

# Limitations, Withdrawals and Proof of Use requests in a separate document

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## Limitations, withdrawals and proof of use requests in a separate document

Requirement of filing in a separate document:

OPPOSITION	CANCELLATION
Limitation	Partial surrender
Withdrawal	Total surrender
Request for proof of use	Request for proof of use (INV)

**Limitations, withdrawals and proof of use requests in a separate document**

**COMMISSION DELEGATED REGULATION (EU) 2017/1430** of 18 May 2017 supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96 (EUTMDR)

## Limitations, withdrawals and proof of use requests in a separate document

# OPPOSITION

## *Article 8*

### **Examination of the opposition**

[...]

8. [...]. Where the applicant wishes to withdraw or restrict the contested application, it shall do so by way of a separate document.\*

\* applied to withdrawal of opposition

## Limitations, withdrawals and proof of use requests in a separate document

# OPPOSITION

## *Article 10*

### **Proof of use**

1. A request for proof of use of an earlier mark [...] shall be admissible if it is submitted as an unconditional request in a separate document within the period specified by the Office pursuant to Article 8(2) of this Regulation.

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## CANCELLATION

### *Article 17*

### **Examination on the merits of an application for revocation or for a declaration of invalidity**

[...]

7. Where the proprietor wishes to surrender the contested EU trade mark, it shall do so by way of a separate document.

## Limitations, withdrawals and proof of use requests in a separate document

# CANCELLATION

## *Article 19*

### **Proof of use in relation to an application for revocation or for a declaration of invalidity**

[...]

2. A request for proof of use pursuant to Article 57(2) or (3) of Regulation (EC) No 207/2009 shall be admissible if the proprietor of the EU trade mark submits it as an unconditional request in a separate document within the period specified by the Office pursuant to Article 17(1) of this Regulation. [...]

**Limitations, withdrawals and proof of use requests in a separate document**

**Guidelines for Examination of European Trade marks** , European Union  
Intellectual Property Office (EUIPO), Part C, Opposition, Section 1,  
Procedural matter.



## Limitations, withdrawals and proof of use requests in a separate document

### **4.4.1 Restrictions, withdrawals and requests for proof of use to be filed by way of a separate document Articles 8(8) and 10(1) EUTMDR**

[...] The request must be separate from other submissions; therefore it may be filed simultaneously with other submissions, however it must be presented separately (on a separate sheet). Consequently, a request will never be accepted where it is merged into observations, even when it is included under a separate section, paragraph or header. [...]

## Limitations, withdrawals and proof of use requests in a separate document

### **4.4.1 Restrictions, withdrawals and requests for proof of use to be filed by way of a separate document Articles 8(8) and 10(1) EUTMDR**

When the party submits such request electronically by selecting the specific options ‘submit a restriction of goods and services’, ‘withdrawal’, ‘submit a request for proof of use’ or ‘submit observations and a request for proof of use’, **the automatic cover page in itself as generated and as inserted in the file will be considered as equivalent to a request in a ‘separate document’.**

## Limitations, withdrawals and proof of use requests in a separate document

### Inadmissible submissions

- Not filed electronically & not filed on a separate sheet/in a separate document

### Consequences

Refusal of the request (interim decision appealable together with the decision on the substance)

## Limitations, withdrawals and proof of use requests in a separate document

### Considerations:

- Clarity gains
- Explicit and unconditional requests
- ‘Overlooked’ requests are refused
- No deficiency raised, loss of time limit for requests for proof of use (Articles 8(2) and 19(2) EUTMDR)

## Limitations, withdrawals and proof of use requests in a separate document

### REQUESTS

#### Example:

It is requested that

1. the opposition No. B ~~002 015 002~~ be rejected,
2. the opponent shall furnish proof of genuine use of the earlier EU trademark registrations
  - 3) EU ~~001 051 004~~,
  - 4) EU ~~003 050 956~~,
  - 5) EU ~~000 800 616~~,
  - 6) EU ~~002 066 100~~ and
  - 7) EU ~~002 901 001~~for all the goods and services on which the opposition is based, and
3. the costs are to be borne by the opponent.

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### Important considerations: EUTMR

#### *Article 105*

#### **Continuation of proceedings**

1. An applicant for or proprietor of an EU trade mark or any other party to proceedings before the Office who has omitted to observe a time limit vis-à-vis the Office may, upon request, obtain the continuation of proceedings, provided that at the time the request is made the omitted act has been carried out.



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Thank you

<b>Presentation</b>	Limitations, withdrawals and Proof of Use requests in a separate document		
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1.0	16/03/2018	CS	Final version