EUIPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

The Executive Director

DECISION No EX-25-03 on the adoption of the Guidelines for Examination of Registered European Union Designs at the European Union Intellectual Property Office

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 on the European Union trade mark (EUTMR) in particular Article 157(4)(a) thereof, and to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs amended by Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002 (EUDR), in particular Article 100 thereof,

After consultation with the Management Board in accordance with Article 153(1)(l) EUTMR,

HAS ADOPTED THE FOLLOWING DECISION:

Article 1
Adoption of the Guidelines

The following sections of the 'Guidelines for Examination of Registered European Union Designs at the European Union Intellectual Property Office' (Guidelines for Examination), which are annexed to this decision, are hereby adopted:

Introduction

Editor's note and general introduction

Examination of applications for registered European Union designs

Examination of design invalidity applications

Part A: General rules
Section 1: Means of communication, time limits
Section 2: General principles to be respected in the proceedings
Section 3: Payment of fees, costs and charges
Section 4: Language of proceedings
Section 5: Parties to the proceedings and professional representation
Section 7: Revision
Section 8: *Restitutio in Integrum*
Section 9: Enlargement
Section 10: Evidence

Part B: Examination
Section 4: Absolute grounds for refusal

Part E: Register operations
Section 3: EUTMs and REUDs as objects of property
Section 4: Renewal
Section 5: Inspection of files
Section 6: Other entries in the register

Article 2
Repeal

1. The following sections of the Guidelines for Examination, as referred to in Article 1 of Decision No EX-24-2 of the Executive Director of the Office of 28 March 2024 on the adoption of the Guidelines for Examination, are repealed:

Introduction

Editor's note and general introduction

Those sections of Parts A, B and E listed in Article 1 above.

2. The following sections of the Guidelines for Examination, as referred to in Article 1 of Decision No EX-23-2 of the Executive Director of the Office of 24 March 2023 on the adoption of the Guidelines for Examination are repealed:

Examination of applications for registered Community designs

Examination of design invalidity applications.

Article 3
Entry into force

This decision will be published in the Official Journal of the Office and will enter into force on 01 May 2025.

Done at Alicante, 30 April 2025.

João Negrão
Executive Director

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GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

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- *Examination of applications for registered European Union designs*
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GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

1 Introduction

The Office's current trade mark and design practice is reflected in a series of Guidelines that are intended to be of practical use both to Office staff in charge of the various procedures and to users of the Office's services.

The Office issues a revision of the Guidelines regularly. See the Guidelines, Editor's Note and General Introduction, paragraph 3, for further information about the revision process of the Office's Guidelines.

The Office's Guidelines are the main point of reference for users of the European Union trade mark system and the European Union design system, and for professional advisers who want to ensure they have the latest information on our examination practices.

They have been drawn up to reflect our Office practice in the most frequent scenarios. They contain general instructions, which have to be adapted to the particularities of a case.

Therefore, the Office's Guidelines are not legal acts, but self-imposed rules of conduct adopted by an administrative decision.

The Guidelines on EU trade marks and the Guidelines on registered EU designs that are currently in force were adopted by the Executive Director on 30/04/2025 (Decision No EX-25-3), and entered into force on 01/05/2025.

The Office's Guidelines can be accessed in the five working languages of the Office (English, French, German, Italian and Spanish), through either a clean or a track-changed version. In the online version of the Guidelines, the track-changed version is visible via the 'show modification' function, which highlights the changes made compared to the previously adopted edition of the Guidelines.

Track-changed versions of new editions of the Office's Guidelines will also be translated and made available online in the other eighteen EU languages after they became available in the five working languages of the Office.

For previous editions of the Guidelines, please visit the Repository .

GUIDELINES FOR EXAMINATION OF REGISTERED EUROPEAN UNION DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Examination of applications for registered European Union designs

1 Introduction

1.1 Purpose of the Guidelines

The Guidelines explain how, in practice, the provisions of the European Union design regulation ([1]) (EUDR) and the European Union design implementing regulation ([2]) (EUDIR) are applied by the Office's Operations Department from receipt of an application for a registered European Union design (REUD) up to its registration and publication.

The Office has no competence with regard to **unregistered** European Union designs.

The purpose of the Guidelines is to ensure consistency among the decisions taken by the Operations Department and to ensure a coherent practice in file handling. These Guidelines are merely a set of consolidated rules setting out the line of conduct that the Office itself proposes to adopt, which means that, to the extent that those rules comply with the legal provisions of a higher authority, they constitute a self-imposed restriction on the Office, in that it must comply with the rules that it has itself laid down. However, these Guidelines cannot derogate from the EUDR or the EUDIR, and it is solely in the light of those regulations that they should be interpreted and applied.

The Guidelines are structured to follow the sequence of the examination process, with each section and subsection constituting a step in the registration proceedings from receipt of the application up to registration and publication. The general principles (see paragraph 1.2 below) should be kept in mind throughout the whole examination process (see the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings).

1.2 General principles

1.2.1 Duty to state reasons

The decisions of the Office must state the reasons on which they are based (Article 62 EUDR). The reasoning must be logical and it must not lead to internal inconsistencies.

1 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs amended by Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002.

2 Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs amended by Commission Implementing Regulation (EU) 2025/73 of 17 January 2025 amending Regulation (EC) No 2245/2002 implementing Council Regulation (EC) No 6/2002 on Community designs.

The Office will apply the principles as explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 1, Adequate reasoning.

1.2.2 Right to be heard

The decisions of the Office will be based only on reasons or evidence on which the applicant has had an opportunity to present its comments (Article 62 EUDR, second sentence).

The Office will apply the principles as explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 2, The right to be heard.

1.2.3 Compliance with time limits

Applicants must respond to the Office's communications within the time limits set by those communications.

The Office will apply the principles explained in the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

Any written submission or document that has not been received within the time limits set by the Office is late. The same applies to supplementary materials attached only to the confirmation copy of a letter that was itself sent on time, where this confirmation mail arrives after the expiry of the time limit. This is irrespective of whether such materials are specifically mentioned in the initial letter.

The Office may disregard facts or evidence that the applicant does not submit in due time (Article 63(2) EUDR).

For calculation of time limits see Article 56 EUDIR.

An applicant's request to extend a time limit has to be made before expiry of that time limit (Article 57(1) EUDIR).

As a general rule, a first request to extend a time limit will be granted. Further extensions will not be granted automatically. Reasons in support of any further request for extension must be submitted to the Office. The request for extension of the time limit must indicate the reasons why the **applicant** cannot meet the deadline. Obstacles faced by the parties' **representatives** do not justify an extension (05/03/2009, C-90/08 P, Corpo livre, EU:C:2009:135, § 20-23).

The extension cannot result in a time limit that is longer than 6 months (Article 57(1) EUDIR). The applicant is informed of any decision on the granting or otherwise of the extension.

Applicants failing to observe the time limits run the risk that their observations may be disregarded, which may result in a loss of rights. In such a case, the applicant may file a request for *restitutio in integrum* (Article 67 EUDR; see also the Guidelines, Part A,

General Rules, Section 8, *Restitutio in Integrum*). However, applicants are reminded that, unlike in the case of European Union trade marks, the EUDR does not provide for the possibility of requesting a continuation of proceedings.

1.2.4 Scope of the examination carried out by the Office

When examining an application for a European Union design, the Office will examine the facts of its own motion (Article 63(1) EUDR).

The examination procedure is kept to a minimum, which means it is mainly an examination of the formalities. However, the following grounds for non-registrability set out in Article 47 EUDR must be examined *ex officio* by the Office:

1. whether the subject matter of the application corresponds to the definition of a design as set forth in Article 3(1) EUDR; and
2. whether the design is contrary to public policy or accepted principles of morality.

Where one of these two grounds is applicable, the procedure explained in paragraph 4 will apply. Other protection requirements are not examined by the Office.

A European Union design that has been registered in breach of the protection requirements referred to in Articles 3 to 9 EUDR is liable to be invalidated if an interested party files a request for a declaration of invalidity (Article 25(1) EUDR) (see the Guidelines, Examination of design invalidity applications).

1.2.5 User-friendliness

One of the fundamental objectives of the EUDR is that the registration of European Union designs should present the minimum cost and difficulty to applicants, so as to make it readily available to any applicant, including small and medium-sized enterprises and individual designers.

To that end, examiners are encouraged to contact the applicant or, if a representative has been appointed (see paragraph 2.5 below), its representative, by telephone, to clarify issues arising from the examination of an application for a European Union design, either before or after an official deficiency letter is sent.

2 Filing an Application with the Office

2.1 Introduction

There are two ways of applying for registration of a European Union design, that is, (i) either via direct filing with the Office (Article 35 EUDR) or (ii) by filing an international registration with the International Bureau of the World Intellectual Property Organization and designating the European Union (Article 106a EUDR).

Applications filed after 01/05/2025 through national offices (Member State intellectual property offices or the Benelux Office for Intellectual Property (BOIP)) are no longer accepted.

This section will deal with direct filings. The examination of the formalities relating to international registrations designating the European Union will be explained in paragraph 12 below.

2.2 Form of the application

2.2.1 Different means of filing

An application for a registered European Union design may be filed directly with the Office by e-filing, post or personal delivery.

By virtue of Article 67(2) EUDIR, the decision of the Executive Director on communication by electronic means lays down that the accepted means of electronic communication with the Office in **procedures relating to EU designs** is the User Area, which is a secure electronic communications platform maintained by the Office. The User Area enables users to submit applications and other documents, receive notifications and documents sent by the Office, reply to these notifications and perform other actions.

Filing via the User Area is the strongly recommended means of filing since it can guarantee accurate quality of the design representation, and the system gives guidance to the applicant, thus reducing the number of potential deficiencies and speeding up the examination procedure.

Where a technical malfunction prevents an applicant from filing through the User Area, an EU design application can be submitted by one of the alternative electronic back-up measures set out in Decision No EX-23-13 of the Executive Director (see below) on condition that the applicant resubmits, within three working days of the original submission, the application for registration of an EU design (with the same content) through the User Area, together with the confirmation of receipt clearly identifying the original submission. Failure to comply with these conditions will result in the original submission being deemed as not having been received.

To facilitate resubmission in the event of a malfunction during the electronic transmission of an application, communication or other document through the specific e-operation or e-filing in the User Area, the Office will make two electronic back-up alternatives available:

1. an upload solution located in the Communications section of the User Area; this is a general upload platform that allows documents to be attached and sent to the Office;
2. a file-sharing solution outside the User Area; the Office will provide the account holder with access to a secure file-sharing location where the document(s) in question can be uploaded.

Technical details on the accessibility and functionality of both back-up alternatives are available in the Conditions of Use of the User Area.

For filings other than e-filing, use of the form provided by the Office (Article 68(1)(a) EUDIR) is not mandatory but is recommended (Article 68(6) EUDIR) in order to facilitate the processing of the application and avoid errors.

Fax is expressly identified as a means of communication in all procedures relating to European Union designs in Article 47(2)(d) EUDIR and Article 51 EUDIR, however pursuant to Article 2 of Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means, due to technical limitations and malfunctions affecting the reliability and uninterrupted functioning of communications by fax that lie beyond the Office's control, **fax can no longer be offered and will no longer be used**, as a means of communication in procedures before the Office.

2.2.2 e-Filing

A registered European Union design can be filed via the Office's website (https://www.euipo.europa.eu/en/designs/how-to-apply/apply-now), which also allows for the accelerated procedure (Fast Track) (see paragraph 2.7.1).

Where a communication is sent to the Office by electronic means, the indication of the sender's name will be deemed to be equivalent to the signature (see paragraph 6.1.4).

2.2.3 Applications sent by post or personal delivery

Applications can be sent by ordinary post or private delivery service to the Office at the following address:

European Union Intellectual Property Office

Avenida de Europa, 4

03008 Alicante

SPAIN

Applications can also be handed in personally at the Office's reception. See Decision No EX-18-5 of the Executive Director of the Office of 3 September 2018 concerning the hours the Office is open to receive submissions by personal delivery relating to registered European Union designs, for further information.

2.3 Content of the application

2.3.1 Minimum requirements

The application must satisfy all the mandatory requirements set out in Articles 36(4) and 37(2) EUDR and Articles 1 (Content of the application), 3 (Classification and indication of products), 4 (Representation of the design) EUDIR.

The application must be signed by the applicant. The name of the signatory must be indicated and the authority of the signatory must be specified (see paragraph 6.1.3).

2.3.2 Additional requirements

Additional requirements apply where the applicant selects one of the following options: a multiple application is filed (Article 37 EUDR and Article 2 EUDIR), a priority or an exhibition priority is claimed (Articles 8 and 9 EUDIR), or where the applicant chooses to be, or must be, represented (Article 77 EUDR).

2.3.3 WIPO DAS

As of 11/07/2020, the Office is a participating office in the World Intellectual Property Organization Digital Access Service (WIPO DAS), which is an electronic system allowing priority documents and similar documents to be securely exchanged between participating IP offices.

The system enables applicants and offices to meet the requirements of the Paris Convention for the certification of priority documents, allowing them to be exchanged in an electronic environment.

Using the EUIPO as **Office of First Filing**, when filing their application electronically (see paragraph 2.2.2 above) applicants may request that their application be registered in the WIPO DAS system. The Office will register the application in WIPO DAS by providing the mandatory data elements in the registration request, including:

- IP type,
- priority office code,
- priority application number,
- priority application filing date,
- access code.

By checking the box to request the inclusion of the application in WIPO DAS, the applicant will automatically receive the access code, which they can then cite when claiming priority from the application in subsequent filings before other offices party to the WIPO DAS system.

2.4 Language of the application

The application may be filed in any of the official languages of the European Union (language of filing, or first language) (Article 98(1) EUDR; Article 1(1)(h) EUDIR).

In addition to the language of filing, the applicant must indicate a second language, which must be a language of the Office, that is to say, English (EN), French (FR), German (DE), Italian (IT) or Spanish (ES). The second language must be different from the language of filing. The second language serves as a potential language for invalidity proceedings. The choice of first and second language cannot be changed once filed.

If the language that the applicant has selected as the first language is one of the five Office languages, then this will be used as the correspondence language.

Only where the language selected as the first language is not one of the five Office languages can the applicant indicate that they want the correspondence language to be the second language. This request can be made on the application form by ticking the relevant box or can be requested later, either by explicit request, or implicitly by sending a communication to the Office in the second language.

This language regime applies throughout the application procedure until registration.

As the choice of languages also affects the determination of the language in invalidity proceedings after the registration, applicants are advised to note that the language regime for designs is not identical to the language regime for the European Union trade mark (see the Guidelines, Examination of design invalidity applications, paragraph 3.3).

2.5 Representatives

Where the applicant does not have its domicile or its principal place of business or a real and effective industrial or commercial establishment within the European Economic Area, it must be represented by a representative in all proceedings before the Office other than in filing an application.

The representative must be indicated in the application. If this requirement is not complied with, the applicant will be requested to appoint a representative within 2 months. Where the applicant does not comply with the request, the application is rejected as inadmissible (Article 77(2) EUDR; Article 10(3)(a) EUDIR).

For more information on representation, please refer to the Guidelines, Part A, General Rules, Section 5, Parties to the proceedings and professional representation.

2.6 Date of receipt, file number and issue of receipt

The date of receipt is the date on which the application reaches the Office. This date will not coincide with the 'date of filing' where the requirements for such a date to be allocated are not met (see paragraph 3).

For registered European Union design applications filed through the Office's User Area (e-filing), the system immediately issues an automatic electronic filing receipt, which contains the date of receipt and the file number. The applicant should keep hold of this receipt.

Where the application is sent by post or personal delivery, the applicant will not receive the confirmation of receipt or file number until the Office issues its first communication (see paragraph 2.7).

For further information on communications to the Office, see the Guidelines, Part A, General Rules, Section 1, Means of communication, time limits.

2.7 Registration or examination report

2.7.1 Registration

If the application for a European Union design satisfies all requirements for registration, it will normally be registered within **10 working days**.

However, even if an application complies with all requirements, it may be delayed if the products in which the design is intended to be incorporated, or to which it is intended to be applied, were not indicated by reference to the list of products included in DesignClass (see paragraph 6.1.5.2), the product indication database on the EUIPO website. In such a case, the indication of the products may have to be sent for translation into the official languages of the European Union (see paragraph 6.1.5.4).

An application complying with all registration requirements can be registered within **2 working days** if the following conditions for the accelerated procedure (Fast Track) are met (for possible modifications of these conditions please consult the EUIPO website):

- the application is filed electronically (e-filing) using the four-step form;
- both the indication of product(s) and its/their classification are made using DesignClass (see paragraph 6.1.5.4);
- priority documents, where a priority is claimed, are already available in WIPO DAS and are identified by a WIPO DAS code, or are included with the e-filing application (not required when the earlier filing is with the Office);
- no exhibition priority is claimed;
- the representative, if any, is registered in the EUIPO database and indicates the respective identification number in the form;

- fees are debited from a current account with the Office or paid by credit card.

2.7.2 Examination report and informal communication on possible deficiencies (preliminary examination report)

Where a deficiency has been detected in the application, the examiner will issue an examination report summarising the irregularities noted and giving a time limit for the applicant to remedy them.

Before sending such an examination report, the examiner can send an informal communication, called a 'preliminary examination report', highlighting some potential deficiencies and aimed at speeding up the examination procedure. This informal communication informs the applicant that the examination procedure is pending due to any of the following circumstances.

2.7.2.1 Priority claims and supporting documents

As of 12/09/2020, the Office is a participating office in WIPO DAS, which is an electronic system allowing priority documents and similar documents to be securely exchanged between participating IP offices.

The system enables applicants and offices to meet the requirements of the Paris Convention for the certification of priority documents, allowing them to be exchanged in an electronic environment.

Where the application claims the priority of one or more previous applications registered in WIPO DAS, the applicant must provide the relevant details, namely, the file number, filing date and country of the previous application together with the WIPO DAS access code in the pertinent fields in the application form, or within 3 months of either the filing date or the priority claim. This then allows the Office to access and download those priority documents as the **Office of Second Filing**.

Where the application claims the priority of one or more previous applications that are not available in WIPO DAS by providing the relevant details but without submitting a copy, or where it claims priority from an exhibition without submitting an exhibition certificate, the applicant may still submit a copy of the previous application within 3 months of the filing date (Articles 42 and 44 EUDR; Articles 8(1) and 9(1) EUDIR; see paragraph 6.2.1.1).

In such circumstances, the examiner will inform the applicant that examination of the application will be put on hold until the missing copy of the previous application(s) or exhibition certificate is submitted. Examination will proceed **3 months** after the filing date unless a copy of the previous application(s) or exhibition certificate (see paragraph 6.2.1.2), or a declaration that the priority claim is withdrawn, is received earlier.

2.7.2.2 Priority claims made subsequent to filing

The priority of one or more previous applications or of an exhibition may still be claimed within 1 month of the filing date, by submitting the declaration of priority, stating the file number, date and country of the previous application (Article 42 EUDR; Article 8(2) EUDIR; see paragraph 6.2.1.1 below), or the name of the exhibition and the date of first disclosure of the product (Article 44 EUDR; Article 9(2) EUDIR; see paragraph 6.2.1.2 below), and by providing the WIPO DAS access code where available (Decision No EX-20-7 of the Executive Director of the EUIPO of 11 September 2020 on the formal requirements of priority claims relating to registered European Union designs; see paragraph 6.2.1.1 below).

Where the applicant states in the application its intention to claim such priority, the examiner will inform the applicant that the examination of the application will be put on hold until the missing information is submitted. The examination will proceed **1 month** after the filing date, unless a declaration of priority, or a declaration that the priority claim is withdrawn, is received earlier.

Where the applicant does not state its intention to claim priority, the examination of the application will proceed as normal. Any priority claims received within 1 month of the filing date will be examined upon receipt, even if this is after registration. However, the Office will not issue a new registration certificate including a priority claimed after registration; instead, applicants may obtain an extract from the Register with updated data including the priority (see paragraph 10.3 below).

2.7.2.3 Multiple applications and requests for partial deferment

For filings other than e-filings, where a multiple application contains a request for deferment for **some** designs (see paragraph 6.2.5), the examiner will send the applicant a summary of the application containing a representation of the first view of each design to be published without delay. The applicant will be requested to confirm the correctness of this summary within 1 month. In the absence of any reply or in the event of contrary instructions from the applicant, the examination will proceed on the basis of the information on file.

3 Allocation of a Filing Date

Under Article 38 EUDR in conjunction with Article 36(1) and (5) EUDR, a filing date is accorded where the application meets the following requirements:

1. the application is a request for registration of a European Union design;
2. the application contains information identifying the applicant;
3. the application contains a sufficiently clear representation of the design pursuant to Article 36(1)(c) EUDR and that satisfies the requirements set out in Article 4(1)(d) and (e) EUDIR; and

4. the application fee (Article 36(4) EUDR) and, where relevant, the additional application fees for a multiple application (Article 37(2) EUDR) have been paid within 1 month of filing the application.

The following paragraphs provide more details on each of these requirements.

3.1 Payment of fees

The application fee and, where relevant, the additional application fees for a multiple application, must be paid within 1 month of the filing of the application in order for the reception date of the application to be accorded as the filing date (provided the other filing date requirements are met, see paragraphs 3.2, 3.3 and 3.4 below). See the Guidelines Part A, Section 3 Payment of fees, costs and charges for further information on acceptable means of payment.

Where the application fee is not paid within 1 month the Office will send a letter requesting the applicant to remedy the deficiency within 2 months. This time limit is not extendable.

If payment is received within these 2 months, the filing date will be the date on which payment is received.

If the payment deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application for an EU design (Article 45(4) EUDR). Any fees paid will be refunded.

If payment is insufficient to cover all fees, unless the applicant has clearly specified the purpose of the payment, it will first be used to cover the application fees in order to secure a filing date. For multiple applications, the payment will first be used for the application fees in the numerical order of the designs. Any remaining sums will be used as payment for deferment fees in the numerical order of the designs. For more information on the payment of deferment fees, see paragraph 6.1.1 below.

3.2 Request for registration

A request for registration is filed where the applicant has used e-filing, or has completed (at least partly) the application form provided by the Office or has used its own form (see paragraph 2.2, above).

3.3 Information identifying the applicant

For the purpose of allocating a filing date, the information identifying the applicant does not have to satisfy all the requirements set out in Article 1(1)(b) EUDIR (see paragraph 6.1.1). It is enough that the surname and forename(s) of natural persons or the corporate name of legal entities is supplied, along with an address for service or any other data communication link that allows the applicant to be contacted. If

the Office has given the applicant an identification number, it is sufficient to mention that number together with the applicant's name. For information on the identification elements of design applicants, including the name, legal form, and address, see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 3, Identification of parties to the proceedings.

Where this requirement is not met, a letter will be sent requesting the applicant to remedy the deficiency within 2 months. This time limit is not extendable.

If the deficiency is remedied within these 2 months, the filing date will be the date on which the mandatory requirements are complete.

If the deficiency is not remedied, the application will not be dealt with as an application for an EU design (Article 45(4) EUDR). Any fees paid shall be refunded.

3.4 Sufficiently clear representation of the design

3.4.1 General requirements

Design protection is conferred for those features of appearance of a registered EU design that are shown visibly in the application for registration (Article 18a EUDR).

The representation of the design must consist of a graphic or photographic reproduction of the design, either in black and white **or** in colour (Article 4(1) EUDIR).

Irrespective of the form used for filing the application (e-filing or paper), the design must be reproduced on a **neutral background** and **must not be retouched** with ink or correcting fluid.

It must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Register of European Union designs and for publication in the *European Union Designs Bulletin* (Article 4(1)(e) EUDIR).

The Court of Justice has held that before the application for registration can obtain a date of filing, it must contain a representation that enables the matter for which protection is sought to be identified. It is not possible to interpret the EUDR as allowing an application for registration to be considered validly filed when it does not enable the design for which registration is sought to be clearly identified (05/07/2018, C-217/17 P, Becher, EU:C:2018:534, § 59).

In addition, for applications filed electronically, it must meet the technical requirements of Article 9 of Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means.

Drawings, photographs (except slides), computer-made representations, or any other graphical representation, are accepted, provided they are suitable for reproduction, including on a registration certificate in paper format. On the basis of the current

legislation set out in Article 36(5) EUDR and Article 4 EUDIR, 3D computer-animated design generating motion simulation can only be considered as an additional technical means of viewing the design and does not replace conventional static views. CD-ROMs and other data carriers are not accepted.

3.4.2 Neutral background and elements external to the design

The background in a view is considered neutral as long as the design shown in this view is clearly distinguishable from its environment without interference from any other object, accessory or decoration, whose inclusion in the representation could cast doubt on the protection sought (16/04/2012, R 2230/2011-3, Webcams, § 11-12).

In other words, the requirement of a neutral background demands neither a 'neutral' colour nor an 'empty' background. Instead, what is decisive is that the design stands out sufficiently clearly from the background to remain identifiable (13/09/2017, R 1211/2016-3, Tavoli, § 61).

The Office and a number of European Union intellectual property offices have agreed on a Common Communication on the Common Practice on the Graphic Representation of Designs (CP6).

3.4.2.1 Background colours, contrast and shadows

In accordance with the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), the following aspects should be taken into consideration when assessing if a background is neutral: colour, contrast and shadow. The examples given below in relation to these aspects are taken from the Common Communication CP6, which also lists additional examples.

A single or predominant colour in a background is always acceptable if it stands out against the colours of the design.

Examples of an acceptable single or predominant background colour

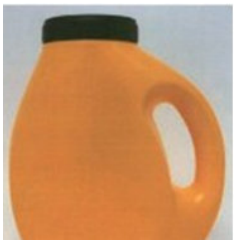
Austrian lapsed design **No 1747/1999**	**REUD No 2 333 484-0001**

Examples of an unacceptable single or predominant background colour

CP6 example	CP6 example

Graduating colour or more than one colour in a background is acceptable provided the design is clearly distinguishable.

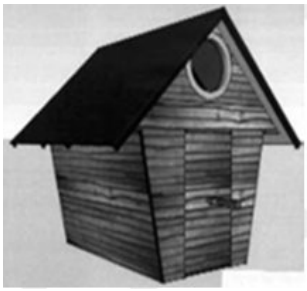
Examples of an acceptable graduating colour and more than one colour in a background

REUD No 1 387 476-0001	French design No 955805-0005
	

As for contrast, all features of the design should be clearly visible. The contrast is considered insufficient when the background colour and the design are similar and melt partly into each other, with the result that not all parts of the design contrast sufficiently with the background (i.e. it is not clear where the product finishes and the background starts). Sometimes, a darker background can help when the design is clear or pale and vice versa.

Example of sufficient contrast with background

Benelux design No 38895-00



Examples of insufficient contrast with background

Portuguese lapsed design **No 420-0006**	**CP6 example**	**Portuguese lapsed design** **No 00023465-0001**

Shadows or reflections are acceptable as long as all of the design features remain visible.

Shadows or reflections are unacceptable when the subject of protection of the design, in any of the submitted views, cannot be determined in an unambiguous way. This can occur when there is limited colour contrast with the design or when the shadows do not allow all the features of the design to be appreciated, for example because they interfere with, or hide parts of, the design or distort the contour of the design.

Examples of acceptable shadows or reflections

Danish design **No 2013 00069**	**CP6 example**

Examples of unacceptable shadows or reflections

CP6 example	**CP6 example**

3.4.2.2 Elements external to the design

Views should not include external and foreign matter, except when their inclusion does not cast any doubt on the protection sought and serves only an illustrative purpose.

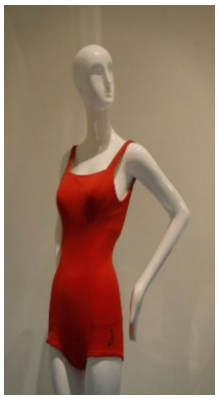
For example, including a hand in the below design serves the purpose of illustrating how the product in which the design is incorporated will be used (even though the way of use does not form part of the design's subject matter of protection). As a human hand is not eligible for design protection (see paragraph 4.1.7), the subject matter of the design is clear.

REUD No 1 627 233

Likewise, when the background shows the context in which the design will be used, and the design itself uses visual disclaimers such as colour shading (see paragraph 5.4.3), allowing for the features for which protection is sought to be clearly perceptible, the subject matter of the design is clear.

REUD No 2 513 598 'Luggage carriers for cycles'

However, the following examples are not acceptable as they contain elements that are external to the design, such as a dressmaker's mannequin in the first design, hand tools and other elements in the second, making the subject matter of protection unclear.

REUD No 5 631 504	REUD No 4 154 086
 This photo by an unknown author is licensed under CC BY-SA	

3.4.2.3 Examination

Of the seven views allowed for representing a design (Article 4(2) EUDIR), those that do not have a neutral background or that contain elements external to the design, will be objected to.

The examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views concerned (which will not form part of the European Union design); or
- submitting new views on a neutral background; or

- amending the views objected to so that the design is isolated from its background. This latter option will make use of visual disclaimers (see paragraph 5.4).

If the applicant withdraws the deficient view(s) within the time limit set by the Office, the date of receipt of the original application will be recorded as the date of filing for the views that are not deficient.

If the applicant submits new or amended views within the time limit set by the Office, the date of receipt of these views will be recorded as the date of filing of the design.

If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application in accordance with Article 46(2) and Article 36(1)(c) EUDR and Article 10(1)(c) EUDIR. The file will be closed by a decision of the examiner and the applicant will be notified. The examiner will notify the Finance Department that a refund of any fees paid should be made to the applicant (Article 10(2) EUDIR).

3.4.3 Designs retouched with ink or correcting fluid

The design must not be retouched with ink or correcting fluid (Article 4(1)(e) EUDIR).

Representations visibly retouched with ink or correcting fluid will be objected to and refused for the purpose of allocating a filing date.

3.4.3.1 Examination

The examiner will use a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views concerned (which will not form part of the European Union design); or
- submitting new views.

If the applicant withdraws the deficient view(s) within the time limit set by the Office, the date of receipt of the original application will be recorded as the date of filing for the views that are not deficient.

If the applicant submits new views within the time limit set by the Office, the date of receipt of these views will be recorded as the date of filing of the design.

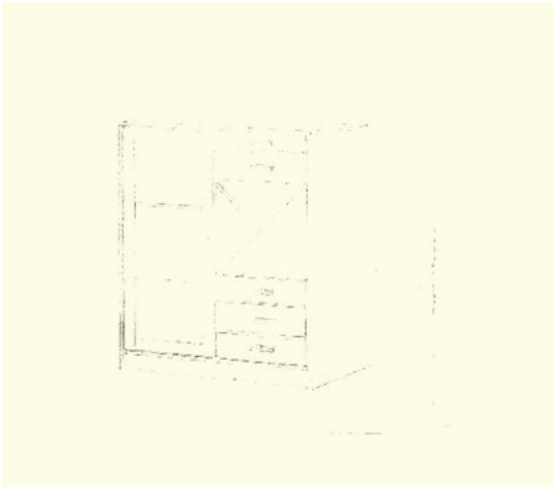
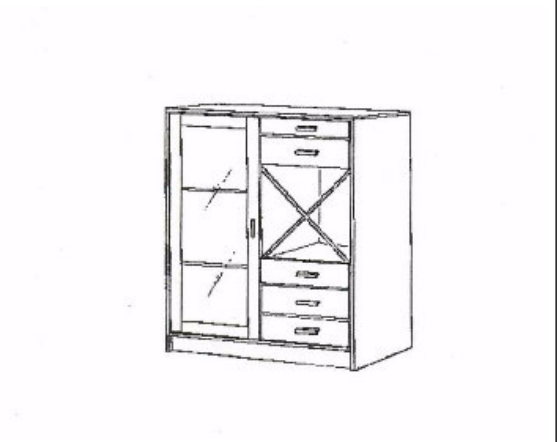
If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application in accordance with Article 46(2) and Article 36(1)(c) EUDR and Article 10(1)(c) EUDIR. The file will be closed by a decision of the examiner and the applicant will be notified. The examiner will notify the Finance Department that a refund of any fees paid should be made to the applicant (Article 10(2) EUDIR).

3.4.4 Quality

In accordance with Article 4(1)(e) EUDIR, the design must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Register of European Union designs and for direct publishing in the *European Union Designs Bulletin*.

Poor quality views are those that do not allow the details of the design to be clearly distinguished.

Examples

Poor quality	**Sufficient quality**
	

Poor quality views are also those that do not allow the design to be reduced or enlarged.

Examples

Poor quality	Sufficient quality

3.4.4.1 Examination

Where the design is not of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views concerned (which will not form part of the European Union design); or
- submitting new views.

If the applicant withdraws the deficient view(s) within the time limit set by the Office, the date of receipt of the original application will be recorded as the date of filing for the views that are not deficient.

If the applicant submits new views within the time limit set by the Office, the date of receipt of these views will be recorded as the date of filing of the design.

If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application in accordance with Article 45(4) and Article 36(1)(c) EUDR. The file will be closed by a decision of the examiner and the applicant will be notified. Any fees paid will be refunded.

The requirement that the design must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished, for publication purposes, applies equally to all applications, irrespective of the means of filing.

Applications sent by e-filing, however, raise specific issues.

E-filing

For e-filing, the terms and conditions determined by the Office must be adhered to (see Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means as well Article 9 for the technical requirements of REUD applications).

Low-resolution attachments are likely to be objected to due to their insufficient quality for reproduction and publication purposes where enlargement of the views to a size of 8 cm by 16 cm causes the details of the design to be blurred.

Where the electronic filing is incomplete or illegible the Office will issue a formal notification requesting the applicant to resend the application within **2 months**. If the deficiencies concern the filing date requirements pursuant to Article 45(1) EUDR, the date on which all deficiencies are remedied determines the date of filing (Article 45(4) EUDR).

If the deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application in accordance with Article 45(4) and Article 36(1)(c) EUDR. The file will be closed by a decision of the examiner and the applicant will be notified. Any fees paid will be refunded.

Where it is clear that the electronic filing was deficient due to technical problems attributable to the Office, with the result that one or more views do not correspond to those originally submitted by the applicant, the Office will allow the resubmission of the affected views. The original filing date via e-filing will be retained, provided that there is no other deficiency affecting the filing date.

4 Examination of the Substantive Requirements

The Office carries out an examination of the substantive protection requirements, which is limited to two grounds for non-registrability.

An application will be refused if the design does not correspond to the definition set out in Article 3(1) EUDR or if it is contrary to public policy or to accepted principles of morality (Article 9 EUDR).

4.1 Compliance with the definition of a design

A ‘design’ means the appearance of the whole or a part of a product resulting from the features, in particular the lines, contours, colours, shape, texture, and/or materials, of the product itself and/or of its decoration, including the movement, transition or any other sort of animation of those features (Article 3(1) EUDR).

A ‘product’ means any industrial or handicraft item, other than a computer program, regardless of whether it is embodied in a physical object or materialises in a non-physical form, including:

(a) packaging, sets of articles, spatial arrangements of items intended to form an interior or exterior environment, and parts intended to be assembled into a complex product;

(b) graphic works or symbols, logos, surface patterns, typographic typefaces, and graphical user interfaces; (Article 3(2) EUDR).

Whether the product claimed is actually made or used, or can be made or used, in an industrial or handicraft manner will not be examined.

Whether a design discloses the appearance of the whole or a part of a 'product' will be examined in the light of the design itself, insofar as it makes clear what the nature of the product is, its intended purpose or its function, and that it makes clear what the indication of the products is that the design is intended to be incorporated in, or to which it is intended to be applied (Article 36(2) EUDR).

The following examples, albeit non-exhaustive, illustrate the Office's practice.

4.1.1 Blueprints, technical drawings, plans for houses or other architectural plans of interior or exterior designs

Blueprints, technical drawings, plans for houses or other architectural plans of interior or exterior designs (e.g. gardens) will be considered 'products' for the purpose of Article 3(2) EUDR and will only be accepted with the corresponding indication of other printed matter in Class 19-08 of the Locarno Classification.

An objection will be raised if the product indicated in an application for a design consisting of a blueprint of a house is *houses* in Class 25-03 of the Locarno Classification. This is because a blueprint does not disclose the appearance of a finished product such as a house.

4.1.2 Colours per se and combinations of colours

A single colour may of course be an element of a design, but on its own it does not comply with the definition of a design because it does not constitute the 'appearance of a product'.

Combinations of colours may be accepted if it can be ascertained from the contours of the representation that they relate to a product such as, for instance, a logo or a graphic symbol in Class 32 of the Locarno Classification.

4.1.3 Icons, graphic user interfaces and the like

Designs of screen displays and icons, graphic user interfaces and other kinds of visible elements of a computer program are eligible for registration (see Class 14-04 of the Locarno Classification).

4.1.4 Mere verbal elements

Mere words per se and sequences of letters (written in standard characters in black and white) do not comply with the definition of a design because they do not constitute the appearance of a product.

The use of fanciful characters and/or the inclusion of a figurative element, however, render(s) the design eligible for protection either as a logo/graphic symbol in Class 32 of the Locarno Classification or as the ornamental representation of a part of any product to which the design will be applied.

4.1.5 Music and sounds

Music and sounds per se do not constitute the appearance of a product and, therefore, do not comply with the definition of a design.

However, the graphical representation of a musical composition, in the form of musical notation, would qualify as a design, if applied for as, for example, *other printed matter* in Class 19-08 or *graphic symbols* in Class 32 of the Locarno Classification.

4.1.6 Photographs

A photograph per se constitutes the appearance of a product and, therefore, complies with the definition of a design, irrespective of what it discloses. The indication of the product can be *writing paper, cards for correspondence and announcements* in Class 19-01, *other printed matter* in Class 19-08 of the Locarno Classification, or any product to which the design will be applied.

4.1.7 Living organisms

Living organisms are not ‘products’, that is, industrial or handicraft items. A design that discloses the appearance of plants, flowers, fruits etc. in their natural state will, in principle, be refused. Even if the shape at issue deviates from that of the common corresponding living organism, the design should be refused if nothing suggests prima facie that the shape is the result of a manual or industrial process (18/02/2013, R 595/2012-3, GROENTE EN FRUIT, § 11).

REUD application No 1 943 283-0001

However, no objection will be raised if it is apparent from the representation that the product does not show a living organism or if the indication of the product specifies that the product is artificial (see, in particular, Class 11-04 of the Locarno Classification).

4.1.8 Teaching materials

Teaching materials such as graphs, charts, maps, etc. can be representations of products in Class 19-07 of the Locarno Classification.

4.1.9 Concepts

A design application will be refused where the representation is of a product that is simply one example amongst many of what the applicant wishes to protect. An exclusive right cannot be granted to a 'non-specific' design that is capable of taking on a multitude of different appearances. This is the case where the subject matter of the application relates, inter alia, to a concept, an invention or a method for obtaining a product.

4.2 Public policy and morality

The Office will apply the concepts of public policy and morality as explained in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 7, Trade marks contrary to public policy or acceptable principles of morality (Article 7(1)(f) EUTMR).

4.3 Objections

Where an objection is raised by the examiner in respect of one of the two above grounds for non-registrability, the applicant will be given the opportunity to withdraw or amend the representation of the design or to submit its observations within 2 months (Article 47(2) EUDR, Article 11 EUDIR).

If the objection relates to compliance with the definition of a design and if this objection can be overcome by amending the indication of the products in which the design is

intended to be incorporated or to which it is intended to be applied, the examiner will propose such an amendment in the communication to the applicant.

Where the applicant opts to submit an amended representation of the design, this representation will be admissible provided that 'the identity of the design is retained' (Article 11(2) EUDIR). The date of receipt of the original application will remain as the date of filing.

Maintenance in an amended form will, therefore, be limited to cases in which the removed or disclaimed features are so insignificant in view of their size or importance that they are likely to pass unnoticed.

Features can be disclaimed by making use of the visual disclaimers referred to in paragraph 5.3 below.

Where the applicant fails to overcome the grounds for non-registrability within the time limit, the Office will refuse the application. If those grounds concern only some of the designs contained in a multiple application, the Office will refuse the application only insofar as those designs are concerned (Article 11(3) EUDIR).

5 Additional Requirements Regarding the Representation of the Design

The purpose of the graphic representation is to disclose the features of the design for which protection is sought. The graphic representation must be self-contained in order to determine with clarity and precision the subject matter of the protection afforded by the registered European Union design to its holder. This rule is dictated by the requirement of legal certainty.

In accordance with the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), use of aspect views of the design is recommended.

Aspect views are defined under the Common Communication CP6 as showing the design from certain directions (angles), and encompass the following: perspective view(s), front view, top view, right side view, left side view, back view and bottom view. See the following examples (for all but a bottom view).

REUD No 2 325 456-0001						

For the purpose of filing a design, it is sufficient to file only one aspect view. However, other (non-traditional) types of view, in particular exploded views (see paragraph 5.3.2 below) and sectional views (see paragraph 5.3.5 below), cannot be filed on their own.

Applicants are reminded that the requirements concerning the format of the representation of the design may vary according to how the application is filed (e.g. e-filing, paper). These requirements are set out in Article 4 EUDIR, and the technical requirements for applications filed electronically are listed in Article 9 of the Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means.

The following instructions supplement the requirements regarding the quality of the reproduction and the neutral background (see paragraph 3.3 above). For general quality recommendations for representations filed in the form of drawings or photographs, please consult the Common Communication CP6. ([3])

The following instructions apply to all designs, irrespective of how the application was filed.

Any deficiency found in an application and relating to one of the requirements in this section will have no bearing on the granting of a filing date. However, if the deficiencies are not remedied within the time limit set by the Office in its examination report, the application will be refused (Article 45(5) EUDR). If the deficiencies concern only some of the designs contained in a multiple application, the Office will refuse the application only insofar as those designs are concerned (Article 11(3) EUDIR).

Once a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid by an applicant (Article 48(4) EUDR).

5.1 Number of views

A maximum of seven different views can be filed in order to represent the design (Article 4(2) EUDIR). The views may be plan, in elevation, cross-sectional, in perspective or exploded. Only one copy of each view should be filed.

For applications other than e-filings, each of the views must be numbered by the applicant in Arabic numerals separated by a dot, the first numeral being the number of the design, the second being the number of the view. For instance, the sixth view of the second design of a multiple application must be numbered ‘2.6’.

In cases where more than seven views are provided, the Office will disregard any of the extra views for registration and publication purposes (27/10/2009, R 571/2007-3, Frames for cycles or motorcycles, § 13), although they will remain in the file. The Office will take the views in the consecutive order in which they were numbered by the applicant (Article 4(2) EUDIR).

Where a reproduction comprises fewer than seven views and the views are not numbered, the examiner will number the views according to the sequence given in the application.

The examiner will not change the order of the views as they appear in the application, or their orientation.

3 https://www.tmdn.org/network/converging-practices.

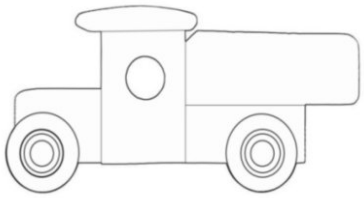
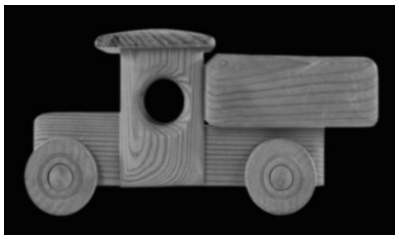
5.2 Consistency of the views

The examiner will check whether the views relate to the same design, that is, to the appearance of one and the same product or of its parts.

It is the applicant's responsibility to submit a correct and complete application (including representations of the design). The Office is not entitled to remedy any deficiencies in respect of incongruent views once the European Union design is registered and published (03/12/2013, R 1332/2013-3, Adapters, § 14 et seq.).

5.2.1 Combination of several means of visual representation

Regarding the combination of several means of visual representation, it is recommended, in accordance with the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), that a design be represented using only one visual format (e.g. a drawing or a photograph). Therefore, the following combination of a drawing and a photograph depicting a vehicle toy, as shown in the Common Communication CP6, is considered unacceptable and thus should not be filed.

CP6 example	
	

Where different visual formats are used, each must clearly relate to the same design and be consistent when comparing the features disclosed.

When the different visual formats show aspects that are inconsistent with one another, they are not considered to represent the same design. A combination of a drawing and a photograph will usually reveal inconsistencies between representations in different visual formats.

In the following example of a chair design, the seat is flat in the drawing but arched in the photograph. The backrests are also of a different shape.

Invented example	**REUD No 1 282 099-0013**

The same may apply when the graphic representation indicates features other than contour lines, such as surface features that are not consistent with the corresponding features in the photographic representation.

The Office therefore strongly recommends that applicants wishing to use different visual formats file each one as a separate design (e.g. one design consisting of drawings only, the other of photographs); these can also be combined in a multiple application.

Where the use of different visual formats leads to an inconsistency of views showing more than one design, the examiner will issue a deficiency letter giving the applicant 2 months to remedy the situation by:

- withdrawing the views representing other designs;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- or if, after the creation of separate design(s) in a multiple application, the maximum number of designs permitted in an application pursuant to Article 37(1) EUDR is exceeded, dividing its application into separate applications and paying the corresponding fees.

If the applicant withdraws the inconsistent view(s) or converts the application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

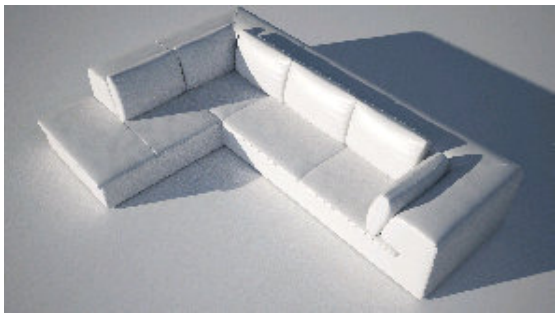
If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

5.2.2 Views relating to more than one design

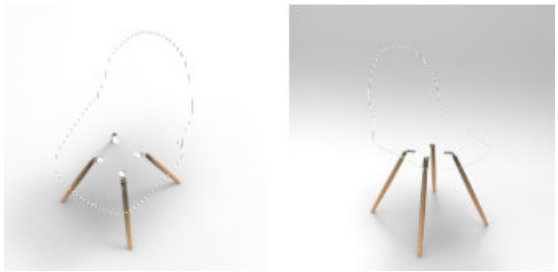
Views relate to more than one design when there are different embodiments of the same concept, or when the lines used to identify the design or the disclaimers used to disclaim certain features, are not used consistently throughout the views.

Different embodiments of the same concept cannot be grouped in a single application because each embodiment is a design on its own. It should not be confused with sets of articles (see paragraph 5.3.7).

Different embodiments of the same concept are considered to be different designs.

Lines and disclaimers must be consistent throughout all the views.

Inconsistent disclaimer	**Consistent disclaimer**
	

Where the application contains different embodiments or where the use of lines or visual disclaimers leads to an inconsistency of views showing more than one design, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views representing other designs;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s) and paying the corresponding fees;
- if after the creation of separate designs in a multiple application the maximum number of designs permitted in an application pursuant to Article 37(1) EUDR is exceeded, dividing its application into separate applications, and paying the corresponding fees.

If the applicant withdraws the inconsistent view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As

a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

5.2.3 Colours

The representation of the design may be submitted **either** in black and white (monochrome) **or** in colour (Article 4(1) EUDIR).

Representations combining black and white views with colour views will be objected to due to their inconsistency and the resulting legal uncertainty as to the protection sought.

The same reasoning applies where identical features of a design are represented in different colours in the various views. Such an inconsistency suggests that the application relates to more than one design (31/03/2005, R 965/2004-3, Bandmaß, § 18-20; 12/11/2009, R 1583/2007-3, Bekleidung, § 9-10).

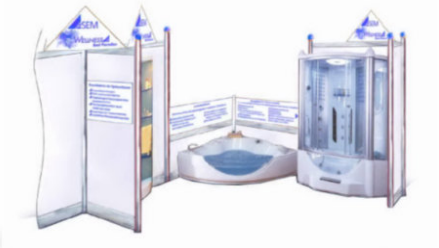
Where the use of different colours leads to an inconsistency of views showing more than one design, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views representing other designs;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- if, after the creation of separate design(s) in a multiple application, the maximum number of designs permitted in an application pursuant to Article 37(1) EUDR is exceeded, dividing its application into separate applications, and paying the corresponding fees.

If the applicant withdraws the inconsistent view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

However, as an exception to the above principle, the same features of a design can be represented in different colours in the various views if the applicant submits evidence, within the time limit set by the Office to remedy the deficiency, that the change of colours at different points in time, while the product is in use, is one of the relevant features of the design, as in the example below (REUD No 283 817-0001, courtesy of ASEM Industrieberatung und Vermittlung).

REUD No 283 817-0001	
	

Where the representation is in colour, the registration and publication will also be in colour (Article 14(2)(c) EUDIR).

5.3 Specific requirements for the different types of views

5.3.1 Alternative positions

Designs with alternative positions are of an appearance that can be modified into various configurations without adding or removing any parts.

These designs have predefined stages of use that each correspond to an alternative position.

In accordance with the Common Communication on the Common Practice on the Graphic Representations of Designs (CP6), views showing different configurations of the design are acceptable provided no parts have been added or deleted.

The alternative positions of the movable or removable parts of a design must be shown in separate views.

The example below of an acceptable representation of a design with alternative positions is taken from the Common Communication CP6, which also lists additional examples.

REUD No 588 694-0012	

In some cases, different configurations may result in different products, such as the bag that can be converted into a towel.

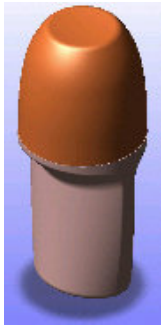
Croatian design No D20110100		

5.3.2 Exploded views

Exploded views are views where parts of a product are shown disassembled, to clarify how the parts fit together.

Exploded views must be combined with at least one view representing the assembled product. In these views, all the product's parts must be shown disassembled in a separate single view. The disassembled parts must be shown in close proximity and in order of assembly.

The example below of an acceptable representation of a design with an assembled and an exploded view is taken from the Common Communication on the Common Practice on the Convergence on graphic representations of designs (CP6), which also lists additional examples.

REUD No 1 847 468-0003	
	

Where there is no view showing the assembled product, the examiner will issue a deficiency letter giving the applicant 2 months to remedy this by submitting a view showing the assembled product for which protection is sought. The new view should not contain features that were not included in the design's original representation. The original filing date will be retained.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

5.3.3 Views magnifying part of the design

Magnified views show one part of an overall design on an enlarged scale.

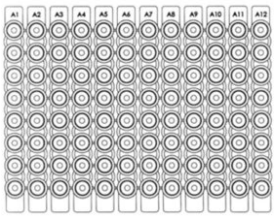
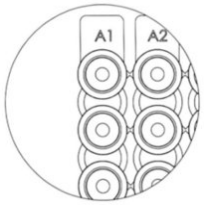
A single magnified view is acceptable provided that the magnified part is already visible in one of the other views submitted.

The view that shows the magnified part of the design must be presented in a separate single view.

Example of an unacceptable magnified view filed as one view

CP6 example

Example of an acceptable magnified view filed as a separate view

REUD No 19 113 690-0002	
	

Where the magnified view is filed within another view, the examiner will issue a deficiency letter inviting the applicant to submit the view showing the magnification separately, which should not contain features that were not included in the original representation of the design. The original filing date will be retained.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

5.3.4 Partial views

A partial view is a view showing part of a product in isolation. A partial view can be magnified.

Partial views must be combined with at least one view of the assembled product (the different parts need to be connected to each other).

Example of an acceptable assembled view, filed together with partial views:

REUD No 2 038 216-0001			
Assembled view	**Partial view**	**Partial view**	**Partial view**

Where all the views disclose different detailed parts, **without showing these parts connected to each other**, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views representing other designs;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s) and paying the corresponding fees;
- if after the creation of separate design(s) in a multiple application the maximum number of designs permitted in an application pursuant to Article 37(1) EUDR is exceeded, dividing its application into separate applications and paying the corresponding fees.

If the applicant withdraws the deficient view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

5.3.5 Sectional views

Sectional views are cutaway portions that complement aspect views by illustrating a feature or features of the product's appearance, such as contour, surface, shape or configuration.

In accordance with the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), representations with technical indications, such as axial lines or sizes (dimensions), numbers, etc., are not acceptable. The sectional view should be an unambiguous view of the same design. Sectional views should not be submitted without other traditional views, such as aspect views.

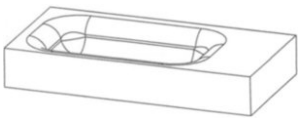
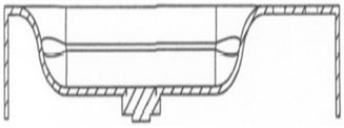
Where the sectional view is submitted alone, without other aspect views, and the subject matter of protection is unclear, the examiner will issue a deficiency letter giving the applicant 2 months to remedy the situation by submitting such a view showing the

product for which protection is sought. The original filing date will be retained provided the new view contains no additional features that were not included in the sectional view originally submitted.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

The following are examples, agreed in the context of the Common Communication CP6, of sectional views that must be submitted together with other traditional views, such as aspect views.

Spanish design No I0152702-D	
Aspect view	**Sectional view**

Benelux design No 38478-0002	
Aspect view	**Sectional view**
	

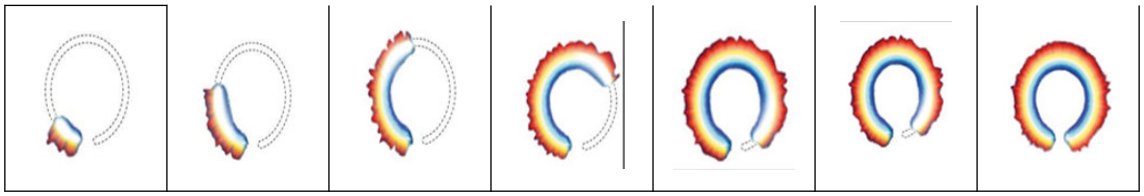
5.3.6 Sequence of snapshots (animated designs)

Snapshots are a short sequence of views used to show a single animated design at different specific moments in time, in a clearly understandable progression.

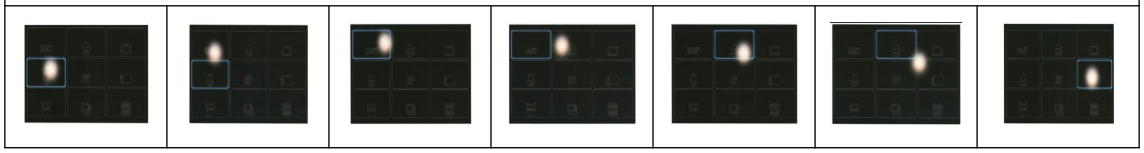
This applies to, for example:

- an animated icon (design consisting of a sequence)

REUD No 2 085 894-0014



- an animated graphical user interface (design of an interface)

REUD No 1 282 388-0031


In principle, according to the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), all views of an animated icon or graphical user interface should be visually related. This means that they must have features in common. It is the applicant's responsibility to order the views in a way that gives a clear perception of the movement or progression.

5.3.7 Sets of articles

A set of articles is a group of products of the same kind that are generally regarded as belonging together and are so used. See the example below.

REUD No 938 709-0001

Sets of articles should not be confused with variations of a design. Different embodiments of the same concept cannot be grouped in a single application because each embodiment is a design on its own. See paragraph 5.2.2, Views relating to more than one design.

The difference between a complex product and a set of articles is that, in contrast to a complex product, the articles of a 'set of articles' are not mechanically connected.

A set of articles can be a 'product' in itself within the meaning of Article 3(2) EUDR. It can be represented in a single design application if the articles making up this set are linked by **aesthetic and functional complementarity** and are, in normal circumstances, sold together as one single product (e.g. a chess board and its pieces or sets of knives, forks and spoons).

It must, however, be clear from the representation that protection is sought for a design resulting from the combination of the articles making up the set, and not for each article separately.

Applicants must submit, among the seven views allowed, at least one view showing the set of articles in its entirety.

Where there is no view showing the set of articles in its entirety, the examiner will issue a deficiency letter giving the applicant 2 months to remedy by:

- withdrawing the views so that the remaining views represent only one design;
- converting its application into a multiple application in which the inconsistent view(s) form separate design(s), and paying the corresponding fees;
- if after the creation of separate design(s) in a multiple application the maximum number of designs permitted in an application pursuant to Article 37(1) EUDR is exceeded, dividing its application into separate applications, and paying the corresponding fees.

If the applicant withdraws the view(s) or converts its application into multiple or separate applications within the time limit set by the Office, the date of receipt of the original application will be the date of filing.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

5.3.8 Repeating surface patterns

Where the application concerns a design consisting of a repeating surface pattern, the representation of the design must disclose the complete pattern and a sufficient portion of the repeating surface (Article 4(3) EUDIR) in order to show how this pattern is infinitely multiplied.

Where there is no indication in the application that the design consists of a repeating surface pattern, the Office will assume that this is not the case and will not request a sufficient portion of the repeating surface.

If additional views represent the pattern applied to one or more specific products for illustrative purposes, the applicant must make sure that the shape of such products is not claimed as part of the design by using any method referred to under paragraph 5.4 below.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As

a date of filing has been granted, refusal of the application does not give rise to a refund of the fees paid (Article 48(4) EUDR).

REUD No 6 574 695-0004

5.3.9 Typographic typefaces

Where the application concerns a design consisting of a typographic typeface, the representation of the design must consist of a string of all the letters of the alphabet, upper case and lower case, and of all the Arabic numerals, as well as of a text of five lines produced using that typeface, all in the same pitch font (Article 4(4) EUDIR). The four requirements for typographic typefaces may be submitted in separate views. Typographic typefaces may concern different alphabets in a single application once the four requirements above are met.

REUD No 1 038 103-0002
ABCDEFGHIJKLMNOPQRSTUVWXYZ abcdefghijklmnopqrstuvwxyz 1234567890 ßÄÖÜäöü !"$%&/()=?@€ Uptat nibh eu faciduismod tie doluptat deliquat alissequisim inim. Met augueros eugait in et volor summy nullaoreet, veliquisim quisissecte dolum volenim auguerit, conulput eugiamc oreros nim vel illamconsed magna facin vel ulputat veniamet, corerat. Nis autet la eummod dit prate delit accumsan henisl delit.

REUD 2458810-0001

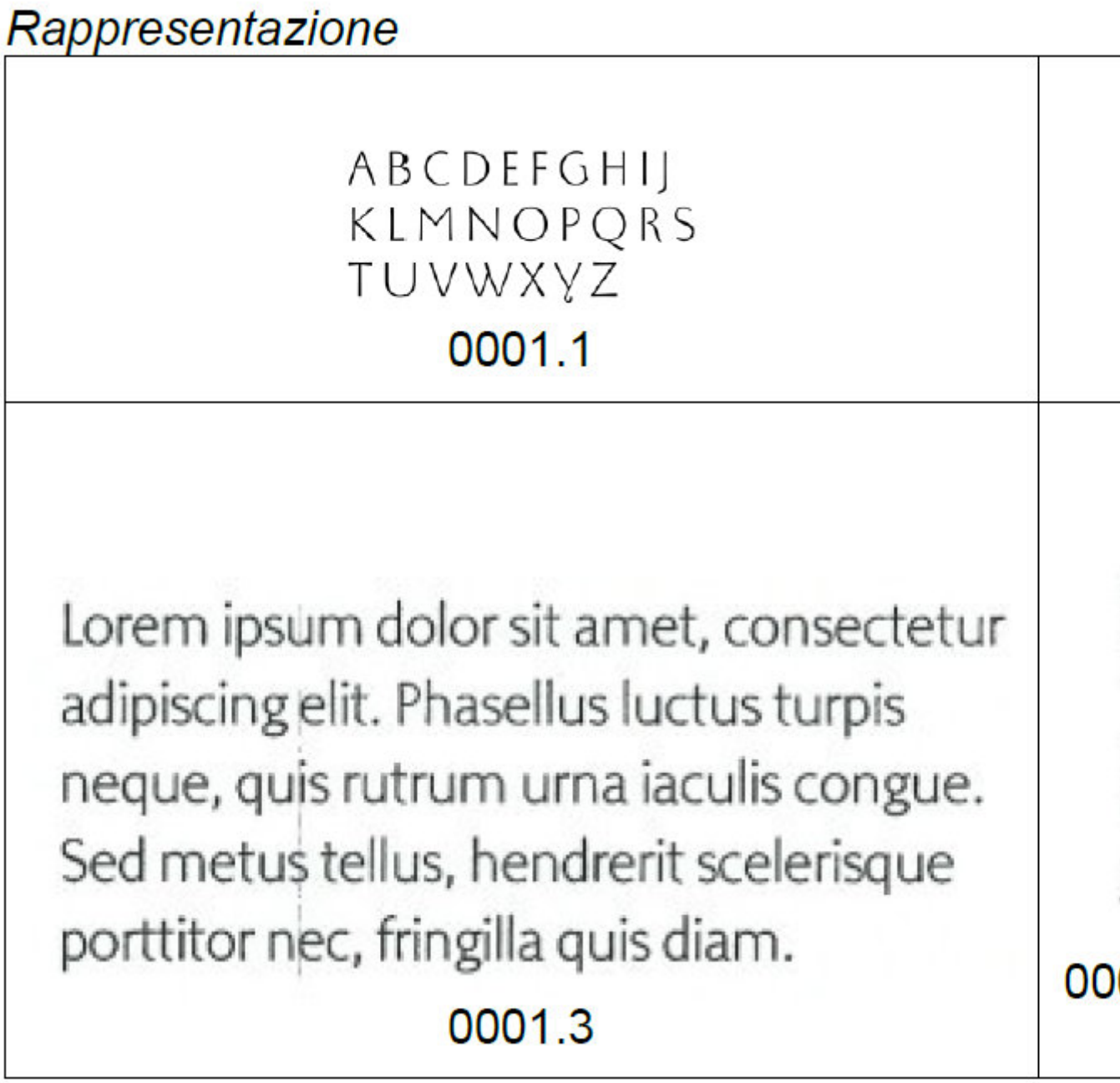


Figure 1:

Where the application does not include a text of five lines using the typeface concerned (Article 4(4) EUDIR), the applicant will be requested to submit such a text or to accept a change in the indication of products to ‘set of characters’ in Class 18-03 of the Locarno Classification.

If the deficiencies are not remedied within the time limit set by the Office, the application will be refused under Article 47(1)(a) EUDR and Article 11(3) EUDIR. As a date of filing will have been granted, refusal of the application will not lead to a refund of the fees paid (Article 48(4) EUDR).

5.4 Use of visual disclaimers to exclude features from protection

Neither the EUDR nor the EUDIR provides rules for the possibility of including in the application a statement that the applicant disclaims any exclusive right to one or more features disclosed in the views.

Use of a description within the meaning of Article 36(3)(a) EUDR is not appropriate in this regard since a description 'shall not affect the scope of protection of the design as such' according to Article 36(6) EUDR (see paragraph 6.2.2). Moreover, only an indication that a description has been submitted is published, not the description as such (Article 14(2)(d) EUDIR).

Disclaimers must therefore be apparent from the representation of the design itself.

In accordance with the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6), visual disclaimers indicate that protection is not being sought, and registration has not been granted, for certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected. This can be achieved by:

- excluding with broken lines, blurring or colour shading the features of the design for which protection is not sought; or
- including the features of the design for which protection is sought within a boundary, thus making it clear that no protection is sought for what falls outside the boundary.

Under the Common Communication CP6, the offices agreed on the general recommendation that graphic or photographic representations showing only the claimed design are preferred. However, visual disclaimers can be used when the graphic or photographic representation of the design contains parts of the product for which no protection is sought. In these cases, the disclaimer must be clear and obvious; the claimed and disclaimed features must be clearly differentiated.

To be accepted, when the design is represented by more than one view, the visual disclaimer must be shown consistently in all the views where it appears (see paragraph 5.2.2).

Where a disclaimer is used, broken lines are recommended. Only when broken lines cannot be used due to technical reasons (e.g. when they are used to indicate stitching on clothing or patterns, or when photographs are used), can other disclaimers be used, such as colour shading, boundaries or blurring.

In accordance with the Common Communication CP6, in an application for registration of a European Union design, the following visual disclaimers will be allowed (see paragraphs 5.4.1 to 5.4.4).

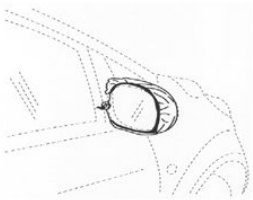
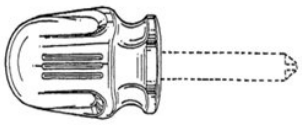
5.4.1 Broken lines

Broken lines consist of a trace made up of dots or dashes (or a combination of both), and are used to indicate that no protection is sought for the features shown using the interrupted trace.

A visual disclaimer consisting of broken lines will usually be combined with continuous lines.

To be accepted, the features for which protection is not sought should be clearly indicated with broken lines, whereas the parts for which protection is sought should be indicated with continuous lines.

The following are examples agreed in the context of the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6) for correctly applied broken lines.

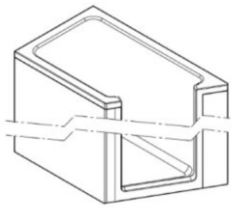
REUD **No 30 606-0005**	**Benelux design** **No 38212-0001**	**Hungarian design** **No D9900409-0001**
		

In cases where broken lines are a feature of the design (such as stitching on clothing), this must be clear from the representation. In such cases, it may be helpful to file, for example, a magnified view.

In cases where broken lines are a feature of the design and a part of the design needs to be disclaimed, any of the other visual disclaimers can be used, such as colour shading, blurring or boundaries.

To help clarify, broken lines may also illustrate separations, indicating that the precise length of the design is not claimed (indeterminate length).

REUD No 2 509 430-0001



In view of Common Communication CP6, the Office does not recommend using broken lines to indicate portions of the design that are not visible in that particular view, that is to say, non-visible lines.

5.4.2 Blurring

Blurring is a type of visual disclaimer that consists in obscuring the features for which protection is not sought in the drawings or photographs of a design application.

Blurring may only be accepted when the features for which protection is sought are clearly distinguishable from the disclaimed (blurred) features.

The following is an example agreed in the context of the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6) of correctly applied blurring.

REUD No 244 520-0002

5.4.3 Colour shading

Colour shading is a type of visual disclaimer that consists of using contrasting tones to sufficiently obscure the features for which protection is not sought in the drawings or photographs of a design application.

With colour shading, the features for which protection is sought must be clearly perceptible, whereas the disclaimed features must be represented in a different tone so as to appear blurred or imperceptible.

The following are examples agreed in the context of the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6) for correctly applied colour shading.

REUD No 910 146-0004	International registration DM/078504

Further examples of Office practice.

REUD No 1 469 530-0001	REUD No 5 295 680-0009

5.4.4 Boundaries

Boundaries are a type of visual disclaimer used in drawings or photographs of an application for a registered European Union design to indicate that no protection is sought for the features not contained within the boundary.

The following are examples that were agreed on in the context of the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6) for correctly applied boundaries.

REUD No 2 182 238-0002	REUD No 1 873 688-0003

To be accepted, the features for which protection is sought should be clearly indicated/ represented within the boundary, whereas all the features outside the boundary are considered to be disclaimed and therefore not protected.

Due to the risk of including more than just the design within the boundary, boundaries must be used carefully in drawings/photographs. The following are examples of incorrectly applied boundaries.

CP6 example	**CP6 example**

5.5 Explanatory text, wording or symbols

No explanatory text, wording or symbols may be displayed in the views.

For paper filings only the indication ‘top’ or the name or address of the applicant may appear (Article 4(1)(c) EUDIR).

Where words, letters, numbers and symbols (such as arrows) are **clearly** not part of the design, the examiner may cut them from the views using the specific IT tool available for this. If the examiner is not able to cut them out for technical reasons, the applicant will be requested to send in clean views or to withdraw the deficient ones.

Where the words, letters, numbers, etc. are part of the design (e.g. graphical symbol), the design is acceptable.

Verbal elements displayed in the representation that are part of the design will be keyed in and entered in the file. Where several verbal elements are displayed, the examiner will only take into account the most prominent one.

5.6 Amending and supplementing views

As a matter of principle, the representation may not be altered after the application has been filed. The submission of additional views or the withdrawal of some views will therefore not be accepted (Article 12(2) EUDIR), unless expressly allowed or required by the Office (see paragraphs 3.3, 4.3 and 5.3 above).

In particular, the views initially filed may not be replaced with better-quality ones. The representations examined and published will be those that the applicant provided in its original application.

The submission of amended or additional views, where allowed, must be made by electronic communication via the Office's website (not by email) in JPEG format (for further information on other formats and technical requirements, see: https://euipo.europa.eu/ohimportal/en/attachments), or by post.

6 Additional Elements that an Application Must or May Contain

6.1 Mandatory requirements

In addition to the requirements for the granting of a filing date (see paragraph 3), the fees for the deferment of publication must be paid (Article 36(4) and 37(2) EUDR), the application must properly identify the applicant and, if applicable, its representative (Article 1(b) and (e) EUDIR), specify the two languages of the application (Article 1(h) EUDIR), contain a signature (Article 1(i) EUDIR) and indicate the products wherein the design is intended to be incorporated or to which it is intended to be applied (Article 1(d) EUDIR).

