

# Mastering *Inter Partes* Proceedings: Expert Tips for Filing Documents

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30 April 2024

## EXPECTATIONS **VS** REALITY



## EXPECTATIONS **VS** REALITY



## EXPECTATIONS **VS** REALITY



## EXPECTATIONS VS REALITY



**+1200**

## EXPECTATIONS **VS** REALITY

Deficiencies cause:



## EXPECTATIONS **VS** REALITY

Deficiencies cause:

 **Loss of time**



## EXPECTATIONS **VS** REALITY

### Deficiencies cause:

 Loss of time

 **Stress**





## EXPECTATIONS **VS** REALITY

### Deficiencies cause:

 Loss of time

 Stress

 Refusal



## EXPECTATIONS VS REALITY



## PROGRAMME

**45'**  
**Presentation**

- Data carriers
- Annexes on Data Carriers
- Encrypted files
- User Area
- Art. 55 EUTMDR
- Static PDFs
- Decision on costs
- Additional sources of practical information

**10'**  
**Questions and answers**



# 1 Data Carriers

## DATA CARRIERS



**DECISION No EX-22-7 of the Executive Director of the Office of 29 November 2022 on technical specifications for annexes submitted on data carriers**

Entered into force on **1 February 2023**

## DATA CARRIERS



## DATA CARRIERS

 **NOT  
ACCEPTED**



## DATA CARRIERS





## DATA CARRIERS

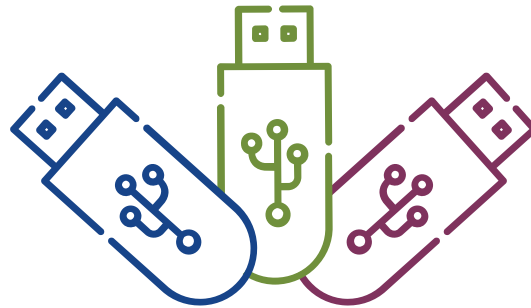


# ACCEPTED



## DATA CARRIERS - Art. 64(2) EUTMDR

Where a communication with annexes is submitted in accordance with Article 63(1)(b) by a party to proceedings involving more than one party, the party shall submit **as many copies** of the annexes **as there are parties** to the proceedings.



2

# Annexes on Data Carriers



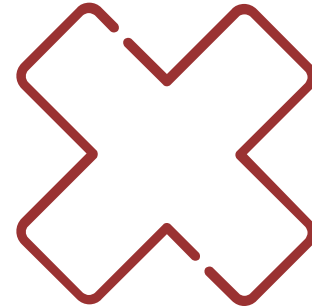
## ANNEXES ON DATA CARRIERS

- Graphic representation
- Sound files
- Video files
- 3D models
- TIFF files
- Standard static PDF files



## ANNEXES ON DATA CARRIERS

- Encrypted or compressed files
- Graphic representation in JPG progressive image
- PDF files that include added objects, added text or redacted



## ANNEXES ON DATA CARRIERS - Graphic representations

Graphic representations, images and photographs

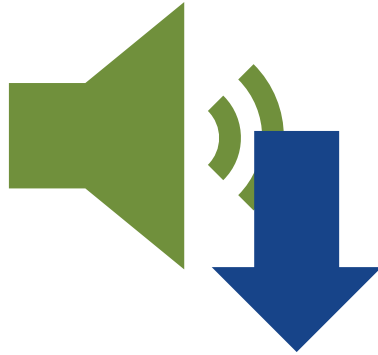
**JPEG**



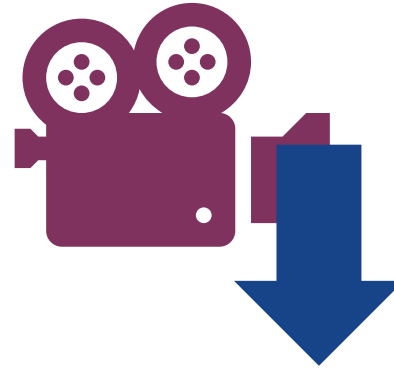
## ANNEXES ON DATA CARRIERS - Sound and video

Sound files & video files

**MP3**



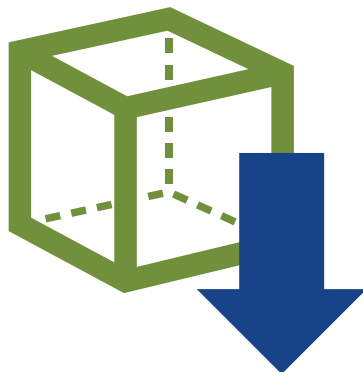
**MP4**



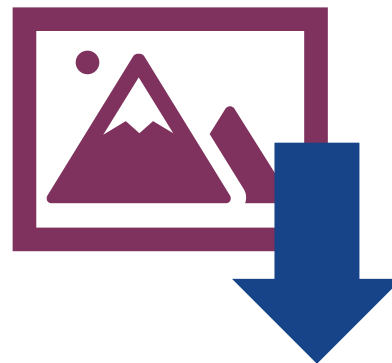
## ANNEXES ON DATA CARRIERS - Graphic representations

3D models & TIFF files

**STL/OBJ/X3D**



**TIFF**





## ANNEXES ON DATA CARRIERS - Others

Static and standard PDF files



## ANNEXES ON DATA CARRIERS - Others

Static and standard PDF files



# QUESTION



Can you send a **Word file** / an  
**Excel file** as part of your  
documents for submission?



 **NO**



## ANNEXES ON DATA CARRIERS - Non compliance





**Illegible** (the file is corrupted **and complies** with specification) → the Office asks to resubmit



**Illegible** (the file is corrupted and does **not comply** with specification) → deemed not filed



## ANNEXES ON DATA CARRIERS - Keeping the files

-  **If exceeds 1 GB**, the Office does not need to upload the data carrier to electronic files
-  **If uploaded in electronic file**, the data carrier is disposed after 5 years



# 3 Encrypted files





# QUESTION



## What is the practice of the Office when we receive USB that is encrypted?

- A. **examiners decrypt files** with the password that is given by the party together with the USB
- B. **examiners send a deficiency letter** asking for the USB to be send again but not being encrypted this time
- C. **examiners send a letter that USB will not be taken into account**



**Not ACCEPTED**  
**No deficiencies sent**



# 4 User area



## USER AREA



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

Annex I: Conditions of use of the User Area

Entered into force on **16 December 2023**

## ACCESS TO USER AREA

- EUIPO account
- Series of e-operations and e-actions
- Filing a joint request in certain *inter partes* proceedings



## ACCEPTED FILE TYPES - Graphic representations

Graphic representations, images and photographs

**JPEG**



20 characters.jpeg

## ACCEPTED FILE TYPES - Sound

Sound files

**MP3**



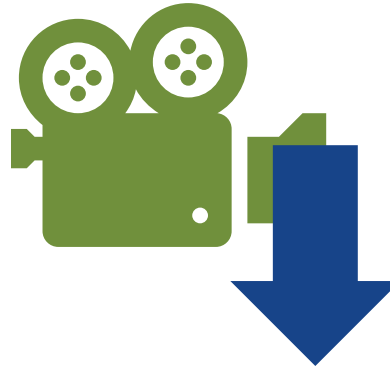
20 characters.mp3



## ACCEPTED FILE TYPES - Video

Video files

**MP4**



20 characters.mp4

## ACCEPTED FILE TYPES - PDF

Static and standard PDF files



20 characters.pdf

# QUESTION



Can you submit

**Annex1\_Stanislava\_Stoyanova.jpeg**

as part of your proof of use submission?



