GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Table of Contents

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 1

Means of communication, time limits

Table of Contents

1 Introduction

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

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

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

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

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

2 Procedures for Filing and for Communication with the Office

Article 30 EUTMR

Articles 63 and 65 EUTMDR

Article 35 CDR

Articles 65 and 68 CDIR

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

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, Parties to the Proceedings and Professional Representation .

3.1 Communications to the Office in writing or by other means

Article 98(3) EUTMR
Article 100 EUTMR Article 55(2), (3) and (4) EUTMDR, and Articles 63 and 64 EUTMDR Articles 65 to 67 CDIR Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means Decision No EX-22-7 of the Executive Director of the Office of 29 November 2022 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 23-13 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 is not offered and is not used**, as a means of communication in procedures before the Office.

3.1.1 Via the User Area (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. The User Area enables users to submit applications and other documents, receive notifications and documents sent by the Office, reply to these 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 3 working days of the original submission, the application for registration of an EUTM or RCD (with the same content) through the User Area. 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:

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.

In the unlikely event that these back-up measures are not available, the Executive Director may take a decision to extend the deadlines pursuant to Article 101(3) EUTMR and Article 58 CDIR (see paragraph 4.2).

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 and the sanctions imposed in the event of the prohibited disclosure of User Area credentials, please see paragraph 4(b) of the Conditions of use of the user area, annexed to Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 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.

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.

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.

3.1.4 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.

The Office only accepts the file formats listed in Decision No EX-22-7 of the Executive Director of the Office of 29/11/2022 on technical specifications for annexes submitted on data carriers, namely JPEG, MP3, MP4, PDF, TIFF, and for 3D models, STL, OBJ and X3D. The Office does not accept files in an executable file format (EXE), in a compressed file format or in an encrypted format, even if the resulting executed, decompressed or unencrypted file is in one of the acceptable file formats. Nor does the Office accept fillable PDF formats and PDF files that include added objects such as redacted (blacked-out) or added text, highlighted text or arrows.

The maximum size of each individual file saved on the data carrier is restricted to 20 MB (Article 4 of Decision No EX-22-7).

For further information, see Article 3 of Decision No EX-22-7 of the Executive Director of the Office of 29/11/2022 on technical specifications for annexes submitted on data carriers.

If an annex on the data carrier does not comply with the acceptable type of data carriers under Article 2(1) or the technical specifications under Article 3 and 4 of Decision No EX-22-7, the Office will deem it not to have been filed without inviting the party to overcome the deficiency (Article 6(a) No EX-22-7).

3.1.5 Signature

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

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

If the application or other communication is filed by electronic means, the indication of the sender's name is deemed to be equivalent to a signature.

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.

3.1.6 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, 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.

3.1.7 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.

3.1.8 References made to documents or items of evidence in other proceedings

For further information on how to refer to documents or items of evidence submitted in other proceedings, see the Guidelines, Part A, Section 10, Evidence, 3.1 Reference to documents or evidence in other proceedings before the Office.

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-23-13 of the Executive Director of the Office of 15 December 2023 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 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.

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.

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

Under Article 101(1) EUTMR, the calculation of a time limit starts on the day following the day on which the 'relevant event' occurred.

Where the Office sets a time limit in a notification indicating a time limit in terms of days, weeks or months (usually 2 months), the 'relevant event' is the date on which the document is notified or deemed notified, depending on the rules governing the 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) and a notification issued by post or courier is deemed to have been notified on the tenth day after it was posted (see paragraph 3.2.2).

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 2-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 the 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 of an 'actual interruption' of 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.

Not every technical error is regarded as an 'actual interruption of the Office's connection to admitted electronic means' under Article 101(3) EUTMR, Article 58 CDIR. An actual interruption requires electronic communication (including all back-up options) to be disrupted for **at least 6 consecutive hours** during **the same working day**. For shorter interruptions, the Office will not extend the time limits under Article 101(3) EUTMR. Parties should be wary, therefore, of filing submissions on the last day of a time limit, especially after Office working hours. If a party misses a deadline, it may consider filing a request for *restitutio in integrum* (see paragraph 4.5) or for continuation of the proceedings (see paragraph 4.4).

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

4.3 Extension of time limits

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

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

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 *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 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.

4.5 *Restitutio in integrum*

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

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 2

General principles to be respected in the proceedings

Table of Contents

1 Adequate reasoning

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

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

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

It is sufficient that it sets out the facts and legal considerations of fundamental importance in the context of the decision (18/01/2013, T-137/12, Vibrator, EU:T:2013:26, § 41-42; 20/02/2013, T-378/11, Medinet, EU:T:2013:83, § 17; 03/07/2013, T-236/12, Neo, EU:T:2013:343, § 57-58; 16/05/2012, T-580/10, Kindertraum, EU:T:2012:240, § 28; or 10/10/2012, T-569/10, Bimbo Doughnuts, EU:T:2012:535, § 42-46, 08/05/2014, C-591/12 P, Bimbo Doughnuts, EU:C:2014:305).

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 likely to be known by anyone or that may be learnt from generally accessible sources (16/10/2014, T-444/12, Linex, EU:T:2014:886, § 30; 22/06/2004, T-185/02 Picaro, EU:T:2004:189, § 29; 09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 29; 28/09/2016, T-476/15, FITNESS, EU:T:2016:568, § 41; 17/09/2020, C-449/18 P – C-474/18 P, MESSI (fig.) / MASSI et al., EU:C:2020:722, § 74).

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 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.

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).

4 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.

4.1 Summons to oral proceedings

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

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

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

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

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

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

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

4.2 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.

4.3 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.

4.4 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.

4.5 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.

5 Decisions

5.1 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.

5.2 Apportionment of costs

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

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

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

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

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

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

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

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

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

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

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

For further information see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 6.5 and the Guidelines on Examination of Design Invalidity Applications.

5.3 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.

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.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 3

Payment of fees, costs and charges

Table of Contents

1 Introduction

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

The specific 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).

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).

In line with Article 178 EUTMR and Article 71 of the EUIPO's Financial Regulation, the Office provides services upon the advance payment of the corresponding fee or charge.

The Office does not issue invoices or debit notes to claim payment for fees or charges as they must be paid before the services are provided by the Office and therefore there are no outstanding payments.

However, the Office can provide a receipt to confirm payment when requested by the user.

Additionally, for each request submitted by a party to proceedings before the Office, the Office issues an acknowledgement of receipt of the request where the fee amount is indicated.

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. Details of these accounts are available on the Office's website (https://www.euipo.europa.eu/en/trade-marks/before-applying/fees-payments) under 'Fees and payments'.

Concerning bank charges, it is important to ensure that the full 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:

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 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, provided that the current account has sufficient funds (see 4.3 Payment by current account on page 57) (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.

The following may hold current accounts (Article 3 of Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021; see the Guidelines, Part A, Section 5, Parties to the Proceedings and Professional representation):

1. natural or legal persons who, in accordance with Article 5 EUTMR and Article 1(b) CDIR, may be proprietors of EU trade marks or holders of RCDs;
2. persons who may act as representatives in accordance with Article 120 EUTMR and Article 78 CDR;
3. associations of representatives;
4. natural or legal persons authorised by proprietors of EU trade marks or holders of RCDs for the purposes of Article 53(1) EUTMR or Article 13(1) CDR.

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

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

method of payment back to payment by current account at any time before the expiry of the payment deadline.

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

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

If the holder does replenish the account, the payment of the fee will be deemed to have been received on the date the relevant document in relation to which the payment was made (for instance a notice of opposition) is received by the Office. If payment concerns the replenishment of a current account, it is sufficient to indicate the current account number.

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

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

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

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

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 0203/2005-1, BLUE CROSS MEDICARE / BLUE CROSS.

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

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

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

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

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).

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 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.

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.

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-23-13 of the Executive Director of the Office of 15 December 2023 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-23-13 of the Executive Director of the Office of 15 December 2023 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.

7 Decisions on Costs

Article 109 EUTMR

Article 1(k), Articles 18 and 27 EUTMIR

7.1 Fixing of costs

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

7.2 Enforcement of the decision on costs

Article 110 EUTMR

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

7.2.1 Conditions

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

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

7.2.2 National authority

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

The Office publishes such designations in its Official Journal.

7.2.3 Proceedings

1. The interested party must request the competent national authority to append the enforcement order to the decision. For the time being, the conditions on languages of the requests, translations of the relevant parts of the decision, fees and the need for a representative depend on the practice of the individual Member States and are not harmonised but are considered on a case-by-case basis.
   The competent authority will append the order to the decision without any other formality beyond the verification of the authenticity of the decision. As to wrong decisions on costs or fixing of costs, see 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).

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 4

Language of proceedings

Table of Contents

1 Introduction

Article 146 EUTMR

Articles 25 and 26 EUTMIR

Article 24 EUTMIR

Article 98 CDR

Articles 80, 81 and 83 CDIR

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

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

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.

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:

- 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 3.10.2.

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.

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.

6 Invariable Nature of the Language Rules

The Regulations allow certain choices to be made from among the available languages in the course of the proceedings (see above) and, during specified periods, a different language to be chosen as the language of proceedings for opposition, cancellation and design invalidity. However, with those exceptions, the language rules are invariable. In

particular, the first and second languages may not be amended in the course of the proceedings.

7 Translations and their Certification

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

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

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

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

8 Non-compliance with the Language Regime

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

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 5

Parties to the Proceedings and Professional representation

Table of Contents

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,

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, as amended by Decision No EX-23-3 of the Executive Director of the Office of 4 April 2023.

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;

- 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 as amended by Decision No EX-23-3 of the Executive Director of the Office of 4 April 2023.

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 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 as amended by Decision No EX-23-3.

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.

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).

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 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.([1])

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.

1 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.

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 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 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.

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.

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).

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 respective industrial property office of the Member State concerned. The certificate must be completed by the respective industrial property office.

Fast-track: 12/03/2025

4.3.4 Exemptions

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

The Executive Director of the Office may grant exemption from the requirement to be a national of a European Economic Area (EEA) Member State, provided that the requestor demonstrates that they are a 'highly qualified professional'. The Executive Director may also grant an exemption from the requirement of having regularly acted as a representative in trade mark matters for at least 5 years, provided that the requestor demonstrates that they have 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 the 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 to 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 of 5 years' experience are limited to cases where the qualification to act as a representative in trade mark or design matters was not achieved before the central industrial property office concerned, but was acquired in another way, for the equivalent period of at least 5 years.

   This exemption can only be requested where the requestor is entitled to act in EEA Member States in which no 'special professional qualification' is required.

   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 requestor (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

Exemptions from the EEA nationality requirement are limited to requestors that comply with the requirements of Article 120(2)(b) and (c) EUTMR, namely that they have their place of business in the EEA, and are entitled under national law to represent third parties before the national industrial property office.

An exemption from the EEA nationality requirement may only be granted where the requestor is a 'highly qualified professional' (Article 120(4)(b) EUTMR).

The term 'highly qualified professional' is not defined in the EUTMR or the EUTMIR, but the Court has described it as referring to a 'specialist with particularly advanced qualities, skills, abilities or knowledge' in trade mark matters (25/09/2024, T-727/20 RENV, Kirimova, EU:T:2024:646, § 30).

The status of 'highly qualified professional' is independent of the entitlement requirement under Article 120(2)(c) EUTMR and has no connection with the conditions necessary for fulfilling that requirement. Accordingly, the particularly advanced qualities, skills, abilities or knowledge do not need to be acquired in the exercise of the necessary entitlement to represent under Article 120(2)(c) EUTMR. Furthermore, they may be acquired within the EEA or in a third country, before or after obtaining the entitlement to represent (25/09/2024, T-727/20 RENV, Kirimova, EU:T:2024:646, § 34).

The onus is on the requestor to demonstrate (with supporting evidence) that they meet the 'highly qualified professional' requirement.

A request for exemption, which is not subject to any time limit, may be filed using the form provided for this purpose available on the EUIPO website. All the arguments and evidence the requestor deems necessary to support the claims made must be submitted together with the request. The Office will decide on the basis of that request.

Decisions of the Executive Director rejecting the exemption requested can be appealed before the General Court of the European Union under 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.

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.

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).

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 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).

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.

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 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.

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 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 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.

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 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.

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.

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 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.

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.

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

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.

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.