Even after a date of filing has been granted, the examiner will issue an objection if a deficiency with regard to any of the above requirements is noted in the course of examining the registered European Union design application (Article 10(3)(a) and (b) EUDIR).

6.1.1 Payment of deferment fees

Pursuant to Article 45(3) EUDR, a deficiency letter will be issued if the Office has not received the full amount of any additional fees payable pursuant to Article 36(4) or Article 37(2) EUDR in respect of deferment of publication.

If the deficiency is not remedied within the time limit set by the Office, the application will be refused (Article 10(5) EUDIR).

If the payment is insufficient to cover all fees, unless the applicant has clearly specified the purpose of the payment, it will first be used to cover the application fees to secure a filing date (see paragraph 3.1). For multiple applications, the payment will first be used for the application fees in the numerical order of the designs. Any remaining sums will be used as payment for deferment fees in the numerical order of the designs. Applications for which the fees paid are insufficient to cover the deferment fees will be refused (Article 10(5) EUDIR).

For more information on the requirements of a request for deferment, see paragraph 6.2.5.

6.1.2 Identification of the applicant and its representative

Pursuant to Article 1(1)(b) EUDIR, an application will be objected to if it does not contain the following information regarding the applicant: its name, address and nationality and the State in which it is domiciled or, if the applicant is a legal entity, in which it has its seat or establishment.

The mandatory indications specified above are required for the clear identification of the legitimate holder by the Office and further communication with that holder. However, the information entered in the Register about the holder's address will contain only the city and country of the holder (Article 72(2)(d) EUDR).

The Office identifies the applicant and, where applicable, its representative, according to the principles set out in the Guidelines Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 3, Identification of parties to the proceedings.

6.1.3 Specification of the languages

The application may be filed in any of the official languages of the European Union (language of filing) (Article 98(1) EUDR; see paragraph 2.4 above). The language of the application form does not affect the language of the application. It is the language of the text entered by the applicant that is decisive. The language of filing will be the first language of the application.

The applicant must indicate a second language, which must be an Office language, that is, English (EN), French (FR), German (DE), Italian (IT) or Spanish (ES).

The second language must be different from the language of filing.

The two-letter ISO (International Organization for Standardization) codes for identifying languages may be used in the box provided in the application form.

6.1.4 Signature

The application must be signed by the applicant (Article 1(1)(i) EUDIR). Where there is more than one applicant, the signature of one of them will be sufficient.

If an application is filed electronically, it is sufficient for the name and authority of the signatory to be indicated.

6.1.5 Indication of products

6.1.5.1 General principles

Pursuant to Article 36(2) EUDR, an application for a European Union design must indicate the products in which the design is intended to be incorporated or to which it is intended to be applied. Pursuant also to Article 1(1)(d) EUDIR and Article 3(3) EUDIR, the indication of products must be worded in such a way as to indicate clearly the nature of the products and to enable each product to be classified in only one class of the Locarno Classification, preferably using the terms appearing in the list of products set out therein, or in DesignClass (see below).

In addition to only being capable of being classified in a single class, for administrative purposes, the indication of product must be worded sufficiently clearly to be able to be classified in a single subclass.

Neither the product indication nor the classification affects the scope of protection of a European Union design as such (Article 36(6) EUDR). A registered European Union design confers on its holder the exclusive right to use the relevant design in all types of products, and not only in the product indicated in the application for registration (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 93).

Classification serves exclusively administrative purposes, in particular allowing third parties to search the registered European Union design databases (Article 3(2) EUDIR).

Applicants do not themselves have to classify the products in which their design is intended to be incorporated or to which it is intended to be applied (Article 36(3)(d) EUDR). This is, however, highly recommended to speed up the registration procedure (see paragraph 6.2.3).

6.1.5.2 The Locarno Classification and DesignClass

The Locarno Classification is an international classification for industrial designs. It exists in two official languages, namely French and English. Its structure and contents are adopted and amended by the Committee of Experts from the countries party to the Locarno Agreement. The Classification is administered by the World Intellectual Property Organization.

The Office's DesignClass web tool, based on the Locarno Classification, helps users search the harmonised product indications database for product indications that best match the products for which they want to register a design. The harmonised product indications database follows the same structure of classes and subclasses as the Locarno Classification. It contains not only the Locarno product indications but also many more that are accepted by the EU Member State IP offices and the Office. The database is updated regularly with every new edition of the Locarno Classification approved by the Committee of Experts.

To speed up and simplify the registration procedure, it is highly recommended that products be indicated using the terms listed in DesignClass.

Using the terms listed in DesignClass obviates the need for translations and thus prevents long delays in the registration procedure. Using these product terms whenever possible will improve the transparency and searchability of the registered European Union design databases.

6.1.5.3 How to indicate products

More than one product can be indicated in the application.

When more than one product is indicated in the application, the products do not have to belong to the same class of the Locarno Classification.

Each class and subclass of the Locarno Classification and DesignClass has a 'heading'. The class and subclass headings give a general indication of the fields to which the products belong.

In any event, the product(s) must be indicated in such a way as to allow classification in both the relevant class and subclass of the Locarno Classification (Article 1(2)(c) EUDIR).

The use of terms listed in the heading of a given class of the Locarno Classification is not per se excluded, but it is not recommended. Applicants should **not** choose generic terms referred to in the heading of the relevant class (e.g. *articles of clothing and haberdashery* in Class 2), but instead select terms listed in the heading of the subclass (e.g. *garments* in subclass 02-02) or more specific terms from among those listed in the subclasses of the class in question (e.g. *jackets* in subclass 02-02).

Where the product indication does not allow classification in a subclass, the examiner will determine the relevant subclass by reference to the product disclosed in the graphical representation (see paragraph 6.2.3.1 below). For example, where an application contains as a product indication the term *furnishing* in Class 6 of the Locarno Classification, the examiner will assign a subclass by taking account of the design itself insofar as it makes clear the nature of the product, its intended purpose or its function. If the design clearly discloses the appearance of a bed, the examiner will assign the subclass 06-02 and change the product indication to *beds*.

The use of adjectives in product indications is not per se excluded, even if such adjectives are not part of the alphabetical list of products of the Locarno Classification or DesignClass (e.g. ***electric*** *tools for drilling* in subclass 08-01, or ***cotton*** *pants* in

subclass 02-02). However, it may cause delays in processing the application where a translation of the adjective into all the EU languages is required.

6.1.5.4 *Ex officio* change of indication

Product terms not listed in the Locarno Classification or DesignClass

Where an applicant uses terms that are not in the Locarno Classification or DesignClass, the examiner will, in straightforward cases, substitute *ex officio* the wording used by the applicant with an equivalent or more general term listed in the Locarno Classification or DesignClass. The purpose is to avoid having to translate terms into every EU language, which would result in delays in processing the application.

For instance, where an applicant chooses the term *running trainers* (assuming it is not listed in the Locarno Classification or DesignClass) to indicate the products in which the design will be incorporated, the examiner will change this indication to *running shoes* (assuming it is listed therein).

Even though the product indication does not affect the scope of protection of a European Union design as such, the examiner will refrain from replacing the terms chosen by the applicant with more specific terms.

Products and their parts

Where a design represents the appearance of one part of a product, and that product as a whole is indicated in the application (e.g. an application for the design of a knife handle specifies that the products in which the design will be incorporated are *knives* in subclass 08-03), the examiner will replace that product indication by the indication *product(s) X (part of -)*, provided both the part in question and the product as a whole belong to the same class of the Locarno Classification.

Where a design represents the appearance of a product as a whole, but only a part of that product is indicated in the application (e.g. an application for the design of a knife specifies that the products in which the design will be incorporated are *knife handles*), the examiner will raise an objection and suggest either disclaiming the part not indicated (in which case a new filing date must be accorded) or replacing that product indication by the product term for the whole product (in which case the original filing date may be kept but the design's subject matter of protection will remain to be determined on the basis of the representation as filed). If the applicant does not reply within the time limit, the examiner will *ex officio* replace the applicant's product indication with the suggestion made.

Where a design represents a set of products, and these products are indicated in the application (e.g. an application for the design of a set of dishes specifies that the products in which the design will be incorporated are *dishes* in subclass 07-01), the examiner will replace that indication by *product(s) X (set of -)*.

Ornamentation

Ornamentation is a decorative element capable of being applied to the surface of a variety of products. It can take the form of a pattern, including a moulding, engraving or carving in which the design stands out from a flat surface.

Although ornamentation is in itself a product within the meaning of the Locarno Classification (Class 32-01), its primary purpose is to constitute a feature of appearance of a given product. Therefore, the representation of a design for ornamentation as such should not include the product to which it will be applied, or it should disclaim the product shown in the representation (see paragraph 5.4).

Where the applicant has indicated the product as *ornamentation* or *product(s) X (ornamentation for)*, the examiner will verify if the representation shows ornamentation only and that any product is properly disclaimed. Where the examiner agrees that it is for ornamentation, the product will be classified in Class 32-01. Where the design does not limit itself to representing ornamentation but also discloses the product to which the ornamentation is applied , or part of that product, without its contours being disclaimed, the examiner will raise an objection and suggest either disclaiming that part (in which case a new filing date must be accorded) or replacing the indication *ornamentation* with the product indication for the product disclosed (in which case the original filing date may be kept but the subject matter for which the design is protected will have to be determined on the basis of the representation as filed). If the applicant does not reply within the time limit set, the product indication will be changed *ex officio* in accordance with the Office's proposal.

Where the design represents ornamentation for a given product, and only that product as a whole is indicated in the application, the examiner will replace that product indication by the indication *product(s) X (ornamentation for -)*. The product will thus be classified under Class 32-01 of the Locarno Classification.

Where the examiner does not agree that the design is for ornamentation, the examiner will replace the product indication *ornamentation* with the product indication for the product shown in the representation on the grounds of an obvious mismatch between the products indicated and the design (see 'obvious mismatch', below).

Obvious mismatch

Since one of the main objectives of the product indication and classification is to enable the Register of European Union designs to be searchable by third parties, where the product indication clearly does not match the product as disclosed in the representation of the design, the examiner will replace that product indication with the correct one.

Notification of the *ex officio* change of indication

Provided there is no deficiency, the examiner will register the European Union design(s) and notify the holder of the registration of the *ex officio* change of product indication.

Where the holder objects to such *ex officio* change, it can apply for correction of the corresponding entry in the Register (see paragraph 11.1) and request that the original terms used in the application be maintained, provided there are no issues concerning the clarity and precision of these terms or their classification (Article 20 EUDIR).

6.1.6 Long lists of products

More than one product can be indicated in an application.

However, in order to ensure that the Register of European Union designs remains searchable, where the product indication contains more than five products the examiner will suggest that the applicant limit the number of products to a maximum of five and select products accordingly; the examiner may also suggest which products should be selected.

If, within the time limit indicated in the examiner's communication, the applicant expresses its wish to maintain the original list of products, the examination will proceed on the basis of that list. If the applicant does not respond within the time limit or expressly agrees with the examiner's suggestion, the examination will proceed on the basis of the product indication as suggested by the examiner.

6.1.7 Objections to product indications

Where the examiner raises an objection, the applicant will be given 2 months to submit its observations and remedy the deficiencies noted (Article 10(3) EUDIR).

The examiner may invite the applicant to specify the nature and purpose of the products in order to allow proper classification, or may suggest product terms from DesignClass in order to assist the applicant.

If the deficiency is not remedied within the time limit, the application will be rejected (Article 10(4) EUDIR).

6.1.7.1 No product indication

An objection will be raised where the application gives no indication of the products concerned (Article 36(2) EUDR). However, if an indication can be found in the description or in the priority document, the examiner will record this as the product indication (21/03/2011, R 2432/2010-3, KYLKROPP FÖR ELEKTRONIKBÄRARE, § 14).

6.1.7.2 Deficient product indication

As noted above, the indication of products must be worded in such a way as to indicate clearly the nature of the products and enable each product to be classified in accordance with the Locarno Classification (Article 3(3) EUDIR). Therefore, the examiner will also object to the product indication if it does not enable each product to be classified in only one class and subclass of the Locarno Classification.

This will be the case where the indication is too vague or ambiguous to allow the nature and purpose of the products in question to be determined, for example, *merchandise*, *novelty items*, *gifts*, *souvenirs*, *home accessories*, *electric devices*, etc.

This will also be the case where the indication concerns a service rather than a product, for example, *sending or processing of information*.

6.2 Optional elements

An application may contain a number of optional elements, as listed in Article 1(1)(f) and (g) EUDIR and Article 1(2) EUDIR, that is,

- a priority or exhibition priority claim;
- a description;
- an indication of the Locarno Classification of the products contained in the application;
- the citation of the designer(s) or of the team of designers, or the waiver of the right to be cited;
- a request for deferment.

6.2.1 Priority and exhibition priority

6.2.1.1 Priority

General principles

An application for a European Union design may claim the priority of one or more previous applications for the same design or utility model in or for any state party to the Paris Convention or to the Agreement establishing the World Trade Organization, or in or for another state with which there is a reciprocity agreement (Article 41 EUDR; Article 8 EUDIR). This 'Convention priority' is of 6 months from the date of filing of the first application.

The effect of the right of priority is that the date of priority counts as the date of filing of the application for a registered European Union design for the purpose of Articles 5, 6, 7 and 22, Article 25(1)(d) and Article 50(1) EUDR (Article 43 EUDR).

If the priority of the same previous application is claimed for all designs of a multiple application, the 'Same priority for all designs' box should be ticked in the (paper) application form.

Any filing that is equivalent to a standard national filing under the domestic law applicable to it will be recognised as giving rise to the right of priority. A standard national filing means any filing that is suitable for establishing the date on which the application was filed in the country concerned, whatever the subsequent outcome of that application (Article 41(3) EUDR).

The Office is a participating office in WIPO DAS, which is an electronic system allowing priority documents and similar documents to be securely exchanged between participating IP offices.

The system enables applicants and offices to meet the requirements of the Paris Convention for the certification of priority documents, allowing them to be exchanged in an electronic environment.

As **Office of Second Filing**, the Office accepts priority claims by way of reference in the fields provided for that purpose, namely, the file number, filing date and country of the previous application together with the WIPO DAS access code. This allows the priority document registered in WIPO DAS to be requested by the Office for immediate download.

Priority may be claimed either when filing the application for a registered European Union design or within 1 month of the filing date. During this month, the applicant must submit the declaration of priority and indicate the file number as well as the date on which, and the country in which, the previous application was made (Article 8(2) EUDIR).

Where there is no indication of the claim in the application, the submission of priority documents, or WIPO DAS access code, within 1 month of the filing date will be construed as a priority claim.

Unless it is expressly indicated in the application that a priority claim will be made subsequently, the application will be examined without delay and, if no deficiency is found, will be registered without waiting 1 month for any potential declaration of priority. If a declaration of priority is validly filed after registration of the registered European Union design application, a corresponding entry will subsequently be made in the Register.

Formal requirements

At the examination stage, the Office will only examine whether all **formal requirements** are met.

The formal requirements are:

- priority claim must be filed together with the registered European Union design application or within 1 month of the filing date (Article 8(2) EUDIR);
- file number, filing date and country of previous application must be indicated when claiming priority (Article 1(1)(f) EUDIR);
- priority documents must be submitted:
  - by providing the WIPO DAS access code at the time of filing via e-filing or within 3 months of either the filing date or, as the case may be, receipt of the priority claim;
  - **or** by submitting a copy of all priority documents* within 3 months of either the filing date or, as the case may be, receipt of the priority claim along with, where applicable, translations thereof (Article 8 EUDIR).

  * The priority document must consist of a copy of the entire previous application or registration, emanating from the authority that received it, stating the filing date of that application. The priority document may be filed in the form of an original or as an accurate photocopy. If the original document contains a representation of the design in colour, the photocopy must also be in colour (Decision No EX-20-7 of the

Executive Director of the EUIPO of 11 September 2020 on the formal requirements of priority claims relating to registered European Union designs).

Where the priority of a previous registered European Union design is claimed, the applicant must indicate the number of the previous application and its date of filing. No additional information or document is required (Decision No EX-20-7 of the Executive Director of the EUIPO of 11 September 2020 on the formal requirements of priority claims relating to registered European Union designs).

The Office will then publish the priority claim 'as claimed', meaning that the Office will not confirm the validity of the priority claim.

Language of previous application

If the language of the previous application is not one of the languages of the European Union, the examiner will invite the applicant to file a translation of the first or second language of the REUD application within 2 months (Article 42 EUDR).

For the purpose of examining the formal requirements, the examiner will only verify that the information allowing the examiner to check the file number, date and country of the previous application has been translated. However, the applicant must also file a translation of the remaining parts concerning the substantive requirements which, where necessary, will be examined during *inter partes* proceedings; this is also in the interests of third parties when inspecting the validity of the priority claim.

Formal priority requirements not satisfied

At the filing stage, the Office will limit itself to verifying whether the formal requirements listed above relating to a priority claim are satisfied (Article 45(2)(d) EUDR).

Where remediable deficiencies are found, the examiner will request that the applicant remedy them within 2 months.

If the deficiencies are not remedied in due time or cannot be remedied, the Office will inform the applicant of the rejection of the priority claim and of the possibility of requesting a formal (i.e. appealable) decision on that rejection (Article 46(1) and (4) EUDR; Article 40(2) EUDIR).

If the deficiencies that are not remedied concern only some of the designs contained in a multiple application, the priority claim will be rejected in respect only of the individual designs concerned (Article 10(8) EUDIR).

Substantive requirements

The **substantive requirements** to be met under Article 41 EUDR for a priority claim to be considered valid will be examined not at the filing stage but, where necessary, during *inter partes* proceedings, and will be based on the copy of the priority documents submitted. **It is, therefore, the responsibility of the European Union design applicant to submit a copy of the priority documents and, where applicable, translations thereof at the filing stage**, to allow the priority claim to be examined substantively when required during *inter partes* proceedings.

The requirements that refer to the substance of the priority claims are:

- previous application must be a first filing;

- previous application must concern a design or a utility model;
- European Union design must relate to the ‘same design or utility model’;
- proprietor must be the same;
- priority must be claimed within 6 months of filing the first application;
- previous application must have been filed in a country where a right of priority can arise.

A priority claim in respect of the contested REUD will be examined *ex officio* by the Office during invalidity proceedings when the outcome of the invalidity case depends on whether priority was validly claimed.

If the priority claim does not satisfy all of the substantive requirements, the holder concerned will be invited to make observations within the time limit set by the Office. If the validity of the priority claim cannot be verified, the priority cannot be taken into account for the purpose of the proceedings concerned. The decision on the priority claim can only be appealed together with the final decision on the invalidity proceedings.

The previous application is a first filing

As a matter of principle, the previous application must be a first filing. The Office will therefore check that the priority document does not refer to priority being claimed in respect of an even earlier application.

As an exception, a subsequent application for a design that was the subject of a previous first application and has been filed in or for the same state, will be considered as a first application for the purpose of determining priority, provided that, at the date of filing of the subsequent application, the previous application had been withdrawn, abandoned or refused without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The previous application may not thereafter serve as a basis for claiming a right of priority (Article 41(4) EUDR).

The previous application concerns a design or a utility model

The priority of a previous design or utility model application may be claimed, including that of a previous European Union design or an international design registration.

Many national laws do not provide for the protection of utility models, for example, the laws of the United States of America. In the European Union, utility models can be registered in, inter alia, the Czech Republic, Denmark, Germany, Spain, Italy, Hungary, Austria, Poland, Portugal, Slovakia and Finland. Utility models can be also be registered in Japan.

A priority claim based on a previous patent application will in principle be rejected. However, an international application filed under the Patent Cooperation Treaty (PCT) can form the basis of a right of priority pursuant to Article 41(1) EUDR provided that the subject of the international application in question is a utility model and that the priority is claimed within 6 months from the date of filing of the first application, as expressly fixed in Article 41(1) EUDR (27/02/2024, C-382/21 P, Turn- oder Sportgeräte und -artikel, EU:C:2024:172, § 78).

A priority claim may only be based on a previous application filed with a national office which protects designs as design patents instead of registered designs (for example the United States Patent and Trademark Office - USPTO) if the subject matter of the previous application relates to a 'design patent', not a 'patent'.

The European Union design relates to the 'same design or utility model'

The subject matter of the previous application must be identical to that of the corresponding European Union design, without the addition or deletion of any features.

According to Article 5(2) EUDR, the subject matter is considered to be identical if the European Union design and the previous application for a design right or a utility model differ only in details that can be qualified as 'immaterial'.

The identity of the subject matter may not be affected when, on account of diverging formal requirements, the representation of the design as shown in the previous application has to be altered in order to be filed as a European Union design (15/05/2013, ICD No 8 683).

The proprietor is the same

Priority can be claimed by the applicant of the first application or its successor in title. In the latter case, the first application must have been transferred prior to the filing date of the registered European Union design application, and documentation to this effect must be submitted.

The right of priority as such may be transferred independently of the first application. Priority can therefore be accepted even if the holders of the European Union design and the previous application are different, provided that evidence of assignment of the priority right is submitted. In this case, the execution date of the assignment must be prior to the filing date of the registered European Union design application.

Subsidiary or associated companies of the applicant are not considered to be the same legal entity as the European Union design applicant itself.

Priority is claimed within 6 months of filing the first application

The Office will examine whether the date of filing allocated to the European Union design is within 6 months of the filing date of the first application. European Union design applicants should note that the date of **filing** allocated by the Office may not always correspond to the date of **receipt** of the registered European Union design application.

The priority right claimed must always be a previous application, which, for this very reason, cannot bear the same date as the registered European Union design application.

The previous application was filed in a country where a right of priority can arise

The 'Convention priority' right is a right limited in time, which is triggered by the first regular filing of a design. A regular national filing is any filing that is 'adequate to establish the date on which the application was filed in the country concerned, whatever the subsequent fate of the application' (Article 4A(3) Paris Convention). It may be claimed during the 6 months following the first filing, provided the country

of first filing was a party to the Paris Convention or to the Agreement establishing the World Trade Organization (WTO), or a country with a reciprocity agreement (see Article 34(5) to (7) EUTMR **–** publication on reciprocity by the Commission).

The states and other entities mentioned below, inter alia, are not members of any of the relevant conventions. Nor do they benefit from reciprocity agreements. Therefore, priority claims based on filings in these countries will be **rejected**.

Independent states (not party to the Paris Convention, WTO or reciprocity agreement):

Afghanistan (AF)

Aruba (AW)

Cook Islands (CK)

Eritrea (ER)

Ethiopia (ET)

Kiribati (KI)

Marshall Islands (MH)

Micronesia (FM)

Nauru (NR)

Palau (PW)

Somalia (SO)

Tuvalu (TV)

Other entities (not party to the Paris Convention, WTO or reciprocity agreement):

Abkhazia (GE-AB)

American Samoa (AS)

Anguilla (AI)

Bermuda (BM)

Cayman Islands (KY)

Falkland Islands (FK)

Guernsey (GG)

Isle of Man (IM)

Jersey (JE)

Montserrat (MS)

Pitcairn Islands (PN)

Saint Helena (SH)

Turks and Caicos Islands (TC)

British Virgin Islands (VG)

6.2.1.2 Exhibition priority

General principles

The effect of exhibition priority is that the date on which the design was displayed at an officially recognised exhibition is deemed to be the date of filing of the application for an REUD for the purposes of Articles 5, 6, 7 and 22, Article 25(1)(d) and Article 50(1) EUDR (Article 43 EUDR).

The applicant can claim exhibition priority within 6 months of the first display. Evidence of the display must be filed (Article 44(1) and (2) EUDR).

Exhibition priority cannot extend the 6-month Convention priority period (Article 44(3) EUDR).

Claiming exhibition priority

Similar to Convention priority (see paragraph 6.2.1.1), exhibition priority can be claimed either when filing an REUD application or subsequently. Where the applicant wishes to claim exhibition priority after having filed an application, the declaration of priority, indicating the name of the exhibition and the date of first display of the product, must be submitted within 1 month of the filing date (Article 9(2) EUDIR).

The applicant must, within 3 months of the filing date or receipt of the declaration of priority, provide the Office with a certificate issued at the exhibition by the responsible authority. This certificate must state that the design was disclosed at the exhibition, specify the opening date of the exhibition and, where first public use did not coincide with the opening date of the exhibition, the date of first public use. The certificate must be accompanied by identification of the actual disclosure of the product in which the design is incorporated, duly certified by the authority (Article 9(1) and (2) EUDIR).

Priority can only be granted where an REUD application is filed within 6 months of first display at an exhibition recognised for this purpose, namely a world exhibition within the meaning of the Convention relating to International Exhibitions signed in Paris on 22/11/1928. These exhibitions are rare and Article 44 EUDR does not cover display at other, national or international, exhibitions. The exhibitions can be found on the website of the Paris 'Bureau International des Expositions': http://www.bie-paris.org/site/en/.

As is the case for Convention priority, the substantive requirements for exhibition priority will not be examined at the filing stage but during *inter partes* proceedings, where necessary, and will be restricted to the extent of the *inter partes* proceedings (see paragraph 6.2.1.1, Priority).

6.2.2 Description

The application may include a description not exceeding 100 words explaining the representation of the design. The description must relate only to those features that appear in the reproductions of the design. It may not contain statements concerning the purported novelty or individual character of the design or its technical value (Article 1(2)(a) EUDIR).

Apart from these requirements, the Office will not examine whether the description accords with the representation of the design.

The description does not affect the scope of protection of a European Union design as such (Article 36(6) EUDR; 21/06/2017, T-286/16, Toilettensitze (Teil von -), EU:T:2017:411, § 44). It cannot substitute visual disclaimers to exclude features from protection (see paragraph 5.4 above).

The description may, however, clarify the nature or purpose of some features of the design in order to avoid a possible objection. For instance, where different views of the same design display different colours, thus raising doubts as to consistency between them (see paragraph 5.2.3 above), the description may explain that the colours of the design change when the product in which this design is incorporated is in use.

Descriptions submitted after the date of filing of the application will not be accepted.

The Register will include a mention that a description has been filed, but the description as such will not be translated or published. However, the description will remain part of the administrative file of the application and will be open to public inspection by third parties under the conditions set out in Articles 74 and 74a EUDR.

6.2.3 Indication of the Locarno Classification

6.2.3.1 General principles

The applicant may itself identify the class and subclass, in accordance with the Locarno Classification, of the products indicated in the application (seeparagraph 6.1.5).

If the applicant provides a classification, the products must be grouped in accordance with the classes of the Locarno Classification, each group being preceded by the number of the relevant class and presented in the order of the classes and subclasses (Article 36(3)(d) EUDR and Article 3 EUDIR).

Using the harmonised database of product indications (Locarno product indications and those accepted by Member States' intellectual property offices and the Office), which can be consulted through DesignClass when filing an REUD application online, will accelerate the examination procedure. The harmonised database of product indications is integrated into the EUIPO design e-filing application.

Since classification is optional, no objection will be raised if the applicant does not submit a classification or does not group or sort the products as required, provided that no objection is raised on the indication of products (paragraph 6.1.7). If no such objection is raised, the examiner will classify the products *ex officio* according to the Locarno Classification.

Where the applicant has indicated only the main class and no subclass, the examiner will assign the subclass that appears suitable in view of the design shown in the representation. For instance, where a design application indicates *packaging* in Class 9

of the Locarno Classification, and the design represents a bottle, the examiner will assign subclass 09-01 (the heading of which is *bottles, flasks, pots, carboys, demijohns, and containers with dynamic dispensing means*).

Where the applicant has given the wrong classification, the examiner will assign the correct one *ex officio*.

Products that combine different elements to perform more than one function will be classified in as many classes and subclasses as the number of purposes served. For instance, the product indication *refrigerating boxes with radios and CD players* will be classified under Classes 14-01 (*equipment for the recording or reproduction of sounds or pictures*), 14-03 (*communications equipment, wireless remote controls and radio amplifiers*) and 15-07 (*refrigeration machinery and apparatus*) of the Locarno Classification.

6.2.3.2 Multiple applications

If the same product indication applies to all designs contained in a multiple application, the relevant box 'Same indication of product for all designs' should be ticked in the (paper) application form and the field 'Indication of product' left blank for the subsequent designs.

6.2.4 Citation of the designer or of the team of designers

The application may include:

1. a citation of the designer or of the team of designers (Article 18 EUDR), or
2. an indication that the designer or the team of designers has waived the right to be cited (Article 1(2)(d) EUDIR).

The citation of the designer or of the members of the team of designers and the waiver are merely optional and are not subject to examination.

Since the right to be cited as the designer or as the team of designers is not limited in time, the designer's name or the names of the members of the team of designers can also be entered into the Register after registration of the design (Article 72(2)(j) EUDR). It can also be changed later when a designer changes his or her name for example due to marriage (Article 18 EUDR). The designer's waiver may also be added or removed later. For more information on changes in the name or address of the REUD holder and the citation of the designer or team of designers, see paragraph 11.2.3 Changes in the name and/or address of the applicant/ holder and/or its representative or in the citation of the designer or team of designers.

6.2.5 Request for deferment

6.2.5.1 General principles

The applicant for a registered European Union design may, **when filing the application**, request that its publication be deferred for **30 months** from the date of filing or, if a priority is claimed, from the date of priority (Article 50(1) EUDR).

Where no deficiency is found, the European Union design will be registered. The information published in Part A.2 of the *European Union Designs Bulletin* consists of the file number, date of filing, date of entry in the Register, registration number, name and address of the holder, and name and business address of the representative (if applicable). No other particulars, such as the representation of the design or the indication of products, are published (Article 14(3) EUDIR).

Nevertheless, third parties may inspect the entire file if they have obtained the applicant's prior approval or if they can establish a legitimate interest (Article 74(1) and (2) EUDR).

In particular, there is a legitimate interest where an interested person submits evidence that the holder of the registered European Union design whose publication is deferred has taken steps to invoke the right against them.

No registration certificate will be made available as long as the publication of a design is deferred. However, the holder of the design registration subject to deferment may request a certified or uncertified extract from the Register containing the representation of the design or other particulars identifying its appearance (Article 74(5) EUDR) for the purpose of invoking its rights against third parties (Article 50(9) EUDR). For more information on obtaining certified extracts from the Register, see the Guidelines, Part E, Register operations, Section 5, Inspection of files.

The procedure described in this section does **not** apply to international registrations designating the European Union (see paragraph 12).

6.2.5.2 Request for deferment

Deferment of publication must be requested in the application (Article 50(1) EUDR). Subsequent requests will not be accepted, even if received on the same day.

Applicants should be aware that designs can be registered and accepted for publication within two working days and even sometimes on the day that the application is received (see paragraph 2.7.1). If, by mistake, an application does not contain a request for deferment, the application should be withdrawn in order to prevent publication. Given the speed of the registration and publication processes, this should be done **immediately** after filing. The applicant should also contact an examiner on the day of the withdrawal.

A request for deferment of publication may concern only some of the designs of a multiple application. In this case, the designs to be deferred must be clearly identified

by ticking the box ‘Request for deferment of publication’ on the (paper) form or the box ‘Publication to be deferred’ (e-filing) for each individual design.

The applicant must pay a fee for deferment of publication along with the application fee (see paragraph 6.1.1).

Deficiencies

If the information contained in the application is contradictory (e.g. the deferment fee has been paid, but the applicant has not ticked the box ‘Request for deferment of publication’) or inconsistent (e.g. the amount of the deferment fees paid for a multiple application does not correspond to the number of designs to be deferred), the examiner will issue a deficiency letter asking the applicant to confirm that deferment is requested and, where applicable, for which specific design(s) of a multiple application, and/or to pay the corresponding fees (see paragraph 6.1.1).

6.2.5.3 Request for earlier publication

Where the EU design holder notifies the Office – **any time before the end of the 30-month deferment period** from the date of filing or, if a priority is claimed, from the date of priority – of its wish to have the design(s) published (‘request for earlier publication’ Article 50(4) EUDR), publication will take place as soon as technically possible (Article 16 EUDIR). Where there is no specific request from the holder, the designs will be published when the deferment period expires.

6.2.5.4 Request for surrender of a deferred design

The Office will remind holders at least 4 months before the expiry of the period of deferment that publication is imminent. Holders must not rely entirely on this possibility as failure by the Office to send such a reminder will not affect the publication date of the design.

If the holder decides that the design should not be published after all, it can prevent publication by submitting a written request for surrender in accordance with Article 51 EUDR well before the design is due to be published and **at the latest 3 months before the end of the period of deferment** (Article 50(5) EUDR). In the case of a multiple registration, the holder should indicate which of the designs among those identified for deferment are to be surrendered and for which designs deferment of publication is to be continued, as the case may be (Article 50(6) EUDR).

The declaration of surrender must comply with the requirements of Article 51 EUDR (see paragraph 11.2.2.2).

Deficiencies

Where a declaration of surrender for a deferred design does not comply with all the requirements of Article 50(6) and Article 51 EUDR, the Office will notify the holder of the deficiencies and request that they be remedied within the prescribed time limit, which may in no case expire after the 30-month deferment period (Article 50(7) EUDR). Where the deficiencies are not remedied within the time limit, the Office will reject the

entry of the surrender in the Register and the EU design holder will be informed in writing. However, if there are still more than 3 months before the end of the deferment period, the holder may submit another request for surrender. Where there is no specific request from the holder, the designs will be published when the deferment period expires (see paragraph 6.2.5.5).

6.2.5.5 Publication after deferment

Where no request for surrender has been submitted in due time, the registration will be published in Part A.1 of the EU Designs Bulletin.

The publication will indicate that deferment was originally requested (Article 50(3) EUDR).

7 Multiple Applications

7.1 General principles

A multiple application is a request for the registration of more than one design within the same application. Each of the designs contained in a multiple application or registration is examined and dealt with separately. In particular, each design may, separately, be enforced, be licensed, be the subject of a right *in rem*, a levy of execution or insolvency proceedings, be surrendered, renewed or assigned, be the subject of deferred publication or be declared invalid (Article 37(4) EUDR).

Multiple applications are subject to specific application fees and deferment fees where the application contains a request for deferment of publication, which vary in proportion to the number of designs (see paragraph 8 below).

7.2 Formal requirements applying to multiple applications

7.2.1 General requirements

All the designs in a multiple application must have the same owner(s) and the same representative(s) (if any).

The number of designs contained in a multiple application is limited to 50 (Article 37(1) EUDR). The designs need not be related to one another or be otherwise similar in terms of appearance, nature or purpose, nor be classified in the same Locarno class.

The number of designs should not be confused with the ‘number of views’ that represent the designs (see paragraph 5.1).

Applicants must number the designs contained in a multiple application consecutively, using Arabic numerals (Article 2(4) EUDIR).

A suitable representation of each design contained in a multiple application must be provided (see paragraph 5) as well as an indication of the product in which the design is intended to be incorporated or to which it is to be applied (Article 2(3) EUDIR, see paragraph 6.1.5).

7.2.2 Separate examination

Each of the designs contained in a multiple application is examined separately. If a deficiency concerning some of the designs contained in a multiple application is not remedied within the time limit set by the Office, the application will be refused only insofar as those designs are concerned (Article 10(8) EUDIR).

The decisions on the registration or refusal of the designs contained in a multiple application will all be taken at the same time.

Even if some of the designs in a multiple application already comply with both the substantive and formal requirements, they will not be registered until any deficiencies affecting other designs have been remedied or the designs in question have been refused by the decision of an examiner.

7.2.3 Maximum number of designs in multiple applications

7.2.3.1 Principle

In accordance with Article 37(1) EUDR a maximum number of 50 designs may be combined in one multiple application for registered EU designs. Each design contained in a multiple application shall be numbered by the Office in accordance with a system determined by the Executive Director.

7.2.3.2 Deficiencies

Maximum number of designs exceeded due to a deficiency

Where, following a deficiency, the total number of designs in a multiple application exceeds 50 (for example, if the views of some designs in a multiple application are divided into more designs (see paragraphs 5.2.1, 5.2.2, 5.2.3, 5.3.4 and 5.3.7)) the examiner will request the applicant to:

- withdraw the views representing other designs so that the total number of designs in the application does not exceed 50, or
- divide the application into more applications (with no more than 50 designs each), for the designs above the 50th design of the original application, and pay the corresponding additional fees.

The total amount to be paid will be calculated by the examiner and included in the deficiency letter.

The applicant will be invited to remedy the deficiency letter within 2 months and pay the total amount of fees for all applications resulting from the division of the multiple application or to withdraw some designs to comply with the maximum number of designs in a multiple application (Article 37(1) EUDR).

Where the applicant does not remedy the deficiencies in due time, the application will be refused insofar as it concerns the deficient designs (the ones with incoherent views).

Maximum number of designs exceeded on a paper application

Where an application filed on paper includes more than 50 designs, the examiner will divide the application into more applications, each of which will contain no more than 50 designs and request the applicant to pay the corresponding additional fees.

The applicant will be invited to pay the total amount of missing fees for all applications resulting from the division of the multiple application within 2 months (Article 37(1) EUDR).

Where the applicant does not pay the total amount of fees in due time, the examiner will register the designs for which the application fee (and deferment fee, where applicable) is covered by the amount paid with the application. The payment received will first be used to cover the application fees in the numerical order of the designs in which they are represented (Article 2(4) EUDIR) to secure a filing date. Any remaining sums will be used as payment for deferment fees in the numerical order of the designs. For more information on the payment of deferment fees, see paragraph 6.1.1.

8 Payment of Fees

8.1 General principles

REUD applications are subject to various fees (Articles 36(4) and 37(2) EUDR), including the application fee or, where the application includes a request for deferment of the publication, the deferment fee.

The application fee and, where relevant, the additional application fees for a multiple application, must be paid within 1 month of the filing of the application. If paid within this time limit, the reception date of the application will be accorded as the filing date (provided the other filing date requirements are met, see paragraph 3).

In the case of multiple applications, additional application or deferment fees must also be paid for each additional design.

Where payment is insufficient to cover all fees, in the absence of any criteria for determining the purpose of the payment, the Office will apply the payment to first cover any application fees in order to secure a filing date (see paragraph 3). Any remaining amounts will then be used to pay deferment fees, where applicable. The Office will take the designs in the numerical order in which they are represented, in accordance with Article 2(4) EUDIR.

If the application fee payment deficiencies are not remedied within the time limit set by the Office, the application will not be dealt with as an application for an EU design (Article 45(4) EUDR). Any fees paid will be refunded.

If the deferment fee payment deficiencies (see paragraph 6.1.1) are not remedied within the time limit set by the Office, the Office will reject the application in so far as it concerns designs for which additional deferment fees have not been paid or have not been paid in full.

For the fee payable with respect to an international application designating the European Union, see paragraph 12.1.2.4. For more information on fees and payments in general, see the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

8.2 Currency and amounts

Fees must be paid in euros. Payments in other currencies are not accepted.

The fees for filing an application are as follows.

Application fees

Single design application	EUR 350
Additional application fee in respect of each additional design included in a multiple application	EUR 125 per design

Deferment fees (where deferment of publication is requested)

Single design or first design with deferment of publication in a multiple application	EUR 40
Additional fee for deferment of publication in respect of each additional design included in a multiple application that is subject to deferment of publication	EUR 20 per design

Example of fees due for the filing of a multiple application where the publication of only some designs is to be deferred

Design number	**Deferment**	**Application fee**	**Deferment fee**
xx xxx xxx-0001	Yes	EUR 350	EUR 40
xx xxx xxx-0002	Yes	EUR 125	EUR 20

xx xxx xxx-0003	No	EUR 125	-
xx xxx xxx-0004	No	EUR 125	-
xx xxx xxx-0005	No	EUR 125	-

8.3 Means of payment, details of the payment and refunds

The means of payment, the details to accompany the payment and the conditions for a refund of fees paid are explained in the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

Fees are refunded when the application is withdrawn or refused without a filing date having been granted (application 'not dealt with as a registered European Union design application').

The Office also refunds amounts paid that are insufficient to cover the application (or deferment) fees for the design or at least one design of a multiple application.

9 Withdrawals and Corrections

9.1 Introduction

The applicant may at any time during the examination withdraw an application for a registered European Union design or, in the case of a multiple application, withdraw some of the designs contained in the multiple application. Corrections are allowed only in some specific situations.

Any correction or change to the Register and/or publication, that is after the design has been registered by the examiner, must be dealt with in accordance with paragraph 11 below.

9.2 Withdrawal of the application

Prior to registration the applicant may, at any time, withdraw an application for a European Union design or, in the case of a multiple application, withdraw some of the designs contained in the multiple application (Article 12(1) EUDIR). The examiner will send confirmation of the withdrawal.

The 'date of withdrawal' is the date on which the Office receives the request for withdrawal.

Requests for withdrawal must be submitted in writing and include:

- the file number of the application for a registered European Union design or, where the request for withdrawal is submitted before an application number has been allocated, any information enabling the application to be identified, such as the reference number of the applicant/representative and/or the provisional file number referred to in the automatic receipt for applications filed via the e-filing system;
- in the case of a multiple application, an indication of which design(s) the applicant wants to withdraw if not all are to be withdrawn; and
- the name and address of the applicant and/or, if applicable, the name and address of the representative.

Fees will only be refunded if no filing date has been granted, except where the amount of fees paid by the applicant is insufficient to cover the application fees (or deferment, as the case may be) for the design, or for at least one design in a multiple application.

Requests for withdrawal received by the Office on or after the date of registration of the design will be dealt with as requests for surrender (see paragraph 11.2.2 below).

Requests for withdrawal received by the Office on the filing date of the design application will be accepted even if the design is registered that same day.

9.3 Corrections to the application

9.3.1 Elements subject to correction

Only the name and address of the applicant or the representative, errors of wording or of copying, or obvious mistakes may be corrected, at the request of the applicant (Article 12(2) EUDIR). Corrections in the name and address are not to be confused with a change of name, or a transfer (see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraphs 10 and 11, and Part E, Register operations, Section 3, EUTMs and REUDs as objects of property, Chapter 1, Transfer).

Apart from the name and address of the applicant or representative, the following elements may be corrected at the applicant's request if they contain errors of wording or of copying or obvious mistakes:

- the date of filing;
- the name of the designer or team of designers;
- the second language;
- an indication of the product(s);
- the classification of the product(s) contained in the application;
- the country, date and number of the prior application where Convention priority is claimed;
- the name, place and date of the first exhibition of the design, where exhibition priority is claimed;
- the description.

9.3.2 Elements that cannot be corrected

As a matter of principle, the representation of the design(s) cannot be altered after the application has been filed (Article 12(2) EUDIR). This applies even if the altered representation is submitted on the same date. The submission of additional views or the withdrawal of any views at a later stage will not be accepted unless expressly required or proposed by the Office (see paragraphs 5.3 and 5.6).

Where a request for correction amends the representation of the design(s), the applicant will be informed that its request is not acceptable. The applicant must decide whether it wishes to continue the registration process, or file a fresh application for which they will have to pay the applicable fees.

9.3.3 Procedure for requesting correction

A request for correction of the application must contain:

1. the file number of the application;
2. the name and address of the applicant;
3. where the applicant has appointed a representative, the name and business address of the representative;
4. an indication of the element of the application to be corrected and the corrected version of that element.

A single request may be made for correction of the same element in two or more applications belonging to the same applicant.

If all the requirements are met, the examiner will send confirmation of the correction.

For corrections and amendments see paragraph 11 below.

9.3.4 Deficiencies

Where a request for correction does not meet the above requirements and the deficiency found can be remedied, the examiner will invite the applicant to remedy the deficiency within 2 months. If the deficiency is not remedied in due time, the examiner will refuse the request for correction.

Requests for correction that would have the effect of amending the representation of the design(s) will be refused irremediably.

Descriptions submitted after the date of filing of the application are not accepted (see paragraph 6.2.2 above). Requests for correction that involve submitting a description for the first time after the date of filing of the application will therefore be refused.

10 Registration, Publication and Certificates

10.1 Registration

Once the examination of grounds for non-registrability and formalities is completed, the examiner must ensure that all the particulars referred to in Article 14 EUDIR have been provided (particulars that are mandatory for the applicant and that must be indicated in the application are in bold type):

1. the date of filing and registration of the application, pursuant to Article 48(3) EUDR;
2. the file number of the application and of each individual design included in a multiple application;
3. **the name, address and nationality of the applicant and the state in which it is domiciled or has its seat or establishment;** in accordance with Article 72(2)(d) EUDR, only the name, city and country of the applicant will be entered in the Register;
4. **the name and business address of the representative**, other than an employee acting as representative in accordance with the first sentence of Article 77(3) EUDR; where there is more than one representative, only the name and business address of the first-named representative, followed by the words 'et al.', will be recorded; where an association of representatives is appointed, only the name and business address of the association will be recorded;
5. **the representation of the design**;
6. **an indication of the product(s)** by name, preceded by the number(s) of and grouped according to the class(es) and subclass(es) of the Locarno Classification;
7. particulars of priority claims pursuant to Article 42 EUDR;
8. particulars of exhibition priority claims pursuant to Article 44 EUDR;
9. the citation of the designer or team of designers or a statement that the designer or team of designers has waived the right to be cited;
10. **the language in which the application was filed and the second language** indicated by the applicant pursuant to Article 98(2) EUDR;
11. the date of registration of the design in the Register and the registration number pursuant to Article 48(1) EUDR;
12. a mention of any request for deferment of publication pursuant to Article 50(3) EUDR, specifying the date of expiry of the period of deferment;
13. a mention that a description was filed pursuant to Article 1(2)(a) EUDIR;
14. a mention that the representation of the design contains a verbal element.

Where no deficiency is found, the application will be registered.

For further information on entries in the Register, see Decision No EX-21-4 Annex II.

10.2 Publication

All registered European Union designs are published in the European Union Designs Bulletin, which is published in electronic format only, on the Office's website.

However, international registrations designating the European Union are published by WIPO (*Hague Express Bulletin*) (see paragraph 12 below).

Unless an application contains a request for deferment of publication, publication will take place immediately after registration; publication is daily.

Where an application contains a request for deferment of publication, publication is made in Part A.2 of the European Union Designs Bulletin and is limited to the following particulars: the design number, filing date, registration date and the names of the applicant and the representative, if any.

Where an application contains a request for deferment of publication for only some of the designs of a multiple application, only the designs for which deferment has not been requested are published in full.

The date of publication will be entered in the Register (Article 72(2)(c) EUDR).

10.3 Registration certificate

A registration certificate is issued after the registered European Union design has been published in full (i.e. publication in Part A.1).

However, the Office does not issue registration certificates for international registrations designating the European Union (see paragraph 12).

Since 15/11/2010, registration certificates have only been issued as online e-certificates. Holders of European Union design registrations are invited to download the certificate from the day after publication, using the eSearch plus tool on the Office's website. No paper copy of the certificate of registration will be issued. However, certified or uncertified copies of the registration certificate may be requested.

The certificate contains all the particulars entered in the Register of European Union designs at the date of registration. No new certificate is issued following changes made in the Register after the date of registration. However, an extract from the Register, which reflects the current administrative status of the design(s), may be requested. For more information on obtaining certified extracts from the Register, see the Guidelines, Part E, Register operations, Section 5, Inspection of files.

A corrected certificate is issued after publication of a relative error detected in a design registration (Part A.3.2) or after publication of a relative error detected in a recordal (Part B.1.2). A relative error is an error attributable to the Office that modifies the scope of the registration.

10.4 Registration symbol

To facilitate the marketing of design protected products and to increase awareness of the design registration, the holder of a registered EU design may inform the public that the design is registered by displaying on the product in which the design is incorporated or to which it is applied the letter 'D' enclosed within a circle. This design notice may be accompanied by the registration number of the design or hyperlinked to the entry of the design in the Register (Recital 21 Amending Regulation, Article 26a EUDR).

The Office has no competence in administering or checking the validity of use of registration symbols.

11 Corrections and changes in the Register and in the publication of European Union design registrations

11.1 Corrections

11.1.1 General principles

Only the name and address of the applicant, errors of wording or of copying, or obvious mistakes may be corrected at the request of the applicant, and provided that these corrections do not change the representation of the design (Article 12(2) EUDIR) (03/12/2013, R 1332/2013-3, Adapters, § 14 et seq.). There is no fee for such requests.

Where the registration of a design or the publication of the registration contains a mistake or error attributable to the Office, the Office will correct the error or mistake of its own motion or at the request of the holder (Article 20 EUDIR). There is no fee for such requests.

A request for correction of mistakes made by the Office can only refer to the contents of the publication of the registration (Articles 49, 73 and 99 EUDR and Articles 14 and 70 EUDIR) and the entries in the Register (Articles 48, 72 and 99 EUDR).

Unless the Office itself made an error when publishing the representation of the design(s) (e.g. by distorting or truncating the representation), the holder will not be allowed to request the correction of its European Union design if this has the effect of altering the representation (Article 12(2) EUDIR) (03/12/2013, R 1332/2013-3, Adapters, § 14 et seq.).

Corrections will be made as soon as the mistake is detected, including, where necessary, years after the original entry in the Register.

11.1.2 The request for correction

According to Articles 12 and 19 EUDIR, requests for the correction of mistakes and errors in the Register and in the publication of the registration must contain:

1. the registration number of the registered European Union design;
2. the name and address of the holder as they appear in the Register or the name of the holder and the identification number assigned to the holder by the Office;
3. where the holder has appointed a representative, the name and business address of the representative or the name of the representative and the identification number assigned to the representative by the Office; and
4. an indication of the entry in the Register and/or of the content of the publication of the registration to be corrected and the corrected version of the element in question.

A single request may be made for the correction of errors and mistakes in respect of two or more registrations belonging to the same holder (Article 19(4) EUDIR and Article 20 EUDIR).

If the requirements for such corrections are not fulfilled, the Office will inform the applicant of the deficiency. If the deficiency is not remedied within the 2 months specified by the Office, the request for correction will be refused (Article 19(5) and Article 20 EUDIR).

Requests for the correction of mistakes or errors that are not entries in the Register or that do not concern the contents of the publication of registrations will be refused. Accordingly, requests for correction of the description explaining the representation of a design will be refused.

Errors in the translation of the product indication into official EU languages are considered attributable to the Office and will be corrected since the translations are considered entries in the Register as part of the contents of the publication of the registration, despite the fact that the translations are not done by the Office but by the Translation Centre for the Bodies of the European Union.

In cases of doubt, the text in the Office language in which the application for a registered European Union design was filed will be considered authentic (Article 99(3) EUDR). If the application was filed in an official EU language other than one of the Office languages, the text in the second language indicated by the applicant will be considered authentic.

11.1.3 Publication of corrections

The holder will be notified of any changes in the Register (Article 72(6) EUDR).

Corrections will be published by the Office in Part A.3 of the European Union Designs Bulletin and entered in the Register together with the date on which they were recorded (Article 69(b) EUDIR and Article 20 EUDIR).

Where the mistake or error is attributable to the Office, the Office will, after publishing the mistake or error, issue the holder with a certificate of registration containing the entries in the Register (Article 72(2) EUDR) and a statement to the effect that those entries have been recorded in the Register (Article 17 EUDIR).

In cases where the mistake or error is the holder's, a certificate of registration reflecting the corrected mistake or error will be issued only where no certificate has previously been issued. In any event, holders can always request the Office to issue an extract of the Register (in certified or simple form) to reflect the current status of their design(s). For more information on obtaining certified extracts from the register, see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files.

11.2 Changes in the Register

11.2.1 Introduction

This paragraph describes the changes in the Register of European Union designs, as follows:

- surrender of a European Union design with or without deferment, in particular partial surrender;
- changes in the name and/or address (the city and country) of the applicant/holder and/or in the name or the business address of the representative and/or in the name of the designer or the team of designers;
- recordal of transfers;
- recordal of licences;
- recordal of entitlement proceedings and related change of ownership.

11.2.2 Surrender of the registered European Union design

11.2.2.1 General principles

A European Union design may be surrendered by the holder at any time after registration. A surrender must be declared to the Office in writing (Article 51 EUDR).

However, a request for renunciation of an international design designating the European Union must be filed with, and recorded by, the International Bureau (see Article 16 Geneva Act and paragraph 12.2) ([4]).

Surrender can also be declared for only some of the designs contained in a multiple registration (Article 27(1)(d) EUDIR).

The effect of a declaration of surrender begins on the date on which the surrender is entered in the Register of European Union designs, without any retroactive effect

4 The Hague Agreement Concerning the International Registration of Industrial Designs, Geneva Act of 02/07/1999.

(Article 51(1) EUDR). However, if a European Union design for which publication has been deferred is surrendered, it will be deemed from the outset not to have had the effects specified in the EUDR (Article 51(2) EUDR).

A registered European Union design may be partially surrendered provided that its amended form complies with the requirements for protection, and the identity of the design is retained (Article 51(3) EUDR). Partial surrender will therefore be limited to cases in which the features removed or disclaimed do not contribute to the novelty or individual character of a European Union design, in particular:

- where the European Union design is incorporated in a product that constitutes a component part of a complex product, and the features removed or disclaimed are invisible during normal use of this complex product (Article 4(2) EUDR); or
- where the features removed or disclaimed are dictated by a function or for the purposes of interconnection (Article 8(1) and (2) EUDR); or
- where the features removed or disclaimed are so insignificant in view of their size or importance that they are likely to go unnoticed.

The surrender will be entered in the Register only with the agreement of the proprietor of a right entered in the Register (Article 51(4) EUDR). Persons having a registered right include the holders of a registered licence, the proprietors of a registered right *in rem*, the creditors of a registered levy of execution or the authority competent for a registered bankruptcy or similar procedures.

In the case of licences registered in the Register of European Union designs, the surrender of a European Union design is entered in the Register only upon receipt of evidence that the rights holder has informed the licensee(s) of the surrender accordingly. The surrender is entered in the Register 3 months after the date on which the Office obtains proof that the holder has informed the licensee(s) of the surrender accordingly, or earlier if proof is obtained of the licensee's/licensees' consent to the surrender (Article 51(4) EUDR; Article 27(2) EUDIR).

Where a claim relating to the entitlement to a registered European Union design has been brought before a court pursuant to Article 15 EUDR, the surrender is entered in the Register only with the agreement of the claimant (Article 27(3) EUDIR).

11.2.2.2 Formal requirements for a declaration of surrender

The proprietor must declare the surrender to the Office in writing. The general rules for communication with the Office apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits).

The declaration of surrender may be filed in the language used for filing the application or in the second language.

However, when the declaration of surrender is filed using the form provided by the Office pursuant to Article 68 EUDIR, according to Article 80(c) EUDIR, the form may be used in any of the official EU languages, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

A declaration of surrender must contain the particulars referred to in Article 27(1) EUDIR:

1. the registration number of the registered European Union design;
2. the name and address of the holder;
3. the name and business address of the representative, where appointed;
4. an indication of the designs for which the surrender is declared in the case of multiple registrations;
5. a representation of the amended design in accordance with Article 4 EUDIR in the case of partial surrender.

If a declaration of surrender does not contain all the particulars listed above and does not fulfil all the above requirements, the Office will notify the holder of the deficiencies and request that they be remedied within the prescribed time limit. Where the deficiencies are not remedied within the time limit, the surrender will not be entered in the Register and the European Union design holder will be informed thereof in writing (Article 27(4) EUDIR).

11.2.3 Changes in the name and/or address of the applicant/ holder and/or its representative or in the citation of the designer or team of designers

The REUD holder may request a recordal of the change of name or address in the Register by submitting a written request to the Office. Recordals of changes of name and/or address are free of charge. The Office shall enter in the Register only the particulars referred to in Article 69(a) EUDIR, namely the changes in the name, the city or the country of the holder.

The registered representative may request a change of its name or business address, which, as referred to in Article 72(3)(b) EUDR, shall be entered in the Register.

The REUD holder may request that a change of name of the designer or one or more members of the team of designers be registered and entered in the Register pursuant to Article 72(3)(d) EUDR.

The request for a recordal of a change of name or address in respect of an international design designating the European Union must be filed with the International Bureau (see Article 16 Geneva Act).

For the differences between a change of name and a transfer, see the Guidelines for Examination, Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 10, Change of name and address and Part E, Register operations, Section 3, EUTMs and REUDs as objects of property, Chapter 1, Transfer.

A single request may be made for a change of name or address for two or more registrations.

A request for a change of name or address must contain:

1. the registration number of the REUD;

2. the holder's name and address as recorded in the Register, or the holder's identification number;
3. an indication of the new name and address;
4. the name and business address of the representative, where one has been appointed.

Where the change concerns the citation, change of name or the waiver of the designer or team of designers, the request must also contain:

- an indication of the designer or team of designers to be added;
- the name of the designer or the members of the team of designers as recorded in the Register and an indication of the new name as changed;
- a statement, signed by the designer or members of the team of designers being removed, that they waive their right to be cited.

If the above requirements are not fulfilled, the Office will send a deficiency letter. If the deficiency is not remedied within the specified time limit, the Office will refuse the request (Article 19(5) EUDIR).

Changes of name and address for applications for REUDs are not entered in the Register but must be recorded in the files kept by the Office concerning REUD applications (Article 19(7) EUDIR).

Changes in the holders of REUD registrations are published in Part B.2.2 of the European Union Designs Bulletin, while transfers of rights are published in Part B.2.1. Changes in the representatives are published in Part B.9 of the European Union Designs Bulletin. Changes in the citation of the designer or team of designers are published in Part B.10.2 of the European Union Designs Bulletin.

11.2.4 Transfers

A European Union design registration may be transferred by the holder, and transfers are recorded upon request in the Register. However, the request for recording a transfer in respect of an international design designating the European Union must be filed with the International Bureau (see Article 16 Geneva Act).

The legal provisions contained in the EUDR and EUDIR in respect of transfers correspond to the provisions in the EUTMR and EUTMIR respectively (see the Guidelines for Examination, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 1, Transfer).

The legal principles and procedure for the recordal of trade mark transfers apply *mutatis mutandis* to European Union designs with the following particularities.

11.2.5 Licences

11.2.5.1 General principles

European Union design registrations may be licensed by the holder and the licences recorded upon request in the Register. The provisions of the EUDR and EUDIR dealing with European Union design licences (Articles 27, 32 and 33, and Article 51(4) EUDR; Articles 24 and 25, and Article 27(2) EUDIR) are almost identical to those in the EUTMR and EUTMIR (see the Guidelines for Examination, Part E, Register operations, Section 3, EUTMs and REUDs as objects of property, Chapter 2, Licences, rights *in rem*, levies of execution, insolvency proceedings or similar proceedings).

The legal principles and procedure for the recordal of licences in respect of European Union trade marks apply *mutatis mutandis* to European Union designs (Article 24(1) EUDIR) with the following particularities.

11.2.5.2 Registered European Union designs

There is no use requirement in European Union design law. Therefore, the issue of whether use by a licensee is use with the consent of the rights holder does not arise.

The EUDR and EUDIR require an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied (see paragraph 6.1.4 above). The recordal of a partial licence for only some of the products in which the design is intended to be incorporated or applied to is not possible.

Any limitations of the scope of the licence will therefore be disregarded by the Office, and the licence will be registered as if there were no such limitations.

11.2.5.3 Multiple applications for registered European Union designs

An application for a registered European Union design may take the form of a multiple application combining several designs (Article 37 EUDR).

Each design contained in a multiple application may be licensed independently of the others (Article 24(1) EUDIR) (see the Guidelines, Part E, Register operations, Section 3, EUTMs and REUDs as objects of property, Chapter 2, Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, paragraph 8.1).

11.2.5.4 Fees

The fee of EUR 200 for the recordal or transfer of a licence applies per design, not per application, with a ceiling of EUR 1 000 if multiple requests are submitted in the same application (point 12 of the Annex to the EUDR).

Example 1

In a multiple application for 10 designs, 6 designs are licensed to the same licensee. The fee for registering the licences is EUR 1 000, provided that:

- all six licences are included in a single registration request, or
- all the relevant requests are submitted on the same day.

The request may indicate that for three of these six designs, the licence is exclusive. This will not impact the fees to be paid.

Example 2

In a multiple application for 10 designs, 5 designs are licensed to the same licensee. A licence is also granted for another design not contained in that multiple application. The fee is EUR 1 000, provided that:

- all six licences are included in a single registration request, or all the relevant requests are submitted on the same day, and
- the holder of the European Union design and the licensee are the same in all six cases.

11.2.6 Entitlement proceedings

Registered European Union designs may be the subject of entitlement proceedings and subsequent changes in ownership (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 2, Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, paragraph 8.2).

12 International Registrations

This part of the Guidelines deals with the particularities of examining international registrations designating the European Union that result from applications filed with the International Bureau of the World Intellectual Property Organization (hereinafter referred to as ‘international registrations designating the EU’ and ‘the International Bureau’) under the Geneva Act of 02/07/1999 of the Hague Agreement Concerning the International Registration of Industrial Designs.

The following general overview merely serves to set the framework for the Office’s role in the examination of international registrations designating the EU. It is therefore limited in scope and the rules and practices issued by WIPO in relation to international registrations prevail. A full review of the Hague System and how to apply under it can be found directly at https://www.wipo.int/hague/en/.

12.1 General overview of the Hague System

12.1.1 The Hague Agreement and the Geneva Act

The Hague Agreement is an international registration system that makes it possible to obtain protection for designs in a number of states and/or intergovernmental organisations, such as the European Union or the African Intellectual Property Organization, by means of a **single** international application filed with the International Bureau. Under the Hague Agreement, a single international application replaces a whole series of applications that, otherwise, would have had to be filed with different national intellectual property offices or intergovernmental organisations.

The Hague Agreement consists of two separate international treaties: the Hague Act (1960) and the Geneva Act (1999). Each Act has a different set of legal provisions, which are independent of one another.

International registrations designating the European Union are governed by the Geneva Act.

12.1.2 Procedure for filing international applications

12.1.2.1 Particularities

Unlike the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, the Geneva Act neither allows nor requires an international registration to be based on a previously filed European Union or national design.

This means that the Office can only be a ‘designated office’, not an ‘office of origin’. **International applications must therefore be filed directly with the International Bureau** (Article 106b EUDR).

Furthermore, neither the Geneva Act nor the EUDR provides procedures for transforming an international registration designating the EU into a European Union or national design application(s) or for converting an international registration designating the EU into national design application(s) of Member States and into designations of contracting parties to the Hague System, or for replacing European Union or national design registrations by an international registration designating the contracting party in question. Nor does the Geneva Act provide for the possibility of subsequent designation of the EU.

The Geneva Act and the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement contain specific rules, which may differ from those applicable to ‘direct filings’ of European Union designs, that is, applications filed directly with the Office (see paragraph 2.2.1). These specific rules relate to , in particular: i) entitlement

to file an international application; ii) the contents of an international application; iii) fees; and iv) publication and deferment of publication.

12.1.2.2 Entitlement to file an international application

To be entitled to file an application for international registration under the Geneva Act, an applicant must satisfy at least one of the following conditions:

1. be a national of a Contracting Party or a Member State of an intergovernmental organisation that is a Contracting Party, such as the European Union or the African Intellectual Property Organization, *or*
2. have a domicile or a habitual residence in the territory of a Contracting Party, *or*
3. have a real and effective industrial or commercial establishment in the territory of a Contracting Party.

12.1.2.3 Contents of an international registration designating the EU

The applicant can choose to file the international application in **English, French or Spanish** (Rule 6(1) CR) and electronically through the electronic filing (e-filing) interface available on the WIPO website (www.wipo.int/hague/en/e-filing.html) or using the official form available on the WIPO website (www.wipo.int/hague/en/forms/).

No prior national or regional application or registration is required.

An international application may include **up to 100 different designs**. All designs must, however, belong to the same class of the International Classification for Industrial Designs (the Locarno Classification).

It must, in particular, contain a reproduction of the industrial designs concerned, together with the designation of the contracting parties where protection is sought.

12.1.2.4 Fees for international registrations designating the EU

Three types of fees must be paid for an international application designating the European Union, namely: ([5])

- a basic fee;
- a publication fee;
- an individual designation fee, that is, EUR 62 per design, converted into Swiss francs (Article 106c EUDR; point 2 of the Annex to the EUDR; Rule 28 CR).

12.1.2.5 Publication and deferment of publication of international registrations designating the EU

As a general rule, publication in the *International Designs Bulletin* takes place 6 months after the international registration date.

5 See https://www.wipo.int/finance/en/hague.html.

An international application designating the EU may contain a request that the international registration be published immediately.

Where immediate publication is requested, publication will take place as soon as the necessary technical preparations have been carried out after the registration of the industrial design.

An international application may contain a request that publication of the design, or of **all** the designs contained in a multiple application, be deferred. The Geneva Act does not allow deferment of publication to be requested for only some of the designs contained in a multiple application (Article 11 Geneva Act).

The period of deferment of publication for an international application designating the European Union is 30 months from the filing date or, where priority is claimed, the priority date. The application will be published at the end of this 30-month period unless the holder submits a request for earlier publication to the International Bureau (Article 11 Geneva Act).

The procedure described in paragraph 6.2.5 above does **not** apply as the Office is not responsible for publishing international registrations designating the European Union.

12.2 The role of the International Bureau

When it receives an international application, the International Bureau checks that it complies with the prescribed **formal** requirements, such as those described under paragraphs 12.1.2.2 and 12.1.2.3 above, as well as those relating to the quality of the reproductions of the design(s), priority claims and the payment of the required fees. The applicant is informed of any deficiency, which must be corrected within the prescribed time limit of 3 months, failing which the international application is considered to be abandoned. All communications must be sent to the International Bureau.

Where an international application complies with the prescribed formal requirements, the International Bureau records it in the International Register and (unless deferment of publication has been requested (see paragraph 12.1.2.5 above)) publishes the corresponding registration in the *International Designs Bulletin*. Publication takes place electronically on the **WIPO** website and contains all relevant data concerning the international registration, including a reproduction of the design(s).

The International Bureau does not examine the novelty or individual character of the design and it is therefore not entitled to reject an international application on this, or any other, substantive ground.

The International Bureau notifies the international registration to all designated offices, which then have the option of refusing protection on substantive grounds.

The following changes, which may affect an international registration, may be recorded in the International Register:

1. change in name and address of the holder;

2. change in the ownership of the international registration (in respect of all or some of the designated contracting parties and/or in respect of all or some of the industrial designs);
3. renunciation of all the industrial designs, in respect of any or all of the designated contracting parties; and
4. limitation of some only of the industrial designs, in respect of any or all of the designated contracting parties.

A request for the recording of such changes **must be presented to the International Bureau** on the relevant official form and must be accompanied by the prescribed fees. Information concerning such changes is recorded in the International Register and is published in the Bulletin for the information of third parties.

12.3 The role of the Office as designated office

12.3.1 General overview

This section explains how international registrations designating the EU are dealt with by the Office once the International Bureau has notified it, all the way through to the final decision on whether the designation of the European Union has been accepted or refused.

One of the main features of the Hague System is that the Office can refuse protection, on EU territory, of an international registration designating the EU that does not fulfil the substantive conditions of protection provided for by EU legislation.

A refusal, however, may not be issued on the grounds of non-compliance with formal requirements, since such requirements are to be considered as already having been satisfied following the examination carried out by the International Bureau.

Any refusal of protection by the Office must be notified to the International Bureau within 6 months from the publication of the international registration designating the EU on the WIPO website. Any refusal of protection will have effect on the entire territory of the EU.

In the event of a refusal, the applicant has the same remedies as he or she would have had if he or she had filed the application in question directly with the Office. The ensuing procedure takes place solely before the Office; an appeal against a refusal must be submitted by the holder to the Boards of Appeal within the time limit and in accordance with the conditions set out in the EUDR and EUDIR. The International Bureau is not involved in this procedure.

A refusal may be withdrawn, totally or partially. Such a withdrawal may also take the form of a statement to the effect that protection is granted to the industrial designs, or some of the industrial designs, that are the subject of the international registration designating the EU.

The main roles of the EUIPO as designated office are:

- receipt of the information on the international registration designating the EU;
- examination of the grounds for non-registrability;
- examination of design invalidity applications against international registrations designating the EU.

It is important to note that priority may be claimed at the time of the international application only. The examination of the formal requirements of the priority claim for international applications is carried out by the International Bureau. The EUIPO does not examine priority or request supporting documents for international registrations designating the EU. Any document received by the Office will be archived with no effect on the grant of protection but may be relied upon in *inter partes* proceedings.

12.3.2 Receipt of the information on the international registration designating the EU

Communications between the Office and the International Bureau are by electronic means (Article 47(3) EUDIR).

12.3.3 Grounds for non-registrability

Once the international registration designating the EU has been notified to the Office by the International Bureau, the rules laid down under Title XIa EUDR apply (Article 106a(1) EUDR).

12.3.3.1 Compliance with the definition of a design, public policy and morality

An international registration designating the EU may not be refused on the grounds of non-compliance with **formal** requirements, since such requirements are considered to have already been satisfied once they have been examined by the International Bureau.

The Office limits its examination to the two grounds for non-registrability (Article 106e EUDR). An international registration designating the EU will be refused if a design does not correspond to the definition in Article 3(1) EUDR or if it is contrary to public policy or accepted principles of morality (Article 9 EUDR) (see paragraph 4 above).

