Notes on the Application Form for a Declaration of Invalidity of a Community Trade Mark

1. General Remarks

1.1 Use of the form

The form may be obtained free of charge from the OHIM and may be downloaded from the OHIM’s website (http://www.oami.europa.eu). The form may also be freely copied.

Applicants for a declaration of invalidity or their representatives may use forms of a similar structure or format, such as forms generated by computers on the basis of the information contained in the form.

Where such electronically generated forms are used, the use of attachments may be avoided by simply extending the electronic version where further space is required.

It is recommended that the form be submitted as complete as possible, including the necessary evidence, at the time of filing. This will facilitate and expedite the handling of the application for a declaration of invalidity.

The application form for a declaration of invalidity consists of two pages of basic data and five pages for identifying the earlier rights upon which the application is based, if the application is based on relative grounds. On the first page particulars on the applicant for invalidity, its representative, the challenged Community trade mark or international registration (IR), the extent of the application, the language of the application, the declaration, payment of the fee and the signature must be given. On the second page the grounds for the application must be indicated. If more than one earlier right is invoked in the application, it is recommended that a separate page be used for each earlier right claimed. Please note that only pages containing information have to be sent.

Explanations as to how to fill in the form are given under ‘2. The form’. These explanations follow the order of the form. Please note that an application for a declaration of invalidity is only admissible if the contested Community trade mark has been registered.

For any information, the OHIM may be contacted on the following telephone number: (34) 965 139 100.

1.2 Sending forms

Completed applications, as well as any other submissions, e.g. observations or evidence sent, should be addressed as follows:

Office for Harmonization in the Internal Market
Receiving Unit
Avenida de Europa, 4
E-03008 Alicante, Spain

Communications by fax should be sent to the following fax number of the OHIM:

+34 965 131 344
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Where communications are sent by fax, confirmation copies are not necessary and not recommended. The OHIM will request further information should the communication sent by fax prove to be insufficient.

2. The form, first page

At the top of the first page the applicant for a declaration of invalidity must indicate the total number of pages of the application including any continuation sheets and attachments (explanation of the grounds, evidence, authorisation, etc) and its reference.

2.1 Applicant for a declaration of invalidity

If the applicant for a declaration of invalidity has previously been allocated an ID number by the OHIM, it is sufficient to indicate that ID number and the name. Otherwise, the applicant must be identified by indicating its name together with its address and nationality. The applicant must also indicate its legal status.

2.2 Representative

Representation is mandatory for all applicants for a declaration of invalidity, either natural or legal persons that have neither their domicile or principal place of business nor a real and effective industrial or commercial establishment in the Community. All other persons may represent themselves or choose to appoint a representative.

The representative must indicate its name together with its ID number attributed by the OHIM. Where such an ID number is not available, the appropriate information relating to the existing/newly appointed representative must also be given in the application form.

Representation before the OHIM may be exercised by professional representatives falling into one of the two following categories:

- legal practitioners qualified in a Member State who are entitled to act in that Member State as representative in trade mark matters, and who have their place of business in the European Community, or
- professional representatives entered on the list maintained by the OHIM. Professional representatives entered on the list for Community trade mark matters may act for design matters. On the other hand a professional representative entered on the list for Community design matters may not act for trade mark matters.

The applicant for a declaration of invalidity may also act through an employee. Where such an employee is appointed, the name of the employee must be indicated in the box “representative”. Employees of legal entities with their domicile or principal place of business or a real and effective industrial or commercial establishment within the European Community may represent other legal entities if (and only if) economic connections exist between the two legal persons, such as common ownership or control. This also applies when the applicant is a legal entity from outside the European Community. In these cases, information relating to the legal entity whose employee acts on behalf of the applicant, and the basis of economic connections (parent company, subsidiary, branch etc.) must be provided in an attachment.

The OHIM will communicate with the professional representative if appointed.

Filing an authorisation of the representative is not required, except where an employee of the applicant for a declaration of invalidity has been appointed as representative.
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2.3 Challenged Community trade mark, language of the application and extent of the application

Challenged Community trade mark: The applicant for a declaration of invalidity must indicate the registration number of the challenged Community trade mark together with the registration date and the name of its proprietor. The information provided by the applicant for invalidity must unambiguously identify the challenged Community trade mark.

Language: The application for a declaration of invalidity should preferably be filed in either the first language of the challenged CTM provided that this is one of the five languages of the OHIM (Spanish - ES; German – DE, English - EN; French - FR; Italian - IT), or in the second language of the challenged CTM, which is necessarily a language of the OHIM. The application for a declaration of invalidity may also be filed in any other of the five languages of the OHIM, provided that a translation of the application for a declaration of invalidity into the first language (if a language of the OHIM) or the second language of the challenged CTM is filed within one month. Any language version of the form may be used, provided the information required is given in the appropriate language.

Extent of the application: If total invalidity is claimed an indication to this effect must be made. If invalidity is not sought for all goods and services for which the challenged Community trade mark is registered, there must be an express indication of the contested goods or services in the application for a declaration of invalidity.

2.4 Declaration

The applicant has to make a statement to the effect that a prior final decision (res judicata) concerning the same parties, as regards absolute or relative grounds, has not been made, and that an application for a declaration of invalidity based on another earlier right has not previously been filed (counterclaims included). This declaration is made by signing the application for a declaration of invalidity.

2.5 Payment of the fee

The payment of the fee must be made in euro

The fee for the application for a declaration of invalidity is 700 euro, regardless of the number of grounds invoked. The application is not deemed to have been filed until the fee has been received by the OHIM. The applicant for a declaration of invalidity has to choose one of the payment options by ticking the corresponding box.

