading names must not be used alone, that is to say **instead of** the name of the legal entity. As a general rule, the Office will assume that applicants identified through mere business or trading names without any legal form are not entitled to own property in their own name unless evidence is submitted to the contrary.

Obsolete

For example, 'J. Smith Ltd trading as Smithy's' would be acceptable where 'J. Smith' is the legal name, 'Ltd' is the legal form, and 'Smithy's' is the trading name. Using the same example, 'Smithy's' by itself (with no legal form), will be objected to. See also the example under paragraph 3.1.1.

The name of a legal entity in the process of being founded will be accepted.

The Office strongly recommends indicating the state of incorporation for companies based in the United States of America, where applicable, in order to differentiate clearly between different owners in its database.

If the legal form is not specified or is incorrectly indicated, a deficiency letter requesting this information will be issued. If the deficiency is not remedied the respective request will be rejected as the party cannot be correctly identified pursuant to Article 2(1)(b) EUTMIR and Article 1(1)(b) CDIR.

3.2 Address

The Office recognises two types of address referred to in Article 2(1)(b) EUTMIR and Article 1(1)(b) CDIR: the official 'legal' address of a party and the 'address for service'.

Only one legal address should be indicated for each applicant. Where several addresses are indicated, the Office will only take into account the address that is mentioned first, except where the applicant designates one of the addresses as an address for service.

3.2.1 Legal address

This is the address where the party has its domicile, principal place of business or real and effective industrial or commercial establishment. It is a compulsory requirement for identification. Furthermore the legal address is necessary for the Office to establish if the party needs to be represented or not pursuant to Article 119(2) EUTMR and Article 77(2) CDR.

For legal persons, the legal address is understood to be where the party has its seat, which is the company's registered headquarters or registered head office as appearing on the extract of the company register.

The address must contain all the identification elements required. This normally consists of the street name, street number, city/town, state/county/province and country, since without such details it is not possible to clearly identify the party.

If any of these particulars is missing, the Office will issue a deficiency and set a time limit by which to remedy the deficiency or to provide a valid reason for omitting it.

A post office box or a forwarding (virtual) address on its own does not constitute a legal address unless it can be proven that it is indeed registered as the company's address (e.g. by submitting an extract of the company register).

Obsolete

3.2.2 Address for service

An address for service (also referred to as a correspondence address) is an optional second address a party can provide. The Office will send any post to that address.

By default any correspondence by post will be addressed to the party's legal address unless a different address for service is provided.

3.3 Other contact details

It is not compulsory to provide additional contact details, such as telephone numbers or email addresses. However, providing an email address is recommended to facilitate setting up a user account.

4 Representatives: 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. 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 professionals who, depending on the national law, are fully entitled to represent third parties before national offices (see paragraph 4.2 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 4.3 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 5.4.3 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) or employees of **economically**

Obsolete

linked legal persons (Article 119(3) EUTMR, second alternative; Article 77(3) CDR, second alternative) (see paragraph 4.4 below).

Employees are to be distinguished from **legal representatives** under national law (see paragraph 4.5 below).

4.1 ID numbers and database

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 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.([14])

A representative may have several IDs.

- Associations of representatives may have different IDs for different legal addresses.
- Individual representatives may have one ID as an employee representative and a different ID as a legal practitioner in their own right.
- If a person confirms that they work for two different associations of representatives or from two different addresses, they can have two different numbers attributed. Only the first ID number will be published in the Official Journal.
- It is also possible to have two different IDs, one as a legal practitioner 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 France, see Annex I). The Office, almost invariably refuses requests from legal practitioners to be entered on the list of Office professional representatives, as they are automatically entitled to appear in the database as 'legal practitioners' in their own right and do not need to be admitted onto the Office's list of professional representatives.

Where an ID is requested for any type of representative, the Office may require the person to prove the real and effective nature of their establishment at the address(es) identified. Any evidence submitted should not be limited to the mere existence of premises at these addresses but should prove real and effective business or employment being carried out and invoiced from the different locations.

An ID will not be granted for a post office box or a simple address for service in the EEA. See paragraph 3.2 for the difference between the 'legal address' and the 'address for service'.

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 persons exclusively entitled to represent in RCD matters under Article 78(1)(c) CDR, and type 2 consists of persons entitled to

14 Regarding the processing of mandatory personal data in relation to the tasks of the Office, which includes contact details, see EUIPO's explanatory note on the processing of personal data within the framework of the EUIPO's tasks as laid down in the EUTMR and CDR, accessible in the 'Data Protection' section of the Office's website.

Obsolete

represent in both trade mark and design matters under Article 120(1)(b) EUTMR and Article 78(1)(b) CDR.

On any form and in any communication sent to the Office, the representative's address and contact details may, and preferably should, be replaced by the ID number attributed by the Office, together with the representative's name.

The ID number can be found by consulting any of the files of the representative in question, or in the advanced search options of the Office's eSearch plus tool available on the Office's website: https://euipo.europa.eu/eSearch/#advanced/representatives.

4.2 Representation by legal practitioners

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

A legal practitioner is a professional 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 the Member State in which they are qualified, to act as a representative in trade mark and/or design matters.

4.2.1 The term `legal practitioner'

The professional titles for each EEA Member State are identified in the column 'Terminology for legal practitioner' in Annex 1 of this Section.

4.2.2 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 doubts in this regard.

4.2.3 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 or an address for service does not constitute a place of business (see paragraph 3.2.1, above, regarding the legal address). 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

Obsolete

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. The Office may at any time require evidence that the address provided is, or continues to be, a real and effective place of business.

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.

4.2.4 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' who has already been attributed an identification number as a legal practitioner requests entry on the list of 'professional representatives', the ID number will be maintained but the status will be changed from 'legal practitioner' to 'professional representative' following prior consultation with the applicant. Please refer to paragraph 4.1 above concerning the situations where multiple ID numbers may be allocated to one person.

Annex 1 gives a detailed explanation of the specific rules and terminology 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.

Obsolete

4.3 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) and (c) 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:

1. the Office's list of professional representatives according to Article 120(1)(b) EUTMR and Article 78(1)(b) CDR (in trade mark and design matters);
2. the list of professional representatives according to Article 78(1)(c) CDR (in design matters).

For this category of professional representatives, the entry on the Office's list of professional representatives 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 and terminology 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 or design 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.

Obsolete

4.3.1 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.

4.3.1.1 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.

4.3.1.2 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, that is to say, representation in trade mark matters is open to anybody, 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 4.3.4 below).

Obsolete

4.3.1.3 Third alternative - recognition by a Member State of the EEA

Where, in the EEA Member State concerned, the entitlement is not conditional upon possession of special professional qualifications, that is to say, representation in trade mark matters is open to anybody, 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.

4.3.2 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.

It is possible for the Executive Director of the Office to grant an exemption from the nationality requirement (see paragraph 4.3.4 below).

A professional representative requesting to be entered on the list must have his or her place of business or employment in the EEA. A post office box address or an address for service does not constitute a place of business. The place of business or employment need not necessarily be the only place of business or employment of the representative. The Office may at any time require evidence that the address provided is, or continues to be, a real and effective place of business or employment.

4.3.3 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.

Where block certificates are issued, the national offices send regularly updated lists of professional representatives entitled to represent clients before their office. In these cases the Office will check the indications in the request against the entries on the lists communicated to the Office.

Otherwise, the person concerned must accompany his or her request with an individual certificate. The applicant must complete the application form (which can be accessed online at https://euipo.europa.eu/ohimportal/en/forms-and-filings) and send it to the

Obsolete

respective industrial property office of the Member State concerned. The certificate must be completed by the respective industrial property office.

4.3.4 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 an EEA Member State, provided that the professional representative demonstrates that he or she is a 'highly qualified professional'. He may also grant an exemption from the requirement of having regularly represented in trade mark matters for at least 5 years, provided that the professional representative demonstrates that he or she has acquired the required qualification in another way. This power is of a discretionary nature.

The broad discretionary power to grant exemptions from the 5 years' experience requirement or from EEA nationality requirement pursuant to Article 120(4) EUTMR and Article 78(4) CDR will be exercised by the Executive Director of the Office with due regard to the fact that the provision (i) does not confer any right to the person requesting the exemptions, (ii) is conceived as an exception from the general rule, which needs to be applied restrictively and on a strictly individual basis only, and (iii) can also be based on more general considerations such as the absence of any need for additional professional representatives.

1. Exemptions from the 5 years' experience requirement

   Exemptions from the requirement for 5 years' experience are limited to cases where the qualification to act as a representative in trade mark or design matters, has not been achieved before the central industrial property office concerned, but rather was acquired in another way, for the equivalent period of at least 5 years.

   It should be noted that such exemption can only be requested where the requester is entitled to act in EEA Member States in which no 'special professional qualification' is required.

   It should also be noted that the experience equivalent to at least 5 years of habitually acting as a representative before the central industrial property office concerned, to be established by the requester (with supporting evidence), must have been obtained in the EEA Member State concerned. For example, if an exemption is requested from the 5 year requirement to act before the central industrial property office of Member State 'A' (e.g. Malta), the evidence of habitually acting as a representative must emanate from that same Member State (Malta), and not from another EEA Member State (e.g. Ireland).

2. Exemptions from the EEA nationality requirement

Obsolete

Exemptions from the EEA nationality requirement are limited to requesters that already comply with the requirements of Article 120(2)(b) and (c) EUTMR, namely they have their place of business in the EEA, and they are entitled under national law to represent third parties before the national industrial property office.

In addition, it should be noted that exemptions from the EEA nationality requirement are only conceivable for a 'highly qualified professional', that is in exceptional circumstances.

This legal condition of being a 'highly qualified professional' would at least, and without being necessarily sufficient in themselves, require the requester to demonstrate (with supporting evidence) that his or her professional experience:

- is specifically related to trade mark and design matters,
- has been specifically obtained 'acting as a representative' in trade mark and/or design matters,
- is attributable to a specific trade mark and/or design portfolio, including elements such as the relevance of the IP rights managed, such as prominent cases and those that are proved to be difficult or standout due to the complexity of the subject or grounds tackled,
- has been performed under his or her own responsibility and authority,
- has been acquired exercising his or her national entitlement to represent others in trade mark or design matters before the national office in relation to which the requester holds that entitlement within the meaning of Article 120(2)(c) EUTMR,
- exceeds the minimum requirement of 5 years' duration laid down in Article 120(2)(c) EUTMR if the entitlement to represent is based on experience and not on qualification.

The following circumstances would, on their own, not be considered to demonstrate that the requester is a 'highly qualified professional' for the purposes of the exemption from the EEA nationality requirement. However, provided that the aforementioned requirements are fulfilled, these could be considered in the overall assessment of all relevant factors:

- experience in IP-related areas of laws other than trade marks and designs (e.g. patents, copyright, etc.);
- formal qualifications (i.e. Trade Mark Attorney, European Patent Attorney, etc.);
- experience achieved under supervision, assisted by others, as part of a team, etc.
- publications, research or articles in recognised peer-reviewed journals or specialised publications, book authorship, experience in IP educational field.

Any request for exemption, which is not subject to any time limit, should be filed using the form provided for this purpose available on the Office's website. All the arguments and evidence the requester deems necessary to support the claims must

Obsolete

be filed together with that request. The Office will decide on the basis of that request.

That decision might be appealed before the General Court of the European Union under the conditions laid down in Article 263(4) TFEU.

As regards exemptions from the nationality requirement for professional representatives in design matters, Article 78(6)(a) CDR does not refer to the requirement of a 'highly qualified professional'. Instead it requires the existence of 'special circumstances'.

However, the broad notion of 'special circumstances' does not preclude that the applicant must show that he or she is a 'highly qualified professional' in order to be exempted from the EEA nationality requirement for the purposes of the decision to be taken pursuant to Article 78(6)(a) CDR. The 'special circumstances' of the latter provision encompass the requirement of being a 'highly qualified professional'.

4.3.5 Procedure for entry on the list

Articles 66(1) and 120(3) EUTMR, Article 162 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 of professional representatives are not fulfilled, a deficiency will be notified. If the deficiency is not remedied, the request for entry on the list will be rejected. 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. Where a request for entry on the list of professional representatives is accompanied by a request for exemption because one of the necessary conditions for entry on the list is missing (see paragraph 4.3.4 above), where the granting of that exemption has been refused by a final decision of the Executive Director, there will be no subsequent decision refusing entry on the list of representatives. This formal subsequent decision will only be issued where the requester explicitly requests it.

Obsolete

4.3.6 Amendment of the list of professional representatives

4.3.6.1 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;
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.

Obsolete

4.3.6.2 Suspension of the entry on the list

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

Upon notification by the relevant national industrial property office of a decision on the suspension of the entitlement to represent natural or legal persons before the respective national industrial property office, the entry of the professional representative on the Office's list of professional representatives or designs list will be suspended. The representative will be informed accordingly.

4.3.7 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 4.2 above).

4.4 Representation by an employee

Article 119(3) EUTMR

Articles 1(j) and 74(1), Article 65(1)(i) EUTMDR

Article 77(3) CDR

Article 62(2) and Article 68(1)(i) CDIR

4.4.1 General considerations

A party to the proceedings before the Office, whether a natural or a legal person, having their domicile or principal place of business, or a real and effective industrial or commercial establishment in the EEA, may be represented before the Office by an employee (Article 119(3) EUTMR, first sentence and Article 77(3) CDR, first sentence).

Employees of the legal persons described above may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons do not have their legal address within the EEA (Article 119(3) EUTMR, second sentence and Article 77(3) CDR, second sentence).

Obsolete

The acceptability of an employee representative therefore depends on whether the represented party is a natural or a legal person, whether the represented party has its legal address within or outside the EEA, and whether the employee is employed directly or indirectly by the represented party, as explained below.

For the definition of legal address, as identified in the represented persons ID number, see paragraph 3.2.1.

The following situations can therefore be differentiated:

- Natural persons whose legal address is within the EEA may be represented by an employee employed by them. The employee may or may not work from the represented natural person's legal address, but the employee must be employed by this natural person. For example, the employee may work from a place of business that is different from the legal address of the natural person.
- Natural persons whose legal address is outside the EEA cannot be represented by an employee.
- Legal persons whose legal address is within the EEA may be represented by an employee directly employed by them. This means the employee may work directly for them at this legal address. It may, however, also be employed by them indirectly. This 'indirect' employee can either work for the represented legal person through another place of business or another real and effective establishment owned by them under a different address within the EEA; or be employed by another legal person within the EEA which is economically linked to the first legal person.
- Legal persons whose legal address is outside the EEA may only be represented by an 'indirect' employee, through an employee working for the represented legal person through another place of business or real and effective establishment owned by them under a different address within the EEA, or be employed by another legal person within the EEA which is economically linked to the first legal person. Regarding the requirements of indirect employee representation see below paragraph 4.4.2.

For all these situations the employee representative must be a natural person and be located in the EEA. An employee located outside the EEA may not represent their employer before the Office.

On the forms made available by the Office, the employee signing the application or request must fill in the field reserved for representatives by indicating his or her name, address (of employment) and select the checkboxes relating to employee representative.

The name(s) of the employee(s) will be entered in the database and published under 'representatives' in the EUTM and RCD Bulletins and in the Office's database accessible through the eSearch plus tool. However, they will not be entered in the respective EUTM and RCD Registers.

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 and Article 79(7)(c), (d) and (f) CDIR are not applicable for the

Obsolete

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.*).

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 sets down that a 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 verify the first time an employee representative claims to represent an employer. At a later stage it may also do so where it has reason to doubt that the employment relationship continues to exist, such as when different addresses are indicated or when one and the same person is nominated as the employee of different legal persons.

4.4.2 Indirect employment

As outlined in paragraph 4.4.1 when a legal person is a party in proceedings before the Office, they can also be represented by an employee, even if that employee does not work directly for the legal person identified by the legal address. This is particularly relevant for legal persons with a legal address outside the EEA since representation is mandatory for them (see paragraph 5.1 below). These non-EEA legal persons may be represented by an employee in the following two scenarios:

- first, legal persons with a legal address outside the EEA , but having a real and effective industrial or commercial establishment within the EEA , may be represented before the Office by an employee of this EEA-based establishment;
- second, legal persons with a legal address outside the EEA may be represented by an employee of another legal person within the EEA provided that both legal persons are economically connected.

For the definition of legal address as identified in the represented persons ID number, see paragraph 3.2.1 .

In the **first scenario** , to successfully claim an employee representative, the represented legal person must show that even though their legal address is outside the EEA, they also have a real and effective industrial or commercial establishment in the EEA, e.g. by proving that they own or control a branch, agency or any other kind of commercial establishment (including subsidiaries) in the EEA to such extent that it can be considered an extension of the non-EEA legal person.

The concept of 'branch, agency or other establishment' implies a place of business which has the appearance of permanency, such as the extension of a parent body, has a management and is materially equipped to negotiate business with third parties so that the latter, although knowing that there will if necessary be a legal link with the parent body, the office of which is abroad, do not have to deal directly with that parent body but may transact business at the place of business constituting the extension (see definition in 22/11/1978, C-33/78, Somafer, EU:C:1978:205, § 12; also quoted in 22/09/2016, T-512/15 , Sun Cali (Fig.), EU:T:2016:527, § 30).

Obsolete

Proof of employment at the EEA-based establishment must also be provided for the employee representative.

For example, the EUTM applicant is a company with a legal address in the US. However, it can **prove** that it owns a branch in Spain. The party must **claim and prove** that the natural person identified as the employee representative works for the establishment in Spain. An employee working for this Spanish establishment can then represent the US EUTM applicant before the Office.

In the **second scenario** , to successfully claim an employee representative, the legal assessment is similar. Firstly, the legal person must show that the other legal person exists within the EEA; secondly, that there is a sufficiently strong economic connection between the represented party and the EEA-based legal person; and thirdly, that the employee representative truly works for the EEA-based legal person.

For example, 'Company A LLC' with a legal address in the US is party to the proceedings before the Office. It can show that it is economically linked to 'Company B Ltd.' in Ireland. John Smith is employed by 'Company B Ltd.' in Ireland. Consequently, John Smith may act as an employee representative of the US-based 'Company A LLC'.

Similar to the first scenario, economic connections only 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 for example:

- 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 do not establish economic links:

- 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.

All the arguments and evidence the requester deems necessary to support the claims, including any evidence to prove the existence and nature of the link between the different entities and any proof of employment, must be submitted together with the request. If this evidence is not submitted, the Office will issue a deficiency.

4.5 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.

Obsolete

In all cases, a natural person that is acting as a legal representative, should indicate 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 5.1 for any exceptions to the general rule). See paragraph 5.2.1 on the consequences of not appointing a representative, when representation is mandatory, once the EUTM or RCD application has been filed.

5 Appointment of a Professional Representative

5.1 Conditions under which appointment is mandatory

Subject to the exceptions outlined in paragraph 4.4 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.

5.1.1 Domicile, principal place of business, or real and effective industrial or commercial establishment

The criterion for mandatory representation is determined by the legal address of the represented person, not their 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. For more information on the legal address, see paragraph 3.2.1.

The criterion 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. For more information on situations where a party may have a legal address outside the EEA but may also have a real and effective industrial or commercial establishment within the EEA, please see

Obsolete

paragraph 4.4.1, which deals with this concept for the purpose of determining if an employee representative is entitled to represent.

5.1.2 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, 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.

5.2 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 5.1, 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.

5.2.1 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.

Obsolete

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.

5.2.2 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).

5.2.3 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

Obsolete

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.

5.3 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 6 below).

5.4 Appointment/replacement of a representative

5.4.1 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 (as concerns the appointment of multiple representatives, see paragraph 6 below).

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

Obsolete

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 7.2 below.

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

5.4.2 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.

Obsolete

5.4.3 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.

In order for the Office to grant an ID number to an association of representatives (see paragraph 4.1 above), there must be at least two legal practitioners or professional representatives practising within that association or partnership that comply with the requirements of Article 120(1) EUTMR or Article 78(1) CDR and that have already obtained individual ID numbers from the Office assigned to the address of the association. This information should be submitted with the initial request.

Where the Office had doubts that the association has at least a minimum of two members complying with the requirements, or doubts regarding the continued presence of at least two qualified association members, the Office will issue a deficiency notification. This deficiency may be issued at the time of examining the initial request, or at any later stage. In the event the deficiency is not remedied, any existing association ID number will be invalidated, and any files assigned to this existing ID will be moved to the individual ID of the only existing member of the 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. It is strongly recommended that any changes and information concerning representatives joining or 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 legal practitioners and 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

Obsolete

individual ID number, if one has been provided by the Office, or his or her association ID number.

6 Communication with Parties and 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 party represented files documents itself with the Office while being represented by a duly authorised representative, these documents will be accepted by the Office as long as the party represented has its domicile or principal place of business or a real and effective industrial or commercial establishment in the EEA. However, the Office will reply to the appointed representative, not to the party directly. Where the represented party has its domicile or principal place of business or a real and effective industrial or commercial establishment outside the EEA, these documents will not be taken into account.

Article 60(2) and Article 73 EUTMDR

Article 53(2) and Article 61 CDIR

A party to the proceedings before the Office may appoint up to a maximum of two 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 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.

Obsolete

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.

7 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 5.2 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.

Obsolete

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. 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.

7.1 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.

7.2 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

Obsolete

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.

7.3 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 5.2 above will apply.

8 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.

8.1 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 5.2 above will apply.

Obsolete

8.2 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.

9 Death or Legal Incapacity of the Party Represented or Representative

9.1 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, Entitlement Proceedings or Similar Proceedings.

Obsolete

9.2 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).

10 Change of name and address

Article 55 and Article 111(3)(a) and (b) EUTMR

Article 19 CDIR, Article 69(3)(a) and (b) CDIR

The name and legal address of an EUTM or an RCD applicant, a party to the proceedings, or a representative may be amended.

A change of name is limited to a change that does not affect the identity of the person, for example, where there is a change in the name (through marriage/divorce), or in the case of a legal person, where the company officially changes its name in the company register.

On the other hand, a change in the party's identity may be a transfer or a change of ownership. In the event of any doubt as to whether a change will be considered a transfer or a change of ownership, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer. That chapter provides detailed information in this respect as well as the applicable procedure.

A representative's name and address may be amended, provided that the representative is not being substituted by another representative. That would be considered an appointment of a new representative, which is subject to the rules governing such an appointment.

Where the address of an association of representatives is changed, the address of all of the association members must also be updated. As seen in paragraph 5.4.3, the

Obsolete

address linked to the ID numbers of the members of an association and the address linked to the ID number of the association itself must all coincide.

A change of name or address can be requested by the affected person. The request must contain the EUTM/RCD number (or the file number assigned to the proceedings in question) and the name and address of the party or representative, both as on the file and as amended. The ID number should also be provided. The request is free of charge.

Where there is any doubt, the Office may ask for proof such as an extract from a trade register, or other evidence, to corroborate the change of name or address.

Changes to the parties' or representatives' name or address will be reflected in the ID number assigned to the party or representative. Consequently, the change will be reflected in all proceedings where this ID is assigned, including all EUTM and RCD applications and pending proceedings. The change cannot be recorded only for a specific portfolio of rights.

For changes in the name or address of the proprietor of a registered EUTM or RCD, see the Guidelines, Part E, Register Operations, Section 1, Changes in a registration.

11 Correction of the name or address

Article 31(1)(b) EUTMR, Article 49(2) EUTMR

Article 11 EUTMDR

Article 36(1)(b) CDR

Article 12(2) CDIR

The name and legal address of an EUTM or an RCD applicant, a party to the proceedings, or a representative may be corrected in case of errors in the respective application or request.

Firstly, corrections pursuant to Article 49(2) EUTMR and Article 12(2) CDIR will be allowed where the error in the name or address that requires correction is considered **obvious**, that is, nothing else could have been intended other than what is offered as the correction. Examples of obvious errors in the name or address could be misspellings, typographical errors, errors of transcription or use of an abbreviated form in the names of natural persons (e.g. 'Phil' instead of 'Phillip').

Additionally, a correction could also be considered in this scenario where there is a typographical error in the legal form (e.g. S.A. was indicated in the application form instead of S.L.). This correction would require evidence to be submitted in support of the request.

Where a correction takes place in the name or address of an EUTM or RCD applicant pursuant to Article 49(2) EUTMR and Article 12(2) CDIR, this correction will have no consequences as regards the filing date of the application, because the applicant is deemed to be correctly identified from the beginning pursuant to Article 31(1)(b) EUTMR and Article 36(1)(b) CDR.

Obsolete

Secondly, errors that are **not considered to be obvious** and that lead to the **change in identification of the EUTM or RCD applicant** can take place, but they do not fall under Article 49(2) EUTMR and Article 12(2) CDIR. They will lead to a change in the filing date of the application, as the correct identification of the applicant is a formal requirement for the granting of a filing date pursuant to Article 31(1)(b) EUTMR and Article 36(1)(b) CDR. The new filing date of the application will be considered to be the one on which the corrected (new) applicant is formally identified and all supporting evidence is submitted in support of the correction.

In this second scenario, the burden of proof is on the party that made the mistake to prove what needs correcting and why it needs correcting. A request for correction of a name which consists of replacing one name with another will require evidence of what needs correcting and the evidence will also need to link the correction to the EUTM/RCD application (or file) in question. For example, where a representative informs the Office that the wrong EUTM applicant was indicated in the EUTM application form by mistake, the evidence must show that the party (as requested to be corrected) bears a relation with the EUTM application in question. A request simply informing the Office that the correction is needed because someone made a mistake, or another applicant was intended, or there was a change of mind after filing, will not be accepted.

Requests for correction of errors must contain the file number of the application or proceeding, the erroneous name or address and its corrected version, and evidence in support of the request for correction where applicable.

Corrections should not be confused with requests for changes of name or address, see paragraph 10.

Obsolete

Annex 1

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OPA – The Austrian Patent Office **(Austria)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Rechtsanwalt'**	Persons holding the title **'Rechtsanwalt'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Austrian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Zugelassener Vertreter'** **'Patentanwalt'** or **'Notar'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the titles **'Patentanwalt'** or **'Notar'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
BOIP – Benelux Office for Intellectual Property **(Benelux)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Advocaat', 'Rechtsanwalt'** or **'Avocat'**	Persons holding the titles **'Avocat'** , **'Advocaat'** or **'Rechtsanwalt'** (meaning a lawyer admitted to the bar), are entitled to act as legal practitioners before the Benelux industrial property office pursuant to national laws, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Gemachtigde' , 'Patentanwalt'** or **'mandataire'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Benelux Office for Intellectual Property. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Benelux Intellectual Property Office **(Option a).** Persons in possession of a professional qualification officially recognised under the regulations laid down by the States of Belgium, the Netherlands or Luxembourg, certified by the central industrial property office of the Member State concerned, are not subject to the 5-year requirement before the BOIP to act as a professional representative before the EUIPO **(Option b)** .

