

***GUIDELINES FOR EXAMINATION OF  
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE  
(EUIPO)***

***Part B***

***Examination***

***Section 1***

***Proceedings***

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## **1 Introduction and general overview of examination proceedings**

This part of the Guidelines outlines the examination procedure from filing to publication of the European Union trade mark (EUTM) application.

Once the EUTM application has been filed, a provisional filing date is accorded, and the Office issues a receipt. At this early stage, the Office only checks whether certain filing date requirements of the European Union trade mark regulation (EUTMR) have been fulfilled. The filing date will only become definitive when the application fee has been paid.

The applicant should check the receipt carefully and notify the Office of any incorrect data. The applicant can only correct data that have an impact on the filing date, such as the applicant's name, the representation of the mark and the list of goods and services, if it notifies the Office on the same date as the incorrect data were submitted. After this date, any amendment is subject to the provisions of the EUTMR, Implementing Regulation (EUTMIR) and Delegated Regulation (EUTMDR), in particular, Articles [20](#) and [49](#) EUTMR. For further details, see [paragraph 5](#) and the Guidelines, [Part B, Examination, Section 2, Formalities](#).

After the receipt has been issued, the Office carries out a language check of the verbal elements of the mark in all the official languages of the EU and prepares a European Union search report. This report will be sent to the applicant only if it was expressly requested when the application was filed.

Payment of the application fee and national search fee (if applicable) is validated 1 month at the latest after the EUTM application has been filed. If the applicant has applied for a national search and paid the relevant fee, the Office forwards the application to the offices of the Member States that perform national searches. For further information on searches, see [paragraph 2](#). For further information on fees, see the Guidelines, [Part A, General Rules, Section 3, Payment of Fees, Costs and Charges](#).

During the examination proceedings, the Office examines the following: filing date, formalities, classification, priority and/or seniority where applicable, the regulations governing use of the mark for collective and certification marks, and absolute grounds for refusal. All these examination steps can be carried out in parallel as there is no strict sequence in examination proceedings.

The applicant will be notified of any deficiency and given 2 months to remedy it and/or submit observations. Any decision partially or wholly refusing an EUTM application must give the ground(s) on which the EUTM application has been refused and inform the applicant of the right to appeal. For further details, see [paragraph 3.2](#) and [paragraph 3.2.1](#).

Applications that comply with the requirements of the regulation are accepted for publication and sent for translation into all the official languages of the EU.

The last step in the examination procedure is the publication of the application in Part A of the European Union Trade Marks Bulletin (EUTM Bulletin). For further details on publication, see [paragraph 4](#).

## 2 Searches

Articles [43](#) and [195](#) EUTMR

The search report identifies earlier rights that could conflict with the EUTM application. However, even if the search report does not indicate any similar earlier rights, an opposition could still be filed against the EUTM application after its publication.

The results of the search report are for information purposes only and to give the applicant the option of withdrawing the EUTM application before it is published. Surveillance letters inform holders of earlier EUTMs about similar new EUTM applications.

Figurative elements are classified under the Vienna Classification.

### 2.1 European Union search reports

The Office will prepare a European Union search report (EU search report) for each EUTM application or international registration (IR) designating the EU that it receives.

However, it will only send the EU search report to the EUTM applicant when the applicant has expressly requested this at the time of filing the application.

Holders of IRs designating the EU that wish to receive an EU search report must send the request to the Office within 1 month of the date of notification of the IR by the World Intellectual Property Organization (WIPO).

The EU search report covers the following earlier rights:

1. EUTM applications with a filing date or priority date earlier than that of the application in question;
2. EUTM marks already registered; and
3. prior international registrations (IR) designating the EU.

The EU search report takes into account the filing date, the verbal elements of the trade mark, the figurative elements of the mark (if applicable) and the classes of goods and services according to the Nice Classification. The search is designed to identify similar earlier marks filed for the same classes or for classes that are considered to contain similar goods and/or services by the Office.