 **NO**

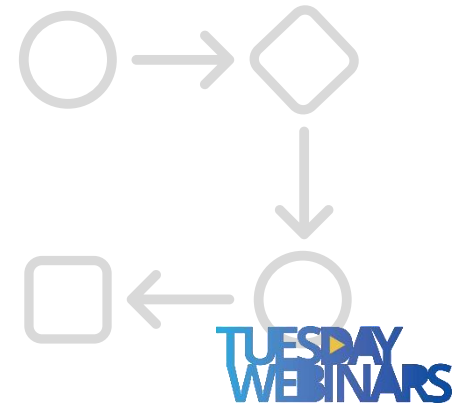


5

# Art. 55 EUTMDR

## ART 55(2) EUTMDR

The documents or other items of evidence shall be contained in annexes to a submission which shall be **numbered consecutively**.



## ART 55(2) EUTMDR

The submission shall include an index indicating, for each document or item of evidence annexed:

- a) the **number of the annex;**





## ART 55(2) EUTMDR

The submission shall include an index indicating, for each document or item of evidence annexed:

- a) the **number of the annex**;
- b) a **short description** of the document or item and, if applicable, the **number of pages**;



## ART 55(2) EUTMDR

The submission shall include an index indicating, for each document or item of evidence annexed:

- a) the **number of the annex**;
- b) a **short description** of the document or item and, if applicable, the **number of pages**;
- c) the **page number** of the submission where the document or item is mentioned.



## ART 55(2) EUTMDR

The submitting party may also indicate, in the index of annexes, **which specific parts** of a document it relies upon in support of its arguments.



## ART 55(2) EUTMDR – When it applies?

- Proof of use
- Further facts, evidence and arguments
- Applicant's observations
- Notice of opposition

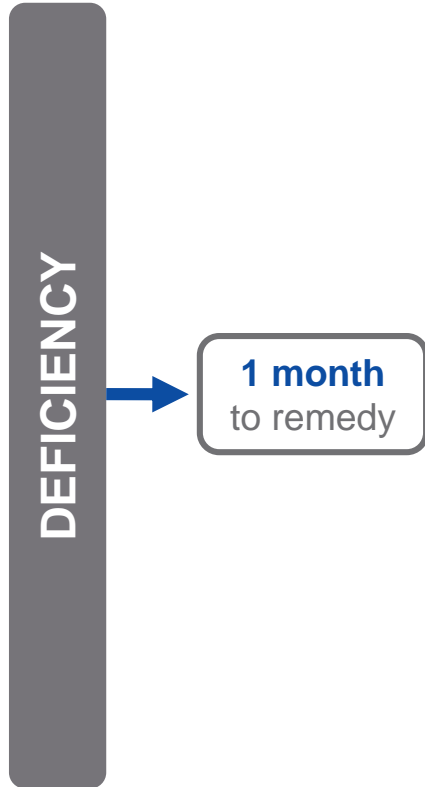
...other



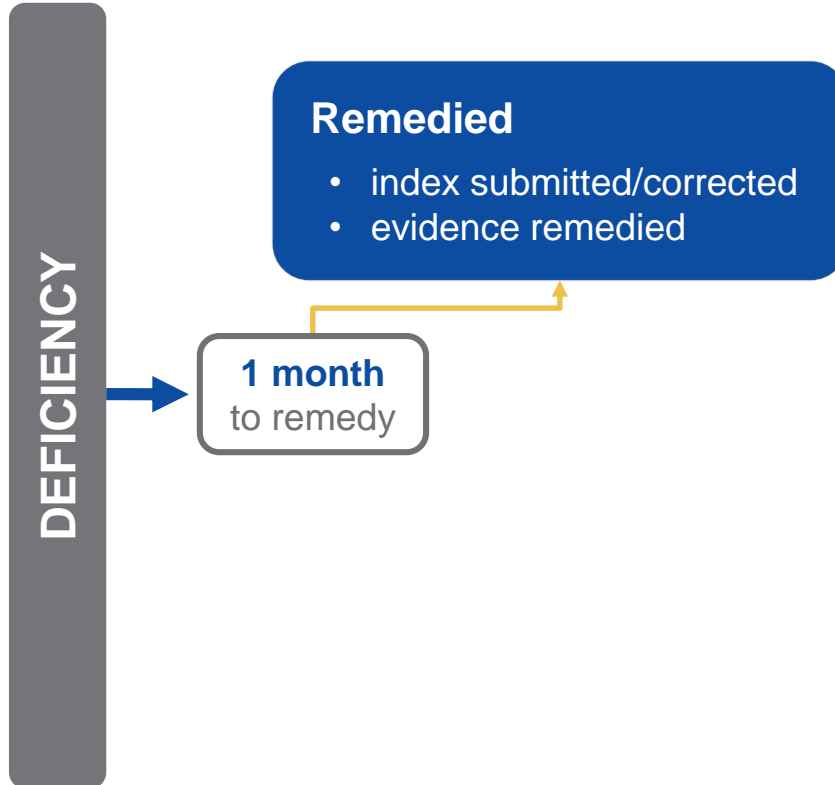
## ART 55(2) EUTMDR – How do we handle deficiencies?

DEFICIENCY

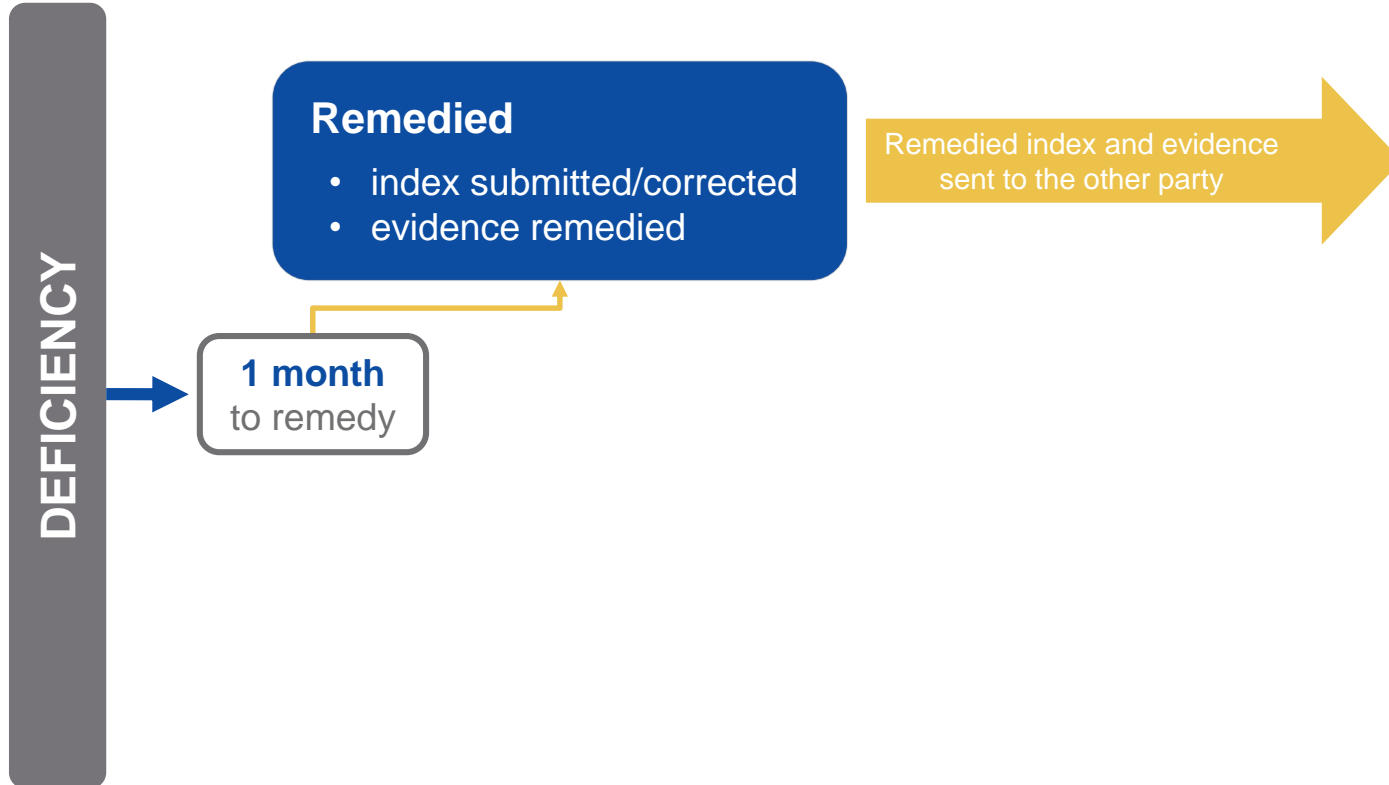
## ART 55(2) EUTMDR – How do we handle deficiencies?



