GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Obsolete

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Obsolete

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 1 Changes in a registration

Obsolete

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1 Surrender

Article 57 EUTMR

Article 15 EUTMIR

1.1 General principles

At any time after registration, a European Union trade mark (EUTM) may be surrendered by its proprietor in respect of some or all of the goods and services. The surrender must be declared to the Office in writing. (For information on the withdrawal of EUTM applications, that is, prior to registration, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1.)

1.2 Legal effect

Article 57(2) EUTMR

Article 15 EUTMIR

Surrenders only become legally effective on the date of entry in the EUTM Register. The registration procedure for the surrender may be suspended during ongoing proceedings (see paragraph 1.4 below).

The proprietor's rights in the registered EUTM, as well as those of its licensees and any other holders of rights in the mark, lapse with an *ex nunc* effect on the date of the registration of the surrender in the EUTM Register. Therefore, the surrender has no retroactive effect.

The surrender has procedural and substantive effects.

In procedural terms, when the surrender is entered in the EUTM Register, the EUTM ceases to exist and any proceedings (with the exception of invalidity or revocation proceedings) involving the mark before the Office terminate.

The substantive effects of surrender vis-à-vis third parties comprise the EUTM proprietor renouncing any rights arising from its mark in the future.

The EUTM proprietor is bound by the declaration of surrender during its registration procedure, provided that the following circumstances are present.

1. No revocation of the declaration reaches the Office on the same day as the receipt of the declaration of surrender. That means that if a declaration of surrender and a communication revoking that declaration reach the Office on the same day (regardless of the hour and minute of their receipt), they cancel each other out. Once it becomes effective, the declaration may not be revoked.

Obsolete

2. The declaration meets all the formal requirements, in particular those identified in paragraph 1.3.7 below.

1.3 Formal requirements

1.3.1 Form and language

Article 146(2) and (6) EUTMR Article 17(7) and Article 65 EUTMDR Article 24 EUTMIR

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

The declaration of surrender must be submitted in writing in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the declaration of surrender is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may, according to Article 146(6) EUTMR, 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.

Where there is an application for revocation or for a declaration of invalidity pending against an EUTM, and the proprietor wishes to surrender the contested EUTM, it must do so by way of a separate document. For more information on the separate document requirement, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.4.1.

The declaration of surrender is void where it contains conditions or time limitations. For example, it may not be made under the condition that the Office takes a particular decision or, in *inter partes* proceedings, that the other party makes a procedural declaration. For instance, during cancellation proceedings the mark may not be (partially) surrendered on the condition that the cancellation applicant withdraws its cancellation action. However, this does not exclude the possibility of an agreement between the parties, or prevent both parties from requesting successive actions (for example, surrender of the trade mark and withdrawal of the cancellation action) in the same communication to the Office.

1.3.2 Fees

There is no fee for a declaration of surrender.

Obsolete

1.3.3 Necessary particulars

Article 15 EUTMIR

The declaration of surrender must contain the particulars referred to in Article 15 EUTMIR. These are:

- the EUTM registration number;
- the EUTM proprietor's name and address or the proprietor's Office ID number together with the proprietor's name;
- where the surrender is only for some of the goods or services for which the mark is registered, either the goods and services for which the surrender is declared or an indication of the goods and services for which the mark is to remain registered or both (see paragraph 1.3.4 below).

1.3.4 Partial surrender

An EUTM may be surrendered in part, that is, for some of the goods and services for which it is registered. A partial surrender only becomes effective on the date it is entered in the EUTM Register.

For a partial surrender to be accepted, the following two conditions relating to the goods and services must be met:

1. the new wording must not constitute an extension of the list of goods and services;
2. the partial surrender must constitute a valid description of goods and services.

For further details on acceptable restrictions and for the practice regarding the declaration referred to in Article 33(8) EUTMR, see the Guidelines, Part B, Examination, Section 3, Classification.

1.3.5 Signature

Except where Article 63(1)(a) EUTMDR allows otherwise, the declaration of surrender must be signed by the EUTM proprietor or its duly appointed representative.

1.3.6 Representation

Articles 119(2) and 120(1) EUTMR

The general rules apply (see the Guidelines, Part A, General Rules, Section 5, Professional Representation).

Obsolete

1.3.7 Requirements where a licence or other right in the EUTM has been registered

A surrender cannot be registered if third parties have registered rights in the EUTM (such as licensees, pledgees, etc.) without first fulfilling certain additional requirements.

Where a licence, or another right in the EUTM, is entered in the EUTM Register, the following additional requirements apply.

1. The EUTM proprietor must submit sufficient proof that it has informed the licensee, pledgee, etc. of its intention to surrender.
   If the proprietor proves to the Office that the licensee, pledgee, etc. has given its **consent** to the surrender, the surrender will be registered upon receipt of that notice.

   If the EUTM proprietor merely submits proof that it has **informed** the licensee/ pledgee of its intention to surrender, the Office will inform the proprietor that the surrender will be registered 3 months after the date on which the Office received the evidence (Article 57(3) EUTMR).

   The Office will consider a copy of the communication from the proprietor to the licensee/pledgee as sufficient evidence. The same applies to a written statement signed by the licensee/pledgee that it has been informed. An affidavit by the proprietor is not necessary. The term 'proves' in Article 57(3) EUTMR does not refer to absolute certainty but to a reasonable probability, as follows from the other language versions of the Regulations (Article 57(3) EUTMR: Italian version: *dimostra*, German version: *glaubhaft macht*). The documents may be in any of the 23 official languages of the European Union. However, the Office may require a translation into the language chosen for the declaration of surrender or, at the choice of the declarant, into any of the five languages of the Office.

   If no proof has been provided or it is insufficient, the Office will request that it be submitted within 2 months.
2. Where a levy of execution is entered in the EUTM Register, the declaration of surrender must be accompanied by a declaration of consent to the surrender signed by the authority competent for the levy of execution (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 2, Licences, Rights *in Rem*, Levies of Execution, Insolvency Proceedings, Entitlement Proceedings or Similar Proceedings).
3. Where insolvency or similar proceedings are entered in the EUTM Register, the declaration of surrender must be requested by the liquidator (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 2, Licences, Rights *in Rem*, Levies of Execution, Insolvency Proceedings, Entitlement Proceedings or Similar Proceedings).

Obsolete

1.4 Examination

Article 57(2) EUTMR

Article 17(4), (5) and (6) EUTMDR

1.4.1 Competence

Where surrender (or a partial surrender) is declared during ongoing revocation or invalidity proceedings against the validity of the EUTM that is being surrendered, the Office will suspend the registration of the surrender and invite the cancellation applicant to indicate whether it wishes to continue with the proceedings. For details concerning the treatment of surrenders received during the course of open cancellation proceedings, see the Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings, paragraph 4.3.1.

Where the EUTM is subject to a case pending before the General Court or the Court of Justice, the surrender must be filed at the Office (not before the General Court or the Court of Justice). The Office will then inform the General Court or the Court of Justice whether or not it finds the surrender acceptable and valid.

2 Alteration of a Trade Mark

2.1 General principles

Article 54 EUTMR

Article 10 EUTMIR

This section of the Guidelines and the provisions cited above deal solely with alterations of the EUTM that are requested by the proprietor of its own accord.

There is a difference between an amendment of an EUTM application and an alteration of a registered EUTM. The amendment of an EUTM application is governed by Article 49 EUTMR and Article 11 EUTMDR. The alteration of a registered EUTM is governed by Article 54 EUTMR and Article 10 EUTMIR (for more information on amendments of an EUTM application, see the Guidelines, Part B, Examination, Section 2, Formalities).

This section does not apply to corrections of obvious errors by the Office in its publications or in the EUTM Register; such corrections are made *ex officio*, or at the proprietor's request, pursuant to Article 44(3) and Article 102 EUTMR (for more information, see the Guidelines, Part A, General Rules, Section 6, Revocation of Decisions, Cancellation of Entries in the Register and Correction of Errors).

Obsolete

The alteration of a mark enables the representation of a mark to be altered, providing the alteration relates to the proprietor's name and/or address **and** does not substantially affect the identity of the trade mark as originally registered.

The Regulations do not provide for the possibility of altering other elements of the EUTM registration.

2.2 Formal requirements

2.2.1 Form and language

Article 54 and Article 146(6) EUTMR

The application to alter the mark, that is, the representation of the mark, must be submitted in writing in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of an alteration of the mark is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may, according to Article 146(6) EUTMR, 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.

2.2.2 Fees

Article 54(4) and Annex I A(28) EUTMR

The application to alter the mark is considered not to have been filed until the fee has been paid. The amount of this fee is EUR 200 (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

2.2.3 Mandatory indications

Article 54(3) EUTMR Article 10 EUTMIR

The application for alteration must contain:

- the EUTM registration number;
- the EUTM proprietor's name and address in accordance with Article 2(1)(b) EUTMIR, or the proprietor's Office ID number together with the proprietor's name;
- an indication of the element in the representation of the mark to be altered and the altered version of the element;
- a representation of the mark as altered that complies with the formal requirements laid down in Article 3 EUTMIR.

Obsolete

2.3 Substantive conditions for alteration

Article 54(2) EUTMR allows the alteration of the representation of the mark only under very limited conditions, namely only when:

- the EUTM includes the EUTM proprietor's name and/or address, **and**
- these are the elements for which alteration is sought, **and**
- the alteration would not substantially affect the identity of the trade mark as originally registered.

Strict rules apply: where the proprietor's name or address is part of the distinctive elements of the mark, for example, part of a word mark, an alteration is in principle excluded since the identity of the mark would be substantially affected. A mark may be altered if the EUTM proprietor's name or address appears on a figurative mark, for example, the label of a bottle, as a subordinate element in small letters. Such elements would normally not be taken into account in determining the scope of protection or the fulfilment of the use requirement. The rationale of Article 54(2) EUTMR is precisely to exclude any alteration of the registered EUTM that could affect its scope of protection or the assessment of the use requirement, so that rights of third parties cannot be affected.

No other element of the mark may be altered, not even if it is only a subordinate element in small letters of a descriptive nature, such as the indication of the percentage of alcohol on a label of a bottle of wine.

Furthermore, Article 54(2) EUTMR does not allow for the alteration of the list of goods and services (09/07/2008, R 585/2008-2, SAGA, § 16). After registration, the only way to change the list of goods and services is through partial surrender under Article 57 EUTMR (see paragraph 1.3.4 above).

2.3.1 Examples of acceptable alterations

Mark as registered	Proposed alteration
EUTM No 7 389 687 	

Obsolete

Mark as registered	Proposed alteration
EUTM No 4 988 556 	

2.3.2 Examples of unacceptable alterations

Mark as registered	Proposed alteration
EUTM No 11 058 823 ROTAM — INNOVATION IN POST PATENT TECHNOLOGY'	ROTAM — INNOVATION IN POST PATENT TECHNOLOGY
EUTM No **9 755 307** **MINADI MINADI Occhiali**	MINADI
EUTM No 10 009 595 CHATEAU DE LA TOUR SAINT-ANNE	CHATEAU DE LA TOUR SAINTE-ANNE
EUTM No 9 436 072 SLITONE ULTRA	SLITONEULTRA
EUTM No **2 701 845** 	
EUTM No 3 115 532 	

Obsolete

Mark as registered	Proposed alteration
EUTM No 7 087 943 	
EUTM No 8 588 329 	

2.4 Publication

Where the alteration of the registration is allowable, it will be registered and published. The publication will contain a representation of the EUTM as altered.

Within 3 months of the publication of the alteration (Article 54(5) EUTMR), third parties whose rights may be affected by the alteration may challenge the registration thereof. For this procedure, the provisions on the opposition procedure apply *mutatis mutandis*.

3 Changes of Name or Address

Articles 55 and 111 and Article 146(6) EUTMR

Article 12(a), (b) and (c) EUTMIR

Both registered European Union trade marks (EUTMs) and EUTM applications may be the subject of changes of name and address. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

It is possible to change the name, address or nationality of the proprietor of a registered EUTM or its representative. The application to register the change must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish. The change will be entered in the EUTM Register and published.

Pursuant to Article 12 EUTMIR, the name, including the indication of the legal form, and address of the proprietor or representative may be amended freely, provided that:

- as regards the proprietor's name, the change is not the consequence of a transfer;

Obsolete

- as regards the representative's name, there is no substitution of one representative by another.

Pursuant to Article 111(3)(a) EUTMR, the indication of the nationality or the State of establishment of a legal person may also be altered or added, provided that it is not the consequence of a transfer.

A change of the proprietor's name within the sense of Article 12 EUTMIR is a change that does not affect the ownership, whereas a transfer is a change from one proprietor to another. In case of doubt as to whether the change falls under Article 20 EUTMR, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 1, Transfer, for details and the applicable procedure.

Likewise, a change of a representative's name within the sense of Article 55(4) EUTMR and Article 12 EUTMIR is limited to a change that does not affect the identity of the appointed representative; for example, where the name changes as a result of marriage. Article 55(4) EUTMR and Article 12 EUTMIR also apply where the name of an association of representatives changes. Such a change of name must be distinguished from the substitution of one representative by another, which is subject to the rules governing the appointment of representatives. For details, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

To register a change of name and address, the proprietor must submit an application to the Office. The application must contain the EUTM number as well as the name and address of the proprietor (Article 2(1)(b) EUTMIR) or of the representative (Article 2(1)(e) EUTMIR), both as registered in the file and as amended.

Normally no proof or evidence of the change is necessary. However, in case of doubt, the examiner may ask for proof such as a certificate from a trade register. The application to register the change of name or address is not subject to a fee.

Legal persons may only have one official address. In case of doubt, the examiner may ask for evidence of the legal form or of the address in particular. The official name and address are also used as the address for service by default. A proprietor should have only one address for service. In order to ensure the veracity and correctness of the Register, a change in the proprietor's official name or official address will be registered for all EUTMs, REUDs and pending proceedings of this entity in the name of that proprietor. Unlike the address for service, a change in the official name or address cannot be registered solely for specific portfolios of rights. These rules apply to representatives by analogy.

4 Changes in Collective and Certification Trade Mark Regulations

Articles 79 and 88 and Article 146(6) EUTMR

According to Articles 79 and 88 EUTMR, the proprietors of EU collective and certification marks must submit to the Office any amended regulations governing use.

Obsolete

The application to enter in the EUTM Register an amendment of the regulations governing the use of a collective or certification trade mark must be submitted in writing in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

4.1 Registration of the amended regulations

Article 75(2), Articles 76 and 77, Article 79(3) and (4) and Articles 84, 85 and 88 and 111 EUTMR

The amendment of the regulations governing the use of a collective or certification trade mark will not be entered in the EUTM Register if the amended regulations do not satisfy the requirements of Article 75(2) or Article 84 EUTMR, or if they involve one of the grounds for refusal referred to in Article 76 or 85 EUTMR.

Where the registration of the amendment of the regulations is accepted, it will be registered and published.

The applicant for the amendment will specify the part of the amended regulations to be entered in the EUTM Register, which can be as follows.

For collective marks:

- the EUTM proprietor's name and address;
- the purpose of the association or the purpose for which the legal person governed by public law is constituted;
- the bodies authorised to represent the association or the legal person;
- the conditions for membership;
- the persons authorised to use the mark;
- where appropriate, the conditions governing use of the mark, including sanctions;
- if the mark designates the geographical origin of goods or services, authorisation for any person whose goods or services originate in the geographical area concerned to become a member of the association.

For certification marks:

- the EUTM proprietor's name and address;
- a declaration that the proprietor complies with the requirements laid down in Article 83(2) EUTMR;
- the characteristics of the goods or services to be certified by the EU certification mark, such as the material, mode of manufacture of goods or performance of services, quality or accuracy;
- the conditions governing the use of the EU certification mark, including sanctions;
- the persons authorised to use the EU certification mark;
- how the certifying body is to test those characteristics and to supervise the use of the EU certification mark.

Obsolete

Within 3 months of the publication of the amended regulations, third parties whose rights may be affected by the amendment may challenge the registration thereof. For this procedure, the provisions on third party observations apply *mutatis mutandis*.

5 Division

5.1 General provisions

Article 56 and Annex I A(25) EUTMR

Article 11 EUTMIR

A registration can be split into different parts not only as the 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 proprietor's own motion. A division of a trade mark is particularly useful in order to isolate a disputed trade mark for certain goods or services and maintain the registration for the remainder. For information on the division of EUTM applications, see the Guidelines, Part B, Examination, Section 1, Proceedings.

Whereas a partial transfer is free of charge and involves a change of ownership, the declaration of division of a trade mark is subject to a fee and the trade mark remains in the hands of the same proprietor. If the fee has not been paid, the declaration of division is considered not to have been filed. The declaration must be made in one of the five languages of the Office.

For 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.

5.2 Formal requirements

5.2.1 Form and language

Article 146(6) EUTMR

A declaration of division of an EUTM must be submitted in writing in one of the five languages of the Office namely, English, French, German, Italian or Spanish.

However, when the declaration of division of an EUTM is filed using the form provided by the Office pursuant to Article 65 EUTMDR, 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.

Obsolete

5.2.2 Fees

Annex I A(25) EUTMR

The declaration is subject to a fee of EUR 250; the declaration is considered not to have been filed until the fee has been paid (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

5.2.3 Mandatory indications

Article 54(4) and Article 56 EUTMR

Article 11 EUTMIR

The declaration of division must contain:

- the registration number of the EUTM to be divided;
- the proprietor's name and address; if the proprietor has previously been allocated an ID number by the Office, it is sufficient to indicate that ID number together with the proprietor's name;
- the list of goods and services for the divisional registration, or, if more than one new registration is to be created, for each divisional registration;
- the list of goods and services that will remain in the original EUTM.

The goods and services must be distributed between the original EUTM and the new EUTM so that the goods and services in the original and the new EUTM do not overlap. The two specifications taken together must not be broader than the original specification. Goods or services that have been objected to or contested (e.g. absolute grounds examination, contested in opposition proceedings, etc.) should remain in the original EUTM. Only those goods and services that are neither contested nor objected to may be split and placed within the new EUTM.

Therefore, the indications must be clear, precise and unequivocal. For example, when an EUTM for goods or services in several classes is involved, and the 'split' between the old and new registration concerns whole classes, it is sufficient to indicate the respective classes for the new registration or for the remaining one.

When the declaration of division indicates goods and services that are explicitly mentioned in the original list of goods and services, the Office will automatically keep the goods and services that are not mentioned in the declaration of division in the original EUTM. For example, the original list contains goods A, B, and C and the declaration of division relates to C; the Office will keep goods A and B in the original registration and create a new registration for C.

For the assessment of whether there is a limitation or a broadening of scope of the list, the rules generally applicable in such situations apply (see the Guidelines, Part B, Examination, Section 3, Classification).

Obsolete

In all cases it is highly recommended to submit a clear and precise list of goods and services to be divided, together with a clear and precise list of goods and services to remain in the original registration. Furthermore, the original list must be clarified. For example, if the original list related to *alcoholic beverages* and the division relates to *whisky* and *gin*, the original list must be amended by restricting it to *alcoholic beverages, except whisky and gin*.

There are also certain periods during which, for procedural economy or to safeguard third-party rights, a declaration of division is not admissible. These periods are prescribed by Article 56(2) EUTM and are as follows.

- While cancellation proceedings are pending before the Office (application for revocation or declaration of invalidity), only those goods and services against which the cancellation request is not directed may be divided from the original EUTM. The Office interprets Article 56(2)(a) EUTMR as not only excluding a division where some of the contested goods are divided from the original EUTM, with the effect that the cancellation proceedings would have to be split, but also as excluding the division of all the contested goods from the original EUTM. However, in this case, the EUTM proprietor will be given the opportunity to amend the declaration of division by dividing the other goods and services from the original EUTM, that is, those that are not contested in the cancellation proceedings.
- While proceedings are pending before the Boards of Appeal, the General Court or the Court of Justice, only those goods and services not affected by those proceedings may be divided from the original EUTM, due to the suspensive effect of the proceedings.
- Likewise, while a counterclaim for revocation or declaration of invalidity is pending before an EUTM court, the same conditions apply. This covers the period starting on the day the counterclaim was lodged before the EUTM court and ending on the date on which the Office records the EUTM court's judgment in the EUTM Register pursuant to Article 128(6) EUTMR.

5.3 Registration

Article 56(5), (6) and (7) EUTMR

If the Office accepts the declaration of division, a new registration is created as of that date and not retroactively from the date of the declaration.

The new registration keeps the filing date and, depending on the goods and services, any priority or seniority dates; the seniority effect may 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 resulting divisional registration. However, fees duly paid for the original registration will not be refunded. The practical effects of this provision can be illustrated by the following examples.

Obsolete

- Where an application for the registration of a licence was submitted and the payment of the fee for its registration was received by the Office prior to the declaration of division, the licence will be registered in the EUTM Register for both the original and the divisional EUTM if the licence covers goods and/or services in the original and divisional EUTM. No further fees need to be paid.
- Where an EUTM registration containing two classes is to be divided into two registrations, no additional class fees for the renewal are payable as from **the date on which the division is entered in the EUTM Register** but, instead, two basic renewal fees will be payable, one for each registration.

5.4 New file, publication

Article 111(3) EUTMR

A new file must be created for the divisional registration. It must contain all the documents that were on file for the original registration, plus all the correspondence related to the declaration of division, as well as all correspondence for the new registration.

The division will be published in the EUTM Bulletin.

6 Post-Registration Seniority Claims

Article 40 EUTMR Decision No EX-17-3 of the Executive Director of the Office of 18/09/2017

6.1 General principles

The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered under international arrangements having effect in a Member State, that holds an identical EUTM for goods or services that are identical with or contained in those for which the earlier trade mark has been registered, may claim for the EUTM the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

Seniority may be claimed at any time after the registration of the EUTM.

6.2 Legal effect

Concerning the legal effects of a seniority claim, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 13, which applies by analogy to post-registration seniority claims.

Obsolete

6.3 Formal requirements

6.3.1 Form and language

Article 40 and Article 146(6) EUTMR

The seniority claim must be declared to the Office in writing and must be submitted in one of the five languages of the Office namely, English, French, German, Italian or Spanish.

However, when the seniority claim is filed using the form provided by the Office pursuant to Article 65 EUTMDR, 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.

6.3.2 Fees

There is no fee for an application for a seniority claim.

6.3.3 Mandatory indications

Article 40 EUTMR Decision No EX-17-3 of the Executive Director of the Office of 18/09/2017

A valid claim must contain the indications as listed in paragraph 13.2 of the Guidelines, Part B, Examination, Section 2, Formalities, which applies equally to post-registration seniority claims.

6.4 Examination

Seniority may only be claimed from an earlier **registration**, not an earlier application. The date of the earlier trade mark must be before the respective dates of the EUTM (filing date or, if available, priority date).

For details of the examination of seniority claims, the triple identity requirements and examples of acceptable and unacceptable seniority claims, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraphs 13.2, 13.3, 13.4 and 13.6, which apply equally to post-registration seniority claims.

If the claim to seniority does not satisfy the formal requirements or if the marks are not identical, the Office will notify the proprietor and give it 2 months to remedy the deficiency or submit observations.

Obsolete

If the deficiency is not remedied, the Office will inform the proprietor that the right to claim seniority has been rejected.

6.5 Registration and publication

Articles 39(5) and 40(4) and Article 111(3)(f) EUTMR

If the claim to seniority is acceptable, the Office will register it and inform the central industrial property office(s) of the Member State(s) concerned.

The seniority claim will be published in the EUTM Bulletin.

6.6 Cancellation of seniority claims

The EUTM proprietor may at any time request cancellation of the seniority claim from the EUTM Register of its own motion.

Seniority claims may also be cancelled by a decision of a national court (see Article 6 Directive (EU) 2015/2436).

The cancellation of the seniority claim will be published in the EUTM Bulletin. Article 111(3)(f) EUTMR provides that the cancellation of seniority will be registered.

7 Replacement of an EUTM Registration by an IR

Article 111(3)(t) and Article 197 EUTMR Article 4*bis* Madrid Protocol Rule 21 Regulations under the Protocol

In accordance with Article 4*bis* of the Madrid Agreement and Protocol, the holder of an international registration designating the European Union (IR) may request the Office to take note in its Register that an EUTM registration is replaced by a corresponding IR. The holder's rights in the European Union will be considered to start from the date of the earlier EUTM registration. Therefore, the Office will enter in the EUTM Register that an EUTM has been replaced by a designation of the EU through an IR, and that entry will be published in the EUTM Bulletin.

For more information on replacement, see the Guidelines, Part M, International Marks.

Obsolete

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 2

Conversion

Obsolete

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1 Introduction

Conversion is the process of turning a European Union trade mark (EUTM) application or registration into one or more national applications. Its main features are laid down in Articles 139 to 141 EUTMR and Articles 22 and 23 EUTMIR. If an EUTM ceases to exist, it can, depending on the specific reason for this, be converted into trade marks that are valid in certain Member States. Conversion is particularly useful for overcoming possible problems with the EUTM's unitary character. For example, if the EUTM faces a registrability problem in only one or several countries on absolute grounds or due to an opposition based on an earlier right valid in only one country or several countries, the EUTM applicant can apply to convert the EUTM into individual, national trade mark applications in the countries not affected by these grounds.

The EUTM system is based on the principle that the European Union and national trade mark systems are complementary. They are notably linked to each other by the seniority and conversion procedures. The system is construed in such a way that the earlier filing date of a registered right will always prevail in the territory in which it is valid, irrespective of whether the registered trade mark results from a national filing, an international designation or an EUTM application (15/07/2008, R 1313/2006-G, CARDIVA (fig.) / CARDIMA (fig.); 22/09/2008, R 207/2007-2, RESTORIA / RESTORIA, § 34).

Conversion is a two-tier system involving, firstly, the payment of the conversion fee and the examination of the request for conversion before the Office and, secondly, the conversion procedure itself before the national offices. Depending on national law, the converted trade mark will either be registered immediately or enter the national examination, registration and opposition procedures in the same way as a normal national trade mark application.

Where the EU is designated in an international registration (IR) and to the extent that the designation has been withdrawn, refused or has ceased to have effect, a request may also be made for conversion into national trade mark applications in one, several or all of the Member States, or through a subsequent designation of the Member States under the Madrid System.

Conversion of IRs designating the EU is not to be confused with 'transformation', which is a legal feature introduced by the Madrid Protocol (MP) in order to soften the consequences of the five-year dependency period and central attack (ceasing of effect of the basic mark) existing under the Madrid Agreement (see Article 6(3) MP). Transformation allows for a centrally attacked international mark to be transformed into a direct EUTM application, but does not allow for the conversion of an EU designation into national filings. For more information on transformation, see the Guidelines, Part M, International marks.