Once the new application has been published, the Office will send a surveillance letter to the proprietors of any earlier EUTMs, EUTM applications or international registrations designating the EU cited in the EU search report, unless the proprietors have expressly requested not to receive these notifications. Such a request can be

made at any time in writing, specifying the EUTM in relation to which the proprietor does not wish to receive surveillance letters.

The sole purpose of the search is to inform the applicant for an EU trade mark, in a non-exhaustive manner, whether there are any conflicts with regard to relative grounds for refusal. They are not intended to produce information useful to the examination of absolute grounds for refusal (07/06/2001, [T-359/99](#), EuroHealth, EU:T:2001:151, § 31). The Office's search report cites only those trade marks that have been discovered and may potentially be invoked under [Article 8 EUTMR](#). It does not preclude other trade marks that have not been discovered and not listed from being invoked in opposition proceedings (11/12/2014, [R 1160/2014-1](#), VALUA (fig. mark) / VALEA et al, § 37).

## 2.2 National search reports

At the time of filing an application, an EUTM applicant may also request national search reports. These reports list any earlier national trade marks, national trade mark applications or trade marks registered under international agreements having effect in the Member State(s) concerned that have been discovered and that may be invoked under [Article 8 EUTMR](#) against the registration of the EUTM applied for, or state that the search has revealed no such rights. These reports are subject to the payment of the corresponding search fees.

Holders of IRs designating the EU that wish to apply for national searches must send the request and pay the relevant fee to the Office within 1 month of the date of notification of the IR by WIPO.

EUTM applications and IR designations that include a valid request for national searches are sent to the participating national offices. A request is valid if it is made at the time of filing and the relevant fee has been paid.

National search reports are prepared by offices that participate in the search system. For more details concerning the participating countries, see the [Office's website](#).<sup>(4)</sup>

A request for national searches implies that all participating national offices will carry out the search. This all-or-nothing approach means that the applicant cannot select the particular participating offices that it wishes to carry out the search.

The national offices are responsible for the content of the national search report.

## 3 General principles concerning examination proceedings

This section describes only the **procedural** aspects of examining absolute grounds (AG) for refusal. For substantive aspects of examining absolute grounds for refusal, see [the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal](#).

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<sup>4</sup> <https://www.euipo.europa.eu/en/help-centre/tm/faq-search-availability>

The EUTMR is intended to enable proprietors to register a right that is valid throughout the European Union provided it does not impinge on the rights of others. Although rights can only be conferred in accordance with the provisions of the EUTMR, the Office's function is to facilitate applications, not obstruct them.

During the examination of each application, the trade mark **and** the goods or services of the application must be taken into account. The Office bears in mind the nature of the trade mark concerned, the manner in which the goods or services are provided and the relevant public — for example, whether it consists of specialists or the general public.

### **3.1 Procedural aspects concerning third-party observations and review of absolute grounds**

#### [Article 45 EUTMR](#)

Communication No [2/09](#) of the Executive Director of the Office

Observations on the existence of an absolute ground for refusal can be made by third parties. Third-party observations received before an EUTM application has been published are dealt with during the examination of absolute grounds for refusal. The Office accepts observations received within the opposition period (3 months from the date of publication) or submitted — in cases where an opposition has been filed — before the final decision on the opposition has been taken. The observations must be submitted in one of the Office's languages: English, French, German, Italian or Spanish.

The Office issues a receipt to the party that submitted the observations (the observer), confirming that the observations have been received and have been forwarded to the applicant. The observer does not become a party to the proceedings before the Office but can consult the online search tools to check the status of the relevant EUTM application. The Office does not inform the observer of any action taken, or whether or not the observations have given rise to an objection.

All observations are forwarded to the applicant, who is invited to submit comments, where appropriate. The Office considers whether the observations are well founded, that is to say, whether an absolute ground for refusal exists. If so, the Office issues an objection and may refuse the EUTM application if the objection is not overcome by the applicant's comments or by a restriction of the list of goods and services.