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
BPO – Patent Office of the Republic of Bulgaria **(Bulgaria)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**Адвокат** ('Advokat')	Persons holding the title **'Адвокат'** (Attorney) are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Bulgaria, and consequently they are entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**Представител по индустриална собственост'** ('Predstavitel po industrialna sobstvenost')	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Представител по индустриална собственост'** ('IP representative') have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.
SIPO – State Intellectual Property Office of the Republic of Croatia **(Croatia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'odvjetnik'**	Persons holding the title **'odvjetnik'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Croatian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Ovlašteni zastupnici'** **'Zastupnik Za Žigove'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Zastupnik Za Žigove'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. An exam must be passed, before the Croatian Intellectual Property Office, in order to obtain this qualification.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Industrial Property Office of the Czech Republic **(Czech Republic)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Advokát'**	Persons holding the title **'Advokát'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of the Czech Republic, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Kvalifikovaných zástupců'** **'Patentový zástupce'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentový zástupce'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. The Czech Republic has a two-part examination: • Persons who have passed part B only (on 'trade marks and appellation of origin') may act as representatives in this field and hence be entered on the list of Article 120(1)(b) EUTMR to represent in trade mark matters . Patent attorneys ***('Patentový zástupce')*** , who have passed both parts of the examination, are therefore entitled to represent applicants in all procedures before the EUIPO (i.e. both trade mark and design matters).

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Department of the Registrar of Companies and Official Receiver **(Cyprus)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'δικηγόρο'** ('Dikigoros')	Only persons holding the title **'Δικηγόρος'** (or 'Dikigoros'), are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Cyprus, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'εγκεκριμένων αντιπροσώπων'**	n/a

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
DKPTO – Danish Patent and Trademark Office **(Denmark)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'advokat'**	Persons holding the Danish title **'Advokat'** meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Danish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Godkendte mødeberettigede'** **'Varemaerkefuldmaegtig'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Anyone may act before the national industrial property office in trade mark matters . In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the national office **(Option a)** . In addition, persons holding the title **'Varemaerkefuldmaegtig'** are officially recognised as professionally qualified to represent third parties before the national office in trade mark and design matters and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b).**

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
EPA – Estonian Patent Office (Estonia)	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'õigusala töötaja' 'Jurist'** and **'Advokaat'**	Persons holding the titles **'Jurist'** and **'Advokaat'** who are also qualified as IP attorneys are entitled to act as legal practitioners before the national industrial property office pursuant to Estonian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Kutseline esindaja' 'Patendivolinik',**	**Entitlement is conditional upon possession of a special professional qualification**
			Persons holding the title **'Patendivolinik'** who have passed the 'trade marks, industrial designs and geographical indications' part of the exam, have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters. Persons who only passed the 'patents and utility models' part of the exam may not act as professional representatives before the EUIPO.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
PRH – Finnish Patent and Registration Office **(Finland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'harjoittamaan oikeutettu'** **'Asianajaja'** or **'Advokat'**	Persons holding the Finnish title **'Asianajaja'** or **'Advokat'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Finland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Ammattimainen edustaja'** **'Tavaramerkkiasiamies'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any natural or legal person can act as a representative in trade mark and design matters before the national industrial property office. In order for this person to be entitled to act as a representative before the EUIPO, the person must have at least 5 years' experience before the national industrial property office **(Option a)** . In addition, persons holding the title **'Tavaramerkkiasiamies'** are officially recognised as being professionally qualified to represent third parties before the Finnish Patent and Registration Office in trade mark matters , and therefore are not subject to the 5-year requirement to act as professional representative before the EUIPO **(Option b)** .

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
INPI – The National Institute for Intellectual Property **(France)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'avocat'**	Persons holding the French title **'avocat'** , meaning a lawyer member of the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to French law, and consequently entitled to act before the EUIPO in trade mark and design matters. These lawyers are fully entitled to act in trade mark and design matters, with an exception, that they cannot act under the title of 'lawyer' (avocat) and under the title of 'professional representative' (see below) at the same time . Therefore, they are not entitled to act before the EUIPO under two separate IDs (one as a lawyer, and one as a professional representative).
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Mandataires agréés'** Persons on the **'Liste des Conseils en propriété industrielle'**	**Entitlement is conditional upon possession of a special professional qualification**
			Only persons on the **'Liste des Conseils en propriété industrielle'** maintained by INPI with the speciality **'Marques, dessins et modèles'** or **'Juriste'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
DPMA – German Patent and Trade Mark Office **(Germany)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Rechtsanwalt'**	Persons holding the German title **'Rechtsanwalt'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to German law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Patentanwalt'**	**Entitlement is conditional upon possession of a special professional qualification**
			Persons holding the title **'Patentanwalt'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. Persons holding the titles of **'Patentassessor '** and **'Syndikuspatentanwalt '** (§ 41a Abs. 2 PAO) do not have such qualification. They have a limited power of representation as they may only act as employee representatives for their employer, not as professional representatives.
GGE – Hellenic Republic Ministry of Economy, Infrastructure, Shipping and Tourism **Designs: Industrial Property Organisation (OBI)** **(Greece)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Δικηγόρος'** (Dikigoros)	Only persons holding the title **'Δικηγόρος'** (or 'Dikigoros'), are entitled to act as legal practitioners before the national industrial property office pursuant to Greek law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'εγκεκριμένων αντιπροσώπων'**	n/a

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
HIPO – Hungarian Intellectual Property Office **(Hungary)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Ügyvéd'**	Persons holding the title **'Ügyvéd'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Hungarian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Hivatásos képviselők'** **'Szabadalmi ügyvivő'** ('patent attorney')	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Szabadalmi ügyvivő'** ('patent attorney') have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. **'Legal advisors'** or **'notaries'** are not entitled to act in procedures relating to industrial property matters and therefore may not be entered on the EUIPO's list of professional representatives.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Icelandic Intellectual Property Office **(Iceland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Lögfræðingur'** (e. Lawyer), **'Lögmaður'** (e. Attorney-at-Law), **'Héraðsdómslögmaður'** (e. District Court Attorney) or **'Hæstaréttarlögmaður'** (e. Supreme Court Attorney)	Persons holding the title **'Lögfræðingur'** (e. Lawyer), **'Lögmaður'** (e. Attorney-at-Law), **'Héraðsdómslögmaður'** (e. District Court Attorney) or **'Hæstaréttarlögmaður'** (e. Supreme Court Attorney), and therefore lawyers admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Iceland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Umboðsmaður'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State** Any person may act before the Icelandic Patent Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Icelandic Patent Office **(Option a)** . In addition, persons holding the title **'Umboðsmaður'** are officially recognised as being professionally qualified to represent third parties before the national industrial property office, and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b)** .

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Intellectual Property Office of Ireland **(Ireland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Barrister'** or **'Solicitor'**	Persons holding the titles **'Barrister'** or **'Solicitor'** , are entitled to act as legal practitioners before the national industrial property office pursuant to Irish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Registered Trade Mark Agent'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Registered Trade Mark Agent'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark matters.
UIBM – Italian Patent and Trademark Office **(Italy)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Avvocato'**	Persons holding the Italian title **'Avvocato'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Italian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Mandatario abilitato in Marchi'** **'Consulente in Marchi'** **'Consulente in Proprietà Industriale'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'Consulente in Marchi'** and **'Consulente in Proprietà Industriale'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in both trade mark and design matters.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
LRPV – Patent Office of the Republic of Latvia **(Latvia)**	**Professional Representative (Trade Marks and Designs)** Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Profesionâlais patentpilnvarnieks'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'profesionālais patentpilnvarnieks'** ('professional patent attorney') and included on the Patent Office List of Professional Patent Attorneys are entitled to represent persons before the national industrial property office (and consequently, before the EUIPO): - in trade mark matters, if they have specialised (and passed a specific exam) in the field of trade marks; - in design matters, if they have specialised (and passed a specific exam) in the field of designs.
Bureau of Intellectual Property Office of Economic Affairs **(Liechtenstein)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Rechtsanwalt'**	Persons holding the title **'Rechtsanwalt'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Liechtenstein, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Patentanwalt'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentanwalt'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
The State Bureau of the Republic of Lithuania **(Lithuania)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'praktikuojantis teisininkas'** **'Advokatas'**	Persons holding the title **'Advokatas'** are entitled to act as legal practitioners before the national industrial property office pursuant to Lithuanian law, and consequently entitled to act before the EUIPO in trade mark and design matters, provided that their clients have a permanent residence in the EU. Clients whose permanent residence is not in the EU may not be represented by a legal practitioner and must be represented by a professional representative.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**' Profesionalūs atstovai '** **'Patentinis patikėtinis'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentinis patikėtinis'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Commerce Department, Industrial Property Registrations Directorate **(Malta)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'prattikant legali'** **'Avukat' or 'Prokuratur Legali'**	Persons holding the titles **'Avukat'** or **'Prokuratur Legali'** , are entitled to act as legal practitioners before the national industrial property office pursuant to Maltese law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'rappreżentanti professjonali'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person, with a legal background including notaries, may act before the Maltese Intellectual Property Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Maltese Intellectual Property Office. **(Option a).**

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
NIPO – Norwegian Industrial Property Office (Norway)	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Advokat'** and **'Advokatfullmektig'**	Persons holding the titles **'Advokat'** and **'Advokatfullmektig',** a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Norway, and consequently entitled to act before the EUIPO in trade mark and design matters. Furthermore, if the legal practitioner acts as an attorney-at-law no power of attorney is necessary. However, 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.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)		**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Norwegian Intellectual Property Office. In order for this person to represent in trade mark matters before the EUIPO, the person must have at least 5 years' experience before the Norwegian Intellectual Property Office. **(Option a).**

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Polish Patent Office **(Poland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**‘ prawnik’** **‘Adwokat, radca prawny’**	Persons holding the title **‘Adwokat, radca prawny’** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office in trade mark and design matters pursuant to the laws of Poland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**‘Zawodowi pełnomocnicy’** **‘Rzecznik Patentowy’**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **‘Rzecznik Patentowy’** (on the list of patent attorneys maintained by the Polish Patent Office) have the necessary ‘special professional qualification’ and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
INPI – Portuguese National Industrial Property Office **(Portugal)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Profissionais de justiça'** **'Advogado'**	Persons holding the title **'Advogado'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Portuguese law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'mandatário autorizado'** **'Agentes da Propiedade Industrial'** and **'notary'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Portuguese Institute of Industrial Property. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Portuguese Institute of Industrial Property **(Option a)** . In addition, persons holding the titles of **'Agentes da Propiedade Industrial'** and **'notary'** are officially recognised as professionally qualified to represent third parties before the Portuguese Institute of Industrial Property and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b)** .

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OSIM – Romanian State Office for Inventions and Trademarks **(Romania)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'Avocat'**	Persons holding the title of **'Avocat'** who are also qualified as IP attorneys and members of the Romanian Chamber of Patent Attorneys , are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Romania, and consequently are entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'reprezentanții or autorizați'** **'Consilier în proprietate industrială'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Consilier în proprietate industrială'** (who in turn must be a member of a national chamber), have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters.
SKIPO – Industrial Property Office of the Slovak Republic **(Slovakia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**' advokát'**	Persons holding the title **'advokát'** are entitled to act as legal practitioners before the national industrial property office pursuant to Slovak law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Oprávnený zástupca'** **'Patentový zástupca'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentový zástupca'** hold the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
SIPO – Slovenian Intellectual Property Office **(Slovenia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'odvetnik'**	Persons holding the title **'Odvetnik'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to laws of Slovenia, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Zastopnik za modele in znamke'** (Design and trademark agent)	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Zastopnik za modele in znamke'** (design and trademark agent) have the necessary 'special professional qualification', must be registered in the Register of Agents at the Slovenian Intellectual Property Office and are therefore entitled to act as a professional representative before the EUIPO. **'Notaries'** are explicitly excluded from representing third parties before the Slovenian Intellectual Property Office.

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OEPM – Spanish Patent and Trademark Office **(Spain)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'abogado'**	Persons holding the title **'abogado'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Spanish law, and consequently entitled to act before the EUIPO in trade mark and design matters provided that the person they represent is a resident of a Member State of the EEA. Where the person that is represented is not a resident of a Member State of the EEA they may not be represented by a legal practitioner (**'abogado'**), and must be represented by a professional representative holding the title **'Agente Oficial de la Propiedad Industrial '** * *21/10/2021 – Spanish law in this area currently under review. See the draft law (*' Anteproyecto de Ley de modificación de la Ley 17/2001, de 7 de diciembre, de Marcas, la Ley 20/2003, de 7 de julio, de Protección Jurídica del Diseño Industrial, y la Ley 24/2015, de 24 de julio, de Patentes. '*) It is possible to be an **'abogado '** and an **'Agente Oficial de la Propiedad Industrial'** at the same time.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Representante autorizado'** **'Agente Oficial de la Propiedad Industrial'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act in trade mark and design matters before the national industrial property office pursuant to Spanish law, provided that the person they represent is a resident of a Member State of the EU. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years of experience before the OEPM **(Option a)** . Where the person that is represented is not a resident of a Member State of the EU they must be represented by a person holding the title of **'Agente de la Propiedad Industrial'** In addition, persons holding the title **'Agente de la**

Obsolete

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
PRV – Swedish Patent and Registration Office **(Sweden)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) CDR	**'juridisk person'** **'Advokat '**	Persons holding the title **'Advokat'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Swedish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) CDR)	**'Auktoriserat ombud'** **'Patentombud'**	Representation is open to anybody a. who has acted before the national office for at least 5 years, or b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State
			Any person may act in trade mark and design matters before the Swedish Patent and Registration Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Swedish Patent and Registration Office **(Option a)** . In addition, persons holding the title **'Patentombud'** are officially recognised as being professionally qualified to represent third parties before the Swedish Patent and Registration Office in trade mark and design matters , and are therefore not subject to the 5-year requirement to act as professional representatives before the EUIPO **(Option b)** .

Obsolete

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.

Obsolete

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 78(4)(c) CDR
PRH – Finnish Patent and Registration Office **(Finland)**	**'Mallioikeusasiamies'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State** Any natural or legal person can act as a representative in design matters before the national industrial property office. In order for this person to be entitled to act as a representative before EUIPO, the person must have at least 5 years' experience before the national industrial property office (**Option a**). Persons holding the title **'Mallioikeusasiamies'** are officially recognised as being professionally qualified to represent third parties before the Finnish Patent and Registration Office in design matters, and therefore are not subject to the 5-year requirement to act as professional representative before the EUIPO (**Option b**).

Obsolete

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 78(4)(c) CDR
Intellectual Property Office of Ireland **(Ireland)**	**'Registered Patent Agents'**	**Entitlement is conditional upon possession of a special professional qualification** Only **'Registered Patent Agents'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters.
UIBM – Italian Patent and Trademark Office **(Italy)**	**'Consulente in brevetti'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'Consulente in brevetti'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters only.
LRPV – Patent Office of the Republic of Latvia **(Latvia)**	**'Patentpilnvarotais dizainparaugu lietas'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'Patentpilnvarotais dizainparaugu lietas'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters only.

Obsolete

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 78(4)(c) CDR
PRV – Swedish Patent and Registration Office **(Sweden)**	**'Varumaerkesombud'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
		Any person may act in design matters before the Swedish Patent and Registration Office. For this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Swedish Patent and Registration Office (**Option a**). Persons holding the title **'Varumaerkesombud'** are officially recognised as being professionally qualified to represent third parties before the Swedish Patent and Registration Office in design matters, and therefore are not subject to the 5-year requirement to act as professional representatives before the EUIPO (**Option b**).

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 7

Revision

Obsolete

Obsolete

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.

Obsolete

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.

Obsolete

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;

Obsolete

- 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.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 8

Restitutio in integrum

Obsolete

Obsolete

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.

1. **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

Obsolete

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.

2. **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).

Obsolete

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.)

Obsolete

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.

Therefore, unless specifically excluded by Article 104(5) EUTMR, *restitutio in integrum* is available.

The reference to Article 105 EUTMR in Article 104(5) EUTMR should be understood as only excluding from *restitutio in integrum* the time limits which are laid down as such in Article 105 EUTMR, namely the time limits for requesting continuation of proceedings and paying the fee pursuant to Article 105(1) EUTMR. Consequently, *restitutio in integrum* is available for the time limits mentioned in Article 105(2) EUTMR to the extent that they are not expressly excluded by Article 104(5) EUTMR.

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.

Obsolete

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;

Obsolete

- a time limit of 1 year for filing the application for *restitutio in integrum* as from the expiry of the missed time limit.

Article 105(1) 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.

Obsolete

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).

As a general rule, the individual fee (EUR 200) must be paid for each application for *restitutio in integrum* (i.e. one fee is due per individual right). Nevertheless, in certain cases exceptions may apply. The minimum conditions for applying such exceptions are the following:

1. all the rights should relate to the same rights holder;
2. all the rights should be of the same type (e.g. EUTMs, RCDs);
3. the unobserved time limit should be the same for all rights (e.g. missed time limit for renewal);
4. the loss of all rights concerned should be the result of the same circumstances.

These conditions are cumulative. Therefore, only when all of them are met, can the application for *restitutio in integrum* relating to multiple rights be subject to a single fee.

Otherwise, an individual fee must be paid for each right concerned.

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).

Obsolete

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.

Obsolete

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

Obsolete

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 division or department 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.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part B

Examination

Obsolete

Obsolete

Section 4 Absolute grounds for refusal

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part B

Examination

Section 4

Absolute grounds for refusal

Chapter 7

Trade marks contrary to public policy or acceptable principles of morality (Article 7(1)(f) EUTMR)

Obsolete

Obsolete

1 General Remarks

Article 7(1)(f) EUTMR excludes from registration trade marks that are contrary to public policy or to accepted principles of morality. Article 7(1)(f) EUTMR mirrors that of Article 6*quinquies*(B)(3) of the Paris Convention ([15]), which provides for the refusal of trade mark applications and for the invalidation of registrations where trade marks are 'contrary to morality or public order'.

The wording of Article 7(1)(f) EUTMR is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to encounter disturbing, abusive, insulting and even threatening trade marks (06/07/2006, R 495/2005-G, SCREW YOU, § 14).

The rationale of Article 7(1)(f) EUTMR is not to identify and filter out signs whose use in commerce must at all costs be prevented, but to preclude trade marks from registration where granting a monopoly would contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society. In other words, the Office should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society (06/07/2006, R 495/2005-G, SCREW YOU, § 13).

The application of Article 7(1)(f) EUTMR is not limited by the principle of freedom of expression (Article 10, Freedom of expression, European Convention on Human Rights) since the refusal to register only means that the sign is not granted protection under trade mark law and does not stop the sign from being used — even in business (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 26).

'Public policy' and 'accepted principles of morality' are two different concepts that often overlap.

The question whether the goods or services for which protection is sought can or cannot be legally offered in a particular Member State's market is irrelevant for the question as to whether the sign itself falls foul of Article 7(1)(f) EUTMR (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 33). Whether or not a mark is contrary to public policy or accepted principles of morality must be determined by the intrinsic qualities of the mark applied for, and not by the circumstances relating to the conduct of the person applying for the trade mark (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 28). In its judgment of 20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, the General Court held that the concepts of 'public policy' and 'acceptable principles of morality' must be interpreted not only with reference to the circumstances common to all Member States but by taking into account 'the particular circumstances of **individual Member States** which are likely to influence the perception of the relevant public within those States' (para. 34).

15 Paris Convention for the Protection of Industrial Property of 20 March 1883 (as amended on 28 September 1979).

Obsolete

The legislation and administrative practice of certain Member States can also be taken into account in this context (i.e. for assessing subjective values), not because of their normative value, but as evidence of facts that make it possible to assess the perception of the relevant public in those Member States (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, § 57). In such a case, the illegality of the EUTM applied for is not the determining factor for the application of Article 7(1)(f) EUTMR, but rather is of evidential value with regard to the perception of the relevant public in the Member State(s) in question.

Considering that the specific circumstances of **individual** Member States may not be widely known in EU territory, the objection letter should explain these circumstances clearly in order to make sure that the applicant is able to fully understand the reasoning behind the objection and is able to respond accordingly.

2 `Public Policy'

2.1 Concept and categories

This objection derives from an assessment based on **objective criteria**. 'Public policy' is the body of all legal rules that are necessary for the functioning of a democratic society and the state of law. In the context of Article 7(1)(f) EUTMR, 'public policy' refers to the **body of EU law applicable in a certain area**, as well as to the legal order and the state of law as defined by the Treaties and secondary EU legislation, which reflect a common understanding of certain basic principles and values, such as human rights.

The following is a non-exhaustive **list of examples** of when signs will be caught by this prohibition.

- Trade marks that contradict the basic principles and fundamental values of the European Union political and social order and, in particular, the universal values on which the European Union is founded, such as human dignity, freedom, equality and solidarity and the principles of democracy and the rule of law, as proclaimed in the Charter of Fundamental Rights of the European Union (OJ C 83, 30/03/2010, p. 389).
- On 27/12/2001, the Council of the European Union adopted Common Position 2001/931/CFSP on the application of specific measures to combat terrorism (OJ L 344, 28/12/2001, p. 93), later updated by Council Decision (CFSP) 2017/1426 of 04/08/2017, updating the list of persons, groups and entities subject to Articles 2, 3 and 4 of Common Position 2001/931/CFSP on the application of specific measures to combat terrorism and repealing Decision (CFSP) 2017/154 (OJ L 204, 05/08/2017, p. 95, consolidated version available at http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017D1426&from=EN), which contains a list of individuals and groups facilitating, attempting to commit or committing terrorist acts

Obsolete

in EU territory. Any EUTM applied for that can be deemed to support or benefit an individual or a group on the list will be rejected as being against public policy.

3 Accepted Principles of Morality

This objection concerns **subjective values**, but these must be applied as objectively as possible by the examiner. The provision excludes registration as European Union trade marks of blasphemous, racist, discriminatory or insulting words or phrases, but only if that meaning is clearly conveyed by the mark applied for in an unambiguous manner; the standard to be applied is that of the reasonable consumer with average sensitivity and tolerance thresholds (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 21).

The concept of accepted principles of morality refers to the fundamental moral values and standards to which a society adheres at a given time. Those values and norms are likely to change over time and vary in space (27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 39).

The concept of morality in Article 7(1)(f) EUTMR is not concerned with bad taste or the protection of individuals' feelings. In order to fall foul of Article 7(1)(f) EUTMR, a trade mark must be perceived by the relevant public, or at least a significant part of it, as going directly against the fundamental moral values and standards of society.

It is not sufficient if the trade mark is only likely to offend a small minority of exceptionally puritanical citizens. Conversely, a trade mark should not be allowed to be registered simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable. The trade mark must be assessed by reference to the standards and values of ordinary citizens who fall between those two extremes (06/07/2006, R 495/2005-G, SCREW YOU, § 21).

The examination is to be based on the perception of a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered and, where appropriate, the particular circumstances of the part of the Union concerned. To that end, elements such as legislation and administrative practices, public opinion and, where appropriate, the way in which the relevant public has reacted in the past to that sign or similar signs, as well as any other factor which may make it possible to assess the perception of that public, are relevant (27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 42).

National legislation and practice of Member States are indicators to be taken into account in order to assess how certain categories of signs are perceived by the relevant public in those Member States (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, § 58). However, the Office must not object to trade marks because of the mere fact that they are in conflict with national legislation and practice. National legislation and practice are considered to be **factual evidence** that enables an assessment of the perception of the relevant public within the relevant territory.

Obsolete

Examples of national legislation taken into account as evidence of a trade mark being contrary to accepted principles of morality:

- use of symbols and names of unconstitutional parties or organisations is prohibited in Germany (§ 86a dt. StGB (German Criminal Code), BGBl. No I 75/1998) and in Austria (§ 1 öst. Abzeichengesetz (Austrian Law on Insignias), BGBl. No 84/1960 in conjunction with § 1 öst. Verbotsgesetz (Austrian Prohibition Law), BGBl. No 25/1947);
- 'use of symbols of totalitarianism' (e.g. the sickle and hammer and the five-pointed red star), specifically in a way to offend the dignity of victims of totalitarian regimes and their right to sanctity is prohibited in Hungary (Section 335 of Act C of 2012 on the Criminal Code) (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498).

Signs that can be perceived as promoting the use of illegal drugs also fall under this provision. Taking into account, as factual evidence, that certain drugs are illegal in some Member States as well as the fact that the EU has undertaken drug policy initiatives to fight against illegal drugs, an objection should be raised. It is an objective indication that such signs would be perceived as going directly against the basic moral norms of society.

The assessment made will take into account the term used in the mark applied for or the presence of other elements that could be perceived as promoting the use of illegal drugs. However, an objection will not be raised if the sign contains a reference to a drug that is for medical use, as the mark would not fall, in principle, within the prohibition of Article 7(1)(f) EUTMR.

The examination of Article 7(1)(f) EUTMR should consider the **context** in which the mark is likely to be encountered, assuming normal use of the mark **in connection with the goods and services** covered by the application (06/07/2006, R 495/2005-G, SCREW YOU, § 21). Taking account of the goods and services for which registration of the mark is sought is normally necessary, since the relevant public may be different for different goods and services and, therefore, may have different thresholds with regard to what is clearly unacceptably offensive. For example, 'a person who is sufficiently interested in [sex toys] to notice the trade marks under which they are sold is unlikely to be offended by a term with crude sexual connotations' (06/07/2006, R 495/2005-G, SCREW YOU, § 29).

Nevertheless, although the Court has held that the goods and services for which protection is sought are important for identifying the relevant public whose perception needs to be examined, it has also made it clear that the **relevant public is not necessarily only that which buys the goods and services covered by the mark**, since a broader public than just the consumers targeted may encounter the mark (05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 17-18). Accordingly, the commercial context of a mark, in the sense of the public targeted by the goods and services, is not always the determining factor in whether that mark would breach accepted principles of morality (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 24; 26/09/2014, T-266/13, Curve, EU:T:2014:836, § 18-19).

Obsolete

Illegality is not a necessary condition for giving rise to a conflict with accepted principles of morality: there are words or signs that would not lead to proceedings before the relevant authorities and courts, but that are sufficiently offensive to the general public to not be registered as trade marks (01/09/2011, R 168/2011-1, fucking freezing! by TÜRPITZ (fig.), § 16). Furthermore, there is an interest in ensuring that children and young people, even if they are not the relevant public of the goods and services in question, do not encounter offensive words in shops that are accessible to the general public. Dictionary definitions will in principle provide a preliminary indication as to whether the word in question has an offensive meaning in the relevant language (01/09/2011, R 168/2011-1, fucking freezing! by TÜRPITZ (fig.), § 25), but the key factor must be the perception of the relevant public in the specific context of how and where the goods or services will be encountered.

However, the Boards of Appeal took the view that the word 'kuro' did not convey to the Hungarian public the offensive meaning of the word 'kúró' (meaning 'fucker' in English), since the vowels 'ó' and 'ú' are separate letters that are distinct from 'o' and 'u', which are pronounced differently and convey different meanings (22/12/2012, R 482/2012-1, kuro, § 12 et seq.).

There is a clear risk that the wording of Article 7(1)(f) EUTMR could be applied subjectively so as to exclude trade marks that are not to the examiner's personal taste. However, for the word(s) to be objectionable, it (they) must have a clearly offensive impact on people of normal sensitivity (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 21).

There is no need to establish that the applicant **wants** to shock or insult the relevant public; the fact that the EUTM applied for **might** be seen, as such, to shock or insult is sufficient (23/10/2009, R 1805/2007-1, PAKI, EU:T:2011:564, § 27, confirmed 05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 20 et seq.).

Finally, it is not only signs with a 'negative' connotation that can be offensive. The banal use of some signs with a **highly positive connotation** can also be offensive (e.g. terms with a religious meaning or national symbols with a spiritual and political value, like 'ATATURK' for the EU general public of Turkish origin (17/09/2012, R 2613/2011-2, ATATURK, § 31)).

Raising an objection when a trade mark is contrary to accepted principles of morality does not, however, prevent the sign from being also contrary to public policy (e.g. the trade mark may be perceived by the relevant public as directly contrary to the basic moral norms of society and, **at the same time**, may contradict the basic principles and fundamental values of the EU political and social order).