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2 Conversion of EUTMs and IRs Designating the EU

2.1 Conversion of EUTMs

Articles 139(1) and 140(1) and Article 159 EUTMR Article 22(e), (f) and Article 35(1) EUTMIR

The applicant for an EUTM or proprietor of a registered EUTM may request the conversion of its EUTM application or registered EUTM. The request may be for conversion into national trade mark applications in one, several or all of the Member States. With regard to Belgium, Luxembourg and the Netherlands, the term 'national trade mark applications' includes Benelux trade mark applications, and 'national office', the Benelux Office for Intellectual Property (BOIP).

Conversion is possible in the following circumstances ('grounds for conversion'):

- where an EUTM application has been finally refused by the Office (Article 139(1)(a) EUTMR) in a decision on absolute or relative grounds for refusal during examination or opposition proceedings;
- where an EUTM application has been withdrawn by the applicant (Article 49, Article 139(1)(a) EUTMR);
- where an EUTM application is considered to be withdrawn, namely when class fees have not been paid within the relevant time limit after filing the application (Article 41(5), Article 139(1)(a) EUTMR);
- where an EUTM registration ceases to have effect (Article 139(1)(b) EUTMR), that is, in the following circumstances:
  - where an EUTM registration has been validly surrendered (Article 57 EUTMR);
  - where an EUTM registration has not been renewed (Article 53 EUTMR);
  - where an EUTM registration has been declared invalid by the Office or by a European Union trade mark court (Articles 62 and 128 EUTMR);
  - where the rights of the proprietor of an EUTM registration have been revoked by the Office or by an EUTM court (Article 62 EUTMR) — except in the case of revocation for non-use, unless the mark was genuinely used under the laws of the Member State for which conversion has been requested (Article 139(2) EUTMR) (see paragraph 4.1 below).

2.2 Conversion of IRs designating the EU

The holder of an IR designating the EU may request the conversion of the designation of the EU:

- into national trade mark applications in one, several or all Member States;

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- into subsequent designations of one or more Member States under the Madrid Protocol ('opting back'), provided that the Member State was a party to either Treaty, not only at the time of the request for conversion, but also on the date of the designation of the EU;
- into national trade mark applications for some Member States and subsequent designations for other Member States. The same Member State may only be selected once.

IR conversion is possible in the following circumstances ('grounds for conversion') where the designation of the EU in an IR ceases to have effect:

- where the effects of an IR designating the EU have been invalidated by the Office or an EUTM court (Article 198 EUTMR, Article 34 EUTMIR);
- where a limitation of the list of goods and services for the EU has been recorded in the International Register (Rule 25(1)(a)(ii), Rule 27(1) Regulations under the Protocol) (see paragraph 6.2.7 and also the Guidelines, Part M, International Marks, Section 3, The EUIPO as Designated Office, paragraph 3.8, Limitations of the list of goods and services)([92]);
- where a renunciation of the designation of the EU has been recorded in the International Register (Rule 25(1)(a)(iii), Rule 27(1) Regulations under the Protocol);
- where the Office is informed by WIPO that the IR has not been renewed for the EU, provided that the grace period for renewal is over (Rule 31(4)(b) Regulations under the Protocol);
- where an IR designating the EU has been finally refused by the Office (Article 78(5)(b) and (c) EUTMDR, Article 33(2)(b) and (c) EUTMIR);
- where the partial or total cancellation of the IR has been recorded in the International Register (Rule 25(1)(a)(v), Rule 27(1) Regulations under the Protocol);

Conversion may be requested for all or for some of the goods or services to which the abovementioned act or decision relates.

Where the abovementioned act or decision relates only to some of the goods and services for which the application was filed or registered, conversion may be requested only for those specific goods or services, or for a part of those goods or services.

'Opting back' may not be requested:

- where the cancellation of the IR has been recorded in the International Register, either totally or partially (Rule 25(1)(a)(v), Rule 27 Regulations under the Protocol). In this case, only national conversion is available for the goods and services affected by the cancellation;
- Where the IR has not been renewed for all the Contracting Parties designated, and the grace period for the renewal is over (Rule 31(4)(a) Regulations under the Protocol);
- where the IR has been cancelled because the basic application, the ensuing registration or the basic registration has ceased to have effect (Rule 22 Regulations

92 Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as in force on 01/02/2020).

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under the Protocol); only transformation is available in such cases for the goods and services affected by the cancellation (Article 9*quinquies* MP).

3 Valid EUTM Application as a Condition for Conversion

Article 139(1) EUTMR

Where conversion is requested on the basis of an EUTM application, conversion is possible only if there is a valid EUTM application (see the Guidelines, Part B, Examination, Section 2, Formalities).

4 Grounds precluding conversion

Article 93, Articles 139(2), 140(1), (3) and (4), and 202(6), (7) and (9) EUTMR

When the relevant Office decision has become 'final' (15/10/2024, R 479/2024-G, Opinion on Conversion and Non-Final Refusal Decisions, § 112-118),conversion will not take place in the following circumstances:

- where a registered EUTM or IR designating the EU has been revoked on the grounds of non-use and there was no use that would be considered genuine use under the laws of the Member State for which conversion is requested (see paragraph 4.1 below); or
- where the particular ground for which the EUTM application or registered EUTM or IR designating the EU has ceased to have effect would preclude registration of the same trade mark in the Member State concerned (see paragraph 4.2 below). Therefore, a request for conversion of a rejected EUTM will not be admissible in the Member State to which the grounds for refusal, invalidity or revocation apply.

Furthermore, without prejudice to Article 139(2) EUTMR, conversion will not take place where it relates to an application for an EU certification mark or to a registered EU certification mark, and the national law of the Member State concerned does not provide for the registration of guarantee or certification marks pursuant to Article 28 of Directive (EU) 2015/2436 approximating the laws of the Member States relating to trade marks.

4.1 Revocation on the grounds of non-use

Article 139(2)(a) EUTMR

The first reason for precluding conversion is when the rights of the EUTM proprietor or IR holder have been revoked on the grounds of non-use.

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Conversion will not take place where the rights of the EUTM proprietor or of the IR holder have been revoked on the grounds of non-use, unless the EUTM or IR has been put to use that would be considered genuine use under the laws of the Member State for which conversion is requested.

4.2 Ground for refusal limited to a Member State or extended to the entire EU

Article 139(2)(b) and Article 140(4) EUTMR

The second reason for precluding conversion is related to grounds for refusal, for revocation (other than non-use) or for a declaration of invalidity. It applies when the decision of the Office or of a European Union trade mark court expressly states that the ground for refusal, for revocation or for invalidity applies in respect of a particular Member State, and precludes conversion for that Member State (05/03/2009, R 1619/2008-2, ORANGE (col.), § 23-24).

Examples

- Where an absolute ground for refusal exists only for one language, conversion will not take place in respect of the Member States where that language is an official language. For example, if an absolute ground for refusal was raised in relation to the English-speaking public, conversion would not take place in respect of Ireland and Malta (see Article 140(4) EUTMR).
- Where an absolute ground for refusal exists only for one Member State, which may be because the trade mark is descriptive or deceptive only in a particular Member State and not in other Member States (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal), conversion will not take place in respect of that Member State, but may be requested for all the Member States in which the ground for refusal has not been found to exist.
- Where an EUTM application or IR designating the EU has been refused in an opposition based on an earlier national trade mark in a specific Member State, conversion will not take place in respect of that Member State. When the opposition is based on a number of earlier rights from different Member States but the final decision rejects the EUTM application or the IR designating the EU on the basis of only **one** of those earlier rights, conversion may be requested for the remaining Member States. For example, if an opposition based on a French, an Italian, and an Irish national right is successful with regard to the Irish national right, and if there is no analysis of the other earlier rights, conversion will not take place for Ireland, but may take place for Italy and France (and all other Member States) (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, T-194/05, Teletech International, EU:T:2006:124).
- According to Article 140(4) EUTMR, applicable by analogy to IRs designating the EU in accordance with Article 202(8) EUTMR, where an EUTM application has been refused or an EUTM registration has been declared invalid on relative grounds

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based on an earlier EUTM or another European Union industrial property right, this has the effect of excluding conversion for the entire European Union, even if likelihood of confusion exists only in part of it.

Where an EUTM or IR designating the EU has been declared invalid in invalidity proceedings on the grounds of Article 59(1)(b) EUTMR ('bad faith'), this has the effect of excluding conversion for the entire European Union.

4.3 Withdrawal/surrender after a decision has been rendered

Where the applicant withdraws the EUTM application or the owner surrenders the EUTM, or where the holder renounces the designation of the EU during the appeal period of a decision by first instance and subsequently requests conversion, the request will be forwarded to the respective Member State(s).

If the applicant, owner or holder files an appeal and subsequently withdraws or limits the refused application, or surrenders (partially or totally) the invalidated or revoked EUTM or designation and then requests a conversion, the withdrawal, limitation or surrender will be forwarded to the competent Board and may be put on hold pending the outcome of the appeal proceedings (24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 43; 22/10/2010, R 463/2009-4, MAGENTA (col.), § 25-27; 07/08/2013, R 2264/2012-2, SHAKEY'S). Only after the withdrawal, limitation or surrender has been processed will the conversion either be forwarded as admissible to all the Member States where conversion is requested, or refused, depending on the outcome of the assessment of the request (see also the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1, Part D, Cancellation, Section 1, Cancellation proceedings, paragraph 4.3 and Part E, Register operations, Section 1, Changes in a registration, paragraph 1).

For information on the suspension of the registration of surrenders during cancellation proceedings, see the Guidelines, Part D, Cancellation, Section 1, Cancellation proceedings, paragraph 4.3.

4.4 Competence to decide on grounds precluding conversion

Article 140(1) and (3) EUTMR

The Office will decide whether the request for conversion fulfils the conditions set out in the Regulations in conjunction with any final decisions (their operative part and reasons) that gave rise to the conversion.

If one of the grounds precluding conversion exists, the Office will refuse to forward the request for conversion to the respective national office or, in the case of an opting-back conversion, will refuse to forward the conversion to WIPO as a subsequent designation for the Member States for which conversion is precluded.

Obsolete

5 Formal Requirements for the Request for Conversion

5.1 Time limit

A general time limit of three months applies for requesting conversion. The start of the time limit depends on the ground for conversion.

The time limit may not be extended.

Furthermore, the continuation of proceedings cannot be requested for this time limit (Article 105(2) EUTMR). However, *restitutio in integrum* is, in principle, possible.

5.1.1 Start of time limit where the Office issues a notification

Article 139(4) EUTMR

Where an EUTM application is considered to be withdrawn, a request for conversion may be filed within three months from the date of the corresponding notification from the Office.

The notification will be contained in the communication on the loss of rights.

5.1.2 Start of time limit in other cases

Article 139(5) and (6) EUTMR

In all other cases the time limit of three months for requesting conversion starts automatically, namely:

- where the EUTM application is withdrawn, on the day the withdrawal is received by the Office;
- where the EUTM is surrendered, on the day on which the surrender is entered in the EUTM Register, that is, the day on which it becomes effective pursuant to Article 57(2) EUTMR;
- where protection of the IR has been limited or renounced with effect for the EU, on the day on which it is recorded by WIPO pursuant to Rule 27(1)(b) Regulations under the Protocol;
- where the EUTM registration was not renewed, on the day following the last day of the period within which a request for renewal may have been submitted pursuant to Article 53(3) EUTMR, that is, six months after the expiry of the registration;
- where the IR was not renewed with effect for the EU, on the day following the last day on which renewal was still possible before WIPO, pursuant to Article 7(4) MP;
- where the EUTM application or IR designating the EU is rejected, on the day on which the decision becomes final;

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- where the EUTM or IR designating the EU is declared invalid or revoked, on the day on which the decision of the Office or the judgment of the EUTM court becomes final.

A decision of the Office becomes final:

- when no appeal has been lodged, at the end of the two-month time limit for appeal pursuant to Article 68 EUTMR;
- following a decision of the Boards of Appeal, at the end of the time limit for an appeal to the General Court, or, where applicable, with the final decision of the Court of Justice.

A decision of an EUTM court becomes final:

- when no appeal has been lodged, at the end of the time limit for appeal under national law;
- in all other cases, with the final decision of the EUTM court of final (second or third) instance.

For example, if an EUTM is rejected by a decision of the Office on absolute grounds for refusal that is **notified** on 11/11/2011, the decision becomes final on 11/01/2012. The three-month period for requesting conversion ends on 11/04/2012. Regarding subsidiary claims of acquired distinctiveness pursuant to Article 7(3) EUTMR and Article 2(2) EUTMIR, the deadline for conversion does not start to run until a decision on the subsidiary claim of acquired distinctiveness becomes final.

5.2 Request for conversion

Article 140(1) EUTMR Article 65(2)(a), (b) EUTMDR

The request for conversion must be filed at the Office. The online form can be found on the Office's website at: https://www.euipo.europa.eu/en/online-services.

The 'Application for Conversion of an IR designating the EU' form can be found on the Office's website at: https://www.euipo.europa.eu/en/online-services/international-application. This form may also be used for opting back. The Office will send the conversion data to WIPO in electronic format.

Using the forms made available by the Office enables it to extract the relevant information concerning the converted EUTM and the data concerning the applicant and representative from its database and to transmit them, together with the Conversion Form, to the designated offices.

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Article 140(1) EUTMR

Article 22 EUTMIR

Applicants or their representatives must provide the following information (Article 22 EUTMIR).

- The name and address of the applicant for conversion, that is, the applicant or proprietor of the EUTM application or registration, or the holder of the IR;
- The filing number of the EUTM application or the registration number of the EUTM or of the IR;
- The indication of the ground on which conversion is requested:
  - where conversion is requested following the withdrawal of the application, the date of withdrawal must be indicated;
  - where conversion is requested following failure to renew the registration, the date on which protection expired must be indicated;
  - where conversion is requested following the surrender of an EUTM, the date on which it was entered in the Register must be indicated;
  - where conversion is requested following a partial surrender, the goods or services for which the EUTM no longer has protection and the date on which the partial surrender was entered in the Register must be indicated;
  - where conversion is requested following a limitation, the goods or services for which the EUTM application no longer has protection and the date of limitation must be indicated;
  - where conversion is requested because the mark ceases to have effect as a result of a decision of a European Union trade mark court, the date on which that decision became final must be indicated, and a copy of that decision, which may be in the language in which the decision was given, must be submitted;
  - where conversion is requested because an IR designating the EU has been finally refused by the Office, the date of the decision must be indicated;
  - where conversion is requested because the effects of an IR designating the EU have been declared invalid by the Office or by an EUTM court, the date of the decision of the Office or the date on which the judgment of the EUTM court became final must be indicated, with a copy of the judgment attached;
  - where conversion is requested because the designation of the EU has been renounced or cancelled before WIPO, the date on which it was recorded by WIPO must be indicated;
  - where conversion is requested because the IR designating the EU has not been renewed, and provided that the grace period for renewal is over, the date on which the protection expired must be indicated.
- The indication of the Member State or the Member States for which conversion is requested; for an IR, it must also be indicated whether conversion is requested into a national application for that Member State or into a designation of the Member State under the Madrid Protocol. With regard to Belgium, the Netherlands and Luxembourg, conversion may be requested only for these three countries together, not separately. The conversion form made available by the Office only allows

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for Belgium, the Netherlands and Luxembourg to be designated together. If the applicant indicates only one of these three countries, the Office will consider it to be a request for conversion for Belgium, the Netherlands and Luxembourg and will forward the request to the Benelux Office for Intellectual Property (BOIP);

- Where the request does not relate to all of the goods or services for which the application has been filed or for which the EUTM has been registered, an indication that it relates only to a part of the goods and services for which the application was filed or registered together with an indication of the goods and services for which conversion is requested;
- An indication that conversion is requested for different goods and services with respect to different Member States, together with an indication of the respective goods and services for each Member State.

The request for conversion may also contain the appointment of a representative before a designated national office, if the relevant boxes in the Annex to the Conversion Form are ticked. This indication is voluntary and is not relevant for the conversion procedure before the Office. However, it will be useful for the national offices when they receive the request for conversion, as they will be able to communicate immediately with a representative who is authorised to practise before them (see paragraph 6 below).

5.3 Language

Article 146(6) and Article 206 EUTMR

Where the request for conversion is made in respect of an EUTM application, it must be filed in the language in which the EUTM application was filed or in the second language indicated therein.

Where the request for conversion is made in respect of an IR designating the EU before a statement of grant of protection has been issued pursuant to Article 79 EUTMDR, the request must be filed in the language in which the international application was filed with WIPO or in the second language indicated therein.

Article 146(6) and Article 206 EUTMR

Where the request is made in respect of an EUTM registration, it may be filed in any of the five languages of the Office.

Where the request for conversion is made in respect of an IR designating the EU after a statement of grant of protection has been issued, the request may be filed in any of the five languages of the Office, except in the case of an ‘opting-back’ conversion, when the request must be filed in English, French or Spanish.

However, when the request for conversion is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may be used in any of the official languages of the Union, provided that textual elements are completed in one of the languages of

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the Office. This concerns, in particular, the list of goods and services in a request for partial conversion. In the event of a partial 'opting-back' conversion, the list of goods and services must be filed in English, French or Spanish.

5.4 Fees

Articles 140(1) and (3), 180(3) and Annex I A(23) EUTMR

The request for conversion, including for conversion of an IR designating the EU, is subject to payment of a fee of EUR 200. The request will not be considered to be filed until the conversion fee has been paid. This means that the conversion fee must be paid within the abovementioned time limit of three months. A payment made after expiry of that period will be considered to have been made in due time if the person concerned submits evidence that the payment was made to a bank or a transfer order placed, in a Member State and within the period of three months and if, at the time of payment, a surcharge of 10 % of the total amount due was paid (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

6 Examination by the Office

6.1 Stages of the procedure – competence

Article 140 EUTMR
Article 111(3)(p) EUTMR Article 23 EUTMIR

The Office will deal with requests for conversion by:

- registering and publishing the receipt of a request for conversion;
- examining the request; and
- either transmitting the request to the designated offices or rejecting it.

6.2 Publication of the request and entry in the Register

Article 111(3)(p) and Article 140(2) EUTMR

Irrespective of its acceptance, a request for conversion that is considered to have been filed because the required fee has been paid (and provided that the request for conversion is of a published EUTM application or a registered EUTM), the Office will make an entry in the Register of European Union trade marks recording the receipt

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of the request for conversion. This request for conversion is also published in the EUTM Bulletin if the EUTM application has already been published in accordance with Article 44 EUTMR.

The entry and the publication exclusively reflect that a request has been filed.

The entry in the Register and the publication of the receipt of the request for conversion contain the indications referred to in Article 23 EUTMIR and, unless it concerns an IR designating the EU, must refer to the previous publication in the EUTM Bulletin and the date of the application for conversion.

Articles 40(1) and 202(5), (6), (7) and (8) EUTMR Article 23 EUTMIR

The lists of goods and services for which conversion is requested will not be published if the conversion is for an IR designating the EU.

6.3 Examination

The examination of the request for conversion by the Office relates to the following points:

- fees
- time limit
- language
- formalities
- grounds
- representation
- partial conversion.

6.3.1 Fees

Articles 140(3) and 202(6) EUTMR

The Office will examine whether the conversion fee has been paid within the applicable time limit.

Where the conversion fee has not been paid within the applicable time limit, the Office will inform the applicant that the request for conversion is considered not to have been filed. Any fees paid late will be reimbursed.

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6.3.2 Time limit

Articles 140(3) and 202(6) EUTMR

When the request for conversion is considered to have been filed because the conversion fee has been paid within the applicable time limit (see paragraph 6.3.1 above), the Office will examine if the request has been filed within the time limit of three months.

Where the request for conversion was not filed within the relevant time limit but payment was received on time, the Office will reject the request as inadmissible. Any fees paid will not be reimbursed.

6.3.3 Language

Article 146(6) and Article 206 EUTMR

The Office will examine whether the request has been filed in the correct language.

When the request is filed in a language that is not one of the acceptable languages for the conversion procedure (see paragraph 5.3 above), the Office will send a deficiency letter to the applicant and specify a period within which it may amend the request for conversion. If the applicant fails to respond, the request will not be dealt with and will be considered not to have been filed. Any fees paid will not be reimbursed.

6.3.4 Formalities

Article 22(b), (d) and (e) EUTMIR

The Office will examine whether the request complies with the formal requirements of the EUTM Regulations (see paragraph 5 above).

Where the applicant for conversion has not used the Conversion Form made available by the Office, and where the deficiency lies in the applicant not having indicated the elements referred to in Article 22(b), (d) or (e) EUTMIR, either the applicant will be invited to submit the missing information or, where the information may be readily ascertained from data available to the Office, the Office will be considered as having been authorised to make available the relevant extracts from its database to the designated offices.

6.3.5 Grounds

Articles 139(2) and 202(8) EUTMR

The Office will examine:

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- whether one of the grounds for conversion referred to in paragraph 2 exists;
- whether one of the grounds precluding conversion referred to in paragraph 4 exists;
- for an opting-back conversion, whether it would have been possible at the date of the IR to designate the Member State concerned in an international application;
- for partial conversion, whether the goods and services to be converted were in fact contained in, and do not go beyond, the goods and services of the EUTM or IR designating the EU when it lapsed or ceased to have effect (see paragraph 6.2);
- for partial conversion in the sense that part of the EUTM or IR designating the EU remains valid, if the goods and services to be converted overlap with the goods and services for which the mark remains valid (see paragraph 6.2).

The aim of these last two examination steps is to avoid conversion for more or broader goods and services than have been refused or cancelled.

When the request for conversion does not comply with any of the other mandatory elements and indications referred to in paragraphs 4 and 5.2, the Office will send a deficiency letter to the applicant and specify a period within which it may amend the request for conversion. If the applicant fails to respond, the request will not be dealt with and will be considered not to have been filed. Any fees paid will not be reimbursed.

6.3.6 Representation

Articles 119(3) and 120(1) EUTMR Article 74(1) to (3) EUTMDR

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation). The applicant for conversion may appoint a new or an additional representative (legal practitioner or Office professional representative) for the conversion procedure.

Any authorisation to act on behalf of the applicant or proprietor extends only to acts before the Office. Whether a representative appointed for proceedings before the Office may act before the national office in respect of the resulting national application and, if so, whether they need to submit an additional authorisation, is determined by the national law concerned.

6.3.7 Partial conversion

Article 139(1) EUTMR Article 22(e) EUTMIR

Where conversion is requested only for some of the goods and services, or for different goods and services for different Member States (‘partial conversion’), the Office will examine whether the goods and services for which conversion is requested are

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contained within the goods and services for which the ground for conversion applies. The same criteria apply for this assessment as for similar procedural situations, such as the restriction of an application or partial refusal in opposition proceedings.

Where an application is refused in part or a registration is declared invalid or revoked in part, conversion may be requested only for the goods or services for which the application was refused or the registration was declared invalid or revoked, and not for the goods or services for which the application or registration remains valid.

Where an application is limited, or a registration is partially surrendered, conversion may be requested only for the limited or partially surrendered goods or services, and not for the goods or services for which the application or registration remains valid. However, please refer to paragraph 4.3 above when such a limitation or partial surrender takes place following a decision.

The applicant must indicate in the abovementioned cases the goods and services for which conversion is requested. Expressing the limitation in a negative way, such as by using expressions of the type 'beverages with the exception of ...', is admissible in the same way that such an expression is admissible when filing or restricting an EUTM application or partially surrendering an EUTM registration (see the Guidelines, Part B, Examination, Section 3, Classification).

6.4 Transmission to designated offices

Articles 140(3) and (5) and 141(1) EUTMR

Once the Office has completed examination of the request for conversion and has found it to be in order, it will transmit the request without delay to the designated offices. The transmission will be made irrespective of whether any required publication has already taken place.

The Office will send a copy of the request for conversion to the designated offices and make available to them an extract of its database containing the data referred to in Article 111(2) EUTMR of the converted EUTM or IR. Any central industrial property office to which the request for conversion is transmitted may obtain from the Office any additional information concerning the request, which will enable that office to make a decision regarding the national trade mark resulting from the conversion.

Article 140(5) EUTMR

At the same time, the Office will inform the applicant for conversion of the date of transmission to the designated offices.

In the case of an opting-back conversion, WIPO will deal with the request as a subsequent designation in accordance with Rule 24(6), (7) Regulations under the Protocol.

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If a national office is the designated office, conversion will result in a national application or registration.

Article 141(3) EUTMR

The national law in force for the Member States concerned may provide that the request for conversion be subject to one, or all, of the following requirements:

- payment of a national application fee;
- filing of a translation of the request and its accompanying documents in one of the official languages of the Member State in question. In particular, for applications for conversion prior to publication of the EUTM, the national office will usually require a translation of the list of goods and services;
- indication of an address for service in the Member State in question;
- submission of a representation of the mark in a number of copies specified by that Member State.

National rules on the appointment of a domestic representative remain applicable. Where use is made of the option in the Conversion Form to indicate a representative for the purposes of the procedure before a specific national office, that national office will be in a position to communicate directly with that representative so no separate communication to appoint a domestic representative will be necessary.

Article 141(2) EUTMR

National law may not subject the request for conversion to any formal requirements different from or additional to the requirements provided for in the EUTM Regulations.

7 Effects of Conversion

Article 139(3) EUTMR

In each Member State concerned, the national trade mark application resulting from the conversion will enjoy the filing date or the date of priority, if any, of the EUTM application, as well as the seniority of an earlier trade mark with effect for that Member State validly claimed for the EUTM application or registration under Article 39 or 40 EUTMR. For information on conversion of an EUTM into national trade mark applications for new Member States, see the Guidelines, Part A, General Rules, Section 9, Enlargement.

In the event of an opting-back conversion, the international application resulting from the subsequent designation of the Member State under Rule 24(6)(e) and (7) Regulations under the Protocol will enjoy the original date of the IR designating the EU, that is, either the actual date of the IR (including, if appropriate, its priority date) or the date of the subsequent designation of the EU.

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However, there is no harmonised procedure for how national offices will proceed with the examination of the converted EUTM. As mentioned in the introduction, the conversion procedure is a two-tier system, where the second tier, the conversion procedure itself, is dealt with by the national offices. Depending on national law, the converted trade mark will either be registered immediately or will enter the national examination, registration and opposition procedure like any other national trade mark application.

National applications deriving from the conversion of an earlier EUTM (application) are considered to come into existence as soon as a valid request for conversion is filed. Therefore, in opposition proceedings, such rights will be considered properly identified for admissibility purposes under Article 2(2)(b)(i) EUTMDR if the opponent indicates the number of the EUTM (application) under conversion and the countries for which it has requested conversion.

When, during opposition or invalidity proceedings on relative grounds, the EUTM application (or EUTM) on which the opposition is based ceases to exist or the list of goods and services is restricted, but at the same time a request for conversion is filed, the opposition or invalidity proceedings can continue. This is because national trade mark registrations resulting from a conversion of an EUTM application (or EUTM) can constitute the basis of the opposition or invalidity procedure originally made on the basis of that EUTM application or registration (15/07/2008, R 1313/2006-G, cardiva (fig.) / cardima (fig.)) (see also the Guidelines, Part C, Opposition, Section 1,Opposition Proceedings, paragraph 4.2.2.2).