The Office may also reopen the examination of absolute grounds on any other ground and at any time prior to registration — for example, when third-party observations are submitted before the application has been published or when the Office itself finds that a ground for refusal has been overlooked. After the application is published, this option should be exercised only in clear-cut cases.

For more information, see the Guidelines, [Part B, Examination, Section 4, Absolute Grounds for Refusal](#).

## 3.2 Decisions

In all cases where the Office issues decisions against applicants, it must give the ground(s) for the decision. The decision(s) must address any pertinent arguments raised by the applicant in its observations. Decisions must not only refer to the appropriate parts of the EUTMR and EUTMDR/EUTMIR, but also give explicit reasons, except in the most obvious cases (for example, where a document is missing or a fee has not been paid).

Where, for example, a decision is given on the basis of internet searches, the Office must provide the applicant with proof of those searches.

### 3.2.1 Appeals

Articles [66](#) and [72](#) EUTMR

[Rules of Procedure of the Boards of Appeal](#)

Applicants have a right to appeal against a decision that terminates proceedings and that adversely affects them. For practical purposes, any decision issued by the Office that terminates proceedings and is not accepted by the applicant falls into this category. Any written communication of such a decision must also inform the applicant that the decision can be appealed within 2 months.

Appeals have suspensive effect. Within the period in which an appeal can be lodged, the Office should not take any steps that cannot easily be reversed (e.g. publication or entry in the Register). The same goes for the period up until a final decision is taken where a case is brought before the General Court (GC) or Court of Justice (CJ) of the European Union by an action under [Article 72 EUTMR](#).

## 3.3 International registrations designating the European Union

Details about the examination of an EUTM application as a result of the transformation of an IR designating the European Union are given in [the Guidelines, Part M, International Marks](#).

## 4 Publication

[Article 44 EUTMR](#)

[Article 7 EUTMIR](#)

Publication takes place if the application fulfils all the acceptance conditions.

Applications are published in all the official EU languages.

The examiner must ensure that the following details are available, where applicable:

1. application file number;
2. filing date;
3. representation of the trade mark;
4. indication of the collective mark or certification mark;
5. indication of the mark type other than word marks, for example figurative marks, shape marks, position marks, pattern marks, hologram marks, sound marks, colour marks, motion marks, multimedia marks and other marks;
6. description of the mark;
7. colour code(s);
8. figurative elements under the Vienna Classification;
9. acquisition of distinctive character through use;
10. applicant's name and address;
11. representative's name and address;
12. first and second language;
13. goods and services under the Nice Classification;
14. priority data as filed;
15. exhibition priority data as filed;
16. seniority data as filed;
17. transformation data.

Once the examiner has checked that all these elements are correct and the Office has received the translation in all the official EU languages, the application will be published.

## **5 Amendments to an EUTM Application**

This part of the Guidelines only covers issues that are relevant to EUTM application amendments.

For amendments to registered European Union trade marks, see [the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration](#).

## 5.1 Withdrawal of an EUTM application

[Article 49](#), Articles [66\(1\)](#), [71\(3\)](#) and [72\(5\)](#) and [Article 146\(6\)\(a\) EUTMR](#)

[Article 58](#) and [Article 60](#) Rules of Procedure of the General Court (RPGC)

[Article 51](#) Rules of Procedure of the Court of Justice (RPCJ)

### 5.1.1 Declaration of withdrawal

An EUTM application can be withdrawn at any time up until a final decision is taken on its subject matter.

After the Office's first-instance decision, an application can be withdrawn at appeal level within the 2-month appeal period, even if no appeal was actually filed or up until the appeal is decided by the Boards of Appeal; this applies both to *ex parte* and *inter partes* proceedings (27/09/2006, [R 331/2006-G](#), Optima; 23/04/2014, [R 451/2014-1](#), SUPERLITE, § 18). The Office will confirm the withdrawal and close the case. The Office's database will be updated accordingly to reflect the withdrawal of the EUTM application.

