GUIDELINES FOR EXAMINATION OF REGISTERED EUROPEAN UNION DESIGNS

EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

1 Introduction

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

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

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

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

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

The Guidelines on EU trade marks and the Guidelines on registered EU designs that are currently in force were adopted by the Executive Director on 30/06/2026 (Decision No EX-26-09), and entered into force on 01/07/2026.

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

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

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

GUIDELINES FOR EXAMINATION OF REGISTERED EUROPEAN UNION DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Examination of applications for registered European Union designs

1 Introduction

The Guidelines explain how, in practice, the provisions of the European Union design regulation ([1]) (EUDR), the European Union design implementing regulation ([2]) (EUDIR) and the European Union design delegated regulation ([3]) (EUDDR) are applied by the Office's Business Operations Department from receipt of an application for a registered European Union design (EUD) up to its registration and publication.

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

The purpose of the Guidelines is to ensure consistency among the decisions taken by the Business Operations Department and to ensure a coherent practice in file handling. These Guidelines are merely a set of consolidated rules setting out the line of conduct that the Office itself proposes to adopt, which means that, to the extent that those rules comply with the legal provisions of a higher authority, they constitute a self-imposed restriction on the Office, in that it must comply with the rules that it has itself laid down. However, these Guidelines cannot derogate from the EUDR, the EUDIR or the EUDDR, and it is solely in the light of those regulations that they should be interpreted and applied.

The Guidelines are structured to follow the sequence of the examination process, with each section and subsection constituting a step in the registration proceedings from receipt of the application up to registration and publication. The general principles should be kept in mind throughout the whole examination process (see the Guidelines, Part A, General Rules, which are shared with current trade mark practice covering such topics as means of communication, time limits, general principles to be respected in the proceedings before the Office, and professional representation, among others).

2 Filing an Application with the Office

2.1 Introduction

There are two ways of applying for registration of a European Union design, that is, (i) either via direct filing with the Office (Article 41 EUDR) or (ii) by filing an international registration with the International Bureau of the World Intellectual Property Organization and designating the European Union (Article 152 EUDR).

1 Regulation (EU) 2026/715 of the European Parliament and of the Council of 11 March 2026 on European Union Designs (codification).

2 Commission Implementing Regulation (EU) 2026/138 of 15 January 2026 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 6/2002 on European Union designs.

3 Commission Delegated Regulation (EU) 2026/137 of 15 January 2026 supplementing Regulation (EC) No 6/2002 on European Union designs with rules specifying the details of certain proceedings concerning registered designs, and repealing Commission Regulation (EC) No 2245/2002.

Applications filed after 01/05/2025 through national offices (Member State intellectual property offices or the Benelux Office for Intellectual Property (BOIP)) are no longer accepted.

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

2.2 Filing the application

An application for a registered European Union design may only be filed directly with the Office by e-filing (i.e. by electronic means).

By virtue of Article 88 EUDR, Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means lays down that the accepted means of electronic communication with the Office in **procedures relating to EU designs** is the User Area.

A registered European Union design can be filed via the Office's website (https://www.euipo.europa.eu/en/designs/how-to-apply/apply-now), which also allows for the accelerated procedure (Fast Track).

Exceptionally, where a technical malfunction prevents the applicant from filing through the User Area, an EUD application may be submitted by one of the alternative electronic back-up measures available (see the Guidelines, Part A, General rules, Section 1 Means of communication, time limits, paragraph 3.1.1 Via the User Area (electronic means)).

2.3 Content of the application

2.3.1 Minimum requirements

The application must satisfy all the mandatory requirements set out in Articles 42, 44, and 48(2) EUDR and Articles 1 (Content of the application) and 2 (Representation of the design) EUDIR.

The application must be signed by the applicant (see paragraph 6.1.4).

2.3.2 Additional requirements

Additional requirements apply where the applicant selects one of the following options: a multiple application is filed (Article 44 EUDR and Article 1(5) EUDIR), a priority or an exhibition priority is claimed (Articles 50 and 53 EUDR and Articles 3 and 4 EUDIR), or where the applicant chooses to be, or must be, represented (Article 115 EUDR).

2.3.3 WIPO DAS

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

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

Using the EUIPO as **Office of First Filing**, applicants may request that their application be registered in the WIPO DAS system. The Office will register the application in WIPO DAS by providing the mandatory data elements in the registration request, including:

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

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

In accordance with the Common Communication for requirements and means of design representation, in respect of the right of priority, when relying on a first filing in the EU for a design represented by means of a dynamic or animated representation, applicants should be aware that such new types of representation may not be recognised in jurisdictions outside the EU. In such cases, an applicant may consider to submit static views of the design as the first EU filing to rely on them for a subsequent filing outside the EU in a jurisdiction which only recognises static views. This does not prevent an applicant from filing a separate design by means of dynamic or animated representation. Such separate designs may also be included within a multiple application.

2.4 Language of the application

For information on the language regime for EUD applications, see the Guidelines, Part A General rules, Section 4, Language of the proceedings, paragraph 2 From filing to registration (excluding opposition).

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

2.5 Representatives

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

The representative must be indicated in the application. If this requirement is not complied with, the applicant will be requested to appoint a representative within 2 months. Where the applicant does not comply with the request, the application is rejected as inadmissible (Articles 55(3) and 115(2) EUDR).

For more information on professional representation, please refer to the Guidelines, Part A, General Rules, Section 5, Parties to the proceedings and professional representation.

2.6 Date of receipt, file number and issue of receipt

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

The Office's User Area (e-filing) immediately issues an automatic electronic filing receipt, which contains the elements of Article 41(2) EUDR, including the date of receipt and the file number for the application for a registered European Union design.

For further information on communications to the Office, see the Guidelines, Part A, General Rules, Section 1, Means of communication, time limits.

3 Filing date requirements

Under Article 46 EUDR, a filing date is accorded where the application meets the following requirements:

1. the application is a request for registration of a European Union design;
2. the application contains information identifying the applicant;
3. the application contains a sufficiently clear representation of the design pursuant to Article 42(1)(c) EUDR and that satisfies the requirements set out in Article 2 EUDIR; and
4. the application fee (Article 42(4) EUDR) and, where relevant, the additional application fees for a multiple application (Article 44(2) EUDR) have been paid within 1 month of filing the application.

The following paragraphs provide more details on each of these requirements.

3.1 Payment of fees

The application fee and, where relevant, the additional application fees for a multiple application, must be paid within 1 month of the filing of the application in order for the reception date of the application to be accorded as the filing date (provided the other filing date requirements are met, see paragraphs 3.2, 3.3 and 3.4 below). See the Guidelines Part A, Section 3 Payment of fees, costs and charges for further information on acceptable means of payment.

Where the application fee is not paid within 1 month the Office will send a letter requesting the applicant to remedy the deficiency within 2 months. This time limit is not extendable.

If payment is received within these 2 months, the filing date will be the date on which payment is received.

If the payment deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application for an EU design (Article 55(4) EUDR). Any fees paid will be refunded.

If payment is insufficient to cover all fees, unless the applicant has clearly specified the purpose of the payment, it will first be used to cover the application fees in order to secure a filing date. For multiple applications, the payment will first be used for the application fees in the numerical order of the designs. Any remaining sums will be used as payment for deferment fees in the numerical order of the designs. For more information on the payment of deferment fees, see paragraph 6.1.1 below.

3.2 Request for registration

A request for registration is filed where the applicant has successfully submitted the application using e-filing (see paragraph 2.2, above).

3.3 Information identifying the applicant

For the purpose of allocating a filing date, the information identifying the applicant does not have to satisfy all the requirements set out in Article 1(1)(a),(b) and (2) EUDIR (see paragraph 6.1.2). It is enough that the surname and forename(s) of natural persons or the corporate name of legal entities is supplied, along with the address at which the applicant is domiciled or has a seat or an establishment, or any other data communication link that allows the applicant to be contacted. If the Office has given the applicant an identification number, it is sufficient to mention that number together with the applicant's name. For information on the identification elements of design applicants, including the name, legal form, and address, see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 3, Identification of parties to the proceedings.

Where this requirement is not met, a letter will be sent requesting the applicant to remedy the deficiency within 2 months. This time limit is not extendable.

If the deficiency is remedied within these 2 months, the filing date will be the date on which the mandatory requirements are complete.

If the deficiency is not remedied, the application will not be dealt with as an application for an EU design (Article 55(4) EUDR). Any fees paid shall be refunded.

3.4 Sufficiently clear representation of the design

Design protection is conferred for those features of appearance of a registered EU design that are shown visibly in the application for registration (Article 19 EUDR). The scope of protection is not affected by any verbal disclaimer included in a description explaining the representation of the design (Article 42(6) EUDR).

The design representation must be sufficiently clear to enable the subject matter for which protection is sought to be determined (Article 42(1)(c) EUDR).

The representation of the design may be static, dynamic or animated, either in black and white or in colour (Article 2(1) EUDIR).

The design must be represented alone, excluding any other matter. However, this does not prevent the use of visual disclaimers for matter for which no protection is sought (see paragraph 5.6).

Drawings, photographs, videos, computer imaging or computer modelling, or representations using any other generally available technology, are accepted, provided they meet the requirements of Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means.

Where the representation of the design is not sufficiently clear to determine the subject matter for which protection is sought, a letter will be sent requesting the applicant to remedy the deficiency within 2 months. This time limit is not extendable.

If the deficiency is remedied within these 2 months, the filing date will be the date on which the mandatory requirements are complete.

If the deficiency is not remedied, the application will not be dealt with as an application for an EU design (Article 55(4) EUDR). The Office will not grant a filing date and will issue a notice of file closure. Any fees paid shall be refunded.

4 Grounds for non-registrability

The Office carries out an examination of the grounds for non-registrability, which, pursuant to Article 56(1) EUDR, are limited to three grounds.

An application will be refused if the design:

1. does not correspond to the definition set out in Article 4(1) EUDR;
2. is contrary to public policy or to accepted principles of morality (Article 10 EUDR);

3. without authorisation from the competent authority for its registration, constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention, or of badges, emblems and escutcheons other than those covered by the said provision, and which are of particular public interest in a Member State.

4.1 Compliance with the definition of a design

A ‘design’ means the appearance of the whole or a part of a product resulting from the features, in particular the lines, contours, colours, shape, texture, and/or materials, of the product itself and/or of its decoration, including the movement, transition or any other sort of animation of those features (Article 4(1) EUDR).

A ‘product’ means any industrial or handicraft item, other than a computer program, regardless of whether it is embodied in a physical object or materialises in a non-physical form, including:

(a) packaging, sets of articles, spatial arrangements of items intended to form an interior or exterior environment, and parts intended to be assembled into a complex product;

(b) graphic works or symbols, logos, surface patterns, typographic typefaces, and graphical user interfaces; (Article 4(2) EUDR).

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

Whether a design discloses the appearance of the whole or a part of a ‘product’ will be examined in the light of the design itself, insofar as it makes clear what the nature of the product is, its intended purpose or its function, and that it makes clear what the indication of the products is that the design is intended to be incorporated in, or to which it is intended to be applied (Article 42(2) EUDR).

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

4.1.1 Blueprints, technical drawings, plans for houses or other architectural plans of interior or exterior designs

Blueprints, technical drawings, plans for houses or other architectural plans of interior or exterior designs (e.g. gardens) will be considered ‘products’ for the purpose of Article 4(2) EUDR and will only be accepted with the corresponding indication of other printed matter in Class 19-08 of the Locarno Classification. Where the design is the 3D representation of an interior or exterior environment, see paragraph 5.5.10 Spatial arrangement of items intended to form an interior or exterior environment.

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

4.1.2 Colours per se and combinations of colours

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

Combinations of colours may be accepted if it can be ascertained from the contours of the representation that they relate to a product such as, for instance, a logo or a graphic symbol in Class 32-01 of the Locarno Classification.

4.1.3 Graphic works or symbols, logos and graphical user interfaces

Designs of screen displays and icons, graphical user interfaces and other kinds of visible elements of a computer program are eligible for registration.

Products that materialise in non-physical forms, such as projected, holographic and/or virtual/augmented-reality designs (PHVAR designs) are also eligible for registration (see Class 14-04 and Class 32-01 of the Locarno Classification).

4.1.4 Mere verbal elements

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

The use of fanciful characters and/or the inclusion of a figurative element, however, render(s) the design eligible for protection either as a logo/graphic symbol in Class 32-01 of the Locarno Classification or as the ornamental representation of a part of any product to which the design will be applied.

4.1.5 Music and sounds

Music and sounds, whether used alone or in combination with an animated representation, do not constitute the appearance of a product and therefore do not comply with the definition of a design.

However, the graphical representation of a musical composition, in the form of musical notation, would qualify as a design, if applied for as, for example, *other printed matter* in Class 19-08 or *graphic symbols* in Class 32-01 of the Locarno Classification.

4.1.6 Photographs

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

4.1.7 Living organisms

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

EUD application No 1 943 283-0001	
	

However, no objection will be raised if it is apparent from the representation that the product does not show a living organism or if the indication of the product specifies that the product is artificial (see, in particular, Class 11-04 of the Locarno Classification). The mere fact that the design replicates a living organism does not automatically mean that the requirements of Article 4(1) EUDR are not met (12/11/2025, ICD No 129 981, BLOOM OBJECTS ApS).

4.1.8 Teaching materials

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

4.1.9 Concepts

A design application will be refused where the representation is of a product that is simply one example amongst many of what the applicant wishes to protect. An

exclusive right cannot be granted to a 'non-specific' design that is capable of taking on a multitude of different appearances. This is the case where the subject matter of the application relates, inter alia, to a concept, an invention or a method for obtaining a product.

4.2 Public policy and morality

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

4.3 Symbols protected under Article 6ter of the Paris Convention and emblems of particular public interest not protected under Article 6ter of the Paris Convention

The Office will apply the concepts of symbols protected under Article 6ter of the Paris Convention and emblems of particular public interest not protected under Article 6ter of the Paris Convention as explained in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 9 Trade marks in conflict with flags and other symbols (Article 7(1)(h) and (i) EUTMR).

4.4 Objections

Under Article 56(2) EUDR, if an examiner raises an objection based on any of the three grounds for non-registrability outlined in paragraphs 4.2 and 4.3, the applicant will be given the opportunity to respond within 2 months by:

- submitting observations;
- withdrawing the EUD application (Article 57(1) EUDR);
- withdrawing the objected views;
- submitting an amended representation of the design that differs only in immaterial details from the originally filed representation (Article 57(2) EUDR).

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

Where the applicant opts to submit an amended representation of the design, this representation will be admissible, as long as it differs from the originally filed representation only in immaterial details. In particular, this applies when the removed or disclaimed features are so insignificant, in terms of their size or importance, that they

are likely to pass unnoticed (Article 57(2) EUDR) (see paragraph 9). Features can be disclaimed by making use of the visual disclaimers referred to in paragraph 5.6. The date of receipt of the original application will remain as the date of filing.

Where the applicant fails to overcome the grounds for non-registrability within the time limit, the Office will refuse the application. If those grounds concern only some of the designs contained in a multiple application, the Office will refuse the application only insofar as those designs are concerned (Article 56(3) EUDR).

5 Formal requirements regarding the representation of the design

Article 42(1)(c) EUDR requires a sufficiently clear representation of the design for the purposes of according a filing date (see paragraph 3.4). However, even if the subject matter for which protection is sought is sufficiently clear, the representation may still not comply with the requirements of Article 2 EUDIR in conjunction with Article 42(5) EUDR and Decision No EX-26-03 of the Executive Director, specifically, regarding the means of representation, the technical requirements for the views, the consistency of the design features, as well as the use of visual disclaimers.

Under the cooperation framework set out in Article 152 EUTMR[4], the EUIPO, the central industrial property offices of the Member States and the Benelux Office for Intellectual Property (the Offices) agreed, on 25 November 2015, on a Common Communication on the graphic representation of designs (CP6), with the aim of giving guidance on the use of appropriate disclaimers, types of views, and the representation of designs with a neutral background.

Furthermore, to ensure a harmonised and clear practice, and to avoid ambiguity given the broadened product and design definitions and the new technical means of graphical representation, the offices have agreed on a Common Communication for requirements and means of design representation. That Common Communication complements the guidance provided under CP6, which remains valid and applicable.

Any deficiency found in an application relating to one of the requirements in this section will have no bearing on the granting of a filing date, unless the representation is not sufficiently clear to be able to determine the subject matter of protection sought (see paragraph 3.4).

If the deficiency raised is not remedied within 2 months, the application will be refused (Article 55(5) EUDR). If the deficiency concerns only some of the designs contained in a multiple application, the Office will refuse the application only insofar as those designs are concerned (Article 44(4) EUDR).

Once a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid by an applicant (Article 59(4) EUDR).

4 Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

5.1 Types and means of representation

The **representation** of a design is understood to be the visualisation of a design by any appropriate means. There are three types of representation: static, dynamic and animated.

The representation may be affected by any appropriate means. A static representation is a still image, including drawings and photographs. A dynamic representation enables a user to display a design from multiple angles, resulting in a virtually unlimited number of reproductions, including computer imaging and computer modelling. An animated representation can show the movement, transition or any other sort of animation of design features, typically by means of a video, in a continuous visual representation.

It is the applicant's responsibility to select the most appropriate type of representation (static, dynamic or animated) depending on the nature of the design and the scope of protection sought.

In accordance with the Common Communication for requirements and means of design representation, in respect of the right of priority, when relying on a first filing in the EU for a design represented by means of a dynamic or animated representation, applicants should be aware that such new types of representation may not be recognised in jurisdictions outside the EU. In such cases, an applicant may consider submitting static views of the design as the first EU filing. This way, it would then be able to rely on these for a subsequent filing outside the EU in a jurisdiction that only recognises static views.

This does not prevent an applicant from filing a separate design by means of a dynamic or an animated representation. Such separate designs may also be included within a multiple application.

5.1.1 Static representation

A static representation is composed of one or more static views. A view is a visual representation of the design, which may illustrate the design from various directions (angles) or at different moments in time, or in various states.

Any one graphic or photographic image may contain only one view.

An example of a static representation can be found in paragraph 5.5.

5.1.2 Dynamic representation

A dynamic representation enables a user to display a design from multiple angles, resulting in a virtually unlimited number of reproductions.

Each angle is a reproduction of that design within the dynamic representation.

An example of a dynamic representation can be found in eSearch here.

5.1.3 Animated representation

An animated representation can show the movement, transition or any other sort of animation of design features, typically by means of a video, in a continuous visual representation.

Each frame of the video is a reproduction of that design within the animated representation.

For designs with animated features, the use of a video can facilitate a clearer understanding of the animation than a series of static views.

Applicants should only file a video for the purpose of detailing specific features of a design when the animation of the product shown is intended to form part of the subject matter of protection. The opening/closing functionality of a sofa bed, for example, where such animation of the features is not intended to form part of the subject matter of protection, should be filed using static views or a dynamic view.

An example of an animated representation from the Common Communication for requirements and means of design representation can be found in eSearch here.

5.2 Number of views

A design can have only one representation, which can include one or more views.

5.2.1 Static views

Article 2 EUDIR does not establish a maximum number of views that can be filed to represent a design. Nevertheless, the technical requirements established in Decision EX-26-03 limit the number of views that can be submitted to 10 views.

To reduce the risk of inconsistencies between static views (see paragraph 5.4), it is recommended to file only the views that are necessary to demonstrate the features of a design for which protection is sought.

It is not obligatory for the applicant to file a specific number or type of view, as long as the design's features are clearly visible in the submitted representation. It may be sufficient to file only one view. However, certain types of views, particularly exploded views and sectional views, cannot be filed on their own (see paragraph 5.5).

It is recommended to file only one image of each of the aspect views (see paragraph 5.5).

The examiner will not change the order of the views as they appear in the application, or their orientation. Applicants should be aware that the first view will be the one that appears in abbreviated references to the design, for example in search results.

5.2.2 Dynamic and animated representation

Only one dynamic or animated representation may be submitted per design (see Decision EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means).

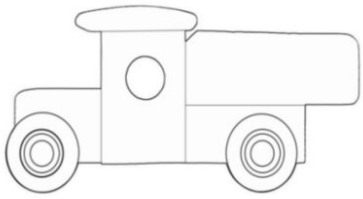
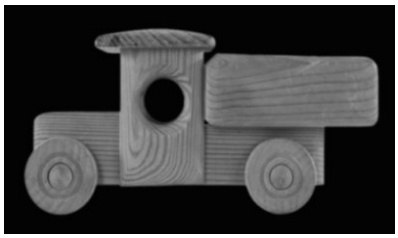
5.3 Combination of several types of representation

5.3.1 Static representation

Designs must be represented by using only one type of visual representation (static, dynamic or animated) per design, to prevent a disclosure of aspects that may create a different overall impression (see paragraph 5.1). See Decision of the Executive Director EX-26-03.

For static representation, the combination of different means is possible, but, it is recommended, in accordance with the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), that a design should be represented using only one static means of representation (e.g. a drawing or a photograph).

The following combination of a drawing and a photograph depicting a vehicle toy, as shown in the Common Communication CP6, is considered unacceptable and thus should not be filed.

CP6 example	
	

Where different static means of representation are used, each must clearly relate to the same design and be consistent when comparing the features disclosed.

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

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

Invented example	EUD No 1 282 099-0013
	

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

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

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

- withdrawing the views representing other designs;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- or if, after the creation of separate design(s) in a multiple application, the maximum number of designs permitted in an application pursuant to Article 44(1) EUDR is exceeded, dividing its application into separate applications and paying the corresponding fees.

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

5.3.2 Dynamic or animated representation

Designs must be represented using only one type of visual representation (static, dynamic or animated) per design, to prevent a disclosure of aspects that may create a different overall impression (see paragraph 5.1). See Decision EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means.

5.4 Consistency of the representation

The representation must relate to the same design, that is, to the appearance of a single product or of its parts.

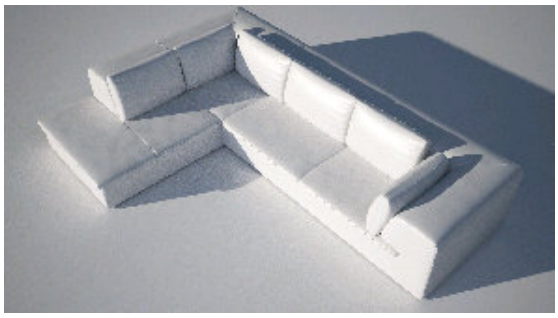
5.4.1 Representations relating to more than one design

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

Different embodiments of the same concept cannot be grouped in a single application because each embodiment is a design on its own. This should not be confused with different configurations of the same product (seeparagraph 5.5.1) or sets of articles (seeparagraph 5.5.7).

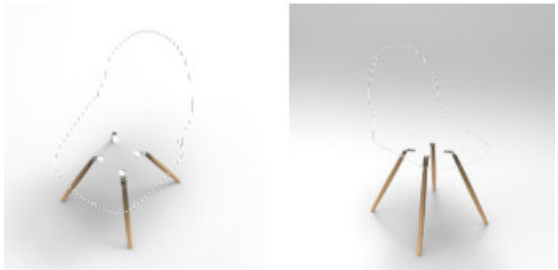
Different embodiments of the same concept are considered to be different designs.





Different configurations of the same design must not be shown simultaneously in a dynamic or animated representation either.

Lines and disclaimers must be consistent throughout all the views.

Inconsistent disclaimer	**Consistent disclaimer**
	

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

- withdrawing the views representing other designs;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s) and paying the corresponding fees;
- if after the creation of separate designs in a multiple application the maximum number of designs permitted in an application pursuant to Article 44(1) EUDR is exceeded, dividing its application into separate applications, and paying the corresponding fees.

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

5.4.2 Colours

The representation of the design may be submitted **either** in black and white (monochrome) **or** in colour (Article 2(1) EUDIR).

A representation combining black and white views with colour views will be objected to due to their inconsistency.





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

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

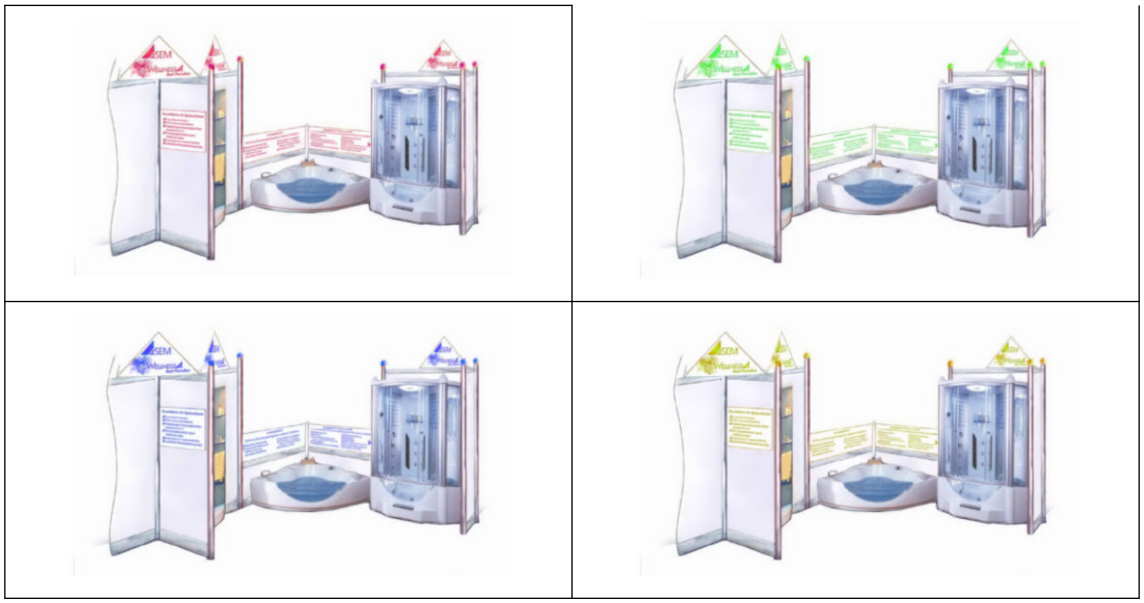
- withdrawing the views representing other designs;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- if, after the creation of separate design(s) in a multiple application, the maximum number of designs permitted in an application pursuant to Article 44(1) EUDR is exceeded, dividing its application into separate applications, and paying the corresponding fees.

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

However, as an exception to the above principle, the same features of a design can be represented in different colours in the various views if the applicant submits evidence, within the time limit set by the Office to remedy the deficiency, that the change of colours at different points in time, while the product is in use, is one of the relevant features of the design, as in the example below (EUD No 283 817-0001, courtesy of ASEM Industrieberatung und Vermittlung). An animated representation may be better suited to show the movement, transition or any other sort of animation of design features (see paragraph 5.1.3).

EUD No 283 817-0001



Where the representation is in colour, the registration and publication will also be in colour (Article 5(1)(c) EUDIR).

5.5 Types of views

It is the applicant's responsibility to disclose the features of the design as completely as possible. This is most likely to be achieved by using aspect views of the design. However, the applicant may provide additional views in order to further disclose the features of the design.

In accordance with the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), use of aspect views of the design is recommended.

Aspect views are defined under the Common Communication CP6 as showing the design from certain directions (angles), and encompass the following: perspective view(s), front view, top view, right side view, left side view, back view and bottom view. It is recommended to file only one image of each of the aspect views. See the following examples (for all but a bottom view).

EUD No 2 325 456-0001						
						

For the purpose of filing a design, it is sufficient to file only one aspect view. However, other (non-traditional) types of view, in particular exploded views (see paragraph 5.5.2) and sectional views (see paragraph 5.5.5), cannot be filed on their own.

CP6 provides guidance for other types of views further detailing specific features of the design.

The guidance provided under CP6 concerns static views. When such views, further detailing specific features of the design, are filed through an animated representation, the question may arise as to whether the animation itself forms part of the intended subject matter of protection. Applicants should only submit a video detailing specific design features when the animation of the product shown is intended to form part of the subject matter of protection.

5.5.1 Alternative positions

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

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

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

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

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

EUD No 588 694-0012	
	

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

Croatian design No D20110100		
		
		

The Common Communication for requirements and means of design representation establishes – in line with the requirement under CP6 which establishes that the views showing the different configurations of a design must be shown separately – that different configurations of the same design must not be displayed side by side, that is, they should not be visible at the same time, within a dynamic or animated representation.

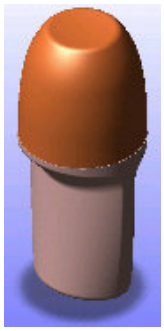
When such views, further detailing specific features of the design, are filed through an animated representation, the question may arise as to whether the animation itself will ultimately form part of the intended subject matter of protection. This issue may occur, for example, when the different configurations of a design are presented through animation.

5.5.2 Exploded views

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

Exploded views must be combined with at least one view representing the assembled product. In these views, all the product's parts must be shown disassembled in a separate single view. The disassembled parts must be shown in close proximity and in order of assembly. Additional explanatory text, wording, or symbols added with the sole purpose of showing how the product is assembled are not acceptable and will lead to an objection, requiring the applicant to delete such elements (see paragraph 5.9).

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

EUD No 1 847 468-0003	
	

When such views, further detailing specific features of the design, are filed through an animated representation, the question may arise as to whether the animation itself will ultimately form part of the intended subject matter of protection. This issue may occur, for example, when an animation depicts an explosion of a physical object, thus revealing its parts.

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 42(5) and 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

5.5.3 Views magnifying part of the design

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

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

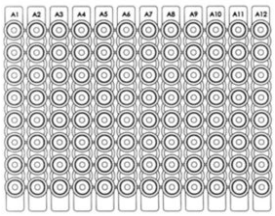
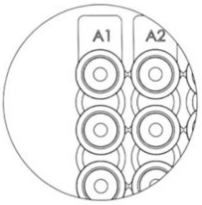
The view that shows the magnified part of the design must be presented in a separate single view.

Example of an unacceptable magnified view filed as one view

CP6 example



Example of an acceptable magnified view filed as a separate view

EUD No 19 113 690-0002	
	

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 42(5) and 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

5.5.4 Partial views

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

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

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

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



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

- withdrawing the views representing other designs;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s) and paying the corresponding fees;
- if after the creation of separate design(s) in a multiple application the maximum number of designs permitted in an application pursuant to Article 44(1) EUDR is exceeded, dividing its application into separate applications and paying the corresponding fees.

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 42(5) and 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

5.5.5 Sectional views

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

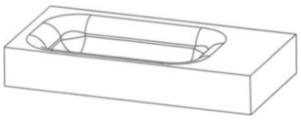
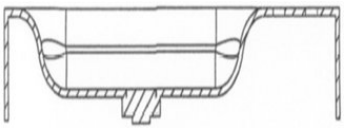
In accordance with the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), representations with technical indications, such as axial lines or sizes (dimensions), numbers, etc., are not acceptable. The sectional view should be an unambiguous view of the same design.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

Where the sectional view is submitted alone, without other aspect views, and the subject matter of protection is unclear, the examiner will issue a deficiency letter giving the applicant 2 months to remedy the situation by submitting such a view showing the product for which protection is sought. The original filing date will be retained provided the new view contains no additional features that were not included in the sectional view originally submitted.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 42(5) and 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

The following are examples, agreed in the context of the Common Communication CP6, of sectional views that must be submitted together with other traditional views, such as aspect views.

Spanish design No I0152702-D	
Aspect view	**Sectional view**
	

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

5.5.6 Sequence of snapshots (animated designs)

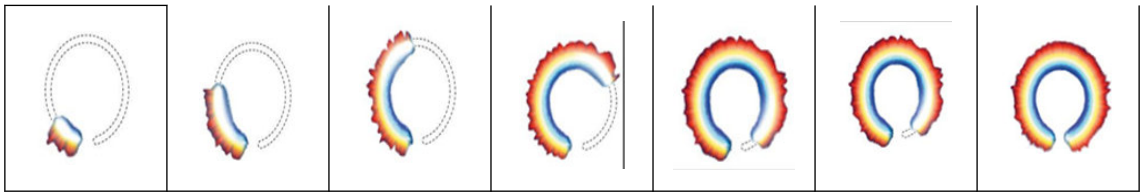
For sequences of snapshots, CP6 establishes requirements concerning static views.

According to CP6, snapshots are a short sequence of views used to show a single animated design at different specific moments in time, in a clearly understandable progression.

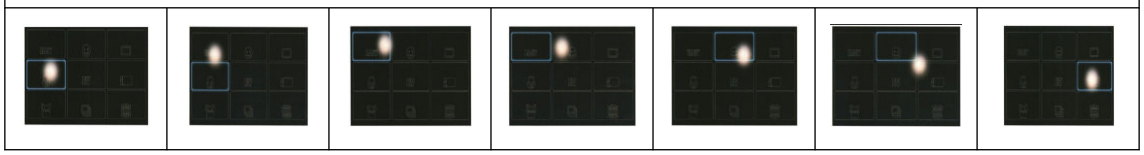
This applies to, for example:

- an animated icon (design consisting of a sequence)

EUD No 2 085 894-0014



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

EUD No 1 282 388-0031


In principle, according to the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), all views of an animated icon or graphical user interface should be visually related. This means that they must have features in common. It is the applicant's responsibility to order the views in a way that gives a clear perception of the movement or progression.

Whilst these requirements remain in place for static views, the new legislative framework also allows animated designs to be represented by means of videos (see paragraph 5.1.3).

An animated representation can show the movement, transition or any other sort of animation of design features, typically by means of a video, in a continuous visual representation.

For animated designs, according to Common Communication for requirements and means of design representation, the use of a video can facilitate a clearer understanding of the progression than static views. Note that videos cannot be combined with static views in a single application (seeparagraph 5.3.2).

5.5.7 Sets of articles

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

EUD 015029004-0001


Sets of articles should not be confused with variations of a design. Different embodiments of the same concept cannot be grouped in a single application because each embodiment is a design on its own. See paragraph 5.4.1.

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

A set of articles can be a 'product' in itself within the meaning of Article 4(2) EUDR. It can be represented in a single design application if the articles making up this set are linked by **aesthetic and functional complementarity** and are, in normal circumstances, sold together as one single product (e.g. a chess board and its pieces or sets of knives, forks and spoons).

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

Applicants must submit at least one view showing the set of articles in its entirety.

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

- withdrawing the views so that the remaining views represent only one design;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- if after the creation of separate design(s) in a multiple application the maximum number of designs permitted in an application pursuant to Article 44(1) EUDR is exceeded, dividing its application into separate applications, and paying the corresponding fees.

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 42(5) and 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

5.5.8 Repeating surface patterns

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

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

If additional views represent the pattern applied to one or more specific products for illustrative purposes, the applicant must make sure that the shape of such products is

not claimed as part of the design by using any method referred to under paragraph 5.6 below.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Articles 42(5) and 55(5) EUDR and Article 2(2) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

EUD No 6 574 695-0004


5.5.9 Typographic typefaces

Where the application concerns a design consisting of a typographic typeface, the representation of the design must consist of a string of all the letters of the alphabet, upper case and lower case, and of all the Arabic numerals, as well as of a text of five lines produced using that typeface, all in the same pitch font. The four requirements for typographic typefaces may be submitted in separate views. Typographic typefaces may concern different alphabets in a single application once the four requirements above are met.

EUD No 1 038 103-0002
ABCDEFGHIJKLMNOPQRSTUVWXYZ abcdefghijklmnopqrstuvwxyz 1234567890 ßÄÖÜäöü !"$%&/()=?@€ Uptat nibh eu faciduismod tie doluptat deliquat alissequisim inim. Met augueros eugait in et volor summy nullaoreet, veliquisim quisissecte dolum volenim auguerit, conulput eugiamc oreros nim vel illamconsed magna facin vel ulputat veniamet, corerat. Nis autet la eummod dit prate delit accumsan henisl delit.

<table>
<tr><td colspan="4">EUD 2458810-0001</td></tr>
<tr>
<td>A B C D E F G H I J
K L M N O P Q R S
T U V W X Y Z</td>
<td>a b c d e f g h i j k l
m n o p q r s t u v w
x y z</td>
<td>Lorem ipsum dolor sit amet, consectetur adipiscing elit. Phasellus luctus turpis neque, quis rutrum urna iaculis congue. Sed metus tellus, hendrerit scelerisque porttitor nec, fringilla quis diam.</td>
<td>á à â ă ã ä ç é è ê ë ñ î ï ř ó ò ô ö õ ú ù û ü
! " # $ % & ' ( ) * + , - . / 0 1 2 3 4 5 6 7 8 9
: ; < = > ? @ [\ ] ^ _ ` {|} ~ Ä Å Ç É Ñ Ö
Ü ° Ç £ § • ¶ ß ® © ™ ´ ¨
Æ Ø ¥ æ ø À Ã Ö Œ œ ‰ ˜ ¸ ˇ</td>
</tr>
</table>

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Articles 42(5) and 55(5) EUDR and Article 2(2) EUDIR. As a date of filing will have been granted, refusal of the application will not lead to a refund of the fees paid (Article 59(4) EUDR).

5.5.10 Spatial arrangement of items intended to form an interior or exterior environment

Designs showing the spatial arrangement of items intended to form an interior or exterior space are eligible for registration.

When more than one view is submitted, all views of the spatial arrangement should be visually related. This means that the views, in conjunction, must clearly show a single environment.

Where the views are not clearly related, the examiner will issue a deficiency letter giving the applicant two months to remedy, by:

- withdrawing the views so that the remaining views represent only one design;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and by paying the corresponding fees;
- dividing its application into separate applications and paying the corresponding fees if, after creating separate design(s) in a multiple application, the maximum number of designs permitted in an application pursuant to Article 44(1) EUDR has been exceeded.

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

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 42(5), Article 55(5) EUDR, and Article 2(2) EUDIR. As a date of filing will have already been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

5.6 Visual disclaimers

Visual disclaimers serve to identify matter contained in the representation of the design for which no protection is sought (Article 2(3) EUDIR).

The visual disclaimers must be clear and obvious from the representation of the design. There must be a clear distinction between the claimed and the disclaimed features. The visual disclaimers should be self-explanatory when appreciated in the context of the whole design.

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

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

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

To be accepted the visual disclaimer must be shown consistently where the disclaimer appears (Article 2(3) EUDIR) (see paragraph 5.4.1).

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

Whilst CP6 recommends the use of broken lines for static views, in accordance with the Common Communication for requirements and means of design representation, in respect of animated features, this general preference for this type of disclaimer does not apply. In such a case, other types of visual disclaimers may be better suited.

In accordance with the Common Communication CP6, in an application for registration of a European Union design, the following visual disclaimers will be allowed (see paragraphs 5.6.1 to 5.6.4).

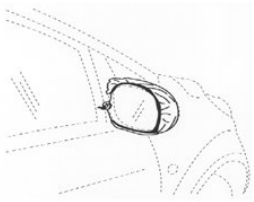
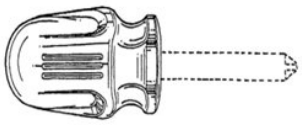
5.6.1 Broken lines

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

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

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

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

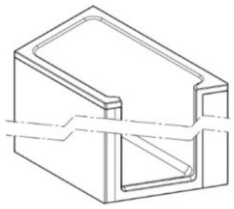
EUD **No 30 606-0005**	**Benelux design** **No 38212-0001**	**Hungarian design** **No D9900409-0001**
		

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

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

To help clarify, broken lines may also illustrate separations, indicating that the precise length of the design is not claimed (indeterminate length).

EUD No 2 509 430-0001



In view of Common Communication CP6, the Office does not recommend using broken lines to indicate portions of the design that are not visible in that particular view, that is to say, non-visible lines. Given that protection is only granted for those features of the appearance of a registered EU design that are shown **visibly** in the application for registration, it is not recommended to attempt to show 'invisible' features.

Furthermore, whilst CP6 recommends the use of broken lines for static views, in accordance with the Common Communication for the requirements and means of design representation, in respect of animated features, this general preference for this type of disclaimer does not apply. In such a case, other types of visual disclaimers may be better suited.

5.6.2 Blurring

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

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

The following is an example agreed in the context of the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6) of correctly applied blurring.

EUD No 244 520-0002



5.6.3 Colour shading

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

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

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

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

Further examples of Office practice.

EUD No 1 469 530-0001	**EUD No 5 295 680-0009**
	
EUD No 15 121 497-0005	

	In this example, it is clear that the red colour shading is a visual disclaimer because the car could not have red tyres and windows.

5.6.4 Boundaries

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

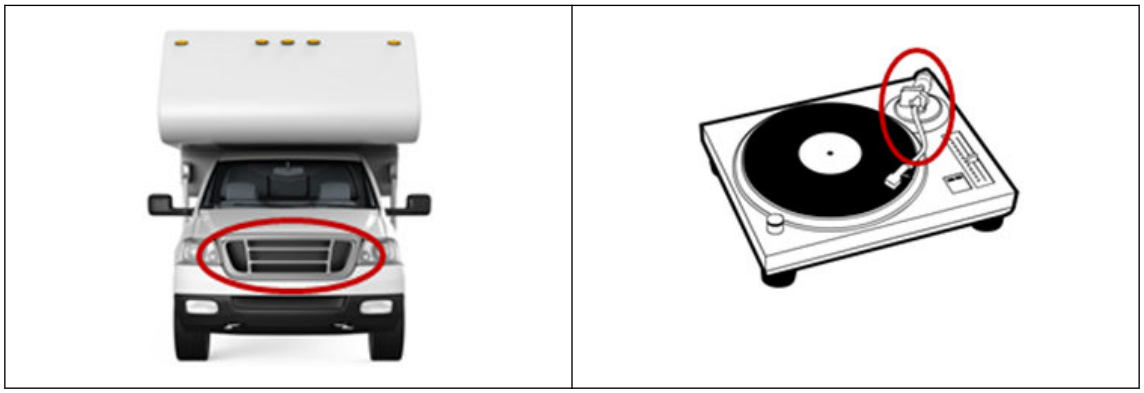
The following are examples that were agreed on in the context of the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6) for correctly applied boundaries.

EUD No 2 182 238-0002	**EUD No 1 873 688-0003**
	

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

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

CP6 example	**CP6 example**



5.7 Neutral background and elements that are external to the design

The design must be represented alone, to the exclusion of any other matter (Article 2(3) EUDIR). Where the background contains any other object, accessory, or decoration, for which no protection is sought, such matter must be visually disclaimed in order to show a neutral background (see paragraph 5.6)

Videos may raise quality issues, in particular as a result of a manual recording, for instance with a handheld device, which may affect, in particular, the requirement for a neutral background.

It is the sole responsibility of the applicant to ensure that a video meets the required level of quality, in line with the applicable legal and technical requirements.

To ensure a harmonised and clear practice, and to avoid ambiguity given the broadened product and design definitions and the new technical means of graphical representation, the Office and a number of European Union-based intellectual property offices have agreed on a Common Communication for requirements and means of design representation, according to which other matter included in the representation but for which no protection is sought must be disclaimed by means of a visual disclaimer.

This applies, for instance, when an interior or exterior environment is shown in the background.



Figure 1: Example from the Common Communication for requirements and means of design representation

A representation that does not have a neutral background and contains elements that are external to the design will be objected to.

The examiner will issue a deficiency letter giving the applicant two months to remedy by either:

- withdrawing the views concerned (which will not form part of the European Union design);
- submitting new views on a neutral background;
- amending the representation objected to so that the design is isolated from its background. This latter option will make use of visual disclaimers (see paragraph 5.6).

If the applicant withdraws the deficient view(s) or submits new views or an amended representation that do not alter the design in material details within the time limit set by the Office, the date of receipt of the original application will be recorded as the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 55(5) EUDR and Article 2(3) EUDIR. As a date of filing will have already been granted, refusal of the application does not give rise to a refund of the fees paid (Article 59(4) EUDR).

5.8 Background colours, contrast and shadows

The Common Communication for the requirements and means of design representation notes that the converged practice concerning the notion of a neutral background under the Common Communication CP6 focusses on colours, contrasts and shadows. The requirements stipulated in this regard for static views are equally applicable for a dynamic or animated representation.

The examples given below in relation to these aspects are taken from the Common Communication CP6, which also lists additional examples.

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

Examples of an acceptable single or predominant background colour

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

Examples of an unacceptable single or predominant background colour

CP6 example	**CP6 example**
	

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

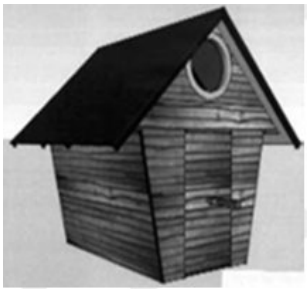
Examples of an acceptable graduating colour and more than one colour in a background

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

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

with the background (i.e. it is not clear where the product finishes and the background starts). Sometimes, a darker background can help when the design is clear or pale and vice versa.

Example of sufficient contrast with background

Benelux design No 38895-00


Examples of insufficient contrast with background

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

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

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

Examples of acceptable shadows or reflections

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

Examples of unacceptable shadows or reflections

CP6 example	**CP6 example**
	

Videos may also raise quality issues, in particular as a result of a manual recording, for instance with a handheld device, which may affect, in particular, the clear visibility of the design's features, which could be impaired, for instance, by poor lighting, reflections, colour distortions, improper focus, motion blur, or excessively fast movements during recording.

It is the sole responsibility of the applicant to ensure that a video meets the required level of quality, in line with the applicable legal and technical requirements.

5.9 Explanatory text, wording or symbols

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

Where words, letters, numbers and symbols (such as arrows) are **clearly** not part of the design, the applicant will be requested to send in clean views or to withdraw the deficient ones.

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

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

6 Other formal requirements

6.1 Mandatory requirements

In addition to the requirements for the granting of a filing date (see paragraph 3), the fees for the deferment of publication must be paid (Article 42(4) and 44(2) EUDR), the application must properly identify the applicant and, if applicable, its representative (Article 42(1)(b) and 42(3)(c) EUDR and Article 1(1)(a), (b), (c), (2) and (3) EUDIR), specify the two languages of the application (Article 1(1)(d) EUDIR), contain a signature (Article 1(1)(e) EUDIR) and indicate the products wherein the design is intended to be incorporated or to which it is intended to be applied (Article 42(2) EUDR).

Even after a date of filing has been granted, the examiner will issue an objection if a deficiency with regard to any of the above requirements is noted in the course of examining the registered European Union design application (Article 55(3) EUDR).

6.1.1 Payment of deferment fees

Where a request for deferment is received, (see paragraph 6.2.5), the deferment fee must be received together with the application fee.

Pursuant to Article 55(3) EUDR, a deficiency letter will be issued if the Office has not received the full amount of any additional fees payable pursuant to Article 42(4) or Article 44(2) EUDR in respect of deferment of publication.

If the deficiency is not remedied within the time limit set by the Office, the application will be refused (Article 55(5) EUDR).

If the payment is insufficient to cover all fees, unless the applicant has clearly specified the purpose of the payment, it will first be used to cover the application fees to secure a filing date (see paragraph 3.1). For multiple applications, the payment will first be used for the application fees in the numerical order of the designs. Any remaining sums will be used as payment for deferment fees in the numerical order of the designs. Applications for which the fees paid are insufficient to cover the deferment fees will be refused (Article 55(6) EUDR).

6.1.2 Identification of the applicant and its representative

Pursuant to Article 1(1)(a), (b) and (2) EUDIR, an application will be objected to if it does not contain the following information regarding the applicant: its name, nationality and address in which it is domiciled or, if the applicant is a legal entity, in which it has its seat or establishment.

The mandatory indications specified above are required for the clear identification of the legitimate applicant by the Office and further communication with that applicant. However, the information entered in the Register about the holder's address will contain only the city and country of the holder (Article 104(2)(d) EUDR).

The Office identifies the applicant and, where applicable, its representative, according to the principles set out in the Guidelines Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 3, Identification of parties to the proceedings.

6.1.3 Specification of the languages

The application may be filed in any of the official languages of the European Union (language of filing) (Article 137(1) EUDR; see paragraph 2.4 above). The language of the application form does not affect the language of the application. It is the language of the text entered by the applicant that is decisive. The language of filing will be the first language of the application.

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

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

6.1.4 Signature

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

As the application is filed by electronic means, the indication of the name of the sender is deemed to be equivalent to the signature pursuant to Article 17(1) EUDDR.

For more information on signatures, please see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.5 Signatures.

6.1.5 Indication of products

6.1.5.1 General principles

Pursuant to Article 42(2) EUDR, an application for a European Union design must indicate the products in which the design is intended to be incorporated or to which it is intended to be applied. Pursuant to Article 48 EUDR, the indication of products must be worded in such a way as to identify clearly and precisely the nature of the products and to enable each product to be classified in only one class and subclass of the Locarno Classification, preferably using the terms appearing in the list of products set out therein, or in DesignClass (seeparagraph 6.1.5.2).

Neither the product indication nor the classification affects the scope of protection of a European Union design as such (Article 42(6) EUDR). A registered European Union design confers on its holder the exclusive right to use the relevant design in all types of products, and not only in the product indicated in the application for registration (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 93).

Classification serves exclusively administrative purposes, in particular allowing third parties to search the registered European Union design databases.

6.1.5.2 The Locarno Classification and DesignClass

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

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

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

6.1.5.3 How to indicate products

6.1.5.3.1 Using DesignClass

To speed up and simplify the registration procedure, it is highly recommended that products be indicated using the terms listed in DesignClass (Article 48(2) EUDR), which are already classified following the Locarno Classification system.

More than one product can be indicated in the application.

When more than one product is indicated in the application, the products do not have to belong to the same class of the Locarno Classification.

6.1.5.3.2 Manually adding product indications

The applicant may indicate their own product, if such a product is not found in DesignClass. The product(s) must be indicated in such a way as to allow classification

in both the relevant class and subclass of the Locarno Classification (Article 48(2) EUDR).

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

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

6.1.5.4 Examination of indications of product

6.1.5.4.1 *Ex officio* changes to product indication is possible

Where the applicant has opted to allow the Office to make *ex officio* changes to the product indication in its application, the Office may make changes and proceed with the examination when further clarification from the applicant is not required (Article 48(4) EUDR).

This may happen in the following scenarios:

Product terms not listed in the Locarno Classification or DesignClass

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

Even though the product indication does not affect the scope of protection of a European Union design as such, the examiner will refrain from proposing more specific terms than the terms chosen by the applicant.

Product indications that do not accord with the representation of the design

Where the product indication clearly does not match the product as disclosed in the representation of the design, for example, where the indication concerns a service rather than a product, the examiner will replace that product indication with the correct one.

Products - part of and set of

Where a design represents the appearance of one part of a product, and that product as a whole is indicated in the application (e.g. an application for the design of a knife handle specifies that the products in which the design will be incorporated are *knives* in subclass 08-03), the examiner will replace that product indication with the indication

product(s) X (part of -), provided both the part in question and the product as a whole belong to the same class of the Locarno Classification.

Where a design represents the appearance of a product as a whole, but only a part of that product is indicated in the application (e.g. an application for the design of a knife specifies that the products in which the design will be incorporated are *knife handles*), the examiner will replace that product indication with the term for the whole product.

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

Ornamentation

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

Although ornamentation is in itself a product within the meaning of the Locarno Classification (Class 32-01), its primary purpose is to constitute a feature of appearance of a given product. Therefore, the representation of a design for ornamentation as such should not include the product to which it will be applied, or it should disclaim the product shown in the representation (see paragraph 5.6).

Where the applicant has indicated the product as *ornamentation* or *product(s) X (ornamentation for)*, the examiner will verify if the representation shows ornamentation only and that any product is properly disclaimed. Where the examiner agrees that it is for ornamentation, the product will be classified in Class 32-01.

Where the design represents ornamentation for a given product, and only that product as a whole is indicated in the application, the examiner will replace that indication by the indication *product(s) X (ornamentation for -)* in Class 32-01 of the Locarno Classification.

Where the design does not limit itself to representing ornamentation, but also discloses the product to which the ornamentation is applied, or part of that product, without its contours being disclaimed, the examiner will replace the product indication *ornamentation* with the product indication for the product shown in the representation.

Notification of the *ex officio* change of indication

Where the applicant has opted to allow the Office to make *ex officio* changes to the product indication in its application, and provided there is no other deficiency, the examiner will register the European Union design(s) and notify the holder of the registration of the *ex officio* change of product indication.

Where the holder objects to such *ex officio* change, it can apply to correct the corresponding entry in the Register (see the Guidelines, Part A, Section 6, Revocation of decisions, cancellation of entries in the register and correction of errors) and request that the original terms used in the application be maintained, provided there are no issues concerning the clarity and precision of these terms or their classification (Article 92 EUDR).

6.1.5.4.2 *Ex officio* changes to product indication is not possible

The indication of products must be worded in such a way as to identify clearly and precisely the nature of the products and enable each product to be classified in only one class and subclass of the Locarno Classification (Article 48(2) EUDR).

Therefore, where the applicant has opted to allow the Office to make *ex officio* changes to the product indication in its application, but the Office requires further clarification from the applicant, the Office will raise an objection and the applicant will be given two months to submit its observations and remedy the deficiencies noted (Article 55(3) EUDR).

This may happen in the following scenarios:

- where the indication is **too vague or ambiguous** to allow the nature and purpose of the products in question to be determined, for example, *merchandise*, *novelty items*, *gifts*, *souvenirs*, *home accessories*, *electric devices*, etc.
- where the product indication **does not enable each product to be classified in only one class and subclass** of the Locarno Classification.

Where the deficiency is not remedied within the time limit, the application will be rejected (Article 55(5) EUDR).

6.1.5.4.3 Opt out of *ex officio* changes to product indication

Where the applicant has not opted to allow the Office to make *ex officio* changes to the product indication in its application, and a deficiency has been identified in relation to the product indication, the examiner will raise an objection and the applicant will be given two months to submit its observations and remedy the deficiencies noted (Article 55(3) EUDR).

Where, in that deficiency, the Office has been able to propose an alternative product indication (see paragraph 6.1.5.4.1, for example), and the applicant fails to reply within the time limit specified by the Office, the Office may proceed with the examination based on the proposed product indication (Article 48(4) EUDR).

Where, in that deficiency, the Office has been unable to propose an alternative product indication, (see paragraph 6.1.5.4.2, for example) and the applicant fails to reply within the time limit specified by the Office, the application will be rejected (Article 55(5) EUDR).

6.2 Optional elements

An application may contain a number of optional elements, as listed in Article 42(3), 50 and 53 EUDR, that is,

- a priority or exhibition priority claim;
- a description;

- an indication of the Locarno Classification of the products contained in the application;
- the citation of the designer(s) or of the team of designers, or the waiver of the right to be cited;
- a request for deferment.

6.2.1 Priority and exhibition priority

6.2.1.1 Priority

General principles

An application for a European Union design may claim the priority of one or more previous applications for the same design or utility model in or for any state party to the Paris Convention or to the Agreement establishing the World Trade Organization, or in or for another state with which there is a reciprocity agreement (Article 49 EUDR; Article 3 EUDIR). This 'Convention priority' is of six months from the date of filing of the first application.

The effect of the right of priority is that the date of priority counts as the date of filing of the application for a registered European Union design for the purpose of Articles 6, 7, 8 and 24, Article 27(1)(d), (e) and (f) and Article 62(1) EUDR (Article 52 EUDR).

Any filing that is equivalent to a standard national filing under the domestic law applicable to it will be recognised as giving rise to the right of priority. A standard national filing means any filing that is suitable for establishing the date on which the application was filed in the country concerned, whatever the subsequent outcome of that application (Article 49(3) EUDR).

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

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

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

Priority claims and supporting documents

Priority may be claimed either when filing the application for a registered European Union design or within two months of the filing date. During this period, the applicant must submit the declaration of priority and indicate the date on which, and the country in which, the previous application was made (Article 50(1) EUDR).

The file number of the previous application and the documentation in support of the priority claim must be filed within three months of the date of filing of the declaration of priority.

Where there is no indication of the claim in the application, the submission of priority documents, or WIPO DAS access code, within two months of the filing date will be construed as a priority claim.

Where the application claims the priority of one or more previous applications that are not available in WIPO DAS by providing the relevant details but without submitting a copy, the applicant may still submit a copy of the previous application within three months of the priority claim (Article 50 EUDR).

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

Priority claims made subsequent to filing

The priority of one or more previous applications may still be claimed within two months of the filing date by submitting the declaration of priority, stating the date and country of the previous application (Article 50(1) EUDR), or the name of the exhibition and the date of first disclosure of the product (Article 53(2) EUDR and Article 4(1) EUDIR; (see paragraph 6.2.1.2). The documentation in support, or WIPO DAS access code where available (Decision No EX-26-08 of the Executive Director of the Office of 1 July 2026 on priority documents for registered European Union designs available from other sources) must be provided within 3 months of the priority claim.

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

Unless it is expressly indicated in the application that a priority claim will be made subsequently, the application will be examined without delay and, if no deficiency is found, will be registered without waiting two months for any potential declaration of priority. If a declaration of priority is validly filed after registration of the registered European Union design application, a corresponding entry will subsequently be made in the Register. However, the Office will not issue a new registration certificate including a priority claimed after registration; instead, applicants may obtain an extract from the Register with updated data including the priority (see paragraph 10.3).

Formal requirements

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

The formal requirements are that the:

- priority claim must be filed together with the registered European Union design application or within two months of the filing date (Article 50(1) EUDR);
- filing date and country of previous application must be indicated when claiming priority (Article 50(1) EUDR);
- file number and priority documents must be submitted:
  - by providing the WIPO DAS access code at the time of filing via e-filing or within three months of either the filing date or, as the case may be, receipt of the priority claim;
  - **or** by submitting a copy of all priority documents* within three months of either the filing date or, as the case may be, receipt of the priority claim along with, where applicable, translations thereof (Article 3(2) EUDIR).

  * The priority document must consist of a copy of the entire previous application or registration. In accordance with Article 4D(3) of the Paris Convention for the Protection of Industrial Property, that copy shall emanate from the authority that received it and contain the same information as the original application, including the representation of the design, in colour where applicable. It shall state or be accompanied by a statement containing the file number and the filing date of that application. (See Decision No EX-26-08 of the Executive Director of the Office of 1 July 2026 on priority documents for registered European Union designs available from other sources).

  A complete verification of this documentation to substantiate the priority claim will not be carried out at the examination stage but only where the priority claim becomes relevant, in particular, in inter partes proceedings.

Where the priority of a previous registered European Union design is claimed, the applicant must indicate the number of the previous application and its date of filing. No additional information or document is required (Decision No EX-26-08 of the Executive Director of the Office of 1 July 2026 on priority documents for registered European Union designs available from other sources).

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

Language of previous application

If the language of the previous application is not one of the languages of the Office, the examiner may invite the applicant to file a translation of the first or second language of the EUD application within two months (Article 3 EUDIR).

Such a translation will only be requested where the examiner is unable, for the purpose of examining the formal requirements, to check the file number, date and country of the previous application.

Formal priority requirements not satisfied

At the filing stage, the Office will limit itself to verifying whether the formal requirements listed above relating to a priority claim are satisfied (Articles 50 and 53 EUDR).

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

If the deficiencies are not remedied in due time or cannot be remedied, the Office will inform the applicant of the rejection of the priority claim and of the possibility of requesting a formal (i.e. appealable) decision on that rejection (Article 55(7) EUDR).

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

Substantive requirements

The **substantive requirements** to be met under Article 49 EUDR for a priority claim to be considered valid will be examined not at the filing stage but, where necessary, during *inter partes* proceedings, and will be based on the copy of the priority documents submitted. The priority document must consist of a copy of the entire previous application or registration. In accordance with Article 4D(3) of the Paris Convention for the Protection of Industrial Property, that copy shall emanate from the authority that received it and contain the same information as the original application, including the representation of the design, in colour where applicable. It shall state or be accompanied by a statement containing the file number and the filing date of that application. **It is, therefore, the responsibility of the European Union design applicant to submit a copy of the priority documents and, where requested by the Office, full translations thereof at the filing stage, to allow the priority claim to be examined substantively when required during *inter partes* proceedings.**

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

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

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

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

The previous application is a first filing

As a matter of principle, the previous application must be a first filing. The Office will therefore check that the priority document does not refer to priority being claimed in respect of an even earlier application. A priority claim of a previous EUD is acceptable if that EUD was granted a filing date.

As an exception, a subsequent application for a design that was the subject of a previous first application and has been filed in or for the same state, will be considered as a first application for the purpose of determining priority, provided that, at the date of filing of the subsequent application, the previous application had been withdrawn, abandoned or refused without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The previous application may not thereafter serve as a basis for claiming a right of priority (Article 49(4) EUDR).

The previous application concerns a design or a utility model

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

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

A priority claim based on a previous patent application will in principle be rejected. However, an international application filed under the Patent Cooperation Treaty (PCT) can form the basis of a right of priority pursuant to Article 49(1) EUDR provided that the subject of the international application in question is a utility model and that the priority is claimed within 6 months from the date of filing of the first application, as expressly fixed in Article 49(1) EUDR (27/02/2024, C-382/21 P, Turn- oder Sportgeräte und -artikel, EU:C:2024:172, § 78).

A priority claim may only be based on a previous application filed with a national office which protects designs as design patents instead of registered designs (for example the United States Patent and Trademark Office - USPTO) if the subject matter of the previous application relates to a ‘design patent’, not a ‘patent’.

The European Union design relates to the ‘same design or utility model’

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

According to Article 6(2) EUDR, the subject matter is considered to be identical if the European Union design and the previous application for a design right or a utility model differ only in details that can be qualified as ‘immaterial’.

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

Furthermore, the use of different types and means of representation does not automatically exclude identity. The identity of the design will be assessed across the different types and means of representation. Therefore, two designs will be considered as identical for the purpose of examination of priority claims if the subject matter of protection and the designs are the same, regardless of the type of representation.

(See Common Communication on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal CP11 for information on how priority claims for different types of marks are examined)

The holder is the same

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

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

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

Priority is claimed within six months of filing the first application

The Office will examine whether the date of filing allocated to the European Union design is within six months of the filing date of the first application. European Union design applicants should note that the date of **filing** allocated by the Office may not always correspond to the date of **receipt** of the registered European Union design application.

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

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

The 'Convention priority' right is a right limited in time, which is triggered by the first regular filing of a design. A regular national filing is any filing that is 'adequate to establish the date on which the application was filed in the country concerned, whatever the subsequent fate of the application' (Article 4A(3) Paris Convention). It may be claimed during the six months following the first filing, provided the country of first filing was a party to the Paris Convention or to the Agreement establishing the World Trade Organization (WTO), or a country with a reciprocity agreement (Article 49(4) to (6) EUDR).

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

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

Afghanistan (AF)

Aruba (AW)

Cook Islands (CK)

Eritrea (ER)

Kiribati (KI)

Marshall Islands (MH)

Micronesia (FM)

Nauru (NR)

Palau (PW)

Somalia (SO)

Tuvalu (TV)

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

Abkhazia (GE-AB)

American Samoa (AS)

Anguilla (AI)

Bermuda (BM)

Cayman Islands (KY)

Falkland Islands (FK)

Guernsey (GG)

Isle of Man (IM)

Jersey (JE)

Montserrat (MS)

Pitcairn Islands (PN)

Saint Helena (SH)

Turks and Caicos Islands (TC)

British Virgin Islands (VG)

6.2.1.2 Exhibition priority

General principles

The effect of exhibition priority is that the date on which the design was displayed at an official or officially recognised international exhibition is deemed to be the date of filing of the application for an EUD for the purposes of Articles 6, 7, 8 and 24, Article 27(1) (d), (e) and (f), and Article 62(1) EUDR (Article 52 EUDR).

The applicant can claim exhibition priority within six months of the first disclosure of the products in which the design is incorporated. Evidence of the disclosure must be filed (Article 53(1) and (2) EUDR and Article 4 EUDIR).

Exhibition priority cannot extend the six-month Convention priority period (Article 53(3) EUDR).

Claiming exhibition priority

Similar to Convention priority (see paragraph 6.2.1.1), exhibition priority can be claimed either when filing an EUD application or subsequently. Where the applicant wishes to claim exhibition priority after having filed an application, the declaration of priority, indicating the name of the exhibition and the date of first display of the product, must be submitted within two months of the filing date (Article 53(2) EUDR).

The applicant must, within three months of the filing date or receipt of the declaration of priority, provide the Office with a certificate issued at the exhibition by the responsible authority. This certificate must attest that the design incorporated in or applied to the product was disclosed at the exhibition. It must also state the opening date of the exhibition and the date of first disclosure of the product if this is different from the opening date of the exhibition. The certificate shall include, or make clear reference to, a representation of the design as disclosed in the exhibition (Article 4 EUDIR).

Priority can only be granted where an EUD application is filed within six months of first display at an exhibition recognised for this purpose, namely a world exhibition within the meaning of the Convention relating to International Exhibitions as last revised on 30 November 1972. These exhibitions are rare and Article 53 EUDR does not cover display at other, national or international, exhibitions. The exhibitions can be found on the website of the Paris 'Bureau International des Expositions': http://www.bie-paris.org/site/en/.

As is the case for Convention priority, the substantive requirements for exhibition priority will not be examined at the filing stage but during *inter partes* proceedings, where necessary, and will be restricted to the extent of the *inter partes* proceedings (see paragraph 6.2.1.1, Priority).

6.2.2 Description

The application may include a description not exceeding 100 words explaining the representation of the design. The description must relate only to those features that appear in the representation of the design. It may not contain statements concerning the purported novelty or individual character of the design or its technical value (Article 1(4) EUDIR).

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

The description does not affect the scope of protection of a European Union design as such (Article 42(6) EUDR; 21/06/2017, T-286/16, TOILETTENSITZE (Teil von -), EU:T:2017:411, § 44). It cannot substitute visual disclaimers to exclude features from protection (see paragraph 5.6 above).

The description may, however, clarify the nature or purpose of some features of the design in order to avoid a possible objection. For instance, where different views of the same design display different colours, thus raising doubts as to consistency between them (see paragraph 5.4.2 above), the description may explain that the colours of the design change when the product in which this design is incorporated is in use.

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

The Register will include a mention that a description has been filed, but the description as such will not be translated or published. However, the description will remain part of the administrative file of the application and will be open to public inspection by third parties under the conditions set out in Articles 109 and 110 EUDR.

6.2.3 Indication of the Locarno Classification

6.2.3.1 General principles

The applicant may itself identify the class and subclass, in accordance with the Locarno Classification, of the products indicated in the application (see paragraph 6.1.5).

If the applicant provides a classification, the products must be grouped in accordance with the classes of the Locarno Classification, each group being preceded by the number of the relevant class and presented in the order of the classes and subclasses (Article 42(3)(d) EUDR).

Using the harmonised database of product indications (Locarno product indications and those accepted by Member States' intellectual property offices and the Office), which can be consulted through DesignClass when filing an EUD application online, will accelerate the examination procedure. The harmonised database of product indications is integrated into the EUIPO design e-filing application.

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

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

6.2.3.2 Multiple applications

If the same product indication applies to all designs contained in a multiple application, the relevant box 'Same indication of product for all designs' should be ticked in the e-filing application form, and the field 'Indication of product' should be left blank for the subsequent designs.

6.2.4 Citation of the designer or of the team of designers

The application may include:

1. a citation of the designer or of the team of designers (Article 18 EUDR), or
2. an indication that the designer or the team of designers has waived the right to be cited (Article 42(3)(e) EUDR).

The citation of the designer or of the members of the team of designers and the waiver are merely optional and are not subject to examination.

Since the right to be cited as the designer or as the team of designers is not limited in time, the designer's name or the names of the members of the team of designers can also be entered into the Register after registration of the design (Article 104(2)(j) EUDR). It can also be changed later when a designer changes his or her name for example due to marriage (Article 18 EUDR). The designer's waiver may also be added or removed later. For more information on changes in the name or address of the EUD holder and the citation of the designer or team of designers, see paragraph 11.4 Changes in the name and/or address of the applicant/ holder and/or its representative or in the citation of the designer or team of designers.

6.2.5 Request for deferment

6.2.5.1 General principles

The applicant for a registered European Union design may, **when filing the application**, request that its publication be deferred for **30 months** from the date of filing or, if a priority is claimed, from the date of priority (Article 62(1) EUDR).

Where no deficiency is found, the European Union design will be registered. The information published in Part A.2 of the *European Union Designs Bulletin* consists of the file number, date of filing, date of entry in the Register, registration number, name, city and country of the holder, and name and business address of the representative (if applicable). No other particulars, such as the representation of the design or the indication of products, are published (Article 62(3) EUDR).

Nevertheless, third parties may inspect the entire file if they have obtained the applicant's prior approval or if they can establish a legitimate interest (Article 109(1) and (2) EUDR).