## ART 55(2) EUTMDR – How do we handle deficiencies?

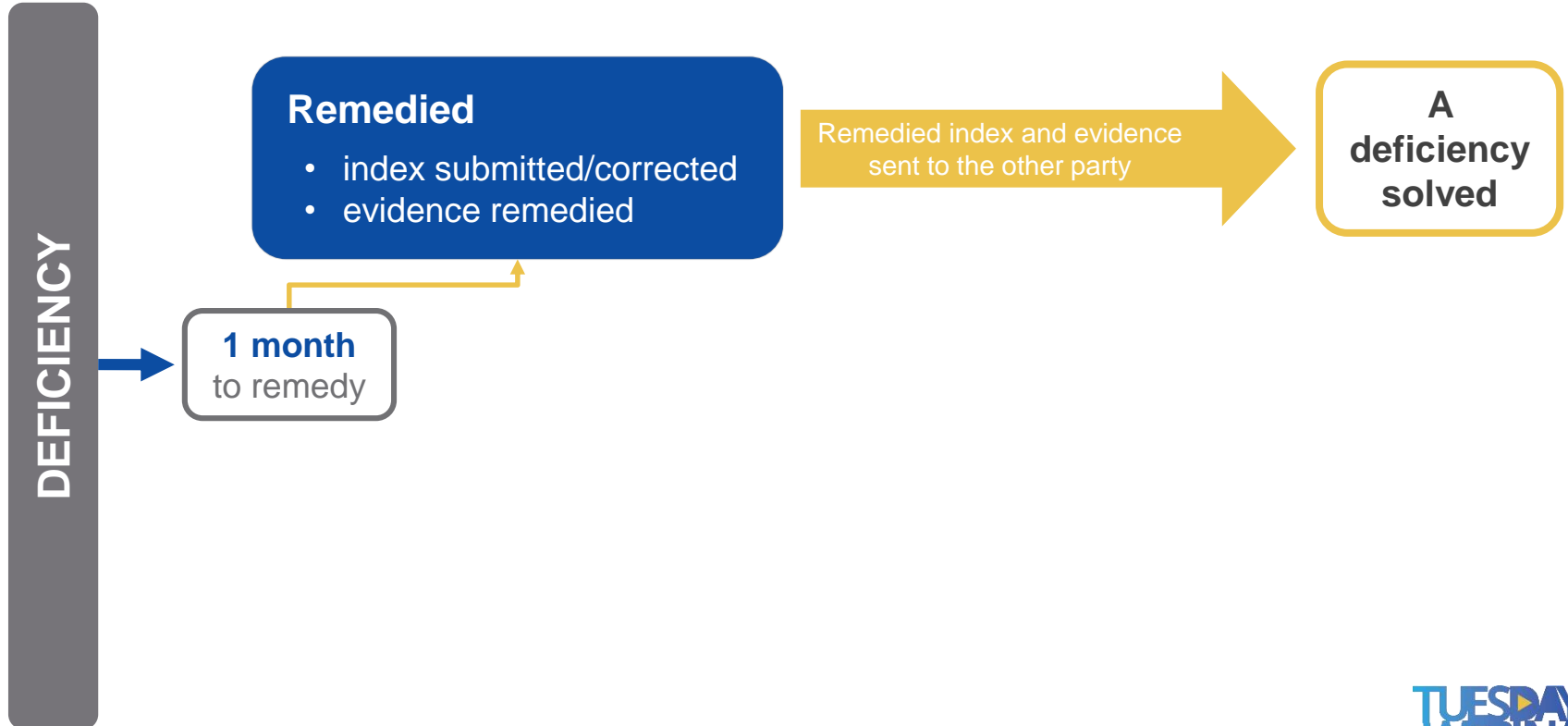


## ART 55(2) EUTMDR – How do we handle deficiencies?

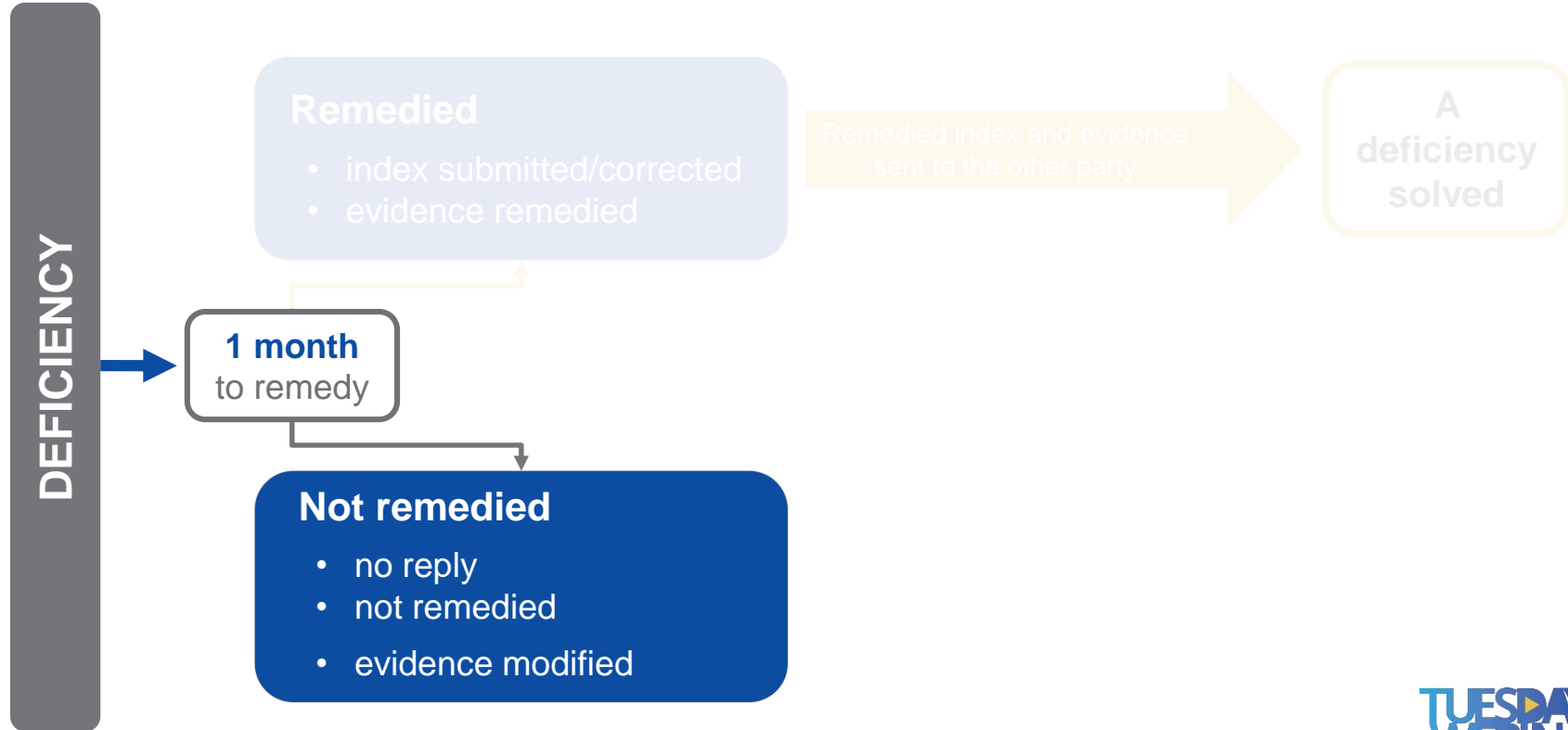