The examination of grounds for non-registrability for international registrations designating the EU will be carried out as if the design(s) had been applied for directly with the Office. The time limits and other general procedural aspects governing the said examination are the same as those that apply in the case of design applications filed directly with the Office (see paragraphs 1.2.3 and 4.3 above).

12.3.3.2 Time limits

The Office must inform the International Bureau of any refusal of protection within **6 months** of publication of the international registration on the WIPO website (Article 106e(1) EUDR).

A provisional refusal must be reasoned and state the grounds on which refusal is based, and the holder of the international registration designating the EU must be given an opportunity to be heard (Article 106e(1) and (2) EUDR).

Thus, within 2 months of the date of the notification of provisional refusal to WIPO, the international registration holder will be given the opportunity to renounce the international registration for the EU (for all the designs in the registration), to limit the international registration to one or some of the designs for the European Union or to submit observations (Article 106e(3) EUDR).

The International Bureau will forward the notification of provisional refusal to the holder (or to its representative before WIPO, if applicable). The holder must reply directly to the Office or, if applicable, through its representative (see paragraph 12.3.3.4 below).

For time-limit extensions, see paragraph 1.2.3 above.

12.3.3.3 Languages

An international application must be filed in English, French or Spanish (Rule 6(1) CR). The recording and publication of the international registration will indicate the language in which the international application was received by the International Bureau (Rule 6(2) CR). In practice, this language can be identified from the product indication (INID code 54): the first language used in the product indication is the language in which the international application was received by the International Bureau. The indications given in the other two languages are translations provided by the International Bureau (Rule 6(2) CR).

The language in which the international application was received by the International Bureau will be the first language of the EU designation and will therefore become the language of the examination proceedings at the Office (Article 98(1) and (3) EUDR).

In all communications with the International Bureau, the Office will therefore use the language in which the international registration was filed.

If the holder wishes to communicate with the Office in one of the other official languages of the EUIPO, it must supply a translation into the language in which the international registration was filed within 1 month of the date of submission of the original document (Article 98(3) EUDR; Article 81(1) EUDIR). If no translation is received within this time limit, the original document is deemed not to have been received by the Office.

12.3.3.4 Professional representation

In principle, the holder does not need to appoint a representative before the Office. Holders outside the European Economic Area (EEA) are, however, required to be represented further to a provisional refusal (see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, and Articles 77 and 78 EUDR).

If a non-EEA holder has appointed a representative before WIPO who also appears in the database of representatives maintained by the Office, this representative will automatically be considered to be the holder's representative before the Office.

If representation is mandatory under Article 77(2) EUDR (see paragraph 2.5), where a non-EEA holder has not appointed a representative or has appointed a representative before WIPO who does not appear in the database of representatives maintained by the Office, any notifications of provisional refusal or objection will contain an invitation to appoint a representative in compliance with Articles 77 and 78 EUDR.

Where the holder has a WIPO representative **within** the EU who does not appear in the database of representatives maintained by the Office, the Office will inform this representative that if they wish to represent the holder before the Office, they must specify the basis of their entitlement (i.e. whether they are a legal practitioner or professional representative within the meaning of Article 78(1)(a) or (b) or Article 78(4) EUDR or an employee representative within the meaning of Article 77(3) EUDR (see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation).

If the holder fails to appoint a representative within the specified time limit, the Office will refuse protection of the international registration (Article 106e(4) EUDR).

12.3.3.5 Renunciation and limitation

Where the holder renounces the entire international registration in the EU or limits it to one or some of the designs for the European Union, it must inform the International Bureau by way of recording procedure in accordance with Article 16(1)(iv) and (v) of the Geneva Act. The holder can inform the Office by submitting a corresponding statement (Article 106e(6) EUDR).

12.3.3.6 Grant of protection

Where the Office finds no grounds for refusing protection or where a provisional refusal is withdrawn, the Office must inform the International Bureau accordingly without delay.

12.3.3.7 Refusal

Where the holder does not renounce the international registration for the EU, limit it to one or some of the designs, submit observations that satisfy the Office within the specified time limit or withdraw the application, the Office will confirm its decision

refusing protection for the international registration. If the refusal concerns only some of the designs contained in a multiple international registration, the Office will refuse the latter only insofar as those designs are concerned (Article 106e(5) EUDIR).

There is no legal provision in the EUDR or EUDIR allowing an applicant to request an amendment of the design to overcome an objection concerning an international registration. However, an applicant may renounce the designation of the EU by addressing the World Intellectual Property Organization directly, which will then notify the Office.

The holder of the international registration has the same remedies available to it as it would have had if it had filed the design in question directly with the Office. The ensuing procedure takes place solely at Office level. An appeal against a decision to refuse protection must be submitted by the holder to the Boards of Appeal within the time limit and in accordance with the conditions set out in Articles 55 to 60 EUDR and Articles 34 to 37 EUDIR (Article 106e(5) EUDR). The International Bureau is not involved in this procedure.

Once the decision to refuse or accept the international registration designating the EU is final, a final notification will be sent to the International Bureau, indicating whether the design has been finally refused or accepted.

Where the final refusal relates to only some of the designs contained in a multiple application, the notification to the International Bureau will indicate which designs have been refused and which have been accepted.

12.4 Effects of international registrations

If no refusal is notified by the Office within 6 months of the publication of the international registration on the WIPO website, or if a notice of preliminary refusal is withdrawn, the international registration will, from the date of registration granted by the International Bureau, as referred to in Article 10(2) Geneva Act (Article 106a(2) EUDR), have the same effect as if it had been applied for with, and registered by, the Office.

12.5 Invalidity applications against international registrations designating the EU

International registrations designating the EU can be subject to invalidity proceedings under the same conditions and procedural rules as ‘direct filings’ of European Union designs (Article 106f EUDR; see the Guidelines for Examination of Design Invalidity Applications). An application for a declaration of invalidity must be filed with the Office and must clearly identify the international registration number including the contested design within a multiple registration. The contested design within a multiple registration can be clearly identified by indicating the views and the view numbers in which the contested design is registered, or by adding an extension number of the particular design to the registration number. The language of filing of an international

registration designating the EU is necessarily an Office language. An application for a declaration of invalidity against such an international registration must be filed in the same language of filing (see paragraph 12.3.3.3).

The Office will notify the holder or their representative directly of any request for a declaration of invalidity. Where a non-EEA holder has not appointed a representative or has appointed a representative before WIPO who does not appear in the database of representatives maintained by the EUIPO, the Office will communicate with the holder directly and will invite them to appoint a representative who can act before the Office. The holder must reply directly to the Office or, if applicable, through a representative who is on the Office's list of representatives, in accordance with Article 78 EUDR (see paragraph 2.5).

Where the Office declares the effects of an international registration invalid in the territory of the European Union, it must inform the International Bureau of its decision as soon as it becomes final (Article 106f(2) EUDR).

12.6 Changes affecting international registrations

The International Register is kept at WIPO.

The procedures governing the renewal of international registrations and recordals of changes of name, transfers, renunciation or limitation of certain designs, registration for any or all of the designated contracting parties, or limitation of the registration to certain designs are dealt with by the International Bureau (see the Guidelines, Part E, Register Operations, Section 4, Renewal, paragraph 13; Articles 16 and 17 Geneva Act; Article 106g EUDR).

The EUIPO will not process requests for renewal or payments of renewal fees.

13 Enlargement and the registered European Union design

This section discusses the rules relating to the accession of new Member States to the European Union and the implications this has for those applying for a registered European Union design, or for those who have already registered one.

Ten new Member States joined the European Union on 01/05/2004 (the Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Slovenia and Slovakia), two joined on 01/01/2007 (Bulgaria and Romania) and one joined on 01/07/2013 (Croatia).

Article 110a EUDR contains provisions relating to EU enlargement as regards registered European Union designs. These provisions were inserted in the EUDR when the EU was enlarged in 2004 and remain applicable for successive enlargements. The only modification to the text of the EUDR is the addition of the names of the new Member States.

As far as the registrability and validity of European Union designs are concerned, the effects of European Union enlargement on registered European Union design rights are the following.

13.1 The automatic extension of the European Union design to the territories of the new Member States

Pursuant to Article 110a(1) EUDR, the effects of all European Union design rights filed before 01/05/2004, 01/01/2007 or 01/07/2013 extend automatically to the territories of the Member States that acceded on those dates (Article 110a(1) EUDR).

Extension is automatic in the sense that there are no administrative formalities and no extra fees. Moreover, it cannot be opposed by the European Union design holder or any third party.

13.2 Other practical consequences

13.2.1 Professional representation

As from the accession date, applicants (as well as other parties to proceedings before the Office) that have their seat or domicile in a new Member State no longer need to be represented by a professional representative. As from the accession date, professional representatives from a new Member State may be added to the list of professional representatives maintained by the Office pursuant to Article 78 EUDR, and may then represent third parties before the Office.

13.2.2 First and second language

Since 01/01/2004 there have been nine additional official EU languages, namely Czech, Estonian, Hungarian, Latvian, Lithuanian, Maltese, Polish, Slovak and Slovenian. A further two languages (Bulgarian and Romanian) were added on 01/01/2007 ([6]) and another (Croatian) on 01/07/2013.

These languages may be used as the first language only for registered European Union design applications filed on or after the accession date concerned.

13.2.3 Translation

Registered European Union design applications with a filing date that is prior to the accession date, or existing European Union design registrations, will not be translated into the language of the new Member State(s), nor will they be republished in that

6 For Irish, see paragraph 2.4.

language. However, Registered European Union design applications filed after the accession date will be translated into all official EU languages and will subsequently also be published in all of those same languages.

13.3 Examination of grounds for non-registrability

The Office limits its examination of the substantive protection requirements to only two grounds for non-registrability (Article 47(1) EUDR). An application will be refused if the design does not correspond to the definition given in Article 3(1) EUDR or if it is contrary to public policy or to accepted principles of morality (Article 9 EUDR) (see paragraph 4).

An application for a registered European Union design cannot be refused on the basis of any of the grounds for non-registrability listed in Article 47(1) EUDR if these grounds become applicable merely because of the accession of a new Member State (Article 110a(2) EUDR).

Whether a European Union design conforms with Article 3 EUDR or complies with public order and accepted principles of morality is normally assessed without reference to any particular national or linguistic context.

However, where a European Union design contains a word element that is offensive in a language that, as a result of the accession of a new Member State, becomes an official language of the European Union after the date of filing, the ground for non-registrability provided for under Article 9 EUDR does not apply.

13.4 Immunity against cancellation actions based on grounds for invalidity that become applicable merely because of the accession of a new Member State

13.4.1 General principles

European Union designs filed or registered before 01/05/2004, 01/01/2007 or 01/07/2013 will not be cancelled on the basis of grounds for invalidity that exist in one of the Member States acceding to the European Union on those dates if the ground for invalidity only became applicable from the accession date in question (Article 110a(3) EUDR). This is an expression of the need to respect acquired rights.

Not all the grounds for invalidity set out in Article 25(1) EUDR may become ‘applicable merely because of the accession of a new Member State’.

13.4.1.1 Grounds for invalidity that are applicable independently of the enlargement of the EU

The accession of a new Member State has no effect on the applicability of the following four grounds for invalidity. Article 110a(3) EUDR therefore does not offer any protection against their application to European Union designs filed before 01/05/2004, 01/01/2007 or 01/07/2013 respectively.

Non-visibility and functionality

The non-visibility of a European Union design applied to part of a complex product and the restrictions applying to features of a design that are solely dictated by technical function or the requirements of interconnection are grounds for invalidity that must be evaluated on the basis of the design itself and not on a factual situation that exists in any given Member State (Article 25(1)(b) EUDR in conjunction with Articles 4 and 8 EUDR).

Novelty and individual character

Under normal circumstances, the lack of novelty or individual character of a European Union design will not be affected by enlargement of the EU (Article 25(1)(b) EUDR in conjunction with Articles 5 and 6 EUDR).

The disclosure of a design prior to the filing or priority date of a European Union design can destroy the latter's novelty or individual character, even if the disclosure took place in a country before the date of its accession to the EU. The sole requirement is that this disclosure could 'reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Union' (Article 7(1) EUDR).

Entitlement to the European Union design

The fact that the holder is not entitled to the European Union design as a result of a court decision is another ground for invalidity that is not affected by enlargement (Article 25(1)(c) EUDR). Article 14 EUDR does not impose any nationality requirement for the person claiming to be entitled to the European Union design, nor does it require that the court decision originates from a court located in a Member State.

Improper use of one or more of the elements listed in Article 6*ter* of the Paris Convention

The invalidity ground of improper use of one or more of the elements listed in Article 6*ter* of the Paris Convention is not affected by enlargement of the EU either. There is no requirement for the sign for which use is prohibited to come from a Member State (Article 25(1)(g) EUDR).

13.4.1.2 Grounds for invalidity resulting from EU enlargement

A European Union design filed before the accession dates of 30/04/2004, 31/12/2006 or 30/06/2013, cannot be invalidated on the basis of any of the five grounds for

invalidity referred to below where any of these grounds become applicable as a result of the accession of a new Member State (Article 110a(3) EUDR).

Conflict with a prior design right protected in a new Member State (Article 25(1)(d) EUDR)

A European Union design filed before the accession date of a new Member State cannot be invalidated on the basis of a conflict with an earlier design that has enjoyed protection in the new Member State since a date prior to the filing or priority date of the European Union design but that was disclosed to the public at a later date.

Use of an earlier distinctive sign (Article 25(1)(e) EUDR)

A European Union design filed before the accession date of a Member State cannot be invalidated on account of the use of a distinctive sign that has enjoyed protection in the new Member State since a date prior to the filing or priority date of the European Union design.

Unauthorised use of a work protected under the copyright law of a Member State (Article 25(1)(f) EUDR)

A European Union design filed before the accession date of a Member State cannot be invalidated on account of the non-authorised use of a work that has been protected by the copyright law of the new Member State since a date prior to the filing or priority date of the European Union design.

Improper use of signs, emblems, coats of arms, other than those covered by Article 6*ter* of the Paris Convention (Article 25(1)(g) EUDR)

A European Union design filed before the accession date of a Member State cannot be invalidated on account of the improper use of signs, emblems or coats of arms, other than those covered by Article 6*ter* of the Paris Convention, which are of particular public interest for the new Member State.

Public policy and morality

A European Union design filed before the accession date of a new Member State cannot be invalidated on account of it being contrary to public policy or morality in the territory of the new Member State.

13.4.2 Effects of a priority claim

European Union designs with a filing date on or after 01/05/2004, 01/01/2007 or 01/07/2013 respectively may be invalidated on the basis of the five abovementioned grounds.

This applies even if the priority date of the European Union design in question precedes the relevant accession date. The priority right does not protect the European Union design holder against any change in the law that is applicable to the validity of its design.

GUIDELINES FOR EXAMINATION OF REGISTERED EUROPEAN UNION DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Examination of design invalidity applications

1 Purpose

The purpose of these Guidelines is to explain how, in practice, the provisions of the European Union design regulation ([7]) (EUDR) and the European Union design Implementing Regulation ([8]) (EUDIR) are applied by the Office from receipt of an application for a declaration of invalidity of a European Union design (application) up to the point of closure of the invalidity proceedings. Their purpose is also to ensure consistency among the decisions taken by the Invalidity Division and to ensure coherent practice in the treatment of the files. These Guidelines are not intended to, and cannot, add to or subtract from the legal contents of the Regulations.

2 Introduction - General Principles Applying to Invalidity Proceedings

2.1 Duty to state reasons

The decisions of the Invalidity Division must state the reasons on which they are based (Article 62 EUDR). The reasoning must be logical and it must not disclose internal inconsistencies.

The Invalidity Division will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 1, Adequate Reasoning.

2.2 Right to be heard

The decisions of the Invalidity Division will 'be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments' (Article 62 EUDR).

The Invalidity Division will apply the principles explained in the Guidelines, Part A, General rules, Section 2, General principles to be respected in the proceedings, Chapter 2, The right to be heard.

7 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs amended by Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002.

8 Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs amended by Commission Implementing Regulation (EU) 2025/73 of 17 January 2025 amending Regulation (EC) No 2245/2002 implementing Council Regulation (EC) No 6/2002 on Community designs.

2.3 Scope of the examination carried out by the Office

In invalidity proceedings, the examination carried out by the Office is restricted to the grounds, facts, evidence and arguments provided by the parties (Article 63(1) EUDR). This does not preclude the Office from taking into consideration well-known facts (16/02/2017, T-828/14 & T-829/14, Radiatori per riscaldamento, EU:T:2017:87, § 90; see the Guidelines, Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 1, Adequate reasoning).

The Office must weigh the facts, evidence and arguments, adjudicate on their conclusiveness, and thereafter draw legal inferences from them without being bound by the points of agreement between the parties. Alleged facts that are not supported by evidence are not taken into account (12/02/2018, R 459/2016-G, Dishes, § 26).

Facts, evidence and arguments are three different items not to be confused with each other. For instance, the date of disclosure of an earlier design is a fact. Evidence of that fact could be the date of publication of a catalogue showing the earlier design together with evidence proving that the catalogue had been made available to the public before the date of filing or the priority date of the contested REUD. The applicant's argument could be that the earlier design forms an obstacle to the individual character of the contested REUD given that the overall impression the contested design produces on the informed user does not differ from that produced by the earlier design. Whether an REUD lacks individual character or not is not a fact but a legal question to be decided by the Invalidity Division on the basis of the facts, evidence and arguments submitted by the parties.

Expert reports or expert opinions and other statements in writing fall within the means of evidence referred to in Article 65(1)(c) and (f) EUDR. However, the fact that they are procedurally admissible does not automatically mean that the statement is credible and will serve as proof of the facts to be proven. Rather, such statements must be critically examined as to the accuracy and correctness of the information, as well as whether they come from an independent source and/or are fettered or supported by written information (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 26).

Moreover, the legal criteria for applying a ground for invalidity are naturally part of the matters of law submitted for examination by the Office. A matter of law may have to be ruled on by the Invalidity Division, even when it has not been raised by the parties, if it is necessary to resolve that matter in order to ensure correct application of the EUDR. The Office will thus examine *ex officio* such matters of law that can be assessed independently of any factual background for the purpose of allowing or dismissing the parties' arguments, even if they have not put forward a view on those matters (01/02/2005, T-57/03, Hooligan, EU:T:2005:29, § 21). Such matters of law will include, inter alia, the definition of the informed user and the degree of freedom of the designer within the meaning of Article 6 EUDR.

2.4 Compliance with time limits

The Office may disregard facts or evidence that are not submitted in due time by the parties concerned (Article 63(2) EUDR).

Parties are reminded that they must submit the facts and evidence on which they rely in due time and within the time limits set by the Office. Parties that fail to observe the time limits run the risk of having their facts and evidence disregarded. Parties have no unconditional right to have facts and evidence submitted after the time limit set by the Office.

Where the Office exercises its discretion under Article 63(2) EUDR, it must state the reasons why the late facts and evidence are admissible or not, taking into consideration whether the material that has been submitted late is, on the face of it, likely to be relevant to the outcome of the invalidity proceedings brought before it. Furthermore, the Office must consider whether the stage of the proceedings at which the late submission takes place, and the circumstances surrounding it, do not argue against such matters being taken into account (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 42-44; 05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 15-18).

The discretionary power as to the admissibility of documents submitted outside the time limit only applies to 'supplementary' or 'additional evidence', as opposed to 'entirely new evidence', which is never admissible. 'Entirely new evidence' is characterised by the absence of any link with the evidence previously submitted and is to be rejected as belated. 'Additional' or 'supplementary evidence', on the other hand, is evidence that supplements other evidence that was previously submitted in due time. This is the evidence over which the Office can exercise its discretionary power (see by analogy 14/05/2019, T-89/18 & T-90/18, Café del Sol / Café del Sol (fig.) et al., EU:T:2019:331, § 42).

An example of where the Office may exercise its discretion under Article 63(2) EUDR to take facts or evidence that were not submitted in due time into consideration could be the evidence submitted by the invalidity applicant in reply to the contested REUD holder's observations, for instance, that disclosure of an earlier design was not properly established pursuant to Article 7 EUDR. However, the exercise of this discretionary power requires that the invalidity applicant's evidence supplements the initial evidence for the purpose of rebutting the REUD holder's specific arguments, for instance as to the time, place or circumstances relating to the earlier design's disclosure. Another example is where the evidence was unavailable at an earlier stage or where a fact came to light during the course of the proceedings (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 34-36; 10/11/2021, T-443/20, Labels, EU:T:2021:767, § 18-22).

Belated evidence concerning a prior design or earlier right that had not been relied upon in the application for a declaration of invalidity is not considered to be additional and will, therefore, be rejected (Article 28(1)(b)(v) EUDIR, see Section 3.10.2, Facts, evidence and arguments) (15/12/2021, T-682/20, Schuwaren, EU:T:2021:907, § 34).

The Office may also exercise its discretion under Article 63(2) EUDR with respect to facts and evidence in the holder's response to the invalidity application submitted after the time limit.

If the time limit is still running, the party may request an extension of the time limit, pursuant to Article 57(1) EUDIR (see paragraph 4.1.6).

For general information on time limits, see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits.

3 Filing of an Application

3.1 Form of the application

Preferably, the Office recommends that applications are filed by e-filing through the User Area, which can be found on the EUIPO website.

For other means of filing an application (Article 52 EUDR), the Office provides a form (Article 68(1)(f) EUDIR), which can be obtained upon request. The Office highly recommends (Article 68(6) EUDIR) that applicants use this form. This helps the Office to process the application as soon as possible and helps the applicant avoid errors. The completed form must be submitted by the statutory means of communication (see paragraph 3.12, Means of filing). If an application, including supporting documents, is filed other than by e-filing, it should be submitted in duplicate, in order that one set of documents can be kept in the Office archives while the other is sent to the holder without any loss of quality due to copying. If only one set of the application is submitted, the Office may invite the applicant to file a second set within a period of 1 month, or 2 months if the applicant does not have its domicile or its principal place of business, or an establishment, within the European Economic Area (Article 57(1) EUDIR).

For general information on means of communication, see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits.

3.2 Scope of the application

In invalidity proceedings, the relief sought by the applicant can only be the declaration of invalidity of the contested European Union design as registered (Article 25 EUDR).

Where contested European Union designs are part of a multiple registration, each design must be contested individually and identified by reference to its full registration number (Article 37(4) EUDR) or the numbering stipulated for multiple international applications respectively. A single application (and a common statement of grounds) may concern more than one European Union design of a multiple registration. In such a case, the fee for the application must be paid for each contested European

Union design. However, for the sake of clarity, the Office recommends that separate applications be filed for each contested European Union design.

3.3 Language of proceedings

The language regime in design invalidity proceedings is not the same as that governing trade mark proceedings, as explained below.

The application for a declaration of invalidity must be filed in the language of proceedings, which is the language used for filing the application for registering the contested European Union design (language of filing), provided the language of filing is one of the five Office languages (Article 98 EUDR; Article 29 EUDIR).

If the language of filing is not one of the five Office languages, the language of proceedings is the second language indicated in the application for the contested European Union design (Article 98(4) EUDR; Article 29(1) EUDIR).

As regards international registrations designating the European Union, the language of proceedings is the language in which the international application was filed (English, French or Spanish). The first language used in the product indication (INID code 54 of the internationally agreed numbers for the identification of (bibliographic) data) is the language in which the international application was filed at the International Bureau. In case of doubt, applicants for a declaration of invalidity are advised to check the language of filing of the international registration with the International Bureau.

Where the application for a declaration of invalidity is not filed in the language of proceedings, the Office will request that the applicant submit a translation within a period of 2 months of the date of receipt of the notification. Where the applicant does not comply with the request, the application will be rejected as inadmissible (Article 30(1) EUDIR).

The parties to the invalidity proceedings may agree on a different language of proceedings provided it is an official language of the European Union. Information on the agreement must reach the Office within a period of 2 months of receipt by the holder of the official communication sent after the completion of the admissibility examination, pursuant to Article 31(1) EUDIR (see paragraph 3.14). Where the application for a declaration of invalidity was not filed in that language, the applicant must, on its own motion, submit a translation of the application in that language within 1 month of the date on which the Office was informed of the agreement (Article 98(5) EUDR; Article 29(6) EUDIR). If these legal requirements are not met, the language of proceedings will remain unchanged.

For the linguistic regime applicable to the supporting documents, see paragraph 3.10.2.

3.4 Identification of the applicant

The application must contain an indication of the name and address of the applicant (Article 28(1)(c)(i) EUDIR). For further information, see the Guidelines, Part A,

General rules, Section 5, Parties to the proceedings and professional representation, paragraph 2, Parties to proceedings before the Office and paragraph 3, Identification of parties to the proceedings.

Where the information given in the application does not make it possible to identify the applicant unambiguously, and the deficiency is not remedied within 2 months of the Office's request in that regard, the application must be rejected as inadmissible (Article 30(1) EUDIR).

3.5 *Locus standi* of the applicant

Any natural or legal person, as well as a public authority empowered to do so, may submit an application for a declaration of invalidity of a European Union design to the Office based on Article 25(1)(a) and (b) EUDR (Article 52(1) EUDR).

However, where the ground for invalidity is lack of entitlement to the REUD pursuant to Article 25(1)(c) EUDR, infringement of an earlier right, within the meaning of Article 25(1)(d) to (f) EUDR, or improper use of flags and other symbols, within the meaning of Article 25(1)(g) EUDR, an application for a declaration of invalidity is admissible only if the applicant is entitled to the earlier right or is affected by use of the symbol, as the case may be (Article 52(1) EUDR). Entitlement will be examined on the basis of the international, national or European Union law that governs the earlier right or symbol in question.

For substantiation of the applicant's entitlement, see paragraph 3.10.2 below.

3.6 Representatives

As a matter of principle, the rules governing representation in European Union trade mark proceedings apply *mutatis mutandis* to invalidity proceedings for European Union designs (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional representation).

3.7 Identification of the contested European Union design

An application for a declaration of invalidity must contain the registration number of the contested European Union design and the name and address of its holder, as entered in the Register (Article 28(1)(a) EUDIR).

Where the information given by the applicant does not make it possible to identify the contested European Union design unambiguously, the applicant will be requested to supply such information within a period of 2 months. If the applicant does not comply with this request, the application will be rejected as inadmissible (Article 30(1) EUDIR).

3.8 Lapsed or surrendered registrations

A registered European Union design may be declared invalid even after the European Union design has lapsed or has been surrendered, if the applicant shows a legitimate interest in obtaining a decision on the merits (Article 24(2) EUDR).

Where the contested European Union design has lapsed or has been surrendered before the filing of the application for a declaration of invalidity or before the date on which the Office's decision on the admissibility of the application is notified to the parties, the applicant will be requested to submit reasons and evidence, within a period of 2 months, that it has a legitimate interest in the declaration of invalidity. Where the applicant does not comply with the request, the application is rejected as inadmissible and the fees are not refunded (Article 30(1) EUDIR).

Where the request for surrender is submitted whilst invalidity proceedings are ongoing, or the grace period for renewal of the contested European Union design expires in the course of invalidity proceedings, the invalidity proceedings will be stayed.

Since the request for surrender starts a separate procedure to which the invalidity applicant is not a party, the contested European Union design holder must submit a separate request rather than requesting the surrender in response to the invalidity application. For more details see the Guidelines for Examination of applications for registered European Union designs, 11.2.2 Surrender of the registered EU design.

Where the request for surrender does not proceed or where the European Union design is renewed, the invalidity proceedings are resumed.

Where the contested European Union design is cancelled from the Register (Article 50(d)(8) EUDR) or the surrender is entered in the Register of European Union designs (Article 51(1) EUDR) whilst invalidity proceedings are ongoing, the applicant will be invited to confirm whether it maintains its application and, if so, to submit reasons and evidence in support of its legitimate interest to request a decision on the merits of the case within a period of 2 months.

Where the invalidity applicant withdraws its application, does not respond to the invitation, or fails to show a legitimate interest in obtaining the decision, the invalidity proceedings will be closed without taking a decision on merits (see paragraph 6, Termination of the Proceedings).

A claim to have a legitimate interest will only be accepted where the applicant shows why a decision on the substance of the declaration of invalidity is required, and why the surrender or expiration of the contested design is not sufficient to satisfy this interest. Claims without any supporting evidence and without any explanation as to why the surrender or expiration of the design does not satisfy legitimate interests (as opposed to a declaration of invalidity) will be rejected. For instance, a legitimate interest will be established where the applicant proves that the holder of the contested European Union design has taken steps to invoke rights under the contested European Union design against it.

Where the Invalidity Division finds that a legitimate interest has not been demonstrated, it will take a decision rejecting the request and giving reasons. The invalidity proceedings are closed (see paragraph 6, Termination of the Proceedings) only when that decision becomes final.

Where a legitimate interest is demonstrated by the applicant, the Office will take a decision on the merits.

The cases above have to be distinguished from invalidity applications directed against a European Union design, which, at the filing of the application for invalidity or before the date on which the Office's decision on the admissibility of the application is notified to the parties, has already been declared invalid by a final decision. In these cases, the later invalidity action is inadmissible and the fees are non-refundable. Where this is the case, the invalidity applicant will be invited to comment on the finding before the application is rejected (Article 62 EUDR).

3.9 Res judicata

An application for a declaration of invalidity is inadmissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on its merits, either by the Office or by a **European Union design court** and the decision has become final (Article 52(3) EUDR). Where this is the case, the invalidity applicant will be invited to comment on the finding before the application is rejected as inadmissible. The invalidity fee is non-refundable.

Where this cause of inadmissibility arises *after* the application was found admissible, the Office will invite the applicant to comment on the finding of *res judicata* before the application is rejected as inadmissible (the earlier decision on admissibility does not need to be revoked since it did not contain any error at the time it was taken).

The Office will apply the same principles of assessment of the defense of *res judicata* as provided in the Guidelines for examination of European Union trade marks, Part D Cancellation, Section 1 Cancellation Proceedings, 2.5.1.3 Res judicata. For awarding of costs see paragraphs 6.2 Decision on cost and 6.2.2 Apportionment of costs.

3.10 Statement of grounds, facts, evidence and arguments

The application must include an indication of the grounds on which the application is based (Article 52(2) EUDR; Article 28(1)(b)(i) EUDIR) together with a reasoned statement explaining the facts, evidence and arguments in support of those grounds (Article 28(1)(b)(vi) EUDIR).

3.10.1 Statement of grounds

Where the applicant uses the form provided by the Office (Article 68(1)(f) EUDIR), the indication of the grounds relied on is made by ticking one or several boxes in the field 'Grounds'.

Where the applicant does not use the form provided by the Office, an indication of the relevant subsection of Article 25(1) EUDR, such as 'ground of Article 25(1)(a) EUDR', will be considered an indication of the grounds invoked.

The Office will examine the application in light of all the grounds put forward in the reasoned statement explaining the facts, evidence and arguments, even if the corresponding boxes in the application form used to lodge the action were not ticked.

Where the application form, together with the reasoned statement explaining the facts, evidence and arguments, does not make it possible to identify unambiguously the ground(s) on which the application is based, the applicant will be requested to provide further specifications in this respect within a period of 2 months. If the applicant does not comply with the request, the application will be rejected as inadmissible (Article 30(1) EUDIR).

Grounds for invalidity, other than those specifically relied on in the application, will be considered inadmissible when subsequently put forward before the Office.

The Office strongly recommends that all grounds for invalidity be put forward in one single application. Where separate applications are lodged against the same contested European Union design but based on different grounds, the Office may deal with them in one set of proceedings. However, the Invalidity Division may subsequently decide to no longer deal with them in this way (Article 32(1) EUDIR).

3.10.2 Facts, evidence and arguments

In proceedings relating to a declaration of invalidity, the Office is restricted in its examination to the grounds, facts, evidence and arguments submitted by the parties and the relief sought (Article 63(1) EUDR).

As a matter of principle, all facts, evidence and arguments relied on in support of an application for a declaration of invalidity must be submitted together with the application.

The applicant must submit the following facts, evidence and arguments in support of the ground(s) on which the application is based (Article 28(1)(b)(vi) EUDIR) for the application to be deemed admissible (Article 30(1) EUDIR) - each ground must be supported by its own set of facts, evidence and arguments.

- Where the applicant claims that the contested European Union design **lacks novelty or individual character (Article 25(1)(b) EUDR)**, the application must contain a representation of the earlier design(s) that could form an obstacle to the

novelty or individual character of the contested European Union design, as well as documents proving the existence of the earlier design(s) (Article 28(1)(b)(v) EUDIR).

Article 28(1)(b)(v) EUDIR requires that evidence of the existence and identification of the earlier design(s) be filed together with the application for a declaration of invalidity (and no later), so that the holder of the contested design can, without delay, take a position on the merits of the action. For this reason, it is a condition for the admissibility of the application for a declaration of invalidity (Article 30(1) EUDIR ; 21/09/2017, C-361/15 P & C-405/15 P Shower drains, EU:C:2017:720, § 65).

If the earlier design is registered before the Office (as an REUD or an EUTM), the applicant does not have to submit any documents (including priority documents) – examination of the existence will be based on the data contained in the Office's Registers.

For details on the examination of invalidity applications based on Article 25(1)(b) EUDR, see paragraph 5.7, Lack of novelty and individual character.

- Where the applicant claims that the holder is **not entitled to the contested European Union design (Article 25(1)(c) EUDR)**, the application must contain particulars showing that the applicant is entitled to the contested European Union design by virtue of a decision of a competent court or authority of the Member State concerned (Article 28(1)(c) EUDIR in conjunction with Article 15 EUDR).

  For details on the examination of invalidity applications based on Article 25(1)(c) EUDR, see paragraph 5.3, Lack of entitlement.

- Where the applicant claims that the contested European Union design is in conflict with **a prior design (Article 25(1)(d) EUDR)**, the prior design right must be identified. The application must contain a representation of and particulars identifying the prior design, including evidence of any priority claims. Furthermore, the application must contain evidence proving that the applicant is entitled to invoke the prior design as a ground for invalidity (Article 28(1)(b)(ii) EUDIR).

  The application will be considered admissible based on this prior design if the design is filed or registered in the name of the invalidity applicant and its date of filing, or the date of priority, where priority is claimed, is earlier than the date of filing of the contested design.

  For details on the examination of invalidity applications based on Article 25(1)(d) EUDR, see paragraph 5.8, Conflict with a prior design right.

- Where the applicant claims that the contested European Union design infringes an **earlier right**, namely that it makes unauthorised use of a **distinctive sign (Article 25(1)(e) EUDR)** or a work protected by **copyright** in a Member State **(Article 25(1)(f) EUDR)**, the application must contain a representation and particulars identifying the distinctive sign, including evidence that the right is earlier (for instance, evidence of any priority claims) or a representation and particulars

identifying the work protected by copyright. Furthermore, the application must contain evidence proving that the applicant is the holder of the earlier right in question (Article 28(1)(b)(iii) EUDIR).

Where the earlier right invoked under Article 25(1)(d) or (e) EUDR is **registered**, a distinction is to be made depending on whether the earlier right is an REUD, an EUTM or a different type of protected right.

- If the earlier right is an REUD or an EUTM, the applicant does not have to submit any documents (including priority documents) – examination of the existence will be based on the data contained in the Office's Register.
- In all other cases, the applicant must provide the Office with evidence of the existence, validity and scope of protection of the earlier right (including the evidence for priority claims). The following documents will be accepted: 1) certificates issued by the competent registration authorities; 2) extracts from the official databases of the competent registration authorities; 3) extracts from official bulletins of the competent registration authorities. In addition, the Office accepts, as evidence for national marks/designs and international registrations, extracts obtained through the Office's TMview portal (https://www.tmdn.org/tmview/welcome) and DesignView portal (https://www.tmdn.org/tmdsview-web/#/dsview). Extracts generated through TMview reflect the information obtained directly from the competent registration authorities and therefore qualify as documents equivalent to filing or registration certificates from the competent registration authorities within the meaning of Article 7(2)(a) EUTMDR, provided that the extract contains all the relevant information (06/12/2018, T-848/16, V (fig.) / V (fig.) et al., EU:T:2018:884, § 59-61, 70). The same applies, *mutatis mutandis*, to extracts generated through DesignView.

  Applicants must carefully check that the relevant official online database is up to date and contains all the relevant information necessary to prove the validity and scope of protection of the earlier right invoked in the application for invalidity. When the extract from an official database or the database accessed online does not contain all the information required, the applicant must supplement it with other documents from an official source that show the missing information.

  The evidence of a priority claim can be in the form of a WIPO DAS access code or a copy of the priority documents.

Where an earlier right is **pending registration**, the applicant must complete the file by submitting evidence of actual registration of the earlier right relied upon once registered. Until that time it is sufficient to submit a copy of the application with the stamp of the receiving office. If necessary, prior to making a decision, the Office may suspend the invalidity proceedings until it has received evidence of registration (see paragraph 4.1.6.2).

Where the earlier right invoked under Article 25(1)(e) EUDR is **unregistered**, the invalidity application will be considered to have complied with the admissibility requirements under Article 25(3) EUDR by submitting evidence that the earlier

distinctive sign was used by the applicant before the date of filing of the contested design, or its date of priority.

For details on the examination of an invalidity application based on Article 25(1)(e) EUDR, see paragraph 5.9, Use of an earlier distinctive sign.

Where the earlier right is invoked under Article 25(1)(f) EUDR, the invalidity applicant will be considered to have complied with the admissibility requirements under Article 25(3) EUDR if they submit evidence that the work protected by copyright law was published before the date of filing of the contested design, or its date of priority, and that the applicant is entitled to prohibit unauthorised use of the work.

For details on the examination of an invalidity application based on Article 25(1)(f) EUDR, see paragraph 5.10, Unauthorised use of a work protected under the copyright law of a Member State.

- Where the applicant claims that the contested European Union design makes improper use of any of the items listed in **Article 6 *ter* of the Paris Convention** or of badges, emblems and escutcheons other than those covered by Article 6 *ter* and which are **of particular interest in a Member State (Article 25(1)(g) EUDR)**, the application must contain a representation and particulars of the relevant item, and particulars showing that the application is filed by the person or entity concerned by the improper use (Article 28(1)(b)(iv) EUDIR).

  For details on the examination of an invalidity application based on Article 25(1)(g) EUDR, see paragraph 5.11, Improper use of flags and other symbols.

If the applicant fails to submit, together with the application, all the particulars listed above, the Office will issue a deficiency letter requesting the facts, evidence and arguments. If the applicant does not comply with this request, the application will be rejected as inadmissible in whole or in part (in relation to the particular ground(s), design(s) or right(s) invoked) under Article 30(1) EUDIR.

Priority claims, whether of the earlier right or the contested design, will be examined on their substantive requirements, if necessary, at a later stage of the invalidity proceedings, when the decision is being taken.

For the substantive requirements of a design priority claim see the Guidelines for Examination of registered European Union designs, 6.2.1 Priority and exhibition priority. They apply *mutatis mutandis* for the prior and contested designs.

For the substantive requirements of a registered trade mark priority claim, see the Guidelines for Examination of European Union trade marks, Part B, Examination, Section 2, Formalities, Chapter 11, Priority, paragraph 11.2 Substantive requirements for priority claims.

Unless the Office has sent a deficiency letter pursuant to Article 30(1) EUDIR, new evidence concerning the indication and reproduction of the earlier design(s) or right(s) can no longer be submitted. Additional particulars or new grounds of invalidity submitted after the notification of the application will be rejected as inadmissible to the extent that they would broaden the scope of the original application

for a declaration of invalidity (05/02/2016, R 2407/2014-3, Kitchen utensils, § 21; 22/10/2009, R 690/2007-3, Chaff cutters, § 44 et seq.).

Where the evidence in support of the application is not filed in the language of proceedings, the applicant must, on its own motion, submit a translation of that evidence into that language within 2 months of the filing of such evidence (Article 29(5) EUDIR). The question whether certain parts of the supporting documents may be considered irrelevant for the application, and therefore not translated, is a matter for the discretion of the applicant. In cases where a translation is not submitted, the Invalidity Division may disregard the text portions of the evidence that are not translated and base its decision solely on the evidence before it that has been translated into the language of proceedings (Article 31(2) EUDIR).

Documents in support of an application should be listed in a schedule of annexes appended to the application itself. As best practice, the schedule of annexes should indicate, for each document annexed, the number of the annex (Annex A.1, A.2, etc.), a short description of the document (e.g. 'letter') followed by its date, the author(s) and the number of pages, and the page reference and paragraph number in the submission where the document is mentioned and its relevance is described.

The documents annexed to a submission must be paginated. This is to ensure that all pages of the annexes have been duly scanned and communicated to the other parties.

An assessment on the **substance** of the above facts, evidence and arguments is carried out by the Invalidity Division at a later stage when a decision is taken.

3.10.3 Admissibility in respect of one of the grounds or the earlier rights or prior designs relied on

An application based on more than one ground for invalidity, or more than one earlier right or prior design, is found to be admissible if and insofar as the requirements regarding admissibility are satisfied for at least one of those grounds, and in relation to at least one earlier right or prior design, irrespective of whether or not these requirements are met for the remaining grounds and earlier rights or prior designs.

Since there is no additional time limit granted for substantiation, all the details must be provided in the application. Therefore, from the outset the applicant must submit a complete application for invalidity containing the necessary details required pursuant to Article 28(1) EUDIR, including the facts, evidence and arguments in relation to all the ground(s) and the earlier right(s) or the prior design(s) invoked (see paragraph 3.10.2 Facts, evidence and arguments).

For reasons of procedural economy when examining the admissibility of the application, the Office may choose not to examine whether all the grounds and earlier rights or prior designs invoked in the application are admissible. Instead, it may choose to limit the examination to one ground and one earlier right or prior design. Consequently, the applicant will not be invited to remedy admissibility deficiencies if and insofar as the requirements regarding admissibility are satisfied for at least one of

those grounds and in relation to at least one earlier right or prior design. The exception to this rule concerns the grounds of Article 4(1) EUDR. If a statement is made that the application for invalidity is based on the ground of novelty and/or individual character, the admissibility examination must ensure that the scope of the application is clear. In case of any doubts, the Office will invite the invalidity applicant to clarify if only novelty, individual character or both grounds are invoked, and which prior designs are relevant with respect to each of the grounds.

Where the application is inadmissible in its entirety, the Office will call upon the invalidity applicant to remedy the admissibility deficiencies within 2 months. If the applicant fails to remedy the deficiencies, the application will be rejected as inadmissible (Article 30(1) EUDIR).

The Office assesses the facts, evidence and arguments on the merits of the case at a later stage when a decision is taken. Where the invalidity application does not succeed on the ground and earlier right or the prior design found to be admissible, the Office will examine whether the remaining grounds(s) and earlier rights(s) or prior design(s) are admissible.

If necessary, it will call upon the invalidity applicant to remedy the admissibility deficiencies concerning the remaining earlier rights or prior designs and grounds within 2 months.

Where the deficiencies are remedied in due time, the holder will be invited to submit observations in that respect before the decision on substance is taken. The Office will then decide on the merits of the case based on those remaining ground(s) and earlier rights(s) or prior designs found admissible.

Where the applicant does not comply with the request, the admissibility issue will be dealt with together with the decision on the merits of the case.

The decision on admissibility of the invalidity application can be appealed together with the final decision terminating the proceedings (Article 55(2) EUDR).

3.11 Signing the application

The application for a declaration of invalidity must be signed by the applicant, or its representative if it has one (Article 65(1) EUDIR).

Where there is no signature, the Office will request that the applicant remedy the deficiency within 2 months. If the applicant does not comply, the application will be rejected as inadmissible (Article 30(1) EUDIR). If the application is filed by electronic means, the indication of the name of the sender is deemed equivalent to a signature. For further details on signatures, see the Guidelines Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.1.5.

3.12 Means of filing

An application for a declaration of invalidity may be filed with the Office by e-filing through the User Area on the Office's website (Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means), by post or by personal delivery (Decision No EX-18-5 of the Executive Director of the Office of 3 September 2018 concerning the hours the Office is open to receive submissions by personal delivery relating to REUDs).

Fax is expressly identified as a means of communication in all procedures relating to European Union designs in Article 47(2)(d) EUDIR and Article 51 EUDIR. However, pursuant to Article 2 of Decision No EX-23-13 of the Executive Director on communication by electronic means, **fax can no longer be offered and will no longer be used**, as a means of communication in procedures before the Office, due to technical limitations and malfunctions affecting the reliability and preventing the uninterrupted functioning of communications by fax (and that lie beyond the Office's control).

In the event of a malfunction during the electronic transmission of an application, communication or other document through the specific e-operation or e-filing via the User Area, the Office has made two electronic backup alternatives available:

1. an upload solution located in the Communications section of the User Area; this is a general upload platform that allows documents to be attached and sent to the Office.
2. a file-sharing solution outside the User Area; the Office will provide the account holder with access to a secure file-sharing location where the document(s) in question can be uploaded.

Technical details on the accessibility and functionality of both backup alternatives are available in the Conditions of Use of the User Area. For more information on communication via the User Area, see the Guidelines, Part A, General Rules, Section 1, Means of communication, time limits, paragraph 3.1.1.

3.13 Payment of fees

For general rules on payments, see the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

An application for a declaration of invalidity will be deemed not to have been filed until the fee has been paid in full (Article 52(2) EUDR; Articles 28(2) and 30(2) EUDIR). Therefore, before examining the admissibility of the application, the Office will first check that the fee has been received.

Where the Office finds the fee has not been paid, it will request that the applicant pay the fee within 2 months of receipt of the notification. If the applicant does not comply with the request, the application is deemed not to have been filed and the applicant is

informed accordingly. If the required fee is paid after the expiry of the specified time limit, it will be refunded to the applicant (Article 30(2) EUDIR).

In cases where the fee is received after the expiry of the time limit specified by the Office but the applicant provides proof that, within the time limit, it duly gave an order to a banking establishment to transfer the amount of the payment in a Member State, Article 180 EUTMR will be applied, including the payment of a surcharge where applicable (see Decision No EX-25-06 of the Executive Director of the Office of 7 April 2025 on methods of payment of fees and charges and determining the insignificant amounts of fees and charges, and the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges).

The filing date of an application for a declaration of invalidity is not affected by the date of payment of the fee, since Article 52(2) EUDR does not provide for any consequence regarding the application's filing date. When the fee is paid before the expiry of the time limit specified by Article 30(2) EUDIR, the application is deemed to have been filed and the filing date will be the date the application was received by the Office.

As a general principle, the invalidity fee is an application fee due for the filing of the application regardless of the outcome of the proceedings. Therefore, it will not be refunded if the application is rejected as inadmissible or withdrawn in the course of proceedings.

3.14 Decision to the effect that the application is inadmissible

Where the Office finds the application inadmissible and the deficiency is not remedied within the specified time limit, it will issue a decision rejecting the application as inadmissible (Article 30(1) EUDIR). The fee will not be refunded.

3.15 Decision to the effect that the application is admissible and communication to the holder

When the application for a declaration of invalidity is submitted via e-filing, the REUD holder receives an automated acknowledgement of receipt.

The notification of an application for a declaration of invalidity, constituting the decision on the admissibility of an application for a declaration of invalidity, is issued to the REUD holder only after the application has been found admissible (Article 31(1) EUDIR). This decision can be appealed together with the final decision (Article 55(2) EUDR).

The decision on admissibility may, however, be withdrawn, in accordance with the general principles of administrative and procedural law, if irregularities are detected *ex officio* by the Office, within a reasonable time, or by the REUD holder in its first observations (Article 31(1) EUDIR), and if the applicant for invalidity fails to remedy

these irregularities within the time limit prescribed by the Office (Article 30 EUDIR) (Article 68 EUDR and, by analogy, 18/10/2012, C-402/11 P, Redtube, EU:C:2012:649, § 59).

Where the Office does not reject the application as inadmissible, it is communicated to the holder and a time limit of 2 months is granted to submit observations in response (see 4.1.1 Observations by the holder).

3.16 Participation of an alleged infringer

As long as no final decision has been taken by the Invalidity Division, any third party that proves that proceedings for infringement based on the contested European Union design have been instituted against it can join as a party to the invalidity proceedings (Article 54 EUDR; Article 33 EUDIR).

The alleged infringer must submit its request to be joined as a party within 3 months of the date on which the infringement proceedings were instituted. Unless proof is submitted by the holder that another date should be retained in accordance with the national law in question, the Office will assume that proceedings are 'instituted' on the date of service of the action to the alleged infringer. The alleged infringer must submit evidence in respect of the date of service of the action.

Any third party that proves that (i) the rights holder of the European Union design has requested that it cease an alleged infringement of the design and that (ii) the third party in question has instituted proceedings for a court ruling that it is not infringing the registered European Union design (if actions for declaration of non-infringement of European Union designs are permitted under national law) may also join as a party in the invalidity proceedings (Article 54 and Article 81(b) EUDR).

The request to be joined as a party must be submitted in a written reasoned statement and will not be deemed to have been submitted until the invalidity fee has been paid. The rules explained above in paragraphs 3.1 Form of the application to 3.13 Payment of fees will apply to the alleged infringer (Article 54(2) EUDR; Article 33 EUDIR).

4 Adversarial Stage of the Proceedings

4.1 Exchange of communications

4.1.1 Observations by the holder

4.1.1.1 Generalities

The holder's observations will be communicated to the applicant without delay (Article 31(3) EUDIR).

Documents in support of observations should be listed in a schedule of annexes (see paragraph 3.10.2 above).

The holder should submit its observations (including supporting documents) in duplicate when not using e-filing (see paragraph 3.1 above).

Where the holder submits no observations within the 2-month time limit, the Invalidity Division will notify the parties that the written phase of the proceedings is closed and that it will take a decision on the merits on the basis of the evidence before it (Article 31(2) EUDIR).

4.1.1.2 Request for proof of use of an earlier trade mark

A request for proof of use of an earlier trade mark during the 5 years preceding the date of the application for a declaration of invalidity may be submitted by the holder if the following cumulative conditions are complied with:

- the application is based on Article 25(1)(e) EUDR;
- the earlier distinctive sign is a (European Union, international or national) trade mark having effect in the European Union that, on the date of the application for a declaration of invalidity, has been registered for not less than 5 years;
- the request for proof of use is explicit and is submitted together with the holder's first submission in response to the application (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 66-72; 27/06/2013, T-608/11, Instruments for writing, EU:T:2013:334, § 87; 15/11/2013,R 1386/2012-3, CINTURONES, § 21).

4.1.2 Translation of the holder's observations

Where the language of proceedings is not the language of filing of the contested European Union design, the holder may submit its observations in the language of filing (Article 98(4) EUDR; Article 29(2) EUDIR). The Office will arrange to have those observations translated into the language of proceedings, free of charge, and will communicate the translations to the applicant without delay.

4.1.3 Scope of defence

The holder's observations must include an indication regarding the extent to which it defends the contested European Union design. Where the holder does not give such an indication, it is assumed that it seeks maintenance of the European Union design in the form as originally registered, that is, in its entirety.

Where the holder requests that the European Union design be maintained in an amended form, the request must include the amended form. The amended form must comply with the requirements for protection and the identity of the European Union design must be retained. 'Maintenance' in an amended form may include registration accompanied by a partial disclaimer by the holder or entry in the Register of a court

decision or a decision by the Invalidity Division, declaring the partial invalidity of the European Union design (Article 25(6) EUDR) (see paragraph 5.10 below).

The request to maintain the contested European Union design in an amended form must be submitted during the invalidity proceedings and before the end of the written phase. The applicant will be given the opportunity to comment on whether the European Union design in its amended form complies with the requirements for protection and whether the identity of the European Union design is retained.

The decision on the maintenance of the European Union design in an amended form will be included in the decision on the merits terminating the invalidity proceedings.

4.1.4 Reply by the applicant

4.1.4.1 Generalities

Where the parties' submissions allow the Office to base its decision on the evidence before it, the Office will notify the parties that the written phase of the proceedings is closed.

However, the applicant will be allowed to reply to the holder's observations within a 2-month time limit (Article 53(2) EUDR; Article 31(3) EUDIR), in particular, under the following circumstances:

- where the holder's observations contain additional facts, evidence and arguments that are prima facie relevant for a decision on the merits; or
- where the holder requests to maintain the European Union design in an amended form; or
- where the holder requested proof of use of the earlier trade mark relied on under Article 25(1)(e) EUDR.

Any reply from the applicant will be communicated to the holder (Article 31(4) EUDIR). If the applicant's reply is considered admissible, the holder will be invited to submit a rejoinder (Article 53(2) EUDR).

Where the applicant does not reply within the specified time limit, the Office will notify the parties that the written phase of the proceedings is closed and that it will take a decision on the merits based on the evidence before it (Article 31(2) EUDIR).

The subject matter of the proceedings must be defined in the application (see paragraph 3.10). Reliance on additional earlier designs or rights is inadmissible when submitted at the belated procedural stage of the reply if the effect is to alter the subject matter of the proceedings (22/03/2019, R 1283/2018-3, Goggles (part of-), § 18; 05/02/2016, R 2407/2014-3, Kitchen utensils, § 21; 22/10/2009, R 690/2007-3, Chaff cutters, § 44 et seq.). The admissibility of additional facts, evidence and arguments relating to earlier designs or rights already referred to in the application is subject to the discretionary powers conferred on the Office under Article 63(2) EUDR (see paragraph 2.4).

The applicant should submit its reply in duplicate when not using e-filing (see paragraph 3.1).

4.1.4.2 Translation of the applicant's reply

Any reply of the applicant must be in the language of proceedings. Where the applicant has been invited to reply and its reply is not in the language of proceedings, the applicant must submit, on its own motion, a translation of its reply within 1 month of the date of the submission of the original reply (Article 81(1) EUDIR). The Office will not remind the applicant of its duty in this respect. Where the applicant submits the translation on time, it will be communicated to the holder. Where the applicant does not submit the translation on time, its reply will be deemed not to have been filed.

4.1.4.3 Submission of evidence of use of an earlier trade mark

Where the applicant is requested to submit evidence of use of its earlier trade mark, it must submit such evidence (i) in connection with the goods or services in respect of which this trade mark is registered, and which the applicant cites as justification for its application and (ii) in respect of the period of 5 years preceding the date of the application for a declaration of invalidity, unless there are proper reasons for non-use. Such reasons for non-use must be substantiated.

Evidence of use of an earlier mark must fulfil **all** the cumulative conditions imposed by Article 10(3) EUTMDR, that is, indications concerning **the place, time, extent** and **nature** of use of the earlier trade mark for the goods and services for which it is registered and on which the application is based.

Where the language of the documents submitted by the applicant is not the language of the proceedings, the Office may require that a translation be supplied in that language, within 1 month, or 2 months if the applicant does not have its domicile or its principal place of business or an establishment within the European Union (Articles 57(1) and 81(2) EUDIR).

In the absence of proof of genuine use of the earlier trade mark (unless there are proper reasons for non-use), or in the absence of a translation if so required by the Office, the application for a declaration of invalidity will be rejected to the extent that it was based on Article 25(1)(e) EUDR.

When examining the evidence of use, the Office will apply the principles explained in the Guidelines, Part C, Opposition, Section 7, Proof of use.

4.1.5 End of exchange of observations

Where the parties' observations do not contain additional facts, evidence or arguments that are prima facie relevant for a decision on the merits, and additional observations are not necessary, the Office will inform both parties that the written proceedings

are closed and that a decision will be taken on the basis of the evidence before it (Article 53(2) EUDR).

Facts, evidence or arguments submitted once the Office has already notified the parties that the written phase of the procedure has been closed will be considered inadmissible, save in exceptional circumstances, for example, where the evidence was unavailable at an earlier stage or where a fact came to light in the course of the proceedings (Article 63(2) EUDR, see paragraph 2.4).

4.1.6 Extension of time limits and suspension

4.1.6.1 Extension of time limits

Requests by any of the parties for an extension of a time limit determined by the Office must be submitted before the original time limit expires (Article 57(1) EUDIR).

As a general rule, a first request for extension of a time limit will be granted. Further extensions will not be granted automatically. In particular, the Office may make the extension of a time limit subject to the agreement of the other party or parties to the proceedings (Article 57(2) EUDIR).

Reasons in support of any further request for extension must be submitted to the Office. The request for an extension of the time limit must indicate the reasons why the **parties** cannot meet the deadline. Obstacles faced by the parties' **representatives** do not justify an extension (see, by analogy, 05/03/2009, C-90/08 P, Corpo livre, EU:C:2009:135, § 20-23).

Where a request for extension of an extendable time limit has been filed and received before the expiry of the time limit (30/01/2014, C-324/13 P, Patrizia Rocha, EU:C:2014:60), the party concerned will be granted at least 1 day, even if the request for extension arrived on the last day of the time limit.

The extension will not result in a time limit longer than 6 months (Article 57(1) EUDIR). Both parties are informed about any extension.

For more information on time limits see Part A, General Rules, Section 1, Means of Communication, Time Limits .

4.1.6.2 Suspension

The Office will suspend the proceedings on its own motion after hearing the parties, unless there are special grounds for continuing the proceedings, where it has been brought to the attention of the Office that the validity of the contested European Union design is already in issue on account of a counterclaim before a competent national court, and the national court does not stay its proceedings (Article 91(2) EUDR).

The Office may also suspend the proceedings when it is appropriate, in particular in the circumstances listed here.

- Where the request for a declaration of invalidity is based on an earlier design or trade mark for which the registration process is pending, until a final decision is taken in those proceedings (Article 25(1)(d) and (e) EUDR).
- Where the request for a declaration of invalidity is based on an earlier design, trade mark or other earlier right, the validity of which is challenged in administrative or in court proceedings, until a final decision is taken in those proceedings.
- Where the Office receives a joint request for suspension signed by both parties with a view to reaching an amicable settlement (Article 31(5) EUDIR).
- Where a number of applications for a declaration of invalidity have been filed relating to the same European Union design, and where a preliminary examination reveals that the European Union design may be invalid on the basis of one of these applications. The Office will deal with this application first and may suspend the other invalidity proceedings (Article 32(2) EUDIR).

The Office has broad discretionary powers when deciding on the appropriateness of the suspension. The decision on the suspension must take into account the balance between the parties' respective interests, including the applicant's interest in obtaining a decision within a reasonable period of time (see, by analogy, 16/05/2011, T-145/08, Atlas, EU:T:2011:213, § 68-77).

The Office will notify the parties of its decision to grant or refuse a suspension, giving reasons and explaining which factors it considers when exercising its discretion. Where the Office decides not to grant the suspension, reasons may instead be given in the decision terminating the proceedings. Where a suspension is granted for a determined period, the Office will indicate in its communication the date of resumption of the proceedings. The proceedings will resume the day after the expiry of the suspension.

Where a suspension is granted for an undetermined period, the invalidity proceedings will be resumed when the parties inform the Office or when it has been brought to the attention of the Office that the event that justified the stay has occurred, or ceased to exist, as the case may be. The date of resumption will be indicated in the communication of the Office or, in the absence of such indication, on the day following the date of that communication.

Where the suspension was requested jointly by the parties, the period will always be 6 months regardless of the period requested by the parties. Any party can bring the suspension to an end ('opting out'). It is immaterial whether the other party disagrees with or has consented to it.

If one of the parties 'opts out', the suspension will end 2 weeks after the parties have been informed thereof. The proceedings will resume the day after.

Where a time limit was running at the time of the suspension, the party concerned will be given 2 months from the date of resumption of the proceedings to submit its observations.

4.1.7 Taking of evidence

The parties may submit evidence in the form of documents and items of evidence, opinions by experts and witnesses, and/or statements in writing, sworn or affirmed or having a similar effect under the law of the state in which the statement is drawn up (Article 65(1) EUDR).

Where a party offers evidence in the form of witness statements or expert opinions, the Office will invite the party to provide the statement of the witness or the opinion of the expert in writing, except where a hearing is considered expedient (Article 65 EUDR; Articles 43 and 46 EUDIR).

For more information, see the Guidelines, Part A, General Rules, Section 10, Evidence.

4.1.8 Oral proceedings

Oral proceedings may be held at the request of the Office or of any of the parties (Article 64 EUDR; Article 38(1) and Article 42 EUDIR).

Where a party requests that they be held, the Office enjoys broad discretionary powers as to whether oral proceedings are really necessary. A hearing will not be held when the Office has before it all the information needed as a basis for the operative part of the decision on invalidity (13/05/2008, R 135/2007-3, Macchine da gioco automatiche, § 14).

The Office will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 4, Oral proceedings.

4.2 Examination

4.2.1 Commencement of examination

The Invalidity Division begins with the examination of the application as soon as the parties are informed that the written phase of the procedure is closed and that no further observations can be submitted (Article 53 EUDR).

4.2.2 Examination of the grounds for invalidity

The grounds for declaring a European Union design invalid are listed exhaustively in Article 25 EUDR. An application for a declaration of invalidity based on a ground other than those listed in the EUDR (e.g. a claim that the holder was acting in bad faith when applying for the registered European Union design) will be rejected as inadmissible

as far as the ground in question is concerned (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 30-31).

The selection and indication of a ground or grounds of invalidity in the application form is a valid declaration of the ground(s) on which the application is based.

The Office must, however, examine an application in the light of all grounds put forward in the statement of grounds, even if the corresponding boxes in the application form were not ticked. Therefore, where the applicant indicated in the statement of grounds that the contested European Union design was 'not novel', that indication constitutes a valid statement of grounds even if the 'Grounds' box concerning the requirements of Articles 4 to 9 EUDR was not ticked (02/08/2007, R 1456/2006-3, Saucepan handles, § 10).

The examination will not be extended to grounds not relied on in the application. Where an applicant exclusively invokes, for instance, either the novelty or the individual character of a European Union design as a ground for invalidity, the Office will only examine the ground invoked (14/03/2018, T-424/16, Footwear, EU:T:2018:136, § 47).

The applicant cannot raise new grounds for invalidity after the notification of the invalidity application (10/02/2016, R 1885/2014-3, Logos, § 15-19). However, the applicant may file another application for a declaration of invalidity based on the same or different grounds.

Where the application can be upheld on the basis of one of several grounds put forward by the applicant, the Invalidity Division will not take a decision on the others (15/12/2004, ICD No 321). Where an application can be upheld on account of the existence of one of the earlier designs or rights relied on by the applicant, the remaining earlier designs or rights will not be examined (14/06/2011, T-68/10, Watches, EU:T:2011:269).

Where the application cannot be upheld on the basis of one of the several grounds or one of the earlier designs or rights found to be admissible, the Office will examine the remaining grounds and rights or prior designs and reopen the admissibility where necessary (see paragraph 3.10.3, Admissibility in respect of one of the grounds or the earlier right or prior designs relied on).

For the examination of the substantive requirements concerning the validity of a priority claim in the course of invalidity proceedings, see the Guidelines, Examination of Applications for Registered European Union Designs, paragraph 6.2.1.1, Priority.

Irrespective of the ground or grounds for invalidity, the contested European Union design's validity should be assessed only based on the representation in the application, as published in the Register. This is because the protection conferred on a registered European Union design extends to all the features visibly shown in the application for registration, as published in the Register (Article 18a EUDR).

5 The Different Grounds for Invalidity

5.1 Not a design

According to Article 25(1)(a) EUDR, a European Union design may be declared invalid if the design does not correspond to the definition under Article 3(1) EUDR. This would be the case where the views of the European Union design are inconsistent and represent different products (other than forming a 'set of products', see Article 3 EUDR and the Guidelines, Examination of Applications for Registered European Union Designs, additional requirements regarding the reproduction of the design, paragraph 5.3.7, Sets of articles), or where the graphical representation consists of mere representations of nature (landscapes, fruits, animals, etc.) that are not products within the meaning of Article 3(2) EUDR.

5.1.1 Living organisms

A design that discloses the appearance of a living organism in its natural state, in principle, has to be refused. Even if the shape at issue deviates from that of the common corresponding living organism, the design should be refused if nothing suggests prima facie that the shape is the result of a manual or industrial process (see, by analogy, 18/02/2013, R 595/2012-3, GROENTE EN FRUIT, § 11).

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A European Union design will not be declared invalid if it is apparent from the representation that the product does not show a living organism or if the indication of the product specifies that the product is artificial (see, in particular, Class 11-04 of the Locarno Classification).

5.1.2 Ideas and methods of use

The law relating to designs protects the appearance of the whole or a part of a product, but does not protect the underlying idea of a design (06/06/2013, T-68/11, Watch-dials,

EU:T:2013:298, § 72). Nor is the method of use or operation protected by a design (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 52).

5.2 Contrary to public policy or morality

According to Article 25 (1)(b) EUDR, a European Union design may be declared invalid if it does not fulfil the requirements of Article 9 EUDR.

The Office will apply the concepts of public policy and morality as explained in the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal.

5.3 Lack of entitlement

According to Article 25(1)(c) EUDR, a European Union design may be declared invalid if, by virtue of a court decision, the rights holder is not entitled to the European Union design under Article 14 EUDR.

This ground may be invoked solely by the person who is entitled to the European Union design under Article 14 EUDR.

In the absence of a court decision, the Invalidity Division cannot declare the contested European Union design invalid under Article 25(1)(c) EUDR (11/02/2008, R 64/2007-3, Loudspeakers, § 15).

It is clear from the words 'by virtue of a court decision' in Article 25(1)(c) EUDR that the Invalidity Division has no jurisdiction to determine who is entitled to a European Union design under Article 14 EUDR. Such jurisdiction belongs to any national court that is competent under Article 27 and Article 79 EUDR in conjunction with Article 93 EUDR.

As to a change of ownership of the REUD, reference is made to the Guidelines, Part E, Register operations, Section 3, EUTMs and REUDs as objects of property, Chapter 2, Licences, rights *in rem*, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, 8.2 Entitlement proceedings for REUDs.

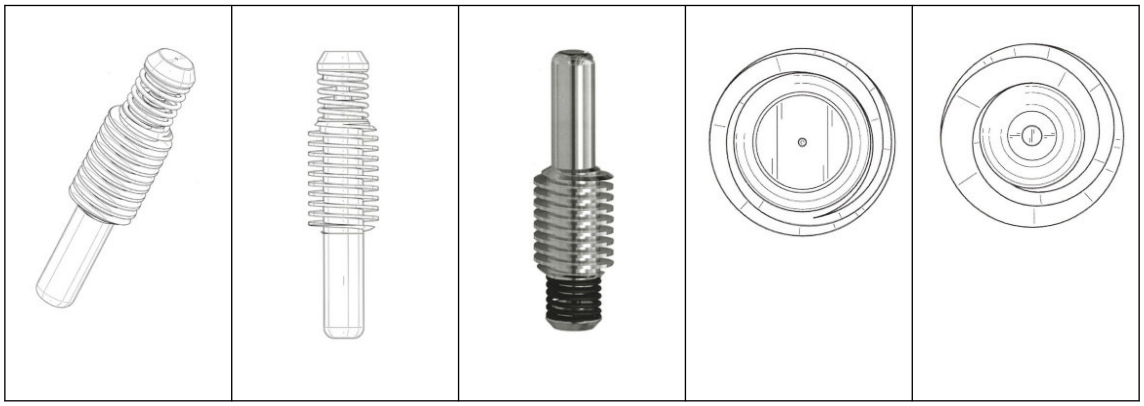
5.4 Invisible component parts of complex products

Features of a European Union design applied to, or incorporated in, a 'component part of a complex product', will be disregarded if they are invisible during normal use of the complex product in question (Article 4(2) EUDR and Recital 13 Amending Regulation).

'Complex product' means a product that is composed of multiple components that can be replaced, permitting disassembly and reassembly of the product (Article 3(3) EUDR). For instance, the visibility requirement does not apply to a European Union design representing the appearance of a dustbin as a whole because though dustbins may be complex products, they are not component parts of complex products (23/06/2008, ICD No 4 919).

Likewise, the requirement under Article 4(2) EUDR does not apply to an electrode designed to be inserted into a welding torch given, inter alia, its consumable nature, the absence of disassembly and reassembly of the torch when the electrode is replaced, and the fact that the torch is regarded as complete without the electrode (22/03/2023, T-617/21, Welding torches (part of -), EU:T:2023:152, § 55-69).

Table 1: REUD No 1292122-0001 (5 of 7 views)



An assessment *in abstracto* of the visibility of the component part incorporated into a complex product, unconnected to any practical situation of use of the product, is not sufficient to allow a component part to benefit from protection as a design. Visibility of a component part of a complex product should be assessed from the perspective of the end user of that product, but also from the perspective of an external observer (16/02/2023, C-472/21, Monz Handelsgesellschaft International, EU:C:2023:105, § 45-46).

'Normal use' means use by the end user, excluding maintenance, servicing or repair work (Article 4(3) EUDR). 'Normal use' is the use made in accordance with the purpose for which the complex product is intended.

'Normal use' covers acts performed during the principal use of a complex product as well as acts which must customarily be carried out by the end user in connection with such use (which, depending of the product, may include its storage and transportation) (16/02/2023, C-472/21, Monz Handelsgesellschaft International, EU:C:2023:105, § 55-56).

For instance, for safety reasons, an electrical connector is a component part that is normally incorporated in a casing in order to be shielded from any contact with potential users when a complex product, such as a train or an electric vehicle, is in operation. The fact that this component part of a complex product can theoretically be made visible when inserted in a transparent casing or cover constitutes a purely hypothetical and random criterion that must be disregarded (03/08/2009, R 1052/2008-3, Contacteurs électriques, § 42-53).