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

No registration certificate will be made available as long as the publication of a design is deferred. However, the holder of the design registration subject to deferment may request a certified or uncertified extract from the Register containing the representation of the design or other particulars identifying its appearance (Article 109(5) EUDR) for

the purpose of invoking its rights against third parties (Article 62(9) EUDR). For more information on obtaining certified extracts from the Register, see the Guidelines, Part E, Register operations, Section 5, Inspection of files.

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

6.2.5.2 Request for deferment

Deferment of publication must be requested in the application (Article 62(1) EUDR). Subsequent requests will not be accepted, even if received on the same day.

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

A request for deferment of publication may concern only some of the designs of a multiple application. In this case, the designs to be deferred must be clearly identified by ticking the box 'Publication to be deferred' (in the e-filing application form) for each individual design.

The applicant must pay a fee for deferment of publication along with the application fee (see paragraph 6.1.1).

Deficiencies

If the information contained in the application is contradictory (e.g. the deferment fee has been paid, but the applicant has not ticked the box 'Publication to be deferred') or inconsistent (e.g. the amount of the deferment fees paid for a multiple application does not correspond to the number of designs to be deferred), the examiner will issue a deficiency letter asking the applicant to confirm that deferment is requested and, where applicable, for which specific design(s) of a multiple application, and/or to pay the corresponding fees (see paragraph 6.1.1).

6.2.5.3 Request for earlier publication

Where the EU design holder notifies the Office – **any time before the end of the 30-month deferment period** from the date of filing or, if a priority is claimed, from the date of priority – of its wish to have the design(s) published ('request for earlier publication' Article 62(4) EUDR), publication will take place as soon as technically possible (Article 63 EUDR). Where there is no specific request from the holder, the designs will be published when the deferment period expires.

6.2.5.4 Request for surrender of a deferred design

The Office will remind holders at least 4 months before the expiry of the period of deferment that publication is imminent. Holders must not rely entirely on this possibility as failure by the Office to send such a reminder will not affect the publication date of the design.

If the holder decides that the design should not be published after all, it can prevent publication by submitting a written request for surrender in accordance with Article 71 EUDR well before the design is due to be published and **at the latest 3 months before the end of the period of deferment** (Article 62(5) EUDR). In the case of a multiple registration, the holder should indicate which of the designs among those identified for deferment are to be surrendered and for which designs deferment of publication is to be continued, as the case may be (Article 62(6) EUDR).

The declaration of surrender must comply with the requirements of Article 71 EUDR (see paragraph 11.2.2).

Deficiencies

Where a declaration of surrender for a deferred design does not comply with all the requirements of Article 62(5) and (6), Article 71 EUDR and Article 10(1) EUDIR, the Office will notify the holder of the deficiencies and request that they be remedied within the prescribed time limit, which may in no case expire after the 30-month deferment period (Article 62(7) EUDR). Where the deficiencies are not remedied within the time limit, the Office will reject the entry of the surrender in the Register and the EU design holder will be informed in writing. However, if there are still more than 3 months before the end of the deferment period, the holder may submit another request for surrender. Where there is no specific request from the holder, the designs will be published when the deferment period expires (see paragraph 6.2.5.5).

6.2.5.5 Publication after deferment

Where no request for surrender has been submitted in due time, the registration will be published in Part A.1 of the EU Designs Bulletin.

The publication will indicate that deferment was originally requested (Article 62(3) EUDR).

7 Multiple Applications

7.1 General principles

A multiple application is a request for the registration of more than one design within the same application. Each of the designs contained in a multiple application or registration is examined and dealt with separately. In particular, each design may,

separately, be enforced, be licensed, be the subject of a right *in rem*, a levy of execution or insolvency proceedings, be surrendered, renewed or assigned, be the subject of deferred publication or be declared invalid (Article 44(4) EUDR).

Multiple applications are subject to specific application fees and deferment fees where the application contains a request for deferment of publication, which vary in proportion to the number of designs (see paragraph 8 below).

7.2 Formal requirements applying to multiple applications

7.2.1 General requirements

The number of designs contained in a multiple application is limited to 50 (Article 44(1) EUDR). The designs need not be related to one another or be otherwise similar in terms of appearance, nature or purpose, nor be classified in the same Locarno class.

The number of designs should not be confused with the 'number of views' that represent the designs (see paragraph 5.2).

A suitable representation of each design contained in a multiple application must be provided (see paragraph 5) as well as an indication of the product in which the design is intended to be incorporated or to which it is to be applied (Article 42(1)(c) and (2) EUDR in conjunction with Article 1(5) EUDIR, see paragraph 6.1.5).

7.2.2 Separate examination

Each of the designs contained in a multiple application is examined separately (Article 44(4) EUDR). If a deficiency concerning some of the designs contained in a multiple application is not remedied within the time limit set by the Office, the application will be refused only insofar as those designs are concerned.

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

7.2.3 Maximum number of designs in multiple applications

7.2.3.1 Principle

In accordance with Article 44(1) EUDR a maximum number of 50 designs may be combined in one multiple application for registered EU designs. Each design contained in a multiple application shall be numbered by the Office in accordance with a system determined by the Executive Director.

7.2.3.2 Deficiencies

Where, following a deficiency, the total number of designs in a multiple application exceeds 50 (for example, if the views of some designs in a multiple application are divided into more designs (see paragraphs 5.3.1, 5.4.1, 5.4.2, 5.5.4 and 5.5.7)) the examiner will request the applicant to:

- withdraw the views representing other designs so that the total number of designs in the application does not exceed 50, or
- divide the application into more applications (with no more than 50 designs each), for the designs above the 50th design of the original application, and pay the corresponding additional fees.

The total amount to be paid will be calculated by the examiner and included in the deficiency letter.

The applicant will be invited to remedy the deficiency letter within 2 months and pay the total amount of fees for all applications resulting from the division of the multiple application or to withdraw some designs to comply with the maximum number of designs in a multiple application (Article 44(1) EUDR).

Where the applicant does not remedy the deficiencies in due time, the application will be refused insofar as it concerns the deficient designs (the ones with incoherent views).

8 Payment of Fees

8.1 General principles

EUD applications are subject to various fees (Articles 42(4) and 44(2) EUDR), including the application fee or, where the application includes a request for deferment of the publication, the deferment fee.

The application fee and, where relevant, the additional application fees for a multiple application, must be paid within 1 month of the filing of the application. If paid within this time limit, the reception date of the application will be accorded as the filing date (provided the other filing date requirements are met, see paragraph 3).

In the case of multiple applications, additional application or deferment fees must also be paid for each additional design.

Where payment is insufficient to cover all fees, in the absence of any criteria for determining the purpose of the payment, the Office will apply the payment to first cover any application fees in order to secure a filing date (see paragraph 3). Any remaining amounts will then be used to pay deferment fees, where applicable. The Office will take the designs in the numerical order in which they are represented, in accordance with Article 44(1) EUDR.

If the application fee payment deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application for an EU design (Article 55(4) EUDR). Any fees paid will be refunded.

If the deferment fee payment deficiencies (see paragraph 6.1.1) are not remedied within the time limit set by the Office, the Office will reject the application in so far as it concerns designs for which additional deferment fees have not been paid or have not been paid in full.

For the fee payable with respect to an international application designating the European Union, see paragraph 12.1.2.4. For more information on fees and payments in general, see the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

8.2 Currency and amounts

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

The fees for filing an application are as follows.

Application fees

Single design application	EUR 350
Additional application fee in respect of each additional design included in a multiple application	EUR 125 per design

Deferment fees (where deferment of publication is requested)

Single design or first design with deferment of publication in a multiple application	EUR 40
Additional fee for deferment of publication in respect of each additional design included in a multiple application that is subject to deferment of publication	EUR 20 per design

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

Design number	**Deferment**	**Application fee**	**Deferment fee**
xx xxx xxx-0001	Yes	EUR 350	EUR 40
xx xxx xxx-0002	Yes	EUR 125	EUR 20

xx xxx xxx-0003	No	EUR 125	-
xx xxx xxx-0004	No	EUR 125	-
xx xxx xxx-0005	No	EUR 125	-

8.3 Means of payment, details of the payment and refunds

The means of payment, the details to accompany the payment and the conditions for a refund of fees paid are explained in the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

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

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

9 Withdrawals and amendments

9.1 Introduction

This section deals with requests submitted by the applicant seeking to either withdraw the EU design application or amend it.

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

Also, the applicant may, at any time during the examination phase, request an amendment of the EU design application regarding changes in immaterial details of the design representation (Article 57(2) EUDR).

Any modification to the representation of an EU design application made in response to a deficiency raised by the Office – such as inconsistencies between views or the use of a non-neutral background (Article 2(2) and (3) EUDIR) – may involve amending or withdrawing one or more views, or even replacing the entire representation. These changes concern formal requirements of the representation and must be dealt with in accordance with paragraphs 5.4 and 5.7.

Any correction of errors in other elements of the application (Article 92(1) EUDR), must be dealt with in accordance with Part A, General rules, Section 5, 11 Correction of the

name and address or Section 6, Revocation of decisions, cancellation of entries in the register and correction of errors.

9.2 Withdrawal of the application

Prior to registration the applicant may, at any time, withdraw an application for a European Union design or, in the case of a multiple application, withdraw some of the designs contained in the multiple application (Article 57(1) EUDR). The examiner will send confirmation of the withdrawal.

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

Requests for withdrawal of the application must be submitted in writing and include:

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

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

Requests for withdrawal received by the Office on or after the date of registration of the design will be dealt with as requests for surrender (see paragraph 11.2 below).

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

9.3 Amendment of the application

9.3.1 Elements subject to amendment

The representation of the EU design may be amended in immaterial details at any time upon request by the applicant (Article 57(2) EUDR). This means that the amended representation must differ from the originally filed version only in immaterial aspects. This applies where amended features (removed, disclaimed, modified or added) and amended or withdrawn view(s) are so minor – in particular, whether in size or significance – that they are unlikely to be noticed. It is important to note that the term *representation* refers to the design as shown in all submitted views or reproductions.

9.3.2 Procedure for requesting amendment of the application

A request for amendment of the representation of the EU design application in immaterial details must contain the following elements:

1. The file number of the application concerned;
2. The name and address of the applicant in accordance with Article 1(2) EUDIR;
3. The representation of the design as amended (only in immaterial details), in accordance with the rules on how the EU design shall be represented visually (Article 2 EUDIR), together with an indication of the features to be amended and of the view(s) that are being amended or withdrawn (Article 1(1)(c) EUDDR).

A single request for amendment may be made for the amendment of the same features in two or more designs, provided that the applicant is the same for all designs covered by the request (Article 1(3) EUDDR).

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

For corrections in other elements of the application while registering an EU design, see the Guidelines Part A, General rules, Section 5, paragraph 11 Correction of the name and address or Section 6 Revocation of decisions, cancellation of entries in the register and correction of errors.

9.3.3 Deficiencies

Deficiencies in the request for amendment of the application

Where a request for amendment of the application does not meet the above requirements and the deficiency found can be remedied, the examiner will invite the applicant to remedy the deficiency within 2 months. If the deficiency is not remedied in due time, the examiner will refuse the request for amendment (Article 1(2) EUDDR).

Deficiencies in the scope of the amendment

Where a request for amendment of the application does not meet the requirement of Article 57(2) EUDR, meaning that the amended design representation goes beyond immaterial details, the examiner will notify the applicant that the request for amendment is not acceptable under the mentioned provision and that it will be rejected.

10 Registration, Publication and Certificates

10.1 Registration

Once the examination of grounds for non-registrability (see paragraph 4) and formalities (see paragraphs 5, 6 and 7) is completed, and where no deficiency is found,

the design will be registered. A new entry will be made in the Register of EU designs with the particulars referred to in Article 104 EUDR.

For further information on entries in the Register, see Decision No EX-26-07 Annex II.

10.2 Publication

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

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

Publication will take place upon registration, unless the application contains a request to defer it.

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

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

The date of publication will be entered in the Register (Article 104(2)(c) EUDR).

10.3 Registration certificate

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

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

Registration certificates are only issued as online e-certificates. Holders of European Union design registrations are invited to download the certificate from the day after publication using the eSearch plus tool on the EUIPO website. Certified or uncertified copies of the registration certificate may be requested.

The certificate contains all the particulars entered in the Register of European Union designs at the date of registration. No new certificate is issued following changes made in the Register after the date of registration. However, an extract from the Register, which reflects the current administrative status of the design(s), may be requested. For more information on obtaining certified extracts from the Register, see the Guidelines, Part E, Register operations, Section 5, Inspection of files.

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

10.4 Registration symbol

To facilitate the marketing of design protected products and to increase awareness of the design registration, the holder of a registered EU design may inform the public that the design is registered by displaying on the product in which the design is incorporated or to which it is applied the letter ‘D’ enclosed within a circle. This design notice may be accompanied by the registration number of the design or hyperlinked to the entry of the design in the Register (Recital 31 EUDR, Article 29 EUDR).

The Office has no competence in administering or checking the validity of use of registration symbols.

11 Changes in the Register and in the publication of European Union design registrations

11.1 Introduction

This paragraph describes the changes in the Register of European Union designs, as follows:

- surrender of a European Union design with or without deferment;
- alteration of the representation of a registered European Union design in immaterial details;
- changes in the name and/or address (the city and country) of the applicant/holder and/or in the name or the business address of the representative and/or in the name of the designer or the team of designers;
- recordal of transfers;
- recordal of licences;
- recordal of entitlement proceedings and related change of ownership.

Correction of errors in EUD registrations, or in the publication, are dealt with under the Guidelines Part A, General rules, Section 6 Revocation of decisions, cancellation of entries in the register and correction of errors.

11.2 Surrender of the registered European Union design

11.2.1 General principles

A European Union design may be surrendered by the holder at any time after registration. A surrender must be declared to the Office in writing (Article 71 EUDR).

However, a request for renunciation or limitation of an international design designating the European Union must be filed with, and recorded by, the International Bureau (see Article 16 Geneva Act and paragraph 12.2) ([5]).

Surrender can also be declared for only some of the designs contained in a multiple registration (Article 10(1)(c) EUDIR).

The effect of a declaration of surrender begins on the date on which the surrender is entered in the Register of European Union designs, without any retroactive effect (Article 71(1) EUDR). However, if a European Union design for which publication has been deferred is surrendered, it will be deemed from the outset not to have had the effects specified in the EUDR (Article 71(2) EUDR). A registered European Union design may only be surrendered in its entirety.

The surrender will be entered in the Register only with the agreement of the proprietor of a right entered in the Register (Article 71(3) EUDR). Persons having a registered right include the holders of a registered licence, the proprietors of a registered right *in rem*, the creditors of a registered levy of execution or the authority competent for a registered bankruptcy or similar procedures.

In the case of licences registered in the Register of European Union designs, the surrender of a European Union design is entered in the Register only upon receipt of evidence that the rights holder has informed the licensee(s) of the surrender accordingly. The surrender is entered in the Register 3 months after the date on which the Office obtains proof that the holder has informed the licensee(s) of the intention to surrender accordingly, or earlier if proof is obtained of the licensee's/licensees' consent to the surrender (Article 71(3) EUDR).

Where a claim relating to the entitlement to a registered European Union design has been brought before the competent court or authority pursuant to Article 15 EUDR, the surrender is entered in the Register only with the agreement of the claimant (Article 10(3) EUDIR).

11.2.2 Formal requirements for a declaration of surrender

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

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

A declaration of surrender must contain the particulars referred to in Article 10(1) EUDIR:

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

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

3. an indication of the designs for which the surrender is declared in the case of multiple registrations.

Where a right of a third party relating to the registered EU design is entered in the Register, the application for surrender must include proof of the third party's agreement to the surrender. A declaration of consent to the surrender duly signed by the holder of that right, or by the representative of that holder, will be sufficient proof of the third party's agreement to surrender that right (Article 10(2) EUDIR). Where proceedings relating to the entitlement to a registered EU design have been instituted before the competent court or authority pursuant to Article 15 EUDR, a declaration of consent to the surrender, signed by the claimant or the representative of that claimant, shall be sufficient proof of the claimant's agreement to the surrender (Article 10(3) EUDIR).

If a declaration of surrender does not contain all the particulars listed above and does not fulfil all the above requirements, the Office will notify the holder of the deficiencies and request that they be remedied within the prescribed time limit. Where the deficiencies are not remedied within the time limit, the surrender will not be entered in the Register and the European Union design holder will be informed thereof in writing (Article 71(5) EUDR).

11.3 Alteration of the representation of a registered EU design

11.3.1 General principles

During the period of registration, or on renewal, upon request by the holder, the representation of a registered EU design may be altered in the Register as long as it only alters immaterial details (Article 67(1) and (2) EUDR).

This means that the altered representation must differ from the originally registered version only in immaterial aspects. This applies where altered features (that have been removed, disclaimed, modified or added) and altered or withdrawn view(s), are so minor – in particular whether in size or significance - that they are unlikely to be noticed. It is important to note that the term 'representation' refers to the design as shown in all submitted views or reproductions.

11.3.2 Procedure for requesting alteration of the design representation

The alteration of the registration with respect to the EU design representation must meet several requirements:

Request for alteration

A request for alteration of the representation of an EU design registration in immaterial details must contain the following elements (Article 7 EUDIR):

1. The registration number of the registered EU design;
2. The name and address of the holder of the registered EU design in accordance with Article 1(2) EUDIR;
3. The representation of the design in its altered version (Article 67(2) EUDR), in accordance with the rules on how the EU design must be represented visually (Article 2 EUDIR), together with an indication of the features altered and the view, or views, that are being altered or withdrawn.

Payment of the fee for alteration

The request for alteration must be accompanied by the payment of a fee (Article 67(3) EUDR). The fee is EUR 200 (Annex I (13) EUDR).

A **single request** may be made for the alteration of the same element in two or more registrations, provided that the holder is the same for all designs. The required alteration fee must be paid in respect of each registration to be altered (Article 67(3) EUDR).

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

11.3.3 Deficiencies

Deficiencies in the payment of the fee for alteration

Where the holder does not pay the fee, or they do not pay it in full, the Office will inform the holder accordingly and grant a period of two months to remedy.

If, within the established deadline, the alteration fee:

- is paid in full, the request for alteration will proceed to assessment;
- is not paid, the request for alteration will be considered as ‘deemed not filed’;
- is not paid in respect of each registration to be altered, where there is a single request affecting two or more registration, the request for alteration will be refused in respect of the additional designs unless it is clear which designs the amount paid is intended to cover. In the absence of other criteria to determine which designs are intended to be covered, the Office will treat the designs in the consecutive numerical order in which they are contained in the multiple request. The request for alteration will be refused in respect of those designs for which the fee for alteration has not been paid or has not been paid in full.

Deficiencies in the request for alteration

Where a request for alteration of the registration does not meet the above requirements (Article 7 EUDIR) and the deficiency can be remedied, the examiner will invite the applicant to remedy the deficiency within two months.

If the deficiency is not remedied in due time, the Office will reject the request for alteration.

Deficiencies in the scope of the request for alteration

Where a request for alteration of the representation of an EU design registration does not meet the requirement of Article 57(2) EUDR, meaning that the alteration of the design representation goes beyond immaterial details, the examiner will notify the applicant that the request for alteration is not acceptable under the mentioned provision and that it will be rejected.

11.3.4 Publication of the alteration

If all the requirements governing the alteration of the registration set out in Article 67(1) to (3) EUDR and Article 7 EUDIR are fulfilled, the alteration will be entered in the Register and published. This publication will contain a representation of the registered EU design as altered (Article 67(4) EUDR). The Office will notify the holder that the request for alteration has been registered.

11.4 Changes in the name and/or address of the applicant/ holder and/or its representative or in the citation of the designer or team of designers

The EUD holder may request a recordal of the change of name or address in the Register. The registered representative may request a change of its name or business address.

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

A request for a change of name or address must contain:

1. the registration number of the EUD;
2. the holder's name and address as recorded in the Register, or the holder's identification number;
3. an indication of the new name and address;
4. the name and business address of the representative, where one has been appointed.

Where the change concerns the citation, change of name or the waiver of the designer or team of designers, the request must also contain:

- an indication of the designer or team of designers to be added;
- the name of the designer or the members of the team of designers as recorded in the Register and an indication of the new name as changed;
- a statement, signed by the designer or members of the team of designers being removed, that they waive their right to be cited.

Changes in the holders of EUD registrations are published in Part B.2.2 of the European Union Designs Bulletin, while transfers of rights are published in Part B.2.1.

Changes in the representatives are published in Part B.9 of the European Union Designs Bulletin. Changes in the citation of the designer or team of designers are published in Part B.10.2 of the European Union Designs Bulletin.

For more information on changes in the name and address see the Guidelines Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 10, Change of name and address.

Changes in the address and name are not to be confused with the correction of errors in EUD applications and registrations. In this regard, see the Guidelines Part A, General rules, Section 6 Revocation of decisions, cancellation of entries in the register and correction of errors.

11.5 Transfers

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

The legal provisions contained in the EUDR and EUDIR in respect of transfers correspond to the provisions in the EUTMR and EUTMIR respectively. The legal principles and procedure for the recordal of EUTM transfers apply to EUD transfers (see the Guidelines for Examination, Part E, Register Operations, Section 3, EUTMs and EUDs as Objects of Property, Chapter 1, Transfer).

11.6 Licences

EUDs may be licensed by the holder and the licences may be recorded, upon request, in the Register. The provisions of the EUDR and EUDIR dealing with European Union design licences correspond to the provisions in the EUTMR and EUTMIR. The legal principles and procedure for the recordal of licences in respect of EUTMs also apply to EUDs with the exception of the specific procedures only applicable to EUDs (see the Guidelines for Examination, Part E, Register operations, Section 3, EUTMs and EUDs as objects of property, Chapter 2, Licences, rights *in rem*, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings).

11.7 Entitlement proceedings

Registered European Union designs may be the subject of entitlement proceedings and subsequent changes in ownership under Article 15 EUDR (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and EUDs as Objects of Property, Chapter 2, Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, paragraph 8.2).

12 International Registrations

This part of the Guidelines deals with the particularities of examining international registrations designating the European Union that result from applications filed with the International Bureau of the World Intellectual Property Organization (hereinafter referred to as 'international registrations designating the EU' and 'the International Bureau') under the Geneva Act of 02/07/1999 of the Hague Agreement Concerning the International Registration of Industrial Designs.

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

12.1 General overview of the Hague System

12.1.1 The Hague Agreement and the Geneva Act

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

International registrations designating the European Union are governed by the Geneva Act (1999).

12.1.2 Procedure for filing international applications

12.1.2.1 Particularities

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

This means that the Office can only be a 'designated office', not an 'office of origin'. **International applications must therefore be filed directly with the International Bureau** (Article 153 EUDR).

Furthermore, neither the Geneva Act nor the EUDR provides procedures for transforming an international registration designating the EU into a European Union or national design application(s) or for converting an international registration designating the EU into national design application(s) of Member States and into designations of contracting parties to the Hague System, or for replacing European Union or national design registrations by an international registration designating the contracting party in question. Nor does the Geneva Act provide for the possibility of subsequent designation of the EU.

The Geneva Act (1999) and the Regulations Under the Geneva Act of the Hague Agreement (HR) contain specific rules, which may differ from those applicable to 'direct filings' of European Union designs, that is, applications filed directly with the Office (see paragraph 2.2.1). These specific rules relate to , in particular: i) entitlement to file an international application; ii) the contents of an international application; iii) fees; and iv) publication and deferment of publication.

12.1.2.2 Entitlement to file an international application

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

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

12.1.2.3 Contents of an international registration designating the EU

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

No prior national or regional application or registration is required.

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

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

12.1.2.4 Fees for international registrations designating the EU

Three types of fees must be paid for an international application designating the European Union, namely: ([6])

- a basic fee;
- a publication fee;
- an individual designation fee, that is, EUR 62 per design, converted into Swiss francs (Article 154 EUDR; Annex I (2) EUDR; Rule 28 CR).

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

As a general rule, publication in the *International Designs Bulletin* takes place 12 months after the international registration date.

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

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

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

The maximum deferment period for publishing an international registration designating the European Union is 30 months from the filing date or, where priority is claimed, the priority date (Article 11 Geneva Act).

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

12.2 The role of the International Bureau

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

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

6 See https://www.wipo.int/finance/en/hague.html.

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

International publication by the International Bureau constitutes notification of the international registration to the designated offices. Each office then has the option of refusing protection on substantive grounds.

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

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

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

12.3 The role of the Office as designated office

12.3.1 General overview

This section explains how international registrations designating the EU are dealt with by the Office once the International Bureau has notified it, all the way through to the final decision on whether the designation of the European Union has been accepted or refused.

One of the main features of the Hague System is that the Office can refuse protection, on EU territory, of an international registration designating the EU that does not fulfil the substantive conditions of protection provided for by EU legislation.

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

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

In the event of a refusal, the holder may renounce the international registration in respect of the Union, limit the international registration to one or some of the industrial

designs in respect of the Union or submit observations, and, where appropriate, appoint a representative. The ensuing procedure takes place solely before the Office; an appeal against a refusal must be submitted by the holder to the Boards of Appeal within the time limit and in accordance with the conditions set out in the EUDR, the EUDIR and the EUDDR. The International Bureau is not involved in this procedure.

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

The main roles of the EUIPO as designated office are:

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

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

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

Communications between the Office and the International Bureau are by electronic means (Article 16 EUDDR).

12.3.3 Grounds for refusal

Once the international registration designating the EU has been notified to the Office by the International Bureau, the rules laid down under Title XII EUDR apply (Article 152(1) EUDR).

12.3.3.1 Compliance with the definition of a design, public policy and morality, and Article 6ter of the Paris Convention

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

The Office limits its examination to the three grounds for refusal (Article 156(1) EUDR). An international registration designating the EU will be refused if a design does not correspond to the definition in Article 4(1) EUDR or if it is contrary to public policy or

accepted principles of morality (Article 10 EUDR) or, in the absence of the authorisation from the competent authority for its registration, it constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention, or of badges, emblems and escutcheons other than those covered by the said provision, and which are of particular public interest in a Member State (see paragraph 4).

The examination of grounds for refusal for international registrations designating the EU will be carried out as if the design(s) had been applied for directly with the Office. The time limits and other general procedural aspects governing the said examination are the same as those that apply in the case of design applications filed directly with the Office (see paragraph 4.4 above).

12.3.3.2 Time limits

The Office must inform the International Bureau of any refusal of protection within **6 months** of publication of the international registration on the WIPO website (Article 156(1) EUDR).

A refusal must be reasoned and state the grounds on which refusal is based, and the holder of the international registration designating the EU must be given an opportunity to be heard (Article 156(1) and (2) EUDR).

Thus, within 2 months of the date of the notification of refusal to WIPO, the international registration holder will be given the opportunity to renounce the international registration for the EU (for all the designs in the registration), to limit the international registration to one or some of the designs for the European Union or to submit observations (Article 156(3) EUDR).

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

For time-limit extensions, see paragraph 1.2.3 above.

12.3.3.3 Languages

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

The language in which the international application was received by the International Bureau will be the first language of the EU designation and will therefore become the language of the examination proceedings at the Office (Article 137(1) and (3) EUDR).

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

If the holder wishes to communicate with the Office in one of the other official languages of the EUIPO, it must supply a translation into the language in which the international application was filed within 1 month of the date of submission of the original document (Article 137(3) and (7) EUDR). If no translation is received within this time limit, the original document is deemed not to have been received by the Office.

12.3.3.4 Professional representation

In principle, the holder does not need to appoint a representative before the Office. Holders outside the European Economic Area (EEA) are, however, required to be represented further to a refusal (see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, and Articles 115 and 116EUDR).

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

If representation is mandatory under Article 115(2) EUDR (see paragraph 2.5), where a non-EEA holder has not appointed a representative or has appointed a representative before WIPO who does not appear in the database of representatives maintained by the Office, any notifications of refusal or objection will contain an invitation to appoint a representative in compliance with Articles 115 and 116 EUDR.

Where the holder has a WIPO representative **within** the EU who does not appear in the database of representatives maintained by the Office, the Office will inform this representative that if they wish to represent the holder before the Office, they must specify the basis of their entitlement (i.e. whether they are a legal practitioner or professional representative within the meaning of Article 116(1)(a) or (b) or Article 116(4) EUDR or an employee representative within the meaning of Article 115(3) EUDR (see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation).

If the holder fails to appoint a representative within the specified time limit, the Office will refuse protection of the international registration (Article 156(4) EUDR).

12.3.3.5 Renunciation and limitation

Where the holder renounces the entire international registration in the EU or limits it to one or some of the designs for the European Union, it must inform the International Bureau by way of recording procedure in accordance with Article 16(1)(iv) and (v) of the Geneva Act. The holder can inform the Office by submitting a corresponding statement (Article 156(6) EUDR).

12.3.3.6 Grant of protection

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

12.3.3.7 Refusal

Where the holder does not renounce the international registration for the EU, limit it to one or some of the designs, submit observations that satisfy the Office within the specified time limit or withdraw the application, the notification of refusal of protection of the EU designation to the International Bureau will be maintained. If the refusal concerns only some of the designs contained in a multiple international registration, the Office will refuse the latter only insofar as those designs are concerned (Article 156(5) EUDR).

There is no legal provision in the EUDR, the EUDIR or the EUDDR allowing an applicant to request an amendment of the design to overcome an objection concerning an international registration. However, a holder may renounce the designation of the EU by addressing the World Intellectual Property Organization directly, which will then notify the Office.

In the event of a refusal, the applicant may renounce the international registration in respect of the EU, limit the international registration to one or some of the industrial designs in respect of the EU or submit observations and, where appropriate, appoint a representative. The ensuing procedure takes place solely at Office level. An appeal against a decision to refuse protection must be submitted by the holder to the Boards of Appeal within the time limit and in accordance with the conditions set out in Articles 77 to 78 EUDR and Article 10 EUDDR (Article 156(5) EUDR). The International Bureau is not involved in this procedure.

Where the holder limits the international registration for the EU to one or some of the designs or submits observations that satisfy the Office within the specified time limit, the Office will send the Statement of Grant of Protection to the International Bureau.

Where the Statement of Grant of Protection relates to only some of the designs contained in a multiple application, the notification to the International Bureau will indicate which designs have been accepted.

12.4 Effects of international registrations

If no refusal is notified by the Office within 6 months of the publication of the international registration on the WIPO website, or if a notice of refusal is withdrawn, the international registration will, from the date of registration granted by the International Bureau, as referred to in Article 10(2) Geneva Act (Article 152(2) EUDR), have the same effect as if it had been applied for with, and registered by, the Office.

12.5 Invalidity applications against international registrations designating the EU

International registrations designating the EU can be subject to invalidity proceedings under the same conditions and procedural rules as 'direct filings' of European Union designs (Article 157 EUDR; see the Guidelines for Examination of Design Invalidity Applications). An application for a declaration of invalidity must be filed with the Office and must clearly identify the international registration number including the contested design within a multiple registration. The contested design within a multiple registration can be clearly identified by indicating the views and the view numbers in which the contested design is registered, or by adding an extension number of the particular design to the registration number. The language of filing of an international application designating the EU is necessarily an Office language. An application for a declaration of invalidity against such an international registration must be filed in the same language of filing (see paragraph 12.3.3.3).

The Office will notify the holder or their representative directly of any request for a declaration of invalidity. Where a non-EEA holder has not appointed a representative or has appointed a representative before WIPO who does not appear in the database of representatives maintained by the EUIPO, the Office will communicate with the holder directly and will invite them to appoint a representative who can act before the Office. The holder must reply directly to the Office or, if applicable, through a representative who is on the Office's list of representatives, in accordance with Article 116 EUDR (see paragraph 2.5).

Where the Office declares the effects of an international registration invalid in the territory of the European Union, it must inform the International Bureau of its decision as soon as it becomes final (Article 157(2) EUDR; Article 15(2) of the Geneva Act).

12.6 Changes affecting international registrations

The International Register is kept at WIPO.

The procedures governing the renewal of international registrations and recordals of changes of name, transfers, renunciation or limitation of certain designs, registration for any or all of the designated contracting parties, or limitation of the registration to certain designs are dealt with by the International Bureau (see the Guidelines, Part E, Register Operations, Section 4, Renewal, paragraph 13, Renewal of International Design Registrations Designating the EU; Articles 16 and 17 Geneva Act; Article 158 EUDR).

The EUIPO will not process requests for renewal or payments of renewal fees, or any other changes to international registrations for designs designating the EU, such as licences, rights in rem, levies of execution, or insolvency proceedings.

13 Enlargement and the registered European Union design

This section discusses the rules relating to the accession of new Member States to the European Union and the implications this has for those applying for a registered European Union design, or for those who have already registered one.

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

Article 161 EUDR contains provisions relating to EU enlargement as regards registered European Union designs. These provisions were inserted in the EUDR when the EU was enlarged in 2004 and remain applicable for successive enlargements. The only modification to the text of the EUDR is the addition of the names of the new Member States.

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

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

Pursuant to Article 161(1) EUDR, the effects of all European Union design rights filed before 01/05/2004, 01/01/2007 or 01/07/2013 extend automatically to the territories of the Member States that acceded on those dates (Article 161(1) EUDR).

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

13.2 Other practical consequences

13.2.1 Professional representation

As from the accession date, applicants (as well as other parties to proceedings before the Office) that have their seat or domicile in a new Member State no longer need to be represented by a professional representative. As from the accession date, professional representatives from a new Member State may be added to the list of professional representatives maintained by the Office pursuant to Article 116 EUDR, and may then represent third parties before the Office.

13.2.2 First and second language

Since 01/01/2004 there have been nine additional official EU languages, namely Czech, Estonian, Hungarian, Latvian, Lithuanian, Maltese, Polish, Slovak and Slovenian. A further two languages (Bulgarian and Romanian) were added on 01/01/2007 ([7]) and another (Croatian) on 01/07/2013.

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

13.2.3 Translation

Registered European Union design applications with a filing date that is prior to the accession date, or existing European Union design registrations, will not be translated into the language of the new Member State(s), nor will they be republished in that language. However, Registered European Union design applications filed after the accession date will be translated into all official EU languages and will subsequently also be published in all of those same languages.

13.3 Examination of grounds for non-registrability

The Office limits its examination of the substantive protection requirements to only three grounds for non-registrability (Article 56(1) EUDR). An application will be refused if:

- the design does not correspond to the definition given in Article 4(1) EUDR (see paragraph 4.1);
- the design is contrary to public policy or to accepted principles of morality (Article 10 EUDR) (see paragraph 4.2);
- in the absence of the authorisation from the competent authority for its registration, the design constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention, or of badges, emblems and escutcheons other than those covered by the said provision, and which are of particular public interest in a Member State (see paragraph 4.3).

An application for a registered European Union design cannot be refused on the basis of any of the grounds for non-registrability listed in Article 56(1) EUDR if these grounds become applicable merely because of the accession of a new Member State (Article 161(2) EUDR).

Whether a European Union design conforms with Article 4 EUDR or complies with public order and accepted principles of morality is normally assessed without reference to any particular national or linguistic context.

7 For Irish, see paragraph 2.4.

However, where a European Union design contains a word element that is offensive in a language that, as a result of the accession of a new Member State, becomes an official language of the European Union after the date of filing, the ground for non-registrability provided for under Article 10 EUDR does not apply.

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

13.4.1 General principles

European Union designs filed or registered before 01/05/2004, 01/01/2007 or 01/07/2013 will not be cancelled on the basis of grounds for invalidity that exist in one of the Member States acceding to the European Union on those dates if the ground for invalidity only became applicable from the accession date in question (Article 161(3) EUDR). This is an expression of the need to respect acquired rights.

Not all the grounds for invalidity set out in Article 27(1) EUDR may become 'applicable merely because of the accession of a new Member State'.

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

The accession of a new Member State has no effect on the applicability of the following four grounds for invalidity. Article 161(3) EUDR therefore does not offer any protection against their application to European Union designs filed before 01/05/2004, 01/01/2007 or 01/07/2013 respectively.

Non-visibility and functionality

The non-visibility of a European Union design applied to part of a complex product and the restrictions applying to features of a design that are solely dictated by technical function or the requirements of interconnection are grounds for invalidity that must be evaluated on the basis of the design itself and not on a factual situation that exists in any given Member State (Article 27(1)(b) EUDR in conjunction with Articles 5 and 9 EUDR).

Novelty and individual character

Under normal circumstances, the lack of novelty or individual character of a European Union design will not be affected by enlargement of the EU (Article 27(1)(b) EUDR in conjunction with Articles 6 and 7 EUDR).

The disclosure of a design prior to the filing or priority date of a European Union design can destroy the latter's novelty or individual character, even if the disclosure took place in a country before the date of its accession to the EU. The sole requirement is that this disclosure could 'reasonably have become known in the normal course of business to

the circles specialised in the sector concerned, operating within the Union' (Article 8(1) EUDR).

Entitlement to the European Union design

The fact that the holder is not entitled to the European Union design as a result of a court decision is another ground for invalidity that is not affected by enlargement (Article 27(1)(c) EUDR). Article 14 EUDR does not impose any nationality requirement for the person claiming to be entitled to the European Union design, nor does it require that the court decision originates from a court located in a Member State.

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

The invalidity ground of improper use of one or more of the elements listed in Article 6*ter* of the Paris Convention is not affected by enlargement of the EU either. There is no requirement for the sign for which use is prohibited to come from a Member State (Article 27(1)(g) EUDR).

13.4.1.2 Grounds for invalidity resulting from EU enlargement

A European Union design filed before the accession dates of 01/05/2004, 01/01/2007 or 01/07/2013, cannot be invalidated on the basis of any of the five grounds for invalidity referred to below where any of these grounds become applicable as a result of the accession of a new Member State (Article 161(3) EUDR).

Conflict with a prior design right protected in a new Member State (Article 27(1)(d) EUDR)

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

Use of an earlier distinctive sign (Article 27(1)(e) EUDR)

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

Unauthorised use of a work protected under the copyright law of a Member State (Article 27(1)(f) EUDR)

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

Improper use of signs, emblems, coats of arms, other than those covered by Article 6*ter* of the Paris Convention (Article 27(1)(g) EUDR)

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

Public policy and morality

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

13.4.2 Effects of a priority claim

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

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

GUIDELINES FOR EXAMINATION OF REGISTERED EUROPEAN UNION DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Examination of design invalidity applications

1 Purpose

The purpose of these Guidelines is to explain how, in practice, the provisions of the European Union design regulation ([8]) (EUDR), the European Union design Implementing Regulation ([9]) (EUDIR) and the European Union design Delegated Regulation ([10])(EUDDR) are applied by the Office from receipt of an application for a declaration of invalidity of a European Union design (application) up to the point of closure of the invalidity proceedings. Their purpose is also to ensure consistency among the decisions taken by the Invalidity Division and to ensure coherent practice in the treatment of the files. These Guidelines are not intended to, and cannot, add to or subtract from the legal contents of the Regulations.

2 Introduction - General Principles Applying to Invalidity Proceedings

2.1 Duty to state reasons

The decisions of the Invalidity Division must state the reasons on which they are based (Article 79 EUDR). The reasoning must be logical and it must not disclose internal inconsistencies.

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

2.2 Right to be heard

The decisions of the Invalidity Division will 'be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments' (Article 79 EUDR).

The Invalidity Division will apply the principles explained in the Guidelines, Part A, General rules, Section 2, General principles to be respected in the proceedings, Chapter 2, The right to be heard.

8 Regulation (EU) 2026/715 of the European Parliament and of the Council of 11 March 2026 on European Union designs (codification).

9 Commission Implementing Regulation (EU) 2026/138 of 15 January 2026 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 6/2002 on Community designs.

10 Commission Delegated Regulation (EU) 2026/137 of 15 January 2026 supplementing Regulation (EC) No 6/2002 on European Union designs with rules specifying the details of certain proceedings concerning registered designs, and repealing Commission Regulation (EC) No 2245/2002.

2.3 Scope of the examination carried out by the Office

In invalidity proceedings, the examination carried out by the Office is restricted to the grounds, facts, evidence and arguments provided by the parties (Article 63(1) EUDR). This does not preclude the Office from taking into consideration well-known facts (16/02/2017, T-828/14 & T-829/14, Radiatori per riscaldamento, EU:T:2017:87, § 90; see the Guidelines, Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 1, Adequate reasoning).

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

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

Expert reports or expert opinions and other statements in writing fall within the means of evidence referred to in Article 83(1)(c) and (f) EUDR. However, the fact that they are procedurally admissible does not automatically mean that the statement is credible and will serve as proof of the facts to be proven. Rather, such statements must be critically examined as to the accuracy and correctness of the information, as well as whether they come from an independent source and/or are fettered or supported by written information (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 26).

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

2.4 Compliance with time limits

The Office may disregard facts or evidence that are not submitted in due time by the parties concerned (Article 80(2) EUDR).

Parties are reminded that they must submit the facts and evidence on which they rely in due time and within the time limits set by the Office. Parties that fail to observe the time limits run the risk of having their facts and evidence disregarded. Parties have no unconditional right to have facts and evidence submitted after the time limit set by the Office.

Where the Office exercises its discretion under Article 80(2) EUDR, it must state the reasons why the late facts and evidence are admissible or not, taking into consideration whether the material that has been submitted late is, on the face of it, likely to be relevant to the outcome of the invalidity proceedings brought before it. Furthermore, the Office must consider whether the stage of the proceedings at which the late submission takes place, and the circumstances surrounding it, do not argue against such matters being taken into account (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 42-44; 05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 15-18).

The discretionary power as to the admissibility of evidence submitted outside the time limit only applies to ‘supplementary’ or ‘additional evidence’, as opposed to ‘entirely new evidence’, which is never admissible. ‘Entirely new evidence’ is characterised by the absence of any link with the evidence previously submitted and is to be rejected as belated. ‘Additional’ or ‘supplementary evidence’, on the other hand, is evidence that supplements other evidence that was previously submitted in due time. This is the evidence over which the Office can exercise its discretionary power (see 13/12/2023, T-10/23, Lampenschirme, EU:T:2023:804, § 48; and by analogy 14/05/2019, T-89/18 & T-90/18, Café del Sol / Café del Sol (fig.) et al., EU:T:2019:331, § 42).

An example of where the Office may exercise its discretion under Article 80(2) EUDR to take facts or evidence that were not submitted in due time into consideration could be the evidence submitted by the invalidity applicant in reply to the contested EUD holder’s observations, for instance, that disclosure of an earlier design was not properly established pursuant to Article 8 EUDR. However, the exercise of this discretionary power requires that the invalidity applicant’s evidence supplements the initial evidence for the purpose of rebutting the EUD holder’s specific arguments, for instance as to the time, place or circumstances relating to the earlier design’s disclosure. Another example is where the evidence was unavailable at an earlier stage or where a fact came to light during the course of the proceedings (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 34-36; 10/11/2021, T-443/20, Labels, EU:T:2021:767, § 18-22).

Belated evidence concerning a prior design or earlier right that had not been relied upon in the application for a declaration of invalidity is not considered to be additional and will, therefore, be rejected (13/12/2023, T-10/23, Lampenschirme, EU:T:2023:804, § 47-48; 15/12/2021, T-682/20, Schuhwaren, EU:T:2021:907, § 34).

The Office may also exercise its discretion under Article 80(2) EUDR with respect to facts and evidence in the holder's response to the invalidity application submitted after the time limit.

If the time limit is still running, the party may request an extension of the time limit, pursuant to Article 21 EUDDR (see paragraph 4.1.5).

For general information on time limits, see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits.

3 Application for invalidity - Admissibility check

3.1 Form of the application

Applications are filed using the e-filing option in the User Area, which can be found on the EUIPO website (Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means).

In the event of a malfunction during the electronic transmission of an application, communication or other document through the specific e-operation or e-filing form in the User Area, the Office has made two electronic backup alternatives available. Technical details on the accessibility and functionality of both backup alternatives are available in the Conditions of Use of the User Area. For more information on communication via the User Area, see the Guidelines, Part A, General Rules, Section 1, Means of communication, time limits, paragraph 3.1.1.

3.2 Scope of the application

In invalidity proceedings, the relief sought by the applicant can only be the declaration of invalidity of the contested European Union design as registered (Article 27 EUDR).

Where contested European Union designs are part of a multiple registration, each design must be contested individually (Article 44(4) EUDR) and identified by reference to its full registration number or the numbering stipulated for multiple international applications respectively. A single application (and a common indication of grounds) may concern more than one European Union design of a multiple registration. In such a case, the fee for the application must be paid for each contested European Union design. However, for the sake of clarity, the Office recommends that separate applications be filed for each contested European Union design.

3.3 Language of proceedings

The language regime in design invalidity proceedings is not the same as that governing trade mark proceedings, as explained below.

The application for a declaration of invalidity must be filed in the language of proceedings, which is the language used for filing the application for registering the contested European Union design (language of filing), provided the language of filing is one of the five Office languages (Article 137 EUDR).

If the language of filing is not one of the five Office languages, the language of proceedings is the second language indicated in the application for the contested European Union design (Article 137(4) EUDR).

As regards international registrations designating the European Union, the language of proceedings is the language in which the international application was filed (English, French or Spanish). This corresponds to the first language used for the product indication (INID code 54 of the internationally agreed numbers for the identification of (bibliographic) data), **as published in the WIPO International Designs Bulletin**. The language used in the product indication in the Hague Express database is interface sensitive and, therefore, cannot be relied upon when determining the language of proceedings, as the order of the three official languages varies according to the selected interface language. In case of doubt, applicants for a declaration of invalidity are advised to check the language of filing of the international registration with the International Bureau.

Where the **application for a declaration of invalidity** has been filed in a language other than the language of proceedings, the Office will request that the applicant submit a translation within a **one-month** period from the date of receipt of the notification. Where the applicant does not comply with the request, the application will be rejected as inadmissible (Article 5(3) EUDDR).

The same language regime requirements apply to the **evidence necessary for the admissibility of the application** (see paragraph 3.10.3.2, Admissibility requirements for individual grounds) including evidence from the online sources referred to by the applicant, where the language of the online evidence is not the same as the language of the proceedings (for further information on online sources see paragraph 3.10.3.1, Online substantiation of earlier rights). If the evidence is not in the language of the proceedings, the Office will invite the applicant to submit the translation within one month. If no translation is received within that period, the Office will consider the evidence inadmissible and proceed with examining the application without taking into account that evidence (Article 5(3) EUDDR).

Any **other supporting documents** not required for the admissibility of the application may be filed in any official language of the European Union. These include documents provided by the applicant in support of an invalidity application based on Article 27(1)(a) EUDR or Article 27(1)(b) in conjunction with Articles 9 or 10 EUDR, as well as supporting documents referred to in paragraph 4.1.3.2, Translation of the applicant's

reply and paragraph 4.1.3.3, Submission of evidence of use of an earlier trade mark. When the supporting documents are not filed in the language of proceedings, the Office may require the applicant to submit a translation of these documents into the language of proceedings within a specified time limit, either on its own motion or upon request by the other party (Article 5(4) EUDDR in conjunction with Article 15 EUDIR and Article 24 EUTMIR).

The question whether certain parts of **the evidence necessary for the admissibility of the application (and the supporting documents)** may be considered irrelevant for the application, and therefore not translated, is a matter for the discretion of the applicant. In cases where a translation is not submitted, the Invalidity Division may disregard the text portions of evidence that are not translated and base its decision solely on the evidence before it that has been translated into the language of proceedings (Article 5(3) EUDDR). For the language requirements on translations, see Part A, General rules, Section 4, Language of proceedings, paragraph 7, Translations and their Certification.

The parties to the invalidity proceedings may agree on a different language of proceedings provided it is an official language of the European Union. Information on the agreement must reach the Office within a period of two months of receipt by the holder of the official communication sent after the completion of the admissibility examination, referred to in Article 6(1) EUDDR (see paragraph 3.14.1). Where the application for a declaration of invalidity was not filed in that language, the holder may request that the applicant files a translation of the application in that language. Such a request should be received by the Office before the expiry of the two-month period since receipt of the admissibility notification by the EU design holder (Article 6(1) EUDDR). The Office will provide the applicant with a one-month time limit to submit the translation of the application. If the translation is not filed within the set time limit, the language of proceedings will remain unchanged.

3.4 Identification of the applicant

The application must contain an indication of the name and address of the applicant (Article 2(1)(d) EUDDR). For further information, see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 2, Parties to proceedings before the Office and paragraph 3, Identification of parties to the proceedings.

Where the information given in the application does not make it possible to identify the applicant unambiguously, and the deficiency is not remedied within 2 months of the Office's request in that regard, the application must be rejected as inadmissible (Article 5(2) EUDDR).

3.5 *Locus standi* of the applicant

Any natural or legal person, as well as any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers (if that group or body has the capacity to sue and be sued in its own name under the terms of the law governing it), may submit an application for a declaration of invalidity of a European Union design to the Office based on **Article 27(1)(a) and (b) EUDR** (Article 27(2) EUDR).

Where the ground for invalidity is lack of entitlement to the EUD pursuant to **Article 27(1)(c) EUDR**, an application for a declaration of invalidity is admissible only if the applicant is entitled to the EUD under Article 14 EUDR.

When the ground for invalidity is infringement of an earlier right, within the meaning of **Article 27(1)(d) to (f) EUDR**, the application may be filed solely by the following:

- the applicant or holder of the earlier right;
- persons who are entitled under European Union law, or the law of the relevant Member State concerned, to exercise the right; or
- a licensee authorised by a proprietor of the earlier right.

Where the ground for invalidity is improper use of flags and other symbols, within the meaning of **Article 27(1)(g) EUDR**, the application may be filed solely by the person or entity concerned by the improper use, unless provided otherwise by the respective Member State (Article 27(6) EUDR). Entitlement will be examined on the basis of the international, national or European Union law that governs the earlier right or symbol in question.

The invalidity application must contain indications proving that the applicant is authorised or entitled to file it (Article 2(1)(f) EUDDR). The information about the applicant´s authorisation or entitlement could also be available via online sources as referred to in paragraph 3.10.3.1.

3.6 Representatives

As a matter of principle, the rules governing representation in European Union trade mark proceedings apply *mutatis mutandis* to invalidity proceedings for European Union designs (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional representation).

3.7 Identification of the contested European Union design

An application for a declaration of invalidity must contain the registration number of the contested European Union design and the name of its holder, as entered in the Register (Article 2(1)(a) EUDDR).

Where the information given by the applicant does not make it possible to identify the contested European Union design unambiguously, the applicant will be requested to supply such information within a period of 2 months. If the applicant does not comply with this request, the application will be rejected as inadmissible (Article 5(2) EUDDR).

3.8 Lapsed or surrendered registrations

A registered European Union design may be declared invalid even after the European Union design has lapsed or has been surrendered, if the applicant shows a legitimate interest in obtaining a decision on the merits (Article 26(2) EUDR).

Where the contested European Union design has lapsed or has been surrendered before the filing of the application for a declaration of invalidity or before the date on which the Office's decision on the admissibility of the application is notified to the parties, the applicant will be requested to submit reasons and evidence, within a period of 2 months, that it has a legitimate interest in the declaration of invalidity. Where the applicant does not comply with the request, the application is rejected as inadmissible and the fees are not refunded (Article 5(2) EUDDR). A decision on costs will not be taken (Article 5(5) EUDDR).

Where the request for surrender is submitted whilst invalidity proceedings are ongoing, or the grace period for renewal of the contested European Union design expires in the course of invalidity proceedings, the invalidity proceedings will be stayed.

Since the request for surrender starts a separate procedure to which the invalidity applicant is not a party, the contested European Union design holder must submit a separate request (Article 6(5) EUDDR) rather than requesting the surrender in response to the invalidity application. For more details see the Guidelines for Examination of applications for registered European Union designs, 11.2 Surrender of the registered EU design.

Where the request for surrender does not proceed or where the European Union design is renewed, the invalidity proceedings are resumed.

Where the contested European Union design is cancelled from the Register (Article 66(8) EUDR) or the surrender is entered in the Register of European Union designs (Article 71(1) EUDR) whilst invalidity proceedings are ongoing, the applicant will be invited to confirm whether it maintains its application and, if so, to submit reasons and evidence in support of its legitimate interest to request a decision on the merits of the case within a period of 2 months.

Where the invalidity applicant withdraws its application, does not respond to the invitation, or fails to show a legitimate interest in obtaining the decision, the invalidity proceedings will be closed without taking a decision on merits (see paragraph 6, Termination of the Proceedings).

A claim to have a legitimate interest will only be accepted where the applicant shows why a decision on the substance of the declaration of invalidity is required, and why the surrender or expiration of the contested design is not sufficient to satisfy this interest.

Requests without any supporting evidence and without any explanation as to why the surrender or expiration of the design does not satisfy legitimate interests (as opposed to a declaration of invalidity) will be rejected. For instance, a legitimate interest will be established where the applicant proves that the holder of the contested European Union design has taken steps to invoke rights under the contested European Union design against it.

Where the Invalidity Division finds that a legitimate interest has not been demonstrated, it will take a decision rejecting the request and giving reasons. The invalidity proceedings are closed (see paragraph 6, Termination of the Proceedings) only when that decision becomes final.

Where a legitimate interest is demonstrated by the applicant, the Office will take a decision on the merits.

The cases above have to be distinguished from invalidity applications directed against a European Union design, which, at the filing of the application for invalidity or before the date on which the Office's decision on the admissibility of the application is notified to the parties, has already been declared invalid by a final decision. In these cases, the later invalidity action is inadmissible and the fees are non-refundable. Where this is the case, the invalidity applicant will be invited to comment on the finding before the application is rejected (Article 79(1) EUDR).

3.9 Res judicata

An application for a declaration of invalidity is inadmissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on its merits, either by the Office or by a **European Union design court** and the decision has become final (Article 73(3) EUDR). Where this is the case, the invalidity applicant will be invited to comment on the finding before the application is rejected as inadmissible. The invalidity fee is non-refundable.

Where this cause of inadmissibility arises *after* the application was found admissible, the Office will invite the applicant to comment on the finding of *res judicata* before the application is rejected as inadmissible (the earlier decision on admissibility does not need to be revoked since it did not contain any error at the time it was taken).

The Office will apply the same principles of assessment of the defense of *res judicata* as provided in the Guidelines for examination of European Union trade marks, Part D Cancellation, Section 1 Cancellation Proceedings, 2.5.1.3 Res judicata. For awarding of costs see paragraphs 6.2 Decision on cost and 6.2.2 Apportionment of costs.

3.10 Grounds, facts, evidence and arguments

The application must include an indication of the grounds on which the application is based (Article 73(2) EUDR; Article 2(1)(b) EUDDR) together with a reasoned statement

explaining the facts, evidence and arguments in support of those grounds (Article 2(1)(c) EUDDR).

3.10.1 Indication of the grounds

An application for invalidity must be filed by using the electronic form available on the EUIPO website. The applicant may invoke one or several grounds of invalidity in one application.

The Office will examine the application in light of all the grounds put forward in the reasoned statement explaining the facts, evidence and arguments, even if the corresponding ground is not indicated in the online form.

Where the application form, together with the reasoned statement explaining the facts, evidence and arguments, does not make it possible to identify unambiguously the ground(s) on which the application for invalidity is based, the applicant will be requested to provide further specifications in this respect within a period of two months. If the applicant does not comply with the request, the application will be rejected as inadmissible (Article 5(2) EUDDR) (see paragraph 3.13 Non-compliance with the admissibility requirements).

Grounds for invalidity, other than those specifically relied on in the application, will be considered inadmissible when subsequently put forward before the Office.

The Office strongly recommends that all grounds for invalidity be put forward in one single application. Where separate applications are lodged against the same contested European Union design but based on different grounds, the Office may deal with them in one set of proceedings. The Office is more likely to join them if, in addition, they are filed by the same invalidity applicant, or if there is an economic link between the invalidity applicants, for example, a parent and subsidiary company. However, the Invalidity Division may subsequently decide to no longer deal with them in this way (Article 8(1) EUDDR).

3.10.2 Reasoned statement setting out facts, evidence and arguments

In proceedings relating to a declaration of invalidity, the Office is restricted in its examination to the grounds, facts, evidence and arguments submitted by the parties and the relief sought (Article 80(1) EUDR).

The applicant must submit a reasoned statement explaining the facts, evidence and arguments in support of each of the grounds invoked, as well as the supporting evidence (Article 2(1)(c) and (d) EUDDR). As a matter of principle, all facts, evidence and arguments relied on in support of an application for a declaration of invalidity must be submitted together with the application.

3.10.3 Supporting evidence

Documents in support of the application should be listed in accordance with the requirements provided in the Guidelines, Part A, General rules, Section 10, Evidence.

3.10.3.1 Online substantiation of earlier rights

Where evidence concerning the filing or registration of the earlier rights or concerning the contents of the relevant national law relied on is accessible online from a source recognised by the Office, the applicant may formally declare to the Office that it relies on such evidence. The Office will not check on its own initiative the substantiation of any rights online where the applicant has not expressly and unconditionally declared its intention to rely on online evidence.

The applicant has to ensure all the information details are available via the evidence from online sources to which the applicant refers to or are contained in the annexed extract(s). Where the online sources do not include all required details, the missing information has to be completed from another official source and filed in the application.

Rights registered before the Office

Where the application is based on an **earlier right registered before the Office** (as an EUD or an EUTM), the applicant does not have to submit any documents (including priority documents), provided that the application also contains the filing or registration number of the **invoked earlier rights** and their representation (or denomination). The Office will assess the necessary information based on the data contained in the Office's Registers.

Rights not registered before the Office

The Office accepts information concerning filing or registration of the invoked rights and prior designs from sources recognised by it, which include the official (including online) databases, registers and bulletins of the Member States, WIPO (including Madrid Monitor and Hague Express databases), and from DesignView and TMview portals.

The extracts from these sources can be directly **annexed** to the invalidity application.

When the **evidence is accessible online** via a source recognised by the Office, the invalidity applicant may provide this evidence by **referencing** the source (Article 2(3) EUDDR), instead of annexing the extract to the application. In this case, the relevant information can be **directly uploaded** from the source in the application form (when this functionality is provided), or the applicant may **add a direct link** (URL address) in the application form. The applicant must formally declare to the Office that it relies on this evidence, otherwise the Office will not check on its own initiative the existence and validity of any rights online.

Reference to an online source will be acceptable, **irrespective of the ground for invalidity invoked**, provided that the application also contains the filing or registration

number of the **invoked earlier rights or prior designs** and their representation (or denomination).

Respectively, the Office recognises, as evidence of the filing or registration of **national designs and trade marks**, information from official online sources of the competent registration authorities of Member States and, as evidence of **international registrations**, information from the respective WIPO online sources.

Furthermore, the Office recognises, as evidence of **filed or registered designs and trade marks**, information obtained through the Office's DesignView and TMview portals.

Extracts generated through DesignView and TMview and online references to these databases reflect the information obtained directly from the competent registration authorities and, therefore**,** qualify as documents equivalent to registration certificates from the competent registration authorities within the meaning of Article 2(3) EUDDR (by analogy 06/12/2018, T-848/16, V (fig.) / V (fig.) et al., EU:T:2018:884, § 59-61, 70).[11]

Applicants must carefully check that the official online source relied on is up to date and contains all the relevant information necessary to prove the disclosure, validity and scope of protection of the invoked earlier right or prior design in the invalidity application. It should also prove the entitlement of the applicant to file the application. When the extract from an official database or the database accessed online does not contain all the information required, the applicant must supplement it with other documents from an official source that show the missing information.

The applicant must provide a translation reproducing the structure and content of the original text of the evidence if it is not in the language of the proceedings (for further information on languages see paragraph 3.3, Language of proceedings).

Content of relevant national law

To prove the **content of the relevant national law**, where applicable (Article 2(3) EUDDR), a reference to any online database will be accepted to the extent that it provides the official legal text originating from the government or official body of the Member State concerned, is publicly accessible, free of charge and its search environment is in the language of the proceedings. In that regard, the WIPO Lex database is a useful source as it compiles official texts for intellectual property legislation in the original language received from the Member States concerned or from other verified sources (for translation requirements, please refer to paragraph 3.3, Language of proceedings). Furthermore, if the original text of the law is not in the language of the proceedings, its translation must also be available at the indicated online source, or should be submitted separately with the invalidity application.

11 For further information on trade marks, see the Trade Mark Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 4.2.3, Trade mark registrations or applications that are not EUTMs.

3.10.3.2 Admissibility requirements for individual grounds

Article 2(2) EUDDR clarifies the specific requirements that the application must comply with, depending on the ground invoked. The applicant has to ensure that all the information details are available via the evidence from the online sources to which the applicant refers, or that they are contained in the annexed extract(s). Where the online sources do not include all the required details, the missing information has to be completed from another official source and filed in the application.

3.10.3.2.1 Article 27(1)(b) EUDR (lack of novelty and individual character)

Where the applicant claims that the contested European Union design **lacks novelty or individual character (Article 27(1)(b) EUDR)**, the application must contain the indication, a representation and evidence of disclosure of the prior design(s) (Article 2(2)(b) EUDDR).

The evidence of indication, representation and disclosure of the prior design(s) may originate from the sources and be provided via the means reflected in paragraph 3.10.3.1, Online substantiation of earlier rights. Evidence from any other sources must be extracted and annexed to the application.

For details on the examination of invalidity applications based on Article 27(1)(b) EUDR, see paragraph 5.7, Lack of novelty and individual character.

3.10.3.2.2 Article 27(1)(c) EUDR (lack of entitlement)

Where the applicant claims that the holder is **not entitled to the contested European Union design (Article 27(1)(c) EUDR)**, the application must contain the final decision of a competent court or authority of the Member State concerned, showing that the applicant is entitled to the contested European Union design (Article 2(2)(b) EUDDR in conjunction with Article 15 EUDR).

For details on the examination of invalidity applications based on Article 27(1)(c) EUDR, see paragraph 5.3, Lack of entitlement.

3.10.3.2.3 Article 27(1)(d) EUDR (prior design right)

Where the applicant claims that the contested European Union design is in conflict with **a prior design (Article 27(1)(d) EUDR)**, the application must contain the representation of the prior design and the particulars identifying it. If it is not a registered EU design, evidence of its filing or registration must be provided. This must consist of a copy of the relevant filing, registration, and, if applicable, the renewal certificate or an equivalent document from the administration where the design was filed or registered. The applicant may instead refer to accessible online sources recognised by the Office where the relevant information is contained (see paragraph 3.10.3.1). The document must prove the existence and validity of the prior

design (Article 2(2)(c) EUDDR) and that the filing date or, where claimed, the priority date, of the prior design is earlier than the filing date of the contested design.

Where an earlier right is pending registration, the applicant must complete the file by providing evidence of registration once granted. Until then, it is sufficient to show that the application was filed at the relevant office. If necessary, before making a decision, the Office may suspend the invalidity proceedings until it has received evidence of registration (see paragraph 4.1.5.2, Suspension).

For details on the examination of invalidity applications based on Article 27(1)(d) EUDR, see paragraph 5.8, Conflict with a prior design right.

3.10.3.2.4 Article 27(1)(e) EUDR (earlier distinctive signs)

Where the applicant claims that the contested European Union design makes unauthorised use of a **distinctive sign (Article 27(1)(e) EUDR)**, pursuant to Article 2(2)(d) EUDDR, the application must contain:

- an indication of the kind or nature of the prior distinctive sign and its representation;
- an indication of whether this distinctive sign exists in the whole of the European Union or in one or more Member States, and if so, an indication of those Member States;
- where the prior distinctive sign is a registrable right, particulars identifying it (e.g. registration number, representation), including evidence that the right is earlier (for instance, evidence of any priority claims);
- evidence of its existence, validity and scope of protection, including **the right of its holder to prohibit the use** of the contested design. That evidence must include, in particular:
  - where the distinctive sign, which is not a registered trade mark, is invoked under the law of a Member State, an indication of the content of the national law relied upon by adducing publications of the relevant provisions or jurisprudence;
  - where the distinctive sign is a registrable right other than an EUTM (e.g. a geographical indication), a copy of the relevant filing, registration or the renewal certificate or an equivalent document from the administration with which the distinctive sign was filed or registered. The applicant may instead refer to accessible online sources recognised by the Office where the relevant information is contained (see paragraph 3.10.3.1). For further information on relevant sources of information for geographical indications see the Trade Mark Guidelines, Part C, Opposition, Section 6, Geographical indications (Article 8(6) EUTMR), paragraph 2.4, Specifics of substantiation.

Where an earlier right is **pending registration**, the applicant must complete the file by providing evidence of the actual registration of the earlier right relied upon once registered. Until that time, it is sufficient to provide evidence that the application was filed at the relevant office. If necessary, prior to making a decision, the Office may suspend the invalidity proceedings until it has received evidence of registration (see paragraph 4.1.5.2, Suspension).

Where the earlier right invoked under Article 27(1)(e) EUDR is **a non-registered trade mark or another sign used in the course of trade**, the invalidity application must contain evidence that the earlier distinctive sign was used by the applicant before the filing date of the contested design, or its priority date.

For details on the examination of an invalidity application based on Article 27(1)(e) EUDR, see paragraph 5.9, Use of an earlier distinctive sign.

3.10.3.2.5 Article 27(1)(f) EUDR (earlier copyright)

Where the applicant claims that the contested European Union design makes an unauthorised use of a work protected by a **copyright law in a Member State** under Article 27(1)(f) EUDR, pursuant to Article 2(2)(e) EUDDR, the application must contain:

- an indication and particulars identifying the work protected by copyright, including evidence that the right is earlier, and its representation;
- an indication of the Member State where it is protected and of the content of the national law relied upon by adducing publications of the relevant provisions or jurisprudence, including, where necessary, court decisions or academic writings;
- the evidence of authorship of the prior work protected by copyright or acquisition of the rights to that work and of its scope of protection under the national law relied upon, including the right to prohibit the contested use conferred on its right holder.

For details on the examination of an invalidity application based on Article 27(1)(f) EUDR, see paragraph 5.10, Unauthorised use of a work protected under the copyright law of a Member State.

3.10.3.2.6 Article 27(1)(g) EUDR (flags and other symbols)

Where the applicant claims that the contested European Union design makes improper use of any of the items listed in **Article 6*ter* of the Paris Convention** or of badges, emblems and escutcheons (other than those covered by Article 6*ter)* that are **of particular interest in a Member State (Article 27(1)(g) EUDR)**, the application must contain a representation and particulars of the relevant item (Article 2(2)(f) EUDDR).

For details on the examination of an invalidity application based on Article 27(1)(g) EUDR, see paragraph 5.11, Improper use of flags and other symbols.

3.11 Signing the application

The application for a declaration of invalidity must be signed by the applicant, or its representative if it has one.

As the application is filed by electronic means, the indication of the name of the sender is deemed equivalent to a signature pursuant to Article 17(1) EUDDR. For further details on signatures, see the Guidelines Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.1.5.

3.12 Payment of fees

For general rules on payments, see the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

An application for a declaration of invalidity will be deemed not to have been filed until the fee has been paid in full (Article 73(2) EUDR; Article 5(1) EUDDR). Therefore, before examining the admissibility of the application, the Office will first check that the fee has been received.

Where the Office finds the fee has not been paid, it will request that the applicant pay the fee within 2 months of receipt of the notification. If the applicant does not comply with the request, the application is deemed not to have been filed and the applicant is informed accordingly. If the required fee is paid after the expiry of the specified time limit, it will be refunded to the applicant (Article 5(1) EUDDR).

In cases where the fee is received after the expiry of the time limit specified by the Office but the applicant provides proof that, within the time limit, it duly gave an order to a banking establishment to transfer the amount of the payment in a Member State, Article 180 EUTMR will be applied, including the payment of a surcharge where applicable (see Decision No EX-25-13 of the Executive Director of the Office of 1 December 2025 on methods of payment of fees and charges and determining the insignificant amounts of fees and charges, and the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges).

The filing date of an application for a declaration of invalidity is not affected by the date of payment of the fee, since Article 73(2) EUDR does not provide for any consequence regarding the application's filing date. When the fee is paid before the expiry of the time limit specified by Article 5(1) EUDDR, the application is deemed to have been filed and the filing date will be the date the application was received by the Office.

As a general principle, the invalidity fee is an application fee due for the filing of the application regardless of the outcome of the proceedings. Therefore, it will not be refunded if the application is rejected as inadmissible or withdrawn in the course of proceedings.

3.13 Non-compliance with the admissibility requirements

If the applicant fails to include in the application all the admissibility particulars listed in this chapter (3 Application for invalidity - Admissibility check), the Office will issue a deficiency letter requesting the submission of the missing information within a specified time limit. If the applicant does not comply with this request, the application will be rejected as inadmissible in whole or in part (in relation to the particular ground(s), design(s) or right(s) invoked) (Article 5(2) EUDDR).