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GUIDELINES FOR EXAMINATION

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Section 3

EUTMs and REUDs as objects of property

Chapter 1

Transfer

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1 Introduction

Article 1(2), Articles 19, 20, 27 and 28, Article 111(1) and Article 111(3)(g) EUTMR
Articles 27, 28 and 34 EUDR
Article 23 and Article 72(3)(j) EUDR

A transfer is the change in ownership of the property rights in a European Union trade mark (EUTM) or an EUTM application from one entity to another. EUTMs and EUTM applications may be transferred from the current proprietor to a new proprietor, primarily by way of assignment or legal succession. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

The transfer may be limited to some of the goods or services for which the mark is registered or applied for (partial transfer). In contrast to a licence or conversion, the transfer of an EUTM cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for **some** territories or Member States.

Both registered European Union designs (REUDs) and applications for an REUD may also be the subject of a transfer.

The provisions in the EUDR and EUDIR dealing with the transfer of registered European Union designs are almost identical to the equivalent provisions of the EUTMR, EUTMDR and EUTMIR. **Therefore, the following applies *mutatis mutandis* to REUDs. Exceptions and specific provisions for REUDs are detailed in paragraphs 3 and 7 below.**

On request of one of the parties, transfers of EUTMs are entered in the EUTM Register.

According to Article 20 EUTMR, the registration of a transfer is not a condition for its validity. However, if a transfer is not registered by the Office, the successor may not invoke the rights arising from the EUTM. Moreover, the new proprietor will not receive communications from the Office, in particular, during *inter partes* proceedings, nor the notification of the renewal period of the mark. Furthermore, according to Article 19 EUTMR, in all aspects of the EUTM as an object of property that are not further defined by provisions of the EUTMR, the proprietor's address defines the applicable subsidiary national law. Consequently, it is important to register a transfer at the Office to ensure that entitlement to EUTMs and EUTM applications is clear.

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1.1 Transfers

Article 20(1) and (2) EUTMR Article 28 EUDR

A transfer of an EUTM involves two aspects, namely the validity of the transfer between the parties and the impact of a transfer on proceedings before the Office, which will only be triggered after the entry of the transfer in the EUTM Register (see paragraph 1.2 below).

Regarding the validity of the transfer between the parties, the EUTMR allows an EUTM to be transferred independently of any transfer of the undertaking to which it belongs (30/03/2006,C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 45 and 48).

1.1.1 Assignment

Article 20(3) EUTMR Article 28 EUDR

When a transfer is made by an assignment, it is only valid where the assignment is made in writing and is signed by both parties, except where the assignment is the result of a court decision, or a decision taken by the Office under Article 21 EUTMR. This formal requirement for the validity of the transfer of an EUTM is applicable irrespective of whether, under the national law governing transfers of (national) trade marks, an assignment is valid without observing a particular form, such as the need for the transfer to be in writing and have the signatures of both parties.

However, the change of ownership of REUDs due to entitlement proceedings before a national authority are not processed through a transfer but through a change in the ownership resulting from the final decision under Article 15 EUDR.

1.1.2 Inheritance

When the proprietor of an EUTM dies, the heirs will become proprietors of the EUTM by way of individual or universal succession. This is also covered by the rules on transfers.

1.1.3 Merger

A universal succession also exists when there is a merger between two companies that leads to the formation of a new company, or an acquisition by one company taking over another. Where the whole of the undertaking to which the mark belongs is transferred, there is a presumption that the transfer includes the EUTM unless, in accordance with

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the law governing the transfer, an agreement to the contrary was made or unless circumstances clearly dictate otherwise.

1.1.4 Applicable law

Article 19 EUTMR Article 27 EUDR

Unless provided otherwise by the EUTMR, transfers are subject to the national law of a Member State determined by Article 19 EUTMR. The national law applicable under that provision is the national law in general and, therefore, also includes private international law which, in turn, may refer to the law of another State.

1.2 Legal effects of the transfer

Article 20(11) EUTMR
Article 27 EUTMR Article 13 EUTMIR Article 28 EUDR Article 23 EUDIR

As long as the transfer has not been entered in the EUTM or EUD Register, the successor in title may not invoke the rights arising from the registration of the EUTM or the REUD (see *mutatis mutandis* 16/01/2020, T-128/19, Sativa, EU:T:2020:3, § 22, 25-26). The transfer has effects with regard to third parties only after entry in the Register. This does not apply to third parties who acquired rights in the EUTM before the transfer was registered, and knew about the transfer when they acquired those rights.

This also applies to a transfer based on the implementation of a decision, even if the judgment established proprietorship with previous or *ex tunc* effect (see paragraph 7).

However, in the period between the date when the Office receives the application to register a transfer and the date of registering the transfer, the new proprietor may already make submissions to the Office with a view to observing time limits. For example, if a party has applied to register the transfer of an EUTM application against which the Office has raised objections on absolute grounds, the new proprietor may reply to those objections (see paragraph 6).

In an application for registration of a transfer, the Office will only examine whether sufficient evidence of the transfer has been submitted.

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For changes of ownership following national entitlement proceedings regarding REUDs, see paragraph 3.

2 Transfers v Changes of Name

Article 55 EUTMR Article 19 EUDIR

A transfer must be distinguished from a change of name of the proprietor.

A change in the name of the proprietor is a change that does not affect the identity of the proprietor, whereas a transfer is a change in the identity of the proprietor.

In particular, no transfer is involved when a natural person changes their name due to marriage, or following an official procedure for changing a name, or when a pseudonym is used instead of the proper name, etc. In all these cases, the identity of the proprietor is not affected.

Where the name or the corporate status of a legal person changes, the criterion for distinguishing a transfer from a mere change of name is whether or not the identity of the legal person remains the same. If the identity remains the same, it will be registered as a change of name (06/09/2010, R 1232/2010-4 , Cartier, § 12-14). In other words, where there is no termination of the legal entity (such as would occur in the case of a merger by acquisition, where one company is completely absorbed by the other and ceases to exist) and no start-up of a new legal entity (e.g. as would be the case following the merger of two companies leading to the creation of a new legal entity), there is only a change in the formal corporate organisation that already existed, and not in the actual identity itself. Therefore, the change will be registered as a change of name, where appropriate.

For example, if an EUTM is in the name of Company A and, as the result of a **merger** , this company is absorbed by Company B, there is a **transfer** of assets from Company A to Company B.

Likewise, during a **division** of Company A into two separate entities, one being the original Company A and the other being a new Company B, if the EUTM in the name of Company A becomes the property of Company B, there is a **transfer** of assets.

Normally, there is no transfer if the company registration number in the national register of companies remains the same.

However, there is in principle the prima facie presumption that there is a transfer of assets if there is a change of country (see, however, 06/11/2013, R 546/2012-1 , PARFUMS LOVE / LOVE et al.).

If the Office has any doubt about the national law applicable to the legal person concerned, it may require appropriate information from the applicant for registration of the change of name.

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Therefore, unless ruled to the contrary under the applicable national law, the change of company type, provided that it is not accompanied by a transfer of assets carried out by means of a merger or an acquisition, will be treated as a change of name and not as a transfer.

However, if the change of company type is the result of a merger, a division or a transfer of assets, depending on which company absorbs or is separated from the other, or on which company transfers which assets to the other, it may be a case of transfer.

2.1 Erroneous application to register a change of name

Articles 55(1), (3) and (5) and 162(1) EUTMR Article 71 EUDR Article 19(1), (5) and (7) EUDIR

When a request is made to register a change of name, but the evidence shows that it is actually a transfer of an EUTM, the Office informs the applicant accordingly and invites it to file an application for registration of a transfer within a specified period. If the applicant agrees or does not submit evidence to the contrary and files the corresponding application to register a transfer, the transfer will be registered. If the applicant does not modify its request and insists on registering the change as a change of name, or if it does not respond, the request to register a change of name will be rejected. The party concerned may file an appeal against this decision.

A new application for the registration of the transfer may be filed at any time.

2.2 Erroneous application for the registration of a transfer

Article 20(5) and (7) EUTMR Article 23(1) and (5) EUDIR

When an application is made to register a transfer, but what is involved is actually a change of name of an EUTM, the Office informs the applicant accordingly and invites it to give, within a specified period, its consent to register the indications concerning the proprietor in the EUTM Register. If the applicant agrees, the change of name will be registered. If the applicant does not agree and insists on registering the change as a transfer, or if it does not respond, the application for the registration of a transfer will be rejected.

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3 Transfers v changes of ownership due to entitlement proceedings for REUDs

Articles 15 and 16 EUDR

Regarding REUDs, a transfer must be distinguished from a change of ownership following entitlement proceedings.

Pursuant to Article 15 EUDR, REUDs may be the subject of entitlement proceedings. Changes in ownership that arise from a final decision of the competent authority or court of the respective Member State are entered in the EUD Register upon request. For more information, see the Guidelines, Part E Register Operations, Section 3, Chapter 2 Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, paragraph 8.2.

There are, in particular, the following differences between changes of ownership arising out of transfers and entitlement proceedings:

- Request to the Office: The rules regarding the proof for the request are different, see for entitlement proceedings the Guidelines, Part E Register Operations, Section 3, Chapter 2 Licenses, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, paragraph 8.2. and for transfers, paragraph 4.5, below. Moreover, how the request can be submitted within the user area is different. For entitlement proceedings, the user must chose the 'communications back-up'. For transfers, the user area provides a specific e-action in the 'recordals' section .
- Register entries and their effect: the entries in the EUD Register differ. Entitlement proceedings may be entered in the register as of their initiation. This freezes the REUD and prevents the registered holder from performing any acts that may prevent the legitimate holder from exercising rights over the REUD (e.g. transfers the design) (for the legal effects of transfers see paragraph 1.2).
- Licences: While the registration of a transfer might not affect existing licences, licences will lapse upon the entry into the EUD Register of a change of ownership resulting from entitlement proceedings (Article 16(1) EUDR).

Persons entitled under Article 14 EUDR should inform the Office immediately about the initiation and the result of entitlement proceedings before national courts or authorities.

The option of a claim to entitlement applicable to REUDs does not exist for EUTMs. Judgments on the proprietorship of an EUTM must be implemented by means of a transfer, as seen in paragraph 1.2.

4 Requirements for an application for registration of a transfer

It is strongly recommended that the application for registration of a transfer for an EUTM be submitted electronically via the Office's website (e-recordals). Using

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e-recordals has advantages, such as the automatic receipt of electronic confirmation of the application, and the possibility to use the manager feature to complete the form quickly for as many EUTMs as required.

4.1 Languages

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

The application for the registration of a transfer for an EUTM application must be made in the first or second language of the EUTM application.

Article 146(6) EUTMR Article 80(c) EUDIR

The application for the registration of a transfer for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of a transfer is filed using the form provided by the Office pursuant to Article 65(1)(e) EUTMDR or Article 68 EUDIR, according to Article 146(6) EUTMR and Article 80(c) EUDIR, the form may be used in any of the official languages of the European Union, provided that it is completed in one of the languages of the Office, as far as textual elements are concerned.

When the application for the registration of the transfer relates to more than one EUTM application, the applicant must select a language for the application that is common to all the EUTMs concerned. If there is no common language, separate applications for registration of the transfer must be filed.

When the application for the registration of the transfer relates to more than one EUTM registration, the applicant must select one of the five languages of the Office as a common language.

Article 24 EUTMIR Article 81(2) EUDIR

Any supporting documents may be filed in any official language of the European Union. This applies to any document submitted as proof of the transfer, such as a countersigned transfer document or a transfer certificate, a deed of assignment or an extract from a trade register or a declaration agreeing to register the successor in title as the new proprietor.

When the supporting documents are submitted in an official language of the European Union that is not the language of the proceedings, the Office may require a translation

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into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

4.2 Application for registration of a transfer filed for more than one mark

Article 20(8) EUTMR Article 23(6) EUDIR

A single application for the registration of a transfer for two or more EUTMs may be submitted only if the registered proprietor and beneficiary, or assignee, are the same in each case.

Separate applications are necessary when the original proprietor and the new one are not exactly identical for each mark. For example, this is the case where there is one successor in title for the first mark and there are multiple successors in title for another mark, even if the successor in title for the first mark is among the successors in title for the other mark. It is immaterial whether the representative is the same in each case.

When a single application is filed in such cases, the Office will issue a deficiency letter. The applicant may overcome the objection either by limiting the application for the registration of the transfer to those EUTMs or EUTM applications for which there is only one and the same original proprietor and only one and the same new proprietor, or by declaring its agreement that the application should be dealt with in two or more separate proceedings. Otherwise, the application for registration of a transfer will be rejected in its entirety. The party concerned may file an appeal against this decision.

4.3 Parties to the proceedings

Article 20(4) and Article 20(6)(b) EUTMR Article 13(3) EUTMIR Article 28(2) EUDR Article 23(4) EUDIR

The application for registration of a **transfer** may be requested at the Office by:

1. the EUTM proprietor(s), or
2. the EUTM proprietor(s) jointly with the assignee(s), or
3. the assignee(s), or
4. a court or authority.

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The formal conditions with which the application must comply depend on who submits the application.

4.4 Formal requirements

4.4.1 Indications concerning the EUTM and the new proprietor

Article 20(5) EUTMR Article 2(1)(b) and (e), and Article 13(1) EUTMIR Article 1(1)(b) and (e), and Article 23(1) and (2) EUDIR

The application for registration of a transfer must contain the following information.

1. The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the registration numbers must be indicated.
2. The details of the new proprietor. In the case of a natural person, the name, address and nationality must be indicated. In the case of a legal entity, the application must indicate the official designation and the legal form of the entity, which may be abbreviated in a customary manner (for example, S.L., S.A., Ltd., PLC). The company's national identification number may also be specified, if available. Both natural persons and legal entities must indicate the State in which they are domiciled or have their seat or an establishment. **The Office strongly recommends US companies to indicate, where applicable, the State of Incorporation, in order for it to differentiate clearly between different owners in its database.** These details correspond to the indications required for an applicant for a new EUTM application. However, where the Office has already assigned an ID number to the new proprietor, it is sufficient to indicate that number together with the name of the new proprietor.
   The form made available by the Office also requests an indication of the original proprietor's name. This indication will facilitate both the Office's and the parties' handling of the file.
3. If the new proprietor designates a representative, the representative's name and ID number assigned by the Office. If the representative has not yet been assigned an ID number, the business address must be indicated.

For additional requirements in cases of partial transfer, see paragraph 5 below.

4.4.2 Representation

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation).

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4.4.3 Signatures

Article 20(5), Article 20(6)(b), and Article 119(4) EUTMR Article 13(2) EUTMIR Article 23(1) and (4) EUDIR

The requirements concerning the person entitled to file the application for registration of the transfer and the signatures must be considered together with the requirement to submit proof of the transfer. The principle is that the signatures of the original proprietor and the new proprietor must appear together or separately on the application for registration of the transfer or in an accompanying document. In the case of co-ownership, and where the transfer concerns the ownership as a whole, all co-owners must sign or appoint a common representative.

When the original proprietor and the new proprietor both sign the application for registration of the transfer, this is sufficient and no additional proof of the transfer is necessary.

When the original proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration signed by the successor in title stating that it agrees to the registration of the transfer, this is sufficient and no additional proof is necessary.

When the new proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration, signed by the original proprietor, stating that it agrees to the registration of the successor in title as the new proprietor, this is also sufficient and no additional proof is necessary.

When the original proprietor's representative is also appointed as the new proprietor's representative, the representative may sign the application for registration of the transfer on behalf of both the original and the new proprietor, and no additional proof is necessary. However, when the representative signing on behalf of both the original and the new proprietor is not the representative on file (i.e. in an application simultaneously appointing the representative and transferring the EUTM), the Office will contact the applicant for registration of the transfer to request evidence of the transfer (authorisation signed by the original proprietor, proof of transfer, confirmation of the transfer by the original proprietor or its representative on file).

4.4.4 Proceedings affecting the transfer

The examination of the formal requirements for registering a transfer means taking into account facts that may have implications for the legality of that registration including the existence of insolvency proceedings at the national level (22/09/2021, T-169/20, Marina Yachting, EU:T:2021:609, § 68).

Where a judgment declaring the registered proprietor of a mark as insolvent has been entered in the Register, any subsequent application for registration of a transfer

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concerning the same mark will be automatically suspended and can only be acted upon with the express authorisation of the liquidator or the national court responsible for the insolvency proceedings. Where the Office registers a transfer but is made aware that the proprietor was insolvent at the relevant time, it may revoke the transfer.

Where the Office receives proof that ownership of a mark is being contested in a competent national court it will suspend any pending transfers until one of the parties has submitted a copy of the final decision of the dispute to the Office.

4.5 Proof of transfer

Article 20(2) and (3) EUTMR
Article 65(1)(e) EUTMDR
Article 13(1)(d) and Article 13(2) EUTMIR
Article 28 EUDR
Article 23(1)(d) and (4)(a) to (c) and Article 68(1)(c) EUDIR

A transfer may be registered only when it is proven by documents duly establishing the transfer, such as a copy of the deed of transfer. However, as already highlighted above, a copy of the deed of transfer is not necessary when:

- the new proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the original proprietor (or its representative) stating that it agrees to the registration of the transfer to the successor in title; or
- the original proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the new proprietor (or its representative) stating that it agrees to the registration of the transfer; or
- the application for registration of the transfer is signed by both the original proprietor (or its representative) and by the new proprietor (or its representative); or
- when the application for registration of the transfer is accompanied by a completed transfer form or document signed by both the original proprietor (or its representative) and by the new proprietor (or its representative).

Where proof of transfer is required, parties to the proceedings may also use the forms established under the Trademark Law Treaty available on WIPO's website (https://wipolex.wipo.int/en/treaties/textdetails/12680). The relevant forms are the 'Transfer Document' – a document conceived as constituting the transfer (assignment) itself – and the 'Certificate of Transfer' – a document in which the parties to a transfer declare that a transfer has taken place. Either of these documents, duly completed, constitutes sufficient proof of transfer.

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However, other means of proof are not excluded. Therefore, the agreement (deed) itself or any other document proving the transfer may be submitted.

Regarding confidentiality, the party submitting the proof must bear in mind that the content of files are available for public inspection, and this is particularly relevant where contracts or other documents are submitted as evidence for a transfer, as they may contain sensitive data. Consequently, certain information may be **blacked out** before being submitted to the Office, or certain pages may **be omitted altogether**. The evidence required in support of a transfer does not need to include commercially sensitive items such as the price paid for the EUTM in question.

While omitting the sensitive information is preferable, alternatively, the Regulations do provide for confidentiality to be invoked where the party concerned expresses a special interest in keeping part of the file confidential. For more information on the formal requirements for invoking confidentiality, see the Guidelines, Part E, Register Operations, Section 5, paragraph 5.1.3 'Parts of the file for which the party concerned expressed a special interest in keeping confidential'.

When the mark has been subject to multiple successive transfers and/or changes of the proprietor's name that have not been previously registered in the register, it is sufficient to submit the chain of evidence showing the events leading to the relationship between the original proprietor and the new proprietor without the need to file separate individual applications for each change.

When the transfer of the mark is the consequence of the transfer of the whole of the undertaking of the original proprietor, documents showing the transfer or assignment of the whole undertaking must be submitted.

When the transfer is due to a merger or another universal succession, the original proprietor will not be available to sign the application for registration of transfer. In this case, the application must be accompanied by supporting documents that prove the merger or universal succession, such as extracts from the trade register.

When the transfer of the mark is a consequence of a right *in rem*, a levy of execution or insolvency proceedings, the original proprietor will not be able to sign the application for registration of transfer. In these cases, the application must be accompanied by a final decision issued by a competent national authority transferring the ownership of the mark to the beneficiary.

It is not necessary to legalise supporting documents nor to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient.

If the Office has reason to doubt the accuracy or veracity of the document, it may require additional proof.

The Office will examine the documents only to the extent that they actually confirm what is indicated in the application, namely the identity of the marks concerned and the identity of the parties, and whether a transfer is involved. The Office does not consider or rule on contractual or legal questions arising under national law (09/09/2011,

Obsolete

T-83/09, Craic, EU:T:2011:450, § 27). If doubts arise, the national courts deal with the legality of the transfer itself.

4.5.1 Translation of proof

Article 146(1) EUTMR Article 24 EUTMIR Article 80(a) and (c) and Article 81(2) EUDIR

The evidence must be:

1. in the language of the Office that has become the language of the proceedings for the registration of the transfer; or
2. in any official language of the European Union other than the language of the proceedings. In this case, the Office may require a translation of the document into a language of the Office to be submitted within a period specified by the Office.

Where the supporting documents are submitted in an official language of the European Union that is not the language of the proceedings, the Office may require a translation into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

4.6 Procedure to remedy deficiencies

Article 20(7) and (12) EUTMR Article 28 EUDR Article 23(5) EUDIR

The Office will inform the applicant for registration of the transfer in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, the Office will reject the application for registration of the transfer. .

4.7 Collective and Certification marks

Article 20(5) and (7), and Articles 75, 79, 83, 84 and 88 EUTMR

The Office's practice in dealing with requests for transfer of EU collective marks and EU certification marks follows the principle that any new proprietor of an EU collective

Obsolete

mark or EU certification mark should comply with the same initial requirements the original proprietor was obliged to comply with at the time of filing of the EUTM.

It is understood therefore, that where a request for transfer is submitted in relation to an EU collective mark or an EU certification mark, in addition to the requirements and the documents duly establishing the transfer (Article 20(5) EUTMR), the Office will require the assignee to submit amended regulations of use (Articles 75, 79, 84 and 88 EUTMR). Specifically for EU certification marks, the applicant has to include in the regulations of use a declaration clearly specifying that the conditions of Article 83(2) EUTMR are fulfilled.

If these documents are not attached to the application for registration of the transfer, or if they do not comply with the requirements of Articles 75, 79, 84 and 88 EUTMR, a deficiency will be raised pursuant to Article 20(7) EUTMR, and in the event the deficiency is not remedied, the application for the registration of the transfer will be refused.

For more information on the formal requirements of EU collective marks and EU certification marks, and on the content and requirements of the regulations of use, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraphs 8.2 and 8.3.

5 Partial Transfers

Article 20(1) EUTMR Article 14 EUTMIR

A partial transfer concerns only some of the goods and services in the EUTM and is only applicable to EUTMs (not to REUDs).

It involves the distribution of the original list of goods and services between the remaining EUTM and a new one. When partial transfers are involved, the Office uses particular terminology to identify the marks. At the beginning of the proceedings there is the ‘original’ mark. This is the mark for which a partial transfer has been applied. After the registration of the transfer, there are two marks: one is a mark that now has fewer goods and services, and is called the ‘remaining’ mark, and one is a ‘new’ mark that has some of the goods and services from the original mark. The ‘remaining’ mark retains the EUTM number of the ‘original’ mark while the ‘new’ mark has a new EUTM number.

Transfer cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be ‘partially’ transferred for **some** territories.

When there are doubts as to whether the transfer is partial or not, the Office will inform the applicant for registration of the transfer and invite it to make the necessary clarifications.

Obsolete

Partial transfers may also be involved when the application for registration of the transfer concerns more than one EUTM. The following rules apply for each EUTM included in the application.

5.1 Rules on the distribution of the lists of goods and services

Articles 33 and 49 EUTMR

Article 14(1) EUTMIR

Communication No 1/2016 of the President of the Office of 08/02/2016

In the application for registration of a partial transfer, the goods and services to which the partial transfer relates must be indicated (the list of goods and services for the 'new' registration). The goods and services must be distributed between the original EUTM and the new EUTM so that the goods and services in the original EUTM and the new one do not overlap. The two specifications taken together must not be broader than the original specification.

Therefore, the indications must be clear, precise and unequivocal. For example, when an EUTM for goods or services in several classes is involved, and the 'split' between the original and new registration concerns entire classes, it is sufficient to indicate the respective classes for the new registration or for the remaining one.

When the application to register a partial transfer indicates goods and services that are explicitly mentioned in the original list of goods and services, the Office will automatically retain, in the original EUTM, the goods and services that are not mentioned in the application to register the partial transfer. For example, the original list contains goods A, B and C, and the transfer application relates to C; the Office will keep goods A and B in the original registration and create a new registration for C.

For further details concerning the scope of the list of goods and services, and for the Office's practice regarding the interpretation of general indications of the Nice Classification class headings, please see the Guidelines, Part B, Examination, Section 3, Classification, and Communication No 1/2016 of the President of the Office of 08/02/2016 concerning the implementation of Article 28 EUTMR (now Article 33 EUTMR), and the Annex thereto.

In all cases, it is highly recommended to file a clear and precise list of goods and services to be transferred together with a clear and precise list of goods and services to remain in the original registration. Furthermore, the original list must be clarified. For example, if the original list related to *alcoholic beverages* and the transfer relates to *whisky* and *gin*, the original list must be amended by restricting it to *alcoholic beverages, except whisky and gin.*

Obsolete

5.2 Objections

Article 20(7) EUTMR

When the application for registration of a partial transfer does not comply with the rules explained above, the Office will invite the applicant to remedy the deficiency. If the deficiencies are not remedied, the Office will reject the application for registration of a partial transfer. The party concerned may file an appeal against the decision.

5.3 Creation of a new EUTM

Article 20(6)(c) EUTMR

Article 14(2) EUTMIR

A partial transfer leads to the creation of a new EUTM. For this new EUTM, the Office will establish a separate file, which will consist of a complete copy of the electronic file of the original EUTM, the application for registration of a transfer, and all the correspondence related to the application for registration of the partial transfer. The new EUTM will be given a new file number. It will have the same filing date and, where applicable, date of priority as the original EUTM.

As far as the original EUTM is concerned, the Office will include a copy of the application for registration of a transfer in its files, but will not normally include copies of the further correspondence relating to the transfer application.

6 Transfer During the Course of Other Proceedings and Fees Issues

Article 20(11) and (12) EUTMR

Article 28(6) and (7) EUDR

Without prejudice to the right to act from the time when the application for registration of a transfer is received by the Office where time limits are involved, the new proprietor will automatically become party to any proceedings involving the mark in question from the time the transfer is registered.

The filing of an application for registration of a transfer has no effect on time limits already running or established by the Office, including time limits for the payment of fees. New time limits for payment will not be established. From the date of registration of the transfer, the new proprietor becomes liable to pay any fees due.

Obsolete

Therefore, it is important that, during the period between the filing of the application for registration of a transfer and the Office's confirmation of its actual entry in the EUTM Register or in the file, the original proprietor and the new proprietor actively collaborate in the communication of time limits and correspondence received during *inter partes* proceedings.