Obsolete

4 Examples

4.1 Examples of rejected EUTM applications

Sign	Relevant Consumer	Public policy/morality	Case No
BIN LADIN	General consumer	Morality and public policy — the mark applied for will be understood by the general public as the name of the leader of the notorious terrorist organisation Al Qaeda; terrorist crimes are in breach of public order and moral principles (para. 17).	29/09/2004 R 176/2004-2
CURVE	General consumer	Morality — 'Curve' is an offensive and vulgar word in Romanian (it means 'whores'). The relevant public is not limited only to the public to which the goods and services covered by the mark are **directly** addressed. 'Curve' equally offends other persons, who are confronted with the sign **accidentally** without being interested in these goods and services (para. 19). With regard to the word 'Curve'+ additions ['AIRCURVE'], see example below in this paragraph (R 203/2014-2).	T-266/13
	General consumer	Morality — 'fucking' is an offensive and vulgar word in English.	R 168/2011-1
	General consumer	Morality — 'HIJOPUTA' is an offensive and vulgar word in Spanish.	T-417/10

Obsolete

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Morality — the Hungarian Criminal Code bans certain 'symbols of despotism', including the hammer and sickle as well as the five-pointed red star symbolising the former USSR. This law is not applicable by reason of its normative value but rather as evidence of the perception of the relevant public (paras 59-63) ([16]).	T-232/10
PAKI	General consumer	Morality — 'PAKI' is a racist insult in English.	T-526/09
SCREW YOU	General consumer (for goods other than sex products)	Morality — a substantial proportion of ordinary citizens in Britain and Ireland would find the words 'SCREW YOU' offensive and objectionable (para. 26).	R 495/2005-G
FICKEN	General consumer	Morality — 'FICKEN' is an offensive and vulgar word in German (it means 'fuck').	14/11/2013, T-52/13, EU:T:2013:596
ATATURK	Average consumer in the EU general public of Turkish origin	Morality — banal use of signs with a highly positive connotation can be offensive under Article 7(1)(f) EUTMR. 'ATATURK' is a national symbol of spiritual and political value for the European general public of Turkish origin.	R 2613/2011-2
FUCK CANCER	General consumer	Morality — the word 'FUCK' is not only a 'slightly rude word' in combination with the word 'CANCER', but offensive and indecent, at least for the English-speaking part of the trade circles (para. 19).	23/02/2015, R 793/2014-2

Obsolete

16 The Hungarian Criminal Code, in force at the time of the judgment (20/09/2011), has been amended by Act C of 2012 to now encompass 'Use of Symbols of Totalitarianism', used 'specifically in a way to offend the dignity of victims of totalitarian regimes and their right to sanctity' (formerly Section 269/B, now Section 335 of the Hungarian Criminal Code).

Sign	Relevant Consumer	Public policy/morality	Case No
MECHANICAL APARTHEID	General consumer	Public policy — 'APARTHEID' refers to an offensive former political regime in South Africa that included state terror, torture and the denial of human dignity. The message conveyed by the sign for computer games, related publications and entertainment is contrary to the European Union's public policy, since it contradicts the indivisible, universal values on which the EU is founded, i.e. human dignity, freedom, physical integrity, equality and solidarity, and the principles of democracy and the rule of law (para. 30).	06/02/2015, R 2804/2014-5
MH17 MH370	General consumer	Morality — acronyms of the flights. The intent to seek financial gain from what is universally accepted to be a tragic event that has resulted in the loss of many hundreds of lives, is unacceptable and contrary to accepted principles of morality.	EUTM 13 092 937 EUTM 12 839 486

Obsolete

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Public policy and morality — mafia-type organised crime is a clear and present threat to the whole of the EU. 'la Mafia' is understood world-wide as referring to a criminal organisation originating in Italy, whose activities extend to States other than the Italian Republic, inter alia, within the European Union. The referred criminal organisation resorts to intimidation, physical violence and murder in carrying out its activities, which include, inter alia, drug trafficking, arms trafficking, money laundering and corruption (para. 35). Such criminal activities breach the very values on which the European Union is founded, in particular the values of respect for human dignity and freedom as laid down in Article 2, Treaty of the European Union and Articles 2, 3 and 6 of the Charter of Fundamental Rights of the European Union (para. 36). The association in the mark of the word element 'la mafia' with the other elements of the contested mark is such to convey a globally positive image of the Mafia's activities and, so doing, to trivialise the perception of the criminal activities of that organisation (para. 46). (…) The contested mark is, therefore, likely to shock or offend not only the victims of that criminal organisation and their families, but also any person who, on EU territory, encounters that mark and has average sensitivity and tolerance thresholds (para. 47).	15/03/2018, T-1/17, EU:T:2018:146

Obsolete

Sign	Relevant Consumer	Public policy/morality	Case No
ETA	General consumer	Public policy and morality — 'ETA' will be immediately understood in Europe, in particular in Spain, as designating the terrorist group ETA (para. 2). ETA is included on the list of individuals and groups facilitating, attempting to commit or committing terrorist acts in EU territory (Council Common Position 2001/931/CFSP of 27/12/2001 on the application of specific measures to combat terrorism updated by Council Common Position 2009/64/CFSP) (para. 14). In a commercial context, the term 'ETA' has the inherent tendency to shock any normal person who hears or reads it and, in particular, members of the Spanish public who particularly keep that name in mind. The fact that ETA is not currently considered to be the biggest threat facing Spain according to an extract from a survey conducted in June 2015 provided by the applicant, does not mean that the term will not continue to be associated with the terrorist group in question in the mind of the public (para. 15).	27/06/2016, R 563/2016-2
	General consumer	Public policy and morality — the words 'KRITIKAL BILBO' identify a variety of plant of the 'cannabis' genus — also called 'marihuana' — which, due to its high content of tetrahydrocannabinol (THC), namely 21.47 %, is used to make marihuana (para 19). Cannabis with a high THC content is considered to be a narcotic that is prohibited in a large number of Member States (19/11/2009, T-234/06, Cannabis, EU:T:2009:448). Non-psychoactive substances are legal and the authorities can issue licences for their cultivation for those purposes. However, due to its high THC content, in this case the product concerned is not non-psychoactive, but is a substance for smoking that is strictly controlled in almost all European Union countries (para. 22).	27/10/2016, R 1881/2015-1

Obsolete

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Morality — the sign, containing the term 'weed' and applied for in Class 32, will be understood by the relevant consumer as glorifying the use of a drug (cannabis/marijuana) that is prohibited by law in many European countries.	EUTM 16 961 732
IBIZASKUNK	General consumer	Morality — applied for in Classes 5, 31 and 35. The sign, contains the term 'skunk' which refers to a cannabis strain with high THC. It will be perceived as a motivational/promotional message, which encourages an activity prohibited in many Member States of the EU, namely the consumption or sale of products containing SKUNK, as well as a banalisation of the aforementioned narcotic substance. The term IBIZA (known as a party location) reinforces the recreational message.	EUTM 18 97 102
	General consumer	The sign depicts cannabis leaves and also contains the term 'cannabis'. The application was filed for goods in Classes 30 and 32 and for services in Class 43. The Court considered that the fact that the sign would be perceived by the relevant public as an indication that the food and drink items contained narcotic substances, prohibited in many Member States, was sufficient to justify the refusal of the mark. It was not required that a sign encourage or trivialise the use of an illegal narcotic substance. As regards factors such as the accuracy of the depiction or the intention of the applicant to use the sign only for legal goods, the Court pointed out that the perception of the public was decisive and clarified that the intentions of the applicant did not play a role in the assessment.	EUTM 16 176 968 12/12/2019, T-683/18, EU:T: 2019:855

Obsolete

4.2 Examples of accepted EUTM applications

Sign	Relevant Consumer	Comment	Case No

KURO	General consumer	That a foreign term, name or abbreviation displays certain similarities with an offensive word (like 'kúró') is not in itself sufficient reason to refuse an EUTM application (para. 20). The Hungarian vowels 'ò' and 'ù' are clearly different from the unaccented vowels 'o' and 'u'. Furthermore, Hungarian words never end with an unaccented 'o' (paras 15-18).	R 482/2012-1
SCREW YOU	General consumer (for sex products)	A person entering a sex shop is unlikely to be offended by a trade mark containing crude, sexually charged language (para. 29).	R 495/2005-G
DE PUTA MADRE	General consumer	Although 'puta' means 'whore' in Spanish, the expression 'DE PUTA MADRE' means 'very good' in Spanish (slang).	EUTM 3 798 469 EUTM 4 781 662 EUTM 5 028 477

Obsolete

AIRCURVE	Specialised public (medical personnel; patients with breathing disorders)	The objectionable word 'Curve' ['whore', 'slut' in Romanian] is seamlessly attached to the English word 'AIR' to form 'AIRCURVE', which, as a whole, is entirely fanciful in Romanian. Even if the relevant public understood the English word 'AIR', and analysed the mark by separating it into two elements, the meaning of 'AIRCURVE' would be 'air whores', which, as a concept, and for respiratory apparatus, is sufficiently nonsensical or puzzling to the extent that it would eclipse any notion of being offensive (para. 13 et seq.). With regard to the word 'Curve' on its own, see the abovementioned example in this paragraph (T-266/13).	04/06/2014, R 203/2014-2
	General consumer	For the goods at issue — *rum* (Class 33) — the relevant public will perceive the sign as provocative, transgressive, rebellious, but not as an indicator of criminal origin of the goods (para. 23).	07/05/2015, R 2822/2014-5

Obsolete

ILLICIT	General consumer	The mark is considered acceptable under Article 7(1)(f) EUTMR, as 'illicit' is different from something like 'counterfeit'. The mark would be seen as fanciful on the goods (*cosmetics, and perfumes*) and it could be accepted.	EUTM 13 469 523
	General consumer	The mark evokes a concept that falls within the domain of vulgarity and profanity. However, the effect is attenuated by the fact that the implicit word does not appear in the mark as such. The presence of the initial figurative element 'W', combined with the euphemistic presentation of 'F___', also suppresses the offensive potential of the sign. Consumers with a normal level of sensitivity and tolerance would not be offended or upset by regular commercial exposure to the term in connection with the relevant goods and services in Classes 16, 18, 25, 35, 41, 43 and 44 (para. 31).	29/11/2018 R 1516/2018-5

Obsolete

hemptouch. PREMIUM CANNABIS ESSENTIALS	General consumer	The sign, containing the terms 'hemptouch' and 'cannabis', is applied for in Classes 3 and 5. It will be perceived by the relevant consumer as a reference to the medicinal use of the substance. Hemp is a variety of *Cannabis sativa*, which contains a very low concentration of THC, and cannabis can be used for medicinal purposes.	EUTM 18 000 042

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Obsolete

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 3

EUTMs and RCDs as objects of property

Obsolete

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 3

EUTMs and RCDs as objects of property

Chapter 1

Transfer

Obsolete

Obsolete

1 Introduction

Article 1(2), Articles 19, 20, and 28, Article 111(1) and Article 111(3)(g) EUTMR
Articles 27, 28 and 34 CDR
Article 23, Article 69(1) and Article 69(3)(i) CDIR

A transfer is the change in ownership of the property rights in a European Union trade mark (EUTM) or an EUTM application from one entity to another. EUTMs and EUTM applications may be transferred from the current proprietor to a new proprietor, primarily by way of assignment or legal succession. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

The transfer may be limited to some of the goods or services for which the mark is registered or applied for (partial transfer). In contrast to a licence or conversion, the transfer of an EUTM cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for **some** territories or Member States.

Both registered Community designs (RCDs) and applications for an RCD may also be the subject of a transfer.

The provisions in the CDR and CDIR dealing with the transfer of registered Community designs are almost identical to the equivalent provisions of the EUTMR, EUTMDR and EUTMIR. **Therefore, the following applies *mutatis mutandis* to RCDs. Exceptions and specific provisions for RCDs are detailed in paragraphs 3 and 7 below.**

On request of one of the parties, transfers of EUTMs are entered in the EUTM Register.

According to Article 20 EUTMR, the registration of a transfer is not a condition for its validity. However, if a transfer is not registered by the Office, the successor may not invoke the rights arising from the EUTM. Moreover, the new proprietor will not receive communications from the Office, in particular, during *inter partes* proceedings, nor the notification of the renewal period of the mark. Furthermore, according to Article 19 EUTMR, in all aspects of the EUTM as an object of property that are not further defined by provisions of the EUTMR, the proprietor's address defines the applicable subsidiary national law. Consequently, it is important to register a transfer at the Office to ensure that entitlement to EUTMs and EUTM applications is clear.

Obsolete

1.1 Transfers

Article 20(1) and (2) EUTMR Article 28 CDR

A transfer of an EUTM involves two aspects, namely the validity of the transfer between the parties and the impact of a transfer on proceedings before the Office, which will only be triggered after the entry of the transfer in the EUTM Register (see paragraph 1.2 below).

Regarding the validity of the transfer between the parties, the EUTMR allows an EUTM to be transferred independently of any transfer of the undertaking to which it belongs (30/03/2006,C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 45 and 48).

1.1.1 Assignment

Article 20(3) EUTMR Article 28 CDR

When a transfer is made by an assignment, it is only valid where the assignment is made in writing and is signed by both parties, except where the assignment is the result of a court decision, or a decision taken by the Office under Article 21 EUTMR. This formal requirement for the validity of the transfer of an EUTM is applicable irrespective of whether, under the national law governing transfers of (national) trade marks, an assignment is valid without observing a particular form, such as the need for the transfer to be in writing and have the signatures of both parties.

However, the change of ownership of RCDs due to entitlement proceedings before a national authority are not processed through a transfer but through a change in the ownership resulting from the final decision under Article 15 CDR.

1.1.2 Inheritance

When the proprietor of an EUTM dies, the heirs will become proprietors of the EUTM by way of individual or universal succession. This is also covered by the rules on transfers.

1.1.3 Merger

A universal succession also exists when there is a merger between two companies that leads to the formation of a new company, or an acquisition by one company taking over another. Where the whole of the undertaking to which the mark belongs is transferred, there is a presumption that the transfer includes the EUTM unless, in accordance with

Obsolete

the law governing the transfer, an agreement to the contrary was made or unless circumstances clearly dictate otherwise.

1.1.4 Applicable law

Article 19 EUTMR
Article 27 CDR

Unless provided otherwise by the EUTMR, transfers are subject to the national law of a Member State determined by Article 19 EUTMR. The national law applicable under that provision is the national law in general and, therefore, also includes private international law which, in turn, may refer to the law of another State.

1.2 Legal effects of the transfer

Article 20(11) EUTMR
Article 13 EUTMIR
Article 28 CDR
Article 23 CDIR

As long as the transfer has not been entered in the EUTM or RCD Register, the successor in title may not invoke the rights arising from the registration of the EUTM or the RCD (see *mutatis mutandis* 16/01/2020, T-128/19, Sativa, EU:T:2020:3, § 22, 25-26).

This also applies to a transfer based on the implementation of a decision, even if the judgment established proprietorship with previous or *ex tunc* effect (see paragraph 7).

However, in the period between the date when the Office receives the application to register a transfer and the date of registering the transfer, the new proprietor may already make submissions to the Office with a view to observing time limits. For example, if a party has applied to register the transfer of an EUTM application against which the Office has raised objections on absolute grounds, the new proprietor may reply to those objections (see paragraph 6).

In an application for registration of a transfer, the Office will only examine whether sufficient evidence of the transfer has been submitted.

For changes of ownership following national entitlement proceedings regarding RCDs, see paragraph 3.

Obsolete

2 Transfers v Changes of Name

Article 55 EUTMR Article 19 CDIR

A transfer must be distinguished from a change of name of the proprietor.

A change in the name of the proprietor is a change that does not affect the identity of the proprietor, whereas a transfer is a change in the identity of the proprietor.

In particular, no transfer is involved when a natural person changes their name due to marriage, or following an official procedure for changing a name, or when a pseudonym is used instead of the proper name, etc. In all these cases, the identity of the proprietor is not affected.

Where the name or the corporate status of a legal person changes, the criterion for distinguishing a transfer from a mere change of name is whether or not the identity of the legal person remains the same. If the identity remains the same, it will be registered as a change of name (06/09/2010, R 1232/2010-4 , Cartier, § 12-14). In other words, where there is no termination of the legal entity (such as would occur in the case of a merger by acquisition, where one company is completely absorbed by the other and ceases to exist) and no start-up of a new legal entity (e.g. as would be the case following the merger of two companies leading to the creation of a new legal entity), there is only a change in the formal corporate organisation that already existed, and not in the actual identity itself. Therefore, the change will be registered as a change of name, where appropriate.

For example, if an EUTM is in the name of Company A and, as the result of a **merger** , this company is absorbed by Company B, there is a **transfer** of assets from Company A to Company B.

Likewise, during a **division** of Company A into two separate entities, one being the original Company A and the other being a new Company B, if the EUTM in the name of Company A becomes the property of Company B, there is a **transfer** of assets.

Normally, there is no transfer if the company registration number in the national register of companies remains the same.

However, there is in principle the prima facie presumption that there is a transfer of assets if there is a change of country (see, however, 06/11/2013, R 546/2012-1 , PARFUMS LOVE / LOVE et al.).

If the Office has any doubt about the national law applicable to the legal person concerned, it may require appropriate information from the applicant for registration of the change of name.

Therefore, unless ruled to the contrary under the applicable national law, the change of company type, provided that it is not accompanied by a transfer of assets carried out

Obsolete

by means of a merger or an acquisition, will be treated as a change of name and not as a transfer.

However, if the change of company type is the result of a merger, a division or a transfer of assets, depending on which company absorbs or is separated from the other, or on which company transfers which assets to the other, it may be a case of transfer.

2.1 Erroneous application to register a change of name

Articles 55(1), (3) and (5) and 162(1) EUTMR

Article 71 CDR

Article 19(1), (5) and (7) CDIR

When a request is made to register a change of name, but the evidence shows that it is actually a transfer of an EUTM, the Office informs the applicant accordingly and invites it to file an application for registration of a transfer within a specified period. If the applicant agrees or does not submit evidence to the contrary and files the corresponding application to register a transfer, the transfer will be registered. If the applicant does not modify its request and insists on registering the change as a change of name, or if it does not respond, the request to register a change of name will be rejected. The party concerned may file an appeal against this decision.

A new application for the registration of the transfer may be filed at any time.

2.2 Erroneous application for the registration of a transfer

Article 20(5) and (7) EUTMR

Article 23(1) and (5) CDIR

When an application is made to register a transfer, but what is involved is actually a change of name of an EUTM, the Office informs the applicant accordingly and invites it to give, within a specified period, its consent to register the indications concerning the proprietor in the EUTM Register. If the applicant agrees, the change of name will be registered. If the applicant does not agree and insists on registering the change as a transfer, or if it does not respond, the application for the registration of a transfer will be rejected.

Obsolete

3 Transfers v Changes of Ownership Due to Entitlement Proceedings for RCDs

Articles 15 and 16 CDR

A transfer must be distinguished from a change of ownership following entitlement proceedings related to an RCD.

Pursuant to Article 15 CDR, RCDs may be the subject of entitlement proceedings and subsequent changes in ownership. Such changes in ownership are subject to a final decision from the competent authority and are entered in the RCD Register free of charge. For more information, see Part E Register Operations, Section 3, Chapter 2 Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, paragraph 8.2.

The main difference between a change of ownership and a transfer of an RCD is that a change of ownership is free of charge while a transfer is subject to a fee. In addition, the effects a change of ownership may have on already existing licences and other rights are different from the effects of transfers. Licenses and other rights lapse when the person entitled is entered in the Register (Article 16(1) CDR).

The option of a claim to entitlement to an RCD does not exist for EUTMs. Judgments on the proprietorship of an EUTM must be implemented through a transfer, as seen in paragraph 1.2.

4 Formal and Substantive Requirements for an Application for Registration of a Transfer

It is strongly recommended that the application for registration of a transfer for an EUTM be submitted electronically via the Office's website (e-recordals). Using e-recordals has advantages, such as the automatic receipt of electronic confirmation of the application, and the possibility to use the manager feature to complete the form quickly for as many EUTMs as required.

4.1 Languages

Article 146(6)(a) EUTMR

Article 80(a) CDIR

The application for the registration of a transfer for an EUTM application must be made in the first or second language of the EUTM application.

Obsolete

Article 146(6) EUTMR

Article 80(c) CDIR

The application for the registration of a transfer for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of a transfer is filed using the form provided by the Office pursuant to Article 65(1)(e) EUTMDR or Article 68 CDIR, according to Article 146(6) EUTMR and Article 80(c) CDIR, the form may be used in any of the official languages of the European Union, provided that it is completed in one of the languages of the Office, as far as textual elements are concerned.

When the application for the registration of the transfer relates to more than one EUTM application, the applicant must select a language for the application that is common to all the EUTMs concerned. If there is no common language, separate applications for registration of the transfer must be filed.

When the application for the registration of the transfer relates to more than one EUTM registration, the applicant must select one of the five languages of the Office as a common language.

Article 24 EUTMIR

Article 81(2) CDIR

Any supporting documents may be filed in any official language of the European Union. This applies to any document submitted as proof of the transfer, such as a countersigned transfer document or a transfer certificate, a deed of assignment or an extract from a trade register or a declaration agreeing to register the successor in title as the new proprietor.

When the supporting documents are submitted in an official language of the European Union that is not the language of the proceedings, the Office may require a translation into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

Obsolete

4.2 Application for registration of a transfer filed for more than one mark

Article 20(8) EUTMR

Article 23(6) CDIR

A single application for the registration of a transfer for two or more EUTMs may be submitted only if the registered proprietor and beneficiary, or assignee, are the same in each case.

Separate applications are necessary when the original proprietor and the new one are not exactly identical for each mark. For example, this is the case where there is one successor in title for the first mark and there are multiple successors in title for another mark, even if the successor in title for the first mark is among the successors in title for the other mark. It is immaterial whether the representative is the same in each case.

When a single application is filed in such cases, the Office will issue a deficiency letter. The applicant may overcome the objection either by limiting the application for the registration of the transfer to those EUTMs or EUTM applications for which there is only one and the same original proprietor and only one and the same new proprietor, or by declaring its agreement that the application should be dealt with in two or more separate proceedings. Otherwise, the application for registration of a transfer will be rejected in its entirety. The party concerned may file an appeal against this decision.

4.3 Parties to the proceedings

Article 20(4) and Article 20(6)(b) EUTMR

Article 13(3) EUTMIR

Article 28(a) CDR

Article 23(4) CDIR

The application for registration of a **transfer** may be requested at the Office by:

1. the EUTM proprietor(s), or
2. the EUTM proprietor(s) jointly with the assignee(s), or
3. the assignee(s), or
4. a court or authority.

The formal conditions with which the application must comply depend on who submits the application.

Obsolete

4.4 Formal requirements

4.4.1 Indications concerning the EUTM and the new proprietor

Article 20(5) EUTMR Article 2(1)(b) and (e), and Article 13(1) EUTMIR Article 1(1)(b) and (e), and Article 23(1) and (2) CDIR

The application for registration of a transfer must contain the following information.

1. The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the registration numbers must be indicated.
2. The details of the new proprietor. In the case of a natural person, the name, address and nationality must be indicated. In the case of a legal entity, the application must indicate the official designation and the legal form of the entity, which may be abbreviated in a customary manner (for example, S.L., S.A., Ltd., PLC). The company's national identification number may also be specified, if available. Both natural persons and legal entities must indicate the State in which they are domiciled or have their seat or an establishment. **The Office strongly recommends US companies to indicate, where applicable, the State of Incorporation, in order for it to differentiate clearly between different owners in its database.** These details correspond to the indications required for an applicant for a new EUTM application. However, where the Office has already assigned an ID number to the new proprietor, it is sufficient to indicate that number together with the name of the new proprietor.
   The form made available by the Office also requests an indication of the original proprietor's name. This indication will facilitate both the Office's and the parties' handling of the file.
3. If the new proprietor designates a representative, the representative's name and ID number assigned by the Office. If the representative has not yet been assigned an ID number, the business address must be indicated.

For additional requirements in cases of partial transfer, see paragraph 5 below.

4.4.2 Representation

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation).

Obsolete

4.4.3 Signatures

Article 20(5), Article 20(6)(b), and Article 119(4) EUTMR Article 13(2) EUTMIR Article 23(1) and (4) CDIR

The requirements concerning the person entitled to file the application for registration of the transfer and the signatures must be considered together with the requirement to submit proof of the transfer. The principle is that the signatures of the original proprietor and the new proprietor must appear together or separately on the application for registration of the transfer or in an accompanying document. In the case of co-ownership, and where the transfer concerns the ownership as a whole, all co-owners must sign or appoint a common representative.

When the original proprietor and the new proprietor both sign the application for registration of the transfer, this is sufficient and no additional proof of the transfer is necessary.

When the original proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration signed by the successor in title stating that it agrees to the registration of the transfer, this is sufficient and no additional proof is necessary.

When the new proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration, signed by the original proprietor, stating that it agrees to the registration of the successor in title as the new proprietor, this is also sufficient and no additional proof is necessary.

When the original proprietor's representative is also appointed as the new proprietor's representative, the representative may sign the application for registration of the transfer on behalf of both the original and the new proprietor, and no additional proof is necessary. However, when the representative signing on behalf of both the original and the new proprietor is not the representative on file (i.e. in an application simultaneously appointing the representative and transferring the EUTM), the Office will contact the applicant for registration of the transfer to request evidence of the transfer (authorisation signed by the original proprietor, proof of transfer, confirmation of the transfer by the original proprietor or its representative on file).

Obsolete

4.5 Proof of transfer

Article 20(2) and (3) EUTMR
Article 65(1)(e) EUTMDR
Article 13(1)(d) and Article 13(2) EUTMIR
Article 28 CDR
Article 23(1)(d) and (4)(a) to (c) and Article 68(1)(c) CDIR

A transfer may be registered only when it is proven by documents duly establishing the transfer, such as a copy of the deed of transfer. However, as already highlighted above, a copy of the deed of transfer is not necessary when:

- the new proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the original proprietor (or its representative) stating that it agrees to the registration of the transfer to the successor in title; or
- the original proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the new proprietor (or its representative) stating that it agrees to the registration of the transfer; or
- the application for registration of the transfer is signed by both the original proprietor (or its representative) and by the new proprietor (or its representative); or
- when the application for registration of the transfer is accompanied by a completed transfer form or document signed by both the original proprietor (or its representative) and by the new proprietor (or its representative).

Where proof of transfer is required, parties to the proceedings may also use the forms established under the Trademark Law Treaty available on WIPO's website (https://wipolex.wipo.int/en/treaties/textdetails/12680). The relevant forms are the 'Transfer Document' – a document conceived as constituting the transfer (assignment) itself – and the 'Certificate of Transfer' – a document in which the parties to a transfer declare that a transfer has taken place. Either of these documents, duly completed, constitutes sufficient proof of transfer.

However, other means of proof are not excluded. Therefore, the agreement (deed) itself or any other document proving the transfer may be submitted.

Regarding confidentiality, the party submitting the proof must bear in mind that the content of files are available for public inspection, and this is particularly relevant where contracts or other documents are submitted as evidence for a transfer, as they may contain sensitive data. Consequently, certain information may be **blacked out** before being submitted to the Office, or certain pages may **be omitted altogether**. The evidence required in support of a transfer does not need to include commercially sensitive items such as the price paid for the EUTM in question.