New earlier designs, rights or new grounds of invalidity invoked after the notification of the application (Article 4 EUDDR) will be rejected as inadmissible to the extent that

they would broaden the scope of the original application for a declaration of invalidity (05/02/2016, R 2407/2014-3, Kitchen utensils, § 21; 22/10/2009, R 690/2007-3, Chaff cutters, § 44 et seq.).

This scenario should not be confused with evidence concerning the indication and reproduction of the invoked earlier design(s) or right(s) submitted in response to a deficiency letter issued by the Office pursuant to Article 5(2) EUDDR.

An assessment of the **substance** of the above facts, evidence and arguments is carried out by the Invalidity Division at a later stage when a decision is taken.

3.13.1 Decision to the effect that the application is inadmissible

Where the Office finds the application inadmissible and the deficiency is not remedied within the specified time limit, it will issue a decision rejecting the application as inadmissible (Article 5(2) EUDDR). The fee will not be refunded.

3.14 Admissibility in respect of one of the grounds or the earlier rights or prior designs relied on

If the application is based on more than one ground for invalidity, or more than one earlier right or prior design, it is found to be admissible if and insofar as the requirements regarding admissibility are satisfied for at least one of those grounds, and in relation to at least one earlier right or prior design, irrespective of whether or not these requirements are met for the remaining grounds and earlier rights or prior designs.

Since there is no additional time limit granted for substantiation, all the details must be provided in the application. Therefore, from the outset the applicant must submit a complete application for invalidity containing the necessary details required pursuant to Article 2(1) and (2) EUDDR, including the facts, evidence and arguments in relation to all the ground(s) and the earlier right(s) or the prior design(s) invoked (see paragraph 3.10.2 Reasoned statement setting out facts, evidence and arguments).

For reasons of procedural economy when examining the admissibility of the application, the Office may choose not to examine whether all the grounds and earlier rights or prior designs invoked in the application are admissible. Instead, it may choose to limit the examination to one ground and one earlier right or prior design. Consequently, the applicant will not be invited to remedy admissibility deficiencies if and insofar as the requirements regarding admissibility are satisfied for at least one of those grounds and in relation to at least one earlier right or prior design. The exception to this rule concerns the grounds of Article 5(1) EUDR. If a statement is made that the application for invalidity is based on the ground of novelty and/or individual character, the admissibility examination must ensure that the scope of the application is clear. In case of any doubts, the Office will invite the invalidity applicant to clarify if only novelty,

individual character or both grounds are invoked, and which prior designs are relevant with respect to each of the grounds.

Where the application is inadmissible in its entirety, the Office will call upon the invalidity applicant to remedy the admissibility deficiencies within 2 months. If the applicant fails to remedy the deficiencies, the application will be rejected as inadmissible (Article 5(2) EUDDR).

The Office assesses the facts, evidence and arguments on the merits of the case at a later stage when a decision is taken. Where the invalidity application does not succeed on the ground and earlier right or the prior design found to be admissible, the Office will examine whether the remaining grounds(s) and earlier rights(s) or prior design(s) are admissible.

If necessary, it will call upon the invalidity applicant to remedy the admissibility deficiencies concerning the remaining earlier rights or prior designs and grounds within 2 months.

Where the deficiencies are remedied in due time, the holder will be invited to submit observations in that respect before the decision on substance is taken. The Office will then decide on the merits of the case based on those remaining ground(s) and earlier rights(s) or prior designs found admissible.

Where the applicant does not comply with the request, the admissibility issue will be dealt with together with the decision on the merits of the case.

The decision on admissibility of the invalidity application can be appealed together with the final decision terminating the proceedings (Article 77(2) EUDR).

3.14.1 Decision to the effect that the application is admissible and communication to the parties

Upon submission via e-filing, the EUD holder receives an automated acknowledgement of receipt of the application for a declaration of invalidity.

Only once the application has been found admissible, the Office issues a communication to the parties informing that the adversarial part of the invalidity proceedings has commenced and inviting the holder to submit observations in response within a two-month time limit (see paragraph 4.1.1, Observations by the holder).(Article 6(1) EUDDR). This notification constitutes the decision on admissibility, which may be appealed together with the final decision (Article 77(2) EUDR).

The decision on admissibility may, however, be withdrawn, in accordance with the general principles of administrative and procedural law, if irregularities are detected *ex officio*, within a reasonable time, or by the EUD holder in its first observations (Article 6(1) EUDDR), and if the applicant for invalidity fails to remedy these irregularities within the time limit prescribed by the Office (Article 5 EUDDR) (Article 99 EUDR and, by analogy, 18/10/2012, C-402/11 P, REDTUBE / www.redtube.com, EU:C:2012:649, § 59).

3.15 Participation of an alleged infringer

As long as no final decision has been taken by the Invalidity Division, any third party that proves that proceedings for infringement based on the contested European Union design have been instituted against it can join as a party to the invalidity proceedings (Article 76 EUDR; Article 9 EUDDR).

The alleged infringer must submit its request to be joined as a party within 3 months of the date on which the infringement proceedings were instituted. Unless proof is submitted by the holder that another date should be retained in accordance with the national law in question, the Office will assume that proceedings are 'instituted' on the date of service of the action to the alleged infringer. The alleged infringer must submit evidence in respect of the date of service of the action.

Any third party that proves that (i) the rights holder of the European Union design has requested that it cease an alleged infringement of the design and that (ii) the third party in question has instituted proceedings for a court ruling that it is not infringing the registered European Union design (if actions for declaration of non-infringement of European Union designs are permitted under national law) may also join as a party in the invalidity proceedings (Article 54 and Article 120(b) EUDR).

The request to be joined as a party must be submitted in a written reasoned statement and will not be deemed to have been submitted until the invalidity fee has been paid. The rules explained above in paragraphs 3.1 Form of the application to 3.13 Payment of fees will apply to the alleged infringer (Article 76(2) EUDR; Article 9 EUDDR).

4 Adversarial Stage of the Proceedings

4.1 Exchange of communications

4.1.1 Observations by the holder

4.1.1.1 Generalities

The holder's observations will be communicated to the applicant without delay.

Documents in support of observations should be listed in accordance with the requirements provided in the Guidelines, Part A, General rules, Section 10, Evidence.

Where the holder does not submit any observations within the two-month time limit, the Office will notify the parties that the adversarial part of the proceedings is closed and that it will take a decision on the merits based on the evidence before it. The same would apply if the applicant did not submit observations within the time limit given by the Office (Article 6(2) EUDDR).

4.1.1.2 Examination of invalidity proceedings as a matter of priority

Under Article 7 EUDDR, the Office shall rule on the invalidity application, which has been found admissible, as a matter of priority when the following cumulative requirements are met:

- the invalidity application is based on Article 27(1)(b) EUDR in conjunction with Articles 6 and/or 7 EUDR;
- the holder of the contested registered EU design has not challenged the grounds of invalidity or the relief sought by submitting observations in reply to the invalidity application.

The matter of priority allows the invalidity application to be examined with a preference in the time limits in which the Office will take a decision. The Office shall apply any available means to resolve the dispute in the most efficient and timely manner.

4.1.1.3 Request for proof of use of an earlier trade mark

A request for proof of use of an earlier trade mark during the 5 years preceding the date of the application for a declaration of invalidity may be submitted by the holder if the following cumulative conditions are complied with:

- the application is based on Article 27(1)(e) EUDR;
- the earlier distinctive sign is an earlier EU trade mark, a trade mark registered in a Member State or at the Benelux Office for Intellectual Property or an international registration with protection in the EU or in a Member State that, on the date of the application for a declaration of invalidity, has been registered for not less than 5 years;
- the request for proof of use is explicit and is submitted in a separate document (Article 6(3) EUDDR in combination with Article 19(2) EUTMDR). For more information on the admissibility of a request for proof of use, see the Guidelines for European Union trade marks, Part C, Opposition, Section 1, Opposition Proceedings, Chapter 5, Admissibility of the request for proof of use, paragraph 5.1.4 Request made in a separate document and paragraph 5.1.5 Applicant's option to deal with proof of use first.

4.1.2 Translation of the holder's observations

Where the language of proceedings is not the language of filing of the contested European Union design, the holder may submit its observations in the language of filing (Article 137(4) EUDR). The Office will arrange to have those observations translated into the language of proceedings, free of charge, and will communicate the translations to the applicant without delay.

4.1.3 Reply by the applicant

4.1.3.1 Generalities

Where the parties' submissions allow the Office to base its decision on the evidence before it, the Office will notify the parties that the adversarial part of the proceedings is closed.

However, the applicant will be allowed to reply to the holder's observations within a 2-month time limit (Article 74(2) EUDR; Article 6(2) EUDDR), in particular, under the following circumstances:

- where the holder's observations contain additional facts, evidence and arguments that are prima facie relevant for a decision on the merits; or
- where the holder requested proof of use of the earlier trade mark relied on under Article 27(1)(e) EUDR.

Any reply from the applicant will be communicated to the holder (Article 6(4) EUDDR). If the applicant's reply is considered admissible, the holder will be invited to submit a rejoinder (Article 74(2) EUDR).

Where the applicant does not reply within the specified time limit, the Office will notify the parties that the adversarial part of the proceedings is closed and that it will take a decision on the merits based on the evidence before it (Article 6(2) EUDDR).

The subject matter of the proceedings must be defined in the application (see paragraph 3.10). Reliance on additional earlier designs or rights is inadmissible when submitted at the belated procedural stage of the reply if the effect is to alter the subject matter of the proceedings (22/03/2019, R 1283/2018-3, Goggles (part of-), § 18; 05/02/2016, R 2407/2014-3, Kitchen utensils, § 21; 22/10/2009, R 690/2007-3, Chaff cutters, § 44 et seq.). The admissibility of additional facts, evidence and arguments relating to earlier designs or rights already referred to in the application is subject to the discretionary powers conferred on the Office under Article 80(2) EUDR (see paragraph 2.4).

Documents in support of the applicant's observations should be listed in a schedule of annexes (see the requirements provided in the Guidelines, Part A, General rules, Section 10 Evidence).

4.1.3.2 Translation of the applicant's reply

Any reply of the applicant must be in the language of proceedings. Where the applicant's reply is not in the language of proceedings, the applicant must submit, on its own motion, a translation of its reply within 1 month of the date of the submission of the original reply (Article 137(7) EUDR). The Office will not remind the applicant of its duty in this respect. Where the applicant submits the translation on time, it will be communicated to the holder. Where the applicant does not submit the translation on time, its reply will be deemed not to have been filed.

Any documents supporting the reply may be filed in any official language of the European Union. When they are not filed in the language of proceedings, the Office may, of its own motion or upon reasoned request by the other party, require the applicant to submit a translation of that evidence into the language of proceedings within a specified time limit (Article 15 EUDIR in conjunction with Article 24 EUTMIR).

4.1.3.3 Submission of evidence of use of an earlier trade mark

Under Article 74(3) EUDR in conjunction with Article 64(2) and (3) EUTMR, where the applicant is requested to submit evidence of use of its earlier trade mark, in regard to an invalidity action based on Article 27(1)(e) EUDR, it must submit such evidence (i) in connection with the goods or services in respect of which this trade mark is registered, and which the applicant cites as justification for its application and (ii) in respect of the period of 5 years preceding the date of the application for a declaration of invalidity (first relevant period), unless there are proper reasons for non-use. Such reasons for non-use must be substantiated.

Additionally, in cases where the earlier trade mark had been registered for not less than five years at the filing or priority date of the contested design, use of that mark must be established within the five years preceding the filing date or, where applicable, the priority date of the contested design (second relevant period). These two relevant periods do not necessarily overlap: they may totally or partially overlap, or follow on from each other (with or without a gap). In the event of an overlap in the periods, proof of use of the earlier mark relating to the overlapping period can be considered for each of the two relevant periods (by analogy 29/11/2018, C-340/17 P, ALCOLOCK, EU:C:2018:965, § 84).

Evidence of use of an earlier mark must fulfil **all** the cumulative conditions imposed by Article 10(3) EUTMDR, that is, indications concerning **the place, time, extent** and **nature** of use of the earlier trade mark for the goods and services for which it is registered and on which the application is based.

Where the language of the documents submitted by the applicant is not the language of the proceedings, the Office may, of its own motion or upon reasoned request of the other party, require that a translation be supplied in that language, within two months (Article 15 EUDIR in conjunction with Article 24 EUTMIR)..

In the absence of proof of genuine use of the earlier trade mark (unless there are proper reasons for non-use), or in the absence of a translation if so required by the Office, the application for a declaration of invalidity will be rejected to the extent that it was based on Article 27(1)(e) EUDR and this earlier mark.

When examining the evidence of use, the Office will apply the principles explained in the Guidelines, Part C, Opposition, Section 7, Proof of use.

4.1.4 End of exchange of observations

Where the parties' observations do not contain additional facts, evidence or arguments that are prima facie relevant for a decision on the merits, and additional observations are not necessary, the Office will inform both parties that the adversarial part of the proceedings are closed and that a decision will be taken on the basis of the evidence before it (Article 74(2) EUDR).

Facts, evidence or arguments submitted once the Office has already notified the parties that the adversarial part of the proceedings has been closed will be considered inadmissible, save in exceptional circumstances, for example, where the evidence was unavailable at an earlier stage or where a fact came to light in the course of the proceedings (Article 80(2) EUDR, see paragraph 2.4).

4.1.5 Extension of time limits and suspension

4.1.5.1 Extension of time limits

Requests by any of the parties for an extension of a time limit determined by the Office must be submitted before the original time limit expires (Article 21 EUDDR).

As a general rule, a first request for extension of a time limit will be considered appropriate and will be granted for a period equal to the original term (or less, if requested). However, any subsequent request for an extension of the same time limit will be refused, unless the party requesting it duly explains and justifies the exceptional circumstances that prevented it from meeting the original time limit and the first extension, and why a further extension is necessary. General or vague explanations will not justify a second extension. In particular, the Office may make the extension of a time limit subject to the agreement of the other party or parties to the proceedings (Article 21 EUDDR).

Reasons in support of any further request for extension must be submitted to the Office. The request for an extension of the time limit must indicate the reasons why the **party** affected by the time limit cannot meet the deadline. Circumstances that are within the control of the party concerned are not 'exceptional circumstances'. For example, last-minute discussions with the other party are not 'exceptional circumstances'. They are within the control of the parties.

Both parties are informed about any extension.

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

4.1.5.2 Suspension

The Office will suspend the proceedings on its own motion after hearing the parties, unless there are special grounds for continuing the proceedings, where it has been

brought to the attention of the Office that the validity of the contested European Union design is already in issue on account of a counterclaim before a competent national court, and the national court does not stay its proceedings (Article 130(2) EUDR).

The Office may also suspend the proceedings when it is appropriate, in particular in the circumstances listed here.

- Where the request for a declaration of invalidity is based on an earlier design or trade mark for which the registration process is pending, until a final decision is taken in those proceedings (Article 27(1)(d) and (e) EUDR).
- Where the request for a declaration of invalidity is based on an earlier design, trade mark or other earlier right, the validity of which is challenged in administrative or in court proceedings, until a final decision is taken in those proceedings (Article 27(1)(d) and (e) EUDR).
- Where the Office receives a joint request for suspension signed by both parties with a view to reaching an amicable settlement under Article 74 EUDR).
- Where a number of applications for a declaration of invalidity have been filed relating to the same European Union design, and where a preliminary examination reveals that the European Union design may be invalid on the basis of one of these applications. The Office will deal with this application first and may suspend the other invalidity proceedings (Article 8(2) EUDDR).

The Office has broad discretionary powers when deciding on the appropriateness of the suspension. The decision on the suspension must take into account the balance between the parties' respective interests, including the applicant's interest in obtaining a decision within a reasonable period of time (see, by analogy, 16/05/2011, T-145/08, Atlas, EU:T:2011:213, § 68-77).

The Office will notify the parties of its decision to grant or refuse a suspension, giving reasons and explaining which factors it considers when exercising its discretion. Where the Office decides not to grant the suspension, reasons may instead be given in the decision terminating the proceedings. Where a suspension is granted for a determined period, the Office will indicate in its communication the date of resumption of the proceedings. The proceedings will resume the day after the expiry of the suspension.

Where a suspension is granted for an undetermined period, the invalidity proceedings will be resumed when the parties inform the Office or when it has been brought to the attention of the Office that the event that justified the stay has occurred, or ceased to exist, as the case may be. The date of resumption will be indicated in the communication of the Office or, in the absence of such indication, on the day following the date of that communication.

Suspension requested by both parties:

According to Article 24(2) EUDDR, if **both parties request the suspension** of the proceedings, the suspension will be granted without any need for the request to be justified. The maximum duration of the suspension of the proceedings is limited to 2 years, as laid down in Article 24(2) EUDDR — a duration that is to be understood as 2 years cumulative over the course of the proceedings. Regardless of the period requested by the parties, the first suspension will be granted for a 6-month period. Any

party can bring the suspension to an end (‘opting out’). It is immaterial whether the other party disagrees with or has consented to it.

If one of the parties ‘opts out’, the suspension will end 2 weeks after the parties have been informed thereof. The proceedings will resume the day after.

Where a time limit was running at the time of the suspension, the party concerned will be granted the same period of time in full from the date of resumption of the proceedings. It is not possible to opt out during the last month of the suspended period, and any requests to do so will be rejected.

Upon a joint request by the parties, the suspension will be extended, without any need for the request to be justified. The extension of the suspension will be granted for a period of 18 months (or for the remaining period of up to 2 years), regardless of the period requested by the parties, but with the possibility of opting out. A joint request for suspension will be rejected as inadmissible if the parties have used up the total maximum of 2 years.

4.1.6 Taking of evidence

The parties may submit evidence in the form of documents and items of evidence, opinions by experts and witnesses, and/or statements in writing, sworn or affirmed or having a similar effect under the law of the state in which the statement is drawn up (Article 83(1) EUDR).

Where a party offers evidence in the form of witness statements or expert opinions, the Office will invite the party to provide the statement of the witness or the opinion of the expert in writing, except where a hearing is considered expedient (Article 83 EUDR; Article 11 EUDDR).

For more information, see the Guidelines, Part A, General Rules, Section 10, Evidence.

4.1.7 Oral proceedings

Oral proceedings may be held at the request of the Office or of any of the parties (Articles 79 and 81 EUDR; Article 11 EUDDR).

Where a party requests that they be held, the Office enjoys broad discretionary powers as to whether oral proceedings are really necessary. A hearing will not be held when the Office has before it all the information needed as a basis for the operative part of the decision on invalidity (13/05/2008, R 135/2007-3, Macchine da gioco automatiche, § 14).

The Office will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 4, Oral proceedings.

4.2 Examination

4.2.1 Commencement of examination

The Invalidity Division begins with the examination of the application as soon as the parties are informed that the adversarial part of the proceedings is closed and that no further observations can be submitted (Article 74 EUDR).

4.2.2 Examination of the grounds for invalidity

The grounds for declaring a European Union design invalid are listed exhaustively in Article 27 EUDR. An application for a declaration of invalidity based on a ground other than those listed in the EUDR (e.g. a claim that the holder was acting in bad faith when applying for the registered European Union design) will be rejected as inadmissible as far as the ground in question is concerned (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 30-31).

The selection and indication of a ground or grounds of invalidity in the application form is a valid declaration of the ground(s) on which the application is based.

The Office must, however, examine an application in the light of all grounds put forward in the reasoned statement, even if the corresponding boxes in the application form were not ticked. Therefore, where the applicant indicated in the reasoned statement that the contested European Union design was ‘not novel’, that indication constitutes a valid indication of grounds, even if this option was not selected in the online invalidity application form (02/08/2007, R 1456/2006-3, Saucepan handles, § 10).

The examination will not be extended to grounds not relied on in the application. Where an applicant exclusively invokes, for instance, either the novelty or the individual character of a European Union design as a ground for invalidity, the Office will only examine the ground invoked (14/03/2018, T-424/16, Footwear, EU:T:2018:136, § 47).

The applicant cannot raise new grounds for invalidity after the notification of the invalidity application to the design holder (10/02/2016, R 1885/2014-3, Logos, § 15-19).

According to Article 27(7) EUDR, a registered EU design may not be declared invalid where the applicant for or the holder of one of the rights referred to in Article 27(1)(d) to (f) EUDR expressly consented to the registration of the EU design before submitting the application for a declaration of invalidity. Under Article 27(8) EUDR, where the applicant for or a holder of one the rights referred to in Article 27(1)(d) to (f) EUDR has previously applied for a declaration that an EU design is invalid, they may not submit a new application for a declaration of invalidity on the basis of any of the other rights referred to in those points, which could have been invoked in support of the first application.

Where the application can be upheld on the basis of one of several grounds put forward by the applicant, the Invalidity Division will not take a decision on the others (15/12/2004, ICD No 321). Where an application can be upheld on account of the existence of one of the earlier designs or rights relied on by the applicant, the remaining earlier designs or rights will not be examined (14/06/2011, T-68/10, Watches, EU:T:2011:269).

Where the application cannot be upheld on the basis of one of the several grounds or one of the earlier designs or rights found to be admissible, the Office will examine the remaining grounds and rights or prior designs and reopen the admissibility where necessary (see paragraph 3.14, Admissibility in respect of one of the grounds or the earlier right or prior designs relied on).

For the examination of the substantive requirements concerning the validity of a priority claim in the course of invalidity proceedings, see the Guidelines, Examination of Applications for Registered European Union Designs, paragraph 6.2.1.1, Priority.

Irrespective of the ground or grounds for invalidity, the contested European Union design's validity should be assessed only based on the representation in the application, as published in the Register. This is because the protection conferred on a registered European Union design extends to all the features visibly shown in the application for registration, as published in the Register (Article 19 EUDR).

5 The Different Grounds for Invalidity

5.1 Not a design

According to Article 27(1)(a) EUDR, a European Union design may be declared invalid if the design does not correspond to the definition under Article 4(1) EUDR. This would be the case where the views of the European Union design are inconsistent and represent different products (other than forming a 'set of products' or an interior or exterior environment, which may also consist of different products, see Article 4 EUDR and the Guidelines, Examination of Applications for Registered European Union Designs, additional requirements regarding the reproduction of the design, paragraph 5.5.7, Sets of articles and paragraph 5.5.10, Spatial arrangement of items intended to form an interior or exterior environment). The assessment will be limited to checking whether the representation shows the appearance of a product or part of a product, that is to say, whether it presents a single, unitary product. By contrast, it cannot be invoked for deficiencies in the representation that go beyond verifying the unicity of the design, as such deficiencies must be corrected during the examination stage within the given time limit (19/02/2025, T-25/23, Bodenmarkierung, EU:T:2025:178, § 33 and 42).

Article 27(1)(a) EUDR can also be invoked where the graphical representation consists of a mere reproduction of a living organism (such as plants, fruits or animals) that is not a product within the meaning of Article 4(2) EUDR.

The assessment of this ground is based solely on those features of the appearance that are shown visibly in the application for registration, as it defines the subject and scope of protection (Article 19 EUDR). Statements made by the applicant or holder during the proceedings are generally only considered if they are reflected in the representation itself (19/02/2025, T-25/23, Bodenmarkierung, EU:T:2025:178, § 33-34).

5.1.1 Living organisms

An application for registration of a European Union design that shows the appearance of a living organism in its natural state has to be refused. Even if the shape at issue deviates from that of the common corresponding living organism, the design should be refused if nothing suggests prima facie that the shape is the result of a manual or industrial process (see, by analogy, 18/02/2013, R 595/2012-3, GROENTE EN FRUIT, § 11).

EUD No 1 943 283-0001	
	

A European Union design will not be declared invalid if it is apparent from the representation that the product does not relate to a living organism or if the indication of the product specifies that the product is artificial (see, in particular, Class 11-04 of the Locarno Classification).

5.1.2 Ideas and methods of use

The law relating to designs protects the appearance of the whole or a part of a product, but does not protect the underlying idea of a design (06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 72). Nor is the method of use or operation protected by a design (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 52).

5.2 Contrary to public policy or morality

According to Article 27(1)(b) EUDR, a European Union design may be declared invalid if it does not fulfil the requirements of Article 10 EUDR.

The Office will apply the concepts of public policy and morality as explained in the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal.

5.3 Lack of entitlement

According to Article 27(1)(c) EUDR, a European Union design may be declared invalid if, by virtue of a decision of the competent court or authority, the right holder is not entitled to the European Union design under Article 14 EUDR (see paragraph 3.5, *Locus standi* of the applicant, for the entitlement to claim this ground).

In the absence of such a decision, the Invalidity Division cannot declare the contested European Union design invalid under Article 27(1)(c) EUDR (11/02/2008, R 64/2007-3, Loudspeakers, § 15).

As an alternative to filing a request for a declaration of invalidity under Article 27(1)(c) EUDR, the person entitled to a European Union design under Article 14 EUDR may submit a request for a change of ownership to the Office. Such a request must be accompanied by the final decision of the competent court or authority of the Member State concerned on the entitlement to the European Union design as per Article 15(4) EUDR.

However, the entitlement proceedings are barred three years after the date of publication of a registered EU design, provided there was no bad faith on the part of the person who is not entitled to the registered EU design. (Article 15(3) EUDR, see the Guidelines, Part E, Register operations, Section 3, EUTMs and EUDs as objects of property, Chapter 2, Licences, rights *in rem*, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, 8.2 Entitlement proceedings for EUDs).

5.4 Component parts of complex products not visible during normal use

Features of a European Union design applied to, or incorporated in, a 'component part of a complex product' will be disregarded if they are not visible during normal use of the complex product in question (Article 5(2) EUDR and Recital 11 EUDR).

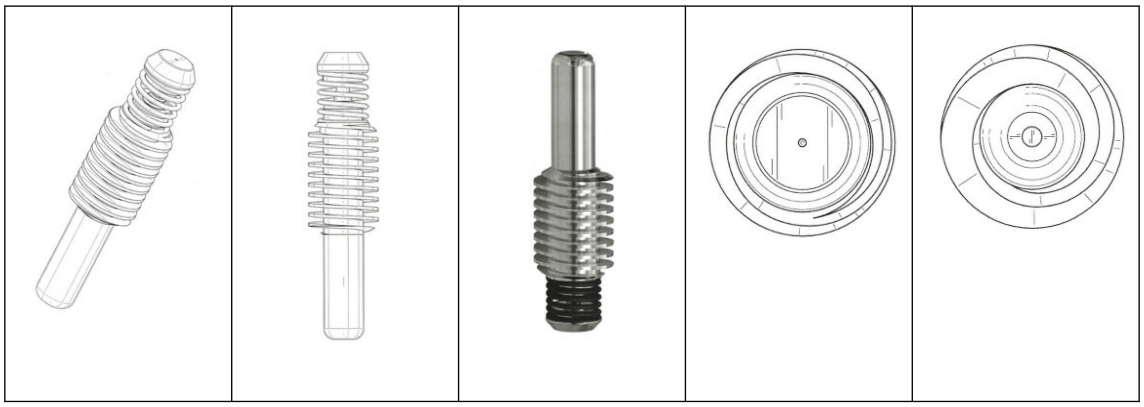
'**Complex product**' means a product that is composed of multiple components that can be replaced, permitting disassembly and reassembly of the product (Article 4(3) EUDR).

The saddle of a bicycle or motorcycle, for example, is a **component part** of a complex product within the meaning of Article 4(3)EUDR. The bicycle or motorcycle itself qualifies as a complex product; the saddle can be replaced through disassembly and reassembly, and without it, the complex product could not be subject to normal use (16/02/2023, C-472/21, Monz Handelsgesellschaft Internation, EU:C:2023:105, § 34).

By contrast, an electrode designed to be inserted into a welding torch cannot qualify as a **component part** according to Article 5(2) EUDR. This is due to its consumable nature, the fact that replacing it does not require disassembling and reassembling the torch, because the torch is regarded as complete even without the electrode and the

interchangeability of the electrode (22/03/2023, T-617/21, Welding torches (part of -), EU:T:2023:152, § 55-69).

Table 1: EUD No 1292122-0001 (5 of 7 views)



An assessment *in abstracto* of the visibility of the component part incorporated into a complex product, unconnected to any practical situation of use of the product, is not sufficient to allow a component part to benefit from protection as a design. Visibility of a component part of a complex product should be assessed from the perspective of the end user of that product, but also from the perspective of an external observer (16/02/2023, C-472/21, Monz Handelsgesellschaft International, EU:C:2023:105, § 45-46).

'**Normal use**' means use by the end user, excluding maintenance, servicing or repair work (Article 5(3) EUDR). 'Normal use' is the use made in accordance with the purpose for which the complex product is intended. It covers acts performed during the principal use of a complex product as well as acts that must customarily be carried out by the end user in connection with such use (which, depending of the product, may include its storage and transportation) (16/02/2023, C-472/21, Monz Handelsgesellschaft International, EU:C:2023:105, § 55-56).

Visibility during normal use must be a real possibility and not be based on unlikely scenarios. For example, for safety reasons, an electrical connector is normally enclosed by a casing to prevent contact with potential users during the operation of a complex product, such as a train or an electric vehicle, meaning that it is not normally visible. The argument that such a component could theoretically become visible if inserted in a transparent casing or cover is a purely hypothetical and random criterion that must be disregarded (03/08/2009, R 1052/2008-3, Electrical contactors, § 42-53).

Where none of the features of a European Union design applied to a component part (e.g. a heat exchanger insert) is visible during normal use of the complex product (e.g. a heat exchanger), the European Union design will be invalidated as a whole (20/01/2015, T-616/13, HEAT EXCHANGER INSERTS, EU:T:2015:30, § 14-16).

However, Article 5(2) EUDR does not require a component to be clearly visible in its entirety at every moment of use of the complex product. It is enough for the component

to be seen some of the time in a way that its essential features can be apprehended (16/02/2023, C-472/21, Monz Handelsgesellschaft International, EU:C:2023:105, § 45).

5.5 Technical function

Article 9(1) EUDR provides that 'a European Union design shall not subsist in features of appearance of a product which are solely dictated by its technical function'.

Those features of a design that are found solely dictated by the technical function are excluded from protection and not taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection (Recital 13 EUDR; 18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 23).

5.5.1 Rationale

The aim of Article 9(1) EUDR is to prevent technological innovation from being hampered by the granting of design protection to features dictated solely by a technical function of a product (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 29).

Article 9(1) EUDR, read together with Article 27(1)(b) EUDR, provide that an EUD is invalid **as a whole** if it is shown to consist exclusively of features of the appearance of a product that are solely dictated by its technical function, even if other designs fulfilling the same function exist (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32).

If **at least one** of the features of the appearance of the product covered by a contested design is not solely dictated by the technical function of that product, the design cannot be declared invalid under Article 9(1) EUDR (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 96).

Article 9(1) EUDR will also be ruled out if:

- the EUD holder establishes that considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have played a role in the choice of those features (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31) (though this does not mean that a design must have an aesthetic quality (recital 13 EUDR)); or
- the EUD holder establishes that the contested EU design concerns a design that serves to facilitate the multiple assembly or connection of mutually interchangeable products within a modular system (see paragraph 5.5.2.5).

5.5.2 Examination

Applying Article 9(1) EUDR requires a three-step analysis:

- determining the technical function of the product concerned;
- identifying the features of appearance of that product;

- examining, in the light of all the relevant objective circumstances, whether those features are solely dictated by the technical function of the product concerned and, if so, whether the EUD holder has established that other considerations have played a role in the choice of the features (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 98).

5.5.2.1 Determining the technical function and the features of appearance of the product

The first step of the examination of Article 9(1) EUDR consists of determining which is the relevant product function within the category of products at issue. The relevant category of products is identified by both the product indication (see Examination of applications for registered European Union designs, 6.1.5 Indication of products on page 46), and the representation of the design itself (see 5.7.2.2 Individual character on page 140, Individual character).

The second step consists of determining what the features of appearance are.

The features of appearance of the contested design are examined by the Office, taking into account the parties' submissions (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 105-108).

The function performed by the product in which the EUD is incorporated, as well as that of each of its features of appearance, will, in principle, not be examined *ex officio* by the Office and must be explained by the invalidity applicant (Article 80(1) EUDR; and paragraph 5.5.2.2, Burden of proof).

5.5.2.2 Appropriate evidence of functionality

Article 9(1) EUDR requires an **objective** assessment having regard, in particular, to the design at issue, the objective circumstances behind the reasons that dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs that fulfil the same technical function. The circumstances, data or information on the existence of alternative designs must, however, be supported by **reliable evidence**.

Burden of proof

The burden of proof lies with the invalidity applicant who must provide evidence that all the features of the contested design are solely dictated by the technical function of the product concerned (Article 80(1) EUDR; 21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 60).

Other intellectual property rights in respect of the product concerned

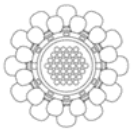
A design protected by a European Union design does not preclude protection by other forms of intellectual property including patents and utility models (Article 135 EUDR).

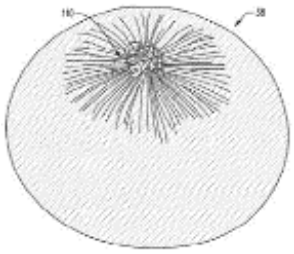
Patents and utility models relied on in invalidity actions based on Article 9(1) EUDR need not predate the contested EUD for them to be relevant. Invalidity actions based

on Article 9(1) EUDR differ in purpose from the ground under Articles 6 and 7 EUDR (novelty and individual character).

Patents or utility models may help to analyse the product incorporating the contested design and identify the elements that make up the product and contribute to its technical function to see if they correspond to the features of its appearance (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 96). However, the fact that the patent or utility model is granted or applied for a product with the same or similar appearance, cannot in itself, without further facts, evidence and arguments, establish that all features of the contested design are solely dictated by the technical function of the product (04/06/2025, T-1060/23, Masque de plongée, EU:T:2025:565, § 44 - 46; 18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 81; 19/10/2022, T-231/21, Posts, EU:T:2022:649, § 32).

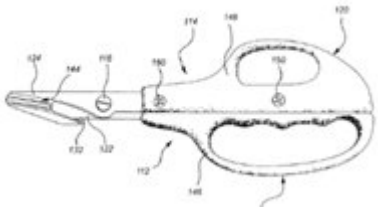
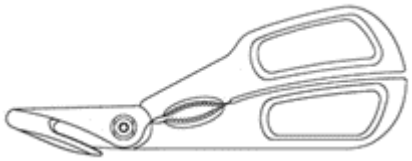
Here are examples of EUDs in which a patent or utility model containing an identical or quasi-identical representation to that of the EUD played a role in the assessment of the features of the product based on Article 9(1) EUDR:

 	 
Patent	Contested design 18/11/2020, T-574/19, Fluid distribution equipment

Utility model	Contested design 26/01/2022, T-325/20, Water purifiers

A patent or utility model containing a representation that is **different** to that of the contested EUD may still be relevant if the description or claims made in the document explain why the features that are the same shape as the contested EUD's might achieve the same function. However, this result is not automatic if the parties fail to submit arguments and evidence explaining how all the features of appearance of the contested EUD (including those that are not disclosed in the patent or utility model) are solely dictated by a technical function. This is illustrated by the following example:

	
Patent	Contested design 10/05/2021, R 440/2020-3, Handheld kitchen cutting appliances

The patent only proved the technical function of the blades pivotally connected and the blade edge curved like a hook, but not that of the rectangular curved shape of the finger rings or the handle shanks in the middle section of the scissors. Given that only part of the features of the contested design were proven to be dictated by the technical function of a pair of scissors within the meaning of Article 9(1) EUDR, the application for a declaration of invalidity was rejected.

The drawings in themselves cannot be evidence of technical function but must be read together with the claims and the description of the invention in order to:

- determine whether or not the design contains features that are visible in the drawings of the patent or utility model but whose function is not covered or is not explained by the claims or the description;
- assess whether or not the **appearance** of a given feature may be linked to a technical function (i.e. the shape/position of a specific feature being required to achieve the desired technical result).

Expert opinions and general information on the use of the product

Expert opinions or any information on the use of the product, in particular that of a technical nature, may serve to illustrate its functioning, including that of its individual features. This information may be contained in the description of the concrete product, promotional material, such as catalogues and brochures, or videos showing its use.

5.5.2.3 Examination

The Office will examine whether, in the light of the invalidity applicant's evidence and arguments, each feature of the contested EUD is proven to be dictated by the product's function.

The fact that the contested EUD may consist of different features, each of which has a **different function**, may not rule out the application of Article 9(1) EUDR. The interpretation of the term 'solely' in this provision does not require that the contested EUD's features must refer to a single technical result. The features may produce several technical results, as long as they contribute to achieving the technical results intended by the product (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 56).

Article 9(1) EUDR may apply to shapes where the graphical representation does not disclose **the entirety** of the elements that are necessary for the implementation of the technical solution, provided it is shown that this technical solution requires, for the product to operate properly, the essential characteristics that can be seen in the graphical representation.

To put it in simple terms, where a technical function of a product requires the interaction of three elements 'A', 'B' and 'C', Article 9(1) EUDR must apply to each of these individual elements if they are filed as an EUD on their own.

Interconnecting features may fall within both Articles 9(1) and 9(2) EUDR. Interconnecting features may be solely dictated by the technical function of the product (i.e. to allow it to be connected to and disconnected from another product), unless the EUD holder shows that the features of interconnection were designed in a way that visual considerations play a role (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 59-63).

If **at least one** of the features of appearance of the product covered by a contested EUD is not solely dictated by the technical function of that product, the contested EUD cannot be declared invalid under Article 9(1) EUDR (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 96). The EUD remains on the Register as a whole, that is, as a combination of arbitrary features and solely functional features. Such an EUD is liable to be invalidated on the ground of lack of individual character if the addition of the arbitrary features does not create a sufficiently far-removed impression compared to a prior design, which for this purpose can be disclosed in an earlier patent or utility model (see paragraph 5.7.2 Assessment of novelty and individual character, 'Features dictated by a technical function and features of interconnection').

5.5.2.4 Defence of the holder

Where each and every feature of the contested EUD is found to be solely dictated by a function because a causal link between its appearance and the function of the product exists according to the principles set out in paragraph 5.5.2.3 Examination, the Office

will assume that these features were chosen and combined exclusively for technical reasons.

It is for the EUD holder to submit counter arguments and evidence establishing that considerations of another nature, particularly those related to the product's visual aspect, have played a role in the choice of those features (Article 80(1) EUDR).

Multiplicity of shapes

The mere existence of alternative designs that fulfil the same technical function cannot, in itself, exclude the finding that all the features of appearance of a product are solely dictated by its technical function (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32, 37).

Nevertheless, the existence of alternative shapes may in some cases be a relevant indication that considerations other than the technical function of the product have played a role in the choice of features (19/10/22, T-231/21, posts, ECLI:EU:T:2022:649, § 45).

Aesthetic considerations

A design is not required to have an aesthetic quality (recital 13 EUDR; 08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 23, 31). However, if it can be established by the EUD holder that it has aesthetic quality, this may be considered a relevant factor.

It is for the EUD holder to explain that the choice of features was dictated by more than purely technical considerations and to prove how these features add to the visual aspect of the design (19/10/22, T-231/21, posts, ECLI:EU:T:2022:649, § 49-54).

Aesthetic considerations must be reflected in an objective manner and cannot be a matter of personal taste. General statements about the elegance or simplicity of the contested EUD that are not supported by objective evidence are likely to be inconclusive of other considerations that have played a role in the choice of the functional features (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543; 26/01/2022, T-325/20, Water purifiers, EU:T:2022:23, § 59-61).

The success of a product on the market does not imply as such that considerations unrelated to functional needs were considered by the designer. The same conclusion applies to awards where the criteria for their adjudication do not relate solely to the design of the products at issue (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 102).

5.5.2.5 Modular systems

Given the overlap between Articles 9(1) and 9(2) EUDR, Article 9(3) EUDR is an exception applying to both grounds of functionality and interconnection.

The Office must examine if the design may benefit from the derogation applicable to modular systems, including where the request for invalidity was not based on Article 9(2) EUDR, provided the EUD holder raised a defence based on Article 9(3) EUDR in due course (02/04/2025, T-220/24, Baumaterialien, EU:T:2025:349, § 73; 24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 69-80).

5.6 Designs of interconnections

Features of a design are excluded from protection if they must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against another product so that either product may perform its function. If Article 9(2) EUDR applies to **all the features** of the EUD, the latter must be declared invalid (20/11/2007, ICD No 2 970).

It is up to the invalidity applicant to prove that the EUD may be objected to on the basis of Article 9(2) EUDR. The applicant must substantiate the existence of the product whose form and dimensions dictate those of the contested EUD and submit facts, evidence and arguments demonstrating the interaction between the contested EUD and an existing product.

As an exception, Article 9(2) EUDR does not apply to an EUD that serves the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system (Article 9(3) EUDR). It is up to the holder to prove that the EUD serves such a purpose.

5.7 Lack of novelty and individual character

5.7.1 Disclosure of earlier design

5.7.1.1 General principles

Challenging the validity of a European Union design on account of its lack of novelty or individual character requires proof that the earlier design that is identical or that produces the same overall impression was made available to the public before the date of filing of the application for registration or, if a priority is claimed, before the date of priority (Article 8 EUDR).

Disclosure of the earlier design is a preliminary step before deciding whether it is identical to the contested European Union design or produces the same overall impression on the informed user (23/10/2018, T-672/17, Cot bumpers, EU:T:2018:707, § 30). Therefore, if it is not proven that the earlier design has been disclosed, the application for declaration of invalidity will be rejected insofar as it is based on Articles 6 and 7 EUDR.

Assessing disclosure of an earlier design requires a two-step analysis. Firstly, the invalidity applicant must prove the event of disclosure, that is, that the invoked earlier design was published following registration, or otherwise exhibited, used in trade or otherwise disclosed (see paragraph 5.7.1.2). Secondly, the holder of the contested European Union design can claim that that event of disclosure should not be taken into

consideration because either of the exceptions to disclosure provided in Article 8(1) EUDR apply (see paragraph 5.7.1.3) (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 48; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 24; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 20).

Therefore, the earlier design will be considered as having been disclosed when at least one event of its disclosure is established, and provided that none of the exceptions contained in Article 8(1) EUDR apply.

Nevertheless, a disclosure must not be taken into consideration if a design was made available to the public during the 'grace period' by the designer, his or her successor in title or a third person as a result of information provided or action taken by the former, or as a consequence of an abuse in relation to the designer or his or her successor in title as provided in Article 8(2) and (3) EUDR (see paragraph 5.7.1.4).

5.7.1.2 Establishing the event of disclosure

For the purpose of establishing the event of disclosure, the following aspects need to be considered.

- The source of the design's disclosure

In general, a design can be disclosed anywhere in the world (13/02/2014, C-479/12, "Athen" gazebo, EU:C:2014:75, § 33), including on the internet (see paragraph 5.7.1.5) and through various sources (e.g. by publishing in a catalogue, displaying in a trade fair, selling in an online store).

The event constituting the disclosure of the prior design does not need to occur within the territory of the European Union. Accordingly, the mere fact that a website may be intended for customers outside the Union is not sufficient to demonstrate that the specialised circles operating within the Union are unaware of such a disclosure (18/05/2022, T-256/21, Armchairs, EU:T:2022:297, § 35).

The evidence submitted must clearly identify the respective source of disclosure. It might also be important to submit any further information regarding that source, such as its purpose or targeted public (11/12/2019, R 311/2019-3, Hookahs, § 23).

- The design invoked

The invoked earlier design should be identified and reproduced precisely and in its entirety (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 65).

The Office is not required to determine through assumptions and deductions which designs among those represented in the evidence may be relevant in respect of the invalidity application. Moreover, the relevant features of the earlier design should be clearly displayed in the evidence (06/03/2024, T-647/22, Shoes, EU:T:2024:147, § 54). Where the views of the earlier design submitted do not enable its comparison with the contested EUD, this does not amount to a disclosure for the purpose of Article 8(1) EUDR (10/03/2008, R 586/2007-3, Barbecues, § 22 *et seq*.).

For the purpose of Article 8 EUDR, it is immaterial whether or not an earlier 'design' within the meaning of Article 4(1) EUDR enjoys or has enjoyed legal protection (as

a design, trade mark, copyright work, patent, utility model or otherwise) (21/05/2015, T-22/13 & T-23/13, Umbrellas, EU:T:2015:310, § 24).

- The date when the design was disclosed

When assessing disclosure of the earlier design, it is crucial to establish the date when it was made available to the public. That date must be prior to the date of filing of the contested EUD's application for registration or, if a priority is claimed, the date of priority.

The date of disclosure is when a product to which a design is applied, or in which it is incorporated, was made publicly available and not when the circles specialised in the sector concerned actually became aware of this disclosure.

It is enough for the disclosure to take place at a point in time that can be identified prior to the filing date or priority date of the contested EUD, even if the exact date of disclosure is unknown (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 34).

Neither the EUDR nor the EUDDR provides for any specific form of evidence required to establish the event of disclosure. Article 2(2)(a) EUDDR only states that the indication and evidence of disclosure of the prior design(s) must be submitted, nor are there any provisions as to any compulsory form of evidence that must be submitted. Article 83 EUDR lists possible means of giving evidence before the Office, but it is clear from its wording that the list is not exhaustive ('shall include the following'). Accordingly, the evidence in support of the event of disclosure is a matter for the discretion of the applicant and, in principle, any evidence capable of proving the event could be accepted (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 21; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 21).

The Office carries out an overall assessment of this evidence by considering all the relevant factors in the particular case. An event of disclosure cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design (09/03/2012, T-450/08, FLACONS, EU:T:2012:117, § 21-24; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 22).

A global examination of the items of evidence relating to the same earlier design implies that these items must be assessed in light of each other. Even if some items of evidence are not conclusive in themselves, they may contribute to establishing the event of disclosure when examined in combination with other items (09/03/2012, T-450/08, FLACONS, EU:T:2012:117, § 25, 30-45; 27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 24; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 52; 17/05/2018, T-760/16, Fahrradkörbe, EU:T:2018:277, § 42, 45 and 50; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 22).

Regarding 'statements in writing, sworn or affirmed', such as affidavits, they may not in themselves be sufficient to prove a fact, such as the event of disclosure of an earlier design. In particular, where they originate from the invalidity applicant itself or related persons, they should normally be corroborated by additional evidence. (18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 29). To assess

the evidential value of an affidavit, attention should be given first and foremost to the credibility of the account it contains. It is then necessary to consider, in particular, the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (09/03/2012, T-450/08, FLACONS, EU:T:2012:117, § 39-40). The Office will apply the principles explained in the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 5.3.2.3, Affidavits and Part A, General rules, Section 10, Evidence, paragraph 4.2 Affidavits.

In the absence of any indications to the contrary, the authenticity of the evidence submitted is assumed. The mere possibility of manipulating the relevant information is not enough to raise doubts as to its authenticity. Therefore, the evidence presented would only be rejected in cases of serious and substantiated doubt (27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 89-90; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 28-29).

Official publications

The publication of an earlier design in the bulletin of any intellectual property office worldwide constitutes an event of disclosure (21/05/2015, T-22/13 & T-23/13, Umbrellas, EU:T:2015:310, § 37). The same applies where the publication concerns the appearance of a product in relation to any other kind of intellectual property right, such as trade marks (16/12/2010, T-513/09, Ornamentación, EU:T:2010:541, § 20) or patents (15/10/2015, T-251/14, Doors (part of -), EU:T:2015:780, § 22).

However, a document kept by an intellectual property office that is available to the public only by means of an application for inspection of files may not be considered to have become known in the normal course of business to the specialised circles in the sector concerned. Therefore, it would not give rise to a disclosure of an earlier design within the meaning of Article 8 EUDR (22/03/2012, R 1482/2009-3, Insulation blocks, § 39-43; 15/04/2013, R 442/2011-3, Skirting boards, § 26).

To prove the event of disclosure, the evidence must allow the date of publication to be established independently of the date of filing or date of registration. Whether or not the publication takes place before registration or after is irrelevant (15/04/2013, R 442/2011-3, Skirting boards, § 24).

Moreover, the date of publication can be identified by the reference to the relevant INID code (internationally agreed numbers for the identification of (bibliographic) data).

Exhibitions

Exhibiting a design at a trade fair exhibition anywhere in the world generally constitutes an event of disclosure (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 67).

Evidence from trade fairs must clearly depict the earlier design. It is also important to link the evidence to the particular event. A list of participants, a plan of stands or even contractual details with organisers may contribute to proving the design's disclosure.

Use in trade

Use in trade is another example given in Article 8(1) EUDR of an event of disclosure, irrespective of whether such use is made within or outside the EU (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 68).

A design can be considered disclosed even when there is no proof that the products in which the earlier design is incorporated have actually been produced or put on the market (21/05/2015, T-22/13 & T-23/13, Umbrellas, EU:T:2015:310, § 36). It may be sufficient that the products were offered for sale in catalogues (22/10/2007, R 1401/2006-3, Ornamentation, § 25), imported from a country outside the EU (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32) or were the object of an act of purchase between two European operators (09/03/2012, T-450/08, FLACONS, EU:T:2012:117, § 30-45).

When submitting catalogues as evidence of disclosure, it is preferable that they be provided in their entirety. However, depending on the particular case, it may be sufficient to submit only excerpts from their relevant parts (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 35). Moreover, when combined or read in conjunction with other items of evidence, a catalogue can serve to establish disclosure even in the absence of evidence showing its distribution (03/07/2024, T-329/22, Bajantes para la recogida de aguas; canalones, EU:T:2024:438, § 31; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 30-33). For further information on evidence, see Part A, General rules, Section 10, Evidence.

5.7.1.3 Exceptions to disclosure

If the event of disclosure is duly established, there is a presumption that the earlier design has been disclosed within the meaning of Article 8(1) EUDR (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 47; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 23; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 41).

Nevertheless, the holder of the contested European Union design can refute this presumption by proving that any of the exceptions to disclosure provided in Article 8(1) EUDR apply in respect of the event of disclosure.

Designs deemed not to have been made available to the public

Following Article 8(1) EUDR, a design will be deemed to have been made available to the public except where the event of disclosure could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned operating within the EU.

Therefore, the party challenging the disclosure must establish to the requisite legal standard that the case's circumstances could reasonably prevent the event of disclosure from becoming known to those specialised circles (15/10/2015, T-251/14, Doors (parts of), EU:T:2015:780, § 26; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 26; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 47; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 23).

When there is more than one event of disclosure (e.g. a design has been presented in a trade fair and offered for sale in an online shop), the presumption would have to be rebutted in respect of them all.

The presumption set out in Article 8(1) EUDR applies irrespective of where an event of disclosure took place. It is therefore not limited to EU territory (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 27). The question whether events of disclosure outside the EU could reasonably have become known to persons forming part of those circles is a question of fact. The answer to that question must be assessed on the basis of the particular circumstances of each individual case (13/02/2014, C-479/12, "Athen" gazebo, EU:C:2014:75, § 34; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 55).

In the context of Article 8(1) EUDR, what matters is whether the 'circles specialised in the sector concerned' have had an opportunity to access the design regardless of how many of them actually seized this opportunity and might have encountered the disclosed design. Therefore, there is no quantitative threshold regarding actual knowledge of the disclosure events. (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 73).

It must be examined, on the basis of the facts to be adduced by the party challenging the disclosure, whether it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, while considering what might reasonably be required of those circles in terms of being aware of prior art. These facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as its interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the products concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can only become aware of it by chance (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 56).

The 'sector concerned', within the meaning of Article 8(1) EUDR, is not limited to that of the product in which the contested European Union design is intended to be incorporated or applied (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 103). Moreover, Article 8(1) EUDR does not lay down any restrictions as to the nature of the activity of the natural or legal persons who may be considered to form part of the 'sector concerned'. Consequently, apart from the persons involved in creating the designs and developing or manufacturing the products based on those designs within the sector concerned, traders may also form part of the 'specialised circles' within the meaning of Article 8(1) EUDR (see, by analogy, 13/02/2014, C-479/12, "Athen" gazebo, EU:C:2014:75, § 27).

Disclosure to a third person under explicit or implicit conditions of confidentiality

Making a European Union design available to a third person under explicit or implicit conditions of confidentiality will not be deemed to constitute its disclosure (Article 8(1) EUDR).

Therefore, disclosure of a design to a third party in the context of commercial negotiations is ineffective if the parties concerned agreed that the information exchanged should remain secret (20/06/2005, ICD No 172, § 22).

The burden of proving facts establishing confidentiality lies with the holder of the contested European Union design (08/07/2020, T-748/18, Pneumatic power tools, EU:T:2020:321, § 25).

5.7.1.4 Grace period

Article 8(2) EUDR provides for a 'grace period' of 12 months preceding the date of filing or the priority date of the contested European Union design. Disclosure of the European Union design within such a period will not be taken into consideration if it was made by the designer or its successor in title.

As a matter of principle, the holder must establish that it is either the creator of the design upon which the application is based or the successor in title to that creator, failing which Article 8(2) EUDR cannot apply (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 26-29). Through its observations, it is for the applicant to bring to the Office's attention the reasons why the explanations and evidence of the holder are not credible or consistent (12/03/2025, T-66/24, LED light bulbs, EU:T:2025:248 § 55)

Acts of disclosure made by a third person as a result of information provided or action taken by the designer or its successor in title are also covered by Article 8(2) EUDR. This can occur, for instance, where a third party has made public a design copied from the design for which protection is sought because that was previously disclosed within the grace period by the holder itself (02/05/2011, R 0658/2010-3, Leuchtvorrichtungen, § 37-39).

The exception provided in Article 8(2) EUDR may apply where the disclosed design is either identical to the contested European Union design within the meaning of Article 6 EUDR, or the disclosed design does not produce a different overall impression within the meaning of Article 7 EUDR.

The 'grace period' also applies where the disclosure of a design is the result of an abuse in relation to the designer or its successor in title (Article 8(3) EUDR). Whether the disclosure is the result of fraudulent or dishonest behaviour will be assessed on a case-by-case basis in the light of the facts, arguments and evidence submitted by the parties (25/07/2009, R 0552/2008-3, MP3 players and recorders, § 24-27).

5.7.1.5 Specificities of design disclosures on the internet

A growing number of design disclosures happen on the internet. For this reason, the Office and a number of Member State intellectual property offices have agreed on a Common Practice 'Criteria for Assessing Disclosure of Designs on the Internet (CP10)'.

The selected principles and recommendations set out in the Common Communication CP10 have been included in this section of the Guidelines, which can be consulted for further guidance.

The following sections deal with the specificities of design disclosure on the internet.

Sources of disclosure on the internet

The internet provides a number of possible sources for disclosure of a design.

Websites are among the most common sources of design disclosure on the internet, in particular those related to e-commerce and social media. Therefore, displaying a product on a website to which the design is applied or in which it is incorporated would generally constitute its disclosure.

Emails can also qualify as sources of design disclosure, in particular those that aim to promote products and are sent to a large number of recipients (27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 93).

Further, designs can be disclosed through mobile applications, file sharing, etc.

Establishing the relevant date of disclosure on the internet

The information available on websites that is relevant for disclosure (e.g. articles, videos, product reviews, sale offers) should show the date when it was published.

However, the relevant date may not be visible in the contents of a website. Instead, only the date that a printout is made would be displayed, and this is normally later than the date of filing of the application of the contested European Union design or its date of priority.

Nevertheless, various tools are available on the internet that can be used to retrieve historic information on a particular website, including the date of disclosure of a design. For instance, website archiving services (such as the 'WayBack Machine') can provide access to archived websites or parts thereof showing a design on a particular date in the past. The date when a website was archived would be considered the date of disclosure, unless an earlier relevant date appears in its contents.

When several dates are displayed in the evidence, the party concerned must clearly indicate which date is the relevant date of disclosure, that is, the date relied on to prove the event of disclosure.

In the case of emails, the date when they have actually been sent would normally be displayed in their details and would thus appear in a printout.

Means for presenting the evidence obtained on the internet

Disclosure of a design on the internet can be established by submitting various types of evidence, such as printouts, screenshots, images, videos and metadata.

Merely providing a link to content on the internet (e.g. the URL address of a website) is not sufficient. The Office will not perform a search for that content. Moreover, the content may have been altered or removed. Links can be considered only when supplemented with additional evidence, such as a printout or screenshot of the

relevant information contained therein (24/01/2024, T-537/22, Building blocks from a toy building set, EU:T:2024:22, § 91).

Printouts from websites, or their screenshots, are the most common means of proving the disclosure of designs on the internet, in particular, on e-commerce platforms, private company websites, social media and online databases.

For the purpose of proving disclosure, a printout or screenshot should show:

- the URL address of the website;
- the date when the design was published; and
- the disclosed design.

Moreover, information regarding the purpose and main characteristics of the website could be relevant for assessing whether the design has been made available to the public.

When a printout or a screenshot does not include all the relevant elements, missing information may be shown by providing additional evidence (27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 61-63).

Moreover, user comments left on e-commerce platforms or in social media might also be relevant when assessing disclosure.

When submitting a printout of an email that contains the representation of a design as an attachment, the link between the printout of that email and the printout of the attachment should be proven.

Printouts and screenshots should not be modified manually, as this might have an effect on the credibility of this evidence (27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 90).

Additionally, a design might be disclosed by the publishing of photos and videos on the internet that show a product to which the design is applied or in which it is incorporated.

Photos should be complemented with the information regarding the source of disclosure and the relevant date.

In the case of videos, the disclosure of a design should preferably be proved by submitting one or several screenshots displaying the exact times that the design appears in the video.

Finally, when photos and videos are submitted as evidence, metadata extracted from digital cameras could be obtained to prove the date and location that the photo or video was taken.

The mere abstract possibility that the content or date of a website may be manipulated is not a sufficient ground to undermine the credibility of evidence constituted by a screenshot of that website. That credibility may only be undermined by invoking facts that concretely suggest a manipulation, such as clear indications of falsifications, indisputable contradictions in the information provided or obvious inconsistencies that may reasonably justify doubts about the authenticity of the screenshots of the website in question (15/03/2023, T-89/22, Chairs, EU:T:2023:132, § 40; 20/10/2021, T-823/19, Bobby pins, EU:T:2021:718, § 49).

Exceptions to the availability to the public

Taking the global nature of the internet into account, in general, online content is available worldwide.

However, due to some restrictions, in particular as to the accessibility or searchability of the information on the internet, it might be considered that an event of disclosure of a design online could not reasonably have become known to the circles specialised in the sector concerned operating within the European Union.

For instance, when assessing an event of disclosure related to the publication of a design on a website, it might be necessary to assess whether that website was technically accessible and the relevant circles were actually able to find the prior art on the internet (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 61).

Unless the content is subject to restricted access in certain internal databases (e.g. used only by employees of a company), as a general rule, neither password nor payment requirements would be considered as precluding accessibility to the information published on the internet. For further information on online evidence, see Part A, General rules, Section 10, Evidence, paragraph 4.1 Online evidence.

5.7.2 Assessment of novelty and individual character

A design will be protected as an EUD to the extent that it is new and has individual character (Article 5(1), Articles 6 and 7 EUDR). The novelty and individual character of an EUD must be examined on its date of filing or, as the case may be, on its date of priority, in the light of the relevant earlier designs, which have been made available to the public pursuant to Article 8 EUDR.

The EUD must be compared individually with each and every earlier design relied on by the applicant. Novelty and individual character of an EUD cannot be defeated by combining features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 69; 19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 23-35; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 23-24).

A combination of already disclosed features is therefore eligible for protection as an EUD, provided the combination, as a whole, is novel and has individual character.

In principle, subject to a number of exceptions detailed below, all the features visible both in the representation of the contested design and in the earlier design, as disclosed, must be taken into consideration when examining novelty and individual character.

Nevertheless, in some circumstances, it remains possible to carry out a comparison on the basis of features of a design, which may be deduced from the compared design's representations themselves (29/04/2020, T-73/19, Wood splitting tools, EU:T:2020:157, § 41). This can be the case where the compared designs represent products in different positions or stages of use or in different perspectives.

Point of reference for the comparison

The contested EUD is the point of reference when assessing novelty and individual character in the comparison with the earlier design (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 87).

Consequently, if the contested EUD is represented in only certain aspect views, for instance the front view, a comparison is only made with the corresponding part of the earlier design. Any additional features disclosed by the earlier design, such as those in its rear view, are disregarded.

The same principle applies when the contested EUD shows **fewer features** than the earlier design, such as, for example, when the contested EUD consists of the appearance of only part of a product whereas the earlier design discloses the whole product, or where the contested design is represented in black and white whereas the earlier design is represented in colour.

However, save for the exceptions outlined below, when the contested EUD shows **more features** than the earlier design, all of its features will be taken into account for the assessment of novelty and individual character. This can happen, for instance, where the contested EUD includes colours, visible effects produced by textures or any other aspects of appearance that are not visible in the earlier design. In the assessment of the individual character, the relative importance given to such features is weighed in the context of the global assessment of the overall impression left by the compared designs (see paragraph 5.7.2.2, subheading 'The overall impression').

Features dictated by a technical function and features of interconnection

Features that are solely dictated by a technical function and features that must necessarily be reproduced in their exact form and dimensions in order to allow interconnection with another product cannot contribute to the novelty and individual character of an EUD. A party alleging that individual features of the contested design are solely dictated by a technical function or by interconnecting purposes must submit facts, evidence and arguments in support of its claim (Article 9 EUDR, see paragraph 5.5.1).

However, when features of a product serve a functional purpose without being solely dictated by the technical function within the meaning of Article 9 EUDR, they may be relevant if it is established that they could be designed differently (10/11/2021, T-443/20, Labels, EU:T:2021:767, § 95; 22/09/2021, T-503/20, Signalling apparatus and devices, EU:T:2021:613, § 75-77). For instance, a button operating the functions on an electronic wristband can be placed on the product in different ways and can have different shapes and sizes (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61). Any limitation to the freedom of the designer and effect on the assessment of the individual character of the contested design will be weighed in the context of the global assessment of the overall impression (see paragraph 5.7.2.2 'The overall impression').

Features of component parts that are not visible during normal use

Where the features of a contested EUD applied to a component part are only partially visible during normal use of the complex product, the comparison with the relevant earlier designs invoked must be limited to the visible parts (Article 4(2), see paragraph 5.4).

Clearly discernible features

Features of an EUD that are not clearly discernible in its graphical representation cannot contribute to its novelty or its individual character (Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, recital 11). Likewise, features of the earlier design that are not of sufficient quality to allow all the details to be discerned in the portrayal of the earlier design cannot be taken in consideration for the purpose of Articles 6 and 7 EUDR (10/03/2008, R 586/2007-3, Barbecues, § 23-26).

Features of an earlier design can be supplemented by additional features that were made available to the public in different ways, for instance, first, by the publication of a registration and, second, by the presentation to the public of a product incorporating the registered design in catalogues. However, these representations must relate to one and the same earlier design (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 25-30).

Disclaimed features

Features of a contested EUD that are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a contested EUD represented with broken lines, blurring, colour shading or boundaries or in any other manner making clear that protection is not sought in respect of such features (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 59-64).

For further guidance, see paragraph 5.6 (Use of visual disclaimers to exclude features from protection) in the Guidelines regarding Examination of applications for registered European Union designs or consult the text of the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6).

In contrast, disclaimed features of an earlier registered design can be taken into account when assessing the novelty and individual character of a contested EUD under Article 27(1)(b) EUDR because the earlier design is considered as a disclosure irrespective of the subject matter of protection as an EUD, and thus includes even the disclaimed features (08/05/2024, T-758/22, Shoes, EU:T:2024:292, § 47-48, 57).

5.7.2.1 Novelty

A European Union design will be considered to be new if it is not predated by an identical design disclosed pursuant to Article 8 EUDR. Designs will be deemed to be identical if their features differ only in immaterial details (Article 6(2) EUDR).

An earlier design incorporated in or applied to a product that is different from the one to which the later design relates is, in principle, relevant for the purposes of assessing novelty (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 104; 15/01/2020, R 2512/2018-3, Stickers, § 25).

There is identity between the European Union design and an earlier design where the latter discloses each and every element constituting the former. A European Union design cannot be new if it is included in a more complex earlier design (25/10/2011, R 978/2010-3, PART OF SANITARY NAPKIN, § 20-21; 18/03/2020, R 751/2019-3, Cube games, § 26).

However, the additional or differentiating features of the European Union design may be relevant for deciding whether it is new, unless these elements are so insignificant that they may pass unnoticed.

An example of an immaterial detail is a slight variation in the shade of the colour pattern of the compared designs (28/07/2009, R 921/2008-3, NAIL FILES, § 25; 20/01/2020, R 2300/2018-3, Graphic symbols and logos, surface patterns, ornamentation, § 28-32).

Another illustration is the display, in one of the two compared designs, of a label that is so small in size that it is not perceived as a relevant feature (08/11/2006, R 216/2005-3, Coffee pot, § 23-26), as in the following example.

Contested EUD No 5 269-0001 (view No 2)	**Earlier design (invented example)**
	

5.7.2.2 Individual character

A design will be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design that has been made available to the public before the filing date of the application for registration or, if a priority is claimed, the date of priority (Article 7(1) EUDR).

In assessing individual character, the designer's degree of freedom in developing the design will be considered (Article 7(2) EUDR). It is apparent from these provisions that the assessment of the individual character of a registered European Union design is the result, in essence, of a four-stage examination. This examination consists of **firstly** deciding on the sector that the products in which the design is intended to be incorporated or to which it is intended to be applied belong; **secondly**, the informed user of those products in accordance with their purpose and, with reference to that

informed user, the degree of awareness of the prior art and the level of attention in the comparison (direct if possible) of the designs; **thirdly**, the designer's degree of freedom in developing their design; and **fourthly**, the outcome of the comparison of the designs at issue, considering the sector in question, the designer's degree of freedom and the overall impressions produced on the informed user by the contested design and by any earlier design that has been made available to the public (10/09/2015, T-525/13, Sacs à main, EU:T:2015:617, § 32; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 66).

The determination of the sector concerned, the informed user and the designer's degree of freedom, must be carried out only in relation to the contested design (10/11/2021, T-193/20, Panels, EU:T:2021:782, § 24).

The products at issue

When defining the product category concerned by the contested design, the relevant product indication in the registration of that design is considered as well as, where necessary, the representation of the contested design itself, insofar as it clarifies the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56).

The claim that the relevant products or the 'sector concerned' is limited to a narrow segment of product for the use of particularly attentive users is unfounded when unsupported by the representation of the contested design (10/11/2021, T-193/20, Panels, EU:T:2021:782, § 43).

In the majority of the cases, the product indication matches the representation of the design.

However, there are situations where the product category must be better defined by considering the design itself. For instance, the contested design may be incorporated in a product that forms a self-contained category of homogeneous products within the more general indication of products (15/10/2020, T-818/19, Support pillows, EU:T:2020:486, § 31; 10/11/2021, T-193/20, Panels, EU:T:2021:782, § 37-40). In other cases, the product indication may be broader than the product shown in the representation (18/05/2022, T-256/21, Armchairs, EU:T:2022:297).

Any time there is a discrepancy between the product indication and the representation, the representation of the design prevails (08/03/2017, R 2113/2015-3, Spülungen für W.C. (Wasser-), § 14).

The products actually marketed in which the designs at issue are incorporated can be considered only for illustrative purposes to determine the visual aspects of those designs. However, this consideration is only permitted on condition that the products actually marketed correspond to the contested design as registered. Therefore, a product that is actually marketed cannot be considered if the design incorporated in that product differs from the design as registered, or if it displays features that are not clearly apparent from the graphic representation of that design, as registered (10/11/2021, T-193/20, Panels, EU:T:2021:782, § 33).

The informed user

The informed user is to be defined in relation to the relevant product in which the contested design is incorporated or to which it is applied (10/11/2021, T-193/20, Panels, EU:T:2021:782, § 24).

The concept of 'informed user' refers to a fictitious person who routinely uses the categories of products in which the contested design is incorporated (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 125-126).

However, according to recital 12 EUDR and the case-law, the informed user is aware of the existing design corpus, that is, any relevant design forming the state of the art. Therefore, their knowledge is not limited to the sector related to the contested design. Furthermore, no actual knowledge of prior designs pertaining to products from different sectors has to be proved (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 121-134).

The status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 46; 09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 24; 06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 58).

The 'informed user' concept lies somewhere between that of the average consumer applicable in trade mark matters, who may not have any specific knowledge, and the sectorial expert, who has detailed technical expertise. Without being a designer or a technical expert (and therefore without necessarily knowing which aspects of the product concerned are dictated by technical function, as found in 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 48), the informed user is aware of the various designs that exist in the sector concerned and possesses a certain degree of knowledge of the features that those designs normally include (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 53, 59; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 47; 06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 59).

Therefore, the informed user is neither a designer nor a technical expert. However, despite not necessarily knowing which aspects of a product are dictated by a technical function, they do have some awareness of the existing designs in the sector concerned.

The informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 25-27).