6.1 Specific issues of partial transfers

Article 20(10) EUTMR

In cases of partial transfers, the new EUTM will be at the same procedural stage as the original (remaining) EUTM. Any time limit still pending for the original EUTM will be considered to be pending for both the remaining and the new EUTM. After registration of the transfer, the Office will treat each EUTM separately and will decide on them separately.

When an EUTM is subject to the payment of fees and these fees have been paid by the original proprietor, the new proprietor will not be liable to pay any additional fees for the new EUTM. The relevant date is the entry date of the transfer in the EUTM Register. Therefore, when the fee for the original EUTM is paid after an application for registration of a transfer has been filed but before the registration of the transfer itself, no additional fees are due.

Articles 31(2) and 41(5) EUTMR Annex I A(3) and (4), Annex I A(7) and (8) EUTMR

When the partial transfer involves an EUTM application and class fees have not yet been paid or have not been paid in full, the Office will proceed to register the transfer in the files of the remaining EUTM application and to create a new EUTM application as described above.

Where additional class fees have to be paid for an EUTM application, the examiner will deal with such cases after creating a new EUTM application, as described below.

When additional class fees were paid prior to registering the transfer but no additional class fees were due for the remaining EUTM application, no reimbursement will be made because the fees were paid correctly at the time of payment.

In all other cases, the examiner will treat the remaining EUTM application and the new one separately, but will not require an additional basic fee to be paid for the new EUTM application. Class fees for the remaining EUTM application and for the new one will be determined according to the situation after the registration of the transfer. For example, when the original EUTM application had seven classes and, after the transfer, the remaining EUTM application has only one class while the new EUTM application has six, no additional class fees will be due for the remaining EUTM application, but the corresponding additional class fees must be paid for the new EUTM application. When

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some of the goods and services of a particular class are transferred and others are not, the fees for that class become payable for both the remaining EUTM application and the new one. When a time limit already set to pay additional class fees has not yet expired, it will be set aside by the Office to allow the determination to be made according to the situation after the registration of the transfer.

Article 53(1), (3) to (5) and (7) to (8) EUTMR

When the application for registration of a partial transfer relates to an EUTM registration that is due for renewal, that is, within 6 months prior to the expiry of the original registration and up to 6 months after that expiry, the Office will proceed to register the transfer and deal with the renewal and renewal fees as described below.

When no request for renewal has been submitted and no fees have been paid prior to the registration of the transfer, the general rules, including the rules relating to the payment of fees, are applicable to both the remaining EUTM registration and the new one (separate requests, separate payment of fees, as necessary).

When a request for renewal has been submitted prior to the registration of the transfer, that request is also valid for the new EUTM. However, while the original proprietor remains a party to the renewal proceedings for the remaining EUTM, the new proprietor automatically becomes party to the renewal proceedings for the new registration.

When a request for renewal has been filed but the relevant fees have not been paid prior to the registration of the transfer, the fees to be paid are determined according to the situation after the registration of the transfer. This means that both the proprietor of the remaining EUTM and the proprietor of the new EUTM must pay the basic renewal fee and any class fees.

When a request for renewal has been filed prior to the registration of the transfer and all the applicable renewal fees have been paid prior to this date, no additional renewal fees are due after the registration of the transfer. No reimbursement is made of any class fees already paid.

6.2 Transfer and *inter partes* proceedings

When an application for registration of a transfer is filed during *inter partes* proceedings, several different situations can arise. For earlier EUTMs on which the opposition/cancellation is based, the new proprietor can only become party to the proceedings (or file observations) once the application for registration of the transfer has reached the Office. The basic principle is that the new proprietor substitutes the original proprietor in the proceedings. The practice of the Office when dealing with transfers in oppositions is described in the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 7.5.

Obsolete

7 Entry in the Register, Notification and Publication

7.1 Publication and Entry in the Register

Article 20(4) and (9), Article 44, and Article 111(3)(g) EUTMR Article 28(2) and Article 49 EUDR Article 23(7) and Article 70(3)(i) EUDIR

The Office will enter the transfer in the EUTM Register and publish it in the EUTM Bulletin. The entry will be published once the EUTM application has been published pursuant to Article 44 EUTMR.

The entry in the EUTM Register will mention the following data:

- the date of registration of the transfer,
- the new proprietor's name and address,
- the name and address of the new proprietor's representative, if any.

For partial transfers, the entry will also contain the following data:

- the number of the original registration and the number of the new registration,
- the list of goods and services remaining in the original registration, and
- the list of goods and services of the new registration.

7.2 Notification

The Office will notify the applicant of the registration of the transfer.

When the application for registration of the transfer was filed by the assignee, the Office will also inform the EUTM proprietor of the registration of the transfer.

8 Transfers for registered European Union designs

Article 1(3) and Articles 27, 28, 33 and 34 and Articles 72(2)(i) and 72(3)(j) EUDR Article 23 and Article 61(2) and Article 68(1)(c) EUDIR.

The legal provisions contained in the EUDR and EUDIR in respect of transfers correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Therefore, both the legal principles and the procedure in respect of the registration of trade mark transfers apply *mutatis mutandis* to REUDs, except for the following specific procedures.

Obsolete

8.1 Rights of prior use for an REUD

Article 22(4) EUDR

The right of prior use for an REUD cannot be transferred except where the third person, who owned the right before the filing or priority date of the application for an REUD, is a business, along with that part of the business in the course of which the act was done or the preparations were made.

9 Transfers for international trade marks

The Madrid System allows for the recording of a 'change of ownership' of an international registration.

All requests to record a change in ownership must be submitted on form MM5:

- directly to the International Bureau by the recorded holder; or
- through the office of the contracting party of the recorded holder or through the office of a contracting party in respect of which the transfer is granted; or
- through the office of the contracting party of the new proprietor (transferee).

The request to record a transfer cannot be submitted directly to the International Bureau by the new proprietor. The Office's own application form should **not** be used.

Detailed information on changes in ownership can be found in paragraph 597 and the following ones of the Guide to the Madrid System. See also the Guidelines, Part M, International Marks.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 3

EUTMs and REUDs as objects of property

Chapter 2

Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings

Obsolete

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1 Introduction

Articles 19 to 29 EUTMR

Articles 27 to 34 EUDR

Articles 23 to 26 EUDIR

Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings

Decision No EX-25-05 of the Executive Director of the Office of 7 April 2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database

Both registered European Union trade marks (EUTMs) and EUTM applications may be the subject of licensing contracts (licences), rights *in rem* or levies of execution, or be affected by insolvency or similar proceedings. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

Both registered European Union designs (REUDs) and applications for an REUD may be the subject of licences, rights *in rem* or levies of execution, or be affected by insolvency or similar proceedings.

The provisions in the EUDR and EUDIR dealing with design licences, rights *in rem* concerning designs, levies of execution concerning designs, and insolvency and similar proceedings concerning designs are almost identical to the corresponding provisions of the EUTMR and EUTMIR respectively. **Therefore, the following applies *mutatis mutandis* to REUDs**. **Exceptions and specific provisions for REUDs are detailed in paragraph 8 below.** Specific procedures for international trade marks are laid down in paragraph 9 below.

This section of the Guidelines deals with the procedures for registering, cancelling or modifying licences, rights *in rem*, levies of execution and insolvency proceedings or similar proceedings.

1.1 Definition of licence contracts

A trade mark licence is a contract by virtue of which the proprietor of a trade mark (the licensor), whilst retaining ownership, authorises a third person (the licensee) to use the trade mark in the course of trade, under the terms and conditions set out in the contract.

A licence refers to a situation where the rights of the licensee to use the EUTM arise from a contractual relationship with the proprietor. The proprietor's consent to, or tolerance of, a third party using the trade mark does not amount to a licence.

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1.2 Definition of rights *in rem*

A right *in rem* or 'real right' is a limited property right that is an absolute right. Rights *in rem* refer to a legal action directed towards property, rather than towards a particular person, allowing the owner of the right the opportunity to recover, possess or enjoy a specific object. These rights may apply to trade marks or designs. They may consist, inter alia, in use rights, usufruct or pledges. '*In rem*' is different from '*in personam*', which means directed toward a particular person.

The most common rights *in rem* for trade marks or designs are pledges or securities. They secure the repayment of a debt of the proprietor of the trade mark or design (i.e. the debtor) in such a way that, where the proprietor cannot repay the debt, the creditor (i.e. the owner of the pledge or security) may receive repayment of the debt by, for example, selling the trade mark or design.

There are two types of right *in rem* for which the applicant can request entry in the EUTM Register:

- rights *in rem* that serve the purpose of guaranteeing securities (pledge, charge, etc.);
- rights *in rem* that do not serve as a guarantee (usufruct).

1.3 Definition of levies of execution

A levy of execution is the act by which a court officer appropriates a debtor's property following a judgment of possession obtained by a plaintiff from a court. In this way, a creditor can recover its claim from all the property of the debtor, including from its trade mark rights.

1.4 Definition of insolvency proceedings or similar proceedings

For the purposes of these Guidelines, 'insolvency proceedings' are understood to be the collective proceedings that entail the partial or total divestment of a debtor and the appointment of a liquidator. They may include winding up by, or under the supervision of, a court, creditors' voluntary winding up (with confirmation by the court), administration, voluntary arrangements under insolvency legislation and bankruptcy. 'Liquidator' is understood as any person or body whose function is to administer or liquidate assets of which the debtor has been divested or to supervise the administration of their affairs, and may include liquidators, supervisors of a voluntary arrangement, administrators, official receivers, trustees and judicial factors. 'Court' is understood to be the judicial body or any other competent body of a Member State empowered to open insolvency proceedings or to take decisions in the course of such proceedings. 'Judgment', in relation to the opening of insolvency proceedings or the appointment of a liquidator, is understood to include the decision of any court

Obsolete

empowered to open such proceedings or to appoint a liquidator (for terminology in other territories, see Regulation (EU) 2015/848 on insolvency proceedings).

1.5 Applicable law

Article 19 EUTMR

Article 27 EUDR

The EUTMR does not establish unified and complete provisions applicable to **licences**, **rights *in rem*** or **levies of execution** for EUTMs or EUTM applications. Instead, Article 19 EUTMR refers to the law of a Member State regarding the acquisition, validity and effects of the EUTM as an object of property, and regarding the procedure for levies of execution. To this end, a licence, a right *in rem* or a levy of execution for an EUTM is, in its entirety and for the whole territory of the European Union, assimilated to a licence, to a right *in rem*, or to a levy of execution for a trade mark registered in the Member State in which the EUTM proprietor has its seat or domicile. If the proprietor does not have a seat or domicile in a Member State, the licence, right *in rem* or levy of execution for an EUTM will be dealt with as a licence, right *in rem* or levy of execution for a trade mark registered in the Member State in which the proprietor has an establishment. If the proprietor does not have an establishment in a Member State, the licence, right *in rem* or levy of execution for an EUTM will be dealt with as a licence, right *in rem* or levy of execution for a trade mark registered in Spain (Member State in which the Office has its seat).

This, however, applies only to the extent that Articles 20 to 28 EUTMR do not provide otherwise.

Article 19 EUTMR is limited to the effects of a licence or right *in rem* as an object of property and does not extend to contract law. Article 19 EUTMR does not govern the applicable law or the validity of a licensing contract or right *in rem* contract, which means that the freedom of the contracting parties to submit the licensing contract or the *right in rem* contract to a given national law is not affected by the EUTMR.

Article 21(1) EUTMR

Article 31(1) EUDIR

Article 3(1) of Regulation (EU) 2015/848 on insolvency proceedings

Furthermore, these Guidelines serve to explain the procedure before the Office for registering the opening, modification or closure of **insolvency proceedings** or **similar proceedings**. In accordance with Article 19 EUTMR, all other provisions are covered by national law. Moreover, Regulation (EU) 2015/848 on insolvency proceedings regulates the provisions on jurisdiction, recognition and applicable law in the area of insolvency proceedings.

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The regulations specifically state that an EUTM may only be involved in insolvency proceedings opened in the Member State in the territory of which the debtor has its centre of main interests. The only exception is when the debtor is an insurance undertaking or credit institution, in which case the EUTM may only be involved in those proceedings opened in the Member State where that undertaking or institution has been authorised. The 'centre of main interests' should correspond to the place where the debtor conducts the administration of its interests on a regular basis and is, therefore, ascertainable by third parties (for further information on the 'centre of main interests' see Article 3(1) of Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings).

1.6 Advantages of registration

Article 27 and Article 57(3) EUTMR
Article 33 and Article 51(4) EUDR
Article 27(2) EUDIR

Entry in the EUTM Register of a licence agreement, a right *in rem*, a levy of execution, or the opening, modification and closure of insolvency proceedings is not compulsory. However, such registration has particular advantages.

1. In view of the provision of Article 27(1) and (3) EUTMR, vis-à-vis third parties who might have acquired, or have entered in the EUTM Register, rights in the trade mark that are incompatible with the **registered licence, right *in rem* or levy of execution**, the licensee, pledgee or beneficiary respectively may avail itself of the rights conferred by this licence, right *in rem* or levy of execution only:
   - if it was entered in the EUTM Register;
     or
   - if the third party acquired its rights after the date of any legal acts such as those referred to in Articles 20, 22, 23, 25 and 26 EUTMR (a transfer, a right *in rem*, a levy of execution, or a previous licence), knowing of the existence of the licence, right *in rem* or levy of execution.

     In view of Article 27(4) EUTMR, vis-à-vis third parties that might have acquired or have entered in the EUTM Register rights in the trade mark that are incompatible with the **registered insolvency**, the effects will be governed by the law of the Member State in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.
2. Where a **licence or a right *in rem*** for an EUTM is entered in the EUTM Register, the surrender or partial surrender of that mark by its proprietor will only be entered in the EUTM Register if the proprietor establishes that it has informed the licensee or pledgee respectively of its intention to surrender.

   The holder of a licence or the pledgee of a right *in rem* that is registered has, therefore, the right to be informed in advance by the proprietor of the trade mark of its intention to surrender the trade mark.

Obsolete

On entry in the EUTM Register of **insolvency proceedings or a levy of execution** against an EUTM, the proprietor loses its right to act and, therefore, may not perform any actions before the Office (such as withdraw, surrender, transfer, act in *inter partes* proceedings).

3. Where a **licence, right *in rem*, levy of execution, or insolvency proceedings** for, or against, an EUTM is entered in the EUTM Register, the Office will notify the licensee, pledgee, beneficiary or liquidator, respectively, of the approaching expiry of the registration at least six months beforehand.
4. Registering **licences, rights *in rem*, levies of execution and insolvency proceedings** (and their modification and/or cancellation, where applicable) is important for maintaining the veracity of the EUTM Register, particularly in the event of *inter partes* proceedings.

However,

1. when a party to proceedings before the Office has to prove use of an EUTM, if such use has been made by a licensee, it is not necessary for the **licence** to have been entered in the EUTM Register for that use to be considered to be use with the proprietor's consent pursuant to Article 18(2) EUTMR;
2. registration is not a condition for considering the use of a trade mark by a pledgee under the terms of the **right *in rem*** contract to have been made with the consent of the proprietor pursuant to Article 18(2) EUTMR;
3. the Office strongly recommends that liquidators duly inform the Office of the withdrawal, surrender or transfer of EUTMs subject to **insolvency proceedings** prior to the final winding up.

2 Requirements for an Application for Registration of a Licence, Right *in Rem*, Levy of Execution, and Insolvency Proceedings

Articles 22(2), 23(3), 24(3) and 25(5), Article 26 and Article 111(3) EUTMR
Articles 29(2), 30(3), 31(3), 32(5) and 72 EUDR
Articles 24 and 25 EUDIR

The application for registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings must comply with the following conditions.

Obsolete

2.1 Application form

Article 146(6) EUTMR

Article 65(1)(f) EUTMDR

Article 68(1)(d) and Article 80 EUDIR

It is strongly recommended that the application for registration of a licence, a right *in rem*, a levy of execution or insolvency proceedings for an EUTM be submitted electronically via the Office's website (e-recordals). Using e-recordals has advantages, such as the automatic receipt of electronic confirmation of the application and the possibility to use the manager feature to complete the form quickly for as many EUTMs as required.

Articles 20(8) and 26(1) EUTMR

Articles 23(6) and 24(1) EUDIR

A single application for the registration of a **licence** for two or more EUTMs may be made only if the registered proprietor and the licensee are the same and the contracts have the same conditions, limitations and terms in each case (see paragraph 2.5 below).

A single application for the registration of a **right *in rem* or a levy of execution** for two or more registered EUTMs may be submitted only if the registered proprietor and beneficiary are the same in each case.

2.2 Languages

Article 146(6)(a) EUTMR

Article 80(a) EUDIR

The application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings for an EUTM application must be made in the first or second language of the EUTM application.

Article 146(6)(b) EUTMR

Article 80(c) EUDIR

The application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

Obsolete

However, when the application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings is filed using the form provided by the Office pursuant to Article 65(1)(f) EUTMDR and Article 68 EUDIR, the form may be used in any of the official languages of the European Union, provided that it is completed in one of the languages of the Office, as far as textual elements are concerned.

2.3 Fees

Article 26(2) and Annex I A(26) and (27) EUTMR Articles 23(3) and 24(1) EUDIR Annex I point (12) EUDR

The application for the registration of a **licence, a right *in rem*** or **a levy of execution** is considered not to have been made until the fee is paid. The amount of this fee is EUR 200 for each EUTM for which the registration is requested.

However, where several registrations of **licences, rights *in rem*** or **levies of execution** have been applied for in one single application and the registered proprietor and the licensee (and contractual terms), pledgee, or beneficiary are the same in all cases, the fee is limited to a maximum of EUR 1 000.

The same maximum amount applies where several registrations of **licences, rights *in rem* or levies of execution** are applied for at the same time, provided that they could have been filed in one single application and that the registered proprietor and the licensee, pledgee or beneficiary are the same in all cases. Furthermore, for the registration of **licences or rights *in rem***, the contractual terms must be the same. For example, an exclusive licence and a non-exclusive licence cannot be filed in the same application, even if they are between the same parties.

Once the corresponding fee has been paid, it will not be reimbursed if the application for registration is refused or withdrawn.

There is no fee for registering **insolvency proceedings** or similar proceedings.

2.4 Parties to the proceedings

2.4.1 Applicants

Articles 22(2), 23(3), 25(5) and 117(1) EUTMR Articles 29(2), 30(3) and 32(5) EUDR

An application for the registration of a **licence**, of a **right *in rem*** or of a **levy of execution** at the Office may be filed by:

Obsolete

1. the EUTM proprietor(s); or
2. the EUTM proprietor(s) jointly with the licensee(s)/pledgee(s)/beneficiary(ies); or
3. the licensee(s)/pledgee(s)/beneficiary(ies).

Where the Office receives documents relating to such existing rights on EUTMs or REUDs from third parties or authorities such as national Registers or national Courts, it will forward the documents to the EUTM proprietor/REUD holder with a notice indicating that such a right could be entered in the EUTM or EUD Register upon request and payment of the relevant fees. Additionally, if the rights holder (pledgee or beneficiary) is fully identified by its contact details, the same notice will also be sent, for information only, to the pledgee(s)/beneficiary(ies). The document will be incorporated into the files relating to the EUTM or REUD affected.

Article 24(3) EUTMR Article 31(3) EUDR

The application for the registration of **insolvency proceedings** may be requested by:

1. a Court, or
2. competent national authorities, including the liquidator in the insolvency proceedings; or
3. any of the parties.

2.4.2 Mandatory indications concerning the EUTM and the licensee, pledgee, beneficiary or liquidator

Articles 24(2) and 26(1) EUTMR Article 2(1)(b) and (e) EUTMIR Article 13 EUTMDR Article 31 EUDR Article 1(1)(b) and (e), Articles 23 and 24 EUDIR

The application for registration of a licence, a right *in rem*, a levy of execution or insolvency proceedings must contain the following information.

1. The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the registration numbers must be indicated.
   Additionally, for **insolvency proceedings**, the Office will register the **insolvency proceedings** against **all** EUTMs/REUDs linked to the proprietor's ID number at the Office.

   Where the proprietor is the joint proprietor of an EUTM or REUD, the **insolvency proceedings** will apply to the share of the joint proprietor.
2. The licensee's, pledgee's, beneficiary's or liquidator's name, address and nationality (for REUDs only), as well as the State in which it is domiciled or has its seat or an

Obsolete

establishment. However, if the Office has already assigned an ID number to them, it is sufficient to indicate this number together with the name.

3. If the licensee, pledgee, beneficiary or liquidator designates a representative, the representative's name and ID number assigned by the Office. If the representative has not yet been assigned an ID number, the business address must be indicated.

2.4.3 Signatures

Article 63(1)(a) EUTMDR Article 67(4) EUDIR

Where the requirement of a signature is referred to, in electronic communications, the indication of the sender's name is considered to be equivalent to the signature.

The general rules on signatures apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits).

2.4.4 Representation

Articles 119(2) and 120(1) EUTMR Articles 77(2) and 78(1) EUDR

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation).

2.4.5 Proof

Articles 55 and 64 EUTMDR

For the special provisions and specific requirements with regard to proof, see the paragraphs below. These give details based on the type of right being registered: paragraph 4.1 for licences; paragraph 5.1 for rights *in rem*; paragraph 6.1 for levies of execution; paragraph 7.1 for insolvency proceedings.

2.4.6 Translation of proof

Article 146(6) EUTMR Article 24 EUTMIR Article 80 and Article 81(2) EUDIR

Proof must be as follows.

Obsolete

1. In the language of the Office that has become the language of the proceedings for the registration of the licence, right *in rem*, levy of execution or insolvency proceedings, see paragraph 2.2 above.
2. Or in any official language of the European Union other than the language of the proceedings. In this case, the Office may require a translation of the document into a language of the Office to be submitted within a period specified by the Office. The Office will set a time limit for submission of the translation. If the translation is not submitted within that time limit, the document will not be taken into account and will be considered not to have been submitted.

2.5 Examination of the application for registration

2.5.1 Fees

Article 26(2) EUTMR Articles 23(3) and 24(1) EUDIR

Where the required fee has not been received, the Office will notify the applicant that the application is considered not to have been filed because the relevant fee has not been paid. However, a new application may be submitted at any time providing the correct fee is paid from the outset.

There is no fee for applications for the registration of **insolvency proceedings** or similar proceedings.

2.5.2 Examination of the mandatory formalities

Article 24(1) EUTMR Article 31(1) EUDR

For **insolvency proceedings**, the Office will check that there are no other pending recordals and that no insolvency proceedings have already been registered for the proprietor concerned.

Article 26(4) EUTMR Article 24(3) EUDIR

The Office will check whether the application for registration complies with the formal conditions mentioned in paragraph 2.4 above and with the specific requirements given below, based on the type of right being registered (see paragraph 4.1 for licences, paragraph 5.1 for rights *in rem*, paragraph 6.1 for levies of execution, and paragraph 7.1 for insolvency proceedings).

Obsolete

Article 26 and Article 120(1) EUTMR

Article 78(1) EUDR

Article 24 EUDIR

The Office will check whether the application for registration of the **licence, right *in rem*, levy of execution** or **insolvency proceedings** has been duly signed. Where the application is signed by the licensee's, pledgee's, beneficiary's or liquidator's representative, an authorisation may be required by the Office or, in the case of *inter partes* proceedings, by the other party to the proceedings. In this case, if no authorisation is submitted, the proceedings will continue as if no representative had been appointed.

Where the application for registration of the **licence, right *in rem, insolvency proceedings*** or **levy of execution** is signed by the representative that has already been designated as the proprietor's representative for the EUTM in question, the requirements relating to signatures and authorisations are fulfilled.

Article 26(4) EUTMR

Article 24(3) EUDIR

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the period established in that communication, the Office will reject the application for registration of the right.

For additional specific formalities that concern only **licences** and **rights *in rem***, see the special provisions below (paragraphs 4.3 and 4.4 for licences, and paragraph 5.2 for rights *in rem*).

3 Procedure for Cancellation or Modification of the Registration

Articles 29(1) and 117(1) EUTMR

Article 26(1) EUDIR

The registration of a **licence**, a **right *in rem***, a **levy of execution** or **insolvency proceedings** will be cancelled or modified at the request of an interested party, that is, the applicant or proprietor of the EUTM or the registered licensee, pledgee, beneficiary or liquidator. In **insolvency proceedings**, it may also be the relevant national authority or court.

A registration of a **licence** or **right *in rem*** may also be transferred (see paragraph 4.6 for licences and paragraph 5.4 for rights *in rem*). The application should make a clear distinction between a request for modification and a request for transfer.

Obsolete

The Office will refuse the cancellation, transfer and/or modification of a **licence, sublicence** or **right *in rem*** if the main licence or right *in rem* has not been entered in the EUTM Register.

3.1 Competence, languages, presentation of the request

Article 29(3) and (6), and Article 162 EUTMR

Article 104 EUDR

Article 26(3), (6) and (7) EUDIR

Paragraphs 2.1 and 2.2 above apply.

It is strongly recommended that requests for cancellation or modification of a **licence, right *in rem*, levy of execution or insolvency proceedings** be submitted using the official forms available on the Office's website. Parties to the proceedings may also use WIPO Model International Form No 1, 'Request for Amendment/Cancellation of Recordal of License', (found in the annex to the Joint Recommendation concerning trademark licenses adopted by the Assembly of the Paris Union and the General Assembly of WIPO on 25/09/2000 to 03/10/2000), which can be downloaded at http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf, or a form with a similar content and format.

3.2 Applicant for a cancellation or modification request

Article 29(1) and (6) and Article 117(1) EUTMR

Article 26(1), (4) and (6) EUDIR

Requests for cancellation or modification of a registration may be submitted by the same parties who can file applications for registration (see paragraph 2.4.1 above).

3.2.1 Licences

3.2.1.1 Cancellation of a licence

In the case of a joint request submitted by the EUTM proprietor and the licensee, or of a request submitted by the licensee, no proof of the cancellation of the licence is required, since the request itself implies a statement from the licensee that it consents to the cancellation of the registration of the licence. However, a request for cancellation submitted by the EUTM proprietor alone must be accompanied by proof that the registered licence no longer exists, or by a declaration from the licensee to the effect that it consents to the cancellation.

Obsolete

Where a registered licensee alone submits a request for cancellation, the EUTM proprietor will not be informed thereof.

If the EUTM proprietor alleges fraud on the part of the licensee, it must submit a final decision of the competent authority to this effect. It is not within the remit of the Office to carry out any investigation in that respect.

Where several licences were requested simultaneously, it is possible to cancel them individually.

The entry in the EUTM Register of licences that are limited in time, that is, temporary licences, does not automatically expire but must be cancelled from the EUTM Register.

3.2.1.2 Modification of a licence

In the case of a joint request from the EUTM proprietor and the licensee, no further proof of the modification of the licence is required.

If the request is made by the EUTM proprietor, proof of the modification of the licence is required only where the modification for which entry in the EUTM Register is requested is of such a nature that it would diminish the rights of the registered licensee under the licence. For example, this would be the case if the licensee's name were to change, if an exclusive licence were to become a non-exclusive licence, or if the licence were to become restricted regarding its territorial scope, the period of time for which it is granted, or the goods or services to which it applies.