Where none of the features of a European Union design applied to a component part (e.g. a heat exchanger insert) is visible during normal use of the complex product

(e.g. a heat exchanger), the European Union design will be invalidated as a whole (20/01/2015, T-616/13, Heat Exchanger Inserts, EU:T:2015:30, § 14-16).

However, Article 4(2) EUDR does not require a component part to be clearly visible in its entirety at every moment of use of the complex product. It is sufficient if the whole of the component can be seen some of the time in such a way that all its essential features can be apprehended (16/02/2023, C-472/21, Monz Handelsgesellschaft International, EU:C:2023:105, § 45).

5.5 Technical function

Article 8(1) EUDR provides that 'a European Union design shall not subsist in features of appearance of a product which are solely dictated by its technical function'.

Those features of a design that are found solely dictated by the technical function are excluded from protection and not taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection (Recital 10 EUDR; 18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 23).

5.5.1 Rationale

The aim of Article 8(1) EUDR is to prevent technological innovation from being hampered by the granting of design protection to features dictated solely by a technical function of a product (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 29).

Article 8(1) EUDR, read together with Article 25(1)(b) EUDR, provide that an REUD is invalid **as a whole** if it is shown to consist exclusively of features of the appearance of a product that are solely dictated by its technical function, even if other designs fulfilling the same function exist (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32).

If **at least one** of the features of the appearance of the product covered by a contested design is not solely dictated by the technical function of that product, the design cannot be declared invalid under Article 8(1) EUDR (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 96).

Article 8(1) EUDR will also be ruled out if:

- the REUD holder establishes that considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have played a role in the choice of those features (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31) (though this does not mean that a design must have an aesthetic quality (recital 10 EUDR)); or
- the REUD holder establishes that the REUD concerns a design that serves to facilitate the multiple assembly or connection of mutually interchangeable products within a modular system (see paragraph 5.5.2.5).

5.5.2 Examination

Applying Article 8(1) EUDR requires a three-step analysis:

- determining the technical function of the product concerned;
- identifying the features of appearance of that product;
- examining, in the light of all the relevant objective circumstances, whether those features are solely dictated by the technical function of the product concerned and, if so, whether the REUD holder has established that other considerations have played a role in the choice of the features (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 98).

5.5.2.1 Determining the technical function and the features of appearance of the product

The first step of the examination of Article 8(1) EUDR consists of determining which is the relevant product function within the category of products at issue. The relevant category of products is identified by both the product indication (see Examination of applications for registered European Union designs, paragraph 6.1.5), and the design itself (see paragraph 5.7.2.2, Individual character).

The second step consists of determining what the features of appearance are.

The features of appearance of the contested design are examined by the Office, taking into account the parties' submissions (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 105-108).

The function performed by the product in which the REUD is incorporated, as well as that of each of its features of appearance, will, in principle, not be examined *ex officio* by the Office and must be explained by the invalidity applicant (Article 63(1) EUDR; and paragraph 5.5.2.2, Burden of proof).

5.5.2.2 Appropriate evidence of functionality

Article 8(1) EUDR requires an **objective** assessment having regard, in particular, to the design at issue, the objective circumstances behind the reasons that dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs that fulfil the same technical function. The circumstances, data or information on the existence of alternative designs must, however, be supported by **reliable evidence**.

Burden of proof

The burden of proof lies with the invalidity applicant who must provide evidence that all the features of the contested design are solely dictated by the technical function of the product concerned (Article 63(1) EUDR; 21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 60).

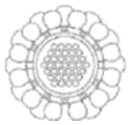
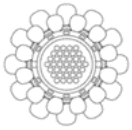
Other intellectual property rights in respect of the product concerned

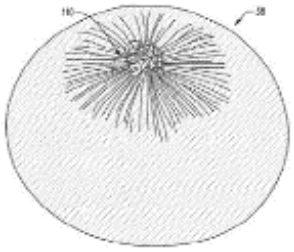
A design protected by a European Union design does not preclude protection by other forms of intellectual property including patents and utility models (Article 96 EUDR).

Patents and utility models relied on in invalidity actions based on Article 8(1) EUDR need not predate the contested REUD for them to be relevant. Invalidity actions based on Article 8(1) EUDR differ in purpose from the ground under Articles 5 and 6 EUDR (novelty and individual character).

Patents or utility models may help to analyse the product incorporating the contested design and identify the elements that make up the product and contribute to its technical function to see if they correspond to the features of its appearance (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 96). However, the fact that the patent or utility model is granted or applied for for a product with the same or similar appearance, cannot in itself, without further facts, evidence and arguments, establish that all features of the contested design are solely dictated by the technical function of the product (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 81; 19/10/2022, T-231/21, Posts, EU:T:2022:649, § 32).

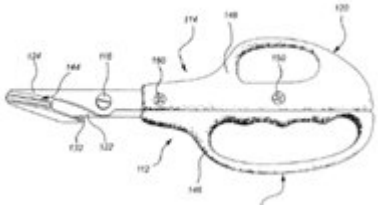
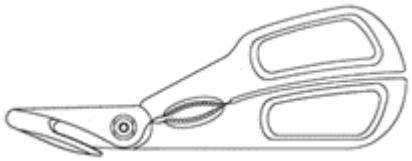
Here are examples of REUDs in which a patent or utility model containing an identical or quasi-identical representation to that of the REUD played a role in the assessment of the features of the product based on Article 8(1) EUDR:

	
Patent	Contested design 18/11/2020, T-574/19, Fluid distribution equipment

	
Utility model	Contested design 26/01/2022, T-325/20, Water purifiers

A patent or utility model containing a representation that is **different** to that of the REUD may still be relevant if the description or claims made in the document explain why the features that are the same shape as the contested REUD's might achieve the same function.

This result is however not automatic if the parties fail to submit arguments and evidence explaining why all the features of appearance of the contested REUD (including those that are not disclosed in the patent or utility model) are solely dictated by a function. This is illustrated by the following example:

	
Patent	Contested design 10/05/2021, R 440/2020-3, Handheld kitchen cutting appliances

The patent only proved the technical function of the blades pivotally connected and the blade edge curved like a hook, but not that of the rectangular curved shape of the finger rings or the handle shanks in the middle section of the scissors. Given that only part of the features of the contested design were proven to be dictated by the technical function of a pair of scissors within the meaning of Article 8(1) EUDR, the application for a declaration of invalidity was rejected.

The drawings in themselves cannot be evidence of technical function but must be read together with the claims and the description of the invention in order to:

- determine whether or not the design contains features that are visible in the drawings of the patent or utility model but whose function is not covered or is not explained by the claims or the description;

- assess whether or not the **appearance** of a given feature may be linked to a technical function (i.e. the shape/position of a specific feature being required to achieve the desired technical result).

Expert opinions and general information on the use of the product

Expert opinions or any information on the use of the product, in particular that of a technical nature, may serve to illustrate its functioning, including that of its individual features. This information may be contained in the description of the concrete product, promotional material, such as catalogues and brochures, or videos showing its use.

5.5.2.3 Examination

The Office will examine whether, in the light of the invalidity applicant's evidence and arguments, each of the features making up the contested REUD is proven to be dictated by the product's function.

The fact that the contested REUD may consist of different features, each of which has a **different function**, may not rule out the application of Article 8(1) EUDR. The interpretation of the term 'solely' in this provision does not require that the contested REUD's features must refer to a single technical result (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 56).

Article 8(1) EUDR may apply to shapes where the graphical representation does not disclose **the entirety** of the elements that are necessary for the implementation of the technical solution, provided it is shown that this technical solution requires, for the product to operate properly, the essential characteristics that can be seen in the graphical representation.

To put it in simple terms, where a technical function of a product requires the interaction of three elements 'A', 'B' and 'C', Article 8(1) EUDR must apply to each of these individual elements if they are filed as an REUD on their own.

Interconnecting features may fall within both Articles 8(1) and 8(2) EUDR. Interconnecting features may be solely dictated by the technical function of the product (i.e. to allow it to be connected to and disconnected from another product), unless the REUD holder shows that the features of interconnection were designed in a way that visual considerations play a role (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 59-63).

If **at least one** of the features of appearance of the product covered by a contested REUD is not solely dictated by the technical function of that product, the REUD cannot be declared invalid under Article 8(1) EUDR (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 96). The REUD remains on the Register as a whole, that is, as a combination of arbitrary features and solely functional features. Such an REUD is liable to be invalidated on the ground of lack of individual character if the addition of the arbitrary features does not create a sufficiently far-removed impression compared to a prior design, which for this purpose can be disclosed in an earlier patent or utility model (see paragraph 5.7.2 Assessment of novelty

and individual character, ‘Features dictated by a technical function and features of interconnection’).

5.5.2.4 Defence of the holder

Where each and every feature of the contested REUD is found to be solely dictated by a function because a causal link between its appearance and the function of the product exists according to the principles set out in paragraph 5.5.2.3 Examination, the Office will assume that these features were chosen and combined exclusively for technical reasons.

It is for the REUD holder to submit counter arguments and evidence establishing that considerations of another nature, particularly those related to the product’s visual aspect, have played a role in the choice of those features (Article 63(1) EUDR).

Multiplicity of shapes

The mere existence of alternative designs that fulfil the same technical function cannot, in itself, exclude the finding that all the features of appearance of a product are solely dictated by its technical function (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32, 37).

Nevertheless, the existence of alternative shapes may in some cases be a relevant indication that considerations other than the technical function of the product have played a role in the choice of features (19/10/22, T-231/21, posts, ECLI:EU:T:2022:649, § 45).

Aesthetic considerations

A design is not required to have an aesthetic quality (recital 10 EUDR; 08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 23, 31). However, if it can be established by the REUD holder that it has aesthetic quality, this remains a relevant factor.

It is for the REUD holder to explain that the choice of features was dictated by more than purely technical considerations and to prove how these features add to the visual aspect of the design (19/10/22, T-231/21, posts, ECLI:EU:T:2022:649, § 49-54).

Aesthetic considerations must be reflected in an objective manner and cannot be a matter of personal taste. General statements about the elegance or simplicity of the contested REUD that are not supported by objective evidence are likely to be inconclusive of other considerations that have played a role in the choice of the functional features (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543; 26/01/2022, T-325/20, Water purifiers, EU:T:2022:23, § 59-61).

The success of a product on the market does not imply as such that considerations unrelated to functional needs were considered by the designer. The same conclusion applies to awards where the criteria for their adjudication do not relate solely to the design of the products at issue (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 102).

5.5.2.5 Modular systems

Given the overlap between Articles 8(1) and 8(2) EUDR, Article 8(3) EUDR is an exception applying to both grounds of functionality and interconnection.

The Office must examine if the design may benefit from the derogation applicable to modular systems, including where the request for invalidity was not based on Article 8(2) EUDR, provided the REUD holder raised a defence based on Article 8(3) EUDR in due course (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 69-80).

5.6 Designs of interconnections

Features of an REUD are excluded from protection if they must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against another product so that either product may perform its function. If Article 8(2) EUDR applies to **all the features** of the REUD, the latter must be declared invalid (20/11/2007, ICD No 2 970).

It is up to the invalidity applicant to prove that an REUD may be objected to on the basis of Article 8(2) EUDR. The applicant must substantiate the existence of the product whose form and dimensions dictate those of the REUD and submit facts, evidence and arguments demonstrating the interaction between the REUD and an existing product.

As an exception, Article 8(2) EUDR does not apply to an REUD that serves the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system (Article 8(3) EUDR). It is up to the holder to prove that the REUD serves such a purpose.

5.7 Lack of novelty and individual character

5.7.1 Disclosure of earlier design

5.7.1.1 General principles

Challenging the validity of a European Union design on account of its lack of novelty or individual character requires proof that the earlier design that is identical or that produces the same overall impression was made available to the public before the date of filing of the application for registration or, if a priority is claimed, before the date of priority (Article 7 EUDR).

Disclosure of the earlier design is a preliminary step before deciding whether it is identical to the contested European Union design or produces the same overall impression on the informed user (23/10/2018, T-672/17, Cot bumpers, EU:T:2018:707, § 30). Therefore, if it is not proven that the earlier design has been disclosed, the application for declaration of invalidity will be rejected insofar as it is based on Articles 5 and 6 EUDR.

Assessing disclosure of an earlier design requires a two-step analysis. Firstly, the invalidity applicant must prove the event of disclosure, that is, that the invoked earlier design was published following registration, or otherwise exhibited, used in trade or otherwise disclosed (see paragraph 5.7.1.2). Secondly, the holder of the contested European Union design can claim that that event of disclosure should not be taken into consideration because either of the exceptions to disclosure provided in Article 7(1) EUDR apply (see paragraph 5.7.1.3) (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 48; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 24; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 20).

Therefore, the earlier design will be considered as having been disclosed when at least one event of its disclosure is established, and provided that none of the exceptions contained in Article 7(1) EUDR apply.

Nevertheless, a disclosure must not be taken into consideration if a design was made available to the public during the 'grace period' by the designer, his or her successor in title or a third person as a result of information provided or action taken by the former, or as a consequence of an abuse in relation to the designer or his or her successor in title as provided in Article 7(2) and (3) EUDR (see paragraph 5.7.1.4).

5.7.1.2 Establishing the event of disclosure

For the purpose of establishing the event of disclosure, the following aspects need to be considered.

1. The source of the design's disclosure

   In general, a design can be disclosed anywhere in the world (13/02/2014, C-479/12, "Athen" gazebo, EU:C:2014:75, § 33), including on the internet (see paragraph 5.7.1.5) and through various sources (e.g. by publishing in a catalogue, displaying in a trade fair, offering in an online store).

   The evidence submitted must clearly identify the respective source of disclosure. It might also be important to submit any further information regarding that source, such as its purpose or targeted public (11/12/2019, R 311/2019-3, Hookahs, § 23).

2. The design invoked

   The invoked earlier design should be identified and reproduced precisely and in its entirety (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 65).

The Office is not required to determine through assumptions and deductions which designs among those represented in the evidence may be relevant in respect of the invalidity application (see paragraph 3.10.2). Moreover, the relevant features of the earlier design should be clearly displayed in the evidence (06/03/2024, T-647/22, Shoes, EU:T:2024:147, § 54). Where the views of the earlier design submitted do not enable its comparison with the contested REUD, this does not amount to a disclosure for the purpose of Article 7(1) EUDR (10/03/2008, R 586/2007-3, Barbecues, § 22 *et seq*.).

For the purpose of Article 7 EUDR, it is immaterial whether or not an earlier 'design' within the meaning of Article 3(1) EUDR enjoys or has enjoyed legal protection (as a design, trade mark, copyright work, patent, utility model or otherwise) (21/05/2015, T-22/13 & T-23/13, Umbrellas, EU:T:2015:310, § 24).

3. The date when the design was disclosed

When assessing disclosure of the earlier design, it is crucial to establish the date when it was made available to the public. That date must be prior to the date of filing of the contested REUD's application for registration or, if a priority is claimed, the date of priority.

The date of disclosure is when a product to which a design is applied, or in which it is incorporated, was made publicly available and not when the circles specialised in the sector concerned actually became aware of this disclosure.

It is enough for the disclosure to take place at a point in time that can be identified prior to the filing date or priority date of the contested REUD, even if the exact date of disclosure is unknown (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 34).

Neither the EUDR nor the EUDIR provides for any specific form of evidence required to establish the event of disclosure. Article 28(1)(b)(v) EUDIR only states that 'documents proving the existence of those earlier designs' must be submitted, nor are there any provisions as to any compulsory form of evidence that must be submitted. Article 65 EUDR lists possible means of giving evidence before the Office, but it is clear from its wording that the list is not exhaustive ('shall include the following'). Accordingly, the evidence in support of the event of disclosure is a matter for the discretion of the applicant and, in principle, any evidence capable of proving the event could be accepted (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 21; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 21).

The Office carries out an overall assessment of this evidence by considering all the relevant factors in the particular case. An event of disclosure cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 21-24; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 22).

A global examination of the items of evidence relating to the same earlier design implies that these items must be assessed in light of each other. Even if some items of evidence are not conclusive in themselves, they may contribute to establishing the event of disclosure when examined in combination with other items (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 25, 30-45; 27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 24; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 52; 17/05/2018, T-760/16, Fahrradkörbe, EU:T:2018:277, § 42, 45 and 50; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 22).

Regarding 'statements in writing, sworn or affirmed', such as affidavits, as a matter of principle, they would not in themselves be sufficient to prove a fact like the event of disclosure of an earlier design. They should be corroborated by additional evidence, particularly when they originate from the invalidity applicant itself or related persons (18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 29). To assess the evidential value of an affidavit, attention should be given first and foremost to the credibility of the account it contains. It is then necessary to consider, in particular, the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 39-40). The Office will apply the principles explained in the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 5.3.2.3, Declarations.

In the absence of any indications to the contrary, the authenticity of the evidence submitted is assumed. The mere possibility of manipulating the relevant information is not enough to raise doubts as to its authenticity. Therefore, the evidence presented would only be rejected in cases of serious and substantiated doubt (27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 89-90; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 28-29).

Official publications

The publication of an earlier design in the bulletin of any intellectual property office worldwide constitutes an event of disclosure (21/05/2015, T-22/13 & T-23/13, Umbrellas, EU:T:2015:310, § 37). The same applies where the publication concerns the appearance of a product in relation to any other kind of intellectual property right, such as trade marks (16/12/2010, T-513/09, Ornamentación, EU:T:2010:541, § 20) or patents (15/10/2015, T-251/14, Doors (part of -), EU:T:2015:780, § 22).

However, a document kept by an intellectual property office that is available to the public only by means of an application for inspection of files may not be considered to have become known in the normal course of business to the specialised circles in the sector concerned. Therefore, it would not give rise to a disclosure of an earlier design within the meaning of Article 7 EUDR (22/03/2012, R 1482/2009-3, Insulation blocks, § 39-43; 15/04/2013, R 442/2011-3, Skirting boards, § 26).

To prove the event of disclosure, the evidence must allow the date of publication to be established independently of the date of filing or date of registration. Whether or not the publication takes place before registration or after is irrelevant (15/04/2013, R 442/2011-3, Skirting boards, § 24).

Moreover, the date of publication can be identified by the reference to the relevant INID code (internationally agreed numbers for the identification of (bibliographic) data).

Exhibitions

Exhibiting a design at a trade fair exhibition anywhere in the world generally constitutes an event of disclosure (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 67).

Evidence from trade fairs must clearly depict the earlier design. It is also important to link the evidence to the particular event. A list of participants, a plan of stands or even contractual details with organisers may contribute to proving the design's disclosure.

Use in trade

Use in trade is another example given in Article 7(1) EUDR of an event of disclosure, irrespective of whether such use is made within or outside the EU (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 68).

A design can be considered disclosed even when there is no proof that the products in which the earlier design is incorporated have actually been produced or put on the market (21/05/2015, T-22/13 & T-23/13, Umbrellas, EU:T:2015:310, § 36). It may be sufficient that the products were offered for sale in catalogues (22/10/2007, R 1401/2006-3, Ornamentation, § 25), imported from a country outside the EU (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32) or were the object of an act of purchase between two European operators (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 30-45).

When submitting catalogues as evidence of disclosure, it is preferable that they be provided in their entirety. However, depending on the particular case, it may be sufficient to submit only excerpts from their relevant parts (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 35). Moreover, when combined or read in conjunction with other items of evidence, a catalogue can serve to establish disclosure even in the absence of evidence showing its distribution (27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 30-33).

5.7.1.3 Exceptions to disclosure

If the event of disclosure is duly established, there is a presumption that the earlier design has been disclosed within the meaning of Article 7(1) EUDR (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 47; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 23; 27/02/2020, T-159/19, Furniture, EU:T:2020:77, § 41).

Nevertheless, the holder of the contested European Union design can refute this presumption by proving that any of the exceptions to disclosure provided in Article 7(1) EUDR apply in respect of the event of disclosure.

Designs deemed not to have been made available to the public

Following Article 7(1) EUDR, a design will be deemed to have been made available to the public except where the event of disclosure could not reasonably have become

known in the normal course of business to the circles specialised in the sector concerned operating within the EU.

Therefore, the party challenging the disclosure must establish to the requisite legal standard that the case's circumstances could reasonably prevent the event of disclosure from becoming known to those specialised circles (15/10/2015, T-251/14, Doors (parts of), EU:T:2015:780, § 26; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 26; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 47; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 23).

When there is more than one event of disclosure (e.g. a design has been presented in a trade fair and offered for sale in an online shop), the presumption would have to be rebutted in respect of them all.

The presumption set out in Article 7(1) EUDR applies irrespective of where an event of disclosure took place. It is therefore not limited to EU territory (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 27). The question whether events of disclosure outside the EU could reasonably have become known to persons forming part of those circles is a question of fact. The answer to that question must be assessed on the basis of the particular circumstances of each individual case (13/02/2014, C-479/12, "Athen" gazebo, EU:C:2014:75, § 34; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 55).

In the context of Article 7(1) EUDR, what matters is whether the 'circles specialised in the sector concerned' have had an opportunity to access the design irrespective of the number that actually seized this opportunity and might have encountered the disclosed design. Therefore, there is no quantitative threshold regarding actual knowledge of the disclosure events (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 73).

It must be examined, on the basis of the facts to be adduced by the party challenging the disclosure, whether it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, while considering what might reasonably be required of those circles in terms of being aware of prior art. These facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as its interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the products concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can only become aware of it by chance (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 56).

The 'sector concerned', within the meaning of Article 7(1) EUDR, is not limited to that of the product in which the contested European Union design is intended to be incorporated or applied (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 103). Moreover, Article 7(1) EUDR does not lay down any restrictions as to the nature of the activity of the natural or legal persons who may be considered to form part of the 'sector concerned'. Consequently, apart from the

persons involved in creating the designs and developing or manufacturing the products based on those designs within the sector concerned, traders may also form part of the 'specialised circles' within the meaning of Article 7(1) EUDR (see, by analogy, 13/02/2014, C-479/12, "Athen" gazebo, EU:C:2014:75, § 27).

Disclosure to a third person under explicit or implicit conditions of confidentiality

Making a European Union design available to a third person under explicit or implicit conditions of confidentiality will not be deemed to constitute its disclosure (Article 7(1) EUDR).

Therefore, disclosure of a design to a third party in the context of commercial negotiations is ineffective if the parties concerned agreed that the information exchanged should remain secret (20/06/2005, ICD No 172, § 22).

The burden of proving facts establishing confidentiality lies with the holder of the contested European Union design (08/07/2020, T-748/18, Pneumatic power tools, EU:T:2020:321, § 25).

5.7.1.4 Grace period

Article 7(2) EUDR provides for a 'grace period' of 12 months preceding the date of filing or the priority date of the contested European Union design. Disclosure of the European Union design within such a period will not be taken into consideration if it was made by the designer or its successor in title.

As a matter of principle, the holder must establish that it is either the creator of the design upon which the application is based or the successor in title to that creator, failing which Article 7(2) EUDR cannot apply (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 26-29).

Moreover, acts of disclosure made by a third person as a result of information provided or action taken by the designer or its successor in title are also covered by Article 7(2) EUDR. This can occur, for instance, where a third party has made public a design copied from the design for which protection is sought because that was previously disclosed within the grace period by the holder itself (02/05/2011, R 658/2010-3, LEUCHTVORRICHTUNGEN, § 37-39).

The exception provided in Article 7(2) EUDR may apply where the disclosed design is either identical to the contested European Union design within the meaning of Article 5 EUDR, or the disclosed design does not produce a different overall impression within the meaning of Article 6 EUDR.

The 'grace period' also applies where the disclosure of a design is the result of an abuse in relation to the designer or its successor in title (Article 7(3) EUDR). Whether the disclosure is the result of fraudulent or dishonest behaviour will be assessed on a case-by-case basis in the light of the facts, arguments and evidence submitted by the parties (25/07/2009, R 552/2008-3, LECTEUR ENREGISTREUR MP3, § 24-27).

5.7.1.5 Specificities of design disclosures on the internet

A growing number of design disclosures happen on the internet. For this reason, the Office and a number of Member State intellectual property offices have agreed on a Common Practice 'Criteria for Assessing Disclosure of Designs on the Internet (CP10)'.

The selected principles and recommendations set out in the Common Communication CP10 have been included in this section of the Guidelines, which can be consulted for further guidance.

The following sections deal with the specificities of design disclosure on the internet.

Sources of disclosure on the internet

The internet provides a number of possible sources for disclosure of a design.

Websites are among the most common sources of design disclosure on the internet, in particular those related to e-commerce and social media. Therefore, displaying a product on a website to which the design is applied or in which it is incorporated would generally constitute its disclosure.

Emails can also qualify as sources of design disclosure, in particular those that aim to promote products and are sent to a large number of recipients (27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 93).

Further, designs can be disclosed through mobile applications, file sharing, etc.

Establishing the relevant date of disclosure on the internet

The information available on websites that is relevant for disclosure (e.g. articles, videos, product reviews, sale offers) should show the date when it was published.

However, the relevant date may not be visible in the contents of a website. Instead, only the date that a printout is made would be displayed, and this is normally later than the date of filing of the application of the contested European Union design or its date of priority.

Nevertheless, various tools are available on the internet that can be used to retrieve historic information on a particular website, including the date of disclosure of a design. For instance, website archiving services (such as the 'WayBack Machine') can provide access to archived websites or parts thereof showing a design on a particular date in the past. The date when a website was archived would be considered the date of disclosure, unless an earlier relevant date appears in its contents.

When several dates are displayed in the evidence, the party concerned must clearly indicate which date is the relevant date of disclosure, that is, the date relied on to prove the event of disclosure.

In the case of emails, the date when they have actually been sent would normally be displayed in their details and would thus appear in a printout.

Means for presenting the evidence obtained on the internet

Disclosure of a design on the internet can be established by submitting various types of evidence, such as printouts, screenshots, images, videos and metadata.

Merely providing a link to content on the internet (e.g. the URL address of a website) is not sufficient. The Office will not perform a search for that content. Moreover, the content may have been altered or removed.

Printouts from websites, or their screenshots, are the most common means of proving the disclosure of designs on the internet, in particular, on e-commerce platforms, private company websites, social media and online databases.

For the purpose of proving disclosure, a printout or a screenshot should show the full URL address of the website, the date when the design was published and the disclosed design. Moreover, information regarding the purpose and main characteristics of the website could be relevant for assessing whether the design has been made available to the public.

When a printout or a screenshot does not include all the relevant elements, missing information may be shown by providing additional evidence (27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 61-63).

Moreover, user comments left on e-commerce platforms or in social media might also be relevant when assessing disclosure.

When submitting a printout of an email that contains the representation of a design as an attachment, the link between the printout of that email and the printout of the attachment should be proven.

Printouts and screenshots should not be modified manually, as this might have an effect on the credibility of this evidence (27/02/2018, T-166/15, Étui pour téléphone portable, EU:T:2018:100, § 90).

Additionally, a design might be disclosed by the publishing of photos and videos on the internet that show a product to which the design is applied or in which it is incorporated.

Photos should be complemented with the information regarding the source of disclosure and the relevant date.

In the case of videos, the disclosure of a design should preferably be proved by submitting one or several screenshots displaying the exact times that the design appears in the video.

Finally, when photos and videos are submitted as evidence, metadata extracted from digital cameras could be obtained to prove the date and location that the photo or video was taken.

The mere abstract possibility that the content or date of a website may be manipulated is not a sufficient ground to undermine the credibility of evidence constituted by a screenshot of that website. That credibility may only be undermined by invoking facts that concretely suggest a manipulation, such as clear indications of falsifications, indisputable contradictions in the information provided or obvious inconsistencies that may reasonably justify doubts about the authenticity of the screenshots of the website in question (15/03/2023, T-89/22, Chairs, EU:T:2023:132, § 40; 20/10/2021, T-823/19, Bobby pins, EU:T:2021:718, § 49).

Exceptions to the availability to the public

Taking the global nature of the internet into account, in general, online content is available worldwide.

However, due to some restrictions, in particular as to the accessibility or searchability of the information on the internet, it might be considered that an event of disclosure of a design online could not reasonably have become known to the circles specialised in the sector concerned operating within the European Union.

For instance, when assessing an event of disclosure related to the publication of a design on a website, it might be necessary to assess whether that website was technically accessible and the relevant circles were actually able to find the prior art on the internet (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 61).

Unless the content is subject to restricted access in certain internal databases (e.g. used only by employees of a company), as a general rule, neither password nor payment requirements would be considered as precluding accessibility to the information published on the internet.

5.7.2 Assessment of novelty and individual character

A design will be protected as an REUD to the extent that it is new and has individual character (Article 4(1), Articles 5 and 6 EUDR). The novelty and individual character of an REUD must be examined on its date of filing or, as the case may be, on its date of priority, in the light of the relevant earlier designs, which have been made available to the public pursuant to Article 7 EUDR.

The REUD must be compared individually with each and every earlier design relied on by the applicant. Novelty and individual character of an REUD cannot be defeated by combining features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 69; 19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 23-35; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 23-24).

A combination of already disclosed features is therefore eligible for protection as an REUD, provided the combination, as a whole, is novel and has individual character.

In principle, subject to a number of exceptions detailed below, all the features visible both in the representation of the contested design and in the earlier design, as disclosed, must be taken into consideration when examining novelty and individual character.

Nevertheless, in some circumstances, it remains possible to carry out a comparison on the basis of features of a design, which may be deduced from the compared design's representations themselves (29/04/2020, T-73/19, Wood splitting tools, EU:T:2020:157, § 41). This can be the case where the compared designs represent products in different positions or stages of use or in different perspectives.

Point of reference for the comparison

The contested REUD is the point of reference when assessing novelty and individual character in the comparison with the earlier design (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 87).

Consequently, if the contested REUD is represented in only certain aspect views, for instance the front view, a comparison is only made with the corresponding part of the earlier design. Any additional features disclosed by the earlier design, such as those in its rear view, are disregarded.

The same principle applies when the contested REUD shows **fewer features** than the earlier design, such as, for example, when the contested REUD consists of the appearance of only part of a product whereas the earlier design discloses the whole product, or where the contested design is represented in black and white whereas the earlier design is represented in colour.

However, save for the exceptions outlined below, when the contested REUD shows **more features** than the earlier design, all of its features will be taken into account for the assessment of novelty and individual character. This can happen, for instance, where the contested REUD includes colours, visible effects produced by textures or any other aspects of appearance that are not visible in the earlier design. In the assessment of the individual character, the relative importance given to such features is weighed in the context of the global assessment of the overall impression left by the compared designs (see paragraph 5.7.2.2, subheading 'The overall impression').

Features dictated by a technical function and features of interconnection

Features that are solely dictated by a technical function and features that must necessarily be reproduced in their exact form and dimensions in order to allow interconnection with another product cannot contribute to the novelty and individual character of an REUD. A party alleging that individual features of the contested design are solely dictated by a technical function or by interconnecting purposes must submit facts, evidence and arguments in support of its claim (Article 8 EUDR, see paragraph 5.5.1).

However, when features of a product serve a functional purpose without being solely dictated by the technical function within the meaning of Article 8 EUDR, they may be relevant if it is established that they could be designed differently (10/11/2021, T-443/20, Labels, EU:T:2021:767, § 95; 22/09/2021, T-503/20, Signalling apparatus and devices, EU:T:2021:613, § 75-77). For instance, a button operating the functions on an electronic wristband can be placed on the product in different ways and can have different shapes and sizes (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61). Any limitation to the freedom of the designer and effect on the assessment of the individual character of the contested design will be weighed in the context of the global assessment of the overall impression (see paragraph 5.7.2.2 'The overall impression').

Invisible features of component parts

Where the features of an REUD applied to a component part are only partially visible during normal use of the complex product, the comparison with the relevant earlier designs invoked must be limited to the visible parts (Article 4(2), see paragraph 5.4).

Clearly discernible features

Features of an REUD that are not clearly discernible in its graphical representation cannot contribute to its novelty or its individual character (Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, recital 11). Likewise, features of the earlier design that are not of sufficient quality to allow all the details to be discerned in the portrayal of the earlier design cannot be taken in consideration for the purpose of Articles 5 and 6 EUDR (10/03/2008, R 586/2007-3, Barbecues, § 23-26).

Features of an earlier design can be supplemented by additional features that were made available to the public in different ways, for instance, first, by the publication of a registration and, second, by the presentation to the public of a product incorporating the registered design in catalogues. However, these representations must relate to one and the same earlier design (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 25-30).

Disclaimed features

Features of a contested REUD that are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a contested REUD represented with broken lines, blurring, colour shading or boundaries or in any other manner making clear that protection is not sought in respect of such features (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 59-64).

For further guidance, see paragraph 5.4 (Use of visual disclaimers to exclude features from protection) in the Guidelines regarding Examination of applications for registered European Union designs or consult the text of the Common Communication on the Common Practice on the Graphic Representation of Designs (CP6).

In contrast, disclaimed features of an earlier registered design can be taken into account when assessing the novelty and individual character of a contested REUD under Article 25(1)(b) EUDR because the earlier design is considered as a disclosure irrespective of the subject matter of protection as an REUD, and thus includes even the disclaimed features.

5.7.2.1 Novelty

A European Union design will be considered to be new if it is not predated by an identical design disclosed pursuant to Article 7 EUDR. Designs will be deemed to be identical if their features differ only in immaterial details (Article 5(2) EUDR).

An earlier design incorporated in or applied to a product that is different from the one to which the later design relates is, in principle, relevant for the purposes of assessing novelty (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 104; 15/01/2020, R 2512/2018-3, Stickers, § 25).

There is identity between the European Union design and an earlier design where the latter discloses each and every element constituting the former. A European Union design cannot be new if it is included in a more complex earlier design (25/10/2011,

R 978/2010-3, PART OF SANITARY NAPKIN, § 20-21; 18/03/2020, R 751/2019-3, Cube games, § 26).

However, the additional or differentiating features of the European Union design may be relevant for deciding whether it is new, unless these elements are so insignificant that they may pass unnoticed.

An example of an immaterial detail is a slight variation in the shade of the colour pattern of the compared designs (28/07/2009, R 921/2008-3, NAIL FILES, § 25; 20/01/2020, R 2300/2018-3, Graphic symbols and logos, surface patterns, ornamentation, § 28-32).

Another illustration is the display, in one of the two compared designs, of a label that is so small in size that it is not perceived as a relevant feature (08/11/2006, R 216/2005-3, CAFETERA, § 23-26), as in the following example.

Contested REUD No 5 269-0001 (view No 2)	**Earlier design (invented example)**

5.7.2.2 Individual character

A design will be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design that has been made available to the public before the filing date of the application for registration or, if a priority is claimed, the date of priority (Article 6(1) EUDR).

In assessing individual character, the designer's degree of freedom in developing the design will be considered (Article 6(2) EUDR). It is apparent from these provisions that the assessment of the individual character of a registered European Union design is the result, in essence, of a four-stage examination. This examination consists of **firstly** deciding on the sector that the products in which the design is intended to be incorporated or to which it is intended to be applied belong; **secondly**, the informed user of those products in accordance with their purpose and, with reference to that informed user, the degree of awareness of the prior art and the level of attention in the comparison (direct if possible) of the designs; **thirdly**, the designer's degree of freedom in developing their design; and **fourthly**, the outcome of the comparison of the designs

at issue, considering the sector in question, the designer's degree of freedom and the overall impressions produced on the informed user by the contested design and by any earlier design that has been made available to the public (10/09/2015, T-525/13, Sacs à main, EU:T:2015:617, § 32; 13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 66).

The determination of the sector concerned, the informed user and the designer's degree of freedom, must be carried out only in relation to the contested design (10/11/2021, T-193/20, Panels, EU:T:2021:782, § 24).

The products at issue

When defining the product category concerned by the contested design, the relevant product indication in the registration of that design is considered as well as, where necessary, the contested design itself, insofar as it clarifies the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56).

Therefore, the definition of the relevant product category is primarily based on the product indication (see Examination of applications for registered European Union designs, paragraph 6.1.4), but it may sometimes need to be better defined by referring to the design itself. It may be the case that the contested design is incorporated in a product that forms a self-contained category of homogenous products within the more general indication of products (15/10/2020, T-818/19, Support pillows, EU:T:2020:486, § 31; 10/11/2021, T-193/20, Panels, EU:T:2021:782, § 37-40).

The claim that the relevant products or the 'sector concerned' is limited to a narrow segment of products for the use of particularly attentive users is unfounded when unsupported by the representation of the contested design itself (10/11/2021, T-193/20, Panels, EU:T:2021:782, § 43).

The products actually marketed in which the designs at issue are incorporated can be considered only for illustrative purposes to determine the visual aspects of those designs. However, this consideration is only permitted on condition that the products actually marketed correspond to the contested design as registered. Therefore, a product that is actually marketed cannot be considered if the design incorporated in that product differs from the design as registered, or if it displays features that are not clearly apparent from the graphic representation of that design, as registered (10/11/2021, T-193/20, Panels, EU:T:2021:782, § 33).

The informed user

The informed user is to be defined in relation to the relevant product in which the contested design is incorporated or to which it is applied (10/11/2021, T-193/20, Panels, EU:T:2021:782, § 24).

The concept of 'informed user' refers to a fictitious person who routinely uses the categories of products in which the contested design is incorporated (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 125-126).

However, according to recital 14 EUDR and the case-law, the informed user is aware of the existing design corpus, that is, any relevant design forming the state of the art.

Therefore, their knowledge is not limited to the sector related to the contested design. Furthermore, no actual knowledge of prior designs pertaining to products from different sectors has to be proved (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 121-134).

The status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 46; 09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 24; 06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 58).

The 'informed user' concept lies somewhere between that of the average consumer applicable in trade mark matters, who may not have any specific knowledge, and the sectorial expert, who has detailed technical expertise. Without being a designer or a technical expert (and therefore without necessarily knowing which aspects of the product concerned are dictated by technical function, as found in 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 48), the informed user is aware of the various designs that exist in the sector concerned and possesses a certain degree of knowledge of the features that those designs normally include (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 53, 59; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 47; 06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 59).

Therefore, the informed user is neither a designer nor a technical expert. However, despite not necessarily knowing which aspects of a product are dictated by a technical function, they do have some awareness of the existing designs in the sector concerned.

The informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 25-27).

However, depending on the nature of the product in which the registered European Union design is incorporated (e.g. promotional items), the 'informed user' concept may include a professional who acquires such products to distribute them to the final users, or the final users themselves (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 54). The fact that one of these two types of informed user perceives the designs at issue as producing the same overall impression is sufficient for a finding that the contested design lacks individual character (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 56).

As a result of their interest in the products concerned, the informed user, as a rule, shows a relatively high degree of attention when using them (24/10/2019, T-559/18, Medizinische Pflaster, EU:T:2019:758 § 50). Unlike the average consumer in the field of trade marks for whom the fact of being faced, for instance, with a fashion accessory may affect their level of attention, this fact is irrelevant when determining the level of attention of the informed user (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 50). Likewise, the mere fact of being frequently faced with a particular design does not make the informed user more or less attentive, as the

user's level of attention is already, by its very nature, high (29/04/2020, T-73/19, Wood splitting tools, EU:T:2020:157, § 75).

When the nature of the product in which the compared designs are incorporated makes it possible, the overall impression made by these designs will be assessed on the assumption that the informed user can make a direct comparison between them (18/10/2012, C-101/11 P & C-102/11 P, Ornamentación, EU:C:2012:641, § 54-55).

The degree of freedom of the designer

The designer's degree of freedom depends on the nature and intended purpose of the product in which the contested design will be incorporated, as well as on the industrial sector to which the product belongs (see above).

The designer's degree of freedom in developing the design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. These constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 44).

In contrast, the designer's degree of freedom was not considered to be restricted in a number of cases (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 79), in particular when the shape of the product into which the design is incorporated may vary considerably (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 36-39) and for instance come in any combination of colours, patterns, shapes and materials (05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 45-47). This may also be the case where the constraints of a functional nature concerning the presence of certain essential features are not liable to affect to a significant extent the form or overall appearance of the product, since they may take various forms and be arranged in various ways (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 79; 04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61).

Furthermore, the designer's degree of freedom is not affected by the fact that similar designs coexist on the market and form a 'general trend' or coexist on the registers of industrial property offices (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 58; 01/06/2012, R 89/2011-3, Sacacorchos, § 27; 06/06/2019, T-209/18, Kraftfahrzeuge / Kraftfahrzeuge, EU:T:2019:377, § 59).

The greater the designer's freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on an informed user. Conversely, the more the designer's freedom in developing the registered European Union design is restricted, the more likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67, 72). Therefore, if the designer enjoys a high degree of freedom in developing a design, this reinforces the conclusion that the designs that do not have significant differences make the same overall impression on an informed user (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 33).

The degree of the designer's freedom is a mitigating factor which makes it possible to reinforce or, *a contrario,* moderate the conclusion as regards the overall impression produced by each design at issue (06/06/2019, T-209/18, Kraftfahrzeuge / Kraftfahrzeuge, EU:T:2019:377, § 48).

Furthermore, the designer's degree of freedom may vary as regards the different features of a design, and this must be taken into account when assessing to what extent individual features contribute to the design's overall impression.

The overall impression

Under Article 6(1)(b) EUDR, a registered European Union design is to be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any earlier design. In assessing individual character, the degree of freedom of the designer in developing the design is to be considered (Article 6(2) EUDR).

Unless the designs compared include functional, invisible or disclaimed features (see paragraph 5.7.2), both designs must be compared globally. That does not mean, however, that the same weight should be given to all the features of the designs compared.

Firstly, the informed user uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended. The relative weight to give to the features of the designs compared may therefore depend on how that product is used. In particular, the role played by some features may be less important depending on their reduced visibility when the product is in use (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 64-66, 72; 21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 45-46; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 97).

Secondly, when appraising the overall impression conveyed by two designs, the informed user will only give minor importance to features that are totally banal and common to the type of product in question and will concentrate on features that are arbitrary or different from the norm (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 77; 28/11/2006, R 1310/2005-3, galletas, § 13; 30/07/2009, R 1734/2008-3, FORCHETTE, § 26 et seq.).

Thirdly, similarities relating to common features that are present in the design for functional or standardising purposes will have only minor importance in the overall impression produced by those designs on the informed user. Additionally, the more the designer's freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 72).

Fourthly, the assessment of individual character (Article 6 EUDR) follows a logic that is different from that underlying the exclusion of protection on account of functionality or interconnection (Article 8 EUDR).

The fact the earlier design is partly or wholly dictated by technical or interconnecting considerations is not decisive because Article 6 EUDR does not require a comparison with an earlier valid design.

Where the contested design differs from or coincides with a prior design in **individual features**, which are solely dictated by technical or interconnecting considerations, a different or similar overall impression may be bestowed on the contested design by other arbitrary features or by the placement of those functional features or the features of interconnections.

The fact that the contested design differs from or coincides with a prior design in one or a number of features which, to some extent, are technical or have interconnecting purposes, will impact the comparison in two respects.

- Greater importance will in principle be given to other features whereby the designer made use of their freedom when developing the design, provided such features are apt to catch the informed user's attention on account of, for example, their size or position.
- The shape, configuration and placement of the functional or interconnecting features may also be considered (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61) to the extent that the designer has some freedom in combining these elements. This degree of freedom can be evidenced by the existence of alternative shapes fulfilling the same function (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 36).

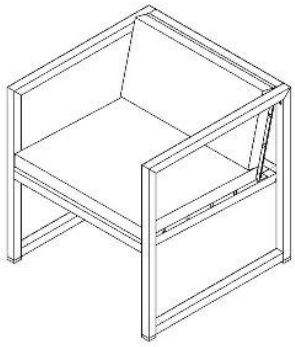
Finally, when familiar with a saturation of the prior art due to the density of the existing design corpus, the informed user may be more sensitive to even minor differences between the designs that may thus produce a different overall impression (13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 81; 12/03/2014, T-315/12, Radiatori per riscaldamento, EU:T:2014:115, § 87). To prove the actual impact of this saturation on the informed user's perception, the holder of the contested registered European Union design must present sufficient evidence of the existing design corpus and its density at the date of filing of the contested design or its priority date (10/10/2014, R 1272/2013-3, RADIATORI PER RISCALDAMENTO, § 36, 47; 09/12/2014, R 1643/2014-3, Radiatori per riscaldamento, § 51).

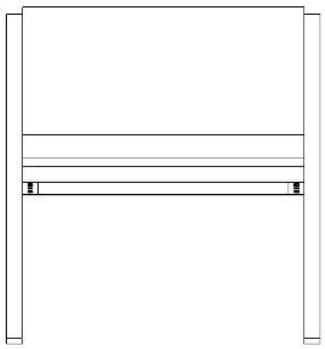
To illustrate, it was held that REUD No 1 512 633-0001 created a different overall impression from that produced by the earlier design (REUD No 52 113-0001). In an area in which the designer's degree of freedom in developing their design is not limited by any technical or legal restraints, the General Court (GC) upheld the decision of the Board of Appeal, which had found that the differentiating features of the two designs below prevailed over their common points. In particular, the fact that the armchair of the earlier design has a rectangular rather than a square shape, that its seat is placed lower and the arms are broader, was considered decisive to support the conclusion that the contested design had individual character (04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 23-37).

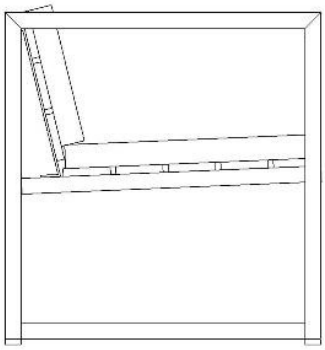
According to the GC, account must be taken of the difference between the designs at issue as regards the angle of the backrest and the seat of the armchair represented

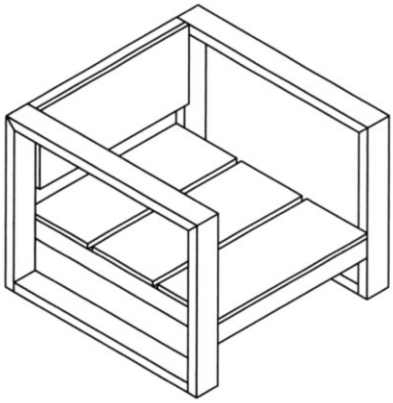
in the contested design, bearing in mind that the overall impression produced on the informed user must necessarily be determined in light of the manner in which the particular product is used. Since an inclined backrest and seat will give rise to a different level of comfort from that of a straight back and seat (albeit that comfort does not constitute a feature of appearance), the use that will be made of that armchair by the circumspect user is thereby liable to be affected (04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 30).

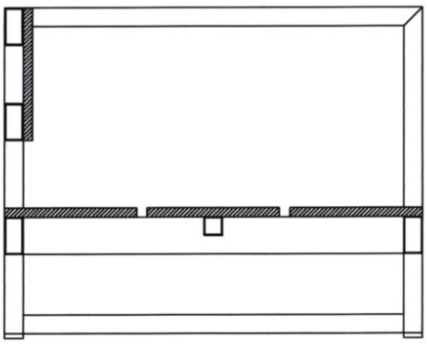
Contested REUD No 1 512 633-0001	**Earlier REUD No 52 113-0001**

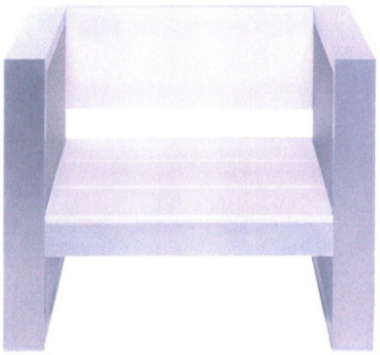


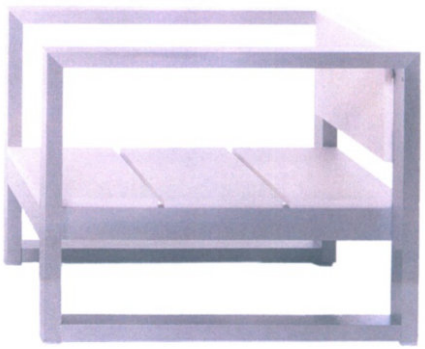








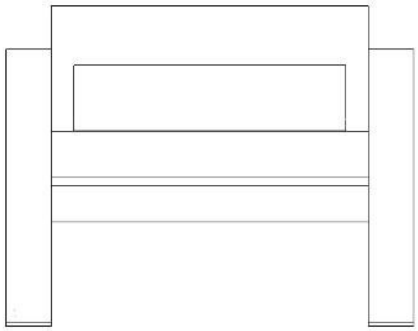


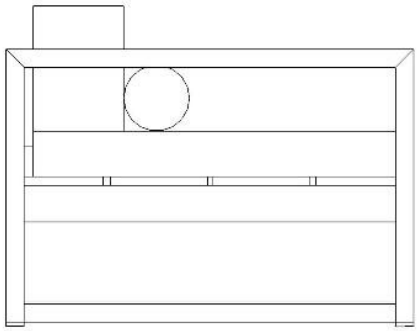


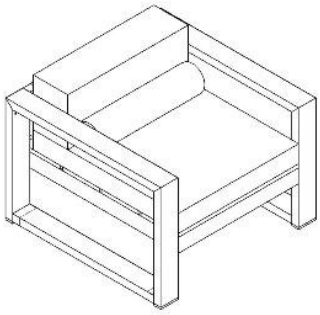
By contrast, the GC found that REUD No 1 512 633-0003 lacked individual character in respect of the same earlier design. It was held that the differentiating features between the designs, including the presence in the contested design of three cushions, were outweighed by their common characteristics (the rectangular shape, the flat back and seat, the seats positioned below the mid-section of the armchairs' structure, etc.) (04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 44-60).

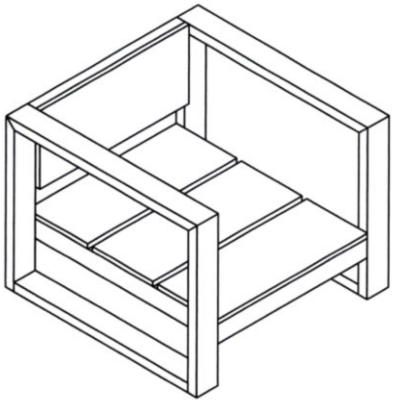
The GC confirmed the view taken by the Board of Appeal (27/04/2012, R 969/2011-3, ARMCHAIRS) that the cushions are less important than the armchairs' structure when assessing the overall impression caused by the designs. This is because cushions are not a fixed element that can be easily separated from the main product and are often sold and purchased separately, at a relatively low cost compared to that of the structure of an armchair. The informed user perceives the cushions as a mere optional accessory. They can hardly be considered as 'a significant part of the design'. Consequently, the overall impression produced by the designs at issue is dominated by the structure of the armchairs itself and not by the cushions, which could be regarded as secondary elements (04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 37-38).

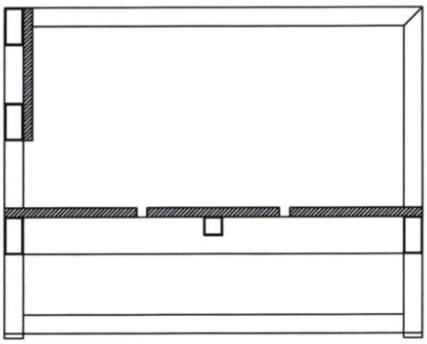
Contested REUD No 1 512 633-0003	**Earlier REUD No 52 113-0001**

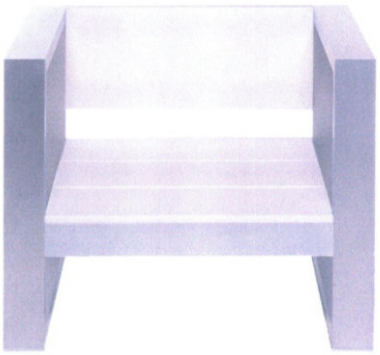


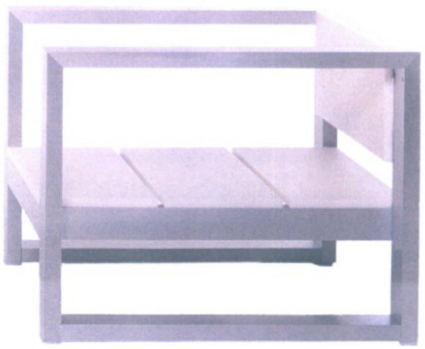












5.8 Conflict with a prior design right

Rationale

Under Article 25(1)(b) EUDR, an EU design may be invalidated by a prior design that was *made available to the public* before the filing or priority date of the EU design. Under Article 25(1)(d) EUDR, an EU design may be invalidated by a design that was not made available to the public before the filing or priority date of the EU design but which had *obtained protection* prior to that date. The protected design under Article 25(1)(d) EUDR must be one of the following:

1. a registered European Union design or an application for such a design; or
2. a registered design right of a Member State or an application for such a right; or
3. a design right registered under the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999, hereinafter referred to as 'the Geneva Act', which was approved by Council Decision 2006/954/EC and which has effect in the European Union, or an application for such a right.

Notion of 'conflict'

Under Article 25(1)(d) EUDR, an EU design is in conflict with a protected design when, taking into consideration the designer's freedom in developing the EU design, that design does not produce a different overall impression on the informed user from that produced by the protected design relied upon (18/03/2010, **T-9/07**, Metal rappers, EU:T:2010:96, § 52; 21/04/2021, **T-326/20**; Beverage bottles, EU:T:2021:208, § 31).

Article 25(1)(d) EUDR is a relative ground for invalidity, the purpose of which is to determine whether the contested EU design falls within the scope of protection of another protected design. This means that the point of reference in the comparison under Article 25(1)(d) EUDR is the earlier design, and not the contested design as in Article 25(1)(b) EUDR. Therefore, in contrast to the novelty/individual character test under Article 25(1)(b) EUDR, only the features that form part of the earlier design right are considered in the assessment under Article 25(1)(d) EUDR. This means that disclaimed features of the earlier design, if there are any, are disregarded (compare with paragraph 5.7.2 under the subheading 'Disclaimed features').

Relevance of priority claims

'The right of priority shall have the effect that the date of priority shall count as the date of the filing of the application for a registered EU design for the purpose of Article […] 25(1)(d) […]' (see Article 43 EUDR).

This principle applies irrespective of whether the EU design is the contested design or an earlier design relied on under Article 25(1)(d) EUDR. This gives equal treatment to all designs (EU, national or international) and comports with Article 4(B) of the Paris Convention which recognises that the protection conferred against acts of exploitation that started between the priority date and the date of filing of a right can never give rise to third–party rights or rights of personal possession.

In conflicts under Article 25(1)(d) EUDR, therefore, the earlier date (filing or priority) determines which right takes precedence (see by analogy Article 36 EUTMR) and a design claiming priority is 'protected' within the meaning of Article 25(1)(d) EUDR, subject to registration, from its date of priority.

The validity of a priority claim will be assessed ex officio only when it becomes relevant to determining which right takes precedence. The assessment is based on the priority documents submitted by the parties (see paragraph 3.10.2).

For the substantive requirements of a design priority claim see Guidelines for Examination of applications for registered European Union designs, 6.2.1 Priority and exhibition priority. They apply *mutatis mutandis* for prior and contested designs.

Continued existence

A prior design relied upon under Article 25(1)(d) EUDR must remain in force on the date on which the Office takes a decision on invalidity.

When an earlier national or international design with effect in the EU on which the invalidity is based expires before the Office takes a decision on the matter, a communication is issued to the invalidity applicant in which it is invited to submit evidence of renewal. This is then communicated to the holder (see, by analogy, 05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 68 et seq.).

Otherwise, the Office will assume that the prior design remains valid unless the holder submits proof that a decision that has become final declared the prior design invalid before the adoption of the decision (see, by analogy, 29/03/2011, **C-96/09 P**, Bud, EU:C:2011:189, § 94-95) (see paragraph 4.1.6.2).

5.9 Use of an earlier distinctive sign

A European Union design will be declared invalid if a distinctive sign is used in a subsequent design, and the law of the European Union or the law of the Member State governing that sign confers on the holder of the sign the right to prohibit such use (Article 25(1)(e) EUDR).

5.9.1 Distinctive sign and right to prohibit use

The notion of a 'distinctive sign' encompasses registered trade marks as well as all signs that can be relied on in the context of Article 8(4) and 8(6) EUTMR.

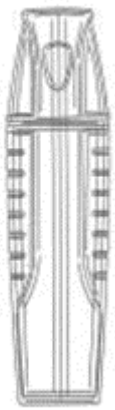
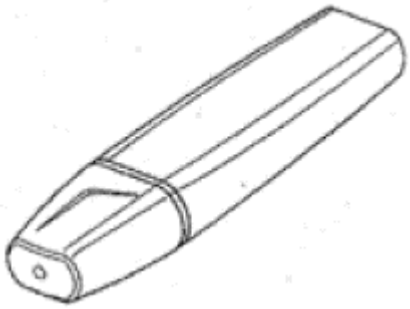
In accordance with the practice under Article 8(4) and 8(6) EUTMR, the applicant may also rely on provisions of national law on the prohibition of a later registration.

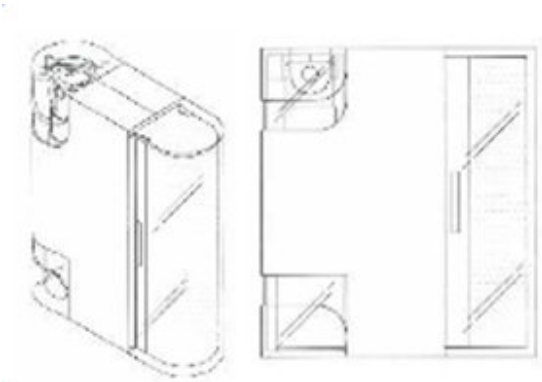
The applicant must establish only that it has a right to prohibit use of the subsequent European Union design. It cannot be required to establish that such right has been exercised; in other words, that the applicant has actually been able to prohibit such use (see, by analogy, 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 191).

Where the earlier distinctive sign is a sign that can be relied on in the context of Article 8(4) and 8(6) EUTMR, the Office will apply the corresponding law as explained in the Guidelines, Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR) and Part C, Opposition, Section 6, Geographical indications (Article 8(6) EUTMR).

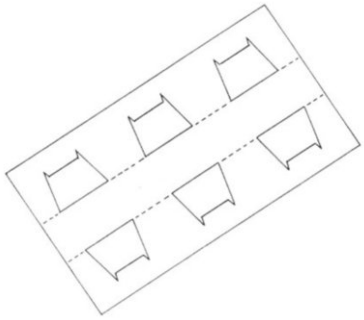
5.9.2 Use in a subsequent design

The notion of 'use in a subsequent design' does not necessarily presuppose a full and detailed reproduction of the earlier distinctive sign in a subsequent European Union design. Even though the European Union design may lack certain features of the earlier distinctive sign or may have different additional features, this may constitute 'use' of that sign, particularly where the features omitted or added are of secondary importance and are unlikely to be noticed by the relevant public. It is enough that the European Union design and the earlier distinctive sign be similar (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 50-52; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 23; 09/08/11, R 1838/2010-3, INSTRUMENTS FOR WRITING, § 43).

Contested REUD No 352 315-0007	Earlier German trade mark No 30 045 470.8
	
12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190	
Contested REUD No 1027718-0001	Earlier EUTM 5 185 079

	
25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219	
Contested REUD No 5887007-0001	Earlier EUTM 8 485 121
07/08/2023, R 136/2021-3, Flaschen	
Contested REUD No 1044150-0003	Earlier International trade mark registration No 608 499
	DIESEL
09/09/2015, T-278/14, DIESEL	

Where a European Union design includes a distinctive sign without any disclaimer making it clear that protection is not sought in respect of this feature, the European Union design will be considered to make use of the earlier distinctive sign, even if the latter is only represented in one of the views (18/09/2007, R 137/2007-3, Containers, § 20).

Contested REUD No 339 312-0003	Earlier international trade mark No 649 535
	Earlier Polish trade mark No 267 378
	DANVIVA

Where it is clear from the applicant's arguments that its claim only covers the infringement of its rights in the distinctive sign, not the other features of the product in which the contested design is to be incorporated, the earlier distinctive sign reproduced in the contested design will be assessed, and not the design itself (19/03/2020, R 2449/2018-3, Pendenti, § 21, 22 and 24).

Contested REUD No 2 100-0001	**Earlier EUTM No 1 417 625**

	PIANEGONDA

5.9.3 Substantiation of the application under Article 25(1)(e) EUDR (earlier distinctive signs)

Where an application for invalidity is based on a right held in an earlier European Union trade mark or an international trade mark designating the EU, it is not necessary to submit the law and case-law relating to European Union trade marks in order to substantiate such earlier right under Article 9(2)(a)(b) or (c) EUTMR; the same applies if the applicant invokes an earlier national registered mark or an international trade mark designating a Member State.

In order to evaluate whether a design is 'subsequent' to a distinctive sign, the material dates for calculation are the filing or priority dates of that design (Article 43 EUDR). If the earlier of these dates is later than the filing or priority date of the distinctive sign (or the date from which protection starts for unregistered signs) then it is a 'subsequent' design.

The validity of priority claims for the respective rights will only be assessed where they can be decisive for determining which right is earlier (e.g. if the filing date for the distinctive sign is later than the filing date of the contested design but its priority date is earlier, or where the filing date of the contested design is later than the filing date of the allegedly 'prior' right but it claims earlier priority).

Where the earlier distinctive sign is a sign that could be relied on in the context of Article 8(4) and 8(6) EUTMR, an application must, pursuant to Article 28(1)(b)(vi) EUDIR, contain particulars establishing the content of the EU or national law of which the applicant is seeking application including, where necessary, court decisions or academic writings (the principles established in the Guidelines, Part C, Opposition,

Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR) and Section 6, Geographical Indications (Article 8(6) EUTMR) will apply).

5.9.4 Examination by the Office

The examination is carried out in accordance with the law governing the earlier distinctive sign.

Where the earlier distinctive sign is a European Union trade mark, the Office will apply the principles established in the Guidelines, Part C, Opposition, Section 2, Double identity and likelihood of confusion, and Section 5, Trade marks with reputation (Article 8(5) EUTMR).

Where the earlier distinctive sign is a registered national trade mark, the Office will apply the same principles (03/10/2017, T-695/15, Comfit boxes, Containers, EU:T:2017:684, § 29).

The validity of the priority claims of the contested design and earlier trade marks will only be assessed where they can be decisive for determining which right is earlier.

For the substantive requirements of a priority claim of a registered trade mark, see the Guidelines, Part B, Examination, Section 2, Formalities, 11.2 Substantive requirements for priority claims.

For the substantive requirements of a design priority claim see pargagraph 6.2.1, Priority and exhibition priority.

For the purpose of applying these principles, the Office will assume that the contested European Union design or an element used in the contested design will be perceived by the relevant public as a sign capable of being used ‘for’ or ‘in relation to’ goods or services (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 107; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 39 and 42).

The Office will examine for which goods the contested European Union design is intended to be used (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 108). To determine whether these goods and services are identical or similar, the Office will consider the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) EUDR), and also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56; 07/11/2011, R 1148/2010-3, PACKAGING, § 34-37).

Where the European Union design is intended to be incorporated in two-dimensional ‘logos’, the Invalidity Division will consider that such logos may be applied to an infinite range of products and services, including the products and services in respect of which the earlier distinctive sign is protected (03/05/2007, R 609/2006-3, logo MIDAS, § 27).

Where the earlier distinctive sign is a sign that could be relied on in the context of Article 8(4) and 8(6) EUTMR, the Office will apply the corresponding law as explained in the Guidelines, Part C, Opposition, Section 4, Non-registered trade marks and

other signs used in the course of trade (Article 8(4) EUTMR) and Part C, Opposition, Section 6, Geographical indications (Article 8(6) EUTMR).

5.10 Unauthorised use of a work protected under the copyright law of a Member State

A European Union design will be declared invalid if it constitutes unauthorised use of a work protected under the copyright law of a Member State (Article 25(1)(f) EUDR).

5.10.1 Substantiation of the application under Article 25(1)(f) EUDR (earlier copyright)

Apart from the elements mentioned under paragraphs 3.5 and 3.10.2, an application must, pursuant to Article 28(1)(b)(vi) EUDIR contain:

- particulars establishing the content of the national law of which the applicant is seeking application including, where necessary, court decisions or academic writings (see, by analogy, 05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452; 23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52); and
- particulars showing that the applicant acquired the rights to the work protected under the copyright law relied on before the filing date or the priority date of the European Union design (Article 43 EUDR) (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 47); and
- particulars showing that the applicant satisfies the necessary conditions, in accordance with that law, to have the European Union design invalidated or its use prohibited by virtue of its earlier right.

The validity of the contested design's priority claim will be examined only if it is relevant for the outcome of the assessment under Article 25(1)(f) EUDR.

For the substantive requirements of a design priority claim, see paragraph 6.2.1 Priority and exhibition priority.

5.10.2 Examination by the Office

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the holder of the copyright invoked and whether unauthorised use of a work protected by the copyright legislation of a Member State, as interpreted by the courts of that Member State, has occurred (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52; 17/10/2013, R 781/2012-3, CHILDREN'S CHAIRS, § 27, 43).

When dealing with an application based on Article 25(1)(f) EUDR, the Office will assess solely whether the disputed design constitutes 'unauthorised use' of the work protected by the law on copyright of the Member State concerned. The tests for the assessment

of novelty or individual character under Article 25(1)(b) in conjunction with Articles 5 and 6 EUDR are not relevant.

It should be noted that Article 25(1)(f) EUDR does not apply to cases in which ownership of the European Union design is contested, in particular when the invalidity applicant's essential argument is that the European Union design was created not by the registered holder but by the invalidity applicant or by its employee. The Office has no jurisdiction to determine which of the parties is the rightful owner of the contested European Union design since such jurisdiction lies with national courts (11/02/2008, R 64/2007-3, Loudspeakers, § 18-19).

5.11 Improper use of flags and other symbols

A European Union design will be declared invalid if it constitutes an improper use of any of the items listed in Article 6*ter* of the Paris Convention, or of badges, emblems and escutcheons other than those covered by Article 6*ter* that are of particular public interest in a Member State (Article 25(1)(g) EUDR).

The items covered by Article 6*ter* are the following (see the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal):

- armorial bearings, flags, other emblems, official signs and hallmarks that belong to states and have been communicated to WIPO, although, in the case of flags, such communication is not mandatory;
- armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations that have been communicated to WIPO, with the exception of those already the subject of international agreements for ensuring their protection (see, for example, the Geneva Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces of 12/08/1949, Article 44 of which protects the emblems of the Red Cross on a white ground, the words 'Red Cross' or 'Geneva Cross', and analogous emblems).

Badges, emblems and escutcheons other than those covered by Article 6*ter* and which are of particular public interest in a Member State could include, for example, religious symbols, political symbols or symbols of public bodies or administrations such as provinces or municipalities.

5.11.1 Substantiation of the application under Article 25(1)(g) EUDR (flags and other symbols)

Apart from the requirements mentioned under paragraphs 3.5 and 3.10.2 above, when an item that is not listed in Article 6*ter* is invoked, the application must, pursuant to Article 28(1)(b)(vi) EUDIR, show that such item is of particular public interest in a Member State.

5.11.2 Examination by the Office

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the person or entity affected by the use and whether the European Union design constitutes an improper use of one of the symbols covered by Article 25(1)(g) EUDR as listed above.

5.12 Partial invalidity

According to Article 25(6) EUDR, a registered European Union design that has been declared invalid pursuant to any of the grounds under Article 25(1)(b), (e), (f) or (g) EUDR may be maintained in an amended form, if in that form it complies with the requirements for protection and the design's identity is retained.

A request for maintenance in an amended form of a registered European Union design must be made by the holder before the end of the written procedure. The request must include the amended form. The proposed amended form may consist of an amended representation of the European Union design from which some features are removed or which makes clear by means, inter alia, of broken lines that protection is not sought in respect of such features. The amended representation may include a partial disclaimer not exceeding 100 words (Article 25(6) EUDR; Article 18(2) EUDIR).

The applicant will be given an opportunity to comment on whether the European Union design in its amended form complies with the requirements for protection and whether the identity of the design is retained (see paragraph 4.1.4.1).

The identity of the European Union design must be retained. Maintenance in an amended form will therefore be limited to cases in which the features removed or disclaimed do not contribute to the novelty or individual character of a European Union design, in particular:

- where the European Union design is incorporated in a product that constitutes a component part of a complex product, and the features removed or disclaimed are invisible during normal use of this complex product (Article 4(2) EUDR); or
- where the features removed or disclaimed are dictated by a technical function or for the purposes of interconnection (Article 8(1) and (2) EUDR); or
- where the features removed or disclaimed are so insignificant in view of their size or importance that they are likely to pass unnoticed.

The decision to maintain the European Union design in an amended form will be included in the decision on the merits terminating the invalidity proceedings.

5.13 Grounds for invalidity that become applicable merely because of the accession of a new Member State

See the Guidelines, Examination of Applications for Registered European Union Designs, paragraph 13, Enlargement and the Registered European Union Design.