However, depending on the nature of the product in which the registered European Union design is incorporated (e.g. promotional items), the 'informed user' concept may include a professional who acquires such products to distribute them to the final users, or the final users themselves (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 54). The fact that one of these two types of informed user perceives the designs at issue as producing the same overall impression is sufficient for a finding that the contested design lacks individual character (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 56).

As a result of their interest in the products concerned, the informed user, as a rule, shows a relatively high degree of attention when using them (24/10/2019, T-559/18, Medizinische Pflaster, EU:T:2019:758 § 50). Unlike the average consumer in the field of trade marks for whom the fact of being faced, for instance, with a fashion accessory may affect their level of attention, this fact is irrelevant when determining the level of attention of the informed user (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 50). Likewise, the mere fact of being frequently faced with a particular design does not make the informed user more or less attentive, as the user's level of attention is already, by its very nature, high (29/04/2020, T-73/19, Wood splitting tools, EU:T:2020:157, § 75).

When the nature of the product in which the compared designs are incorporated makes it possible, the overall impression made by these designs will be assessed on the assumption that the informed user can make a direct comparison between them (18/10/2012, C-101/11 P & C-102/11 P, Ornamentación, EU:C:2012:641, § 54-55).

The degree of freedom of the designer

The designer's degree of freedom depends on the nature and intended purpose of the product in which the contested design will be incorporated, as well as on the industrial sector to which the product belongs (see above).

The designer's degree of freedom in developing the design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. These constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 44).

In contrast, the designer's degree of freedom was not considered to be restricted in a number of cases (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 79), in particular when the shape of the product into which the design is incorporated may vary considerably (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 36-39) and for instance come in any combination of colours, patterns, shapes and materials (05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 45-47). This may also be the case where the constraints of a functional nature concerning the presence of certain essential features are not liable to affect to a significant extent the form or overall appearance of the product, since they may take various forms and be arranged in various ways (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 79; 04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61).

Furthermore, the designer's degree of freedom is not affected by the fact that similar designs coexist on the market and form a 'general trend' or coexist on the registers of industrial property offices (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 58; 01/06/2012, R 89/2011-3, Sacacorchos, § 27; 06/06/2019, T-209/18, Kraftfahrzeuge / Kraftfahrzeuge, EU:T:2019:377, § 59).

As a way of example, the General Court found that the designer's degree of freedom in developing dolls' heads is wide and that freedom is restricted only in so far as those

heads must follow the basic charateristics of a human being. However, this freedom is not restricted by market preferences as regards the appearance of 'fashion dolls' (01/12/2021, T-84/21, Doll's heads, EU:T:2021:844, § 39-41).

Contested EUD	**Prior design**
 Figure 2:	 Figure 3:

The greater the designer's freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on an informed user. Conversely, the more the designer's freedom in developing the registered European Union design is restricted, the more likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67, 72). Therefore, if the designer enjoys a high degree of freedom in developing a design, this reinforces the conclusion that the designs that do not have significant differences make the same overall impression on an informed user (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 33).

The degree of the designer's freedom is a mitigating factor which makes it possible to reinforce or, *a contrario,* moderate the conclusion as regards the overall impression produced by each design at issue (06/06/2019, T-209/18, Kraftfahrzeuge / Kraftfahrzeuge, EU:T:2019:377, § 48).

Furthermore, the designer's degree of freedom may vary as regards the different features of a design, and this must be taken into account when assessing to what extent individual features contribute to the design's overall impression.

Saturation of the state of the art

Saturation of the state of the art, while not to be considered as limiting the freedom of the designer, may be such as to render the user more sensitive to differences in detail of the conflicting designs. Therefore, a design, because of a saturation of the state of the art, may have individual character because of features which, in the absence of

such saturation, would not be likely to create a difference in overall impression on the informed user (15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:259, § 67).

Saturation of the state of the art cannot be assumed but must be demonstrated by the holder with sufficient evidence, such as catalogues and documentary evidence of goods offered by a large number of competing undertakings, statements from sector experts, statements from producers and consumer associations, catalogues and price lists of larger distributors operating in the relevant sector and, finally, in surveys and sector studies carried out by third parties (10/10/2024, R 1272/2013-3, RADIATORI PER RISCALDAMENTO, § 47).

As an example, the GC found that the coexistence of a dozen of models of radiators produced by companies is not sufficient to demonstrate saturation of the state of the art (15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:259, § 105).

The overall impression

Under Article 7(1)(b) EUDR, a registered European Union design is to be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any earlier design. In assessing individual character, the degree of freedom of the designer in developing the design is to be considered (Article 7(2) EUDR).

Unless the designs compared include functional or disclaimed features, or features that are not visible during normal use (see paragraph 5.7.2), both designs must be compared globally. That does not mean, however, that the same weight should be given to all the features of the designs compared.

Firstly, the informed user uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended. The relative weight to give to the features of the designs compared may therefore depend on how that product is used. In particular, the role played by some features may be less important depending on their reduced visibility when the product is in use (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 64-66, 72; 21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 45-46; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 97).

Secondly, when appraising the overall impression conveyed by two designs, the informed user will only give minor importance to features that are totally banal and common to the type of product in question and will concentrate on features that are arbitrary or different from the norm (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 77; 28/11/2006, R 1310/2005-3, galletas, § 13; 30/07/2009, R 1734/2008-3, FORCHETTE, § 26 et seq.).

Thirdly, similarities relating to common features that are present in the design for functional or standardising purposes will have only minor importance in the overall impression produced by those designs on the informed user. Additionally, the more the designer's freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a

different overall impression on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 72).

Fourthly, the assessment of individual character (Article 7 EUDR) follows a different logic from the exclusion of protection based on functionality or interconnection (under Article 9 EUDR):

- The fact that the **earlier design is partly or entirely dictated by technical function or composed of interconnecting features** is not decisive because Article 7 EUDR does not require the comparison to be made with an earlier valid design.

Where the **contested design** differs from or coincides with a prior design in **individual features**, that are **solely dictated by technical function or composed of interconnecting features**, the overall impression may still differ depending on the presence of other arbitrary features or the arrangement of those functional features or interconnecting elements.

When the contested design includes one or more features that are, to some extent, technical or serve interconnecting purposes, this impacts the comparison in two respects:

- Greater importance will in principle be given to other features whereby the designer made use of their freedom when developing the design, provided such features are likely to catch the informed user's attention on account of, for example, their size or position.
- The shape, configuration and placement of the functional or interconnecting features may also be considered (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61) to the extent that the designer has some freedom in combining these elements. This degree of freedom can be demonstrated for example by the existence of alternative shapes fulfilling the same function (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 36).

Examples:

Same overall impression (Contested design declared invalid)

According to the GC, the differences between the contested design and the prior design, such as the presence of an additional central stripe of dark filling, minor variations in the length, proportion or colour intensity, are not significant enough to create a different overall impression. The degree of freedom of the designer in the relevant sector is considered average, meaning that only clear and notable differences would affect the overall impression. The informed user, who is familiar with the range of snack products on the market and aware that such items often vary in size, shape, and filling, would not focus on the marginal differences but rather on the general appearance and structure of the product. The rectangular shape, the combination of two dark outer layers and a white filling and the overall configuration of the designs lead to a strong impression of similarity. The central dark stripe in the contested design would likely be perceived not as a significant difference but simply as a flavour variation, especially since it does not alter the external form of the product (10/05/2019, T-517/18, Backwaren, EU:T:2019:323, § 42-50).

Contested design	Prior design
 Figure 4:	 Figure 5:

Different overall impression

According to the GC, there are several significant differences between the contested design and the prior invoked designs, such as the shape and size of the roof and door, the presence of a canopy and ventilation openings, differences in wall coverings and colours, as well as differing pictograms. These differences alter the appearance of the public toilet units and are not dictated by regulatory requirements. In fact, while public toilets must comply with certain technical, health and safety standards, these requirements primarily concern the interior, which is not protected by the contested EU design. The designer has a relatively high degree of freedom regarding external features, such as the side panels, roof shape, and depiction of toilet symbols. Furthermore, the contested design includes some elements that are not visible in the earlier designs, such as a large city map panel or a bumper at the bottom of the structure. Taken together, the differences between the two designs are sufficiently pronounced to confer individual character to the contested design (26/03/2025, T-608/23, Public toilets; Outdoor toilet, EU:T:2025:333, § 76, 81).

Contested design	Prior design*









*Only one of the prior designs has been provided for illustrative purposes.

5.8 Conflict with a prior design right

Rationale

Under Article 27(1)(d) EUDR, an EU design may be invalidated upon application by the holder of a prior design that was registered in the EU and made available to the public, regardless of whether this occurred before or after the contested design's filing date (including any priority claim).

The protected design under Article 27(1)(d) EUDR must be one of the following:

1. a registered European Union design or an application for such a design subject to its registration (Article 13 EUDR); or
2. a registered design right of a Member State or an application for such a right subject to its registration (Article 10 DD); or
3. a design right registered under the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999, hereinafter referred to as 'the Geneva Act', which was approved by Council Decision 2006/954/EC and which has effect in the European Union (Article 14 Geneva Act), or an application for such a right subject to its registration.

When the application for invalidity is based on an earlier design application, a decision can only be taken once the design is registered. This means that the invalidity proceedings are suspended until the registration procedure is completed.

Notion of 'conflict'

Under Article 27(1)(d) EUDR, an EU design is in conflict with a protected design when, taking into consideration the designer's freedom in developing the EU design, that design does not produce a different overall impression on the informed user from that produced by the protected design relied upon (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 52; 21/04/2021, T-326/20; Beverage bottles, EU:T:2021:208, § 31).

Article 27(1)(d) EUDR is a relative ground for invalidity, the purpose of which is to determine whether the contested EU design falls within the scope of protection of another protected design. This means that the point of reference in the comparison under Article 27(1)(d) EUDR is the **earlier design**, and not the contested design as in Article 27(1)(b) EUDR. Therefore, in contrast to the novelty/individual character test under Article 27(1)(b) EUDR, only the features that form part of the earlier design right are considered in the assessment under Article 27(1)(d) EUDR. This means that disclaimed features of the earlier design, if there are any, are disregarded (compare with paragraph 5.7.2 under the subheading 'Disclaimed features').

Relevance of priority claims

'The right of priority shall have the effect that the date of priority shall count as the date of the filing of the application for a registered EU design for the purpose of Article […] 25(1)(d) […]' (see Article 52 EUDR).

This principle applies irrespective of whether the EU design is the contested design or an earlier design relied on under Article 27(1)(d) EUDR. This gives equal treatment to all designs (EU, national or international) and comports with Article 4(B) of the Paris Convention which recognises that the protection conferred against acts of exploitation that started between the priority date and the date of filing of a right can never give rise to third–party rights or rights of personal possession.

In conflicts under Article 27(1)(d) EUDR, therefore, the earlier date (filing or priority) determines which right takes precedence (see by analogy Article 36 EUTMR) and a design claiming priority is 'protected' within the meaning of Article 27(1)(d) EUDR, subject to registration, from its date of priority.

The validity of a priority claim will be assessed ex officio only when it becomes relevant to determining which right takes precedence. The assessment will be based on the priority documents submitted by the parties (see paragraph 3.10.3).

For the substantive requirements of a design priority claim see Guidelines for Examination of applications for registered European Union designs, 6.2.1 Priority and exhibition priority. They apply *mutatis mutandis* for prior and contested designs.

Continued existence

A prior design relied upon under Article 27(1)(d) EUDR must remain in force on the date on which the Office takes a decision on invalidity.

When an earlier national or international design with effect in the EU on which the invalidity is based expires before the Office takes a decision on the matter, a communication is issued to the invalidity applicant in which it is invited to submit evidence of renewal. This is then communicated to the holder (see, by analogy, 05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 68 et seq.).

Otherwise, the Office will assume that the prior design remains valid unless the holder submits proof that a decision that has become final declared the prior design invalid before the adoption of the decision (see, by analogy, 29/03/2011, **C-96/09 P**, Bud, EU:C:2011:189, § 94-95) (see paragraph 4.1.5.2).

According to Article 27(7) EUDR, a registered EU design may not be declared invalid where the applicant for or the holder of one of the rights referred to in Article 27(1)(d) to (f) EUDR consented expressly to the registration of the EU design before submitting the application for a declaration of invalidity. Under Article 27(8) EUDR, where the applicant for or a holder of one the rights referred to in Article 27(1)(d) to (f) EUDR has previously applied for a declaration that an EU design is invalid, they may not submit a new application for a declaration of invalidity on the basis of any of the other rights referred to in those points, which could have been invoked in support of the first application.

5.9 Use of an earlier distinctive sign

A European Union design will be declared invalid if a distinctive sign is used in a subsequent design, and the law of the European Union or the law of the Member State governing that sign confers on the holder of the sign the right to prohibit such use (Article 27(1)(e) EUDR).

5.9.1 Distinctive sign and right to prohibit use

The notion of a ‘distinctive sign’ encompasses registered trade marks as well as all signs that can be relied on in the context of Article 8(4) and 8(6) EUTMR.

In accordance with the practice under Article 8(4) and 8(6) EUTMR, the applicant may also rely on provisions of national law on the prohibition of a later registration.

The applicant must establish only that it has a right to prohibit use of the subsequent European Union design. It cannot be required to establish that such right has been exercised; in other words, that the applicant has actually been able to prohibit such use (see, by analogy, 29/03/2011, C-96/09 P, BUD/BUD, EU:C:2011:189, § 191).

Where the earlier distinctive sign is a sign that can be relied on in the context of Article 8(4) and 8(6) EUTMR, the Office will apply the corresponding law as explained in the Guidelines, Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR) and Part C, Opposition, Section 6, Geographical indications (Article 8(6) EUTMR).

5.9.2 Substantiation of the application under Article 27(1)(e) EUDR (earlier distinctive signs)

Where an application for invalidity is based on a right held in an earlier European Union trade mark or an international trade mark designating the EU, it is not necessary to submit the law and case-law relating to European Union trade marks in order to substantiate such earlier right under Article 9(2)(a)(b) or (c) EUTMR; the same applies if the applicant invokes an earlier national registered mark or an international trade mark designating a Member State.

In order to evaluate whether a design is 'subsequent' to a distinctive sign, the material dates for calculation are the filing or priority dates of that design (Article 52 EUDR). If the earlier of these dates is later than the filing or priority date of the distinctive sign (or the date from which protection starts for unregistered signs) then it is a 'subsequent' design.

The validity of priority claims for the respective rights will only be assessed where they can be decisive for determining which right is earlier (e.g. if the filing date for the distinctive sign is later than the filing date of the contested design but its priority date is earlier, or where the filing date of the contested design is later than the filing date of the allegedly 'prior' right but it claims earlier priority).

For the substantive requirements of a registered trade mark priority claim, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 11.2 Substantive requirements for priority claims.

Where the earlier distinctive sign is a sign that could be relied on in the context of Article 8(4) and 8(6) EUTMR, an application must, pursuant to Article 2(2)(d)(iv) EUDDR, contain particulars establishing the content of the EU or national law of which the applicant is seeking application including, where necessary, court decisions or academic writings (the principles established in the Guidelines, Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR) and Section 6, Geographical Indications (Article 8(6) EUTMR) will apply). For further information on the substantiation of the application based on a non-registered trade mark or another sign used in the course of trade (Article 8(4) EUTMR) or a geographical indication (Article 8(6) EUTMR), see Guidelines, Part C, Section 1, Opposition proceedings, paragraph 4.2.4.3 Non-registered trade mark or another sign used in the course of trade and Section 6 Geographical Indications (Article 8(6) EUTMR), paragraph 2.4 Substantiation).

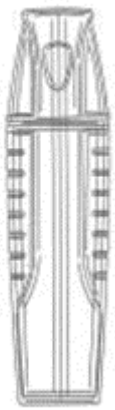
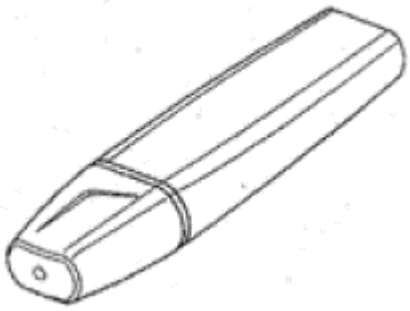
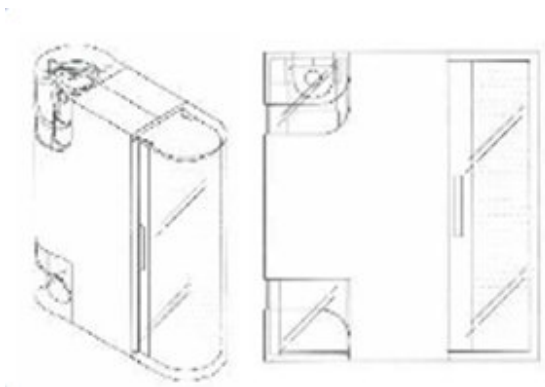
5.9.3 Use in a subsequent design

The notion of 'use in a subsequent design' does not necessarily presuppose a full and detailed reproduction of the earlier distinctive sign in a subsequent European Union design. Even though the European Union design may lack certain features of the earlier distinctive sign or may have different additional features, this may constitute

'use' of that sign, particularly where the features omitted or added are of secondary importance and are unlikely to be noticed by the relevant public. It is enough that the European Union design and the earlier distinctive sign be similar (12/05/2010, T-148/08, INSTRUMENTS FOR WRITING, EU:T:2010:190, § 50-52; 25/04/2013, T-55/12, CLEANING DEVICES, EU:T:2013:219, § 23; 09/08/11, R 1838/2010-3, Instruments for writing, § 43).

The examination under Article 27(1)(e) EUDR must be based on the perception of the relevant public regarding the distinctive sign relied on and they must form the impression that the contested EUD uses the distinctive sign relied on in support of the application for a declaration of invalidity (24/09/2019, T-219/18, Ciclomotori, EU:T:2019:681, § 67).

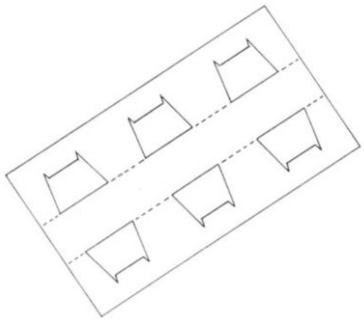
In the following cases, the contested design was declared invalid because it was concluded that it made use of the earlier trade mark and that the invalidity applicant was entitled to prohibit such use.

<table>
<tr><td>Contested EUD No 352 315-0007</td><td>Earlier German trade mark No 30 045 470.8</td></tr>
<tr><td></td><td></td></tr>
<tr><td colspan="2">12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190</td></tr>
<tr><td>Contested EUD No 1027718-0001</td><td>Earlier EUTM 5 185 079</td></tr>
<tr><td></td><td></td></tr>
</table>

25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219	
Contested EUD No 5887007-0001	Earlier EUTM 8 485 121
	
07/08/2023, R 136/2021-3, Flaschen	
Contested EUD No 1044150-0003	Earlier International trade mark registration No 608 499
	DIESEL
09/09/2015, T-278/14, DIESEL	

Where a European Union design includes a distinctive sign without any disclaimer making it clear that protection is not sought in respect of this feature, the European Union design will be considered to make use of the earlier distinctive sign, even if the latter is only represented in one of the views (18/09/2007, R 137/2007-3, Containers, § 20).

Contested EUD No 339 312-0003	Earlier international trade mark No 649 535

	 Earlier Polish trade mark No 267 378
	DANVIVA

Where it is clear from the applicant's arguments that its claim only covers the infringement of its rights in the distinctive sign, not the other features of the product in which the contested design is to be incorporated, the earlier distinctive sign reproduced in the contested design will be assessed, and not the design itself (19/03/2020, R 2449/2018-3, Pendenti, § 21, 22 and 24).

Contested EUD No 2 100-0001	**Earlier EUTM No 1 417 625**

	**PIANEGONDA**

According to Article 27(7) EUDR, a registered EU design may not be declared invalid where the applicant for or the holder of one of the rights referred to in Article 27(1)(d) to (f) EUDR consented expressly to the registration of the EU design before submitting the application for a declaration of invalidity. Under Article 27(8) EUDR, where the applicant for or a holder of one the rights referred to in Article 27(1)(d) to (f) EUDR has previously applied for a declaration that an EU design is invalid, they may not submit a new application for a declaration of invalidity on the basis of any of the other rights referred to in those points, which could have been invoked in support of the first application.

5.9.4 Examination by the Office

The examination is carried out in accordance with the law governing the earlier distinctive sign.

Where the earlier distinctive sign is a European Union trade mark, the Office will apply the principles established in the Guidelines, Part C, Opposition, Section 2, Double identity and likelihood of confusion, and Section 5, Trade marks with reputation (Article 8(5) EUTMR).

Where the earlier distinctive sign is a registered national trade mark, the Office will apply the same principles (03/10/2017, T-695/15, Comfit boxes, Containers, EU:T:2017:684, § 29).

The validity of the priority claims of the contested design and earlier trade marks will only be assessed where they can be decisive for determining which right is earlier.

For the substantive requirements of a priority claim of a registered trade mark, see the Guidelines, Part B, Examination, Section 2, Formalities, 11.2 Substantive requirements for priority claims.

For the substantive requirements of a design priority claim see paragraph 6.2.1 Priority and exhibition priority.

For the purpose of applying these principles, the Office will assume that the contested European Union design or an element used in the contested design will be perceived by the relevant public as a sign capable of being used 'for' or 'in relation to' goods or services (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 107; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 39 and 42).

The Office will examine for which goods the contested European Union design is intended to be used (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 108). To determine whether these goods and services are identical or similar, the Office will consider the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied (Article 42(2) EUDR), and also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56; 07/11/2011, R 1148/2010-3, PACKAGING, § 34-37).

Where the European Union design is intended to be incorporated in two-dimensional 'logos', the Invalidity Division will consider that such logos may be applied to an infinite range of products and services, including the products and services in respect of which the earlier distinctive sign is protected (03/05/2007, R 609/2006-3, logo MIDAS, § 27).

Where the earlier distinctive sign is a sign that could be relied on in the context of Article 8(4) and 8(6) EUTMR, the Office will apply the corresponding law as explained in the Guidelines, Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR) and Part C, Opposition, Section 6, Geographical indications (Article 8(6) EUTMR).

5.10 Unauthorised use of a work protected under the copyright law of a Member State

A European Union design will be declared invalid if it constitutes unauthorised use of a work protected under the copyright law of a Member State (Article 27(1)(f) EUDR).

For a subject matter to be classified as a '**work**', and specifically, a '**work of applied art'**, two cumulative conditions must be satisfied. First, the subject matter concerned must be **original** in the sense that it is the author's own intellectual creation. Second, it must be **the expression of the author's own intellectual creation** (04/12/2025, C-580/23 and C-795/23, MIO, EU:C:2025:941 § 48; 24/10/2024, C-227/23, Kwantum, EU:C:2024:914, § 48; 12/09/2019, C-683/17, COFEMEL, EU:C:2019:721, § 29).

A subject matter can be regarded as original if it reflects the personality of its author, as an expression of their free and creative choices. Otherwise, if the creation of a subject matter is dictated by technical considerations, rules, or other constraints that leave no

room for creative freedom, it cannot be considered sufficiently original to qualify as a work (12/09/2019, C-683/17, COFEMEL, EU:C:2019:721, § 30 and 31; 04/12/2025, C-580/23 and C-795/23, MIO, EU:C:2025:941 § 48). Choices dictated by various constraints, particularly technical, that bind the author during the creation of the subject matter are not free and creative. Nor are choices which, while free, do not bear the imprint of the author's personality by giving the subject matter a unique appearance. Circumstances such as the author's intentions during the creative process, their sources of inspiration and the use of pre–existing shapes, the likelihood of a similar independent creation or the recognition of that subject matter in professional circles, may be taken into account where appropriate. However, these factors are not, in any event, necessary or decisive for establishing the originality of the subject matter for which protection is claimed (04/12/2025, C-580/23 and C-795/23, MIO, EU:C:2025:941 § 82).

As regards the second condition, copyright protection is conferred to the expression of the author's own intellectual creation that is **identifiable with sufficient precision and objectivity** (12/09/2019, C-683/17, COFEMEL, EU:C:2019:721, § 29 and 32).

The work on which the applicant relies for the purposes of applying Article 27(1)(f) EUDR therefore cannot be an accumulation of stylistic versions of a product over many decades or an idea, but a specific expression of that idea (24/09/2019, T-219/18, Ciclomotori, EU:T:2019:681, § 100-102).

According to Article 27(7) EUDR, a registered EU design may not be declared invalid where the applicant for, or the holder of, one of the rights referred to in Article 27(1)(d) to (f) EUDR has expressly consented to the registration of the EU design before submitting the application for a declaration of invalidity. Under Article 27(8) EUDR, where the applicant for or a holder of one the rights referred to in Article 27(1)(d) to (f) EUDR has previously applied for a declaration that an EU design is invalid, they may not submit a new application for a declaration of invalidity on the basis of any of the other rights referred to in those points, which could have been invoked in support of the first application.

5.10.1 Substantiation of the application under Article 27(1)(f) EUDR (earlier copyright)

Apart from the elements mentioned under paragraphs 3.5 and 3.10.3.2.5, an application pursuant to Article 2(2)(e) EUDDR must contain:

- particulars showing that the applicant satisfies the necessary conditions, in accordance with the relevant law, and that the design constitutes an unauthorised use of the work protected.

Where applicable, the validity of the contested design's priority claim will be examined only if it is relevant for the outcome of the assessment under Article 27(1)(f) EUDR and Article 52 EUDR.

For the substantive requirements of a design priority claim, see paragraph 6.2.1 Priority and exhibition priority.

5.10.2 Examination by the Office

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the owner of the copyright invoked and whether the contested design constitutes unauthorised use of a work protected by the copyright legislation of a Member State, as interpreted by the courts of that Member State (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52; 17/10/2013, R 781/2012-3, CHILDREN'S CHAIRS, § 27, 43).

The tests for the assessment of novelty or individual character under Article 27(1)(b) in conjunction with Articles 6 and 7 EUDR are not relevant for the assessment of this ground.

It should be noted that Article 27(1)(f) EUDR does not apply to cases in which ownership of the European Union design is contested, in particular when the invalidity applicant's essential argument is that the European Union design was created not by the registered holder but by the invalidity applicant or by its employee. The Office has no jurisdiction to determine which of the parties is the rightful owner of the contested European Union design since such jurisdiction lies with national courts (Article 15 EUDR; 11/02/2008, R 64/2007-3, Loudspeakers, § 18-19).

5.11 Improper use of flags and other symbols

A European Union design will be declared invalid if it constitutes an improper use of any of the items listed in Article 6*ter* of the Paris Convention, or of badges, emblems and escutcheons other than those covered by Article 6*ter* that are of particular public interest in a Member State (Article 27(1)(g) EUDR).

The items covered by Article 6*ter* are the following (see the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal):

- armorial bearings, flags, other emblems, official signs and hallmarks that belong to states and have been communicated to WIPO, although, in the case of flags, such communication is not mandatory;
- armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations that have been communicated to WIPO, with the exception of those already the subject of international agreements for ensuring their protection (see, for example, the Geneva Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces of 12/08/1949, Article 44 of which protects the emblems of the Red Cross on a white ground, the words 'Red Cross' or 'Geneva Cross', and analogous emblems).

Badges, emblems and escutcheons other than those covered by Article 6*ter* and which are of particular public interest in a Member State could include, for example, religious symbols, political symbols or symbols of public bodies or administrations such as provinces or municipalities.

5.11.1 Substantiation of the application under Article 27(1)(g) EUDR (flags and other symbols)

Apart from the requirements mentioned under paragraphs 3.4, 3.5 and 3.10.3.2.6, when an item that is not listed in Article 6*ter* is invoked, the application must show that such item is of particular public interest in a Member State.

5.11.2 Examination by the Office

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the person or entity affected by the improper use and whether the European Union design constitutes an improper use of one of the symbols covered by Article 27(1)(g) EUDR as listed above.

5.12 Grounds for invalidity that become applicable merely because of the accession of a new Member State

See the Guidelines, Examination of Applications for Registered European Union Designs, paragraph 13, Enlargement and the Registered European Union Design.

6 Termination of the Proceedings

6.1 Termination of proceedings without a decision on the merits

The invalidity proceedings are terminated without a decision on the merits when:

1. the applicant withdraws its application as a result of an amicable settlement or otherwise; or
2. the holder surrenders the European Union design in accordance with Article 71 EUDR and the applicant did not show a legitimate interest in obtaining a decision on the merits of the case (Article 26(2) EUDR; see paragraph 3.8); or
3. the contested European Union design has lapsed and the applicant did not show a legitimate interest in obtaining a decision on the merits of the case (Article 26(2) EUDR; see paragraph 3.8); or
4. the Office suspends a number of applications for a declaration of invalidity relating to the same registered European Union design. These applications will be deemed to have been disposed of once a decision declaring the invalidity of the European Union design has become final (Article 8(3) EUDDR).

The Office informs the parties that the proceedings are terminated without a decision on the merits.

6.2 Decision on costs

If a decision on the merits of the case is taken, the decision on apportionment of costs is given at the end of the decision.

In all other cases, where the Office closes the case without a decision on the merits, a separate decision on costs is issued unless the parties have agreed on the costs as outlined in paragraph 6.2.1.

For further information, see Guidelines, Part A, General Rules, Section 3 Payment of fees, costs and charges, paragraph 7.

6.2.1 Agreement on costs

Whenever the parties inform the Office that they have settled the invalidity proceedings with an agreement that includes the costs, the Office will not issue a decision on costs (Article 101(5) EUDR). The Office will apply the principles explained in the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 6.5.2.1, Agreement on costs.

6.2.2 Apportionment of costs

The general rule is that the losing party, or the party that terminates the proceedings must bear the fees incurred by the other party as well as all costs incurred by it that are essential to the proceedings (Article 101(1) and (3) EUDR).

If both parties lose in part or if reasons of equity so dictate, a different apportionment has to be decided (Article 101(2) EUDR). As a general rule, it is equitable for each party to bear its own costs.

Where a number of applications for a declaration of invalidity relating to the same registered European Union design have been suspended, they are deemed to be disposed of once a decision declaring the invalidity of the European Union design has become final. Each applicant whose application is deemed to have been disposed of will bear its own costs (Article 101(4) EUDR). In addition, the Office will refund 50 % of the invalidity fee (Article 8(4) EUDDR).

For further information, see The Guidelines, Part A, General Rules, Section 2 General principles to be respected in the proceedings, paragraph 5.2.

6.2.3 Fixing of costs

Recoverable costs regarding representation and fees

Where the costs are limited to representation costs and the application fee, the decision fixing the amount of costs will be included in the decision on the

apportionment of the costs, except where the parties are ordered to bear their own costs.

The maximum rate set for each category of costs is determined in Article 11 EUDIR.

As regards fees, the recoverable amount is limited to the invalidity fee of EUR 320 if the applicant wins.

As regards representation costs, the recoverable amount is limited to EUR 450. This applies both to the applicant and the holder insofar as represented in the invalidity proceedings by a professional representative within the meaning of Article 115 EUDR. A winning party no longer represented by a professional representative at the time of taking a decision is also entitled to costs regardless of when during the proceedings professional representation ceased. This is without prejudice to the need to appoint a professional representative where it is mandatory. The amount to be borne by the losing party is always fixed in euro, regardless of the currency in which the winning party had to pay its representative.

Representation costs for employees, even from another company with economic connections, are not recoverable.

Other recoverable costs

Where the costs include expenses in relation to an oral hearing or the taking of evidence, the Invalidity Division will, on request, fix the amount of costs to be paid (Article 101(6) EUDR).

The amount of recoverable costs may be reviewed by a decision of the Invalidity Division on a reasoned request filed within 1 month of the date of notification of the fixing of costs (Article 101(7) EUDR).

Fixing of costs after remittance of the case to the Invalidity Division for further prosecution

When the invalidity decision has been annulled, wholly or partly, and the case is remitted by the Boards of Appeal, the situation will be the following:

- The first decision (which was appealed) does not become final, not even as regards apportionment or fixing of costs.
- As regards the costs of the invalidity proceedings, one single decision on the apportionment and on the fixing of costs must be taken for the invalidity procedure as a whole.
- As regards the costs of the appeal procedure, the notion of ‘winning party’ has to be applied to the outcome of the appeal proceedings, with the result that the decision can be different for the two instances. The amount of reimbursable representation costs for the appeal procedure is EUR 550, which applies in addition to the representation costs for the invalidity proceedings.

6.2.4 Enforcement of decisions fixing the amount of costs

For the enforcement of decisions fixing the amount of costs the Office will apply the principles explained in the Guidelines, Part A General Rules, Section 3 Payment of fees, costs and charges, paragraph 7.2. Enforcement of the decision on costs.

6.3 Correction of errors, revocation of decisions and entry in the Register

6.3.1 Correction of mistakes

In Invalidity Division decisions, only linguistic errors, errors of transcription and manifest oversights may be corrected. They will be corrected by the Invalidity Division, acting of its own motion or at the request of an interested party (Article 92 EUDR).

For further information on the correction of mistakes, see the Guidelines, Part A, Section 6 Revocation of decisions, cancellation of entries in the register and correction of errors.

6.3.2 Revocation of Decisions

The decisions of the Invalidity Division shall be revoked when they contain obvious errors attributable to the Office. They will be revoked by the Invalidity Division, acting of its own motion or at the request of an interested party (Article 93 EUDR).

For further information on revocation of decisions, see the Guidelines, Part A, Section 6 Revocation of decisions, cancellation of entries in the register and correction of errors.

6.3.3 Entry in the Register

Under Article 104(3)(r) EUDR, the date and content of the decision on the application (Article 74(4) EUDR), or of any other termination of proceedings, will be entered in the Register once it is final.

7 Other procedural issues

7.1 Change of parties

As regards the rules on **transfer and invalidity proceedings, change of name, change of representative** and **interruption of the proceedings due to death or legal incapacity of the applicant or its representative** in the course of invalidity proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 7.5 Change of parties (transfer, change of name, change of representative, interruption of proceedings), as the rules are applicable *mutatis mutandis* to EUDs and EUD proceedings.

8 Appeal

8.1 Right to appeal

Any party to invalidity proceedings has the right to appeal against a decision that affects it adversely (Article 77 EUDR). Appeals have a suspensive effect.

A decision that does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal. Any written communication of such a decision will include a notice that the decision may be appealed within 2 months of the date of receipt of the decision's notification.

GUIDELINES FOR EXAMINATION OF REGISTERED EUROPEAN UNION DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Parts shared with current trade mark practice

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Editor's note and general introduction

1 Subject Matter

The European Union Intellectual Property Office (the EUIPO or the Office), established in Alicante, is responsible for the registration of European Union trade marks (EUTM) and registered European Union designs (EUD) under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 and Regulation 2026/715 of the European Parliament and of the Council on European Union designs codifying Council Regulation No 6/02 of 12 December 2001. These registrations provide uniform trade mark and design protection throughout the European Union.

The Office deals with registration procedures (including the examination of applications for absolute grounds for refusal and, where an opposition has been raised regarding an EUTM application, for relative grounds for refusal) accordingly, maintains the public registers of these rights and decides on applications for those rights, once registered, to be declared invalid or revoked. The Office's Guidelines cover practice in all of these areas.

2 Objective of the Guidelines

The Guidelines on EUTMs and the Guidelines on EUDs exist to improve the coherence, predictability and quality of Office decisions. The Guidelines are designed to bring together, systematically, the principles of practice derived from the jurisprudence of the European Court of Justice, the case-law of the Office's Boards of Appeal, the decisions of the Office's Business Operations Department and the outcomes of the Office's convergence programmes with EU IP offices.

As case-law evolves, so the Guidelines also evolve. They are regularly adapted to reflect developments in Office practice by means of an ongoing revision exercise (see paragraph 3 below).

3 Guidelines revision process

As the sole source of reference on Office practice with regard to EUTMs and EUDs, the current Guidelines are available in the five Office languages. Additionally, the Office translates the Guidelines into the remaining official EU languages on a regular basis.

They are revised by the Office's cross-departmental 'Knowledge Circles' in a cyclical and open process: 'cyclical' because practice is updated on a continuous basis by looking at the case-law of the preceding year and taking into account the operational needs and outcomes of convergence initiatives, and 'open' because external stakeholders are involved in defining that practice.

Involving national offices and user associations not only benefits the quality of the Guidelines, but also facilitates convergence, that is, the process of finding common ground on issues where there may be diverging practices. Making the Guidelines available in all the EU languages helps raise awareness of Office practice among Member States and users and makes differences in practice easier to identify.

The process involves the following phases:

1. **Preparation of the draft Guidelines by the Office**
   During this phase, the draft Guidelines are produced by the Office's Knowledge Circles. The three steps of this phase — analysis, drafting and discussion — must be completed in a timely manner. Analysis involves the Knowledge Circles extracting trends from the preceding years' case-law, studying the conclusions of the convergence projects and taking into consideration the comments received in the previous cycle from the Office's users and stakeholders. As the next step, the Knowledge Circles draft the Guidelines. Finally, the texts are discussed within the Knowledge Circles, where representatives of the Office's various units and departments are represented.
2. **Consultation with stakeholders**
   Once the drafts have been prepared, they are sent for consultation to internal stakeholders, and additionally to the external stakeholders, national offices and user associations. Stakeholders have the opportunity to study the drafts and submit their comments and suggestions within the consultation phase. At the end of the consultation phase, the Knowledge Circles process the feedback received and implement them into the drafts. The Knowledge Circles can choose to accept or reject a comment, take it on board for consideration in the next revision cycle, or mark it as out of scope.
3. **Adoption of the Guidelines**
   After consulting the MB in accordance with Article 153(1)(l) EUTMR and Article 162 EUDR, the Executive Director adopts the updated Guidelines. The versions in the five Office languages together make up the official text. In the event of discrepancies between different language versions, the text in the drafting language (English) will prevail. The Guidelines are translated into the remaining official languages of the European Union on a regular basis. These additional translations are published on the Office's website, and external stakeholders, whether national offices or user associations, are free to submit feedback on their quality; any linguistic amendments made as a result of this informal feedback will be incorporated into the texts without any formal procedure
4. **Fast-track procedure**
   In certain circumstances (e.g. a Court of Justice judgment that has immediate impact on Office practice) the Office will amend the Guidelines using a fast-track procedure outside the normal time frame outlined above. However, this procedure is an exception to the norm.

4 Structure of the Guidelines

The items dealt with in the Guidelines are set out below.

Introduction

Editor's Note and General Introduction

EUROPEAN UNION TRADE MARKS

Part A: General Rules

Section 1: Means of Communication, Time Limits

Section 2: General Principles to be Respected in the Proceedings

Section 3: Payment of Fees, Costs and Charges

Section 4: Language of Proceedings

Section 5: Parties to the Proceedings and Professional Representation

Section 6: Revocation of Decisions, Cancellation of Entries in the Register and Correction of Errors

Section 7: Revision

Section 8: *Restitutio in Integrum*

Section 9: Enlargement

Section 10: Evidence

Part B: Examination

Section 1: Proceedings

Section 2: Formalities

Section 3: Classification

Section 4: Absolute Grounds for Refusal

Chapter 1: General Principles

Chapter 2: EUTM Definition (Article 7(1)(a) EUTMR)

Chapter 3: Non-Distinctive Trade Marks (Article 7(1)(b) EUTMR)

Chapter 4: Descriptive Trade Marks (Article 7(1)(c) EUTMR)

Chapter 5: Customary Signs or Indications (Article 7(1)(d) EUTMR)

Chapter 6: Shapes or Other Characteristics that Result from the Nature of the Goods, are Necessary to Obtain a Technical Result or give Substantial Value to the Goods (Article 7(1)(e) EUTMR)

Chapter 7: Trade Marks Contrary to Public Policy or Acceptable Principles of Morality (Article 7(1)(f) EUTMR)

Chapter 8: Deceptive Trade Marks (Article 7(1)(g) EUTMR)

Chapter 9: Trade Marks in Conflict with Flags and Other Symbols (Article 7(1)(h) and (i) EUTMR)

Chapter 10: Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR)

Chapter 11: Trade Marks in Conflict with Traditional Terms for Wines (Article 7(1)(k) EUTMR)

Chapter 12: Trade Marks in Conflict with Traditional Specialities Guaranteed (Article 7(1)(l) EUTMR)

Chapter 13: Trade Marks in Conflict with Earlier Plant Variety Denominations (Article 7(1)(m) EUTMR)

Chapter 14: Acquired Distinctiveness Through Use (Article 7(3) EUTMR)

Chapter 15: European Union Collective Marks

Chapter 16: European Union Certification Marks

Part C: Opposition

Section 0: Introduction

Section 1: Opposition Proceedings

Section 2: Double Identity and Likelihood of Confusion

Chapter 1: General Principles

Chapter 2: Comparison of Goods and Services

Chapter 3: Relevant Public and Degree of Attention

Chapter 4: Comparison of Signs

Chapter 5: Distinctiveness of the Earlier Mark

Chapter 6: Other Factors

Chapter 7: Global Assessment

Section 3: Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR)

Section 4: Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR)

Section 5: Trade Marks with Reputation (Article 8(5) EUTMR)

Section 6: Geographical Indications (Article 8(6) EUTMR)

Section 7: Proof of use

Part D: Cancellation

Section 1: Cancellation Proceedings

Section 2: Substantive Provisions

Part E: Register Operations

Section 1: Changes in a Registration

Section 2: Conversion

Section 3: EUTMs and EUDs as Objects of Property

Chapter 1: Transfer

Chapter 2: Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings

Section 4: Renewal

Section 5: Inspection of Files

Section 6: Other Entries in the Register

Chapter 1: Counterclaims

Part M: International Marks

REGISTERED EUROPEAN UNION DESIGNS

Examination of Applications for Registered European Union Designs

Examination of Design Invalidity Applications

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 1

Means of communication, time limits

1 Introduction

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

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

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

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

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

2 Procedures for filing and for communication with the Office

Articles 30, 98 and 100 EUTMR
Articles 63 and 65 EUTMDR
Articles 41, 85 and 88 EUDR
Articles 17 and 18 EUDDR

In proceedings relating to European Union trade marks (EUTMs) communications addressed to the Office can be submitted by electronic means, post or courier. Notifications issued by the Office can be made by electronic means, post, courier services or public notification.

In proceedings relating to registered European Union designs (EUDs) communications addressed to the Office can only be submitted by electronic means. Notifications issued by the Office can only be made by electronic means or public notification.

Applications for EUTMs and EUDs must be filed directly with the Office.

- Applications for EUDs must be filed via e-filing (online applications via the User Area).
- For applications for EUTMs, e-filing (online applications via the User Area) is the recommended means of filing. In addition, EUTMs filed through the Office's e-filing system are subject to a reduced fee.

For both EUTM and EUD online applications, the Office also offers the possibility of an accelerated procedure known as Fast Track (for more details, please check the EUIPO website for Fast Track conditions for trade marks and Fast Track conditions for designs).

For EUTM-related proceedings, in the event of opting for filing by means other than e-filing, the Office makes various forms available to the public, in all the official languages of the EU. Their use is not mandatory but strongly recommended to facilitate complying with the filing requirements. However, when filing an international application or subsequent designation under the Madrid Protocol, either the World Intellectual Property Organization's (WIPO) MM 2 or MM 4 form, or the Office's EM 2 or EM 4 form, must be used.

3 Notification and communication of documents

Articles 98 and 100 EUTMR
Article 60(3) and Article 66 EUTMDR
Articles 85 and 88 EUDR
Article 13(3) and Article 19 EUDDR

The EUTMDR and the EUDDR distinguish between documents **addressed to** the Office and notifications **issued by** the Office.

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

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

Any notification addressed to the representative will have the same effect as if it had been addressed to the person represented. Similarly, any communication addressed to the Office by a representative will be considered to have originated from the person he or she represents.

For further details, including information on appointing representatives and authorisations, see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation.

3.1 Communications to the Office

Article 98(3) and Article 100 EUTMR

Articles 63 and 64 EUTMDR

Articles 85(2) and Article 88 EUDR

Articles 12 and 17 EUDDR

Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means

Decision No EX-26-5 of the Executive Director of the Office of 1 July 2026 on technical specifications for annexes submitted on data carriers

The following section provides the general provisions and explains the different methods of communication that can be used by parties when communicating with the Office in EUTM or EUD-related proceedings, for all submissions, including any accompanying annexes.

3.1.1 Via the User Area (electronic means)

The accepted means of electronic communication with the Office in **procedures relating to EUTMs and EUDs** is the User Area, which is a secure electronic communications platform maintained by the Office. The User Area enables users to submit applications and other documents, receive notifications and documents sent by the Office, reply to these notifications and perform other actions.

In design proceedings, Article 17 EUDDR refers to the accessibility of incoming communications from the parties to the Office and mentions access to the content of such submissions. Submissions in this format will only be allowed as determined by the Office, including the manner and conditions of their use.

Nevertheless, exceptionally, where a technical malfunction prevents the applicant from filing through the User Area, an **EUTM or EUD application** submitted by one of the alternative electronic back-up measures available (see below) will be deemed to have been received by the Office provided that the applicant resubmits, within three working days of the original submission, the application for registration of an EUTM or EUD (with the same content) through the User Area. Failure to comply with these conditions will result in the original submission being deemed as not having been received. For further information on the submission of an **application for renewal of an EUTM or EUD** by one of the alternative electronic back-up measures available, see the Guidelines, Part E, Register Operations, Section 4, Renewal, paragraph 7.

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

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

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

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

In the unlikely event that these back-up measures are not available, the Executive Director may take a decision to extend the deadlines (see paragraph 4.2).

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

A series of e-operations (e-filings, e-actions and other e-operations) can be carried out via the User Area. These are accessible after logging into the User Area through the 'Dashboard' or the 'Online Services' sections of the account.

In addition, in certain *inter partes* proceedings, when both parties are registered users of the User Area they can file joint requests that are validated (signed) electronically by the two parties.

If an account holder uses one of the standard e-operations in the User Area to file a submission, that e-operation will prevail over any other statement or observation made by the account holder through other means on the same day, provided that the Office does not receive a withdrawal of the e-operation on the same day (see paragraph 3.1.6) for same day withdrawals).

Where a communication submitted by electronic means, is incomplete or illegible, or the Office has reasonable doubts as to the accuracy of the transmission, in accordance with Article 63(3) EUTMDR and Article 17(3) EUDDR, it will advise the sender and invite it to retransmit the communication or submit it by acceptable means of communication within a specified deadline. If the retransmission is complete, the date of receipt will be considered to be the date of the first transmission, except for the purposes of establishing a filing date for an application. Otherwise, the Office will not take the transmission into account or will consider only the received and/or legible parts (04/07/2012, R 2305/2010-4, HOUBIGANT/ PARFUMS HOUBIGANT PARIS et al.).

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

For further information on the User Area, and in particular on the proper use of the user account and the sanctions imposed in the event of the prohibited disclosure of User Area credentials, please see paragraph 4(b) of Annex I: Conditions of use of the user area, annexed to Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means.

3.1.2 By post or courier service (for EUTMs only)

Post or courier service can only be used as a means of communication in proceedings relating to EUTMs.

In proceedings relating to EUDs, any submissions sent by post or courier will be deemed not to have been received and the sender will be informed accordingly. No acknowledgement of receipt will be issued by the Office. Consequently, such submissions will neither be scanned nor become part of the file. Furthermore, the submissions will not be returned to the sender and will be destroyed after 30 days, unless the applicant reclaims them by its own means.

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

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

The date of receipt is the date on which the Office receives the communication irrespective of when it was placed in the mail or postal system (28/09/2016, T-400/15; CITRUS SATURDAY / CITRUS, EU:T:2016:569, § 25; 15/03/2011, T-50/09, Dada & Co. Kids (fig.) / DADA, EU:T:2011:90, § 67). The time of receipt is the local time in Alicante (Spain).

For further information on copies of the documents submitted in *inter partes* proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 4.2, Substantiation.

3.1.3 Annexes to communications

Pursuant to Article 55 EUTMDR and Article 11 EUDDR, any documents or other items of evidence submitted by the party must be contained in an annex to the submission, be numbered, be accompanied by an index with a short description of each item of evidence together with the number of pages, if applicable, and the page number where it is mentioned in the submission.

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

In *inter partes* proceedings

- annexes submitted by electronic means do not need to be submitted in duplicate;
- annexes submitted by post or courier (in EUTM-related proceedings) consisting of paper documents (such as loose sheets of evidence) up to and including size A3 do not need to be submitted in duplicate;
- annexes submitted by post or courier (in EUTM-related proceedings) consisting of paper documents larger than A3 or not on paper (e.g. data carriers, physical items of evidence such as product samples) must be submitted in duplicate, with one copy to be sent to the other party.

Where in *inter partes* proceedings relating to EUTMs, a copy is required but not provided, the annexes in question will not be taken into account.

For further information on items of evidence to be submitted in *inter partes* proceedings for the purpose of establishing use, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 5.3.2.1, Means of evidence, Principles.

In addition to the requirements of Article 55(2) EUTMDR, the Office recommends that the following key aspects of a structured presentation be taken into account in order to facilitate the processing and handling of the files:

1. to ensure a manageably sized file, parties should limit their submissions to items of evidence that are relevant to the case and to the ground/argument in question;
2. if the documentation is sent in different batches, each batch submitted should clearly indicate the total number of batches (including the total number of pages and the number of pages in each batch);
3. for physical specimens such as containers, packaging, etc. a photograph may be taken and submitted instead of the item itself and a duplicate (unless the electronic content of the item is relevant, as in the case of a data carrier);
4. where original documents or items are sent to the Office by mail, they should not be stapled, bound or placed in folders;
5. all items sent in duplicate for forwarding to the other party should be clearly identified; however, where the original is submitted to the Office by electronic means, no second copy needs to be sent.

3.1.4 Data carriers

In EUTM-related proceedings, annexes to communications may be submitted by post on data carriers.

The Office considers data carriers to be small portable storage devices such as USB flash drives, pen drives or similar memory units. External hard drives, memory cards, CD ROMs, DVDs and other optical discs, as well as magnetic data carriers of any kind are excluded.

The Office only accepts the file formats listed in Decision No EX-26-05 of the Executive Director of the Office of 1 July 2026 on technical specifications for annexes submitted on data carriers, namely JPEG, MP3, MP4, PDF, TIFF, and for 3D models, STL, OBJ and X3D. The Office does not accept files in an executable file format (EXE), in a compressed file format or in an encrypted format, even if the resulting executed,

decompressed or unencrypted file is in one of the acceptable file formats. Nor does the Office accept fillable PDF formats and PDF files that include added objects such as redacted (blacked-out) or added text, highlighted text or arrows.

The maximum size of each individual file saved on the data carrier is restricted to 20 MB (Article 4 of Decision No EX-26-05).

For further information, see Article 3 of Decision No EX-26-05 of the Executive Director of the Office of 1 July 2026 on technical specifications for annexes submitted on data carriers.

If an annex on the data carrier does not comply with the acceptable type of data carriers under Article 2(1) or the technical specifications under Article 3 and 4 of Decision No EX-26-05, the Office will deem it not to have been filed without inviting the party to overcome the deficiency (Article 6(a) No EX-26-05).

3.1.5 Signature

Article 63(1) EUTMDR Article 17(1) EUDDR

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

A distinction should be made between signatures in applications (requests submitted to the Office) and in supporting evidence.

Signatures on applications:

- Applications submitted through electronic means

When an application is submitted through electronic means (electronic means of communication with the Office pursuant to Decision No EX-26-03, namely the User Area), the indication of the sender's name is deemed to be equivalent to a signature.

- Applications submitted by post or courier in EUTM-related matters

When an application is submitted by post or courier in trade mark-related matters, a physical signature (handwritten) is required.

Signatures on supporting evidence:

Where a supporting document must be signed for it to be admissible, a physical signature (handwritten) is required. Additionally, where required by the Regulations (such as in evidence in support of a transfer request) it must be signed by all parties to the contract. Whether a document is signed or not may also have an impact on its credibility (e.g. an affidavit).

Where a submission or supporting document has to be signed, the signature must be accompanied by the name of the physical person signing and, if the signature is on behalf of a legal person (company), it must also include an indication of the role of the physical person in the company or their authority as signatory (e.g. Chief Executive Officer, President). The Office identification number (ID) may optionally also

be indicated if available. If any of these identification elements are missing from the signature, the Office may issue a deficiency requesting the missing element(s). If a submission is not signed at all, the Office will invite the party concerned to correct the deficiency.

If a deficiency is notified, and is not remedied within the set time limit, the application will be rejected or the communication not taken into account.

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

The use of electronic signatures as a replacement for physical signatures is not excluded from the Regulations. The Office will accept electronic signatures that comply with the technical specifications of the 'eIDAS Regulation' Regulation (EU) No 910/2014, which allows for a handwritten signature to be legally replaced by a 'qualified electronic signature' (see Article 3 and Article 25(2) of the eIDAS Regulation). When an electronic signature is used, it must be accompanied by the printed signature details or the identification of a source for validation, to ensure that the signature is compliant with said Regulation.

3.1.6 Confidentiality

Article 114(4) EUTMR Article 109(4)(c) EUDR

Regarding confidentiality, the party making a submission must bear in mind that the content of files is available for public inspection, and this is particularly relevant where contracts or other documents are submitted as evidence in support of a request, as they may contain sensitive data.

A party may, upon submitting a document or at a later stage, request that all or part of a document be kept confidential, as long as no request for an inspection of files is pending.

The party concerned must have expressly invoked, and sufficiently justified, a special interest in keeping the document confidential. For further details on invoking confidentiality and special interest, and on the examination process of confidential information, see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files, paragraph 4.3.4. Alternatively, the party may submit evidence in such a way that avoids revealing parts of the document or information that the party considers confidential, as long as the parts of the document submitted contain the required information.

The evidence required in support of a request does not need to include commercially sensitive items, for example, the price paid for a licence or for the purchase of a EUTM or an EUD. Where contracts or other documents are submitted as evidence, certain

information may be blacked out before being submitted to the Office, or certain pages may be omitted altogether.

In principle, documents of a personal nature such as passports or other identification documents, which are submitted in particular as evidence in relation to requests for transfer, evidence of 'health data', which is submitted in particular as evidence in relation to restitutio in integrum or as supporting evidence for extension requests, and bank account extracts, which may, for example, be attached to applications and requests as evidence of fee payment, because of their inherent personal nature, confidentiality vis à vis any third parties is justified, and, in principle, overrides any third-party interest.

In *inter partes* proceedings, one of the parties might request the Office to keep certain documents confidential even vis-à-vis the other party in the proceedings. Although the Office can keep documents confidential vis-à-vis third parties (inspection of files), it can under no circumstances keep them confidential vis-à-vis the other party in *inter partes* proceedings. For further details concerning confidentiality in *inter partes* proceedings see the Guidelines, Part C, Opposition Proceedings, Section 1, Opposition Proceedings, paragraph 4.4.4.

3.1.7 Withdrawal of communications

Submissions become effective upon receipt by the Office, provided that the Office does not receive a withdrawal of the submission on the same day . This means that a submission will only be annulled if the withdrawal of the submission reaches the Office on the same day it was received.

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

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

3.2 Notification by the Office

Article 94(2) and Article 98 EUTMR

Articles 56 to 62 EUTMDR

Articles 79(2) and 85 EUDR

Articles 12 to 15 EUDDR

Decision No EX-26-04 of the Executive Director of the Office of 1 July 2026 on notification by public notice

Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means

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

The Office by default notifies by electronic means. When the user does not have a User Area account, notification will be carried out by public notification, following a previous attempt at notification by post (in EUTM-related proceedings only).

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

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

3.2.1 Notification by electronic means

The User Area is the sole platform through which the Office will issue notifications by electronic means, and account holders may not opt-out of this means of receiving electronic communications from the Office as long as the User Area account remains active. This applies equally to new and existing user account holders, including those who may have previously opted-out under the former rules as set out in Article 3(1) of

Decision of the Executive Director No EX-23-13. Transmission may be of the document itself, or by providing electronic access to that document.

The date on which the document is placed in an account holder's inbox will be recorded by the Office and mentioned in the User Area. The document is deemed to have been notified on the fifth calendar day following the day on which the document is placed in the account holder's inbox, irrespective of whether the recipient actually opened and read it.

3.2.2 Notification by post or courier (for EUTMs only)

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

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

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

Notification will be deemed to have taken place 10 days after the document was posted. The recipient can only rebut this presumption by proving that it did not receive the document or that it received it later. Indications giving rise to reasonable doubt about correct receipt are considered to be sufficient proof (25/10/2012, T-191/11, Miura, EU:T:2012:577, § 34).

In the event of a dispute, the Office must be able to establish that the notification reached its destination or the date on which it was delivered to the addressee. In this regard, the Office must establish that it had created the conditions for the document to be notified to arrive within the sphere of influence of the addressee. A distinction must be drawn between, first, the transmission of a document to the addressee, which is required for due notification, and, secondly, effective knowledge of that document, which is not required for the notification to be regarded as due notification. Existence of a valid notification to the addressee is in no way conditional on its having actually been brought to the notice of the person competent to deal with it under the internal rules of the entity addressed (22/11/2018, T-356/17, RoB, EU:T:2018:845, § 31-32, and the case-law cited therein).

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

3.2.3 Public notification by public notice

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

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

Public notification will be used for all notifications in EUD-related proceedings where notification by electronic means is impossible because the recipient does not have an active User Area account.

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

4 Time Limits Specified by the Office

Article 101 EUTMR Articles 67 to 69 EUTMDR Article 90 EUDR Articles 20 to 22 EUDDR

Time limits before the Office are an essential tool for conducting orderly and reasonably swift proceedings. They can be divided into two categories:

- those set by the EUTMR, EUDR and related delegated and implementing acts, which cannot be extended;
- those specified by the Office, which can be extended under certain circumstances.

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

If the time limit is still running, the party may **request an extension** of the time limit pursuant to Article 68 EUTMDR and Article 21 EUDDR.

If the time limit has expired, the party that has missed it has two possible courses of action: it can either seek **continuation of proceedings** (pursuant to Article 105 EUTMR and Article 96 EUDR), which only requires meeting certain formal requirements, or it can request *restitutio in integrum* (pursuant to Article 104 EUTMR and Article 95 EUDR), which requires meeting formal and substantive requirements (such as showing all due care).

Additional information is provided under paragraphs 4.4 and 4.5 below.

4.1 Length of the time limits specified by the Office

With the exception of the time limits expressly specified in the EUTMR, EUDR and all related delegated or implementing acts, the time limits specified by the Office may not be less than one month or longer than six months.

The general practice is to grant two months.

4.2 Expiry of time limits

Under Article 101(1) EUTMR and Article 90 EUDR, the calculation of a time limit starts on the day following the day on which the 'relevant event' occurred.

Where the Office sets a time limit in a notification indicating a time limit in terms of days, weeks or months (usually two months), the 'relevant event' is the date on which the document is notified or deemed notified, depending on the rules governing the notification. A notification issued by electronic means is deemed to have been notified on the fifth calendar day following the day on which the document is placed in the account holder's inbox (see paragraph 3.2.1) and a notification issued by post or courier in EUTM-related proceedings is deemed to have been notified on the tenth day after it was posted (see paragraph 3.2.2).

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

It is immaterial whether the 'relevant event' occurred on a working day, a holiday or a Sunday; that is relevant only for the expiry of the time limit.

Where the relevant subsequent month has no day with the same number, the time limit in question will expire on the last day of that month. A two-month time limit specified in a notification on 31 July will therefore expire on 30 September.

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

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

In the event a time limit is missed, there is no provision requiring the Office to inform a party of the procedures available to it under Articles 104 and 105 EUTMR and Articles 95 and 96 EUDR, nor, *a fortiori*, is it incumbent on it to advise that party to pursue any particular legal remedy. Therefore, the principle of sound administration is not violated by the Office for not informing of the means for rectifying a late submission (04/05/2018, T-34/17, SKYLEADER (fig.), EU:T:2018:256, § 43).

A time limit that expires on a day on which the Office is not open (Saturdays, Sundays and holidays) will be extended to the first working day thereafter. Additionally, where post is relied on as a method of communication (in EUTM-related proceedings only) a time limit that expires on a day on which post is not delivered in the locality in which the Office is located will be extended to the first working day thereafter. For this purpose, before the start of each calendar year, the Executive Director of the Office determines the days on which the Office is closed or on which post will not be delivered. The extension is automatic but it applies only at the end of the time limit (12/05/2011, R 924/2010-1, whisper power (fig.) / WHISPER).

In the event of a 'general interruption' to the postal service in Spain (for EUTM-related proceedings only) or of an 'actual interruption' of the Office's connection to authorised electronic means of communication, any time limit that expires during that period will

be extended. These periods of interruption and of extension will be determined by the Executive Director of the Office and will apply to all parties to the proceedings.

Not every technical error is regarded as an 'actual interruption of the Office's connection to admitted electronic means of communication' warranting an extension of time limits under Article 101(3) EUTMR and Article 90(3) EUDR. For an interruption to be considered 'actual', all means of electronic communication (including all back-up options) must be unavailable for at least four consecutive hours within, or commencing within, Office working hours on the same day. Therefore, parties should be wary of filing submissions on the last day of a time limit, especially after Office working hours. If a party misses a deadline, it may, depending on the circumstances, consider filing a request for continuation of the proceedings (see paragraph 4.4) or for *restitutio in integrum* (see paragraph 4.5).

In the event of an exceptional occurrence (strike, natural disaster, etc.), which interrupts or interferes with the communications between the parties and the Office, time limits may be extended for a period determined by the Executive Director of the Office. In principle the extension of time limits in case of exceptional occurrence will apply to the parties to the proceedings affected, namely those having their residence or registered office in the country/place concerned or where the occurrence is in the EEA, who have appointed a representative with a place of business in this EEA Member State. However, if the occurrence affects the seat of the Office (Alicante, Spain), such determination of the Executive Director must specify that it applies in respect of all parties to the proceedings (see Article 101(4) EUTMR and Article 90(4) EUDR, last sentences).

4.3 Extension of time limits

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

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

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

Examples of justifications that can be accepted:

- 'Evidence is being gathered from distribution channels/all our licensees/our suppliers in several Member States. So far, we have gathered documents from

some of them but, due to the commercial structure of the company, we have only recently been able to contact the rest.'

- 'In order to show that the mark has acquired distinctiveness through use we started carrying out market research at the beginning of the period (on date X). However, the fieldwork has only recently been concluded; consequently, we need a second extension in order to finish the analysis and prepare our submissions to the Office.'
- 'Death' is also considered an 'exceptional circumstance'. The same applies to serious illness, provided that no reasonable substitution was available.
- Finally, 'exceptional circumstances' also include 'force majeure' situations. 'Force majeure' is defined as a natural and unavoidable catastrophe that interrupts the expected course of events. It includes natural disasters, wars and terrorism, and unavoidable events that are beyond the party's control.

4.4 Continuation of proceedings

Article 105 EUTMR

Article 96 EUDR

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

Article 105 EUTMR and Article 96 EUDR provide for the continuation of proceedings where time limits have been missed, but excludes various time limits laid down in certain articles of the EUTMR and EUDR respectively.

As regards EUTMs, the **excluded** time limits are the following:

- Article 32 EUTMR, namely the date on which the payment of the basic application fee is due;
- Articles 34(1) and 38(1) EUTMR, namely the six-month period during which a right to priority or exhibition priority can be claimed;
- Article 39 EUTMR, namely the two-month time limit to claim seniority in a pre-registration claim;
- Article 41(2) EUTMR, namely the two-month time limit to remedy – i) filing date deficiencies (Article 41(1)(a) EUTMR), ii) formal deficiencies (Article 41(1)(b) EUTMR), and iii) class fee deficiencies (Article 41(1)(c) EUTMR);
- Article 46(1) and (3) EUTMR, namely the three-month opposition period and the time limit for paying the opposition fee;
- Article 53(3) EUTMR, namely the periods of renewal and payment of the renewal fee – i) the six-month period prior to the expiry of the registration, and ii) the further six-month period following the expiry of the registration;

- Article 68 EUTMR and Article 72(5) EUTMR, namely the two-month time limit for the filing of an appeal and paying the appeal fee, the four-month time limit for submitting the written statement setting out the grounds of the appeal and the two-month time limit for filing an appeal before the Court of Justice;
- Articles 104(2) and 105(1) EUTMR, namely the time limits relating to claiming *restitutio in integrum* and continuation of proceedings itself, to avoid double relief for missing the same time limit;
- Article 139 EUTMR, namely the three-month period within which conversion must be requested and the conversion fee paid.

However, none of the time limits in **opposition proceedings** (other than the time limit for filing an opposition and paying the applicable fee, as mentioned above) are excluded. Consequently, continuation of proceedings is available for missing:

- the time limit under Article 146(7) EUTMR to translate the notice of opposition;
- the time limit under Article 5(5) EUTMDR to remedy deficiencies that affect the admissibility of the opposition;
- the time limits for the opponent to substantiate its opposition under Article 7 EUTMDR;
- the time limit laid down in Article 8(2) EUTMDR for the applicant to file its observations;
- the time limit under Article 8(4) EUTMDR for the opponent to reply;
- the time limits for any further exchange of arguments, if allowed by the Office (07/12/2011, R 2463/2010-1, Pierre Robert/ Pierre Robert (fig.);
- the time limit under Article 10(1) EUTMDR for the applicant to request that the opponent prove use of its earlier mark;
- the time limit under Article 10(2) EUTMDR for the opponent to submit proof of use of its earlier mark;
- the time limit under Article 10(6) EUTMDR to translate proof of use.

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

As regards EUDs, the **excluded** time limits are the following:

- Article 46 EUDR, namely the date on which the payment of the fee is due;
- Articles 49(1) and 53(1) EUDR, namely the six-month period during which a right to priority or exhibition priority can be claimed;
- Article 55(3) EUDR, namely the two-month time limit to remedy i) filing date deficiencies (Article 46 EUDR), and ii) formal deficiencies referred to in Article 55(2) EUDR;
- Article 66(3) EUDR, namely the periods of renewal and payment of the renewal fee – i) the six-month period prior to the expiry of the registration; and ii) the further six-month period following the expiry of the registration;
- Article 68 and Article 72(5) EUTMR, namely the two-month time limit for the filing of an appeal and paying the appeal fee, the four-month time limit for submitting the written statement setting out the grounds of the appeal, and the two-month time limit for filing an appeal before the Court of Justice, pursuant to Article 77(2) EUDR;

- Articles 95(2) and 96(1) EUDR, namely the time limits relating to claiming *restitutio in integrum* and continuation of proceedings itself, to avoid double relief for missing the same time limit.

However, Article 96 EUDR does not exclude any of the time limits that apply in **design invalidity proceedings.**

The party seeking continuation of proceedings must make the request, for which a fee is charged as established in Annex I of the EUTMR and Annex I of the EUDR, within two months of the expiry of the original time limit and complete the omitted act by the time the request for continuation is received. There is no substantive requirement to be fulfilled such as when requesting *restitutio in integrum*; that is, there is no need to justify the missing of the time limit.

- Request to be submitted **within two months of the expiry of the original time limit**

  The two months available for submitting a request for continuation of proceedings is an **objective** time limit and it is **non-extendable**. Consequently, unlike in the case of *restitutio in integrum*, it is irrelevant when the reason of non-compliance with the original time limit has been removed or when the party became aware of missing the original time limit.

  The request is deemed to be received only once the applicable fee has been paid (EUR 400).

  Once a request for continuation of proceedings has been **granted**, the time limit is deemed to be observed and the opportunity of continuation of proceedings is exhausted. Hence, any **subsequent** request for a continuation of proceedings for the same time limit is, by definition, inadmissible, even if submitted within the time remaining of the two months available for submitting such a request. Conversely, where the initial request for continuation of proceedings is **rejected**, a **subsequent** request for continuation of proceedings will be accepted if it is submitted within the time remaining of the two months available for submitting such a request (and the other requirements are also complied with, i.e. the fee is paid and the omitted act is carried out).
- Omitted act must be carried out **together with the request**
  The omitted act must be carried out together with the request. The Office also accepts if the omitted act is carried out **before submission of the request**, so long as the request is made within the two months of the expiry of the original time limit.

  However, if the omitted act is carried out **after the submission of the request**, the request for continuation of proceedings will be rejected as inadmissible. This is so even in the case where the omitted act is carried out subsequent to the request, but still within the time remaining of the two months open for such a request.
- Omitted act must be **carried out**
  The party requesting continuation of proceedings must perform the procedural act whose time limit it missed (e.g. submit evidence in support of the opposition, request proof use, submit observations in reply to the opposition). If the omitted act is not

carried out, the request will be rejected as inadmissible. A request for an extension of time cannot substitute the completion of the omitted act.