If the request is made by the registered licensee, proof of the modification of the licence is required only where the modification for which entry in the EUTM Register is requested is of such a nature that it would extend the rights of the registered licensee under the licence. For example, this would be the case if a non-exclusive licence were to become an exclusive licence, or if any registered restrictions of the licence as to its territorial scope, the period of time for which it is granted, or the goods or services to which it applies, were to be cancelled fully or in part.

Where proof of the modification of the licence is necessary, it is sufficient if any of the documents referred to in paragraph 4.1.4 below are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the licence contract and must relate to the registration of the modification of the licence as requested.
- The request for modification or cancellation of a licence must indicate how the licence has been modified.
- The copy or extract of the licence agreement must be of the licence as modified.

3.2.2 Rights *in rem*

3.2.2.1 Cancellation of the registration of a right *in rem*

If the EUTM proprietor and the pledgee submit a joint request, or if the pledgee alone submits a request, no proof of the cancellation of the registration of the right

Obsolete

in rem is required, since the request itself implies a statement by the pledgee that it consents to the cancellation of the registration of the right *in rem*. When the request for cancellation is submitted by the EUTM proprietor, it must be accompanied by proof that the registered right *in rem* no longer exists, or by a declaration by the pledgee that it consents to the cancellation.

Where the registered pledgee submits the request for cancellation by itself, the EUTM proprietor will not be informed thereof.

Where the registration of several rights *in rem* was requested simultaneously, it is possible to cancel them individually.

3.2.2.2 Modification of the registration of a right *in rem*

If the EUTM proprietor and the pledgee submit a joint request, no further proof of the modification of the registration of the right *in rem* is required.

If the request is submitted by the EUTM proprietor or the registered pledgee, proof of the modification of the registration of the right *in rem* is required.

Where proof of the modification of the registration of the right *in rem* is necessary, it is sufficient if any of the documents referred to in paragraph 5.1.4 below are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the right *in rem* agreement and must relate to the registration of the modification of the right *in rem* as requested.
- The request for modification or cancellation of the registration of a right *in rem* must show the right *in rem* in its modified form.
- The copy or extract of the right *in rem* agreement must show the right *in rem* in its modified form.

3.2.3 Levies of execution

3.2.3.1 Cancellation of the registration of a levy of execution

A request for cancellation of the registration of a levy of execution must be accompanied by proof that the registered levy of execution no longer exists. This proof comprises the final decision of the competent authority.

3.2.3.2 Modification of the registration of a levy of execution

A levy of execution may be modified on submission of the corresponding final decision of the competent authority showing such modification.

Obsolete

3.2.4 Insolvency proceedings

3.2.4.1 Cancellation of the registration of an insolvency

A request for the cancellation of the registration of insolvency proceedings must be accompanied by proof that the registered insolvency no longer exists. This proof comprises the final decision of the competent authority.

3.2.4.2 Modification of the registration of an insolvency

The registration of insolvency proceedings may be modified on submission of the corresponding final decision of the competent authority showing such modification.

3.3 Contents of the request

Article 29(1) EUTMR

Article 12 EUTMIR

Articles 19 and 26 EUDIR

Paragraph 2.4 above applies, except that the data concerning the licensee, pledgee, beneficiary or liquidator need not be indicated except in the case of a modification of the registered licensee's, pledgee's, beneficiary's or liquidator's name.

Paragraph 4.2 below applies if a modification of the scope of a **licence** is requested, for example, if a licence becomes a temporary licence or if the geographical scope of a licence is changed.

3.4 Fees

3.4.1 Cancellation

Article 29(3) and Annex I A(27) EUTMR

Article 26(3) EUDIR

For EUTMs, any request for the cancellation of **licences**, **rights *in rem*** and **levies of execution** is considered not to have been made until the fee is paid. The fee is EUR 200 for each EUTM for which cancellation is requested.

However, where several requests for cancellations of licences, rights *in rem* and levies of execution are applied for in one single application or at the same time, and the registered proprietor and the licensee (including contractual terms), pledgee, or

Obsolete

beneficiary are the same in all cases, the cancellation fee is limited to a maximum of EUR 1 000.

This applies irrespective of how the initial applications for registration of these licences, rights *in rem* or levies of execution were filed. This means that, even where the initial applications for registration of these rights were staggered over time and could not, therefore, benefit from the maximum fee of EUR 1 000, they can still benefit from the maximum fee of EUR 1 000 if their cancellation is requested in the same application for cancellation.

Requests for cancellation of the registration of **insolvency proceedings** are not subject to a fee.

For REUDs, requests for the cancellation of **licences**, **rights *in rem,* levies of execution** and **insolvency proceedings** are not subject to a fee.

3.4.2 Modification

Article 29(3) EUTMR

Article 26(6) EUDIR

Modification of the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings is not subject to a fee.

3.5 Examination of requests for cancellation or modification

3.5.1 Fees

Article 29(3) EUTMR

For EUTMs, where the required fee for a request for cancellation of a **licence**, a **right *in rem***, or a **levy of execution** has not been received, the Office will notify the applicant that the request for cancellation is considered not to have been filed.

As seen above, requests for cancellation of the registration of **insolvency proceedings** are not subject to a fee.

For REUDs, requests for the cancellation of **licences**, **rights *in rem,* levies of execution** and **insolvency proceedings** are not subject to a fee.

Obsolete

3.5.2 Examination by the Office

Article 29(2) and (4) EUTMR Article 26(2) and (4) EUDIR

For the mandatory elements of the request, paragraph 2.5.2 above applies *mutatis mutandis*, including in respect of proof, to the extent that such proof is required. Additionally, specific formalities apply to **licences** (see paragraph 4.3 below), to **rights *in rem*** (see paragraph 5.2 below), to **levies of execution** (see paragraph 6.1 below) and to **insolvency proceedings** (see paragraph 7.1 below).

The Office will notify the applicant for cancellation or modification of any deficiency, setting a time limit of 2 months. If the deficiencies are not remedied, the Office will reject the request for cancellation or modification.

Article 29(1), (2), (4) and (5), Articles 111(6) and 117(1) EUTMR Article 72(7) EUDR and Article 26(6) EUDIR

Paragraph 4.4 below applies to the extent that modification of the **licence** would affect its nature or its limitation to a part of the goods and services covered by the EUTM.

Registration of the cancellation or modification of a **licence**, a **right *in rem***, a **levy of execution** or **insolvency proceedings** will be communicated to all the parties concerned.

3.6 Registration and publication

Articles 111(3)(s) and 116(1)(a) EUTMR Article 72(3)(t) EUDR and Article 70(2) EUDIR

The creation, cancellation or modification will be entered in the EUTM Register or EUD Register and published in the EUTM Bulletin or EUD Bulletin.

Obsolete

4 Licences - Special Provisions

4.1 Requirements concerning proof

Article 19 and Article 26(1) EUTMR
Articles 2(1)(b) and 13(3)(a) EUTMIR
Article 27 EUDR
Article 1(1)(b) and Articles 23(4) and 24(1) EUDIR

4.1.1 Application made by the EUTM proprietor alone

When an application for the registration of a licence is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

No proof of the licence is necessary.

The Office will inform the licensee when the licence is registered in the EUTM Register.

The licensee may file a statement with the Office to oppose the registration of the licence. The Office will not take any further action on the statement but will register the licence. Following the registration of the licence, any licensee that disagrees with the registration of the licence may request the cancellation or modification of the licence (see paragraph 3 above).

The Office will not take into account whether or not the parties, although having agreed to a licence contract, have agreed to register it at the Office. Any dispute regarding the licence is a matter that must be resolved among the parties concerned under the relevant national law (Article 19 EUTMR).

4.1.2 Application made jointly by the EUTM proprietor and the licensee

When an application for the registration of a licence is made jointly by the EUTM proprietor and its licensee, it must be signed both by the EUTM proprietor and the licensee. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the licence.

Where there is a formal deficiency regarding the signature of the licensee or regarding its representative, the application will still be accepted as long as it would have been acceptable if it had been presented by the EUTM proprietor alone.

Obsolete

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or regarding its representative, but where the application would have been acceptable if it had been presented by the licensee alone.

4.1.3 Application made by the licensee alone

An application for the registration of a licence may also be made by the licensee alone. In this case, it must be signed by the licensee and proof of the licence must be submitted.

4.1.4 Proof of the licence

There is sufficient proof of the licence if the application for registration of the licence is accompanied by any of the following.

- A declaration stating that the EUTM proprietor agrees to the registration of the licence, signed by the EUTM proprietor or its representative.
  According to Article 13(3)(a) EUTMIR, it is also considered sufficient proof if an application for registration of the licence is signed by both parties. This case has already been dealt with in paragraph 4.1.2 above.
- The licence agreement, or an extract therefrom, indicating the parties and the EUTM being licensed, and bearing their signatures.
  In many cases, the parties to the licence agreement will not wish to disclose all the details, which may contain confidential information on the licence royalties or other terms and conditions of the licence. In such cases, it is sufficient if only a part or an extract of the licence agreement is submitted, as long as it identifies the parties to the licence agreement, confirms that the EUTM in question is the subject of a licence and contains the signatures of both parties. All other elements may be omitted or blacked out.
- An uncertified statement of licence using the complete WIPO Model International Form No 1 ‘Request for Recordal of License’. The form must be signed by both the EUTM proprietor, or its representative, and the licensee, or its representative. It can be found at http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf
  It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

Obsolete

4.2 Optional contents of the application

Articles 25(1) and 26(3) EUTMR Article 32(1) EUDR Article 25 EUDIR

Depending on the nature of the licence, an application for registration of the licence may contain the request to register the licence together with other indications, namely those referred to under letters a) to e) below. These indications may be individual or in any combination, for one licence (e.g. an exclusive licence limited in time) or for several licences (e.g. one exclusive licence for A as regards Member State X and another for B as regards Member State Y). They are entered in the EUTM Register by the Office only if the application for registration of the licence itself clearly requests that they be registered. Without such an explicit request, the Office will not enter in the EUTM Register any indications contained in the licence agreement that are submitted, for example, as proof of the licence.

However, if entry in the EUTM Register is requested for one or more of these indications, the following details must be indicated.

1. Where an application for the registration of a licence is limited to only some of the goods or services, the goods or services for which the licence has been granted must be indicated.
2. Where an application is for the registration of a licence as a territorially limited licence, the application must indicate the part of the European Union for which the licence has been granted. A part of the European Union may consist of one or several Member States or one or several administrative districts within a Member State.
3. Where registration of an exclusive licence is sought, a statement to this effect must be made in the application for registration.
4. Where the registration of a licence granted for a limited period of time is sought, the expiry date of the licence must be specified. Furthermore, the date of the commencement of the licence may be indicated.
5. Where the licence is granted by a licensee whose licence is already entered in the EUTM Register, the application for registration may indicate that it is for a sublicence. Sublicences cannot be registered without first registering the main licence.

Obsolete

4.3 Examination of specific formalities (licences)

Article 26(4) EUTMR

Article 24(3) EUDIR

Where an application for the registration of a licence has been made jointly by the EUTM proprietor and the licensee, the Office will communicate with the EUTM proprietor and send a copy to the licensee.

Where the licensee has also made and signed the application, it will not be allowed to contest the existence or scope of the licence.

Where the application for registration of the licence is filed by the EUTM proprietor alone, the Office will not inform the licensee.

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, which will normally be 2 months following the date of the notification, the Office will reject the application.

4.4 Examination of optional elements (licences)

Article 26 EUTMR

Article 25 EUDIR

Where an application for the registration of a licence specifies that the licence be registered as one of the following:

- an exclusive licence;
- a temporary licence;
- a territorially limited licence;
- a licence limited to certain goods or services; or
- a sublicence,

the Office will examine whether the indications mentioned in paragraphs 2.4 and 4.1 above are indicated.

As far as the indication ‘exclusive licence’ is concerned, the Office will accept only this term and not any other wording. If ‘exclusive licence’ is not expressly indicated, the Office will consider the licence to be non-exclusive.

Where an application for registration indicates that it is for a licence limited to certain goods or services covered by the EUTM, the Office will check whether the goods and services are properly grouped and are actually covered by the EUTM.

As far as a sublicence is concerned, the Office will check whether it has been granted by a licensee whose licence has already been entered in the EUTM Register. The

Obsolete

Office will refuse the registration of a sublicence when the main licence has not been entered in the EUTM Register. However, the Office will not check the validity of an application for the registration of a sublicence as an exclusive licence when the main licence is not an exclusive licence. Nor will it examine whether the main licence contract excludes granting sublicences.

It is the duty of the applicant for the registration of a licence not to conclude and register incompatible contracts and to request the cancellation or modification of entries in the Register that are no longer valid. For example, if an exclusive licence has been registered without limitation as to the goods and the territory, and the registration of another exclusive licence is applied for, the Office will register that second licence, even where both licences seem incompatible at first sight.

Parties are, furthermore, encouraged to update all EUTM Register information regularly and swiftly by cancelling or modifying existing licences (see paragraph 3 above).

Article 25(1), and Article 26(3) and (4) EUTMR Article 32(1) EUDR Articles 24(3) and 25 EUDIR

If the indications mentioned in paragraph 4.2 above are missing, the Office will invite the applicant for the registration of the licence to submit the supplementary information. If the applicant does not reply to that communication, the Office will not take into account the abovementioned indications and will register the licence without mentioning them.

4.5 Registration procedure and publication (licences)

Article 25(5) and Articles 111(3)(j) and 116(1)(a) EUTMR Articles 32(5) and 72(3)(t) EUDR Article 70(2) EUDIR

The Office will enter the licence in the EUTM or EUD Register and publish it in the EUTM Bulletin or EUD Bulletin.

Where applicable, the entry in the EUTM or EUD Register will only mention that the licence is:

- an exclusive licence;
- a temporary licence;
- a territorially limited licence;
- a sublicence; or
- a licence limited to certain goods or services covered by the EUTM.

The following details will not be published:

- the period of validity of a temporary licence;

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- the territory covered by a territorially limited contract;
- the goods and services covered by a partial licence.

Article 111(6) EUTMR Article 72(6) EUDR

The Office will notify the applicant for a registration of a licence of the registration thereof.

When an application for registration of a licence was filed by the licensee, the Office will also inform the EUTM proprietor or REUD holder of the registration of the licence.

4.6 Transfer of a Licence

4.6.1 Provision for the transfer of a licence

Article 25(5) EUTMR Article 32(5) EUDR

A licence concerning an EUTM may be transferred. The transfer of a licence is different from the transfer of a sublicence insofar as, in the former, the licensee loses all its rights under the licence and is replaced by a new licensee, whereas, in the case of the transfer of a sublicence, the main licence remains in force. Likewise, the transfer of a licence is different from a change of name of the owner where no change of ownership is implied (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 1, Transfer).

4.6.2 Applicable rules

Article 26(1) and (5) and Annex I A(26)(b) EUTMR Article 24(1) and (3) EUDIR Annex (12)(b) EUDR

The procedure for the registration of a transfer of a licence follows the same rules as for an application for registration of a licence.

The transfer of a licence is subject to the payment of a fee. Paragraph 2.3 above applies *mutatis mutandis*.

To the extent that a declaration by or signature of the EUTM proprietor is required in accordance with the rules, its place will be taken by a declaration by or signature of the registered licensee (the former licensee).

Obsolete

5 Rights *in Rem* - Special Provisions

5.1 Requirements concerning proof

Article 19 and Article 26(1) EUTMR
Articles 2(1)(b) and 13(3)(a) EUTMIR
Article 27 EUDR
Article 1(1)(b), Articles 23(4) and 24(1) EUDIR

5.1.1 Application submitted by the EUTM proprietor alone

When an application for the registration of a right *in rem* is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

The signature of the EUTM proprietor constitutes proof of the right *in rem*. Consequently, no additional proof of the right *in rem* is necessary.

The Office will inform the pledgee when the right *in rem* is registered in the EUTM Register.

Where the pledgee files a statement with the Office to oppose the registration of the right *in rem*, the Office will forward the statement to the EUTM proprietor for information purposes only. The Office will not take any further action on the statement. Following the registration of the right *in rem*, any pledgee that disagrees with the registration of the right *in rem* may request the cancellation or modification of the registration of the right *in rem* (see paragraph 3 above).

The Office will not take into account whether the parties have agreed to register a right *in rem* contract at the Office. Any dispute regarding the right *in rem* is a matter that must be resolved between the parties concerned under the relevant national law (Article 19 EUTMR).

5.1.2 Application submitted jointly by the EUTM proprietor and the pledgee

When an application for the registration of the right *in rem* is submitted jointly by the EUTM proprietor and the pledgee, it must be signed by both parties. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the right *in rem*.

Where there is a formal deficiency regarding the signature of the pledgee or regarding its representative, the application will still be accepted as long as it would have been acceptable if it had been submitted by the EUTM proprietor alone.

Obsolete

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or its representative, but where the application would have been acceptable if it had been submitted by the pledgee alone.

5.1.3 Application submitted by the pledgee alone

An application may also be submitted by the pledgee alone. In this case, it must be signed by the pledgee and proof of the right *in rem* must be submitted.

5.1.4 Proof of the right *in rem*

There is sufficient proof of the right *in rem* if the application for registration of the right *in rem* is accompanied by any of the following.

- A declaration signed by the EUTM proprietor stating that it agrees to the registration of the right *in rem*.
  According to Article 13(3)(a) EUTMIR, it is also considered sufficient proof if an application for registration of the right *in rem* is signed by both parties. This case has already been dealt with in paragraph 5.1.2 above.
- The right *in rem* contract, or an extract therefrom indicating the EUTM at issue and the parties, and bearing their signatures.
  It is sufficient if the right *in rem* contract is submitted. In many cases, the parties to the right *in rem* contract will not wish to disclose all the details of the contract, which may contain confidential information about the terms and conditions of the pledge. In such cases, it is sufficient if only a part or an extract of the right *in rem* contract is submitted, as long as it identifies the parties to the right *in rem* contract and the EUTM that is subject to a right *in rem*, and bears the signatures of both parties. All other elements may be omitted or blacked out.
- An uncertified statement of a right *in rem*, signed by both the EUTM proprietor and the pledgee.
  It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

Obsolete

5.2 Examination of specific formalities requirements (rights *in rem*)

Article 26(4) EUTMR Article 24(3) EUDIR

Where an application for registration of a right *in rem* has been submitted jointly by the EUTM proprietor and the pledgee, the Office will communicate with the EUTM proprietor and send a copy to the pledgee.

Where the pledgee has also submitted and signed the application, it will not be allowed to contest the existence or scope of the right *in rem* agreement within the Office's proceedings, notwithstanding what could be established by the national laws of the Member States in this regard.

If the EUTM proprietor alleges fraud on the part of the pledgee, it must provide a final decision of the competent authority to this effect. It is not up to the Office to carry out any investigation into such a claim.

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit fixed in that communication, the Office will reject the application.

5.3 Registration procedure and publication (rights *in rem*)

Articles 22(2) and 26(5) and Article 111(3)(h) and Article 111(6) EUTMR Article 29(2) and Article 72(3)(k) and Article (6) EUDR Article 24(4) EUDIR

The Office will enter the right *in rem* in the EUTM or EUD Register and publish it in the EUTM Bulletin or EUD Bulletin.

The Office will notify the applicant for registration of a right *in rem* of the registration thereof.

When an application for registration of a right *in rem* was filed by the pledgee, the Office will also inform the EUTM proprietor or REUD holder of the registration.

Obsolete

5.4 Transfer of a Right *in rem*

Article 26(1) and (5) and Annex I A(26)(d) EUTMR Article 24(1) EUDIR Annex I point (12)(d) EUDR

5.4.1 Provision for the transfer of a right *in rem*

A right *in rem* may be transferred.

5.4.2 Applicable rules

The procedure for the registration of a transfer of a right *in rem* follows the same rules as for the registration of a right *in rem*.

The transfer of a right *in rem* is subject to the payment of a fee. Paragraph 2.3 above applies *mutatis mutandis*.

To the extent that a declaration by or signature of the EUTM proprietor is required in accordance with the rules, it must be replaced by a declaration by or signature of the registered pledgee (the former pledgee).

6 Levies of Execution - Special Provisions

6.1 Requirements concerning proof

Article 26(1) EUTMR Article 2(1)(b) EUTMIR Article 1(1)(b) and Article 24(1) EUDIR

6.1.1 Application filed by the EUTM proprietor

When an application for the registration of a levy of execution is made by the EUTM proprietor, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

The Office will inform the beneficiary when the levy of execution is registered in the EUTM Register.

The beneficiary may file a statement with the Office to oppose the registration of the levy of execution. The Office will not take any further action on such a statement.

Obsolete

Following the registration of the levy of execution, any beneficiary that disagrees with the registration of the levy of execution may request the cancellation or modification of the registration of the levy of execution (see paragraph 3 above).

Any dispute regarding the levy of execution is a matter that must be resolved between the parties concerned under the applicable national law (Article 19 EUTMR).

6.1.2 Application filed by the beneficiary

An application for registration of a levy of execution may also be filed by the beneficiary. In this case, it must be signed by the beneficiary.

In addition, proof of the levy of execution must be submitted.

6.1.3 Proof of the levy of execution

There is sufficient proof of the levy of execution if the application for registration of a levy of execution is accompanied by a final decision of the competent national authority

In many instances, the parties to the levy of execution proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the levy of execution judgment is submitted, as long as it identifies the parties to the levy of execution proceedings and the EUTM that is subject to the levy of execution, and confirms that the judgment is final. All other elements may be omitted or blacked out.

6.2 Registration procedure and publication (levy of execution)

Articles 111(3)(i) and 116(1)(a) EUTMR Article 72(3)(l) EUDR and Article 70(2) EUDIR

When the right is registered, the levy of execution will be entered in the EUTM or EUD Register and published in the EUTM Bulletin or EUD Bulletin.

The Office will notify the applicant for registration of a levy of execution of the registration thereof.

Where applicable, the EUTM proprietor or REUD holder will also be informed.

Obsolete

7 Insolvency Proceedings - Special Provisions

7.1 Requirements concerning proof

There is sufficient proof of the appointment of a liquidator and of the insolvency proceedings if an application for registration of the insolvency proceedings is accompanied by a final decision of the competent national authority.

It suffices if the insolvency judgment is submitted. In many instances, the parties to the insolvency proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the judgment is submitted, as long as it identifies the parties to the proceedings. All other elements may be omitted or blacked out.

It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

7.2 Registration procedure and publication (insolvency proceedings)

Articles 111(3)(i) and 116(1)(a) EUTMR Article 72(3)(l) EUDR and Article 70(2) EUDIR

When the mark is registered, the insolvency proceedings will be entered in the EUTM Register and published in the EUTM Bulletin. The publication contains the EUTM registration number(s), the name of the authority requesting the entry in the EUTM Register, the date and number of the entry and the publication date of the entry in the EUTM Bulletin.

The Office will notify the applicant for registration of insolvency proceedings of the registration thereof.

The liquidator's contact details are recorded as the EUTM proprietor's 'correspondence address' in the Office's database, and third parties may consult the full details of the insolvency proceedings through an application for inspection of files (see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files).

Obsolete

8 Procedures for registered European Union designs

Articles 27, 29, 30, 31, 32, 32a, 33, 33a and 51(4) EUDR

Articles 24 to 26 and Article 27(2) EUDIR

The legal provisions contained in the EUDR and EUDIR in respect of licences, rights *in rem*, levies of execution and insolvency proceedings correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Therefore, both the legal principles and the procedure in respect of the registration, cancellation or modification of trade mark licences, rights *in rem*, levies of execution or insolvency proceedings apply *mutatis mutandis* to REUDs, except for the following specific procedures.

8.1 Multiple applications for REUDs

Article 37 EUDR

Article 24(1) EUDIR

An application for the registration of licences, rights *in rem* and levies of execution for an REUD may be in the form of a multiple application containing several designs.

For the purposes of the legal effect of licences, rights *in rem* and levies of execution, as well as of the procedure for registering licences, rights *in rem* and levies of execution, the individual designs contained in a multiple application will be dealt with as if they were separate applications. This continues to apply after registration of the designs contained in the multiple application.

In other words, each design contained in a multiple application may be licensed, pledged or levied independently of the others.

For **licences** specifically, the optional indications as to the kind of licence and the procedure for their examination referred to in paragraphs 4.2 and 4.4 above (with the exception of a licence limited to some products, which is not possible), apply to each of the individual designs contained in a multiple application separately and independently.

Point (12) of the Annex to the EUDR

The fee of EUR 200 for the registration of a licence, a right in rem or a levy of execution, or for the transfer of a licence or right in rem applies per design and not per multiple application. However, the ceiling of EUR 1 000 applies where multiple requests are submitted in the same application for registration of a licence or another right.

Obsolete

8.2 Entitlement proceedings for REUDs

Articles 15, 16 and 19 EUDR and Article 72(3)(g), (h) and (i) EUDR

Article 80(c) EUDIR

REUD applications and registrations may be the subject of entitlement proceedings.

Regarding the differences between the registration of a change of ownership following a transfer or entitlement proceedings, see the Guidelines, Part E Register operations, Section 3, Chapter 1 Transfers, paragraph 3.

If an REUD has been applied for or registered in the name of a person who is not entitled to it under Article 14 EUDR, the person entitled to it under that provision, namely the designer or their successor, may claim recognition as the REUD's legitimate holder.

A distinction must be made between proceedings before national courts or authorities and proceedings before the Office.

Entitlement claims must be brought before the competent national court (e.g. specialised courts authorised to handle matters of entitlement in cases of employment or family matters) or the competent national authority (e.g. administrative offices or specialised bodies) in the relevant Member State.

Where a person is jointly entitled to the REUD, that person may, in accordance with Article 15(2) EUDR, claim recognition as joint holder.

Regarding the applicable law for these proceedings, see paragraph 1.5.

The Office is only competent to register the following entries in the EUD Register:

- the mention that legal entitlement proceedings have been initiated before the competent court or authority of the Member State concerned;
- the date and particulars of the final decision of the competent court or authority or any other termination of the entitlement proceedings;
- any change in the REUD's ownership resulting from the final decision of the competent court or authority.

The application for registration must comply with the conditions laid down inparagraph 8.2.1.

The effects of the different entries in the Register are described in paragraph 8.2.3.

8.2.1 Requirements for an application for registration of entries relating to entitlement proceedings

Application form and language of proceedings

An application for registration of entitlement proceedings can be submitted through the 'communications back-up' option in the User Area.

Regarding the language of proceedings, see paragraph 2.2, above.

Obsolete

Fees

There is no fee for registering any of the entries relating to entitlement proceedings.

Parties to the proceedings

A request for the registration of an entry in the Register under Article 15(5) EUDR (the initiation or result of entitlement proceedings) may be filed by:

- the REUD holder(s);
- the person(s) claiming to be the legitimate holder in the entitlement proceedings; or
- the competent national court or authority.