6 Termination of the Proceedings

6.1 Termination of proceedings without a decision on the merits

The invalidity proceedings are terminated without a decision on the merits when:

1. the applicant withdraws its application as a result of an amicable settlement or otherwise; or
2. the holder surrenders the European Union design in its entirety and the applicant did not show a legitimate interest in obtaining a decision on the merits of the case (Article 24(2) EUDR; see paragraph 3.8); or
3. the contested European Union design has lapsed and the applicant did not show a legitimate interest in obtaining a decision on the merits of the case (Article 24(2) EUDR; see paragraph 3.8); or
4. the Office suspends a number of applications for a declaration of invalidity relating to the same registered European Union design. These applications will be deemed to have been disposed of once a decision declaring the invalidity of the European Union design has become final (Article 32(3) EUDIR).

The Office informs the parties that the proceedings are terminated without a decision on the merits.

6.2 Decision on costs

If a decision on the merits of the case is taken, the decision on apportionment of costs is given at the end of the decision (Article 79(1) EUDIR).

In all other cases, where the Office closes the case without a decision on the merits, a separate decision on costs is issued unless the parties have agreed on the costs as outlined below paragraph 6.2.1.

6.2.1 Agreement on costs

Whenever the parties inform the Office that they have settled the invalidity proceedings with an agreement that includes the costs, the Office will not issue a decision on costs

(Article 70(5) EUDR). The Office will apply the principles explained in the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 6.5.2.1, Agreement on costs.

If no indication is given as to whether the parties have agreed on the costs, the Office will take a decision on costs at the same time as confirming the withdrawal of the application. If the parties inform the Office that they have reached an agreement on costs after the withdrawal of the application, the decision on costs already issued will not be revised by the Office. However, it is left to the parties to respect the agreement and not to enforce the Office's decision on costs.

6.2.2 Apportionment of costs

The general rule is that the losing party, or the party that terminates the proceedings by surrendering the European Union design, maintaining it in an amended form or withdrawing the application, must bear the fees incurred by the other party as well as all costs incurred by it that are essential to the proceedings (Article 70(1) and (3) EUDR).

If both parties lose in part or if reasons of equity so dictate, a different apportionment has to be decided (Article 70(2) EUDR). As a general rule, it is equitable for each party to bear its own costs.

Where a number of applications for a declaration of invalidity relating to the same registered European Union design have been suspended, they are deemed to be disposed of once a decision declaring the invalidity of the European Union design has become final. Each applicant whose application is deemed to have been disposed of will bear its own costs (Article 70(4) EUDR). In addition, the Office will refund 50 % of the invalidity fee (Article 32(4) EUDIR).

6.2.3 Fixing of costs

Recoverable costs regarding representation and fees

Where the costs are limited to representation costs and the application fee, the decision fixing the amount of costs will be included in the decision on the apportionment of the costs.

The amount that the winning party is entitled to claim is mentioned in Article 70(1) EUDR and Article 79(6) and (7) EUDIR.

As regards fees, the recoverable amount is limited to the invalidity fee of EUR 320 if the applicant wins.

As regards representation costs, the recoverable amount is limited to EUR 400. This applies both to the applicant and the holder insofar as represented in the invalidity proceedings by a professional representative within the meaning of Article 77 EUDR. A winning party no longer represented by a professional representative at the time of

taking a decision is also entitled to costs regardless of when during the proceedings professional representation ceased. This is without prejudice to the need to appoint a professional representative where it is mandatory. The amount to be borne by the losing party is always fixed in euro, regardless of the currency in which the winning party had to pay its representative.

Representation costs for employees, even from another company with economic connections, are not recoverable.

Other recoverable costs

Where the costs include expenses in relation to an oral hearing or the taking of evidence, the Invalidity Division will, on request, fix the amount of costs to be paid (Article 70(6) EUDR). A bill of costs, with supporting evidence, must be attached to the request for the fixing of costs (Article 79(3) EUDIR).

The amount of recoverable costs may be reviewed by a decision of the Invalidity Division on a reasoned request filed within 1 month of the date of notification of the awarding of costs (Article 70(6) EUDR; Article 79(4) EUDIR).

Fixing of costs after remittance of the case to the Invalidity Division for further prosecution

When the invalidity decision has been annulled, wholly or partly, and the case is remitted by the Boards of Appeal, the situation will be the following.

- The first decision (which was appealed) does not become final, not even as regards apportionment or fixing of costs.
- As regards the costs of the invalidity proceedings, one single decision on the apportionment and on the fixing of costs must be taken for the invalidity procedure as a whole.
- As regards the costs of the appeal procedure, it has to be ascertained whether the Boards adjudicated on them. The notion of ‘winning party’ has to be applied to the outcome of the appeal proceedings, with the result that the decision can be different for the two instances. The amount of reimbursable representation costs for the appeal procedure is EUR 500, which applies in addition to the representation costs for the invalidity proceedings.

6.2.4 Enforcement of decisions fixing the amount of costs

For the enforcement of decisions fixing the amount of costs the Office will apply the principles explained in the Guidelines, Part A General Rules, Section 3 Payment of fees, costs and charges, paragraph 7.2. Enforcement of the decision on costs.

6.3 Correction of mistakes and entry in the Register

6.3.1 Correction of mistakes

In Invalidity Division decisions, only linguistic errors, errors of transcription and obvious mistakes may be corrected. They will be corrected by the Invalidity Division, acting of its own motion or at the request of an interested party (Article 39 EUDIR).

6.3.2 Entry in the Register

Under Article 72(3)(r) EUDR, the date and content of the decision on the application (Article 53(4) EUDR), or of any other termination of proceedings, will be entered in the Register once it is final.

7 Other procedural issues

7.1 Change of parties

As regards the rules on **transfer and invalidity proceedings, change of name, change of representative** and **interruption of the proceedings due to death or legal incapacity of the applicant or its representative** in the course of invalidity proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 7.5 Change of parties (transfer, change of name, change of representative, interruption of proceedings), as the rules are applicable *mutatis mutandis* to REUDs and REUD proceedings.

8 Appeal

8.1 Right to appeal

Any party to invalidity proceedings has the right to appeal against a decision that affects it adversely. A decision that does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal. Any written communication of such a decision will include a notice that the decision may be appealed within 2 months of the date of receipt of the decision's notification. Appeals have a suspensive effect (Article 55 EUDR).

GUIDELINES FOR EXAMINATION OF REGISTERED EUROPEAN UNION DESIGNS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Parts shared with current trade mark practice

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Editor's note and general introduction

1 Subject Matter

The European Union Intellectual Property Office (the EUIPO or the Office), established in Alicante, is responsible for the registration of European Union trade marks (EUTM) and registered European Union designs (REUD) under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 and Council Regulation No 6/02 of 12 December 2001. These registrations provide uniform trade mark and design protection throughout the European Union.

The Office deals with registration procedures (including the examination of applications for absolute grounds for refusal and, where an opposition has been raised regarding an EUTM application, for relative grounds for refusal) accordingly, maintains the public registers of these rights and decides on applications for those rights, once registered, to be declared invalid. The Office's Guidelines cover practice in all of these areas.

2 Objective of the Guidelines

The Guidelines on EUTMs and the Guidelines on REUDs exist to improve the coherence, predictability and quality of Office decisions. The Guidelines are designed to bring together, systematically, the principles of practice derived from the jurisprudence of the European Court of Justice, the case-law of the Office's Boards of Appeal, the decisions of the Office's Operations Department and the outcomes of the Office's convergence programmes with EU IP offices.

As case-law evolves, so the Guidelines also evolve. They are adapted to reflect developments in Office practice on a yearly basis by means of an ongoing revision exercise (see paragraph 3 below).

3 Guidelines revision process

As the sole source of reference on Office practice with regard to EUTMs and REUDs, the current Guidelines are available in the five Office languages. Additionally, the Office translates the Guidelines into the remaining official EU languages on a regular basis. They are revised by the Office's cross-departmental 'Knowledge Circles' in a cyclical and open process: 'cyclical' because practice is updated on a yearly basis by looking at the case-law of the preceding year and taking into account the operational needs and outcomes of convergence initiatives, and 'open' because external stakeholders are involved in defining that practice.

Involving national offices and user associations not only benefits the quality of the Guidelines, but also facilitates convergence, that is, the process of finding common ground on issues where there may be diverging practices. Making the Guidelines

available in all the EU languages helps raise awareness of Office practice among Member States and users and makes differences in practice easier to identify.

The process involves the following phases:

1. **Preparation of the draft Guidelines by the Office**
   During this phase, the draft Guidelines are produced by the Office's Knowledge Circles. The three steps of this phase — analysis, drafting and discussion — must be completed in a timely manner. Analysis involves the Knowledge Circles extracting trends from the preceding year's case-law, studying the conclusions of the convergence projects and taking into consideration the comments received in previous years from the Office's users and stakeholders. As the next step, the Knowledge Circles draft the Guidelines. Finally, the texts are discussed within the Knowledge Circles, where representatives of the Office's various units and departments are represented.
2. **Consultation with stakeholders**
   Once the drafts have been prepared, they are sent simultaneously for consultation to the external stakeholders, national offices and user associations, and internal stakeholders. For at least 3 calendar months in normal revision cycles, stakeholders have the opportunity to study the drafts and submit their comments and suggestions. At the end of the consultation phase, the Knowledge Circles process the feedback received and implement them into the drafts. The Knowledge Circles can choose to accept or reject a comment, take it on board for consideration in the next revision cycle, or mark it as out of scope. A list is published annually on the Office's website, containing the outcome of each comment received.
3. **Adoption of the Guidelines**
   After consulting the MB in accordance with Article 153(1)(l) EUTMR and Article 101(b) EUDR, the Executive Director adopts the updated Guidelines. The versions in the five Office languages together make up the official text. In the event of discrepancies between different language versions, the text in the drafting language (English) will prevail. The Guidelines are translated into the remaining official languages of the European Union on a regular basis. These additional translations are published on the Office's website, and external stakeholders, whether national offices or user associations, are free to submit feedback on their quality; any linguistic amendments made as a result of this informal feedback will be incorporated into the texts without any formal procedure
4. **Fast-track procedure**
   In certain circumstances (e.g. a Court of Justice judgment that has immediate impact on Office practice) the Office will amend the Guidelines using a fast-track procedure outside the normal time frame outlined above. However, this procedure is an exception to the norm.

4 Structure of the Guidelines

The items dealt with in the Guidelines are set out below.

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GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 1

Means of communication, time limits

1 Introduction

This part of the Guidelines includes those provisions that are common to all proceedings before the Office in trade mark and design matters, except appeals.

In the interests of efficiency and in order to prevent parties encountering different practices, the Office applies procedural rules consistently.

Proceedings before the Office can be classified into two broad types: ***ex parte*** proceedings, which involve only one party, or ***inter partes*** proceedings, in which two or more parties are in conflict.

The first category comprises, in particular, applications for registration or renewal of a European Union trade mark (EUTM) or a registered European Union design (REUD), transfer-related entries in the Register, licences, levy of execution or bankruptcy, insolvency proceedings, priority/seniority claims and conversion proceedings.

The second category includes opposition and cancellation proceedings (revocation or declaration of invalidity of a registered EUTM or an REUD).

2 Procedures for Filing and for Communication with the Office

Article 30 EUTMR

Articles 63 and 65 EUTMDR

Article 35 EUDR

Articles 65 and 68 EUDIR

Decision No EX-18-5 of the Executive Director of the Office of 3 September 2018 concerning the hours the Office is open to receive submissions by personal delivery relating to registered European Union designs

Communications addressed to the Office can be submitted by electronic means, post or courier in proceedings relating to European Union trade marks and in addition by personal delivery in proceedings relating to European Union designs. Notifications issued by the Office can be made by electronic means, post, courier services or public notification.

Applications for EUTMs and REUDs must be filed directly with the Office.

E-filing is a recommended means of filing, to the extent that the system gives guidance to the applicant, thus reducing the number of potential deficiencies and speeding up the examination procedure. EUTMs filed through the Office's e-filing system are subject to a reduced fee. The Office also offers the possibility of an accelerated procedure known as Fast Track (for more details, please check the Office's website).

In the event of opting for filing by other means, the Office makes various forms available to the public, in all the official languages of the EU. With one exception, their use is not mandatory but strongly recommended. The exception is when filing an international application or subsequent designation under the Madrid Protocol, for which either the World Intellectual Property Organization's (WIPO) MM 2 or MM 4 form, or the Office's EM 2 or EM 4 form must be used.

3 Notification and Communication of Documents

The EUTMDR and the EUDIR distinguish between documents originating from the parties and addressed to the Office and notifications issued by the Office.

A document's date of notification or communication is the date on which that document, is **received or is deemed to be received** by the addressee (including the Office) (30/01/2014, C-324/13 P , Patrizia Rocha, EU:C:2014:60, § 43). Exactly when receipt is deemed to have taken place will depend on the method of notification or communication.

Any notification addressed to the representative will have the same effect as if it had been addressed to the person represented (Article 60(3) EUTMDR and Article 53 EUDIR). Any communication addressed to the Office by a representative will be considered to have originated from the person he or she represents (Article 66 EUTMDR and Article 63 EUDIR).

If a professional representative has been duly appointed, the Office will send all notifications solely to the representative (12/07/2012, T-279/09 , 100% Capri, EU:T:2012:367; 25/04/2021, T-326/11 , BrainLAB, EU:T:2012:202). 'Duly appointed' means that the representative is entitled to act as such and has been properly appointed, and that no general obstacle exists to preclude representation by that person, such as illicit representation of both parties in *inter partes* proceedings. Filing an authorisation is not required in order to receive Office notifications.

For further details see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation .

3.1 Communications to the Office in writing or by other means

Article 98(3) EUTMR
Article 100 EUTMR Article 55(2), (3) and (4) EUTMDR, and Articles 63 and 64 EUTMDR Articles 65 to 67 EUDIR Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means 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

Fax is expressly identified as a means of communication in all procedures relating to European Union designs in Article 47(2)(d) EUDIR and Article 51 EUDIR, however, pursuant to Article 2 of Decision of the Executive Director No 23-13 on communication by electronic means, due to technical limitations and malfunctions affecting the reliability and preventing the uninterrupted functioning of communications by fax (and that lie beyond the Office's control), **fax is not offered and is not used**, as a means of communication in procedures before the Office.

3.1.1 Via the User Area (electronic means)

The accepted means of electronic communication with the Office in **procedures relating to EUTMs and European Union designs** is the User Area, which is a secure electronic communications platform maintained by the Office. The User Area enables users to submit applications and other documents, receive notifications and documents sent by the Office, reply to these notifications and perform other actions.

Nevertheless, exceptionally, where a technical malfunction prevents the applicant from filing through the User Area, an **EUTM or REUD application** submitted by one of the alternative electronic back-up measures available (see below) will be deemed to have been received by the Office provided that the applicant resubmits, within 3 working days of the original submission, the application for registration of an EUTM or REUD (with the same content) through the User Area. Failure to comply with these conditions will result in the original submission being deemed as not having been received. For further information on the submission of an **application for renewal of an EUTM or REUD** by one of the alternative electronic back-up measures available, see the Guidelines, Part E, Register Operations, Section 4, Renewal, paragraph 7.

To facilitate resubmission, in the event of a malfunction during the electronic transmission of an application, communication or other document through the specific e-operation or e-filing in the User Area, the Office will make two alternative electronic back-up measures available:

1. an upload solution located in the Communications section of the User Area - this is a general upload platform that allows documents to be attached and sent to the Office;
2. a file-sharing solution outside the User Area; the Office will provide the account holder with access to a secure file-sharing location where the document(s) in question can be uploaded.

Technical details on the accessibility and functionality of both these alternative back-up measures are available in the Conditions of Use of the User Area.

In the unlikely event that these back-up measures are not available, the Executive Director may take a decision to extend the deadlines pursuant to Article 101(3) EUTMR and Article 58 EUDIR (see paragraph 4.2).

The time of receipt of applications, communications or documents submitted by electronic means is the local time in Alicante (Spain) when the receipt was validated.

A series of e-operations (e-filings, e-actions and other e-operations) can be carried out via the User Area. These are accessible after logging into the User Area through the 'Dashboard' or the 'Online Services' sections of the account.

In addition, in certain *inter partes* proceedings, when both parties are registered users of the User Area they can file joint requests that are validated (signed) electronically by the two parties.

If an account holder uses one of the standard e-operations in the User Area to file a submission, that e-operation will prevail over any other statement or observation made by the account holder through other means on the same day, provided that the Office does not receive a withdrawal of the e-operation on the same day (see paragraph 3.1.6) for same day withdrawals).

Where a communication submitted by electronic means, is incomplete or illegible, or the Office has reasonable doubts as to the accuracy of the transmission, in accordance with Article 63(3) EUTMDR and Articles 67(3) and 66(2) EUDIR, it will advise the sender and invite it to retransmit the communication or to submit a signed original of the document in question to the Office by post or any other available means within a specified deadline. If the retransmission is complete, the date of receipt will be considered to be the date of the first transmission, except for the purposes of establishing a filing date for an application. Otherwise, the Office will not take the transmission into account or will consider only the received and/or legible parts (04/07/2012, R 2305/2010-4, HOUBIGANT/ PARFUMS HOUBIGANT PARIS et al.).

For further information on the filing date, see the Guidelines, Part B, Examination, Section 2, Formalities and the Guidelines for Examination of Applications for Registered European Union Designs.

For further information on the User Area, and in particular on the proper use of the user account and the sanctions imposed in the event of the prohibited disclosure of User Area credentials, please see paragraph 4(b) of the Conditions of use of the user area, annexed to Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means.

3.1.2 By post or courier service

Documents sent by post or courier service should be sent to the Office's official address.

Documents sent by post or courier service must bear an original signature. If a document sent to the Office is not signed, the Office will invite the party concerned to do so within a specific deadline. If the document is not signed within that time, the application or request will be declared inadmissible, or the document will not be taken into account, as the case may be.

The date of receipt is the date on which the Office receives the communication irrespective of when it was placed in the mail or postal system (28/09/2016, T-400/15; CITRUS SATURDAY / CITRUS, EU:T:2016:569, § 25; 15/03/2011, T-50/09, Dada & Co / kids, EU:T:2011:90, § 67). The time of receipt is the local time in Alicante (Spain).

For further information on copies of the documents submitted in *inter partes* proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.2, Substantiation; and the Guidelines for Examination of Design Invalidity Applications, paragraph 4.1, Exchange of communications.

3.1.3 Annexes to communications

Pursuant to Article 55 EUTMDR, any documents or other items of evidence submitted by the party in EUTM proceedings must be contained in an annex to the submission, be numbered, be accompanied by an index with a short description of each item of evidence together with the number of pages, if applicable, and the page number where it is mentioned in the submission.

During the proceedings stage (i) when the evidence is not structured in numbered annexes; (ii) no index is sent (this meaning, when the required content of the index is not identifiable in any form); or (iii) when, on its own motion or after it being questioned by the other party, the Office finds it justified, in particular when it considers that the failure to comply with the relevant requirements significantly impairs the Office's or the other party's ability to review and assess the documents or items of evidence submitted and to understand the relevance of the same, a deficiency will be raised. A deficiency will not be raised if the content of the annexes is included in the text of the observations.

In *inter partes* proceedings

- annexes submitted by electronic means do not need to be submitted in duplicate;
- annexes submitted by post or courier consisting of paper documents (such as loose sheets of evidence) up to and including size A3 do not need to be submitted in duplicate;
- annexes submitted by post or courier consisting of paper documents larger than A3 or not on paper (e.g. data carriers, physical items of evidence such as product samples) must be submitted in duplicate, with one copy to be sent to the other party.

Where in *inter partes* proceedings relating to EUTMs, a copy is required but not provided, the annexes in question will not be taken into account. However, in *inter partes* proceedings relating to European Union designs, the Invalidity Division may invite the party to file a duplicate within a specified deadline.

For further information on items of evidence to be submitted in *inter partes* proceedings for the purpose of establishing use, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 5.3.2.1, Means of evidence, Principles.

In addition to the requirements of Article 55(2) EUTMDR, the Office recommends that the following key aspects of a structured presentation be taken into account in order to facilitate the processing and handling of the files:

1. to ensure a manageably sized file, parties should limit their submissions to items of evidence that are relevant to the case and to the ground/argument in question;
2. if the documentation is sent in different batches, each batch submitted should clearly indicate the total number of batches (including the total number of pages and the number of pages in each batch);
3. for physical specimens such as containers, packaging, etc. a photograph may be taken and submitted instead of the item itself and a duplicate (unless the electronic content of the item is relevant, as in the case of a data carrier);
4. where original documents or items are sent to the Office by mail, they should not be stapled, bound or placed in folders;
5. all items sent in duplicate for forwarding to the other party should be clearly identified; however, where the original is submitted to the Office by electronic means, no second copy needs to be sent.

3.1.4 Data carriers

Annexes to communications may be submitted on data carriers.

The Office considers data carriers to be small portable storage devices such as USB flash drives, pen drives or similar memory units. External hard drives, memory cards, CD ROMs, DVDs and other optical discs, as well as magnetic data carriers of any kind are excluded.

The Office only accepts the file formats listed in Decision No EX-22-7 of the Executive Director of the Office of 29/11/2022 on technical specifications for annexes submitted on data carriers, namely JPEG, MP3, MP4, PDF, TIFF, and for 3D models, STL, OBJ and X3D. The Office does not accept files in an executable file format (EXE), in a compressed file format or in an encrypted format, even if the resulting executed, decompressed or unencrypted file is in one of the acceptable file formats. Nor does the Office accept fillable PDF formats and PDF files that include added objects such as redacted (blacked-out) or added text, highlighted text or arrows.

The maximum size of each individual file saved on the data carrier is restricted to 20 MB (Article 4 of Decision No EX-22-7).

For further information, see Article 3 of Decision No EX-22-7 of the Executive Director of the Office of 29/11/2022 on technical specifications for annexes submitted on data carriers.

If an annex on the data carrier does not comply with the acceptable type of data carriers under Article 2(1) or the technical specifications under Article 3 and 4 of Decision No EX-22-7, the Office will deem it not to have been filed without inviting the party to overcome the deficiency (Article 6(a) No EX-22-7).

3.1.5 Signature

Article 63(1) EUTMDR Article 65(1) EUDIR

Applications and other communications to the Office must be signed by the sender.

If the application or other communication is filed by electronic means, the indication of the sender's name is deemed to be equivalent to a signature.

Where a submission or supporting document has to be signed, the signature must be accompanied by the name of the physical person signing and, if the signature is on behalf of a legal person (company), it must also include an indication of the role of the physical person in the company or their authority as signatory (e.g. Chief Executive Officer, President). The Office identification number (ID) may optionally also be indicated if available. If any of these identification elements are missing from the signature, the Office may issue a deficiency requesting the missing element(s). If a submission is not signed at all, the Office will invite the party concerned to correct the deficiency.

If a deficiency is notified, and is not remedied within the set time limit, the application will be rejected or the communication not taken into account.

For joint requests submitted in one single submission by electronic means in *inter partes* proceedings, the indication of the sender's name is deemed to be equivalent to its signature; however, the other party's signature must be presented in order for the request to be acceptable.

3.1.6 Confidentiality

Article 114(4) EUTMR Article 74(4)(c) EUDR

A party may, upon submitting a document or at a later stage, request that all or part of a document be kept confidential, as long as no request for an inspection of files is pending.

The party concerned must have expressly invoked, and sufficiently justified, a special interest in keeping the document confidential. For further details on invoking confidentiality and special interest, and on the examination process of confidential information, see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files, paragraph 5.1.3. Alternatively, the party may submit evidence in such a way that avoids revealing parts of the document or information that the party considers confidential, as long as the parts of the document submitted contain the required information. For example, where contracts or other documents are submitted as evidence, certain information may be blacked out before being submitted to the Office, or certain pages may be omitted altogether.

In principle, documents of a personal nature such as passports or other identification documents, which are submitted in particular as evidence in relation to requests for transfer, evidence of 'health data', which is submitted in particular as evidence in relation to restitutio in integrum or as supporting evidence for extension requests, and bank account extracts, which may, for example, be attached to applications and requests as evidence of fee payment, because of their inherent personal nature, confidentiality vis à vis any third parties is justified, and, in principle, overrides any third-party interest.

In *inter partes* proceedings, one of the parties might request the Office to keep certain documents confidential even vis-à-vis the other party in the proceedings. Although the Office can keep documents confidential vis-à-vis third parties (inspection of files), it can under no circumstances keep them confidential vis-à-vis the other party in *inter partes* proceedings. For further details concerning confidentiality in *inter partes* proceedings see the Guidelines, Part C, Opposition Proceedings, Section 1, Opposition Proceedings, paragraph 4.4.4.

3.1.7 Withdrawal of communications

Submissions become effective upon receipt by the Office, provided that the Office does not receive a withdrawal of the submission on the same day. This means that a submission will only be annulled if a letter withdrawing its submission reaches the Office on the same day it was received.

3.1.8 References made to documents or items of evidence in other proceedings

For further information on how to refer to documents or items of evidence submitted in other proceedings, see the Guidelines, Part A, Section 10, Evidence, 3.1 Reference to documents or evidence in other proceedings before the Office.

3.2 Notification by the Office

Article 94(2) and Article 98 EUTMR

Articles 56 to 62 EUTMDR

Article 41(1) and Articles 47 to 53 EUDIR

Decision No EX-18-4 of the Executive Director of the Office of 3 September 2018 concerning public notification

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

Written communications from the Office to the party or parties to proceedings will be 'notified'. A document is considered to be **notified** when it has been received or is deemed to have been received by the addressee, irrespective of whether the addressee has been advised of this. Consequently, the date of notification of a document is the date on which that document is **made accessible to or has reached the addressee**, and not the date on which it was sent or the date on which the person to whom it was addressed actually learned of the notification. However, exactly when receipt is deemed to take place will depend on the method of notification.

The Office can choose freely the most appropriate means of notification, apart from public notification. In practice, the Office will always opt to notify by electronic means, whenever available.

If the proper notification procedure has been followed, the document is deemed to have been notified, unless the recipient can prove that it either did not receive the document at all, or received it late. If this is proved, the Office will re-notify the document(s) Conversely, where the proper notification procedure was not followed, the document will still be considered notified if the Office can prove that the document actually reached the recipient (13/01/2011, T-28/09, Pine Tree, EU:T:2011:7, § 32).

Any communication or notification from the Office will indicate the department or division of the Office and the name(s) of the official(s) responsible. These documents have to be signed by the official(s) or, if not, bear the Office's printed or stamped seal.

3.2.1 Notification by electronic means

The User Area is the sole platform through which the Office will issue notifications by electronic means, and account holders may not opt-out of this means of receiving electronic communications from the Office as long as the User Area account remains active. This applies equally to new and existing user account holders, including those who may have previously opted-out under the former rules as set out in Article 3(1) of Decision of the Executive Director No EX-23-13. The Office will therefore send all notifications through the User Area, unless this is impossible for technical reasons.

The date on which the document is placed in an account holder's inbox will be recorded by the Office and mentioned in the User Area. The document is deemed to have been notified on the fifth calendar day following the day on which the document is placed in the account holder's inbox, irrespective of whether the recipient actually opened and read it.

3.2.2 Notification by post or courier

The procedure for notification by post or courier will depend on the nature of the document notified.

Decisions subject to a deadline for appeal, summonses and other documents as determined by the Executive Director of the Office will be notified by courier service or registered post, in both cases with advice of delivery.

All other notifications can be sent either by courier service or registered post, with or without advice of delivery, or by ordinary post. If the recipient's address is not in the EEA or the addressee has not appointed a professional representative, the Office will send the document by ordinary post.

Notification will be deemed to have taken place 10 days after the document was posted. The recipient can only rebut this presumption by proving that it did not receive the document or that it received it later. Indications giving rise to reasonable doubt about correct receipt are considered to be sufficient proof (25/10/2012, T-191/11, Miura, EU:T:2012:577, § 34).

In the event of a dispute, the Office must be able to establish that the notification reached its destination or the date on which it was delivered to the addressee. In this regard, the Office must establish that it had created the conditions for the document to be notified to arrive within the sphere of influence of the addressee. A distinction must be drawn between, first, the transmission of a document to the addressee, which is required for due notification, and, secondly, effective knowledge of that document, which is not required for the notification to be regarded as due notification. Existence of a valid notification to the addressee is in no way conditional on its having actually been brought to the notice of the person competent to deal with it under the internal rules of the entity addressed (22/11/2018, T-356/17, RoB, EU:T:2018:845, § 31-32, and the case-law cited therein).

Notification by registered letter will be deemed to have been effected even if the addressee refuses to accept the letter.

3.2.3 Public notification by public notice

Public notification will be used for all notifications where the addressee's address is unknown or where a notification by post has been returned to the Office after at least one failed attempt.

This relates primarily to post returned to the Office by the Post Office marked 'not known at this address' and post that has not been claimed by the addressee.

Public notifications will be published on the Office's website. The document will be deemed to have been notified one month after the day on which it was posted on the internet.

4 Time Limits Specified by the Office

Article 101 EUTMR
Articles 67 to 69 EUTMDR
Articles 56 to 58 EUDIR

Time limits before the Office can be divided into two categories:

- those laid down by the EUTMR, EUTMDR, EUTMIR, EUDR or EUDIR, which are therefore mandatory;
- those specified by the Office, which are therefore not mandatory and can be extended under certain circumstances.

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. They are a matter of public policy and rigorous compliance with them is necessary to ensure clarity and legal certainty.

The regulations provide three measures that mitigate the rigorous application of the principle of strict observance of time limits (deadlines), depending on whether they are still running or have expired.

If the time limit is still running, the party may **request an extension** of the time limit pursuant to Article 68 EUTMDR and Article 57(1) EUDIR.

In REUD proceedings, if the time limit has expired, the party that has missed it can request *restitutio in integrum* (pursuant to Article 67 EUDR), which requires meeting formal and substantive requirements (such as showing all due care).

In EUTM proceedings, if the time limit has expired, the party that has missed it has two possible courses of action: it can either seek **continuation of proceedings** (pursuant to Article 105 EUTMR), which only requires meeting certain formal requirements, or it can request *restitutio in integrum* (pursuant to Article 104 EUTMR), which requires meeting formal and substantive requirements (such as showing all due care).

Additional information is provided under paragraphs 4.4 and 4.5 below.

4.1 Length of the time limits specified by the Office

Regarding EUTM proceedings, with the exception of the time limits expressly specified in the EUTMR, EUTMDR, or EUTMIR, the time limits specified by the Office may not be less than one month or longer than six months.

Regarding REUD proceedings, with the exception of the time limits expressly specified in the EUDR or EUDIR, the time limits specified by the Office, when the party concerned has its domicile or its principal place of business or an establishment within the EU may not be less than one month or longer than six months. When the party concerned does not have its domicile or principal place of business or an establishment within the EU, the time limits may not be less than two months or longer than six months.

The general practice is to grant two months.

For further information, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

4.2 Expiry of time limits

Under Article 101(1) EUTMR, the calculation of a time limit starts on the day following the day on which the 'relevant event' occurred.

Where the Office sets a time limit in a notification indicating a time limit in terms of days, weeks or months (usually 2 months), the 'relevant event' is the date on which the document is notified or deemed notified, depending on the rules governing the notification. A notification issued by electronic means is deemed to have been notified on the fifth calendar day following the day on which the document is placed in the account holder's inbox (see paragraph 3.2.1) and a notification issued by post or courier is deemed to have been notified on the tenth day after it was posted (see paragraph 3.2.2).

Where a time limit is expressed in months, it will expire in the relevant subsequent month on the same day as the day on which the 'relevant event' occurred.

It is immaterial whether the 'relevant event' occurred on a working day, a holiday or a Sunday; that is relevant only for the expiry of the time limit.

Where the relevant subsequent month has no day with the same number, the time limit in question will expire on the last day of that month. A 2-month time limit specified in a notification on 31 July will therefore expire on 30 September.

The same applies to time limits expressed in weeks or years.

Any time limit will be deemed to expire at midnight on the final day (local time in Alicante (Spain)).

In the event a time limit is missed, there is no provision requiring the Office to inform a party of the procedures available to it under Articles 104 and 105 EUTMR, nor, *a fortiori*, is it incumbent on it to advise that party to pursue any particular legal remedy. Therefore, the principle of sound administration is not violated by the Office for not informing of the means for rectifying a late submission (04/05/2018, T-34/17, SKYLEADER (fig.), EU:T:2018:256, § 43).

A time limit that expires on a day on which the Office is not open for the receipt of documents or on which ordinary post is not delivered in the locality in which the

Office is located (Saturdays, Sundays and public holidays) will be extended to the first working day thereafter. For this purpose, the Executive Director of the Office determines the days on which the Office is closed before the start of each calendar year. The extension is automatic but it applies only at the end of the time limit (12/05/2011, R 924/2010-1, whisper power (fig.) / WHISPER).

In the event of a 'general interruption' to the postal service in Spain or of an 'actual interruption' of the Office's connection to authorised electronic means of communication, any time limit that expires during that period will be extended to the first working day after the period of interruption. These periods will be determined by the Executive Director of the Office; the extension will apply to all parties to the proceedings.

Not every technical error is regarded as an 'actual interruption of the Office's connection to admitted electronic means' under Article 101(3) EUTMR, Article 58 EUDIR. An actual interruption requires electronic communication (including all back-up options) to be disrupted for **at least 6 consecutive hours** during **the same working day**. For shorter interruptions, the Office will not extend the time limits under Article 101(3) EUTMR. Parties should be wary, therefore, of filing submissions on the last day of a time limit, especially after Office working hours. If a party misses a deadline, it may consider filing a request for *restitutio in integrum* (see paragraph 4.5) or for continuation of the proceedings (see paragraph 4.4).

In the event of an exceptional occurrence (strike, natural disaster, etc.) causing a disruption to the running of the Office or a serious impediment to its communication with the outside world, time limits may be extended for a period determined by the Executive Director of the Office.

4.3 Extension of time limits

In ***ex parte* proceedings** before the Office, if a request is made for an extension before the time limit expires, then a further period should be allowed, depending on the circumstances of the case, but not exceeding six months.

For the rules applicable to the extension of time limits in ***inter partes* proceedings** (i.e. where there are two or more parties involved, such as in opposition, invalidity and/or revocation proceedings), see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, and the Guidelines for Examination of Design Invalidity Applications.

As a general rule, the first request for an extension that is received in time will be considered appropriate and will be granted for a period equal to the original term (or less if requested). However, any subsequent request for an extension of the same time limit will be refused unless the party requesting it can explain and justify the 'exceptional circumstances' that (a) prevented it from carrying out the required action during the previous two periods (i.e. the original time limit plus the first extension) and (b) still prevent the requester from carrying it out, so that more time is needed.

Examples of justifications that can be accepted:

- ‘Evidence is being gathered from distribution channels/all our licensees/our suppliers in several Member States. So far, we have gathered documents from some of them but, due to the commercial structure of the company (as shown in the document enclosed), we have only recently been able to contact the rest.’
- ‘In order to show that the mark has acquired distinctiveness through use we started carrying out market research at the beginning of the period (on date X). However, the fieldwork has only recently been concluded (as shown in the enclosed documents); consequently, we need a second extension in order to finish the analysis and prepare our submissions to the Office.’
- ‘Death’ is also considered an ‘exceptional circumstance’. The same applies to serious illness, provided that no reasonable substitution was available.
- Finally, ‘exceptional circumstances’ also include ‘force majeure’ situations. ‘Force majeure’ is defined as a natural and unavoidable catastrophe that interrupts the expected course of events. It includes natural disasters, wars and terrorism, and unavoidable events that are beyond the party’s control.

Where a request is filed for an extension to an extendable time limit before this time limit expires and is not accepted, the party concerned will be granted at least one day to meet the deadline, even if the request for an extension arrives on the last day of the time limit.

4.4 Continuation of proceedings

Article 105 EUTMR

Continuation of proceedings is not available in REUD proceedings.

The expressions ‘further processing’ and ‘continuation of proceedings’ have the same meaning.

Article 105 EUTMR provides for the continuation of proceedings where time limits have been missed but excludes various time limits laid down in certain articles of the EUTMR.

The **excluded** time limits are the following:

- those laid down in Article 104 EUTMR (*restitutio in integrum*) and Article 105 itself (continuation of proceedings), in order to avoid double relief for missing the same time limit;
- those referred to in Article 139 EUTMR , that is to say, the three-month period within which conversion must be requested and the conversion fee paid;
- the opposition period and the time limit for paying the opposition fee laid down in Article 46 EUTMR ;
- those laid down in Article 32 (payment of the application fee), Articles 34(1) (right of priority), 38(1) (right of exhibition priority), 41(2) (period to remedy filing deficiencies) and 53(3) (period for renewal), Article 68 (appeal) and Article 72(5) EUTMR (appeal before the Court of Justice), and the time limits laid down by

the EUTMIR for claiming, after the application has been filed, seniority within the meaning of Article 39 EUTMR .

However, none of the time limits in **opposition proceedings** (other than the time limit for filing an opposition and paying the applicable fee, as mentioned above) are excluded. Consequently, continuation of proceedings is available for missing:

- the time limit under Article 146(7) EUTMR to translate the notice of opposition;
- the time limit under Article 5(5) EUTMDR to remedy deficiencies that affect the admissibility of the opposition;
- the time limits for the opponent to substantiate its opposition under Article 7 EUTMDR ;
- the time limit laid down in Article 8(2) EUTMDR for the applicant to reply;
- the time limit under Article 8(4) EUTMDR for the opponent to reply;
- the time limits for any further exchange of arguments, if allowed by the Office (07/12/2011, R 2463/2010-1 , Pierre Robert/ Pierre Robert (fig.) ;
- the time limit under Article 10(1) EUTMDR for the applicant to request that the opponent prove use of its earlier mark;
- the time limit under Article 10(2) EUTMDR for the opponent to submit proof of use of its earlier mark;
- the time limit under Article 10(6) EUTMDR to translate proof of use.

Furthermore, Article 105 EUTMR does not exclude any of the time limits that apply in proceedings for **revocation** or **declaration of invalidity**.

The party seeking continuation of proceedings must make the request, for which a fee is charged as established in Annex I of the EUTMR , within two months of the expiry of the original time limit and complete the omitted act by the time the request for continuation is received. There is no substantive requirement to be fulfilled such as when requesting *restitutio in integrum*; i.e. there is no need to justify the missing of the time limit.

- Request to be submitted **within two months of the expiry of the original time limit**

  The two months available for submitting a request for continuation of proceedings is an **objective** time limit and it is **non-extendable**. Consequently, unlike in the case of *restitutio in integrum*, it is irrelevant when the reason of non-compliance with the original time limit has been removed or when the party became aware of missing the original time limit.

  The request is deemed to be received only once the applicable fee has been paid (400 EUR).

  Once a request for continuation of proceedings has been **granted**, the time limit is deemed to be observed and the opportunity of continuation of proceedings is exhausted. Hence, any **subsequent** request for a continuation of proceedings for the same time limit is, by definition, inadmissible, even if submitted within the time remaining of the two months available for submitting such a request. Conversely, where the initial request for continuation of proceedings is **rejected**, a **subsequent** request for continuation of proceedings will be accepted if it is submitted within the

time remaining of the two months available for submitting such a request (and the other requirements are also complied with, i.e. the fee is paid and the omitted act is carried out).

- Omitted act must be carried out **together with the request**
  The omitted act must be carried out together with the request. The Office also accepts if the omitted act is carried out **before submission of the request**, so long as the request is made within the two months of the expiry of the original time limit.

  However, if the omitted act is carried out **after the submission of the request**, the request for continuation of proceedings will be rejected as inadmissible. This is so even in the case where the omitted act is carried out subsequent to the request, but still within the time remaining of the two months open for such a request.
- Omitted act must be **carried out**
  The party requesting continuation of proceedings must perform the procedural act whose time limit it missed (e.g. submit evidence in support of the opposition, request proof use, submit observations in reply to the opposition). If the omitted act is not carried out, the request will be rejected as inadmissible. A request for an extension of time cannot substitute the completion of the omitted act.

  The verification of the admissibility of the request does not entail an examination of whether the submission complies with the **substantive** legal requirements of the omitted act. Therefore, notwithstanding that a request for continuation of proceedings may have been found admissible and the relevant fees charged, the submission for 'carrying out the omitted act' may be found not to comply with the **substantive legal requirements** of the act concerned. Therefore, parties should prepare their submissions completing the omitted act with utmost care so that the request for continuation of proceedings could serve its purpose.

  Examples:

  - in the case of missing the time limit for **substantiation of the opposition**, if together with the request for continuation of proceedings the party submits documents with the purpose of substantiating the opposition, the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted. However, that evidence may be found to be insufficient to substantiate the opposition later in the course of its **substantive** examination;
  - in the case of missing a time limit for **submitting proof of use** in opposition proceedings, if together with the request for continuation of proceedings the party submits documents with the purpose of proving genuine use, the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted. However, that evidence may be found to be insufficient to prove genuine use later in the course of its **substantive** examination;
  - in the case of missing a time limit for **requesting proof of use** in opposition proceedings, if together with the request for continuation of proceedings the party submits a properly formulated request for proof of use (i.e. unambiguous, unconditional and submitted in a separate document, in compliance with the

formal requirements laid down in Article 10(1) EUTMDR), but the earlier mark is not yet subject to the requirement of use (thus does not satisfy the **substantive** requirement of Article 47(2) or (3) EUTMR), the omitted act will be considered to have been 'carried out' and the request for continuation of proceedings will be granted, however, the request for proof of use will be rejected.

However, the **formal** requirements of the omitted act must be complied with in order for the omitted act to be considered as duly **introduced** and, thus, 'carried out'.

Example:

- in the case of missing a time limit for **requesting proof of use** in opposition proceedings, if under a separate heading **within** the request for continuation of proceedings (i.e. not in a separate document as required by Article 10(1) EUTMDR) the party requests proof of use, the request for proof of use will not be considered to have been **introduced**, and thus, the omitted act will not be considered to have been 'carried out'. The request for continuation of proceedings will be rejected as inadmissible.

- Outcome of the request

  If the Office **accepts** the request for continuation of proceedings, the consequences of having failed to observe the time limit will be deemed not to have occurred. If a decision has been taken between the expiry of that time limit and the request for the continuation of proceedings, the department competent to decide on the omitted act will review the decision and, where completion of the omitted act itself is sufficient, take a different decision. If, following the review, the Office concludes that the original decision does not need to be altered, it will confirm that decision in writing.

  If the Office **rejects** the request for continuation of proceedings, the fee will be refunded, or if not yet debited from the party's current account, it will not be charged (Article 105(5) EUTMR). However, as stated above, the party may introduce a new request if there is still time remaining of the two months open for such a request.

4.5 *Restitutio in integrum*

A party to proceedings before the Office may be reinstated in its rights (*restitutio in integrum*) if, in spite of all due care required by the circumstances having been taken, it was unable to meet a time limit vis-à-vis the Office, provided that the failure to meet the time limit had the direct consequence, by virtue of the provisions of the regulations, of causing the loss of any right or means of redress.

For further information see the Guidelines, Part A, General Rules, Section 8, *Restitutio in Integrum*.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 2

General principles to be respected in the proceedings

1 Adequate reasoning

Articles 94 to 97 and 109 EUTMR Articles 62 to 65 and 70 EUDR Article 38 EUDIR

Office decisions will be in writing and will state the reasons on which they are based. The reason for this is twofold: to explain to interested parties why the measure was taken so that they can protect their rights, and to enable the Courts of the European Union to exercise their power to review the legality of the decision (12/07/2012, T-389/11, Guddy, EU:T:2012:378, § 16; 22/05/2012, T-585/10, Penteo, EU:T:2012:251, § 37, as well as the case-law cited; 27/06/2013, T-608/11, Instruments for writing, EU:T:2013:334, § 67).

However, if the Office does not respond to all the arguments raised by the parties, this does not necessarily infringe the duty to state reasons (11/06/2014, T-486/12, Metabol, EU:T:2014:508, § 19; 28/01/2014, T-600/11, Carrera Panamericana, EU:T:2014:33, § 21; 15/07/2014, T-576/12, Protekt, EU:T:2014:667, § 78; 18/11/2015, T-813/14, Cases for Portable computers, EU:T:2015:868, § 15).

It is sufficient that it sets out the facts and legal considerations of fundamental importance in the context of the decision (18/01/2013, T-137/12, Vibrator, EU:T:2013:26, § 41-42; 20/02/2013, T-378/11, Medinet, EU:T:2013:83, § 17; 03/07/2013, T-236/12, Neo, EU:T:2013:343, § 57-58; 16/05/2012, T-580/10, Kindertraum, EU:T:2012:240, § 28; or 10/10/2012, T-569/10, Bimbo Doughnuts, EU:T:2012:535, § 42-46, 08/05/2014, C-591/12 P, Bimbo Doughnuts, EU:C:2014:305).

The Office can use facts that are a matter of common knowledge as a basis for its reasoning. Well-known facts are those that are likely to be known by anyone or that may be learnt from generally accessible sources (16/10/2014, T-444/12, Linex, EU:T:2014:886, § 30; 22/06/2004, T-185/02 Picaro, EU:T:2004:189, § 29; 09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 29; 28/09/2016, T-476/15, FITNESS, EU:T:2016:568, § 41; 17/09/2020, C-449/18 P – C-474/18 P, MESSI (fig.) / MASSI et al., EU:C:2020:722, § 74).

The Office is not required to prove the accuracy of these well-known facts and, therefore, it is not obliged to give examples of such practical experience; it is up to the party concerned to submit evidence to refute it (20/03/2013, T-277/12, Caffè Kimbo, EU:T:2013:146, § 46; 11/07/2013, T-208/12, Rote Schnürsenkelenden, EU:T:2013:376, § 24; 21/02/2013, T-427/11, Bioderma, EU:T:2013:92, § 19-22; 08/02/2013, T-33/12, Medigym, EU:T:2013:71, § 20, 25; 07/12/2012, T-42/09, Quadratum, EU:T:2012:658, § 73; 19/09/2012, T-231/11, Stoffmuster, EU:T:2012:445, § 51).

Where a party argues that the circumstances of the proceedings are comparable to a previous Office decision, and the Office departs from the position taken in said decision, this needs to be addressed and particular explanations may be required (see

the Guidelines, Part A, General Rules, Section 2, General principles to be respected in the proceedings, Paragraph 3, Other General Principles of EU Law in relation to the principle of sound administration).

2 The Right to Be Heard

Articles 94 to 97 and 109 EUTMR Article 62 EUDR

The defence's right to be heard is a general principle of EU law, according to which a person whose interests are appreciably affected by a decision addressed to him or her by a public authority must be given the opportunity to make his or her point of view known. In accordance with that principle, the Office may base its decision only on matters of fact or of law on which the parties have been able to set out their views. Consequently, where the Office gathers facts to serve as a basis for its decision, it is obliged to notify the parties of those facts in order that the parties may submit their views on them (07/11/2014, T-567/12, Kaatsu, EU:T:2014:937, § 50-51 and case-law cited therein).

The right to be heard covers all the matters of fact or law and evidence that form the basis for the decision.

The Office will take legal issues into account, irrespective of whether or not they have been pleaded by the parties. For examination, it will examine the facts on its own motion; however, in opposition, cancellation and design invalidity proceedings, it will restrict its examination of facts, evidence and arguments to those provided by the parties. Nevertheless, this restriction does not prevent the Office from taking additional well-known facts into consideration.

While the Office must rule on each head of claim (10/06/2008, T-85/07, Gabel, EU:T:2008:186, § 20), it is not required to give express reasons for its assessment in respect of each and every piece of evidence submitted or arguments put forward, where it considers that evidence or arguments to be unimportant or irrelevant to the outcome of the dispute (15/06/2000, C-237/98 P, Dorsch Consult v Council and Commission, EU:C:2000:321, § 51).

The right to be heard does not apply to the final position to be adopted. Therefore, the Office is not bound to inform the parties of its legal opinion before issuing a decision and thus afford them the opportunity to submit their observations on that position or even to submit additional evidence (09/07/2014, T-184/12, Heatstrip, EU:T:2014:621, § 37; 14/06/2012, T-293/10, Colour per se, EU:T:2012:302, § 46 *in fine*; 08/03/2012, T-298/10, Biodanza, EU:T:2012:113, § 101; 20/03/2013, T-277/12, Caffè Kimbo, EU:T:2013:146, § 45-46).

Changing circumstances arising in the course of the proceedings (e.g. if during opposition proceedings the earlier right on which the opposition was based lapses

because it is not renewed or is declared invalid) will also be taken into account and the parties will be informed accordingly.

3 Other general principles of EU Law

The Office must respect the general principles of EU law, such as equal treatment and sound administration (24/01/2012, T-260/08, Visual Map, EU:T:2012:23; 23/01/2014, T-68/13, Care to care, EU:T:2014:29, § 51; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 73).

For reasons of legal certainty and of sound administration, there must be a stringent and full examination of all applications in order to prevent trade marks and designs from being improperly registered. That examination must be undertaken in each individual case (23/01/2014, T-68/13, Care to care, EU:T:2014:29, § 51).

The lawfulness of the Office's decisions must be assessed solely on the basis of EU regulations, as interpreted by the European Union judicature. Accordingly, the Office is not bound either by its previous decision-making practice or by a decision given in a Member State, or indeed a third country, that the sign/design in question is registrable as a national mark/design (23/01/2014, T-513/12, Norwegian getaway, EU:T:2014:24, § 63). This is true even if the decision was adopted in a country belonging to the linguistic area in which the word sign in question originated (16/05/2013, T-356/11, Equipment, EU:T:2013:253, § 7).

However, in the light of the principles of equal treatment and sound administration, the Office will take into account the decisions already taken in comparable cases and must carefully consider whether it should decide in the same way or not (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509, § 61 and 66; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 74-75).

Moreover, the principle of equal treatment and sound administration must be applied in a manner that is consistent with the principle of legality, according to which a person may not rely, in support of his or her claim, on an unlawful act committed in another procedure (23/01/2014, T-68/13, Care to care, EU:T:2014:29, § 51; 12/12/2013, T-156/12, Oval, EU:T:2013:642, § 29; 02/05/2012, T-435/11, UniversalPHOLED, EU:T:2012:210, § 38; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 76-77).

4 Oral proceedings

Articles 96 to 97 EUTMR
Articles 49 to 55 EUTMDR
Articles 64 to 65 EUDR
Articles 42 to 46 and 82 EUDIR

Article 96 EUTMR and Article 64 EUDR provide that the Office may hold oral proceedings.

Any unofficial contacts such as telephone conversations will not be considered to constitute oral proceedings within the meaning of Article 96 EUTMR and Article 64 EUDR.

The Office will hold oral proceedings either on its own initiative or at the request of any party to the proceedings only when it considers these to be absolutely necessary. This will be at the Office's discretion (20/02/2013, T-378/11, Medinet, EU:T:2013:83, § 72 and the case-law cited therein; 16/07/2014, T-66/13, Flasche, EU:T:2014:681, § 88). In the vast majority of cases it will be sufficient for the parties to present their observations in writing.

4.1 Summons to oral proceedings

Where the Office has decided to hold oral proceedings and to summon the parties, the period of notice may not be less than one month unless the parties agree to a shorter period.

Since the purpose of any oral proceedings is to clarify all outstanding points before the final decision is taken, the Office, in its summons, should draw the parties' attention to the points that need to be discussed in order for the decision to be taken.

Where the Office considers it necessary to hear oral evidence from the parties, witnesses or experts, it will take an interim decision stating the means by which it intends to obtain evidence, the relevant facts to be proven and the date, time and place of the hearing. The period of notice will be at least one month, unless the parties concerned agree to a shorter period. The summons will provide a summary of this decision and state the names of the parties to the proceedings and details of the costs, if any, that the witnesses or experts may be entitled to have reimbursed by the Office.

The Office may also offer the possibility of taking part in the oral proceedings by video conference or other technical means.

If required, and in order to facilitate the hearing, the Office may invite the parties to submit written observations or to submit evidence prior to the oral hearing. The period

fixed by the Office for receiving these observations must allow sufficient time for them to reach the Office and then be forwarded to the other parties.

The parties may likewise submit evidence in support of their arguments on their own initiative. However, if this evidence ought to have been produced at an earlier stage of the proceedings, the Office will decide whether these items of evidence are admissible, taking account of the principle of hearing both parties, where appropriate.

4.2 Language of oral proceedings

Oral proceedings will be in the language of the proceedings unless the parties agree to use a different official EU language.

The Office may communicate in oral proceedings in another official EU language and it may, upon prior written request, authorise a party to communicate in another official EU language provided that simultaneous interpretation of the communication into the language of proceedings can be made available. The costs of providing simultaneous interpretation will be paid by the party making the request or by the Office as the case may be.

4.3 Course of the oral proceedings

Oral proceedings before the examiners, the Opposition Division and the department in charge of the Register will not be public.

Oral proceedings, including the delivery of the decision, will be public before the Cancellation/Invalidity Division and the Boards of Appeal, insofar as the department before which the proceedings are taking place does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

If a party who has been duly summoned to oral proceedings does not appear before the Office, the proceedings may continue without them.

If the Office invites a party to give evidence orally, it will advise the other parties accordingly so that they can attend.

Similarly, when the Office summons an expert or a witness to a hearing, it will advise the parties concerned. These may be present and put questions to the person giving evidence.

At the end of the oral proceedings the Office will allow the parties to present their final pleadings.

4.4 Minutes of oral evidence and of oral proceedings

Article 53 EUTMDR

Article 46 EUDIR

Minutes of the taking of oral evidence and of oral proceedings will be confined to the essential elements. In particular, they will not contain the verbatim statements made nor be submitted for approval. However, any statements by experts or witnesses will be recorded so that at further instances the exact statements made can be verified.

Where oral proceedings or the taking of evidence before the Office are recorded, the recording will replace the minutes.

The parties will receive a copy of the minutes.

4.5 Costs of taking evidence in oral proceedings

The Office may make the taking of evidence conditional upon a deposit by the party requesting it. The amount will be fixed by the Office based on an estimate of the costs.

The witnesses and experts summoned or heard by the Office will be entitled to reimbursement of expenses for travel and subsistence, including an advance. They will also be entitled to compensation for loss of earnings and payment for their work.

The amounts reimbursed and the advances for expenses are determined by the Executive Director of the Office and are published in the Office's Official Journal. For details, see Decision No EX-99-1 of the President of the Office of 12/01/1999 as amended by Decision No EX-03-2 of the President of the Office of 20/01/2003.

Where the Office decides to adopt means of taking evidence that require oral evidence from witnesses or experts, the Office will bear the cost of this. However, where one of the parties has requested oral evidence, then that party will bear the cost, subject to a decision on the apportionment of costs in *inter partes* proceedings.

5 Decisions

5.1 Contents

Article 94 EUTMR

Article 62 EUDR

Articles 38 to 41 EUDIR

Office decisions will be reasoned to such an extent that their legality can be assessed at the appeal stage or before the General Court or Court of Justice.

The decision will cover the relevant points raised by the parties. In particular, if there are different outcomes for some goods and services of the EUTM application or registration concerned, the decision will make clear which of the goods and services are refused and which are not.

The name or names of the person(s) who took the decision will appear at the end of the decision.

At the end of the decision, there will also be a notice advising of the right to appeal.

Failure to include this notice does not affect the legality of the decision and does not affect the deadline for filing an appeal.

5.2 Apportionment of costs

Article 105(5), Article 109 and Annex I A(33)EUTMR

Article 33 EUTMDR

Article 70 EUDR and point 18 of the Annex to the EUDR

Articles 37 and 79 EUDIR

'Costs' comprise the costs incurred by the parties to the proceedings, chiefly (i) representation costs and costs for taking part in oral hearings ('representation costs' means the costs for professional representatives within the meaning of Article 120 EUTMR and Article 78 EUDR, not for employees — not even those from another company with economic links); and (ii) the opposition, cancellation or invalidity fee.

'Apportionment of costs' means that the Office will decide whether and to what extent the parties have to reimburse each other. It does not involve the relationship with the Office (fees paid, the Office's internal costs).

In *ex parte* proceedings, there is no decision on costs, nor any apportionment of costs. The Office will not reimburse any fees paid (the exceptions are Article 33 EUTMDR and

Article 37 EUDIR, refund of the appeal fee in certain cases, and Article 105(5) EUTMR, refund of the fee for continuation of proceedings if the application is not granted).

Decisions on costs, or the fixing of costs, are limited to opposition, cancellation and design invalidity proceedings (including the ensuing appeal proceedings or proceedings before the GC and CJEU).

If a decision is given in *inter partes* proceedings, the Office will also decide on the apportionment of costs.

The decision will fix the costs to be paid by the losing party/parties. The losing party will bear the fees and costs incurred by the other party that are essential to the proceedings. No proof that these costs were actually incurred is required.

If both parties fail on one or more heads or if reasons of equity so dictate, the Office may determine a different apportionment of costs.

If the contested EUTM application, EUTM or REUD is withdrawn or surrendered, or the opposition, request for cancellation or application for a declaration of invalidity is withdrawn, the Office will not decide on the substance of the case, although it will normally take a decision on costs. The party terminating the proceedings will bear the fees and costs incurred by the other party. Where the case is closed for other reasons, the Office will fix the costs at its discretion. This part of the decision can be enforced in simplified proceedings in all Member States of the EU once it becomes final.

In no case will the decision on costs be based on hypothetical assumptions about who might have won the proceedings if a decision on substance had been taken.

Furthermore, within one month of the date of notification fixing the amount of the costs, the party concerned may request a review. This request must state the reasons on which it is based and must be accompanied by the corresponding fee.

For further information see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 6.5 and the Guidelines on Examination of Design Invalidity Applications.

5.3 Public availability of decisions

Article 113 EUTMR

Decision No EX-25-05 of the Executive Director of the Office of 7 April 2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database.

To promote convergence of practices, the Office maintains a case-law database, making publicly available Office decisions defined by the EUTMR, the EUDR and the legislative acts adopted pursuant to them, as well as judgments of national and EU courts in intellectual property matters.

For reasons of transparency and in the interest of the public, the Office makes its decisions publicly available upon their notification, irrespective of the fact whether the decisions have become final. This includes making decisions publicly available

following the examination of an EUTM application upon their notification, although the EUTM application may remain unpublished following its refusal or a withdrawal of the EUTM application (see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 4, Publication). It also includes decisions even if they are annulled at a later stage, or if they do not become final for any other reason.

The Office's decisions will be kept in the database. Requests for removal of decisions from the database will be refused.

However, before the publication of an REUD pursuant to Article 49 or Article 50(4) EUDR, public availability of Office decisions is subject to the restrictions laid down in Article 50(2) and (3) EUDR and Article 14(3) EUDIR. These include REUD applications refused before reaching registration, and registered EU designs subject to deferment of publication. In both cases the disclosure of content is subject to the restrictions in the aforementioned articles.

Making such decisions publicly available in the database is not to be confused with their entry in the register. The outcome of the decisions is recorded in the EUTM or EUD registers only once they are final.

The judgments and decisions are made available in their original language. Official translations are published where available. The case-law database may contain unofficial translations, where indicated, or may facilitate automatic machine translations for information purposes only.

The case-law database is accessible free of charge on the Office's website through the tool eSearch Case Law.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 3

Payment of fees, costs and charges

1 Introduction

Articles 178 to 181 and Annex I EUTMR

Articles -106aa to -106ad and Annex I EUDR

The specific rules on the payment of fees and charges in European Union trade mark (EUTM) matters are laid down in Articles 178 to 181 and Annex I EUTMR.

The specific rules on the payment of fees and charges in European Union design (EUD) matters are laid down in Articles -106aa to -106ad and Annex I EUDR.

The full list of fees can be found on the EUIPO website: for EUTMs and REUDs.

The Executive Director of the Office is empowered to lay down charges that may be payable to the Office for services it may render and to authorise methods of payments in addition to those explicitly provided for in the EUTMR and the EUDR.

The differences between fees, costs and charges are as follows.

- **Fees** must be paid to the Office by users for the filing and handling of trade mark and design proceedings; the above regulations determine the amounts of the fees and the ways in which they must be paid. Most of the proceedings before the Office are subject to the payment of fees, such as the application fee for an EUTM or an REUD, renewal fees, etc. Some fees have been reduced to zero (e.g. registration fees, transfers).

  Rights of the Office to the payment of a fee are extinguished after 4 years from the end of the calendar year in which the fee fell due (Article 108 EUTMR and Article 69 EUDR).
- **Costs** refer to the costs of the parties in *inter partes* proceedings before the Office, in particular for professional representation (for trade marks see Article 109 EUTMR and Articles 18 and 27 EUTMIR; for designs see Articles 70 to 71 EUDR and Article 79 EUDIR). Decisions in *inter partes* cases can contain, where necessary, a decision on fees and costs of the professional representatives, and must fix the amount. The decision on costs may be enforced once the decision has become final, pursuant to Article 110 EUTMR
  and Article 71 EUDR.
- **Charges** are fixed by the Executive Director of the Office for any services rendered by the Office other than those specified in Annex I EUTMR and Annex I EUDR (Article 178 EUTMR and Article -106aa EUDR). The amounts of the charges laid down by the Executive Director will be published in the Official Journal of the Office and can be found on the website under decisions of the Executive Director. Examples are the charges for mediation in Brussels or for certain publications issued by the Office.

The payment of a fee and indication of the nature of the fee and the procedure to which it refers does not dispense with the obligation to meet the other remaining formal requirements of the procedural act concerned unless expressly established

in the EUTMR, the EUDR and the secondary legislative acts (e.g. for renewals). For example, the payment of the appeal fee and the indication of the number of the contested decision is not sufficient to file a valid notice of appeal (31/05/2005, T-373/03, Parmitalia, EU:T:2005:191, § 58; 09/09/2010, T-70/08, Etrax, EU:T:2010:375, § 23-25).

2 Means of Payment

Article 179(1) EUTMR

Article -106ab(1) EUDR

Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

All fees and charges must be paid in euros. Payments in other currencies are not valid, do not create rights and will be reimbursed.

The admissible means of payment are, in most cases, bank transfers, debits from the current accounts held at the Office, and (for certain online services only) debit or credit cards. Cash payments at the Office's premises and cheques are not accepted (03/09/2008, R 524/2008-1, Teamstar / TeamStar).

In line with Article 178 EUTMR and Article 71 of the EUIPO's Financial Regulation, the Office provides services upon the advance payment of the corresponding fee or charge.

The Office does not issue invoices or debit notes to claim payment for fees or charges as they must be paid before the services are provided by the Office and therefore there are no outstanding payments.

However, the Office can provide a receipt to confirm payment when requested by the user.

Additionally, for each request submitted by a party to proceedings before the Office, the Office issues an acknowledgement of receipt of the request where the fee amount is indicated.

2.1 Payment by bank transfer

Money may be sent to the Office by means of transfer. A fee is not deemed to be paid if the order to transfer is given after the end of the time limit. If the fee is sent before the time limit but arrives after its expiry, under specific conditions the Office may consider the fee has been duly paid (see paragraph 4.1 below).

2.1.1 Bank accounts

Payment by bank transfer can only be made to one of the Office's bank accounts. Details of these accounts are available on the Office's website (https://www.euipo.europa.eu/en/trade-marks/before-applying/fees-payments) under 'Fees and payments'.

Concerning bank charges, it is important to ensure that the full amount reaches the Office without any deductions.

2.1.2 Details that must accompany the payment

Article 179(2) and (3) EUTMR

Decision EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amounts of fees and charges

Every payment must indicate the name of the person making the payment and must include the information the Office needs to immediately identify the payment's purpose.

1. Name

   Regarding **the name of the person making the payment**, the sender's full name must be included in the sender field of the bank transfer.

2. Purpose

   Regarding the **payment's purpose**, the description field of the bank transfer must include the information needed to immediately identify the payment's purpose.

Additionally, it is recommended that contact details be provided either in the sender field or in the description field. This allows the Office to contact the person making the payment should this be necessary.

The Office provides users with a single **payment transaction code**. If a party selects 'bank transfer' as the payment method when filling out an online e-filing form in the User Area, the system will provide a unique eight-digit payment transaction code in the filing receipt. The first two digits stand for the current year, the next five digits are a mix of numbers and letters and the last is a control number (e.g. 2139EDH2).

It is highly recommended to put the payment transaction code in the description field of the bank transfer, preferably at the beginning. This field should also include the nature of the fee, for instance the type of proceedings in abbreviated form (see examples below), and the application or file number. Following these **two crucial items**, other information can be included, such as the name of the party or representative (when different from the person making the payment) and their Office ID number.

Properly filling in the name and description fields in the bank transfer will ensure that the Office identifies the payment correctly and deals with the applications or procedural

acts in a timely manner. Since these fields have character limits, it is recommended to use abbreviations where possible and avoid excessive use of spaces or initial zeros in numbers.

The following are suggested abbreviations (or a combination thereof) for the most common transactions before the Office subject to a fee, and can be used, along with the payment transaction code, to assist in identifying the payment:

Description	Abbreviation
Application fee for EUTM or REUD	EUTM, REUD
International application fee	IA
Renewal fee	REN
Opposition fee	OPP
Cancellation fee	CANC
Appeal	R
Recordal	REC
Conversion	CONV
Inspection of files	IOF
Current Account	CA
Owner ID number	OWN ID
Representative ID number	REP ID

For example, when paying for an EUTM filing where a payment code has been provided (2132EDH2), the EUTM application number appears on the receipt (184583674) and it is filed by a Representative that has an ID with the Office (ID 1024891), the preferred description would be '**2132EDH2 EUTM 184583674 REP ID1024891**'.

Another example, where a Representative (ID 1024891) is making a payment to replenish a current account held with the Office (account No 6361), as there would be no individual payment transaction code, the preferred description would be '**CA6361 REP ID 1024891**'.

Incorrect or insufficient information identifying the file the payment is linked to can cause considerable delays in processing the applications or procedural acts.

When the information supplied is **insufficient for the Office to establish the purpose of the payment**, the Office will contact the person making the payment (if they provided their contact details), and specify a time limit within which the missing information must be provided, failing which the payment will be deemed not to have been made and the sum will be reimbursed (if the sender provides the necessary bank details).

Where there is **contradictory information** in the description field identifying more than one file or proceeding, the Office will contact the sender (if they provided their contact details), and specify a time limit for them to clarify which of the files the payment should be linked to. In the absence of clarification, the payment will in principle be considered to be for the file **identified in first place** in the payment description field. For example, a payment of EUR 850 for an EUTM application with two payment transaction codes (e.g. '**2132EDH2, 2141KHG1, EUTM**') in the description field, each relating to a different EUTM filing. Where the party does not reply to the Office's letter, the payment will be linked to the EUTM application first identified, namely, in the example, the one with the payment transaction code '**2132EDH2**'.

2.2 Payment by debit or credit card

Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

Annex I A EUTMR

Article -106ab(1) EUDR

Most online services can be paid for by debit or credit card, provided that payment is made for a service requested through the User Area. However, payment by debit or credit card is not yet available for all of the Office's fees. The relevant online tool (e.g. e-filing) will indicate when a fee can be paid by credit or debit card. In particular, debit or credit cards cannot be used to pay charges referred to in Article 178(1) EUTMR and Article -106aa(1) EUDR or for replenishing a current account.

Debit or credit card payments allow the Office to make the best use of its own automatic internal systems, so that work on the file can start more quickly.

Debit or credit card payments are immediate (see paragraph 4.2 below) and are therefore not allowed for making delayed payments (payments to be made within 1 month from the filing date).

Debit or credit card payments require some essential information. The information disclosed will not be stored by the Office in any permanent database. It will only be kept until it is sent to the bank. Any record of the form will only include the debit or credit card type plus the last four digits of the debit or credit card number. The entire debit or credit card number can safely be entered via a secure server, which encrypts all information submitted.

2.3 Payment by the Office current account

Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges.

It is advisable to open a current account at the Office as, for any request that is subject to time limits, such as filing oppositions or appeals, the payment will be deemed to have been made on time, even if the relevant documentation for which the payment was made (e.g. a notice of opposition) is submitted on the last day of the deadline, provided that the current account has sufficient funds (see 4.3 Payment by current account on page 224) (07/09/2012, R 2596/2011-3, Stair Gates, § 13-14). The date on which the current account is actually debited will usually be later, but payment will be deemed to have been made on the date on which the request for a procedural act is received by the Office, or as otherwise convenient for the party to the proceedings, in accordance with Article 7 of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges.

The following may hold current accounts (Article 2 of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025; see the Guidelines, Part A, Section 5, Parties to the Proceedings and Professional representation):

1. natural or legal persons who, in accordance with Article 5 EUTMR and Articles 17 and 2a EUDR, are proprietors of EUTMs or holders of REUDs;
2. persons who may act as representatives in accordance with Article 120 EUTMR and Article 78 EUDR;
3. associations of representatives;
4. natural or legal persons authorised by proprietors of EUTMs or holders of REUDs for the purposes of Article 53(1) EUTMR or Article 50d(1) EUDR.