The verification of the admissibility of the request does not entail an examination of whether the submission complies with the **substantive** legal requirements of the omitted act. Therefore, notwithstanding that a request for continuation of proceedings may have been found admissible and the relevant fees charged, the submission for 'carrying out the omitted act' may be found not to comply with the **substantive legal requirements** of the act concerned. Therefore, parties should prepare their submissions completing the omitted act with utmost care so that the request for continuation of proceedings could serve its purpose.

Examples:

- in the case of missing the time limit for **substantiation of the opposition**, if together with the request for continuation of proceedings the party submits documents with the purpose of substantiating the opposition, the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted. However, that evidence may be found to be insufficient to substantiate the opposition later in the course of its **substantive** examination;
- in the case of missing a time limit for **submitting proof of use** in opposition proceedings, if together with the request for continuation of proceedings the party submits documents with the purpose of proving genuine use, the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted. However, that evidence may be found to be insufficient to prove genuine use later in the course of its **substantive** examination;
- in the case of missing a time limit for **requesting proof of use** in opposition proceedings, if together with the request for continuation of proceedings the party submits a properly formulated request for proof of use (i.e. unambiguous, unconditional and submitted in a separate document, in compliance with the formal requirements laid down in Article 10(1) EUTMDR), but the earlier mark is not yet subject to the requirement of use (thus does not satisfy the **substantive** requirement of Article 47(2) or (3) EUTMR), the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted, however, the request for proof of use will be rejected.

However, the **formal** requirements of the omitted act must be complied with in order for the omitted act to be considered as duly **introduced** and, thus, 'carried out'.

Example:

- in the case of missing a time limit for **requesting proof of use** in opposition proceedings, if under a separate heading **within** the request for continuation of proceedings (i.e. not in a separate document as required by Article 10(1) EUTMDR) the party requests proof of use, the request for proof of use will not be considered to have been **introduced**, and thus, the omitted act will

not be considered to have been 'carried out'. The request for continuation of proceedings will be rejected as inadmissible.

- Outcome of the request

  If the Office **accepts** the request for continuation of proceedings, the consequences of having failed to observe the time limit will be deemed not to have occurred and the corresponding proceedings will be reopened. If a decision has been taken between the time limit expiring and the request for the continuation of proceedings, the Office will **review it** to determine whether completing the omitted act (or its consequences) alters the outcome or reasoning of the decision, or introduces new elements to the proceedings. If so, to take account of this, the Office will take a different decision that i) can be appealed; and ii) renders the original decision void in its entirety. Otherwise, the Office will confirm in writing that the original decision does not need to be altered.

  Where the first instance decision affected by the request for continuation of proceedings is already appealed before the Boards of Appeal, the relevant department will inform the Boards of Appeal when the request for continuation of proceedings is accepted and about the outcome in the main proceedings.

  If the Office **rejects** the request for continuation of proceedings, the fee will be refunded, or if not yet debited from the party's current account, it will not be charged (Article 105(5) EUTMR and Article 96(5) EUDR). However, as stated above, the party may introduce a new request if there is still time remaining of the two months open for such a request.

4.5 *Restitutio in integrum*

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

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 2

General principles to be respected in the proceedings

1 Adequate reasoning

Articles 94, 95 and 97EUTMR Articles 79, 80, and 83 EUDR

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

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

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

The Office can use facts that are a matter of common knowledge as a basis for its reasoning. Well-known facts are those that are likely to be known by anyone or that may be learnt from generally accessible sources (16/10/2014, T-444/12, Linex, EU:T:2014:886, § 30; 22/06/2004, T-185/02 Picaro, EU:T:2004:189, § 29; 09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 29; 28/09/2016, T-476/15, FITNESS, EU:T:2016:568, § 41; 17/09/2020, C-449/18 P – C-474/18 P, MESSI (fig.) / MASSI et al., EU:C:2020:722, § 74).

The Office is not required to prove the accuracy of these well-known facts and, therefore, it is not obliged to give examples of such practical experience; it is up to the party concerned to submit evidence to refute it (20/03/2013, T-277/12, Caffè Kimbo, EU:T:2013:146, § 46; 11/07/2013, T-208/12, Rote Schnürsenkelenden, EU:T:2013:376, § 24; 21/02/2013, T-427/11, Bioderma, EU:T:2013:92, § 19-22; 08/02/2013, T-33/12, Medigym, EU:T:2013:71, § 20, 25; 07/12/2012, T-42/09, Quadratum, EU:T:2012:658, § 73; 19/09/2012, T-231/11, Stoffmuster, EU:T:2012:445, § 51).

Where a party argues that the circumstances of the proceedings are comparable to a previous Office decision, and the Office departs from the position taken in said decision, this needs to be addressed and particular explanations may be required (see the Guidelines, Part A, General Rules, Section 2, General principles to be respected

in the proceedings, Paragraph 3, Other General Principles of EU Law in relation to the principle of sound administration).

2 The right to be heard

Articles 94 to 97 EUTMR Articles 79 to 83 EUDR

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

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

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

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

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

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

3 Other general principles of EU Law

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

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

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

However, in the light of the principles of equal treatment and sound administration, the Office will take into account the decisions already taken in comparable cases and must carefully consider whether it should decide in the same way or not (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509, § 61 and 66; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 74-75).

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

4 Oral proceedings

Articles 96 to 97 EUTMR
Articles 49 to 55 EUTMDR
Articles 81 to 83 EUDR
Article 11 EUDDR

Article 96 EUTMR and Article 81 EUDR provide that the Office may hold oral proceedings.

Any unofficial contacts such as telephone conversations will not be considered to constitute oral proceedings within the meaning of Article 96 EUTMR and Article 81 EUDR.

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

4.1 Summons

4.1.1 Summons to oral proceedings

Where the Office has decided to hold oral proceedings, it will issue a summons to the parties.

The Office must ensure that the case is ready for decision at the conclusion of the proceedings, unless there are special reasons to the contrary. The Office, in its summons, will request that the parties provide all relevant information and documents prior to the hearing and may also draw the parties' attention to the points that need to be discussed in order for a decision to be taken.

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

If required, and in order to facilitate the hearing, the Office may invite the parties to submit written observations or to submit evidence prior to the oral hearing. The period fixed by the Office for receiving these observations must allow sufficient time for them to reach the Office and then be forwarded to the other parties.

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

For the requirements in relation to the submission of written evidence, see the Guidelines Part A, Section 10, Evidence, paragraph 2, How to submit evidence.

4.1.2 Summons for providing oral evidence by parties, witnesses or experts

Where the Office considers it necessary to hear oral evidence from the parties, witnesses or experts, it will take an interim decision stating the means by which it intends to obtain evidence, the relevant facts to be proven and the date, time and place of the hearing. The summons will provide a summary of this decision and state

the names of the parties to the proceedings and details of the costs, if any, that the witnesses or experts may be entitled to have reimbursed by the Office.

The period of notice provided in such summons will be at least one month, unless the parties, witnesses or experts agree to a shorter period.

The Office may also offer the possibility of providing oral evidence by video conference or other technical means.

4.2 Language of oral proceedings

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

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

4.3 Course of the oral proceedings

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

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

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

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

4.4 Commissioning of and opinions by experts

When the Office summons an expert or a witness to a hearing, it will advise the parties concerned. These may be present and put questions to the person giving evidence. The Office will decide on the form in which the expert opinion is to be submitted and will determine the opportunity for parties to take part in the oral proceedings by videoconference or other technical means.

Where an expert is appointed, the expert opinion will be submitted in the language of the proceedings or accompanied by a translation into that language. A copy of

any written opinion, and of the translation if needed, shall be sent to the parties. Any objection to the appointment of an expert must be submitted in the language of the proceedings, or accompanied by a translation into that language.

The parties may **object to the appointment** of an expert on grounds of incompetence or on the same grounds as those on which objection may be made against an examiner or against a member of a Division or Board of Appeal. The department of the Office concerned will rule on the objection.

4.5 Minutes of oral evidence and of oral proceedings

Article 53 EUTMDR Article 11 EUDDR

Minutes of the taking of oral evidence and of oral proceedings must contain:

- the number of the relevant case and date of the oral proceedings;
- the names of the officials of the Office, their representatives and of the witnesses and experts who are present;
- the submissions and requests made by the parties;
- the means of giving or obtaining evidence; and
- if applicable, the orders or the decision issued by the Office.

In particular, the minutes will not contain the verbatim statements made nor be submitted for approval. However, any statements by experts or witnesses will be recorded so that at further instances the exact statements made can be verified.

The minutes of the testimony of a witness, expert or party do not have to be read out to them for their approval or objection. In addition, they do not need to be signed by the employee who drew them up or the employee who conducted the proceedings or taking of evidence.

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

The minutes will become part of the file of the relevant EUTM or EUD application or registration. They will be notified to the parties.

4.6 Costs of taking evidence in oral proceedings

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

Witnesses and experts summoned or heard by the Office will be entitled to reimbursement of reasonable travel and subsistence expenses, where such expenses are actually incurred. The Office may grant the reimbursement in advance. They will also be entitled to compensation for loss of earnings and payment for their work.

The amounts reimbursed and the advances for expenses are determined by the Executive Director of the Office and are published in the Office's Official Journal. The amounts shall be calculated on the same basis as laid down in the Staff Regulations of the Officials of the Union and the Conditions of Employment of Other Servants of the Union, laid down in Council Regulation (EEC, Euratom, ECSC) No 259/68 and Annex VII thereto. For more details, see Decision No EX-99-1 of the President of the Office of 12/01/1999 as amended by Decision No EX-03-2 of the President of the Office of 20/01/2003.

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

5 Decisions

5.1 Contents

Article 94 EUTMR Article 79 EUDR

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

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

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

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

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

5.2 Decision on costs and fixing of costs

Articles 109, 110 and Annex I A(33) EUTMR

Article 18 EUTMIR

Articles 101, 102 and 103 EUDR and Annex I(18) EUDR

Article 11 EUDIR

The process for apportioning costs has two aspects:

- a decision on costs (i.e. establishing if and who should bear the fees and costs incurred by the other party);
- where it has been established costs are to be awarded, a decision on the fixing of costs (i.e. establishing the amounts to be paid).

In *ex parte* proceedings, there are no decisions on costs. Decisions on costs are limited to *inter partes* proceedings, namely opposition, cancellation and design invalidity proceedings (including the ensuing appeal proceedings or proceedings before the GC and CJEU).

A decision on costs will comprise the fees and costs incurred by the parties to proceedings that are essential to the proceedings, chiefly:

1. representation costs and costs for taking part in oral hearings; and
2. the opposition, cancellation or invalidity fee.

'Representation costs' means the costs for professional representatives within the meaning of Article 120 EUTMR and Article 116 EUDR (i.e. where a legal practitioner, professional representative or association of representatives is appointed). It does not cover situations where an employee representative was used, not even an employee from another company with economic links.

Where a decision on substance is taken, the decision on costs (and a decision on the fixing of costs if applicable) will be included in the decision on substance. The general rule is that the losing party will bear the costs. However, if both parties fail on one or more heads or if reasons of equity so dictate, the Office may determine a different apportionment of costs (e.g. that each party bears its own costs).

For further information on cases where a decision on costs is taken (or not), and standard cases of decision, see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 6.5 and the Guidelines on Examination of Design Invalidity Applications, paragraph 6.2 Decisions on costs.

The decision will fix the amount of costs to be paid by the losing party(ies). The losing party will bear the fees and costs incurred by the other party that are essential to the proceedings. No proof that these costs were actually incurred is required. The decision on the fixing of costs will be included in the decision on costs.

Within one month of the date of notification fixing the amount of the costs, the party concerned may request a review of the amount of costs pursuant to Article 109(8) EUTMR and Article 101(7) EUDR. This request must state the reasons on which it is based and must be accompanied by the corresponding fee.

Any final decision fixing the amount of costs can be enforced pursuant to Article 110 EUTMR and Article 103 EUDR, in simplified proceedings in all EU Member States once it becomes final. For further information, see the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges, paragraph 7.2 Enforcement of the decision on costs.

5.3 Decisions subject to appeal

Articles 66 to 71 and 99 EUTMR

Articles 77 and 87 EUDR

An appeal will lie from decisions of examiners, Opposition Divisions, a department in charge of the register, Cancellation Divisions or any other unit or person appointed by the Executive Director to that effect. These decisions will take effect only as from the date of expiration of the appeal period referred to in Article 68 EUTMR. The filing of the appeal will have suspensive effect.

However, a decision that does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

Where the Office finds that the loss of any rights results from the provisions of the EUTMR and EUDR or acts adopted under them, without any decision having been taken, it will communicate this to the person concerned. The latter may apply for a decision on the matter within two months of notification of the communication, if they consider that the Office's finding is incorrect. The Office will adopt such a decision only where it disagrees with the person requesting it; otherwise it will amend its finding and inform the person requesting the decision.

5.4 Public availability of decisions

Article 113 EUTMR

Article 106 EUDR

Decision No EX-26-07 of the Executive Director of the Office of 1 July 2026 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.

To promote convergence of practices, the Office maintains a case-law database, making publicly available Office decisions defined by the EUTMR, the EUDR and the

legislative acts adopted pursuant to them, as well as judgments of national and EU courts in intellectual property matters.

For reasons of transparency and in the interest of the public, the Office makes its decisions publicly available upon their notification, irrespective of the fact whether the decisions have become final. This includes making decisions publicly available following the examination of an EUTM application upon their notification, although the EUTM application may remain unpublished following its refusal or a withdrawal of the EUTM application (see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 4, Publication). It also includes decisions even if they are annulled at a later stage, or if they do not become final for any other reason.

The Office's decisions will be kept in the database. Requests for removal of decisions from the database will be refused.

However, before the publication of an EUD pursuant to Article 60 or Article 62(4) EUDR, public availability of Office decisions is subject to the restrictions laid down in Article 62(2) and (3) EUDR and Article 14(3) EUDIR. These include EUD applications refused before reaching registration, and registered EU designs subject to deferment of publication. In both cases the disclosure of content is subject to the restrictions in the aforementioned articles.

Making such decisions publicly available in the database is not to be confused with their entry in the register. The outcome of the decisions is recorded in the EUTM or EUD registers only once they are final.

The judgments and decisions are made available in their original language. Official translations are published where available. The case-law database may contain unofficial translations, where indicated, or may facilitate automatic machine translations for information purposes only.

The case-law database is accessible free of charge on the Office's website through the tool eSearch Case Law.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 3

Payment of fees, costs and charges

1 Introduction

Articles 178 to 181 and Annex I EUTMR

Articles 148 to 151 and Annex I EUDR

The specific rules on the payment of fees and charges in European Union trade mark (EUTM) matters are laid down in Articles 178 to 181 and Annex I EUTMR.

The specific rules on the payment of fees and charges in European Union design (EUD) matters are laid down in Articles 148 to 151 and Annex I EUDR.

The full list of fees can be found on the EUIPO website: for EUTMs and EUDs.

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

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

- **Fees** must be paid to the Office by users for the filing and handling of trade mark and design proceedings; the above regulations determine the amounts of the fees and the ways in which they must be paid. Most of the proceedings before the Office are subject to the payment of fees, such as the application fee for an EUTM or an EUD, renewal fees, etc. Some fees have been reduced to zero (e.g. registration fees, transfers).

  Rights of the Office to the payment of a fee are extinguished after 4 years from the end of the calendar year in which the fee fell due (Article 108 EUTMR and Article 100 EUDR).
- **Costs** refer to the costs of the parties in *inter partes* proceedings before the Office, in particular for professional representation (for trade marks see Article 109 EUTMR and Articles 18 and 27 EUTMIR; for designs see Articles 101 to 103 EUDR and Article 11 EUDIR). Decisions in *inter partes* cases can contain, where necessary, a decision on fees and costs of the professional representatives, and must fix the amount. The decision on costs may be enforced once the decision has become final, pursuant to Article 110 EUTMR
  and Article 103 EUDR.
- **Charges** are fixed by the Executive Director of the Office for any services rendered by the Office other than those specified in Annex I EUTMR and Annex I EUDR (Article 178 EUTMR and Article 148 EUDR). The amounts of the charges laid down by the Executive Director will be published in the Official Journal of the Office and can be found on the website under decisions of the Executive Director. Examples are the charges for mediation in Brussels or for certain publications issued by the Office.

The payment of a fee and indication of the nature of the fee and the procedure to which it refers does not dispense with the obligation to meet the other remaining formal requirements of the procedural act concerned unless expressly established

in the EUTMR, the EUDR and the secondary legislative acts (e.g. for renewals). For example, the payment of the appeal fee and the indication of the number of the contested decision is not sufficient to file a valid notice of appeal (31/05/2005, T-373/03, Parmitalia, EU:T:2005:191, § 58; 09/09/2010, T-70/08, Etrax, EU:T:2010:375, § 23-25).

2 Means of Payment

Article 179(1) EUTMR

Article 149(1) EUDR

Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

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

The admissible means of payment are, in most cases, bank transfers, debits from the current accounts held at the Office, and (for certain online services only) debit or credit cards. Cash payments at the Office's premises and cheques are not accepted (03/09/2008, R 524/2008-1, Teamstar / TeamStar).

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

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

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

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

2.1 Payment by bank transfer

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

2.1.1 Bank accounts

Payment by bank transfer can only be made to one of the Office's bank accounts. Details of these accounts are available on the Office's website (https://www.euipo.europa.eu/en/trade-marks/before-applying/fees-payments) under 'Fees and payments'.

Concerning bank charges, it is important to ensure that the full amount reaches the Office without any deductions.

2.1.2 Details that must accompany the payment

Article 179(2) and (3) EUTMR

Decision EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amounts of fees and charges

Every payment must indicate the name of the person making the payment and must include the information the Office needs to immediately identify the payment's purpose.

1. Name

   Regarding **the name of the person making the payment**, the sender's full name must be included in the sender field of the bank transfer.

2. Purpose

   Regarding the **payment's purpose** , the description field of the bank transfer must include the information needed to immediately identify the payment's purpose.

Additionally, it is recommended that contact details be provided either in the sender field or in the description field. This allows the Office to contact the person making the payment should this be necessary.

The Office provides users with a single **payment transaction code**. If a party selects 'bank transfer' as the payment method when filling out an online e-filing form in the User Area, the system will provide a unique eight-digit payment transaction code in the filing receipt. The first two digits stand for the current year, the next five digits are a mix of numbers and letters and the last is a control number (e.g. 2139EDH2).

It is highly recommended to put the payment transaction code in the description field of the bank transfer, preferably at the beginning. This field should also include the nature of the fee, for instance the type of proceedings in abbreviated form (see examples below), and the application or file number. Following these **two crucial items**, other information can be included, such as the name of the party or representative (when different from the person making the payment) and their Office ID number.

Properly filling in the name and description fields in the bank transfer will ensure that the Office identifies the payment correctly and deals with the applications or procedural

acts in a timely manner. Since these fields have character limits, it is recommended to use abbreviations where possible and avoid excessive use of spaces or initial zeros in numbers.

The following are suggested abbreviations (or a combination thereof) for the most common transactions before the Office subject to a fee, and can be used, along with the payment transaction code, to assist in identifying the payment:

Description	Abbreviation
Application fee for EUTM or EUD	EUTM, EUD
International application fee	IA
Renewal fee	REN
Opposition fee	OPP
Cancellation fee	CANC
Appeal	R
Recordal	REC
Conversion	CONV
Inspection of files	IOF
Current Account	CA
Owner ID number	OWN ID
Representative ID number	REP ID

For example, when paying for an EUTM filing where a payment code has been provided (2132EDH2), the EUTM application number appears on the receipt (184583674) and it is filed by a Representative that has an ID with the Office (ID 1024891), the preferred description would be '**2132EDH2 EUTM 184583674 REP ID1024891**'.

Another example, where a Representative (ID 1024891) is making a payment to replenish a current account held with the Office (account No 6361), as there would be no individual payment transaction code, the preferred description would be '**CA6361 REP ID 1024891**'.

Incorrect or insufficient information identifying the file the payment is linked to can cause considerable delays in processing the applications or procedural acts.

When the information supplied is **insufficient for the Office to establish the purpose of the payment**, the Office will contact the person making the payment (if they provided their contact details), and specify a time limit within which the missing information must be provided, failing which the payment will be deemed not to have been made and the sum will be reimbursed (if the sender provides the necessary bank details).

Where there is **contradictory information** in the description field identifying more than one file or proceeding, the Office will contact the sender (if they provided their contact details), and specify a time limit for them to clarify which of the files the payment should be linked to. In the absence of clarification, the payment will in principle be considered to be for the file **identified in first place** in the payment description field. For example, a payment of EUR 850 for an EUTM application with two payment transaction codes (e.g. '**2132EDH2, 2141KHG1, EUTM**') in the description field, each relating to a different EUTM filing. Where the party does not reply to the Office's letter, the payment will be linked to the EUTM application first identified, namely, in the example, the one with the payment transaction code '**2132EDH2**'.

2.2 Payment by debit or credit card

Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

Annex I A EUTMR

Article 149(1) EUDR

Most online services can be paid for by debit or credit card, provided that payment is made for a service requested through the User Area. However, payment by debit or credit card is not yet available for all of the Office's fees. The relevant online tool (e.g. e-filing) will indicate when a fee can be paid by credit or debit card. In particular, debit or credit cards cannot be used to pay charges referred to in Article 178(1) EUTMR and Article 148(1) EUDR or for replenishing a current account.

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

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

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

2.3 Payment by the Office current account

Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges.

It is advisable to open a current account at the Office as, for any request that is subject to time limits, such as filing oppositions or appeals, the payment will be deemed to have been made on time, even if the relevant documentation for which the payment was made (e.g. a notice of opposition) is submitted on the last day of the deadline, provided that the current account has sufficient funds (see 4.3 Payment by current account on page 220) (07/09/2012, R 2596/2011-3, Stair Gates, § 13-14). The date on which the current account is actually debited will usually be later, but payment will be deemed to have been made on the date on which the request for a procedural act is received by the Office, or as otherwise convenient for the party to the proceedings, in accordance with Article 7 of Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges.

The following may hold current accounts (Article 2 of Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025; see the Guidelines, Part A, Section 5, Parties to the Proceedings and Professional representation):

1. natural or legal persons who, in accordance with Article 5 EUTMR and Articles 3 and 17 EUDR, are proprietors of EUTMs or holders of EUDs;
2. persons who may act as representatives in accordance with Article 120 EUTMR and Article 116 EUDR;
3. associations of representatives;
4. natural or legal persons authorised by proprietors of EUTMs or holders of EUDs for the purposes of Article 53(1) EUTMR or Article 66(1) EUDR.

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

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

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

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

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

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

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

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

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

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

Payment of a fee by debiting a current account held by a third party requires explicit written authorisation. The authorisation must be given by the holder of the current account and must state that the account can be debited for a specific fee. The authorisation must reach the Office before payment is due. Payment will be considered effective on the date the Office receives the authorisation.

If the holder is neither the party nor their representative, the Office will check whether such authorisation exists. Where the authorisation is not on file, the Office will inform the party concerned. In the absence of the submission of the holder’s authorisation on time, that is, before payment is due, the party’s request to debit the fee will be disregarded by the Office.

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

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

Once an account has been opened, the Office reserves the right to close a current account by written notification to the holder, in particular where it deems that the use made of the current account was not in accordance with the terms and conditions laid down in Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges, or when it is determined that there has been a misuse of the account. Misuse could be considered in situations such as systematic lack of funds, repeated misuse of third-party authorisations or multiple accounts, non-payment of administrative charges, or situations where the actions of the account holder have led to an excessive administrative burden on the Office. For more details on closure, reference is made to Article 12 of Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges.

3 Time of Payment

Article 178(2) EUTMR

Article 148(2) EUDR

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

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

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

4 Date on which Payment is Deemed to be Made

Article 180(1) and (3) EUTMR

Article 150 EUDR

Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

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

4.1 Payment by bank transfer

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

4.1.1 Late payment with or without surcharge

A payment that is received by the Office after expiry of the time limit will be considered to have been made in due time if evidence is submitted to the Office that the person who made the payment (a) duly gave an order, within the relevant period for payment, to a banking establishment to transfer the amount of the payment, and (b) paid a surcharge of 10 % of the total amount due (up to a maximum amount of EUR 200). Both conditions must be fulfilled in accordance with the judgment of 12/05/2011, T-488/09, Redtube, EU:T:2011:211, § 38, and decision of 10/10/2006, R 0203/2005-1, BLUE CROSS MEDICARE / BLUE CROSS.

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

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

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

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

4.1.2 Evidence of payment and of the date of payment

Article 180(4) EUTMR

Article 24 EUTMIR

Any means of evidence may be submitted, such as:

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

In addition, the following evidence may be submitted:

- acknowledgement of receipt of payment instructions by the bank;

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

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

This list is not exhaustive.

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

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

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

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

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

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

4.2 Payment by debit or credit card

Articles 15 and 16 of Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

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

4.3 Payment by current account

Article 7 of Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

If the payment is made through a current account held with the Office, Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges provides that the date on which the payment is deemed to be made is fixed in order to be convenient for the party to the proceedings. For example, for the application fee for an EUTM or an EUD, the fees will be debited from the current account on the day of receipt of the application. However, the account holder may instruct the Office to debit its account on the last day of the one-month time limit provided for payment. Likewise, upon renewal, the fees for renewal (including the class fees) are debited on the day of receipt of the request, unless the account holder requests otherwise.

If a party withdraws its action on the same day it was submitted, or before the end of the time limit to make the payment, the fee (where applicable) will not be debited from the current account. See paragraphs 5.1 and 5.6 below on the specific conditions for refund of application and renewal fees where payment is made by current account, and Guidelines, Part A, Section 1, Means of Communication, paragraph 3.1.6, Withdrawal of submissions).

5 Refund of fees

Article 108, Article 179(3) and Article 181 EUTMR

Article 149(4) and Article 151(1) EUDR

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

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

Where a fee is to be refunded, the refund will be made to the party directly or to the representative on file (if one is appointed) at the time the refund is made. Refunds will not be made to the original payee where this person is no longer on file.

5.1 Refund of application fees

Article 32 and Article 49(1) EUTMR

Article 46, Article 59 and Article 66 EUDR

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

- (in the case of payment by **bank transfer)** before or at the latest on the same day as the amount actually entered the bank account of the Office;
- (in the case of payment by debit or **credit card)** on the same day as the application containing the debit or credit card instructions/details;
- (in the case of payment by **current account**, and where the holder explicitly requested the application fee to be debited on the last day of the 1-month time limit provided for payment or, where later written instruction has been given to immediately debit the current account within that month) before or at the latest on the same day on which the payment is due to be debited.

In all the above scenarios, a filing date will not be assigned to the application.

Where the basic application fee has to be refunded, any additional class fees (for EUTMs) or deferment fees (for EUDs) paid will be refunded as well.

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

5.2 Refund of the opposition fee

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

If an opposition is deemed not entered (because it was filed after the 3-month time limit), or if the opposition fee was not paid in full or was paid after the expiry of the opposition period, or if the Office refuses protection of the mark *ex officio* pursuant to Article 45(3) EUTMR, the Office must refund the fee (see Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 6.4, Fee refund).

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

Article 15(1) EUTMDR

If an application for revocation or for declaration of invalidity is deemed not to have been entered because the fee was not paid within the period specified by the Office, the Office must refund the fee, including the surcharge (see Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings, paragraph 2.3, Payment and Examination of design invalidity application guidelines, paragraph 3.13 Payment of fees).

5.4 Refund of fees for international marks

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

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

5.5 Refund of appeal fees

Article 33 EUTMDR Article 10 EUDDR

Provisions regarding the refund of appeal fees are dealt with under Article 33 EUTMDR and Article 10 EUDDR.

5.6 Refund of renewal fees

Article 53(8) EUTMR Article 66 EUDR

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

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

Where the owner has filed a request for renewal of an EUTM and subsequently either totally or partially (in relation to some classes) withdraws the renewal request, the renewal fee will only be refunded:

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

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

5.7 Refund of insignificant amounts

Article 181 EUTMR

Article 151 EUDR

Article 18 of Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

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

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

For EUTMs, where an excess sum is paid to cover a fee or a charge, the excess will not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. Insignificant amounts are fixed at EUR 15 by Decision No EX-25-13 of the Executive Director of the Office of 01/12/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges.

6 Fee reduction for an EUTM application filed by electronic means

Annex I A(2) EUTMR Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means

According to Annex I A(2) EUTMR, the basic fee for an application for an individual mark may benefit from a reduction if the application has been filed by electronic means. The applicable rules and procedure for such an electronic filing may be found in Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means in conjunction with Annex I: Conditions of Use of the User Area as established in this decision.

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

7 Decisions on Costs

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

Article 101 EUDR

Article 11 EUDIR

7.1 Fixing of costs

The decision fixing the amount of costs includes the lump sum provided in Article 18 EUTMIR and Article 11 EUDIR for professional representation and fees (see above) incurred by the winning party, independently of whether they have actually been incurred. The fixing of the costs may be reviewed in specific proceedings pursuant to Article 109(8) EUTMR and Article 101(7) EUDR.

7.2 Enforcement of the decision on costs

Article 110 EUTMR

Article 103 EUDR

Any final decision of the Office fixing the amount of costs will be enforceable pursuant to Article 110 EUTMR and Article 103 EUDR.

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

7.2.1 Conditions

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

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

7.2.2 National authority

Each Member State must designate a single national authority for the purpose of verifying the authenticity of the decision and for appending the order for the enforcement of Office decisions fixing costs. The Member State must communicate its contact details to the Office, to the Court of Justice and to the Commission (Article 110(2) EUTMR and Article 103(2) EUDR).

Communication No 1/23 of the Executive Director of the Office of 9 June 2023 concerning the competent authorities under Article 110(2) EUTMR and Article 103(2) EUDR lists all the national authorities and their contact details, as provided by the Member States.

7.2.3 Proceedings

1. The interested party must request the competent national authority to append the enforcement order to the decision. For the time being, the conditions on languages of the requests, translations of the relevant parts of the decision, fees and the need for a representative depend on the practice of the individual Member States and are not harmonised but are considered on a case-by-case basis.
   The competent authority will append the order to the decision without any other formality beyond the verification of the authenticity of the decision. As to wrong decisions on costs or fixing of costs, see paragraph 7.3 below.
2. If the formalities have been completed, the party concerned may proceed to enforcement. Enforcement is governed by the rules of civil procedure in force in the territory where it is carried out (Article 110(2) EUTMR and Article 103(2)

EUDR). The enforcement may be suspended only by a decision of the Court of Justice of the European Union. However, the courts of the country concerned have jurisdiction over complaints that enforcement is being carried out in an irregular manner (Article 110(4) EUTMR and Article 103(4) EUDR).

7.3 Apportionment of costs

In *inter partes* proceedings, the Opposition Division, the Cancellation Division, the Invalidity Division and the Boards of Appeal take, where necessary, a decision on the apportionment of costs. Those costs include in particular the costs of the professional representatives, if any, and the corresponding fees. For further information relating to the apportionment of costs in opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 6.5, Decision on the apportionment of costs. Regarding cancellation proceedings, see the Guidelines, Part D, Cancellation, Section 1, Cancellation proceedings, paragraph 4.3.4, Decision on the apportionment of costs. Regarding design invalidity proceedings, see the Guidelines, Examination of design invalidity applications, paragraph 6.2 Decision on costs. Where the decision contains obvious mistakes as regards the costs, the parties may ask for a corrigendum (Article 102(1) EUTMR and Article 92(1)EUDR) or a revocation (Article 103 EUTMR and Article 93 EUDR), depending on the circumstances (see the Guidelines, Part A, General Rules, Section 6, Revocation of decisions, Cancellation of entries in the Register and correction of errors).

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 4

Language of proceedings

1 Introduction

Article 146 EUTMR

Articles 25 and 26 EUTMIR

Article 24 EUTMIR

Article 137 EUDR

Article 17 EUDIR

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

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

Pursuant to Article 146(6) EUTMR and Article 137(5)(b) EUDR, when a request is filed using a form provided by the Office pursuant to Article 65 EUTMDR and Article 18 EUDDR, the form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

2 From Filing to Registration (Excluding Opposition)

Article 146 EUTMR

Article 137 EUDR

EUTM and EUD applications may be filed in any of the official EU languages (first language). The language of the proceedings will be the language used for filing the application.

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

The second language serves as a potential language for opposition, cancellation and design invalidity proceedings. The second language must be different from the language selected as the first language. The choice of first and second language cannot be changed once the application has been filed.

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

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

For more information on the linguistic regime and translations for EUTM examination, including the possibility of changing the correspondence language, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 6.

3 Opposition and Cancellation

Article 146(5), (7) and (8) EUTMR

Article 3 EUTMDR

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

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

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

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

For more information on the linguistic regime and translations for supporting documents in opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraphs 2.3 and 4.3, and for cancellation proceedings see the Guidelines, Part D, Cancellation, Section 1, Proceedings, paragraphs 2.4 and 3.3.

4 Design invalidity

Article 137(4), (5) and (6) EUDR

An application for a declaration of invalidity may be filed:

- in the first language of the EUD, if the first language is one of the five languages of the Office;

- in the second language, if the first language is not an Office language.

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

For further details on the linguistic regime applicable to design invalidity proceedings, see the Guidelines on Examination of Design Invalidity Applications, paragraph 3.3 Language of proceedings.

5 Other Requests

5.1 Before registration (excluding opposition)

Article 146(6) EUTMR

Article 65 EUTMDR

Article 24 EUTMIR

Article 137(5) EUDR, Article 18 EUDDR and Article 15 EUDIR

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

For example, where the first language of the EUTM application is Bulgarian, and the second language is German, a request for transfer of ownership of the EUTM application can be filed in either Bulgarian or German.

Supporting evidence (if needed) may be in any of the official EU languages. However, if it is not in the language of the proceedings, the Office may require a translation into the language of the proceedings.

For more information on the linguistic regime and translations concerning Register operations please see the respective sections in the Guidelines, Part E, Register Operations.

5.2 After registration (excluding cancellation and design invalidity)

Article 146(6) EUTMR

Article 65 EUTMDR

Article 24 EUTMIR

Article 137(4)EUDR, Article 18 EUDDR and Article 15 EUDIR

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

Furthermore, post-registration requests concerning the same registered EUTM or EUD do not necessarily have to be submitted in the same language. For example, after an EUTM has been registered, the EUTM proprietor may file a request for the registration of a licence in English and, a few weeks later, file a request for renewal in Italian and/or a transfer of ownership request in French. The only requirement is that the requests are submitted in one of the five Office languages.

Supporting evidence (if needed) may be in any of the official EU languages. However, if it is not in the language of the proceedings, the Office may require a translation into the language of the proceedings.

For more information on the linguistic regime and translations concerning Register operations, please see the respective sections in the Guidelines, Part E, Register Operations.

6 Invariable Nature of the Language Rules

The Regulations allow certain choices to be made from among the available languages in the course of the proceedings (see above) and, during specified periods, a different language to be chosen as the language of proceedings for opposition, cancellation and design invalidity. However, with those exceptions, the language rules are invariable. In particular, the first and second languages may not be amended in the course of the proceedings.

7 Translations and their Certification

Article 146(10) EUTMR Articles 24 to 26 EUTMIR Articles 16 and 17 EUDIR

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

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

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

8 Non-compliance with the Language Regime

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

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 5

Parties to the Proceedings and Professional representation

1 Introduction - Parties to the Proceedings and Principle of Representation

Articles 3, 5, 119 and 120 EUTMR
Article 7(b) EUTMIR
Articles 14, 73, 115 and 116 EUDR
Article 26 EUDDR

Any natural or legal person, including authorities established under public law, may be the proprietors of a European Union trade mark (EUTM) and of a registered Eropean Union design (EUD), in general, may be parties to proceedings before the Office. The only exceptions are certain limitations on the ownership of collective and certification marks (see the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapters 15 and 16, on collective and certification marks respectively).

Companies or firms and other legal bodies will be regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts, and to sue and be sued.

Persons having their domicile or their principal place of business or a real and effective industrial or commercial establishment within the European Economic Area (EEA), which consists of the European Union (EU) and Iceland, Liechtenstein and Norway, are not required to be represented in any proceedings before the Office in either trade mark or design matters (see paragraph 5.1.1).

Natural persons not domiciled in or legal persons that do not have their principal place of business or a real and effective industrial or commercial establishment in the EEA must be represented by a representative based within the EEA, unless appointment of a representative is not mandatory (see paragraph 5.1 for any exceptions to the general rule). See paragraph 5.2.1 on the consequences of not appointing a representative, when representation is mandatory, once the EUTM or EUD application has been filed.

Representatives in the sense of Articles 119 and 120 EUTMR and Article 115 and 116 EUDR must have a place of business or employment in the EEA.

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

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

The first part of this section (paragraphs 2 and 3) deals with the identification of all parties to proceedings before the Office.

The second part of this section (paragraph 4) sets out the different types of representatives.

The third part of this section (paragraphs 5 to 9) deals with the appointment of representatives or the failure to do so, and the authorisation of representatives.

The final part of this section (paragraphs 10 and 11) deals with changes and corrections in names and addresses of parties in pre-registration stages. For further information on changes to registrations, see the Guidelines, Part E, Register operations, Section 1, Changes in a registration and the Design Guidelines, Examination of applications for registered European Union designs, paragraph 11.

2 Parties to proceedings before the Office

Article 112(1) EUTMR

Article 105 EUDR

Decision No EX-26-07 of the Executive Director of the Office of 1 July 2026 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

This section of the Guidelines deals with the general provisions on parties to the proceedings. For information on the parties' entitlements in the different procedures before the Office, please see the rules in the relevant sections of these Guidelines. For example, for further information on:

- persons entitled to own EUTM Collective marks and EUTM certification marks, see the Guidelines, Part B, Section 4, Absolute Grounds for Refusal, Chapter 15 Collective Marks, Paragraph 2; and the Guidelines, Part B, Chapter 16 Certification marks, Paragraph 4;
- specific aspects of persons entitled to file an opposition, see the Guidelines, Part C, Section 1, Opposition Proceedings, Paragraph 2.4.2.6;
- specific aspects of persons entitled to file an application for cancellation, see the Guidelines, Part D, Section 1, Cancellation Proceedings, Paragraph 2.1;
- specific aspects of persons entitled to file an application for international application based on an EUTM (EUIPO as Office of origin), see the Guidelines, Part M, International Marks, Paragraph 2.1.3.1;
- specific aspects of persons entitled to file an application for the declaration of invalidity of a EUD, see the Guidelines, Examination of Design Invalidity Applications, Paragraph 3.5;

All persons that identify themselves as parties to proceedings before the Office are entered into the Office's database and are allocated an identification (ID) number. The ID number can be viewed in the Office's eSearch plus tool available on the Office's website.

The Office encourages parties to always use their ID number to import existing details instead of manually inserting the address and/or any other contact details on any form or in any communication to the Office as this leads to less errors. However, the ID

number cannot replace the party's name where it needs to appear on any form or communication.

3 Identification of parties to the proceedings

Article 3 EUTMR

Article 2(1)(b) EUTMIR

Articles 1(1)(a) and 1(2) EUDIR

Decision No EX-26-07 of the Executive Director of the Office of 1 July 2026 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

EUTM and EUD applicants are identified pursuant to the criteria laid down in Article 2(1)(b) EUTMIR and Articles 1(1)(a) and 1(2) EUDIR respectively. This criteria applies, *mutatis mutandis*, to all parties to proceedings before the Office (e.g. opponents, applicants for revocation or for a declaration of invalidity, applicants for registration of a transfer).

The information required to identify a party is:

- name;
- address;
- the country of domicile if a natural person, or the country in which it is domiciled or has its seat or an establishment if a legal entity.

In an application for an EUD, natural persons must also indicate their nationality.

If the party to the proceedings has previously been allocated an ID number by the Office, it is sufficient to indicate the ID number and the party's name.

Where there are multiple parties to the proceedings, the same identification requirements are required for each one of them.

Where the name and legal address of a party, or their professional representative, are recorded in the EUTM or EUD Registers, they will be kept indefinitely (pursuant to Article 111(9) EUTMR and Article 105(5) EUDR).

For information on what data appears in the EUTM and EUD Registers, please see Annex I and II of Decision No EX-26-07.

3.1 Name

3.1.1 Natural persons

Names of **natural persons** must include the person's first name(s) and surname(s) as they appear in official personal identification documents (example: John Steven Smith instead of J.S.Smith).

Where the name provided appears to be that of a physical person but the party has indicated that they are a 'legal entity' and filled in the legal form section with an indication which is not a legal form as such (such as free professional, freelance, sole proprietorship, etc.), the Office will send a notification of a deficiency. If the applicant fails to reply, the Office will change the type of person from 'legal entity' to 'natural person'.

For example, 'John Smith', identified as being a legal entity with the legal form 'freelance', will be changed to a natural person and the legal form deleted.

A natural person may provide any business or trading name as an optional indication in addition to their legal name. For example, natural person 'John Smith trading as Smithy's' is acceptable. See paragraph 3.1.2 for more information on the use of business or trading names.

3.1.2 Legal entities

Names of **legal entities** must be indicated by their official designation (full statutory name) and include the legal form of the entity (if applicable), which may be abbreviated in a customary manner (for example, S.L., S.A., Ltd, PLC). The company's national identification number may also be specified.

Legal entities may provide their business or trading names as an optional indication **in addition to** their official designation (typically indicated by using the legal name followed by 'trading as' or 'acting as' in the title). However, business or trading names must not be used alone, that is to say **instead of** the name of the legal entity. As a general rule, the Office will assume that applicants identified through mere business or trading names without any legal form are not entitled to own property in their own name unless evidence is submitted to the contrary.

For example, 'J. Smith Ltd trading as Smithy's' would be acceptable where 'J. Smith' is the legal name, 'Ltd' is the legal form, and 'Smithy's' is the trading name. Using the same example, 'Smithy's' by itself (with no legal form), will be objected to. See also the example under paragraph 3.1.1.

The name of a legal entity in the process of being founded will be accepted.

The Office strongly recommends indicating the state of incorporation for companies based in the United States of America, where applicable. Companies with the same name and legal form, but with a different state of incorporation, are considered to be different legal entities and are therefore assigned different ID numbers in the database.

If the legal form is not specified or is incorrectly indicated, a deficiency letter requesting this information will be issued. If the deficiency is not remedied the respective request

will be rejected as the party cannot be correctly identified pursuant to Article 2(1)(b) EUTMIR and Article 1(1)(a) and 1(2) EUDIR.

3.2 Address

The Office recognises two types of address referred to in Article 2(1)(b) EUTMIR and Article 1(1)(a) and 1(2) EUDIR: the official 'legal' address of a party and the 'address for service'.

3.2.1 Legal address

Only one legal address should be indicated for each applicant.

This is the address where the party has its domicile, principal place of business or real and effective industrial or commercial establishment. It is a compulsory requirement for identification. Furthermore the legal address is necessary for the Office to establish if the party needs to be represented or not pursuant to Article 119(2) EUTMR and Article 115(2) EUDR.

For legal persons, the legal address is understood to be where the party has its seat, which is the company's registered headquarters or registered head office as appearing on the extract of the company register.

The address must contain all the identification elements required.

If any of these particulars is missing, the Office will issue a deficiency and set a time limit by which to remedy the deficiency or to provide a valid reason for omitting it.

A post office box or a forwarding (virtual) address on its own does not constitute a legal address unless it can be proven that it is indeed registered as the company's address (e.g. by submitting an extract of the company register).

3.2.2 Address for service

An address for service (also referred to as a correspondence address) is an optional second address a party can provide. The Office will send any post to that address in EUTM-related proceedings.

By default, any correspondence by post in EUTM-related proceedings will be addressed to the party's legal address unless a different address for service is provided.

3.3 Other contact details

It is not compulsory to provide additional contact details, such as telephone numbers or email addresses. However, providing an email address is recommended to facilitate setting up a user account.

4 Representatives: Who May Represent

Article 119(3) and Article 120(1)(a) and (b) EUTMR

Article 74(8) EUTMDR

Article 115(3), Article 116(1)(a) and (b) and Article 116(8) EUDR

Article 26 EUDDR

In all Member States of the EEA, representation in legal proceedings is a regulated profession and may only be exercised under particular conditions. In proceedings before the Office, the following categories of natural persons who can act as a representative are distinguished.

Legal practitioners (Article 120(1)(a) EUTMR and Article 116(1)(a) EUDR) are professionals who, depending on the national law, are fully entitled to represent third parties before national offices (see paragraph 4.2).

Other professionals (Article 120(1)(b) EUTMR and Article 116(1)(b) EUDR) need to comply with further conditions and need to be included on a specific list maintained by the Office for this purpose (the Office's list of professional representatives). Amongst these, two further groups need to be distinguished: those who may represent only in EUD proceedings ('designs list') and those who may represent in both EUTM and EUD proceedings (see paragraph 4.3). The Office refers to these other professionals collectively as '**professional representatives**'.

Several legal practitioners and professional representatives may be organised in entities called '**associations of representatives**' (Article 74(8) EUTMDR; Article 26 EUDDR) (see paragraph 5.4.3).

The final category of representatives is made up of **employees** acting as representatives for the party to proceedings before the Office (Article 119(3) EUTMR, first alternative; Article 115(3) EUDR, first alternative) or employees of **economically linked** legal persons (Article 119(3) EUTMR, second alternative; Article 115(3) EUDR, second alternative) (see paragraph 4.4).

Employees are to be distinguished from **legal representatives** under national law (see paragraph 4.5).

4.1 ID numbers and the database

Article 116(8) EUDR

All persons that identify themselves as representatives for, or employees of, individual parties to proceedings before the Office, and that fulfil the requirements provided by the regulations, are entered into the database and obtain an ID number. The database has a double function, providing all the relevant contact details under a specific ID number

for any type of representative, as well as being the public information on the Office's list of professional representatives or designs list ([12]).

A representative may have several IDs.

- Associations of representatives may have different IDs for different legal addresses.
- Individual representatives may have one ID as an employee representative and a different ID as a legal practitioner in their own right.
- If a person confirms that they work for two different associations of representatives or from two different addresses, they can have two different numbers attributed. Only the first ID number will be published in the Official Journal.
- It is also possible to have two different IDs, one as a legal practitioner and one as an Office professional representative where such a dual qualification is allowed under national law (which is not the case, for example, in France, see Annex I). The Office almost invariably refuses requests from legal practitioners to be entered on its list of professional representatives as they are automatically entitled to appear in the database as 'legal practitioners' in their own right and do not need to be admitted onto the Office's list of professional representatives.

Where an ID is requested for any type of representative, the Office may require the person to prove the real and effective nature of their establishment at the business address(es) identified. Any evidence submitted should not be limited to the mere existence of premises at these addresses but should prove real and effective business or employment being carried out and invoiced from the different locations. The name and the business address of legal practitioners and professional representatives are publicly disclosed in the Office's database and in the EUTM and EUD Registers.

An ID will not be granted for a post office box or a simple address for service in the EEA. See paragraph 3.2 for the difference between the 'legal address' and the 'address for service'.

In the database, representatives are identified as: association, employee, lawyer (legal practitioner), and professional representative. Internally, the latter category is divided into two subcategories: type 1 consists of persons exclusively entitled to represent in EUD matters under Article 116(1)(c) EUDR, and type 2 consists of persons entitled to represent in both trade mark and design matters under Article 120(1)(b) EUTMR and Article 116(1)(b) EUDR.

On any form and in any communication sent to the Office, the representative's address and contact details may, and preferably should, be replaced by the ID number attributed by the Office, together with the representative's name.

The ID number can be found by consulting any of the files of the representative in question, or in the advanced search options of the Office's eSearch plus tool available on the EUIPO website: https://euipo.europa.eu/eSearch/#advanced/representatives.

12 Regarding the processing of mandatory personal data in relation to the tasks of the Office, which includes contact details, see the EUIPO's explanatory note on the processing of personal data within the framework of the EUIPO's tasks as laid down in the EUTMR and EUDR (accessible in the 'Data Protection' section of the Office's website).

4.2 Representation by legal practitioners

Article 120(1)(a) EUTMR Article 116(1)(a) EUDR

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

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

4.2.1 The term `legal practitioner'

The professional titles for each EEA Member State are identified in the column 'Terminology for legal practitioner' in Annex 1 of this Section.

4.2.2 Qualification

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

4.2.3 Nationality and place of business

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

The place of business must be in the EEA. A post office box address or an address for service does not constitute a place of business (see paragraph 3.2.1, above, regarding the legal address). The place of business need not necessarily be the only place of business of the representative. Furthermore, the place of business may be in a Member State of the EEA other than the one in which the legal practitioner is admitted to the bar. However, legal practitioners who have their sole place of business outside the EEA are not entitled to represent before the Office even when they are admitted to practise in one of the Member States of the EEA. The Office may at any time require evidence that the address provided is, or continues to be, a real and effective place of business.

Where an association of representatives, such as a law firm or a law office, has several places of business, it may perform acts of representation only under a place

of business within the EEA, and the Office will only communicate with the legal practitioner at an address within the EEA.

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

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

Legal practitioners referred to in Article 120(1)(a) EUTMR and Article 116(1)(a) EUDR who fulfil the conditions laid down in this Article are automatically entitled as of right to represent their clients before the Office. This basically means that if a legal practitioner is entitled to act in trade mark and/or design matters before the central industrial property office of the Member State of the EEA in which they are qualified, they will also be able to act before the Office.

Legal practitioners are not entered on the list of professional representatives to which Article 120(2) EUTMR and Article 116(1)(b) and (c) EUDR refer, because the entitlement and the special professional qualifications referred to in those provisions relate to persons belonging to categories of professional representatives specialising in industrial property or trade mark matters, whereas legal practitioners are by definition entitled to be representatives in all legal matters.

If a 'legal practitioner' who has already been attributed an identification number as a legal practitioner requests entry on the list of 'professional representatives', the ID number will be maintained but the status will be changed from 'legal practitioner' to 'professional representative' following prior consultation with the applicant. Please refer to paragraph 4.1 above concerning the situations where multiple ID numbers may be allocated to one person.

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

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

Article 120(1)(b) and Article 120(2) EUTMR Article 116(1)(b) and (c) EUDR

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

1. the Office's list of professional representatives according to Article 120(1)(b) EUTMR and Article 116(1)(b) EUDR (in trade mark and design matters);
2. the list of professional representatives according to Article 116(1)(c) EUDR (in design matters).

For this category of professional representatives, the entry on the Office's list of professional representatives entitles them to represent third parties before the Office. A representative who is entered on the Office's list of professional representatives, referred to in Article 120(1)(b) EUTMR, is automatically entitled to represent third parties in design matters according to Article 116(1)(b) EUDR and will not be entered on the special list of professional representatives in design matters ('designs list').

If a person on the list maintained under Article 120(1)(b) EUTMR requests entry on the designs list maintained for professional representatives authorised to act exclusively in European Union design matters under Article 116(1)(c) and (4) EUDR, the request will be rejected.

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

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

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

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

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

4.3.1 Entitlement under national law

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

Article 120(2)(c) EUTMR Article 116(1)(b) EUDR

In a large number of Member States of the EEA, entitlement to represent third parties before the national office in trade mark matters is conditional upon possession of a special professional qualification (Article 120(2)(c) EUTMR, first alternative;

Article 116(4)(c) EUDR, first alternative). Therefore, in order to be entitled to act as a representative, the person must have the required qualification.

In other Member States of the EEA, there is no such requirement for a special qualification, that is to say, representation in trade mark matters is open to anybody. In this case, the person involved must have regularly represented third parties in trade mark or design matters before the national office concerned for at least 5 years (Article 120(2)(c) EUTMR, second alternative; Article 116(4)(c) EUDR, second alternative). A subcategory of this category of Member States of the EEA consists of those States that have a system officially recognising a professional qualification to represent third parties before the national office concerned even though such recognition is not a prerequisite for the exercise of professional representation. In this case, persons so recognised are not subject to the requirement of having regularly acted as a representative for at least 5 years.

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

4.3.1.1 First alternative - special professional qualifications

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

4.3.1.2 Second alternative - 5 years' experience

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

It is possible for the Executive Director of the Office to grant an exemption from this requirement (see paragraph 4.3.4 below).

4.3.1.3 Third alternative - recognition by a Member State of the EEA

Where, in the EEA Member State concerned, the entitlement is not conditional upon possession of special professional qualifications, that is to say, representation in trade mark matters is open to anybody, persons whose professional qualification to represent natural or legal persons in trade mark and/or design matters before the central industrial property office of one of the Member States of the EEA is officially recognised in accordance with the regulations laid down by that State will not be subject to the condition of having exercised the profession for at least 5 years.

4.3.2 Nationality and place of business

Article 120(2) and (4) EUTMR

Articles 116(4) and 116(6) EUDR

A professional representative requesting to be entered on the list must be a national of a Member State of the EEA.

It is possible for the Executive Director of the Office to grant an exemption from the nationality requirement (see paragraph 4.3.4 below).

A professional representative requesting to be entered on the list must have his or her place of business or employment in the EEA. A post office box address or an address for service does not constitute a place of business. The place of business or employment need not necessarily be the only place of business or employment of the representative. The Office may at any time require evidence that the address provided is, or continues to be, a real and effective place of business or employment.

4.3.3 Certificate

Article 120(3) EUTMR

Article 116(5) EUDR

Fulfilment of the abovementioned conditions laid down in Article 120(2) EUTMR and Article 78(4) EUDR must be attested by a certificate provided by the national office concerned. Some national offices issue individual certificates while others provide the Office with block certificates.

Where block certificates are issued, the national offices send regularly updated lists of professional representatives entitled to represent clients before their office. In these cases the Office will check the indications in the request against the entries on the lists communicated to the Office.

Otherwise, the person concerned must accompany his or her request with an individual certificate. The applicant must complete the application form (which can be accessed online at https://www.euipo.europa.eu/en/online-services) and send it to the respective industrial property office of the Member State concerned. The certificate must be completed by the respective industrial property office.

4.3.4 Exemptions

Article 120(4) EUTMR

Article 116(6) EUDR

The Executive Director of the Office may grant exemption from the requirement to be a national of a European Economic Area (EEA) Member State, provided that the requestor demonstrates that they are a 'highly qualified professional'. The Executive Director may also grant an exemption from the requirement of having regularly acted as a representative in trade mark matters for at least 5 years, provided that the requestor demonstrates that they have acquired the required qualification in another way. This power is of a discretionary nature.

The broad discretionary power to grant exemptions from the 5 years' experience requirement or from the EEA nationality requirement pursuant to Article 120(4) EUTMR and Article 116(4) EUDR will be exercised by the Executive Director of the Office with due regard to the fact that the provision (i) does not confer any right to the person requesting the exemptions, (ii) is conceived as an exception to the general rule, which needs to be applied restrictively and on a strictly individual basis only, and (iii) can also be based on more general considerations such as the absence of any need for additional professional representatives.

1. Exemptions from the 5 years' experience requirement

   Exemptions from the requirement of 5 years' experience (Article 120(4)(a) EUTMR) are limited to cases where the qualification to act as a representative in trade mark or design matters was not achieved before the central industrial property office concerned, but was acquired in another way, for the equivalent period of at least 5 years.

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

   The experience equivalent to at least 5 years of habitually acting as a representative before the central industrial property office concerned, to be established by the requestor (with supporting evidence), must have been obtained in the EEA Member State concerned. For example, if an exemption is requested from the 5-year requirement to act before the central industrial property office of Member State 'A' (e.g. Malta), the evidence of habitually acting as a representative must emanate from that same Member State (Malta), and not from another EEA Member State (e.g. Ireland).

2. Exemptions from the EEA nationality requirement

   Exemptions from the EEA nationality requirement are limited to requestors that comply with the requirements of Article 120(2)(b) and (c) EUTMR or Article 116(4)(b) and (c) EUDR, namely that they have their place of business in the EEA, and are

entitled under national law to represent third parties before the national industrial property office.

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

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

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

The onus is on the requestor to demonstrate (with supporting evidence) that they meet the 'highly qualified professional' requirement. A request for exemption, which is not subject to any time limit, may be filed using the form provided for this purpose available on the EUIPO website. All the arguments and evidence the requestor deems necessary to support the claims made must be submitted together with the request. The Executive Director will decide on the basis of that request.

Decisions of the Executive Director rejecting the exemption requested can be appealed before the General Court of the European Union under Article 263(4) TFEU.

4.3.5 Procedure for entry on the list

Articles 66(1) and 120(3) EUTMR, Article 162 EUTMR Articles 77(1), 116(5) and 143 EUDR

Entry on the list is confirmed by notification of a positive decision, which contains the indication of the ID number attributed to the professional representative. Entries on the Office's list of professional representatives or designs list are published in the Official Journal of the Office.

If any of the requirements for entry on the list of professional representatives are not fulfilled, a deficiency will be notified. If the deficiency is not remedied, the request for entry on the list will be rejected. The party concerned may file an appeal against this decision.

Professional representatives may obtain an additional copy of the decision free of charge.

The files relating to requests for entry on the Office's list of professional representatives or designs list are not open to public inspection. Where a request for entry on the list of professional representatives is accompanied by a request for exemption because one of the necessary conditions for entry on the list is missing (see paragraph 4.3.4 above), where the granting of that exemption has been refused by a final decision of the Executive Director, there will be no subsequent decision refusing entry on the list of representatives. This formal subsequent decision will only be issued where the requester explicitly requests it.

4.3.6 Amendment of the list of professional representatives

4.3.6.1 Deletion

First alternative — upon own request

Article 120(5) EUTMR Article 116(7) EUDR Article 26 EUDDR

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

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

Second alternative — automatic deletion from the list of professional representatives

Article 75(1) EUTMDR Article 26 EUDDR

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

1. in the event of the death or legal incapacity of the professional representative;
2. where the professional representative is no longer a national of a Member State of the EEA;
3. where the professional representative no longer has a place of business or employment in the EEA; or
4. where the professional representative is no longer entitled to represent third parties before the central industrial property office of a Member State of the EEA.

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

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

The deletion will be entered in the files kept by the Office. The decision of the deletion will be notified to the representative and the deletion will be published in the Official Journal of the Office.

4.3.6.2 Suspension of the entry on the list

Article 75(2) EUTMDR

Article 26 EUDDR

Upon notification by the relevant national industrial property office of a decision on the suspension of the entitlement to represent natural or legal persons before the respective national industrial property office, the entry of the professional representative on the Office's list of professional representatives or designs list will be suspended. The representative will be informed accordingly.

4.3.7 Reinstatement in the list of professional representatives

Article 75(3) EUTMDR

Article 26 EUDDR

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

A new request must be submitted in accordance with the normal procedure for obtaining an entry on the list of professional representatives (see paragraph 4.2 above).

4.4 Representation by an employee

Article 119(3) EUTMR

Articles 1(j) and 74(1), Article 65(1)(i) EUTMDR

Article 115(3) EUDR

Article 18 EUDDR

4.4.1 General considerations

A party to the proceedings before the Office, whether a natural or a legal person, having their domicile or principal place of business, or a real and effective industrial or commercial establishment in the European Economic Area (EEA), may be represented before the Office by an employee (Article 119(3) EUTMR, first sentence and Article 115(3) EUDR, first sentence).

Employees of the legal persons described above may also represent other legal persons that have economic connections with the first legal person, even if those other legal persons do not have their legal address within the EEA (Article 119(3) EUTMR, second sentence and Article 115(3) EUDR, second sentence).

The acceptability of an employee representative therefore depends on whether the represented party is a natural or a legal person, whether the represented party has its legal address within or outside the EEA, and whether the employee is employed directly or indirectly by the represented party, as explained below.

For the definition of legal address, as identified in the represented person's ID number, see paragraph 3.2.1.

The following situations can therefore be differentiated:

- Natural persons whose legal address is within the EEA may be represented by an employee employed by them. The employee may or may not work from the represented natural person's legal address, but the employee must be employed by this natural person. For example, the employee may work from a place of business that is different from the legal address of the natural person.
- Natural persons whose legal address is outside the EEA cannot be represented by an employee.
- Legal persons whose legal address is within the EEA may be represented by an employee directly employed by them. This means the employee may work directly for them at this legal address. They may, however, also be employed by them indirectly. This 'indirect' employee can either work for the represented legal person through another place of business or another real and effective establishment owned by them under a different address within the EEA; or be employed by another legal person within the EEA that is economically linked to the first legal person.
- Legal persons whose legal address is outside the EEA may only be represented by an 'indirect' employee, through an employee working for the represented legal person through another place of business or real and effective establishment owned by them under a different address within the EEA, or be employed by another legal person within the EEA that is economically linked to the first legal person. Regarding the requirements of indirect employee representation see paragraph 4.4.2.

For all these situations the employee representative must be a natural person and be located in the EEA. An employee located outside the EEA may not represent their employer before the Office.

On the forms made available by the Office, the employee signing the application or request must fill in the field reserved for representatives by indicating their name, address (of employment) and select the checkboxes relating to employee representative.

The name(s) of the employee(s) will be entered in the database and published under 'representatives' in the EUTM and EUD Bulletins and in the Office's database accessible through the eSearch plus tool. However, they will not be entered in the respective EUTM and EUD Registers.

Where employees act for their employer, this is not a case of professional representation under Article 120(1) EUTMR or Article 116(1) EUDR. As such, Article 109(1) EUTMR and Article 11(1)(b) and (c) EUDIR are not applicable for the apportionment and fixing of costs in *inter partes* proceedings (17/07/2012, T-240/11, MyBeauty (fig.) / BEAUTY TV et al., EU:T:2012:391, § 15 *et seq.*).

No authorisation needs to be submitted, unless the Office or any party to the proceedings requests it.

The Office will verify the first time an employee representative claims to represent an employer. At a later stage it may also do so where it has reason to doubt that the employment relationship continues to exist, such as when different addresses are indicated or when one and the same person is nominated as the employee of different legal persons.

4.4.2 Indirect employment

As outlined in paragraph 4.4.1 when a legal person is a party in proceedings before the Office, they can also be represented by an employee, even if that employee does not work directly for the legal person identified by the legal address. This is particularly relevant for legal persons with a legal address outside the EEA since representation is mandatory for them (see paragraph 5.1 below). These non-EEA legal persons may be represented by an employee in the following two scenarios:

- first, legal persons with a legal address outside the EEA , but having a real and effective industrial or commercial establishment within the EEA , may be represented before the Office by an employee of this EEA-based establishment;
- second, legal persons with a legal address outside the EEA may be represented by an employee of another legal person within the EEA provided that both legal persons are economically connected.

For the definition of legal address as identified in the represented persons ID number, see paragraph 3.2.1 .

In the first scenario, to successfully claim an employee representative, the represented legal person must show that even though their legal address is outside the EEA, they also have a real and effective industrial or commercial establishment in the EEA, e.g. by proving that they own or control a branch, agency or any other kind of commercial establishment (including subsidiaries) in the EEA to such extent that it can be considered an extension of the non-EEA legal person.

The concept of 'branch, agency or other establishment' implies a place of business which has the appearance of permanency, such as the extension of a parent body, has a management and is materially equipped to negotiate business with third parties so that the latter, although knowing that there will if necessary be a legal link with the parent body, the office of which is abroad, do not have to deal directly with that parent body but may transact business at the place of business constituting the extension (see definition in 22/11/1978, C-33/78, Somafer, EU:C:1978:205, § 12; also quoted in 22/09/2016, T-512/15 , Sun Cali (fig.), EU:T:2016:527, § 30).

Proof of employment at the EEA-based establishment must also be provided for the employee representative.

For example, the EUTM applicant is a company with a legal address in the US. However, it can **prove** that it owns a branch in Spain. The party must **claim and prove** that the natural person identified as the employee representative works for the establishment in Spain. An employee working for this Spanish establishment can then represent the US EUTM applicant before the Office.

In the second scenario, to successfully claim an employee representative, the legal assessment is similar. Firstly, the legal person must show that the other legal person exists within the EEA; secondly, that there is a sufficiently strong economic connection between the represented party and the EEA-based legal person; and thirdly, that the employee representative truly works for the EEA-based legal person.

For example, 'Company A LLC' with a legal address in the US is party to the proceedings before the Office. It can show that it is economically linked to 'Company B Ltd.' in Ireland. John Smith is employed by 'Company B Ltd.' in Ireland. Consequently, John Smith may act as an employee representative of the US-based 'Company A LLC'.

Similar to the first scenario, economic connections only exist when there is economic dependence between the two legal persons, either in the sense that the party to the proceedings is dependent on the employer of the employee concerned, or vice versa. This economic dependence may exist for example:

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

However, the following do not establish economic links:

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

All the arguments and evidence the requester deems necessary to support the claims, including any evidence to prove the existence and nature of the link between the different entities and any proof of employment, must be submitted together with the request. If this evidence is not submitted, the Office will issue a deficiency.

4.5 Legal representation and signature

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

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

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

It should be borne in mind, however, that a legal person addressing the Office from outside the EEA must be represented by a professional representative within the EEA, unless appointment of a representative is not mandatory (see paragraph 5.1 for any exceptions to the general rule). See paragraph 5.2.1 on the consequences of not appointing a representative, when representation is mandatory, once the EUTM or EUD application has been filed.

5 Appointment of a Professional Representative

5.1 Conditions under which appointment is mandatory

Subject to the exceptions outlined in paragraph 4.4, the appointment of a professional representative is mandatory for parties to proceedings before the Office that do not have their domicile or their principal place of business, or a real and effective industrial or commercial establishment **in the EEA**. This obligation exists for all proceedings before the Office, except for the filing of an application for an EUTM or an EUD, an application for renewal of an EUTM or an EUD, and an application for inspection of files.

The same applies to international registrations designating the EU. For further information on this point, see the Guidelines,Part M, International marks and the Guidelines on Examination of applications for registered European Union designs, 12 International registrations, 12.3.3.4 Professional representation.

5.1.1 Domicile, principal place of business, or real and effective industrial or commercial establishment

The criterion for mandatory representation is determined by the legal address of the represented person, not their nationality. For example, a French national domiciled in

Japan has to be represented, but an Australian national domiciled in Belgium does not have to be. For more information on the legal address, see paragraph 3.2.1.

The criterion is not fulfilled where the party to the proceedings merely has a post office box or an address for service in the EEA, nor where the applicant indicates the address of an agent with a place of business in the EEA. For more information on situations where a party may have a legal address outside the EEA but may also have a real and effective industrial or commercial establishment within the EEA, please see paragraph 4.4.1, which deals with this concept for the purpose of determining if an employee representative is entitled to represent.

5.1.2 The notion of 'in the EEA'

Article 119(2) EUTMR

Article 115(2) EUDR

In applying Article 119(2) EUTMR and Article 115(2) EUDR, the relevant territory is the territory of the EEA, which comprises the EU and the countries of Iceland, Liechtenstein and Norway.

5.2 Consequences of non-compliance when appointment is mandatory

Article 120(1) EUTMR Article 116(1) EUDR

Where a party to proceedings before the Office is in one of the situations described under paragraph 5.1, but has failed to appoint a professional representative within the meaning of Article 120(1) EUTMR or Article 116(1) EUDR in the application or request, or where compliance with the representation requirement ceases to exist at a later stage (e.g. where the representative withdraws), the legal consequences depend on the nature of the proceedings concerned.

5.2.1 During registration

Articles 31(3) and 119(2) EUTMR
Article 115(2) EUDR Article 55(3) EUDR

Where representation is mandatory and the applicant fails to designate a professional representative in the application form, the examiner will invite the applicant to appoint

a representative as part of the formality examination pursuant to Article 31(3) EUTMR, first sentence, or Article 55(3) EUDR. Where the applicant fails to remedy this deficiency, the application will be refused.

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

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

5.2.2 During opposition

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

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

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

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

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

5.2.3 Cancellation

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

Article 2(1)(e) and Article 5(2) EUDDR

In cancellation proceedings, the above paragraphs concerning the opponent apply to the applicant for revocation or declaration of invalidity of an EUTM and to the applicant for declaration of in validity of a EUD.

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

5.3 Appointment of a representative when not mandatory

Where the party to the proceedings before the Office is not obliged to be represented, they may nevertheless, at any time, appoint a representative within the meaning of Article 119 or 120 EUTMR and Articles 115 and 116 EUDR.

Where a representative has been appointed, the Office will communicate solely with that representative (see paragraph 6 below).

5.4 Appointment/replacement of a representative

5.4.1 Appointment/replacement of an individual representative

Article 74(7) EUTMDR

Articles 1(1)(c) and (3) EUDIR and Article 26 EUDDR

A representative is normally appointed in the official Office form initiating the procedure involved, for example, the application form or the opposition form (as concerns the appointment of multiple representatives, see paragraph 6 below).

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

The appointment must be unequivocal.

In EUTM-related proceedings, it is strongly recommended that the request for registration of an appointment of a representative be submitted electronically via the

Office's website (e-recordals). In EUD-related proceedings, such requests can only be made by electronic means.