Payment (all bank charges to be met by the payer who should instruct the bank accordingly) can be effected by:

- Debiting a current account held with the OHIM, indicating the number of that account;
- Making a transfer, in euro, to a bank account of the OHIM, indicating the name, address and reference number of the invalidity applicant or representative, and the type of fee to which the payment refers as well as the date on which the transfer was made.

Current accounts may be opened by applying in writing to the OHIM at the following address:

Office for Harmonization in the Internal Market
Finance Department
Avenida de Europa, 4
E-03008 Alicante, Spain
Telephone: (34) 965 139 340
Fax: (34) 965 139 113
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Transfers should be made to one of the following OHIM bank accounts:

Banco Bilbao Vizcaya Argentaria
0182-5596-90-0092222222  Swift code (BIC): BBVAESMM XXX
IBAN ES88 0182 5596 9000 9222 2222

La Caixa
2100-2353-01-07000000888  Swift code (BIC): CAIXESBB XXX
IBAN ES03 2100 2353 0107 0000 0888

2.6 Signature

The application for a declaration of invalidity must be signed and the name of the signatory must be indicated.

3. The form, second page

3.1 Grounds

The applicant must state at least one ground for invalidity and give a statement or explanation of grounds.

Where the application is based on absolute grounds, an indication to this effect and a reasoned statement must be provided, where appropriate accompanied by evidence.

Where the application for a declaration of invalidity is based on relative grounds, the applicant must indicate if the application for a declaration of invalidity is based on the grounds of Article 53(1) and/or 53(2) CTMR. Only in the case of relative grounds must details of the earlier rights be provided. To this end pages three to seven should be used.

For each ground the applicant for a declaration of invalidity must indicate the facts in support of the ground and provide evidence to prove those facts. Furthermore, the applicant must give arguments explaining the significance of the facts and evidence to the alleged invalidity of the challenged Community trade mark.

4. The form, pages three to seven

4.1 Trade mark registrations and applications

For trade mark registrations and applications the following details must be provided:

- the type of mark (CTM, national, or international registration indicating the Member States where it has effect) (see 4.6)
- data on the registration and/or application
- a representation of the mark (see 4.7)
- the goods and services on which the application is based
- an indication of the entitlement of the applicant for a declaration of invalidity
- the specific ground for the application for a declaration of invalidity
- an explanation of grounds.

If it is claimed that the mark has a reputation, in addition to the above requirements the applicant for a declaration of invalidity must give:
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- data on the territory where the mark has a reputation and for which goods or services it has a reputation.

The applicant for a declaration of invalidity must also attach evidence of the existence of the earlier mark, its entitlement and, where appropriate, evidence of reputation. If necessary, a translation of the evidence must be provided.

4.2 Well-known marks

For well-known marks (Art. 6 bis of the Paris Convention), the applicant for a declaration of invalidity must indicate:

- the geographical area of protection, i.e. the Member State where the mark is well known (see 4.6)
- a representation of the mark (see 4.7)
- an indication of the goods or services for which it is well known
- the specific ground for the application for a declaration of invalidity
- an explanation of grounds.

The applicant for a declaration of invalidity must also attach evidence of the existence of the earlier mark, its entitlement and evidence of the mark being well known. If necessary, a translation of the evidence must be provided.

4.3 Contested applications filed by an agent of the applicant

For agent marks the applicant for a declaration of invalidity must provide:

- data on the mark
- the country or countries where it is registered, applied for or protected
- a representation of the mark (see 4.7)
- an indication of the goods or services
- the specific ground for the application for a declaration of invalidity
- an explanation of grounds.

The applicant must also attach evidence of ownership of the mark and of the time of acquisition of the right, evidence of the agent-representative relationship and evidence that the CTM was registered without the owner’s consent. If necessary, a translation of the evidence must be provided.

4.4 Non-registered trade mark or sign used in the course of trade

For earlier non-registered trade marks or signs the applicant must indicate:

- the nature of the sign, such as company name, trade name etc.
- an indication of the entitlement
- territory / Member State(s) where the trade mark or sign is used in the course of trade (see 4.6)
- the geographical scope of the sign
- a representation of the sign (see 4.7)
- the goods, services or activities for which the sign is used
- an explanation of grounds.
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The applicant for a declaration of invalidity must also attach evidence of ownership/use of the sign, evidence of the time of acquisition of the sign, evidence of the applicable law and its scope of protection vis-à-vis later trade marks. If necessary, a translation of the evidence must be provided.

4.5 Other earlier rights

For other earlier rights the applicant for a declaration of invalidity must indicate:

- the nature of the right
- data on the earlier right, including the geographical scope of the right (see 4.6)
- a representation/indication of the right (see 4.7)
- an explanation of grounds.

The applicant must also attach evidence of entitlement, evidence of the time of acquisition of the right, evidence of the applicable law and its scope of protection vis-à-vis later trade marks. If necessary, a translation of the evidence must be provided.

4.6 Country codes

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4.7 Representation of the mark/sign

For word marks, the sign can simply be typed in.

For any other marks, the sign can be imported into the application in two ways. If you have Adobe Acrobat Writer, the representation of the mark can be imported in any format (e.g. .jpg, .gif, .tif, .bmp). If you have Adobe Acrobat Reader, the image can be imported in pdf format only. Alternatively, you can attach a representation of the sign on a separate sheet.