Obsolete

While omitting the sensitive information is preferable, alternatively, the Regulations do provide for confidentiality to be invoked where the party concerned expresses a special interest in keeping part of the file confidential. For more information on the formal requirements for invoking confidentiality, see the Guidelines, Part E, Register Operations, Section 5, paragraph 5.1.3 'Parts of the file for which the party concerned expressed a special interest in keeping confidential'.

When the mark has been subject to multiple successive transfers and/or changes of the proprietor's name that have not been previously registered in the register, it is sufficient to submit the chain of evidence showing the events leading to the relationship between the original proprietor and the new proprietor without the need to file separate individual applications for each change.

When the transfer of the mark is the consequence of the transfer of the whole of the undertaking of the original proprietor, documents showing the transfer or assignment of the whole undertaking must be submitted.

When the transfer is due to a merger or another universal succession, the original proprietor will not be available to sign the application for registration of transfer. In this case, the application must be accompanied by supporting documents that prove the merger or universal succession, such as extracts from the trade register.

When the transfer of the mark is a consequence of a right *in rem*, a levy of execution or insolvency proceedings, the original proprietor will not be able to sign the application for registration of transfer. In these cases, the application must be accompanied by a final decision issued by a competent national authority transferring the ownership of the mark to the beneficiary.

It is not necessary to legalise supporting documents nor to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient.

If the Office has reason to doubt the accuracy or veracity of the document, it may require additional proof.

The Office will examine the documents only to the extent that they actually confirm what is indicated in the application, namely the identity of the marks concerned and the identity of the parties, and whether a transfer is involved. The Office does not consider or rule on contractual or legal questions arising under national law (09/09/2011, T-83/09, Craic, EU:T:2011:450, § 27). If doubts arise, the national courts deal with the legality of the transfer itself.

Obsolete

4.5.1 Translation of proof

Article 146(1) EUTMR Article 24 EUTMIR Article 80(a) and (c) and Article 81(2) CDIR

The evidence must be:

1. in the language of the Office that has become the language of the proceedings for the registration of the transfer; or
2. in any official language of the European Union other than the language of the proceedings. In this case, the Office may require a translation of the document into a language of the Office to be submitted within a period specified by the Office.

Where the supporting documents are submitted in an official language of the European Union that is not the language of the proceedings, the Office may require a translation into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

4.6 Procedure to remedy deficiencies

Article 20(7) and (12) EUTMR Article 28 CDR Article 23(5) CDIR

The Office will inform the applicant for registration of the transfer in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, the Office will reject the application for registration of the transfer. The party concerned may file an appeal against the decision.

4.7 Collective and Certification marks

Article 20(5) and (7), and Articles 75, 79, 83, 84 and 88 EUTMR

The Office's practice in dealing with requests for transfer of EU collective marks and EU certification marks follows the principle that any new proprietor of an EU collective mark or EU certification mark should comply with the same initial requirements the original proprietor was obliged to comply with at the time of filing of the EUTM.

It is understood therefore, that where a request for transfer is submitted in relation to an EU collective mark or an EU certification mark, in addition to the requirements and the

Obsolete

documents duly establishing the transfer (Article 20(5) EUTMR), the Office will require the assignee to submit amended regulations of use (Articles 75, 79, 84 and 88 EUTMR). Specifically for EU certification marks, the applicant has to include in the regulations of use a declaration clearly specifying that the conditions of Article 83(2) EUTMR are fulfilled.

If these documents are not attached to the application for registration of the transfer, or if they do not comply with the requirements of Articles 75, 79, 84 and 88 EUTMR, a deficiency will be raised pursuant to Article 20(7) EUTMR, and in the event the deficiency is not remedied, the application for the registration of the transfer will be refused.

For more information on the formal requirements of EU collective marks and EU certification marks, and on the content and requirements of the regulations of use, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraphs 8.2 and 8.3.

5 Partial Transfers

Article 20(1) EUTMR
Article 14 EUTMIR

A partial transfer concerns only some of the goods and services in the EUTM and is only applicable to EUTMs (not to RCDs).

It involves the distribution of the original list of goods and services between the remaining EUTM and a new one. When partial transfers are involved, the Office uses particular terminology to identify the marks. At the beginning of the proceedings there is the 'original' mark. This is the mark for which a partial transfer has been applied. After the registration of the transfer, there are two marks: one is a mark that now has fewer goods and services, and is called the 'remaining' mark, and one is a 'new' mark that has some of the goods and services from the original mark. The 'remaining' mark retains the EUTM number of the 'original' mark while the 'new' mark has a new EUTM number.

Transfer cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for **some** territories.

When there are doubts as to whether the transfer is partial or not, the Office will inform the applicant for registration of the transfer and invite it to make the necessary clarifications.

Partial transfers may also be involved when the application for registration of the transfer concerns more than one EUTM. The following rules apply for each EUTM included in the application.

Obsolete

5.1 Rules on the distribution of the lists of goods and services

Articles 33 and 49 EUTMR

Article 14(1) EUTMIR

Communication No 1/2016 of the President of the Office of 08/02/2016

In the application for registration of a partial transfer, the goods and services to which the partial transfer relates must be indicated (the list of goods and services for the 'new' registration). The goods and services must be distributed between the original EUTM and the new EUTM so that the goods and services in the original EUTM and the new one do not overlap. The two specifications taken together must not be broader than the original specification.

Therefore, the indications must be clear, precise and unequivocal. For example, when an EUTM for goods or services in several classes is involved, and the 'split' between the original and new registration concerns entire classes, it is sufficient to indicate the respective classes for the new registration or for the remaining one.

When the application to register a partial transfer indicates goods and services that are explicitly mentioned in the original list of goods and services, the Office will automatically retain, in the original EUTM, the goods and services that are not mentioned in the application to register the partial transfer. For example, the original list contains goods A, B and C, and the transfer application relates to C; the Office will keep goods A and B in the original registration and create a new registration for C.

For further details concerning the scope of the list of goods and services, and for the Office's practice regarding the interpretation of general indications of the Nice Classification class headings, please see the Guidelines, Part B, Examination, Section 3, Classification, and Communication No 1/2016 of the President of the Office of 08/02/2016 concerning the implementation of Article 28 EUTMR (now Article 33 EUTMR), and the Annex thereto.

In all cases, it is highly recommended to file a clear and precise list of goods and services to be transferred together with a clear and precise list of goods and services to remain in the original registration. Furthermore, the original list must be clarified. For example, if the original list related to *alcoholic beverages* and the transfer relates to *whisky* and *gin*, the original list must be amended by restricting it to *alcoholic beverages, except whisky and gin.*

Obsolete

5.2 Objections

Article 20(7) EUTMR

When the application for registration of a partial transfer does not comply with the rules explained above, the Office will invite the applicant to remedy the deficiency. If the deficiencies are not remedied, the Office will reject the application for registration of a partial transfer. The party concerned may file an appeal against the decision.

5.3 Creation of a new EUTM

Article 20(6)(c) EUTMR

Article 14(2) EUTMIR

A partial transfer leads to the creation of a new EUTM. For this new EUTM, the Office will establish a separate file, which will consist of a complete copy of the electronic file of the original EUTM, the application for registration of a transfer, and all the correspondence related to the application for registration of the partial transfer. The new EUTM will be given a new file number. It will have the same filing date and, where applicable, date of priority as the original EUTM.

As far as the original EUTM is concerned, the Office will include a copy of the application for registration of a transfer in its files, but will not normally include copies of the further correspondence relating to the transfer application.

6 Transfer During the Course of Other Proceedings and Fees Issues

Article 20(11) and (12) EUTMR

Article 28(b) and (c) CDR

Without prejudice to the right to act from the time when the application for registration of a transfer is received by the Office where time limits are involved, the new proprietor will automatically become party to any proceedings involving the mark in question from the time the transfer is registered.

The filing of an application for registration of a transfer has no effect on time limits already running or established by the Office, including time limits for the payment of fees. New time limits for payment will not be established. From the date of registration of the transfer, the new proprietor becomes liable to pay any fees due.

Obsolete

Therefore, it is important that, during the period between the filing of the application for registration of a transfer and the Office's confirmation of its actual entry in the EUTM Register or in the file, the original proprietor and the new proprietor actively collaborate in the communication of time limits and correspondence received during *inter partes* proceedings.

6.1 Specific issues of partial transfers

Article 20(10) EUTMR

In cases of partial transfers, the new EUTM will be at the same procedural stage as the original (remaining) EUTM. Any time limit still pending for the original EUTM will be considered to be pending for both the remaining and the new EUTM. After registration of the transfer, the Office will treat each EUTM separately and will decide on them separately.

When an EUTM is subject to the payment of fees and these fees have been paid by the original proprietor, the new proprietor will not be liable to pay any additional fees for the new EUTM. The relevant date is the entry date of the transfer in the EUTM Register. Therefore, when the fee for the original EUTM is paid after an application for registration of a transfer has been filed but before the registration of the transfer itself, no additional fees are due.

Articles 31(2) and 41(5) EUTMR Annex I A(3) and (4), Annex I A(7) and (8) EUTMR

When the partial transfer involves an EUTM application and class fees have not yet been paid or have not been paid in full, the Office will proceed to register the transfer in the files of the remaining EUTM application and to create a new EUTM application as described above.

Where additional class fees have to be paid for an EUTM application, the examiner will deal with such cases after creating a new EUTM application, as described below.

When additional class fees were paid prior to registering the transfer but no additional class fees were due for the remaining EUTM application, no reimbursement will be made because the fees were paid correctly at the time of payment.

In all other cases, the examiner will treat the remaining EUTM application and the new one separately, but will not require an additional basic fee to be paid for the new EUTM application. Class fees for the remaining EUTM application and for the new one will be determined according to the situation after the registration of the transfer. For example, when the original EUTM application had seven classes and, after the transfer, the remaining EUTM application has only one class while the new EUTM application has six, no additional class fees will be due for the remaining EUTM application, but the corresponding additional class fees must be paid for the new EUTM application. When

Obsolete

some of the goods and services of a particular class are transferred and others are not, the fees for that class become payable for both the remaining EUTM application and the new one. When a time limit already set to pay additional class fees has not yet expired, it will be set aside by the Office to allow the determination to be made according to the situation after the registration of the transfer.

Article 53(1), (3) to (5) and (7) to (8) EUTMR

When the application for registration of a partial transfer relates to an EUTM registration that is due for renewal, that is, within 6 months prior to the expiry of the original registration and up to 6 months after that expiry, the Office will proceed to register the transfer and deal with the renewal and renewal fees as described below.

When no request for renewal has been submitted and no fees have been paid prior to the registration of the transfer, the general rules, including the rules relating to the payment of fees, are applicable to both the remaining EUTM registration and the new one (separate requests, separate payment of fees, as necessary).

When a request for renewal has been submitted prior to the registration of the transfer, that request is also valid for the new EUTM. However, while the original proprietor remains a party to the renewal proceedings for the remaining EUTM, the new proprietor automatically becomes party to the renewal proceedings for the new registration.

When a request for renewal has been filed but the relevant fees have not been paid prior to the registration of the transfer, the fees to be paid are determined according to the situation after the registration of the transfer. This means that both the proprietor of the remaining EUTM and the proprietor of the new EUTM must pay the basic renewal fee and any class fees.

When a request for renewal has been filed prior to the registration of the transfer and all the applicable renewal fees have been paid prior to this date, no additional renewal fees are due after the registration of the transfer. No reimbursement is made of any class fees already paid.

6.2 Transfer and *inter partes* proceedings

When an application for registration of a transfer is filed during *inter partes* proceedings, several different situations can arise. For earlier EUTMs on which the opposition/cancellation is based, the new proprietor can only become party to the proceedings (or file observations) once the application for registration of the transfer has reached the Office. The basic principle is that the new proprietor substitutes the original proprietor in the proceedings. The practice of the Office when dealing with transfers in oppositions is described in the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 7.5.

Obsolete

7 Entry in the Register, Notification and Publication

7.1 Publication and Entry in the Register

Article 20(4) and (9), Article 44, and Article 111(3)(g) EUTMR
Article 28(a) and Article 49 CDR
Article 23(7) and Article 70(3)(i) CDIR

The Office will enter the transfer in the EUTM Register and publish it in the EUTM Bulletin. The entry will be published once the EUTM application has been published pursuant to Article 44 EUTMR.

The entry in the EUTM Register will mention the following data:

- the date of registration of the transfer,
- the new proprietor's name and address,
- the name and address of the new proprietor's representative, if any.

For partial transfers, the entry will also contain the following data:

- the number of the original registration and the number of the new registration,
- the list of goods and services remaining in the original registration, and
- the list of goods and services of the new registration.

7.2 Notification

The Office will notify the applicant of the registration of the transfer.

When the application for registration of the transfer was filed by the assignee, the Office will also inform the EUTM proprietor of the registration of the transfer.

8 Transfers for Registered Community Designs

Article 1(3) and Articles 27, 28, 33 and 34 and Article 107(2)(f) CDR
Article 23 and Article 61(2) and Articles 68(1)(c) and 69(2)(i) CDIR
Annexes No 16 and No 17 CDFR

The legal provisions contained in the CDR, CDIR and CDFR in respect of transfers correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Obsolete

Therefore, both the legal principles and the procedure in respect of the registration of trade mark transfers apply *mutatis mutandis* to RCDs, except for the following specific procedures.

8.1 Rights of prior use for an RCD

Article 22(4) CDR

The right of prior use for an RCD cannot be transferred except where the third person, who owned the right before the filing or priority date of the application for an RCD, is a business, along with that part of the business in the course of which the act was done or the preparations were made.

8.2 Fees

Annexes No 16 and No 17 CDFR

The fee of EUR 200 for the registration of a transfer applies per design and not per multiple application. This is also the case for the ceiling of EUR 1 000 if multiple applications for registration of transfers are submitted.

9 Transfers for International Trade Marks

The Madrid System allows for the recording of a 'change of ownership' of an international registration.

All requests to record a change in ownership must be submitted on form MM5:

- directly to the International Bureau by the recorded holder, or
- through the office of the contracting party of the recorded holder or through the office of a contracting party in respect of which the transfer is granted, or
- through the office of the contracting party of the new proprietor (transferee).

The request to record a transfer cannot be submitted directly to the International Bureau by the new proprietor. The Office's own application form should **not** be used.

Detailed information on changes in ownership can be found in paragraphs B.II.60.01-67.02 of the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol (www.wipo.int/madrid/en/guide/). See also the Guidelines, Part M, International Marks.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 3

EUTMs and RCDs as objects of property

Chapter 2

Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings

Obsolete

Obsolete

1 Introduction

Articles 19 to 29 EUTMR

Articles 27 to 34 CDR

Articles 23 to 26 CDIR

Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings

Decision No EX-21-4 of the Executive Director of the Office of 30 March 2021 on the Register of EU trade marks, the Register of Community designs, the database of proceedings before the Office, and on the case-law database.

Both registered European Union trade marks (EUTMs) and EUTM applications may be the subject of licensing contracts (licences), rights *in rem* or levies of execution, or be affected by insolvency or similar proceedings. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

Both registered Community designs (RCDs) and applications for an RCD may be the subject of licences, rights *in rem* or levies of execution, or be affected by insolvency or similar proceedings.

The provisions in the CDR and CDIR dealing with design licences, rights *in rem* concerning designs, levies of execution concerning designs, and insolvency and similar proceedings concerning designs are almost identical to the corresponding provisions of the EUTMR and EUTMIR respectively. **Therefore, the following applies *mutatis mutandis* to RCDs**. **Exceptions and specific provisions for RCDs are detailed in paragraph 8 below.** Specific procedures for international trade marks are laid down in paragraph 9 below.

This section of the Guidelines deals with the procedures for registering, cancelling or modifying licences, rights *in rem*, levies of execution and insolvency proceedings or similar proceedings.

1.1 Definition of licence contracts

A trade mark licence is a contract by virtue of which the proprietor of a trade mark (the licensor), whilst retaining ownership, authorises a third person (the licensee) to use the trade mark in the course of trade, under the terms and conditions set out in the contract.

A licence refers to a situation where the rights of the licensee to use the EUTM arise from a contractual relationship with the proprietor. The proprietor's consent to, or tolerance of, a third party using the trade mark does not amount to a licence.

Obsolete

1.2 Definition of rights *in rem*

A right *in rem* or 'real right' is a limited property right that is an absolute right. Rights *in rem* refer to a legal action directed towards property, rather than towards a particular person, allowing the owner of the right the opportunity to recover, possess or enjoy a specific object. These rights may apply to trade marks or designs. They may consist, inter alia, in use rights, usufruct or pledges. '*In rem*' is different from '*in personam*', which means directed toward a particular person.

The most common rights *in rem* for trade marks or designs are pledges or securities. They secure the repayment of a debt of the proprietor of the trade mark or design (i.e. the debtor) in such a way that, where the proprietor cannot repay the debt, the creditor (i.e. the owner of the pledge or security) may receive repayment of the debt by, for example, selling the trade mark or design.

There are two types of right *in rem* for which the applicant can request entry in the EUTM Register:

- rights *in rem* that serve the purpose of guaranteeing securities (pledge, charge, etc.);
- rights *in rem* that do not serve as a guarantee (usufruct).

1.3 Definition of levies of execution

A levy of execution is the act by which a court officer appropriates a debtor's property following a judgment of possession obtained by a plaintiff from a court. In this way, a creditor can recover its claim from all the property of the debtor, including from its trade mark rights.

1.4 Definition of insolvency proceedings or similar proceedings

For the purposes of these Guidelines, 'insolvency proceedings' are understood to be the collective proceedings that entail the partial or total divestment of a debtor and the appointment of a liquidator. They may include winding up by, or under the supervision of, a court, creditors' voluntary winding up (with confirmation by the court), administration, voluntary arrangements under insolvency legislation and bankruptcy. 'Liquidator' is understood as any person or body whose function is to administer or liquidate assets of which the debtor has been divested or to supervise the administration of their affairs, and may include liquidators, supervisors of a voluntary arrangement, administrators, official receivers, trustees and judicial factors. 'Court' is understood to be the judicial body or any other competent body of a Member State empowered to open insolvency proceedings or to take decisions in the course of such proceedings. 'Judgment', in relation to the opening of insolvency proceedings or the appointment of a liquidator, is understood to include the decision of any court

Obsolete

empowered to open such proceedings or to appoint a liquidator (for terminology in other territories, see Regulation (EU) 2015/848 on insolvency proceedings).

1.5 Applicable law

Article 19 EUTMR Article 27 CDR

The EUTMR does not establish unified and complete provisions applicable to **licences**, **rights *in rem*** or **levies of execution** for EUTMs or EUTM applications. Instead, Article 19 EUTMR refers to the law of a Member State regarding the acquisition, validity and effects of the EUTM as an object of property, and regarding the procedure for levies of execution. To this end, a licence, a right *in rem* or a levy of execution for an EUTM is, in its entirety and for the whole territory of the European Union, assimilated to a licence, to a right *in rem*, or to a levy of execution for a trade mark registered in the Member State in which the EUTM proprietor has its seat or domicile. If the proprietor does not have a seat or domicile in a Member State, the licence, right *in rem* or levy of execution for an EUTM will be dealt with as a licence, right *in rem* or levy of execution for a trade mark registered in the Member State in which the proprietor has an establishment. If the proprietor does not have an establishment in a Member State, the licence, right *in rem* or levy of execution for an EUTM will be dealt with as a licence, right *in rem* or levy of execution for a trade mark registered in Spain (Member State in which the Office has its seat).

This, however, applies only to the extent that Articles 20 to 28 EUTMR do not provide otherwise.

Article 19 EUTMR is limited to the effects of a licence or right *in rem* as an object of property and does not extend to contract law. Article 19 EUTMR does not govern the applicable law or the validity of a licensing contract or right *in rem* contract, which means that the freedom of the contracting parties to submit the licensing contract or the *right in rem* contract to a given national law is not affected by the EUTMR.

Article 21(1) EUTMR Article 31(1) CDIR Article 3(1) of Regulation (EU) 2015/848 on insolvency proceedings

Furthermore, these Guidelines serve to explain the procedure before the Office for registering the opening, modification or closure of **insolvency proceedings** or **similar proceedings**. In accordance with Article 19 EUTMR, all other provisions are covered by national law. Moreover, Regulation (EU) 2015/848 on insolvency proceedings regulates the provisions on jurisdiction, recognition and applicable law in the area of insolvency proceedings.

Obsolete

The regulations specifically state that an EUTM may only be involved in insolvency proceedings opened in the Member State in the territory of which the debtor has its centre of main interests. The only exception is when the debtor is an insurance undertaking or credit institution, in which case the EUTM may only be involved in those proceedings opened in the Member State where that undertaking or institution has been authorised. The 'centre of main interests' should correspond to the place where the debtor conducts the administration of its interests on a regular basis and is, therefore, ascertainable by third parties (for further information on the 'centre of main interests' see Article 3(1) of Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings).

1.6 Advantages of registration

Article 27 and Article 57(3) EUTMR
Article 33 and Article 51(4) CDR
Article 27(2) CDIR

Entry in the EUTM Register of a licence agreement, a right *in rem*, a levy of execution, or the opening, modification and closure of insolvency proceedings is not compulsory. However, such registration has particular advantages.

1. In view of the provision of Article 27(1) and (3) EUTMR, vis-à-vis third parties who might have acquired, or have entered in the EUTM Register, rights in the trade mark that are incompatible with the **registered licence, right *in rem* or levy of execution**, the licensee, pledgee or beneficiary respectively may avail itself of the rights conferred by this licence, right *in rem* or levy of execution only:
   - if it was entered in the EUTM Register;
     or
   - if the third party acquired its rights after the date of any legal acts such as those referred to in Articles 20, 22, 23, 25 and 26 EUTMR (a transfer, a right *in rem*, a levy of execution, or a previous licence), knowing of the existence of the licence, right *in rem* or levy of execution.

     In view of Article 27(4) EUTMR, vis-à-vis third parties that might have acquired or have entered in the EUTM Register rights in the trade mark that are incompatible with the **registered insolvency**, the effects will be governed by the law of the Member State in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.
2. Where a **licence or a right *in rem*** for an EUTM is entered in the EUTM Register, the surrender or partial surrender of that mark by its proprietor will only be entered in the EUTM Register if the proprietor establishes that it has informed the licensee or pledgee respectively of its intention to surrender.

   The holder of a licence or the pledgee of a right *in rem* that is registered has, therefore, the right to be informed in advance by the proprietor of the trade mark of its intention to surrender the trade mark.

Obsolete

On entry in the EUTM Register of **insolvency proceedings or a levy of execution** against an EUTM, the proprietor loses its right to act and, therefore, may not perform any actions before the Office (such as withdraw, surrender, transfer, act in *inter partes* proceedings).

3. Where a **licence, right *in rem*, levy of execution, or insolvency proceedings** for, or against, an EUTM is entered in the EUTM Register, the Office will notify the licensee, pledgee, beneficiary or liquidator, respectively, of the approaching expiry of the registration at least six months beforehand.
4. Registering **licences, rights *in rem*, levies of execution and insolvency proceedings** (and their modification and/or cancellation, where applicable) is important for maintaining the veracity of the EUTM Register, particularly in the event of *inter partes* proceedings.

However,

1. when a party to proceedings before the Office has to prove use of an EUTM, if such use has been made by a licensee, it is not necessary for the **licence** to have been entered in the EUTM Register for that use to be considered to be use with the proprietor's consent pursuant to Article 18(2) EUTMR;
2. registration is not a condition for considering the use of a trade mark by a pledgee under the terms of the **right *in rem*** contract to have been made with the consent of the proprietor pursuant to Article 18(2) EUTMR;
3. the Office strongly recommends that liquidators duly inform the Office of the withdrawal, surrender or transfer of EUTMs subject to **insolvency proceedings** prior to the final winding up.

2 Requirements for an Application for Registration of a Licence, Right *in Rem*, Levy of Execution, and Insolvency Proceedings

Articles 22(2), 23(3), 24(3) and 25(5), Article 26 and Article 111(3) EUTMR
Articles 29(2), 30(3), 31(3) and 32(5) CDR
Articles 24 and 25 CDIR

The application for registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings must comply with the following conditions.

Obsolete

2.1 Application form

Article 146(6) EUTMR

Article 65(1)(f) EUTMDR

Article 68(1)(d) and Article 80 CDIR

It is strongly recommended that the application for registration of a licence, a right *in rem*, a levy of execution or insolvency proceedings for an EUTM be submitted electronically via the Office's website (e-recordals). Using e-recordals has advantages, such as the automatic receipt of electronic confirmation of the application and the possibility to use the manager feature to complete the form quickly for as many EUTMs as required.

Articles 20(8) and 26(1) EUTMR

Articles 23(6) and 24(1) CDIR

A single application for the registration of a **licence** for two or more EUTMs may be made only if the registered proprietor and the licensee are the same and the contracts have the same conditions, limitations and terms in each case (see paragraph 2.5 below).

A single application for the registration of a **right *in rem* or a levy of execution** for two or more registered EUTMs may be submitted only if the registered proprietor and beneficiary are the same in each case.

2.2 Languages

Article 146(6)(a) EUTMR

Article 80(a) CDIR

The application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings for an EUTM application must be made in the first or second language of the EUTM application.

Article 146(6)(b) EUTMR

Article 80(c) CDIR

The application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

Obsolete

However, when the application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings is filed using the form provided by the Office pursuant to Article 65(1)(f) EUTMDR and Article 68 CDIR, the form may be used in any of the official languages of the European Union, provided that it is completed in one of the languages of the Office, as far as textual elements are concerned.

2.3 Fees

Article 26(2) and Annex I A(26) and (27) EUTMR Articles 23(3) and 24(1) CDIR Annex (18) CDFR

The application for the registration of a **licence, a right *in rem*** or **a levy of execution** is considered not to have been made until the fee is paid. The amount of this fee is EUR 200 for each EUTM for which the registration is requested.

However, where several registrations of **licences, rights *in rem*** or **levies of execution** have been applied for in one single application and the registered proprietor and the licensee (and contractual terms), pledgee, or beneficiary are the same in all cases, the fee is limited to a maximum of EUR 1 000.

The same maximum amount applies where several registrations of **licences, rights *in rem* or levies of execution** are applied for at the same time, provided that they could have been filed in one single application and that the registered proprietor and the licensee, pledgee or beneficiary are the same in all cases. Furthermore, for the registration of **licences or rights *in rem***, the contractual terms must be the same. For example, an exclusive licence and a non-exclusive licence cannot be filed in the same application, even if they are between the same parties.

Once the corresponding fee has been paid, it will not be reimbursed if the application for registration is refused or withdrawn.

There is no fee for registering **insolvency proceedings** or similar proceedings.

2.4 Parties to the proceedings

2.4.1 Applicants

Articles 22(2), 23(3), 25(5) and 117(1) EUTMR Articles 29(2), 30(3) and 32(5) CDR

An application for the registration of a **licence**, of a **right *in rem*** or of a **levy of execution** at the Office may be filed by:

Obsolete

1. the EUTM proprietor(s); or
2. the EUTM proprietor(s) jointly with the licensee(s)/pledgee(s)/beneficiary(ies); or
3. the licensee(s)/pledgee(s)/beneficiary(ies).

Where the Office receives documents relating to such existing rights on EUTMs or RCDs from third parties or authorities such as national Registers or national Courts, it will forward the documents to the EUTM proprietor/RCD holder with a notice indicating that such a right could be entered in the EUTM or RCD Register upon request and payment of the relevant fees. Additionally, if the rights holder (pledgee or beneficiary) is fully identified by its contact details, the same notice will also be sent, for information only, to the pledgee(s)/beneficiary(ies). The document will be incorporated into the files relating to the EUTM or RCD affected.