An application to record an appointment must contain:

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

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

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

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

If there is no representative in the proceedings, a communication made in respect of a particular procedure (e.g. registration or opposition), accompanied by an authorisation signed by the party to the proceedings, implies the appointment of a representative. This also applies where a general authorisation is filed in the same way. For information about general authorisations, see paragraph 7.2 below.

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

The Office will then send a letter setting a time limit to the 'new' representative, inviting them to submit documents confirming their appointment as representative.

If the requested documents are submitted, the previous submissions will be considered and the Office will send further communications to the 'new' representative.

If the 'new' representative does not reply within the time limit or does not submit the requested documents confirming their appointment, the proceedings will continue with the 'old' representative. The submission and answer from the 'new' representative will not be considered and will be forwarded to the 'old' representative for information purposes only.

5.4.2 Appointment/replacement of an association of representatives

Article 74(8) EUTMDR

Article 116(8) EUDR

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

Since the regulations do not establish the required legal nature of an association of representatives, an association of representatives does not necessarily have to be understood as being a legal entity as a registered company would be. The objective of Article 74(8) EUTMDR and Article 116(8) EUDR is to allow a party to appoint or to authorise all individual representatives of an association, irrespective of the legal or factual arrangements under which that association may have been constituted (see 10/04/2024, T-262/23, Mushie / KUSHIES, EU:T:2024:227, § 21-22).

In order for the Office to grant an ID number to an association of representatives (see paragraph 4.1), there must be at least two legal practitioners or professional representatives practising within that association or partnership that comply with the requirements of Article 120(1) EUTMR or Article 116(1) EUDR and that have already obtained individual ID numbers from the Office assigned to the address of the association. This information should be submitted with the initial request.

Where the Office has doubts that the association has at least a minimum of two members complying with the requirements, or doubts regarding the continued presence of at least two qualified association members, the Office will issue a deficiency notification. This deficiency may be issued at the time of examining the initial request, or at any later stage. In the event the deficiency is not remedied, any existing association ID number will be invalidated, and any files assigned to this existing ID will be moved to the individual ID of the only existing member of the association.

The appointment of an association of representatives automatically extends to any professional representative who, subsequent to the initial appointment, joins that association of representatives. Conversely, any representative who leaves the association of representatives automatically ceases to be authorised under that association. It is strongly recommended that any changes and information concerning representatives joining or leaving the association be notified to the Office. The Office reserves the right, if justified by the circumstances of the case, to verify whether a given representative actually operates within the association.

Article 120(1) EUTMR

Article 74 EUTMDR

Article 116(1) and 115(3) EUDR

The appointment of an association of representatives does not depart from the general rule that only legal practitioners and professional representatives within the meaning

of Article 120(1) EUTMR and Article 116(1) EUDR may perform legal acts before the Office on behalf of third parties. Therefore, any application, request or communication must be signed by a physical person possessing this qualification. The representative must indicate their name underneath the signature. They may indicate their individual ID number, if one has been provided by the Office, or their association ID number.

6 Communication with Parties and Representatives

Article 60(1) and (3) and Article 66 EUTMDR

Article 13(1) and (2) EUDDR and Article 19 EUDDR

Where a representative has been appointed within the meaning of Article 119 or 120 EUTMR and Article 115 or 116 EUDR, the Office will communicate solely with that representative.

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

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

In addition, if the party represented files documents itself with the Office while being represented by a duly authorised representative, these documents will be accepted by the Office as long as the party represented has its domicile or principal place of business or a real and effective industrial or commercial establishment in the EEA. However, the Office will reply to the appointed representative, not to the party directly. Where the represented party has its domicile or principal place of business or a real and effective industrial or commercial establishment outside the EEA, these documents will not be taken into account.

Article 60(2) and Article 73 EUTMDR

Article 13(2) EUDDR and Article 26 EUDDR

A party to the proceedings before the Office may appoint up to a maximum of two representatives, in which case each of the representatives may act either jointly or separately, unless the authorisation given to the Office provides otherwise. The Office, however, will as a matter of course communicate only with the first named representative, except where the additional representative is appointed for a specific secondary procedure (such as inspection of files or opposition), in which case the Office will communicate with this representative during the course of this specific secondary procedure.

Article 119(4) EUTMR

Articles 60(1) and (2) and 73(1) EUTMDR

Article 115(4) EUDR

Articles 13 and 26 EUDDR

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

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

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

The Office will address all notifications to the common representative. A notification to the common representative will be sufficient, since it will have the same effect as if it had been addressed to the represented persons.

7 Authorisation

Articles 119(3) and 120(1) EUTMR

Article 74 EUTMDR

Articles 115(3) and 116(1) EUDR

Article 26 EUDDR

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

In such cases, the Office will invite the representative to file the authorisation within a specific time limit. The letter will include a warning that if the representative does not reply within the time limit, the Office will assume that he or she has not been appointed as representative and proceedings will continue directly with the party. Where representation is mandatory, the party represented will be invited to appoint a new representative and paragraph 5.2 above applies. Any procedural steps, other

than the filing of the application, taken by the representative will be deemed not to have been taken if the party represented does not approve them within a period specified by the Office.

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

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

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

7.1 Individual authorisations

Article 120(3) EUTMR

Article 65(1)(i) and Article 74 EUTMDR

Article 116(5) EUDR

Articles 18 and 26 EUDDR

Individual authorisations may be made on the form established by the Office pursuant to Article 65(1)(i) EUTMDR and Article 18 EUDDR. The procedure to which the authorisation relates must be indicated (e.g. 'concerning EUTM application number 12345'). The authorisation will then extend to all acts during the lifetime of the ensuing EUTM. Several proceedings may be indicated.

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

7.2 General authorisations

Article 120(1) EUTMR

Article 65(1)(i) and Article 74 EUTMDR

Article 116(1) EUDR

Articles 18 and 26 EUDDR

A 'general authorisation' authorises the representative, the association of representatives or the employee to perform all acts in all proceedings before the Office, including, but not limited to, the filing and prosecution of EUTM applications, the filing of oppositions and the filing of requests for a declaration of revocation or invalidity, as well as in all proceedings concerning EUDs and international marks. The

authorisation should be made on the form made available by the Office, or a form with the same content. The authorisation must cover all proceedings before the Office and may not contain limitations. For example, where the text of the authorisation relates to the 'filing and prosecution of EUTM applications and defending them', this is not acceptable because it does not cover the authority to file oppositions and requests for a declaration of revocation or invalidity. Where the authorisation contains such restrictions, it will be treated as an individual authorisation.

7.3 Consequences where authorisation expressly requested by the Office is missing

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

If representation is mandatory, paragraph 5.2 above will apply.

8 Withdrawal of a Representative's Appointment or Authorisation

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

8.1 Action taken by the person represented

Article 74(4) and (5) EUTMDR Article 26 EUDDR

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

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

Where the party to the proceedings is obliged to be represented, paragraph 5.2 above will apply.

8.2 Withdrawal by the representative

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

9 Death or Legal Incapacity of the Party Represented or Representative

9.1 Death or legal incapacity of the party represented

Article 106(1) and (2) EUTMR
Article 74(6) EUTMDR Article 97(1) and (2) EUDR
Article 26 EUDDR

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

Depending on the proceedings, the representative will have to apply for registration of a transfer to the successor in title. However, in the event of the death or legal incapacity of the applicant for, or proprietor of, an EUTM or an EUD, the representative may apply for an interruption of proceedings.

For more information on interrupting opposition proceedings following the death or legal incapacity of the EUTM applicant or its representative, see the Guidelines, Part C, Opposition, Section 1 Opposition proceedings, 7.5.5 Interruption of the proceedings due to death or legal incapacity of the applicant or its representative. This practice applies *mutatis mutandis* to the interruption of EUD invalidity proceedings due to the death or legal incapacity of the applicant for, or holder of, an EUD.

The interrupted proceedings before the Office may be resumed as soon as the identity of the person authorised to continue them has been established. Where no information about the identity of the person authorised to continue the proceedings has been provided following their interruption, the Office will make all reasonable attempts to establish this information. If after exhausting such attempts this person's identity still

has not been identified, proceedings may be resumed and specific legal consequences may apply.

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

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

9.2 Death or legal incapacity of the representative

Article 106(1) and (2) EUTMR

Article 72(2) EUTMDR

Article 97(1)(c) and (2) EUDR and Article 25(2) EUDDR

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

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

10 Change of name or address

Article 55 and Article 111(3)(a) and (b) EUTMR

Articles 69(1) and 104(3)(a),(b) and (c) EUDR

Article 8 EUDIR

The name or address of an EUTM applicant/proprietor or an EUD applicant/holder, a party to the proceedings, or a representative may be amended by submitting a request to the Office.

The EUD holder may request that a change of name of the designer or one or more members of the team of designers be registered and entered in the Register pursuant to Article 104(3)(d) EUDR.

A change of name is limited to a change that does not affect the identity of the person, for example, where there is a change in the name (through marriage/divorce), or in the case of a legal person, where the company officially changes its name in the company register.

On the other hand, a change in the party's identity may be a transfer or a change of ownership. In the event of any doubt as to whether a change will be considered a transfer or a change of ownership, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and EUDs as Objects of Property, Chapter 1, Transfer. That chapter provides detailed information in this respect as well as the applicable procedure.

A representative's name or address may be amended, provided that the representative is not being substituted by another representative. That would be considered an appointment of a new representative, which is subject to the rules governing such an appointment.

Where the address of an association of representatives is changed, the address of all of the association members must also be updated. As seen in paragraph 5.4.3, the address linked to the ID numbers of the members of an association and the address linked to the ID number of the association itself must all coincide.

A change of name or address can be requested by the affected person. The request must contain the EUTM/EUD number (or the file number assigned to the proceedings in question) and the name and address of the party or representative, both as on the file and as amended. The ID number should also be provided. The request is free of charge.

Where there is any doubt, the Office may ask for proof such as an extract from a trade register, or other evidence, to corroborate the change of name or address.

Changes to the parties' or representatives' name or address will be reflected in the ID number assigned to the party or representative. Consequently, the change will be reflected in all proceedings where this ID is assigned, including all EUTM and EUD applications and pending proceedings. The change cannot be recorded only for a specific portfolio of rights.

A single request may be made for a change of name or address for two or more registrations.

For changes in the name or address of the proprietor of a registered EUTM, see the Guidelines, Part E, Register Operations, Section 1, Changes in a registration. For changes in the name or address of the holder or its representative or in the citation of the designer or team of designers for an EUD, see the GuidelinesExamination of applications for registered European Union designs, paragraph 11.4.

11 Correction of the name or address

Article 31(1)(b) EUTMR, Article 49(2) EUTMR

Article 11(5) EUTMDR

Articles 42(1)(b) and 92 EUDR

Article 8 EUDIR

The name and legal address of an EUTM or an EUD applicant, a party to the proceedings, or a representative may be corrected in case of errors in the respective application or request.

Firstly, corrections will be allowed where the error in the name or address that requires correction is considered **obvious**, that is, nothing else could have been intended other than what is offered as the correction. Examples of obvious errors in the name or address could be misspellings, typographical errors, errors of transcription or use of an abbreviated form in the names of natural persons (e.g. 'Phil' instead of 'Phillip').

Additionally, a correction could also be considered in this scenario where there is a typographical error in the legal form (e.g. S.A. was indicated in the application form instead of S.L.). This correction would require evidence to be submitted in support of the request.

Correction in the name or address of an EUTM or EUD applicant will have no consequences as regards the filing date of the application, because the applicant is deemed to be correctly identified from the beginning pursuant to Article 31(1)(b) EUTMR and Article 42(1)(b) EUDR.

Secondly, errors that are **not considered to be obvious** and that lead to the **change in identification of the EUTM or EUD applicant** can take place, but they do not fall under Article 49(2) EUTMR and Article 92 EUDR. They will lead to a change in the filing date of the application, as the correct identification of the applicant is a formal requirement for the granting of a filing date pursuant to Article 31(1)(b) EUTMR and Article 42(1)(b) EUDR. The new filing date of the application will be considered to be the one on which the corrected (new) applicant is formally identified and all supporting evidence is submitted in support of the correction.

In this second scenario, the burden of proof is on the party that made the mistake to prove what needs correcting and why it needs correcting. A request for correction of a name which consists of replacing one name with another will require evidence of what needs correcting and the evidence will also need to link the correction to the EUTM/EUD application (or file) in question. For example, where a representative informs the Office that the wrong EUTM applicant was indicated in the EUTM application form by mistake, the evidence must show that the party (as requested to be corrected) bears a relation with the EUTM application in question. A request simply informing the Office that the correction is needed because someone made a mistake, or another applicant was intended, or there was a change of mind after filing, will not be accepted.

Requests for correction of errors must contain the file number of the application or proceeding, the erroneous name or address and its corrected version, and evidence in support of the request for correction where applicable.

Corrections should not be confused with requests for changes of name or address, see paragraph 10.

For correction of other errors in registering an EUTM or in publishing the registration, and for correction of errors in registering an EUD and in publishing the registration, see the Guidelines Part A, Section 6 Revocation of decisions, cancellation of entries in the register and correction of errors.

Annex 1

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OPA – The Austrian Patent Office **(Austria)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Rechtsanwalt'**	Persons holding the title **'Rechtsanwalt'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Austrian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Zugelassener Vertreter'** **'Patentanwalt'** or **'Notar'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the titles **'Patentanwalt'** or **'Notar'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
BOIP – Benelux Office for Intellectual Property **(Benelux)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Advocaat', 'Rechtsanwalt'** or **'Avocat'**	Persons holding the titles **'Avocat'** , **'Advocaat'** or **'Rechtsanwalt'** (meaning a lawyer admitted to the bar), are entitled to act as legal practitioners before the Benelux industrial property office pursuant to national laws, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Gemachtigde' , 'Patentanwalt'** or **'mandataire'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Benelux Office for Intellectual Property. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Benelux Intellectual Property Office **(Option a).** Persons in possession of a professional qualification officially recognised under the regulations laid down by the States of Belgium, the Netherlands or Luxembourg, certified by the central industrial property office of the Member State concerned, are not subject to the 5-year requirement before the BOIP to act as a professional representative before the EUIPO **(Option b)** .

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
BPO – Patent Office of the Republic of Bulgaria **(Bulgaria)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**Адвокат** ('Advokat')	Persons holding the title **'Адвокат'** (Attorney) are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Bulgaria, and consequently they are entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**Представител по индустриална собственост'** ('Predstavitel po industrialna sobstvenost')	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Представител по индустриална собственост'** ('IP representative') have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.
SIPO – State Intellectual Property Office of the Republic of Croatia **(Croatia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'odvjetnik'**	Persons holding the title **'odvjetnik'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Croatian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Ovlašteni zastupnici'** **'Zastupnik Za Žigove'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Zastupnik Za Žigove'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. An exam must be passed, before the Croatian Intellectual Property Office, in order to obtain this qualification.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Industrial Property Office of the Czech Republic **(Czech Republic)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Advokát'**	Persons holding the title **'Advokát'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of the Czech Republic, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Kvalifikovaných zástupců'** **'Patentový zástupce'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentový zástupce'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. The Czech Republic has a two-part examination: • Persons who have passed part B only (on 'trade marks and appellation of origin') may act as representatives in this field and hence be entered on the list of Article 120(1)(b) EUTMR to represent in trade mark matters . Patent attorneys ***('Patentový zástupce')*** , who have passed both parts of the examination, are therefore entitled to represent applicants in all procedures before the EUIPO (i.e. both trade mark and design matters).

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Department of the Registrar of Companies and Intellectual Property **(Cyprus)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Δικηγόρος'** ('Dikigoros')	Only persons holding the title **'Δικηγόρος'** (or 'Dikigoros'), are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Cyprus, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Εγκεκριμένος Αντιπρόσωπος'**	n/a

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
DKPTO – Danish Patent and Trademark Office **(Denmark)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'advokat'**	Persons holding the Danish title **'Advokat'** meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Danish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Godkendte mødeberettigede'** **'Varemaerkefuldmaegtig'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Anyone may act before the national industrial property office in trade mark matters . In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the national office **(Option a)** . In addition, persons holding the title **'Varemaerkefuldmaegtig'** are officially recognised as professionally qualified to represent third parties before the national office in trade mark and design matters and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b).**

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
EPA – Estonian Patent Office **(Estonia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'õigusala töötaja'** **'Jurist'** and **'Advokaat'**	Persons holding the titles **'Jurist'** and **'Advokaat'** who are also qualified as IP attorneys are entitled to act as legal practitioners before the national industrial property office pursuant to Estonian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Kutseline esindaja'** **'Patendivolinik'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patendivolinik'** who have passed the 'trade marks, industrial designs and geographical indications' part of the exam, have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters. Persons who only passed the 'patents and utility models' part of the exam may not act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
PRH – Finnish Patent and Registration Office **(Finland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'harjoittamaan oikeutettu'** **'Asianajaja'** or **'Advokat'**	Persons holding the Finnish title **'Asianajaja'** or **'Advokat'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Finland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Ammattimainen edustaja'** **'Tavaramerkkiasiamies'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any natural or legal person can act as a representative in trade mark and design matters before the national industrial property office. In order for this person to be entitled to act as a representative before the EUIPO, the person must have at least 5 years' experience before the national industrial property office **(Option a)** . In addition, persons holding the title **'Tavaramerkkiasiamies'** are officially recognised as being professionally qualified to represent third parties before the Finnish Patent and Registration Office in trade mark matters , and therefore are not subject to the 5-year requirement to act as professional representative before the EUIPO **(Option b)** .

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
INPI – The National Institute for Intellectual Property **(France)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'avocat'**	Persons holding the French title **'avocat'** , meaning a lawyer member of the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to French law, and consequently entitled to act before the EUIPO in trade mark and design matters. These lawyers are fully entitled to act in trade mark and design matters, with an exception, that they cannot act under the title of 'lawyer' (avocat) and under the title of 'professional representative' (see below) at the same time . Therefore, they are not entitled to act before the EUIPO under two separate IDs (one as a lawyer, and one as a professional representative).
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Mandataires agréés'** Persons on the **'Liste des Conseils en propriété industrielle'**	**Entitlement is conditional upon possession of a special professional qualification**
			Only persons on the **'Liste des Conseils en propriété industrielle'** maintained by INPI with the speciality **'Marques, dessins et modèles'** or **'Juriste'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
DPMA – German Patent and Trade Mark Office **(Germany)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Rechtsanwalt'**	Persons holding the German title **'Rechtsanwalt'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to German law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Patentanwalt'**	**Entitlement is conditional upon possession of a special professional qualification**
			Persons holding the title **'Patentanwalt'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. Persons holding the titles of **'Patentassessor '** and **'Syndikuspatentanwalt '** (§ 41a Abs. 2 PAO) do not have such qualification. They have a limited power of representation as they may only act as employee representatives for their employer, not as professional representatives.
OBI - Industrial Property Organisation **(Greece)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Δικηγόρος'** (Dikigoros)	Only persons holding the title **'Δικηγόρος'** (or 'Dikigoros'), are entitled to act as legal practitioners before the national industrial property office pursuant to Greek law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Εγκεκριμένος Αντιπρόσωπος'**	n/a

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
HIPO – Hungarian Intellectual Property Office **(Hungary)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Ügyvéd'**	Persons holding the title **'Ügyvéd'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Hungarian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Hivatásos képviselők'** **'Szabadalmi ügyvivő'** ('patent attorney')	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Szabadalmi ügyvivő'** ('patent attorney') have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. **'Legal advisors'** or **'notaries'** are not entitled to act in procedures relating to industrial property matters and therefore may not be entered on the EUIPO's list of professional representatives.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Icelandic Intellectual Property Office **(Iceland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Lögfræðingur'** (e. Lawyer), **'Lögmaður'** (e. Attorney-at-Law), **'Héraðsdómslögmaður'** (e. District Court Attorney) or **'Hæstaréttarlögmaður'** (e. Supreme Court Attorney)	Persons holding the title **'Lögfræðingur'** (e. Lawyer), **'Lögmaður'** (e. Attorney-at-Law), **'Héraðsdómslögmaður'** (e. District Court Attorney) or **'Hæstaréttarlögmaður'** (e. Supreme Court Attorney), and therefore lawyers admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Iceland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Umboðsmaður'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Icelandic Patent Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Icelandic Patent Office **(Option a)** . In addition, persons holding the title **'Umboðsmaður'** are officially recognised as being professionally qualified to represent third parties before the national industrial property office, and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b)** .

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Intellectual Property Office of Ireland **(Ireland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Barrister'** or **'Solicitor'**	Persons holding the titles **'Barrister'** or **'Solicitor'** , are entitled to act as legal practitioners before the national industrial property office pursuant to Irish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Registered Trade Mark Agent'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Registered Trade Mark Agent'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark matters.
UIBM – Italian Patent and Trademark Office **(Italy)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Avvocato'**	Persons holding the Italian title **'Avvocato'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Italian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Mandatario abilitato in Marchi'** **'Consulente in Marchi'** **'Consulente in Proprietà Industriale'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'Consulente in Marchi'** and **'Consulente in Proprietà Industriale'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in both trade mark and design matters.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
LRPV – Patent Office of the Republic of Latvia **(Latvia)**	**Professional Representative (Trade Marks and Designs)** Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Profesionâlais patentpilnvarnieks'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'profesionālais patentpilnvarnieks'** ('professional patent attorney') and included on the Patent Office List of Professional Patent Attorneys are entitled to represent persons before the national industrial property office (and consequently, before the EUIPO): - in trade mark matters, if they have specialised (and passed a specific exam) in the field of trade marks; - in design matters, if they have specialised (and passed a specific exam) in the field of designs.
Bureau of Intellectual Property Office of Economic Affairs **(Liechtenstein)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Rechtsanwalt'**	Persons holding the title **'Rechtsanwalt'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Liechtenstein, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Patentanwalt'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentanwalt'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
The State Bureau of the Republic of Lithuania **(Lithuania)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'praktikuojantis teisininkas'** **'Advokatas'**	Persons holding the title **'Advokatas'** are entitled to act as legal practitioners before the national industrial property office pursuant to Lithuanian law, and consequently entitled to act before the EUIPO in trade mark and design matters, provided that their clients have a permanent residence in the EU. Clients whose permanent residence is not in the EU may not be represented by a legal practitioner and must be represented by a professional representative.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**' Profesionalūs atstovai '** **'Patentinis patikėtinis'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentinis patikėtinis'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Commerce Department, Industrial Property Registrations Directorate **(Malta)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'prattikant legali'** **'Avukat'** or **'Prokuratur Legali'**	Persons holding the titles **'Avukat'** or **'Prokuratur Legali'** , are entitled to act as legal practitioners before the national industrial property office pursuant to Maltese law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'rappreżentanti professjonali'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person, with a legal background including notaries, may act before the Maltese Intellectual Property Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Maltese Intellectual Property Office. **(Option a).**

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
NIPO – Norwegian Industrial Property Office **(Norway)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Advokat'** and **'Advokatfullmektig'**	Persons holding the titles **'Advokat'** and **'Advokatfullmektig',** a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Norway, and consequently entitled to act before the EUIPO in trade mark and design matters. Furthermore, if the legal practitioner acts as an attorney-at-law no power of attorney is necessary. However, if the legal practitioner acts as an employee of a company a power of attorney is necessary, even if the employee is an attorney-at-law.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)		**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Norwegian Intellectual Property Office. In order for this person to represent in trade mark matters before the EUIPO, the person must have at least 5 years' experience before the Norwegian Intellectual Property Office. **(Option a).**

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Polish Patent Office **(Poland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**‘ prawnik’** **‘Adwokat, radca prawny’**	Persons holding the title **‘Adwokat, radca prawny’** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office in trade mark and design matters pursuant to the laws of Poland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**‘Zawodowi pełnomocnicy’** **‘Rzecznik Patentowy’**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **‘Rzecznik Patentowy’** (on the list of patent attorneys maintained by the Polish Patent Office) have the necessary ‘special professional qualification’ and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
INPI – Portuguese National Industrial Property Office **(Portugal)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Profissionais de justiça'** **'Advogado'**	Persons holding the title **'Advogado'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Portuguese law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'mandatário autorizado'** **'Agentes da Propiedade Industrial'** and **'notary'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Portuguese Institute of Industrial Property. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Portuguese Institute of Industrial Property **(Option a)** . In addition, persons holding the titles of **'Agentes da Propiedade Industrial'** and **'notary'** are officially recognised as professionally qualified to represent third parties before the Portuguese Institute of Industrial Property and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b)** .

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OSIM – Romanian State Office for Inventions and Trademarks **(Romania)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'Avocat'**	Persons holding the title of **'Avocat'** are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Romania (Law no. 30/2024 for the amendment of Law no. 84/1998 regarding trademarks and geographical indications, of Law no. 129/1992 regarding the protection of designs and models, as well as Law no. 64/1991 regarding patents, published in the Official Gazette of Romania, Part I no. 173 of March 4, 2024), and consequently are entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'reprezentanții autorizați'** **'Consilier în proprietate industrială'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Consilier în proprietate industrială'** (who in turn must be a member of a national chamber), have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters.
SKIPO – Industrial Property Office of the Slovak Republic **(Slovakia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**' advokát'**	Persons holding the title **'advokát'** are entitled to act as legal practitioners before the national industrial property office pursuant to Slovak law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Oprávnený zástupca'** **'Patentový zástupca'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentový zástupca'** hold the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
SIPO – Slovenian Intellectual Property Office **(Slovenia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'odvetnik'**	Persons holding the title **'Odvetnik'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to laws of Slovenia, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Zastopnik za modele in znamke'** (Design and trademark agent)	**Entitlement is conditional upon possession of a special professional qualification**
			Persons holding the title **'Zastopnik za modele in znamke'** (design and trademark agent) have the necessary 'special professional qualification', must be registered in the Register of Agents at the Slovenian Intellectual Property Office and are therefore entitled to act as a professional representative before the EUIPO. **'Notaries'** are explicitly excluded from representing third parties before the Slovenian Intellectual Property Office.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OEPM – Spanish Patent and Trademark Office **(Spain)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'abogado'**	Persons holding the title **'abogado'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Spanish law, and consequently entitled to act before the EUIPO in trade mark and design matters provided that the person they represent is a resident of a Member State of the EEA. Where the person that is represented is not a resident of a Member State of the EEA they may not be represented by a legal practitioner (**'abogado'**), and must be represented by a professional representative holding the title **'Agente Oficial de la Propiedad Industrial '** * *21/10/2021 – Spanish law in this area currently under review. See the draft law (*' Anteproyecto de Ley de modificación de la Ley 17/2001, de 7 de diciembre, de Marcas, la Ley 20/2003, de 7 de julio, de Protección Jurídica del Diseño Industrial, y la Ley 24/2015, de 24 de julio, de Patentes. '*) It is possible to be an **'abogado '** and an **'Agente Oficial de la Propiedad Industrial'** at the same time.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Representante autorizado'** **'Agente Oficial de la Propiedad Industrial'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act in trade mark and design matters before the national industrial property office pursuant to Spanish law, provided that the person they represent is a resident of a Member State of the EU. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years of experience before the OEPM **(Option a)** . Where the person that is represented is not a resident of a Member State of the EU they must be represented by a person holding the title of **'Agente de la Propiedad Industrial'** In addition, persons holding the title **'Agente de la**

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
PRV – Swedish Patent and Registration Office **(Sweden)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 116(1)(a) EUDR	**'juridisk person'** **'Advokat '**	Persons holding the title **'Advokat'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Swedish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 116(1)(b) EUDR)	**'Auktoriserat ombud'** **'Patentombud'**	Representation is open to anybody a. who has acted before the national office for at least 5 years, or b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State
			Any person may act in trade mark and design matters before the Swedish Patent and Registration Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Swedish Patent and Registration Office **(Option a)** . In addition, persons holding the title **'Patentombud'** are officially recognised as being professionally qualified to represent third parties before the Swedish Patent and Registration Office in trade mark and design matters , and are therefore not subject to the 5-year requirement to act as professional representatives before the EUIPO **(Option b)** .

Annex 2

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

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 116(4)(c) EUDR
PRH – Finnish Patent and Registration Office **(Finland)**	**'Mallioikeusasiamies'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
		Any natural or legal person can act as a representative in design matters before the national industrial property office. In order for this person to be entitled to act as a representative before EUIPO, the person must have at least 5 years' experience before the national industrial property office (**Option a**). Persons holding the title **'Mallioikeusasiamies'** are officially recognised as being professionally qualified to represent third parties before the Finnish Patent and Registration Office in design matters, and therefore are not subject to the 5-year requirement to act as professional representative before the EUIPO (**Option b**).

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 116(4)(c) EUDR
Intellectual Property Office of Ireland **(Ireland)**	**'Registered Patent Agents'**	**Entitlement is conditional upon possession of a special professional qualification** Only **'Registered Patent Agents'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters.
UIBM – Italian Patent and Trademark Office **(Italy)**	**'Consulente in brevetti'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'Consulente in brevetti'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters only.
LRPV – Patent Office of the Republic of Latvia **(Latvia)**	**'PatentpiInvarotais dizainparaugu lietas'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'PatentpiInvarotais dizainparaugu lietas'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters only.

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 116(4)(c) EUDR
PRV – Swedish Patent and Registration Office **(Sweden)**	**'Varumaerkesombud'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
		Any person may act in design matters before the Swedish Patent and Registration Office. For this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Swedish Patent and Registration Office (**Option a**). Persons holding the title **'Varumaerkesombud'** are officially recognised as being professionally qualified to represent third parties before the Swedish Patent and Registration Office in design matters, and therefore are not subject to the 5-year requirement to act as professional representatives before the EUIPO (**Option b**).

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 6

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

1 Introduction

The Office will remedy errors, in particular, by:

- revocation of decisions and cancellation of entries in the Register (Article 103(1) and (2) EUTMR and Article 93(1) and (2) EUDR, see paragraph 2);
- correction of errors in the publication of an EUTM application (Article 44(3) EUTMR, see paragraph 3);
- correction of errors in decisions (Article 102 EUTMR and Article 92 EUDR), see paragraph 4).
- correction of errors in registering or in publishing the registration of an EUTM or EUD (Article 102 EUTMR and Article 92 EUDR, see paragraph 4)

The distinction between revocation under Article 103 EUTMR and Article 93 EUDR and correction under Article 102(1) EUTMR and Article 92(1) EUDR relates to the nature of the errors. Different types of errors may give rise to a correction or a revocation (20/11/2024, T-13/24, The King of Soho (fig.) / SOHO et al., EU:T:2024:846, §24, 29). The types of errors covered by Article 103 EUTMR and Article 93 EUDR require a new analysis of the case while those covered by Article 102(1) EUTMR and Article 92(1) EUDR do not (20/11/2024, T-13/24, The King of Soho (fig.) / SOHO et al., EU:T:2024:846, §27).

In the context of decisions, a correction under Article 102 EUTMR and Article 92(1) EUDR apply in case of linguistic errors, errors of transcription or a manifest oversight by the Office, while a revocation under Article 103 EUTMR and Article 93 EUDR requires 'an obvious error attributable to the Office'.

Linguistic errors include mistakes in grammar, syntax, spelling and semantic mistakes. Errors of transcription refer to situations in which data is copied or entered incorrectly.

The difficulty is sometimes establishing the distinction between 'manifest oversight' in decisions under Article 102 EUTMR and Article 92(1) EUDR, which can only be subject to correction and 'obvious errors' under Article 103(1) EUTMR and Article 93 EUDR, which can only be subject to revocation.

A 'manifest oversight' under Article 102 EUTMR and Article 92 EUDR exists when its correction does not change the overall content, substance and coherence of the decision (22/09/2021, T-169/20, Marina yachting, EU:T:2021:609, § 111; 28/05/2020, T-724/18 and T-184/19, AUREA BIOLABS (fig.) / Aurea et al., EU:T:2020:227, § 34-40).

In contrast, an **'**obvious error**'** under Article 103(1) EUTMRand Article 93(1) EUDR refers to errors that flagrantly overlook relevant legal provisions or circumstances, and as a result, require a re-examination of the outcome of the decision. Revocation of a decision is justified by errors which do not allow the operative part of the decision at issue to be maintained (31/10/2019, C-281/18 P, REPOWER, EU:C:2019:916, § 34; 20/11/2024, T-13/24, The King of Soho (fig.) / SOHO et al., EU:T:2024:846, § 27).

As to the effects, revocation annuls a decision whereas the correction of errors does not affect the validity of the decision and does not open a new appeal period (28/05/2020, T-724/18 and T-184/19, AUREA BIOLABS (fig.) / Aurea et al., EU:T:2020:227, § 28-30; 22/09/2021, T-169/20, Marina yachting, EU:T:2021:609, § 111).

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

2 Revocation of decisions and cancellation of entries in the EUTM and EUD Registers

2.1 General remarks

Article 103 EUTMR

Article 70 EUTMDR

Article 93 EUDR

Article 23 EUDDR

Article 103 EUTMR and Article 93 EUDR provide for the cancellation of entries in the Register and revocation of decisions containing obvious errors attributable to the Office.

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

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

The **effect of the revocation of a decision** is that the decision is deemed never to have existed. The initial erroneous decision will need to be replaced with a new decision in which the identified errors are remedied.

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

2.2 Assessment

2.2.1 Nature of the error

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

An error is obvious if it **does not allow the operative part of that decision or that entry to be maintained without a new analysis**, which will be carried out subsequently by the department that took that decision or made that entry (22/09/2021, T-169/20, Marina yachting, EU:T:2021:609, § 111; 20/11/2024, T-13/24, The King of Soho (fig) / SOHO et al., EU:T:2024:846, § 27).

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

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

- The opposition has been found admissible even though some admissibility requirements were not met (18/10/2012, C-402/11 P, Redtube, EU:C:2012:649).
- A decision refusing the EUTM application on absolute grounds is notified in the absence of any observations from the applicant in reply to the objection before the expiry of the time limit for submitting observations, or ignoring the observations that the applicant submitted on time.
- The EUTM is refused on absolute grounds, ignoring a valid subsidiary claim to prove acquired distinctiveness pursuant to Article 7(3) EUTMR or ignoring the evidence of acquired distinctiveness duly submitted.
- The EUTM is refused by the Opposition Division, ignoring a request for proof of use or without dealing with the issue of proof of use.
- The opposition is rejected on the basis of lack of proof of use but the opponent was not expressly given a time limit for submitting proof of use, or proof of use was submitted on time and was overlooked.
- The decision in opposition or invalidity proceedings was rendered while the proceedings were suspended or interrupted or, more generally, while a time limit for one of the parties was still running.
- Any breach of the right to be heard (observations not forwarded to the other party when that party should have been given a time limit to reply pursuant to the Regulation or Office practice).
- When closing a file due to a limitation of the contested EUTM application or a withdrawal, the Office has issued a decision on costs, overlooking an agreement on costs between both parties that was on file at the time (01/07/2009, T-419/07, OKATECH, EU:T:2009:238, § 33 and 40).
- A decision in inter-partes proceedings incorrectly lists a class of goods/services that were not subject of the opposition/cancellation, thereby exceeding the scope of the decision and resulting in flawed reasoning (24/10/2019, T-498/18, Happy Moreno choco (fig.) / MORENO (fig.) et al., EU:T:2019:763; 28/05/2020, T-724/18, AUREA

BIOLABS (fig.) / Aurea et al, EU:T:2020:227, § 32; 20/11/2024, T-13/24, The King of Soho (fig.) / SOHO et al., EU:T:2024:846, § 30).

- A change of name is entered in the Register instead of a transfer of ownership.
- A transfer of ownership is entered in the Register after an entry of the filing of an entitlement claim (Article 104(3)(g) EUDR).

2.2.2 One-year deadline

The Office must verify, secondly, whether one year has passed since the date on which the entry was made in the Register or the decision was taken.

Article 103(2) EUTMR and Article 93(2) EUDR provide that revocation/cancellation must be effected within one year of the date on which the erroneous decision was taken or the erroneous entry was made in the Register, after consultation with the parties to the proceedings and any proprietor of rights to the EUTM or EUD in question that are entered in the Register. The revocation/cancellation is deemed effected on the date of notification of the decision on revocation/cancellation, regardless of any appeal.

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

Considering the fixed time limit, any party to the proceedings should inform the Office about the obvious error identified without any delay, particularly where there is more than one party affected.

The Office will always initiate the procedure for revocation/cancellation as soon as it becomes aware of an obvious error requiring revocation or cancellation, and it will do its utmost to conduct an expedient procedure to conclude on time.

2.2.3 Decision against which an appeal is pending

An appeal filed against a decision containing an obvious error is not an obstacle to revocation. Article 103(4) EUTMR and Article 93(3) EUDR provide that the appeal proceedings will become devoid of purpose upon revocation of an erroneous decision and the appeal fee will be reimbursed to the appellant. The department competent to decide on the revocation of the decision will inform the Boards of Appeal promptly if it is considering a revocation and will also inform them of the outcome.

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

The procedure where only **one party** is affected, such as a decision refusing an application for an EUTM or EUD, is described in paragraph 2.3.1.

If the revocation of a decision affects **more than one party**, such as a decision in EUTM *inter partes* proceedings, or a decision in invalidity of an EUD, the procedure described in paragraph 2.3.2 must be followed.

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

Pursuant to Article 103(2) EUTMR (Article 70(5) EUTMDR) and Article 93(2) EUDR (Article 23(5) EUDDR), where the revocation of a decision or an entry in the Register affects a decision or entry that has been published, the revocation shall also be published. A corresponding entry will be made in the Register (Article 111(3)(x) EUTMR and Article 104(3)(u) EUDR).

2.3.1 Procedures when only one party is affected

a) Error found by the Office

If the Office itself finds that an error has been made, it will inform the party of its intention to revoke the decision/cancel the entry, it will state the reasons and set a time limit of one month for observations.

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

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

b) Error notified by the affected party

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

2.3.2 Procedure when more than one party is affected

a) Error found by the Office

If the Office itself finds that an error has been made, it informs the parties of its intention to revoke the decision/cancel the entry, it will state reasons and set a time limit of one month for observations (Article 70(1) EUTMDR and Article 23(1) EUDDR).

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

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

b) Error notified by one of the parties

If the party adversely affected by an error informs the Office, the Office must determine whether revocation/cancellation is justified and possible. If so, the Office notifies the party that benefited from the error of its intention to revoke/cancel and sets a time limit of one month for observations (sending a copy of the notification to the other party for information purposes as set out in Article 70(4) EUTMDR and Article 23(4) EUDDR).

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

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

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

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

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

3 Correction of errors in the publication of the EUTM application

Article 44(3) and (4) EUTMR

Article 46(2) EUTMR

Article 11 EUTMDR

3.1 General remarks

Article 44(1) EUTMR states that EUTM applications that have not been refused on absolute grounds must be published. The publication of the application shall contain the items listed in Article 7 EUTMIR.

Where the publication of the application contains an error, Article 44(3) and (4) EUTMR allow for the correction of any errors attributable to the Office.

The following are examples of errors that can be corrected:

- the EUTM has been published for fewer classes than applied for;
- sign 'x' was applied for but the publication refers to sign 'y';
- the list of goods and services published is incorrect.

This section refers to the correction of errors in the publication of EUTM applications. For amendments to the EUTM application itself see the Guidelines, Part B, Examination, Section 1, Proceedings, 5 Amendments to an EUTM Application.

This section does not apply to EUDs as an EU design is only published upon registration.

3.2 Procedure

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

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

Where the correction is requested by the applicant, the Office verifies the existence of an error, and the applicant is notified of the correction.

Depending on the nature of the correction, either the correction is published, or the EUTM application is republished.

Corrections of errors in EUTM applications pursuant to Article 44(3) and (4) EUTMR that do not require republication of the application for opposition purposes are

published in Section B.2 of the Bulletin. Corrections that do require republication of the application for opposition purposes are published in Section A.2.

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

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

4 Correction of errors in decisions and in registering or publishing the registration of an EUTM or EUD

Article 102 EUTMR Article 92 EUDR

4.1 General remarks

According to Article 102(1) EUTMR and Article 92(1) EUDR, the Office will, of its own motion or at the request of a party, correct:

- any **linguistic errors or errors of transcription** and **manifest oversights** in its decisions; or
- **errors** in registering an EUTM or EUD or in publishing the registration.

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

As there is no time limit, errors under Article 102(1) EUTMR and Article 92(1) EUDR can be corrected at any time, and the request is free of charge.

4.2 Assessment: correction of errors in decisions

The Office must verify whether the error to be corrected in the decision is a **linguistic error, an error of transcription or a manifest oversight**.

Corrections in decisions under Article 102(1) EUTMR and Article 92(1) EUDR are limited to obvious formal mistakes which affect the form of the decision only, not its scope or substance. This is true of errors which are so obvious that no wording other than the corrected wording could be intended and errors which do not justify invalidating or revoking the decision marred by them. This includes errors that constitute incongruous elements in a decision which is otherwise consistent and

unambiguous (28/05/2020, T-724/18 & T-184/19, AUREA BIOLABS (fig.) / Aurea et al., EU:T:2020:227, § 29, 33-34; 20/11/2024, T-13/24, The King of Soho (fig.) / SOHO et al., EU:T:2024:846, § 26, § 31). Even the dictum of a decision may be corrected if no wording other than that resulting from the correction could have been envisaged.

The nature of the errors and oversights that can be corrected in a decision pursuant to Article 102(1) EUTMR and Article 92(1) EUDR means that an appeal against a decision is not an obstacle to the correction of the decision by the first instance department that adopted it. Nevertheless, the relevant department will inform the Boards of Appeal promptly if it is considering a correction, as well as informing them of the outcome of its deliberations (i.e. whether any correction has been made) so this can be taken into account in the appeal proceedings.

The following are examples of errors in a decision that can be corrected:

- contradiction between the reasoning and the dictum (operative part of the decision), not requiring new assessment (28/05/2020, T-724/18 & T-184/19, AUREA BIOLABS (fig.) / Aurea et al., EU:T:2020:227, § 34-40) or the dictum of the decision based on Article 8(1)(b) EUTMR upholds the opposition whereas the body of the decision finds that the opposition is unfounded;
- where, in the case of a partially upheld opposition, based on Article 8(1)(b) EUTMR, the dictum does not list all the goods/services for which the EUTM should be rejected according to the comparison in the body of the decision;
- where there are duplicated paragraphs with the reasoning (20/11/2024, T-13/24, The King of Soho (fig.) / SOHO et al., EU:T:2024:846, § 33);
- where the parties' procedural position is misdescribed, for example the opponent is indicated as being the applicant.

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

4.3. Assessment: correction of errors in registering or in publishing the registration of an EUTM or EUD

Article 102(1) EUTMR and Article 92(1) EUDR refer to errors in registering an EUTM or EUD, or in any entry made in the Register, in accordance with Article 111(2) and (3) EUTMR, Article 104(2) and (3) EUDR or a Decision of the Executive Director pursuant to Article 111(4) EUTMR and Article 104(4) EUDR, and to errors in the publication of those entries in the Register.

The correction of these errors should not require a new analysis of the case.

The following are examples of errors that can be corrected:

- the EUTM was registered without taking into account a limitation or account amendments to the mark’s representation after publication;
- the EUTM was registered despite being previously withdrawn;
- the EUTM was registered despite a deficiency, such as in the payment of the application fees;

- the EUTM was registered despite a pending or successful opposition;
- the EUD was registered with an erroneous filing date due to a transcription error, while the priority document submitted to the Office proves otherwise;
- the EUD was registered with an incorrect product indication.

Errors in the translation of the product indication into official EU languages will be corrected since the translations are considered entries in the Register as part of the contents of the publication of the registration. In case of doubt, the text in the Office language in which the application for an EUD was filed will be considered authentic (Article 147(3) EUTMR and Article 139(3) EUDR). If the application was filed in an official EU language other than one of the Office languages, the text in the second language indicated by the applicant will be considered authentic.

For corrections to the name or address of an EUTM or EUD applicant, a party to the proceedings, or a representative, see the Guidelines, Part A, General rules, Section 5, paragraph 11, Correction of the name or address.

4.4. Procedure

The Office corrects errors (as defined in Article 102 EUTMR and Article 92 EUDR), either of its own motion (where the Office itself has become aware of the error) or at the request of one of the parties.

Where the proprietor requests the correction of errors in the registering or publishing of the registration of an EUTM or EUD, the request must contain the following information:

- the registration number of the EUTM or EUD;
- the name and address of the EUTM proprietor or EUD holder or the ID number assigned by the Office and the proprietor's name;
- where the EUTM proprietor or EUD holder have appointed a representative, the name and business address of the representative or the name of the representative and their ID number as assigned by the Office;
- the indication of the entry in the Register or the content of the publication of the registration to be corrected, together with its corrected version.

A single request may be made for the correction of errors in respect of two or more registrations belonging to the same EUTM proprietor or EUD holder.

If the requirements for the requested correction are not fulfilled, the Office will inform the applicant of the deficiency. If the deficiency is not remedied within the two months specified by the Office, the request for correction will be refused.

Requests for the correction of errors that do not concern entries in the Register or the content of the publication of registrations will be refused.

Unlike in revocation, Article 102 EUTMR and Article 92 EUDR do not establish any procedural steps. A corrigendum will be sent to the affected party/parties. The accompanying letter must briefly explain the corrections.

4.5. Publication of corrections

a) Correction to entries in the Register

Corrections to entries in the Register must be published pursuant to Article 102(3) EUTMR and Article 92(3) EUDR and Article 116(1)(a) EUTMR. Corrections of errors in Register entries are published in subsection C.10. of the Bulletin for EUTMs and B.1 for EUDs and entered in the Register indicating the date on which they were recorded.

The EUTM proprietor or EUD holder will be notified of any changes in the Register (Article 111(6) EUTMR and Article 104(6) EUDR).

An extract of the Register (in certified or simple form) to reflect the current status of the EUTM or EUD can be requested at any time. For more information on obtaining certified extracts from the Register, see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files.

No corrections need to be published pursuant to Article 102 EUTMR and Article 92 EUDR when the initial publication was in the wrong section of the Bulletin.

b) Correction of errors in registered and published EUTMs or EUDs

For more information, see paragraph 4.4.

c) Corrections in decisions

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

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

d) Correction in notifications other than decisions

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 7

Revision

1 General principles

Article 66 EUTMR
Article 77(2) EUDR
Article 69 EUTMR Article 34(1) EUTMDR

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

Revision enables the first-instance decision taker to rectify a decision that has been appealed if the appeal is admissible and well founded. The purpose of revision is to avoid the Boards of Appeal ruling on appeals against decisions for which a need for rectification has been recognised by the department that took the decision.

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

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

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

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

2 Revision of decisions

Article 69 EUTMR

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

Article 77(2) EUDR

Article 10 EUDDR

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

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

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

- the appeal is admissible (Article 23(1) EUTMDR, Article 10 EUDDR); and

- the appeal is ‘well founded’ within the scope of the appeal, on substantive or procedural grounds.

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

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

2.1 No rectification of the appealed decision

Article 69(2) EUTMR

Article 77(2) EUDR

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

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

2.2 Rectification of the appealed decision

Article 69(1) and (2) EUTMR

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

Article 77(2) EUDR

Article 10 EUDDR

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

In addition, the following procedural actions will be taken:

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

2.2.1 Contents of the decision on rectification

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

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

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

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

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

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

     or
   - a statement that a new decision on the merits of the case replacing the initial decision is herewith adopted, and a statement that an appeal can be filed within 2 months.

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

2.2.2 Communication of the decision on rectification

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 8

Restitutio in integrum

1 General principles

Article 104 EUTMR

Article 95 EUDR

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

Observing time limits is a matter of public policy, and serves the requirements of legal certainty and the need to avoid any discrimination or arbitrary treatment in the administration of justice. Derogations from these rules can only be made in exceptional circumstances (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 34). Consequently, the conditions for the application of *restitutio in integrum* have to be interpreted strictly (19/09/2012, T-267/11, VR, EU:T:2012:446, § 35; 16/06/2015, T-585/13, JBG Gauff Ingenieure (fig.) / Gauff et al., EU:T:2015:386, § 25).

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

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

2 Criteria for granting *restitutio in integrum*

There are two requirements for *restitutio in integrum*:

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

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

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

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

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

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

   Failure to deliver mail (in EUTM-related proceedings)

   In principle, in EUTM-related proceedings, failure to deliver by postal or delivery service does not involve any lack of due care by the party concerned (25/06/2012, R 1928/2011-4, SUN PARK HOLIDAYS / SUNPARKS). However, it is up to the parties' representative to at least find out in advance from the delivery company what the usual delivery times are (for example, in the case of letters sent from Germany to Spain in the decision of 04/05/2011, R 2138/2010-1, YELLOWLINE / Yello).

   Errors of the Office and their repercussions

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

   Force majeure

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

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

   a. **Errors in administration or organisation**

      Delegation of tasks

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

      Management of files

      Errors in the management of files caused by the representative's employees or by the computerised system itself are predictable. Consequently, due care would require a system for monitoring and detecting any such errors (13/05/2009, T-136/08, Aurelia, EU:T:2009:155, § 18; 26/09/2017, T-84/16, widiba (fig.) / ING DiBa (fig.) et al., EU:T:2017:661, § 39; 21/04/2021, T-382/20, Table knives, forks and spoons, EU:T:2021:210, § 31-34).

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

Workload

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

Absence of a key member of the accounts department

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

Delay in instructions

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

Financial problems / closure of business

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

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

Legal errors and misunderstandings

Legal errors by a professional representative do not warrant *restitutio in integrum* (16/11/2010, R 1498/2010-4, REGINE'S / REGINA DETECHA, CH.V.D). A misunderstanding of the applicable law may not, as a matter of principle, be regarded as an 'obstacle' to compliance with a time limit (14/06/2012, R 2235/2011-1, KA; 28/04/2020, R 2391/2019-5, STAHL (fig.)).

Consideration of time limits

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

Calculation of time limits

An erroneous calculation of the time limit does not constitute an exceptional event that cannot be predicted from experience (05/07/2013, R 194/2011-4, PAYENGINE / SP ENGINE). The correct calculation of the deadline is governed by the EUTMR and the EUTMDR, and the party cannot justify its non-compliance with the time limit by the fact that the deadline was not displayed in the Office's online database (03/09/2019, R 500/2019-5, minimon (fig.) / Minimensch, § 36).

The same rule applies to European Union designs where the relevant provisions are in the EUDR and the EUDIR.

c. **Clerical mistakes**

Deletion of a deadline

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

Bank transfer error

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

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

Articles 41 and 42 and Articles 47(2), 95(2), 96(1) and 104(1) EUTMR Article 7, Article 8(1) to (4), (7) and (8), Article 14 and Article 17(1) and (2) EUTMDR Articles 81 and 95(1) EUDR Articles 4 and 6 EUDDR

Failure to meet the time limit must have had the direct consequence of causing the loss of rights or means of redress.

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

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

Restitutio in integrum is also available for the late submission of facts and arguments and late filing of observations on the other party's statements in inter partes proceedings if and when the Office refuses to take them into account as being filed

late. The loss of rights in this case involves the exclusion of these submissions and observations from the facts and arguments on which the Office bases its decision.

3 Procedural Aspects

Article 104(2) EUTMR

Article 65(1)(i) EUTMDR

Article 95(2) EUDR

3.1 Proceedings to which *restitutio in integrum* applies

Restitutio in integrum is available in all proceedings before the Office (*ex parte*, *inter partes* and appeal proceedings).

This includes proceedings under the EUTMR and EUDR . The relevant provisions differ in terms of the requirements for translations (see paragraph 3.7), the time period for a request relating to non-payment of a renewal fee (see paragraph 3.5) and the reimbursement of the fee (see paragraph 3.6).

Unless specifically excluded by Article 104(5) EUTMR or Article 95(5) EUDR, *restitutio in integrum* is available.

For *restitutio in integrum* in renewal proceedings see paragraph 3.12.

3.2 Parties

Article 104 EUTMR

Article 95 EUDR

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

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

3.3 Time limits excluded from *restitutio in integrum*

Article 104(5) EUTMR

Article 95(5) EUDR

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

- The time limit for filing an opposition referred to in Article 46(1) EUTMR, including the time limit for paying the opposition fee referred to in Article 46(3) EUTMR.
- The time limits for requesting *restitutio in integrum* itself pursuant to Article 104(2) EUTMR and Article 95 EUDR, namely:
  - a time limit of 2 months for filing the application for *restitutio in integrum* as from the removal of the cause of non-compliance;
  - a time limit of 2 months from the date for completing the act that was omitted;
  - a time limit of 1 year for filing the application for *restitutio in integrum* as from the expiry of the missed time limit.
- The time limit for requesting continuation of proceedings pursuant to Article 105(1) EUTMR and Article 96(1) EUDR and the time limit for paying the fee referred to in Article 105(1) EUTMR and Article 96(1) EUDR.
- The 2-month time limit to file an appeal against the decision of the Boards of Appeal before the General Court (08/06/2016, T-583/15, DEVICE OF THE PEACE SYMBOL, EU:T:2016:338).

3.4 Effect of *restitutio in integrum*

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

3.5 Time limits for requesting restitutio in integrum

Articles 53(3) and 104(2) EUTMR Articles 95(2) and 66(3) EUDR

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

The applicant must make the application within 2 months of the removal of the cause of non-compliance and no later than 1 year after expiry of the missed time limit. However, in case of non-payment of a renewal fee for designs, the application must be made no later than one year from the date of expiration of the grace period for renewal (Article 66(3) EUDR). Within the same period, the act that was omitted must be completed. The date when the cause of non-compliance is removed is the first date on which the party knew or should have known about the facts that led to the non-observance. If the ground for non-compliance was the absence or illness of the professional representative dealing with the case, the date on which the cause of non-compliance is removed is the date on which the representative returns to work.

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

3.6 Fees

Article 104(3) and Annex I (22) EUTMR

Article 95(3) and Annex I (11) EUDR

The applicant must also pay the fee for *restitutio in integrum* within the same time limit (see paragraph 3.5 above).

As a general rule, the individual fee (EUR 200) must be paid for each application for *restitutio in integrum* (i.e. one fee is due per individual right). Nevertheless, in certain cases exceptions may apply. The minimum conditions for applying such exceptions are the following:

1. all the rights should relate to the same rights holder;
2. all the rights should be of the same type (e.g. EUTMs, EUDs);
3. the unobserved time limit should be the same for all rights (e.g. missed time limit for renewal);
4. the loss of all rights concerned should be the result of the same circumstances.

These conditions are cumulative. Therefore, only when all of them are met, can the application for *restitutio in integrum* relating to multiple rights be subject to a single fee.

If all the conditions are not met, an individual fee must be paid for each right concerned.

If the applicant does not pay the fee by expiry of the time limit, the application for *restitutio in integrum* will be deemed not to have been filed.

In the event the application is deemed not to have been filed due to late or insufficient payment of the fee or because it was filed in relation to a time limit that is excluded from *restitutio in integrum* (see paragraph 3.3 above), any fee paid (including late or insufficient fees) will be refunded.

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

In EUD proceedings, the fee will be refunded if the request for *restitutio in integrum* is granted (Article 95(3) EUDR).

3.7 Languages and translations

Article 146 EUTMR

Article 24 EUTMIR

Article 137(5) and (7) EUDR

Article 15 EUDIR

The applicant must submit the application for *restitutio in integrum* in the language, or in one of the languages, of the proceedings in which the failure to meet the time limit occurred. For example, in the EUTM registration procedure, this is the correspondence language indicated in the application; in the EUD registration procedure this is the language used for filing the application or the second language indicated by the applicant in the application; in the opposition procedure, it is the language of the opposition procedure; in the EUD invalidity procedure, it is the language of the invalidity procedure (Article 137(4) EUDR); and in the renewal procedure, it is any of the Office's five languages.

Where the application for *restitutio in integrum* is not filed in the language of the proceedings, the applicant must submit a translation into that language within one month of the date of submission of the application (Article 146(9) EUTMR and Article 137(7) EUDR). If a translation into the language of proceedings is not submitted on time, the application for *restitutio in integrum* will be rejected as inadmissible.

Evidence in support of the application for *restitutio in integrum* may be filed in any official language of the European Union. Where evidence was not submitted in the language of the proceedings, the Office may require a translation into that language (Article 24 EUTMIR and Article 15 EUDIR).

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

3.8 Particulars and evidence

Articles 97 and 104 EUTMR

Articles 83 and 95 EUDR

In its application for *restitutio in integrum* the applicant must state the grounds on which the application is based and set out the facts on which it relies. The application must set out which deadline has been missed.

As granting *restitutio in integrum* is essentially based on facts, it is advisable for the requesting party to submit evidence by means of sworn or affirmed statements. Statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence (16/06/2015, T-586/13, Gauff

THE ENGINEERS WITH THE BROADER VIEW (fig.) / Gauff et al., EU:T:2015:385, § 29).

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

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

3.9 Competence

Article 104 EUTMR

Article 95 EUDR

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

3.10 Publications

Articles 53(5), (7) and (8), and 104(7), Articles 111(3)(k) and (l) and 116(1)(a) EUTMR

Article 66(7) and (8), Article 95, Article 104(3)(n) and (o), and Article 107(1)(a) EUDR

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

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

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

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

Articles 66 and 67 EUTMR

Article 77 EUDR

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

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

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

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

3.12 *Restitutio in integrum* in the event of renewals

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

Party to the proceedings

In renewal proceedings, authorised persons within the meaning of Article 53(1) EUTMR or Article 66(1) EUDR who missed the renewal deadline are party to the renewal proceedings and may, therefore, request *restitutio in integrum* in their own name (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 26, 31-32).

Time limits

Where a renewal deadline was missed and the loss of rights was notified to the EUTM proprietor, the day of this notification is the point in time from which a diligent proprietor has 2 months to comply with the requirements set out in Article 104 EUTMR or Article 95 EUDR (30/09/2010, C-479/09 P, DANELECTRO, EU:C:2010:571, § 36, 42; 28/09/2021, R 396/2021-2, Netcomponents, § 28). The notification of the loss of right to the proprietor is also valid for an authorised person (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 47 et seq.).

If the applicant for the renewal of an EUTM fails to submit the request for renewal or to pay the renewal fee, the 1-year period after expiry of the missed time limit

(Article 104(2) EUTMR) starts on the day on which the protection ends and *not* on the expiry of the further 6-month grace period set out in Article 53(3) EUTMR.

However, for the renewal of an EUD, the 1-year period after expiry of the missed time limit (Article 95(2) EUDR) starts on the expiry of the further 6-month grace period set out by Article 66(3) EUDR.

Fees

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

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

Indication of which period should be reinstated

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

4 Third-Party Proceedings

Article 104(6) and (7) EUTMR Article 95(6) and (7) EUDR

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

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

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

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

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

The Regulations do not contain any provisions governing this procedure. The division or department that took the decision to re-establish the rights is responsible for third-

party proceedings. The Office will conduct adversarial *inter partes* proceedings, which means that it will hear both parties before taking a decision.

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 9

Enlargement

1 Introduction

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

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

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

2 Rules Concerning Examination

2.1 Automatic extension of EUTMs to new Member States

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

2.2 Pending EUTM applications

Article 209(2) EUTMR enshrines an important transitional provision, according to which EUTM applications **pending on the accession date** may not be refused on the basis of any of the absolute grounds for refusal listed in Article 7(1) EUTMR if this ground becomes applicable merely because of the accession of a new Member State ('grandfathering clause'). In practice, this means that if, for example, an EUTM application is non-distinctive, descriptive, generic, deceptive or contrary to public policy or morality in the language or in the territory of a new Member State, it will not be refused if its filing date is **before** this State's accession date.

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

relevant to its application. Therefore, examiners have to apply the same examination criteria as for all the other official languages of the EU. This means that the examiner also has to check whether the EUTM application is descriptive, etc. in the new Member State.

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

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

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

2.3 Distinctiveness acquired through use

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

2.4 Bad faith

The Office will consider the filing of an EUTM application as having been made in bad faith if it was made prior to the accession date for a term that is descriptive or otherwise not eligible for registration in the language of a new Member State for the sole purpose of obtaining exclusive rights to a non-registrable term or for otherwise objectionable purposes.

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

2.5 Conversion

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

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

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

2.6 Other practical consequences

2.6.1 Professional representation

As from the accession date of a new Member State, applicants (as well as other parties to proceedings before the Office) with their seat or domicile in that State need no longer be represented by a professional representative. As from the accession date of

a new Member State, professional representatives from that State may be entered on the list of professional representatives maintained by the Office pursuant to Article 120 EUTMR and may then represent third parties before the Office.

2.6.2 First and second language

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

2.6.3 Translation

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

2.6.4 Seniority

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

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

2.6.5 Search

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

3 Rules Concerning Oppositions and Cancellations

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

4. According to Article 209(5) EUTMR , the use of an EUTM with a filing date prior to the date of accession of a new Member State, may be prohibited pursuant to Articles 137 and 138 EUTMR on the basis of an earlier national trade mark registered in the new Member State where the latter has a filing or priority date prior to the date of accession and was registered in good faith.
   The above provision also applies to:
   - applications for national marks filed in new Member States, provided that they have subsequently been registered;
   - unregistered rights acquired in new Member States falling under Article 8(4) or Article 60(2) EUTMR with the proviso that the date of acquisition of the right under national law replaces the filing or priority date.
5. Where an opposition is based on a national registered mark or other right in a new Member State, whether or not that right may validly be invoked as a ground for opposition against an EUTM application depends on whether the opposition is well founded and is not an issue of admissibility.
6. The acquisition in good faith of the earlier national mark is presumed. This means that, if good faith is questioned, the other party to the proceedings (the applicant for the opposed EUTM application in the case of Article 209(4) EUTMR or the owner of the registered EUTM in the case of Article 209(5) EUTMR) must prove that the owner of the earlier national right obtained in a new Member State acted in bad faith when filing the national application or otherwise acquiring the right.
7. Article 209 EUTMR does not contain any transitional provisions concerning the use requirement (Articles 18 and 47 EUTMR). In opposition proceedings, the obligation to prove genuine use of the mark arises when the applicant for the opposed EUTM application requests that the opponent prove use of the earlier mark pursuant to Article 47(2) and (3) EUTMR and Article 10 EUTMDR . Issues relating to enlargement could arise regarding the time and place of use of the earlier mark.
   Two cases can be distinguished:
   a. **The earlier mark is a national mark registered in a new Member State**
      In this case, the opponent must prove genuine use of the earlier mark. This situation can only arise in the context of an opposition directed either against an EUTM application with a filing date after the date of accession or against an EUTM application filed within the period of 6 months preceding the date of accession.

      The earlier national mark must have been put to genuine use in the territory in which it is protected during the 5 years preceding the filing or priority date [13] of the contested EUTM application. In this regard, it is immaterial whether the use relates to a period during which the State concerned was already a Member State of the European Union. In other words, the proof of use may also relate to a period prior to the date of accession (in the case of Croatia before 01/07/2013).
   b. **The earlier mark is an EUTM**
      Where the owner of the earlier EUTM can prove use only in the territory of a new Member State or several new Member States, since the obligation of use relates

[13] For oppositions and invalidity applications filed before 23/03/2016, the relevant date is the publication date.

to the period of 5 years preceding the filing or priority date [14] of the contested EUTM application, use in a new Member State (or several new Member States) can only be taken into account if the State concerned was a Member State of the European Union at the date of filing or the priority date of of the contested EUTM application (Article 47(2) EUTMR requires use *'in the Union').* Before their accession dates, the new States do not constitute 'Member States of the Union'; therefore, it is not possible to prove use *'in the Union'.*

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

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

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

Annex 1

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 10 Evidence

1 Introduction

This section of the Guidelines deals with the general provisions on the means of evidence for proceedings before the Office relating to EUTMs and EUDs. More detailed information concerning each of the proceedings before the Office can be found in the respective dedicated sections of the Guidelines.

Submitting relevant and persuasive evidence is vital to supporting claims, validating the underlying facts and arguments and laying the foundation for a case before the Office. Procedural rules dictate the manner and time limits for submitting evidence, but the quality of that evidence is of utmost importance, so ensuring its credibility (or probative value) is fundamental to its effectiveness. This part of the Guidelines aims to assist parties in understanding the rules relating to evidence and how the probative value of evidence can be enhanced. Based on the relevant legal framework and case-law, practical guidance is given on the kind of evidence that can be submitted to prove a fact or support an argument, as well as how it should be presented.

This section is structured as follows:

- General principles − defines the concepts of facts, evidence and arguments, presents the principles for admissibility and relevance, and clarifies the burden and standard of proof;
- How to submit evidence − outlines the procedural framework for collection of evidence;
- Specific means of evidence − focuses on the different kinds of evidence that can be submitted;
- Belated evidence in inter partes proceedings − discusses the rules governing belated presentation of evidence in inter partes proceedings.

2 General principles

Articles 95, 96 and 97 EUTMR

Articles 49 to 55 EUTMDR

Articles 80, 81 and 83 EUDR

Article 11 EUDDR

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

Common Communication on Evidence in Trade Mark appeal proceedings: Filing, Structure and Presentation of Evidence, and the Treatment of Confidential Evidence published on 31 March 2021 (CP12)

2.1 Facts, evidence and arguments

The EUTMR, EUDR and respective secondary acts use the expression 'facts, evidence and arguments' in provisions related to proceedings before the Office. They are the fundamental elements in legal discourse. The relationship and interplay between (i) facts; (ii) evidence; and (iii) arguments is pivotal as each plays a vital but distinct role in the decision-making process.

Facts refer to circumstances, events or situations that constitute the foundations of a claim (or defence). They are the material elements that must be established for the application of the relevant legal provision.

Evidence is the means by which the facts are supported and can be verified. The relevance and reliability of the evidence determines its 'probative value' in supporting the alleged facts or legal provision (see paragraph 2.3.2).

Arguments advance reasons for (i) establishing certain facts; or (ii) for deciding how a legal rule applies to a particular set of facts.

A fundamental task of the Office is evaluating facts, evidence and arguments when deciding on the questions of law pertinent to the matters brought before it. Pursuant to Article 95(1) EUTMR and Article 80(1) EUDR, the Office must make its own evaluation of the facts. In *inter partes* proceedings, the Office is restricted in this examination to the 'facts, evidence and arguments provided by the parties and the relief sought'. As explained below, the extent of the latter restriction has been clarified by case-law in two important aspects: (i) it does not preclude the Office from considering well-known facts; and (ii) it obliges the Office to examine the conditions for application of a provision relied on by the parties in support of their claims.

An important distinction exists between what is a question of fact and what is a question of law.

- **Questions of law** relate to the interpretation and application of legal rules. The decisions of the Office must determine the questions of law that are *necessary*[15]

  for resolving the matter before it and ensuring the correct application of the law (see, to that effect, judgment of 12/07/2023, T-694/21, aTmos, EU:T:2023:395, § 69). These questions of law include any matters that must be examined for the purpose of assessing the facts and evidence relied on by the parties and allowing or dismissing their arguments.

  Some questions of law concern essential procedural requirements or are necessary to be resolved to ensure the correct application of the law. These legal parameters must be examined by the Office even if not raised by the parties. For example:

  - in opposition proceedings based on likelihood of confusion, determining the inherent distinctive character of the earlier mark is necessary even if not raised

15 There is no duty to deal with every argument presented but rather to reach conclusions and give reasons to show the basis upon which the decision has been decided.

by any party (18/06/2020, C-702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 43);

- the definition of the relevant public and territory should always be examined as it forms part of the global analysis of whether there is a likelihood of confusion, even if not raised by any party (05/10/2017, T-337/16, VERSACCINO (fig.) / VERSACE et al., EU:T:2017:692, § 67-68).

Other questions of law will be analysed by the Office only if raised and argued by parties, for example, a claim for enhanced distinctiveness of the earlier mark.

- **Questions of fact** concern the circumstances, events or situations to be proven through evidence. For example, in opposition proceedings, it is a question of fact whether the relevant public understands a certain element of a sign in a particular way.

  Importantly, Article 95(1) EUTMR does not prevent the Office from considering, on its own initiative, well-known facts that do not have to be proven as they are likely to be known by everyone or that may be learnt from generally accessible sources (05/10/2017, T-36/17, COLINEB / Colina (fig.), EU:T:2017:690, § 29). For more information, seePart A, General rules, Section 2, General principles to be respected in the proceedings, 1 Adequate reasoning, and the case-law cited therein.

For more information regarding the distinction between questions of fact and questions of law in the assessment of likelihood of confusion, see Part C Opposition, Section 2 Double identity and likelihood of confusion, Chapter 1 General principles, 3.4 Likelihood of confusion: questions of fact and questions of law.

2.2 Burden of proof

The burden of proof refers to the obligation to provide evidence and arguments in support of a factual or legal claim. As a rule, it lies on the party making or placing reliance upon the claim.