If the person that has filed the application or the respective procedural act is the holder of a current account with the Office, the Office will automatically debit the current account, unless instructions to the contrary are given in any individual case. In order for the account to be correctly identified, the Office recommends clearly indicating the Office ID number of the holder of the current account with the Office.

The system of current accounts is an automatic debiting system, meaning that upon identification of such an account, the Office may, according to the development of the procedures concerned and insofar as there are sufficient funds in the account, debit all fees and charges due within the limits of the aforementioned procedures, and a payment date will be accorded each time without any further instructions. The only exception to this rule is made when the holder of a current account who wishes to exclude the use of their current account for a particular fee or charge informs the Office thereof in writing. In this scenario, however, the holder of the account may change the

method of payment back to payment by current account at any time before the expiry of the payment deadline.

The absence of an indication or the incorrect indication of the amount of the fee does not have any negative effect, since the current account will be automatically debited with reference to the corresponding procedural act for which the payment is due.

If there are insufficient funds in a current account, the holder will be notified by the Office and given the possibility to replenish the account with sufficient funds to allow for the payment of the fees concerned and of the administrative charge, which is 20 % of the total of the late fee. The administrative charge must not in any event exceed the maximum of EUR 500 or the minimum of EUR 100.

If the holder does replenish the account, the payment of the fee will be deemed to have been received on the date the relevant document in relation to which the payment was made (for instance a notice of opposition) is received by the Office. If payment concerns the replenishment of a current account, it is sufficient to indicate the current account number.

Where the current account is replenished to cover only part of the amount due, the debit will be made, without exceptions, in the following order:

1. the administrative charges will be debited first; then,
2. if there are several fees or charges pending, the debit will be made in chronological order, taking into account the date when the fees were due, and only where the complete fee can be debited.

Where the current account is not replenished to cover all of the administrative charges and fees concerned on time, the payment will be deemed not to have been made and any rights depending on the timely payment will be lost.

The Office provides current account holders with access to their current account information over a secure internet connection. The account holder can view, save or print account movements and pending debits online via the User Area of the Office website.

Payment of a fee by debiting a current account held by a third party requires explicit written authorisation. The authorisation must be given by the holder of the current account and must state that the account can be debited for a specific fee. The authorisation must reach the Office before payment is due. Payment will be considered effective on the date the Office receives the authorisation.

If the holder is neither the party nor their representative, the Office will check whether such authorisation exists. Where the authorisation is not on file, the Office will inform the party concerned. In the absence of the submission of the holder’s authorisation on time, that is, before payment is due, the party’s request to debit the fee will be disregarded by the Office.

A current account can be opened at the Office either by emailing a request to fee.information@euipo.europa.eu or by initiating an e-Action in the User Area.

The minimum amount required to open a current account is EUR 1 000.

Once an account has been opened, the Office reserves the right to close a current account by written notification to the holder, in particular where it deems that the use made of the current account was not in accordance with the terms and conditions laid down in Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges, or when it is determined that there has been a misuse of the account. Misuse could be considered in situations such as systematic lack of funds, repeated misuse of third-party authorisations or multiple accounts, non-payment of administrative charges, or situations where the actions of the account holder have led to an excessive administrative burden on the Office. For more details on closure, reference is made to Article 12 of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges.

3 Time of Payment

Article 178(2) EUTMR Article -106aa(2) EUDR

Fees must be paid on or before the date on which they become due.

If a time limit is specified for a payment to be made, then that payment must be made within that time limit.

Fees and charges for which the regulations do not specify a due date will be due on the date of receipt of the request for the service for which the fee or the charge is incurred, for example, a recordal application.

4 Date on which Payment is Deemed to be Made

Article 180(1) and (3) EUTMR Article -106ac EUDR Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

The date on which a payment is deemed to be made will depend on the method of payment.

4.1 Payment by bank transfer

When the payment is made by transfer or payment to an Office bank account, the date on which payment is deemed to have been made is the date on which the amount is credited to the Office bank account.

4.1.1 Late payment with or without surcharge

A payment that is received by the Office after expiry of the time limit will be considered to have been made in due time if evidence is submitted to the Office that the person who made the payment (a) duly gave an order, within the relevant period for payment, to a banking establishment to transfer the amount of the payment, and (b) paid a surcharge of 10 % of the total amount due (up to a maximum amount of EUR 200). Both conditions must be fulfilled in accordance with the judgment of 12/05/2011, T-488/09, Redtube, EU:T:2011:211, § 38, and decision of 10/10/2006, R 0203/2005-1, BLUE CROSS MEDICARE / BLUE CROSS.

The same is not true for the late payment of the surcharge. If the surcharge is late, the entire payment is late and cannot be remedied by the payment of a 'surcharge on the surcharge' (07/09/2012, R 1774/2011-1, LAGUIOLE (fig.), § 12-15).

The surcharge will not be due if the person submits proof that the payment was initiated more than 10 days before expiry of the relevant time limit.

The Office may set a time limit for the person who made the payment after the expiry of the time limit to submit evidence that one of the above conditions was fulfilled.

For more information on the consequences of late payment in particular proceedings, see the relevant parts of the Guidelines. For example, the Guidelines, Part B, Examination, Section 2, Formalities, deals with the consequences of late payment of the application fee, while the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, deals with the consequences of late payment of the opposition fee.

4.1.2 Evidence of payment and of the date of payment

Article 180(4) EUTMR

Article 24 EUTMIR

Any means of evidence may be submitted, such as:

- a bank transfer order (e.g. SWIFT order) bearing stamps and the date of receipt from the bank involved;
- an online payment order sent via the internet or a printout of an electronic transfer, provided it contains information on the date of the transfer, on the bank it was sent to, and an indication such as 'transfer done'.

In addition, the following evidence may be submitted:

- acknowledgement of receipt of payment instructions by the bank;

- letters from the bank where the payment was effected, certifying the day on which the order was placed or the payment was made, and indicating the procedure for which it was made;
- statements from the party or its representative in writing, sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.

This additional evidence is only considered sufficient if supported by the initial evidence.

This list is not exhaustive.

If the evidence is not clear, the Office will send a request for further evidence.

If no evidence is submitted, the procedure for which the payment was made is deemed not to have been entered.

In the event of insufficient proof, or if the payer fails to comply with the Office's request for the missing information, the latter will consider that the time limit for payment has not been observed.

The Office may likewise, within the same time limit, request the person to pay the surcharge. In the event of non-payment of the surcharge, the deadline for payment will be considered not to have been observed.

The fee or charges or the part thereof that have been paid will be reimbursed since the payment is invalid.

The documents may be filed in any official language of the EU. Where the language of the documents is not the language of the proceedings, the Office may require that a translation be supplied in any Office language.

4.2 Payment by debit or credit card

Articles 15 and 16 of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

Payment by credit or debit card is deemed to have been made on the date on which the related filing or request is successfully completed via the User Area and if the money actually reaches the Office's account as a consequence of the credit or debit card transaction, and is not withdrawn at a later date. If, when the Office attempts to debit the credit or debit card, the transaction fails for any reason, payment is considered not to have been made. This applies in all cases where the transaction fails.

4.3 Payment by current account

Article 7 of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

If the payment is made through a current account held with the Office, Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges provides that the date on which the payment is deemed to be made is fixed in order to be convenient for the party to the proceedings. For example, for the application fee for an EUTM or an REUD, the fees will be debited from the current account on the day of receipt of the application. However, the account holder may instruct the Office to debit its account on the last day of the one-month time limit provided for payment. Likewise, upon renewal, the fees for renewal (including the class fees) are debited on the day of receipt of the request, unless the account holder requests otherwise.

If a party withdraws its action on the same day it was submitted, or before the end of the time limit to make the payment, the fee (where applicable) will not be debited from the current account. See paragraphs 5.1 and 5.6 below on the specific conditions for refund of application and renewal fees where payment is made by current account, and Guidelines, Part A, Section 1, Means of Communication, paragraph 3.1.6, Withdrawal of submissions).

5 Refund of fees

Article 108, Article 179(3) and Article 181 EUTMR

Article -106ab(4) and Article -106ad(1) EUDR

The refund of fees is explicitly provided for in the Regulations. Refunds are given by means of bank transfer or through current accounts with the Office, even when the fees were paid by debit or credit card.

As a general rule, if a declaration that is subject to the payment of a fee has been withdrawn before or on the day the payment is deemed to have been made, the fee will be refunded.

Where a fee is to be refunded, the refund will be made to the party directly or to the representative on file (if one is appointed) at the time the refund is made. Refunds will not be made to the original payee where this person is no longer on file.

5.1 Refund of application fees

Article 32 and Article 49(1) EUTMR

Article 38, Article 48 and Article 50d EUDR

Article 12(1) EUDIR

In the event of the withdrawal of an application, fees are not refunded except if a declaration of withdrawal reaches the Office:

- (in the case of payment by **bank transfer)** before or at the latest on the same day as the amount actually entered the bank account of the Office;
- (in the case of payment by debit or **credit card)** on the same day as the application containing the debit or credit card instructions/details;
- (in the case of payment by **current account**, and where the holder explicitly requested the application fee to be debited on the last day of the 1-month time limit provided for payment or, where later written instruction has been given to immediately debit the current account within that month) before or at the latest on the same day on which the payment is due to be debited.

In all the above scenarios, a filing date will not be assigned to the application.

Where the basic application fee has to be refunded, any additional class fees paid will be refunded as well.

The Office will only refund additional class fees on their own where they have been paid in excess of the classes indicated by the applicant in the EUTM application and where such payment was not requested by the Office or where, upon examination of the classification, the Office concludes that additional classes have been included that were not required in order to cover the goods and services contained within the original application.

5.2 Refund of the opposition fee

Articles 5(1), 6(5) and 7(1) EUTMDR

If an opposition is deemed not entered (because it was filed after the 3-month time limit), or if the opposition fee was not paid in full or was paid after the expiry of the opposition period, or if the Office refuses protection of the mark *ex officio* pursuant to Article 45(3) EUTMR, the Office must refund the fee (see Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 6.4, Fee refund).

5.3 Refund of the fee for an application for revocation or for a declaration of invalidity

Article 15(1) EUTMDR

If an application for revocation or for declaration of invalidity is deemed not to have been entered because the fee was not paid within the period specified by the Office, the Office must refund the fee, including the surcharge (see Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings, paragraph 2.3, Payment and Examination of design invalidity application guidelines, paragraph 3.13 Payment of fees).

5.4 Refund of fees for international marks

Decision No ADM-11-98 of the President of the Office related to the regularisation of certain reimbursements of fees

For information on the different scenarios where a refund may be applicable in processes relating to international applications and registrations where the EUIPO is the office of origin and/or designated office, see the Guidelines, Part M, International Marks.

5.5 Refund of appeal fees

Article 33 EUTMDR Article 35(3) and Article 37 EUDIR

Provisions regarding the refund of appeal fees are dealt with under Article 33 EUTMDR and Article 35(3) and Article 37 EUDIR.

5.6 Refund of renewal fees

Article 53(8) EUTMR Article 50d EUDR

Fees that are paid **before** the start of the first 6-month time limit for renewal will not be taken into consideration and will be refunded.

Where the fees have been paid, but the registration is not renewed (i.e. where the fee has been paid only after the expiry of the additional time limit, or where the fee paid amounts to less than the basic fee and the fee for late payment/late submission of the request for renewal, or where certain other deficiencies have not been remedied), the fees will be refunded.

Where the owner has filed a request for renewal of an EUTM and subsequently either totally or partially (in relation to some classes) withdraws the renewal request, the renewal fee will only be refunded:

- if, in the case of payment by **bank transfer**, the Office received the withdrawal before or at the latest on the same day as the amount actually entered the bank account of the Office;
- if, in the case of payment by **debit** or **credit card**, the Office received the withdrawal before or on the same day as receiving the debit or credit card payment;
- if, in the case of payment by **current account**, and where the holder explicitly requested the fee to be debited on the last day of the 6-month time limit provided for payment, and the Office received the withdrawal within the 6-month time limit for renewal or, where later written instruction was given to debit the current account immediately, before or at the latest on the same day that the payment is due to be debited.

For further information, see the Guidelines, Part E, Register Operations, Section 4, Renewal.

5.7 Refund of insignificant amounts

Article 181 EUTMR

Article -106ad(4) EUDR

Article 18 of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges

A fee will not be considered settled until it has been paid in full. If this is not the case, the amount already paid will be reimbursed after the expiry of the time limit allowed for payment, since in this case the fee no longer has any purpose.

However, insofar as it is possible, the Office may invite the person to complete payment within the time limit.

For EUTMs, where an excess sum is paid to cover a fee or a charge, the excess will not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. Insignificant amounts are fixed at EUR 15 by Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025 on methods of payment of fees and charges and determining the insignificant amount of fees and charges.

6 Fee reduction for an EUTM application filed by electronic means

Annex I A(2) EUTMR

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

According to Annex I A(2) EUTMR, the basic fee for an application for an individual mark may benefit from a reduction if the application has been filed by electronic means. The applicable rules and procedure for such an electronic filing may be found in Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means in conjunction with the Conditions of Use of the User Area as established in this decision.

In order to be considered an application for an EUTM filed by electronic means in the sense of Annex I A(2) EUTMR, the applicant has to insert all the goods and/or services to be covered by the application directly into the Office tool. Consequently, the applicant must not include the goods and/or services in an annexed document or submit them by any other means of communication. If the goods and/or services are annexed in a document or submitted to the Office by any other means of communication, the application will not be considered as having been filed by electronic means and may not benefit from the corresponding fee reduction.

7 Decisions on Costs

Article 109 EUTMR

Article 1(k), Articles 18 and 27 EUTMIR

Article 70 EUDR

Article 79 EUDIR

7.1 Fixing of costs

The decision fixing the amount of costs includes the lump sum provided in Article 27 EUTMIR and Article 79 EUDIR for professional representation and fees (see above) incurred by the winning party, independently of whether they have actually been incurred. The fixing of the costs may be reviewed in specific proceedings pursuant to Article 109(7) EUTMR and Article 70(6) EUDR.

7.2 Enforcement of the decision on costs

Article 110 EUTMR

Article 71 EUDR

Any final decision of the Office fixing the amount of costs will be enforceable pursuant to Article 110 EUTMR and Article 71 EUDR.

The Office is not competent for enforcement procedures. These must be carried out by the competent national authorities.

7.2.1 Conditions

The winning party may enforce the decision on costs, provided that:

- the decision contains a decision fixing the costs in their favour;
- the decision has become final;
- the decision bears the order of the competent national authority.

7.2.2 National authority

Each Member State must designate a single national authority for the purpose of verifying the authenticity of the decision and for appending the order for the enforcement of Office decisions fixing costs. The Member State must communicate its contact details to the Office, to the Court of Justice and to the Commission (Article 110(2) EUTMR and Article 71(2) EUDR).

Communication No 1/23 of the Executive Director of the Office of 9 June 2023 concerning the competent authorities under Article 110(2) EUTMR and Article 71(2) EUDR lists all the national authorities and their contact details, as provided by the Member States.

7.2.3 Proceedings

1. The interested party must request the competent national authority to append the enforcement order to the decision. For the time being, the conditions on languages of the requests, translations of the relevant parts of the decision, fees and the need for a representative depend on the practice of the individual Member States and are not harmonised but are considered on a case-by-case basis.
   The competent authority will append the order to the decision without any other formality beyond the verification of the authenticity of the decision. As to wrong decisions on costs or fixing of costs, see paragraph 7.3 below.
2. If the formalities have been completed, the party concerned may proceed to enforcement. Enforcement is governed by the rules of civil procedure in force in the territory where it is carried out (Article 110(2) EUTMR and Article 71(2)

EUDR). The enforcement may be suspended only by a decision of the Court of Justice of the European Union. However, the courts of the country concerned have jurisdiction over complaints that enforcement is being carried out in an irregular manner (Article 110(4) EUTMR and Article 71(4) EUDR).

7.3 Apportionment of costs

In *inter partes* proceedings, the Opposition Division, the Cancellation Division, the Invalidity Division and the Boards of Appeal take, where necessary, a decision on the apportionment of costs. Those costs include in particular the costs of the professional representatives, if any, and the corresponding fees. For further information relating to the apportionment of costs in opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 6.5, Decision on the apportionment of costs. Regarding cancellation proceedings, see the Guidelines, Part D, Cancellation, Section 1, Cancellation proceedings, paragraph 4.3.4, Decision on the apportionment of costs. Regarding design invalidity proceedings, see the Guidelines, Examination of design invalidity applications, paragraph 6.2 Decision on costs. Where the decision contains obvious mistakes as regards the costs, the parties may ask for a corrigendum (Article 102(1) EUTMR) or a revocation (Article 103 EUTMR), depending on the circumstances (see the Guidelines, Part A, General Rules, Section 6, Revocation of decisions, Cancellation of entries in the Register and correction of errors).

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 4

Language of proceedings

1 Introduction

Article 146 EUTMR

Articles 25 and 26 EUTMIR

Article 24 EUTMIR

Article 98 EUDR

Articles 80, 81 and 83 EUDIR

There are five Office languages: English, French, German, Italian and Spanish. However, an application for a European Union trade mark (EUTM) or registered European Union design (REUD) may be filed in any of the official EU languages. The EUTMR and the EUDR lay down rules for determining and using the language of proceedings. These rules may vary from one set of proceedings to another, in particular depending on whether the proceedings are *ex parte* or *inter partes*.

This section deals only with the horizontal provisions common to all types of proceedings. The exceptions for particular types of proceedings are dealt with in the corresponding sections of the Guidelines.

Pursuant to Article 146(6) EUTMR and Article 80(c) EUDIR, when a request is filed using a form provided by the Office pursuant to Article 65 EUTMDR and Article 68 EUDIR, the form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

2 From Filing to Registration (Excluding Opposition)

Article 146 EUTMR

Article 98 EUDR

EUTM and REUD applications may be filed in any of the official EU languages (first language). The language of the proceedings will be the language used for filing the application.

A second language must be indicated from among the five languages of the Office.

The second language serves as a potential language for opposition, cancellation and design invalidity proceedings. The second language must be different from the language selected as the first language. The choice of first and second language cannot be changed once the application has been filed.

If the language that the applicant has selected as the first language is one of the five languages of the Office, then this will be used by the Office as the correspondence language.

This language regime applies throughout the application and examination procedure until registration, except for oppositions and ancillary requests (see following paragraphs).

For more information on the linguistic regime and translations for EUTM examination, including the possibility of changing the correspondence language, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 6.

3 Opposition and Cancellation

Article 146(5), (7) and (8) EUTMR Article 3 EUTMDR

An opposition or request for cancellation (application for revocation or declaration of invalidity) may be filed:

- at the discretion of the opponent/applicant for cancellation in the first or second language of the EUTM application if the first language is one of the five languages of the Office;
- in the second language if the first language is not an Office language.

This language becomes the language of proceedings for the opposition or cancellation proceedings unless the parties agree to a different one (from among the official EU languages).

An opposition or request for cancellation may also be filed in any of the other Office languages, provided that within 1 month of expiry of the opposition period or within 1 month of filing the application for cancellation, the opponent/applicant for cancellation files a translation into a language that is available as a language of proceedings.

For more information on the linguistic regime and translations for supporting documents in opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraphs 2.3 and 4.3, and for cancellation proceedings see the Guidelines, Part D, Cancellation, Section 1, Proceedings, paragraphs 2.4 and 3.3.

4 Design invalidity

Article 98(4) and (5) EUDR Article 29 and Article 30(1) EUDIR

An application for a declaration of invalidity may be filed:

- in the first language of the REUD if the first language is one of the five languages of the Office;
- in the second language if the first language is not an Office language.

This language becomes the language of proceedings for the invalidity proceedings.

The parties to the invalidity proceedings may agree on a different language of proceedings provided it is an official language of the European Union. Information about the agreement must reach the Office within 2 months of the official communication sent after the completion of the admissibility examination pursuant to Article 31(1) EUDIR.

Where the application for a declaration of invalidity was not filed in that language, the applicant must, on its own motion, file a translation of the application in that language within 1 month of the date when the Office was informed of the agreement. If these legal requirements are not met, the language of proceedings will remain unchanged.

Where the application is not filed in the language of proceedings, the Invalidity Division will notify the applicant to file a translation within 2 months of the date of receipt of the notification. Where the applicant does not comply with the request, the application will be rejected as inadmissible.

For the linguistic regime applicable to the supporting documents filed in invalidity proceedings, see the Guidelines on Examination of Design Invalidity Applications, paragraph 3.10.2.

5 Other Requests

5.1 Before registration (excluding opposition)

Article 146(6) EUTMR Article 65 EUTMDR Article 24 EUTMIR Article 68, Article 80(a) and (c), and Article 81 EUDIR

Unless otherwise provided, during the period from filing to registration, any request, application or declaration that is not concerned with the examination of the application as such but that starts an ancillary procedure (e.g. restriction of the list of goods or services, registration of a transfer or licence, request for conversion, declaration of division for an EUTM or REUD) may be filed in the first or second language of the respective EUTM or REUD application, at the discretion of the applicant or third party. That language then becomes the language of proceedings for those ancillary proceedings. This applies irrespective of whether or not the first language is an Office language.

For example, where the first language of the EUTM application is Bulgarian, and the second language is German, a request for transfer of ownership of the EUTM application can be filed in either Bulgarian or German.

Supporting evidence (if needed) may be in any of the official EU languages. However, if it is not in the language of the proceedings, the Office may require a translation into the language of the proceedings or into a language of the Office (REUD proceedings only).

For more information on the linguistic regime and translations concerning Register operations please see the respective sections in the Guidelines in Part E, Register Operations.

5.2 After registration (excluding cancellation and design invalidity)

Article 146(6) EUTMR

Article 65 EUTMDR

Article 24 EUTMIR

Article 68 and Article 80(b) and (c), and Article 81 EUDIR

Any request, application or declaration filed after the EUTM or REUD has been registered must be submitted in one of the five Office languages.

Furthermore, post-registration requests concerning the same registered EUTM or REUD do not necessarily have to be submitted in the same language. For example, after an EUTM has been registered, the EUTM proprietor may file a request for the registration of a licence in English and, a few weeks later, file a request for renewal in Italian and/or a transfer of ownership request in French. The only requirement is that the requests are submitted in one of the five Office languages.

Supporting evidence (if needed) may be in any of the official EU languages. However, if it is not in the language of the proceedings, the Office may require a translation into the language of the proceedings or into a language of the Office (REUD proceedings only).

For more information on the linguistic regime and translations concerning Register operations, please see the respective sections in the Guidelines in Part E, Register Operations.

6 Invariable Nature of the Language Rules

The Regulations allow certain choices to be made from among the available languages in the course of the proceedings (see above) and, during specified periods, a different language to be chosen as the language of proceedings for opposition, cancellation and design invalidity. However, with those exceptions, the language rules are invariable. In

particular, the first and second languages may not be amended in the course of the proceedings.

7 Translations and their Certification

Article 146(10) EUTMR Articles 24 to 26 EUTMIR Article 83 EUDIR

The general rule is that where a translation of a document is required, it must reach the Office within the time limit set for filing the original document. This applies unless an exception to this rule is expressly provided in the Regulations.

The translation must identify the document to which it refers and reproduce the structure and contents of the original document. The party may indicate that only parts of the document are relevant and limit the translation to those parts. However, the party does not have discretion to consider irrelevant any parts that are required by the Regulations (for example, when proving the existence of an earlier trade mark registration in opposition proceedings).

In the absence of evidence or indications to the contrary, the Office will assume that a translation corresponds to the relevant original text. In the event of doubt, the Office may require the filing, within a specific period, of a certificate that the translation corresponds to the original text. If the required certificate is not submitted, the document for which the translation had to be filed will be deemed not to have been received by the Office.

8 Non-compliance with the Language Regime

If the language regime is not complied with, the Office will issue a deficiency letter, unless otherwise provided in the Regulations. Should the deficiency not be remedied, the application or the request will be refused.

For more information on language regimes for particular types of proceedings the corresponding sections of the Guidelines should be consulted.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 5

Parties to the Proceedings and Professional representation

1 Introduction - Parties to the Proceedings and Principle of Representation

Articles 3, 5, 119 and 120 EUTMR
Article 7(b) EUTMIR
Articles 14, 52, 77 and 78 EUDR
Article 62 EUDIR

Any natural or legal person, including authorities established under public law, may be the proprietors of a European Union trade mark (EUTM) and, in general, may be parties to proceedings before the Office. The only exceptions are certain limitations on the ownership of collective and certification marks (see the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapters 15 and 16, on collective and certification marks respectively).

In principle, the right to a registered European Union design (REUD) will vest in the designer or their successor in title. However, a legal person may also hold a registered European Union design and be party to the proceedings before the Office.

Companies or firms and other legal bodies will be regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts, and to sue and be sued.

Persons having their domicile or their principal place of business or a real and effective industrial or commercial establishment within the European Economic Area (EEA), which consists of the European Union (EU) and Iceland, Liechtenstein and Norway, are not required to be represented in any proceedings before the Office in either trade mark or design matters (see paragraph 5.1.1).

Natural persons not domiciled in or legal persons that do not have their principal place of business or a real and effective industrial or commercial establishment in the EEA must be represented by a representative based within the EEA, unless appointment of a representative is not mandatory (see paragraph 5.1 for any exceptions to the general rule). See paragraph 5.2.1 on the consequences of not appointing a representative, when representation is mandatory, once the EUTM or REUD application has been filed.

Representatives in the sense of Articles 119 and 120 EUTMR and Article 77 and 78 EUDR must have a place of business or employment in the EEA.

In principle, representatives do not need to file an authorisation to act before the Office unless the Office expressly requires it, or where, in *inter partes* proceedings, the other party expressly requests it.

Where a representative has been appointed, the Office will communicate solely with that representative.

The first part of this section (paragraphs 2 and 3) deals with the identification of all parties to proceedings before the Office.

The second part of this section (paragraph 4) sets out the different types of representatives.

The third part of this section (paragraphs 5 to 9) deals with the appointment of representatives or the failure to do so, and the authorisation of representatives.

The final part of this section (paragraphs 10 and 11) deals with changes and corrections in names and addresses of parties in pre-registration stages. For further information on changes to registrations, see the Guidelines, Part E, Register operations, Section 1, Changes in a registration and the Design Guidelines, Examination of applications for registered European Union designs, paragraph 11.

2 Parties to proceedings before the Office

Article 112(1) EUTMR

Decision No EX-25-05 of the Executive Director of the Office of 07/04/2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database

This section of the Guidelines deals with the general provisions on parties to the proceedings. For information on the parties' entitlements in the different procedures before the Office, please see the rules in the relevant sections of these Guidelines. For example, for further information on:

- persons entitled to own EUTM Collective marks and EUTM certification marks, see the Guidelines, Part B, Section 4, Absolute Grounds for Refusal, Chapter 15 Collective Marks, Paragraph 2; and the Guidelines, Part B, Chapter 16 Certification marks, Paragraph 4;
- specific aspects of persons entitled to file an opposition, see the Guidelines, Part C, Section 1, Opposition Proceedings, Paragraph 2.4.2.6;
- specific aspects of persons entitled to file an application for cancellation, see the Guidelines, Part D, Section 1 Proceedings, Paragraph 2.1;
- specific aspects of persons entitled to file an application for international application based on an EUTM (EUIPO as Office of origin), see the Guidelines, Part M, International Marks, Paragraph 2.1.3.1;
- specific aspects of persons entitled to file an application for the declaration of invalidity of a REUD, see the Guidelines, Examination of Design Invalidity Applications, Paragraph 3.5;

All persons that identify themselves as parties to proceedings before the Office are entered into the Office's database and are allocated an identification (ID) number. The ID number can be viewed in the Office's eSearch plus tool available on the Office's website.

The Office encourages parties to always use their ID number to import existing details instead of manually inserting the address and/or any other contact details on any form

or in any communication to the Office as this leads to less errors. However, the ID number cannot replace the party's name where it needs to appear on any form or communication.

3 Identification of parties to the proceedings

Article 3 EUTMR

Article 2(1)(b) EUTMIR

Article 1(1)(b) EUDIR

Decision No EX-25-05 of the Executive Director of the Office of 07/04/2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database

EUTM and REUD applicants are identified pursuant to the criteria laid down in Article 2(1)(b) EUTMIR and Article 1(1)(b) EUDIR respectively. This criteria applies, *mutatis mutandis*, to all parties to proceedings before the Office (e.g. opponents, applicants for revocation or for a declaration of invalidity, applicants for registration of a transfer).

The information required to identify a party is:

- name;
- address;
- the country of domicile if a natural person, or the country in which it is domiciled or has its seat or an establishment if a legal entity.

In an application for an REUD, natural persons must also indicate their nationality.

If the party to the proceedings has previously been allocated an ID number by the Office, it is sufficient to indicate the ID number and the party's name.

Where there are multiple parties to the proceedings, the same identification requirements are required for each one of them.

Where the name and legal address of a party, or their professional representative, are recorded in the EUTM or EUD Registers, they will be kept indefinitely (pursuant to Article 111(9) EUTMR and Article 72a(5) EUDR). For REUDs, the information entered in the Register about the applicant's legal address will contain only the city and country (Article 72(2)(d) EUDR).

For information on what data appears in the EUTM and EUD Registers, please see Annex I and II of Decision No EX-25-05.

3.1 Name

3.1.1 Natural persons

Names of **natural persons** must include the person's first name(s) and surname(s) as they appear in official personal identification documents (example: John Steven Smith instead of J.S.Smith).

Where the name provided appears to be that of a physical person but the party has indicated that they are a 'legal entity' and filled in the legal form section with an indication which is not a legal form as such (such as free professional, freelance, sole proprietorship, etc.), the Office will send a notification of a deficiency. If the applicant fails to reply, the Office will change the type of person from 'legal entity' to 'natural person'.

For example, 'John Smith', identified as being a legal entity with the legal form 'freelance', will be changed to a natural person and the legal form deleted.

A natural person may provide any business or trading name as an optional indication in addition to their legal name. For example, natural person 'John Smith trading as Smithy's' is acceptable. See paragraph 3.1.2 for more information on the use of business or trading names.

3.1.2 Legal entities

Names of **legal entities** must be indicated by their official designation (full statutory name) and include the legal form of the entity (if applicable), which may be abbreviated in a customary manner (for example, S.L., S.A., Ltd, PLC). The company's national identification number may also be specified.

Legal entities may provide their business or trading names as an optional indication **in addition to** their official designation (typically indicated by using the legal name followed by 'trading as' or 'acting as' in the title). However, business or trading names must not be used alone, that is to say **instead of** the name of the legal entity. As a general rule, the Office will assume that applicants identified through mere business or trading names without any legal form are not entitled to own property in their own name unless evidence is submitted to the contrary.

For example, 'J. Smith Ltd trading as Smithy's' would be acceptable where 'J. Smith' is the legal name, 'Ltd' is the legal form, and 'Smithy's' is the trading name. Using the same example, 'Smithy's' by itself (with no legal form), will be objected to. See also the example under paragraph 3.1.1.

The name of a legal entity in the process of being founded will be accepted.

The Office strongly recommends indicating the state of incorporation for companies based in the United States of America, where applicable, in order to differentiate clearly between different owners in its database.

If the legal form is not specified or is incorrectly indicated, a deficiency letter requesting this information will be issued. If the deficiency is not remedied the respective request

will be rejected as the party cannot be correctly identified pursuant to Article 2(1)(b) EUTMIR and Article 1(1)(b) EUDIR.

3.2 Address

The Office recognises two types of address referred to in Article 2(1)(b) EUTMIR and Article 1(1)(b) EUDIR: the official 'legal' address of a party and the 'address for service'.

Only one legal address should be indicated for each applicant. Where several addresses are indicated, the Office will only take into account the address that is mentioned first, except where the applicant designates one of the addresses as an address for service.

3.2.1 Legal address

This is the address where the party has its domicile, principal place of business or real and effective industrial or commercial establishment. It is a compulsory requirement for identification. Furthermore the legal address is necessary for the Office to establish if the party needs to be represented or not pursuant to Article 119(2) EUTMR and Article 77(2) EUDR.

For legal persons, the legal address is understood to be where the party has its seat, which is the company's registered headquarters or registered head office as appearing on the extract of the company register.

The address must contain all the identification elements required. This normally consists of the street name, street number, city/town, state/county/province and country, since without such details it is not possible to clearly identify the party.

If any of these particulars is missing, the Office will issue a deficiency and set a time limit by which to remedy the deficiency or to provide a valid reason for omitting it.

A post office box or a forwarding (virtual) address on its own does not constitute a legal address unless it can be proven that it is indeed registered as the company's address (e.g. by submitting an extract of the company register).

3.2.2 Address for service

An address for service (also referred to as a correspondence address) is an optional second address a party can provide. The Office will send any post to that address.

By default any correspondence by post will be addressed to the party's legal address unless a different address for service is provided.

3.3 Other contact details

It is not compulsory to provide additional contact details, such as telephone numbers or email addresses. However, providing an email address is recommended to facilitate setting up a user account.

4 Representatives: Who May Represent

Article 119(3) and Article 120(1)(a) and (b) EUTMR
Article 74(8) EUTMDR
Article 77(3), Article 78(1)(a) and (b) and Article 78(8) EUDR
Article 62(9) EUDIR

In all Member States of the EEA, representation in legal proceedings is a regulated profession and may only be exercised under particular conditions. In proceedings before the Office, the following categories of representative are distinguished.

Legal practitioners (Article 120(1)(a) EUTMR and Article 78(1)(a) EUDR) are professionals who, depending on the national law, are fully entitled to represent third parties before national offices (see paragraph 4.2 below).

Other professionals (Article 120(1)(b) EUTMR and Article 78(1)(b) EUDR) need to comply with further conditions and need to be included on a specific list maintained by the Office for this purpose (the Office's list of professional representatives). Amongst these, two further groups need to be distinguished: those who may represent only in REUD proceedings ('designs list') and those who may represent in both EUTM and REUD proceedings (see paragraph 4.3 below). The Office refers to these other professionals collectively as '**professional representatives**'.

Several legal practitioners and professional representatives may be organised in entities called '**associations of representatives**' (Article 74(8) EUTMDR; Article 62(9) EUDIR) (see paragraph 5.4.3 below).

The final category of representatives is made up of **employees** acting as representatives for the party to proceedings before the Office (Article 119(3) EUTMR, first alternative; Article 77(3) EUDR, first alternative) or employees of **economically linked** legal persons (Article 119(3) EUTMR, second alternative; Article 77(3) EUDR, second alternative) (see paragraph 4.4 below).

Employees are to be distinguished from **legal representatives** under national law (see paragraph 4.5 below).

4.1 ID numbers and the database

Article 78(8) EUDR

All persons that identify themselves as representatives for, or employees of, individual parties to proceedings before the Office, and that fulfil the requirements provided by the regulations, are entered into the database and obtain an ID number (Article 78(8) EUDR). The database has a double function, providing all the relevant contact details under a specific ID number for any type of representative, as well as being the public information on the Office's list of professional representatives or designs list ([9]).

A representative may have several IDs.

- Associations of representatives may have different IDs for different legal addresses.
- Individual representatives may have one ID as an employee representative and a different ID as a legal practitioner in their own right.
- If a person confirms that they work for two different associations of representatives or from two different addresses, they can have two different numbers attributed. Only the first ID number will be published in the Official Journal.
- It is also possible to have two different IDs, one as a legal practitioner and one as an Office professional representative where such a dual qualification is allowed under national law (which is not the case, for example, in France, see Annex I). The Office almost invariably refuses requests from legal practitioners to be entered on its list of professional representatives as they are automatically entitled to appear in the database as 'legal practitioners' in their own right and do not need to be admitted onto the Office's list of professional representatives.

Where an ID is requested for any type of representative, the Office may require the person to prove the real and effective nature of their establishment at the address(es) identified (Article 78(8) EUDR). Any evidence submitted should not be limited to the mere existence of premises at these addresses but should prove real and effective business or employment being carried out and invoiced from the different locations.

An ID will not be granted for a post office box or a simple address for service in the EEA. See paragraph 3.2 for the difference between the 'legal address' and the 'address for service'.

In the database, representatives are identified as: association, employee, lawyer (legal practitioner), and professional representative. Internally, the latter category is divided into two subcategories: type 1 consists of persons exclusively entitled to represent in REUD matters under Article 78(1)(c) EUDR, and type 2 consists of persons entitled to represent in both trade mark and design matters under Article 120(1)(b) EUTMR and Article 78(1)(b) EUDR.

9 Regarding the processing of mandatory personal data in relation to the tasks of the Office, which includes contact details, see the EUIPO's explanatory note on the processing of personal data within the framework of the EUIPO's tasks as laid down in the EUTMR and EUDR (accessible in the 'Data Protection' section of the Office's website).

On any form and in any communication sent to the Office, the representative's address and contact details may, and preferably should, be replaced by the ID number attributed by the Office, together with the representative's name.

The ID number can be found by consulting any of the files of the representative in question, or in the advanced search options of the Office's eSearch plus tool available on the EUIPO website: https://euipo.europa.eu/eSearch/#advanced/representatives.

4.2 Representation by legal practitioners

Article 120(1)(a) EUTMR Article 78(1)(a) EUDR

A legal practitioner is a professional who is automatically and without any further formal recognition allowed to represent third parties before the Office provided that they meet the following three conditions:

1. they must be qualified in one of the Member States of the EEA;
2. they must have their place of business within the EEA; and
3. they must be entitled, within the Member State in which they are qualified, to act as a representative in trade mark and/or design matters.

4.2.1 The term `legal practitioner'

The professional titles for each EEA Member State are identified in the column 'Terminology for legal practitioner' in Annex 1 of this Section.

4.2.2 Qualification

The requirement to be qualified in one of the Member States of the EEA means that the person must be admitted to the bar or be admitted to practise under one of the professional titles identified in Annex 1 pursuant to the relevant national rules. The Office will not verify this unless there are doubts in this regard.

4.2.3 Nationality and place of business

There is no requirement as to nationality. Therefore, the legal practitioner may be a national of a state other than one of the Member States of the EEA.

The place of business must be in the EEA. A post office box address or an address for service does not constitute a place of business (see paragraph 3.2.1, above, regarding the legal address). The place of business need not necessarily be the only place of business of the representative. Furthermore, the place of business may be in a Member State of the EEA other than the one in which the legal practitioner is admitted to the bar. However, legal practitioners who have their sole place of business outside the EEA are not entitled to represent before the Office even when they are admitted to

practise in one of the Member States of the EEA. The Office may at any time require evidence that the address provided is, or continues to be, a real and effective place of business.

Where an association of representatives, such as a law firm or a law office, has several places of business, it may perform acts of representation only under a place of business within the EEA, and the Office will only communicate with the legal practitioner at an address within the EEA.

4.2.4 Entitlement to act in trade mark and/or design matters

The entitlement to act as a representative in trade mark and/or design matters in a state must include the entitlement to represent clients before the national industrial property office of that state. This condition applies to all Member States of the EEA.

Legal practitioners referred to in Article 120(1)(a) EUTMR and Article 78(1)(a) EUDR who fulfil the conditions laid down in this Article are automatically entitled as of right to represent their clients before the Office. This basically means that if a legal practitioner is entitled to act in trade mark and/or design matters before the central industrial property office of the Member State of the EEA in which they are qualified, they will also be able to act before the Office.

Legal practitioners are not entered on the list of professional representatives to which Article 120(2) EUTMR and Article 78(1)(b) and (c) EUDR refer, because the entitlement and the special professional qualifications referred to in those provisions relate to persons belonging to categories of professional representatives specialising in industrial property or trade mark matters, whereas legal practitioners are by definition entitled to be representatives in all legal matters.

If a ‘legal practitioner’ who has already been attributed an identification number as a legal practitioner requests entry on the list of ‘professional representatives’, the ID number will be maintained but the status will be changed from ‘legal practitioner’ to ‘professional representative’ following prior consultation with the applicant. Please refer to paragraph 4.1 above concerning the situations where multiple ID numbers may be allocated to one person.

Annex 1 gives a detailed explanation of the specific rules and terminology for most of the countries. The information contained in this Annex has been provided by the national industrial property office of each State, and any clarifications as regards its accuracy should therefore be addressed to the national industrial property office in question. The Office would appreciate being informed of any inconsistencies.

4.3 Professional representatives admitted and entered on the lists maintained by the Office

Article 120(1)(b) and Article 120(2) EUTMR

Article 78(1)(b) and (c) EUDR

The second group of persons entitled to represent third parties professionally before the Office are those persons whose names appear on one of the two lists of professional representatives maintained by the Office:

1. the Office's list of professional representatives according to Article 120(1)(b) EUTMR and Article 78(1)(b) EUDR (in trade mark and design matters);
2. the list of professional representatives according to Article 78(1)(c) EUDR (in design matters).

For this category of professional representatives, the entry on the Office's list of professional representatives entitles them to represent third parties before the Office. A representative who is entered on the Office's list of professional representatives, referred to in Article 120(1)(b) EUTMR, is automatically entitled to represent third parties in design matters according to Article 78(1)(b) EUDR and will not be entered on the special list of professional representatives in design matters ('designs list').

If a person on the list maintained under Article 120(1)(b) EUTMR requests entry on the designs list maintained for professional representatives authorised to act exclusively in European Union design matters under Article 78(1)(c) and (4) EUDR, the request will be rejected.

The designs list is intended only for professional representatives who are entitled to represent clients before the Office in design matters but not trade mark matters.

Annex 2 gives a detailed explanation of the specific rules and terminology for most of the countries. The information contained in this Annex has been provided by the national industrial property office of each State, and any clarifications as regards its accuracy should therefore be addressed to the national industrial property office in question. The Office would appreciate being informed of any inconsistencies.

Entry on the lists is subject to a request being completed and signed individually by the person concerned, using the form established for this purpose by the Office (which can be accessed online at: https://euipo.europa.eu/ohimportal/en/forms-and-filings).

In order to be entered on the list, three requirements must be fulfilled.

1. The representative must be a national of one of the Member States of the EEA.
2. They must have their place of business within the EEA.
3. They must be entitled under national law to represent third parties in trade mark or design matters before the national industrial property office. To that end they must provide a certificate attesting this from the national industrial property office of a Member State of the EEA.

4.3.1 Entitlement under national law

The conditions for entry on the Office's list of professional representatives and the designs list depend on the legal situation in the Member State of the EEA concerned.

Article 120(2)(c) EUTMR Article 78(1)(b) EUDR

In a large number of Member States of the EEA, entitlement to represent third parties before the national office in trade mark matters is conditional upon possession of a special professional qualification (Article 120(2)(c) EUTMR, first alternative; Article 78(4)(c) EUDR, first alternative). Therefore, in order to be entitled to act as a representative, the person must have the required qualification.

In other Member States of the EEA, there is no such requirement for a special qualification, that is to say, representation in trade mark matters is open to anybody. In this case, the person involved must have regularly represented third parties in trade mark or design matters before the national office concerned for at least 5 years (Article 120(2)(c) EUTMR, second alternative; Article 78(4)(c) EUDR, second alternative). A subcategory of this category of Member States of the EEA consists of those States that have a system officially recognising a professional qualification to represent third parties before the national office concerned even though such recognition is not a prerequisite for the exercise of professional representation. In this case, persons so recognised are not subject to the requirement of having regularly acted as a representative for at least 5 years.

Please refer to Annex 1 for the countries where special professional qualifications are required.

4.3.1.1 First alternative - special professional qualifications

Where, in the Member State of the EEA concerned, entitlement is conditional upon having special professional qualifications, persons applying to be entered on the list must have acquired this special professional qualification.

4.3.1.2 Second alternative - 5 years' experience

Where, in the Member State of the EEA concerned, the entitlement is not conditional upon possession of special professional qualifications, that is to say, representation in trade mark matters is open to anybody, persons applying to be entered on the list must have regularly acted as professional representatives in trade mark or design matters for at least 5 years before a central industrial property office of a Member State of the EEA.

It is possible for the Executive Director of the Office to grant an exemption from this requirement (see paragraph 4.3.4 below).

4.3.1.3 Third alternative - recognition by a Member State of the EEA

Where, in the EEA Member State concerned, the entitlement is not conditional upon possession of special professional qualifications, that is to say, representation in trade mark matters is open to anybody, persons whose professional qualification to represent natural or legal persons in trade mark and/or design matters before the central industrial property office of one of the Member States of the EEA is officially recognised in accordance with the regulations laid down by that State will not be subject to the condition of having exercised the profession for at least 5 years.

4.3.2 Nationality and place of business

Article 120(2) and (4) EUTMR Articles 78(4) and 78(6) EUDR

A professional representative requesting to be entered on the list must be a national of a Member State of the EEA.

It is possible for the Executive Director of the Office to grant an exemption from the nationality requirement (see paragraph 4.3.4 below).

A professional representative requesting to be entered on the list must have his or her place of business or employment in the EEA. A post office box address or an address for service does not constitute a place of business. The place of business or employment need not necessarily be the only place of business or employment of the representative. The Office may at any time require evidence that the address provided is, or continues to be, a real and effective place of business or employment.

4.3.3 Certificate

Article 120(3) EUTMR Article 78(5) EUDR

Fulfilment of the abovementioned conditions laid down in Article 120(2) EUTMR and Article 78(4) EUDR must be attested by a certificate provided by the national office concerned. Some national offices issue individual certificates while others provide the Office with block certificates.

Where block certificates are issued, the national offices send regularly updated lists of professional representatives entitled to represent clients before their office. In these cases the Office will check the indications in the request against the entries on the lists communicated to the Office.

Otherwise, the person concerned must accompany his or her request with an individual certificate. The applicant must complete the application form (which can be accessed online at https://euipo.europa.eu/ohimportal/en/forms-and-filings) and send it to the

respective industrial property office of the Member State concerned. The certificate must be completed by the respective industrial property office.

4.3.4 Exemptions

Article 120(4) EUTMR Article 78(6) EUDR

The Executive Director of the Office may grant exemption from the requirement to be a national of a European Economic Area (EEA) Member State, provided that the requestor demonstrates that they are a 'highly qualified professional'. The Executive Director may also grant an exemption from the requirement of having regularly acted as a representative in trade mark matters for at least 5 years, provided that the requestor demonstrates that they have acquired the required qualification in another way. This power is of a discretionary nature.

The broad discretionary power to grant exemptions from the 5 years' experience requirement or from the EEA nationality requirement pursuant to Article 120(4) EUTMR and Article 78(4) EUDR will be exercised by the Executive Director of the Office with due regard to the fact that the provision (i) does not confer any right to the person requesting the exemptions, (ii) is conceived as an exception to the general rule, which needs to be applied restrictively and on a strictly individual basis only, and (iii) can also be based on more general considerations such as the absence of any need for additional professional representatives.

1. Exemptions from the 5 years' experience requirement

   Exemptions from the requirement of 5 years' experience (Article 120(4)(a) EUTMR) are limited to cases where the qualification to act as a representative in trade mark or design matters was not achieved before the central industrial property office concerned, but was acquired in another way, for the equivalent period of at least 5 years.

   This exemption can only be requested where the requestor is entitled to act in EEA Member States in which no 'special professional qualification' is required.

   The experience equivalent to at least 5 years of habitually acting as a representative before the central industrial property office concerned, to be established by the requestor (with supporting evidence), must have been obtained in the EEA Member State concerned. For example, if an exemption is requested from the 5-year requirement to act before the central industrial property office of Member State 'A' (e.g. Malta), the evidence of habitually acting as a representative must emanate from that same Member State (Malta), and not from another EEA Member State (e.g. Ireland).

2. Exemptions from the EEA nationality requirement

Exemptions from the EEA nationality requirement are limited to requestors that comply with the requirements of Article 120(2)(b) and (c) EUTMR or Article 78(4)(b) and (c) EUDR, namely that they have their place of business in the EEA, and are entitled under national law to represent third parties before the national industrial property office.

An exemption from the EEA nationality requirement may only be granted where the requestor is a 'highly qualified professional' (Article 120(4)(b) EUTMR).

The term 'highly qualified professional' is not defined in the EUTMR or the EUTMIR, but the Court has described it as referring to a 'specialist with particularly advanced qualities, skills, abilities or knowledge' in trade mark matters (25/09/2024, T-727/20 RENV, Kirimova, EU:T:2024:646, § 30).

The status of 'highly qualified professional' is independent of the entitlement requirement under Article 120(2)(c) EUTMR and has no connection with the conditions necessary for fulfilling that requirement. Accordingly, the particularly advanced qualities, skills, abilities or knowledge do not need to be acquired in the exercise of the necessary entitlement to represent under Article 120(2)(c) EUTMR. Furthermore, they may be acquired within the EEA or in a third country, before or after obtaining the entitlement to represent (25/09/2024, T-727/20 RENV, Kirimova, EU:T:2024:646, § 34).

The onus is on the requestor to demonstrate (with supporting evidence) that they meet the 'highly qualified professional' requirement. A request for exemption, which is not subject to any time limit, may be filed using the form provided for this purpose available on the EUIPO website. All the arguments and evidence the requestor deems necessary to support the claims made must be submitted together with the request. The Office will decide on the basis of that request.

Decisions of the Executive Director rejecting the exemption requested can be appealed before the General Court of the European Union under Article 263(4) TFEU.

4.3.5 Procedure for entry on the list

Articles 66(1) and 120(3) EUTMR, Article 162 EUTMR Articles 55(1), 78(5) and 104 EUDR

Entry on the list is confirmed by notification of a positive decision, which contains the indication of the ID number attributed to the professional representative. Entries on the Office's list of professional representatives or designs list are published in the Official Journal of the Office.

If any of the requirements for entry on the list of professional representatives are not fulfilled, a deficiency will be notified. If the deficiency is not remedied, the request for

entry on the list will be rejected. The party concerned may file an appeal against this decision (Article 66(1) and Article 162 EUTMR; Article 55(1) and Article 104 EUDR).

Professional representatives may obtain an additional copy of the decision free of charge.

The files relating to requests for entry on the Office's list of professional representatives or designs list are not open to public inspection. Where a request for entry on the list of professional representatives is accompanied by a request for exemption because one of the necessary conditions for entry on the list is missing (see paragraph 4.3.4 above), where the granting of that exemption has been refused by a final decision of the Executive Director, there will be no subsequent decision refusing entry on the list of representatives. This formal subsequent decision will only be issued where the requester explicitly requests it.

4.3.6 Amendment of the list of professional representatives

4.3.6.1 Deletion

First alternative — upon own request

Article 120(5) EUTMR Article 78(7) EUDR Article 64(1) and (6) EUDIR

The entry of a professional representative on the Office's list of professional representatives or designs list will be deleted at the request of that representative.

The deletion will be entered in the files kept by the Office. The notification of deletion will be sent to the representative and the deletion will be published in the Official Journal of the Office.

Second alternative — automatic deletion from the list of professional representatives

Article 75(1) EUTMDR Article 64(2) and (5) EUDIR

The entry of a professional representative in the Office's list of professional representatives or designs list will be deleted automatically:

1. in the event of the death or legal incapacity of the professional representative;
2. where the professional representative is no longer a national of a Member State of the EEA;
3. where the professional representative no longer has a place of business or employment in the EEA; or
4. where the professional representative is no longer entitled to represent third parties before the central industrial property office of a Member State of the EEA.

Where a professional representative changes from a design attorney to a trade mark attorney, he or she will be removed from the designs list and entered on the Office's list of professional representatives.

The Office may be informed of the above events in a number of ways. In case of doubt, the Office will, prior to deletion from the list, seek clarification from the national office concerned. It will also hear the professional representative, in particular where it is possible that he or she may be entitled to remain on the list on another legal or factual basis.

The deletion will be entered in the files kept by the Office. The decision of the deletion will be notified to the representative and the deletion will be published in the Official Journal of the Office.

4.3.6.2 Suspension of the entry on the list

Article 75(2) EUTMDR

Article 64(3) EUDIR

Upon notification by the relevant national industrial property office of a decision on the suspension of the entitlement to represent natural or legal persons before the respective national industrial property office, the entry of the professional representative on the Office's list of professional representatives or designs list will be suspended. The representative will be informed accordingly.

4.3.7 Reinstatement in the list of professional representatives

Article 75(3) EUTMDR

Article 64(4) EUDIR

A person whose entry has been deleted or suspended will, upon request, be reinstated in the list of professional representatives if the conditions for deletion or suspension no longer exist.

A new request must be submitted in accordance with the normal procedure for obtaining an entry on the list of professional representatives (see paragraph 4.2 above).

4.4 Representation by an employee

Article 119(3) EUTMR

Articles 1(j) and 74(1), Article 65(1)(i) EUTMDR

Article 77(3) EUDR

Article 68(1)(i) EUDIR

4.4.1 General considerations

A party to the proceedings before the Office, whether a natural or a legal person, having their domicile or principal place of business, or a real and effective industrial or commercial establishment in the European Economic Area (EEA), may be represented before the Office by an employee (Article 119(3) EUTMR, first sentence and Article 77(3) EUDR, first sentence).

Employees of the legal persons described above may also represent other legal persons that have economic connections with the first legal person, even if those other legal persons do not have their legal address within the EEA (Article 119(3) EUTMR, second sentence and Article 77(3) EUDR, second sentence).

The acceptability of an employee representative therefore depends on whether the represented party is a natural or a legal person, whether the represented party has its legal address within or outside the EEA, and whether the employee is employed directly or indirectly by the represented party, as explained below.

For the definition of legal address, as identified in the represented person's ID number, see paragraph 3.2.1.

The following situations can therefore be differentiated.

- Natural persons whose legal address is within the EEA may be represented by an employee employed by them. The employee may or may not work from the represented natural person's legal address, but the employee must be employed by this natural person. For example, the employee may work from a place of business that is different from the legal address of the natural person.
- Natural persons whose legal address is outside the EEA cannot be represented by an employee.
- Legal persons whose legal address is within the EEA may be represented by an employee directly employed by them. This means the employee may work directly for them at this legal address. They may, however, also be employed by them indirectly. This 'indirect' employee can either work for the represented legal person through another place of business or another real and effective establishment owned by them under a different address within the EEA; or be employed by another legal person within the EEA that is economically linked to the first legal person.
- Legal persons whose legal address is outside the EEA may only be represented by an 'indirect' employee, through an employee working for the represented legal person through another place of business or real and effective establishment owned by them under a different address within the EEA, or be employed by another legal person within the EEA that is economically linked to the first legal person. Regarding the requirements of indirect employee representation see paragraph 4.4.2.

For all these situations the employee representative must be a natural person and be located in the EEA. An employee located outside the EEA may not represent their employer before the Office.

On the forms made available by the Office, the employee signing the application or request must fill in the field reserved for representatives by indicating their name, address (of employment) and select the checkboxes relating to employee representative.

The name(s) of the employee(s) will be entered in the database and published under 'representatives' in the EUTM and EUD Bulletins and in the Office's database accessible through the eSearch plus tool. However, they will not be entered in the respective EUTM and EUD Registers.

Where employees act for their employer, this is not a case of professional representation under Article 120(1) EUTMR or Article 78(1) EUDR. As such, Article 109(1) EUTMR and Article 79(7)(c), (d) and (f) EUDIR are not applicable for the apportionment and fixing of costs in *inter partes* proceedings (17/07/2012, T-240/11, MyBeauty (fig.) / BEAUTY TV et al., EU:T:2012:391, § 15 *et seq.*).

No authorisation needs to be submitted, unless the Office or any party to the proceedings requests it.

The Office will verify the first time an employee representative claims to represent an employer. At a later stage it may also do so where it has reason to doubt that the employment relationship continues to exist, such as when different addresses are indicated or when one and the same person is nominated as the employee of different legal persons.

4.4.2 Indirect employment

As outlined in paragraph 4.4.1 when a legal person is a party in proceedings before the Office, they can also be represented by an employee, even if that employee does not work directly for the legal person identified by the legal address. This is particularly relevant for legal persons with a legal address outside the EEA since representation is mandatory for them (see paragraph 5.1 below). These non-EEA legal persons may be represented by an employee in the following two scenarios:

- first, legal persons with a legal address outside the EEA , but having a real and effective industrial or commercial establishment within the EEA , may be represented before the Office by an employee of this EEA-based establishment;
- second, legal persons with a legal address outside the EEA may be represented by an employee of another legal person within the EEA provided that both legal persons are economically connected.

For the definition of legal address as identified in the represented persons ID number, see paragraph 3.2.1 .

In the first scenario, to successfully claim an employee representative, the represented legal person must show that even though their legal address is outside the EEA, they also have a real and effective industrial or commercial establishment in the EEA, e.g. by proving that they own or control a branch, agency or any other kind of commercial establishment (including subsidiaries) in the EEA to such extent that it can be considered an extension of the non-EEA legal person.

The concept of 'branch, agency or other establishment' implies a place of business which has the appearance of permanency, such as the extension of a parent body, has a management and is materially equipped to negotiate business with third parties so that the latter, although knowing that there will if necessary be a legal link with the parent body, the office of which is abroad, do not have to deal directly with that parent body but may transact business at the place of business constituting the extension (see definition in 22/11/1978, C-33/78, Somafer, EU:C:1978:205, § 12; also quoted in 22/09/2016, T-512/15 , Sun Cali (fig.), EU:T:2016:527, § 30).

Proof of employment at the EEA-based establishment must also be provided for the employee representative.

For example, the EUTM applicant is a company with a legal address in the US. However, it can **prove** that it owns a branch in Spain. The party must **claim and prove** that the natural person identified as the employee representative works for the establishment in Spain. An employee working for this Spanish establishment can then represent the US EUTM applicant before the Office.

In the second scenario, to successfully claim an employee representative, the legal assessment is similar. Firstly, the legal person must show that the other legal person exists within the EEA; secondly, that there is a sufficiently strong economic connection between the represented party and the EEA-based legal person; and thirdly, that the employee representative truly works for the EEA-based legal person.

For example, 'Company A LLC' with a legal address in the US is party to the proceedings before the Office. It can show that it is economically linked to 'Company B Ltd.' in Ireland. John Smith is employed by 'Company B Ltd.' in Ireland. Consequently, John Smith may act as an employee representative of the US-based 'Company A LLC'.

Similar to the first scenario, economic connections only exist when there is economic dependence between the two legal persons, either in the sense that the party to the proceedings is dependent on the employer of the employee concerned, or vice versa. This economic dependence may exist for example:

- either because the two legal persons are members of the same group; or
- because of management control mechanisms (22/09/2016, T-512/15 , SUN CALI (fig.), EU:T:2016:527, § 33 et seq.).

However, the following do not establish economic links:

- a connection by virtue of a trade mark licensing agreement;
- a contractual relationship between two enterprises aimed at mutual representation or legal assistance;
- a mere supplier/client relationship, for example, on the basis of an exclusive distribution or franchising agreement.

All the arguments and evidence the requester deems necessary to support the claims, including any evidence to prove the existence and nature of the link between the different entities and any proof of employment, must be submitted together with the request. If this evidence is not submitted, the Office will issue a deficiency.

4.5 Legal representation and signature

Legal representation refers to the representation of natural or legal persons through other persons in accordance with national law. For example, the president of a company is the legal representative of that company.

In all cases, a natural person that is acting as a legal representative, should indicate underneath the signature(s), the name(s) of the individual person(s) signing and the person's(persons') status, for example, 'president', 'chief executive officer', 'gérant', 'procuriste', 'Geschäftsführer' or 'Prokurist'.

Other examples of legal representation according to national law are cases where minors are represented by their parents or by a custodian, or a company is represented by a liquidator. In these cases, the person actually signing must demonstrate his or her capacity to sign even though no authorisation is required.

It should be borne in mind, however, that a legal person addressing the Office from outside the EEA must be represented by a professional representative within the EEA, unless appointment of a representative is not mandatory (see paragraph 5.1 for any exceptions to the general rule). See paragraph 5.2.1 on the consequences of not appointing a representative, when representation is mandatory, once the EUTM or REUD application has been filed.

5 Appointment of a Professional Representative

5.1 Conditions under which appointment is mandatory

Subject to the exceptions outlined in paragraph 4.4 above, the appointment of a professional representative is mandatory for parties to proceedings before the Office that do not have their domicile or their principal place of business, or a real and effective industrial or commercial establishment **in the EEA**. This obligation exists for all proceedings before the Office, except for the filing of an application for an EUTM or an REUD, an application for renewal of an EUTM or an REUD, and an application for inspection of files.

The same applies to international registrations designating the EU. For further information on this point, please see the Guidelines, Part M, International Marks.

5.1.1 Domicile, principal place of business, or real and effective industrial or commercial establishment

The criterion for mandatory representation is determined by the legal address of the represented person, not their nationality. For example, a French national domiciled in Japan has to be represented, but an Australian national domiciled in Belgium does not have to be. For more information on the legal address, see paragraph 3.2.1.

The criterion is not fulfilled where the party to the proceedings merely has a post office box or an address for service in the EEA, nor where the applicant indicates the address of an agent with a place of business in the EEA. For more information on situations where a party may have a legal address outside the EEA but may also have a real and effective industrial or commercial establishment within the EEA, please see paragraph 4.4.1, which deals with this concept for the purpose of determining if an employee representative is entitled to represent.

5.1.2 The notion of 'in the EEA'

Article 119(2) EUTMR

Article 77(2) EUDR

In applying Article 119(2) EUTMR and Article 77(2) EUDR, the relevant territory is the territory of the EEA, which comprises the EU and the countries of Iceland, Liechtenstein and Norway.

5.2 Consequences of non-compliance when appointment is mandatory

Article 120(1) EUTMR Article 78(1) EUDR

Where a party to proceedings before the Office is in one of the situations described under paragraph 5.1, but has failed to appoint a professional representative within the meaning of Article 120(1) EUTMR or Article 78(1) EUDR in the application or request, or where compliance with the representation requirement ceases to exist at a later stage (e.g. where the representative withdraws), the legal consequences depend on the nature of the proceedings concerned.

5.2.1 During registration

Articles 31(3) and 119(2) EUTMR
Article 77(2) EUDR Article 45(3) EUDR

Where representation is mandatory and the applicant fails to designate a professional representative in the application form, the examiner will invite the applicant to appoint a representative as part of the formality examination pursuant to Article 31(3) EUTMR,

first sentence, or Article 45(3) EUDR. Where the applicant fails to remedy this deficiency, the application will be refused.

The same course of action will be taken where the appointment of a representative ceases to exist later during the registration process, up until any time before actual registration, that is to say, even within the period between publication of the EUTM application and registration of the EUTM.

Where a specific ('secondary') request is introduced on behalf of the applicant during the registration process, for example a request for inspection of files, a request for registration of a licence or a request for *restitutio in integrum*, the appointment of a representative need not be repeated, but the Office may in case of doubt request an authorisation. The Office will in this case communicate with the representative on file, and the representative for the recordal applicant, where different.

5.2.2 During opposition

For EUTM applicants, the preceding paragraphs apply where appointment of a representative is mandatory. The procedure to remedy any deficiencies relating to representation will take place outside the opposition proceedings. Where the applicant fails to remedy the deficiency, the EUTM application will be refused, and the opposition proceedings will be terminated.

Article 2(2)(h)(ii) and Article 5(5) EUTMDR

As regards the opponent, any initial deficiency relating to representation is a ground for inadmissibility of the opposition. Where representation is mandatory pursuant to Article 119(2) EUTMR and the notice of opposition does not contain the appointment of a representative, the examiner will invite the opponent to appoint a representative within a 2-month time limit pursuant to Article 5(5) EUTMDR. If the deficiency is not remedied before the time limit expires, the opposition will be rejected as inadmissible.

When a representative resigns, the proceedings continue with the opponent itself if it is from the EEA. If the opponent is from outside the EEA, the Office will issue a deficiency inviting the opponent to appoint a representative. If the deficiency is not remedied, the opposition will be rejected as inadmissible.

When there is a withdrawal, change or appointment of a representative during opposition proceedings, the Office will inform the other party of the change by sending a copy of the letter and of the authorisation (if submitted).

5.2.3 Cancellation

Article 12(1)(c)(ii) and Article 15(4) EUTMDR

In cancellation proceedings, the above paragraphs concerning the opponent apply *mutatis mutandis* to the applicant for revocation or declaration of invalidity of an EUTM.

Where an EUTM proprietor from outside the EEA is no longer represented, the examiner will invite it to appoint a representative. If it does not do so, procedural statements made by it will not be taken into account, and the cancellation application will be dealt with on the basis of the evidence that the Office has before it. However, a registered EUTM will not be cancelled simply because an EUTM proprietor from outside the EEA is no longer represented.

5.3 Appointment of a representative when not mandatory

Where the party to the proceedings before the Office is not obliged to be represented, they may nevertheless, at any time, appoint a representative within the meaning of Article 119 or 120 EUTMR and Articles 77 and 78 EUDR.

Where a representative has been appointed, the Office will communicate solely with that representative (see paragraph 6 below).

5.4 Appointment/replacement of a representative

5.4.1 Explicit appointment/replacement

Article 74(7) EUTMDR Article 1(1)(e) and Article 62(8) EUDIR

A representative is normally appointed in the official Office form initiating the procedure involved, for example, the application form or the opposition form (as concerns the appointment of multiple representatives, see paragraph 6 below).

A representative may also be appointed in a subsequent communication. In the same way, a representative may also be replaced at any stage of the proceedings.

The appointment must be unequivocal.

It is strongly recommended that the request for registration of an appointment of a representative be submitted electronically via the Office's website (e-recordals).

An application to record an appointment must contain:

- the registration or application number of the EUTM/REUD registration or application;
- the new representative's particulars;
- the signature(s) of the person(s) requesting the recordal.

When the application does not comply with the above, the recordal applicant will be invited to remedy the deficiency. The notification will be addressed to the person who filed the application to record the appointment of the representative. If the recordal applicant fails to remedy the deficiency, the Office will reject the application.

Where a representative has been appointed, the notification will be sent to the party that submitted the application to register the appointment, that is to say, to the

recordal applicant. Any other party, including the previous representative in the case of a replacement when he or she is not the recordal applicant, will be informed of the appointment in a separate communication only once the appointment has been registered.

When the application relates to more than one proceeding, the recordal applicant must select a language for the application that is common to all proceedings. If there is no common language, separate applications for appointment must be filed. For more information on the use of languages see the Guidelines, Part A, General Rules, Section 4, Language of Proceedings.

If there is no representative in the proceedings, a communication made in respect of a particular procedure (e.g. registration or opposition), accompanied by an authorisation signed by the party to the proceedings, implies the appointment of a representative. This also applies where a general authorisation is filed in the same way. For information about general authorisations, see paragraph 7.2 below.

If there is already a representative in the proceedings, the person represented has to clarify whether the former representative will be replaced.

5.4.2 Implicit appointment

Submissions, requests, etc. filed on behalf of the parties by a representative (hereafter the ‘new’ representative) other than the one who appears in our register (hereafter the ‘old’ representative) will initially be accepted.

The Office will then send a letter to the ‘new’ representative inviting him or her to confirm his or her appointment within 1 month. The letter will include a warning that if the representative does not reply within the time limit, the Office will assume that he or she has not been appointed as representative.

If the ‘new’ representative confirms his or her appointment, the submission will be taken into account and the Office will send further communications to the ‘new’ representative.

If the ‘new’ representative does not reply within 1 month or confirms that he or she is not the ‘new’ representative, the proceedings will go on with the ‘old’ representative. The submission and the answer from the ‘new’ representative will not be taken into account and will be forwarded to the ‘old’ representative for information purposes only.

In particular, when the submission leads to the closure of proceedings (withdrawals/ limitations), the ‘new’ representative must confirm his or her appointment as representative so that the closure of proceedings or the limitation can be accepted. In any case, the proceedings will not be suspended.

5.4.3 Associations of representatives

Article 74(8) EUTMDR

Article 78(8) EUDR

An association of representatives (such as firms or partnerships of lawyers or professional representatives or both) may be appointed rather than the individual representatives working within that association.

In order for the Office to grant an ID number to an association of representatives (see paragraph 4.1), there must be at least two legal practitioners or professional representatives practising within that association or partnership that comply with the requirements of Article 120(1) EUTMR or Article 78(1) EUDR and that have already obtained individual ID numbers from the Office assigned to the address of the association. This information should be submitted with the initial request.

Where the Office has doubts that the association has at least a minimum of two members complying with the requirements, or doubts regarding the continued presence of at least two qualified association members, the Office will issue a deficiency notification. This deficiency may be issued at the time of examining the initial request, or at any later stage. In the event the deficiency is not remedied, any existing association ID number will be invalidated, and any files assigned to this existing ID will be moved to the individual ID of the only existing member of the association.

The appointment of an association of representatives automatically extends to any professional representative who, subsequent to the initial appointment, joins that association of representatives. Conversely, any representative who leaves the association of representatives automatically ceases to be authorised under that association. It is strongly recommended that any changes and information concerning representatives joining or leaving the association be notified to the Office. The Office reserves the right, if justified by the circumstances of the case, to verify whether a given representative actually works within the association.

Article 120(1) EUTMR

Article 74 EUTMDR

Article 78(1) EUDR

Article 62 EUDIR

The appointment of an association of representatives does not depart from the general rule that only legal practitioners and professional representatives within the meaning of Article 120(1) EUTMR and Article 78(1) EUDR may perform legal acts before the Office on behalf of third parties. Therefore, any application, request or communication must be signed by a physical person possessing this qualification. The representative must indicate their name underneath the signature. They may indicate their individual ID number, if one has been provided by the Office, or their association ID number.

