

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

1 General Remarks

1.1 Use of the form

The form may be obtained free of charge from the EUIPO and downloaded from its website (<http://www.euipo.europa.eu>). It may also be copied freely.

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

Where such electronically generated forms are used, attachments can 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 six pages to identify the earlier rights upon which the application is based, if it is established on relative grounds. Particulars on the applicant, their representative, the challenged European Union 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 in the first page. The grounds for the application must be indicated in the second page. 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 about 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 European Union trade mark has been registered.

For any further information, contact the EUIPO on the following telephone number:

+34 965139100

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1.2 Sending forms

Completed applications, as well as any other submissions, (e.g. observations or evidence) should be sent to the following address:

European Union Intellectual Property Office
Receiving Unit
Avenida de Europa, 4
E-03008 Alicante, Spain

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

+34 965131344

Where communications are sent by fax, confirmation copies are unnecessary and not recommended. The EUIPO will request further information should the communication sent by fax prove to be insufficient.

2 The form, first page

The applicant for a declaration of invalidity must indicate the total number of pages in the application at the top of the first page, including any continuation sheets and attachments (explanation of the grounds, evidence, authorisation, etc.) and their 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 EUIPO, it is sufficient to indicate that ID number and their name. Otherwise, the applicant must be identified by indicating their name together with their address and nationality. The applicant must also indicate their legal status.

2.2 Representative

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

The representative must indicate their name together with their ID number attributed by the EUIPO. Where such an ID number is unavailable, the appropriate information relating to the existing/newly appointed representative must be given in the application form.

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Representation before the EUIPO may be exercised by professional representatives, which fall into one of the two following categories:

- legal practitioners qualified in a Member State of the European Economic Area, who are entitled to act in that same country, as representatives in trade mark matters, and who have their place of business in the European Union;
- or professional representatives entered on the list maintained by the EUIPO. These professionals, entered on the list for European Union trade mark matters, may also 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 issues.

The applicant for a declaration of invalidity may also act through an employee. Where an employee is appointed, their name must be indicated in the 'representative' box. Employees of legal entities with their domicile or principal place of business, a real and effective industrial or commercial establishment within the European Union 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 Union. 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 EUIPO will communicate with the professional representative if appointed.

Filing an authorisation for the representative or an employee of the applicant is not required.

2.3 Challenged European Union trade mark, language of the application and extent of the application

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

Language: The application for a declaration of invalidity should preferably be filed in either the first language of the challenged EUTM provided that this is one of the five languages of the EUIPO (English, French, German, Italian or Spanish), or in the second language of the challenged EUTM, which is necessarily a language of the EUIPO. The application for a declaration of invalidity may also be filed in any other of the five languages of the EUIPO, provided that a translation of the application for a declaration of invalidity into the first language (if a language of the EUIPO) or the second language of the challenged EUTM 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 European Union trade mark is registered, there must be an express

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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 application's fee is EUR 630, regardless of the number of grounds invoked. The application is not deemed to have been filed until the fee has been received by the EUIPO. The applicant for a declaration of invalidity has to choose one of the payment options by ticking the corresponding box.

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

- debiting a current account held with the EUIPO, indicating the number of that account;
- making a transfer, in euro, to one of the EUIPO's bank accounts, indicating the invalidity applicant's name, address and reference number, the type of fee to which the payment refers and the date on which the transfer was made.

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

European Union Intellectual Property Office
Finance Department
Avenida de Europa, 4
E-03008 Alicante, Spain
Telephone: +34 965139340
Fax: +34 965139113

Transfers should be made to one of the following EUIPO bank accounts:

Banco Bilbao Vizcaya Argentaria
0182-5596-90-009222222 — Swift code (BIC): BBVAESMM XXX
IBAN: ES88 0182 5596 9000 9222 2222

La Caixa
2100-2353-01-0700000888 — 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 signatory's name 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) EUTMR. Only in the case of relative grounds must details of the earlier rights be provided. To this end pages three to eight 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. Furthermore, the applicant must give arguments explaining the significance of the facts and evidence to the alleged invalidity of the challenged European Union trade mark.

4 The form, pages three to eight

4.1 Trade mark registrations and applications

The following details must be provided for trade mark registrations and applications:

- the type of mark (EUTM, national, or international registration indicating the Member States where it has effect) (see paragraph 4.7);
- data on the registration and/or application;
- a representation of the mark (see paragraph 4.8);
- 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 also give:

- data on the territory where the mark has a reputation and for which goods or services it has a reputation.

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The applicant must also attach a document giving proof of the earlier mark's existence, 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 (Article 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 paragraph 4.7);
- a representation of the mark (see paragraph 4.8);
- 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 earlier mark's existence, 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 paragraph 4.8);
- 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 EUTM 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 the company name, trade name etc.;
- an indication of the entitlement;
- the territory/Member State(s) where the trade mark or sign is used in the course of trade (see paragraph 4.7);
- the geographical scope of the sign;
- a representation of the sign (see paragraph 4.8);

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- the goods, services or activities for which the sign is used;
- an explanation of grounds.

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 Protected designation of origin or geographical indication (PDO/PGI)

For protected designations of origin or geographical indications the applicant must indicate:

- the nature of the right (protected designation of origin or geographical Indication),
- an indication of the entitlement
- territory / Member State(s) where it is protected (see 4.7)
- furnish a representation of the PDO or PGI (see 4.8)
- the goods for which the PDO or PGI is protected.
- an explanation of grounds

The applicant for a declaration of invalidity must also attach evidence of the existence and validity of the earlier right, entitlement to file the opposition, evidence of the applicable law and the scope of protection of the earlier right *vis-à-vis* preventing use of later trade marks. If necessary a translation of the evidence must be provided.

4.6 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 right's geographical scope (see paragraph 4.7)
- a representation/indication of the right (see paragraph 4.8)
- an explanation of grounds.

The applicant must also attach evidence of entitlement, evidence of the time of acquisition of the right, and 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.

4.7 Country codes

<input type="checkbox"/> AT Austria	<input type="checkbox"/> ES Spain	<input type="checkbox"/> NL Netherlands
<input type="checkbox"/> BE Belgium	<input type="checkbox"/> FR France	<input type="checkbox"/> PL Poland
<input type="checkbox"/> BG Bulgaria	<input type="checkbox"/> HR Croatia	<input type="checkbox"/> PT Portugal
<input type="checkbox"/> CZ Czech Republic	<input type="checkbox"/> IT Italy	<input type="checkbox"/> RO Romania
<input type="checkbox"/> DK Denmark	<input type="checkbox"/> CY Cyprus	<input type="checkbox"/> SI Slovenia
<input type="checkbox"/> DE Germany	<input type="checkbox"/> LV Latvia	<input type="checkbox"/> SK Slovakia
<input type="checkbox"/> EM European Union	<input type="checkbox"/> LT Lithuania	<input type="checkbox"/> FI Finland
<input type="checkbox"/> EE Estonia	<input type="checkbox"/> LU Luxembourg	<input type="checkbox"/> SE Sweden
<input type="checkbox"/> IE Ireland	<input type="checkbox"/> HU Hungary	<input type="checkbox"/> UK United Kingdom
<input type="checkbox"/> EL Greece	<input type="checkbox"/> MT Malta	

4.8 Representation of the right

For rights of a verbal nature (including marks, signs and PDOs or PGIs in words), the right can simply be typed in.

For rights other than those of a verbal nature, they can be imported into the application in two ways. If you have Adobe Acrobat Writer, the mark's representation 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 right on a separate sheet.