Establishing where the burden of proof lies is particularly important in inter partes proceedings, where, pursuant to Article 95(1) EUTMR and Article 80(1) EUDR, the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought [16]. For example, in opposition proceedings, if, in response to a request by the EUTM applicant, the opponent fails to submit evidence to prove use of the only earlier mark invoked, the opposition will be rejected in line with Article 47(2) and (3) EUTMR. Likewise, if the applicant is arguing coexistence of conflicting marks, it must present evidence showing that such marks coexisted peacefully, that the relevant public was aware of each of the trade marks in question before the date of filing of the application for registration and the other requisites

16 Except, as explained above, that (i) the Office can take into consideration well-known facts and (ii) must examine the conditions of application of a provision relied on by the parties in support of their claims even if the parties do not present arguments.

(01/03/2018, C-412/16 P, ocean beach club Ibiza (fig.) / ocean club Ibiza (fig.), EU:C:2018:140, § 43-44).

Although in general, the burden of proof is on the party making the claim, there are situations where it is reversed. For example, in revocation cases based on non-use, the cancellation applicant is not required to prove its claim that the contested mark was not put to genuine use, but it is for the EUTM proprietor to prove that its mark has been genuinely used. This follows from Article 19(1) EUTMDR and is confirmed in case-law (10/03/2022, C-183/21, MAXUS, EU:C:2022:174, § 36-38). For more information, see Part D, Cancellation, Section 2, Substantive provisions, paragraph 2.2.1 Burden of proof.

The burden of proof can also be shifted where a presumption exists. For example, there is a presumption of good faith that the proprietor enjoys in a cancellation action where bad faith is pleaded. Where compelling evidence rebuts that presumption, it is for the proprietor to provide plausible explanations regarding the objectives and commercial logic pursued by the application for registration of the relevant mark (23/05/2019, T-3/18 & T-4/18, ANN TAYLOR / ANNTAYLOR et al., EU:T:2019:357, § 36-37 and case-law cited therein). For more information on burden of proof where bad faith is claimed, see Part D, Cancellation, Section 2, Substantive provisions, paragraph 3.3.3 Proof of bad faith.

2.3 Standard of proof and probative value

When evaluating evidence in proceedings, two related but distinct concepts come into play: the standard of proof and the probative value.

The standard of proof refers to the level of evidence needed to prove a fact in a legal case. The two main standards are ‘beyond a reasonable doubt’ (mostly for criminal cases) and ‘on the balance of probabilities’ (for civil matters).

Probative value, on the other hand, refers to the quality of the evidence and its ability to prove a given thing. By way of example, evidence from independent and impartial sources generally has a higher probative value than evidence originating from the party itself.

Determining the probative value of evidence is a key step when assessing all the evidence together against the applicable standard of proof.

2.3.1 Standard of proof

Factual assertions must be proven with specific and compelling evidence, not based on probabilities or suppositions (see 10/09/2008, T-325/06, CAPIO / CAPIOX, EU:T:2008:338, § 34). The submitted evidence must be assessed to determine whether it satisfies the necessary standard of proof, which, in general, is based on the balance of probabilities test (23/05/2019, T-312/18, AQUAPRINT / AQUACEM et al., EU:T:2019:358, § 107).

Consequently, a party must prove that its assertions are more likely to be true than not. Mere suppositions are not sufficient, and the party must present clear and convincing evidence to validate the requirements of the respective claim, such as:

- for establishing reputation (Article 8(5) EUTMR) – 'detailed and verifiable' evidence is required (10/05/2007, T-47/06, NASDAQ (fig.) / NASDAQ, EU:T:2007:131, § 52);
- for proving use which is detrimental or the risk of detriment to the distinctive character of the earlier mark under Article 8(5) EUTMR – serious likelihood of a change in the economic behaviour of the average consumer must be established (19/05/2021, T-510/19, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:T:2021:281, § 143 & 152);
- proving bad faith under Article 59(1)(b) EUTMR requires evidence which given the seriousness of the allegation cannot be regarded as incidental, doubtful or weak (23/05/2019, T-3/18 & T-4/18, ANN TAYLOR / ANNTAYLOR et al., EU:T:2019:357, § 177).

The Office evaluates the evidence submitted in an overall assessment, meaning all the circumstances of the specific case have to be considered and all the materials submitted must be **assessed in conjunction with each other**. Even if pieces of evidence may be insufficient by themselves to prove the claim, they may contribute in combination with other documentation and information (17/04/ 2008, C-108/07 P, FERRO / FERRERO, EU:C:2008:234, § 36, and 7/02/2024, T-792/22, WOXTER (fig.), EU:T:2024:69, § 41).

Moreover, evidence must be assessed in the view of the particular circumstances of the case. Therefore, evidence that would be deemed insufficient in certain cases may be enough to tip the balance in a specific situation. For example, low sales figures may indicate genuine use where the products are expensive or niche (05/03/2025, T-118/24, ROZALIYA jewelry for enlightenment, EU:T:2025:216, § 52).

2.3.2 Probative value

The parties must provide persuasive and reliable evidence that is convincing as to the assertions made.

In proceedings before the Office, the only relevant criterion for the purpose of assessing the probative value of evidence lawfully adduced is its credibility (13/05/2020, T-288/19, IPANEMA (fig.) / iPANEMA (fig.) et al., EU:T:2020:201, § 41). Credibility is a guiding principle in the examination of evidence and the Office must assess whether evidence can be regarded as trustworthy, reliable and objectively persuasive. For written evidence, which is by far the most common form submitted in proceedings before the Office, case-law provides a consistent set of criteria for assessing credibility (06/11/2014, T-463/12, MB / MB&P (fig.) et al., EU:T:2014:935, § 53). In particular, the probative value of evidence must be examined in light of:

- its origin, including who issued it and their relationship to the parties;
- the circumstances in which it was drawn up, such as the purpose and timing of its creation;
- its addressee, which may indicate its intended use or reliability;

- its content, the plausibility and accuracy of the information contained and if it appears to be sound and reliable.

The origin and context of the evidence are important indicators of their credibility. Documents originating from independent sources are given more weight in terms of credibility. On the other hand, documents originating from individuals closely linked to the party submitting them – such as statements made by the chief operating officer or a hired expert – are given less weight in terms of probative value due to their lack of independence. While such evidence is admissible, it cannot, on its own, substantiate the allegations made (30/06/2009, T-435/05, DR. NO / DR.NO, EU:T:2009:226, § 45 and 07/06/2005, T-303/03, Salvita / SOLEVITA, EU:T:2005:200, § 42-45).

The credibility of certain types of evidence, even when prepared by reputable experts, is often questioned. For example, consumer surveys may be challenged for methodological flaws, such as leading questions that encourage 'unusual speculation' (02/03/2022, T-125/21, Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL (fig.) et al., EU:T:2022:102, § 43-47).

Similarly, sworn affidavits or statutory declarations are generally attributed a low probative value. The Court of Justice has emphasised that, to assess their plausibility, it is essential to consider who issued the document, the circumstances of its creation, its addressee, and whether its content appears sound and reliable (07/09/2022, T-521/21, ad pepper the e-advertising network (fig.), EU:T:2022:520, § 99 and the case-law cited).

More information on the assessment of different types of written evidence is presented in paragraph 4.

2.4 Admissibility and relevance

To be **admissible**, evidence must comply with the relevant procedural rules set by the regulations and the respective Executive Director's decisions. For example:

- The Office may disregard evidence which is not submitted in due time (Article 95(2) EUTMR and Article 80(2) EUDR).
- Written evidence must be presented in accordance with the formal requirements of Article 55 EUTMDR which also apply in proceedings related to EUDs by virtue of Article 11 EUDDR;
- If an annex on a data carrier does not comply with the acceptable type of data carriers under Article 2(1) or the technical specifications under Article 3 and 4 of Decision No EX-26-05, the Office will deem it not filed without inviting the party to overcome the deficiency (Article 6(a) Decision No EX-26-05).

Relevance refers to the connection between the evidence and the facts to be proved. The following table contains **examples** of claims with general indications about the evidence relevant to the facts that must be proven:

Table 1: EUTM proceedings

Table 2:

Claim	Aim of evidence submitted by the party	Cross reference
Descriptive mark	To demonstrate that a trade mark consists/does not consist exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services for which registration is sought or the trade mark is registered, in the relevant territory.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Descriptive trade marks (Article 7(1)(c) EUTMR) Part D, Cancellation, Section 2, Substantive provisions, 3 Absolute Grounds for Invalidity
Non-distinctive mark	To demonstrate that the trade mark is/is not devoid of any distinctive character. Such distinctiveness can be assessed only by reference, first, to the goods or services for which registration is sought or the trade mark is registered and, second, to the relevant public's perception of that sign, in the relevant territory.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 3, Non-distinctive trade marks (Article 7(1)(b) EUTMR) Part D, Cancellation, Section 2, Substantive provisions, 3 Absolute Grounds for Invalidity
Acquired distinctiveness	To demonstrate that a mark has acquired a distinctive character in the relevant geographical area regarding the goods or services for which registration is requested or for which the mark is registered, following the use which has been made of it.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 14, Acquired distinctiveness through use (Article 7(3) EUTMR)

Enhanced distinctiveness	To demonstrate that a mark has obtained enhanced distinctiveness, in the relevant geographical area, as a consequence of the use which has been made of it. The evidence of enhanced distinctiveness acquired through use should also refer to the relevant goods and services.	Part C, Opposition, Section 2, Double Identity and likelihood of confusion, Chapter 5, Distinctiveness of the earlier mark, 2 Assessment of Distinctiveness of the earlier mark, 2.3 Examination of enhanced distinctiveness Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation
Reputation	To demonstrate that a mark is known by a significant part of the public concerned, in the territory in which reputation is claimed, for the relevant goods or services covered by that trade mark.	Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation
Well-known mark	To demonstrate that a mark is well known in the Member State(s) concerned, in the sense in which the words 'well known' are used in Article 6*bis* of the Paris Convention. The mark should be well known in the relevant sector of the public for the particular goods and services.	Part C, Opposition, Section 1, Opposition proceedings, 4.2.4.1 Well-known marks Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation
Proof of use / genuine use	To demonstrate that within a specific period the proprietor has put the trade mark to genuine use in the Member State(s) in connection with the relevant goods or services in respect of which it is registered. The evidence should consist of indications concerning the place, time, extent and nature of use of the trade mark.	Part C, Opposition, Section 7, Proof of Use

Table 2: EUD proceedings

Table 3:

Claim	Aim of evidence submitted by the party	Cross Reference
Disclosure	To demonstrate that an earlier design that is identical or produces the same overall impression on the informed user as the contested design has been made available to the public before the date of filing of the application for registration or, if a priority is claimed, the date of priority (Article 8 EUDR).	Design Guidelines, Examination of design invalidity applications, 5.7.1 Disclosure of earlier design
Features of appearance solely dictated by the technical function of the product	To demonstrate that no consideration other than the technical function of the design played a role in designing a given feature or all the features of a design (Article 9(1) EUDR).	Design Guidelines, Examination of design invalidity applications, 5.5.2.2 Appropriate evidence of functionality

There are also other aspects that can determine the relevance of the evidence, such as the point in time to be considered under each ground and, specifically for trade mark proceedings, the goods and services involved.

3 How to submit evidence

Article 115(3) EUTMR, Article 64(2) EUTMDR, Article 112 EUDR
Decision No EX-25-04 of the Executive Director of the Office of 7 April 2025 on the keeping of files and the inspection of files
Decision No EX-26-05 of the Executive Director of the Office of 1 July 2026 on technical specifications for annexes submitted on data carriers

According to Article 97 EUTMR, Article 51 EUTMDR, Article 83 EUDR and Article 43 EUDIR, the means of giving and obtaining evidence in all proceedings before the Office include:

- hearing the parties;
- requests for information;
- producing documents and items of evidence;
- hearing witnesses;

- expert opinions;
- sworn or affirmed statements in writing or statements having a similar effect under the law of the State in which they are drawn up;
- inspection *in situ* by the Office.

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

- invoices and other commercial documents;
- catalogues, advertisements and marketing-related documents;
- publications;
- samples;
- official and public documents;
- witness statements;
- sworn or affirmed statements (affidavits);
- market surveys;
- extracts from social media, printouts and screenshots from online sources.

Different types of evidence may be submitted to establish the same fact or requirement and the parties are free to choose the means of evidence they submit (26/06/2019, T-651/18, HAWKERS (fig.) / HAWKERS (fig.) et al., EU: T:2019:444, § 35).

Choosing the right information to present as evidence is important. The evidence must be sufficiently specific to prove the facts at issue. For example, general evidence about turnover or profits will not indicate the extend of use as effectively as the more specific programming details and length of time for the broadcasting of a film on TV or screening in cinemas which more accurately show the extent of use (30/06/2009, T-435/05, DR. NO / DR. NO, EU:T:2009:226, § 45).

3.1 General requirements and recommendations

According to Article 55(2) EUTMDR and Article 11 EUDDR on the examination of written evidence in proceedings, any documents or other items of evidence must be contained in an annex to the submission. The submission must also include an index detailing the evidence in the annexes, namely:

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

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

Annex No.	**Description**	**Pages**	**Page where the evidence is mentioned**

Annex 1	Survey 2021	1 - 30	Observations, page 1
Annex 2	Catalogues 2022	31 - 45	Observations, page 5

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

As regards evidence on **data carriers**, technical specifications are established in Decision No EX-26-05 of the Executive Director of the Office of 1 July 2026 on technical specifications for annexes submitted on data carriers (for further information see the Guidelines,Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.4, Data carriers). Parties must structure evidence on data carriers in line with Article 55 EUTMDR treating each folder as the equivalent of an 'Annex'.

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

1. the parties should limit their submissions strictly to items of evidence that are relevant to the case and to the ground/argument in question and avoid extraneous or superfluous materials;
2. if documentation is sent in separate batches, each batch should be numbered, have page numbers and show the total number of pages in each batch;
3. even if annexes are submitted at different times in the same proceedings, they should be numbered consecutively to avoid confusion due to repetition of numbering;
4. photographs should be submitted instead of physical specimens (e.g. containers, packaging, etc.) unless the relevant features cannot be reproduced visually;
5. no original documents or items should be sent by mail as the Office will not return any originals but keep them on file (Article 115 EUTMR, Article 112 EUDR);
6. to facilitate scanning, items sent by mail must not be stapled, bound or placed in folders and where items must be sent in duplicate for forwarding to the other party, they should be clearly identified as such;
7. if several trade marks, goods and services or dates are displayed in a single item of evidence, the submission should clearly indicate which is the relevant information for the proceedings in question;
8. if colour is of relevance to the proceedings, the evidence should be submitted in colour (for example, a registration certificate for a mark in colour or evidence of genuine use);
9. if the case involves a range of different earlier marks, grounds, multiple classes, or long lists of goods and services, the party should explain in its submission which issue each item of the evidence supports (e.g. Annexes A-D concern proof of use of the earlier mark 1 for Class 25, or for goods falling under the broad category of clothing in Class 25, Annexes E-F show reputation/well-known character/enhanced

distinctiveness of earlier mark 2 for Class 25, Annex G concerns proof of use of earlier mark 3 for the retail sale of clothing in Class 35).

3.1.1 Deficiencies

A deficiency may be raised pursuant to Article 55(3) EUTMDR and Article 11 EUDDR when:

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

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

For annexes submitted on data carriers, even if the annex complies with the technical specifications of Articles 3 and 4 of Decision No EX-26-05 a deficiency may be raised if the material is illegible.

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

3.2 Specific requirement in inter partes proceedings

In *inter partes* EUTM proceedings, where a communication with annexes is submitted **by post or courier**, the party must submit as many copies of the annexes as there are parties to the proceedings (Article 64 EUTMDR). This requirement does not apply to EUD proceedings where all communication can only be submitted via electronic means.

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

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

- the annex consists of **paper documents larger than A3 size;** or

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

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

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

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

3.3 Confidentiality

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

Time limits	Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.6 Confidentiality
Inspection of files	Part E, Register operations, Section 5 Inspection of files, 4.3.4 Parts of the file for which the party concerned expressed a special interest in keeping confidential

3.4 References to other proceedings

Article 115(3) EUTMR

Article 64(2) EUTMDR

Article 112 EUDR

Decision No EX-25-04 of the Executive Director of the Office of 7 April 2025 on the keeping of files and the inspection of files

Decision No EX-26-05 of the Executive Director of the Office of 1 July 2026 on technical specifications for annexes submitted on data carriers

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

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

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

1. the type and, where applicable, number of the proceedings (e.g. opposition, cancellation proceedings, appeal, transfers etc.);
2. the title of the document and, where relevant, the number of the Annex where the document was contained;
3. the number of pages in the document; and
4. the date the document was sent to the Office.

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

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

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

A party may refer to all or some of the annexes provided previously on a data carrier, but they must also submit a copy of the annexes with the same content on a data

carrier that complies with the **current** technical specifications, as detailed in Decision No EX-26-05.

Material submitted in other proceedings that was not kept in an electronic format may have been destroyed according to Article 115(3) EUTMR, Article 112 EUDR and Decision No EX-23-12. In this case, the party referring to such evidence will be invited to submit the previous evidence again with duplicates if necessary (see the Guidelines, Part A, General rules, Section 10, Evidence, paragraph 2.2, Specific requirement in *inter partes* proceedings). If this evidence is resubmitted on a data carrier, it must comply with Decision No EX-26-05. Where the evidence is resubmitted via the User Area, Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means should be followed.

If reference is made to a procedure in a different language, a translation may be necessary if the content of the evidence is not self-explanatory (for further information on the translation of evidence in *inter partes* proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 4.3.3, Translation of supporting documents other than observations and the Design Guidelines, Examination of design invalidity applications, 3.3 Language of proceedings).

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

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

When referring to such decisions no strict rules apply but they must be clearly identifiable. For example, the Office cites such decisions as follows: Board of Appeal decisions: 02/03/2022, R 1184/2021-5, Sütat, § 5; 15/02/2012, R 2077/2010-1, PEBAFLEX / PEBAX, § 18; General Court decisions: 26/07/2023, T-315/22, Sütat, EU:T:2023:432, § 5; 01/02/2023, T-349/22, Hacker space / Hacker-pschorr et al., EU:T:2023:31 § 35.

When a party refers to **national office or court decisions**, the Office is not bound by those decisions. Nevertheless, national courts have a thorough knowledge of the specific characteristics of their Member State, in particular, the marketplace reality in which goods and services are marketed and the customer perception of signs, and this may be relevant for the assessment made by the Office, especially where the facts are similar (see 18/03/2016, T-501/13, WINNETOU, EU:T:2016:161, § 35-36 and the case law cited). Maximising the relevance of these decisions before the Office will require sufficient information, in particular, about the facts and evidence on which the decision was based as well as an explanation as to why the party believes the national decision is relevant to the outcome of the case.

When the party refers to **decisions of the Office (EUIPO)**, it should explain in detail why it believes that the cases are comparable and how the previous decision may influence the outcome (e.g. same legal issue, same or comparable signs, same parties). In any event, the Office is not bound to come to the same conclusion as

in its previous decision. It must examine each case on its own merits. Regarding the obligations to state reasons, see the Guidelines,Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 1, Adequate reasoning). For additional information on references to national decisions or decisions of the Office, see:

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

4 Specific means of evidence

4.1 Online evidence

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

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

Mere reference to a website

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

- not all web pages mention when they were published;

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

Therefore, a mere reference to a website (even if by a direct hyperlink) **is not valid** . However, the Office accepts a reference to a database recognised by the Office for substantiation purposes in *inter partes* trade mark proceedings (seePart C, Opposition, Section 1, Opposition proceedings, 4.2 Substantiation) and design proceedings (see Design Guidelines, Examination of invalidity application, 3.10.3.1 Online substantiation of earlier rights.

Date of the online evidence

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

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

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

Example:

Case No	Comment

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

4.1.1 Printouts from websites

In principle, extracts from **editable websites**, such as the online encyclopedia Wikipedia or similar sources, can only be attributed a low probative value on their own. This is because their content may be amended at any time and, in certain cases, by any visitor, even anonymously (23/09/2020, T-738/19, Wi-Fi Powered by The Cloud (fig.), EU:T:2020:441, § 38-39; 16/10/2018, T-548/17, ANOKHI (fig.) / Kipling (fig.) et al., EU: T:2018:686, § 131, and the case-law cited therein).

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

Depending on what must be proven, printouts or screenshots will also need to be supported by corroborating evidence in particular situations. For example, when the accuracy of the evidence is contested by the other party, where relevant data is missing, or where evidence is drawn from a website controlled by the interested party or which does not seem reliable for other reasons.

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

4.1.2 Website analytics reports

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

Examples:

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

4.1.3 Social media

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

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

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

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

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

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

For online advertising, see paragraph 4.8.1.

4.2 Affidavits

Overview

Statements in writing sworn, affirmed or having a similar effect under the law of the Member State in which the statement is drawn up (affidavits) are valid means of evidence (Article 97(1)(f) EUTMR, Article 83(1)(f) EUDR).

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

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

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

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

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

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

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

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

4.2.1 Affidavits by the party or its employees

Affidavits coming from the sphere of the interested party (such as an affidavit by inhouse counsel confirming sales and marketing figures) are generally given less weight because the perception of a party involved in the case may be affected by personal interests in the matter.

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

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

4.2.2 Affidavits made by the lawyer representing the party

An affidavit of a lawyer constitutes, in itself, sound evidence of the information contained therein, if it is clear, consistent and conclusive and there is no doubt about its authenticity (16/12/2020, T-3/20, Canoleum / Marmoleum, EU:T:2020:606, § 55-56, 58). This is because a lawyer is a legal professional required to follow a code of ethics and uphold moral standards, which prohibits them, inter alia, from deliberately misleading the authorities and, in particular, the court. Furthermore, if they were guilty of giving a solemnly affirmed statement that was false, that would not only make them

subject to criminal sanctions, but would also jeopardise their professional reputation and cast serious doubts on their integrity.

4.2.2 Affidavits made by third parties

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

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

Example:

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

4.3 Opinion polls and market surveys

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

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

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

4.3.1 Survey provider

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

The survey provider's choice is up to the parties but the Office **recommends** using independent research institutes, companies or other independent experts who have the relevant knowledge and experience to properly understand the survey's purpose, reliably structure and conduct the survey, and to interpret the results.

Example:

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

4.3.2 Target public, sample size and representativeness of the results

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

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

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

A representative sample does not necessarily require a large number of interviewees. It depends on the type of relevant consumer concerned (01/06/2011, R 1345/2010-1, Fukato Fukato (FIG. MARK) / DEVICE OF A SQUARE (FIG. MARK) et al., § 58). The survey should explain how the sample size was chosen for the relevant consumer. There is a particular danger that small samples may be unreliable for general-use goods that target the general public (09/09/2020, T-187/19, Colour Purple -2587C (col), EU:T:2020:405, § 100-101). However, small samples could be representative for certain groups of professionals or more specialised goods and services.

Examples:

Case No	Comment
15/03/2011, R 1191/2010-4, Más Kolombiana…y qué más!! / COLOMBIANA LA NUESTRA (fig), § 23.	A survey was submitted to demonstrate that the earlier sign was well-known to the Spanish public for aerated waters. However, the interviewees were carefully selected on the basis of their origin, that is, Colombians resident in Spain. This is only a very small part of the population living in Spain, and the information was inconclusive.
01/06/2011, R1345/2010-1, Fukato Fukato (fig.) / DEVICE OF A SQUARE (fig.) et al., § 58.	In principle, samples of 1 000-2 000 interviewees are considered sufficient, provided they are representative of the type of consumer concerned. The opponent's opinion poll was based on a sample of 500 interviewees. It was found insufficient considering the services for which reputation was claimed (among others, scientific and technological services).

09/09/2020, T-187/19, Colour Purple -2587C (col), EU:T:2020:405, § 100-101.	The patient surveys were only carried out in 10 EU Member States in relation to pharmaceutical preparations and inhalers. Only 50-200 patients were interviewed in each of the Member States. In light of the market shares held by the applicant in each Member State, the numbers of patients interviewed appeared to be much too low to be reliable. The same is true with regard to the professional public, given that less than 0.1 % of general practitioners in the Member States participated in the surveys.

4.3.3 Method used, form of questions and circumstances

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

The probative value of surveys also heavily depends on how the questions are formulated (24/10/2018, T-261/17, SALOSPIR 500 mg (fig.) / Aspirin et al., EU:T:2018:710, § 68). The questions must be formulated correctly in an open and unassisted manner so they are neutral and representative. They must not lead the participant to a certain answer (13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 79).

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

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

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

For further guidance on structuring surveys and wording questions, see the Common Practice on Evidence in Trade Mark Appeal Proceedings: Filing, Structure and Presentation of Evidence, and the Treatment of Confidential Evidence (CP 12) (on

pages 36-38). CP12 recommends a three-step test for determining the respondents' ability to spontaneously recognise a test object as coming from one specific commercial source.

Examples:

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

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

4.3.4 Dates

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

4.4 Audits

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

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

4.5 Annual reports on economic results and company profiles

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

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

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

4.6 Invoices and other commercial documents

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

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

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

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

Invoices can also be relevant in EUD invalidity proceedings for the purpose of proving disclosure or the state of the art. They may be used in combination with other evidence or even on their own if they include a representation of a prior design.

Codes used in invoices

The invoices should allow a connection to be made between the sign used on the invoiced goods or services. Invoices may not explicitly list the goods or services or the trade mark representation, but they can allow for these to be deduced by including product numbers or codes. The party must explain such codes and numbers. Cross referencing invoices with catalogues or other depictions of the goods, such as packaging, can allow a clear link to be made with the sign in question (27/04/2022, T-181/21, SmartThinQ (fig.) / SMARTTHING (fig.), EU:T:2022:247, § 91; 22/03/2023, T-408/22, SEVEN SEVEN 7 (fig.) / Seven, EU:T:2023:157, § 29-31, 33).

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

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

Exemplary character - extrapolating

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

Addressee

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

Company name and trade mark representation

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

4.7 Certifications, rankings and awards

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

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

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

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

Examples:

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

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

4.8 Promotional materials and publications

4.8.1 Catalogues, advertisements and marketing campaigns

A party may submit promotional materials, including:

- price lists and offers;
- advertising reach and spend;
- material related to online shops;
- promotions on company websites;
- website archives;
- television spots and video/audio files;
- business correspondence and business cards; and
- materials from fairs and conferences.

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

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

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

Example:

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

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

For further information on advertising evidence see:

Acquired distinctiveness	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Acquired distinctiveness through use (Article 7(3) EUTMR), 8.1.2 Market share and 8.1.3 Advertising and turnover expenses
Reputation	Part C, Opposition, Section 5, Trade marks with reputation (Article 8(5) EUTMR), 3.1.3.6 Promotional activities
Proof of use	Part C, Opposition, Section 7, Proof of use, 6.1.2.5 Use in advertising

Promotional materials may also constitute relevant evidence of design disclosure in invalidity proceedings. Catalogues, trade fair brochures, press releases or advertising materials that depict the earlier design and indicate the date of publication or distribution can demonstrate that the design was made available to the public before the relevant date. Where such materials originate from independent or widely accessible sources, or prove dissemination to the relevant circles within the Union, they may provide indications that the design formed part of the state of the art under Article 8 EUDR (see Design Guidelines, Examination of design invalidity applications, Section 5 The different Grounds for Invalidity, paragraph 5.7.1.2 Establishing the event of disclosure).

4.8.2 Publications

A party may submit publications, including:

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

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

Case No	**Comment**

16/12/2010, T-345/08 & T-357/08, Botolist /Botocyl, confirmed 10/05/2012, C-100/11 P, § 54	The very existence of articles in a scientific publication or the general-interest press constitutes a relevant factor in establishing the reputation of the products marketed under the trade mark BOTOX among the general public, irrespective of the positive or negative content of those articles.
10/03/2011, R 0555/2009-2, BACI MILANO (fig.) / BACI & ABBRACCI, § 35	The earlier trade mark's reputation on Italy was proved by the copious documentation the opponent submitted. This included, inter alia, an article from Economy revealing that in 2005 the 'BACI & ABBRACCI' trade mark was one of the 15 most counterfeited fashion brands in the world; an article published in Il Tempo on 05/08/2005, in which the 'BACI & ABBRACCI' trade mark is mentioned alongside others – including Dolce & Gabbana, Armani, Lacoste and Puma – as being targeted by counterfeiters; an article published in Fashion on 15/06/2006, in which the trade mark is defined as 'a true market phenomenon'; publicity campaigns from 2004 to 2007, with testimonials from entertainment and sports celebrities; and a market survey conducted by the renowned independent agency Doxa in September 2007, from which it emerges that the trade mark is 'top of mind' in the fashion sector for 0.6 % of the Italian public.
08/07/2020, T-533/19, sflooring (fig.) / T-flooring, EU:T:2020:323, § 51	The affixing of a trade mark to a magazine, periodical, review, journal or catalogue is, in principle, capable of constituting 'valid use of the sign' as a trade mark for the goods and services designated by that mark if the content of the publications confirms use of the sign for the goods and services it covers (05/02/2020, T-44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 67).

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

4.9 Oral evidence

Oral evidence refers to evidence taken at oral proceedings, such as hearing the oral evidence of parties, witnesses or experts. For more information on oral proceedings, see the GuidelinesPart A, General rules, Section 2, General principles to be respected in the proceedings, 4 Oral proceedings.

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

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

Neither Article 97 EUTMR and Article 51 EUTMDR nor Article 81 EUDR and Article 11 EUDDR impose an obligation on the Office to summon witnesses to oral proceedings where requested by either party (14/06/2021, T-512/20, Protective covers covers for computer hardware, EU:T:2021:359, § 31-34).

Where a party requests the admission of oral evidence, the requester must explain why the oral testimonies would be more apt to attest the facts alleged or why it was not able to provide those testimonies in writing or in any other form of evidence (18/01/2018, T-178/17, HYALSTYLE, EU:T:2018:18, § 23).

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

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

4.10 Commissioning of expert opinions by the Office

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

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

The commissioning of expert opinions by the Office under Article 52 EUTMDR and Article 44 EUDIR is different from expert opinions that a party may submit as

written evidence in the proceedings or where experts are summoned under Article 51 EUTMDR and Article 43 EUDIR (15/12/2022, R 1613/2019-G, Iceland (fig.).

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

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

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

The Office does not maintain a list of experts.

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

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

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

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

4.11 Inspections in situ carried out by the Office

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

If the Office decides to carry out an inspection, it will take an interim decision, stating the relevant facts to be proved, the date, time and place of the inspection.

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

5 Belated evidence in *inter partes* proceedings

Article 95(2) EUTMR, Article 8(5) EUTMDR, Article 10(7) EUTMDR, Article 19(1) and (2) EUTMDR Article 80(2) EUDR

Parties to proceedings must submit their observations within the time limits laid down in the EU trade mark and European Union design regulations or within those established by the Office (see the GuidelinesPart A, General rules, Section 1, Means of communication, time limits, 4 Time limits specified by the Office).

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

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

Guidance in particular proceedings can be found here:

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

The concept of 'belated evidence' requires:

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

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

5.1 Distinction between supplementary and new facts or evidence

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

- **entirely new facts or evidence**, meaning there is no link to facts and evidence that were provided on time; or
- **supplementary facts or evidence**, meaning the party submitted facts or evidence on time and later supplements them (e.g. to rebut the argument of the other party in inter partes proceedings or to overcome arguments of the Office) 19/01/2022, T-76/21, Pomodoro, EU:T:2022:16, § 40.

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

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

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

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

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

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

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

5.2 Discretionary power

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

In doing so, the Office must consider:

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

These factors are independent.

Examples:

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

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

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

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

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

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part B

Examination

Section 4 Absolute grounds for refusal

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part B

Examination

Section 4

Absolute grounds for refusal

Chapter 7

Trade marks contrary to public policy or acceptable principles of morality (Article 7(1)(f) EUTMR)

1 General remarks

Article 7(1)(f) EUTMR excludes from registration trade marks that are contrary to public policy or to accepted principles of morality. Article 7(1)(f) EUTMR mirrors that of Article 6*quinquies*(B)(3) of the Paris Convention ([17]), which provides for the refusal of trade mark applications and for the invalidation of registrations where trade marks are 'contrary to morality or public order'.

The wording of Article 7(1)(f) EUTMR is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to encounter disturbing, abusive, insulting and even threatening trade marks (06/07/2006, R 495/2005-G, SCREW YOU, § 14).

The rationale of Article 7(1)(f) EUTMR is not to identify and filter out signs whose use in commerce must at all costs be prevented, but to preclude trade marks from registration where granting a monopoly would contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society. In other words, the Office should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society (06/07/2006, R 495/2005-G, SCREW YOU, § 13).

The application of Article 7(1)(f) EUTMR is not limited by the principle of freedom of expression (Article 10, Freedom of expression, European Convention on Human Rights) since the refusal to register only means that the sign is not granted protection under trade mark law and does not stop the sign from being used — even in business (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 26).

'Public policy' and 'accepted principles of morality' are two different concepts that often overlap.

The question whether the goods or services for which protection is sought can or cannot be legally offered in a particular Member State's market is irrelevant for the question as to whether the sign itself falls foul of Article 7(1)(f) EUTMR (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 33). Whether or not a mark is contrary to public policy or accepted principles of morality must be determined by the intrinsic qualities of the mark applied for, and not by the circumstances relating to the conduct of the person applying for the trade mark (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 28). In its judgment of 20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, the General Court held that the concepts of 'public policy' and 'acceptable principles of morality' must be interpreted not only with reference to the circumstances common to all Member States but by taking into account 'the particular circumstances of **individual Member States** which are likely to influence the perception of the relevant public within those States' (para. 34).

17 Paris Convention for the Protection of Industrial Property of 20 March 1883 (as amended on 28 September 1979).

The legislation and administrative practice of certain Member States can also be taken into account in this context (i.e. for assessing subjective values), not because of their normative value, but as evidence of facts that make it possible to assess the perception of the relevant public in those Member States (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, § 57). In such a case, the illegality of the EUTM applied for is not the determining factor for the application of Article 7(1)(f) EUTMR, but rather is of evidential value with regard to the perception of the relevant public in the Member State(s) in question.

Considering that the specific circumstances of **individual** Member States may not be widely known in EU territory, the objection letter should explain these circumstances clearly in order to make sure that the applicant is able to fully understand the reasoning behind the objection and is able to respond accordingly. In the framework of the European Union Intellectual Property Network (EUIPN), the Office and a number of trade mark offices in the European Union have agreed on a Common Practice (CP) in relation to trade marks contrary to public policy or accepted principles of morality (also referred to as Convergence Project 14 or CP14 Practice). The CP establishes general principles on the assessment of signs contrary to public policy or to accepted principles of morality, in particular, the common understanding of these concepts, their relationship, the criteria for their assessment, and different groups of signs that could be considered contrary to public policy and/or to accepted principles of morality, including illustrative examples.

2 `Public Policy'

2.1 Concept and categories

This objection derives from an assessment based on **objective criteria**. ‘Public policy’ is the body of all legal rules that are necessary for the functioning of a democratic society and the state of law. In the context of Article 7(1)(f) EUTMR, ‘public policy’ refers to the **body of EU law applicable in a certain area**, as well as to the legal order and the state of law as defined by the Treaties and secondary EU legislation, which reflect a common understanding of certain basic principles and values, such as human rights.

The following is a non-exhaustive **list of examples** of when signs will be caught by this prohibition.

- Trade marks that contradict the basic principles and fundamental values of the European Union political and social order and, in particular, the universal values on which the European Union is founded, such as human dignity, freedom, equality and solidarity and the principles of democracy and the rule of law, as proclaimed in the Charter of Fundamental Rights of the European Union (OJ C 83, 30/03/2010, p. 389).

- On 27/12/2001, the Council of the European Union adopted Common Position 2001/931/CFSP on the application of specific measures to combat terrorism (OJ L 344, 28/12/2001, p. 93), later updated by Council Decision (CFSP) 2017/1426 of 04/08/2017, updating the list of persons, groups and entities subject to Articles 2, 3 and 4 of Common Position 2001/931/CFSP on the application of specific measures to combat terrorism and repealing Decision (CFSP) 2017/154 (OJ L 204, 05/08/2017, p. 95, consolidated version available at http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017D1426&from=EN), which contains a list of individuals and groups facilitating, attempting to commit or committing terrorist acts in EU territory. Any EUTM applied for that can be deemed to support or benefit an individual or a group on the list will be rejected as being against public policy.

3 Accepted Principles of Morality

This objection concerns **subjective values**, but these must be applied as objectively as possible by the examiner. The provision excludes registration as European Union trade marks of blasphemous, racist, discriminatory or insulting words or phrases, but only if that meaning is clearly conveyed by the mark applied for in an unambiguous manner; the standard to be applied is that of the reasonable consumer with average sensitivity and tolerance thresholds (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 21).

The concept of accepted principles of morality refers to the fundamental moral values and standards to which a society adheres at a given time. Those values and norms are likely to change over time and vary in space (27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 39).

The concept of morality in Article 7(1)(f) EUTMR is not concerned with bad taste or the protection of individuals' feelings. In order to fall foul of Article 7(1)(f) EUTMR, a trade mark must be perceived by the relevant public, or at least a significant part of it, as going directly against the fundamental moral values and standards of society.

It is not sufficient if the trade mark is only likely to offend a small minority of exceptionally puritanical citizens. Conversely, a trade mark should not be allowed to be registered simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable. The trade mark must be assessed by reference to the standards and values of ordinary citizens who fall between those two extremes (06/07/2006, R 495/2005-G, SCREW YOU, § 21).

The examination is to be based on the perception of a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered and, where appropriate, the particular circumstances of the part of the Union concerned. To that end, elements such as legislation and administrative practices, public opinion and, where appropriate, the way in which the relevant public has reacted in the past to that sign or similar signs, as well as any other factor which may make it possible to assess the perception of that public, are relevant (27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 42).

National legislation and practice of Member States are indicators to be taken into account in order to assess how certain categories of signs are perceived by the relevant public in those Member States (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, § 58). However, the Office must not object to trade marks because of the mere fact that they are in conflict with national legislation and practice. National legislation and practice are considered to be **factual evidence** that enables an assessment of the perception of the relevant public within the relevant territory.

Examples of national legislation taken into account as evidence of a trade mark being contrary to accepted principles of morality:

- use of symbols and names of unconstitutional parties or organisations is prohibited in Germany (§ 86a dt. StGB (German Criminal Code), BGBl. No I 75/1998) and in Austria (§ 1 öst. Abzeichengesetz (Austrian Law on Insignias), BGBl. No 84/1960 in conjunction with § 1 öst. Verbotsgesetz (Austrian Prohibition Law), BGBl. No 25/1947);
- 'use of symbols of totalitarianism' (e.g. the sickle and hammer and the five-pointed red star), specifically in a way to offend the dignity of victims of totalitarian regimes and their right to sanctity is prohibited in Hungary (Section 335 of Act C of 2012 on the Criminal Code) (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498).

Signs that can be perceived as promoting the use of illegal drugs also fall under this provision. Taking into account, as factual evidence, that certain drugs are illegal in some Member States as well as the fact that the EU has undertaken drug policy initiatives to fight against illegal drugs, an objection should be raised. It is an objective indication that such signs would be perceived as going directly against the basic moral norms of society.

The assessment made will take into account the term used in the mark applied for or the presence of other elements that could be perceived as promoting the use of illegal drugs. However, an objection will not be raised if the sign contains a reference to a drug that is for medical use, as the mark would not fall, in principle, within the prohibition of Article 7(1)(f) EUTMR.

The examination of Article 7(1)(f) EUTMR should consider the **context** in which the mark is likely to be encountered, assuming normal use of the mark **in connection with the goods and services** covered by the application (06/07/2006, R 495/2005-G, SCREW YOU, § 21). Taking account of the goods and services for which registration of the mark is sought is normally necessary, since the relevant public may be different for different goods and services and, therefore, may have different thresholds with regard to what is clearly unacceptably offensive. For example, 'a person who is sufficiently interested in [sex toys] to notice the trade marks under which they are sold is unlikely to be offended by a term with crude sexual connotations' (06/07/2006, R 495/2005-G, SCREW YOU, § 29).

Nevertheless, although the Court has held that the goods and services for which protection is sought are important for identifying the relevant public whose perception needs to be examined, it has also made it clear that the **relevant public is not**

necessarily only that which buys the goods and services covered by the mark, since a broader public than just the consumers targeted may encounter the mark (05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 17-18). Accordingly, the commercial context of a mark, in the sense of the public targeted by the goods and services, is not always the determining factor in whether that mark would breach accepted principles of morality (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 24; 26/09/2014, T-266/13, Curve, EU:T:2014:836, § 18-19).

Illegality is not a necessary condition for giving rise to a conflict with accepted principles of morality: there are words or signs that would not lead to proceedings before the relevant authorities and courts, but that are sufficiently offensive to the general public to not be registered as trade marks (01/09/2011, R 168/2011-1, fucking freezing! by TÜRPITZ (fig.), § 16). Furthermore, there is an interest in ensuring that children and young people, even if they are not the relevant public of the goods and services in question, do not encounter offensive words in shops that are accessible to the general public. Dictionary definitions will in principle provide a preliminary indication as to whether the word in question has an offensive meaning in the relevant language (01/09/2011, R 168/2011-1, fucking freezing! by TÜRPITZ (fig.), § 25), but the key factor must be the perception of the relevant public in the specific context of how and where the goods or services will be encountered.

However, the Boards of Appeal took the view that the word ‘kuro’ did not convey to the Hungarian public the offensive meaning of the word ‘kúró’ (meaning ‘fucker’ in English), since the vowels ‘ó’ and ‘ú’ are separate letters that are distinct from ‘o’ and ‘u’, which are pronounced differently and convey different meanings (22/12/2012, R 482/2012-1, kuro, § 12 et seq.).

There is a clear risk that the wording of Article 7(1)(f) EUTMR could be applied subjectively so as to exclude trade marks that are not to the examiner’s personal taste. However, for the word(s) to be objectionable, it (they) must have a clearly offensive impact on people of normal sensitivity (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 21).

There is no need to establish that the applicant **wants** to shock or insult the relevant public; the fact that the EUTM applied for **might** be seen, as such, to shock or insult is sufficient (23/10/2009, R 1805/2007-1, PAKI, EU:T:2011:564, § 27, confirmed 05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 20 et seq.).

Finally, it is not only signs with a ‘negative’ connotation that can be offensive. The banal use of some signs with a **highly positive connotation** can also be offensive (e.g. terms with a religious meaning or national symbols with a spiritual and political value, like ‘ATATURK’ for the EU general public of Turkish origin (17/09/2012, R 2613/2011-2, ATATURK, § 31)).

Raising an objection when a trade mark is contrary to accepted principles of morality does not, however, prevent the sign from being also contrary to public policy (e.g. the trade mark may be perceived by the relevant public as directly contrary to the basic moral norms of society and, **at the same time**, may contradict the basic principles and fundamental values of the EU political and social order).

4 Examples

4.1 Examples of rejected EUTM applications

Sign	Relevant Consumer	Public policy/morality	Case No
BIN LADIN	General consumer	Morality and public policy — the mark applied for will be understood by the general public as the name of the leader of the notorious terrorist organisation Al Qaeda; terrorist crimes are in breach of public order and moral principles (para. 17).	29/09/2004 R 176/2004-2
CURVE	General consumer	Morality — 'Curve' is an offensive and vulgar word in Romanian (it means 'whores'). The relevant public is not limited only to the public to which the goods and services covered by the mark are **directly** addressed. 'Curve' equally offends other persons, who are confronted with the sign **accidentally** without being interested in these goods and services (para. 19). With regard to the word 'Curve'+ additions ['AIRCURVE'], see example below in this paragraph (R 203/2014-2).	T-266/13
	General consumer	Morality — 'fucking' is an offensive and vulgar word in English.	R 168/2011-1
	General consumer	Morality — 'HIJOPUTA' is an offensive and vulgar word in Spanish.	T-417/10

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Morality — the Hungarian Criminal Code bans certain 'symbols of despotism', including the hammer and sickle as well as the five-pointed red star symbolising the former USSR. This law is not applicable by reason of its normative value but rather as evidence of the perception of the relevant public (paras 59-63) ([18]).	T-232/10
PAKI	General consumer	Morality — 'PAKI' is a racist insult in English.	T-526/09
SCREW YOU	General consumer (for goods other than sex products)	Morality — a substantial proportion of ordinary citizens in Britain and Ireland would find the words 'SCREW YOU' offensive and objectionable (para. 26).	R 495/2005-G
FICKEN	General consumer	Morality — 'FICKEN' is an offensive and vulgar word in German (it means 'fuck').	14/11/2013, T-52/13, EU:T:2013:596
ATATURK	Average consumer in the EU general public of Turkish origin	Morality — banal use of signs with a highly positive connotation can be offensive under Article 7(1)(f) EUTMR. 'ATATURK' is a national symbol of spiritual and political value for the European general public of Turkish origin.	R 2613/2011-2
FUCK CANCER	General consumer	Morality — the word 'FUCK' is not only a 'slightly rude word' in combination with the word 'CANCER', but offensive and indecent, at least for the English-speaking part of the trade circles (para. 19).	23/02/2015, R 793/2014-2

18 The Hungarian Criminal Code, in force at the time of the judgment (20/09/2011), has been amended by Act C of 2012 to now encompass 'Use of Symbols of Totalitarianism', used 'specifically in a way to offend the dignity of victims of totalitarian regimes and their right to sanctity' (formerly Section 269/B, now Section 335 of the Hungarian Criminal Code).

Sign	Relevant Consumer	Public policy/morality	Case No
MECHANICAL APARTHEID	General consumer	Public policy — 'APARTHEID' refers to an offensive former political regime in South Africa that included state terror, torture and the denial of human dignity. The message conveyed by the sign for computer games, related publications and entertainment is contrary to the European Union's public policy, since it contradicts the indivisible, universal values on which the EU is founded, i.e. human dignity, freedom, physical integrity, equality and solidarity, and the principles of democracy and the rule of law (para. 30).	06/02/2015, R 2804/2014-5
MH17 MH370	General consumer	Morality — acronyms of the flights. The intent to seek financial gain from what is universally accepted to be a tragic event that has resulted in the loss of many hundreds of lives, is unacceptable and contrary to accepted principles of morality.	EUTM 13 092 937 EUTM 12 839 486

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Public policy and morality — mafia-type organised crime is a clear and present threat to the whole of the EU. 'la Mafia' is understood world-wide as referring to a criminal organisation originating in Italy, whose activities extend to States other than the Italian Republic, inter alia, within the European Union. The referred criminal organisation resorts to intimidation, physical violence and murder in carrying out its activities, which include, inter alia, drug trafficking, arms trafficking, money laundering and corruption (para. 35). Such criminal activities breach the very values on which the European Union is founded, in particular the values of respect for human dignity and freedom as laid down in Article 2, Treaty of the European Union and Articles 2, 3 and 6 of the Charter of Fundamental Rights of the European Union (para. 36). The association in the mark of the word element 'la mafia' with the other elements of the contested mark is such to convey a globally positive image of the Mafia's activities and, so doing, to trivialise the perception of the criminal activities of that organisation (para. 46). (…) The contested mark is, therefore, likely to shock or offend not only the victims of that criminal organisation and their families, but also any person who, on EU territory, encounters that mark and has average sensitivity and tolerance thresholds (para. 47).	15/03/2018, T-1/17, EU:T:2018:146

Sign	Relevant Consumer	Public policy/morality	Case No
ETA	General consumer	Public policy and morality — 'ETA' will be immediately understood in Europe, in particular in Spain, as designating the terrorist group ETA (para. 2). ETA is included on the list of individuals and groups facilitating, attempting to commit or committing terrorist acts in EU territory (Council Common Position 2001/931/CFSP of 27/12/2001 on the application of specific measures to combat terrorism updated by Council Common Position 2009/468/CFSP) (para. 14). In a commercial context, the term 'ETA' has the inherent tendency to shock any normal person who hears or reads it and, in particular, members of the Spanish public who particularly keep that name in mind. The fact that ETA is not currently considered to be the biggest threat facing Spain according to an extract from a survey conducted in June 2015 provided by the applicant, does not mean that the term will not continue to be associated with the terrorist group in question in the mind of the public (para. 15).	27/06/2016, R 563/2016-2
	General consumer	Public policy and morality — the words 'KRITIKAL BILBO' identify a variety of plant of the 'cannabis' genus — also called 'marihuana' — which, due to its high content of tetrahydrocannabinol (THC), namely 21.47 %, is used to make marihuana (para 19). Cannabis with a high THC content is considered to be a narcotic that is prohibited in a large number of Member States (19/11/2009, T-234/06, Cannabis, EU:T:2009:448). Non-psychoactive substances are legal and the authorities can issue licences for their cultivation for those purposes. However, due to its high THC content, in this case the product concerned is not non-psychoactive, but is a substance for smoking that is strictly controlled in almost all European Union countries (para. 22).	27/10/2016, R 1881/2015-1

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Morality — the sign, containing the term 'weed' and applied for in Class 32, will be understood by the relevant consumer as glorifying the use of a drug (cannabis/marijuana) that is prohibited by law in many European countries.	EUTM 16 961 732
IBIZASKUNK	General consumer	Morality — applied for in Classes 5, 31 and 35. The sign, contains the term 'skunk' which refers to a cannabis strain with high THC. It will be perceived as a motivational/promotional message, which encourages an activity prohibited in many Member States of the EU, namely the consumption or sale of products containing SKUNK, as well as a banalisation of the aforementioned narcotic substance. The term IBIZA (known as a party location) reinforces the recreational message.	EUTM 18 097 102
	General consumer	The sign depicts cannabis leaves and also contains the term 'cannabis'. The application was filed for goods in Classes 30 and 32 and for services in Class 43. The Court considered that the fact that the sign would be perceived by the relevant public as an indication that the food and drink items contained narcotic substances, prohibited in many Member States, was sufficient to justify the refusal of the mark. It was not required that a sign encourage or trivialise the use of an illegal narcotic substance. As regards factors such as the accuracy of the depiction or the intention of the applicant to use the sign only for legal goods, the Court pointed out that the perception of the public was decisive and clarified that the intentions of the applicant did not play a role in the assessment.	EUTM 16 176 968 12/12/2019, T-683/18, EU:T: 2019:855

4.2 Examples of accepted EUTM applications

Sign	Relevant Consumer	Comment	Case No

KURO	General consumer	That a foreign term, name or abbreviation displays certain similarities with an offensive word (like 'kúró') is not in itself sufficient reason to refuse an EUTM application (para. 20). The Hungarian vowels 'ò' and 'ù' are clearly different from the unaccented vowels 'o' and 'u'. Furthermore, Hungarian words never end with an unaccented 'o' (paras 15-18).	R 482/2012-1
SCREW YOU	General consumer (for sex products)	A person entering a sex shop is unlikely to be offended by a trade mark containing crude, sexually charged language (para. 29).	R 495/2005-G
DE PUTA MADRE	General consumer	Although 'puta' means 'whore' in Spanish, the expression 'DE PUTA MADRE' means 'very good' in Spanish (slang).	EUTM 3 798 469 EUTM 4 781 662 EUTM 5 028 477

AIRCURVE	Specialised public (medical personnel; patients with breathing disorders)	The objectionable word 'Curve' ['whore', 'slut' in Romanian] is seamlessly attached to the English word 'AIR' to form 'AIRCURVE', which, as a whole, is entirely fanciful in Romanian. Even if the relevant public understood the English word 'AIR', and analysed the mark by separating it into two elements, the meaning of 'AIRCURVE' would be 'air whores', which, as a concept, and for respiratory apparatus, is sufficiently nonsensical or puzzling to the extent that it would eclipse any notion of being offensive (para. 13 et seq.). With regard to the word 'Curve' on its own, see the abovementioned example in this paragraph (T-266/13).	04/06/2014, R 203/2014-2
	General consumer	For the goods at issue — *rum* (Class 33) — the relevant public will perceive the sign as provocative, transgressive, rebellious, but not as an indicator of criminal origin of the goods (para. 23).	07/05/2015, R 2822/2014-5

ILLICIT	General consumer	The mark is considered acceptable under Article 7(1)(f) EUTMR, as 'illicit' is different from something like 'counterfeit'. The mark would be seen as fanciful on the goods (*cosmetics, and perfumes*) and it could be accepted.	EUTM 13 469 523
	General consumer	The mark evokes a concept that falls within the domain of vulgarity and profanity. However, the effect is attenuated by the fact that the implicit word does not appear in the mark as such. The presence of the initial figurative element 'W', combined with the euphemistic presentation of 'F___', also suppresses the offensive potential of the sign. Consumers with a normal level of sensitivity and tolerance would not be offended or upset by regular commercial exposure to the term in connection with the relevant goods and services in Classes 16, 18, 25, 35, 41, 43 and 44 (para. 31).	29/11/2018 R 1516/2018-5

hemptouch. PREMIUM CANNABIS ESSENTIALS	General consumer	The sign, containing the terms 'hemptouch' and 'cannabis', is applied for in Classes 3 and 5. It will be perceived by the relevant consumer as a reference to the medicinal use of the substance. Hemp is a variety of *Cannabis sativa*, which contains a very low concentration of THC, and cannabis can be used for medicinal purposes.	EUTM 18 000 042

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part B

Examination

Section 4

Absolute grounds for refusal

Chapter 9

Trade marks in conflict with flags and other symbols (Article 7(1)(h) and (i) EUTMR)

1 Introduction

Article 7(1)(h) EUTMR incorporates Article 6*ter* of the Paris Convention for the Protection of Industrial Property (PC) into the European Union trade mark system.

Article 7(1)(i) EUTMR, on the other hand, protects badges, emblems and escutcheons that are not protected under Article 6*ter* PC but are of particular public interest.

In accordance with Article 7(1)(h) and (i) EUTMR, the Office will refuse the registration of trade mark applications that contain or consist of these protected symbols or any imitation thereof from a heraldic point of view unless the applicant provides authorisation for their registration from the competent authority.

2 Article 7(1)(h) EUTMR-symbols protected under Article 6*ter* PC

The objective of Article 7(1)(h) EUTMR is to prevent symbols protected under Article 6*ter* PC, or any imitation thereof from a heraldic point of view, from being registered as EU trade marks, or as elements of EU trade marks, without the authorisation of the competent authority.

These protected symbols are:

- armorial bearings, flags and other state emblems,
- official signs and hallmarks indicating the control and warranty,
- the armorial bearings, flags, names, abbreviations and other emblems of IGOs.

Except for state flags (Article 6*ter*(3)(a) PC), to enjoy such protection, these symbols need to have been communicated under Article 6*ter* PC by the competent authorities via the International Bureau of WIPO.

WIPO publishes a biannual publication with the list of communicated symbols which are then published in the Article 6*ter* Express Database on the WIPO website (see below 2.1.4 Search for protected symbols) under a unique reference number (e.g. ES5, JP3, QO188). The date of publication of the communication which is considered to constitute the reception date is the date mentioned in the database.

The protection granted to those symbols applies only to trade marks registered more than two months after the reception of this communication (Article 6*ter(6)* PC).

The protection granted under Article 7(1)(h) EUTMR extends to the protected symbols of all countries that can invoke Article 6*ter* PC including non-EU countries.

2.1 Symbols protected under Article 7(1)(h) EUTMR

2.1.1 Armorial bearings, flags and other emblems

Armorial bearings normally consist of a design or image depicted on a shield. An example of an armorial bearing is the coat of arms of Spain.



Published under ES5

A **state flag** is defined by the constitution of the state or by a specific law of that state. Normally, a state will have only one state flag. For instance, the Spanish flag is defined in Article 4 of the Spanish Constitution; the French flag is defined in Article 2 of the French Constitution; and the German flag is defined in Article 22 of the German Constitution.

'**Other state emblems**' is an expression that covers symbols of the sovereignty of a state, such as a representation of the national crown, an official seal of the state, or flags other than state flags, namely those of the first political division of a federal state. For instance:

- Germany has requested protection for the flags of each *Bundesland* ('federal state').



Published under DE34 (flag of the federal state of Berlin)

- The Netherlands has requested protection for the national crown,



Published under NL48.

- The USA has requested protection for its official seal,



Published under US1.

2.1.2 Official signs and hallmarks indicating control and warranty

The purpose of official signs and hallmarks indicating control and warranty is to certify that a state, or an organisation that has been duly appointed by a state for that

purpose, has checked that certain goods and services meet specific standards or are of a given level of quality.

There are official signs and hallmarks indicating control and warranty in several states, for products such as precious metals, or butter, cheese, meat, electrical equipment, etc. Official signs and hallmarks can also apply to services – for instance, those relating to education, tourism, etc.

Typical examples are signs of warranty for metals, such as:

		
Published under CZ35 for platinum	Published under IT13 for gold	Published under HU10 for silver

These symbols are normally communicated through WIPO for specific products and services, such as:

	
Published under BR6 for tourism; national and international promotion and advertising; marketing studies; business management; business administration; and office functions.	Published under JP3 for agricultural, forestry and fishery products and foodstuffs.

2.1.3 Armorial bearings, flags, names, abbreviations and other emblems of intergovernmental organisations

Intergovernmental organisations of which one or more Member States of the PC is a member enjoy protection for their armorial bearings, flags, names, abbreviations and other emblems when these symbols have been communicated via WIPO.

For instance, the following signs enjoy protection under the Paris Convention:

Published under QO60.	Published under QO1.	Published under QO1248.

AU
Published under QO884 for the AFRICAN UNION.

The European Union has requested, for instance, protection for the following signs, abbreviations and names:

Published under QO1717	EUIPO Published under QO1742 (QO1743 to QO1746 in other languages)	European Union Intellectual Property Office Published under QO1718 (QO1719 to QO1741 in other languages)

Published under QO188

2.1.4 Search for protected symbols

Relevant information about protected symbols is found in the WIPO Article *6ter* Express Database. The results can be filtered by 'state' (i.e. country), 'category' (i.e. the type of 'emblem') and 'Vienna Classification' (i.e. figurative elements). Users can also search for similar images within the *6ter* signs via the 'Image search' option.

An image search (e.g. https://images.google.com/) might give some basic hints for identifying a protected emblem.

State flags enjoy protection without any need for communication through WIPO and are normally not in the WIPO Article *6ter* database (except if they have been communicated through WIPO as a state emblem). Tools for finding flags, such as http://www.flagid.org or http://www.flag-finder.com can be consulted.

2.2 Applicability of Article 7(1)(h) EUTMR

In order to fall within the scope of Article 7(1)(h) EUTMR, a trade mark must consist of or contain an **identical reproduction or a 'heraldic imitation'** of a protected symbol in accordance with Article 6*ter*(1)(a) and (b) PC (see paragraph 2.2.1 Identical reproduction or heraldic imitation of a protected symbol).

Articles 6*ter*(1)(c) and (2) PC, set out **additional requirements** for the protection of official signs or hallmarks indicating control and warranty and for the symbols of IGOs (see paragraph 2.2.2 Additional requirements for specifically protected symbols).

Trade marks that would fall within the scope of Article 7(1)(h) EUTMR can nevertheless be registered when the competent authority gives its **authorisation** to the registration of the trade mark (see paragraph 4 Authorisation for the registration of trade marks containing protected symbols or heraldic imitations thereof).

2.2.1 Identical reproduction or heraldic imitation of a protected symbol

The Office will raise an objection when a trade mark consists of or contains an **identical reproduction** or a '**heraldic imitation**' of a protected symbol.

2.2.1.1 Identical reproduction

The Office considers that there is an identical reproduction of a protected symbol when the sign reproduces, without any modification or addition, all the elements constituting the protected symbol or where, viewed as a whole, it contains differences that are so insignificant that they may go unnoticed by the relevant consumer.

2.2.1.2 Heraldic imitation

The prohibition against the imitation of a protected symbol applies only to **imitations from a heraldic perspective.**

Heraldry is a discipline relating to the design, display and study of armorial bearings, as well as related disciplines, such as vexillology (study of flags).

To assess whether a sign contains the heraldic imitation of a protected symbol, the Office will consider the heraldic description of the symbol, not how it appears in daily use (16/07/2009, C-202/08 P & C-208/08 P, RW feuille d'érable, EU:C:2009:477, § 48). The heraldic description is a formal description that identifies the heraldic elements represented in the protected symbol but does not focus on the specific detail of each element, which can be displayed with some degree of variation or artistic licence.

For example, for state flags the relevant elements of the heraldic description are usually the shape, the colours and the format (proportion and pattern) whereas for armorial bearings the heraldic description would normally include metals (gold/silver), colours, furs (animal pelts), and charges (devices or images).

By way of example, the heraldic description of the EU flag ()is the following: 'on an azure background, a circle composed of twelve five-pointed gold stars whose points do not touch' (13/03/2014, T-430/12, European Network Rapid Manufacturing (fig.), EU:T:2014:120, § 21).

The Office will look at the overall combination of the elements of the heraldic description and see if it is reproduced in the mark as perceived by the relevant public (16/07/2009, C-202/08 P, RW (fig.), EU:C:2009:477, § 50).

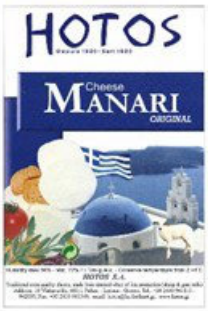
A difference detected by a specialist in heraldic art between the trade mark applied for and the state emblem will not necessarily be perceived by the average consumer and, therefore, in spite of differences in certain heraldic details, the contested trade mark may be an imitation of the emblem in question within the meaning of **Article 6*ter* PC** (16/07/2009, C-202/08 P & C-208/08 P, RW feuille d'érable, EU:C:2009:477, § 50 et seq.; 25/05/2011, T-397/09, Suscipere et finire, EU:T:2011:246, § 24-25).

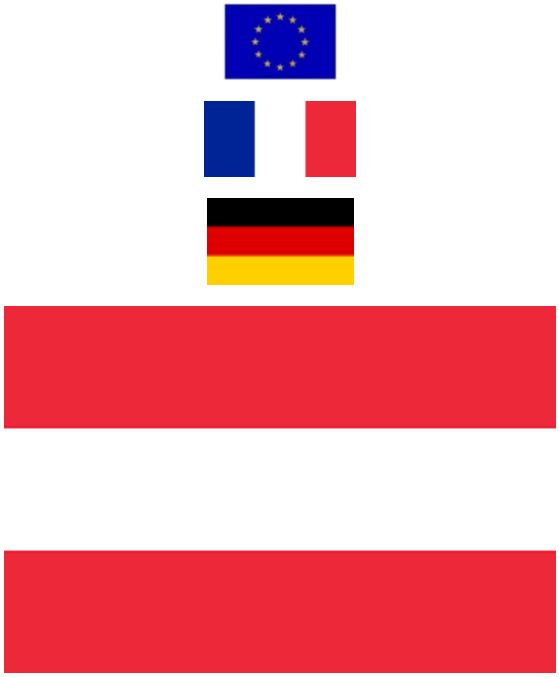
In the assessment of heraldic imitation, the Office will take into consideration the following:

- **Colours** are relevant, however:
  - **A black and white** depiction of a protected symbol may still be considered a heraldic imitation provided it allows a specific symbol to be recognised (21/04/2004, T-127/02, ECA, EU:T:2004:110, § 45; 28/02/2008, T-215/06, RW (fig.), EU:T:2008:55, § 68).
  - Slight **differences in the actual colour** are irrelevant (light blue v dark blue). Heraldry does not normally distinguish between different tones of the same colour (15/01/2013, T-413/11, EUROPEAN DRIVESHAFT SERVICES EDS (fig.), EU:T:2013:12, § 42).
  - **Gold and silver:** Gold is often reproduced as yellow (20/05/2009, R 1041/2008-1, kultur IN DEUTSCHLAND + EUROPA (fig.), § 33) and silver as grey.
- When **part of the protected symbol** is not represented in the trade mark, a heraldic imitation can still be found when a significant part of the protected symbol is still visible. For example, this will be the case when the protected symbol is hidden by another element but where a significant part of the protected symbol is still visible.
- The **size** of the protected symbol contained in the trade mark is irrelevant as long as it is identifiable.
- A **moving flag** may be considered a heraldic imitation when the effect of a moving flag is clearly represented in the trade mark and the shape and format (proportion and pattern) of the flag are visible.

2.2.1.3 Examples of heraldic imitations

- Heraldic imitation found

Protected symbol	Trade mark applied for
	
Flag of Greece	EUTM application No 8 474 488
Although the flag is moving and partially covered by another element, the different elements, the colour, shape and format (proportion) of the Greek flag are reproduced in the mark.	
	
Flag of the United Kingdom	EUTM application No 13 169 313
The trade mark contains a stylised representation of the UK flag. The colours, shape and format (proportion) are reproduced in the mark.	
	
Swiss flag	EUTM application No 18 961 334
The square shape of the Swiss flag can be identified although the edges are slightly rounded.	
	

French flag	18/03/2015, R 1731/2013-1, LAPIN NA LA NOUVELLE AGRICULTURE (fig.)
The French flag is incorporated into the trade mark. Although it is small, it is immediately recognisable.	
	
EU flag Published under QO188 French flag German flag Austrian flag	EUTM application No 18 835 724
The EU flag is moving, but all the heraldic elements of the flag are reproduced. The Austrian flag is partially covered but its heraldic elements are clearly visible. The German flag and the French flag are reproduced in the trade mark.	
	
Flag of the EU Published under QO188	EUTM application No 18 162 022
The 12 yellow stars and the blue background of the EU flag are clearly reproduced in the trade mark even if the EU flag is moving.	

	
EU flag Published under QO188	EUTM application No 17 948 600
Although the red grid hides part of the EU flag and the flag is tilted, all the heraldic elements of the EU flag are reproduced in the trade mark.	
	
EU flag Published under QO188	EUTM application No 18 508 393
The 12 yellow stars are reproduced on a blue background in the trade mark.	
	
EU flag Published under QO188	EUTM application No 6 697 916; 01/03/2012, R 1211/2011-1, DIRO.net Lawyers for Europe (fig.); 13/03/2014, T-430/12, European Network Rapid Manufacturing

The General Court highlighted that:

1. Even if the mark included three stars fewer than appear in the European Union flag, such a circumstance could not rule out the possibility that it contained an imitation of that flag. Firstly, it noted that the word element should be regarded as covering the part of the circle where the three missing stars should have appeared. Secondly, it considered that, despite the absence of these three stars, it was easy to recognise the shape of a circle by tracing the trajectory of the nine stars in one's mind. Finally, she noted that the three stars in question could easily be imagined (13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120, § 24).
2. The Board of Appeal acknowledged that the colours of the figurative elements of the mark at issue were different from those used by the European Union flag but considered that these differences were not substantial. Indeed, it noted that the emblems were not systematically reproduced in colour. In this respect, it pointed out that it was well known that the European Union's bodies often used the European Union flag 'in the form of a negative', that is, by representing the stars in black on a white background (13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120, § 25).

Protected symbol	Trade mark applied for
	
EU flag Published under QO188	EUTM application No 1 106 442; 21/04/2004, T-127/02, ECA, EU:T:2004:110
	
Canadian state emblem Published under CA2	EUTM application No 2 785 368; C-202/08 P & C-208/08 P, RW (fig.), EU:C:2009:477
	
Swiss state emblem Published under CH27	EUTM application No 12 530 366; 28/10/2014, R 1577/2014-4, Swiss Concept (fig.)
The trade marks contain a black and white representation of the protected symbol	

- Heraldic imitation not found

Protected symbol	**Trade mark applied for**
	
French flag	EUTM application No 4 624 987, 05/05/2011, T-41/10, esf école du ski français (fig.), EU:T:2011:200

Although the colours of the French flag are recognisable, the trade mark does not reproduce the shape and format (proportion) of the French flag.

	
Flag of the United Kingdom	EUTM application No 15 008 253

The shape and format (proportion) of the UK flag are not reproduced in the trade mark.

	
Swiss flag	EUTM application No 18 213 246

The square shape and the colours of the Swiss flag are not reproduced in the trade mark.

	
Published under IE11	EUTM application No 11 945 797; 01/04/2014, R 139/2014-5, REPRESENTATION OF A CLOVERLEAF (fig.)

The Board considered that the graphic element of the trade mark applied for has a colour configuration that is clearly different from the Irish national symbols. These elements are so strong that the mere fact that the trade mark also contains a cloverleaf does not mean that the sign is similar to one of the national emblems of Ireland (paras 18-19).

	
Published under SE20	EUTM application No 13 580 981
The trade mark contains only one of the three crowns that are represented in the Swedish armorial bearing. In addition, the colour blue is missing, the shape is different, and further elements of the protected emblems are also absent.	
	
Various state flags	Invented example
It is not possible to recognise a specific flag, as the sign could be a black and white reproduction of any of the four flags.	