Article 24(3) EUTMR Article 31(3) CDR

The application for the registration of **insolvency proceedings** may be requested by:

1. a Court, or
2. competent national authorities, including the liquidator in the insolvency proceedings; or
3. any of the parties.

2.4.2 Mandatory indications concerning the EUTM and the licensee, pledgee, beneficiary or liquidator

Articles 24(2) and 26(1) EUTMR Article 2(1)(b) and (e) EUTMIR Article 13 EUTMDR Article 31 CDR Article 1(1)(b) and (e), Articles 23 and 24 CDIR

The application for registration of a licence, a right *in rem*, a levy of execution or insolvency proceedings must contain the following information.

1. The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the registration numbers must be indicated.
   Additionally, for **insolvency proceedings**, the Office will register the **insolvency proceedings** against **all** EUTMs/RCDs linked to the proprietor's ID number at the Office.

   Where the proprietor is the joint proprietor of an EUTM or RCD, the **insolvency proceedings** will apply to the share of the joint proprietor.
2. The licensee's, pledgee's, beneficiary's or liquidator's name, address and nationality (for RCDs only), as well as the State in which it is domiciled or has its seat or an

Obsolete

establishment. However, if the Office has already assigned an ID number to them, it is sufficient to indicate this number together with the name.

3. If the licensee, pledgee, beneficiary or liquidator designates a representative, the representative's name and ID number assigned by the Office. If the representative has not yet been assigned an ID number, the business address must be indicated.

2.4.3 Signatures

Article 63(1)(a) EUTMDR Article 67(4) CDIR

Where the requirement of a signature is referred to, in electronic communications, the indication of the sender's name is considered to be equivalent to the signature.

The general rules on signatures apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits).

2.4.4 Representation

Articles 119(2) and 120(1) EUTMR Articles 77(2) and 78(1) CDR

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation).

2.4.5 Proof

Articles 55 and 64 EUTMDR

For the special provisions and specific requirements with regard to proof, see the paragraphs below. These give details based on the type of right being registered: paragraph 4.1 for licences; paragraph 5.1 for rights *in rem*; paragraph 6.1 for levies of execution; paragraph 7.1 for insolvency proceedings.

2.4.6 Translation of proof

Article 146(6) EUTMR Article 24 EUTMIR Article 80 and Article 81(2) CDIR

Proof must be as follows.

Obsolete

1. In the language of the Office that has become the language of the proceedings for the registration of the licence, right *in rem*, levy of execution or insolvency proceedings, see paragraph 2.2 above.
2. Or in any official language of the European Union other than the language of the proceedings. In this case, the Office may require a translation of the document into a language of the Office to be submitted within a period specified by the Office. The Office will set a time limit for submission of the translation. If the translation is not submitted within that time limit, the document will not be taken into account and will be considered not to have been submitted.

2.5 Examination of the application for registration

2.5.1 Fees

Article 26(2) EUTMR Articles 23(3) and 24(1) CDIR

Where the required fee has not been received, the Office will notify the applicant that the application is considered not to have been filed because the relevant fee has not been paid. However, a new application may be submitted at any time providing the correct fee is paid from the outset.

There is no fee for applications for the registration of **insolvency proceedings** or similar proceedings.

2.5.2 Examination of the mandatory formalities

Article 24(1) EUTMR Article 31(1) CDR

For **insolvency proceedings**, the Office will check that there are no other pending recordals and that no insolvency proceedings have already been registered for the proprietor concerned.

Article 26(4) EUTMR Article 24(3) CDIR

The Office will check whether the application for registration complies with the formal conditions mentioned in paragraph 2.4 above and with the specific requirements given below, based on the type of right being registered (see paragraph 4.1 for licences, paragraph 5.1 for rights *in rem*, paragraph 6.1 for levies of execution, and paragraph 7.1 for insolvency proceedings).

Obsolete

Article 26 and Article 120(1) EUTMR

Article 78(1) CDR

Article 24 CDIR

The Office will check whether the application for registration of the **licence, right *in rem*, levy of execution** or **insolvency proceedings** has been duly signed. Where the application is signed by the licensee's, pledgee's, beneficiary's or liquidator's representative, an authorisation may be required by the Office or, in the case of *inter partes* proceedings, by the other party to the proceedings. In this case, if no authorisation is submitted, the proceedings will continue as if no representative had been appointed.

Where the application for registration of the **licence, right *in rem, insolvency proceedings*** or **levy of execution** is signed by the representative that has already been designated as the proprietor's representative for the EUTM in question, the requirements relating to signatures and authorisations are fulfilled.

Article 26(4) EUTMR

Article 24(3) CDIR

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the period established in that communication, the Office will reject the application for registration of the right. The party concerned may file an appeal against this decision.

For additional specific formalities that concern only **licences** and **rights *in rem***, see the special provisions below (paragraphs 4.3 and 4.4 for licences, and paragraph 5.2 for rights *in rem*).

3 Procedure for Cancellation or Modification of the Registration

Articles 29(1) and 117(1) EUTMR

Article 26(1) CDIR

The registration of a **licence**, a **right *in rem***, a **levy of execution** or **insolvency proceedings** will be cancelled or modified at the request of an interested party, that is, the applicant or proprietor of the EUTM or the registered licensee, pledgee, beneficiary or liquidator. In **insolvency proceedings**, it may also be the relevant national authority or court.

Obsolete

A registration of a **licence** or **right *in rem*** may also be transferred (see paragraph 4.6 for licences and paragraph 5.4 for rights *in rem*). The application should make a clear distinction between a request for modification and a request for transfer.

The Office will refuse the cancellation, transfer and/or modification of a **licence, sublicence** or **right *in rem*** if the main licence or right *in rem* has not been entered in the EUTM Register.

3.1 Competence, languages, presentation of the request

Article 29(3) and (6), and Article 162 EUTMR Article 104 CDR Article 26(3), (6) and (7) CDIR

Paragraphs 2.1 and 2.2 above apply.

It is strongly recommended that requests for cancellation or modification of a **licence, right *in rem*, levy of execution or insolvency proceedings** be submitted using the official forms available on the Office's website. Parties to the proceedings may also use WIPO Model International Form No 1, 'Request for Amendment/Cancellation of Recordal of License', (found in the annex to the Joint Recommendation concerning trademark licenses adopted by the Assembly of the Paris Union and the General Assembly of WIPO on 25/09/2000 to 03/10/2000), which can be downloaded at http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf, or a form with a similar content and format.

3.2 Applicant for a cancellation or modification request

Article 29(1) and (6) and Article 117(1) EUTMR Article 26(1), (4) and (6) CDIR

Requests for cancellation or modification of a registration may be submitted by the same parties who can file applications for registration (see paragraph 2.4.1 above).

3.2.1 Licences

3.2.1.1 Cancellation of a licence

In the case of a joint request submitted by the EUTM proprietor and the licensee, or of a request submitted by the licensee, no proof of the cancellation of the licence is required, since the request itself implies a statement from the licensee that it consents to the cancellation of the registration of the licence. However, a request for cancellation

Obsolete

submitted by the EUTM proprietor alone must be accompanied by proof that the registered licence no longer exists, or by a declaration from the licensee to the effect that it consents to the cancellation.

Where a registered licensee alone submits a request for cancellation, the EUTM proprietor will not be informed thereof.

If the EUTM proprietor alleges fraud on the part of the licensee, it must submit a final decision of the competent authority to this effect. It is not within the remit of the Office to carry out any investigation in that respect.

Where several licences were requested simultaneously, it is possible to cancel them individually.

The entry in the EUTM Register of licences that are limited in time, that is, temporary licences, does not automatically expire but must be cancelled from the EUTM Register.

3.2.1.2 Modification of a licence

In the case of a joint request from the EUTM proprietor and the licensee, no further proof of the modification of the licence is required.

If the request is made by the EUTM proprietor, proof of the modification of the licence is required only where the modification for which entry in the EUTM Register is requested is of such a nature that it would diminish the rights of the registered licensee under the licence. For example, this would be the case if the licensee's name were to change, if an exclusive licence were to become a non-exclusive licence, or if the licence were to become restricted regarding its territorial scope, the period of time for which it is granted, or the goods or services to which it applies.

If the request is made by the registered licensee, proof of the modification of the licence is required only where the modification for which entry in the EUTM Register is requested is of such a nature that it would extend the rights of the registered licensee under the licence. For example, this would be the case if a non-exclusive licence were to become an exclusive licence, or if any registered restrictions of the licence as to its territorial scope, the period of time for which it is granted, or the goods or services to which it applies, were to be cancelled fully or in part.

Where proof of the modification of the licence is necessary, it is sufficient if any of the documents referred to in paragraph 4.1.4 below are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the licence contract and must relate to the registration of the modification of the licence as requested.
- The request for modification or cancellation of a licence must indicate how the licence has been modified.
- The copy or extract of the licence agreement must be of the licence as modified.

Obsolete

3.2.2 Rights *in rem*

3.2.2.1 Cancellation of the registration of a right *in rem*

If the EUTM proprietor and the pledgee submit a joint request, or if the pledgee alone submits a request, no proof of the cancellation of the registration of the right *in rem* is required, since the request itself implies a statement by the pledgee that it consents to the cancellation of the registration of the right *in rem*. When the request for cancellation is submitted by the EUTM proprietor, it must be accompanied by proof that the registered right *in rem* no longer exists, or by a declaration by the pledgee that it consents to the cancellation.

Where the registered pledgee submits the request for cancellation by itself, the EUTM proprietor will not be informed thereof.

Where the registration of several rights *in rem* was requested simultaneously, it is possible to cancel them individually.

3.2.2.2 Modification of the registration of a right *in rem*

If the EUTM proprietor and the pledgee submit a joint request, no further proof of the modification of the registration of the right *in rem* is required.

If the request is submitted by the EUTM proprietor or the registered pledgee, proof of the modification of the registration of the right *in rem* is required.

Where proof of the modification of the registration of the right *in rem* is necessary, it is sufficient if any of the documents referred to in paragraph 5.1.4 below are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the right *in rem* agreement and must relate to the registration of the modification of the right *in rem* as requested.
- The request for modification or cancellation of the registration of a right *in rem* must show the right *in rem* in its modified form.
- The copy or extract of the right *in rem* agreement must show the right *in rem* in its modified form.

3.2.3 Levies of execution

3.2.3.1 Cancellation of the registration of a levy of execution

A request for cancellation of the registration of a levy of execution must be accompanied by proof that the registered levy of execution no longer exists. This proof comprises the final decision of the competent authority.

Obsolete

3.2.3.2 Modification of the registration of a levy of execution

A levy of execution may be modified on submission of the corresponding final decision of the competent authority showing such modification.

3.2.4 Insolvency proceedings

3.2.4.1 Cancellation of the registration of an insolvency

A request for the cancellation of the registration of insolvency proceedings must be accompanied by proof that the registered insolvency no longer exists. This proof comprises the final decision of the competent authority.

3.2.4.2 Modification of the registration of an insolvency

The registration of insolvency proceedings may be modified on submission of the corresponding final decision of the competent authority showing such modification.

3.3 Contents of the request

Article 29(1) EUTMR
Article 12 EUTMIR
Articles 19 and 26 CDIR

Paragraph 2.4 above applies, except that the data concerning the licensee, pledgee, beneficiary or liquidator need not be indicated except in the case of a modification of the registered licensee's, pledgee's, beneficiary's or liquidator's name.

Paragraph 4.2 below applies if a modification of the scope of a **licence** is requested, for example, if a licence becomes a temporary licence or if the geographical scope of a licence is changed.

Obsolete

3.4 Fees

3.4.1 Cancellation

Article 29(3) and Annex I A(27) EUTMR Article 26(3) CDIR Annex (19) CDFR

Any request for the cancellation of **licences**, **rights *in rem*** and **levies of execution** is considered not to have been made until the fee is paid. The fee is EUR 200 for each EUTM for which cancellation is requested.

However, where several requests for cancellations of licences, rights *in rem* and levies of execution are applied for in one single application or at the same time, and the registered proprietor and the licensee (including contractual terms), pledgee, or beneficiary are the same in all cases, the cancellation fee is limited to a maximum of EUR 1 000.

This applies irrespective of how the initial applications for registration of these licences, rights *in rem* or levies of execution were filed. This means that, even where the initial applications for registration of these rights were staggered over time and could not, therefore, benefit from the maximum fee of EUR 1 000, they can still benefit from the maximum fee of EUR 1 000 if their cancellation is requested in the same application for cancellation.

Requests for cancellation of the registration of **insolvency proceedings** are not subject to a fee.

3.4.2 Modification

Article 29(3) EUTMR Article 26(6) CDIR

Modification of the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings is not subject to a fee.

3.5 Examination of requests for cancellation or modification

Obsolete

3.5.1 Fees

Article 29(3) EUTMR

Article 26(3) CDIR

Where the required fee for a request for cancellation of a **licence**, a **right *in rem***, or a **levy of execution** has not been received, the Office will notify the applicant that the request for cancellation is considered not to have been filed.

As seen above, requests for cancellation of the registration of **insolvency proceedings** are not subject to a fee.

3.5.2 Examination by the Office

Article 29(2) and (4) EUTMR

Article 26(2) and (4) CDIR

For the mandatory elements of the request, paragraph 2.5.2 above applies *mutatis mutandis*, including in respect of proof, to the extent that such proof is required. Additionally, specific formalities apply to **licences** (see paragraph 4.3 below), to **rights *in rem*** (see paragraph 5.2 below), to **levies of execution** (see paragraph 6.1 below) and to **insolvency proceedings** (see paragraph 7.1 below).

The Office will notify the applicant for cancellation or modification of any deficiency, setting a time limit of 2 months. If the deficiencies are not remedied, the Office will reject the request for cancellation or modification.

Article 29(1), (2), (4) and (5), Articles 111(6) and 117(1) EUTMR

Articles 26(6) and 69(6) CDIR

Paragraph 4.4 below applies to the extent that modification of the **licence** would affect its nature or its limitation to a part of the goods and services covered by the EUTM.

Registration of the cancellation or modification of a **licence**, a **right *in rem***, a **levy of execution** or **insolvency proceedings** will be communicated to all the parties concerned.

Obsolete

3.6 Registration and publication

Articles 111(3)(s) and 116(1)(a) EUTMR Article 69(3)(t) and Article 70(2) CDIR

The creation, cancellation or modification will be entered in the EUTM Register and published in the EUTM Bulletin.

4 Licences - Special Provisions

4.1 Requirements concerning proof

Article 19 and Article 26(1) EUTMR Articles 2(1)(b) and 13(3)(a) EUTMIR Article 27 CDR Article 1(1)(b) and Articles 23(4) and 24(1) CDIR

4.1.1 Application made by the EUTM proprietor alone

When an application for the registration of a licence is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

No proof of the licence is necessary.

The Office will inform the licensee when the licence is registered in the EUTM Register.

The licensee may file a statement with the Office to oppose the registration of the licence. The Office will not take any further action on the statement but will register the licence. Following the registration of the licence, any licensee that disagrees with the registration of the licence may request the cancellation or modification of the licence (see paragraph 3 above).

The Office will not take into account whether or not the parties, although having agreed to a licence contract, have agreed to register it at the Office. Any dispute regarding the licence is a matter that must be resolved among the parties concerned under the relevant national law (Article 19 EUTMR).

Obsolete

4.1.2 Application made jointly by the EUTM proprietor and the licensee

When an application for the registration of a licence is made jointly by the EUTM proprietor and its licensee, it must be signed both by the EUTM proprietor and the licensee. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the licence.

Where there is a formal deficiency regarding the signature of the licensee or regarding its representative, the application will still be accepted as long as it would have been acceptable if it had been presented by the EUTM proprietor alone.

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or regarding its representative, but where the application would have been acceptable if it had been presented by the licensee alone.

4.1.3 Application made by the licensee alone

An application for the registration of a licence may also be made by the licensee alone. In this case, it must be signed by the licensee and proof of the licence must be submitted.

4.1.4 Proof of the licence

There is sufficient proof of the licence if the application for registration of the licence is accompanied by any of the following.

- A declaration stating that the EUTM proprietor agrees to the registration of the licence, signed by the EUTM proprietor or its representative.
  According to Article 13(3)(a) EUTMIR, it is also considered sufficient proof if an application for registration of the licence is signed by both parties. This case has already been dealt with in paragraph 4.1.2 above.
- The licence agreement, or an extract therefrom, indicating the parties and the EUTM being licensed, and bearing their signatures.
  In many cases, the parties to the licence agreement will not wish to disclose all the details, which may contain confidential information on the licence royalties or other terms and conditions of the licence. In such cases, it is sufficient if only a part or an extract of the licence agreement is submitted, as long as it identifies the parties to the licence agreement, confirms that the EUTM in question is the subject of a licence and contains the signatures of both parties. All other elements may be omitted or blacked out.
- An uncertified statement of licence using the complete WIPO Model International Form No 1 ‘Request for Recordal of License’. The form must be signed by both the EUTM proprietor, or its representative, and the licensee, or its representative. It can be found at http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf

Obsolete

It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

4.2 Optional contents of the application

Articles 25(1) and 26(3) EUTMR Article 32(1) CDR Article 25 CDIR

Depending on the nature of the licence, an application for registration of the licence may contain the request to register the licence together with other indications, namely those referred to under letters a) to e) below. These indications may be individual or in any combination, for one licence (e.g. an exclusive licence limited in time) or for several licences (e.g. one exclusive licence for A as regards Member State X and another for B as regards Member State Y). They are entered in the EUTM Register by the Office only if the application for registration of the licence itself clearly requests that they be registered. Without such an explicit request, the Office will not enter in the EUTM Register any indications contained in the licence agreement that are submitted, for example, as proof of the licence.

However, if entry in the EUTM Register is requested for one or more of these indications, the following details must be indicated.

1. Where an application for the registration of a licence is limited to only some of the goods or services, the goods or services for which the licence has been granted must be indicated.
2. Where an application is for the registration of a licence as a territorially limited licence, the application must indicate the part of the European Union for which the licence has been granted. A part of the European Union may consist of one or several Member States or one or several administrative districts within a Member State.
3. Where registration of an exclusive licence is sought, a statement to this effect must be made in the application for registration.
4. Where the registration of a licence granted for a limited period of time is sought, the expiry date of the licence must be specified. Furthermore, the date of the commencement of the licence may be indicated.
5. Where the licence is granted by a licensee whose licence is already entered in the EUTM Register, the application for registration may indicate that it is for a sublicence. Sublicences cannot be registered without first registering the main licence.

Obsolete

4.3 Examination of specific formalities (licences)

Article 26(4) EUTMR

Article 24(3) CDIR

Where an application for the registration of a licence has been made jointly by the EUTM proprietor and the licensee, the Office will communicate with the EUTM proprietor and send a copy to the licensee.

Where the licensee has also made and signed the application, it will not be allowed to contest the existence or scope of the licence.

Where the application for registration of the licence is filed by the EUTM proprietor alone, the Office will not inform the licensee.

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, which will normally be 2 months following the date of the notification, the Office will reject the application. The party concerned may file an appeal against this decision.

4.4 Examination of optional elements (licences)

Article 26 EUTMR

Article 25 CDIR

Where an application for the registration of a licence specifies that the licence be registered as one of the following:

- an exclusive licence;
- a temporary licence;
- a territorially limited licence;
- a licence limited to certain goods or services; or
- a sublicence,

the Office will examine whether the indications mentioned in paragraphs 2.4 and 4.1 above are indicated.

As far as the indication ‘exclusive licence’ is concerned, the Office will accept only this term and not any other wording. If ‘exclusive licence’ is not expressly indicated, the Office will consider the licence to be non-exclusive.

Where an application for registration indicates that it is for a licence limited to certain goods or services covered by the EUTM, the Office will check whether the goods and services are properly grouped and are actually covered by the EUTM.

As far as a sublicence is concerned, the Office will check whether it has been granted by a licensee whose licence has already been entered in the EUTM Register. The

Obsolete

Office will refuse the registration of a sublicence when the main licence has not been entered in the EUTM Register. However, the Office will not check the validity of an application for the registration of a sublicence as an exclusive licence when the main licence is not an exclusive licence. Nor will it examine whether the main licence contract excludes granting sublicences.

It is the duty of the applicant for the registration of a licence not to conclude and register incompatible contracts and to request the cancellation or modification of entries in the Register that are no longer valid. For example, if an exclusive licence has been registered without limitation as to the goods and the territory, and the registration of another exclusive licence is applied for, the Office will register that second licence, even where both licences seem incompatible at first sight.

Parties are, furthermore, encouraged to update all EUTM Register information regularly and swiftly by cancelling or modifying existing licences (see paragraph 3 above).

Article 25(1), and Article 26(3) and (4) EUTMR Article 32(1) CDR Articles 24(3) and 25 CDIR

If the indications mentioned in paragraph 4.2 above are missing, the Office will invite the applicant for the registration of the licence to submit the supplementary information. If the applicant does not reply to that communication, the Office will not take into account the abovementioned indications and will register the licence without mentioning them. The applicant will be notified of this and may file an appeal against the decision.

4.5 Registration procedure and publication (licences)

Article 25(5) and Articles 111(3)(j) and 116(1)(a) EUTMR Article 32(5) CDR Article 69(3)(t) and Article 70(2) CDIR

The Office will enter the licence in the EUTM Register and publish it in the EUTM Bulletin.

Where applicable, the entry in the EUTM Register will only mention that the licence is:

- an exclusive licence;
- a temporary licence;
- a territorially limited licence;
- a sublicence; or
- a licence limited to certain goods or services covered by the EUTM.

The following details will not be published:

Obsolete

- the period of validity of a temporary licence;
- the territory covered by a territorially limited contract;
- the goods and services covered by a partial licence.

Article 111(6) EUTMR Article 69(5) CDIR

The Office will notify the applicant for a registration of a licence of the registration thereof.

When an application for registration of a licence was filed by the licensee, the Office will also inform the EUTM proprietor of the registration of the licence.

4.6 Transfer of a Licence

4.6.1 Provision for the transfer of a licence

Article 25(5) EUTMR Article 32(5) CDR

A licence concerning an EUTM may be transferred. The transfer of a licence is different from the transfer of a sublicence insofar as, in the former, the licensee loses all its rights under the licence and is replaced by a new licensee, whereas, in the case of the transfer of a sublicence, the main licence remains in force. Likewise, the transfer of a licence is different from a change of name of the owner where no change of ownership is implied (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer).

4.6.2 Applicable rules

Article 26(1) and (5) and Annex I A(26)(b) EUTMR Article 24(1) and (3) CDIR Annex (18)(b) CDFR

The procedure for the registration of a transfer of a licence follows the same rules as for an application for registration of a licence.

The transfer of a licence is subject to the payment of a fee. Paragraph 2.3 above applies *mutatis mutandis*.

To the extent that a declaration by or signature of the EUTM proprietor is required in accordance with the rules, its place will be taken by a declaration by or signature of the registered licensee (the former licensee).

Obsolete

5 Rights *in Rem* - Special Provisions

5.1 Requirements concerning proof

Article 19 and Article 26(1) EUTMR
Articles 2(1)(b) and 13(3)(a) EUTMIR
Article 27 CDR
Article 1(1)(b), Articles 23(4) and 24(1) CDIR

5.1.1 Application submitted by the EUTM proprietor alone

When an application for the registration of a right *in rem* is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

The signature of the EUTM proprietor constitutes proof of the right *in rem*. Consequently, no additional proof of the right *in rem* is necessary.

The Office will inform the pledgee when the right *in rem* is registered in the EUTM Register.

Where the pledgee files a statement with the Office to oppose the registration of the right *in rem*, the Office will forward the statement to the EUTM proprietor for information purposes only. The Office will not take any further action on the statement. Following the registration of the right *in rem*, any pledgee that disagrees with the registration of the right *in rem* may request the cancellation or modification of the registration of the right *in rem* (see paragraph 3 above).

The Office will not take into account whether the parties have agreed to register a right *in rem* contract at the Office. Any dispute regarding the right *in rem* is a matter that must be resolved between the parties concerned under the relevant national law (Article 19 EUTMR).

5.1.2 Application submitted jointly by the EUTM proprietor and the pledgee

When an application for the registration of the right *in rem* is submitted jointly by the EUTM proprietor and the pledgee, it must be signed by both parties. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the right *in rem*.

Where there is a formal deficiency regarding the signature of the pledgee or regarding its representative, the application will still be accepted as long as it would have been acceptable if it had been submitted by the EUTM proprietor alone.

Obsolete

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or its representative, but where the application would have been acceptable if it had been submitted by the pledgee alone.

5.1.3 Application submitted by the pledgee alone

An application may also be submitted by the pledgee alone. In this case, it must be signed by the pledgee and proof of the right *in rem* must be submitted.

5.1.4 Proof of the right *in rem*

There is sufficient proof of the right *in rem* if the application for registration of the right *in rem* is accompanied by any of the following.

- A declaration signed by the EUTM proprietor stating that it agrees to the registration of the right *in rem*.
  According to Article 13(3)(a) EUTMIR, it is also considered sufficient proof if an application for registration of the right *in rem* is signed by both parties. This case has already been dealt with in paragraph 5.1.2 above.
- The right *in rem* contract, or an extract therefrom indicating the EUTM at issue and the parties, and bearing their signatures.
  It is sufficient if the right *in rem* contract is submitted. In many cases, the parties to the right *in rem* contract will not wish to disclose all the details of the contract, which may contain confidential information about the terms and conditions of the pledge. In such cases, it is sufficient if only a part or an extract of the right *in rem* contract is submitted, as long as it identifies the parties to the right *in rem* contract and the EUTM that is subject to a right *in rem*, and bears the signatures of both parties. All other elements may be omitted or blacked out.
- An uncertified statement of a right *in rem*, signed by both the EUTM proprietor and the pledgee.
  It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

Obsolete

5.2 Examination of specific formalities requirements (rights *in rem*)

Article 26(4) EUTMR Article 24(3) CDIR

Where an application for registration of a right *in rem* has been submitted jointly by the EUTM proprietor and the pledgee, the Office will communicate with the EUTM proprietor and send a copy to the pledgee.

Where the pledgee has also submitted and signed the application, it will not be allowed to contest the existence or scope of the right *in rem* agreement within the Office's proceedings, notwithstanding what could be established by the national laws of the Member States in this regard.

If the EUTM proprietor alleges fraud on the part of the pledgee, it must provide a final decision of the competent authority to this effect. It is not up to the Office to carry out any investigation into such a claim.

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit fixed in that communication, the Office will reject the application. The party concerned will have the possibility of filing an appeal against this decision.

5.3 Registration procedure and publication (rights *in rem*)

Articles 22(2) and 26(5) and Article 111(3)(h) and Article 111(6) EUTMR Article 29(2) CDR Article 24(4) and Article 69(3)(j) and (5) CDIR

For EUTMs, the Office will enter the right *in rem* in the EUTM Register and publish it in the EUTM Bulletin.

The Office will notify the applicant for registration of a right *in rem* of the registration thereof.

When an application for registration of a right *in rem* was filed by the pledgee, the Office will also inform the EUTM proprietor of the registration.

Obsolete

5.4 Transfer of a Right *in rem*

Article 26(1) and (5) and Annex I A(26)(d) EUTMR
Article 24(1) CDIR
Annex (18)(d) CDFR

5.4.1 Provision for the transfer of a right *in rem*

A right *in rem* may be transferred.