At GC level, an application can be withdrawn within the 2-month appeal period, extended by a period of 10 days (on account of distance) pursuant to [Article 60](#) of the Rules of Procedure of the GC. The Boards of Appeal decision cannot be considered final within this period. The application can also be withdrawn up until completion of the appeal process before the GC.

At CJ level, an application can be withdrawn within the 2-month period for filing an appeal before the CJ, extended by a period of 10 days (on account of distance) pursuant to [Article 51](#) of the Rules of Procedure of the Court of Justice, or before the CJ has issued a final and binding decision (18/09/2012, [C-588/11 P](#), OMNICARE, EU:C:2012:576).

When the case is pending before the GC or the CJ, the applicant must request withdrawal of the EUTM application from the Office (not the GC or CJ). The Office will then inform the GC or CJ whether or not it finds the withdrawal acceptable and valid.

Any declaration of withdrawal of the EUTM application submitted after the expiry of the appeal period is inadmissible.

The **withdrawal of any pending appeal** (before the Boards of Appeal, the GC or the CJ) means that the **contested decision becomes final**. Consequently, the EUTM application may no longer be withdrawn thereafter.

There is no charge for a declaration of withdrawal but the declaration must be made in writing.

The declaration of withdrawal can be made in the first or second language indicated by the applicant in its EUTM application. The same applies during

opposition proceedings (see [the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 6.2.1.5](#)).

### 5.1.2 Unconditional and binding character of the declaration

A declaration of withdrawal becomes effective upon receipt by the Office, provided that the Office does not receive a withdrawal of the declaration on the same day.

This means that if a declaration of withdrawal and a letter withdrawing that declaration both reach the Office on the same day (regardless of the actual time of receipt), the latter annuls the former.

Once a declaration becomes effective, it cannot be withdrawn.

A declaration of withdrawal is void where it contains conditions or time limitations. For example, it must not require the Office to take a particular decision or, in opposition proceedings, require the other party to make a procedural declaration. Such a requirement is simply viewed as a suggestion for resolving the case; the Office informs the opponent accordingly and may invite the parties to come to an amicable settlement. Furthermore, a declaration does not become effective if it is made for some goods and/or services (partial withdrawal) on condition that the Office accepts the application for the remaining goods and/or services. Such a declaration is simply viewed as a suggestion to enable the Office to arrive at an acceptable list of goods and services.

Where an applicant responds to an official action by filing a restricted list of goods and services (partial withdrawal), the Office checks whether the applicant is declaring the unequivocal withdrawal of the remaining goods and services or whether the amended list of goods and services is a proposal or counterproposal by the applicant, subject to the Office's agreement.

### 5.1.3 Action to be taken

The Office will process a declaration of withdrawal, ensure publication and entry in the Register of the full or partial withdrawal in the EUTM Bulletin (if the EUTM application has already been published) and, in the event of a full withdrawal, will close the EUTM application file.

For the consequences of full or partial withdrawal of the opposition procedure, see [the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings](#).

Detailed information on the refund of application fees can be found in [the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges](#).

## 5.2 Restriction of the list of goods and services in an EUTM application

[Article 49](#) and [Article 146\(6\)\(a\) EUTMR](#)

The applicant may restrict the list of goods and services of its EUTM application at any time, either of its own volition, in reply to an objection regarding classification or absolute grounds, or in the course of opposition proceedings.

In principle, declarations of restrictions follow the same rules as declarations of withdrawals; see [paragraph 5.1](#). This applies also to the language regime, meaning that the declaration can be filed in the first or second language of the EUTM application.

Where the case is pending before the GC or the CJ, the restriction must be filed with the Office, not with the GC or the CJ. The Office will then inform the GC or the CJ whether or not it finds the restriction acceptable and valid.