Fast-track: 31/03/2024

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.

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)** .

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.

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).

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

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).**

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.

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)** .

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.

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

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.

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)** .

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.

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.

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.

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).**

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).**

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.

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)** .

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'** are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Romania (Law no. 30/2024 for the amendment of Law no. 84/1998 regarding trademarks and geographical indications, of Law no. 129/1992 regarding the protection of designs and models, as well as Law no. 64/1991 regarding patents, published in the Official Gazette of Romania, Part I no. 173 of March 4, 2024), 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.

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.

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**

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)** .

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.

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**).

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.

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**).

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 6

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

Table of Contents

1 Introduction

The Office will remedy errors attributable to it, in particular, in the following ways:

- revocation of decisions and cancellation of entries in the Register (Article 103 EUTMR, see paragraph 2);
- correction of errors in the publication of an EUTM application (Article 44(3) EUTMR, see paragraph 3);
- correction of errors in decisions, EUTM registrations or the publication of EUTM registrations (Article 102 EUTMR, see paragraph 4).

This section deals with the assessment and procedural aspects of the provisions above.

The distinction between revocation under Article 103 EUTMR and correction under Article 102(1) EUTMR relates to the nature of the errors. The types of errors covered by Article 103 EUTMR require a new analysis of the case while those covered by Article 102(1) EUTMR do not. As to the effects, revocation annuls a decision whereas the correction of errors does not affect the validity of the decision and does not open a new appeal period (28/05/2020, T-724/18 and T-184/19, AUREA BIOLABS (fig.) / Aurea et al., EU:T:2020:227, § 28-30; 22/09/2021, T-169/20, Marina Yachting, EU:T:2021:609, § 111).

The Office's interpretation of Article 44(3) EUTMR is that it covers errors that are so obvious they do not require a new assessment or analysis. These corrections pursuant to Article 44(3) EUTMR can only apply to the publication of EUTM applications whereas corrections under Article 102(1) EUTMR can apply to decisions and to the registration and publication of EUTM registrations.

This section does **not** apply to registered Community designs (RCDs).

2 Revocation of decisions and cancellation of entries in the Register

2.1 General remarks

Article 103 EUTMR
Article 70 EUTMDR

Article 103 EUTMR provides for the cancellation of entries in the Register and revocation of decisions containing obvious errors attributable to the Office.

The revocation or cancellation procedure may be initiated by the Office on its own motion or at the request of one of the parties to the proceedings.

A decision can only be revoked by another decision. Likewise, cancellations of entries in the Register also require a revocation decision. Decisions on revocation/cancellation are made by the department that made the entry or took the decision.

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

2.2 Assessment

2.2.1 Nature of the error

The Office must verify, firstly, whether the decision or entry contains an obvious error.

An error is obvious if it **does not allow the operative part of that decision or that entry to be maintained without a new analysis**, which will be carried out subsequently by the department that took that decision or made that entry (22/09/2021, T-169/20, Marina yachting, EU:T:2021:609, § 111).

Obvious errors are not limited to procedural errors (22/09/2021, T-169/20, Marina yachting, EU:T:2021:609, § 110). Therefore, 'obvious error' covers flagrant procedural violations, an obvious distortion of facts or obvious errors of substance, which require a new analysis of the case.

The following is a non-exhaustive list of examples of obvious errors giving rise to erroneous decisions that may be revoked or erroneous entries that may be cancelled.

- The opposition has been found admissible even though some admissibility requirements were not met (18/10/2012, C-402/11 P, Redtube, EU:C:2012:649).
- A decision refusing the EUTM application on absolute grounds is notified in the absence of any observations from the applicant in reply to the objection before the expiry of the time limit for submitting observations, or ignoring the observations that the applicant submitted on time.
- The EUTM is refused on absolute grounds, ignoring a valid subsidiary claim to prove acquired distinctiveness or ignoring the evidence of acquired distinctiveness duly submitted (Article 7(3) EUTMR).
- The EUTM is refused by the Opposition Division, ignoring a request for proof of use or without dealing with the issue of proof of use.
- The opposition is rejected on the basis of lack of proof of use but the opponent was not expressly given a time limit for submitting proof of use, or proof of use was submintted on time and was overlooked.
- The opposition decision was rendered while the proceedings were suspended or interrupted or, more generally, while a time limit for one of the parties was still running.

- Any breach of the right to be heard (observations not forwarded to the other party when that party should have been given a time limit to reply pursuant to the Regulation or Office practice).
- When closing a file due to a limitation of the contested EUTM application or a withdrawal, the Office has issued a decision on costs, overlooking an agreement on costs between both parties that was on file at the time.

2.2.2 One-year deadline

The Office must verify, secondly, whether 1 year has passed since notification of the decision or entry in the Register.

Article 103(2) EUTMR provides that revocation/cancellation must be effected within 1 year of the date on which the erroneous decision was taken or the erroneous entry was made in the Register, after consultation with the parties to the proceedings and any proprietor of rights to the EU trade mark in question that are entered in the Register. The revocation/cancellation is deemed effected on the date of notification of the decision on revocation/cancellation, regardless of any appeal.

Any request for revocation/cancellation received after 1 year of the date on which the erroneous decision was taken or the erroneous entry was made in the Register will be rejected as inadmissible because Article 103(2) EUTMR provides that revocation/cancellation must be effected within 1 year of the relevant error. Likewise, even if a request has been received within that time limit, it will be rejected if the Office cannot carry it out before the expiry of the 1-year period, irrespective of the reason why the request could not be effected on time.

In light of the fixed time limit, any party to the proceedings should inform the Office about the obvious error identified without any delay, particularly where an adverse party needs to be consulted. In any event, irrespective of the time remaining before the 1-year deadline, the Office will always initiate the procedure for revocation/cancellation if it becomes aware of an obvious error requiring revocation or cancellation, and will do its utmost to conduct an expedient procedure to conclude on time.

2.2.3 Decision against which an appeal is pending

An appeal filed against a decision containing an obvious error is not an obstacle to revocation. Article 103(4) EUTMR provides that the appeal proceedings will become devoid of purpose upon revocation of an erroneous decision. The department competent to decide on the revocation will inform the Boards of Appeal promptly if it is considering a revocation and will also inform them of the outcome of its deliberations.

2.3 Procedure – distinction between where only one party or more parties are affected

The procedure where only **one party** is affected is described in paragraph 2.3.1.

One example is when the EUTM applicant's observations have not been taken into account when refusing the EUTM application.

If revocation of a decision is likely to affect **more than one party**, the procedure described in paragraph 2.3.2 must be followed. For example, where the Office overlooked a request for proof of use, more than one party will be affected by the revocation of a decision in opposition proceedings.

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

2.3.1 Procedures when only one party is affected

a) Error found by the Office

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

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

If the party does not agree to revocation or cancellation, a formal decision has to be taken, which is subject to the usual requirements described in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 5.

b) Error notified by the affected party

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

2.3.2 Procedure when more than one party is affected

a) Error found by the Office

If the Office itself finds that an error has been made, it informs the parties of its intention to revoke the decision / cancel the entry and sets a time limit of 1 month for observations.

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

If the party that benefited from the error does not agree to the revocation/cancellation, a reasoned decision has to be taken, which is subject to the usual requirements

described in the Guidelines Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 5.

b) Error notified by one of the parties

If the party adversely affected by an error informs the Office in writing, it must be determined whether revocation/cancellation is justified and possible. If so, the Office notifies the party that benefited from the error of its intention to revoke/cancel and sets a time limit of 1 month for observations (sending a copy of the notification to the first party for information purposes).

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

If the party that benefited from the error does not agree to revocation or cancellation, a reasoned decision has to be taken, which is subject to the usual requirements described in the Guidelines Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 5.

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

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

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

3 Correction of errors in the publication of the application

Article 44(3) and (4) EUTMR

Article 46(2) EUTMR

Article 11 EUTMDR

3.1 General remarks

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

Article 44(3) and (4) EUTMR refer to the correction of errors attributable to the Office in the publication of the application.

The following are examples of errors that can be corrected:

- The EUTM has been published for less classes than applied for.
- Sign 'x' was applied for but the publication refers to sign 'y'.
- The list of goods and services published is wrong.

3.2 Procedure

Where the publication of the application contains an **error attributable to the Office**, the Office must, of its own motion, or at the request of the applicant, correct the error and publish the correction.

There is no **time limit** for corrections pursuant to Article 44(3) and (4) EUTMR.

Where the correction is requested by the applicant, the request must contain:

- the file number of the EUTM application;
- the name and address of the applicant or the ID number and the applicant's name;
- the indication of the element to be corrected and a corrected version of the element.

If the Office verifies the existence of an error, the applicant is notified of the correction and the EUTM and the correction are published.

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

Republication for opposition purposes will be required where a correction involves changes to the representation of the mark or a broadening of the list of goods and

services already published. For other corrections, republication must be decided on a case-by-case basis.

For more information on the effect of republication on pending opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 7.1.2.

The above paragraphs refer to the correction of errors attributable to the Office only. For amendments to an EUTM application on the applicant's own initiative, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.

4 Correction of errors in decisions, EUTM registrations or the publication of EUTM registrations

Article 55 EUTMR

Article 102 EUTMR

4.1 General remarks

According to Article 102(1) EUTMR, the Office will correct any **linguistic errors or errors of transcription** and **manifest oversights** in its decisions, or **technical errors** attributable to it in registering an EUTM or in publishing the registration.

For the difference between these corrections under Article 102(1) EUTMR and corrections of the publication of the application under Article 44(3) EUTMR or the revocation/cancellation of entries under Article 103 EUTMR, see paragraph 1.

4.2 Assessment

As there is no **time limit**, errors under Article 102(1) EUTMR can be corrected any time.

It must be verified whether the error to be corrected is a **linguistic error or an error of transcription, a manifest oversight or a technical error**.

Corrections in decisions under Article 102(1) EUTMR are limited to obvious formal mistakes which affect the form of the decision only, not its scope or substance. This is true of errors which are so obvious that no wording other than the corrected wording could be intended and errors which do not justify invalidating or revoking the decision marred by them. This includes errors that constitute incongruous elements in a decision which is otherwise consistent and unambiguous (28/05/2020, T-724/18 & T-184/19, AUREA BIOLABS (fig.) / Aurea et al., EU:T:2020:227, § 29, 33-34). Even the dictum of a decision may be corrected if no wording other than that resulting from the correction could have been envisaged.

By contrast, the adoption of a revocation decision is justified by errors which do not allow the operative part of the decision at issue to be maintained without a new

analysis. This is true of errors affecting the award of costs, those relating to the right to be heard or those concerning the obligation to state reasons (28/05/2020, T-724/18 & T-184/19, AUREA BIOLABS (fig.) / Aurea et al., EU:T:2020:227, § 30).

The nature of the errors and oversights that can be corrected pursuant to Article 102(1) EUTMR means that an appeal against a decision is not an obstacle to the correction of the decision by the first instance department that adopted it. Nevertheless, the relevant department will inform the Boards of Appeal promptly if it is considering a correction, as well as informing them of the outcome of its deliberations (i.e. whether any correction has been made) so this can be taken into account in the appeal proceedings.

Additionally, Article 102(1) EUTMR refers to errors in the **registration of an EUTM or in any entry made in the Register** in accordance with Article 111(2) and (3) EUTMR or a Decision of the Executive Director pursuant to Article 111(4) EUTMR, and to errors in the publication of those entries in the Register. As set out above, the correction of these errors should not require a new analysis of the case.

The following are examples of errors that can be corrected:

- the EUTM is registered without taking a limitation into consideration;
- the EUTM is registered despite having been previously withdrawn;
- the EUTM is registered despite a deficiency, e.g. in the payment of the application fees;
- the EUTM is registered despite a pending or successful opposition;
- the dictum of the decision lists the wrong classes of goods or services even though the correct ones are stated in the body of the decision;
- the dictum of the decision based on Article 8(1)(b) EUTMR upholds the opposition whereas the body of the decision finds that the opposition is unfounded;
- where, in the case of a partially upheld opposition, based on Article 8(1)(b) EUTMR, the dictum does not list all the goods/services for which the EUTM should be rejected according to the comparison in the body of the decision.