6 Communication with Parties and Representatives

Article 60(1) and (3) and Article 66 EUTMDR

Article 53(1) and (3) and Article 63 EUDIR

Where a representative has been appointed within the meaning of Article 119 or 120 EUTMR and Article 77 or 78 EUDR, the Office will communicate solely with that representative.

Any notification or other communication addressed by the Office to the duly authorised representative will have the same effect as if it had been addressed to the person represented.

Any communication addressed to the Office by the duly authorised representative will have the same effect as if it originated from the person represented.

In addition, if the party represented files documents itself with the Office while being represented by a duly authorised representative, these documents will be accepted by the Office as long as the party represented has its domicile or principal place of business or a real and effective industrial or commercial establishment in the EEA. However, the Office will reply to the appointed representative, not to the party directly. Where the represented party has its domicile or principal place of business or a real and effective industrial or commercial establishment outside the EEA, these documents will not be taken into account.

Article 60(2) and Article 73 EUTMDR

Article 53(2) and Article 61 EUDIR

A party to the proceedings before the Office may appoint up to a maximum of two representatives, in which case each of the representatives may act either jointly or separately, unless the authorisation given to the Office provides otherwise. The Office, however, will as a matter of course communicate only with the first named representative, except where the additional representative is appointed for a specific secondary procedure (such as inspection of files or opposition), in which case the Office will communicate with this representative during the course of this specific secondary procedure.

Article 119(4) EUTMR

Articles 60(1) and (2) and 73(1) EUTMDR

Article 77(4) EUDR

Article 61(1) EUDIR

Where there is more than one applicant, opponent or any other party to proceedings before the Office, a common representative may be expressly appointed.

Where a common representative is not expressly appointed, the first applicant named in the application that is domiciled in the EEA, or its representative if appointed, will be considered to be the common representative.

If none of the applicants are domiciled in the EEA, they are obliged to appoint a professional representative; therefore, the first named professional representative appointed by any of the applicants will be considered to be the common representative.

The Office will address all notifications to the common representative.

7 Authorisation

Articles 119(3) and 120(1) EUTMR

Article 74 EUTMDR

Articles 77(3) and 78(1) EUDR

Article 62 EUDIR

In principle, professional representatives do not need to file an authorisation to act before the Office. However, any professional representative (legal practitioner or Office professional representative entered on the list, including an association of representatives) acting before the Office must file an authorisation for insertion in the files if the Office expressly requires this or, where there are several parties to the proceedings in which the representative acts before the Office, if the other party expressly asks for this.

In such cases, the Office will invite the representative to file the authorisation within a specific time limit. The letter will include a warning that if the representative does not reply within the time limit, the Office will assume that he or she has not been appointed as representative and proceedings will continue directly with the party. Where representation is mandatory, the party represented will be invited to appoint a new representative and paragraph 5.2 above applies. Any procedural steps, other than the filing of the application, taken by the representative will be deemed not to have been taken if the party represented does not approve them within a period specified by the Office.

An authorisation must be signed by the party to the proceedings. In the case of legal persons, it must be signed by a person who is entitled, under the applicable national law, to act on behalf of that person.

Simple photocopies of the signed original may be submitted. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them.

Authorisations may be submitted in the form of individual or general authorisations.

7.1 Individual authorisations

Article 120(3) EUTMR

Article 65(1)(i) and Article 74 EUTMDR

Article 78(5) EUDR

Article 62 and Article 68(1)(i) EUDIR

Individual authorisations may be made on the form established by the Office pursuant to Article 65(1)(i) EUTMDR and Article 68(1)(i) EUDIR. The procedure to which the authorisation relates must be indicated (e.g. 'concerning EUTM application number 12345'). The authorisation will then extend to all acts during the lifetime of the ensuing EUTM. Several proceedings may be indicated.

Individual authorisations, whether submitted on the form made available by the Office or on the representative's own form, may contain restrictions as to its scope.

7.2 General authorisations

Article 120(1) EUTMR

Article 65(1)(i) and Article 74 EUTMDR

Article 78(1) EUDR

Article 62 and Article 68(1)(i) EUDIR

A 'general authorisation' authorises the representative, the association of representatives or the employee to perform all acts in all proceedings before the Office, including, but not limited to, the filing and prosecution of EUTM applications, the filing of oppositions and the filing of requests for a declaration of revocation or invalidity, as well as in all proceedings concerning REUDs and international marks. The authorisation should be made on the form made available by the Office, or a form with the same content. The authorisation must cover all proceedings before the Office and may not contain limitations. For example, where the text of the authorisation relates

to the 'filing and prosecution of EUTM applications and defending them', this is not acceptable because it does not cover the authority to file oppositions and requests for a declaration of revocation or invalidity. Where the authorisation contains such restrictions, it will be treated as an individual authorisation.

7.3 Consequences where authorisation expressly requested by the Office is missing

If representation is not mandatory, the proceedings will continue with the person represented.

If representation is mandatory, paragraph 5.2 above will apply.

8 Withdrawal of a Representative's Appointment or Authorisation

A withdrawal or change of representative may be brought about by an action taken by the person represented, the previous representative or the new representative.

8.1 Action taken by the person represented

Article 74(4) EUTMDR Article 62(5) EUDIR

The person represented may at any time revoke, in a written and signed communication to the Office, the appointment of a representative or the authorisation granted to them. Revocation of an authorisation implies revocation of the representative's appointment.

Article 74(5) EUTMDR Article 62(6) EUDIR

Any representative who has ceased to be authorised will continue to be regarded as the representative until the termination of that representative's authorisation has been communicated to the Office.

Where the party to the proceedings is obliged to be represented, paragraph 5.2 above will apply.

8.2 Withdrawal by the representative

The representative may at any time declare, by a signed communication to the Office, that they withdraw as a representative. The request must indicate the number of the proceedings (e.g. EUTM/REUD number, opposition, etc.). If the representative declares that representation will be taken over by another representative as from that moment, the Office will record the change accordingly and correspond with the new representative.

9 Death or Legal Incapacity of the Party Represented or Representative

9.1 Death or legal incapacity of the party represented

Article 74(6) EUTMDR Article 62(7) EUDIR

In the event of the death or legal incapacity of the authorising party, the proceedings will continue with the representative, unless the authorisation contains provisions to the contrary.

Article 106(1) EUTMR Article 59(1) EUDIR

Depending on the proceedings, the representative will have to apply for registration of a transfer to the successor in title. However, in the event of the death or legal incapacity of the applicant for, or proprietor of, an EUTM, the representative may apply for an interruption of proceedings. For more information on interrupting opposition proceedings following the death or legal incapacity of the EUTM applicant or its representative, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters.

In insolvency proceedings, a liquidator, once nominated, will assume the capacity to act on behalf of the bankrupt person and may — or (in the case of mandatory representation) must — appoint a new representative, or else confirm the appointment of the existing representative.

For more information on insolvency proceedings, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 2, Licences, Rights *in Rem*, Levies of Execution, Insolvency Proceedings, Entitlement Proceedings or Similar Proceedings.

9.2 Death or legal incapacity of the representative

Article 106(1) and (2) EUTMR

Article 72(2) EUTMDR

Article 59(1)(c) and Article 59(3) EUDIR

In the event of the death or legal incapacity of a representative, the proceedings before the Office will be interrupted. If the Office has not been informed of the appointment of a new representative within a period of 3 months after the interruption, the Office will:

- where representation is not mandatory, inform the authorising party that the proceedings will now be resumed with them;
- where representation is mandatory, inform the authorising party that the legal consequences will apply, depending on the nature of the proceedings concerned (e.g. the application will be deemed to have been withdrawn, or the opposition will be rejected), if a new representative is not appointed within 2 months of the date of notification of that communication (28/09/2007, R 48/2004-4, PORTICO / PORTICO, § 13, 15).

10 Change of name and address

Article 55 and Article 111(3)(a) and (b) EUTMR

Article 72(3)(b) EUDR

Article 19 and 69(a) EUDIR

The name and legal address of an EUTM or an REUD applicant, a party to the proceedings, or a representative may be amended.

A change of name is limited to a change that does not affect the identity of the person, for example, where there is a change in the name (through marriage/divorce), or in the case of a legal person, where the company officially changes its name in the company register.

On the other hand, a change in the party's identity may be a transfer or a change of ownership. In the event of any doubt as to whether a change will be considered a transfer or a change of ownership, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 1, Transfer. That chapter provides detailed information in this respect as well as the applicable procedure.

A representative's name and address may be amended, provided that the representative is not being substituted by another representative. That would be considered an appointment of a new representative, which is subject to the rules governing such an appointment.

Where the address of an association of representatives is changed, the address of all of the association members must also be updated. As seen in paragraph 5.4.3, the address linked to the ID numbers of the members of an association and the address linked to the ID number of the association itself must all coincide.

A change of name or address can be requested by the affected person. The request must contain the EUTM/REUD number (or the file number assigned to the proceedings in question) and the name and address of the party or representative, both as on the file and as amended. The ID number should also be provided. The request is free of charge.

Where there is any doubt, the Office may ask for proof such as an extract from a trade register, or other evidence, to corroborate the change of name or address.

Changes to the parties' or representatives' name or address will be reflected in the ID number assigned to the party or representative. Consequently, the change will be reflected in all proceedings where this ID is assigned, including all EUTM and REUD applications and pending proceedings. The change cannot be recorded only for a specific portfolio of rights.

For changes in the name or address of the proprietor of a registered EUTM or REUD, see the Guidelines, Part E, Register Operations, Section 1, Changes in a registration.

11 Correction of the name or address

Article 31(1)(b) EUTMR, Article 49(2) EUTMR

Article 11 EUTMDR

Article 36(1)(b) EUDR

Article 12(2) EUDIR

The name and legal address of an EUTM or an REUD applicant, a party to the proceedings, or a representative may be corrected in case of errors in the respective application or request.

Firstly, corrections pursuant to Article 49(2) EUTMR and Article 12(2) EUDIR will be allowed where the error in the name or address that requires correction is considered **obvious**, that is, nothing else could have been intended other than what is offered as the correction. Examples of obvious errors in the name or address could be misspellings, typographical errors, errors of transcription or use of an abbreviated form in the names of natural persons (e.g. 'Phil' instead of 'Phillip').

Additionally, a correction could also be considered in this scenario where there is a typographical error in the legal form (e.g. S.A. was indicated in the application form instead of S.L.). This correction would require evidence to be submitted in support of the request.

Where a correction takes place in the name or address of an EUTM or REUD applicant pursuant to Article 49(2) EUTMR and Article 12(2) EUDIR, this correction will have no consequences as regards the filing date of the application, because the applicant

is deemed to be correctly identified from the beginning pursuant to Article 31(1)(b) EUTMR and Article 36(1)(b) EUDR.

Secondly, errors that are **not considered to be obvious** and that lead to the **change in identification of the EUTM or REUD applicant** can take place, but they do not fall under Article 49(2) EUTMR and Article 12(2) EUDIR. They will lead to a change in the filing date of the application, as the correct identification of the applicant is a formal requirement for the granting of a filing date pursuant to Article 31(1)(b) EUTMR and Article 36(1)(b) EUDR. The new filing date of the application will be considered to be the one on which the corrected (new) applicant is formally identified and all supporting evidence is submitted in support of the correction.

In this second scenario, the burden of proof is on the party that made the mistake to prove what needs correcting and why it needs correcting. A request for correction of a name which consists of replacing one name with another will require evidence of what needs correcting and the evidence will also need to link the correction to the EUTM/ REUD application (or file) in question. For example, where a representative informs the Office that the wrong EUTM applicant was indicated in the EUTM application form by mistake, the evidence must show that the party (as requested to be corrected) bears a relation with the EUTM application in question. A request simply informing the Office that the correction is needed because someone made a mistake, or another applicant was intended, or there was a change of mind after filing, will not be accepted.

Requests for correction of errors must contain the file number of the application or proceeding, the erroneous name or address and its corrected version, and evidence in support of the request for correction where applicable.

Corrections should not be confused with requests for changes of name or address, see paragraph 10.

Fast-track: 01/11/2024

Annex 1

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OPA – The Austrian Patent Office **(Austria)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Rechtsanwalt'**	Persons holding the title **'Rechtsanwalt'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Austrian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Zugelassener Vertreter'** **'Patentanwalt'** or **'Notar'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the titles **'Patentanwalt'** or **'Notar'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
BOIP – Benelux Office for Intellectual Property **(Benelux)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Advocaat', 'Rechtsanwalt'** or **'Avocat'**	Persons holding the titles **'Avocat'** , **'Advocaat'** or **'Rechtsanwalt'** (meaning a lawyer admitted to the bar), are entitled to act as legal practitioners before the Benelux industrial property office pursuant to national laws, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Gemachtigde' , 'Patentanwalt'** or **'mandataire'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Benelux Office for Intellectual Property. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Benelux Intellectual Property Office **(Option a).** Persons in possession of a professional qualification officially recognised under the regulations laid down by the States of Belgium, the Netherlands or Luxembourg, certified by the central industrial property office of the Member State concerned, are not subject to the 5-year requirement before the BOIP to act as a professional representative before the EUIPO **(Option b)** .

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
BPO – Patent Office of the Republic of Bulgaria **(Bulgaria)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**Адвокат** ('Advokat')	Persons holding the title **'Адвокат'** (Attorney) are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Bulgaria, and consequently they are entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**Представител по индустриална собственост'** ('Predstavitel po industrialna sobstvenost')	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Представител по индустриална собственост'** ('IP representative') have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.
SIPO – State Intellectual Property Office of the Republic of Croatia **(Croatia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'odvjetnik'**	Persons holding the title **'odvjetnik'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Croatian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Ovlašteni zastupnici'** **'Zastupnik Za Žigove'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Zastupnik Za Žigove'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. An exam must be passed, before the Croatian Intellectual Property Office, in order to obtain this qualification.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Industrial Property Office of the Czech Republic **(Czech Republic)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Advokát'**	Persons holding the title **'Advokát'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of the Czech Republic, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Kvalifikovaných zástupců'** **'Patentový zástupce'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentový zástupce'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. The Czech Republic has a two-part examination: • Persons who have passed part B only (on 'trade marks and appellation of origin') may act as representatives in this field and hence be entered on the list of Article 120(1)(b) EUTMR to represent in trade mark matters . Patent attorneys ***('Patentový zástupce')*** , who have passed both parts of the examination, are therefore entitled to represent applicants in all procedures before the EUIPO (i.e. both trade mark and design matters).

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Department of the Registrar of Companies and Official Receiver **(Cyprus)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Δικηγόρος'** ('Dikigoros')	Only persons holding the title **'Δικηγόρος'** (or 'Dikigoros'), are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Cyprus, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Εγκεκριμένος Αντιπρόσωπος'**	n/a

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
DKPTO – Danish Patent and Trademark Office **(Denmark)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'advokat'**	Persons holding the Danish title **'Advokat'** meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Danish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Godkendte mødeberettigede'** **'Varemaerkefuldmaegtig'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Anyone may act before the national industrial property office in trade mark matters . In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the national office **(Option a)** . In addition, persons holding the title **'Varemaerkefuldmaegtig'** are officially recognised as professionally qualified to represent third parties before the national office in trade mark and design matters and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b).**

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
EPA – Estonian Patent Office **(Estonia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'õigusala töötaja'** **'Jurist'** and **'Advokaat'**	Persons holding the titles **'Jurist'** and **'Advokaat'** who are also qualified as IP attorneys are entitled to act as legal practitioners before the national industrial property office pursuant to Estonian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Kutseline esindaja'** **'Patendivolinik'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patendivolinik'** who have passed the 'trade marks, industrial designs and geographical indications' part of the exam, have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters. Persons who only passed the 'patents and utility models' part of the exam may not act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
PRH – Finnish Patent and Registration Office **(Finland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'harjoittamaan oikeutettu'** **'Asianajaja'** or **'Advokat'**	Persons holding the Finnish title **'Asianajaja'** or **'Advokat'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Finland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Ammattimainen edustaja'** **'Tavaramerkkiasiamies'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any natural or legal person can act as a representative in trade mark and design matters before the national industrial property office. In order for this person to be entitled to act as a representative before the EUIPO, the person must have at least 5 years' experience before the national industrial property office **(Option a)** . In addition, persons holding the title **'Tavaramerkkiasiamies'** are officially recognised as being professionally qualified to represent third parties before the Finnish Patent and Registration Office in trade mark matters , and therefore are not subject to the 5-year requirement to act as professional representative before the EUIPO **(Option b)** .

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
INPI – The National Institute for Intellectual Property **(France)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'avocat'**	Persons holding the French title **'avocat'** , meaning a lawyer member of the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to French law, and consequently entitled to act before the EUIPO in trade mark and design matters. These lawyers are fully entitled to act in trade mark and design matters, with an exception, that they cannot act under the title of 'lawyer' (avocat) and under the title of 'professional representative' (see below) at the same time . Therefore, they are not entitled to act before the EUIPO under two separate IDs (one as a lawyer, and one as a professional representative).
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Mandataires agréés'** Persons on the **'Liste des Conseils en propriété industrielle'**	**Entitlement is conditional upon possession of a special professional qualification**
			Only persons on the **'Liste des Conseils en propriété industrielle'** maintained by INPI with the speciality **'Marques, dessins et modèles'** or **'Juriste'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
DPMA – German Patent and Trade Mark Office **(Germany)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Rechtsanwalt'**	Persons holding the German title **'Rechtsanwalt'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to German law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Patentanwalt'**	**Entitlement is conditional upon possession of a special professional qualification**
			Persons holding the title **'Patentanwalt'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. Persons holding the titles of **'Patentassessor '** and **'Syndikuspatentanwalt '** (§ 41a Abs. 2 PAO) do not have such qualification. They have a limited power of representation as they may only act as employee representatives for their employer, not as professional representatives.
GGE – Hellenic Republic Ministry of Economy, Infrastructure, Shipping and Tourism **Designs: Industrial Property Organisation (OBI)** **(Greece)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Δικηγόρος'** (Dikigoros)	Only persons holding the title **'Δικηγόρος'** (or 'Dikigoros'), are entitled to act as legal practitioners before the national industrial property office pursuant to Greek law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Εγκεκριμένος Αντιπρόσωπος'**	n/a

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
HIPO – Hungarian Intellectual Property Office **(Hungary)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Ügyvéd'**	Persons holding the title **'Ügyvéd'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Hungarian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Hivatásos képviselők'** **'Szabadalmi ügyvivő'** ('patent attorney')	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Szabadalmi ügyvivő'** ('patent attorney') have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO. **'Legal advisors'** or **'notaries'** are not entitled to act in procedures relating to industrial property matters and therefore may not be entered on the EUIPO's list of professional representatives.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Icelandic Intellectual Property Office **(Iceland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Lögfræðingur'** (e. Lawyer), **'Lögmaður'** (e. Attorney-at-Law), **'Héraðsdómslögmaður'** (e. District Court Attorney) or **'Hæstaréttarlögmaður'** (e. Supreme Court Attorney)	Persons holding the title **'Lögfræðingur'** (e. Lawyer), **'Lögmaður'** (e. Attorney-at-Law), **'Héraðsdómslögmaður'** (e. District Court Attorney) or **'Hæstaréttarlögmaður'** (e. Supreme Court Attorney), and therefore lawyers admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Iceland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Umboðsmaður'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Icelandic Patent Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Icelandic Patent Office **(Option a)** . In addition, persons holding the title **'Umboðsmaður'** are officially recognised as being professionally qualified to represent third parties before the national industrial property office, and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b)** .

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Intellectual Property Office of Ireland **(Ireland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Barrister'** or **'Solicitor'**	Persons holding the titles **'Barrister'** or **'Solicitor'** , are entitled to act as legal practitioners before the national industrial property office pursuant to Irish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Registered Trade Mark Agent'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Registered Trade Mark Agent'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark matters.
UIBM – Italian Patent and Trademark Office **(Italy)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Avvocato'**	Persons holding the Italian title **'Avvocato'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Italian law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Mandatario abilitato in Marchi'** **'Consulente in Marchi'** **'Consulente in Proprietà Industriale'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'Consulente in Marchi'** and **'Consulente in Proprietà Industriale'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in both trade mark and design matters.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
LRPV – Patent Office of the Republic of Latvia **(Latvia)**	**Professional Representative (Trade Marks and Designs)** Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Profesionâlais patentpilnvarnieks'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'profesionālais patentpilnvarnieks'** ('professional patent attorney') and included on the Patent Office List of Professional Patent Attorneys are entitled to represent persons before the national industrial property office (and consequently, before the EUIPO): - in trade mark matters, if they have specialised (and passed a specific exam) in the field of trade marks; - in design matters, if they have specialised (and passed a specific exam) in the field of designs.
Bureau of Intellectual Property Office of Economic Affairs **(Liechtenstein)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Rechtsanwalt'**	Persons holding the title **'Rechtsanwalt'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Liechtenstein, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Patentanwalt'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentanwalt'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
The State Bureau of the Republic of Lithuania **(Lithuania)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'praktikuojantis teisininkas'** **'Advokatas'**	Persons holding the title **'Advokatas'** are entitled to act as legal practitioners before the national industrial property office pursuant to Lithuanian law, and consequently entitled to act before the EUIPO in trade mark and design matters, provided that their clients have a permanent residence in the EU. Clients whose permanent residence is not in the EU may not be represented by a legal practitioner and must be represented by a professional representative.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**' Profesionalūs atstovai '** **'Patentinis patikėtinis'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentinis patikėtinis'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Commerce Department, Industrial Property Registrations Directorate **(Malta)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'prattikant legali'** **'Avukat'** or **'Prokuratur Legali'**	Persons holding the titles **'Avukat'** or **'Prokuratur Legali'** , are entitled to act as legal practitioners before the national industrial property office pursuant to Maltese law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'rappreżentanti professjonali'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person, with a legal background including notaries, may act before the Maltese Intellectual Property Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Maltese Intellectual Property Office. **(Option a).**

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
NIPO – Norwegian Industrial Property Office **(Norway)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Advokat'** and **'Advokatfullmektig'**	Persons holding the titles **'Advokat'** and **'Advokatfullmektig',** a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Norway, and consequently entitled to act before the EUIPO in trade mark and design matters. Furthermore, if the legal practitioner acts as an attorney-at-law no power of attorney is necessary. However, if the legal practitioner acts as an employee of a company a power of attorney is necessary, even if the employee is an attorney-at-law.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)		**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State** Any person may act before the Norwegian Intellectual Property Office. In order for this person to represent in trade mark matters before the EUIPO, the person must have at least 5 years' experience before the Norwegian Intellectual Property Office. **(Option a).**

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
Polish Patent Office **(Poland)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**‘ prawnik’** **‘Adwokat, radca prawny’**	Persons holding the title **‘Adwokat, radca prawny’** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office in trade mark and design matters pursuant to the laws of Poland, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**‘Zawodowi pełnomocnicy’** **‘Rzecznik Patentowy’**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **‘Rzecznik Patentowy’** (on the list of patent attorneys maintained by the Polish Patent Office) have the necessary ‘special professional qualification’ and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
INPI – Portuguese National Industrial Property Office **(Portugal)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Profissionais de justiça'** **'Advogado'**	Persons holding the title **'Advogado'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Portuguese law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'mandatário autorizado'** **'Agentes da Propiedade Industrial'** and **'notary'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act before the Portuguese Institute of Industrial Property. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Portuguese Institute of Industrial Property **(Option a)** . In addition, persons holding the titles of **'Agentes da Propiedade Industrial'** and **'notary'** are officially recognised as professionally qualified to represent third parties before the Portuguese Institute of Industrial Property and are therefore not subject to the 5-year requirement to act as a professional representative before the EUIPO **(Option b)** .

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OSIM – Romanian State Office for Inventions and Trademarks **(Romania)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'Avocat'**	Persons holding the title of **'Avocat'** are entitled to act as legal practitioners before the national industrial property office pursuant to the laws of Romania (Law no. 30/2024 for the amendment of Law no. 84/1998 regarding trademarks and geographical indications, of Law no. 129/1992 regarding the protection of designs and models, as well as Law no. 64/1991 regarding patents, published in the Official Gazette of Romania, Part I no. 173 of March 4, 2024), and consequently are entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'reprezentanții autorizați'** **'Consilier în proprietate industrială'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Consilier în proprietate industrială'** (who in turn must be a member of a national chamber), have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in trade mark and design matters.
SKIPO – Industrial Property Office of the Slovak Republic **(Slovakia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**' advokát'**	Persons holding the title **'advokát'** are entitled to act as legal practitioners before the national industrial property office pursuant to Slovak law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Oprávnený zástupca'** **'Patentový zástupca'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title **'Patentový zástupca'** hold the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
SIPO – Slovenian Intellectual Property Office **(Slovenia)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'odvetnik'**	Persons holding the title **'Odvetnik'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to laws of Slovenia, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Zastopnik za modele in znamke'** (Design and trademark agent)	**Entitlement is conditional upon possession of a special professional qualification**
			Persons holding the title **'Zastopnik za modele in znamke'** (design and trademark agent) have the necessary 'special professional qualification', must be registered in the Register of Agents at the Slovenian Intellectual Property Office and are therefore entitled to act as a professional representative before the EUIPO. **'Notaries'** are explicitly excluded from representing third parties before the Slovenian Intellectual Property Office.

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
OEPM – Spanish Patent and Trademark Office **(Spain)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'abogado'**	Persons holding the title **'abogado'** , a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Spanish law, and consequently entitled to act before the EUIPO in trade mark and design matters provided that the person they represent is a resident of a Member State of the EEA. Where the person that is represented is not a resident of a Member State of the EEA they may not be represented by a legal practitioner (**'abogado'**), and must be represented by a professional representative holding the title **'Agente Oficial de la Propiedad Industrial '** * *21/10/2021 – Spanish law in this area currently under review. See the draft law (*' Anteproyecto de Ley de modificación de la Ley 17/2001, de 7 de diciembre, de Marcas, la Ley 20/2003, de 7 de julio, de Protección Jurídica del Diseño Industrial, y la Ley 24/2015, de 24 de julio, de Patentes. '*) It is possible to be an **'abogado '** and an **'Agente Oficial de la Propiedad Industrial'** at the same time.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Representante autorizado'** **'Agente Oficial de la Propiedad Industrial'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
			Any person may act in trade mark and design matters before the national industrial property office pursuant to Spanish law, provided that the person they represent is a resident of a Member State of the EU. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years of experience before the OEPM **(Option a)** . Where the person that is represented is not a resident of a Member State of the EU they must be represented by a person holding the title of **'Agente de la Propiedad Industrial'** In addition, persons holding the title **'Agente de la**

National/ Regional IP Office (Country)	Type of representative	National terminology	Entitlements/specific rules for representing clients in trade mark and design matters
PRV – Swedish Patent and Registration Office **(Sweden)**	**Legal practitioner** Article 120(1)(a) EUTMR / Article 78(1)(a) EUDR	**'juridisk person'** **'Advokat '**	Persons holding the title **'Advokat'** , meaning a lawyer admitted to the bar, are entitled to act as legal practitioners before the national industrial property office pursuant to Swedish law, and consequently entitled to act before the EUIPO in trade mark and design matters.
	Professional Representative (Trade Marks and Designs) Article 120(2)(c) EUTMR / Article 78(1)(b) EUDR)	**'Auktoriserat ombud'** **'Patentombud'**	Representation is open to anybody a. who has acted before the national office for at least 5 years, or b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State
			Any person may act in trade mark and design matters before the Swedish Patent and Registration Office. In order for this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Swedish Patent and Registration Office **(Option a)** . In addition, persons holding the title **'Patentombud'** are officially recognised as being professionally qualified to represent third parties before the Swedish Patent and Registration Office in trade mark and design matters , and are therefore not subject to the 5-year requirement to act as professional representatives before the EUIPO **(Option b)** .

Annex 2

The list below shows the countries where a title exists for a person who is only entitled to represent in design matters. If the country is not on the list it means that the relevant entitlement also covers trade mark matters and so this person would not be on the special designs list.

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 78(4)(c) EUDR
PRH – Finnish Patent and Registration Office **(Finland)**	**'Mallioikeusasiamies'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
		Any natural or legal person can act as a representative in design matters before the national industrial property office. In order for this person to be entitled to act as a representative before EUIPO, the person must have at least 5 years' experience before the national industrial property office (**Option a**). Persons holding the title **'Mallioikeusasiamies'** are officially recognised as being professionally qualified to represent third parties before the Finnish Patent and Registration Office in design matters, and therefore are not subject to the 5-year requirement to act as professional representative before the EUIPO (**Option b**).

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 78(4)(c) EUDR
Intellectual Property Office of Ireland **(Ireland)**	**'Registered Patent Agents'**	**Entitlement is conditional upon possession of a special professional qualification** Only **'Registered Patent Agents'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters.
UIBM – Italian Patent and Trademark Office **(Italy)**	**'Consulente in brevetti'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'Consulente in brevetti'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters only.
LRPV – Patent Office of the Republic of Latvia **(Latvia)**	**'PatentpiInvarotais dizainparaugu lietas'**	**Entitlement is conditional upon possession of a special professional qualification** Persons holding the title of **'PatentpiInvarotais dizainparaugu lietas'** have the necessary 'special professional qualification' and are therefore entitled to act as professional representatives before the EUIPO in design matters only.

National/Regional IP Office (Country)	National terminology	Professional Representative (exclusively Designs) Article 78(4)(c) EUDR
PRV – Swedish Patent and Registration Office **(Sweden)**	**'Varumaerkesombud'**	**Representation is open to anybody** **a. who has acted before the national office for at least 5 years, or** **b. who is exempt from the 5-year requirement as they are in possession of a professional qualification officially recognised in accordance with the regulations laid down by that State**
		Any person may act in design matters before the Swedish Patent and Registration Office. For this person to be entitled to act as a professional representative before the EUIPO, the person must have at least 5 years' experience before the Swedish Patent and Registration Office (**Option a**). Persons holding the title **'Varumaerkesombud'** are officially recognised as being professionally qualified to represent third parties before the Swedish Patent and Registration Office in design matters, and therefore are not subject to the 5-year requirement to act as professional representatives before the EUIPO (**Option b**).

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 7

Revision

1 General principles

Article 66 EUTMR
Article 55 EUDR
Article 69 EUTMR Article 58 EUDR

Article 34(1) EUTMDR

Revision only occurs in *ex parte* cases, that is to say, those that involve only one party.

Revision enables the first-instance decision taker to rectify a decision that has been appealed if the appeal is admissible and well founded. The purpose of revision is to avoid the Boards of Appeal ruling on appeals against decisions for which a need for rectification has been recognised by the department that took the decision.

Revision proceedings can take place where an appeal has been lodged against a decision for which the Boards of Appeal are competent.

The Boards of Appeal send the appealed decision back to the department that took the decision in order for it to be revised.

A decision can only be rectified within 1 month of receipt of the statement of grounds of appeal.

Since revision requires a pending appeal, it will not take place when the appeal is withdrawn before a decision on revision could be taken.

2 Revision of decisions

Article 69 EUTMR

Article 58 EUDR

Articles 23(1), 33 and 34(1) EUTMDR

Article 35(1) and (2) EUDIR

In *ex parte* proceedings, once the Board of Appeal considers the appeal to be admissible, the Registrar of the Boards of Appeal sends the appeal documents (the notice of appeal and the statement of grounds) to the department that adopted the appealed decision for revision.

The department concerned examines whether the appealed decision should be rectified or not.

Since the revision may result in a rectification of the appealed decision only where the appeal is admissible and well founded, the competent department must also verify that the following conditions are met:

- the appeal is admissible (Article 23(1) EUTMDR or Article 35(1) and (2) EUDIR); and
- the appeal is 'well founded' within the scope of the appeal, on substantive or procedural grounds.

The relevant date for assessing whether the appeal is 'well founded' is that on which the competent department took the appealed decision.

The appealed decision will not be rectified when the appellant attempts to remedy deficiencies for the first time before the Boards of Appeal.

2.1 No rectification of the appealed decision

Article 69(2) EUTMR

Article 58(2) EUDR

When the competent department concludes that the conditions for rectifying the appealed decision are not met, and at the latest upon expiry of 1 month from the receipt of the statement of grounds of appeal, it remits the case to the Boards of Appeal without any comment or statement.

No formal decision refusing the rectification of the appealed decision is issued and the proceedings will continue before the Boards of Appeal.

2.2 Rectification of the appealed decision

Article 69(1) and (2) EUTMR

Article 33(b) and 34(1) and (2) EUTMDR

Article 58(1) and (2) EUDR

Articles 37 EUDIR

When the competent department concludes that the conditions for rectifying the appealed decision are met, it will inform the Board of Appeal thereof without delay.

In addition, the following procedural actions will be taken:

- within 1 month of the Board of Appeal submitting the statement of grounds of the appeal to the competent department, this department must take a decision repealing the appealed decision in its entirety ('decision on rectification');
- the competent department takes a new decision on the merits either together with the decision on rectification or at a later stage;
- the Board of Appeal decides on the closure of the appeal.

2.2.1 Contents of the decision on rectification

Depending on the reasons found by the competent department to rectify the appealed decision, the outcome may lead to one of the following situations.

1. A new interaction with the party (for example, because a request for an extension of time had been overlooked).

   In this case, the Office will set new time limits for the party, and a new decision on the merits will be adopted at a later stage.
2. A new decision on the merits taken directly without any interaction with the party (for example, if evidence of acquired distinctiveness was on file but was not addressed in the appealed decision).

   In this case, the new decision on the merits can be issued either together with the decision on rectification or at a later stage.

Taking this into account, the decision on rectification must contain the following:

1. the reasons that justify the rectification of the initial decision;
2. a statement that the initial decision (i.e. the appealed decision) is deemed to have been repealed;
3. a statement establishing the procedural situation of the examination proceedings, that is:
   - a statement that a decision on the merits will be taken at a later stage, and a statement that the decision on rectification can only be appealed together with the later decision on the merits;

     or
   - a statement that a new decision on the merits of the case replacing the initial decision is herewith adopted, and a statement that an appeal can be filed within 2 months;
4. in design proceedings, an order to reimburse the appeal fee.

The new decision on the merits may set the proceedings back and allow for a new examination, which may go beyond the scope of the initial appeal. The new decision on the merits may result in the same outcome.

2.2.2 Communication of the decision on rectification

Once the decision on rectification is taken, the competent department must promptly inform the Registrar of the Boards of Appeal. The Board of Appeal decides on the closure of the appeal. The appeal fee will be reimbursed.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 8

Restitutio in integrum

1 General principles

Article 104 EUTMR

Article 67 EUDR

Parties to proceedings before the Office may have their rights reinstated (*restitutio in integrum*) if they were unable to meet a time limit vis-à-vis the Office despite taking all due care required by the circumstances, provided that the failure to meet the time limit had the direct consequence, by virtue of the provisions of the Regulations, of causing a loss of rights or loss of means of redress (28/06/2012, T-314/10, Cook's, EU:T:2012:329, § 16-17; 26/09/2017, T-84/16, widiba (fig.) / ING DiBa (fig.) et al., EU:T:2017:661, § 27).

Observing time limits is a matter of public policy, and serves the requirements of legal certainty and the need to avoid any discrimination or arbitrary treatment in the administration of justice. Derogations from these rules can only be made in exceptional circumstances (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 34). Consequently, the conditions for the application of *restitutio in integrum* have to be interpreted strictly (19/09/2012, T-267/11, VR, EU:T:2012:446, § 35; 16/06/2015, T-585/13, JBG Gauff Ingenieure (fig.) / Gauff et al., EU:T:2015:386, § 25).

Restitutio in integrum is only available upon application to the Office and is subject to the payment of a fee (see paragraph 3.7).

The Office is under no obligation to inform or advise a party to the proceedings before it to pursue any particular legal remedy, including *restitutio in integrum* (06/10/2021, T-635/20, Juvéderm vybrance, EU:T:2021:656, § 36).

2 Criteria for granting *restitutio in integrum*

There are two requirements for *restitutio in integrum*:

1. that the party has exercised all due care required by the circumstances; and
2. that the non-observance (of a deadline) by the party has the direct consequence of causing the loss of a right or means of redress.

2.1 The condition of 'all due care required by the circumstances'

Rights will be re-established only under exceptional circumstances that cannot be predicted from experience (13/05/2009, T-136/08, Aurelia, EU:T:2009:155, § 26) and are therefore unpredictable and involuntary.

If the party is represented, the representative's failure to take all due care is attributable to the party that they represent (19/09/2012, T-267/11, VR, EU:T:2012:446, § 40;

16/12/2020, T-3/20, Canoleum / Marmoleum, EU:T:2020:606, § 45). The question whether the party has exercised the necessary vigilance to mitigate the errors of its representative causing the loss of a right cannot excuse the representative (19/09/2012, T-267/11, VR, EU:T:2012:446, § 41; 31/01/2019, T-604/17, REJECTION OF RESTITUTIO IN INTEGRUM (RECORDAL), EU:T:2019:42, § 21).

1. **Examples of where the 'all due care' requirement has been fulfilled**

   Failure to deliver mail

   In principle, failure to deliver by postal or delivery service does not involve any lack of due care by the party concerned (25/06/2012, R 1928/2011-4, SUN PARK HOLIDAYS / SUNPARKS). However, it is up to the parties' representative to at least find out in advance from the delivery company what the usual delivery times are (for example, in the case of letters sent from Germany to Spain in the decision of 04/05/2011, R 2138/2010-1, YELLOWLINE / Yello).

   Errors of the Office and their repercussions

   The degree of due care that the parties must demonstrate in order to have their rights re-established must be determined in the light of all the relevant circumstances. Relevant circumstances may include a relevant error made by the Office and its repercussions. Thus, even though the party concerned has failed to take all due care, a relevant error by the Office may result in the granting of *restitutio in integrum* (25/04/2012, T-326/11, BrainLAB, EU:T:2012:202, § 57, 59).

   Force majeure

   Circumstances such as natural disasters and general strikes are regarded as fulfilling the requirement for all due care. Another unpredictable event may be when all the employees of a law firm representing the party concerned are factually prevented from accessing the physical files and, consequently, from taking any further action to observe the time limit (14/06/2021, R 735/2021-4, MOOI MUSEUM OF OPTICAL ILLUSIONS (fig.) / MUSEUM OF ILLUSIONS (fig.) et al., § 15).

2. **Examples of where the 'all due care' requirement has not been fulfilled**

   a. **Errors in administration or organisation**

      Delegation of tasks

      The party to proceedings who delegates the administrative tasks relating thereto must ensure that the person chosen provides the necessary guarantees to ensure the tasks are properly carried out (13/09/2011, T-397/10, Sport shoe, EU:T:2011:464, § 25).

      Management of files

      Errors in the management of files caused by the representative's employees or by the computerised system itself are predictable. Consequently, due care would require a system for monitoring and detecting any such errors (13/05/2009, T-136/08, Aurelia, EU:T:2009:155, § 18; 26/09/2017, T-84/16, widiba (fig.) / ING DiBa (fig.) et al., EU:T:2017:661, § 39; 21/04/2021, T-382/20, Table knives, forks and spoons, EU:T:2021:210, § 31-34).

For example, an error by the Renewals Department Manager of a private company, who monitors staff performance daily, does not constitute an exceptional event (24/04/2013, R 1728/2012-3, LIFTING DEVICES (PART OF-)).

Workload

The exceptional workload and organisational strains to which the applicants claim they were subject are, in principle, irrelevant (20/06/2001, T-146/00, Dakota, EU:T:2001:168, § 62; 20/04/2010, T-187/08, Dog, EU:T:2010:150, § 34).

Absence of a key member of the accounts department

The absence of a key member of the Accounts Department cannot be regarded as an exceptional or unpredictable event (10/04/2013, R 2071/2012-5, STARFORCE).

Delay in instructions

Delay by the owner in providing instructions is not an exceptional event (15/04/2011, R 1439/2010-4, SUBSTRAL NUTRI+MAX / NUTRIMIX).

Financial problems / closure of business

Financial problems at the proprietor's business, its closure and the loss of jobs cannot be accepted as reasons preventing the proprietor from being able to observe the time limit to renew its European Union trade mark (31/03/2011, R 1397/2010-1, CAPTAIN).

b. **Duties and errors of professional representatives**

Legal errors and misunderstandings

Legal errors by a professional representative do not warrant *restitutio in integrum* (16/11/2010, R 1498/2010-4, REGINE'S / REGINA DETECHA, CH.V.D). A misunderstanding of the applicable law may not, as a matter of principle, be regarded as an 'obstacle' to compliance with a time limit (14/06/2012, R 2235/2011-1, KA; 28/04/2020, R 2391/2019-5, STAHL (fig.)).

Consideration of time limits

The careful consideration of the time limits is part of the basic duties of professional representatives, including the careful checking of the facsimile transmission report after submitting documents (26/06/2017, R 748/2017-2, GIBBS S3 Business, Technology and Community Partner (fig.) / STHREE et al., § 43). A clerical error in entering a deadline cannot be regarded as an exceptional or unpredictable event (31/01/2013, R 265/2012-1, KANSI / Kanz).

Calculation of time limits

An erroneous calculation of the time limit does not constitute an exceptional event that cannot be predicted from experience (05/07/2013, R 194/2011-4, PAYENGINE / SP ENGINE). The correct calculation of the deadline is governed by the EUTMR and the EUTMDR, and the party cannot justify its non-compliance with the time limit by the fact that the deadline was not displayed in the Office's online database (03/09/2019, R 500/2019-5, minimon (fig.) / Minimensch, § 36).

The same rule applies to European Union designs where the relevant provisions are in the EUDR and the EUDIR.

c. **Clerical mistakes**

Deletion of a deadline

The deletion of a deadline by an assistant is not unpredictable (28/06/2010, R 268/2010-2, ORION).

Bank transfer error

An error in the transmission of the data to a bank or an error made by a bank in the execution of the transfer to the Office cannot be regarded as exceptional or unforeseeable. The party to the proceedings before the Office is under an obligation to anticipate those circumstances and to take the necessary precautions to ensure that the payment is made within the established time period (13/10/2021, T-732/20, Crystal, EU:T:2021:696, § 29-31).

2.2 Loss of rights or means of redress caused directly by failure to meet the time limit

Article 104(1) EUTMR

Article 67(1) EUDR

Failure to meet the time limit must have had the direct consequence of causing the loss of rights or means of redress.

Articles 47(2), 95(2) and 96(1) EUTMR Article 7, Article 8(1) to (4), (7) and (8), Article 14 and Article 17(1) and (2) EUTMDR

Article 64 EUDR

This is not the case where the Regulations offer procedural options that parties to proceedings are free to use, such as requesting an oral hearing, requesting that the opponent prove genuine use of its earlier mark, or applying for an extension of the cooling-off period, pursuant to Article 7 EUTMDR. The cooling-off period itself is not subject to *restitutio in integrum* either because it is not a time limit within which a party must perform an action.

Article 38(1), Articles 41 and 42, and Article 155(1) EUTMR

However, *restitutio in integrum* does apply to the late response to an examiner's notification of provisional refusal if the application is not rectified by the time limit specified because, in this case, there is a direct relationship between failure to meet the time limit and possible refusal.

Restitutio in integrum is also available for the late submission of facts and arguments and late filing of observations on the other party's statements in inter partes proceedings if and when the Office refuses to take them into account as being filed late. The loss of rights in this case involves the exclusion of these submissions and observations from the facts and arguments on which the Office bases its decision.

3 Procedural Aspects

Article 104(2) EUTMR
Article 65(1)(i) EUTMDR
Article 67(2) EUDR
Article 68(1)(g) EUDIR

3.1 Proceedings to which *restitutio in integrum* applies

Restitutio in integrum is available in all proceedings before the Office (*ex parte*, *inter partes* and appeal proceedings).

This includes proceedings under the EUTMR and EUDR . The relevant provisions differ in terms of the requirements for translations (see paragraph 3.7), the time period for a request relating to non-payment of a renewal fee (see paragraph 3.5) and the reimbursement of the fee (see paragraph 3.6).

Unless specifically excluded by Article 104(5) EUTMR or Article 67(5) EUDR, *restitutio in integrum* is available.

The reference to Article 105 EUTMR in Article 104(5) EUTMR should be understood as only excluding from *restitutio in integrum* the time limits that are laid down as such in Article 105 EUTMR, namely the time limits for requesting continuation of proceedings and paying the fee pursuant to Article 105(1) EUTMR. Consequently, *restitutio in integrum* is available within the time limits mentioned in Article 105(2) EUTMR to the extent that they are not expressly excluded by Article 104(5) EUTMR.

Unlike the EUTMR for EUTMs, the EUDR does not provide for continuation of proceedings for REUDs.

For *restitutio* in renewal proceedings see paragraph 3.12.

3.2 Parties

Article 104 EUTMR

Article 67 EUDR

Restitutio in integrum is available to any party to proceedings before the Office.

The time limit must have been missed by the party concerned or its representative.

3.3 Time limits excluded from *restitutio in integrum*

Article 104(5) EUTMR

Article 67(5) EUDR

In the interests of legal certainty, *restitutio in integrum* is not applicable to the following time limits.

Articles 41(1) and 67(5) EUDR

Article 8(1) EUDIR

- The priority period, which is the 6-month time limit for filing an application claiming the priority of a previous design or utility model application pursuant to Article 41(1) EUDR. However, *restitutio in integrum* does apply to the 3-month time limit for providing the file number of the previous application and filing a copy of it, as specified in Article 8(1) EUDIR.

Articles 46(1) and (3) and 104(5) EUTMR

- The time limit for filing an opposition pursuant to Article 46(1) EUTMR, including the time limit for paying the opposition fee referred to in Article 46(3) EUTMR.

Article 104(2) and (5) EUTMR

Article 67(2) and (5) EUDR

- The time limits for *restitutio in integrum* itself, namely:
  - a time limit of 2 months for filing the application for *restitutio in integrum* as from the removal of the cause of non-compliance;
  - a time limit of 2 months from the date for completing the act that was omitted;
  - a time limit of 1 year for filing the application for *restitutio in integrum* as from the expiry of the missed time limit.

Article 105(1) EUTMR

- The time limit for requesting continuation of proceedings pursuant to Article 105 EUTMR, including the time limit for paying the fee referred to in Article 105(1) EUTMR.

Article 72(5) EUTMR

- The 2-month time limit to file an appeal against the decision of the Boards of Appeal before the General Court (08/06/2016, T-583/15, DEVICE OF THE PEACE SYMBOL, EU:T:2016:338).

3.4 Effect of *restitutio in integrum*

Granting *restitutio in integrum* has the retroactive legal effect that the time limit that was not met will be considered to have been met, and that any loss of rights in the interim will be deemed never to have occurred. If the Office has taken a decision in the interim based on failure to meet the time limit, that decision will become void, with the consequence that, once *restitutio in integrum* is granted, there is no longer any need to lodge an appeal against such a decision of the Office in order to have it removed. Effectively, *restitutio in integrum* will re-establish all the rights of the party concerned.

3.5 Time limits

Articles 53(3) and 104(2) EUTMR

Articles 13(3) and 67(2) EUDR

Applicants must apply to the Office in writing for *restitutio in integrum*.

The applicant must make the application within 2 months of the removal of the cause of non-compliance and no later than 1 year after expiry of the missed time limit. However, in case of non-payment of a renewal fee for designs, the application must be made no later than one year from the date of expiration of the grace period for renewal (Article 50d(3) EUDR). Within the same period, the act that was omitted must be completed. The date when the cause of non-compliance is removed is the first date on which the party knew or should have known about the facts that led to the non-observance. If the ground for non-compliance was the absence or illness of the professional representative dealing with the case, the date on which the cause of non-compliance is removed is the date on which the representative returns to work.

If the application for *restitutio in integrum* is filed late, it will be rejected as inadmissible.

3.6 Fees

Article 104(3) and Annex I (22) EUTMR

Article 67(3) and Annex I, point 11 EUDR

The applicant must also pay the fee for *restitutio in integrum* within the same time limit (see paragraph 3.5 above).

As a general rule, the individual fee (EUR 200) must be paid for each application for *restitutio in integrum* (i.e. one fee is due per individual right). Nevertheless, in certain cases exceptions may apply. The minimum conditions for applying such exceptions are the following:

1. all the rights should relate to the same rights holder;
2. all the rights should be of the same type (e.g. EUTMs, REUDs);
3. the unobserved time limit should be the same for all rights (e.g. missed time limit for renewal);
4. the loss of all rights concerned should be the result of the same circumstances.

These conditions are cumulative. Therefore, only when all of them are met, can the application for *restitutio in integrum* relating to multiple rights be subject to a single fee.

If all the conditions are not met, an individual fee must be paid for each right concerned.

If the applicant does not pay the fee by expiry of the time limit, the application for *restitutio in integrum* will be deemed not to have been filed.

In the event the application is deemed not to have been filed due to late or insufficient payment of the fee or because it was filed in relation to a time limit that is excluded from *restitutio in integrum* (see paragraph 3.3 above), any fee paid (including late or insufficient fees) will be refunded.

For EUTM proceedings, once the application for *restitutio in integrum* has been deemed to have been filed, the fee will not be refunded if the request for *restitutio in integrum* is later withdrawn, rejected as inadmissible or rejected on the grounds of the substance of the claim (i.e. if the 'all due care' requirement is not fulfilled, see paragraph 2.1 above).

In REUD proceedings, the fee will be refunded if the request for *restitutio in integrum* is granted (Article 67(3) EUDR).

3.7 Languages and translations

Article 146 EUTMR

Article 24 EUTMIR

Article 98 EUDR

Article 80 and 81 EUDIR

The applicant must submit the application for *restitutio in integrum* in the language, or in one of the languages, of the proceedings in which the failure to meet the time limit occurred. For example, in the EUTM registration procedure, this is the correspondence language indicated in the application; in the REUD registration procedure this is the language used for filing the application or the second language indicated by the applicant in the application; in the opposition procedure, it is the language of the opposition procedure; in the REUD invalidity procedure, it is the language of the invalidity procedure (Article 98(4) EUDR); and in the renewal procedure, it is any of the Office's five languages.

Where the application for *restitutio in integrum* is not filed in the language of the proceedings, the applicant must submit a translation into that language within one month of the date of submission of the application (Article 146(9) EUTMR and Article 81(1) EUDIR). If a translation into the language of proceedings is not submitted on time, the application for *restitutio in integrum* will be rejected as inadmissible.

Evidence in support of the application for *restitutio in integrum* may be filed in any official language of the European Union. The rules for translation in EUTM proceedings differ from those in REUD proceedings. Where evidence in EUTM proceedings was not submitted in the language of the proceedings, the Office may require a translation into that language (Article 24 EUTMIR). In proceedings concerning REUDs, the Office may require that a translation be supplied, within a time limit specified by it, in the language of the proceedings or, at the choice of the party to the proceedings, in any language of the Office (Article 81(2) EUDIR).

If a translation is not submitted on time, the evidence will be disregarded.

3.8 Particulars and evidence

Articles 97 and 104 EUTMR

Articles 65 and 67 EUDR

In its application for *restitutio in integrum* the applicant must state the grounds on which the application is based and set out the facts on which it relies. The application must set out which deadline has been missed.

As granting *restitutio in integrum* is essentially based on facts, it is advisable for the requesting party to submit evidence by means of sworn or affirmed statements. Statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence (16/06/2015, T-586/13, Gauff THE ENGINEERS WITH THE BROADER VIEW (fig.) / Gauff et al., EU:T:2015:385, § 29).

Moreover, the act that was omitted must be completed, together with the application for *restitutio in integrum*, at the latest by the time limit for submitting that application. For example, if the deadline to submit observations has been missed, the observations must be submitted with the request for *restitutio in integrum*. A request for extension of the time limit will not be accepted as the 'omitted act'. If the payment of a fee has been missed, that fee must be paid together with the *restitutio in integrum* request.

If the grounds on which the application is based, and the facts on which it relies are not submitted, the application for *restitutio in integrum* will be rejected as inadmissible. The same applies if the omitted act is not completed.

3.9 Competence

Article 104 EUTMR Article 67 EUDR

The division or department competent to decide on the act that was omitted (i.e. responsible for the procedure in which failure to meet the deadline occurred) is responsible for dealing with applications for *restitutio in integrum*.

3.10 Publications

Articles 53(5), (7) and (8), and 104(7), Articles 111(3)(k) and (l) and 116(1)(a) EUTMR Article 50d(7) and (8) and Articles 67 and 72(3)(n) and (o) EUDR Article 70(2) EUDIR

The EUTMR and EUDR provide for a mention of the re-establishment of rights to be published in the Bulletin. This mention will be published only if the failure to meet the time limit that gave rise to the application for *restitutio in integrum* has actually led to publication of a change of status of the EUTM or REUD application or registration, because only in such a case would third parties be able to take advantage of the absence of such rights. For example, the Office will publish a mention that *restitutio in integrum* has been granted if it published a mention that registration had expired due to failure to meet the time limit for paying the renewal fee.

In the event of such a publication, a corresponding entry will also be made in the Register.

No mention of receipt of an application for *restitutio in integrum* will be published.

3.11 Decision, role of other parties in *restitutio in integrum* proceedings

Articles 66 and 67 EUTMR

The applicant for *restitutio in integrum* is the sole party to the *restitutio in integrum* proceedings, even where failure to meet the time limit occurred in *inter partes* proceedings.

The decision on *restitutio in integrum* will be taken, if possible, in the decision terminating the proceedings. The Office may also adopt a separate decision on the application for *restitutio in integrum*. In both cases, the applicant for *restitutio in integrum* can appeal the refusal of its request for *restitutio in integrum* together with an appeal against the decision terminating the proceedings.

The decision to grant *restitutio in integrum* cannot be appealed.

The other party to *inter partes* proceedings will be informed both that *restitutio in integrum* has been requested and about the outcome of the proceedings. If *restitutio in integrum* is granted, the other party's only means of redress is to initiate third-party proceedings (see paragraph 4 below).

3.12 *Restitutio in integrum* in the event of renewals

The principles mentioned in this chapter also apply to requests for *restitutio in integrum* in renewal proceedings, but with the following particularities.

Party to the proceedings

In renewal proceedings, authorised persons within the meaning of Article 53(1) EUTMR or Article 50d(1) EUDR who missed the renewal deadline are party to the renewal proceedings and may, therefore, request *restitutio in integrum* in their own name (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 26, 31-32).

Time limits

Where a renewal deadline was missed and the loss of rights was notified to the EUTM proprietor, the day of this notification is the point in time from which a diligent proprietor has 2 months to comply with the requirements set out in Article 104 EUTMR or Article 67 EUDR (30/09/2010, C-479/09 P, DANELECTRO, EU:C:2010:571, § 36, 42; 28/09/2021, R 396/2021-2, Netcomponents, § 28). The notification of the loss of right to the proprietor is also valid for an authorised person (23/09/2020, T-557/19, 7SEVEN (fig.), EU:T:2020:450, § 47 et seq.).

If the applicant for the renewal of an EUTM fails to submit the request for renewal or to pay the renewal fee, the 1-year period after expiry of the missed time limit (Article 104(2) EUTMR) starts on the day on which the protection ends and *not* on the expiry of the further 6-month grace period set out in Article 53(3) EUTMR.

However, for the renewal of an REUD, the 1-year period after expiry of the missed time limit (Article 67(2) EUDR) starts on the expiry of the further 6-month grace period set out by Article 50d(3) EUDR.

Fees

The exception to the general rule that an individual fee must be paid for each application for *restitutio in integrum* also applies to renewals (see paragraph 3.7). When a party has missed renewing multiple EUTM registrations, it can file a single request for *restitutio in integrum* for the renewal of all of its marks and pay a single *restitutio in integrum* fee.

The fees must be paid together with the *restitutio in integrum* request. The fee amount depends on which time limit the party asks to have reinstated: the basic period for renewal, the grace period for renewal or the deadline for late payment within the meaning of Article 180 EUTMR.

Indication of which period should be reinstated

In its application for *restitutio in integrum*, the applicant must clearly state if it is seeking reinstatement of the basic period, the grace period or the period within the meaning of Article 180 EUTMR.

4 Third-Party Proceedings

Article 104(6) and (7) EUTMR Article 67 EUDR

A third party who, in the period between the loss of rights and publication of the mention of the re-establishment of rights,

- has, in good faith, put goods on the market or supplied services under a sign that is identical or similar to the EUTM, or
- in the case of a European Union design, has, in good faith, put on the market products in which a design included within the scope of protection of the REUD is incorporated or to which it is applied,

may bring third-party proceedings against the decision re-establishing the rights of the applicant, proprietor or holder of the EUTM or REUD.

This request is subject to a 2-month time limit, which starts:

- on the date of publication, where publication has taken place;
- on the date on which the decision to grant *restitutio in integrum* took effect, where publication has not taken place.

The Regulations do not contain any provisions governing this procedure. The division or department that took the decision to re-establish the rights is responsible for third-party proceedings. The Office will conduct adversarial *inter partes* proceedings, which means that it will hear both parties before taking a decision.

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 9

Enlargement

1 Introduction

This section discusses the rules relating to the accession of new Member States to the European Union and the consequences for holders of European Union trade marks. Both absolute and relative grounds are dealt with in this section.

Article 209 EUTMR contains the relevant provisions relating to enlargement and European Union trade marks. These provisions were introduced into the Regulation pursuant to the 2004 enlargement process (at that time Article 142a CTMR) and have remained unchanged during successive enlargement processes. The only modification in the text of the Regulation is the addition of the names of the new Member States.

A table in Annex 1 lists the new Member States with their accession dates and official languages.

2 Rules Concerning Examination

2.1 Automatic extension of EUTMs to new Member States

Article 209(1) EUTMR lays down the basic rule of enlargement, which is that all existing EUTM applications and registered EUTMs are automatically extended to the new Member States without any kind of additional intervention by the European Union Intellectual Property Office, any other body or the holders of the rights concerned. There is no need to pay any extra fees or complete any other administrative formality. The extension of existing EUTM applications or EUTMs to the territories of new Member States ensures that these rights have equal effect throughout the EU and complies with the fundamental principle of the unitary character of the EUTM.

2.2 Pending EUTM applications

Article 209(2) EUTMR enshrines an important transitional provision, according to which EUTM applications **pending on the accession date** may not be refused on the basis of any absolute ground for refusal if this ground becomes applicable merely because of the accession of a new Member State (‘grandfathering clause’). In practice, this means that if an EUTM application is non-distinctive, descriptive, generic, deceptive or contrary to public policy or morality in the language or in the territory of a new Member State, it will not be refused if its filing date is **before** this State’s accession date.

For applications filed **after the accession date** the grounds for refusal of Article 7(1) EUTMR apply also for the new Member State. This is the case even when the EUTM application has a priority date that is earlier than the relevant accession date. The priority right does not protect the EUTM applicant against any change in the law relevant to its application. Therefore, examiners have to apply the same examination

criteria as for all the other official languages of the EU. This means that the examiner also has to check whether the EUTM application is descriptive, etc. in the new Member State.

However, this principle should be applied with caution as it merely means that the criteria for applying Article 7(1) EUTMR should not be made stricter as a result of the accession of new Member States. The inverse conclusion that terms that are descriptive in a language or in the territory of a new Member State may, in any event, be registered for EUTM applications filed prior to the accession date will not always be correct. For example, descriptive terms from new Member States' languages may have entered the customary languages of existing Member States or be widely known in them (e.g. vodka), and geographical indications may already have to be refused as descriptive terms (e.g. Balaton or Tokaj). Consideration must also be given to geographical indications already protected in the new Member States and to protection arising from EU legislation or bilateral treaties between the new Member States and the EU or existing Member States.

More precisely, the grounds for refusal of Article 7(1)(f) and (g) EUTMR, relating to marks contrary to public policy or morality and deceptive marks respectively, are only affected by this provision insofar as the deceptiveness or breach of public morality is due to a meaning that is **only** understood in a language of a new Member State. The Office interprets Article 7(1)(f) EUTMR in accordance with EU-wide criteria, irrespective of the relative levels of morality in different countries of the EU.

Finally, the provision of Article 209(2) EUTMR does not affect the grounds for refusal of Article 7(1)(e) or (i) EUTMR: the former relates to signs consisting exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, the shape, or another characteristic, which is necessary to obtain a technical result or the shape, or another characteristic, which gives substantial value to the goods, and the latter relates to badges and emblems not protected by Article 6*ter* of the Paris Convention but of particular public interest.

2.3 Distinctiveness acquired through use

According to Office practice, distinctiveness acquired through use (Article 7(3) EUTMR) must exist on the EUTM filing date and subsist until its registration date. Where an applicant for an EUTM application filed **before** the accession date is able to demonstrate that acquired distinctiveness existed at the filing date, Article 209(2) EUTMR precludes an objection based on the ground that it is not distinctive through use in the new Member States. Therefore, the applicant does not have to prove acquired distinctiveness in the new Member States.

2.4 Bad faith

The Office will consider the filing of an EUTM application as having been made in bad faith if it was made prior to the accession date for a term that is descriptive or otherwise

not eligible for registration in the language of a new Member State for the sole purpose of obtaining exclusive rights to a non-registrable term or for otherwise objectionable purposes.

This has no practical effect during the examination stage, as bad faith does not constitute an absolute ground for refusal and, consequently, the Office has no authority to object *ex officio*. The Office will exercise its duties in respect of 'bad faith filings' only when a request for a declaration of invalidity is filed (Article 59(1)(b) EUTMR). The national offices of the new Member States are equally determined to act against bad faith in the context of enlargement. EUTM applicants should, therefore, bear in mind that, even if there are no grounds for refusal during the registration procedure, their EUTM registrations may be contested at a later date on the basis of Article 59(1)(b) EUTMR.

2.5 Conversion

Conversion of an EUTM application into national trade mark applications for new Member States may be requested as from the accession date of those States. Conversion is also possible when a converted EUTM has a filing date prior to the accession date. However, in the case of a new Member State, the converted application will have the effect of an earlier right under national law. National law in new Member States has enacted provisions equivalent to Article 209 EUTMR providing that extended EUTMs have the effect of earlier rights in the new Member States only with effect from the accession date. In practice, this means that the 'conversion date' in a new Member State cannot be earlier than that State's accession date.

Taking Croatia's accession as an example, this means that even if a converted EUTM has a filing date of 01/05/2005, in Croatia the conversion date will not be 01/05/2005 but 01/07/2013, that is to say, Croatia's accession date.

The date of enlargement does not trigger a new 3-month time limit for requesting conversion under Article 139(4) EUTMR.

2.6 Other practical consequences

2.6.1 Professional representation

As from the accession date of a new Member State, applicants (as well as other parties to proceedings before the Office) with their seat or domicile in that State need no longer be represented by a professional representative. As from the accession date of a new Member State, professional representatives from that State may be entered on the list of professional representatives maintained by the Office pursuant to Article 120 EUTMR and may then represent third parties before the Office.

2.6.2 First and second language

As of the accession date of a new Member State (see Annex 1), the official language(s) of that State may be used as the first language for EUTM applications filed on or after that date.

2.6.3 Translation

EUTM applications with a filing date prior to the accession date of a new Member State and existing EUTM registrations will neither be translated into nor republished in the language of that State. EUTM applications filed after the accession date of a new Member State will be translated into and published in all official languages of the EU.

2.6.4 Seniority

Seniority may be claimed from a national trade mark that was registered before the accession of the new Member State in question or even before the creation of the European Union. The seniority claim may, however, only be made after the accession date. The mark registered in the new Member State must be 'earlier' than the EUTM. As an extended EUTM has, in the new Member State, the effect of an earlier right as from the accession date, the seniority claim only makes sense when the earlier national mark has a filing or priority date prior to the accession date.

- **Example 1:** The same person files an EUTM application on 01/04/1996 and a national trade mark application in Romania on 01/01/1999. After 01/01/2007 (Romania's date of accession), the seniority of the Romanian national trade mark application may be claimed.
- **Example 2:** The same person owns an international registration designating the EU on 01/01/2005 and subsequently designating Romania on 01/01/2006. After 01/01/2007, the seniority of that Romanian designation may be claimed even though the designation itself is later than the IR designating the EU. This is because the extended EUTM takes effect from the accession date of the new Member State (in this case 01/01/2007).

2.6.5 Search

The national offices of a new Member State may carry out searches (Article 43(2) and (3) EUTMR) as from that State's accession date. Only EUTM applications with a filing date on or after the accession date are sent to national offices for a search.

3 Rules Concerning Oppositions and Cancellations

1. According to Article 209(4)(b) EUTMR , an EUTM application cannot be opposed or declared invalid on the basis of a national earlier right acquired in a new Member State prior to that State's accession date.

However, EUTM applications filed on or after the accession date are not subject to this 'grandfathering clause' and may be rejected upon opposition, or declared invalid, on account of an earlier national right existing in a new Member State, provided that the earlier right is 'earlier' when the two filing or priority dates are compared.

2. An exception to this (transitional) rule is contained in Article 209(3) EUTMR regarding oppositions. An EUTM application filed within the 6 months preceding the accession date may be challenged by an opposition based on a national right existing in a new Member State at the date of the accession, provided that this right
   a. has an earlier filing or priority date, and
   b. was acquired in good faith.
3. The filing date and not the priority date is the decisive element for determining when an EUTM application can be opposed on the basis of an earlier right in a new Member State. In practice, the abovementioned provisions have the consequences illustrated in the following examples with reference to the accession of Croatia (01/07/2013).
   a. An EUTM application filed before 01/01/2013 (the priority date is irrelevant in this context) cannot be opposed or declared invalid on the basis of a national earlier right in a new Member State under any circumstances.
   b. An EUTM application with a filing date between 01/01/2013 and 30/06/2013 (i.e. **during the 6 months prior to the date of accession**), may be opposed by a Croatian trade mark, provided that the filing or priority date of the Croatian trade mark is earlier than the filing or priority date of the opposed EUTM application and the national mark was applied for in good faith.
   c. An EUTM application with a filing date of 01/07/2013 or later may be opposed or declared invalid on the basis of a trade mark registered in Croatia if that mark has an earlier filing or priority date under the normal rules. Acquisition in good faith is not a condition. This applies to all national marks and earlier non-registered rights filed or acquired in a new Member State prior to accession.
   d. An EUTM application with a filing date of 01/07/2013 or later but with a priority date before 01/07/2013 may be opposed or declared invalid on the basis of a national trade mark registered in Croatia if that mark has an earlier filing or priority date under the normal rules.
      This transitional exception is limited to the right to file an opposition and does not include the right to file an application for cancellation based on relative grounds. This means that once the abovementioned period of 6 months has expired without an opposition having been lodged, the EUTM application cannot be challenged any more by an opposition or by an application for a declaration of invalidity.
4. According to Article 209(5) EUTMR , the use of an EUTM with a filing date prior to the date of accession of a new Member State, may be prohibited pursuant to Articles 137 and 138 EUTMR on the basis of an earlier national trade mark registered in the new Member State where the latter has a filing or priority date prior to the date of accession and was registered in good faith.
   The above provision also applies to:

- applications for national marks filed in new Member States, provided that they have subsequently been registered;
- unregistered rights acquired in new Member States falling under Article 8(4) or Article 60(2) EUTMR with the proviso that the date of acquisition of the right under national law replaces the filing or priority date.

5. Where an opposition is based on a national registered mark or other right in a new Member State, whether or not that right may validly be invoked as a ground for opposition against an EUTM application depends on whether the opposition is well founded and is not an issue of admissibility.
6. The acquisition in good faith of the earlier national mark is presumed. This means that, if good faith is questioned, the other party to the proceedings (the applicant for the opposed EUTM application in the case of Article 209(4) EUTMR or the owner of the registered EUTM in the case of Article 209(5) EUTMR) must prove that the owner of the earlier national right obtained in a new Member State acted in bad faith when filing the national application or otherwise acquiring the right.
7. Article 209 EUTMR does not contain any transitional provisions concerning the use requirement (Articles 18 and 47 EUTMR). In opposition proceedings, the obligation to prove genuine use of the mark arises when the applicant for the opposed EUTM application requests that the opponent prove use of the earlier mark pursuant to Article 47(2) and (3) EUTMR and Article 10 EUTMDR . Issues relating to enlargement could arise regarding the time and place of use of the earlier mark.
   Two cases can be distinguished.

   a. **The earlier mark is a national mark registered in a new Member State**
      In this case, the opponent must prove genuine use of the earlier mark. This situation can only arise in the context of an opposition directed either against an EUTM application with a filing date after the date of accession or against an EUTM application filed within the period of 6 months preceding the date of accession.

      The earlier national mark must have been put to genuine use in the territory in which it is protected during the 5 years preceding the filing or priority date [10] of the contested EUTM application. In this regard, it is immaterial whether the use relates to a period during which the State concerned was already a Member State of the European Union. In other words, the proof of use may also relate to a period prior to the date of accession (in the case of Croatia before 01/07/2013).

   b. **The earlier mark is an EUTM**
      Where the owner of the earlier EUTM can prove use only in the territory of a new Member State or several new Member States, since the obligation of use relates to the period of 5 years preceding the filing or priority date [11] of the contested EUTM application, use in a new Member State (or several new Member States) can only be taken into account if the State concerned was a Member State of the European Union at the date of filing or the priority date of of the contested EUTM application (Article 47(2) EUTMR requires use *'in the Union').* Before their

[10] For oppositions and invalidity applications filed before 23/03/2016, the relevant date is the publication date.
[11] For oppositions and invalidity applications filed before 23/03/2016, the relevant date is the publication date.

accession dates, the new States do not constitute 'Member States of the Union'; therefore, it is not possible to prove use *'in the Union'.*

Therefore, the 5-year period should be counted only from the relevant date of accession.