### 5.2.1 Procedural admissibility of a restriction

The restriction must be procedurally admissible; see [paragraph 5.1.2](#).

As a matter of principle, a restriction becomes effective on the date on which the Office receives it. The restriction can only be withdrawn if the withdrawal is received on the same date as the restriction itself.

Two requirements must be met in order for a restriction to be acceptable.

1. The new wording must not constitute an extension of the list of goods and services.
2. The restriction must constitute a valid description of goods and services and apply only to acceptable goods or services that appear in the original EUTM application.

For further details on restrictions of an EUTM application, see [the Guidelines, Part B, Examination, Section 3, Classification](#).

If these requirements are not met, the Office must refuse the proposed restriction and the list of goods and services will remain unchanged (14/10/2013, [R 1502/2013-4](#), REPRESENTATION OF A CIRCLE (fig.), § 12-16).

In any restriction request, the goods and/or services to be restricted must be clearly indicated.

### 5.3 Other amendments

[Article 49\(2\)](#) and [Article 55 EUTMR](#)

[Article 11 EUTMDR](#)

[Article 12 EUTMIR](#)

This paragraph and the legal provisions cited above solely concern amendments to the EUTM application requested by the applicant on its own initiative and not amendments or restrictions made following an examination, opposition or appeal procedure as a result of a decision by an examiner, Opposition Division or Board of Appeal.

Nor does this paragraph apply to the correction of errors in the Office's publications, which is carried out *ex officio* pursuant to [Article 44\(3\) and \(4\) EUTMR](#).

Amendments require a written request in accordance with the language regime (for more information, see the Guidelines, [Part B, Examination, Section 2, Formalities](#)).

There is no charge for this.

The following elements of an EUTM application may be amended:

- the name and address of the applicant or representative (see [paragraph 5.3.1](#));
- errors of wording or of copying, or obvious mistakes, provided that the correction does not substantially change the trade mark (for further details on such amendments, see the Guidelines, [Part B, Examination, Section 2, Formalities](#));
- the list of goods and services (see [paragraph 5.2](#)).

For amendments of regulations governing use of EU collective and EU certification marks, see the Guidelines, [Part E, Register Operations, Section 1, Changes in a Registration, paragraph 4, Changes in Collective and Certification Trade Mark Regulations](#).

### 5.3.1 Name and address of applicant or representative

Articles [55](#) and [111](#) EUTMR

[Article 2\(1\)\(b\) and \(e\) EUTMIR](#)

For information **on the change of name/address of the EUTM applicant**, including the name, legal form, and address, see the Guidelines, [Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation, paragraph 10, Change of name and address](#) and [paragraph 11, Correction of the name or address](#).

### 5.3.2 Recording and publication of amendments

[Article 49\(2\) EUTMR](#)

If an amendment is allowed, it will be recorded in the file and entered in the Register.

Where the EUTM application has not yet been published, it is published in the EUTM Bulletin in the amended form.

Where the EUTM application has already been published and (only) if the amendment concerns the list of goods and services or the representation of the mark, the EUTM application is published in its amended form in the EUTM Bulletin. The publication of the amended application may open a new opposition period of 3 months.

Any other amendments are not published separately but appear in the publication of the registration.

## 5.4 Division of an EUTM application

[Article 50 EUTMR](#)

[Article 8 EUTMIR](#)

An EUTM application can be divided into different parts not only as a result of a partial transfer (see the Guidelines, [Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 1, Transfer](#)), but also on the EUTM applicant's own initiative. Division is particularly useful for isolating a disputed EUTM application for certain goods or services while maintaining the original application for the remainder. For information on the division of EUTMs, see the Guidelines, [Part E, Register Operations, Section 1, Changes in a Registration](#).

Whereas a partial transfer is free of charge and involves a change of ownership, there is a charge for a request for the division of an EUTM application, and the EUTM application remains in the hands of the same applicant. If the fee is not paid, the

request is deemed not to have been filed. The request can be made in the first or second language indicated by the applicant in its EUTM application.