4.3 Procedure

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

When the correction of errors in the registration of an EUTM or in the publication of the registration is requested by the proprietor, the request must contain:

- the registration number of the EUTM;
- the name and address of the proprietor or the ID number and the proprietor's name;
- the indication of the element to be corrected and the element in its corrected version.

Unlike in revocation, Article 102 EUTMR does not establish any procedural steps. A corrigendum will be sent to the affected party/parties. The accompanying letter must briefly explain the corrections.

a) Correction in registrations

Corrections to entries in the Register must be published pursuant to Article 102(3) EUTMR and Article 116(1)(a) EUTMR. Corrections of errors in Register entries are published in subsection C.10. of the Bulletin.

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

b) Correction in decisions

If a correction is made in a decision, the corrigendum is made publicly available in the Office's eSearch Case Law database.

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

c) Correction in notifications other than decisions

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 7

Revision

Table of Contents

1 General principles

Article 66 EUTMR
Article 55 CDR
Article 69 EUTMR Article 58 CDR

Article 34(1) EUTMDR

Revision only occurs in *ex parte* cases, that is to say, those that involve only one party.

Revision enables the first-instance decision taker to rectify a decision that has been appealed 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 department that took the decision.

Revision proceedings can take place where an appeal has been lodged against a decision for which the Boards of Appeal are competent.

The Boards of Appeal send the appealed decision back to the department that took the decision in order for it to be revised.

A decision can only be rectified within 1 month of receipt of the statement of grounds of appeal.

Since revision requires a pending appeal, it will not take place when the appeal is withdrawn before a decision on revision could be taken.

2 Revision of decisions

Article 69 EUTMR

Article 58 CDR

Articles 23(1), 33 and 34(1) EUTMDR

Article 35(1) and (2) CDIR

In *ex parte* proceedings, once the Board of Appeal considers the appeal to be admissible, the Registrar of the Boards of Appeal sends the appeal documents (the notice of appeal and the statement of grounds) to the department that adopted the appealed decision for revision.

The department concerned examines whether the appealed decision should be rectified or not.

Since the revision may result in a rectification of the appealed decision only where the appeal is admissible and well founded, the competent department must also verify that the following conditions are met:

- the appeal is admissible (Article 23(1) EUTMDR or Article 35(1) and (2) CDIR); and
- the appeal is 'well founded' within the scope of the appeal, on substantive or procedural grounds.

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

The appealed decision will not be rectified when the appellant attempts to remedy deficiencies for the first time before the Boards of Appeal.

2.1 No rectification of the appealed decision

Article 69(2) EUTMR

Article 58(2) CDR

When the competent department concludes that the conditions for rectifying the appealed decision are not met, and at the latest upon expiry of 1 month from the receipt of the statement of grounds of appeal, it remits the case to the Boards of Appeal without any comment or statement.

No formal decision refusing the rectification of the appealed decision is issued and the proceedings will continue before the Boards of Appeal.

2.2 Rectification of the appealed decision

Article 69(1) and (2) EUTMR

Article 33(b) and 34(1) and (2) EUTMDR

Article 58(1) and (2) CDR

Articles 37 CDIR

When the competent department concludes that the conditions for rectifying the appealed decision are met, it will inform the Board of Appeal thereof without delay.

In addition, the following procedural actions will be taken:

- within 1 month of the Board of Appeal submitting the statement of grounds of the appeal to the competent department, this department must take a decision repealing the appealed decision in its entirety ('decision on rectification');
- the competent department takes a new decision on the merits either together with the decision on rectification or at a later stage;
- the Board of Appeal decides on the closure of the appeal.

2.2.1 Contents of the decision on rectification

Depending on the reasons found by the competent department to rectify the appealed decision, the outcome may lead to one of the following situations.

1. A new interaction with the party (for example, because a request for an extension of time had been overlooked).

   In this case, the Office will set new time limits for the party, and a new decision on the merits will be adopted at a later stage.
2. A new decision on the merits taken directly without any interaction with the party (for example, if evidence of acquired distinctiveness was on file but was not addressed in the appealed decision).

   In this case, the new decision on the merits can be issued either together with the decision on rectification or at a later stage.

Taking this into account, the decision on rectification must contain the following:

1. the reasons that justify the rectification of the initial decision;
2. a statement that the initial decision (i.e. the appealed decision) is deemed to have been repealed;
3. a statement establishing the procedural situation of the examination proceedings, that is:
   - a statement that a decision on the merits will be taken at a later stage, and a statement that the decision on rectification can only be appealed together with the later decision on the merits;

     or
   - a statement that a new decision on the merits of the case replacing the initial decision is herewith adopted, and a statement that an appeal can be filed within 2 months;
4. in design proceedings, an order to reimburse the appeal fee.

The new decision on the merits may set the proceedings back and allow for a new examination, which may go beyond the scope of the initial appeal. The new decision on the merits may result in the same outcome.

2.2.2 Communication of the decision on rectification

Once the decision on rectification is taken, the competent department must promptly inform the Registrar of the Boards of Appeal. The Board of Appeal decides on the closure of the appeal. The appeal fee will be reimbursed.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 8

Restitutio in integrum

Table of Contents

1 General principles

Article 104 EUTMR Article 67 CDR

Parties to proceedings before the Office may have their rights reinstated (*restitutio in integrum*) if they were unable to meet a time limit vis-à-vis the Office despite taking all due care required by the circumstances, provided that the failure to meet the time limit had the direct consequence, by virtue of the provisions of the Regulations, of causing a loss of rights or loss of means of redress (28/06/2012, T-314/10, Cook's, EU:T:2012:329, § 16-17; 26/09/2017, T-84/16, widiba (fig.) / ING DiBa (fig.) et al., EU:T:2017:661, § 27).

Observing time limits is a matter of public policy, and serves the requirements of legal certainty and the need to avoid any discrimination or arbitrary treatment in the administration of justice. Derogations from these rules can only be made in exceptional circumstances (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 34). 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; 16/06/2015, T-585/13, JBG Gauff Ingenieure (fig.) / Gauff et al., EU:T:2015:386, § 25).

Restitutio in integrum is only available upon application to the Office and is subject to the payment of a fee (see paragraph 3.7).

The Office is under no obligation to inform or advise a party to the proceedings before it to pursue any particular legal remedy, including *restitutio in integrum* (06/10/2021, T-635/20, Juvéderm vybrance, EU:T:2021:656, § 36).

2 Criteria for granting *restitutio in integrum*

There are two requirements for *restitutio in integrum*:

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 unpredictable and involuntary.

If the party is represented, the representative's failure to take all due care is attributable to the party that they represent (19/09/2012, T-267/11, VR, EU:T:2012:446, § 40;

16/12/2020, T-3/20, Canoleum / Marmoleum, EU:T:2020:606, § 45). The question whether the party has exercised the necessary vigilance to mitigate the errors of its representative causing the loss of a right cannot excuse the representative (19/09/2012, T-267/11, VR, EU:T:2012:446, § 41; 31/01/2019, T-604/17, REJECTION OF RESTITUTIO IN INTEGRUM (RECORDAL), EU:T:2019:42, § 21).

1. **Examples of where the 'all due care' requirement has been fulfilled**

   Failure to deliver mail

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

   Errors of the Office and their repercussions

   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).

   Force majeure

   Circumstances such as natural disasters and general strikes are regarded as fulfilling the requirement for all due care. Another unpredictable event may be when all the employees of a law firm representing the party concerned are factually prevented from accessing the physical files and, consequently, from taking any further action to observe the time limit (14/06/2021, R 735/2021-4, MOOI MUSEUM OF OPTICAL ILLUSIONS (fig.) / MUSEUM OF ILLUSIONS (fig.) et al., § 15).

2. **Examples of where the 'all due care' requirement has not been fulfilled**

   a. **Errors in administration or organisation**

      Delegation of tasks

      The party to proceedings who delegates the administrative tasks relating thereto must ensure that the person chosen provides the necessary guarantees to ensure the tasks are properly carried out (13/09/2011, T-397/10, Sport shoe, EU:T:2011:464, § 25).

      Management of files

      Errors in the management of files caused by the representative's employees or by the computerised system itself are predictable. 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; 26/09/2017, T-84/16, widiba (fig.) / ING DiBa (fig.) et al., EU:T:2017:661, § 39; 21/04/2021, T-382/20, Table knives, forks and spoons, EU:T:2021:210, § 31-34).

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

Workload

The exceptional workload and organisational strains to which the applicants claim they were subject are, in principle, irrelevant (20/06/2001, T-146/00, Dakota, EU:T:2001:168, § 62; 20/04/2010, T-187/08, Dog, EU:T:2010:150, § 34).

Absence of a key member of the accounts department

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

Delay in instructions

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 / closure of business

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).

b. **Duties and errors of professional representatives**

Legal errors and misunderstandings

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). 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; 28/04/2020, R 2391/2019-5, STAHL (fig.)).

Consideration of time limits

The careful consideration of the time limits is part of the basic duties of professional representatives, including the careful checking of the facsimile transmission report after submitting documents (26/06/2017, R 748/2017-2, GIBBS S3 Business, Technology and Community Partner (fig.) / STHREE et al., § 43). A clerical error in entering a deadline cannot be regarded as an exceptional or unpredictable event (31/01/2013, R 265/2012-1, KANSI / Kanz).

Calculation of time limits

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). The correct calculation of the deadline is governed by the EUTMR and the EUTMDR, and the party cannot justify its non-compliance with the time limit by the fact that the deadline was not displayed in the Office's online database (03/09/2019, R 500/2019-5, minimon (fig.) / Minimensch, § 36).

The same rule applies to Community designs where the relevant provisions are in the CDR and the CDIR.

c. **Clerical mistakes**

Deletion of a deadline

The deletion of a deadline by an assistant is not unpredictable (28/06/2010, R 268/2010-2, ORION).

Bank transfer error

An error in the transmission of the data to a bank or an error made by a bank in the execution of the transfer to the Office cannot be regarded as exceptional or unforeseeable. The party to the proceedings before the Office is under an obligation to anticipate those circumstances and to take the necessary precautions to ensure that the payment is made within the established time period (13/10/2021, T-732/20, Crystal, EU:T:2021:696, § 29-31).

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.

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

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.

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 (*ex parte*, *inter partes* and appeal proceedings).

This includes proceedings under the EUTMR and proceedings concerning registered Community designs under the CDR. The relevant provisions do not differ materially, however the requirements for translations differ (see paragraph 3.8).

Therefore, unless specifically excluded by Article 104(5) EUTMR or Article 67(5) CDR, *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.

Unlike the EUTMR for EUTMs, the CDR does not provide for continuation of proceedings for RCDs.

For *restitutio* in renewal proceedings see paragraph 3.13.

3.2 Parties

Article 104 EUTMR

Article 67 CDR

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

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

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

Articles 35(1) and 38(2) CDR

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

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

3.4 Time limits excluded from *restitutio in integrum*

Article 104(5) EUTMR Article 67(5) CDR

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

Articles 41(1) and 67(5) CDR Article 8(1) CDIR

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

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

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

Article 104(2) and (5) EUTMR Article 67(2) and (5) CDR

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

- a time limit of 1 year for filing the application for *restitutio in integrum* as from 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 application for *restitutio in integrum* is filed late, it will be rejected as inadmissible.

3.7 Fees

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

The applicant must also pay the fee for *restitutio in integrum* within the same time limit (see paragraph 3.6 above).

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.

If all the conditions are not met, 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).

3.8 Languages and translations

Article 146 EUTMR

Article 24 EUTMIR

Article 98 CDR

Article 80 and 81 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 EUTM registration procedure, this is the correspondence language indicated in the application; in the RCD registration procedure this is the language used for filing the application or the second language indicated by the applicant in the application; in the opposition procedure, it is the language of the opposition procedure; in the RCD invalidity procedure, it is the language of the invalidity procedure (Article 98(4) CDR); and in the renewal procedure, it is any of the Office's five languages.

Where the application for *restitutio in integrum* is not filed in the language of the proceedings, the applicant must submit a translation into that language within one month of the date of submission of the application (Article 146(9) EUTMR and Article 81(1) CDIR). If a translation into the language of proceedings is not submitted on time, the application for *restitutio in integrum* will be rejected as inadmissible.