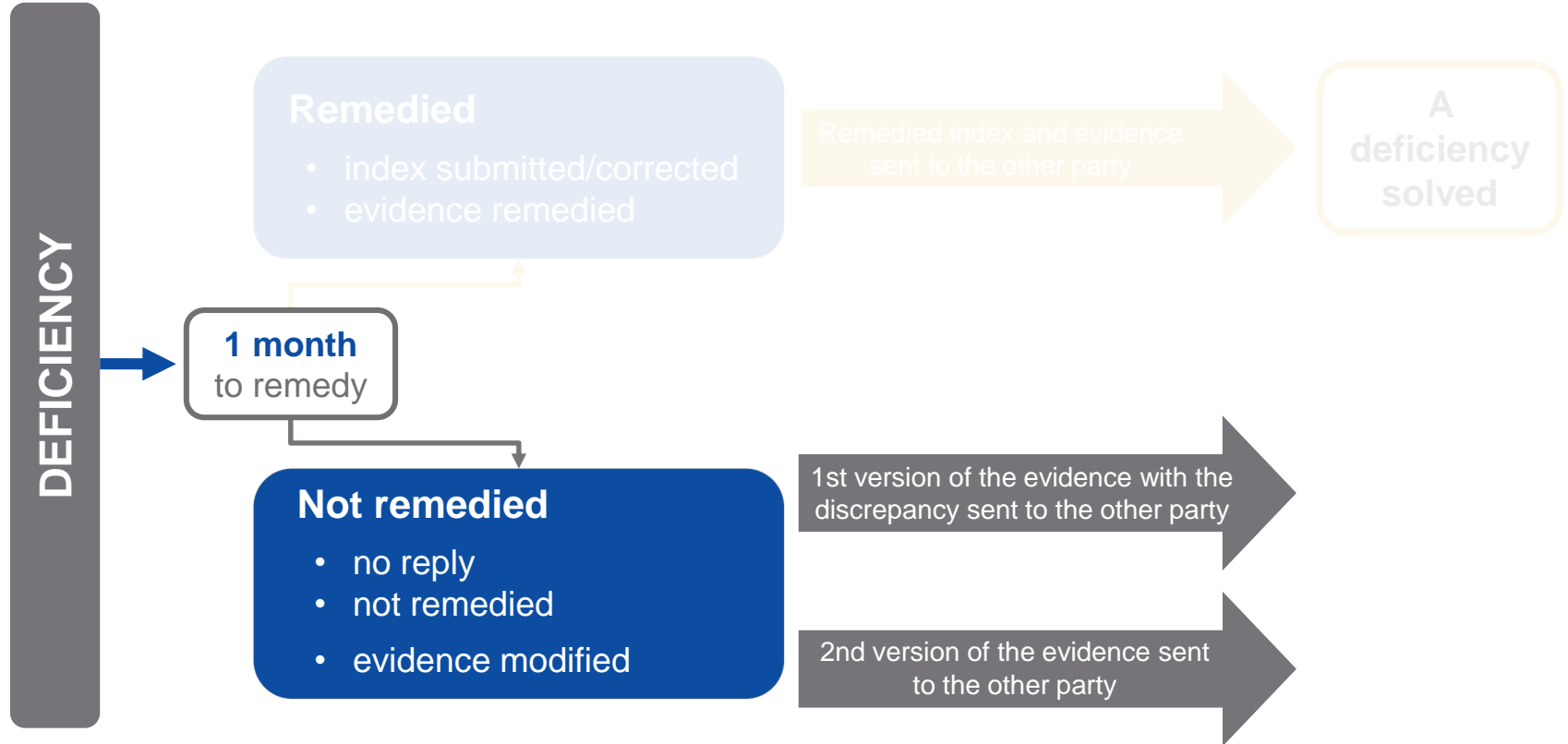
## ART 55(2) EUTMDR – How do we handle deficiencies?



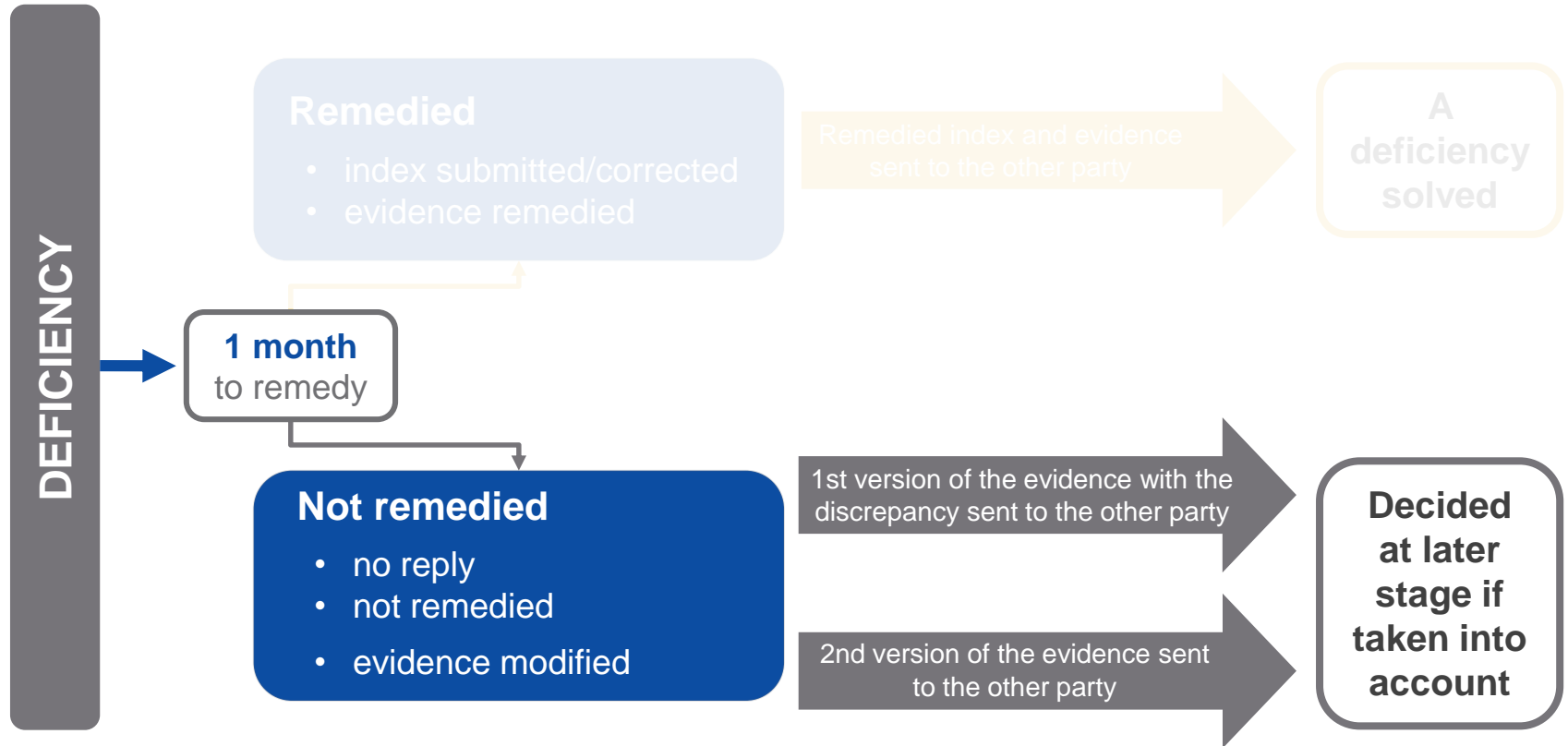
## ART 55(2) EUTMDR – How do we handle deficiencies?