Where the Office receives documents relating to such proceedings from anyone other than the registered REUD holder, it will forward the documents to the holder.

Additionally, if the request does not originate from the person recognised as the legitimate holder but this person is fully identified by their contact details, the Office will also forward the documents to that person.

Mandatory indications

The request for the mention in the Register that entitlement proceedings have been initiated, or terminated, must contain the following information:

- the registration number of the REUD concerned. If the application relates to several REUDs, each of the registration numbers must be indicated;
- the holder's name, address and nationality, as well as the State in which it is domiciled or has its seat or an establishment. However, if the Office has already assigned an ID number to the holder, it is sufficient to indicate this number together with the name.

The application for a change of ownership must additionally contain the following information:

- the name, address and nationality of the person recognised as the legitimate holder of the REUD as well as the State in which it is domiciled or has its seat or an establishment. However, if the Office has already assigned an ID number to the legitimate holder, it is sufficient to indicate this number together with the name.

Regarding signature and representation, see paragraphs 2.4.3 and 2.4.4.

8.2.2 Requirements concerning proof

For entry of the initiation of entitlement proceedings in the Register, the application must be accompanied by evidence that shows the court or authority of the Member State before which entitlement proceedings have been initiated.

For the entry of the final decision or other termination of entitlement proceedings in the Register, the application must be accompanied by evidence that the entitlement proceedings have concluded, such as a final decision of the competent authority or court of the Member State.

Obsolete

8.2.3 Effects of the entries in the Register

Article 16(2) and Article 17 EUDR

Initiation of entitlement proceedings – effects on subsequent requests

The entry of the initiation of entitlement proceedings in the Register freezes the REUD, meaning that any subsequent request for a transfer, licences, levies, insolvencies or rights in rem filed will be suspended.

The proceedings are resumed upon the following entries in the Register:

- an entry indicating the change of ownership as a result of the entitlement proceedings; or
- an entry of the final decision of the competent court or authority rejecting the claim of entitlement or terminating the proceedings in a way that does not change the entitlement over the REUD.

Change of ownership – effect on licences

Where there is a complete change of ownership of an REUD as a result of entitlement proceedings under Article 15(1) EUDR, licences and other rights lapse upon the entering in the Register of the new REUD holder.

Upon registration of the new holder, the Office will inform:

- the new holder that they may request the cancellation of an already registered licence;
- the registered licensee about:
  - the date of registration of the new owner;
  - that the registered licence may be cancelled upon request since it lapsed according to Article 16(1) EUDR; and
  - that the licensee may ask the new holder to grant a new non-exclusive licence within 3 months of the registration of the new holder according to Article 16(2) EUDR.

Upon request of the holder or the licensee, the Office will:

- cancel the registered licence; or
- enter a modification of the already registered licence if the licensee requested a new licence from the new holder under Article 16(2) EUDR.

If the licensee requests a modification of the licence, it must provide proof that the new holder granted a new licence.

The Office will not interfere in arranging the period and terms of the licence between the previous holder/licensee and the new holder. Any dispute regarding the licence is a matter that must be resolved among the parties concerned under the relevant national law (Article 27 EUDR).

Change of ownership – effect on ongoing proceedings

Obsolete

As long as the change of ownership has not been entered in the Register, the allegedly entitled person may not invoke the rights arising from the registration of the REUD (see Article 17 EUDR).

Where there are time limits to be observed vis-à-vis dealings with the Office, the new holder may make the corresponding statements to the Office once the application for registration of the change of ownership has been received by the Office.

9 Procedures for international trade marks

Rules 20 and 20bis Regulations under the Madrid Protocol.

9.1 Recording of licences

The Madrid System allows for the recording of **licences** against an international registration.

All requests for the recording of a licence should be submitted on form MM13 either:

- directly to the International Bureau by the recorded holder; or
- through the office of the contracting party of the recorded holder or through the office of a contracting party in respect of which the licence is granted; or
- through the office of the licensee.

The request cannot be submitted directly to the International Bureau by the licensee. The Office's application form should **not** be used.

Detailed information on the recording of licences can be found in paragraph 703 and the following ones of the Guide to the Madrid System. For further information on international trade marks, see the Guidelines, Part M, International Marks.

9.2 Recording of rights *in rem*, levies of execution or insolvency proceedings

The Madrid System allows for the recording of **rights *in rem***, **levies of execution** or **insolvency proceedings** against an international registration (see Rule 20 of Regulations under the Madrid Protocol). For the convenience of users, form MM19 is available for requesting the recording of a restriction of the holder's right of disposal in the International Register. The use of this form is strongly recommended to avoid irregularities.

Requests should be submitted either:

- directly to the International Bureau by the recorded holder; or
- to the office of the contracting party of the registered holder; or
- to the office of a contracting party to whom the right *in rem*, levy of execution or insolvency is granted; or

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- to the office of the contracting party of the pledgee, beneficiary or liquidator.

The request cannot be submitted directly to the International Bureau by the pledgee, beneficiary or liquidator. The Office's application form should **not** be used.

Detailed information on the registration of rights *in rem*, levies of execution or insolvency proceedings can be found in paragraphs 698 and the following ones of the Guide to the Madrid System. For further information on international trade marks, see the Guidelines, Part M, International Marks.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 4

Renewal

Obsolete

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1 Fraud Warning

1.1 Private companies sending misleading invoices

The Office is aware that users are receiving an increasing amount of unsolicited mail from companies requesting payment for trade mark and design services such as renewal.

A list of letters from firms or registers that users have complained are misleading is published on the Office website. These services are not connected with any official trade mark or design registration services provided by IP offices or other public bodies within the European Union such as the EUIPO.

If a user receives a letter or invoice, he or she should carefully check what is being offered, and its source. It must be pointed out that the **EUIPO never sends invoices to users or letters requesting direct payment for services** (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

1.2 Renewal by unauthorised third persons

The Office is also aware that fraudsters have targeted the e-renewal module. If, upon filing a request for e-renewal, a user discovers that the mark is 'blocked', as renewal has already been requested, they should contact the Office.

2 Terms of Registration of European Union Trade Marks

Articles 1, 32, 52 and Article 41(5) and (8) EUTMR

The term of registration of a European Union trade mark (EUTM) is 10 years from the **filing date** of the application. For example, an EUTM with a filing date of 16/04/2020 will expire on 16/04/2030.

The filing date of the application is determined according to Articles 31 and 32 EUTMR and Article 41(5) and (8) EUTMR.

A registration may be renewed indefinitely for further periods of 10 years.

Obsolete

3 Terms of Protection of Registered European Union Designs

Articles 12, 38 and 45 EUDR

The term of protection of a registered European Union design (REUD) is 5 years from the **date of filing** of the application (Article 12 EUDR). For example, an REUD with a filing date of 16/04/2020 will expire on 16/04/2025.

The date of filing of the application is determined according to Article 38 EUDR and Article 45 EUDR (see the Guidelines for Examination of Registered European Union Designs, Examination of Applications for Registered European Union Designs, paragraph 3, Allocation of a Filing Date).

A registration may be renewed for periods of 5 years each, up to a total of 25 years from the date of filing.

4 Notification of Expiry of Registration

Article 53(2) EUTMR

Article 60(3) and Article 66 EUTMDR

Article 13(2) EUDR

Articles 21 and 63 EUDIR

At least 6 months before the expiry of the registration, the Office will inform:

- the registered proprietor/holder of the EUTM/REUD, and
- any person having a registered right in respect of the EUTM/REUD

that the registration is approaching expiry. Persons having a registered right include the holders of a registered licence, the proprietors of a registered right *in rem*, the creditors of a registered levy of execution or the authority competent to act on behalf of the proprietor/holder in insolvency procedures.

Failure to give such information does not affect the expiry of the registration and does not involve the responsibility of the Office.

Obsolete

5 Renewal of an EUTM Application

Article 53(2) EUTMR Annex I A(19) EUTMR

In the exceptional circumstance where an application has not yet matured to registration because of pending proceedings, the Office will not send the notice referred to in Article 53(2) EUTMR. The applicant is not obliged to renew its application during proceedings that last for more than 10 years and where the outcome of registration is uncertain. Only once the trade mark is registered will the Office invite the owner to renew the EUTM and pay the relevant renewal fees due. The owner will then have 4 months to pay the renewal fee (including any additional class fees). The surcharge for the renewal fee of 25 % pursuant to Annex I A(19) EUTMR does not apply. If the renewal fee is not paid within the time limit given, the Office will issue a notice that the registration has expired. The expiry will take effect from the date of registration of the EUTM.

6 Renewal of an REUD application

Article 13(2) EUDR Annex to the EUDR point 8

In the exceptional circumstance where an application has not yet matured to registration because of pending proceedings, the Office will not send the notice referred to in Article 13(2) EUDR. The applicant is not obliged to renew its application during proceedings that last for more than 5 years and where the outcome of registration is uncertain. The Office will only invite the owner to renew the REUD and pay the renewal fee once the design has been registered. The owner will then have 4 months to pay the renewal fee. The surcharge for the renewal fee of 25 % pursuant to point 8 of the Annex to the EUDR does not apply. If the renewal fee is not paid within the time limit given, the Office will issue a notice that the registration has expired. The expiry will take effect from the date of registration of the REUD.

Obsolete

7 Fees and other formal requirements for the request for renewal

Articles 63 and 64 EUTMDR

Article 22(8) and Articles 65, 66 and 67 and Article 68(1)(e) EUDIR

Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means

The general rules concerning communications to the Office apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits), which means that the request may be submitted in the following ways.

- By electronic means available on the EUIPO website (e-renewal available via the User Area). For EUTMs, there is a reduction of EUR 150 on the basic renewal fee for an individual mark using e-renewal (EUR 300 for a collective mark). Entering the name and surname in the appropriate place on the electronic form is deemed to be a signature. In addition, using e-renewal offers additional advantages such as the receipt of immediate electronic confirmation of the renewal request automatically or the use of the renewal manager feature to complete the form quickly for as many EUTMs/REUDs as needed.
- By transmitting a signed original form electronically, by post or by courier (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits). A standard form is available on request to the Office. Forms have to be signed but annexes need not be signed.

Following Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023, EUTM and REUD renewals must be made via e-renewal, post or courier. In cases where technical malfunction prevents e-renewal, renewals by one of the two alternative electronic back-up measures will be treated by the Office only when received within the last three working days before the expiry of: (i) the deadline for renewal or (ii) the extended deadline for renewal.

A single application for renewal may be submitted for two or more EUTMs/REUDs (including REUDs that form part of the same multiple registration), upon payment of the required fees for each EUTM/REUD.

7.1 Persons who may submit a request for renewal

Articles 20(12) and 53(1) EUTMR

Article 50d(1) and Article 28(7) EUDR

The request for renewal may be submitted by:

Obsolete

1. the registered proprietor/holder of the EUTM/REUD;
2. where the EUTM/REUD has been transferred, the successor in title as from the point in time a request for registration of the transfer has been received by the Office;
3. any person expressly authorised by the proprietor/holder of the EUTM/REUD to do so. Such a person may, for instance, be a registered licensee, a non-registered licensee or any other person who has obtained the authorisation of the proprietor/holder to renew the EUTM/REUD.

Professional representation is not mandatory for renewal.

When the renewal request is submitted by a person other than the registered proprietor/holder or its representative on file, an authorisation will have to exist in its favour; however, it does not need to be filed with the Office unless the Office requests it.

When a person other than the proprietor/holder or its representative on file sends a direct payment or submits a request for renewal with the indication that payment will be made by bank transfer, the proprietor/holder will be informed that the renewal will be processed once payment has been received. If no reply is received from the proprietor/holder, or no objection is raised to the renewal, the Office will validate the payment once it reaches the Office and the renewal will be processed.

If the Office receives fees from two different sources, neither of which is the proprietor/holder or its representative on file, the proprietor/holder will be contacted in order to ascertain who is authorised to file the renewal request. Where no reply is received from the proprietor/holder, the Office will validate the payment that reached the Office first (12/05/2009, T-410/07, Jurado, EU:T:2009:153, § 33-35; 13/01/2008, R 989/2007-4, ELITE GLASS-SEAL, § 17-18).

7.2 Content of the request for renewal

Article 53(4) EUTMR Article 50d EUDR

The request for renewal must contain the following: name and address of the person requesting renewal and the registration number of the EUTM/REUD to be renewed. In the case of an EUTM renewal, the extent of the renewal is deemed to cover the full specification by default.

Payment alone can constitute a valid request for renewal, providing such payment reaches the Office and contains the name of the payer, the registration number of the EUTM/REUD and an indication that it is a request for renewal. In such circumstances, no further formalities need to be complied with (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges). Where this option is relied on in EUTM renewals, the payment must be of the renewal fee laid out in Annex I A,

Obsolete

paragraphs (11) or (15) EUTMR and not of the discounted fee for renewal by electronic means pursuant to Annex I A, paragraphs (12) or (16).

Consequently, payment alone cannot constitute a valid request for e-renewal. The discounted fee may only be relied on where a renewal application is submitted by electronic means, as such payment must be accompanied by a valid e-renewal application form.

7.2.1 Name and address and other particulars of the person submitting a request for renewal

Article 2(1)(b) and (e) EUTMIR Article 50d(4)(a) EUDR

7.2.1.1 Request filed by the proprietor/holder

Where the request is filed by the EUTM/REUD proprietor/holder, its name must be indicated.

7.2.1.2 Request filed by a person authorised to do so by the proprietor/holder

Where the request for renewal is filed by a person authorised by the proprietor/holder to do so, the name and address or the ID number and name of the authorised person in accordance with Article 2(1)(e) EUTMIR or Article 50d(4)(a) EUDR must be indicated.

If the selected payment method is bank transfer, a copy of the renewal request is sent to the proprietor/holder.

7.2.2 Registration number

Article 53(4)(b) EUTMR Article 50d(4)(b) EUDR

The EUTM/REUD registration number must be indicated.

7.2.3 Indication as to the extent of the renewal

Article 53(4) EUTMR Article 50d(4)(c) EUDR

For EUTMs, renewal is deemed to cover the entire specification of goods and/or services of the EUTM by default.

Obsolete

Where renewal is requested for only some of the goods or services for which the mark is registered:

- those classes or those goods and services for which renewal is requested must be indicated in a clear and unequivocal way.

Or, alternatively:

- those classes or those goods and services for which renewal is not requested must be indicated in a clear and unequivocal way.

The e-renewal platform only allows for deleting (i.e. not renewing) entire classes; it does not allow for the partial renewal of only some goods or services within a class (i.e. it does not allow the deletion of some of the goods or services listed in a specific class at the time of the renewal). Therefore, where renewal is required for only **some goods or services within a class**, the renewal application can *either* be submitted using any other means of communication accepted by the Office, *or*, the whole class can be renewed through e-renewal and a request for partial surrender can be submitted pursuant to Article 57 EUTMR for those goods or services that the proprietor wishes to remove from the EUTM.

For REUDs, in the case of a multiple registration, an indication that renewal is requested for all the designs covered by the multiple registration or, if the renewal is not requested for all the designs, an indication of the file number for which it is requested. If nothing is indicated, the renewal is deemed to be for all the designs by default.

7.3 Languages

Article 146(6) EUTMR Article 68 and Article 80(b) and (c) EUDIR

The request for renewal may be filed in any of the five languages of the Office. The chosen language becomes the language of the renewal proceedings. However, when the request for renewal is filed by using the form provided by the Office pursuant to Article 65(1)(g) EUTMDR or Article 68(1)(e) EUDIR, such a form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned. This concerns, in particular, the list of goods and services in the event of a partial renewal of an EUTM.

Obsolete

7.4 Time limits

Article 52 and Article 53(3) EUTMR

Article 69(1) EUTMDR

Article 50d(3) EUDR

Articles 56 and 58 EUDIR

Communication No 3/2024 of the Executive Director of the Office of 11 December 2024

7.4.1 Six-month period for renewal before expiry (basic period)

The request for renewal and the renewal fee must be submitted in the 6-month period prior to the expiry of the registration ('the basic period').

For example, where the EUTM has a filing date of 10/06/2021, the day on which protection ends will be 10/06/2031. Therefore, a request for renewal must be introduced and the renewal fee paid as from 11/12/2030 until 10/06/2031 or, where this is a Saturday, Sunday or other day on which the Office is closed, or does not receive ordinary mail within the meaning of Article 69(1) EUTMDR, the first following working day on which the Office is open to the public and does receive ordinary mail.

For example, where the REUD has a filing date of 10/06/2021, the day on which protection ends will be 10/06/2026. Therefore, a request for renewal must be introduced and the renewal fee paid as from 11/12/2025 until 10/06/2026 or, where the latter date is a Saturday, Sunday or other day on which the Office is closed or does not receive ordinary mail within the meaning of Article 58(1) EUDIR, the first following working day on which the Office is open to the public and does receive ordinary mail.

7.4.2 Six-month period following expiry (grace period)

Where the EUTM/REUD is not renewed within the basic period, the request may still be submitted and the renewal fee may still be paid, upon payment of an additional fee (see paragraph 7.5), within a further period of 6 months ('the grace period').

For example, where the EUTM has a filing date of 10/06/2021, the day on which protection ends will be 10/06/2031. Therefore, the grace period during which a request for renewal may still be introduced upon payment of the renewal fee plus the additional fee is counted from the day after 10/06/2031, namely from 11/06/2031, and ends on 10/12/2031 or, if 10/12/2031 is a Saturday, Sunday or other day on which the Office is closed, or does not receive ordinary mail within the meaning of Article 69(1) EUTMDR, the first following working day on which the Office is open to the public and receives ordinary mail. This also applies if in the above example 11/06/2031 was a Saturday or Sunday; the rule that a time limit to be observed vis-à-vis the Office is extended until

Obsolete

the next working day applies only once and to the end of the basic period, and not to the starting date of the grace period. The same approach applies to REUD renewals albeit that the period of protection is 5 years and not 10.

During the 6-month grace period, the only action that may be carried out in an EUTM or REUD is the payment of the renewal fee (including the payment of the additional fee for late payment). In the event the Office receives any other request during the grace period, such as a transfer, registration of a licence, surrender, change of name, etc. or any other request for entry into the Registers, the Office will put the request on hold until the renewal fee is paid. Only once the renewal fee is paid in full, and the EUTM or REUD is officially renewed, will the Office examine any requests that had been placed on hold.

7.4.3 Transitional arrangements for calculating the basic and grace periods for REUDs

The EUDR changed the calculation of the renewal periods for REUDs, which is now aligned with those for EUTMs. Now, the basic period for renewal of REUDs ends on the date of expiry of the registration (previously the last day of the month in which expiry occurred). The 6-month grace period for renewal, therefore, starts on the day after the expiry of the registration.

The practice of the Office reflecting the transitional arrangements is laid down in Communication No 3/2024 of the Executive Director of the Office of 11 December 2024 concerning the caluclation of the Registered Community Design renewal fees and the basic and grace period for renewal in view of the entry into force of the Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002.

This practice is that where the basic 6-month period for renewal started to run **before** the applicability date of the EUDR, the provisions contained in the former Article 13(3) EUDR (before amendment) will apply for calculating both the basic period and, where applicable, the grace period.

For example, where the REUD has a filing date of 15/03/2020, the basic renewal period will run up to and include the last day of the month in which protection ends, namely 31/03/2025. Therefore, a request for renewal must be introduced and the renewal fee paid between 01/10/2024 and 31/03/2025 (both dates inclusive). The grace period would then run from 01/04/2025 up to and including 30/09/2025.

Where the basic 6-month period for renewal starts to run on or after the applicability date of the EUDR, the provisions contained in Article 50d EUDR will apply for calculating both the basic period and, where applicable, the grace period.

For example, where the REUD has a filing date of 24/11/2020, it will expire on 24/11/2025. The basic period for renewal will run from 25/05/2025 up to and including 24/11/2025 (date of expiry). The grace period would then run from 25/11/2025 up to and including 24/05/2026.

Obsolete

7.5 Fees

As regards the calculation of the amount of the renewal fees, the due date for the renewal fees is the date of expiry of the registration (Article 53(3) EUTMR and Article 50d(3) EUDR). This principle applies regardless of the moment at which renewal is actually requested and paid for, with the exception of the transitional arrangements for REUD renewals (see paragraph 7.5.3).

7.5.1 Fees payable for EUTMs

Article 53(3) and Annex I A(11), (12), (13), (14), (15), (16), (17), (18) and (19) EUTMR Communication No 2/16 of the President of the Office of 20/01/2016

The fees payable for the renewal of an EUTM consist of:

- a basic fee that covers the first class of goods/services;
- one or more class fees for each class of goods/services exceeding the first one;
- any additional fee applicable for late payment of the renewal fee or late submission of the request for renewal.

The amount of the renewal fee is as follows.

Basic fee (by e-renewal):

- for an individual mark: EUR 850, and
- for a collective or certification mark: EUR 1 500.

Basic fee (other than by e-renewal):

- for an individual mark: EUR 1 000, and
- for a collective or certification mark: EUR 1 800.

Class fees:

- for the second class: EUR 50,
- for each class exceeding two: EUR 150.

The fee must be submitted in the 6-month period prior to the expiry of the registration (see paragraph 7.4 above).

The additional fee for late payment or late submission is:

- 25% of the belated renewal fee, subject to a maximum of EUR 1 500.

7.5.2 Fees payable for REUDs

Article 50d(3) EUDR Article -106ac and Annex I to the EUDR points 6 and 8

The fees payable for the renewal of an REUD consist of:

Obsolete

- a renewal fee;
- any additional fee applicable for late payment of the renewal fee or late submission of the request for renewal.

The amount of the renewal fee, per design, whether or not included in a multiple registration, is as follows:

- for the first renewal: EUR 150;
- for the second renewal: EUR 250;
- for the third renewal: EUR 400;
- for the fourth renewal: EUR 700.

The fee must be paid within a period of 6 months prior to the expiry of the registration (see paragraph 7.4 above).

The additional fee for late payment or late submission is:

- 25% of the renewal fee.

7.5.3 Transitional arrangements for calculating the amount of REUD renewal fees

The practice of the Office laid down in Communication No 3/2024 is that the fees applied to each renewal will depend on the **DATE OF REQUEST** of the renewal.

For example:

- if the request for renewal is received **on or after** the applicability date of the legal reform, the fees set out in Annex I of the EUDR will apply, regardless of the payment method and whether it is debit now or debit later;
- if a renewal request is received **before** the applicability date of the legal reform, the fees set out in the Annex to the CDFR will apply.

Holders are encouraged to check whether a renewal before or after the applicability is more beneficial to them and act accordingly.

7.5.4 Time limit for payment

Articles 53(3) and 180(3) and Annex I A(19) EUTMR Article 50d(3) EUDR and Annex I to the EUDR points 6 and 8 Article 8(c) and (h) of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025.

The fee must be paid within a basic period of 6 months (for calculation of the period, see paragraphs 7.4.1 and 7.4.3 above).

The fee may be paid within a further grace period of 6 months (see paragraph 7.4.2 and 7.4.3 above), provided that an additional fee for late payment is paid, which amounts to 25 % of the total renewal fee, including any class fees.

Obsolete

Renewal will be effected only if payment of **all** fees reaches the Office within the grace period, this includes all renewal fees, additional fees for payment within the grace period, and surcharges for late payment by bank transfer (see Part A, Section 3, Payment of Fees, Costs and Charges, paragraph 4.1.1) where applicable.

Fees that are paid **before** the start of the basic period of 6 months will not, in principle, be taken into consideration and will be refunded.

7.5.5 Payment by third parties

Article 5 of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025.

Payment may also be made by the other persons identified in paragraph 7.1 above.

Payment by debiting a current account held by a third party requires an explicit authorisation of the holder of the current account that the account can be debited for the benefit of the particular fee. In such cases, the Office will check if there is an authorisation. If there is no authorisation, a letter will be sent to the renewal applicant asking them to submit the authorisation to debit the account held by a third party. In such cases, payment is considered to be effected on the date the Office receives the authorisation.

7.5.6 Fee refund

Article 53(8) EUTMR Article 50d(8) EUDR

Renewal fees and, where applicable, the additional fee for late payment may be refunded under certain circumstances. For more information, please see the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

8 Procedure Before the Office

8.1 Examination of formal requirements

The examination of the request for renewal is limited to formalities and relates to the following points.

Obsolete

8.1.1 Observation of time limits

Article 53(3), (4) and (8) EUTMR

Article 50d(3), (4) and (8) and Article -106ab(1) and (4) EUDR

8.1.1.1 Payment during the basic period or the grace period

Where the request for renewal is filed and the renewal fee is paid within the basic period, the Office will record the renewal, provided that the other conditions laid down in the EUTM or REUD Regulations are fulfilled (see paragraph 8.1.2).

Where no request for renewal has been filed, but the payment of a renewal fee reaches the Office that contains the minimum identification elements (see paragraph 7.2), this constitutes a valid request and no further formalities need be complied with. This is pursuant to Article 53(4) EUTMR, last sentence and Article 50d(4) EUDR, last sentence.

Where this option is relied on in EUTM renewals, the payment must be of the renewal fee laid out in Annex I A, paragraphs (11) or (15) EUTMR and **not of the discounted fee for renewal by electronic means** pursuant to Annex I A, paragraphs (12) or (16). Consequently, as payment alone cannot constitute a valid request for e-renewal, the fee discount may only be relied on where a renewal application is submitted by electronic means. The requester will either have to submit a valid e-renewal application form, or pay the difference in the basic fee, in all cases before the expiry of the renewal period. Furthermore, if this is carried out during the grace period, the additional fee for late payment will also be due.

Where no request for renewal has been filed but a renewal fee has been paid that does not contain the minimum identification elements, the Office will invite the person requesting renewal to provide the missing indications. A letter will be sent out as early as is reasonably possible after receipt of the fee, so as to enable the request to be filed before the additional fee becomes due.

Where a request for renewal has been submitted but the renewal fee has not been paid in full, the Office will, where possible, remind the person requesting renewal to pay the remaining part thereof within the basic renewal period and the additional fee for late payment if within the grace period.

The lack of payment is not a remediable deficiency that the Office will set the party a time limit to remedy.

In the case of incomplete payment of an EUTM renewal fee, the proprietor may, instead of paying the missing amount, restrict its request for renewal to the corresponding number of classes.

In the case of incomplete payment of an REUD renewal fee, the holder may, instead of paying the missing amount, restrict its request for renewal to the corresponding number of multiple designs.

Obsolete

8.1.1.2 Insufficient payments and payment after the expiry of the grace period

Article 53(5) and (8) and Article 99 EUTMR

Article 50d(5) and (8) EUDR

Where a request for renewal has not been submitted or is submitted only after the expiry of the grace period, or the fees have not been paid, the Office will determine that the registration has expired and will issue a notification on loss of rights to the proprietor/holder.