Evidence in support of the application for *restitutio in integrum* may be filed in any official language of the European Union. The rules for translation in EUTM proceedings differ from those in RCD proceedings. Where evidence in EUTM proceedings was not submitted in the language of the proceedings, the Office may require a translation into that language (Article 24 EUTMIR). In proceedings concerning RCDs, the Office may require that a translation be supplied, within a time limit specified by it, in the language of the proceedings or, at the choice of the party to the proceedings, in any language of the Office (Article 81(2) CDIR).

If a translation is not submitted on time, the evidence will be disregarded.

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. The application must set out which deadline has been missed.

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. For example, if the deadline to submit observations has been missed, the observations must be submitted with the request for *restitutio in integrum*. A request for extension of the time limit will not be accepted as the 'omitted act'. If the payment of a fee has been missed, that fee must be paid together with the *restitutio in integrum* request.

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

3.10 Competence

Article 104 EUTMR Article 67 CDR

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

3.11 Publications

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

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

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

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

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

Articles 66 and 67 EUTMR

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

The decision on *restitutio in integrum* will be taken, if possible, in the decision terminating the proceedings. The Office may also adopt a separate decision on the application for *restitutio in integrum*. In both cases, the applicant for *restitutio in integrum* can appeal the refusal of its request for *restitutio in integrum* together with an appeal against the decision terminating the proceedings.

The decision to grant *restitutio in integrum* cannot be appealed.

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

3.13 *Restitutio in integrum* in the event of renewals

The principles mentioned in this chapter also apply to requests for *restitutio in integrum* in renewal proceedings, but with the following particularities.

Party to the proceedings

In renewal proceedings, authorised persons within the meaning of Article 53(1) EUTMR or Article 13(1) CDR who missed the renewal deadline are party to the renewal proceedings and may, therefore, request *restitutio in integrum* in their own name (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 26, 31-32).

Time limits

Where a renewal deadline was missed and the loss of rights was notified to the EUTM proprietor, the day of this notification is the point in time from which a diligent proprietor has 2 months to comply with the requirements set out in Article 104 EUTMR or Article 67 CDR (30/09/2010, C-479/09 P, DANELECTRO, EU:C:2010:571, § 36, 42; 28/09/2021, R 396/2021-2, Netcomponents, § 28). The notification of the loss of right to the proprietor is also valid for an authorised person (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 47 et seq.).

If the applicant fails to submit the request for renewal or to pay the renewal fee, the 1-year period after expiry of the missed time limit (Article 104(2) EUTMR or Article 67(2) CDR) starts on the day on which the protection ends, and not on the date the further 6-month time limit set out by Article 53(3) EUTMR or Article 13(3) CDR expires.

Fees

The exception to the general rule that an individual fee must be paid for each application for *restitutio in integrum* also applies to renewals (see paragraph 3.7). When a party has missed renewing multiple EUTM registrations, it can file a single request for *restitutio in integrum* for the renewal of all of its marks and pay a single *restitutio in integrum* fee.

The fees must be paid together with the *restitutio in integrum* request. The fee amount depends on which time limit the party asks to have reinstated: the basic period for renewal, the grace period for renewal or the deadline for late payment within the meaning of Article 180 EUTMR or Article 7(3) CDFR.

Indication of which period should be reinstated

In its application for *restitutio in integrum*, the applicant must clearly state if it is seeking reinstatement of the basic period, the grace period or the period within the meaning of Article 180 EUTMR or Article 7(3) CDFR.

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.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 9

Enlargement

Table of Contents

1 Introduction

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

Article 209 EUTMR contains the relevant provisions relating to enlargement and European Union trade marks. These provisions were introduced into the Regulation pursuant to the 2004 enlargement process (at that time Article 142a CTMR) and have remained unchanged during successive enlargement processes. The only modification in the text of the Regulation is the addition of the names of the new Member States.

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

2 Rules Concerning Examination

2.1 Automatic extension of EUTMs to new Member States

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

2.2 Pending EUTM applications

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

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

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

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

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

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

2.3 Distinctiveness acquired through use

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

2.4 Bad faith

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

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

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

2.5 Conversion

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

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

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

2.6 Other practical consequences

2.6.1 Professional representation

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

2.6.2 First and second language

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

2.6.3 Translation

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

2.6.4 Seniority

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

- **Example 1:** The same person files an EUTM application on 01/04/1996 and a national trade mark application in Romania on 01/01/1999. After 01/01/2007 (Romania's date of accession), the seniority of the Romanian national trade mark application may be claimed.
- **Example 2:** The same person owns an international registration designating the EU on 01/01/2005 and subsequently designating Romania on 01/01/2006. After 01/01/2007, the seniority of that Romanian designation may be claimed even though the designation itself is later than the IR designating the EU. This is because the extended EUTM takes effect from the accession date of the new Member State (in this case 01/01/2007).

2.6.5 Search

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

3 Rules Concerning Oppositions and Cancellations

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

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

2. An exception to this (transitional) rule is contained in Article 209(3) EUTMR regarding oppositions. An EUTM application filed within the 6 months preceding the accession date may be challenged by an opposition based on a national right existing in a new Member State at the date of the accession, provided that this right
   a. has an earlier filing or priority date, and
   b. was acquired in good faith.
3. The filing date and not the priority date is the decisive element for determining when an EUTM application can be opposed on the basis of an earlier right in a new Member State. In practice, the abovementioned provisions have the consequences illustrated in the following examples with reference to the accession of Croatia (01/07/2013).
   a. An EUTM application filed before 01/01/2013 (the priority date is irrelevant in this context) cannot be opposed or declared invalid on the basis of a national earlier right in a new Member State under any circumstances.
   b. An EUTM application with a filing date between 01/01/2013 and 30/06/2013 (i.e. **during the 6 months prior to the date of accession**), may be opposed by a Croatian trade mark, provided that the filing or priority date of the Croatian trade mark is earlier than the filing or priority date of the opposed EUTM application and the national mark was applied for in good faith.
   c. An EUTM application with a filing date of 01/07/2013 or later may be opposed or declared invalid on the basis of a trade mark registered in Croatia if that mark has an earlier filing or priority date under the normal rules. Acquisition in good faith is not a condition. This applies to all national marks and earlier non-registered rights filed or acquired in a new Member State prior to accession.
   d. An EUTM application with a filing date of 01/07/2013 or later but with a priority date before 01/07/2013 may be opposed or declared invalid on the basis of a national trade mark registered in Croatia if that mark has an earlier filing or priority date under the normal rules.
   This transitional exception is limited to the right to file an opposition and does not include the right to file an application for cancellation based on relative grounds. This means that once the abovementioned period of 6 months has expired without an opposition having been lodged, the EUTM application cannot be challenged any more by an opposition or by an application for a declaration of invalidity.
4. According to Article 209(5) EUTMR , the use of an EUTM with a filing date prior to the date of accession of a new Member State, may be prohibited pursuant to Articles 137 and 138 EUTMR on the basis of an earlier national trade mark registered in the new Member State where the latter has a filing or priority date prior to the date of accession and was registered in good faith.
   The above provision also applies to:

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

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

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

      The earlier national mark must have been put to genuine use in the territory in which it is protected during the 5 years preceding the filing or priority date [2] of the contested EUTM application. In this regard, it is immaterial whether the use relates to a period during which the State concerned was already a Member State of the European Union. In other words, the proof of use may also relate to a period prior to the date of accession (in the case of Croatia before 01/07/2013).

   b. **The earlier mark is an EUTM**
      Where the owner of the earlier EUTM can prove use only in the territory of a new Member State or several new Member States, since the obligation of use relates to the period of 5 years preceding the filing or priority date [3] of the contested EUTM application, use in a new Member State (or several new Member States) can only be taken into account if the State concerned was a Member State of the European Union at the date of filing or the priority date of of the contested EUTM application (Article 47(2) EUTMR requires use *'in the Union').* Before their

2 For oppositions and invalidity applications filed before 23/03/2016, the relevant date is the publication date.
3 For oppositions and invalidity applications filed before 23/03/2016, the relevant date is the publication date.

accession dates, the new States do not constitute 'Member States of the Union'; therefore, it is not possible to prove use *'in the Union'.*

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

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

Annex 1

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 10 Evidence

Table of Contents

1 Introduction

Articles 96 and 97 EUTMR

Articles 49 to 55 EUTMDR

Articles 64 and 65 CDR

Articles 42 to 46 CDIR

Common Communication on the Common Practice on Criteria for Assessing Disclosure of Designs on the internet published on 1 April 2020 (CP10)

Common Communication on the Common Practice on Evidence in Trade Mark Appeal Proceedings: Filing, Structure and Presentation of Evidence, and the Treatment of Confidential Evidence on 31 March 2021 (CP12)

This section of the Guidelines deals with the general provisions on the means of evidence for all proceedings before the Office. The principle that prevails in EU law is that of the 'unfettered evaluation of evidence'. This means that the **only relevant criterion** for the purpose of assessing the probative value of evidence lawfully adduced **relates to its credibility** (13/05/2020, T-288/19, IPANEMA (fig.) / iPANEMA (fig.) et al., EU:T:2020:201, § 41).

Establishing the credibility or probative value of evidence is fundamental in proceedings before the Office. This part of the Guidelines aims to assist parties in understanding how the probative value of evidence can be enhanced and what to avoid when adducing evidence.

According to Article 97 EUTMR, Article 51 EUTMDR, Article 65 CDR and Article 43 CDIR, the **means of giving and obtaining evidence** in all proceedings before the Office include:

- hearing the parties;
- requests for information;
- producing documents and items of evidence;
- hearing witnesses;
- expert opinions;
- 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 *in situ* by the Office.

The most frequently used means of evidence is the submission of documents and items. In accordance with CP10 and CP12, the Office accepts, for example, the following:

- invoices and other commercial documents;
- catalogues, advertisements and marketing campaigns;

- publications;
- samples;
- official and public documents;
- witness statements;
- sworn or affirmed statements (affidavits);
- market surveys
- extracts from social media.

Different types of evidence may be submitted to establish the same fact or requirement and the parties are free to choose the means of evidence they submit (26/06/2019, T-651/18, HAWKERS (fig.) / HAWKERS (fig.) et al., EU: T:2019:444, § 35). To assess the probative value of a document, it is particularly necessary to consider from whom it originates, the circumstances in which it came to be, the person to whom it is addressed and whether the document appears sound and reliable (06/11/2014, T-463/12, MB, EU:T:2014:935, § 53).

For information on specific aspects of the various proceedings, the rules in the relevant sections of these Guidelines should be consulted. The following table contains **examples** of claims to be proved relating to trade marks or designs.

Table 1: EUTM proceedings

Claim	Aim of evidence	Cross reference
Descriptive mark	To demonstrate that a trade mark consists/does not consist exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services for which registration is sought or the trade mark is registered, in the relevant territory.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Descriptive trade marks (Article 7(1)(c) EUTMR) Part D, Cancellation, Section 2, Substantive provisions, 3 Absolute Grounds for Invalidity

Non-distinctive mark	To demonstrate that the trade mark is/is not devoid of any distinctive character. Such distinctiveness can be assessed only by reference, first, to the goods or services for which registration is sought or the trade mark is registered and, second, to the relevant public's perception of that sign, in the relevant territory.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 3, Non-distinctive trade marks (Article 7(1)(b) EUTMR) Part D, Cancellation, Section 2, Substantive provisions, 3 Absolute Grounds for Invalidity
Acquired distinctiveness	To demonstrate that a mark has acquired a distinctive character in the relevant geographical area regarding the goods or services for which registration is requested or for which the mark is registered, following the use which has been made of it.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 14, Acquired distinctiveness through use (Article 7(3) EUTMR)
Enhanced distinctiveness	To demonstrate that a mark has obtained enhanced distinctiveness, in the relevant geographical area, as a consequence of the use which has been made of it. The evidence of enhanced distinctiveness acquired through use should also refer to the relevant goods and services.	Part C, Opposition, Section 2, Double Identity and likelihood of confusion, Chapter 5, Distinctiveness of the earlier mark, 2 Assessment of Distinctiveness of the earlier mark, 2.3 Examination of enhanced distinctiveness Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation
Reputation	To demonstrate that a mark is known by a significant part of the public concerned, in the territory in which reputation is claimed, for the relevant goods or services covered by that trade mark.	Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation

Well-known mark	To demonstrate that a mark is well known in the Member State(s) concerned, in the sense in which the words 'well known' are used in Article 6*bis* of the Paris Convention. The mark should be well known in the relevant sector of the public for the particular goods and services.	Part C, Opposition, Section 1, Opposition proceedings, 4.2.4.1 Well-known marks Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation
Proof of use / genuine use	To demonstrate that within a specific period the proprietor has put the trade mark to genuine use in the Member State(s) in connection with the relevant goods or services in respect of which it is registered. The evidence should consist of indications concerning the place, time, extent and nature of use of the trade mark.	Part C, Opposition, Section 7, Proof of Use

Table 2: RCD proceedings

Claim	**Aim of evidence**	**Cross Reference**
Disclosure	To demonstrate that an earlier design that is identical or produces the same overall impression on the informed user as the contested design 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).	Design Guidelines, Examination of design invalidity applications, 5.7.1 Disclosure of earlier design
Features of appearance solely dictated by the technical function of the product	To demonstrate that no consideration other than the technical function of the design played a role in designing a given feature or all the features of a design (Article 8(1) CDR).	Design Guidelines, Examination of design invalidity applications, 5.5.2.2 Appropriate evidence of functionality

2 How to submit evidence

2.1 General requirements and recommendations

According to Article 55(2) EUTMDR on the examination of **written evidence in EUTM proceedings**, any documents or other items of evidence must be contained in an annex to the submission. The submission must also include an index detailing the evidence in the annexes, namely:

- the number of the annex where the item is contained,
- a short description of each item of evidence,
- the number of pages of each document or item (if applicable), and
- the page number of the submission where the document or item is mentioned.