## ART 55(2) EUTMDR – How do we handle deficiencies?



## ART 55(2) EUTMDR – How do we handle deficiencies?



## ART 55(2) EUTMDR – Model index

MODEL INDEX			
Documents and items submitted physically, electronically or using a data carrier			
Annex No	Description of the Annex <sup>(1)</sup>	No of pages <sup>(2)</sup>	Page number (of the submission in question) where the document or item is mentioned
1.	Letter of 10/12/2017, from Mr Green to Ms Smith	3	p. 2
2.	25 invoices, Jan. 2017–Jun. 2018, NewCo Ltd	60	pp. 7-11, 13, 14
3.	40 invoices, Jan. 2016–Jun. 2018, ABC Ltd	50	pp. 15-17
4.	Affidavit of 24/08/2018, from Ms Green, CEO of NewCo Ltd	1	pp. 17-211, 23, 24
5.	Article by Dr Blue published 12/12/2017 in GO magazine 4/2017: <i>Confusing brand X with Y</i> , addressing the inherent distinctiveness of brand X on p. 12 <sup>(3)</sup>	23	pp. 30, 32
6.	Printout of 01/01/2019 of webpage <a href="http://www.webpage1.com">www.webpage1.com</a>	5	p. 41
7.	Video showing (at running time 00:07:42) use of EUTM X No 123 456 789 at the <i>Exhibition of Consumer Products 2018</i> (file 'vid1.mp4' submitted on a USB flash drive)	n/a	p. 45

Example: Index

## ART 55(2) EUTMDR – Model index



EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE  
Opposition action manager

Annexes to the submission						
Number	Type	Title	Size	Pages	Confidential	
1	application/pdf	Exhibit A.pdf	4137271	22		
<b>Description</b>						
Product Catalogue 2023						
<b>Reference to the submission</b>						
10						
<b>Reason of the confidentiality</b>						
Number	Type	Title	Size	Pages	Confidential	
2	application/pdf	Exhibit B.PDF	9959	1		
<b>Description</b>						
Invoice to Bv Mister B dated 26 January 2009						
<b>Reference to the submission</b>						
10						
<b>Reason of the confidentiality</b>						
Number	Type	Title	Size	Pages	Confidential	
3	application/pdf	Exhibit C.pdf	12133530	24		
<b>Description</b>						
Opponent's Social Media Pages						
<b>Reference to the submission</b>						
10						
<b>Reason of the confidentiality</b>						
Number	Type	Title	Size	Pages	Confidential	
4	application/pdf	Exhibit D.pdf	2131096	6		
<b>Description</b>						
Opponent's Websites and Products						
<b>Reference to the submission</b>						
10						
<b>Reason of the confidentiality</b>						

Index available on User Area

## ART 55(2) EUTMDR – Annexes numbered consecutively

Number of the annex **inserted** or **handwritten** on the page

Welcome to our new website. Help us to improve it by giving us feedback.

### 1 Examination period

When you have filed your European Union trade mark application, we will process it to check that it can first be published and later, if nothing prevents it, registered.

[What happens during the examination period →](#)

### 2 Opposition period

When your trade mark application is published, the 3-month opposition period starts. This means that anyone who has an earlier right that they believe conflicts with your trade mark application can object to it being registered.

[What happens during the opposition period →](#)

### 3 Registration

If your application is published and nobody files an opposition (or the opposition is rejected), your trade mark will be registered and the registration will be published. This is done so that other trade mark owners and the public in general are aware that this particular trade mark is registered and that it is yours.

[Proof of registration →](#)

### 4 Appeal

If your trade mark application is rejected, you can file an appeal. You must file your notice of appeal within 2 months of the date of the rejection decision. Your appeal must include a statement of the grounds on which you base your appeal. If you're not quite ready to submit the statement of grounds with the appeal notice, don't worry. You have up to 4 months after the rejection decision to file the statement.

Annex no.2

Before applying ^

How to apply ^

Examination

Opposition

Registration

Appeal

Looking after your rights

Strategy

Manage my application

Misleading invoices

Apply for your  
trade mark **fast  
and easy**

[Apply now →](#)

Annex no. 1

## ART 55(2) EUTMDR – Annexes numbered consecutively

Number of the annex **inserted** or **handwritten** on the page



Annex no.2

Before applying

How to apply

- Examination
- Opposition
- Registration
- Appeal
- Looking after your rights
- Strategy
- Manage my application
- Misleading invoices

Apply for your  
trade mark **fast  
and easy**

Apply now →

Discover IP ▾ Trade marks ▾ Designs ▾ Manage IP ▾ Enforce IP ▾ The Office ▾

Welcome to our new website. Help us to improve it by giving us feedback.

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Annex no. 1

Separate sheet inserted  
between the annexes  
with the annex No.



# 6 Static PDFs



# NON-STATIC PDFS



24.4.2018

EN

Official Journal of the European Union

Annex 1

L 104/1

II

(Non-legislative acts)

## REGULATIONS

COMMISSION DELEGATED REGULATION (EU) 2018/625

of 5 March 2018

supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430

THE EUROPEAN COMMISSION,

Having regard to the Treaty on the Functioning of the European Union,

*Arkadiusz Makar*

Having regard to Regulation (EU) 2017/1001 of the European Parliament and [redacted] on the European Union trade mark (1), and in particular Article 48, Article 49(3), Article 65, Article 73, Article 96(4), Article 97(6), Article 98(5), Article 100(2), [redacted] Article 106(3), Article 121, Article 168, Article 194(3) and Article 196(4) thereof,

**APPROVED**

4 comments

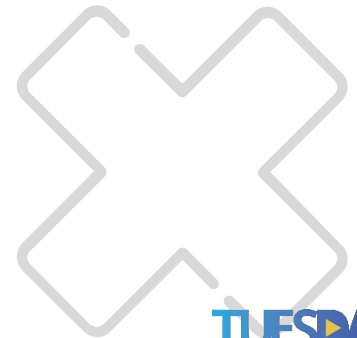
PAGE 1

- M [redacted] 16:58  
Main legal act regarding trade marks in EU
- M [redacted] 16:57  
Applied Stamp
- M [redacted] 16:55  
Highlighted Text
- M [redacted] 16:59  
Pencil