5.4.2 Applicable rules

The procedure for the registration of a transfer of a right *in rem* follows the same rules as for the registration of a right *in rem*.

The transfer of a right *in rem* is subject to the payment of a fee. Paragraph 2.3 above applies *mutatis mutandis*.

To the extent that a declaration by or signature of the EUTM proprietor is required in accordance with the rules, it must be replaced by a declaration by or signature of the registered pledgee (the former pledgee).

6 Levies of Execution - Special Provisions

6.1 Requirements concerning proof

Article 26(1) EUTMR
Article 2(1)(b) EUTMIR
Article 1(1)(b) and Article 24(1) CDIR

6.1.1 Application filed by the EUTM proprietor

When an application for the registration of a levy of execution is made by the EUTM proprietor, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

The Office will inform the beneficiary when the levy of execution is registered in the EUTM Register.

The beneficiary may file a statement with the Office to oppose the registration of the levy of execution. The Office will not take any further action on such a statement.

Obsolete

Following the registration of the levy of execution, any beneficiary that disagrees with the registration of the levy of execution may request the cancellation or modification of the registration of the levy of execution (see paragraph 3 above).

Any dispute regarding the levy of execution is a matter that must be resolved between the parties concerned under the applicable national law (Article 19 EUTMR).

6.1.2 Application filed by the beneficiary

An application for registration of a levy of execution may also be filed by the beneficiary. In this case, it must be signed by the beneficiary.

In addition, proof of the levy of execution must be submitted.

6.1.3 Proof of the levy of execution

There is sufficient proof of the levy of execution if the application for registration of a levy of execution is accompanied by a final decision of the competent national authority

In many instances, the parties to the levy of execution proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the levy of execution judgment is submitted, as long as it identifies the parties to the levy of execution proceedings and the EUTM that is subject to the levy of execution, and confirms that the judgment is final. All other elements may be omitted or blacked out.

6.2 Registration procedure and publication (levy of execution)

Articles 111(3)(i) and 116(1)(a) EUTMR Article 69(3)(k) and Article 70(2) CDIR

When the mark is registered, the levy of execution will be entered in the EUTM Register and published in the EUTM Bulletin.

The Office will notify the applicant for registration of a levy of execution of the registration thereof.

Where applicable, the EUTM proprietor will also be informed.

Obsolete

7 Insolvency Proceedings - Special Provisions

7.1 Requirements concerning proof

There is sufficient proof of the appointment of a liquidator and of the insolvency proceedings if an application for registration of the insolvency proceedings is accompanied by a final decision of the competent national authority.

It suffices if the insolvency judgment is submitted. In many instances, the parties to the insolvency proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the judgment is submitted, as long as it identifies the parties to the proceedings. All other elements may be omitted or blacked out.

It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

7.2 Registration procedure and publication (insolvency proceedings)

Articles 111(3)(i) and 116(1)(a) EUTMR Article 69(3)(k) and Article 70(2) CDIR

When the mark is registered, the insolvency proceedings will be entered in the EUTM Register and published in the EUTM Bulletin. The publication contains the EUTM registration number(s), the name of the authority requesting the entry in the EUTM Register, the date and number of the entry and the publication date of the entry in the EUTM Bulletin.

The Office will notify the applicant for registration of insolvency proceedings of the registration thereof.

The liquidator's contact details are recorded as the EUTM proprietor's 'correspondence address' in the Office's database, and third parties may consult the full details of the insolvency proceedings through an application for inspection of files (see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files).

Obsolete

8 Procedures for Registered Community Designs

Articles 27, 29, 30, 31, 32, and 33 and Article 51(4) CDR Articles 24 to 26 and Article 27(2) CDIR Annex (18) and (19) CDFR

The legal provisions contained in the CDR, CDIR and CDFR in respect of licences, rights *in rem*, levies of execution and insolvency proceedings correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Therefore, both the legal principles and the procedure in respect of the registration, cancellation or modification of trade mark licences, rights *in rem*, levies of execution or insolvency proceedings apply *mutatis mutandis* to RCDs, except for the following specific procedures.

8.1 Multiple applications for RCDs

Article 37 CDR Article 24(1) CDIR

An application for the registration of licences, rights *in rem* and levies of execution for an RCD may be in the form of a multiple application containing several designs.

For the purposes of the legal effect of licences, rights *in rem* and levies of execution, as well as of the procedure for registering licences, rights *in rem* and levies of execution, the individual designs contained in a multiple application will be dealt with as if they were separate applications. This continues to apply after registration of the designs contained in the multiple application.

In other words, each design contained in a multiple application may be licensed, pledged or levied independently of the others.

For **licences** specifically, the optional indications as to the kind of licence and the procedure for their examination referred to in paragraphs 4.2 and 4.4 above (with the exception of a licence limited to some products, which is not possible), apply to each of the individual designs contained in a multiple application separately and independently.

Annex (18) and (19) CDFR

The fee of EUR 200 for the registration of a licence, a right *in rem,* or a levy of execution; the transfer of a licence or right *in rem*; or the cancellation of a licence, a right *in rem*, or levy of execution applies per design and not per multiple application. The same is true for the ceiling of EUR 1 000 if multiple applications are submitted.

Obsolete

8.2 Entitlement proceedings for RCDs

Article 15 CDR

Article 69(3)(f), (g) and (h) and Article 80(c) CDIR

RCD applications and registrations may be the subject of entitlement proceedings and subsequent changes in ownership.

If an RCD has been applied for or registered in the name of a person who is not entitled to it under Article 14 CDR, the person entitled to it under that provision may claim recognition as the RCD's legitimate holder.

Moreover, where a person is jointly entitled to the RCD, that person may, in accordance with Article 15(2) CDR, claim recognition as joint holder.

The following entries in the Register are specific to RCDs:

- the mention that legal entitlement proceedings have been initiated;
- the final decision or any other termination of the entitlement proceedings;
- any change in the RCD's ownership resulting from the final decision.

The applicant for the institution of entitlement proceedings can request that the mention that legal proceedings have been initiated be entered in the Register.

Once the legal proceedings have concluded, the person recognised as the RCD's legitimate holder can request the entry of the final decision and the change of ownership in the Register.

8.2.1 Requirements for an application for registration of entries relating to entitlement proceedings

Paragraph 2, concerning the requirements for an application for registration, applies by analogy, with the following exceptions.

Fees

There is no fee for registering any of the entries relating to entitlement proceedings.

Parties to the proceedings

An application for the registration of a mention that entitlement proceedings have been initiated may be filed by:

- the RCD holder(s); or
- the applicant for the institution of entitlement proceedings.

An application for the registration of the entry of the final decision or any other termination on the entitlement proceedings, or for a change in ownership of the RCD resulting from a final decision may be filed by:

- the RCD holder(s); or
- the person recognised as the legitimate holder of the RCD.

Obsolete

Where the Office receives documents relating to such proceedings from third parties or authorities such as national Courts, it will forward the documents to the RCD holder with a notice indicating that such a right could be entered in the RCD Register upon request. Additionally, if the person recognised as the legitimate holder is fully identified by their contact details, the same notice will also be sent.

Mandatory indications

The application for the mention that legal entitlement proceedings have been initiated, or terminated, must contain the following information:

- the registration number of the RCD concerned. If the application relates to several RCDs, each of the registration numbers must be indicated;
- the holder's name, address and nationality, as well as the State in which it is domiciled or has its seat or an establishment. However, if the Office has already assigned an ID number to the holder, it is sufficient to indicate this number together with the name.

The application for a change of ownership must additionally contain the following information:

- the name, address and nationality, as well as the State in which it is domiciled or has its seat or an establishment of the person recognised as the legitimate holder of the RCD. However, if the Office has already assigned an ID number to the legitimate holder, it is sufficient to indicate this number together with the name.

8.2.2 Requirements concerning proof

There is sufficient proof for entry of entitlement proceedings in the Register if the application for registration is accompanied by evidence that entitlement proceedings have been initiated before the competent authority. For entry of the final decision or other termination of entitlement proceedings in the Register, the application for registration must be accompanied by evidence that the entitlement proceedings have concluded, such as a final decision of the competent authority.

Obsolete

9 Procedures for International Trade Marks

Rules 20 and 20*bis*Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (CR)

9.1 Recording of licences

The Madrid System allows for the recording of **licences** against an international registration.

All requests for the recording of a licence should be submitted on form MM13 either:

- directly to the International Bureau by the recorded holder; or
- through the office of the contracting party of the recorded holder or through the office of a contracting party in respect of which the licence is granted; or
- through the office of the licensee.

The request cannot be submitted directly to the International Bureau by the licensee. The Office's application form should **not** be used.

Detailed information on the recording of licences can be found in Sections B.II.93.01-99.04 of the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol (www.wipo.int/madrid/en/guide/). For further information on international trade marks, see the Guidelines, Part M, International Marks.

9.2 Recording of rights *in rem*, levies of execution or insolvency proceedings

The Madrid System allows for the recording of **rights *in rem***, **levies of execution** or **insolvency proceedings** against an international registration (see Rule 20 CR). For the convenience of users, form MM19 is available for requesting the recording of a restriction of the holder's right of disposal in the International Register. The use of this form is strongly recommended to avoid irregularities.

Requests should be submitted either:

- directly to the International Bureau by the recorded holder, or
- to the office of the contracting party of the registered holder or
- to the office of a contracting party to whom the right *in rem*, levy of execution or insolvency is granted; or
- to the office of the contracting party of the pledgee, beneficiary or liquidator.

The request cannot be submitted directly to the International Bureau by the pledgee, beneficiary or liquidator. The Office's application form should **not** be used.

Detailed information on the registration of rights *in rem*, levies of execution or insolvency proceedings can be found in Part B, Chapter II, paragraphs 92.01-92.04 of the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol (www.wipo.int/madrid/en/guide). For further information on international trade marks, see the Guidelines, Part M, International Marks.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 4

Renewal

Obsolete

Obsolete

1 Fraud Warning

1.1 Private companies sending misleading invoices

The Office is aware that users are receiving an increasing amount of unsolicited mail from companies requesting payment for trade mark and design services such as renewal.

A list of letters from firms or registers that users have complained are misleading is published on the Office website. These services are not connected with any official trade mark or design registration services provided by IP offices or other public bodies within the European Union such as the EUIPO.

If a user receives a letter or invoice, he or she should carefully check what is being offered, and its source. It must be pointed out that the **EUIPO never sends invoices to users or letters requesting direct payment for services** (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

1.2 Renewal by unauthorised third persons

The Office is also aware that fraudsters have targeted the e-renewal module. If, upon filing a request for e-renewal, a user discovers that the mark is 'blocked', as renewal has already been requested, they should contact the Office.

2 Terms of Registration of European Union Trade Marks

Articles 1, 32, 52 and Article 41(5) and (8) EUTMR

The term of registration of a European Union trade mark (EUTM) is 10 years from the **filing date** of the application. For example, an EUTM with a filing date of 16/04/2020 will expire on 16/04/2030.

The filing date of the application is determined according to Articles 31 and 32 EUTMR and Article 41(5) and (8) EUTMR.

A registration may be renewed indefinitely for further periods of 10 years.

Obsolete

3 Terms of Protection of Registered Community Designs

Articles 12 and 38 CDR Article 10 CDIR

The term of protection of a registered Community design (RCD) is 5 years from the **date of filing** of the application (Article 12 CDR). For example, an RCD with a filing date of 16/04/2020 will expire on 16/04/2025.

The date of filing of the application is determined according to Article 38 CDR and Article 10 CDIR (see the Guidelines for Examination of Registered Community Designs, Examination of Applications for Registered Community Designs, paragraph 3, Allocation of a Filing Date).

A registration may be renewed for periods of 5 years each, up to a total of 25 years from the date of filing.

4 Notification of Expiry of Registration

Article 53(2) EUTMR Article 60(3) and Article 66 EUTMDR Article 13(2) CDR Articles 21 and 63 CDIR

At least 6 months before the expiry of the registration, the Office will inform:

- the registered proprietor/holder of the EUTM/RCD, and
- any person having a registered right in respect of the EUTM/RCD

that the registration is approaching expiry. Persons having a registered right include the holders of a registered licence, the proprietors of a registered right *in rem*, the creditors of a registered levy of execution or the authority competent to act on behalf of the proprietor/holder in insolvency procedures.

Failure to give such information does not affect the expiry of the registration and does not involve the responsibility of the Office.

Obsolete

5 Renewal of an EUTM Application

Article 53(2) EUTMR Annex I A(19) EUTMR

In the exceptional circumstance where an application has not yet matured to registration because of pending proceedings, the Office will not send the notice referred to in Article 53(2) EUTMR. The applicant is not obliged to renew its application during proceedings that last for more than 10 years and where the outcome of registration is uncertain. Only once the trade mark is registered will the Office invite the owner to renew the EUTM and pay the relevant renewal fees due. The owner will then have 4 months to pay the renewal fee (including any additional class fees). The surcharge for the renewal fee of 25 % pursuant to Annex I A(19) EUTMR does not apply. If the renewal fee is not paid within the time limit given, the Office will issue a notice that the registration has expired. The expiry will take effect from the date of registration of the EUTM.

6 Renewal of an RCD Application

Article 13(2) CDR Annex to the CDFR point 12

In the exceptional circumstance where an application has not yet matured to registration because of pending proceedings, the Office will not send the notice referred to in Article 13(2) CDR. The applicant is not obliged to renew its application during proceedings that last for more than 5 years and where the outcome of registration is uncertain. The Office will only invite the owner to renew the RCD and pay the renewal fee once the design has been registered. The owner will then have 4 months to pay the renewal fee. The surcharge for the renewal fee of 25 % pursuant to point 12 of the Annex to the CDFR does not apply. If the renewal fee is not paid within the time limit given, the Office will issue a notice that the registration has expired. The expiry will take effect from the date of registration of the RCD.

Obsolete

7 Fees and Other Formal Requirements for the Request for Renewal

Articles 63 and 64 EUTMDR

Article 22(8) and Articles 65, 66 and 67 and Article 68(1)(e) CDIR

Decision No EX-20-9 of the Executive Director of the Office of 03/11/2020

The general rules concerning communications to the Office apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits), which means that the request may be submitted in the following ways.

- By electronic means available on the EUIPO website (e-renewal available via the User Area). For EUTMs, there is a reduction of EUR 150 on the basic renewal fee for an individual mark using e-renewal (EUR 300 for a collective mark). Entering the name and surname in the appropriate place on the electronic form is deemed to be a signature. In addition, using e-renewal offers additional advantages such as the receipt of immediate electronic confirmation of the renewal request automatically or the use of the renewal manager feature to complete the form quickly for as many EUTMs/RCDs as needed.
- By transmitting a signed original form electronically, by post or by courier (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits). A standard form is available on request to the Office. Forms have to be signed but annexes need not be signed.

Following Decision No EX-20-9 of the Executive Director of the Office of 03/11/2020, EUTM and RCD renewals must be made via e-renewal, post or courier. In cases where technical malfunction prevents e-renewal, renewals by one of the two alternative electronic back-up measures will be treated by the Office only when received within the last three working days before the expiry of: (i) the deadline for renewal or (ii) the extended deadline for renewal.

A single application for renewal may be submitted for two or more EUTMs/RCDs (including RCDs that form part of the same multiple registration), upon payment of the required fees for each EUTM/RCD.

7.1 Persons who may submit a request for renewal

Articles 20(12) and 53(1) EUTMR

Article 13(1) and Article 28(c) CDR

The request for renewal may be submitted by:

1. the registered proprietor/holder of the EUTM/RCD;

Obsolete

2. where the EUTM/RCD has been transferred, the successor in title as from the point in time a request for registration of the transfer has been received by the Office;
3. any person expressly authorised by the proprietor/holder of the EUTM/RCD to do so. Such a person may, for instance, be a registered licensee, a non-registered licensee or any other person who has obtained the authorisation of the proprietor/holder to renew the EUTM/RCD.

Professional representation is not mandatory for renewal.

When the renewal request is submitted by a person other than the registered proprietor/holder or its representative on file, an authorisation will have to exist in its favour; however, it does not need to be filed with the Office unless the Office requests it.

When a person other than the proprietor/holder or its representative on file sends a direct payment or submits a request for renewal with the indication that payment will be made by bank transfer, the proprietor/holder will be informed that the renewal will be processed once payment has been received. If no reply is received from the proprietor/holder, or no objection is raised to the renewal, the Office will validate the payment once it reaches the Office and the renewal will be processed.

If the Office receives fees from two different sources, neither of which is the proprietor/holder or its representative on file, the proprietor/holder will be contacted in order to ascertain who is authorised to file the renewal request. Where no reply is received from the proprietor/holder, the Office will validate the payment that reached the Office first (12/05/2009, T-410/07, Jurado, EU:T:2009:153, § 33-35; 13/01/2008, R 989/2007-4, ELITE GLASS-SEAL, § 17-18).

7.2 Content of the request for renewal

Article 53(4) EUTMR Article 22(1) CDIR

The request for renewal must contain the following: name and address of the person requesting renewal and the registration number of the EUTM/RCD to be renewed. In the case of an EUTM renewal, the extent of the renewal is deemed to cover the full specification by default.

Payment alone can constitute a valid request for renewal, providing such payment reaches the Office and contains the name of the payer, the registration number of the EUTM/RCD and an indication that it is a request for renewal. In such circumstances, no further formalities need to be complied with (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges). Where this option is relied on in EUTM renewals, the payment must be of the renewal fee laid out in Annex I A, paragraphs (11) or (15) EUTMR and not of the discounted fee for renewal by electronic means pursuant to Annex I A, paragraphs (12) or (16).

Obsolete

Consequently, payment alone cannot constitute a valid request for e-renewal. The discounted fee may only be relied on where a renewal application is submitted by electronic means, as such payment must be accompanied by a valid e-renewal application form.

7.2.1 Name and address and other particulars of the person submitting a request for renewal

Article 2(1)(b) and (e) EUTMIR Article 22(1)(a) CDIR

7.2.1.1 Request filed by the proprietor/holder

Where the request is filed by the EUTM/RCD proprietor/holder, its name must be indicated.

7.2.1.2 Request filed by a person authorised to do so by the proprietor/holder

Where the request for renewal is filed by a person authorised by the proprietor/holder to do so, the name and address or the ID number and name of the authorised person in accordance with Article 2(1)(e) EUTMIR or Article 22(1)(a) CDIR must be indicated.

If the selected payment method is bank transfer, a copy of the renewal request is sent to the proprietor/holder.

7.2.2 Registration number

Article 53(4)(b) EUTMR Article 22(1)(b) CDIR

The EUTM/RCD registration number must be indicated.

7.2.3 Indication as to the extent of the renewal

Article 53(4) EUTMR Article 22(1)(c) CDIR

For EUTMs, renewal is deemed to cover the entire specification of goods and/or services of the EUTM by default.

Where renewal is requested for only some of the goods or services for which the mark is registered:

Obsolete

- those classes or those goods and services for which renewal is requested must be indicated in a clear and unequivocal way.

Or, alternatively:

- those classes or those goods and services for which renewal is not requested must be indicated in a clear and unequivocal way.

The e-renewal platform only allows for deleting (i.e. not renewing) entire classes; it does not allow for the partial renewal of only some goods or services within a class (i.e. it does not allow the deletion of some of the goods or services listed in a specific class at the time of the renewal). Therefore, where renewal is required for only **some goods or services within a class**, the renewal application can *either* be submitted using any other means of communication accepted by the Office, *or*, the whole class can be renewed through e-renewal and a request for partial surrender can be submitted pursuant to Article 57 EUTMR for those goods or services that the proprietor wishes to remove from the EUTM.

For RCDs, in the case of a multiple registration, an indication that renewal is requested for all the designs covered by the multiple registration or, if the renewal is not requested for all the designs, an indication of the file number for which it is requested. If nothing is indicated, the renewal is deemed to be for all the designs by default.

7.3 Languages

Article 146(6) EUTMR Article 68 and Article 80(b) and (c) CDIR

The request for renewal may be filed in any of the five languages of the Office. The chosen language becomes the language of the renewal proceedings. However, when the request for renewal is filed by using the form provided by the Office pursuant to Article 65(1)(g) EUTMDR or Article 68(1)(e) CDIR, such a form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned. This concerns, in particular, the list of goods and services in the event of a partial renewal of an EUTM.

Obsolete

7.4 Time limits

Article 52 and Article 53(3) EUTMR
Article 69(1) EUTMDR
Article 13(3) CDR
Articles 56 and 58 CDIR
Communication No 2/16 of the President of the Office of 20/01/2016

7.4.1 Six-month period for renewal before expiry (basic period)

For EUTMs, the request for renewal and the renewal fee must be submitted in the 6-month period prior to the expiry of the registration.

For example, where the EUTM has a filing date of 10/06/2010, the day on which protection ends will be 10/06/2020. Therefore, a request for renewal must be introduced and the renewal fee paid as from 11/12/2019 until 10/06/2020 or, where this is a Saturday, Sunday or other day on which the Office is closed, or does not receive ordinary mail within the meaning of Article 69(1) EUTMDR, the first following working day on which the Office is open to the public and receives ordinary mail.

For RCDs, the request for renewal and the renewal fee must be submitted within a period of 6 months ending on the last day of the month in which protection ends.

For example, where the RCD has a filing date of 01/04/2015, the basic period will run up to and including the last day of the month in which protection ends, namely 30/04/2020. Therefore, a request for renewal must be submitted and the renewal fee paid between 01/11/2019 and 30/04/2020 or, where the latter date is a Saturday, Sunday or other day on which the Office is closed or does not receive ordinary mail within the meaning of Article 58(1) CDIR, the first following working day on which the Office is open to the public and does receive ordinary mail.

7.4.2 Six-month grace period following expiry (grace period)

Where the EUTM/RCD is not renewed within the basic period, the request may still be submitted and the renewal fee may still be paid, upon payment of an additional fee (see paragraph 7.5 below), within a further period of 6 months.

For example, where the EUTM has a filing date of 10/06/2010, the day on which protection ends will be 10/06/2020. Therefore, the grace period during which a request for renewal may still be introduced upon payment of the renewal fee plus the additional fee is counted from the day after 10/06/2020, namely from 11/06/2020, and ends on 10/12/2020 or, if 10/12/2020 is a Saturday, Sunday or other day on which the Office is closed, or does not receive ordinary mail within the meaning of Article 69(1) EUTMDR, the first following working day on which the Office is open to the public and receives

Obsolete

ordinary mail. This also applies if the above example 11/06/2020 was a Saturday or Sunday; the rule that a time limit to be observed vis-à-vis the Office is extended until the next working day applies only once and to the end of the basic period, and not to the starting date of the grace period.

For example, where the RCD has a filing date of 01/04/2015, the basic period will run up to and including the last day of the month in which protection ends, namely 30/04/2020. Therefore, a request for renewal must be submitted and the renewal fee paid between 01/11/2019 and 30/04/2020 or, where the latter date is a Saturday, Sunday or other day on which the Office is closed or not receiving ordinary mail within the meaning of Article 58(1) CDIR, the first following working day on which the Office is open to the public and receiving ordinary mail. The grace period would then run from 01/05/2020 up to and including 31/10/2020 (or the first working day thereafter).

During the 6-month grace period, the only action that may be carried out in an EUTM or RCD is the payment of the renewal fee (including the payment of the additional fee for late payment). In the event the Office receives any other request during the grace period, such as a transfer, registration of a licence, surrender, change of name, etc. or any other request for entry into the Registers, the Office will put the request on hold until the renewal fee is paid. Only once the renewal fee is paid in full, and the EUTM or RCD is officially renewed, will the Office examine any requests that had been placed on hold.

7.5 Fees

As regards the calculation of the amount of the renewal fees, the due date for the renewal fees is the date of expiry of the registration (Article 53(3) EUTMR and Article 13(3) CDR).This principle applies regardless of the moment at which renewal is actually requested and paid for.

7.5.1 Fees payable for EUTMs

Article 53(3) and Annex I A(11), (12), (13), (14), (15), (16), (17), (18) and (19) EUTMR Communication No 2/16 of the President of the Office of 20/01/2016

The fees payable for the renewal of an EUTM consist of:

- a basic fee that covers the first class of goods/services;
- one or more class fees for each class of goods/services exceeding the first one;
- any additional fee applicable for late payment of the renewal fee or late submission of the request for renewal.

The amount of the renewal fee is as follows.

Basic fee (by e-renewal):

- for an individual mark: EUR 850, and
- for a collective or certification mark: EUR 1 500.

Obsolete

Basic fee (other than by e-renewal):

- for an individual mark: EUR 1 000, and
- for a collective or certification mark: EUR 1 800.

Class fees:

- for the second class: EUR 50,
- for each class exceeding two: EUR 150.

The fee must be submitted in the 6-month period prior to the expiry of the registration (see paragraph 7.4 above).

The additional fee for late payment or late submission is:

- 25% of the belated renewal fee, subject to a maximum of EUR 1 500.

7.5.2 Fees payable for RCDs

Article 13(3) CDR Article 22(2) (a), (b) CDIR Article 7(1) and Annex to the CDFR points 11 and 12

The fees payable for the renewal of an RCD consist of:

- a renewal fee, which, where several designs are covered by a multiple registration, is in proportion to the number of designs covered by the renewal;
- any additional fee applicable for late payment of the renewal fee or late submission of the request for renewal.

The amount of the renewal fee, per design, whether or not included in a multiple registration, is as follows:

- for the first renewal: EUR 90;
- for the second renewal: EUR 120;
- for the third renewal: EUR 150;
- for the fourth renewal: EUR 180.

The fee must be paid within a period of 6 months ending on the last day of the month in which protection ends (see paragraph 7.4 above).

The additional fee for late payment or late submission is:

- 25% of the renewal fee.

Obsolete

7.5.3 Time limit for payment

Articles 53(3) and 180(3) and Annex I A(19) EUTMR

Article 13(3) CDR

Annex to the CDFR point 12

Article 8(c) and (h) of Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021.

The fee must be paid within a basic period of 6 months (for calculation of the period, see the example given in paragraph 7.4.1 above).

The fee may be paid within a further grace period of 6 months (see paragraph 7.4.2 above), provided that an additional fee for late payment is paid, which amounts to 25 % of the total renewal fee, including any class fees.

Renewal will be effected only if payment of **all** fees reaches the Office within the grace period, this includes all renewal fees, additional fees for payment within the grace period, and surcharges for late payment by bank transfer (see Part A, Section 3, Payment of Fees, Costs and Charges, paragraph 4.1.1) where applicable.

Fees that are paid **before** the start of the basic period of 6 months will not, in principle, be taken into consideration and will be refunded.

7.5.4 Payment by third parties

Article 6 of Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021.

Payment may also be made by the other persons identified in paragraph 7.1 above.

Payment by debiting a current account held by a third party requires an explicit authorisation of the holder of the current account that the account can be debited for the benefit of the particular fee. In such cases, the Office will check if there is an authorisation. If there is no authorisation, a letter will be sent to the renewal applicant asking them to submit the authorisation to debit the account held by a third party. In such cases, payment is considered to be effected on the date the Office receives the authorisation.

Obsolete

7.5.5 Fee refund

Article 53(8) EUTMR Article 22(7) CDIR

Renewal fees and, where applicable, the additional fee for late payment may be refunded under certain circumstances. For full information, please see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

8 Procedure Before the Office

8.1 Examination of formal requirements

The examination of the request for renewal is limited to formalities and relates to the following points.