The following is an example of an admissible **index**:

Annex No.	**Description**	**Pages**	**Page where the evidence is mentioned**
Annex 1	Survey 2021	1 - 30	Observations, page 1
Annex 2	Catalogues 2022	31 - 45	Observations, page 5

The annexes must be numbered consecutively and in accordance with the index. The annexes themselves should be named on their first page and have page numbers that continue from one annex to the next. The submission must refer to the number of the annex in accordance with the index (e.g. Annex 1) when it is mentioned in the text.

As regards evidence on **data carriers**, technical specifications are established in Decision No EX-22-7 of the Executive Director of the Office of 29 November 2022 on technical specifications for annexes submitted on data carriers (for further information see the Guidelines,Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.4, Data carriers).

Best Practice: in the interests of the parties, the Office and higher instances, the Office recommends the following approach when structuring evidence and submissions to facilitate the processing and handling of the files:

1. the parties should limit their submissions strictly to items of evidence that are relevant to the case and to the ground/argument in question and avoid extraneous or superfluous materials;
2. if documentation is sent in separate batches, each batch should be numbered, have page numbers and show the total number of pages in each batch;
3. even if annexes are submitted at different times in the same proceedings, they should be numbered consecutively to avoid confusion due to repetition of numbering;

4. photographs should be submitted instead of physical specimens (e.g. containers, packaging, etc.) unless the relevant features cannot be reproduced visually;
5. no original documents or items should be sent by mail as the Office will not return any originals but keep them on file (Article 115 EUTMR, Article 76 CDR);
6. to facilitate scanning, items sent by mail must not be stapled, bound or placed in folders and where items must be sent in duplicate for forwarding to the other party, they should be clearly identified as such;
7. if several trade marks, goods and services or dates are displayed in a single item of evidence, the submission should clearly indicate which is the relevant information for the proceedings in question;
8. if colour is of relevance to the proceedings, the evidence should be submitted in colour (for example, a registration certificate for a mark in colour or evidence of genuine use);
9. if the case involves a range of different earlier marks, grounds, multiple classes, or long lists of goods and services, the party should explain in its submission which issue each item of the evidence supports (e.g. Annexes A-D concern proof of use of the earlier mark 1 for Class 25, or for goods falling under the broad category of clothing in Class 25, Annexes E-F show reputation/well-known character/enhanced distinctiveness of earlier mark 2 for Class 25, Annex G concerns proof of use of earlier mark 3 for the retail sale of clothing in Class 35).

There are no specific legal provisions regarding the format of documents or items of evidence for **RCD proceedings** although the technical specifications established for data carriers in Decision No Ex-22-7 also apply. In any event, the information mentioned above is also recommended for evidence provided in RCD proceedings (see the Guidelines on the Examination of design invalidity applications, paragraph 3.10.2, Facts, evidence and arguments).

2.1.1 Deficiencies

A **deficiency** in **EUTM proceedings** may be raised according to Article 55(3) EUTMDR when:

1. no clear index can be identified;
2. the index does not indicate the number of annexes, a description of each item of evidence or the page number of the submission where the item of evidence is mentioned; or
3. the evidence is not structured in consecutively numbered annexes and/or these are not structured in accordance with the index.

Furthermore, a document or item may not be taken into account where the Office cannot clearly establish to which ground or argument it relates. The relevant decision of the Office will identify items of evidence not taken into account for failing to comply with Article 55 EUTMDR.

For annexes submitted on data carriers, even if the annex complies with the technical specifications of Articles 3 and 4 of Decision No EX-22-7 a deficiency may be raised if the material is illegible.

If a corrected annex is not resubmitted, the original annex is deemed not to have been submitted (see Articles 5 and 6(b) of that decision; for further information on data carriers, see the Guidelines,Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.4, Data carriers).

2.2 Specific requirement in inter partes proceedings

In *inter partes* proceedings, where a communication with annexes is submitted **by post or courier**, the party must submit as many copies of the annexes as there are parties to the proceedings (Article 64 EUTMDR). This also applies to design proceedings (see Examination of design invalidity applications, 3.1 Form of the application).

The Office, however, does not require duplicates when the annexes submitted by post or courier consist of paper documents (such as loose sheets of evidence) that are smaller than or equal to A3 size. This is because these documents are scanned into the electronic file and transmitted to the other party by electronic means of communication. In exceptional cases where the other party is not a user of electronic communication, the Office will produce a paper copy or a copy on a data carrier and forward it by post or courier.

Annexes submitted by post or courier must, however, be submitted in duplicate when:

- the annex consists of **paper documents larger than A3 size;** or
- the annex does **not consist of paper** (e.g. physical items of evidence such as product samples). This also includes evidence on **data carriers** because, although the content of the data carrier is uploaded into the electronic file, a copy is nevertheless required as a safeguard (for further information on data carriers, see the Guidelines,Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.4 Data carriers).

Annexes submitted by **electronic means** do not require duplicates (for further information on the technical requirements for communication by electronic means, see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.1 [Communications...] via the User Area (electronic means)).

In *inter partes* proceedings relating to **EUTMs**, where duplicate annexes are required but not provided, the annexes in question will not be considered.

However, in *inter partes* proceedings relating to **RCDs**, the Invalidity Division may invite the party to file a missing duplicate within a specified deadline.

The Office will base its decision only on evidence on which both sides have had an opportunity to submit observations. Therefore, evidence submitted properly will be communicated to the other party and the Office may set a time limit to reply.

2.3 Confidentiality

A party may request, when submitting a document or at a later stage, that all or part of it be kept confidential (as long as no request for an inspection of files is pending). For further information on confidentiality of documents submitted, see the Guidelines:

Time limits	Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.6 Confidentiality
Inspection of files	Part E, Register operations, Section 5 Inspection of files, 5.3.1 Parts of the file for which the party concerned expressed a special interest in keeping confidential

3 References to other proceedings

Article 115(3) EUTMR

Article 64(2) EUTMDR

Article 76 CDIR

Decision No EX-23-12 of the Executive Director of the Office of 15 December 2023 on the keeping of files and the inspection of files

Decision No EX-22-7 of the Executive Director of the Office of 29 November 2022 on technical specifications for annexes submitted on data carriers

3.1 Reference to documents or evidence in other proceedings before the Office

Parties may incorporate evidence into proceedings before the Office by referring to documents or evidence submitted in **other proceedings**.

Such references are acceptable when the party clearly identifies the documents referred to. They must indicate the following:

1. the type and, where applicable, number of the proceedings (e.g. opposition, cancellation proceedings, appeal, transfers etc.);
2. the title of the document and, where relevant, the number of the Annex where the document was contained;

3. the number of pages in the document; and
4. the date the document was sent to the Office.

Example of an acceptable reference: 'the statutory declaration that was submitted to the Office on 12/12/2020 as Annex I in opposition proceedings B 123 456, together with exhibits 1 to 8, consisting of 200 pages'.

> **Best practice**: References to submissions and evidence in other cases should be made via **a separate document or separate section at the beginning of the observations**. This ensures visibility and prevents proceedings being unnecessarily delayed. If this recommendation is not followed, the party risks the reference being overlooked. This may lead to reopening and delaying the proceedings.

When the party only makes a general reference to documents or evidence submitted in other proceedings, the Office will invite the party to provide a clear and precise indication of the documents or evidence referred to within a given time limit. If this is not done, the general reference **will not be taken into account**.

A party may refer to all or some of the annexes provided previously on a data carrier, but they must also submit a copy of the annexes with the same content on a data carrier that complies with the **current** technical specifications, as detailed in Decision No EX-22-7.

Material submitted in other proceedings that was not kept in an electronic format may have been destroyed according to Article 115(3) EUTMR and Decision No EX-23-12. In this case, the party referring to such evidence will be invited to submit the previous evidence again with duplicates if necessary (see the Guidelines, Part A, General rules, Section 10, Evidence, paragraph 2.2, Specific requirement in *inter partes* proceedings). If this evidence is resubmitted on a data carrier, it must comply with Decision No EX-22-7. Where the evidence is resubmitted via the User Area, Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means should be followed.

If reference is made to a procedure in a different language, a translation may be necessary if the content of the evidence is not self-explanatory (for further information on the translation of evidence in *inter partes* proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 4.3.3, Translation of supporting documents other than observations and the Design Guidelines, Examination of design invalidity applications, 3.10.2 Facts, evidence and arguments).

3.2 References to national office and court decisions, and decisions of the Office

Parties may refer to findings in previous decisions of national offices and courts, or to previous Office decisions.

When a party refers to **national office or court decisions**, the Office is not bound by those decisions. Nevertheless, national courts have a thorough knowledge of the specific characteristics of their Member State, in particular, the marketplace reality in

which goods and services are marketed and the customer perception of signs, and this may be relevant for the assessment made by the Office. Maximising the relevance of these decisions before the Office will require sufficient information, in particular, about the facts and evidence on which the decision was based as well as an explanation as to why the party believes the national decision is relevant to the outcome of the case.

When the party refers to **decisions of the Office (EUIPO)**, it should explain in detail why it believes that the cases are comparable and how the previous decision may influence the outcome (e.g. same legal issue, same or comparable signs, same parties). In any event, the Office is not bound to come to the same conclusion as in its previous decision. It must examine each case on its own merits. Regarding the obligations to state reasons, see the Guidelines,Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 1, Adequate reasoning). For additional information on references to national decisions or decisions of the Office, see:

General principles of EU Law	Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 3, Other general principles of EU law
Acquired distinctiveness	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 14 Acquired distinctiveness through use (Article 7(3) EUTMR), paragraph 8.1.5, Prior registrations and acquired distinctiveness
Likelihood of confusion	Part C, Opposition, Section 2, Double identity and likelihood of confusion, Chapter 6, Other factors, paragraph 5, Prior decisions by EU or national authorities involving conflicts between the same (or similar) trade marks
Reputation	Part C, Opposition, Section 5, Trade marks with reputation (Article 8(5) EUTMR), paragraph 3.1.4.4, Means of evidence

4 Specific means of evidence

4.1 Online evidence

Considering the development of information technologies and the growing importance of e-commerce, social media and other online platforms in business, evidence originating from the internet is accepted as a valid means of evidence.

Where internet evidence is submitted in EUTM proceedings, most claims require the party to show online interaction rather than mere internet presence. This can be done by providing data related to the geographic distribution of website visitors, pages viewed during website visits, duration of website visits and completed transactions.

Mere reference to a website

The nature of the internet can make it difficult to establish the content available there and the date or period this content was made available to the public because:

- not all web pages mention when they were published;
- when updated, they do not provide an archive of the material previously displayed or a record that accurately indicates what was published on a given date;
- web pages may be live when evidence is submitted but disabled at a later date when the Office needs to refer to them.