2.2.2 Additional requirements for specific protected symbols

2.2.2.1 Official signs or hallmarks indicating control and warranty

For **official signs or hallmarks indicating control and warranty**, Article 7(1)(h) EUTMR is applicable when the mark has been applied for goods and services of the same or a similar kind to those concerned. An objection will be raised, therefore, **depending on the goods and services applied for**.

2.2.2.2 Armorial bearings, flags, names, abbreviations or any other emblems of an IGO and the misleading connection

For **armorial bearings, flags, names, abbreviations or any other emblems of an IGO**, Article 7(1)(h) EUTMR is applicable when (i) the protected symbol as displayed in the sign would suggest to the public that there is a connection between the sign and the organisation concerned; and (ii) the suggestion of a connection between the user [the applicant] and the organisation is misleading (Article 6*ter*(1)(c) PC). Therefore, in order to determine that Article 7(1)(h) EUTMR is applicable, it should be assessed whether a misleading connection is perceived by the public, which is carried out in two steps:

- a) Firstly, the Office assesses whether it is likely that the public will perceive a **connection** between the organisation concerned and the applicant.

The mere fact that a trade mark contains an **identical reproduction** or a **heraldic imitation** of a protected symbol is not sufficient to reach the conclusion that the public will see a connection between the organisation concerned and the applicant of the EU trade mark. Such connection can exist when the goods and services applied for can be linked to the activities of the IGO and could lead the public to believe they originate from it, have been approved by it, or are otherwise linked to it (15/01/2013, T-413/11, EUROPEAN DRIVESHAFT SERVICES EDS (fig.), EU:T:2013:12, § 61).

Even though the European Union is not a state in terms of international law, but rather an international intergovernmental organisation, its area of activity is equated with that of a state (12/05/2011, R 1590/2010-1, EUROPEAN DRIVESHAFT SERVICES EDS (fig.), § 54; 15/01/2013, T-413/11, EUROPEAN DRIVESHAFT SERVICES EDS (fig.), EU:T:2013:12, § 70) and any goods or services can, in principle, be connected to the European Union.

If the goods and services applied for are linked to the activities of the IGO, the Office will assess whether the elements reproduced in the sign will establish a connection for the relevant consumer. This assessment includes those elements that are not linked to the protected emblem but which can still alter the perception of this connection in the eyes of the public (01/12/2021, T-700/20, Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE (fig.), EU:T:2021:851, § 41).

- b) Secondly, the Office assesses whether the connection between the user [the applicant] and the organisation perceived by the public (see a) above) is misleading.

When the relevant public perceives in the sign a connection with the authority to which the protected symbol relates (‘the organisation’), but there is no connection between the organisation and the applicant, such perception is misleading and an objection should be raised. On the contrary, no objection will be raised when a trade mark application is filed by the organisation or by an entity linked to it, because in such cases, the perceived connection cannot be considered to be misleading.

For example, EUTM 18 839 087 reproduces the symbol of the EUIPO (communicated through WIPO and published under reference QO1742). The application was filed by the EUIPO itself and was therefore not misleading as to the existing connection between the user and the organisation.

3 Article 7(1)(i) EUTMR — emblems of particular public interest not protected under Article *6ter* PC

The objective of Article 7(1)(i) EUTMR is to prevent badges, emblems or escutcheons that are not protected under Article 7(1)(h) EUTMR but that are of **particular public interest** from being registered as EU trade marks, or as elements of EU trade marks, without the authorisation of the competent authority.

3.1 Symbols protected under Article 7(1)(i) EUTMR

Article 7(1)(i) EUTMR protects badges, emblems or escutcheons that are not protected under Article 7(1)(h) EUTMR but that are of **particular public interest.**

Article 7(1)(i) EUTMR does not define symbols of 'particular public interest'. The nature of these symbols can vary and may include, for example, symbols of states, international intergovernmental organisations, or public bodies or administrations, such as provinces or municipalities.

The requirement for a 'particular public interest' implies that such interest is established in a public document, for example a national or international legal instrument, a regulation or another normative act.

The particular public interest can exist in the EU or in part of the EU (10/07/2013, T-3/12, MEMBER OF €e EURO EXPERTS (fig.), EU:T:2013:364, § 45-46).

A particular public interest can exist when the emblem has a particular link with the organisation itself or even one of the activities carried out by the organisation (10/07/2013, T-3/12, MEMBER OF €e EURO EXPERTS (fig.), EU:T:2013:364, § 44).

The following signs enjoy protection under Article 7(1)(i) EUTMR:

- the Euro symbol (€, as defined by the European Commission);



- the EU symbols for 'protected designation of origin' and for 'protected geographical indication'. The EU has exclusive competence to adopt legal acts that protect indications of origin, and those symbols are considered of particular public interest. The use of those symbols is regulated through Regulation (EU) 2024/1143 of the European Parliament and of the Council of 11 April 2024 on geographical indications for wine, spirit drinks and agricultural products, as well as traditional specialities guaranteed, and optional quality terms for agricultural products (Article 37 among others). See also 01/12/2021, T-700/20, Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE (fig.), EU:T:2021:851, § 38);



- the symbols protected under the Geneva Conventions and their additional protocols, that is to say, the red cross, the red crescent and the

red crystal emblems and their names (https://www.icrc.org/en/war-and-law/emblem);



- the Olympic Symbol protected under the Nairobi Treaty on the Protection of the Olympic Symbol (http://www.wipo.int/treaties/en/text.jsp?file_id=287432).

The five interlaced rings in blue, yellow, black, green and red, arranged in that order from left to right. The symbol consists of the Olympic rings alone, whether in a single colour or in different colours, as set out in the Nairobi Treaty on the Protection of the Olympic Symbol.	

3.2 Applicability of Article 7(1)(i) EUTMR

Article 7(1)(i) and (h) EUTMR have a similar scope of application and provide an equivalent level of protection (10/07/2013, T-3/12, MEMBER OF €e EURO EXPERTS (fig.), EU:T:2013:364, § 39; 01/12/2021, T-700/20, Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE (fig.), EU:T:2021:851, § 25).

Accordingly, Article 7(1)(i) EUTMR is subject to the same conditions as those governing the protection of symbols under Article 7(1)(h) EUTMR.

Therefore, the rules regarding the assessment of identical reproduction and heraldic imitation under Article 7(1)(h) EUTMR (see paragraph 2.2.1, Identical reproduction or heraldic imitation of a protected symbol), as well as the rules regarding the assessment of whether a misleading connection is perceived under Article 7(1)(h) EUTMR (see paragraph 2.2.2.2, Armorial bearings, flags, names, abbreviations or any other emblems of an IGO and the misleading connection) apply to the assessment under Article 7(1)(i) EUTMR.

Trade marks that would fall within the scope of Article 7(1)(i) EUTMR can also nevertheless be registered when the competent authority gives its **authorisation** to the registration of the trade mark (see paragraph 4, Authorisation for the registration of trade marks containing protected symbols or heraldic imitations thereof).

3.2.1 Examples of reproduction of emblems protected under Article 7(1)(i) EUTMR and heraldic imitations

- Reproduction/heraldic imitation found

Protected symbol	Trade mark applied for
	
Red cross	EUTM application No 2 966 265 13/05/2008, C-2192
The trade mark clearly contains the emblem of the Red Cross on a white background, as defined by and protected by the Geneva Convention, as a discernible, individual portion of the mark (para. 23).	
	
Euro	EUTM application No 6 110 423 10/07/2013, T-3/12, MEMBER OF €e EURO EXPERTS (fig.), EU:T:2013:364
The EUTM application contains a heraldic imitation of the euro symbol.	
	
Red cross	EUTM application No 5 988 985 Applied for Classes 28 and 30.

The EUTM application contains a heraldic imitation of the Red Cross, which is protected by the Geneva Convention.

- Reproduction/heraldic imitation not found

Protected symbol	Trade mark applied for contains
	 or 
Red Cross	‘Templar cross’ ‘Maltese cross’ (invented examples)

A number of well-known red crosses have traditionally been used and are still in use. Their incorporation in a trade mark would not be considered a reproduction/heraldic imitation of the ‘Red Cross’. They consist of different shapes.

	
Red cross	EUTM application No 2 362 085 28/06/2007, R 315/2006-1, D&W REPAIR (fig.) Applied for Classes 8, 11 and 12.

The Red Cross cannot be said to be included in the contested EUTM because of the difference in colour. The Red Cross, as its denomination indicates, is red and the colour constitutes a very essential element of its heraldic description. The cancellation applicant's argument that the colour orange may be very similar to some shades of red cannot be accepted (para. 20).

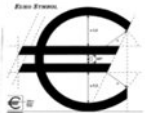
3.2.2 Examples of misleading connection

- Misleading connection with the organisation

Protected symbol	Trade mark applied for
	
Euro	EUTM application No 6 110 423 10/07/2013, T-3/12, MEMBER OF €e EURO EXPERTS (fig.), EU:T:2013:364
A link will be established with the European Union. The trade mark contains a heraldic imitation of the protected emblems, and the other elements of the sign reinforce the link between the EUTM and the EU. (*The other three elements forming the trade mark are not such as to neutralise the impression given to the public by the presence of the imitation euro symbol* (10/07/2013, T-3/12, MEMBER OF €e EURO EXPERTS (fig.), EU:T:2013:364, § 109 et seq). The sign has not been applied for by the organisation itself or any related authority.	
	

Euro	EUTM application No 18 871 878 Applied among others for Class 35 (*Publicity services*) and Class 36 (*financial services)*.
The Euro symbol is reproduced in the sign. Considering that the sign is applied for *financial services*, a link can be established between the sign and the activities carried out by the European Union. The consumer will perceive a connection between the applicant and the organisation. The sign has not been applied for by the organisation itself or any related authority. The mark was refused on this basis for Class 36. The mark was accepted for Class 35, where no connection could be found with the institutions of the EU.	
	
Red cross	EUTM application No 18 996 208 Applied for Class 3 (*Non-medicated cosmetics; essential oils; Beauty masks; toothpaste*) and Class 5 (*Vitamin supplements; Dietary supplements*)
The trade mark contains the symbol of the Red Cross. It is applied for healthcare-related goods. The mark would suggest to the public that there is a connection with the organisation to which the symbol relates, which is involved in medical services in general. The sign has not been applied for by the organisation itself or any related authority.	

- No connection with the IGO

Protected symbol	**Trade mark applied for**
	
Euro	EUTM application No 10 868 985 Applied for Classes 12, 35, 38, 39 and 42 (car rental related).

The EUTM application contains a heraldic imitation of the euro symbol. However, the mark would not suggest to the public that there is a connection with the European Union; the symbol as used in the mark will be perceived in relation to the 'good price' of the goods and services.

	
Euro	EUTM application No 11 076 866 Applied for Classes 9, 35, 36, 37 and 42 (e.g. *services related to building and construction*).

The EUTM application contains a heraldic imitation of the euro symbol. However, the mark would not suggest to the public that there is a connection with the European Union. There is nothing in the sign in relation to the goods and services applied for that could suggest a connection to the EU.

4 Authorisation for the registration of trade marks containing protected symbols or heraldic imitations thereof

EUTM applications can be registered despite being objectionable under Article 7(1)(h) or (i) EUTMR, if the applicant provides the Office with authorisation from the competent authority to include the protected symbol in its trade mark. The authorisation must cover registration as a trade mark.

General announcements or authorisations rendered by competent authorities under national law to use a protected symbol in trade might not be sufficient. It will be examined on a case-by-case basis whether such authorisations specifically authorise the use of an emblem in a trade mark (26/02/2015, R 1166/2014-1, ALPENBAUER BAYERISCHE BONBONLUTSCHKULTUR (fig.), § 23-29).

It is up to the applicant to submit the authorisation.

If an EUTM applied for contains or consists of the heraldic imitation of protected symbols of two or more states, which are similar, it is sufficient to present authorisation from one of them (Article 6*ter*(8) PC).

State flag of the Netherlands	State flag of Luxembourg

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 3

EUTMs and EUDs as objects of property

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 3

EUTMs and EUDs as objects of property

Chapter 1

Transfer

1 Introduction

Article 1(2), Articles 19, 20, 27 and 28, Article 111(1) and Article 111(3)(g) EUTMR
Articles 13 and 14 EUTMIR
Article 1(3), Articles 25, 30, 31, 38 and 40, Article 104(1) and Article 104(3)(j) EUDR
Article 9 EUDIR

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 (EUDs) and applications for an EUD 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. However, exceptions and specific provisions for EUDs are detailed in paragraph 3.

Upon request of one of the parties, transfers of EUTMs and EUDs are entered in the EUTM and EUD Registers and published. There is no fee for registering a transfer.

According to Article 20(11) EUTMR and Article 31(6) EUDR, the registration of a transfer is not a condition for its validity. However, if a transfer is not registered by the Office, the successor in title may not invoke the rights arising from the registration of the EUTM or EUD. Moreover, the new proprietor will not receive communications from the Office, in particular, during *inter partes* proceedings, nor the notification of the renewal period (as set out in Article 53(2) EUTMR and Article 66(2) EUDR). Furthermore, according to Article 19 EUTMR and Article 30 EUDR, in all aspects of the EUTM and EUD as an object of property that are not further defined by provisions of the EUTMR and EUDR, 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 EUTM and EUD applications and registrations is clear.

1.1 Transfers

Article 20 EUTMR Article 31 EUDR

A transfer of ownership 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 or EUD Registers (see paragraph 1.2 below).

An EUTM may be transferred independently of any transfer of the undertaking to which it belongs and in respect of some or all of the goods and services for which it is registered (Article 20(1) EUTMR).

1.1.1 Assignment

Article 20(3) EUTMR, Article 21 EUTMR Article 15 EUDR, Article 31(1) 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. This formal requirement for the validity of the transfer of a EUTM or an EUD is applicable irrespective of whether, under the national law governing transfers of (national) trade marks or designs, 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.

The exceptions to the above are where the assignment is the result of a court decision, or in EUTM-related proceedings where a decision is taken by the Office in a request for assignment under Article 21 EUTMR

It should be noted that the change of ownership of EUDs 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 (see paragraph 3 below).

1.1.2 Inheritance

When the proprietor of an EUTM or EUD dies, the heirs will become proprietors of the EUTM or EUD 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 or EUD unless, in accordance with 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 30 EUDR

Unless provided otherwise by the EUTMR or EUDR, transfers are subject to the national law of a Member State determined by Article 19 EUTMR and Article 30 EUDR. 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 and Article 27 EUTMR
Article 13 EUTMIR
Article 31(6) EUDR and Article 38 EUDR
Article 9 EUDIR

The general rule is that a successor in title may invoke the rights arising from the registration of the EUTM or the EUD only upon entry in the EUTM or EUD Register (see also 16/01/2020, T-128/19, Sativa (fig.) / K KATIVA (fig.) et al, EU:T:2020:3, § 22, 25-26). Nevertheless, prior to such entry in the Register, a transfer shall be effective against any third party who acquired rights in the EUTM or the EUD and who was aware of the transfer at the time those rights were acquired.

An exception to this general rule applies in cases of universal succession (e.g. transfer of the whole undertaking).

The above principles also apply to transfers resulting from the implementation of a decision or judgment, even where they establish proprietorship with previous or retroactive (*ex tunc)* effect.

However, in the period between the date when the Office receives the application to register a transfer and the date of registering the transfer, the new proprietor may

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

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

For changes of ownership following national entitlement proceedings regarding EUDs, see paragraph 3.1.

2 Transfers v changes of name

Article 55 EUTMR
Article 12 EUTMIR
Article 69 EUDR
Article 8 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.

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

Article 55 EUTMR
Article 12 EUTMIR
Article 69 EUDR
Article 8 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 or EUD, 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 13 EUTMIR Article 31(3) and (4) EUDR Article 9 EUDIR

When an application is made to register a transfer, but actually refers to a change of name of an EUTM or EUD proprietor, 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 or EUD 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.

3 Exceptions and specific provisions for EUDs

3.1 Transfers v changes of ownership due to entitlement proceedings for EUDs

Articles 15 and 16 EUDR, Article 104(3)(g) to (i), and (j) to (m) EUDR

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

Pursuant to Article 15 EUDR, EUDs 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 choose 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 EUD and prevents the registered holder from performing any acts that may prevent the legitimate holder from exercising rights over the EUD (e.g. transfer 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 EUDs does not exist for EUTMs. Judgments on the ownership of an EUTM must be implemented by means of a transfer.

4 Requirements for an application for registration of a transfer

Article 20 EUTMR
Article 13 EUTMIR
Article 31 EUDR
Article 9 EUDIR

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). An application for a transfer of an EUD can **only** be submitted electronically. For more information see the Guidelines, Part A, Section 1, Means of Communication, time limits, paragraph 3.1.

4.1 Languages

Article 146(6) EUTMR
Article 24 EUTMIR
Article 137(5) EUDR
Article 15 EUDIR

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

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

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

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

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

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

For more information on languages and use of forms see the Guidelines1 Introduction on page 229. For more information on translations see the Guidelines Part A, Section 4, Language of Proceedings, paragraph 7, Translations and their certification.

4.2 Application for registration of a transfer filed for more than one EUTM or EUD

Article 20(8) EUTMR Article 31(5) EUDR

A single application for the registration of a transfer for two or more EUTMs or EUDs 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 EUTM or EUD. For example, this is the case where there is one successor in title for the first one and there are multiple successors in title for another, even if the successor in title for the first one is among the successors in title for the other. 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 EUD applications or registrations 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 (6)(b) EUTMR

Article 13(3) EUTMIR

Articles 31(2) and 32(b)EUDR

Article 9(3) EUDIR

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

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

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

4.4 Formal requirements

4.4.1 Indications concerning the EUTM/EUD and the new proprietor

Article 20(5) EUTMR

Article 2(1)(b) and (e), and Article 13(1) EUTMIR

Article 31(3) EUDR

Article 1(1)(b) and (e), and Article 9(1) and (2) EUDIR

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

1. The registration number of the EUTM or EUD concerned. If the application relates to several EUTMs or EUDs, each of the registration numbers must be indicated.
2. The details of the new proprietor. These details correspond to the indications required for an applicant for a new EUTM or EUD application. For more information on the identification requirements of the applicant, see the Guidelines Part A, Section 5 Parties to the proceedings and professional representation, paragraph 3. Identification of parties to the proceedings.

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 more information on who may act as a representative and the appointment of a representative, see the Guidelines Part A, Section 5 Parties to the proceedings and professional representation, paragraph 5. Appointment of a professional representative.

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

4.4.2 Representation

Article 20(5) EUTMR

Articles 2(1)(e) and 13(1) EUTMIR

Article 31(3) EUDR

Articles 1(1)(f) and 9(1) and (2) EUDIR

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

4.4.3 Signatures

Articles 20(3) and (5) and 119(4) EUTMR

Article 13 EUTMIR

Article 63(1) EUTMDR

Articles 31(1) and (3) and 115(4) EUDR

Article 9 EUDIR

Article 17(1) EUDDR

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.

For more information on the requirements of signatures and explanations regarding the distinctions between signatures in applications or in supporting evidence, see the GuidelinesPart A, Section 1, Means of Communication and time limits, paragraph 3.1.5, Signature.

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 the proprietor of an EUTM or EUD is subject to insolvency proceedings, on request, an entry to this effect should be made in the Register and published in the Bulletin. Any subsequent application for registration of a transfer concerning the same right 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 then made aware that the proprietor was insolvent at the time, it may revoke the transfer. The Office should also refuse to register a transfer if it was preceded by an earlier request that had been submitted in accordance with Article 24(3) EUTMR or Article 35(4) EUDR, informing it that the proprietor of an EUTM or EUD was subject to insolvency proceedings (22/09/2021, T-173/20, Henry Cotton's and Henry Cotton's (fig.), EU:T:2021:610, § 70).

Where the Office receives proof that ownership of an EUTM or EUD 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 EUTMR
Article 13(1)(d), (2) and (3) EUTMIR
Article 31 EUDR
Article 9(1)(d), (2) and (3) 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, there are situations where a copy of the deed of transfer is not necessary.

Proof of transfer **is not necessary in the following circumstances:**

- When the original proprietor and the new proprietor both sign the application for registration of the transfer.
- When the original proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration signed by the new proprietor stating that it agrees to the registration of the transfer.

- 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 transfer.
- When the original proprietor's representative on file is also asking to be 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.

Proof of transfer **is necessary** in all other situations, including:

- when the representative that signs the transfer application form on behalf of both the original and the new proprietor is **not** the representative on file of the original proprietor (i.e. the transfer application form simultaneously appoints the person as representative of both parties and transfers the EUTM or EUD). Proof of transfer must be supplied with the transfer application request. If it is not provided, the Office will issue a deficiency to request evidence of the transfer (i.e. an authorisation signed by the original proprietor, proof of transfer, confirmation of the transfer by the original proprietor or its representative on file).

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

However, other means of proof are not excluded. Therefore, the agreement (deed) itself or any other document proving the transfer may be submitted. The transfer of rights to an EUTM or EUD must explicitly follow from the document(s) filed in support of the request. Accordingly, the evidence must not only contain a clear declaration of the transfer of rights, but also specify the relevant EUTM or EUD number. For instance, an authorisation to commercially exploit a trade mark does not, in itself, constitute formal proof of a transfer of ownership (07/11/2023, T-299/22, Diego maradona, EU:T:2023:710, § 38-39 and § 44-45).

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 of 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 or EUD 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 general information on confidentiality see the Guidelines Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.6, Confidentiality. For more information on claiming special interest and on the examination process of confidential information, see the Guidelines

Part E, Register operations, Section 5, Inspection of files, paragraph 4.3.4, 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.

When dealing with a request for transfer, the Office's competence is, in principle, confined to examining the formal requirements set out in Article 20 EUTMR and Article 13 EUTMIR (Article 31 EUDR and Article 9 EUDIR) and does not imply an assessment of substantive issues that may arise under the applicable national law (22/09/2021, T-173/20, Henry Cotton's and Henry Cotton's (fig.), EU:T:2021:610, § 62; 22/09/2021, T-169/20, Marina yachting, EU:T:2021:609, § 61).

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 EUTMs or EUDs concerned and the identity of the parties, and whether a transfer is involved. The Office does not consider or rule on contractual or legal questions arising under national law (09/09/2011, T-83/09, CRAIC, EU:T:2011:450, § 27 and 07/03/2023, T-299/22, Diego maradona, EU:T:2023:710). If doubts arise, the national courts deal with the legality of the transfer itself.

However, the duty of diligence on the side of the Office requires taking into account facts that may have implications for the legality of the registration of a transfer, such as the existence of insolvency proceedings at the national level as mentioned in paragraph 4.4.4. (22/09/2021, T-169/20, Marina yachting, EU:T:2021:609, § 68;

22/09/2021, T-173/20, Henry Cotton's and Henry Cotton's (fig.), EU:T:2021:610,§ 59 and 69).

4.5.1 Translation of proof

Article 146(1) EUTMR Articles 24 and 25 EUTMIR Article 137(5) EUDR Articles 15 and 16 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) EUTMR Article 31(4) EUDR

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 (EUTMs only)

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

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

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

It is understood therefore, that where a request for transfer is submitted in relation to an EU collective mark or an EU certification mark, in addition to the requirements and the 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 (EUTMs only)

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 EUDs).

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

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

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

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

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.*

5.2 Procedure to remedy deficiencies

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 31(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 EUTM or EUD 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.

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 or EUD 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.

The above also applies to the time limit for paying renewal fees. Given the fixed deadlines for both timely and late payment of renewal fees, as well as the consequences of non-renewal on the validity of an EUTM or EUD, the examination of a renewal request will take precedence over a request for transfer, even if the latter was submitted earlier.

6.1 Specific issues of partial transfers (EUTMs only)

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 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 or EUDs 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.

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 31(2), Article 60 and Article 104(3)(j) EUDR

Decision No EX-26-07 of the Executive Director of the Office of 1 July 2026 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 Annexes I and II.

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

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 new proprietor (assignee), the Office will also inform the original proprietor (assignor) of the registration of the transfer.

8 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.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 3

EUTMs and EUDs as objects of property

Chapter 2

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

1 Introduction

Articles 19 to 29, Article 111(1) and Article 111 (3)(h),(i) and (j) EUTMR

Articles 30 to 40, Article 104(1) and Article 104(3)(g),(h),(i),(k),(l) and (m) EUDR

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

Decision No EX-26-07 of the Executive Director of the Office of 1 July 2026 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

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.

Unless otherwise provided, the practice applicable to registered European Union trade marks (EUTMs) is also applicable to EUTM applications. Similarly, the practice applicable to registered European Union designs (EUDs) is also applicable to applications for an EUD.

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, EUTMDR and EUTMIR.

Exceptions and specific provisions for EUDs are detailed in paragraph 8. Specific procedures for international trade marks are laid down in paragraph 9.

1.1 Definition of licence contracts

A licence is a contract by virtue of which the proprietor of an EUTM or EUD (the licensor), whilst retaining ownership, authorises a third person (the licensee) to use the trade mark or design 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 or EUD arise from a contractual relationship with the proprietor. The proprietor's consent to, or tolerance of, a third party using the trade mark or design does not amount to a licence.

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. 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 or EUD 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 or design 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 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 24(1) EUTMR

Article 30 EUDR, Article 35(1) and (2) EUDR

Articles 2(8) and 3(1) of Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings

The EUTMR and the EUDR do not establish unified and complete provisions applicable to **licences, rights *in rem*** or **levies of execution** for EUTMs or EUDs. Alternatively, Article 19 EUTMR and Article 30 EUDR refer to the law of a Member State regarding the acquisition, validity and effects of the EUTM or EUD as an object of property and regarding the procedure for levies of execution. In this context, a licence, right *in rem* or a levy of execution for an EUTM or EUD is, in its entirety and for the whole territory of the European Union, assimilated to a licence, right *in rem*, or to a levy of execution for a trade mark or design registered in the Member State in which the proprietor has its seat or domicile. If the proprietor does not have a seat or domicile in a Member State, it will be dealt with as a licence, right *in rem* or levy of execution for a trade mark or design registered in the Member State where the proprietor has an establishment. If the proprietor does not have an establishment in a Member State, it will be dealt with as a licence, right *in rem* or a levy of execution for a trade mark or design registered in the Member State where the Office has its seat, namely Spain.

This, however, applies only to the extent that Articles 20 to 28 EUTMR and Articles 31 to 40 EUDR do not provide otherwise.

Article 19 EUTMR and Article 30 EUDR are limited to the effects of a licence or right *in rem* as an object of property and do not extend to contract law. These articles do not govern the applicable law or the validity of a licensing contract or right *in rem* contract. Consequently, 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 or EUDR.

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 and Article 30 EUDR, all other provisions are covered by national law. Moreover, Regulation (EU) 2015/848 regulates the provisions on jurisdiction, recognition and applicable law in the area of insolvency proceedings.

The regulations specifically state that an EUTM or EUD may only be involved in insolvency proceedings opened in the Member State where the debtor's centre of main interests is located. An example of an exception is when the debtor is an insurance undertaking or credit institution, in which case the EUTM or EUD 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). Furthermore, Article 2(8) of Regulation (EU) 2015/848 states that insolvency proceedings commence at 'the time at which the judgment opening insolvency proceedings becomes effective, regardless of whether the judgment is final or not'. The entry in the Register is not, therefore, dependent on the judgment having become final.

1.6 Advantages of registration

Article 27 and Article 57(3) EUTMR Article 38 and Article 71(4) EUDR Article 10(2) EUDIR

Entry in the EUTM or EUD 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. It allows third parties to consult the full details of any of these proceedings through an application for inspection of files (Guidelines, Part E, Register operations, Section 5, Inspection of files, paragaph 4, Inspection of files).
2. In view of the provision of Article 27(1) EUTMR and Article 38(1) EUDR, **licences and rights *in rem*** will have affect vis-à-vis third parties who might have acquired, or have entered in the Register, rights in the trade mark or design that are incompatible with the registered licence or right *in rem*. The licensee or pledgee respectively may avail themselves of the rights conferred by this licence or right *in rem* only:
   - if it was entered in the Register; or
   - if the third party acquired their rights after the date of these legal acts and with full knowledge of the existence of the licence or right *in rem*.
3. Where a **licence or a right *in rem*** is entered in the Register, the surrender of that mark or design by its proprietor will only be entered in the Register if the proprietor can prove 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 therefore has the right to be informed in advance by the proprietor of the trade mark or design of their intention to surrender.
4. On entry in the Register of **insolvency proceedings or a levy of execution**, the proprietor loses their right to act and, therefore, may not perform any actions before the Office (such as withdraw, surrender, transfer, act in *inter partes* proceedings).
5. Where a **licence, right *in rem*, levy of execution or insolvency proceedings** for, or against, an EUTM or EUD is entered in the Register, the Office will notify the licensee, pledgee, beneficiary or liquidator, respectively, of the approaching expiry of the registration at least six months beforehand.

6. 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 and EUD Registers, 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 or EUDs 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 33(2), 34(3) and 35(3), Article 37 and Article 104(3) EUDR

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

2.1 Application form

Articles 20(8) and 26(1) EUTMR, Article 146(6) EUTMR Article 65 EUTMDR Articles 31(5) and 37(1) EUDR, Article 137 EUDR Article 18 EUDDR

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). An application concerning an EUD can **only** be submitted electronically. For more information, see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.

A single application for the registration of a **licence** for two or more EUTMs or EUDs 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).

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

2.2 Languages

Article 146(6)(a) and (b) EUTMR Article 137(5)(a) and (b) EUDR

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

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

For more information on languages and the use of forms, see the GuidelinesPart A, Section 4, Language of Proceedings, paragraph 1, Introduction. For more information on translations, see the GuidelinesPart A, Section 4, Language of Proceedings, paragraph 7, Translations and their Certification.

2.3 Fees

Article 26(2) and Annex I A(26) and (27) EUTMR Article 37(2) and Annex I (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 or EUD 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.

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

2.4 Parties to the proceedings

2.4.1 Applicants

Articles 22(2), 23(3), 24(3), 25(5) and 117(1) EUTMR Articles 33(2), 34(3), 35(3) and 36(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:

1. the proprietor(s); or
2. the 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 EUDs from third parties or authorities such as national Registers or national Courts, it will forward the documents to the proprietor 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 EUD affected.

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/EUD and the licensee, pledgee, beneficiary or liquidator

Articles 24(2) and 26(1) EUTMR

Article 2(1)(b) and (e) EUTMIR

Article 35(3) and 37(1) EUDR

Article 1(1)(b) and (e) 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 or EUD concerned. If the application relates to several EUTMs or EUDs, each of the registration numbers must be indicated.
   Additionally, for **insolvency proceedings**, the Office will register the **insolvency proceedings** against **all** EUTMs/EUDs linked to the proprietor's ID number at the Office.

   Where the proprietor is the joint proprietor of an EUTM or EUD, the **insolvency proceedings** will apply to the share of the joint proprietor.
2. The details of the licensee, pledgee, beneficiary or liquidator. These details correspond to those indications required for an applicant for a new EUTM or EUD application. For more information on the identification requirements of the applicant, see the GuidelinesPart A, Section 5 Parties to the Proceedings and Professional Representation, Paragraph 3 Identification of parties to the proceedings.
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.

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

   For more information on who may act as a representative and the appointment of a representative, see the GuidelinesPart A, Section 5 Parties to the Proceedings and Professional Representation, paragraph 4 Who may represent and paragraph 5 Appointment of a Professional Representative.

2.4.3 Signatures

Article 63(1) EUTMDR

Article 17 EUDDR

The general rules on signatures apply.

For information on the requirements of signatures and explanations regarding the distinctions between signatures in applications or in supporting evidence, see the Guidelines Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.1.5, Signature.

2.4.4 Representation

Articles 119(2) and 120(1) EUTMR Articles 115(2) and 116(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 Article 88 EUDR Article 17(1) EUDDR

The Office will examine the supporting documents only to the extent that they actually confirm what is indicated in the application, namely the identity of the EUTMs or EUDs concerned and the identity of the parties, and whether a licence, right *in rem*, levy of execution or insolvency proceeding is involved.

Regarding confidentiality, the party submitting the proof must bear in mind that the content of these files are available for public inspection. This is particularly relevant where contracts or other documents are submitted as evidence for a licence, right *in rem* and levy of execution, 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.

For general information on confidentiality, see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.6, and for more information on claiming special interest and on the examination process of confidential information, see the Guidelines, Part E, Register operations, Section 5, Inspection of files, paragraph 4.3.4.

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 137(5) EUDR Article 15 EUDIR

Proof must be as follows.

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

Article 24(1), Article 26, Article 120(1) EUTMR Article 35(1), Article 37, Article 116(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.

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).

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 or EUD in question, the requirements relating to signatures and authorisations are fulfilled.

The Office will notify the applicant of any deficiencies. If the deficiencies are not remedied within the period established, 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 cancelling or modifying the registration of licences and other rights

Articles 29(1) and 117(1) EUTMR Article 39(1) EUDR

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 EUD 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.

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 or EUD Register.

3.1 Competence, languages, presentation of the request

Article 29(3) and (6), and Article 162 EUTMR
Article 65 EUTMDR Articles 39, 40 and 143 EUDR Article 18 EUDDR

It is strongly recommended that requests for cancellation or modification of a **licence, right *in rem*, levy of execution or insolvency proceedings** for an EUTM be submitted electronically via the Office's website (e-recordals). Any application for a EUD can **only** be submitted electronically. Paragraphs 2.1 and 2.2 above apply.

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 39(1) and (3), Article 40 and 113(1) EUDR

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 registered licence

In the case of a joint request submitted by the licensor (EUTM or EUD 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 licensor 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.

If the licensor 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 or EUD Register of licences that are limited in time, that is, temporary licences, does not automatically expire but must be cancelled from the Register.

3.2.1.2 Modification of a registered licence

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

If the request is made by the licensor, proof of the modification of the licence is required only where the modification for which entry in the EUTM or EUD 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 or EUD 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 pledgor (EUTM or EUD proprietor) and the pledgee submit a joint request, or if the pledgee alone submits a request, no proof of the cancellation of the registration of the right *in rem* is required, since the request itself implies a statement by the pledgee that it consents to the cancellation. When the request for cancellation is submitted by the pledgor, 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 pledgor 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 pledgor 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 pledgor or the 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.

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(2) EUTMR

Article 12 EUTMIR

Articles 39(2) and 69(1) EUDR

Paragraph 2.4 above applies, except that the data concerning the licensee, pledgee, beneficiary or liquidator do not need to 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

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 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.

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

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

3.4.2 Modification

Article 29(3) EUTMR Article 39 EUDR

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 Article 39 EUDR

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

3.5.2 Examination by the Office

Articles 29 EUTMR, 111(6) and 117(1) EUTMR Article 39, 104(6) and 113(1) EUDR

For the mandatory elements of the request, paragraph 2.5 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 two months. If the deficiencies are not remedied, the Office will reject the request for cancellation or modification.

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 or range of products covered by the EUTM or EUD.

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 104(3)(t) and 107(1)(a) EUDR
Article 12 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.

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
Articles 30 and 37(1) EUDR
Article 1(1)(a) and (b), Articles 1(2) and 9(3)(a) EUDIR

4.1.1 Application made by the EUTM or EUD proprietor alone

When an application for the registration of a licence is made by the licensor (EUTM or EUD proprietor) alone, it must be signed by them. 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 or EUD 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 and Article 30 EUDR).

4.1.2 Application made jointly by the licensor and the licensee

When an application for the registration of a licence is made jointly by the licensor (EUTM or EUD proprietor) and its licensee, it must be signed by both the licensor 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 licensor alone.

The same applies where there is a deficiency regarding the signature of the licensor 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 or EUD proprietor agrees to the registration of the licence, signed by the proprietor. The consent of the proprietor is particularly pertinent in instances where a licence was granted by a predecessor in title prior to the recordal of a transfer of rights (22/11/2023, T-679/22, LAPLANDIA Land of purity et al., EU:T:2023:738, § 23). According to Article 13(3)(a) EUTMIR and Article 9(3)(a) EUDIR, 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 or EUD 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 or EUD 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 licensor and the licensee. It can be found at http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf.

4.2 Optional contents of the application

Articles 25(1) and 26(3) EUTMR Articles 36(1) and 37(3) EUDR

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) in Article 26(3) EUTMR and Article 37(3) EUDR. 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 or EUD 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 or EUD Register any indications contained in the licence agreement that are submitted, for example, as proof of the licence.

However, if entry in the 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, or to only some of the product indications for EUDs, the goods or services or the specific product range 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 or EUD Register, the application for registration may indicate that it is for a sublicence. Sublicences cannot be registered without first registering the main licence.

4.3 Examination of specific formalities (licences)

Article 26(4) EUTMR

Article 37(3) and (4) EUDR

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

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

The Office will notify the applicant of any deficiencies in the application. If the deficiencies are not remedied within the time limit established, the Office will reject the application.

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

4.4 Examination of optional elements (licences)

Articles 25(1) and 26 EUTMR

Articles 36(1) and 37(3) EUDR

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 (EUTMs) or to a certain range of products (EUDs); 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, or a specific range of products covered by the EUD, the Office will check whether these are properly grouped and are actually covered by the EUTM or EUD.

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 or EUD Register. The Office will refuse the registration of a sublicence when the main licence has not been entered in the 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 and EUD Register information regularly and swiftly by cancelling or modifying existing licences (see paragraph 3 above).

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 (6) and 116(1)(a) EUTMR Article 37(3), Article 104(3)(m) and (6) and Article 107(1)(a) EUDR

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 or to a certain product range covered by the EUD.

The following details will not be published:

- the period of validity of a temporary licence;
- the territory covered by a territorially limited contract;
- the goods and services or product range covered by a partial licence.

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 EUD 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 37(3) and 104(3)(m) and (t) EUDR

A licence concerning an EUTM or an EUD 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 licensee where no change of ownership is implied (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and EUDs 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 37(1), (2) and (4) EUDR, Article 40 EUDR and Annex I (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 or EUD 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).

5 Rights *in Rem* - Special Provisions

5.1 Requirements concerning proof

Article 19 and Article 26(1) EUTMR
Articles 2(1)(b) EUTMIR
Articles 30, 33 and 37 EUDR
Article 1(1)(a), (b) and (2) EUDIR, Article 9(3) EUDIR

5.1.1 Application submitted by the EUTM or EUD proprietor alone

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

The signature of the pledgor 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 or EUD 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 or EUD 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 and Article 30 EUDR).

5.1.2 Application submitted jointly by the pledgor and the pledgee

When an application for the registration of the right *in rem* is submitted jointly by the pledgor (EUTM or EUD 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 pledgor alone.

The same applies where there is a deficiency regarding the signature of the pledgor 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 or EUD 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 or EUD 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 or EUD 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 pledgor (EUTM or EUD proprietor) and the pledgee.

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

Article 26(4) EUTMR Article 37(4) EUDR

Where an application for registration of a right *in rem* has been submitted jointly by the pledgor (EUTM or EUD proprietor) and the pledgee, the Office will communicate with the pledgor 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 pledgor 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 33(2) and Article 40 and Article 104(3)(k) and Article (6) EUDR

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 EUD holder of the registration.

5.4 Transfer of a Right *in rem*

Article 26(1) and (5)
Article 37(1) and Article 40 EUDR
Annex I (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 or EUD 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)(a) and (b), Article 1(2) EUDIR and Article 9(3) EUDIR

6.1.1 Application filed by the EUTM or EUD proprietor

When an application for the registration of a levy of execution is made by the EUTM or EUD proprietor, it must be signed by the 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 or EUD 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. 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 and Article 30 EUDR).

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 or EUD 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 34, Article 104(3)(l) and Article 107 EUDR

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 EUD holder will also be informed.

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 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 35, Article 104(3)(l) and Article 107 EUDR

When the EUTM or EUD is registered, the insolvency proceedings will be entered in the Register and published in the Bulletin. The publication contains the EUTM registration number(s), the name of the authority requesting the entry in the Register, the date and number of the entry and the publication date of the entry in the 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 or EUD proprietor's contact details in the Office's database.

8 Specific procedures for registered European Union designs

Articles 30, 33, 34, 35, 36, 37, 38, 39, 40 and 71(4) EUDR

8.1 Multiple applications for EUDs

Article 44(4) EUDR and Annex I (12) EUDR

An application for an EUD may take the form of a multiple application combining several designs (Article 44 EUDR). An application for the registration of licences, rights *in rem* and levies of execution for an EUD may concern an individual design contained in a multiple application.

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, 4.4 and 4.5, apply to each of the individual designs contained in a multiple application separately and independently.

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 (see also paragraph 2.3).

Example 1

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

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

The request may indicate that, for three of these six designs, the licence is exclusive. This will not impact the fees to be paid.

Example 2

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

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

8.2 Entitlement proceedings for EUDs

Articles 15, 16 and 20 EUDR, Article 104(3)(g), (h) and (i) EUDR and Article 137(5) EUDR Article 9(1)(b) EUDIR

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

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

If an EUD 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 EUD'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. See the Guidelines on the examination of design invalidity applications, paragraph 5.3 Lack of entitlement.

Where a person is jointly entitled to the EUD, 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 EUD's ownership resulting from the final decision of the competent court or authority.

The application for registration must comply with the conditions laid down in paragraph 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.

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 EUD 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 EUD 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 EUD concerned. If the application relates to several EUDs, 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 EUD 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.

8.2.3 Effects of the entries in the Register

Article 15(4), Article 16, Article 17, Article 30 and Article 104(3)(g)-(i) EUDR

Initiation of entitlement proceedings – effects on subsequent requests

The entry of the initiation of entitlement proceedings in the Register freezes the EUD, meaning that any subsequent request for a transfer, licences, levies, insolvencies or rights in rem filed will be suspended. In the event of a request for surrender, the Office shall not enter the surrender into the EUD Register without the agreement of the claimant.

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 EUD.

Change of ownership – effect on licences

Where there is a complete change of ownership of an EUD 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 EUD 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 30 EUDR).

Change of ownership – effect on ongoing proceedings

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 EUD (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
- 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.

10 Procedures for international designs

Concerning changes to international registrations for designs, the recording of licences, rights *in rem*, levies of execution or insolvency proceedings are not possible at the EUIPO. This is however possible for EUDs filed directly at the Office, where these requests can be processed and entered in the EUD Register.

Consequently, the Office will not process any such requests for international designs.

For more information concerning international registrations for designs, please see the Guidelines, Examination of application for registered European Union designs, paragraph 12 International Registrations.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 4

Renewal

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.

3 Terms of Protection of Registered European Union Designs

Articles 13, 46 and 55 EUDR

The term of protection of a registered European Union design (EUD) is 5 years from the **date of filing** of the application (Article 13 EUDR). For example, an EUD 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 46 EUDR and Article 55 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 66 EUDR

Articles 13 and 19 EUDDR

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

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

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.

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 EUD application

Article 66(2) EUDR Annex I (8) EUDR

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 66(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 EUD 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 Annex I (8) 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 EUD.

7 Fees and other formal requirements for the request for renewal

Article 53 EUTMR
Article 63 EUTMDR Article 66 EUDR Article 17 EUDDR Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 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:

- For both EUTMs and EUDs, 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). 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/EUDs as needed.
- For EUTMs, by transmitting a signed original form by post or by courier. A standard form is available on request to the Office.

Following Decision EX-26-03 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/EUDs (including EUDs that form part of the same multiple registration), upon payment of the required fees for each EUTM/EUD.

7.1 Persons who may submit a request for renewal

Articles 20(12) and 53(1) EUTMR Article 66(1) and Article 31(7) EUDR

The request for renewal may be submitted by:

1. the registered proprietor/holder of the EUTM/EUD;

2. where the EUTM/EUD 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/EUD 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/EUD.

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 66 EUDR

The request for renewal must contain the following: name of the person requesting renewal and the registration number of the EUTM/EUD 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/EUD and an indication that it is a request for renewal. In such circumstances, no further formalities need to be complied with (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges). Where this option is relied on in EUTM renewals, the payment must be of the renewal fee laid out in Annex I A, paragraphs (11) or (15) EUTMR and not of the discounted fee for renewal by electronic means pursuant to Annex I A, paragraphs (12) or (16).

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 other particulars of the person submitting a request for renewal

Article 2(1)(b) and (e) EUTMIR

Article 66(4)(a) EUDR

7.2.1.1 Request filed by the proprietor/holder

Where the request is filed by the EUTM/EUD 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 66(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 66(4)(b) EUDR

The EUTM/EUD registration number must be indicated.

7.2.3 Indication as to the extent of the renewal

Article 53(4) EUTMR

Article 66(4)(c) EUDR

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

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

- 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 EUDs, 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.

7.4 Time limits

Article 52 and Article 53(3) EUTMR

Article 69(1) EUTMDR

Article 66(3) EUDR

Articles 20 and 22 EUDDR

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 EUD 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 not open within the meaning of Article 22 EUDDR, the first following working day on which the Office is open to the public.

7.4.2 Six-month period following expiry (grace period)

Where the EUTM/EUD 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

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 EUD 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 EUD 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 EUD 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 EUDs

The EUDR changed the calculation of the renewal periods for EUDs, which is now aligned with those for EUTMs. Now, the basic period for renewal of EUDs 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 calculation 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 EUD 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 66 EUDR will apply for calculating both the basic period and, where applicable, the grace period.

For example, where the EUD 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.

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 66(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 EUD 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 EUDs

Article 66(3) EUDR Article 150 and Annex I (6) and (8) EUDR

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

- 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 EUD 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 66(3) EUDR and Annex I (6) and (8) EUDR 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.

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 66(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.

8.1.1 Observation of time limits

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

Article 66(3), (4) and (8) and Article 149(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 EUD 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 66(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 EUD renewal fee, the holder may, instead of paying the missing amount, restrict its request for renewal to the corresponding number of multiple designs.

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

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

Article 66(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 EUDs, where the fee paid covers the basic fee and the fee for late payment, but the fees paid are insufficient to cover all designs identified in the renewal application, the Office will only renew the registration for some designs. In the absence of an indication of the designs to be renewed, or of any other criteria for determining which designs are intended to be covered, the Office will determine the designs to be renewed by taking them in numerical order.

8.1.1.3 Situation where the requester holds a current account

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

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

For payment by third parties, see paragraph 7.5.4 above.

8.1.2 Compliance with formal requirements

8.1.2.1 Renewal requested by an authorised person

Article 53(1) EUTMR Article 66(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 66(4) and (7) EUDR

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

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

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

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

Article 66(8) and Article 87 EUDR

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 87 EUDR 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 EUD nor will an EUD be reclassified that was registered in accordance with an edition of the Locarno

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

9 Partial Renewals of EUTMs

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

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

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

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

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

For example:

An EUTM registration has 10 classes.

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

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

If, within the grace period, the Office receives a new renewal request for two more classes of the registration, the fees payable would be:

Additional classes (EUR 150 x 2):	EUR 300
25 % surcharge of the belated fee:	EUR 75
Total additional fees payable:	**EUR 375**

Total additional fees payable: EUR 375.

Using the same example, at the end of the grace period the Office would issue a notification to the proprietor of loss of rights for the remaining three classes of goods or services which were not renewed, for which registration is deemed expired.

10 Entries in the Register

Articles 53(5), 111(6) and Article 111(3)(k) EUTMR

Article 66(6) and Article 104(3)(n) and Article 104(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/EUD, 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 66(6) and (8) and Article 87 EUDR

Where the Office has made a determination pursuant to Article 53(8) EUTMR or Article 66(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 87 EUDR within 2 months.

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 13 and Article 66(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 EUD 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 EUD 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 EUD).

11.2 Conversion of lapsed EUTMs

Articles 53(3) and 139(5) EUTMR

Where the owner wants to convert its lapsed EUTM into a national mark, the request must be filed within 3 months from the day following the last day of the 6-month grace period. The time limit of 3 months for requesting conversion starts automatically without notification (see the Guidelines, Part E, Register Operations, Section 2, Conversion).

12 Renewal of International Marks Designating the EU

Article 202(1) EUTMR

The procedure for renewal of international marks is managed entirely by the International Bureau. The Office will not deal with renewal requests or payment of renewal fees. The International Bureau will send notice for renewal, receive the renewal fees and record the renewal in the International Register. The effective date of the renewal is the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register. Where an international registration designating the EU is renewed, the Office will be notified by the International Bureau.

If the international registration is not renewed for the designation of the EU, it can be converted into national marks or into subsequent designations of Member States under the Madrid Protocol. The 3-month time limit for requesting conversion starts on the day following the last day on which renewal may still be effected before WIPO pursuant to Article 7(4) of the Madrid Protocol (see the Guidelines, Part E, Register Operations, Section 2, Conversion).

13 Renewal of International Design Registrations Designating the EU

Article 152 and 158 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.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 5

Inspection of the Registers and files

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 104, 109, 110, 111 and 113 EUDR

Articles 13 and 14 EUDIR

Decision No EX-25-4 on the keeping of files and the inspection of files

Decision No EX-26-07 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 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' are the official record of all entries made in relation to European Union trade marks (EUTM) or registered European Union designs (EUD) where these entries are required by the EUTMR, the EUDR or acts adopted pursuant to them; and
- the 'files' contain all the documents or items of evidence submitted by the parties to the Office in all proceedings provided for by the EUTMR or EUDR, and all the correspondence and decisions issued by the Office relating to those proceedings.

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, or an EUD or when an EUD is subject to deferred publication, inspection of files is possible only in exceptional cases (see paragraphs 4.2.1 and 4.2.2).

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.

2 The Registers of EUTMs and European Union designs

Article 111(1) and (5) EUTMR

Article 104 and 105 EUDR

Decision EX-26-07 of the Executive Director of the Office of 1 July 2026 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.

All entries made in the Registers are made into an electronic archive (the 'eRegister').

The eRegister provides one accessible electronic repository of all entries in the Register for a specific EUTM or EUD.

The eRegister can be accessed through the eSearch plus tool available on the Office website. On finding an EUTM or EUD in eSearch Plus, the user is presented with the option of viewing the eRegister repository for this right in a separate interface.

The eRegister is also accessible through the Office's TMview and DesignView tools.

The particulars that are recorded in the eRegisters are specified in Annexes I and II of Decision EX-26-07 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.

Where data contained in the eRegisters is not yet publicly accessible, such data may be accessed by submitting a request for information or by obtaining certified or uncertified extracts or copies of the file documents (see paragraph 5.2).

3 Inspection of the Registers

3.1 The Register of EUTMs

Article 111(2), (3) and (4) EUTMR

Decision EX-26-07 of the Executive Director of the Office of 1 July 2026 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.

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.

The entries in the Register for each EUTM will become available in the eRegister once the EUTM application is considered to have been filed pursuant to Article 32 EUTMR.

The content of each entry in the Register as set out in Article 111 EUTMR is listed in Annex I to Decision EX-26-07.

3.2 The Register of EU designs

Articles 62, 104 and Article 109(5) EUDR

Decision EX-26-07 of the Executive Director of the Office of 1 July 2026 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 II.

The Register of EU designs contains the information specified in Article 104(2) and (3) EUDR and any other items determined by the Executive Director of the Office pursuant to Article 104(4) EUDR.

The entries in the Register for each EUD will become available in the eRegister once the EUD is registered pursuant to Article 59 EUDR.

In accordance with Article 109(5) EUDR, where the EUDs are subject to a deferment of publication pursuant to Article 62(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 content of each entry in the Register as set out in Article 104 EUDR is listed in Annex II to Decision EX-26-07.

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 EUD;
- 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

Article 114 and 115 EUTMR

Article 109 and 112 EUDR

Decision No EX-25-4 of the Executive Director of the Office on the keeping of files and the inspection of files

The files relating to an EUTM or EUD consist of all the documents and items of evidence submitted by the parties to the Office in all the proceedings under the EUTMR or EUDR, as well as all the correspondence and decisions issued by the Office relating to those proceedings.

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.

Inspection of the respective files remains possible even where an EUTM or EUD application is deemed not filed, rejected, withdrawn or considered to have been withdrawn, or an EUTM or EUD registration expires or is surrendered, declared invalid or revoked.

Where an applicant or proprietor requests access to their own file, they will have access to all documents that form part of the file, except for those documents referred to in Article 114(4) EUTMR and Article 109(4)(a) and (b) EUDR.

Where the files are kept in electronic format, the electronic files, or back-up copies thereof, will be kept indefinitely. The Office may dispose of original documents submitted by the parties, which have been scanned or uploaded to form the basis of the electronic files, five years after their receipt by the Office. Where files or part of files are not kept electronically (e.g. articles or physical items of evidence that cannot be converted to electronic format due to their physical form or volume), the Office will keep the relevant articles or items of evidence for at least five years from the end of the year in which:

- the EUTM/EUD application is rejected or withdrawn;
- the EUTM/EUD registration expires definitively;
- the surrender of the registered EUTM or EUD is entered in the Register; or
- the registered EUTM or EUD is removed from the Register.

4.2.1 The files relating to EUTM applications

Articles 41(3), 44 114 and 115 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 only possible when 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 5.5.1); or
- the applicant for inspection has established a legitimate interest in the inspection of the EUTM application, in particular where the EUTM applicant has stated that it will invoke the rights under the EUTM, once registered, against the applicant for inspection (see paragraph 5.5.2).

4.2.2 The files relating to EUD applications and EUDs subject to deferment of publication

Articles 62, 109 and Article 110(2) EUDR

The files relating to EUD applications, or an EUD 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 EUD applicant/holder; or
- the applicant for the EUD has consented to inspection of the file relating to the EUD application (see paragraph 5.5.1); or
- the applicant for inspection has established a legitimate interest in the inspection of the EUD application, in particular where the EUD applicant has stated that it will invoke the rights under the EUD, once registered, against the applicant for inspection (see paragraph 5.5.2).

In the case of an application for multiple EUDs, this inspection restriction will only apply to information relating to the EUDs 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 EUDs

The files relating to EUDs 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 EUD 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 105 and 155 EUDR

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.

For international registrations of designs designating the EU the Office provides information 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 156 EUDR and the invalidation of the international design pursuant to Article 157 EUDR. They may be inspected subject to the restrictions pursuant to Article 109 EUDR (see paragraph 4.3) and subject to the same limitations as explained in paragraphs 4.2.2 and 4.2.4.

4.3 Parts of the file excluded from inspection

4.3.1 Excluded documents

Article 114(4) and Article 169 EUTMR Article 109 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 (see paragraph 4.3.2);
- draft decisions and opinions and all other internal documents used for preparing decisions and opinions (see paragraph 4.3.3);
- parts of the file for which the party concerned expressed a special interest in keeping confidential (see paragraph 4.3.4);
- all correspondence relating to mediation, where the parties make use of the mediation services offered by the Office in accordance with Decision No EX-25-09 of the Executive Director of the Office on the administration of mediation processes ('Rules on Mediation);
- the files relating to requests for entry on the Office's list of professional representatives or the designs list, including all decisions made in this regard. These files are not open to public inspection because the files do not relate to EUTM or EUD 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. These documents are not open to public inspection because confidentiality vis-à-vis any third parties is justified, and, in principle, overrides any third-party interest.

4.3.2 Documents relating to exclusion or objection

Article 114(4) EUTMR Article 109(4)(a) EUDR

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 regarding an objection by a party to the proceedings on the basis of a ground for exclusion or suspicion of partiality are excluded from inspection.

However, the following documents form part of the file and are not excluded from inspection:

- letters in which a party to the proceedings raises an objection based on a ground for exclusion or suspicion of partiality, either separately or together with other statements, to any decision on the action to be taken in the cases mentioned above;
- the decision taken by the competent instance of the Office.

4.3.3 Draft decisions and opinions and internal documents

Article 114(4) EUTMR

Article 109(4)(b) EUDR

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 are excluded from inspection.

Documents that contain a communication, notice or final decision by the Office in relation to a particular case are not excluded. 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.

4.3.4 Parts of the file for which the party concerned expressed a special interest in keeping confidential

Articles 67 and 114(4) EUTMR

Articles 77(2) and 109(4)(c) EUDR

The documents that constitute the files are open to public inspection (see paragraph 4.2). The onus is on the party making the submission to ensure that sensitive data is blacked out, or certain pages omitted altogether, before submitting them to the Office. Where this is not possible, the party concerned may express a special interest in keeping parts of the file confidential.

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

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.

Requests for confidentiality can only be filed in relation to documents that have been filed by the party concerned (and not, for example, documents filed by the other party in *inter partes* proceedings).

In *inter partes* proceedings, where the party concerned (the opponent or applicant for revocation or declaration of invalidity) has shown a special interest in keeping their documents confidential vis-à-vis third parties, they will be informed that their documents cannot be kept confidential with respect to the other party to the

proceedings. They will be invited to either disclose the documents or withdraw them from the proceedings. If they choose to withdraw their documents, they will not be sent to the other party and will not be taken into account by the Office in its decision.

If, on the other hand, they want the documents to be taken into account but to remain confidential for third parties, the documents can be forwarded by the Office to the other party to the proceedings, but they 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).

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).

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 documentation as evidence in respect of a request for registration of a transfer or licence.

The Office must check whether that special interest is sufficiently demonstrated.

Where the Office concludes that the special interests claimed do not justify the confidentiality of the document, prior to lifting the confidentiality it will communicate this to the person who filed the documents. In reply, the applicant may resubmit the evidence in a manner that does not disclose any information they consider confidential. 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 indication of any special interest nor any attempt on behalf of the party to justify the confidential nature of the submission, the Office will not consider those documents to be confidential unless they are clearly of a personal nature and not open to public inspection (see paragraph 4.3.1). The Office will not inform the requesting party.

The party can still, at any time before the receipt of a request for inspection of files, invoke and justify a special interest in keeping the document confidential. This request will be examined by the Office in accordance with the existing rules.

Limitations to the confidentiality

Access to confidential documents 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 to be inspected contains confidential documents, the Office will inform the applicant for inspection of files thereof. The applicant may invoke an overriding legitimate interest.

The party requesting inspection will be given the opportunity to present its observations in this respect. Each request will be analysed on its own merits.

Before taking a decision, the request, as well as any observations, must be sent to the party that filed the confidential documents, who has a right to be heard.

The Office will take a decision as to whether to grant access to such documents. This decision may be appealed by the adversely affected party.

5 Procedures before the Office relating to applications for inspection of files

5.1 Online inspection of files

Use of online inspection is strongly recommended as it is provides immediate access and is free of charge. Providing the EUTM application or the EUD registration (not subject to deferment) has been published, any user logged into their User Area account on the Office's website can access the contents of the files.

The contents of the files are available in the ‘Correspondence’ section of the file in eSearch plus on the Office’s website.

The alternative to using online inspection is to request an inspection of files by submitting a form to the Office, which is subject to a fee (see paragraph 5.3).

5.2 Downloadable certified or uncertified copies

Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 on communication by electronic means, and its Annex I.

Decision EX-26-07 of the Executive Director of the Office of 1 July 2026 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 EUD applications, registration certificates, extracts of the Register and copies of the documents in the file (currently 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 EUD; and
- from the TMview and DesignView databases (application forms and registration certificates).

For certified copies, 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 bears 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/EUD 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.

Certified copies can be verified online using the unique identification code provided. A link 'Verify certified copies' is available under the 'Databases' section of the Office's website. The unique identification code can be entered in the box provided 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 5.2.2.

5.2.1 Certified or uncertified extracts of the Registers

Article 111(7) EUTMR

Article 63 EUTMDR

Articles 62 and 104 and Article 109(5) EUDR

Decision EX-26-07 of the Executive Director of the Office of 1 July 2026 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.

Extracts from the EUTM and EUD Registers can be obtained through the following methods:

1. The eRegister: on entering the eRegister repository of an EUTM or EUD, 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 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.
3. By post: This option is only available for EUTMs. The user may request, via the User Area, that the Office send an extract, or a similar request, by post. 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 (see paragraph 5.4). Requests cannot be made for extracts of the EUD Register because Article 104(7) EUDR only allows the issuing of extracts by electronic means.

For deferred designs, such extracts are subject to the conditions laid down in Article 109(5) EUDR and will therefore 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.

5.2.2 Certified or uncertified copies of file documents

Copies of file documents constituting the EUTM and EUD files (see paragraph 4.2) can be obtained through the following methods:

1. Through eSearch plus: on entering the database information of the EUTM or EUD, a user who is logged in has the option of downloading a copy of specific file documents for this right. Downloading such documents directly from eSearch plus is free of charge.
2. An online request in the User Area: 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. Such requests are free of charge.
3. By post: this option is only available for EUTMs. The user may request, via the User Area, that the Office send certified or uncertified copies of specific documents by post. The Office will send the user the certified or uncertified document that is retrieved from, and corresponds to, the documents retrievable online through eSearch plus. The request is subject to the payment of a fee pursuant to Article 111(7) EUTMR and point A.29 of Annex I EUTMR (see paragraph 5.4). Requests cannot be made for documents of EU design files because Article 104(7) EUDR only allows the issuing of documents by electronic means.

Certified copies of the EUTM or the EUD application 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 EUD 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 EUD 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.

It should be borne in mind that the certified copy of the application or registration certificate 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/EUD registration certificate. Up-to-date information is available from the electronic database or by requesting a certified extract of the Register (see paragraph 5.2.1).

5.3 Written applications for inspection of files

Article 63 EUTMDR Article 17 EUDDR

The alternative to online inspection via eSearch plus (see paragraph 5.1), is to file an application for inspection of files using the online filing form available in the User Area.

Any language version of this form may be used, provided that it complies with the general language rules. See the Guidelines, Part A, General Rules, Section 4 Language of proceedings.

Representation is not mandatory for filing an application for inspection of files. However, where a representative is appointed, the general rules for representation and authorisation apply. See the Guidelines, Part A, General Rules, Section 5, Professional Representation.

The application for inspection of files 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.
- The type of information needed must be specified where communication of information from the file is applied for.
- An indication and evidence to the effect that the third party concerned has a right to inspect the file in cases where the application for inspection relates to an EUTM application that has not yet been published, the application for an EUD that has not yet been published or an EUD that is subject to deferment of publication in accordance with Article 62 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.

- Where printed copies are requested to be sent (for EUTM-related proceedings only), an indication of the number of copies requested, whether 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 required. Unless the applicant expressly requests printed copies to be sent by mail, the Office will provide an electronic copy of the requested, which will be notified through the User Area via electronic means of communication.
- The applicant's signature. In accordance with Article 63(1) EUTMDR and Article 17(1) EUDDR the sender's name will be deemed to be equivalent to the signature.

Where an application for inspection of the files fails to comply with the requirements concerning the contents of the application, the applicant for inspection will be invited to remedy the deficiencies. If the deficiencies are not remedied within the established time limit, the application for inspection will be refused.

5.4 Fees for inspection and communication of information contained in the files

Online inspection of files and the communication of information contained in the files, as well as the download of certified or uncertified copies of file documents or extracts from the Register are free of charge for both EUTM and EUD-related files.

In EUTM-related proceedings, inspection and communication of information contained in the files on the Office's premises or through issuing hard copies of those documents is subject to different fees as seen in the following paragraphs. These options are not available in EUD-related proceedings.

5.4.1 Communication of information contained in an EUTM-related file

Article 114(9) and Annex I A(32) EUTMR

Communication of information in a file is subject to payment of a fee of EUR 10.

5.4.2 Inspection of the files

Article 114(6) and Annex I A(30) EUTMR

A request for inspection of the files on the Office's premises is subject to payment of a fee of EUR 30. Where the files are in electronic format, the Office will only provide electronic access to the files at the Office's premises.

Article 114(7) and Annex I A(31)(a) EUTMR

Where inspection of a 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 i) application; ii) certificate of registration; iii) extract from the Register; or iv) extract of the application from the database is subject to the payment of a EUR 10 fee per copy or extract.

Article 114(7) and Annex I A(31)(b) EUTMR

Where inspection of a file is obtained through the issuing of **certified** copies of file documents, those copies are subject to payment of a fee of EUR 30 plus EUR 1 for every page exceeding ten.

Article 51(2) EUTMR

Articles 111(7), 114(7) and Annex I A(29)(b) EUTMR

A **certified** copy of an EUTM i) application; ii) certificate of registration; iii) extract from the Register; or iv) extract of the application from the database is subject to the payment of a EUR 30 fee per copy or extract.

5.4.3 Consequences of failure to pay

Article 114(6) EUTMR

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 in part or in full, the Office will notify the applicant for inspection by issuing a deficiency 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 its calculation depends on the number of pages to be issued, the Office will either include that information in the standard letter or inform the applicant for inspection by other appropriate means.

5.4.4 Refund of fees

Where an application for inspection of EUTM files is rejected, the corresponding fee is not refunded. 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.

5.5 Inspection of files of an unpublished EUTM application, or a deferred EUD, filed by a third party

Article 114(1) and (2) EUTMR Articles 109 and 110(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 EUD subject to deferment of publication in accordance with Article 62 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), is filed by a third party (i.e. by a person other than the EUTM or EUD applicant or its representative), the right to obtain the inspection of files will be granted only when the applicant has consented to the inspection (see paragraph 5.5.1) or when the requester has established a legitimate interest to inspect a file (see paragraph 5.5.2).

5.5.1 Consent

If an application by a third party is based on the grounds specified in Article 114(1) EUTMR (see paragraph 4.2.1) or in Articles 109(1) or 110(2)(a) EUDR (see paragraph 4.2.2), it must contain an indication and evidence to the effect that the EUTM applicant or EUD applicant or holder has consented to the inspection.

The consent of the EUTM applicant or EUD 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, EUD applicant or holder consenting to the inspection of the files, the applicant for inspection will be notified and given two 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 77 EUDR).

5.5.2 Legitimate interest in inspecting the file

Article 114(2) EUTMR

Articles 109(2) and 110(2) EUDR

Where the application relies on the allegation that the EUTM applicant or EUD proprietor will invoke the rights under the EUTM or EUD, 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 EUD applicant or holder for the right 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 EUD applicant or holder and invite it to comment within two months. If the EUTM applicant or EUD 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 EUD 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 EUD applicant or holder. It may be appealed by the adversely affected party (Articles 67 and 68 EUTMR and Article 77 EUDR).

5.6 Grant of an application for inspection of files

Following a written application for inspection of files, when granted, the Office will send the requested copies of file documents, or requested information, as appropriate, to the applicant for inspection.

5.6.1 Communication of information contained in a file

Article 114(9) EUTMR

Article 111 EUDR

Information contained in the file can be inspected by the user directly via eSearch plus free of charge (see paragraph 5.1).

However, the Office may, on request, communicate information contained in any file relating to EUTM or EUD applications or registrations.

Information contained in the files will be provided without an application for inspection, such as, 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, for example, 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.

5.6.2 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.

5.6.3 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.

6 Procedures to grant inspection of files or give access to the files to courts or authorities of the Member States

Article 117(1) EUTMR

Article 113(1) EUDR

Articles 20 and 21 EUTMIR

Articles 13 and 14 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.

The Office will also, on request, communicate relevant information about the filing of EUTM or EUD 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.

Inspection of the files relating to EUTM and EUD applications or registrations by courts or Member States' authorities will be granted by providing copies of the original documents in electronic format. The Office may provide printouts from the electronic system as an exception, if expressly demanded by the requesting authority.

6.1 Fees

Article 20(3) and Article 21(1) and (3) EUTMIR

Article 113(2) EUDR

Articles 13(4) and 14(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.

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.

6.2 No restriction as to unpublished applications

Articles 114(4) and 117(1) EUTMR
Articles 20(1) and 21(2) and (3) EUTMIR
Articles 109 and 113(1) EUDR
Articles 13(1) and 14(2) and (3) 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 109 EUDR. Consequently, these bodies may be granted access to files relating to unpublished EUTM applications (see paragraph 4.2.1) and EUDs subject to deferment of publication (see paragraph 4.2.2), 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 109(4)(b) EUDR, will not be made available to these bodies.

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 109 EUDR, as if the inspection had been requested by a third party.

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 EUD applications or EUD registrations pursuant to Article 109 EUDR.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 6

Other entries in the register

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 6

Other entries in the register

Chapter 1

Counterclaims

1 Introduction

Counterclaims, as provided for in Article 128 EUTMR or Article 123 EUDR, are defence claims made by a defendant that is being sued for the infringement of an EUTM or registered European Union design (EUD). 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 EUD 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 EUDs, 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 EUD.

By entering such counterclaims and their final judgments in the Register, the Office strives to comply with the principles of conformity to truth, public faith and the legal certainty of a public register.

2 Application to register the filing of a counterclaim before an EUTM or an EUD court

Article 111(3)(n) and Article 128(4) EUTMR Articles 123, 123(5) and 104(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 125(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 EUD 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 EUD 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 119 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:

- indicate the date on which the counterclaim was filed;
- quote the number of the EUTM or EUD 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 EUD 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 130(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 125(3) and 104(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 EUD, 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 EUD 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.

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 EUD 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.