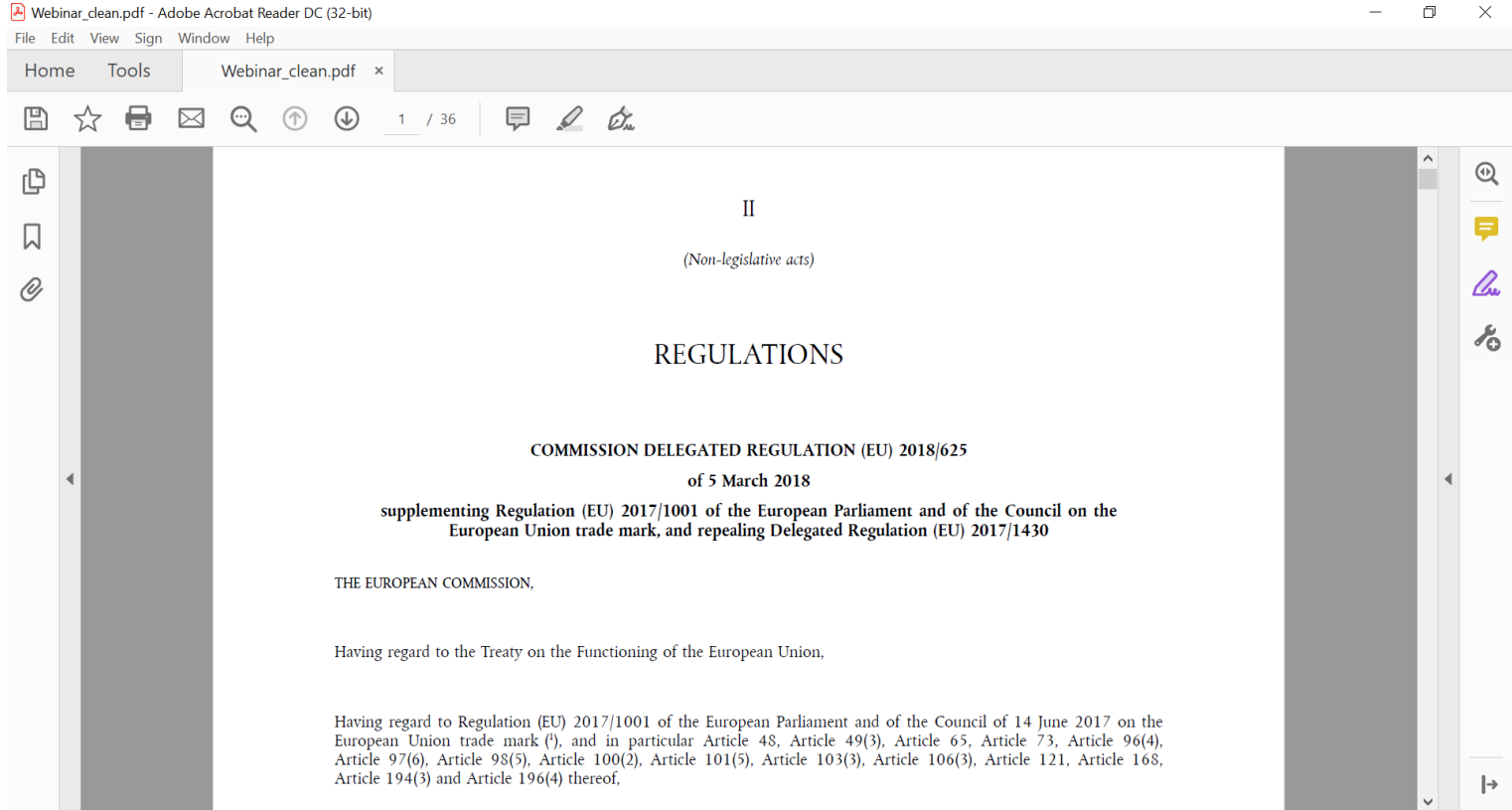
## NON-STATIC PDFS – Consequences



Non-static PDFs are **NOT ACCEPTED.**



## MAKE PDF STATIC – Practical tip



Webinar\_clean.pdf - Adobe Acrobat Reader DC (32-bit)

File Edit View Sign Window Help

Home Tools Webinar\_clean.pdf x

1 / 36

II

(Non-legislative acts)

REGULATIONS

COMMISSION DELEGATED REGULATION (EU) 2018/625

of 5 March 2018

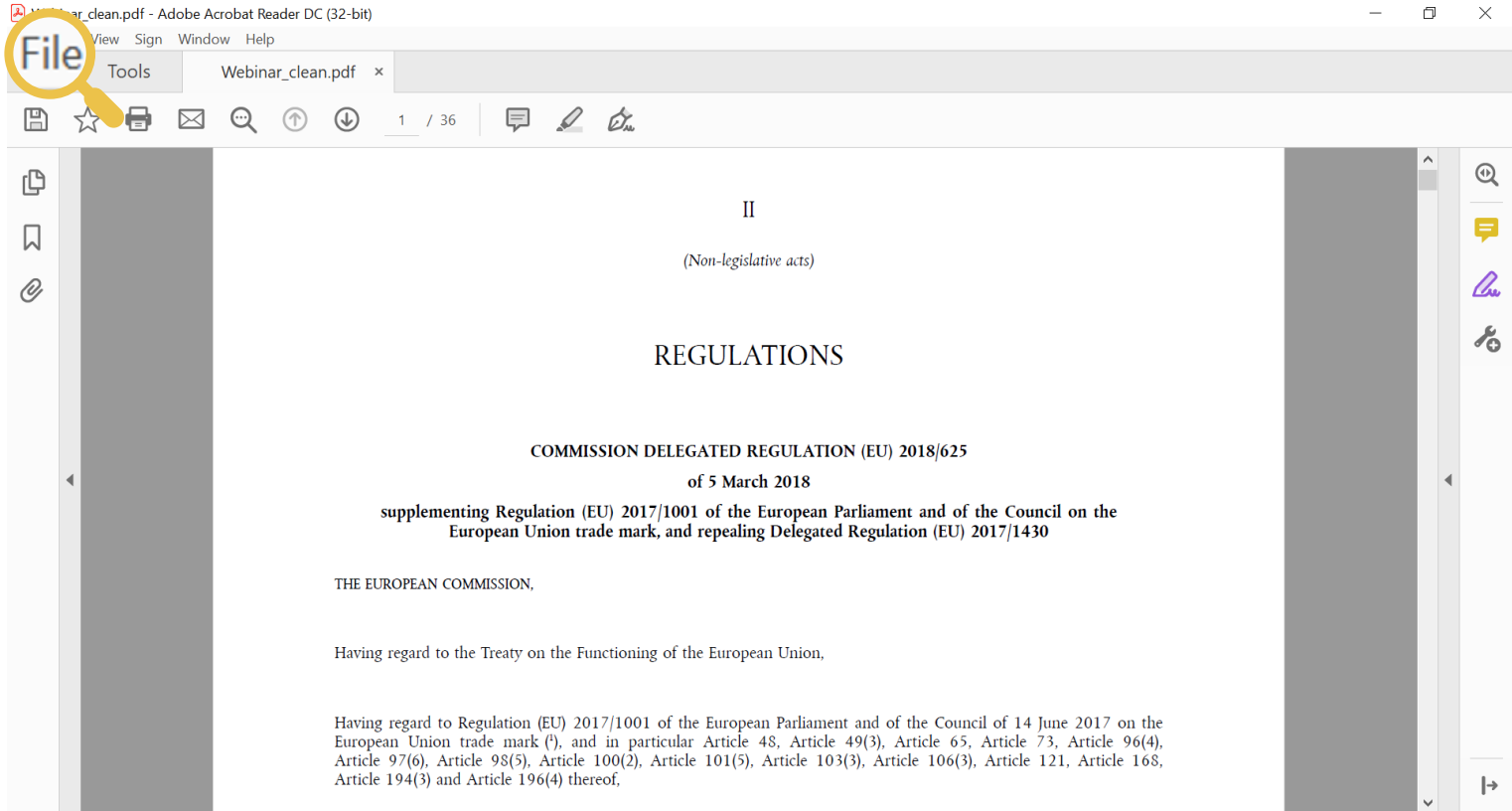
supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430

THE EUROPEAN COMMISSION,

Having regard to the Treaty on the Functioning of the European Union,

Having regard to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark <sup>(1)</sup>, and in particular Article 48, Article 49(3), Article 65, Article 73, Article 96(4), Article 97(6), Article 98(5), Article 100(2), Article 101(5), Article 103(3), Article 106(3), Article 121, Article 168, Article 194(3) and Article 196(4) thereof,

## MAKE PDF STATIC – Practical tip



Webinar\_clean.pdf - Adobe Acrobat Reader DC (32-bit)

File View Sign Window Help

Tools Webinar\_clean.pdf x

1 / 36

II  
(Non-legislative acts)