Therefore, a mere reference to a website (even if by a direct hyperlink) **is not valid** . However, the Office accepts a reference to a database recognised by the Office for substantiation purposes in inter-partes trade mark proceedings (seePart C, Opposition, Section 1, Opposition proceedings, 4.2 Substantiation).

Date of the online evidence

The **date of the information** is to be shown, for example, when it was posted on social media or when the evidence was printed.

The Office can establish the date of the evidence from the internet if:

- the website provides time-stamp information relating to the history of modifications applied to a file or web page (as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs);
- a web page screenshot bears a given date (20/10/2021, T-823/19, Bobby pins, EU:T:2021:718, § 26, 32 and 42); or
- information relating to a web page's updates is available from an internet archiving service, such as the Wayback Machine (19/11/2014, T-344/13, FUNNY BANDS / FUNNY BANDS, EU:T:2014:974), but it is recommended that archive printouts are corroborated by other evidence from alternative sources.

Example:

Case No	Comment

19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN (fig), EU:T:2022:654, § 80 and 82-84	Evidence of the presence and promotion of a brand on the internet may play a role in assessing distinctive character acquired through use of a trade mark. In that case, the proprietor of the mark at issue must demonstrate that the relevant websites and, in particular, the web pages on which that mark was displayed, promoted or marketed, target or are consulted by a significant part of the relevant public in the Member States in which the mark is, *ab initio*, devoid of inherent distinctiveness. To prove the intensity of use of the trade mark on the websites in question, the mark's proprietor must demonstrate, for example, by submitting a traffic analysis report for that website during the relevant period, that a significant number of internet users in the Member State concerned, consulted or interacted with the content of the website in question. For instance, data relating to the number of visits to that website, comments or other forms of web user interactions in the Member State may be taken into consideration. In addition, evidence showing that search engine and social network algorithms display non-sponsored search results which, for search terms describing the trade mark at issue, systematically return the trade mark proprietor's goods, may also be relevant. On the other hand, the mere fact that a website on which the mark at issue was promoted is accessible in certain Member States is not sufficient to demonstrate that a significant part of the relevant public in those Member States has been exposed to that mark.

4.1.1 Printouts from websites

In principle, extracts from **editable websites**, such as the online encyclopedia Wikipedia or similar sources, cannot be considered to be probative on their own. This is because their content may be amended at any time and, in certain cases, by any visitor, even anonymously (23/09/2020, T-738/19, Wi-Fi Powered by The Cloud (fig.), EU:T:2020:441, § 38-39; 16/10/2018, T-548/17, ANOKHI (fig.) / Kipling (fig.) et al., EU:T:2018:686, § 131, and the case-law cited therein).

Evidence of this kind should be corroborated with information from other sources, such as scientific studies, extracts from technical publications, press articles or statements from professionals, traders and consumers (see 01/02/2023, T-319/22, aquamation, EU:T:2023:30, § 28, and the case law cited therein).

Depending on what must be proven, printouts or screenshots from **non-editable websites** will also need to be supported by corroborating evidence in particular situations. For example, when the evidence's accuracy is contested by the other party, where relevant data is missing, or where evidence is drawn from non-editable websites owned by the interested party or does not seem reliable for other reasons.

However, when the extracts from websites are used to prove the disclosure of designs, they can be sufficient to the extent that they show when the content was published and that it was made publicly available.

4.1.2 Website analytics reports

Website analytics reports showing the website traffic may be a useful way to show that the website has been visited and by whom it has been visited (see 19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2022:654, § 80, 82). The analytics reports may contain information such as page views, a page hit, the duration of page visits, and the geographical region of the user. This information may be relevant, for example, when proving genuine use, acquired distinctiveness or reputation.

Examples:

Case No	**Comment**
14/12/2017, T-304/16, BET365, EU:T:2017:912, § 66	A high ranking in terms of visitors can help to establish that a mark, which is repeated in the name of the party's website (or otherwise prominently appears on such website), has acquired distinctive character through use in the countries concerned.
19/11/2014, T-344/13, FUNNY BANDS / FUNNY BANDS, EU:T:2014:974, § 29	The intensity of the alleged use of the rights relied on may be shown by, inter alia, a certain number of visits to the site, the emails received via the site or the volume of business generated.

4.1.3 Social media

Social media is understood as websites and applications that facilitate social networking. Evidence from social media can be used to show the relevant public's recognition of the mark or its use or to show the disclosure of a design.

Social media may be an independent source of evidence for information created by the platforms themselves (e.g. the account's date of creation or information on the modification of the account/page name), which cannot be controlled or altered by the owner of a page/account (24/10/2017, T-202/16, coffee inn (fig.) / coffee in (fig.) et al., EU:T:2017:750, § 51).

Content created by users can be changed, however, and it is recommended to:

- submit a printout or a screenshot;
- ensure that the evidence makes reference to the relevant trade mark and goods and services, or that it displays a clear image of the design and indicates the relevant date and disclosure source;
- ensure that the post's publication date and URL address is shown;
- include file analytic reports (see paragraph 4.1.2); and
- provide information on the purpose and the social media website's main characteristics.

Regarding references to influencer marketing, it is recommended to submit:

- information on the influencer and followers (e.g. the geographical location of the influencer/followers and related advertising expenditure); or
- the results of a followers campaign (e.g. the sales volume on a country-by-country basis made via a dedicated influencer URL address or code).

For online advertising, see paragraph 4.8.1.

4.2 Affidavits

Overview

Statements in writing sworn, affirmed or having a similar effect under the law of the Member State in which the statement is drawn up (affidavits) are valid means of evidence (Article 97(1)(f) EUTMR, Article 65(1)(f) CDR).

Before the Office, their evidential value is assessed in light of EU law, not the laws of a Member State (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 33; 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 53).

The Office will assess the probative value of the information the affidavit contains, together with any other supporting evidence, considering:

- the document's origin, including the capacity of the person giving the evidence (see paragraphs4.2.1 and 4.2.2);
- the circumstances of its preparation;
- to whom it is addressed;
- whether the content makes sense and seems reliable; and
- the relevance of the contents of the statement to the particular case.

(07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42; 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 50; 18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 26).

Affidavits containing detailed and specific information and that are supported by other evidence have a higher probative value than general and abstract statements.

The Office makes a distinction between affidavits coming from the party or the sphere of influence of the party (e.g. employees) and affidavits from an independent source. That said, an affidavit must be considered under the circumstances of the particular case and its reliability cannot be automatically denied, even if drawn up by the interested parties or their employees (16/12/2020, T-3/20, Canoleum / Marmoleum, EU:T:2020:606, § 51-52; 28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 30; 05/10/2022, T-429/21, ALDIANO, EU:T:2022:601, §52).

The fact that affidavits from different sources are made according to a **predetermined draft provided by the interested party** does not in itself affect their probative value (16/09/2013, T-200/10, Avery Dennison, EU:T:2013:467, § 73).

The relevance of the contents of the affidavit to the particular case contributes to its probative value. For example, the affidavit will be less effective if it only generally refers to 'the trade marks of the party' instead of to the specific mark(s) in question (see for acquired distinctiveness 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 83-84; 04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230).

4.2.1 Affidavits by the party or its employees

Affidavits coming from the sphere of the interested party are generally given less weight because the perception of a party involved in the case may be affected by personal interests in the matter.

Consequently, this evidence must be treated as indicative and should be corroborated by other evidence (21/11/2012, T-338/11, PHOTOS.COM, EU:T:2012:614, § 51; 28/05/2020, T-615/18, D (fig.) / D (fig.) et al., EU:T:2020:223, § 61; 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 51; 18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 29).

An assessment should be made, therefore, of whether the content of the affidavit is sufficiently supported by the other evidence (or vice versa).

4.2.2 Affidavits made by third parties

Affidavits from **independent third parties** have more probative value than those from entities that have links with the interested party (19/01/2011, R 1595/2008-2, FINCONSUM ESTABLECIMIENTO FINANCIERO DE CREDITO / FINCONSUMO (fig.), § 31).

Evidence from suppliers or distributors of the party concerned generally have less weight, but their degree of independence of the latter will heavily influence the probative value (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 54-56).

Example:

Case No	Comment
19/10/2022, T-275/21, chequerboard pattern (fig), EU:T:2022:654, § 99	'It should be recalled that sworn statements, particularly from chambers of commerce and industry, other professional associations or independent bodies, or from public authorities, relating to the relevant public's perception of a trade mark, constitute "direct" evidence of the acquisition of distinctive character through use, in particular where they emanate from independent sources and their content is sound and reliable (see, to that effect, judgments of 7 June 2005, Lidl Stiftung v OHIM – REWE-Zentral (Salvita), T-303/03, EU:T:2005:200, paragraph 42; of 28 October 2009, BCS v OHIM – Deere (Combination of the colours green and yellow), T-137/08, EU:T:2009:417, paragraphs 54 to 56; and of 29 January 2013, Manual tile-cutting machine, T-25/11, not published, EU:T:2013:40, paragraphs 74 and 75).'

4.3 Opinion polls and market surveys

Opinion polls and market surveys ('the surveys') constitute primary evidence to show the recognition of a trade mark among consumers. They are, in particular, used in proceedings concerning acquired distinctiveness, enhanced distinctiveness or reputation of a trade mark.

When assesssing the probative value of the surveys, the Office will consider the:

- survey provider;
- target public, the sample size and representation of the results;
- method used, the set of questions, and the circumstances under which the survey was carried out; and
- dates.

4.3.1 Survey provider

The party must submit information that allows the Office to determine the provider's expertise and impartiality, since these have an impact on the probative value.

The survey provider's choice is up to the parties but the Office **recommends** using independent research institutes, companies or other independent experts who have

the relevant knowledge and experience to properly understand the survey's purpose, reliably structure and conduct the survey, and to interpret the results.

Example:

Case No	Comment
27/03/2014, R0540/2013-2, Shape of a bottle (3D) § 49	Serious doubts were cast on the surveys' source, reliability and independent nature owing to the use of the company logo of the well-known GfK company. The surveys did not seem to be carried out by the company, as the applicant argued, but rather by a person who, according to their own declaration, was only 'a former director of GfK'. It was not clear how a former GfK employee could be authorised to use that company's logo on every page of the surveys when they were now 'an independent market research consultant'.

4.3.2 Target public, sample size and representativeness of the results

The target public or sample size must be representative of the entire relevant public and must be selected randomly (29/01/2013, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 88). Therefore, the criteria applied for selecting the sample are decisive for establishing whether it is representative and whether the survey is valid.

The party must submit information that allows the Office to assess whether the sample chosen was representative (09/09/2020, T-187/19, Colour Purple -2587C (col), EU:T:2020:405, § 101). The number and profile (sex, age, occupation and background) of the sample must be submitted, to allow the Office to evaluate whether the results of the survey are representative of the relevant consumers of the goods in question (general public, specific groups of consumers within the general public, or professionals).

A survey will lack probative value where there are no checks on who replied to the questions (21/03/2018, R 1852/2017-4, V V-WHEELS (fig.) / VOLVO (fig.) et al., § 49). In such cases, the real profile of the sample cannot be determined. Additionally, the results of the survey must show whether the percentages reflected in the results correspond to the total number of persons questioned or only to those who replied.

A representative sample does not necessarily require a large number of interviewees. It depends on the type of relevant consumer concerned (01/06/2011, R 1345/2010-1, Fukato Fukato (FIG. MARK) / DEVICE OF A SQUARE (FIG. MARK) et al., § 58). The survey should explain how the sample size was chosen for the relevant consumer. There is a particular danger that small samples may be unreliable for general-use goods that target the general public (09/09/2020, T-187/19, Colour Purple -2587C

(col), EU:T:2020:405, § 100-101). However, small samples could be representative for certain groups of professionals or more specialised goods and services.

