

The Executive Director

DECISION No EX-17-3 of the Executive Director of the Office of 18 September 2017 concerning the formal requirements of a priority claim for a European Union trade mark or a seniority claim for a European Union trade mark or a designation of the European Union under the Madrid Protocol (consolidated version)

The Executive Director of the European Union Intellectual Property Office (the Office),

Having regard to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark¹, and in particular to Article 143(1), Article 153(1)(h), Article 153(2) and Article 157(4)(n) thereof,

Having regard to Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 (EUTMIR)²,

Whereas:

- (1) Articles 35(3), 39(7), 191(2) and 192(3) EUTMR provide that the Executive Director may determine that the documentation to be provided by the applicant in support of the priority or seniority claim may consist of less than what is required in Articles 4, 6 and Article 32(1)(f) EUTMIR, provided that the information is available to the Office from other sources.
- (2) The information required to be contained in a priority document referred to in Article 35(1) EUTMR, namely the country, the file number, the filing date of the previous application, the name of the applicant or proprietor, the representation of the mark and the list of goods and services, can be available on the internet websites of some of the central industrial property offices of States party to the Paris Convention for the Protection of Industrial Property or to the Agreement establishing the World Trade Organization.
- (3) The information required to be contained in a seniority document referred to in Articles 39(2), 40(2), 191(2) and 192(3) and (6) EUTMR, namely the Member State or Member States in or for which the earlier mark is registered, the date of filing, registration and, where applicable, of priority, the number of the earlier registration, the name of the proprietor of the earlier registration, the representation of the trade mark and the indication of the goods and services for which the earlier mark is registered, can be available on the internet websites of the central industrial property offices of the Member States in which the mark is registered or, concerning international registrations with effects in a Member State, on the internet website of the International Bureau of the World Intellectual Property Organization (International Bureau).

¹ OJ L 154, 16.6.2017, p. 1.

² OJ L 104, 24.4.2018, pages 37-56.

- (4) If this is the case, the Office will be in a position to access and verify this information of its own motion.
- (5) If the required information is not available on such a website, the applicant or proprietor of the European Union trade mark remains under the obligation to submit a copy of the document referred to in Articles 35(1), 39(2) and 40(2) EUTMR and the holder of the international trade mark designating the European Union remains under the obligation to submit a copy of the document referred to in Articles 191(2) and 192(3) EUTMR.
- (6) Article 4(2) EUTMIR confers discretionary powers on the Office on whether or not to require the applicant to provide a translation where the language of the previous application for which priority is claimed is not one of the languages of the Office.
- (7) The applicant itself is in a position to verify, before claiming priority or seniority, the availability online and the accuracy of the required information and to assess the corresponding need to submit or not a priority or seniority document,

HAS ADOPTED THE FOLLOWING DECISION:

Article 1

Substitution of priority documents by information available online

The evidence to be provided by the applicant in support of a priority claim may consist of less than what is required under Article 4(1) EUTMIR, provided that the information required is available to the Office from other sources, such as the website of a central industrial property office of a State party to the Paris Convention for the Protection of Industrial Property or to the Agreement establishing the World Trade Organization.

Article 2

Procedure

- (1) Where priority is claimed, and where the documents referred to in Article 35(1) EUTMR have not already been submitted by the applicant, the Office will verify of its own motion whether the required information on the country, the file number, the filing date of the previous application, the name of the applicant or proprietor, the representation of the mark and the list of goods and services of the earlier trade mark the priority of which is claimed is available on the website of the central industrial property office of the State in or for which that earlier trade mark application is claimed to have been filed.
- (2) Where the required information is available on such a website in any of the languages of the European Union, the Office will make a note to this effect in the file of the European Union trade mark application. Otherwise, the Office will request the applicant to remedy the deficiency pursuant to Article 41(2) EUTMR by submitting documents in support of the claim.

Article 3
Priority documents

To the extent that the applicant submits or is required to submit evidence in support of the priority claim, the documentation shall consist of either a copy of the previous application or an extract of the bulletin where the earlier mark was published or a printout of a database extracting data from the competent central industrial property office. The document submitted must contain the indication of the country, the file number, the filing date of the previous application, the name of the applicant or proprietor, the representation of the mark and the list of goods and services. Where the mark in the previous application is represented in colour(s), the priority document shall also contain a representation of the mark in colour(s). If the previous application does not contain a representation of the mark in colour but only an indication of colour(s) or a colour claim, the priority document shall contain the same indications.

Article 4
Translations

If the priority documents submitted or the priority information referred to in Article 2 is not in one of the languages of the European Union, the applicant must submit, within a period specified by the Office, a translation into the first or second language of the application.

Article 5
Substitution of seniority documents by information available online

The evidence to be provided by the applicant when claiming seniority may consist of less than what is required under Article 6 EUTMIR and Article 32(1)(f) EUTMIR, provided that the information required is available to the Office from other sources, such as the website of a central industrial property office of a Member State in or for which the mark is registered or, concerning international registrations with effects in a Member State, on the website of the International Bureau.

Article 6
Procedure

- (1) Where seniority is claimed, and where the documents referred to in Articles 39(2), 40(2), 191(2) and 192(3) EUTMR have not already been submitted, the Office will verify of its own motion whether the required information on the date of filing, registration and, where applicable, of priority of the earlier trade mark, the number of the earlier registration, the name of the proprietor of the earlier registration, the representation of the trade mark and the indication of the goods and services for which the earlier mark is registered is available on the website of the central industrial property office of the Member State in or for which that earlier trade mark is claimed to be registered or, concerning international registrations with effects in a Member State, on the website of the International Bureau.
- (2) Where the required information is available on such a website, the Office will make a note to this effect in the file of the trade mark application or registration. Otherwise, the Office will request the applicant to remedy the deficiency pursuant

to Articles 40(3), 41(2), 191(4) and 192(4) EUTMR by submitting the documents in support of the claim referred to in Articles 39(2), 40(2), 191(2) and 192(3) EUTMR.

Article 7
Seniority documents

To the extent that the applicant or holder submits or is required to submit evidence in support of the seniority claim, the documentation shall consist of a copy of the earlier registration or an extract of the bulletin where the earlier mark was published or a printout of a database extracting data from the competent central industrial property office. The document submitted must contain the date of filing, registration and, where applicable, of priority of the earlier trade mark, the number of the earlier registration, the name of the proprietor of the earlier registration, the representation of the trade mark and the indication of the goods and services for which the earlier mark is registered. Where the mark in the earlier registration is represented in colour(s), the seniority document shall also contain a representation of the mark in colour(s). If the earlier registration does not contain a representation of the mark in colour but only an indication of colour(s) or a colour claim, the seniority document will contain the same indications.

Article 8
Repeal

The following decisions are repealed:

Decision No EX-05-5 of 1 June 2005 concerning the evidence to be provided when claiming priority and seniority;

Decision No EX-03-5 of 20 January 2003 concerning the formal requirements of a priority or seniority claim.

Article 9
Entry into force

This decision will enter into force on 1 October 2017 and will be published in the Official Journal of the Office.

Done at Alicante, 18 September 2017

António Campinos
Executive Director