8.1.1 Observation of time limits

Article 53(3), (4) and (8) EUTMR Article 13(3) CDR Article 22(3), (4) and (5) CDIR Article 5 and Article 6(2) CDFR

8.1.1.1 Payment during the basic period or the grace period

Where the request for renewal is filed and the renewal fee is paid within the basic period, the Office will record the renewal, provided that the other conditions laid down in the EUTM Regulations or CDR and CDIR are fulfilled (see paragraph 8.1.2 below).

Where no request for renewal has been filed, but the payment of a renewal fee reaches the Office that contains the minimum identification elements (see paragraph 7.2), this constitutes a valid request and no further formalities need be complied with. This is pursuant to Article 53(4) EUTMR, last sentence and Article 22(3) CDIR.

Where this option is relied on in EUTM renewals, the payment must be of the renewal fee laid out in Annex I A, paragraphs (11) or (15) EUTMR and **not of the discounted fee for renewal by electronic means** pursuant to Annex I A, paragraphs (12) or (16). Consequently, as payment alone cannot constitute a valid request for e-renewal, the fee discount may only be relied on where a renewal application is submitted by electronic means. The requester will either have to submit a valid e-renewal application

Obsolete

form, or pay the difference in the basic fee, in all cases before the expiry of the renewal period. Furthermore, if this is carried out during the grace period, the additional fee for late payment will also be due.

Where no request for renewal has been filed but a renewal fee has been paid that does not contain the minimum identification elements, the Office will invite the person requesting renewal to provide the missing indications. A letter will be sent out as early as is reasonably possible after receipt of the fee, so as to enable filing of the request before the additional fee becomes due.

Where a request for renewal has been submitted but the renewal fee has not been paid in full, the Office will, where possible, remind the person requesting renewal to pay the remaining part thereof within the basic renewal period and the additional fee for late payment if within the grace period.

The lack of payment is not a remediable deficiency that the Office will set the party a time limit to remedy.

In the case of incomplete payment of the fee for the renewal of an EUTM, the proprietor may, instead of paying the missing amount, restrict its request for renewal to the corresponding number of classes.

In the case of incomplete payment of the fee for the renewal of an RCD, the holder may, instead of paying the missing amount, restrict its request for renewal to the corresponding number of multiple designs.

8.1.1.2 Insufficient payments and payment after the expiry of the grace period

Article 53(5) and (8) and Article 99 EUTMR Article 22(5) CDIR

Where a request for renewal has not been submitted or is submitted only after the expiry of the grace period, or the fees have not been paid, the Office will determine that the registration has expired and will issue a notification on loss of rights to the proprietor/holder.

Where the fees received in the grace period are not paid in full (i.e. the fee received amounts to less than the required basic fee and the additional fee for late payment) or are received only after expiry of the grace period, the Office will determine that the registration has expired and will issue a notification on loss of rights to the proprietor/ holder.

For EUTMs, where the insufficient fee received in the grace period covers the basic fee and the additional fee for late payment, but not all class fees, the Office will only renew the registration for some classes. The determination of which classes of goods and services are to be renewed will be made according to the following criteria.

- Where the request for renewal is expressly limited to particular classes, only those classes will be renewed.

Obsolete

- Where it is otherwise clear from the request which class or classes are to be covered by the request, that class or those classes will be renewed.
- The Office may contact the proprietor to ask for the class preferences in the event of partial payment.
- In the absence of other criteria, the Office will take the classes into account in the numerical order of classification, beginning with the class having the lowest number.

Where not all class fees are paid and the Office determines that the registration has expired for some of the classes of goods or services, it will issue the renewal confirmation to the proprietor, as well as a notification of loss of rights for those classes of goods or services to the proprietor. If the person concerned considers that the finding of the Office is inaccurate, he or she may, within 2 months of the notification of the loss of rights, apply for a decision on the matter.

For RCDs, where the fee paid covers the basic fee and the fee for late payment, but the fees paid are insufficient to cover all designs identified in the renewal application, the Office will only renew the registration for some designs. In the absence of an indication of the designs to be renewed, or of any other criteria for determining which designs are intended to be covered, the Office will determine the designs to be renewed by taking them in numerical order.

8.1.1.3 Situation where the requester holds a current account

The Office will not debit a current account unless there is an express request for renewal. It will debit the account of the person requesting renewal.

Where the renewal applicant has a current account at the Office, the renewal fee will only be debited once a request for renewal has been filed and the renewal fee (including any class fees) will be debited on the day of receipt of the request, unless other instructions are given. In the event the request for renewal is filed during the 6-month grace period, the renewal fee and the additional fee for late payment will both be debited from the current account.

For payment by third parties, see paragraph 7.5.4 above.

8.1.2 Compliance with formal requirements

8.1.2.1 Renewal requested by an authorised person

Article 53(1) EUTMR Article 13(1) CDR

Where a renewal request is filed on behalf of the proprietor/holder, there is no need to file an authorisation. However, such an authorisation should exist in favour of the person filing the request should the Office request it.

Obsolete

8.1.2.2 Further requirements

Article 53(4) and (7) EUTMR Article 22(3) and (4) CDIR

Where the request for renewal does not comply with other formal requirements, namely where the name and address of the person requesting renewal has not been sufficiently indicated, where the registration number has not been indicated, where it has not been properly signed or, for EUTMs, if partial renewal was requested but the goods and services to be renewed have not been properly indicated, the Office will inform the person requesting renewal of the deficiencies found.

The Office will consider the request to be made for the renewal for all goods and services or all the designs covered by the multiple registration, unless partial renewal is expressly requested. In the event of a partial renewal, please refer to paragraph 7.2.3 above.

If the request for renewal is filed by a person authorised by the proprietor/holder (see paragraph 7.1(c) above), the proprietor/holder will receive a copy of the deficiency notification.

Article 53(5), (8) and Article 99 EUTMR Article 22(5) and Article 40 CDIR

Where these deficiencies are not remedied before the expiry of the relevant time limit, the Office will proceed as follows.

- If the deficiency consists of failing to indicate the goods and services of the EUTM to be renewed, the Office will renew the registration for all the classes for which the fees have been paid, and if the fees paid do not cover all the classes of the EUTM registration, the determination of which classes are to be renewed will be made according to the criteria set out in paragraph 8.1.1.2 above. The Office will issue, at the end of the grace period, a notification of loss of rights for those classes of goods or services the Office deems expired to the proprietor.
- If the deficiency consists of the proprietor's/holder's failure to respond to a request for clarification of who the authorised person is, the Office will accept the request for renewal filed by the authorised representative on file. If neither of the requests for renewal has been filed by an authorised representative on file, the Office will accept the renewal request that was first received by the Office.
- If the deficiency lies in the fact that there is no indication of the designs to be renewed, and the fees paid are insufficient to cover all the designs for a multiple application for which renewal is requested, the determination of which designs are to be renewed will be made according to the criteria set out in paragraph 8.1.1.2 above. The Office will determine that the registration has expired for all designs for which the renewal fees have not been paid in part or in full.

Obsolete

- In the case of the other deficiencies, it will determine that the registration has expired and will issue a notification of loss of rights to the proprietor/holder and, where applicable, the person requesting renewal.

The person concerned may apply for a decision on the matter under Article 99 EUTMR or Article 40(2) CDIR within 2 months.

8.2 Items not to be examined

No examination will be carried out on renewal for the registrability of the mark or design, nor will any examination be carried out as to whether the EUTM has been put to genuine use.

No examination will be carried out by the Office on renewal as to the correct classification of the EUTM, nor will a registration be reclassified that has been registered in accordance with an edition of the Nice Classification that is no longer in force at the point in time of renewal. All of this is without prejudice to the application of Article 57 EUTMR.

The Office will not examine the product classification of the RCD nor will an RCD be reclassified that was registered in accordance with an edition of the Locarno Classification no longer in force at the time of renewal. Such reclassification will not even be available at the holder's request.

9 Partial Renewals of EUTMs

Article 53(4)(c) and Article 53(8) EUTMR Annex I A(19) EUTMR

An EUTM may be renewed in part for some of the goods and/or services for which it has been registered.

A partial renewal is not a partial surrender for those goods and/or services for which the EUTM has not been renewed.

An EUTM may be partially renewed several times during the initial basic renewal period of 6 months or during the 6-month grace period. See to this extent 22/06/2016, C-207/15 P, CVTC, EU:C:2016:465.

For each partial renewal, the full amount of the corresponding fee has to be paid, and in the event a partial renewal request is submitted within the grace period, the additional fee for the late payment of the renewal fee must also be paid, namely 25 % of the belated renewal fee (subject to a maximum of EUR 1 500).

For example:

An EUTM registration has 10 classes.

Obsolete

If within the basic period the Office receives an e-renewal request for 5 classes (out of the 10) the fees payable would be:

Basic e-renewal fee (including 1 class):	EUR 850
Second class:	EUR 50
Remaining classes (150 EUR x 3):	EUR 450
Total renewal fee:	**EUR 1 350**

If, within the grace period, the Office receives a new renewal request for two more classes of the registration, the fees payable would be:

Additional classes (EUR 150 x 2):	EUR 300
25 % surcharge of the belated fee:	EUR 75
Total additional fees payable:	**EUR 375**

Total additional fees payable: EUR 375.

Using the same example, at the end of the grace period the Office would issue a notification to the proprietor of loss of rights for the remaining three classes of goods or services which were not renewed, for which registration is deemed expired.

10 Entries in the Register

Articles 53(5), 111(6) and Article 111(3)(k) EUTMR

Article 13(4) CDR

Article 69(3)(m) and Article 69(5) and Article 71 CDIR

Where the request for renewal complies with all the requirements, the renewal will be registered.

The Office will notify the proprietor/holder of the renewal of the EUTM/RCD, of its entry in the Register, and the date from which renewal takes place. Where the renewal applicant is a person other than the registered proprietor/holder or its representative on file, they will also be informed of the renewal.

Where renewal has taken place only for some of the goods and services contained in the registration, the Office will notify the proprietor of the goods and services for which the registration has been renewed and the entry of the renewal in the Register and of the date from which renewal takes effect (see paragraph 11 below). After the expiry of

Obsolete

the grace period, the Office will notify the proprietor of expiry of the registration for the remaining goods and services and of their removal from the Register.

Where only some of the designs contained in a multiple application have been renewed, the Office will notify the holder of the designs for which the registration has been renewed, of the entry of the renewal in the Register and of the date from which renewal takes effect (see paragraph 11 below). After the expiry of the grace period, the Office will notify the holder of expiry of the registration for the remaining designs and of their removal from the Register.

Article 53(5), (8) and Article 99 EUTMR Article 13(4) CDR Articles 22(5) and 40(2) CDIR

Where the Office has made a determination pursuant to Article 53(8) EUTMR or Article 22(5) CDIR that the registration has expired, the Office will cancel the mark/ design in the Register and notify the proprietor/holder accordingly. The proprietor/ holder may apply for a decision on the matter under Article 99 EUTMR or Article 40(2) CDIR within 2 months.

Obsolete

11 Date of Effect of Renewal or Expiry, Conversion

11.1 Date of effect of renewal

Article 53(6) and (8) EUTMR Article 67(2) EUTMDR Article 12 and Article 13(4) CDR Article 22(6) CDIR

Renewal will take effect from the day following the date on which the existing registration expires.

For example:

- Where the filing date of the EUTM registration is 01/04/2010, the registration will expire on 01/04/2020. Therefore, renewal takes effect from the day following 01/04/2020, namely 02/04/2020. Its new term of registration is 10 years from this date, which will end on 01/04/2030.
- Where the filing date of the RCD is 01/04/2015, the registration will expire on 01/04/2020. Therefore, renewal takes effect from the day following 01/04/2020, namely 02/04/2020. Its new term of registration is five years from this date, which will end on 01/04/2025.

It is immaterial whether any of these days is a Saturday, Sunday or an official holiday. Even in cases where the renewal fee is paid within the grace period, the renewal takes effect from the day following the date on which the existing registration expires.

Where the EUTM or RCD has expired and is removed from the Register, the cancellation will take effect from the day following the date on which the existing registration expired. Using the same two examples listed above, the removal from the Register would take effect on 02/04/2020 (for the EUTM) and 02/04/2020 (for the RCD).

11.2 Conversion of lapsed EUTMs

Articles 53(3) and 139(5) EUTMR

Where the owner wants to convert its lapsed EUTM into a national mark, the request must be filed within 3 months from the day following the last day of the 6-month grace period. The time limit of 3 months for requesting conversion starts automatically without notification (see the Guidelines, Part E, Register Operations, Section 2, Conversion).

12 Renewal of International Marks Designating the EU

Article 202(1) EUTMR

The procedure for renewal of international marks is managed entirely by the International Bureau. The Office will not deal with renewal requests or payment of renewal fees. The International Bureau will send notice for renewal, receive the renewal fees and record the renewal in the International Register. The effective date of the renewal is the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register. Where an international registration designating the EU is renewed, the Office will be notified by the International Bureau.

If the international registration is not renewed for the designation of the EU, it can be converted into national marks or into subsequent designations of Member States under the Madrid Protocol. The 3-month time limit for requesting conversion starts on the day following the last day on which renewal may still be effected before WIPO pursuant to Article 7(4) of the Madrid Protocol (see the Guidelines, Part E, Register Operations, Section 2, Conversion).

Obsolete

13 Renewal of International Design Registrations Designating the EU

Article 106a CDR
Article 22a CDIR

International registrations must be renewed directly at the International Bureau of WIPO in compliance with Article 17 of the Geneva Act. The Office will not deal with renewal requests or payments of renewal fees in respect of international registrations.

The procedure for the renewal of international design registrations is managed entirely by the International Bureau, which sends out the notice for renewal, receives the renewal fees and records the renewal in the International Register. When international registrations designating the EU are renewed, the International Bureau also notifies the Office.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 5

Inspection of files

Obsolete

Obsolete

1 General Principles

Article 111(1) and (5), Article 114, Article 117(1) and (2) and Annex 1 A(30) EUTMR
Articles 20 and 21 EUTMIR
Articles 72, 74, and 75 CDR
Article 69(1), Articles 74, 75, 77 and 78 CDIR

The principle established under the European Union trade mark and design system is that:

- the 'Register of European Union trade marks' and the 'Register of Community designs' contain all particulars relating to European Union trade mark (EUTM) applications and Community design applications and registered EUTMs and registered Community designs (RCD); and
- the 'files' contain all correspondence and decisions relating to those trade marks and designs.

Both the Registers and the files of the Office are, in principle, open to inspection by the public. However, before publication of an EUTM application, an RCD or when an RCD is subject to deferred publication, inspection of files is possible only in exceptional cases (see paragraphs 4.2.1 and 4.2.2 below).

All the information in the Registers is stored in the Office's databases and, where applicable, published in the EUTM/RCD Bulletin in electronic format.

This section of the Guidelines deals specifically with inspection of files.

Inspection of the files may involve:

- inspection of the Registers;
- obtaining certified or uncertified extracts of the Registers;
- inspection of the content of the file(s);
- the communication of information contained in the files, implying communication of specific information contained in the files without supplying the actual file document(s);
- obtaining certified or uncertified copies of documents contained in the files.

In these Guidelines, the term 'inspection of the files' is used to cover all of the abovementioned forms of inspection of files, unless otherwise stated.

The provisions in the CDR and CDIR dealing with the inspection of files of Community designs are almost identical to the equivalent provisions of the EUTM Regulations. Therefore, the following applies *mutatis mutandis* to Community designs. Where the procedure is different, the differences are specified under a separate sub-heading.

Obsolete

2 The Registers of EUTMs and Community Designs

Article 111(1) and (5) EUTMR
Article 72 CDR
Article 69 CDIR

The Registers are maintained electronically and consist of entries in the Office's database systems. They are available on the Office website for public inspection, except, in the case of Community designs, to the extent that Article 50(2) CDR provides otherwise. Insofar as some data contained in the Registers are not yet available online, the only means of access is by a request for information or by obtaining certified or uncertified extracts or copies of the file documents from the Registers, which is subject to the payment of a fee.

3 Inspection of the Registers

3.1 Information contained in the Registers

3.1.1 The Register of EUTMs

Article 111(2), (3) and (4) EUTMR
Decision No EX-00-1 of the President of the Office of 27/11/2000
Decision No EX-07-1 of the President of the Office of 16/03/2007

The Register of EUTMs contains the information specified in Article 111(2) and (3) EUTMR and any other items determined by the Executive Director of the Office pursuant to Article 111(4) EUTMR.

3.1.2 The Register of Community designs

Article 50 CDR
Articles 69 and 73 CDIR
Decision No EX-07-2 of the President of the Office of 16/03/2007

The Register of Community designs contains the information specified in Article 69 CDIR and any other items determined by the Executive Director of the Office.

Obsolete

In accordance with Article 73(a) CDIR, where the RCDs are subject to a deferment of publication pursuant to Article 50(1) CDR, access to the Register to persons other than the holder shall be limited to the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred.

4 Inspection of Files

4.1 Persons/Entities authorised to request access to the files

The rules and degree of access to the files vary according to who requests inspection.

The Regulations differentiate between the following three categories:

- the applicant/proprietor of the EUTM or RCD;
- third parties;
- courts or authorities of the Member States.

Inspection of the files by courts or authorities of the Member States is covered by the system of administrative cooperation with the Office (see paragraph 7 below).

4.2 Documents that constitute the files

The files relating to an EUTM or RCD consist of all correspondence between the applicant/proprietor and the Office and all documents (and their related annexes) established in the course of examination, as well as any correspondence concerning the ensuing EUTM or RCD. The file does not include trade mark search reports provided by national offices.

Documents relating to opposition, cancellation, invalidity and appeal proceedings before the Office or other proceedings, such as recordals (transfer, licence, etc.), also form part of the files.

All original documents submitted become part of the file and, therefore, cannot be returned to the person who submitted them. When submitting documents, simple photocopies are sufficient. They do not need to be authenticated or legalised.

Where the parties make use of the mediation services offered by the Office in accordance with Decision No 2013-3 of the Presidium of the Boards of Appeal of 05/07/2013 on the amicable settlement of disputes ('Decision on Mediation'), or the conciliation services in accordance with Decision No 2014-2 of the Presidium of the Boards of Appeal of 31/01/2014 on the friendly settlement of disputes by the competent Board ('Decision on Conciliation'), all correspondence relating to that mediation or conciliation are excluded from inspection of files.

Obsolete

Article 115 EUTMR

Article 76 CDIR

Even where an EUTM application is no longer pending, or an EUTM registration or RCD registration ceases to have effect, inspection of the respective files remains possible just as if the application or registration were still pending or effective, as long as the files are kept. An EUTM application or RCD application ceases to be pending when it is rejected, or when the application has been withdrawn or is considered to have been withdrawn, and an EUTM registration or RCD registration ceases to have effect when it expires or is surrendered, declared invalid or revoked. Where the files are kept in electronic format, the electronic files, or back-up copies thereof, will be kept indefinitely. Where, and to the extent that files or part of files are kept in any form other than electronically, the Office will keep the files in any form other than electronic format for at least 5 years from the end of the year in which such an event occurs.

4.2.1 The files relating to EUTM applications

Articles 44 and 114 EUTMR

Article 7 EUTMIR

The files relating to EUTM applications are available for inspection once the application has been published by the Office in the EUTM Bulletin. The day of publication is the date of issue shown in the EUTM Bulletin and is reflected under the INID code 442 in the Register. The dissemination of data relating to unpublished EUTM applications by means of online access or otherwise does not constitute publication of the application within the meaning of Article 44 EUTMR and Article 7 EUTMIR.

Before the publication of the application, inspection of the files is restricted and possible only if one of the following conditions is fulfilled:

- the applicant for inspection is the EUTM applicant; or
- the EUTM applicant has consented to inspection of the file relating to the EUTM application (see paragraph 6.12.1 below); or
- the applicant for inspection can prove that the EUTM applicant has stated that it will invoke the rights under the EUTM, once registered, against the applicant for inspection (see paragraph 6.12.2 below).

Article 41(3) and Article 115 EUTMR

The applicant always has access to the files relating to its own EUTM application. This comprises the following:

- the EUTM application, even where the Office has refused to attribute a filing date to it or where the application does not fulfil the minimum requirements for the attribution of a filing date, in which case the application will not be dealt with as an EUTM application and, legally speaking, there is no EUTM application;

Obsolete

- the files for as long as they are kept (see paragraph 4.2), even after the EUTM application has been rejected or withdrawn.

4.2.2 The files relating to RCD applications

Articles 50 and 74 CDR Article 70 and Article 74(2) CDIR

The files relating to RCD applications, or an RCD still subject to deferment of publication, including those that have been surrendered, are only available for inspection if one of the following conditions is fulfilled:

- the applicant for inspection is the RCD applicant/holder; or
- the applicant for the RCD has consented to inspection of the file relating to the RCD application; or
- the applicant for inspection has established a legitimate interest in the inspection of the RCD application, in particular where the applicant for the RCD has stated that after the design has been registered he/she will invoke the rights under it against the person requesting the inspection.

In the case of an application for multiple RCDs, this inspection restriction will only apply to information relating to the RCDs subject to deferment of publication, or to those that are not eventually registered, either due to rejection by the Office or withdrawal by the applicant.

4.2.3 The files relating to registered EUTMs

The files relating to EUTMs after registration are available for inspection.

4.2.4 The files relating to RCDs

The files relating to RCDs are available for inspection once the registration has been published by the Office in the Community Designs Bulletin. The day of publication is the date of issue shown in the Community Designs Bulletin and is reflected under the INID code 45 in the Register.

For inspection of the files relating to an RCD that is subject to deferment of publication, please see paragraph 4.2.2., above.

Obsolete

4.2.5 The files relating to international registrations designating the European Union

Articles 114(8), Articles 189 and 190 EUTMR

Article 106(d) CDR

Article 71 CDIR

International registrations are exclusive rights administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva according to the Madrid Protocol (in the case of trade marks) and the Geneva Act (in the case of designs). WIPO processes the applications and then sends them to the Office for examination in accordance with the conditions specified in the EUTMR and in the CDR. These registrations have the same effect as applying directly for an EUTM or an RCD.

The files kept by the Office relating to international trade mark registrations designating the EU may be inspected on request as from the date of publication referred to in Articles 114(8) and 190(1) EUTMR. The same rules apply as for the inspection of EUTMs.

The Office provides information on international registrations of designs designating the EU in the form of an electronic link to the searchable database maintained by the International Bureau (http://www.wipo.int/designdb/hague/en/). The files kept by the Office may relate to the refusal of the international design pursuant to Article 106e CDR and the invalidation of the international design pursuant to Article 106f CDR. They may be inspected subject to the restrictions pursuant to Article 72 CDIR (see paragraph 5 below) and subject to the same limitations as explained in paragraphs 4.2.2 and 4.2.4 above.

5 Parts of the File Excluded from Inspection

5.1 Excluded documents

Article 114(4) and Article 169 EUTMR

Article 72 CDIR

Certain documents contained in the files are excluded from inspection of files, namely:

- documents relating to the exclusion of or objection to Office staff, for example, on the grounds of suspicion of partiality;
- draft decisions and opinions and all other internal documents used for preparing decisions and opinions;

Obsolete

- parts of the file for which the party concerned expressed a special interest in keeping confidential;
- all documents relating to the invitation of the Office to find a friendly settlement, except those that have an immediate impact on the trade mark or design, such as limitations, transfers etc., and have been declared to the Office. (For mediation and conciliation proceedings, see paragraph 4.2 above).

The files relating to requests for entry on the Office's list of professional representatives or designs list, including all decisions taken therein, are not open to public inspection because the files do not relate to EUTM or RCD proceedings as such (see the Guidelines, Part A, General rules, Section 5, Professional representation, paragraph 2.3.5).

In principle, documents of a personal nature such as **passports or other identification documents**, which are submitted in particular as evidence in relation to requests for transfer, evidence of '**health data**', which is submitted in particular as evidence in relation to *restitutio in integrum* or as supporting evidence for extension requests, and **bank account extracts**, which may, for example, be attached to applications and requests as evidence of fee payment, because of their inherent personal nature, confidentiality vis à vis any third parties is justified, and, in principle, overrides any third-party interest.

5.1.1 Documents relating to exclusion or objection

Article 114(4) EUTMR Article 72(a) CDIR

This exception relates to documents in which an examiner states that they consider themselves excluded from participating in the case, and documents in which such a person makes observations about an objection by a party to the proceedings on the basis of a ground for exclusion or suspicion of partiality. However, it does not relate to letters in which a party to the proceedings raises, either separately or together with other statements, an objection based on a ground for exclusion or suspicion of partiality, or to any decision on the action to be taken in the cases mentioned above. The decision taken by the competent instance of the Office, without the person who withdraws or has been objected to, will form part of the files.

5.1.2 Draft decisions and opinions and internal documents

Article 114(4) EUTMR Article 72(b) CDIR

This exception relates to documents used for preparing decisions and opinions, such as reports and notes drafted by an examiner that contain considerations or suggestions

Obsolete

for dealing with or deciding on a case, or annotations containing specific or general instructions on dealing with certain cases.

Documents that contain a communication, notice or final decision by the Office in relation to a particular case are not included in this exception. Any document to be notified to a party to the proceedings will take the form of either the original document or a copy thereof, certified by or bearing the seal of the Office, or a computer printout bearing that seal. The original communication, notice or decision or copy thereof will remain in the file.

The Notes and the Guidelines of the Office relating to general procedure and treatment of cases, such as these Guidelines, do not form part of the files. The same is true for measures and instructions concerning the allocation of duties.

5.1.3 Parts of the file for which the party concerned expressed a special interest in keeping confidential

Article 114(4) EUTMR Article 72(c) CDIR

Point in time for the request

Keeping all or part of a document confidential may be requested on its submission or at a later stage, as long as there is no pending request for an inspection of files. During inspection of files proceedings confidentiality may not be requested.

Parts of the file for which the party concerned expressed a special interest in keeping confidential before the application for inspection of files was made are excluded from inspection of files, unless their inspection is justified by an overriding legitimate interest of the party seeking inspection.

Invoking confidentiality and expressing a special interest

The party concerned must have expressly invoked, and sufficiently justified, a special interest in keeping the document confidential (see 08/11/2018, R 722/2018-5, nume (fig.) / Numederm, § 16). Where any request is submitted on an Office form (paper or e-filing format), the form itself cannot be marked as confidential. However, any attachments thereto may be excluded from inspection of files. This applies to all proceedings as the form includes the minimum information, which is later included in the publicly available Register, and is, therefore, incompatible with a declaration of confidentiality.

If a special interest in keeping a document confidential is invoked, the Office must check whether that special interest is sufficiently demonstrated. The documents falling into this category must originate from the party concerned (e.g. EUTM/RCD applicant, opponent).

Confidentiality invoked and special interest claimed

Obsolete

Where special interest is invoked and elaborated upon, the special interest must be due to the confidential nature of the document or its status as a trade or business secret. This may be the case, for example, where the applicant has submitted underlying documentation as evidence in respect of a request for registration of a transfer or licence.

Where the Office concludes that the requirements for keeping documents confidential are not met because the special interests claimed do not justify maintaining the confidentiality of the document, prior to lifting the confidentiality it will communicate with the person who filed the documents and make a decision. In reply, the applicant may submit evidence in such a way that avoids revealing parts of the document or information that the applicant considers confidential, as long as the parts of the document submitted contain the required information. For example, where contracts or other documents are submitted as evidence for a transfer or licence, certain information may be blacked out before being submitted to the Office, or certain pages may be omitted altogether.