Examples:

Case No	Comment
15/03/2011, R 1191/2010-4, Más Kolombiana…y qué más!! / COLOMBIANA LA NUESTRA (fig), § 23.	A survey was submitted to demonstrate that the earlier sign was well-known to the Spanish public for aerated waters. However, the interviewees were carefully selected on the basis of their origin, that is, Colombians resident in Spain. This is only a very small part of the population living in Spain, and the information was inconclusive.
01/06/2011, R1345/2010-1, Fukato Fukato (fig.) / DEVICE OF A SQUARE (fig.) et al., § 58.	In principle, samples of 1 000-2 000 interviewees are considered sufficient, provided they are representative of the type of consumer concerned. The opponent's opinion poll was based on a sample of 500 interviewees. It was found insufficient considering the services for which reputation was claimed (among others, scientific and technological services).
09/09/2020, T-187/19, Colour Purple -2587C (col), EU:T:2020:405, § 100-101.	The patient surveys were only carried out in 10 EU Member States in relation to pharmaceutical preparations and inhalers. Only 50-200 patients were interviewed in each of the Member States. In light of the market shares held by the applicant in each Member State, the numbers of patients interviewed appeared to be much too low to be reliable. The same is true with regard to the professional public, given that less than 0.1 % of general practitioners in the Member States participated in the surveys.

4.3.3 Method used, form of questions and circumstances

The method and circumstances under which the survey was carried out (e.g. face to face, over the phone, on the internet) impact its probative value (12/07/2006, T-277/04, Vitacoat, EU:T:2006:202, § 38).

The probative value of surveys also heavily depends on how the questions are formulated (24/10/2018, T-261/17, SALOSPIR 500 mg (fig.) / Aspirin et al., EU:T:2018:710, § 68). The questions must be formulated correctly in an open and

unassisted manner so they are neutral and representative. They must not lead the participant to a certain answer (13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 79).

The party must submit the complete list of questions included in the questionnaire to allow the Office to determine if open and unassisted questions were used (08/04/2011, R 0925/2010-2, 1 CLEAN! 2 FRESH! 3 STRONG! (fig.) / FRESH & CLEAN et al. § 27). The party must also show how the questions were asked and ordered.

The survey must be carried out in a manner that considers the objective circumstances in which the marks at issue are present, or may be present, on the market (24/10/2018, T-261/17, SALOSPIR 500 mg (fig.) / Aspirin et al., EU:T:2018:710, § 63-64). The aim is to show the target public's spontaneous association or recognition of the mark in question as seen inthe examples below.

The probative value of the survey will be lesser where it cannot be ruled out that an unobjective formulation of questions facilitated the association of that mark with a particular undertaking in the minds of those questioned (19/06/2019, T-307/17, DEVICE OF THREE PARALLEL STRIPES (fig.), EU:T:2019:427, § 131) or when the sequencing of the questions leads to unusual speculation on the core issue (02/03/2022, T-125/21, Eurobic/ BANCO BiG BANCO DE INVESTIMENTO GLOBAL (fig.) et al., EU:T:2022:102, § 42-45).

For further guidance on structuring surveys and wording questions, see the Common Practice on Evidence in Trade Mark Appeal Proceedings: Filing, Structure and Presentation of Evidence, and the Treatment of Confidential Evidence (CP 12) (on pages 36-38). CP12 recommends a three-step test for determining the respondents' ability to spontaneously recognise a test object as coming from one specific commercial source.

Examples:

Case No	Comment

02/03/2022, T-125/21, Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL (fig.) et al., EU:T:2022:102, § 42-45.	The interviewees were informed in the earlier questions that the 'Banco Bic' bank had changed its trade mark to 'EuroBic' and, in response to that information, they were asked to choose from among three options. That question and the seven subsequent questions raised, in a leading manner, the question of the link between the trade marks. It is only later in the survey that the interviewees were asked to express their views for the first time on the link between the marks 'Banco BiG' and 'EUROBIC'. It was held that the persons questioned could have been clearly influenced by the eight preceding questions, and by the approach seeking to support, initially, the link between 'EuroBic' and 'Banco BIC' then influence the answers to the questions on comparing the signs 'EUROBIC' and 'BANCO BiG'.
08/04/2011, R 925/2010-2, 1 CLEAN! 2 FRESH! 3 STRONG! (fig.) / FRESH & CLEAN et al., § 27.	This case shows thatsurvey participants' levels of prompted and spontaneous recognition vary. According to the extracts from the 2001 survey in Italy, although the level of 'prompted recognition' stood at 86 %, the rate of 'spontaneous recognition' was only 56 %. This survey failed on other grounds, as there was no indication of the questions put to the target public. This made it impossible to determine whether the questions were genuinely open and unassisted. Further, it failed to state for which goods the trade mark was known.

28/05/2020, T-677/18, GULLÓN TWINS COOKIE SANDWICH (fig.) / OREO et al., EU:T:2020:229, § 92-93.	The survey used a representation of the three-dimensional biscuit in which the verbal element 'Oreo' that usually appears in its centre had been removed. The Court found that the removal of the name for the purpose of the survey was precisely the reason why the results of the survey were more reliable for proving the recognition of the three-dimensional shape. According to the Court, it was appropriate that the survey did not indicate that the three-dimensional shape was a trade mark, precisely to verify whether, when encountering that image, the public identified a specific commercial origin, and therefore identified it as a trade mark.

4.3.4 Dates

The survey must indicate the period in which it was conducted. This period must be relevant for the proceedings. For example, if the survey intends to show distinctiveness acquired through use at the date of filing of the EUTM application, the probative value is likely to vary depending on the proximity to the relevant filing date or priority date (12/07/2006, T-277/04, Vitacoat, EU:T:2006:202, § 38-39).

4.4 Audits

Audits of a party's undertaking usually comprise data on financial results, sales volumes, turnover and profits. They may provide useful information about the intensity of a mark's use. However, such evidence will only be pertinent if it specifically refers to the goods or services traded under the mark in question, rather than to the party's activities in general.

Audits may be carried out on the initiative of the party itself or be required by company law or financial regulations. In the former case, the same rules as for surveys apply. The status of the entity conducting the audit and the reliability of the applied method will be decisive for determining its credibility. The probative value of official audits and inspections is as a rule much higher, since they are usually conducted by a state authority or recognised body of auditors on the basis of generally accepted standards and rules.

4.5 Annual reports on economic results and company profiles

This type of evidence includes all kinds of internal publications containing information about the history, activities and prospects of the party's company, or more detailed figures about turnover, sales and advertising.

Usually, evidence originating from the party concerned is mainly intended to promote its image. Therefore, the relevant information should be treated with caution, especially if it mainly consists of estimates and subjective evaluations.

However, the probative value may be enhanced where publications are circulated to clients and other interested parties, and contain objectively verifiable information. This is the case, for example, when they have been compiled or revised by independent auditors (as is often the case with annual reports).

4.6 Invoices and other commercial documents

All kinds of commercial documents may be grouped under this heading, such as invoices, order forms, delivery notes, distribution and sponsoring contracts, samples of correspondence with clients, suppliers or associates. Documents of this kind may provide a variety of information on use of a mark (e.g. intensity of use, geographical extent and duration of use). Such evidence can be primary evidence (e.g. to prove that a mark is genuinely used) or secondary evidence (e.g. an indication of the degree of recognition of a mark).

If these documents include sensitive commercial information, the party can either redact specific data in the document or claim confidentiality of the entire document upon a reasoned request (for further information on confidentiality, see the Guidelines, Part A, General rules, Section 1, Means of communication, Time limits, 3.1.6 Confidentiality).

Invoices are one of the most common means of evidence in EUTM proceedings concerning proof of use (for further information on use of trade marks, see the Guidelines, Part C, Opposition, Section 7, Proof of use, 6.1 Use as a trade mark, and for general considerations on use, seePart C, Opposition, Section 7, Proof of use).

They must be carefully assessed in conjunction with the evidence as a whole. Invoices must refer to the particulars that are relevant for the proceedings to have probative value (e.g. who issued the invoice, to whom it was addressed, the goods or services, representation of the mark in question and date when they were issued).

Codes used in invoices

The invoices should allow a connection to be made between the sign used on the invoiced goods or services. Invoices may not explicitly list the goods or services or the trade mark representation, but they can allow for these to be deduced by including product numbers or codes. The party must explain such codes and numbers. Cross referencing invoices with catalogues or other depictions of the goods, such as

packaging, can allow a clear link to be made with the sign in question (27/04/2022, T-181/21, SmartThinQ (fig.) / SMARTTHING (fig.), EU:T:2022:247, § 91; 22/03/2023, T-408/22, SEVEN SEVEN 7 (fig.) / Seven, EU:T:2023:157, § 29-31, 33).

These pieces of evidence assessed in combination allow conclusions to be made, such as which goods or services were sold under which trade mark, in what quantities and when.

Best Practice: When submitting invoices as evidence, parties should highlight the goods and services which are relevant for the proceedings to ensure that they can be correctly identified. This is of particular importance when the invoices may include other trade marks or goods and services which are not relevant to the proceedings.

Exemplary character - extrapolating

Invoices relate to individual transactions but the full context must be considered. Although selected invoices will not reflect the entire sales of a company, they can, however, indicate that more sales took place during the relevant period (07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773, § 43). For example, if there are gaps in the sequential numbering of invoices provided, this demonstrates other invoices were emitted that might help in corroborating a party's statements, or other accounting information, as to volumes or continuity of sales.

Addressee

A range of invoices dated in the relevant period helps define the time span and frequency of sales, and together with the addressee information, provides important indications on geographical extent of use. When redacting information, a party must ensure that the addressee information still clearly indicates the relevant territory (whether a country, region or city, etc.).

Company name and trade mark representation

In some invoices there may be clear use of the trade mark in question, while in others a company name may be used or both. For example, where the trade mark is systematically placed in invoice headers as the first element above the company name, use of the sign goes beyond merely identifying the company and refers to the commercial origin of the services provided. The layout of the invoices therefore allows a close connection to be made between the sign and the invoiced services (03/10/2019, T-666/18, ad pepper (fig.), EU:T:2019:720, § 82). The use of a sign as a company name does not exclude its use as a trade mark (26/04/2023, T-546/21, R.T.S. ROCHEM Technical Services (fig.) / ROCHEM MARINE (fig.), EU:T:2023:221, § 61).

4.7 Certifications, rankings and awards

Certifications attesting the quality or other characteristics, rankings and awards granted by public authorities or official institutions – such as chambers of commerce and industry, professional, sporting or cultural associations and societies and consumer organisations – can be used as evidence.

These specialised sources are usually independent of the parties. They attest facts in the course of their official tasks. Therefore, the reliability of such evidence is generally high.

Conversely, prizes and awards offered by unknown entities, or on the basis of unspecified or subjective criteria, should be given less weight.

The probative value also depends on the content of the documents.

Examples:

The fact that the party is a holder of an ISO 9001 quality certificate or a royal warrant does not automatically mean that the sign is known to the public. It only means that the party's goods meet certain quality or technical standards or that it is a supplier to a royal house.

Case No	Comment
25/01/2011, R 0907/2009-2, O2PLS / O2 et al.	The many brand awards won by the mark were, together with the huge investment in advertising and the number of articles published in different publications, considered an important part of the evidence for reputation (para. 9(iii) and para. 27).
2023/01/18, R 0218/2020-4, Aalto / Aalto ps et al.	Undoubtedly, the opponent has, according to the evidence submitted, received high rankings and accolades worldwide in relation to its wines. For instance, the 'AALTO PS 2013' wine was ranked among the top 5 *grandes pagos de España* in 2015 (para. 75). However, the fact the 'AALTO' wines received very positive acclaim by professionals in the field and may even be among the highest quality wines in the world does not necessarily mean that the earlier marks have achieved recognition among a significant part of the … public (para. 76).

4.8 Promotional materials and publications

4.8.1 Catalogues, advertisements and marketing campaigns

A party may submit promotional materials, including:

- price lists and offers;
- advertising reach and spend;
- material related to online shops;

- promotions on company websites;
- website archives;
- television spots and video/audio files;
- business correspondence and business cards; and
- materials from fairs and conferences.

Advertising material often supports facts indicated by other items of evidence.

It is important to have indications on the impact of the advertising. This may be shown by reference to the amount of promotional expenditure, the nature of the promotional strategy, and the media used.

For example, when demonstrating recognition of a sign, advertising on a nationwide television channel or in a famous periodical should be given more weight than regional or local campaigns. High audience or circulation figures will help to establish the reputation of the trade mark. Likewise, sponsoring prestigious sporting or cultural events may be a further indication of intensive promotion. This is because the considerable investment this involves is mainly due to the size or nature of the audience reached.