For specific information on the division of international registrations designating the EU under the Madrid Protocol, please see the Guidelines, [Part M, International Marks, paragraph 5, Division](#).

#### 5.4.1 Requirements

A request for division must contain the following information:

- the file number of the EUTM application to be divided;
- the name and address or name and ID number of the applicant;
- the list of goods and services for the divisional application or, if more than one new application will be created, the list of goods and services for each divisional application;
- the list of the goods and services that will remain in the original EUTM application.

Furthermore, the goods and services of the divisional application must not overlap with the list of goods and services of the original application.

The Office will notify the applicant of any deficiency in this regard and give it 2 months to remedy the deficiency. If it is not remedied within this period, the request for division will be refused.

There are certain periods during which, for procedural economy or to safeguard third-party rights, division is not admissible. These periods are outlined below.

1. While an opposition is pending, only the non-contested goods and services may be hived off. The same applies if the case is pending before the Boards of Appeal or the Courts. The Office interprets the legal provisions cited above as preventing the applicant from hiving off some or all of the contested goods to form a new application that would cause the opposition proceedings to be split. If such a request for division is made, the applicant is given the opportunity to amend it by hiving off the non-contested goods and services.
2. Division is not admissible during the 3-month opposition period following publication of the application. Allowing a division during this time would counteract the aim of not splitting an opposition procedure and frustrate third parties, who have to rely on the EUTM Bulletin to know what to oppose.
3. Division is not admissible during the period before a filing date has been issued either. This does not necessarily coincide with the first month following filing. For further details on the filing date, see [the Guidelines, Part B, Examination, Section 2, Formalities](#).

For all practical purposes, in the period following publication of the application, division is only admissible if an opposition has been entered against the application and only for the non-contested part. The aim of the provisions cited is to allow the applicant to register its mark for the non-contested goods quickly, without having to wait for the outcome of a lengthy opposition procedure.

## 5.4.2 Acceptance

### Article 50(6) EUTMR

If the Office accepts the declaration of division, a new application is created as of the date of acceptance and not retroactively as of the date of the declaration.

The new application keeps the filing date and any priority and seniority dates. The seniority effect will then become partial.

All requests and applications submitted and all fees paid prior to the date on which the Office receives the declaration of division are also deemed to have been made or paid for the divisional application. However, fees duly paid for the original application are not refunded.

The practical effects of this provision are as follows.

- Where an application for the registration of a licence was made and payment of the registration fee was received by the Office prior to the declaration of division, the licence will be registered against the original registration and recorded in the file of the new registration. No further fees need be paid.
- Where an EUTM application claiming six classes is divided into two applications of three classes each, no class fees are payable as of the date the Office receives the declaration of division. However, fees paid prior to that date cannot be refunded.

Where the division is not accepted, the old application remains unchanged. It does not matter whether:

- the declaration of division was deemed not to have been filed because no fee had been paid;
- the declaration was refused because it failed to comply with the formal requirements;
- the declaration was found inadmissible because it was filed during one of the periods in which division is not admissible.

The fee will not be reimbursed in any of these three cases. The worst-case scenario for the applicant is that the declaration of division is not accepted, but this never affects the original application. The applicant can repeat the declaration of division later, on payment of a new fee.

## 5.4.3 New files and their publication

A new file is created for the divisional application, with all the documents that were on file for the original application, all the correspondence relating to the declaration of division and all future correspondence for the new application. Inspection of this file will be unrestricted under the general rules.

If the declaration of division concerns an EUTM application that has not yet been published, both the divisional and the original application are published separately and in the normal way, without any express reference to each other.

If the declaration of division concerns an EUTM application that has already been published, the fact that there has been a division is entered into the Register and published with reference to the original application. The new application must also be published with all the usual particulars; however, no new opposition period will be opened. Division is admissible only for goods for which an opposition period has already started but not been made use of.