Confidentiality invoked with no attempt to claim any special interest

Where a claim for confidentiality has been submitted by the party by use of a standard 'confidential' stamp on the cover page of the submission, or by ticking the 'confidential' tick-box when using the electronic communication platform, but the documents enclosed contain no explanation nor indication of any special interest nor any attempt on behalf of the party to justify the confidential nature or status of the submission, the Office will remove this indication.

This applies to all submissions where the party claims confidentiality 'by default', yet provides no justification in support of its claim. The party can at any time before the receipt of a request for inspection of files, invoke and sufficiently justify a special interest in keeping the document confidential.

In the event that the Office invites the parties to opposition, cancellation or invalidity proceedings to consider a friendly settlement, all corresponding documents referring to those proceedings are considered confidential and, in principle, not open to inspection of files.

Access to documents that the Office has accepted as being confidential and thus, excluded from inspection, may nevertheless be granted to a person who demonstrates an overriding legitimate interest in inspecting the document. The overriding legitimate interest must be that of the person requesting inspection.

If the file contains such documents, the Office will inform the applicant for inspection of files about the existence of such documents within the files. The applicant for inspection of files may then decide whether or not it wants to file a request invoking an overriding legitimate interest. Each request must be analysed on its own merits.

The Office must give the party requesting inspection the opportunity to present its observations.

Before taking a decision, the request, as well as any observations, must be sent to the party concerned, who has a right to be heard.

Obsolete

Article 67 EUTMR Article 56 CDR

The Office must make a decision as to whether to grant access to such documents. Such a decision may be appealed by the adversely affected party.

5.2 Access for applicant or proprietor to excluded documents

Article 114(4) EUTMR Article 72 CDIR

Where an applicant or proprietor requests access to their own file, this will mean all documents forming part of the file, excluding only those documents referred to in Article 114(4) EUTMR and Article 72(a) and (b) CDIR.

In *inter partes* proceedings, where the one concerned (the opponent or applicant for revocation or declaration of invalidity) has shown a special interest in keeping its document confidential vis-à-vis third parties, it will be informed that the documents cannot be kept confidential with respect to the other party to the proceedings and it will be invited to either disclose the documents or withdraw them from the proceedings. If it confirms the confidentiality, the documents will not be sent to the other party and will not be taken into account by the Office in the decision.

If, on the other hand, it wants the documents to be taken into account but not available for third parties, the documents can be forwarded by the Office to the other party to the proceedings, but will not be available for inspection by third parties (for opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.4.4).

6 Procedures before the Office Relating to Applications for Inspection of Files

6.1 Certified or uncertified extracts of the Registers

6.1.1 Extracts from the Register of EUTMs

Article 111(7) EUTMR

The Office shall provide certified or uncertified extracts from the Register on request, on payment of a fee. Downloadable (certified) copies are, however, free of charge (see paragraph 6.4 below).

Obsolete

Requests for an extract from the Register of EUTMs may be submitted using the online form which can be found on the Office's website at https://euipo.europa.eu/ohimportal/en/forms-and-filings, or any equivalent request.

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 6.7 below

Article 63 EUTMDR

An application for inspection of files may be submitted as a signed original by electronic means, post or courier (see paragraph 6.5 below).

6.1.2 Extracts from the Register of Community designs

Article 50 CDR Articles 69 and 73 CDIR

Subject to Article 73 CDIR, the Office shall provide certified or uncertified extracts from the Register on request, on payment of a fee.

Where the registration is subject to a deferment of publication, pursuant to Article 50(1) CDR, certified (or uncertified) extracts from the Register shall contain only the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred, except where the request has been made by the holder or its representative.

Requests for an extract from the Register of Community designs may be submitted using the online form, which can be found on the Office's website at https://euipo.europa.eu/ohimportal/en/forms-and-filings, or any equivalent request.

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 6.7 below.

Articles 65, 66 and 67 CDIR

An application for inspection of files may be submitted as a signed original by electronic means, post or courier (see paragraph 6.5 below).

6.2 Certified or uncertified copies of file documents

The Office shall provide certified or uncertified copies of documents constituting the files (see paragraph 4.2 above) on request, on payment of a fee. Downloadable (certified) copies are, however, free of charge (see paragraph 6.4 below).

Requests for certified or uncertified copies of documents may be submitted using the online form, which can be found on the Office's website at https://euipo.europa.eu/ohimportal/en/forms-and-filings, or any equivalent request.

Obsolete

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 6.7 below.

Certified and uncertified copies of the EUTM and RCD applications, registration certificates, extracts of the Register and copies of the documents in the file (available only for EUTMs), may also be requested as an alternative to the downloadable copies available free of charge (see paragraph 6.4 below).

Certified copies of the EUTM application or the RCD registration certificate will only be available when a filing date has been accorded (for EUTM filing date requirements, see the Guidelines, Part B, Examination, Section 2, Formalities; for RCD filing date requirements, see the Guidelines on Examination of Applications for Registered Community Designs).

In the case of an application for multiple designs, certified copies of the application will only be available for those designs that have been accorded a filing date.

Where the EUTM application or RCD registration has not yet been published, a request for certified or uncertified copies of the file documents will be subject to the restrictions listed in paragraphs 4.2.1 to 4.2.4 above.

It should be borne in mind that the certified copy of the application or registration only reflects the data on the date of application or registration. The trade mark or design may have been the subject of a transfer, surrender, partial surrender or other act affecting its scope of protection, which will not be reflected in the certified copy of the EUTM application form or EUTM/RCD registration certificate. Up-to-date information is available from the electronic database or by requesting a certified extract of the Register (see paragraph 6.1 above).

6.3 Online access to the files

The contents of the files are available in the 'Correspondence' section of the file in the Office's online tool on the Office's website.

Providing the EUTM application or the RCD registration (not subject to a deferment) has been published, registered users of the website can consult these files free of charge.

6.4 Downloadable certified copies

Decision No EX-13-2 of the President of the Office of 26/11/2013, Article 6.

Certified and uncertified copies of the EUTM and RCD applications, registration certificates, extracts of the Register and copies of the documents in the file (available only for EUTMs) can be automatically generated and downloaded via a direct link from the Office's website using the Office's online tool, from within the Inspection of Files e-filing form and from within the files for a selected EUTM or RCD.

Obsolete

The copy of the document will be made available in PDF format, and will be composed of a cover page in the five Office languages, introducing the certified document and followed by the certified document itself. The document contains a unique identification code. Each page of the document should bear a header and footer containing important elements in order to guarantee the authenticity of the certified copy: a unique identification code, a 'copy' stamp, the signature of the Office staff member responsible for issuing certified copies, the date of the certified copy, the EUTM/RCD number and page number. The date indicated is the date when the certified copy was automatically generated.

The automatically generated certified copies have the same value as certified copies sent on paper on request, and can be used either in electronic format or printed.

When an authority receives a certified copy, it can verify the original document online using the unique identification code given in the certified copy. A link 'Verify certified copies' is available under the 'Databases' section of the Office's website. Clicking on the link will bring up a screen with a box in which the unique identification code can be entered in order to retrieve and display the original document from the Office's online systems.

It should be borne in mind that the certified copy only reflects the data on the date of application/registration. The trade mark or design may have been the subject of a transfer, surrender, partial surrender or other act affecting its scope of protection, which will not be reflected in the certified copy of the EUTM application form or EUTM/RCD registration certificate. Up-to-date information is available from the electronic database or by requesting a certified extract of the Register or database.

6.5 Online applications for inspection of files

Users may access the application form online through their user account, where they will be invited to log in and complete the application for inspection of files requesting certified or uncertified copies of specific documents.

6.6 Written applications for inspection of files

Article 63 EUTMDR Article 65 CDIR

Applications for inspection may be submitted using the online form, which can be found on the Office's website at https://euipo.europa.eu/ohimportal/en/forms-and-filings, or any equivalent request.

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 6.7 below.

Obsolete

Article 63 EUTMDR

Article 67 CDIR

An application for inspection of files may be submitted as a signed original form by electronic means (see paragraph 6.5 above), post or courier.

6.7 Languages

Applications for inspection of files must be filed in one of the languages indicated below.

6.7.1 For EUTM or RCD applications

Article 146(6) and (9) EUTMR

Article 25 EUTMIR

Articles 80, 81, 83 and 84 CDIR

Where the application for an inspection of files relates to a EUTM application or RCD application, whether already published or not, it must be filed in the language in which the EUTM application or RCD application was filed (the 'first' language) or in the second language indicated by the EUTM applicant or RCD applicant in their application (the 'second' language).

Where the application for inspection is filed in a language other than indicated above, the applicant for inspection must, of its own motion, submit a translation into one of the languages indicated above within 1 month. If such a translation is not submitted within the deadline, the application for inspection of files will be considered not to have been filed.

This does not apply where the applicant for inspection could not have been aware of the languages of the EUTM application or RCD application. This can be the case only where such information is not available in the online Register and the application can immediately be dealt with. In this case, the application for inspection may be filed in any of the five languages of the Office.

Obsolete

6.7.2 For registered EUTMs or RCDs

Article 146(6) and (9) EUTMR Article 25 EUTMIR Article 80(b), Articles 81, 83 and 84 CDIR

Where the application for inspection of files relates to a registered EUTM or RCD, it must be filed in one of the five languages of the Office.

The language in which the application for inspection was filed will become the language of the inspection proceedings.

Where the application for inspection of files is made in a language other than indicated above, the party requesting inspection must, on its own motion, submit a translation into one of the languages indicated above within one month, or the application for inspection of files will be considered not to have been filed.

6.8 Representation and authorisation

Representation is not mandatory for filing an application for inspection of files.

Where a representative is appointed, the general rules for representation and authorisation apply. See the Guidelines, Part A, General Rules, Section 5, Professional Representation.

6.9 Contents of the application for inspection of files

The application for inspection of files mentioned in paragraphs 6.5 and 6.6 above must contain the following.

- An indication of the file number or registration number for which inspection is applied.
- The name and address of the applicant for inspection of files.
- If appropriate, an indication of the document or information for which inspection is applied (applications may be made to inspect the whole file or specific documents only). In the case of an application to inspect a specific document, the nature of the document (e.g. ‘application’, ‘notice of opposition’) must be stated. Where communication of information from the file is applied for, the type of information needed must be specified. Where the application for inspection relates to an EUTM application that has not yet been published, the application for an RCD that has not yet been published or an RCD that is subject to deferment of publication in accordance with Article 50 CDR or which, being subject to such deferment, has been surrendered before or on the expiry of that period, and inspection of the files is

Obsolete

applied for by a third party, an indication and evidence to the effect that the third party concerned has a right to inspect the file.

- Where copies are requested, an indication of the number of copies requested, whether or not they should be certified and, if the documents are to be presented in a third country requiring an authentication of the signature (legalisation), an indication of the countries for which authentication is needed.
- The applicant's signature in accordance with Article 63(1) EUTMDR and Article 65 CDIR.

6.10 Deficiencies

Where an application for inspection of the files fails to comply with the requirements concerning the contents of applications, the applicant for inspection will be invited to remedy the deficiencies. If deficiencies are not remedied within the established time limit, the application for inspection will be refused.

6.11 Fees for inspection and communication of information contained in the files

All fees are due on the date of receipt of the application for inspection (see paragraphs 6.5 and 6.6 above).

6.11.1 Communication of information contained in a file

Article 114(9) and Annex I A(32) EUTMR Article 75 CDIR Article 2 CDFR in conjunction with Annex (23) CDFR

Communication of information in a file is subject to payment of a fee of EUR 10.

6.11.2 Inspection of the files

Article 114(6) and Annex I A(30) EUTMR Article 74(1) CDIR Article 2 and Annex (21) CDFR

A request for inspection of the files on the Office premises is subject to payment of a fee of EUR 30.

Obsolete

Article 114(7) and Annex I A(31)(a) EUTMR

Article 74(4) CDIR

Article 2 and Annex (22) CDFR

Where inspection of a file is obtained through the issuing of **uncertified** copies of file documents, those copies are subject to payment of a fee of EUR 10 plus EUR 1 for every page exceeding ten.

Article 51(2) EUTMR

Articles 111(7), 114(7) and Annex I A(29)(a) EUTMR

Articles 17(2), 69(6) and 74(5) CDIR

Article 2 and Annex 20 CDFR

An **uncertified** copy of an EUTM application or RCD application, an **uncertified** copy of the certificate of registration, an **uncertified** extract from the Register or an **uncertified** extract of the EUTM application or RCD application from the database is subject to payment of a fee of EUR 10 per copy or extract.

However, registered users of the website can obtain electronic **uncertified** copies of EUTM or RCD applications or registration certificates free of charge through the website.

Article 114(7) and Annex I A(31)(b) EUTMR

Article 74(4) CDIR

Article 2 and Annex (22) CDFR

Where inspection of a file is obtained through the issuing of **certified** copies of file documents, those copies are subject to payment of a fee of EUR 30 plus EUR 1 for every page exceeding ten.

Article 51(2) EUTMR

Articles 111(7), 114(7) and Annex I A(29)(b) EUTMR

Articles 17(2), 69(6) and 74(5) CDIR

Article 2 and Annex (20) CDFR

A **certified** copy of an EUTM application or RCD application, a **certified** copy of the certificate of registration, a **certified** extract from the Register or a **certified** extract of the EUTM application or RCD application from the database is subject to payment of a fee of EUR 30 per copy or extract.

Obsolete

However, registered users of the website can obtain electronic **certified** copies of EUTM or RCD applications or registration certificates free of charge through the website.

6.11.3 Consequences of failure to pay

Article 114(6) EUTMR Article 74(1) CDIR

An application for inspection of files will be considered not to have been filed until the fee has been paid. The fees apply not only where the application for inspection has been filed by a third party, but also where it has been filed by the EUTM or RCD applicant or proprietor. The Office will not process the inspection application until the fee has been paid.

However, if the fee is not paid or is not paid in full, the Office will notify the applicant for inspection:

- if no payment is received by the Office for a certified or uncertified copy of an EUTM application or RCD application, a certificate of registration or an extract from the Register or from the database;
- if no payment is received by the Office for inspection of the files obtained through the issuing of certified or uncertified copies of file documents;
- if no payment is received by the Office for the communication of information contained in a file.

The Office will issue a letter indicating the amount of fees to be paid. If the exact amount of the fee is not known to the applicant for inspection because it depends on the number of pages, the Office will either include that information in the standard letter or inform the applicant for inspection by other appropriate means.

6.11.4 Refund of fees

Where an application for inspection of the files is rejected, the corresponding fee is not refunded. However, where, after the payment of the fee, the Office finds that not all the certified or uncertified copies requested may be issued (e.g. if the request concerns confidential documents and the applicant has not proven an overriding legitimate interest), any fees paid in excess of the amount actually due will be refunded.

Obsolete

6.12 Requirements concerning the right to obtain inspection of files concerning an unpublished EUTM application, or a deferred RCD filed by a third party

Article 114(1) and (2) EUTMR
Article 74 CDR
Article 74(2) CDIR

Where an application for inspection of files for an EUTM application that has not yet been published, or for files relating to an RCD subject to deferment of publication in accordance with Article 50 CDR, or for those which, subject to such deferment, have been surrendered before or on the expiry of that period, (see paragraphs 4.2.1 and 4.2.2 above) is filed by a third party (i.e. by a person other than the EUTM or RCD applicant or its representative), different situations may arise.

If the application by a third party is based on the grounds specified in Article 114(1) and (2) EUTMR (see paragraph 4.2.1 above), or in Article 74(2) CDR or in Article 74(2) CDIR (see paragraph 4.2.2 above), it must contain an indication and evidence to the effect that the EUTM applicant or RCD applicant or holder has consented to the inspection, or has stated that it will invoke the rights under the RCD, once registered, against the applicant for inspection.

6.12.1 Consent

The consent of the EUTM applicant or RCD applicant or holder must be in the form of a written statement in which it consents to the inspection of the particular file(s). Consent may be limited to inspection of certain parts of the file, such as the application, in which case the application for inspection of files may not exceed the scope of the consent.

Where the applicant for inspection of files does not submit a written statement from the EUTM applicant, RCD applicant or holder consenting to the inspection of the files, the applicant for inspection will be notified and given 2 months from the date of notification to remedy the deficiency.

If, after expiry of the time limit, no consent has been submitted, the Office will reject the application for inspection of files. The applicant for inspection will be informed of the decision to reject the application for inspection.

The decision may be appealed by the applicant for inspection (Articles 67 and 68 EUTMR and Article 56 CDR).

Obsolete

6.12.2 Statement that EUTM or RCD rights will be invoked

Article 114(2) EUTMR Article 74(2) CDR Article 74(2) CDIR

Where the application relies on the allegation that the EUTM or RCD proprietor will invoke the rights under the EUTM or RCD, once registered, it is up to the applicant for inspection to prove this allegation. The proof to be submitted must take the form of documents, such as, statements by the EUTM applicant or RCD applicant or holder for the EUTM application, RCD application or registered and deferred RCD in question, business correspondence, etc. Filing an opposition based on an EUTM application against a national mark constitutes a statement that the EUTM will be invoked. Mere assumptions on the part of the applicant for inspection of the file will not constitute sufficient proof.

The Office will first examine whether the proof is sufficient.

If so, the Office will send the application for inspection of files and the supporting documents to the EUTM applicant or RCD applicant or holder and invite it to comment within two months. If the EUTM applicant or RCD applicant or holder consents to an inspection of the files, it will be granted. If the EUTM applicant or RCD applicant or holder submits comments contesting inspection of the files, the Office will send the comments to the applicant for inspection. Any further statement by the applicant for inspection will be sent to the EUTM applicant or RCD applicant or holder and vice versa. The Office will take into account all submissions made on time by the parties and decide accordingly. The Office's decision will be notified to both the applicant for inspection of the files and the EUTM applicant or RCD applicant or holder. It may be appealed by the adversely affected party (Articles 67 and 68 EUTMR and Article 56 CDR).

6.13 Grant of inspection of files, means of inspection

When inspection is granted, the Office will send the requested copies of file documents, or requested information, as appropriate, to the applicant for inspection or invite it to inspect the files at the Office's premises. The Office will not forward the requested documents to any third parties.

Obsolete

6.13.1 Communication of information contained in a file

Article 114(9) EUTMR Article 75 CDIR

The Office may, on request, communicate information contained in any file relating to EUTM or RCD applications or registrations.

Information contained in the files will be provided without an application for inspection, inter alia, where the party concerned wishes to know whether a given EUTM application has been filed by a given applicant, the date of such application, or whether the list of goods and services has been amended in the period between the filing of the application and its publication.

Having obtained this information, the party concerned may then decide whether or not to request copies of the relevant documents, or to apply for inspection of the file.

Where the party concerned wishes to know, inter alia, which arguments an opponent has brought forward in opposition proceedings, which seniority documents have been filed, or the exact wording of the list of goods and services as filed, such information will not be provided. Instead the Office will advise the party to apply for inspection of the file.

In such cases, the quantity and complexity of the information to be supplied would exceed reasonable limits and create an undue administrative burden.

6.13.2 Copies of file documents

Where inspection of the files is granted in the form of the provision of certified or uncertified copies of file documents, the party will be sent the requested documents.

Where inspection of files is granted on the Office premises, the applicant will be given an appointment to inspect the files.

6.13.3 Specific interest concerning the inspection applicant

Where a party shows a specific interest in knowing whether its file has been inspected and by whom, there should be a compromise between the general interest of the public to be able to inspect files of proceedings before the Office with a minimum of formalities and the parties' specific interest to know who has inspected the file in exceptional, duly justified circumstances.

Considering that online inspection requests are not communicated as a matter of course to the party whose file has been inspected, that party must put forward a reasoned and substantiated request showing that there are legitimate reasons for being informed if its file has been inspected, and by whom. The Office will not automatically grant such a request. Instead, on a case-by-case basis, it will balance these reasons against the explanations provided by the person who made the

Obsolete

inspection within a period set by the Office to that effect, before any such request is granted.

7 Procedures to Give Access to the Files to Courts or Authorities of the Member States

Article 117(1) EUTMR
Article 75 CDR
Articles 20 and 21 EUTMIR
Articles 77 and 78 CDIR

For the purposes of administrative cooperation, the Office will, on request, assist the courts or authorities of the Member States by communicating information or opening files for inspection.

For the purposes of administrative cooperation, the Office will also, on request, communicate relevant information about the filing of EUTM or RCD applications and proceedings relating to such applications, and the marks or designs registered as a result thereof, to the central industrial property offices of the Member States.

7.1 No fees

Article 20(3) and Article 21(1) and (3) EUTMIR
Article 77(3) and Article 78(1) and (2) CDIR

Inspection of files and communication of information from the files requested by the courts or authorities of the Member States are not subject to the payment of fees.

Article 21(3) EUTMIR
Article 78(2) CDIR

Courts or public prosecutors' offices of a Member State may open to inspection by third parties files, or copies thereof, that have been transmitted to them by the Office. The Office will not charge any fee for such inspection.

Obsolete

7.2 No restriction as to unpublished applications

Articles 114(4) and 117(1) EUTMR

Article 20(1) EUTMIR

Article 75 CDR

Article 72 and Article 77(1) CDIR

Inspection of files and communication of information from the files requested by the courts or authorities of the Member States is not subject to the restrictions contained in Article 114 EUTMR and Article 74 CDR. Consequently, these bodies may be granted access to files relating to unpublished EUTM applications (see paragraph 4.2.1 above) and RCDs subject to deferment of publication (see paragraph 4.2.2 above), as well as to parts of the files for which the party concerned has expressed a special interest in keeping confidential. However, documents relating to exclusion and objection, as well as the documents referred to in Article 114(4) EUTMR and Article 72(b) CDIR, will not be made available to these bodies.

Article 114(4) EUTMR

Article 21(3) EUTMIR

Article 74 CDR

Article 72 and Article 78(2) CDIR

Courts or public prosecutors' offices of the Member States may open to inspection by third parties files or copies that have been transmitted to them by the Office. Such subsequent inspection shall be subject to the restrictions contained in Article 114(4) EUTMR or Article 74 CDR, as if the inspection had been requested by a third party.

Article 21(2) EUTMIR

Article 78(4) CDIR

When transmitting files or copies thereof to the courts or public prosecutors' offices of the Member States, the Office will indicate the restrictions imposed on inspection of files relating, on the one hand to EUTM applications or registrations pursuant to Article 114 EUTMR, and on the other hand to RCD applications or RCD registrations pursuant to Article 74 CDR and Article 72 CDIR.

Obsolete

7.3 Means of inspection

Article 21(1) EUTMIR

Article 78(1) CDIR

Inspection of the files relating to EUTM/RCD applications or registrations by courts or authorities of the Member States may be granted by providing copies of the original documents. As the files contain no original documents as such, the Office will provide printouts from the electronic system.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 6

Other entries in the register

Obsolete

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 6

Other entries in the register

Chapter 1

Counterclaims

Obsolete

Obsolete

1 Introduction

Counterclaims, as provided for in Article 128 EUTMR or Article 84 CDR, are defence claims made by a defendant that is being sued for the infringement of an EUTM or Registered Community Design (RCD). By way of such a counterclaim, the defendant asks the European Union trade mark court (EUTM court) or Community design court (CD court) to declare the revocation or invalidity of the EUTM or the invalidity of the RCD that it is alleged to have infringed.

The purpose of recording the filing and the final judgment of the counterclaim in the Office Register lies in the general interest of making all the relevant information on counterclaims concerning EUTMs and RCDs, in particular the final judgments thereof, publicly available. In this way, the Office can implement these final judgments, in particular those that declare the total or partial revocation or invalidity of an EUTM, as well as those that declare the total invalidity of an RCD.

By entering such counterclaims and their final judgments in the Register, the Office strives to comply with the principles of conformity to truth, public faith and the legal certainty of a public register.

2 Application to Register the Filing of a Counterclaim Before an EUTM or a CD Court

Article 111(3)(n) and Article 128(4) EUTMR
Article 86(2) CDR
Article 69(3)(p) CDIR
Communications No 9/05 and No 10/05 of the President of the Office of 28/11/2005

According to Article 128(4) EUTMR and Article 86(2) CDR, the EUTM or CD court before which a counterclaim for revocation of an EUTM or for a declaration of invalidity of an EUTM or RCD has been filed must inform the Office of the date on which the counterclaim was filed.

The Regulations provide that the EUTM court with which a counterclaim for revocation or for a declaration of invalidity of an EUTM has been filed must not proceed with the examination of the counterclaim until either the interested party or the court has informed the Office of the date on which the counterclaim was filed.

Communications No 9/05 and No 10/05 of the President of the Office of 28/11/2005 concern the designation of EUTM and CD courts in the Member States pursuant to Article 123 EUTMR.

The Office also allows any party to the counterclaim proceedings to request the entry of a counterclaim in the Register, if not yet communicated by the EUTM or CD court.

Obsolete

The applicant should:

- indicate the date on which the counterclaim was filed;
- quote the number of the EUTM or RCD concerned;
- state whether the application is for revocation or for a declaration of invalidity;
- submit evidence that the counterclaim has been raised before the EUTM or CD court with authority to rule on the counterclaim, including, where possible, the case or reference number from the court.

If the above is not submitted, or if the information submitted by the applicant requires clarification, the Office will issue a deficiency letter. If the deficiencies are not remedied, the Office will reject the application for registration of the counterclaim. The party concerned may file an appeal against this decision.

The Office will notify the EUTM or RCD proprietor and the EUTM or CD court that the counterclaim has been entered in the Register. If the request was made by the other party to the counterclaim proceedings, the Office will also inform this party.

If an application for revocation or for a declaration of invalidity of an EUTM had already been filed with the Office before the counterclaim was filed, the Office will inform the courts before which a counterclaim is pending in respect of the same mark. The courts will stay the proceedings in accordance with Article 132(1) EUTMR until the decision on the application is final or the application is withdrawn.

3 Application to Register a Judgment on a Counterclaim Before an EUTM or a CD Court

Article 111(3)(o) and Article 128(6) EUTMR Article 86(4) CDR Article 69(3)(q) CDIR

Where an EUTM or a CD court has delivered a judgment that has become final on a counterclaim for revocation of an EUTM or for a declaration of invalidity of an EUTM or RCD, a copy of the judgment must be sent to the Office.

The Office also allows any party to the counterclaim proceedings to request the entry of a judgment on the counterclaim action in the Register, if not yet communicated by the EUTM or CD court.

The applicant should:

- submit a copy of the judgment, together with confirmation from the EUTM or CD court that the judgment has become final;
- indicate the date on which the judgment was issued;
- quote the number of the EUTM or RCD concerned;
- state whether the request is for revocation or for a declaration of invalidity;

Obsolete

- in the event of partial cancellation or invalidity, indicate the list of goods and services affected by the judgment, if relevant.

In order to enter the counterclaim in the Register, the Office needs confirmation that the judgment **is final** (passée en force de chose jugée/rechtskräftig/adquirido fuerza de cosa juzgada, etc.). If the Office requires clarification, it may request this in writing.

The Office must mention the judgment in the Register and take the necessary measures to comply with its operative part.

Where the final judgment partially cancels an EUTM, the Office will alter the list of goods and services according to the EUTM court judgment and, where necessary, send the amended list of goods and services for translation.

The Office will notify the EUTM or RCD proprietor and the EUTM or CD court that the judgment has been entered in the Register. If the request was made by the other party to the counterclaim proceedings, the Office will also inform this party.

Obsolete

Obsolete