Example:

Case No	**Comment**
19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2022:654, § 64	evidence relating to trade mark advertising campaigns in the press, on the radio or on television, as well as excerpts from catalogues and brochures containing images of goods bearing that mark, may constitute indications that the contested mark has acquired distinctive character through use (see 14/12/2017, T-304/16, BET365, EU:T:2017:912, § 71).

As regards online advertising efforts, they may also be used as evidence by providing data concerning ‘paid search’ and ‘paid social advertising’. These refer to the practice of paying for an advertisement space in search engines or on social media platforms.

For further information on advertising evidence see:

Acquired distinctiveness	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Acquired distinctiveness through use (Article 7(3) EUTMR), 8.1.2 Market share and 8.1.3 Advertising and turnover expenses
Reputation	Part C, Opposition, Section 5, Trade marks with reputation (Article 8(5) EUTMR), 3.1.3.6 Promotional activities

Proof of use	Part C, Opposition, Section 7, Proof of use, 6.1.2.5 Use in advertising

4.8.2 Publications

A party may submit publications, including:

- press notes;
- newspapers;
- magazines;
- printed materials;
- extracts from guides, books, encyclopedias, dictionaries or scientific papers.

In EUTM proceedings, the probative value of publications to show the success of the relevant mark depends on whether they are merely promotional or are the result of independent, objective research. If articles appear in prestigious publications with rigorous quality standards or are written by independent professionals, they may have a high probative value.

Case No	**Comment**
16/12/2010, T-345/08 & T-357/08, Botolist /Botocyl, confirmed 10/05/2012, C-100/11 P, § 54	The very existence of articles in a scientific publication or the general-interest press constitutes a relevant factor in establishing the reputation of the products marketed under the trade mark BOTOX among the general public, irrespective of the positive or negative content of those articles.

10/03/2011, R 0555/2009-2, BACI MILANO (fig.) / BACI & ABBRACCI, § 35	The earlier trade mark's reputation on Italy was proved by the copious documentation the opponent submitted. This included, inter alia, an article from Economy revealing that in 2005 the 'BACI & ABBRACCI' trade mark was one of the 15 most counterfeited fashion brands in the world; an article published in Il Tempo on 05/08/2005, in which the 'BACI & ABBRACCI' trade mark is mentioned alongside others – including Dolce & Gabbana, Armani, Lacoste and Puma – as being targeted by counterfeiters; an article published in Fashion on 15/06/2006, in which the trade mark is defined as 'a true market phenomenon'; publicity campaigns from 2004 to 2007, with testimonials from entertainment and sports celebrities; and a market survey conducted by the renowned independent agency Doxa in September 2007, from which it emerges that the trade mark is 'top of mind' in the fashion sector for 0.6 % of the Italian public.
08/07/2020, T-533/19, sflooring (fig.) / T-flooring, EU:T:2020:323, § 51	The affixing of a trade mark to a magazine, periodical, review, journal or catalogue is, in principle, capable of constituting 'valid use of the sign' as a trade mark for the goods and services designated by that mark if the content of the publications confirms use of the sign for the goods and services it covers (05/02/2020, T-44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 67).

Where genuine use is being demonstrated and the scale of use is not the essence, different criteria might apply and even less famous or prestigious publications may be useful. Likewise, in design invalidity proceedings, almost all kinds of publications are a suitable means of proving disclosure of a prior design (see the Design Guidelines, Examination of design invalidity applications, Section 5 The different Grounds for Invalidity, paragraph 5.7.1.2 Establishing the event of disclosure).

4.9 Oral evidence

Oral evidence refers to evidence taken at oral proceedings, such as hearing the oral evidence of parties, witnesses or experts. For more information on oral proceedings,

see the GuidelinesPart A, General rules, Section 2, General principles to be respected in the proceedings, 4 Oral proceedings.

Only in exceptional cases will the Office decide to hear oral evidence. This is because oral evidence is not normally necessary for the parties to present their legal and factual arguments effectively. Moreover, the cumbersome nature of the procedure can unjustifiably lengthen proceedings and increase costs significantly (15/12/2022, R 1613/2019-G, Iceland (fig.), where the Office heard witness and expert evidence).

Where the Office decides to hear witnesses or experts, it will bear the costs. However, where the parties request oral evidence, they will bear the costs.

Neither Article 97 EUTMR and Article 51 EUTMDR nor Article 64 CDR and Article 42 CDIR impose an obligation on the Office to summon witnesses to oral proceedings where requested by either party (14/06/2021, T-512/20, Protective covers covers for computer hardware, EU:T:2021:359, § 31-34).

Where a party requests oral proceedings, the requester must explain why the oral testimonies would be more apt to attest 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, § 15-24).

The Office will inform the parties about hearing of a witness or expert before the Office, so they can attend and pose questions to the witness or expert.

The probative value and reliability of the oral evidence given by witnesses and parties can be assessed in broadly the same way as affidavits.

4.10 Commissioning of expert opinions by the Office

Article 52 EUTMDR, Article 97 EUTMR Articles 43 and 44 CDIR

The Office does not often commission an expert opinion because it can usually decide matters based on the evidence on file (see as exceptional cases 21/09/2011, R 1105/2010-5, FLUGBÖRSE, where the Office commissioned an expert opinion on the meaning of the word ‘Flugbörse’ on a certain date in the past, and 25/02/2021, R 0696/2018-5, QUESO Y TORTA DE LA SERENA (fig.) / Torta del Casar et al., where the Office commissioned an expert opinion on the generic character of the term ‘Torta’). Moreover, expert opinions may involve substantial costs and lengthen the proceedings.

The commissioning of expert opinions by the Office under Article 52 EUTMDR and Article 44 CDIR (‘commissioned expert opinions’) is different from expert opinions that a party may submit on its behalf in proceedings and from experts to be summoned under Article 51 EUTMDR and Article 43 CDIR (15/12/2022, R 1613/2019-G, Iceland (fig.), where experts were heard as witnesses).

Commissioned expert opinions may be written or oral. If delivered orally, the practice described in paragraph 4.9 Oral evidence applies.

If a party requests the Office to commission an expert opinion, the Office will assess:

- whether or not to commission an expert opinion;
- who to appoint as expert; and
- what form the opinion should take.

The Office does not maintain a list of experts.

If the Office decides to commission an expert opinion, under Article 52(2) EUTMDR and Article 44(2) CDIR, the invitation to the expert includes:

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

The commissioned expert opinion must be submitted in the language of the proceedings or accompanied by a translation into that language. A copy of the written opinion, and of the translation if needed, must be forwarded to the parties.

The parties can object to a commissioned expert on the grounds of incompetence, a conflict of interest (because the expert was previously involved in the dispute as a representative of one of the parties or in taking a decision at any stage) or because of partiality. If a party objects to the expert, the Office will rule on the objection.

4.11 Inspections in situ carried out by the Office

The Office almost never has to inspect items outside its premises. Only in very exceptional circumstances will the Office carry out an inspection in situ under Article 51(1) EUTMDR and Article 43(1) CDIR, for example at the premises of a party.

If the Office decides to carry out an inspection, it will take an interim decision, stating the relevant facts to be proved, 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 some reason, the proceedings will continue based on the evidence on file.

5 Belated evidence in *inter partes* proceedings

Article 95(2) EUTMR, Article 8(5) EUTMDR, Article 10(7) EUTMDR, Article 19(1) and (2) EUTMDR

Article 63(2) CDR

Parties to proceedings must submit their observations within the time limits laid down in the EU trade mark and Community design regulations or within those

established by the Office (see the GuidelinesPart A, General rules, Section 1, Means of communication, time limits, 4 Time limits specified by the Office).

The Office may disregard facts or evidence that are not submitted in due time. The Office has broad discretion in this regard (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 43; 05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 16). Therefore, there is no guarantee that the Office will take belated facts and evidence into account.

> **Best practice:** if the party knows that it will not be able to submit all its evidence within the time limit set by the Office, it should request an extension of the time limit rather than sending part of the evidence late (see the GuidelinesPart A, General rules, Section 1, Means of communication, time limits, 4.3 Extension of time limits).

Guidance in particular proceedings can be found here:

Opposition proceedings: substantiation	Part C, Opposition, Section 1, Opposition proceedings, 4.2.6 Facts and evidence submitted after the substantiation time limit
Belated proof of use	Part C, Section 1, Opposition proceedings, 5.3.1. Time limit for providing proof of use
Trade mark invalidity and revocation proceedings	Part D, Section 1, Cancellation Proceedings, 2 Applications for Cancellation and 3 Adversarial stage
Design invalidity proceedings	Design Guidelines, Examination of design invalidity applications, Section 2, Introduction – General Principles Applying to Invalidity Proceedings, 2.4 compliance with time limits

The concept of 'belated evidence' requires:

- a time limit to have been set and to have been missed, and;
- the evidence to be submitted after the expiry of this time limit ('late').

Where no time limit was missed, paragraphs 5.1-5.2 do not apply.

5.1 Distinction between supplementary and new facts or evidence

If a party provides facts or evidence outside the time limit, a distinction is made between:

- **entirely new facts or evidence**, meaning there is no link to facts and evidence that were provided on time; or

- **supplementary facts or evidence**, meaning the party submitted facts or evidence on time and later supplements them (e.g. to rebut the argument of the other party in inter partes proceedings or to overcome arguments of the Office) 19/01/2022, T-76/21, Pomodoro, EU:T:2022:16, § 40.

The Office does not accept entirely new facts or evidence in **inter partes proceedings**. The acceptance of such belated evidence would render time limits ineffective. There would be no incentive for parties to meet a deadline (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 48; 19/01/2022, T-76/21, Pomodoro, EU:T:2022:16, § 37).

> **Best practice**: if a time limit has been missed in EUTM inter partes proceedings and entirely new evidence is submitted, the party should consider requesting continuation of proceedings instead (Part A, General rules, Section 1, Means of communication, time limits, 4.4 Continuation of proceedings).

However, the Office may accept supplementary facts or evidence exercising its power of discretion (see paragraph 5.2).

> **Best practice:** the party submitting late facts or evidence must provide arguments why such facts or evidence are only supplementary (not entirely new) and may therefore be accepted. It should establish a concrete link by indicating to which previously submitted facts or evidence the supplementary evidence relates to, for example, by providing a table.

To be considered supplementary evidence, the party must have made a serious attempt to provide sufficient evidence for all factors to be proven within the time limit. For example, if a party only refers to its own website as evidence of use of a mark, no serious attempt has been made to provide proof for the time, place and extent of use. Any invoices or other evidence submitted at a later stage will be considered as new evidence (04/05/2017, T-97/16, GEOTEK, EU:T:2017:298, § 29).

Moreover, the facts and evidence submitted within the deadline must cover all relevant factors to be proved for supplementary evidence to be possible. If only some of the factors are covered within the deadline, late evidence that relates to other factors may be considered inadmissible. For example, if the party did not submit any facts or evidence on time to prove the **place of use** and did not argue anything in that regard, late evidence provided to show the place of use will be treated as entirely new evidence.

The fact that the number of items of evidence submitted beyond the time limit is considerably greater than the items of evidence submitted in due time does not necessarily make the late evidence inadmissible (19/01/2022, T-76/21, Pomodoro, EU:T:2022:16, § 44).

5.2 Discretionary power

If the evidence is considered supplementary evidence in ***inter partes*** **proceedings**, the Office must exercise its discretionary power and decide whether the evidence is to be taken into account.

In doing so, the Office must consider:

- the stage of the proceedings when the belated evidence was submitted;
- if the late evidence is at first sight relevant, insofar as it appears to have an impact on the assessment and outcome of the case;
- whether there are valid reasons for the late submission; and
- whether the surrounding circumstances would prevent the late facts and evidence being considered.

These factors are independent.

Examples:

Additional facts or evidence are more likely to be accepted if they can be relevant to the outcome of the case, and are submitted at an early stage of the proceedings with a justification for their submission at that stage. However, the later the stage of proceedings, the stronger the reason must be for late submission or the relevance of the evidence.

If the circumstances of the case lead to the conclusion that a party is using delaying tactics by submitting evidence in parts with the intention of prolonging the proceedings, the late evidence is unlikely to be admitted.

The difficulties involved in obtaining the evidence are not, as such, a valid reason for its belated submission.

The Office must **state reasons in its decision** showing that it exercised discretionary power (05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 18). It must:

- state why the late facts and evidence are admissible or not;
- set out the factors it took into account; and
- balance the interests at stake.