REGULATIONS

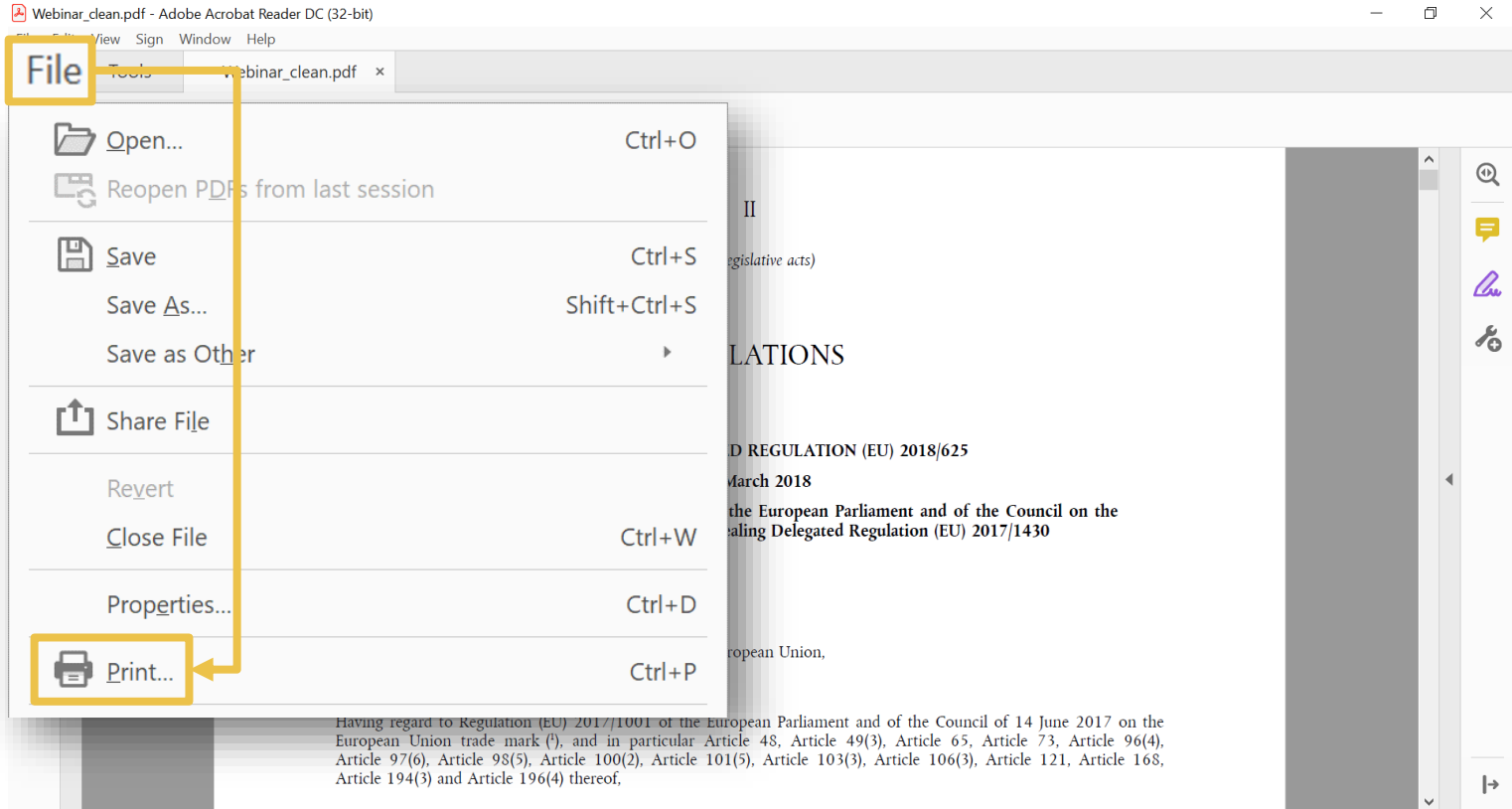
COMMISSION DELEGATED REGULATION (EU) 2018/625  
of 5 March 2018  
supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the  
European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430

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Having regard to the Treaty on the Functioning of the European Union,

Having regard to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the  
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Article 97(6), Article 98(5), Article 100(2), Article 101(5), Article 103(3), Article 106(3), Article 121, Article 168,  
Article 194(3) and Article 196(4) thereof,

## MAKE PDF STATIC – Practical tip

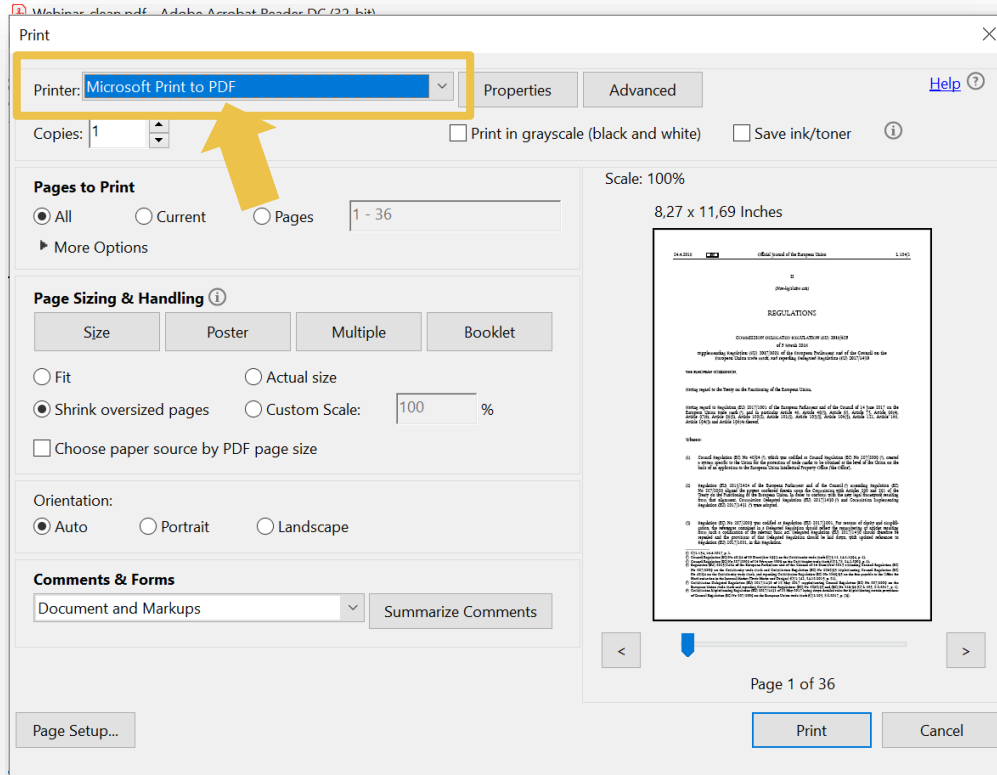


The screenshot shows the Adobe Acrobat Reader DC interface. The 'File' menu is open, and the 'Print...' option is highlighted with a yellow box. A yellow arrow points from the 'File' menu title to the 'Print...' option. The background shows a PDF document with the following text:

II  
legislative acts)  
LATIONS  
D REGULATION (EU) 2018/625  
March 2018  
the European Parliament and of the Council on the  
dealing Delegated Regulation (EU) 2017/1430  
European Union,

Having regard to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (1), and in particular Article 48, Article 49(3), Article 65, Article 73, Article 96(4), Article 97(6), Article 98(5), Article 100(2), Article 101(5), Article 103(3), Article 106(3), Article 121, Article 168, Article 194(3) and Article 196(4) thereof,

## MAKE PDF STATIC – Practical tip



Print

Printer: **Microsoft Print to PDF** Properties Advanced Help

Copies: 1  Print in grayscale (black and white)  Save ink/toner

**Pages to Print**

All  Current  Pages 1 - 36

More Options

**Page Sizing & Handling**

Size Poster Multiple Booklet

Fit  Actual size

Shrink oversized pages  Custom Scale: 100 %

Choose paper source by PDF page size

**Orientation:**

Auto  Portrait  Landscape

**Comments & Forms**

Document and Markups Summarize Comments

Page Setup... Print Cancel

Council on the  
7/1430

f 14 June 2017 on the  
Article 73, Article 96(4),  
Article 121, Article 168,



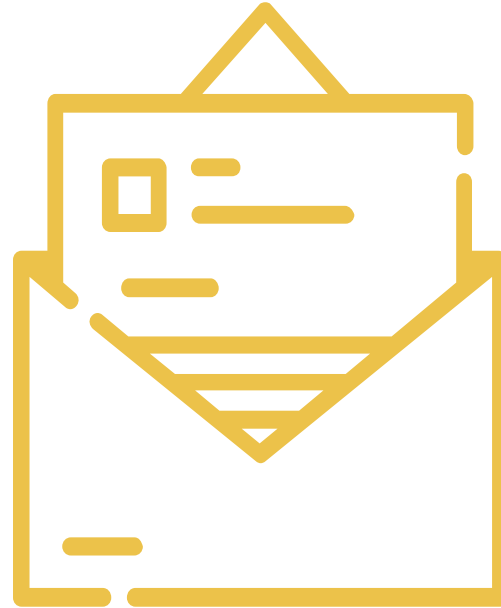
# 7 Decision on costs



## DECISION ON COSTS



## DECISION ON COSTS



# QUESTION



If the **opponent withdraws** the opposition during the adversarial part without attaching the agreement or the confirmation of the other party that **they have reached a settlement**, will the Office need to issue a decision on costs?