Where the fees received in the grace period are not paid in full (i.e. the fee received amounts to less than the required basic fee and the additional fee for late payment) or are received only after expiry of the grace period, the Office will determine that the registration has expired and will issue a notification on loss of rights to the proprietor/holder.

For EUTMs, where the insufficient fee received in the grace period covers the basic fee and the additional fee for late payment, but not all class fees, the Office will only renew the registration for some classes. The determination of which classes of goods and services are to be renewed will be made according to the following criteria.

- Where the request for renewal is expressly limited to particular classes, only those classes will be renewed.
- Where it is otherwise clear from the request which class or classes are to be covered by the request, that class or those classes will be renewed.
- The Office may contact the proprietor to ask for the class preferences in the event of partial payment.
- In the absence of other criteria, the Office will take the classes into account in the numerical order of classification, beginning with the class having the lowest number.

Where not all class fees are paid and the Office determines that the registration has expired for some of the classes of goods or services, it will issue the renewal confirmation to the proprietor, as well as a notification of loss of rights for those classes of goods or services to the proprietor. If the person concerned considers that the finding of the Office is inaccurate, he or she may, within 2 months of the notification of the loss of rights, apply for a decision on the matter.

For REUDs, where the fee paid covers the basic fee and the fee for late payment, but the fees paid are insufficient to cover all designs identified in the renewal application, the Office will only renew the registration for some designs. In the absence of an indication of the designs to be renewed, or of any other criteria for determining which designs are intended to be covered, the Office will determine the designs to be renewed by taking them in numerical order.

Obsolete

8.1.1.3 Situation where the requester holds a current account

The Office will not debit a current account unless there is an express request for renewal. It will debit the account of the person requesting renewal.

Where the renewal applicant has a current account at the Office, the renewal fee will only be debited once a request for renewal has been filed and the renewal fee (including any class fees) will be debited on the day of receipt of the request, unless other instructions are given. In the event the request for renewal is filed during the 6-month grace period, the renewal fee and the additional fee for late payment will both be debited from the current account.

For payment by third parties, see paragraph 7.5.4 above.

8.1.2 Compliance with formal requirements

8.1.2.1 Renewal requested by an authorised person

Article 53(1) EUTMR Article 50d(1) EUDR

Where a renewal request is filed on behalf of the proprietor/holder, there is no need to file an authorisation. However, such an authorisation should exist in favour of the person filing the request should the Office request it.

8.1.2.2 Further requirements

Article 53(4) and (7) EUTMR Article 22(3) and (4) EUDIR

Where the request for renewal does not comply with other formal requirements, namely where the name and address of the person requesting renewal has not been sufficiently indicated, where the registration number has not been indicated, where it has not been properly signed or, for EUTMs, if partial renewal was requested but the goods and services to be renewed have not been properly indicated, the Office will inform the person requesting renewal of the deficiencies found.

The Office will consider the request to be made for the renewal for all goods and services or all the designs covered by the multiple registration, unless partial renewal is expressly requested. In the event of a partial renewal, please refer to paragraph 7.2.3 above.

If the request for renewal is filed by a person authorised by the proprietor/holder (see paragraph 7.1(c) above), the proprietor/holder will receive a copy of the deficiency notification.

Obsolete

Article 53(5), (8) and Article 99 EUTMR Article 22(5) and Article 40 EUDIR

Where these deficiencies are not remedied before the expiry of the relevant time limit, the Office will proceed as follows.

- If the deficiency consists of failing to indicate the goods and services of the EUTM to be renewed, the Office will renew the registration for all the classes for which the fees have been paid, and if the fees paid do not cover all the classes of the EUTM registration, the determination of which classes are to be renewed will be made according to the criteria set out in paragraph 8.1.1.2 above. The Office will issue, at the end of the grace period, a notification of loss of rights for those classes of goods or services the Office deems expired to the proprietor.
- If the deficiency consists of the proprietor's/holder's failure to respond to a request for clarification of who the authorised person is, the Office will accept the request for renewal filed by the authorised representative on file. If neither of the requests for renewal has been filed by an authorised representative on file, the Office will accept the renewal request that was first received by the Office.
- If the deficiency lies in the fact that there is no indication of the designs to be renewed, and the fees paid are insufficient to cover all the designs for a multiple application for which renewal is requested, the determination of which designs are to be renewed will be made according to the criteria set out in paragraph 8.1.1.2 above. The Office will determine that the registration has expired for all designs for which the renewal fees have not been paid in part or in full.
- In the case of the other deficiencies, it will determine that the registration has expired and will issue a notification of loss of rights to the proprietor/holder and, where applicable, the person requesting renewal.

The person concerned may apply for a decision on the matter under Article 99 EUTMR or Article 40(2) EUDIR within 2 months.

8.2 Items not to be examined

No examination will be carried out on renewal for the registrability of the mark or design, nor will any examination be carried out as to whether the EUTM has been put to genuine use.

No examination will be carried out by the Office on renewal as to the correct classification of the EUTM, nor will a registration be reclassified that has been registered in accordance with an edition of the Nice Classification that is no longer in force at the point in time of renewal. All of this is without prejudice to the application of Article 57 EUTMR.

The Office will not examine the product classification of the REUD nor will an REUD be reclassified that was registered in accordance with an edition of the Locarno

Obsolete

Classification no longer in force at the time of renewal. Such reclassification will not even be available at the holder's request.

9 Partial Renewals of EUTMs

Article 53(4)(c) and Article 53(8) EUTMR Annex I A(19) EUTMR

An EUTM may be renewed in part for some of the goods and/or services for which it has been registered.

A partial renewal is not a partial surrender for those goods and/or services for which the EUTM has not been renewed.

An EUTM may be partially renewed several times during the initial basic renewal period of 6 months or during the 6-month grace period. See to this extent 22/06/2016, C-207/15 P, CVTC, EU:C:2016:465.

For each partial renewal, the full amount of the corresponding fee has to be paid, and in the event a partial renewal request is submitted within the grace period, the additional fee for the late payment of the renewal fee must also be paid, namely 25 % of the belated renewal fee (subject to a maximum of EUR 1 500).

For example:

An EUTM registration has 10 classes.

If within the basic period the Office receives an e-renewal request for 5 classes (out of the 10) the fees payable would be:

Basic e-renewal fee (including 1 class):	EUR 850
Second class:	EUR 50
Remaining classes (150 EUR x 3):	EUR 450
Total renewal fee:	**EUR 1 350**

If, within the grace period, the Office receives a new renewal request for two more classes of the registration, the fees payable would be:

Additional classes (EUR 150 x 2):	EUR 300
25 % surcharge of the belated fee:	EUR 75
Total additional fees payable:	**EUR 375**

Obsolete

Total additional fees payable: EUR 375.

Using the same example, at the end of the grace period the Office would issue a notification to the proprietor of loss of rights for the remaining three classes of goods or services which were not renewed, for which registration is deemed expired.

10 Entries in the Register

Articles 53(5), 111(6) and Article 111(3)(k) EUTMR

Article 50d(6) and Article 72(3)(n) and Article 72(6) EUDR

Where the request for renewal complies with all the requirements, the renewal will be registered.

The Office will notify the proprietor/holder of the renewal of the EUTM/REUD, of its entry in the Register, and the date from which renewal takes place. Where the renewal applicant is a person other than the registered proprietor/holder or its representative on file, they will also be informed of the renewal.

Where renewal has taken place only for some of the goods and services contained in the registration, the Office will notify the proprietor of the goods and services for which the registration has been renewed and the entry of the renewal in the Register and of the date from which renewal takes effect (see paragraph 11 below). After the expiry of the grace period, the Office will notify the proprietor of expiry of the registration for the remaining goods and services and of their removal from the Register.

Where only some of the designs contained in a multiple application have been renewed, the Office will notify the holder of the designs for which the registration has been renewed, of the entry of the renewal in the Register and of the date from which renewal takes effect (see paragraph 11 below). After the expiry of the grace period, the Office will notify the holder of expiry of the registration for the remaining designs and of their removal from the Register.

Article 53(5), (8) and Article 99 EUTMR

Article 50d(6) and (8) EUDR

Article 40(2) EUDIR

Where the Office has made a determination pursuant to Article 53(8) EUTMR or Article 50d(8) EUDR that the registration has expired, the Office will cancel the mark/design in the Register and notify the proprietor/holder accordingly. The proprietor/holder may apply for a decision on the matter under Article 99 EUTMR or Article 40(2) EUDIR within 2 months.

Obsolete

11 Date of Effect of Renewal or Expiry, Conversion

11.1 Date of effect of renewal

Article 53(6) and (8) EUTMR

Article 67(2) EUTMDR

Article 12 and Article 50d(6) EUDR

Renewal will take effect from the day following the date on which the existing registration expires.

For example:

- Where the filing date of the EUTM registration is 01/04/2010, the registration will expire on 01/04/2020. Therefore, renewal takes effect from the day following 01/04/2020, namely 02/04/2020. Its new term of registration is 10 years from this date, which will end on 01/04/2030.
- Where the filing date of the REUD is 01/04/2015, the registration will expire on 01/04/2020. Therefore, renewal takes effect from the day following 01/04/2020, namely 02/04/2020. Its new term of registration is five years from this date, which will end on 01/04/2025.

It is immaterial whether any of these days is a Saturday, Sunday or an official holiday. Even in cases where the renewal fee is paid within the grace period, the renewal takes effect from the day following the date on which the existing registration expires.

Where the EUTM or REUD has expired and is removed from the Register, the cancellation will take effect from the day following the date on which the existing registration expired. Using the same two examples listed above, the removal from the Register would take effect on 02/04/2020 (for the EUTM) and 02/04/2020 (for the REUD).

11.2 Conversion of lapsed EUTMs

Articles 53(3) and 139(5) EUTMR

Where the owner wants to convert its lapsed EUTM into a national mark, the request must be filed within 3 months from the day following the last day of the 6-month grace period. The time limit of 3 months for requesting conversion starts automatically without notification (see the Guidelines, Part E, Register Operations, Section 2, Conversion).

Obsolete

12 Renewal of International Marks Designating the EU

Article 202(1) EUTMR

The procedure for renewal of international marks is managed entirely by the International Bureau. The Office will not deal with renewal requests or payment of renewal fees. The International Bureau will send notice for renewal, receive the renewal fees and record the renewal in the International Register. The effective date of the renewal is the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register. Where an international registration designating the EU is renewed, the Office will be notified by the International Bureau.

If the international registration is not renewed for the designation of the EU, it can be converted into national marks or into subsequent designations of Member States under the Madrid Protocol. The 3-month time limit for requesting conversion starts on the day following the last day on which renewal may still be effected before WIPO pursuant to Article 7(4) of the Madrid Protocol (see the Guidelines, Part E, Register Operations, Section 2, Conversion).

13 Renewal of International Design Registrations Designating the EU

Article 106a EUDR
Article 106g EUDR

International registrations must be renewed directly at the International Bureau of WIPO in compliance with Article 17 of the Geneva Act. The Office will not deal with renewal requests or payments of renewal fees in respect of international registrations.

The procedure for the renewal of international design registrations is managed entirely by the International Bureau, which sends out the notice for renewal, receives the renewal fees and records the renewal in the International Register. When international registrations designating the EU are renewed, the International Bureau also notifies the Office.

Obsolete

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 5

Inspection of files

Obsolete

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Obsolete

1 General Principles

Article 111(1) and (5), Article 114, Article 117(1) and (2) and Annex 1 A(30) EUTMR
Articles 20 and 21 EUTMIR
Articles 72, 74, 74a, 74b and 75 EUDR
Articles 77 and 78 EUDIR

ED Decision concerning the keeping of files and the inspection of files

The principle established under the European Union trade mark and design system is that:

- the 'Register of European Union trade marks' and the 'Register of European Union designs' contain all particulars relating to European Union trade mark (EUTM) applications, applications for registered European Union designs, registered EUTMs and registered European Union designs (REUDs); and
- the 'files' contain all correspondence and decisions relating to those trade marks and designs.

Both the Registers and the files of the Office are, in principle, open to inspection by the public. However, before publication of an EUTM application, an REUD or when an REUD is subject to deferred publication, inspection of files is possible only in exceptional cases (see paragraphs 4.2.1 and 4.2.2 below).

This section of the Guidelines deals specifically with inspection of files.

Inspection of the files may involve:

- inspection of the Registers;
- obtaining certified or uncertified extracts of the Registers;
- inspection of the content of the file(s);
- the communication of information contained in the files, implying communication of specific information contained in the files without supplying the actual file document(s);
- obtaining certified or uncertified copies of documents contained in the files.

In these Guidelines, the term 'inspection of the files' is used to cover all of the abovementioned forms of inspection of files, unless otherwise stated.

The provisions in the EUDR and EUDIR dealing with the inspection of files of European Union designs are almost identical to the equivalent provisions of the EUTM Regulations. Therefore, the following applies *mutatis mutandis* to European Union designs. Where the procedure is different, the differences are specified under a separate sub-heading.

Obsolete

2 The Registers of EUTMs and European Union designs

Article 111(1) and (5) EUTMR

Article 72 and 72a EUDR

Decision EX-25-05 of the Executive Director of the Office of 07/04/2025 on the Register of EU trade marks, the Register of EU Designs, the database of proceedings before the Office, and on the case-law database.

The Registers are maintained electronically. The Registers can be publicly inspected through the eRegisters, which can be accessed through the eSearch Plus database on the Office website. The eRegisters are also accessible through the Office's TMview and DesignView tools, except, in the case of European Union designs, where Article 50(2) EUDR provides otherwise. Insofar as some data contained in the Registers is not yet available online, the only means of access is by a request for information or by obtaining certified or uncertified extracts or copies of the file documents from the Registers.

3 Inspection of the Registers

3.1 Information contained in the Registers

3.1.1 The Register of EUTMs

Article 111(2), (3) and (4) EUTMR

Decision EX-25-05 of the Executive Director of the Office of 07/04/2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database, and its Annex I and Annex II.

The Register of EUTMs contains the information specified in Article 111(2) and (3) EUTMR and any other items determined by the Executive Director of the Office pursuant to Article 111(4) EUTMR.

Obsolete

3.1.2 The Register of European Union designs

Articles 50, 72 and Article 74(5) EUDR

Decision EX-25-05 of the Executive Director of the Office of 07/04/2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database, and its Annex I and Annex II.

The Register of European Union designs contains the information specified in Article 72 EUDR and any other items determined by the Executive Director of the Office.

In accordance with Article 74(5) EUDR, where the REUDs are subject to a deferment of publication pursuant to Article 50(1) EUDR, access to the Register to persons other than the holder shall be limited to the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred.

The particulars that are recorded in the eRegisters are specified in Annexes I and II of Decision EX-25-05 of the Executive Director of the Office on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database.

For EUDs, the street, postal code and province/county of **holders** are no longer recorded in the Register. Entries that existed in the Register before the entry into force of the new Regulation will not be amended so they will continue to show the full address details. The full addresses of representatives remain visible. For EUTMs, the full address of proprietors and representatives is recorded in the Register.

The nationality of parties and representatives is no longer recorded in the Register but remains visible for cases that existed on the Register before the entry into force of the new Regulation.

Obsolete

4 Inspection of Files

4.1 Persons/Entities authorised to request access to the files

The rules and degree of access to the files vary according to who requests inspection.

The Regulations differentiate between the following three categories:

- the applicant/proprietor of the EUTM or REUD;
- third parties;
- courts or authorities of the Member States.

Inspection of the files by courts or authorities of the Member States is covered by the system of administrative cooperation with the Office (see paragraph 7 below).

4.2 Documents that constitute the files

The files relating to an EUTM or REUD consist of all correspondence between the parties and the Office and all documents (and their related annexes) established in the course of examination, as well as any correspondence concerning the ensuing EUTM or REUD. The file does not include trade mark search reports provided by national offices.

Documents relating to opposition, cancellation, invalidity and appeal proceedings before the Office or other proceedings, such as recordals (transfer, licence, etc.), also form part of the files.

All original documents submitted become part of the file and, therefore, cannot be returned to the person who submitted them. When submitting documents, simple photocopies are sufficient. They do not need to be authenticated or legalised.

Where the parties make use of the mediation services offered by the Office in accordance with the Decision of the Executive Director of the Office on the administration of mediation processes ('Rules on Mediation'), all correspondence relating to that mediation are excluded from inspection of files.

Article 115 EUTMR Article 74c EUDR

Decision EX-25-04 of the Executive Director of the Office of 07/04/2025 on the keeping of files and the inspection of files

Even where an EUTM application is no longer pending, or an EUTM registration or REUD registration ceases to have effect, inspection of the respective files remains possible. An EUTM application or REUD application ceases to be pending when it is rejected, or when the application has been withdrawn or is considered to have been withdrawn. An EUTM registration or REUD registration ceases to have effect when it expires or is surrendered, declared invalid or revoked and, where applicable, the period for conversion is over.

Where the files are kept in electronic format, the electronic files, or back-up copies thereof, will be kept indefinitely. The Executive Director established when originals should be disposed of by the Office in his decision on the keeping and inspection of files. This decision states that the Office may dispose of original documents submitted by the parties, which have been digitised in the electronic files, 5 years after the Office received them. Where files or part of files are not kept electronically, the Office will keep the relevant documents or items of evidence for at least 5 years from the end of the year in which:

- the EUTM/REUD application is rejected or withdrawn;
- the EUTM/REUD registration expires definitely;
- the surrender of the registered EUTM or REUD is entered in the Register; or
- the registered EUTM or REUD is removed from the Register.

Obsolete

4.2.1 The files relating to EUTM applications

Articles 44 and 114 EUTMR

Article 7 EUTMIR

The files relating to EUTM applications are available for inspection once the application has been published by the Office in the EUTM Bulletin. The day of publication is the date of issue shown in the EUTM Bulletin and is reflected under the INID code 442 in the Register. The dissemination of data relating to unpublished EUTM applications by means of online access or otherwise does not constitute publication of the application within the meaning of Article 44 EUTMR and Article 7 EUTMIR.

Before the publication of the application, inspection of the files is restricted and possible only if one of the following conditions is fulfilled:

- the applicant for inspection is the EUTM applicant; or
- the EUTM applicant has consented to inspection of the file relating to the EUTM application (see paragraph 6.12.1 below); or
- the applicant for inspection can prove that the EUTM applicant has stated that it will invoke the rights under the EUTM, once registered, against the applicant for inspection (see paragraph 6.12.2 below).

Article 41(3) and Article 115 EUTMR

The applicant always has access to the files relating to its own EUTM application. This comprises the following:

- the EUTM application, even where the Office has refused to attribute a filing date to it or where the application does not fulfil the minimum requirements for the attribution of a filing date, in which case the application will not be dealt with as an EUTM application and, legally speaking, there is no EUTM application;
- the files for as long as they are kept (see paragraph 4.2), even after the EUTM application has been rejected or withdrawn.

4.2.2 The files relating to REUD applications

Articles 50, 74 and Article 74a(2) EUDR

Article 70 EUDIR

The files relating to REUD applications, or an REUD still subject to deferment of publication, including those that have been surrendered, are only available for inspection if one of the following conditions is fulfilled:

- the applicant for inspection is the REUD applicant/holder; or
- the applicant for the REUD has consented to inspection of the file relating to the REUD application; or

Obsolete

- the applicant for inspection has established a legitimate interest in the inspection of the REUD application, in particular where the applicant for the REUD has stated that after the design has been registered he/she will invoke the rights under it against the person requesting the inspection.

In the case of an application for multiple REUDs, this inspection restriction will only apply to information relating to the REUDs subject to deferment of publication, or to those that are not eventually registered, either due to rejection by the Office or withdrawal by the applicant.

4.2.3 The files relating to registered EUTMs

The files relating to EUTMs after registration are available for inspection.

4.2.4 The files relating to REUDs

The files relating to REUDs are available for inspection once the registration has been published by the Office in the European Union Designs Bulletin. The day of publication is the date of issue shown in the European Union Designs Bulletin and is reflected under the INID code 45 in the Register.

For inspection of the files relating to an REUD that is subject to deferment of publication, please see paragraph 4.2.2., above.

4.2.5 The files relating to international registrations designating the European Union

Articles 114(8), Articles 189 and 190 EUTMR

Articles 72a and 106(d) EUDR

International registrations are exclusive rights administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva according to the Madrid Protocol (in the case of trade marks) and the Geneva Act (in the case of designs). WIPO processes the applications and then sends them to the Office for examination in accordance with the conditions specified in the EUTMR and in the EUDR. These registrations have the same effect as applying directly for an EUTM or an REUD.

The files kept by the Office relating to international trade mark registrations designating the EU may be inspected on request as from the date of publication referred to in Articles 114(8) and 190(1) EUTMR. The same rules apply as for the inspection of EUTMs.

The Office provides information on international registrations of designs designating the EU in the form of an electronic link to the searchable database maintained by the International Bureau (http://www.wipo.int/designdb/hague/en/). The files kept by the Office may relate to the refusal of the international design pursuant to Article 106e EUDR and the invalidation of the international design pursuant to Article 106f

Obsolete

EUDR. They may be inspected subject to the restrictions pursuant to Article 74 EUDR (see paragraph 5 below) and subject to the same limitations as explained in paragraphs 4.2.2 and 4.2.4 above.

5 Parts of the File Excluded from Inspection

5.1 Excluded documents

Article 114(4) and Article 169 EUTMR Article 74 EUDR

Certain documents contained in the files are excluded from inspection of files, namely:

- documents relating to the exclusion of or objection to Office staff, for example, on the grounds of suspicion of partiality;
- draft decisions and opinions and all other internal documents used for preparing decisions and opinions;
- parts of the file for which the party concerned expressed a special interest in keeping confidential;
- documents relating to the invitation of the Office to find a friendly settlement, except those that have an immediate impact on the trade mark or design, such as limitations, transfers, etc., and have been declared to the Office. (For mediation proceedings, see paragraph 4.2).

The files relating to requests for entry on the Office's list of professional representatives or designs list, including all decisions taken therein, are not open to public inspection because the files do not relate to EUTM or REUD proceedings as such (see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 4.3.5).

In principle, documents of a personal nature such as **passports or other identification documents**, which are submitted in particular as evidence in relation to requests for transfer, evidence of '**health data**', which is submitted in particular as evidence in relation to *restitutio in integrum* or as supporting evidence for extension requests, and **bank account extracts**, which may, for example, be attached to applications and requests as evidence of fee payment, because of their inherent personal nature, confidentiality vis-à-vis any third parties is justified, and, in principle, overrides any third-party interest.

Obsolete

5.1.1 Documents relating to exclusion or objection

Article 114(4) EUTMR

Article 74(4)(a) EUDR

This exception relates to documents in which an examiner states that they consider themselves excluded from participating in the case, and documents in which such a person makes observations about an objection by a party to the proceedings on the basis of a ground for exclusion or suspicion of partiality. However, it does not relate to letters in which a party to the proceedings raises, either separately or together with other statements, an objection based on a ground for exclusion or suspicion of partiality, or to any decision on the action to be taken in the cases mentioned above. The decision taken by the competent instance of the Office, without the person who withdraws or has been objected to, will form part of the files.

5.1.2 Draft decisions and opinions and internal documents

Article 114(4) EUTMR

Article 74(4)(b) EUDR

This exception relates to documents used for preparing decisions and opinions, such as reports and notes drafted by an examiner that contain considerations or suggestions for dealing with or deciding on a case, or annotations containing specific or general instructions on dealing with certain cases.

Documents that contain a communication, notice or final decision by the Office in relation to a particular case are not included in this exception. Any document to be notified to a party to the proceedings will take the form of either the original document or a copy thereof, certified by or bearing the seal of the Office, or a computer printout bearing that seal. The original communication, notice or decision or copy thereof will remain in the file.

The Notes and the Guidelines of the Office relating to general procedure and treatment of cases, such as these Guidelines, do not form part of the files. The same is true for measures and instructions concerning the allocation of duties.

5.1.3 Parts of the file for which the party concerned expressed a special interest in keeping confidential

Article 114(4) EUTMR

Article 74(4)(c) EUDR

Point in time for the request

Obsolete

Keeping all or part of a document confidential may be requested on its submission or at a later stage, as long as there is no pending request for an inspection of files. During inspection of files proceedings confidentiality may not be requested.

Parts of the file for which the party concerned expressed a special interest in keeping confidential before the application for inspection of files was made are excluded from inspection of files, unless their inspection is justified by an overriding legitimate interest of the party seeking inspection.

Invoking confidentiality and expressing a special interest

The party concerned must have expressly invoked, and sufficiently justified, a special interest in keeping the document confidential (see 08/11/2018, R 722/2018-5, nume (fig.) / Numederm, § 16). Where any request is submitted on an Office form (paper or e-filing format), the form itself cannot be marked as confidential. However, any attachments thereto may be excluded from inspection of files. This applies to all proceedings as the form includes the minimum information, which is later included in the publicly available Register, and is, therefore, incompatible with a declaration of confidentiality.

If a special interest in keeping a document confidential is invoked, the Office must check whether that special interest is sufficiently demonstrated. The documents falling into this category must originate from the party concerned (e.g. EUTM/REUD applicant, opponent).

Confidentiality invoked and special interest claimed

Where special interest is invoked and elaborated upon, the special interest must be due to the confidential nature of the document or its status as a trade or business secret. This may be the case, for example, where the applicant has submitted underlying documentation as evidence in respect of a request for registration of a transfer or licence.

Where the Office concludes that the requirements for keeping documents confidential are not met because the special interests claimed do not justify maintaining the confidentiality of the document, prior to lifting the confidentiality it will communicate with the person who filed the documents and make a decision. In reply, the applicant may submit evidence in such a way that avoids revealing parts of the document or information that the applicant considers confidential, as long as the parts of the document submitted contain the required information. For example, where contracts or other documents are submitted as evidence for a transfer or licence, certain information may be blacked out before being submitted to the Office, or certain pages may be omitted altogether.

Confidentiality invoked with no attempt to claim any special interest

Where a claim for confidentiality has been submitted by the party by use of a standard ‘confidential’ stamp on the cover page of the submission, or by ticking the ‘confidential’ tick-box when using the electronic communication platform, but the documents enclosed contain no explanation nor indication of any special interest nor

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any attempt on behalf of the party to justify the confidential nature or status of the submission, the Office will remove this indication.

This applies to all submissions where the party claims confidentiality 'by default', yet provides no justification in support of its claim. The party can at any time before the receipt of a request for inspection of files, invoke and sufficiently justify a special interest in keeping the document confidential.

In the event that the Office invites the parties to opposition, cancellation or invalidity proceedings to consider a friendly settlement, all corresponding documents referring to those proceedings are considered confidential and, in principle, not open to inspection of files.

Access to documents that the Office has accepted as being confidential and thus, excluded from inspection, may nevertheless be granted to a person who demonstrates an overriding legitimate interest in inspecting the document. The overriding legitimate interest must be that of the person requesting inspection.