## DECISION ON COSTS

### Request

*I hereby request the EUIPO to withdraw the above referenced opposition (after the commencement of the adversarial part of the proceedings).*

### Request details

Decision on costs requested

## DECISION ON COSTS

### Request

*I hereby request the EUIPO to withdraw the above referenced opposition (after the commencement of the adversarial part of the proceedings).*

### Request details

Decision on costs requested



**AGREEMENT / CONFIRMATION**

## DECISION ON COSTS

- File on hold
- Other party contacted
- ≠ Prolongs the proceeding
- ≠ Party does not come back / decision issued





8

# Additional tips and sources of practical information

## CONFIDENTIALITY - 114(4) EUTMR

(...) parts of the file which the party concerned **showed a special interest** in keeping confidential before the request for inspection of the files was made, unless inspection of such parts of the file is justified by overriding, legitimate interests of the party seeking inspection, may be withheld from inspection.



## CONFIDENTIALITY – Request

### Confidential Request

*I hereby submit facts, evidence and arguments in support of the opposition.*



#### Request details

eo.fg.am.pm.lp.12

#### Documents (FFEA) in support of the opposition

Attachment 1	Part 1.pdf (132 pages) *Confidential*
Attachment 2	Part 2.pdf (29 pages) *Confidential*
Attachment 3	Part 3.pdf (64 pages) *Confidential*
Attachment 4	Part 4.pdf (49 pages) *Confidential*

## BACK UPS

-  After hours **emergency phone**  
(Monday to Friday: 18:30-23:59)
-  Communication **back up**



## SOURCES

Entrepreneurs **IP professionals**

[Discover IP](#) ▾

[Protect IP](#) ▾

[Manage IP](#) ▾

[Enforce IP](#) ▾

[News & events](#)

[The Office](#) ▾

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## SOURCES

Entrepreneurs **IP professionals**

Discover IP ▾

**Protect IP** ▾

Manage IP ▾

Enforce IP ▾

News & events

The Office ▾

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# Guidelines

The EUIPO's current trade mark and design practice is reflected in a series of Guidelines for Examination that are intended to help both our users and our staff in charge of the various procedures.



# SOURCES

Entrepreneurs IP professionals

Accessibility

Discover IP

Protect IP

Manage IP

Enforce IP

News & events

The Office



Login

Welcome to our new website. Help us to improve it by giving us feedback.

## Law

The law related to EU trade mark and community design registration.



Law > Communications & decisions of the ED



Law overview



**Communications & decisions of  
the Executive Director**




### Communications & decisions of the executive director

The decisions and communications of the Executive Director of the European Union Intellectual Property Office (EUIPO) on issues concerned with Office activities.

# SOURCES

Entrepreneurs | **IP professionals**

Accessibility | 

Discover IP ▾

**Protect IP ▾**

Manage IP ▾

Enforce IP ▾

News & events

The Office ▾



Login



## The Office

### Governance & cooperation

EUIPO governing bodies, MBBC. Cooperation with IP Offices in EU and international organisations providing tools, services and common practices

### Observatory

On Infringements of Intellectual Property Rights is a network of experts and specialist stakeholders

### Boards of Appeal

Responsible for deciding on appeals against first instance decisions taken by EUIPO

### Help centre / support

Find the answers to all your questions on trade marks, designs and our online services

### About us

We are responsible for managing the EU trade mark and the registered Community design





## EXPECTATIONS **VS** REALITY



**Master filing documents:**

## EXPECTATIONS **VS** REALITY



**Master filing documents:**

 **Time gains**

## EXPECTATIONS **VS** REALITY



### Master filing documents:



Time gains



Less stress

## EXPECTATIONS **VS** REALITY



### Master filing documents:



Time gains



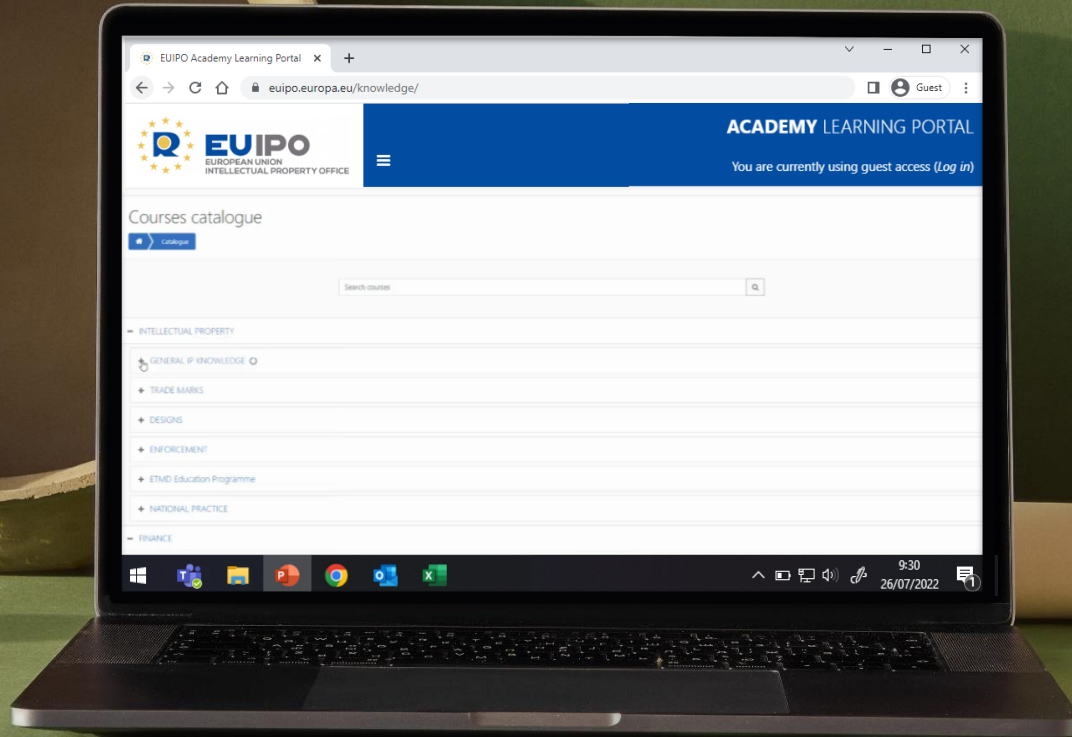
Less stress



Success



## Keep in touch with EUIPO Academy





**EUIPO**

EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE

[www.euipo.europa.eu](http://www.euipo.europa.eu)

 [@EU\\_IPO](https://twitter.com/EU_IPO)

 [EUIPO](https://www.linkedin.com/company/euipo)

 [EUIPO.EU](https://www.facebook.com/EUIPO.EU)

**THANK YOU**



**Petra CHARUZOVÁ**  
Operations Department, EUIPO

**Stanislava STOYANOVA-  
ATANASOVA**  
Operations Department , EUIPO