If the file contains such documents, the Office will inform the applicant for inspection of files about the existence of such documents within the files. The applicant for inspection of files may then decide whether or not it wants to file a request invoking an overriding legitimate interest. Each request must be analysed on its own merits.

The Office must give the party requesting inspection the opportunity to present its observations.

Before taking a decision, the request, as well as any observations, must be sent to the party concerned, who has a right to be heard.

Article 67 EUTMR Article 56 EUDR

The Office must make a decision as to whether to grant access to such documents. Such a decision may be appealed by the adversely affected party.

5.2 Access for applicant or proprietor to excluded documents

Article 114(4) EUTMR Article 74 EUDR

Where an applicant or proprietor requests access to their own file, this will mean all documents forming part of the file, excluding only those documents referred to in Article 114(4) EUTMR and Article 74(4)(a) and (b) EUDR.

In *inter partes* proceedings, where the one concerned (the opponent or applicant for revocation or declaration of invalidity) has shown a special interest in keeping its document confidential vis-à-vis third parties, it will be informed that the documents cannot be kept confidential with respect to the other party to the proceedings and it will

Obsolete

be invited to either disclose the documents or withdraw them from the proceedings. If it confirms the confidentiality, the documents will not be sent to the other party and will not be taken into account by the Office in the decision.

If, on the other hand, it wants the documents to be taken into account but not available for third parties, the documents can be forwarded by the Office to the other party to the proceedings, but will not be available for inspection by third parties (for opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.4.4).

6 Procedures before the Office Relating to Applications for Inspection of Files

6.1 Certified or uncertified extracts of the Registers

Article 111(7) EUTMR
Article 63 EUTMDR
Articles 50 and 72 and Article 74(5) EUDR
Decision EX-25-05 of the Executive Director of the Office of 07/04/2025 on the register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database.

The Office will provide certified or uncertified extracts from the EUTM or EUD Register. For deferred designs, such excerpts are subject to the conditions laid down in Article 74(5) EUDR.

Where registration is subject to a deferment of publication, pursuant to Article 50(1) EUDR, certified (or uncertified) extracts from the Register should only contain the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred.

Extracts from the EUTM and EUD Registers can be obtained through the following methods.

1. The eRegister: on entering the eRegister repository of an IP right, a user who is logged into their User Area account has the option of downloading a certified copy of the extract from the Register for this IP right. Generating this extract directly from the eRegister is free of charge.
2. An online request in the User Area: where this is carried out online through the User Area account, the user will be redirected to the eRegister repository (see point 1) to download a certified copy of the extract immediately and free of charge.

Obsolete

3. Only for EUTMs: the user may request the Office send an extract, or a similar request, by post in the User Area. The Office will send the user the certified or uncertified extract that is retrieved from, and corresponds to, the extracts retrievable online through the eRegister. The request is subject to the payment of a fee pursuant to Article 111(7) EUTMR and point A.29 of Annex I EUTMR. Requests cannot be made for extracts of the EUD Register because Article 72(7) EUDR only allows the issuing of extracts by electronic means.

Extracts downloaded from the eRegister for any IP right are authentic extracts from the EUTM and EUD Registers. They are certified by default and bear an identification code that may be used to verify the authenticity of certified copies online.

6.2 Certified or uncertified copies of file documents

The Office will provide certified or uncertified copies of documents constituting the EUTM or REUD files (see paragraph 4.2). Downloadable (certified) copies are free of charge (see paragraph 6.4).

In addition, requests for certified or uncertified copies of documents may be submitted using the online form, which can be found on the EUIPO website at https://euipo.europa.eu/ohimportal/en/forms-and-filings, or any equivalent request.

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 6.7.

Certified copies of the EUTM application or the REUD registration certificate will only be available when a filing date has been accorded (for EUTM filing date requirements, see the Guidelines, Part B, Examination, Section 2, Formalities; for REUD filing date requirements, see the Guidelines on Examination of Applications for Registered European Union Designs).

In the case of an application for multiple designs, certified copies of the application will only be available for those designs that have been accorded a filing date.

Where the EUTM application or REUD registration has not yet been published, a request for certified or uncertified copies of the file documents will be subject to the restrictions listed in paragraphs 4.2.1 to 4.2.4 above.

It should be borne in mind that the certified copy of the application or registration only reflects the data on the date of application or registration. The trade mark or design may have been the subject of a transfer, surrender, partial surrender or other act affecting its scope of protection, which will not be reflected in the certified copy of the EUTM application form or EUTM/REUD registration certificate. Up-to-date information is available from the electronic database or by requesting a certified extract of the Register (see paragraph 6.1 above).

Obsolete

6.3 Online access to the files

The contents of the EUTM files are available in the 'Correspondence' section of the file in the Office's online tool on the Office's website.

Providing the EUTM application or the REUD registration (not subject to a deferment) has been published, registered users of the website can consult these files free of charge.

6.4 Downloadable certified copies

Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means, and its Annex I.

Decision EX-25-05 of the Executive Director of the Office of 7 April 2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database, Article 5, and its Annex I and Annex II.

Article 51(2) EUTMR

Certified and uncertified copies of EUTM and REUD applications, registration certificates, extracts of the Register and copies of the documents in the file (available only for EUTMs) can be automatically generated and downloaded:

- when the user is logged in via a direct link from the EUIPO website using the Office's online eSearch Plus tool or from the eRegisters;
- from within the Inspection of Files e-filing form;
- from within the files for a selected EUTM or REUD; and
- certified copies of application forms and registration certificates can also be downloaded from the TMview and DesignView databases.

The copy of the document will be made available in PDF format, and will be composed of a cover page in the five Office languages, introducing the certified document and followed by the certified document itself. The document contains a unique identification code. Each page of the document should bear a header and footer containing important elements in order to guarantee the authenticity of the certified copy: a unique identification code, a 'copy' stamp, the signature of the Office staff member responsible for issuing certified copies, the date of the certified copy, the EUTM/REUD number and page number. The date indicated is the date when the certified copy was automatically generated.

The automatically generated certified copies have the same value as certified copies sent on paper upon request in EUTM proceedings, and can be used in either their electronic or printed format.

Obsolete

When an authority receives a certified copy, it can verify the original document online using the unique identification code given in the certified copy. A link 'Verify certified copies' is available under the 'Databases' section of the Office's website. Clicking on the link will bring up a screen with a box in which the unique identification code can be entered in order to retrieve and display the original document from the Office's online systems.

The authenticity of certified copies of application or registration certificates downloaded from TMview or DesignView can also be verified in TMview or DesignView.

For further information on the availability and content of the certificates, see paragraph 6.2.

6.5 Online applications for inspection of files

Users may access the application form online through their user account, where they will be invited to log in and complete the application for inspection of files requesting certified or uncertified copies of specific documents.

6.6 Written applications for inspection of files

Article 63 EUTMDR Article 65 EUDIR

Online inspection within eSearch plus (correspondence section) is strongly recommended. This type of online inspection is immediate and free of charge once the user is logged into the User Area.

For any files that are not subject to online inspection in eSearch plus, applications for inspection, or any equivalent requests, may be submitted using the online form, which can be found on the EUIPO website at https://euipo.europa.eu/ohimportal/en/forms-and-filings. The following explains the conditions for a request for inspection.

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 6.7 below.

Article 63 EUTMDR Article 67 EUDIR

An application for inspection of files may be submitted as an original signed form by electronic means (see paragraph 6.5 above).

For EUTMs, the request may also be submitted by post or courier. For REUDs, only inspection by electronic means is possible.

Obsolete

6.7 Languages

Applications for inspection of files must be filed in one of the languages indicated below.

6.7.1 For EUTM or REUD applications

Article 146(6) and (9) EUTMR

Article 25 EUTMIR

Articles 80, 81, 83 and 84 EUDIR

Where the application for an inspection of files relates to a EUTM application or REUD application, whether already published or not, it must be filed in the language in which the EUTM application or REUD application was filed (the 'first' language) or in the second language indicated by the EUTM applicant or REUD applicant in their application (the 'second' language).

Where the application for inspection is filed in a language other than indicated above, the applicant for inspection must, of its own motion, submit a translation into one of the languages indicated above within 1 month. If such a translation is not submitted within the deadline, the application for inspection of files will be considered not to have been filed.

This does not apply where the applicant for inspection could not have been aware of the languages of the EUTM application or REUD application. This can be the case only where such information is not available in the online Register and the application can immediately be dealt with. In this case, the application for inspection may be filed in any of the five languages of the Office.

6.7.2 For registered EUTMs or REUDs

Article 146(6) and (9) EUTMR

Article 25 EUTMIR

Article 80(b), Articles 81, 83 and 84 EUDIR

Where the application for inspection of files relates to a registered EUTM or REUD, it must be filed in one of the five languages of the Office.

The language in which the application for inspection was filed will become the language of the inspection proceedings.

Where the application for inspection of files is made in a language other than indicated above, the party requesting inspection must, on its own motion, submit a translation

Obsolete

into one of the languages indicated above within one month, or the application for inspection of files will be considered not to have been filed.

6.8 Representation and authorisation

Representation is not mandatory for filing an application for inspection of files.

Where a representative is appointed, the general rules for representation and authorisation apply. See the Guidelines, Part A, General Rules, Section 5, Professional Representation.

6.9 Contents of the application for inspection of files

The application for inspection of files mentioned in paragraphs 6.5 and 6.6 above must contain the following.

- An indication of the file number or registration number for which inspection is applied.
- The name and address of the applicant for inspection of files.
- If appropriate, an indication of the document or information for which inspection is applied (applications may be made to inspect the whole file or specific documents only). In the case of an application to inspect a specific document, the nature of the document (e.g. 'application', 'notice of opposition') must be stated. Where communication of information from the file is applied for, the type of information needed must be specified. Where the application for inspection relates to an EUTM application that has not yet been published, the application for an REUD that has not yet been published or an REUD that is subject to deferment of publication in accordance with Article 50 EUDR or which, being subject to such deferment, has been surrendered before or on the expiry of that period, and inspection of the files is applied for by a third party, an indication and evidence to the effect that the third party concerned has a right to inspect the file.
- As a general rule, the Office only provides electronic copies of files which are notified through the User Area. Where copies can be requested, an indication of the number of copies requested, whether or not they should be certified and, if the documents are to be presented in a third country requiring an authentication of the signature (legalisation), an indication of the countries for which authentication is needed.
- The applicant's signature in accordance with Article 63(1) EUTMDR and Article 65 EUDIR.

6.10 Deficiencies

Where an application for inspection of the files fails to comply with the requirements concerning the contents of applications, the applicant for inspection will be invited to

Obsolete

remedy the deficiencies. If deficiencies are not remedied within the established time limit, the application for inspection will be refused.

6.11 Fees for inspection and communication of information contained in the files

Any fees payable are due on the date of receipt of the application for inspection.

6.11.1 Communication of information contained in a file

Article 114(9) and Annex I A(32) EUTMR

For EUTMs, communication of information in a file is subject to payment of a fee of EUR 10.

6.11.2 Inspection of the files

Article 114(6) and Annex I A(30) EUTMR

For EUTMs, a request for inspection of the files on the Office's premises is subject to payment of a fee of EUR 30. Since all files are electronic, the Office will only provide electronic access to the files at the Office's premises. Therefore, inspection of the files on the Office's premises has de facto become obsolete for EUTM files.

For REUD files, no inspection on the Office's premises is available.

Article 114(7) and Annex I A(31)(a) EUTMR

Where inspection of an EUTM file is done by the Office issuing **uncertified** copies of file documents, these copies are subject to the payment of a EUR 10 fee plus EUR 1 for every page exceeding ten.

Article 51(2) EUTMR

Articles 111(7), 114(7) and Annex I A(29)(a) EUTMR

An **uncertified** copy of an EUTM application, an **uncertified** copy of the certificate of registration, an **uncertified** extract from the Register or an **uncertified** extract of the EUTM application from the database is subject to the payment of a EUR 10 fee per copy or extract.

However, registered users of the website can obtain electronic **uncertified** copies of EUTM or REUD applications or registration certificates free of charge through the website.

Article 114(7) and Annex I A(31)(b) EUTMR

Where inspection of an EUTM file is obtained through the issuing of **certified** copies of file documents, those copies are subject to payment of a fee of EUR 30 plus EUR 1 for every page exceeding ten.

Obsolete

Article 51(2) EUTMR

Articles 111(7), 114(7) and Annex I A(29)(b) EUTMR

A **certified** copy of an EUTM application, a **certified** copy of the certificate of registration, a **certified** extract from the Register or a **certified** extract of the EUTM application from the database is subject to the payment of a EUR 30 fee per copy or extract.

However, registered users of the website can obtain electronic **certified** copies of EUTM applications or registration certificates free of charge through the website.

6.11.3 Consequences of failure to pay

Article 114(6) EUTMR

Regarding the inspection of an EUTM file, an application for inspection of files will be considered not to have been filed until the fee has been paid. The fees apply not only where the application for inspection has been filed by a third party, but also where it has been filed by the EUTM applicant or proprietor. The Office will not process the inspection application until the fee has been paid.

However, if the fee is not paid or is not paid in full, the Office will notify the applicant for inspection:

- if no payment is received by the Office for a certified or uncertified copy of an EUTM application, a certificate of registration or an extract from the Register or from the database;
- if no payment is received by the Office for inspection of the files obtained through the issuing of certified or uncertified copies of file documents;
- if no payment is received by the Office for the communication of information contained in a file.

The Office will issue a letter indicating the amount of fees to be paid. If the exact amount of the fee is not known to the applicant for inspection because it depends on the number of pages, the Office will either include that information in the standard letter or inform the applicant for inspection by other appropriate means.

6.11.4 Refund of fees

Where an application for inspection of EUTM files is rejected, the corresponding fee is not refunded. However, where, after the payment of the fee, the Office finds that not all the certified or uncertified copies requested may be issued (e.g. if the request concerns confidential documents and the applicant has not proven an overriding legitimate interest), any fees paid in excess of the amount actually due will be refunded.

Obsolete

6.12 Requirements concerning the right to obtain inspection of files concerning an unpublished EUTM application, or a deferred REUD filed by a third party

Article 114(1) and (2) EUTMR

Articles 74 and 74a(2) EUDR

Where an application for inspection of files for an EUTM application that has not yet been published, or for files relating to an REUD subject to deferment of publication in accordance with Article 50 EUDR, or for those which, subject to such deferment, have been surrendered before or on the expiry of that period, (see paragraphs 4.2.1 and 4.2.2 above) is filed by a third party (i.e. by a person other than the EUTM or REUD applicant or its representative), different situations may arise.

If the application by a third party is based on the grounds specified in Article 114(1) and (2) EUTMR (see paragraph 4.2.1 above), or in Articles 74(2) or 74a(2) EUDR (see paragraph 4.2.2 above), it must contain an indication and evidence to the effect that the EUTM applicant or REUD applicant or holder has consented to the inspection, or has stated that it will invoke the rights under the REUD, once registered, against the applicant for inspection.

6.12.1 Consent

The consent of the EUTM applicant or REUD applicant or holder must be in the form of a written statement in which it consents to the inspection of the particular file(s). Consent may be limited to inspection of certain parts of the file, such as the application, in which case the application for inspection of files may not exceed the scope of the consent.

Where the applicant for inspection of files does not submit a written statement from the EUTM applicant, REUD applicant or holder consenting to the inspection of the files, the applicant for inspection will be notified and given 2 months from the date of notification to remedy the deficiency.

If, after expiry of the time limit, no consent has been submitted, the Office will reject the application for inspection of files. The applicant for inspection will be informed of the decision to reject the application for inspection.

The decision may be appealed by the applicant for inspection (Articles 67 and 68 EUTMR and Article 56 EUDR).

Obsolete

6.12.2 Statement that EUTM or REUD rights will be invoked

Article 114(2) EUTMR

Articles 74(2) and 74a(2) EUDR

Where the application relies on the allegation that the EUTM or REUD proprietor will invoke the rights under the EUTM or REUD, once registered, it is up to the applicant for inspection to prove this allegation. The proof to be submitted must take the form of documents, such as, statements by the EUTM applicant or REUD applicant or holder for the EUTM application, REUD application or registered and deferred REUD in question, business correspondence, etc. Filing an opposition based on an EUTM application against a national mark constitutes a statement that the EUTM will be invoked. Mere assumptions on the part of the applicant for inspection of the file will not constitute sufficient proof.

The Office will first examine whether the proof is sufficient.

If so, the Office will send the application for inspection of files and the supporting documents to the EUTM applicant or REUD applicant or holder and invite it to comment within two months. If the EUTM applicant or REUD applicant or holder consents to an inspection of the files, it will be granted. If the EUTM applicant or REUD applicant or holder submits comments contesting inspection of the files, the Office will send the comments to the applicant for inspection. Any further statement by the applicant for inspection will be sent to the EUTM applicant or REUD applicant or holder and vice versa. The Office will take into account all submissions made on time by the parties and decide accordingly. The Office's decision will be notified to both the applicant for inspection of the files and the EUTM applicant or REUD applicant or holder. It may be appealed by the adversely affected party (Articles 67 and 68 EUTMR and Article 56 EUDR).

6.13 Grant of inspection of files, means of inspection

When inspection is granted, the Office will send the requested copies of file documents, or requested information, as appropriate, to the applicant for inspection or invite it to inspect the files at the Office's premises. The Office will not forward the requested documents to any third parties.

6.13.1 Communication of information contained in a file

Article 114(9) EUTMR

Article 74b EUDR

Information regarding the file can be inspected by the user via eSearch Plus free of charge.

Obsolete

However, the Office may, on request, communicate information contained in any file relating to EUTM or REUD applications or registrations.

Information contained in the files will be provided without an application for inspection, inter alia, where the party concerned wishes to know whether a given EUTM application has been filed by a given applicant, the date of such application, or whether the list of goods and services has been amended in the period between the filing of the application and its publication.

Having obtained this information, the party concerned may then decide whether or not to request copies of the relevant documents, or to apply for inspection of the file.

Where the party concerned wishes to know, inter alia, which arguments an opponent has brought forward in opposition proceedings, which seniority documents have been filed, or the exact wording of the list of goods and services as filed, such information will not be provided. Instead the Office will advise the party to apply for inspection of the file.

In such cases, the quantity and complexity of the information to be supplied would exceed reasonable limits and create an undue administrative burden.

6.13.2 Copies of file documents

Where inspection of the files is by means of the Office providing certified or uncertified copies of file documents, the party will be sent the requested documents.

Where inspection of EUTM files is granted on the Office premises, the applicant will be given an appointment to inspect the files. However, it is strongly recommended to refrain from an inspection on the Office's premises, since the exact same information can be made available online or sent to the user through the user area (see paragraph 6.11.2).

6.13.3 Specific interest concerning the inspection applicant

Where a party shows a specific interest in knowing whether its file has been inspected and by whom, there should be a compromise between the general interest of the public to be able to inspect files of proceedings before the Office with a minimum of formalities and the parties' specific interest to know who has inspected the file in exceptional, duly justified circumstances.

Considering that online inspection requests are not communicated as a matter of course to the party whose file has been inspected, that party must put forward a reasoned and substantiated request showing that there are legitimate reasons for being informed if its file has been inspected, and by whom. The Office will not automatically grant such a request. Instead, on a case-by-case basis, it will balance these reasons against the explanations provided by the person who made the inspection within a period set by the Office to that effect, before any such request is granted.

Obsolete

7 Procedures to Give Access to the Files to Courts or Authorities of the Member States

Article 117(1) EUTMR

Article 75(1) EUDR

Articles 20 and 21 EUTMIR

Articles 77 and 78 EUDIR

For the purposes of administrative cooperation, the Office will, on request, assist the courts or authorities of the Member States by communicating information or opening files for inspection.

For the purposes of administrative cooperation, the Office will also, on request, communicate relevant information about the filing of EUTM or REUD applications and proceedings relating to such applications, and the marks or designs registered as a result thereof, to the central industrial property offices of the Member States.

7.1 No fees

Article 20(3) and Article 21(1) and (3) EUTMIR

Article 75(2) EUDR

Article 77(3) and Article 78(3) EUDIR

Inspection of files and communication of information from the files requested by the courts or authorities of the Member States are not subject to the payment of fees.

Article 21(3) EUTMIR

Article 78(2) EUDIR

Courts or public prosecutors' offices of a Member State may open to inspection by third parties files, or copies thereof, that have been transmitted to them by the Office. The Office will not charge any fee for such inspection.

Obsolete

7.2 No restriction as to unpublished applications

Articles 114(4) and 117(1) EUTMR

Article 20(1) EUTMIR

Articles 74 and 75(1) EUDR

Article 77(1) EUDIR

Inspection of files and communication of information from the files requested by the courts or authorities of the Member States is not subject to the restrictions contained in Article 114 EUTMR and Article 74 EUDR. Consequently, these bodies may be granted access to files relating to unpublished EUTM applications (see paragraph 4.2.1 above) and REUDs subject to deferment of publication (see paragraph 4.2.2 above), as well as to parts of the files for which the party concerned has expressed a special interest in keeping confidential. However, documents relating to exclusion and objection, as well as the documents referred to in Article 114(4) EUTMR and Article 74(4)(b) EUDR, will not be made available to these bodies.

Article 114(4) EUTMR

Article 21(3) EUTMIR

Article 74 EUDR

Article 78(2) EUDIR

Courts or public prosecutors' offices of the Member States may open to inspection by third parties files or copies that have been transmitted to them by the Office. Such subsequent inspection shall be subject to the restrictions contained in Article 114(4) EUTMR or Article 74 EUDR, as if the inspection had been requested by a third party.

Article 21(2) EUTMIR

Article 78(4) EUDIR

When transmitting files or copies thereof to the courts or public prosecutors' offices of the Member States, the Office will indicate the restrictions imposed on inspection of files relating, on the one hand to EUTM applications or registrations pursuant to Article 114 EUTMR, and on the other hand to REUD applications or REUD registrations pursuant to Article 74 EUDR.

Obsolete

7.3 Means of inspection

Article 21(1) EUTMIR Article 78(1) EUDIR

Inspection of the files relating to EUTM/REUD applications or registrations by courts or authorities of the Member States may be granted by providing copies of the original documents. As the files contain no original documents as such, the Office will provide printouts from the electronic system.

Obsolete

GUIDELINES FOR EXAMINATION

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GUIDELINES FOR EXAMINATION

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1 Introduction

Counterclaims, as provided for in Article 128 EUTMR or Article 84 EUDR, are defence claims made by a defendant that is being sued for the infringement of an EUTM or registered European Union design (REUD). By way of such a counterclaim, the defendant asks the European Union trade mark court (EUTM court) or European Union design court (EUD court) to declare the revocation or invalidity of the EUTM or the invalidity of the REUD that it is alleged to have infringed.

The purpose of recording the filing and the final judgment of the counterclaim in the Office Register lies in the general interest of making all the relevant information on counterclaims concerning EUTMs and REUDs, in particular the final judgments thereof, publicly available. In this way, the Office can implement these final judgments, in particular those that declare the total or partial revocation or invalidity of an EUTM, as well as those that declare the total invalidity of an REUD.

By entering such counterclaims and their final judgments in the Register, the Office strives to comply with the principles of conformity to truth, public faith and the legal certainty of a public register.

Application to register the filing of a counterclaim before an EUTM or an EUD court

Article 111(3)(n) and Article 128(4) EUTMR Articles 84, 84(5) and 72(3)(q) EUDR Communications No 9/05 and No 10/05 of the President of the Office of 28/11/2005

According to Article 128(4) EUTMR and Article 86(2) EUDR, the EUTM or EUD court before which a counterclaim for revocation of an EUTM or for a declaration of invalidity of an EUTM or REUD has been filed must inform the Office of the date on which the counterclaim was filed.

The Regulations provide that the court with which a counterclaim for revocation of an EUTM or for a declaration of invalidity of an EUTM or REUD has been filed must not proceed with the examination of the counterclaim until either the interested party or the court has informed the Office of the date on which the counterclaim was filed.

Communications No 9/05 and No 10/05 of the President of the Office of 28/11/2005 concern the designation of EUTM and EUD courts in the Member States pursuant to Article 123 EUTMR and Article 80 EUDR.

The Office also allows any party to the counterclaim proceedings to request the entry of a counterclaim in the Register, if not yet communicated by the EUTM or EUD court.

The applicant should:

Obsolete

- indicate the date on which the counterclaim was filed;
- quote the number of the EUTM or REUD concerned;
- state whether the application is for revocation or for a declaration of invalidity;
- submit evidence that the counterclaim has been raised before the EUTM or EUD court with authority to rule on the counterclaim, including, where possible, the case or reference number from the court.

If the above is not submitted, or if the information submitted by the applicant requires clarification, the Office will issue a deficiency letter. If the deficiencies are not remedied, the Office will reject the application for registration of the counterclaim. The party concerned may file an appeal against this decision.

The Office will notify the EUTM or REUD proprietor and the EUTM or EUD court that the counterclaim has been entered in the Register. If the request was made by the other party to the counterclaim proceedings, the Office will also inform this party.

If an application for revocation or for a declaration of invalidity of an EUTM had already been filed with the Office before the counterclaim was filed, the Office will inform the courts before which a counterclaim is pending in respect of the same mark. The courts will stay the proceedings in accordance with Article 132(1) EUTMR and Article 91(1) EUDR until the decision on the application is final or the application is withdrawn.

3 Application to register a judgment on a counterclaim before an EUTM or an EUD court

Article 111(3)(o) and Article 128(6) EUTMR

Articles 86(3) and 72(3)(r) EUDR

Where an EUTM or a EUD court has delivered a judgment that has become final on a counterclaim for revocation of an EUTM or for a declaration of invalidity of an EUTM or REUD, a copy of the judgment must be sent to the Office.

The Office also allows any party to the counterclaim proceedings to request the entry of a judgment on the counterclaim action in the Register, if not yet communicated by the EUTM or EUD court.

The applicant should:

- submit a copy of the judgment, together with confirmation from the EUTM or EUD court that the judgment has become final;
- indicate the date on which the judgment was issued;
- quote the number of the EUTM or REUD concerned;
- state whether the request is for revocation or for a declaration of invalidity;
- in the event of partial cancellation or invalidity, indicate the list of goods and services affected by the judgment, if relevant.

In order to enter the counterclaim in the Register, the Office needs confirmation that the judgment **is final** (passée en force de chose jugée/rechtskräftig/adquirido fuerza de cosa juzgada, etc.). If the Office requires clarification, it may request this in writing.

Obsolete

The Office must mention the judgment in the Register and take the necessary measures to comply with its operative part.

Where the final judgment partially cancels an EUTM, the Office will alter the list of goods and services according to the EUTM court judgment and, where necessary, send the amended list of goods and services for translation.

The Office will notify the EUTM or REUD proprietor and the EUTM or EUD court that the judgment has been entered in the Register. If the request was made by the other party to the counterclaim proceedings, the Office will also inform this party.

Obsolete