8. There are no particular transitional problems relating to the opposition proceedings. The right pursuant to Article 146(8) EUTMR to choose a language that is not one of the five languages of the Office as the language of the proceedings applies as from the date of accession in respect of the other official languages of the European Union.

Annex 1

Member States	Accession date	Languages
Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Slovenia and Slovakia.	01/05/2004	Czech, Estonian, Greek, Latvian, Lithuanian, Hungarian, Maltese, Polish, Slovak and Slovenian
Bulgaria and Romania	01/01/2007	Bulgarian and Romanian
Croatia	01/07/2013	Croatian

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part A

General rules

Section 10 Evidence

1 Introduction

Articles 96 and 97 EUTMR

Articles 49 to 55 EUTMDR

Articles 64 and 65 EUDR

Articles 42 to 46 EUDIR

Common Communication on the Common Practice on Criteria for Assessing Disclosure of Designs on the internet published on 1 April 2020 (CP10)

Common Communication on the Common Practice on Evidence in Trade Mark Appeal Proceedings: Filing, Structure and Presentation of Evidence, and the Treatment of Confidential Evidence on 31 March 2021 (CP12)

This section of the Guidelines deals with the general provisions on the means of evidence for all proceedings before the Office. The principle that prevails in EU law is that of the 'unfettered evaluation of evidence'. This means that the **only relevant criterion** for the purpose of assessing the probative value of evidence lawfully adduced **relates to its credibility** (13/05/2020, T-288/19, IPANEMA (fig.) / iPANEMA (fig.) et al., EU:T:2020:201, § 41).

Establishing the credibility or probative value of evidence is fundamental in proceedings before the Office. This part of the Guidelines aims to assist parties in understanding how the probative value of evidence can be enhanced and what to avoid when adducing evidence.

According to Article 97 EUTMR, Article 51 EUTMDR, Article 65 EUDR and Article 43 EUDIR, the **means of giving and obtaining evidence** in all proceedings before the Office include:

- hearing the parties;
- requests for information;
- producing documents and items of evidence;
- hearing witnesses;
- expert opinions;
- sworn or affirmed statements in writing or statements having a similar effect under the law of the State in which they are drawn up;
- inspection *in situ* by the Office.

The most frequently used means of evidence is the submission of documents and items. In accordance with CP10 and CP12, the Office accepts, for example, the following:

- invoices and other commercial documents;
- catalogues, advertisements and marketing campaigns;

- publications;
- samples;
- official and public documents;
- witness statements;
- sworn or affirmed statements (affidavits);
- market surveys
- extracts from social media and online sources.

Different types of evidence may be submitted to establish the same fact or requirement and the parties are free to choose the means of evidence they submit (26/06/2019, T-651/18, HAWKERS (fig.) / HAWKERS (fig.) et al., EU: T:2019:444, § 35). To assess the probative value of a document, it is particularly necessary to consider from whom it originates, the circumstances in which it came to be, the person to whom it is addressed and whether the document appears sound and reliable (06/11/2014, T-463/12, MB, EU:T:2014:935, § 53).

For information on specific aspects of the various proceedings, the rules in the relevant sections of these Guidelines should be consulted. The following table contains **examples** of claims to be proved relating to trade marks or designs.

Table 2: EUTM proceedings

Claim	Aim of evidence	Cross reference
Descriptive mark	To demonstrate that a trade mark consists/does not consist exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services for which registration is sought or the trade mark is registered, in the relevant territory.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Descriptive trade marks (Article 7(1)(c) EUTMR) Part D, Cancellation, Section 2, Substantive provisions, 3 Absolute Grounds for Invalidity

Non-distinctive mark	To demonstrate that the trade mark is/is not devoid of any distinctive character. Such distinctiveness can be assessed only by reference, first, to the goods or services for which registration is sought or the trade mark is registered and, second, to the relevant public's perception of that sign, in the relevant territory.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 3, Non-distinctive trade marks (Article 7(1)(b) EUTMR) Part D, Cancellation, Section 2, Substantive provisions, 3 Absolute Grounds for Invalidity
Acquired distinctiveness	To demonstrate that a mark has acquired a distinctive character in the relevant geographical area regarding the goods or services for which registration is requested or for which the mark is registered, following the use which has been made of it.	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 14, Acquired distinctiveness through use (Article 7(3) EUTMR)
Enhanced distinctiveness	To demonstrate that a mark has obtained enhanced distinctiveness, in the relevant geographical area, as a consequence of the use which has been made of it. The evidence of enhanced distinctiveness acquired through use should also refer to the relevant goods and services.	Part C, Opposition, Section 2, Double Identity and likelihood of confusion, Chapter 5, Distinctiveness of the earlier mark, 2 Assessment of Distinctiveness of the earlier mark, 2.3 Examination of enhanced distinctiveness Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation
Reputation	To demonstrate that a mark is known by a significant part of the public concerned, in the territory in which reputation is claimed, for the relevant goods or services covered by that trade mark.	Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation

Well-known mark	To demonstrate that a mark is well known in the Member State(s) concerned, in the sense in which the words 'well known' are used in Article 6*bis* of the Paris Convention. The mark should be well known in the relevant sector of the public for the particular goods and services.	Part C, Opposition, Section 1, Opposition proceedings, 4.2.4.1 Well-known marks Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), 3 Conditions of application, 3.1 Earlier mark with reputation
Proof of use / genuine use	To demonstrate that within a specific period the proprietor has put the trade mark to genuine use in the Member State(s) in connection with the relevant goods or services in respect of which it is registered. The evidence should consist of indications concerning the place, time, extent and nature of use of the trade mark.	Part C, Opposition, Section 7, Proof of Use

Table 3: REUD proceedings

Claim	**Aim of evidence**	**Cross Reference**
Disclosure	To demonstrate that an earlier design that is identical or produces the same overall impression on the informed user as the contested design has been made available to the public before the date of filing of the application for registration or, if a priority is claimed, the date of priority (Article 7 EUDR).	Design Guidelines, Examination of design invalidity applications, 5.7.1 Disclosure of earlier design
Features of appearance solely dictated by the technical function of the product	To demonstrate that no consideration other than the technical function of the design played a role in designing a given feature or all the features of a design (Article 8(1) EUDR).	Design Guidelines, Examination of design invalidity applications, 5.5.2.2 Appropriate evidence of functionality

2 How to submit evidence

2.1 General requirements and recommendations

According to Article 55(2) EUTMDR on the examination of **written evidence in EUTM proceedings**, any documents or other items of evidence must be contained in an annex to the submission. The submission must also include an index detailing the evidence in the annexes, namely:

- the number of the annex where the item is contained,
- a short description of each item of evidence,
- the number of pages of each document or item (if applicable), and
- the page number of the submission where the document or item is mentioned.

The following is an example of an admissible **index**:

Annex No.	**Description**	**Pages**	**Page where the evidence is mentioned**
Annex 1	Survey 2021	1 - 30	Observations, page 1
Annex 2	Catalogues 2022	31 - 45	Observations, page 5

The annexes must be numbered consecutively and in accordance with the index. The annexes themselves should be named on their first page and have page numbers that continue from one annex to the next. The submission must refer to the number of the annex in accordance with the index (e.g. Annex 1) when it is mentioned in the text.

As regards evidence on **data carriers**, technical specifications are established in 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 (for further information see the Guidelines,Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.4, Data carriers).

Best Practice: in the interests of the parties, the Office and higher instances, the Office recommends the following approach when structuring evidence and submissions to facilitate the processing and handling of the files:

1. the parties should limit their submissions strictly to items of evidence that are relevant to the case and to the ground/argument in question and avoid extraneous or superfluous materials;
2. if documentation is sent in separate batches, each batch should be numbered, have page numbers and show the total number of pages in each batch;
3. even if annexes are submitted at different times in the same proceedings, they should be numbered consecutively to avoid confusion due to repetition of numbering;

4. photographs should be submitted instead of physical specimens (e.g. containers, packaging, etc.) unless the relevant features cannot be reproduced visually;
5. no original documents or items should be sent by mail as the Office will not return any originals but keep them on file (Article 115 EUTMR, Article 76 EUDR);
6. to facilitate scanning, items sent by mail must not be stapled, bound or placed in folders and where items must be sent in duplicate for forwarding to the other party, they should be clearly identified as such;
7. if several trade marks, goods and services or dates are displayed in a single item of evidence, the submission should clearly indicate which is the relevant information for the proceedings in question;
8. if colour is of relevance to the proceedings, the evidence should be submitted in colour (for example, a registration certificate for a mark in colour or evidence of genuine use);
9. if the case involves a range of different earlier marks, grounds, multiple classes, or long lists of goods and services, the party should explain in its submission which issue each item of the evidence supports (e.g. Annexes A-D concern proof of use of the earlier mark 1 for Class 25, or for goods falling under the broad category of clothing in Class 25, Annexes E-F show reputation/well-known character/enhanced distinctiveness of earlier mark 2 for Class 25, Annex G concerns proof of use of earlier mark 3 for the retail sale of clothing in Class 35).

There are no specific legal provisions regarding the format of documents or items of evidence for **REUD proceedings** although the technical specifications established for data carriers in Decision No Ex-22-7 also apply. In any event, the information mentioned above is also recommended for evidence provided in REUD proceedings (see the Guidelines on the Examination of design invalidity applications, paragraph 3.10.2, Facts, evidence and arguments).

2.1.1 Deficiencies

A **deficiency** in **EUTM proceedings** may be raised according to Article 55(3) EUTMDR when:

1. no clear index can be identified;
2. the index does not indicate the number of annexes, a description of each item of evidence or the page number of the submission where the item of evidence is mentioned; or
3. the evidence is not structured in consecutively numbered annexes and/or these are not structured in accordance with the index.

Furthermore, a document or item may not be taken into account where the Office cannot clearly establish to which ground or argument it relates. The relevant decision of the Office will identify items of evidence not taken into account for failing to comply with Article 55 EUTMDR.

For annexes submitted on data carriers, even if the annex complies with the technical specifications of Articles 3 and 4 of Decision No EX-22-7 a deficiency may be raised if the material is illegible.

If a corrected annex is not resubmitted, the original annex is deemed not to have been submitted (see Articles 5 and 6(b) of that decision; for further information on data carriers, see the Guidelines,Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.4, Data carriers).

2.2 Specific requirement in inter partes proceedings

In *inter partes* proceedings, where a communication with annexes is submitted **by post or courier**, the party must submit as many copies of the annexes as there are parties to the proceedings (Article 64 EUTMDR). This also applies to design proceedings (see Examination of design invalidity applications, 3.1 Form of the application).

The Office, however, does not require duplicates when the annexes submitted by post or courier consist of paper documents (such as loose sheets of evidence) that are smaller than or equal to A3 size. This is because these documents are scanned into the electronic file and transmitted to the other party by electronic means of communication. In exceptional cases where the other party is not a user of electronic communication, the Office will produce a paper copy or a copy on a data carrier and forward it by post or courier.

Annexes submitted by post or courier must, however, be submitted in duplicate when:

- the annex consists of **paper documents larger than A3 size;** or
- the annex does **not consist of paper** (e.g. physical items of evidence such as product samples). This also includes evidence on **data carriers** because, although the content of the data carrier is uploaded into the electronic file, a copy is nevertheless required as a safeguard (for further information on data carriers, see the Guidelines,Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.4 Data carriers).

Annexes submitted by **electronic means** do not require duplicates (for further information on the technical requirements for communication by electronic means, see the Guidelines, Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.1 [Communications...] via the User Area (electronic means)).

In *inter partes* proceedings relating to **EUTMs**, where duplicate annexes are required but not provided, the annexes in question will not be considered.

However, in *inter partes* proceedings relating to **REUDs**, the Invalidity Division may invite the party to file a missing duplicate within a specified deadline.

The Office will base its decision only on evidence on which both sides have had an opportunity to submit observations. Therefore, evidence submitted properly will be communicated to the other party and the Office may set a time limit to reply.

2.3 Confidentiality

A party may request, when submitting a document or at a later stage, that all or part of it be kept confidential (as long as no request for an inspection of files is pending). For further information on confidentiality of documents submitted, see the Guidelines:

Time limits	Part A, General rules, Section 1, Means of communication, time limits, paragraph 3.1.6 Confidentiality
Inspection of files	Part E, Register operations, Section 5 Inspection of files, 5.3.1 Parts of the file for which the party concerned expressed a special interest in keeping confidential

3 References to other proceedings

Article 115(3) EUTMR

Article 64(2) EUTMDR

Article 74c EUDR

Decision No EX-25-04 of the Executive Director of the Office of 7 April 2025 on the keeping of files and the inspection of files

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

3.1 Reference to documents or evidence in other proceedings before the Office

Parties may incorporate evidence into proceedings before the Office by referring to documents or evidence submitted in **other proceedings**.

Such references are acceptable when the party clearly identifies the documents referred to. They must indicate the following:

1. the type and, where applicable, number of the proceedings (e.g. opposition, cancellation proceedings, appeal, transfers etc.);
2. the title of the document and, where relevant, the number of the Annex where the document was contained;

3. the number of pages in the document; and
4. the date the document was sent to the Office.

Example of an acceptable reference: 'the statutory declaration that was submitted to the Office on 12/12/2020 as Annex I in opposition proceedings B 123 456, together with exhibits 1 to 8, consisting of 200 pages'.

> **Best practice**: References to submissions and evidence in other cases should be made via **a separate document or separate section at the beginning of the observations**. This ensures visibility and prevents proceedings being unnecessarily delayed. If this recommendation is not followed, the party risks the reference being overlooked. This may lead to reopening and delaying the proceedings.

When the party only makes a general reference to documents or evidence submitted in other proceedings, the Office will invite the party to provide a clear and precise indication of the documents or evidence referred to within a given time limit. If this is not done, the general reference **will not be taken into account**.

A party may refer to all or some of the annexes provided previously on a data carrier, but they must also submit a copy of the annexes with the same content on a data carrier that complies with the **current** technical specifications, as detailed in Decision No EX-22-7.

Material submitted in other proceedings that was not kept in an electronic format may have been destroyed according to Article 115(3) EUTMR and Decision No EX-23-12. In this case, the party referring to such evidence will be invited to submit the previous evidence again with duplicates if necessary (see the Guidelines, Part A, General rules, Section 10, Evidence, paragraph 2.2, Specific requirement in *inter partes* proceedings). If this evidence is resubmitted on a data carrier, it must comply with Decision No EX-22-7. Where the evidence is resubmitted via the User Area, Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means should be followed.

If reference is made to a procedure in a different language, a translation may be necessary if the content of the evidence is not self-explanatory (for further information on the translation of evidence in *inter partes* proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 4.3.3, Translation of supporting documents other than observations and the Design Guidelines, Examination of design invalidity applications, 3.10.2 Facts, evidence and arguments).

3.2 References to national office and court decisions, and decisions of the Office

Parties may refer to findings in previous decisions of national offices and courts, or to previous Office decisions.

When a party refers to **national office or court decisions**, the Office is not bound by those decisions. Nevertheless, national courts have a thorough knowledge of the specific characteristics of their Member State, in particular, the marketplace reality in

which goods and services are marketed and the customer perception of signs, and this may be relevant for the assessment made by the Office. Maximising the relevance of these decisions before the Office will require sufficient information, in particular, about the facts and evidence on which the decision was based as well as an explanation as to why the party believes the national decision is relevant to the outcome of the case.

When the party refers to **decisions of the Office (EUIPO)**, it should explain in detail why it believes that the cases are comparable and how the previous decision may influence the outcome (e.g. same legal issue, same or comparable signs, same parties). In any event, the Office is not bound to come to the same conclusion as in its previous decision. It must examine each case on its own merits. Regarding the obligations to state reasons, see the Guidelines,Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 1, Adequate reasoning). For additional information on references to national decisions or decisions of the Office, see:

General principles of EU Law	Part A, General rules, Section 2, General principles to be respected in the proceedings, paragraph 3, Other general principles of EU law
Acquired distinctiveness	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 14 Acquired distinctiveness through use (Article 7(3) EUTMR), paragraph 8.1.5, Prior registrations and acquired distinctiveness
Likelihood of confusion	Part C, Opposition, Section 2, Double identity and likelihood of confusion, Chapter 6, Other factors, paragraph 5, Prior decisions by EU or national authorities involving conflicts between the same (or similar) trade marks
Reputation	Part C, Opposition, Section 5, Trade marks with reputation (Article 8(5) EUTMR), paragraph 3.1.4.4, Means of evidence

4 Specific means of evidence

4.1 Online evidence

Considering the development of information technologies and the growing importance of e-commerce, social media and other online platforms in business, evidence originating from the internet is accepted as a valid means of evidence.

Where internet evidence is submitted in EUTM proceedings, most claims require the party to show online interaction rather than mere internet presence. This can be done by providing data related to the geographic distribution of website visitors, pages viewed during website visits, duration of website visits and completed transactions.

Mere reference to a website

The nature of the internet can make it difficult to establish the content available there and the date or period this content was made available to the public because:

- not all web pages mention when they were published;
- when updated, they do not provide an archive of the material previously displayed or a record that accurately indicates what was published on a given date;
- web pages may be live when evidence is submitted but disabled at a later date when the Office needs to refer to them.

Therefore, a mere reference to a website (even if by a direct hyperlink) **is not valid** . However, the Office accepts a reference to a database recognised by the Office for substantiation purposes in inter-partes trade mark proceedings (seePart C, Opposition, Section 1, Opposition proceedings, 4.2 Substantiation).

Date of the online evidence

The **date of the information** is to be shown, for example, when it was posted on social media or when the evidence was printed.

The Office can establish the date of the evidence from the internet if:

- the website provides time-stamp information relating to the history of modifications applied to a file or web page (as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs);
- a web page screenshot bears a given date (20/10/2021, T-823/19, Bobby pins, EU:T:2021:718, § 26, 32 and 42); or
- information relating to a web page's updates is available from an internet archiving service, such as the Wayback Machine (19/11/2014, T-344/13, FUNNY BANDS / FUNNY BANDS, EU:T:2014:974), but it is recommended that archive printouts are corroborated by other evidence from alternative sources.

Example:

Case No	Comment

19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN (fig), EU:T:2022:654, § 80 and 82-84	Evidence of the presence and promotion of a brand on the internet may play a role in assessing distinctive character acquired through use of a trade mark. In that case, the proprietor of the mark at issue must demonstrate that the relevant websites and, in particular, the web pages on which that mark was displayed, promoted or marketed, target or are consulted by a significant part of the relevant public in the Member States in which the mark is, *ab initio*, devoid of inherent distinctiveness. To prove the intensity of use of the trade mark on the websites in question, the mark's proprietor must demonstrate, for example, by submitting a traffic analysis report for that website during the relevant period, that a significant number of internet users in the Member State concerned, consulted or interacted with the content of the website in question. For instance, data relating to the number of visits to that website, comments or other forms of web user interactions in the Member State may be taken into consideration. In addition, evidence showing that search engine and social network algorithms display non-sponsored search results which, for search terms describing the trade mark at issue, systematically return the trade mark proprietor's goods, may also be relevant. On the other hand, the mere fact that a website on which the mark at issue was promoted is accessible in certain Member States is not sufficient to demonstrate that a significant part of the relevant public in those Member States has been exposed to that mark.

4.1.1 Printouts from websites

In principle, extracts from **editable websites**, such as the online encyclopedia Wikipedia or similar sources, cannot be considered to be probative on their own. This is because their content may be amended at any time and, in certain cases, by any visitor, even anonymously (23/09/2020, T-738/19, Wi-Fi Powered by The Cloud (fig.), EU:T:2020:441, § 38-39; 16/10/2018, T-548/17, ANOKHI (fig.) / Kipling (fig.) et al., EU:T:2018:686, § 131, and the case-law cited therein).

Evidence of this kind should be corroborated with information from other sources, such as scientific studies, extracts from technical publications, press articles or statements from professionals, traders and consumers (see 01/02/2023, T-319/22, aquamation, EU:T:2023:30, § 28, and the case law cited therein).

Depending on what must be proven, printouts or screenshots from **non-editable websites** will also need to be supported by corroborating evidence in particular situations. For example, when the evidence's accuracy is contested by the other party, where relevant data is missing, or where evidence is drawn from non-editable websites owned by the interested party or does not seem reliable for other reasons.

However, when the extracts from websites are used to prove the disclosure of designs, they can be sufficient to the extent that they show when the content was published and that it was made publicly available.

4.1.2 Website analytics reports

Website analytics reports showing the website traffic may be a useful way to show that the website has been visited and by whom it has been visited (see 19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2022:654, § 80, 82). The analytics reports may contain information such as page views, a page hit, the duration of page visits, and the geographical region of the user. This information may be relevant, for example, when proving genuine use, acquired distinctiveness or reputation.

Examples:

Case No	**Comment**
14/12/2017, T-304/16, BET365, EU:T:2017:912, § 66	A high ranking in terms of visitors can help to establish that a mark, which is repeated in the name of the party's website (or otherwise prominently appears on such website), has acquired distinctive character through use in the countries concerned.
19/11/2014, T-344/13, FUNNY BANDS / FUNNY BANDS, EU:T:2014:974, § 29	The intensity of the alleged use of the rights relied on may be shown by, inter alia, a certain number of visits to the site, the emails received via the site or the volume of business generated.

4.1.3 Social media

Social media is understood as websites and applications that facilitate social networking. Evidence from social media can be used to show the relevant public's recognition of the mark or its use or to show the disclosure of a design.

Social media may be an independent source of evidence for information created by the platforms themselves (e.g. the account's date of creation or information on the modification of the account/page name), which cannot be controlled or altered by the owner of a page/account (24/10/2017, T-202/16, coffee inn (fig.) / coffee in (fig.) et al., EU:T:2017:750, § 51).

Content created by users can be changed, however, and it is recommended to:

- submit a printout or a screenshot;
- ensure that the evidence makes reference to the relevant trade mark and goods and services, or that it displays a clear image of the design and indicates the relevant date and disclosure source;
- ensure that the post's publication date and URL address is shown;
- include file analytic reports (see paragraph 4.1.2); and
- provide information on the purpose and the social media website's main characteristics.

Regarding references to influencer marketing, it is recommended to submit:

- information on the influencer and followers (e.g. the geographical location of the influencer/followers and related advertising expenditure); or
- the results of a followers campaign (e.g. the sales volume on a country-by-country basis made via a dedicated influencer URL address or code).

For online advertising, see paragraph 4.8.1.

4.2 Affidavits

Overview

Statements in writing sworn, affirmed or having a similar effect under the law of the Member State in which the statement is drawn up (affidavits) are valid means of evidence (Article 97(1)(f) EUTMR, Article 65(1)(f) EUDR).

Before the Office, their evidential value is assessed in light of EU law, not the laws of a Member State (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 33; 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 53).

The Office will assess the probative value of the information the affidavit contains, together with any other supporting evidence, considering:

- the document's origin, including the capacity of the person giving the evidence (see paragraphs4.2.1 and 4.2.2);
- the circumstances of its preparation;
- to whom it is addressed;
- whether the content makes sense and seems reliable; and
- the relevance of the contents of the statement to the particular case.

(07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42; 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 50; 18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 26).

Affidavits containing detailed and specific information and that are supported by other evidence have a higher probative value than general and abstract statements.

The Office makes a distinction between affidavits coming from the party or the sphere of influence of the party (e.g. employees) and affidavits from an independent source. That said, an affidavit must be considered under the circumstances of the particular case and its reliability cannot be automatically denied, even if drawn up by the interested parties or their employees (16/12/2020, T-3/20, Canoleum / Marmoleum, EU:T:2020:606, § 51-52; 28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 30; 05/10/2022, T-429/21, ALDIANO, EU:T:2022:601, §52).

The fact that affidavits from different sources are made according to a **predetermined draft provided by the interested party** does not in itself affect their probative value (16/09/2013, T-200/10, Avery Dennison, EU:T:2013:467, § 73).

The relevance of the contents of the affidavit to the particular case contributes to its probative value. For example, the affidavit will be less effective if it only generally refers to 'the trade marks of the party' instead of to the specific mark(s) in question (see for acquired distinctiveness 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 83-84; 04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230).

4.2.1 Affidavits by the party or its employees

Affidavits coming from the sphere of the interested party are generally given less weight because the perception of a party involved in the case may be affected by personal interests in the matter.

Consequently, this evidence must be treated as indicative and should be corroborated by other evidence (21/11/2012, T-338/11, PHOTOS.COM, EU:T:2012:614, § 51; 28/05/2020, T-615/18, D (fig.) / D (fig.) et al., EU:T:2020:223, § 61; 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 51; 18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 29).

An assessment should be made, therefore, of whether the content of the affidavit is sufficiently supported by the other evidence (or vice versa).

4.2.2 Affidavits made by the lawyer representing the party

An affidavit of a lawyer constitutes, in itself, sound evidence of the information contained therein, if it is clear, consistent and conclusive and there is no doubt about its authenticity (16/12/2020, T-3/20, Canoleum / Marmoleum, EU:T:2020:606, § 55-56, 58). This is because a lawyer is a legal professional required to follow a code of ethics and uphold moral standards, which prohibits them, inter alia, from deliberately misleading the authorities and, in particular, the court. Furthermore, if they were guilty of giving a solemnly affirmed statement that was false, that would not only make them subject to criminal sanctions, but would also jeopardise their professional reputation and cast serious doubts on their integrity.

4.2.2 Affidavits made by third parties

Affidavits from **independent third parties** have more probative value than those from entities that have links with the interested party (19/01/2011, R 1595/2008-2, FINCONSUM ESTABLECIMIENTO FINANCIERO DE CREDITO / FINCONSUMO (fig.), § 31).

Evidence from suppliers or distributors of the party concerned generally have less weight, but their degree of independence of the latter will heavily influence the probative value (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 54-56).

Example:

Case No	Comment
19/10/2022, T-275/21, chequerboard pattern (fig), EU:T:2022:654, § 99	'It should be recalled that sworn statements, particularly from chambers of commerce and industry, other professional associations or independent bodies, or from public authorities, relating to the relevant public's perception of a trade mark, constitute "direct" evidence of the acquisition of distinctive character through use, in particular where they emanate from independent sources and their content is sound and reliable (see, to that effect, judgments of 7 June 2005, Lidl Stiftung v OHIM – REWE-Zentral (Salvita), T-303/03, EU:T:2005:200, paragraph 42; of 28 October 2009, BCS v OHIM – Deere (Combination of the colours green and yellow), T-137/08, EU:T:2009:417, paragraphs 54 to 56; and of 29 January 2013, Manual tile-cutting machine, T-25/11, not published, EU:T:2013:40, paragraphs 74 and 75).'

4.3 Opinion polls and market surveys

Opinion polls and market surveys ('the surveys') constitute primary evidence to show the recognition of a trade mark among consumers. They are, in particular, used in proceedings concerning acquired distinctiveness, enhanced distinctiveness or reputation of a trade mark.

When assesssing the probative value of the surveys, the Office will consider the:

- survey provider;
- target public, the sample size and representation of the results;

- method used, the set of questions, and the circumstances under which the survey was carried out; and
- dates.

4.3.1 Survey provider

The party must submit information that allows the Office to determine the provider's expertise and impartiality, since these have an impact on the probative value.

The survey provider's choice is up to the parties but the Office **recommends** using independent research institutes, companies or other independent experts who have the relevant knowledge and experience to properly understand the survey's purpose, reliably structure and conduct the survey, and to interpret the results.

Example:

Case No	**Comment**
27/03/2014, R0540/2013-2, Shape of a bottle (3D) § 49	Serious doubts were cast on the surveys' source, reliability and independent nature owing to the use of the company logo of the well-known GfK company. The surveys did not seem to be carried out by the company, as the applicant argued, but rather by a person who, according to their own declaration, was only 'a former director of GfK'. It was not clear how a former GfK employee could be authorised to use that company's logo on every page of the surveys when they were now 'an independent market research consultant'.

4.3.2 Target public, sample size and representativeness of the results

The target public or sample size must be representative of the entire relevant public and must be selected randomly (29/01/2013, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 88). Therefore, the criteria applied for selecting the sample are decisive for establishing whether it is representative and whether the survey is valid.

The party must submit information that allows the Office to assess whether the sample chosen was representative (09/09/2020, T-187/19, Colour Purple -2587C (col), EU:T:2020:405, § 101). The number and profile (sex, age, occupation and background) of the sample must be submitted, to allow the Office to evaluate whether the results of the survey are representative of the relevant consumers of the goods in question (general public, specific groups of consumers within the general public, or professionals).

A survey will lack probative value where there are no checks on who replied to the questions (21/03/2018, R 1852/2017-4, V V-WHEELS (fig.) / VOLVO (fig.) et al., § 49). In such cases, the real profile of the sample cannot be determined. Additionally, the results of the survey must show whether the percentages reflected in the results correspond to the total number of persons questioned or only to those who replied.

A representative sample does not necessarily require a large number of interviewees. It depends on the type of relevant consumer concerned (01/06/2011, R 1345/2010-1, Fukato Fukato (FIG. MARK) / DEVICE OF A SQUARE (FIG. MARK) et al., § 58). The survey should explain how the sample size was chosen for the relevant consumer. There is a particular danger that small samples may be unreliable for general-use goods that target the general public (09/09/2020, T-187/19, Colour Purple -2587C (col), EU:T:2020:405, § 100-101). However, small samples could be representative for certain groups of professionals or more specialised goods and services.

Examples:

Case No	Comment
15/03/2011, R 1191/2010-4, Más Kolombiana…y qué más!! / COLOMBIANA LA NUESTRA (fig), § 23.	A survey was submitted to demonstrate that the earlier sign was well-known to the Spanish public for aerated waters. However, the interviewees were carefully selected on the basis of their origin, that is, Colombians resident in Spain. This is only a very small part of the population living in Spain, and the information was inconclusive.
01/06/2011, R1345/2010-1, Fukato Fukato (fig.) / DEVICE OF A SQUARE (fig.) et al., § 58.	In principle, samples of 1 000-2 000 interviewees are considered sufficient, provided they are representative of the type of consumer concerned. The opponent's opinion poll was based on a sample of 500 interviewees. It was found insufficient considering the services for which reputation was claimed (among others, scientific and technological services).

09/09/2020, T-187/19, Colour Purple -2587C (col), EU:T:2020:405, § 100-101.	The patient surveys were only carried out in 10 EU Member States in relation to pharmaceutical preparations and inhalers. Only 50-200 patients were interviewed in each of the Member States. In light of the market shares held by the applicant in each Member State, the numbers of patients interviewed appeared to be much too low to be reliable. The same is true with regard to the professional public, given that less than 0.1 % of general practitioners in the Member States participated in the surveys.

4.3.3 Method used, form of questions and circumstances

The method and circumstances under which the survey was carried out (e.g. face to face, over the phone, on the internet) impact its probative value (12/07/2006, T-277/04, Vitacoat, EU:T:2006:202, § 38).

The probative value of surveys also heavily depends on how the questions are formulated (24/10/2018, T-261/17, SALOSPIR 500 mg (fig.) / Aspirin et al., EU:T:2018:710, § 68). The questions must be formulated correctly in an open and unassisted manner so they are neutral and representative. They must not lead the participant to a certain answer (13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 79).

The party must submit the complete list of questions included in the questionnaire to allow the Office to determine if open and unassisted questions were used (08/04/2011, R 0925/2010-2, 1 CLEAN! 2 FRESH! 3 STRONG! (fig.) / FRESH & CLEAN et al. § 27). The party must also show how the questions were asked and ordered.

The survey must be carried out in a manner that considers the objective circumstances in which the marks at issue are present, or may be present, on the market (24/10/2018, T-261/17, SALOSPIR 500 mg (fig.) / Aspirin et al., EU:T:2018:710, § 63-64). The aim is to show the target public's spontaneous association or recognition of the mark in question as seen inthe examples below.

The probative value of the survey will be lesser where it cannot be ruled out that an unobjective formulation of questions facilitated the association of that mark with a particular undertaking in the minds of those questioned (19/06/2019, T-307/17, DEVICE OF THREE PARALLEL STRIPES (fig.), EU:T:2019:427, § 131) or when the sequencing of the questions leads to unusual speculation on the core issue (02/03/2022, T-125/21, Eurobic/ BANCO BiG BANCO DE INVESTIMENTO GLOBAL (fig.) et al., EU:T:2022:102, § 42-45).

For further guidance on structuring surveys and wording questions, see the Common Practice on Evidence in Trade Mark Appeal Proceedings: Filing, Structure and Presentation of Evidence, and the Treatment of Confidential Evidence (CP 12) (on

pages 36-38). CP12 recommends a three-step test for determining the respondents' ability to spontaneously recognise a test object as coming from one specific commercial source.

Examples:

Case No	Comment
02/03/2022, T-125/21, Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL (fig.) et al., EU:T:2022:102, § 42-45.	The interviewees were informed in the earlier questions that the 'Banco Bic' bank had changed its trade mark to 'EuroBic' and, in response to that information, they were asked to choose from among three options. That question and the seven subsequent questions raised, in a leading manner, the question of the link between the trade marks. It is only later in the survey that the interviewees were asked to express their views for the first time on the link between the marks 'Banco BiG' and 'EUROBIC'. It was held that the persons questioned could have been clearly influenced by the eight preceding questions, and by the approach seeking to support, initially, the link between 'EuroBic' and 'Banco BIC' then influence the answers to the questions on comparing the signs 'EUROBIC' and 'BANCO BiG'.
08/04/2011, R 925/2010-2, 1 CLEAN! 2 FRESH! 3 STRONG! (fig.) / FRESH & CLEAN et al., § 27.	This case shows thatsurvey participants' levels of prompted and spontaneous recognition vary. According to the extracts from the 2001 survey in Italy, although the level of 'prompted recognition' stood at 86 %, the rate of 'spontaneous recognition' was only 56 %. This survey failed on other grounds, as there was no indication of the questions put to the target public. This made it impossible to determine whether the questions were genuinely open and unassisted. Further, it failed to state for which goods the trade mark was known.

28/05/2020, T-677/18, GULLÓN TWINS COOKIE SANDWICH (fig.) / OREO et al., EU:T:2020:229, § 92-93.	The survey used a representation of the three-dimensional biscuit in which the verbal element 'Oreo' that usually appears in its centre had been removed. The Court found that the removal of the name for the purpose of the survey was precisely the reason why the results of the survey were more reliable for proving the recognition of the three-dimensional shape. According to the Court, it was appropriate that the survey did not indicate that the three-dimensional shape was a trade mark, precisely to verify whether, when encountering that image, the public identified a specific commercial origin, and therefore identified it as a trade mark.

4.3.4 Dates

The survey must indicate the period in which it was conducted. This period must be relevant for the proceedings. For example, if the survey intends to show distinctiveness acquired through use at the date of filing of the EUTM application, the probative value is likely to vary depending on the proximity to the relevant filing date or priority date (12/07/2006, T-277/04, Vitacoat, EU:T:2006:202, § 38-39).

4.4 Audits

Audits of a party's undertaking usually comprise data on financial results, sales volumes, turnover and profits. They may provide useful information about the intensity of a mark's use. However, such evidence will only be pertinent if it specifically refers to the goods or services traded under the mark in question, rather than to the party's activities in general.

Audits may be carried out on the initiative of the party itself or be required by company law or financial regulations. In the former case, the same rules as for surveys apply. The status of the entity conducting the audit and the reliability of the applied method will be decisive for determining its credibility. The probative value of official audits and inspections is as a rule much higher, since they are usually conducted by a state authority or recognised body of auditors on the basis of generally accepted standards and rules.

4.5 Annual reports on economic results and company profiles

This type of evidence includes all kinds of internal publications containing information about the history, activities and prospects of the party's company, or more detailed figures about turnover, sales and advertising.

Usually, evidence originating from the party concerned is mainly intended to promote its image. Therefore, the relevant information should be treated with caution, especially if it mainly consists of estimates and subjective evaluations.

However, the probative value may be enhanced where publications are circulated to clients and other interested parties, and contain objectively verifiable information. This is the case, for example, when they have been compiled or revised by independent auditors (as is often the case with annual reports).

4.6 Invoices and other commercial documents

All kinds of commercial documents may be grouped under this heading, such as invoices, order forms, delivery notes, distribution and sponsoring contracts, samples of correspondence with clients, suppliers or associates. Documents of this kind may provide a variety of information on use of a mark (e.g. intensity of use, geographical extent and duration of use). Such evidence can be primary evidence (e.g. to prove that a mark is genuinely used) or secondary evidence (e.g. an indication of the degree of recognition of a mark).

If these documents include sensitive commercial information, the party can either redact specific data in the document or claim confidentiality of the entire document upon a reasoned request (for further information on confidentiality, see the Guidelines, Part A, General rules, Section 1, Means of communication, Time limits, 3.1.6 Confidentiality).

Invoices are one of the most common means of evidence in EUTM proceedings concerning proof of use (for further information on use of trade marks, see the Guidelines, Part C, Opposition, Section 7, Proof of use, 6.1 Use as a trade mark, and for general considerations on use, seePart C, Opposition, Section 7, Proof of use).

They must be carefully assessed in conjunction with the evidence as a whole. Invoices must refer to the particulars that are relevant for the proceedings to have probative value (e.g. who issued the invoice, to whom it was addressed, the goods or services, representation of the mark in question and date when they were issued).

Codes used in invoices

The invoices should allow a connection to be made between the sign used on the invoiced goods or services. Invoices may not explicitly list the goods or services or the trade mark representation, but they can allow for these to be deduced by including product numbers or codes. The party must explain such codes and numbers. Cross referencing invoices with catalogues or other depictions of the goods, such as

packaging, can allow a clear link to be made with the sign in question (27/04/2022, T-181/21, SmartThinQ (fig.) / SMARTTHING (fig.), EU:T:2022:247, § 91; 22/03/2023, T-408/22, SEVEN SEVEN 7 (fig.) / Seven, EU:T:2023:157, § 29-31, 33).

These pieces of evidence assessed in combination allow conclusions to be made, such as which goods or services were sold under which trade mark, in what quantities and when.

Best Practice: When submitting invoices as evidence, parties should highlight the goods and services which are relevant for the proceedings to ensure that they can be correctly identified. This is of particular importance when the invoices may include other trade marks or goods and services which are not relevant to the proceedings.

Exemplary character - extrapolating

Invoices relate to individual transactions but the full context must be considered. Although selected invoices will not reflect the entire sales of a company, they can, however, indicate that more sales took place during the relevant period (07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773, § 43). For example, if there are gaps in the sequential numbering of invoices provided, this demonstrates other invoices were emitted that might help in corroborating a party's statements, or other accounting information, as to volumes or continuity of sales.

Addressee

A range of invoices dated in the relevant period helps define the time span and frequency of sales, and together with the addressee information, provides important indications on geographical extent of use. When redacting information, a party must ensure that the addressee information still clearly indicates the relevant territory (whether a country, region or city, etc.).

Company name and trade mark representation

In some invoices there may be clear use of the trade mark in question, while in others a company name may be used or both. For example, where the trade mark is systematically placed in invoice headers as the first element above the company name, use of the sign goes beyond merely identifying the company and refers to the commercial origin of the services provided. The layout of the invoices therefore allows a close connection to be made between the sign and the invoiced services (03/10/2019, T-666/18, ad pepper (fig.), EU:T:2019:720, § 82). The use of a sign as a company name does not exclude its use as a trade mark (26/04/2023, T-546/21, R.T.S. ROCHEM Technical Services (fig.) / ROCHEM MARINE (fig.), EU:T:2023:221, § 61).

4.7 Certifications, rankings and awards

Certifications attesting the quality or other characteristics, rankings and awards granted by public authorities or official institutions – such as chambers of commerce and industry, professional, sporting or cultural associations and societies and consumer organisations – can be used as evidence.

These specialised sources are usually independent of the parties. They attest facts in the course of their official tasks. Therefore, the reliability of such evidence is generally high.

Conversely, prizes and awards offered by unknown entities, or on the basis of unspecified or subjective criteria, should be given less weight.

The probative value also depends on the content of the documents.

Examples:

The fact that the party is a holder of an ISO 9001 quality certificate or a royal warrant does not automatically mean that the sign is known to the public. It only means that the party's goods meet certain quality or technical standards or that it is a supplier to a royal house.

Case No	Comment
25/01/2011, R 0907/2009-2, O2PLS / O2 et al.	The many brand awards won by the mark were, together with the huge investment in advertising and the number of articles published in different publications, considered an important part of the evidence for reputation (para. 9(iii) and para. 27).
2023/01/18, R 0218/2020-4, Aalto / Aalto ps et al.	Undoubtedly, the opponent has, according to the evidence submitted, received high rankings and accolades worldwide in relation to its wines. For instance, the 'AALTO PS 2013' wine was ranked among the top 5 *grandes pagos de España* in 2015 (para. 75). However, the fact the 'AALTO' wines received very positive acclaim by professionals in the field and may even be among the highest quality wines in the world does not necessarily mean that the earlier marks have achieved recognition among a significant part of the … public (para. 76).

4.8 Promotional materials and publications

4.8.1 Catalogues, advertisements and marketing campaigns

A party may submit promotional materials, including:

- price lists and offers;
- advertising reach and spend;
- material related to online shops;

- promotions on company websites;
- website archives;
- television spots and video/audio files;
- business correspondence and business cards; and
- materials from fairs and conferences.

Advertising material often supports facts indicated by other items of evidence.

It is important to have indications on the impact of the advertising. This may be shown by reference to the amount of promotional expenditure, the nature of the promotional strategy, and the media used.

For example, when demonstrating recognition of a sign, advertising on a nationwide television channel or in a famous periodical should be given more weight than regional or local campaigns. High audience or circulation figures will help to establish the reputation of the trade mark. Likewise, sponsoring prestigious sporting or cultural events may be a further indication of intensive promotion. This is because the considerable investment this involves is mainly due to the size or nature of the audience reached.

Example:

Case No	**Comment**
19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2022:654, § 64	evidence relating to trade mark advertising campaigns in the press, on the radio or on television, as well as excerpts from catalogues and brochures containing images of goods bearing that mark, may constitute indications that the contested mark has acquired distinctive character through use (see 14/12/2017, T-304/16, BET365, EU:T:2017:912, § 71).

As regards online advertising efforts, they may also be used as evidence by providing data concerning ‘paid search’ and ‘paid social advertising’. These refer to the practice of paying for an advertisement space in search engines or on social media platforms.

For further information on advertising evidence see:

Acquired distinctiveness	Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Acquired distinctiveness through use (Article 7(3) EUTMR), 8.1.2 Market share and 8.1.3 Advertising and turnover expenses
Reputation	Part C, Opposition, Section 5, Trade marks with reputation (Article 8(5) EUTMR), 3.1.3.6 Promotional activities

Proof of use	Part C, Opposition, Section 7, Proof of use, 6.1.2.5 Use in advertising

4.8.2 Publications

A party may submit publications, including:

- press notes;
- newspapers;
- magazines;
- printed materials;
- extracts from guides, books, encyclopedias, dictionaries or scientific papers.

In EUTM proceedings, the probative value of publications to show the success of the relevant mark depends on whether they are merely promotional or are the result of independent, objective research. If articles appear in prestigious publications with rigorous quality standards or are written by independent professionals, they may have a high probative value.

Case No	**Comment**
16/12/2010, T-345/08 & T-357/08, Botolist /Botocyl, confirmed 10/05/2012, C-100/11 P, § 54	The very existence of articles in a scientific publication or the general-interest press constitutes a relevant factor in establishing the reputation of the products marketed under the trade mark BOTOX among the general public, irrespective of the positive or negative content of those articles.

10/03/2011, R 0555/2009-2, BACI MILANO (fig.) / BACI & ABBRACCI, § 35	The earlier trade mark's reputation on Italy was proved by the copious documentation the opponent submitted. This included, inter alia, an article from Economy revealing that in 2005 the 'BACI & ABBRACCI' trade mark was one of the 15 most counterfeited fashion brands in the world; an article published in Il Tempo on 05/08/2005, in which the 'BACI & ABBRACCI' trade mark is mentioned alongside others – including Dolce & Gabbana, Armani, Lacoste and Puma – as being targeted by counterfeiters; an article published in Fashion on 15/06/2006, in which the trade mark is defined as 'a true market phenomenon'; publicity campaigns from 2004 to 2007, with testimonials from entertainment and sports celebrities; and a market survey conducted by the renowned independent agency Doxa in September 2007, from which it emerges that the trade mark is 'top of mind' in the fashion sector for 0.6 % of the Italian public.
08/07/2020, T-533/19, sflooring (fig.) / T-flooring, EU:T:2020:323, § 51	The affixing of a trade mark to a magazine, periodical, review, journal or catalogue is, in principle, capable of constituting 'valid use of the sign' as a trade mark for the goods and services designated by that mark if the content of the publications confirms use of the sign for the goods and services it covers (05/02/2020, T-44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 67).

Where genuine use is being demonstrated and the scale of use is not the essence, different criteria might apply and even less famous or prestigious publications may be useful. Likewise, in design invalidity proceedings, almost all kinds of publications are a suitable means of proving disclosure of a prior design (see the Design Guidelines, Examination of design invalidity applications, Section 5 The different Grounds for Invalidity, paragraph 5.7.1.2 Establishing the event of disclosure).

4.9 Oral evidence

Oral evidence refers to evidence taken at oral proceedings, such as hearing the oral evidence of parties, witnesses or experts. For more information on oral proceedings,

see the GuidelinesPart A, General rules, Section 2, General principles to be respected in the proceedings, 4 Oral proceedings.

Only in exceptional cases will the Office decide to hear oral evidence. This is because oral evidence is not normally necessary for the parties to present their legal and factual arguments effectively. Moreover, the cumbersome nature of the procedure can unjustifiably lengthen proceedings and increase costs significantly (15/12/2022, R 1613/2019-G, Iceland (fig.), where the Office heard witness and expert evidence).

Where the Office decides to hear witnesses or experts, it will bear the costs. However, where the parties request oral evidence, they will bear the costs.

Neither Article 97 EUTMR and Article 51 EUTMDR nor Article 64 EUDR and Article 42 EUDIR impose an obligation on the Office to summon witnesses to oral proceedings where requested by either party (14/06/2021, T-512/20, Protective covers covers for computer hardware, EU:T:2021:359, § 31-34).

Where a party requests oral proceedings, the requester must explain why the oral testimonies would be more apt to attest the facts alleged or why it was not able to provide those testimonies in writing or in any other form (18/01/2018, T-178/17, HYALSTYLE, EU:T:2018:18, § 15-24).

The Office will inform the parties about hearing of a witness or expert before the Office, so they can attend and pose questions to the witness or expert.

The probative value and reliability of the oral evidence given by witnesses and parties can be assessed in broadly the same way as affidavits.

4.10 Commissioning of expert opinions by the Office

Article 52 EUTMDR, Article 97 EUTMR Articles 43 and 44 EUDIR

The Office does not often commission an expert opinion because it can usually decide matters based on the evidence on file (see as exceptional cases 21/09/2011, R 1105/2010-5, FLUGBÖRSE, where the Office commissioned an expert opinion on the meaning of the word ‘Flugbörse’ on a certain date in the past, and 25/02/2021, R 0696/2018-5, QUESO Y TORTA DE LA SERENA (fig.) / Torta del Casar et al., where the Office commissioned an expert opinion on the generic character of the term ‘Torta’). Moreover, expert opinions may involve substantial costs and lengthen the proceedings.

The commissioning of expert opinions by the Office under Article 52 EUTMDR and Article 44 EUDIR (‘commissioned expert opinions’) is different from expert opinions that a party may submit on its behalf in proceedings and from experts to be summoned under Article 51 EUTMDR and Article 43 EUDIR (15/12/2022, R 1613/2019-G, Iceland (fig.), where experts were heard as witnesses).

Commissioned expert opinions may be written or oral. If delivered orally, the practice described in paragraph 4.9 Oral evidence applies.

If a party requests the Office to commission an expert opinion, the Office will assess:

- whether or not to commission an expert opinion;
- who to appoint as expert; and
- what form the opinion should take.

The Office does not maintain a list of experts.

If the Office decides to commission an expert opinion, under Article 52(2) EUTMDR and Article 44(2) EUDIR, the invitation to the expert includes:

- a precise description of their task;
- the deadline for submitting their opinion;
- the names of the parties to the proceedings;
- details of any costs the Office will reimburse.

The commissioned expert opinion must be submitted in the language of the proceedings or accompanied by a translation into that language. A copy of the written opinion, and of the translation if needed, must be forwarded to the parties.

The parties can object to a commissioned expert on the grounds of incompetence, a conflict of interest (because the expert was previously involved in the dispute as a representative of one of the parties or in taking a decision at any stage) or because of partiality. If a party objects to the expert, the Office will rule on the objection.

4.11 Inspections in situ carried out by the Office

The Office almost never has to inspect items outside its premises. Only in very exceptional circumstances will the Office carry out an inspection in situ under Article 51(1) EUTMDR and Article 43(1) EUDIR, for example at the premises of a party.

If the Office decides to carry out an inspection, it will take an interim decision, stating the relevant facts to be proved, the date, time and place of the inspection.

The date fixed for the inspection must allow the party concerned sufficient time to prepare for it. If the inspection cannot take place for some reason, the proceedings will continue based on the evidence on file.

5 Belated evidence in *inter partes* proceedings

Article 95(2) EUTMR, Article 8(5) EUTMDR, Article 10(7) EUTMDR, Article 19(1) and (2) EUTMDR Article 63(2) EUDR

Parties to proceedings must submit their observations within the time limits laid down in the EU trade mark and European Union design regulations or within those

established by the Office (see the GuidelinesPart A, General rules, Section 1, Means of communication, time limits, 4 Time limits specified by the Office).

The Office may disregard facts or evidence that are not submitted in due time. The Office has broad discretion in this regard (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 43; 05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 16). Therefore, there is no guarantee that the Office will take belated facts and evidence into account.

> **Best practice:** if the party knows that it will not be able to submit all its evidence within the time limit set by the Office, it should request an extension of the time limit rather than sending part of the evidence late (see the GuidelinesPart A, General rules, Section 1, Means of communication, time limits, 4.3 Extension of time limits).

Guidance in particular proceedings can be found here:

Opposition proceedings: substantiation	Part C, Opposition, Section 1, Opposition proceedings, 4.2.6 Facts and evidence submitted after the substantiation time limit
Belated proof of use	Part C, Section 1, Opposition proceedings, 5.3.1. Time limit for providing proof of use
Trade mark invalidity and revocation proceedings	Part D, Section 1, Cancellation Proceedings, 2 Applications for Cancellation and 3 Adversarial stage
Design invalidity proceedings	Design Guidelines, Examination of design invalidity applications, Section 2, Introduction – General Principles Applying to Invalidity Proceedings, 2.4 compliance with time limits

The concept of ‘belated evidence’ requires:

- a time limit to have been set and to have been missed, and;
- the evidence to be submitted after the expiry of this time limit (‘late’).

Where no time limit was missed, paragraphs 5.1-5.2 do not apply.

5.1 Distinction between supplementary and new facts or evidence

If a party provides facts or evidence outside the time limit, a distinction is made between:

- **entirely new facts or evidence**, meaning there is no link to facts and evidence that were provided on time; or

- **supplementary facts or evidence**, meaning the party submitted facts or evidence on time and later supplements them (e.g. to rebut the argument of the other party in inter partes proceedings or to overcome arguments of the Office) 19/01/2022, T-76/21, Pomodoro, EU:T:2022:16, § 40.

The Office does not accept entirely new facts or evidence in **inter partes proceedings**. The acceptance of such belated evidence would render time limits ineffective. There would be no incentive for parties to meet a deadline (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 48; 19/01/2022, T-76/21, Pomodoro, EU:T:2022:16, § 37).

> **Best practice**: if a time limit has been missed in EUTM inter partes proceedings and entirely new evidence is submitted, the party should consider requesting continuation of proceedings instead (Part A, General rules, Section 1, Means of communication, time limits, 4.4 Continuation of proceedings).

However, the Office may accept supplementary facts or evidence exercising its power of discretion (see paragraph 5.2).

> **Best practice:** the party submitting late facts or evidence must provide arguments why such facts or evidence are only supplementary (not entirely new) and may therefore be accepted. It should establish a concrete link by indicating to which previously submitted facts or evidence the supplementary evidence relates to, for example, by providing a table.

To be considered supplementary evidence, the party must have made a serious attempt to provide sufficient evidence for all factors to be proven within the time limit. For example, if a party only refers to its own website as evidence of use of a mark, no serious attempt has been made to provide proof for the time, place and extent of use. Any invoices or other evidence submitted at a later stage will be considered as new evidence (04/05/2017, T-97/16, GEOTEK, EU:T:2017:298, § 29).

Moreover, the facts and evidence submitted within the deadline must cover all relevant factors to be proved for supplementary evidence to be possible. If only some of the factors are covered within the deadline, late evidence that relates to other factors may be considered inadmissible. For example, if the party did not submit any facts or evidence on time to prove the **place of use** and did not argue anything in that regard, late evidence provided to show the place of use will be treated as entirely new evidence.

The fact that the number of items of evidence submitted beyond the time limit is considerably greater than the items of evidence submitted in due time does not necessarily make the late evidence inadmissible (19/01/2022, T-76/21, Pomodoro, EU:T:2022:16, § 44).

5.2 Discretionary power

If the evidence is considered supplementary evidence in ***inter partes*** **proceedings**, the Office must exercise its discretionary power and decide whether the evidence is to be taken into account.

In doing so, the Office must consider:

- the stage of the proceedings when the belated evidence was submitted;
- if the late evidence is at first sight relevant, insofar as it appears to have an impact on the assessment and outcome of the case;
- whether there are valid reasons for the late submission; and
- whether the surrounding circumstances would prevent the late facts and evidence being considered.

These factors are independent.

Examples:

Additional facts or evidence are more likely to be accepted if they can be relevant to the outcome of the case, and are submitted at an early stage of the proceedings with a justification for their submission at that stage. However, the later the stage of proceedings, the stronger the reason must be for late submission or the relevance of the evidence.

If the circumstances of the case lead to the conclusion that a party is using delaying tactics by submitting evidence in parts with the intention of prolonging the proceedings, the late evidence is unlikely to be admitted.

The difficulties involved in obtaining the evidence are not, as such, a valid reason for its belated submission.

The Office must **state reasons in its decision** showing that it exercised discretionary power (05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 18). It must:

- state why the late facts and evidence are admissible or not;
- set out the factors it took into account; and
- balance the interests at stake.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part B

Examination

Section 4 Absolute grounds for refusal

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Section 4

Absolute grounds for refusal

Chapter 7

Trade marks contrary to public policy or acceptable principles of morality (Article 7(1)(f) EUTMR)

1 General remarks

Article 7(1)(f) EUTMR excludes from registration trade marks that are contrary to public policy or to accepted principles of morality. Article 7(1)(f) EUTMR mirrors that of Article 6*quinquies*(B)(3) of the Paris Convention ([12]), which provides for the refusal of trade mark applications and for the invalidation of registrations where trade marks are 'contrary to morality or public order'.

The wording of Article 7(1)(f) EUTMR is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to encounter disturbing, abusive, insulting and even threatening trade marks (06/07/2006, R 495/2005-G, SCREW YOU, § 14).

The rationale of Article 7(1)(f) EUTMR is not to identify and filter out signs whose use in commerce must at all costs be prevented, but to preclude trade marks from registration where granting a monopoly would contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society. In other words, the Office should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society (06/07/2006, R 495/2005-G, SCREW YOU, § 13).

The application of Article 7(1)(f) EUTMR is not limited by the principle of freedom of expression (Article 10, Freedom of expression, European Convention on Human Rights) since the refusal to register only means that the sign is not granted protection under trade mark law and does not stop the sign from being used — even in business (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 26).

'Public policy' and 'accepted principles of morality' are two different concepts that often overlap.

The question whether the goods or services for which protection is sought can or cannot be legally offered in a particular Member State's market is irrelevant for the question as to whether the sign itself falls foul of Article 7(1)(f) EUTMR (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 33). Whether or not a mark is contrary to public policy or accepted principles of morality must be determined by the intrinsic qualities of the mark applied for, and not by the circumstances relating to the conduct of the person applying for the trade mark (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 28). In its judgment of 20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, the General Court held that the concepts of 'public policy' and 'acceptable principles of morality' must be interpreted not only with reference to the circumstances common to all Member States but by taking into account 'the particular circumstances of **individual Member States** which are likely to influence the perception of the relevant public within those States' (para. 34).

12 Paris Convention for the Protection of Industrial Property of 20 March 1883 (as amended on 28 September 1979).

The legislation and administrative practice of certain Member States can also be taken into account in this context (i.e. for assessing subjective values), not because of their normative value, but as evidence of facts that make it possible to assess the perception of the relevant public in those Member States (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, § 57). In such a case, the illegality of the EUTM applied for is not the determining factor for the application of Article 7(1)(f) EUTMR, but rather is of evidential value with regard to the perception of the relevant public in the Member State(s) in question.

Considering that the specific circumstances of **individual** Member States may not be widely known in EU territory, the objection letter should explain these circumstances clearly in order to make sure that the applicant is able to fully understand the reasoning behind the objection and is able to respond accordingly. In the framework of the European Union Intellectual Property Network (EUIPN), the Office and a number of trade mark offices in the European Union have agreed on a Common Practice (CP) in relation to trade marks contrary to public policy or accepted principles of morality (also referred to as Convergence Project 14 or CP14 Practice). The CP establishes general principles on the assessment of signs contrary to public policy or to accepted principles of morality, in particular, the common understanding of these concepts, their relationship, the criteria for their assessment, and different groups of signs that could be considered contrary to public policy and/or to accepted principles of morality, including illustrative examples.

2 `Public Policy'

2.1 Concept and categories

This objection derives from an assessment based on **objective criteria**. ‘Public policy’ is the body of all legal rules that are necessary for the functioning of a democratic society and the state of law. In the context of Article 7(1)(f) EUTMR, ‘public policy’ refers to the **body of EU law applicable in a certain area**, as well as to the legal order and the state of law as defined by the Treaties and secondary EU legislation, which reflect a common understanding of certain basic principles and values, such as human rights.

The following is a non-exhaustive **list of examples** of when signs will be caught by this prohibition.

- Trade marks that contradict the basic principles and fundamental values of the European Union political and social order and, in particular, the universal values on which the European Union is founded, such as human dignity, freedom, equality and solidarity and the principles of democracy and the rule of law, as proclaimed in the Charter of Fundamental Rights of the European Union (OJ C 83, 30/03/2010, p. 389).

- On 27/12/2001, the Council of the European Union adopted Common Position 2001/931/CFSP on the application of specific measures to combat terrorism (OJ L 344, 28/12/2001, p. 93), later updated by Council Decision (CFSP) 2017/1426 of 04/08/2017, updating the list of persons, groups and entities subject to Articles 2, 3 and 4 of Common Position 2001/931/CFSP on the application of specific measures to combat terrorism and repealing Decision (CFSP) 2017/154 (OJ L 204, 05/08/2017, p. 95, consolidated version available at http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017D1426&from=EN), which contains a list of individuals and groups facilitating, attempting to commit or committing terrorist acts in EU territory. Any EUTM applied for that can be deemed to support or benefit an individual or a group on the list will be rejected as being against public policy.

3 Accepted Principles of Morality

This objection concerns **subjective values**, but these must be applied as objectively as possible by the examiner. The provision excludes registration as European Union trade marks of blasphemous, racist, discriminatory or insulting words or phrases, but only if that meaning is clearly conveyed by the mark applied for in an unambiguous manner; the standard to be applied is that of the reasonable consumer with average sensitivity and tolerance thresholds (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 21).

The concept of accepted principles of morality refers to the fundamental moral values and standards to which a society adheres at a given time. Those values and norms are likely to change over time and vary in space (27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 39).

The concept of morality in Article 7(1)(f) EUTMR is not concerned with bad taste or the protection of individuals' feelings. In order to fall foul of Article 7(1)(f) EUTMR, a trade mark must be perceived by the relevant public, or at least a significant part of it, as going directly against the fundamental moral values and standards of society.

It is not sufficient if the trade mark is only likely to offend a small minority of exceptionally puritanical citizens. Conversely, a trade mark should not be allowed to be registered simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable. The trade mark must be assessed by reference to the standards and values of ordinary citizens who fall between those two extremes (06/07/2006, R 495/2005-G, SCREW YOU, § 21).

The examination is to be based on the perception of a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered and, where appropriate, the particular circumstances of the part of the Union concerned. To that end, elements such as legislation and administrative practices, public opinion and, where appropriate, the way in which the relevant public has reacted in the past to that sign or similar signs, as well as any other factor which may make it possible to assess the perception of that public, are relevant (27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 42).

National legislation and practice of Member States are indicators to be taken into account in order to assess how certain categories of signs are perceived by the relevant public in those Member States (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, § 58). However, the Office must not object to trade marks because of the mere fact that they are in conflict with national legislation and practice. National legislation and practice are considered to be **factual evidence** that enables an assessment of the perception of the relevant public within the relevant territory.

Examples of national legislation taken into account as evidence of a trade mark being contrary to accepted principles of morality:

- use of symbols and names of unconstitutional parties or organisations is prohibited in Germany (§ 86a dt. StGB (German Criminal Code), BGBl. No I 75/1998) and in Austria (§ 1 öst. Abzeichengesetz (Austrian Law on Insignias), BGBl. No 84/1960 in conjunction with § 1 öst. Verbotsgesetz (Austrian Prohibition Law), BGBl. No 25/1947);
- 'use of symbols of totalitarianism' (e.g. the sickle and hammer and the five-pointed red star), specifically in a way to offend the dignity of victims of totalitarian regimes and their right to sanctity is prohibited in Hungary (Section 335 of Act C of 2012 on the Criminal Code) (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498).

Signs that can be perceived as promoting the use of illegal drugs also fall under this provision. Taking into account, as factual evidence, that certain drugs are illegal in some Member States as well as the fact that the EU has undertaken drug policy initiatives to fight against illegal drugs, an objection should be raised. It is an objective indication that such signs would be perceived as going directly against the basic moral norms of society.

The assessment made will take into account the term used in the mark applied for or the presence of other elements that could be perceived as promoting the use of illegal drugs. However, an objection will not be raised if the sign contains a reference to a drug that is for medical use, as the mark would not fall, in principle, within the prohibition of Article 7(1)(f) EUTMR.

The examination of Article 7(1)(f) EUTMR should consider the **context** in which the mark is likely to be encountered, assuming normal use of the mark **in connection with the goods and services** covered by the application (06/07/2006, R 495/2005-G, SCREW YOU, § 21). Taking account of the goods and services for which registration of the mark is sought is normally necessary, since the relevant public may be different for different goods and services and, therefore, may have different thresholds with regard to what is clearly unacceptably offensive. For example, 'a person who is sufficiently interested in [sex toys] to notice the trade marks under which they are sold is unlikely to be offended by a term with crude sexual connotations' (06/07/2006, R 495/2005-G, SCREW YOU, § 29).

Nevertheless, although the Court has held that the goods and services for which protection is sought are important for identifying the relevant public whose perception needs to be examined, it has also made it clear that the **relevant public is not**

necessarily only that which buys the goods and services covered by the mark, since a broader public than just the consumers targeted may encounter the mark (05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 17-18). Accordingly, the commercial context of a mark, in the sense of the public targeted by the goods and services, is not always the determining factor in whether that mark would breach accepted principles of morality (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 24; 26/09/2014, T-266/13, Curve, EU:T:2014:836, § 18-19).

Illegality is not a necessary condition for giving rise to a conflict with accepted principles of morality: there are words or signs that would not lead to proceedings before the relevant authorities and courts, but that are sufficiently offensive to the general public to not be registered as trade marks (01/09/2011, R 168/2011-1, fucking freezing! by TÜRPITZ (fig.), § 16). Furthermore, there is an interest in ensuring that children and young people, even if they are not the relevant public of the goods and services in question, do not encounter offensive words in shops that are accessible to the general public. Dictionary definitions will in principle provide a preliminary indication as to whether the word in question has an offensive meaning in the relevant language (01/09/2011, R 168/2011-1, fucking freezing! by TÜRPITZ (fig.), § 25), but the key factor must be the perception of the relevant public in the specific context of how and where the goods or services will be encountered.

However, the Boards of Appeal took the view that the word ‘kuro’ did not convey to the Hungarian public the offensive meaning of the word ‘kúró’ (meaning ‘fucker’ in English), since the vowels ‘ó’ and ‘ú’ are separate letters that are distinct from ‘o’ and ‘u’, which are pronounced differently and convey different meanings (22/12/2012, R 482/2012-1, kuro, § 12 et seq.).

There is a clear risk that the wording of Article 7(1)(f) EUTMR could be applied subjectively so as to exclude trade marks that are not to the examiner’s personal taste. However, for the word(s) to be objectionable, it (they) must have a clearly offensive impact on people of normal sensitivity (09/03/2012, T-417/10, ¡Que buenu ye! HIJOPUTA (fig.), EU:T:2012:120, § 21).

There is no need to establish that the applicant **wants** to shock or insult the relevant public; the fact that the EUTM applied for **might** be seen, as such, to shock or insult is sufficient (23/10/2009, R 1805/2007-1, PAKI, EU:T:2011:564, § 27, confirmed 05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 20 et seq.).

Finally, it is not only signs with a ‘negative’ connotation that can be offensive. The banal use of some signs with a **highly positive connotation** can also be offensive (e.g. terms with a religious meaning or national symbols with a spiritual and political value, like ‘ATATURK’ for the EU general public of Turkish origin (17/09/2012, R 2613/2011-2, ATATURK, § 31)).

Raising an objection when a trade mark is contrary to accepted principles of morality does not, however, prevent the sign from being also contrary to public policy (e.g. the trade mark may be perceived by the relevant public as directly contrary to the basic moral norms of society and, **at the same time**, may contradict the basic principles and fundamental values of the EU political and social order).

4 Examples

4.1 Examples of rejected EUTM applications

Sign	Relevant Consumer	Public policy/morality	Case No
BIN LADIN	General consumer	Morality and public policy — the mark applied for will be understood by the general public as the name of the leader of the notorious terrorist organisation Al Qaeda; terrorist crimes are in breach of public order and moral principles (para. 17).	29/09/2004 R 176/2004-2
CURVE	General consumer	Morality — 'Curve' is an offensive and vulgar word in Romanian (it means 'whores'). The relevant public is not limited only to the public to which the goods and services covered by the mark are **directly** addressed. 'Curve' equally offends other persons, who are confronted with the sign **accidentally** without being interested in these goods and services (para. 19). With regard to the word 'Curve'+ additions ['AIRCURVE'], see example below in this paragraph (R 203/2014-2).	T-266/13
	General consumer	Morality — 'fucking' is an offensive and vulgar word in English.	R 168/2011-1
	General consumer	Morality — 'HIJOPUTA' is an offensive and vulgar word in Spanish.	T-417/10

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Morality — the Hungarian Criminal Code bans certain 'symbols of despotism', including the hammer and sickle as well as the five-pointed red star symbolising the former USSR. This law is not applicable by reason of its normative value but rather as evidence of the perception of the relevant public (paras 59-63) ([13]).	T-232/10
PAKI	General consumer	Morality — 'PAKI' is a racist insult in English.	T-526/09
SCREW YOU	General consumer (for goods other than sex products)	Morality — a substantial proportion of ordinary citizens in Britain and Ireland would find the words 'SCREW YOU' offensive and objectionable (para. 26).	R 495/2005-G
FICKEN	General consumer	Morality — 'FICKEN' is an offensive and vulgar word in German (it means 'fuck').	14/11/2013, T-52/13, EU:T:2013:596
ATATURK	Average consumer in the EU general public of Turkish origin	Morality — banal use of signs with a highly positive connotation can be offensive under Article 7(1)(f) EUTMR. 'ATATURK' is a national symbol of spiritual and political value for the European general public of Turkish origin.	R 2613/2011-2
FUCK CANCER	General consumer	Morality — the word 'FUCK' is not only a 'slightly rude word' in combination with the word 'CANCER', but offensive and indecent, at least for the English-speaking part of the trade circles (para. 19).	23/02/2015, R 793/2014-2

13 The Hungarian Criminal Code, in force at the time of the judgment (20/09/2011), has been amended by Act C of 2012 to now encompass 'Use of Symbols of Totalitarianism', used 'specifically in a way to offend the dignity of victims of totalitarian regimes and their right to sanctity' (formerly Section 269/B, now Section 335 of the Hungarian Criminal Code).

Sign	Relevant Consumer	Public policy/morality	Case No
MECHANICAL APARTHEID	General consumer	Public policy — 'APARTHEID' refers to an offensive former political regime in South Africa that included state terror, torture and the denial of human dignity. The message conveyed by the sign for computer games, related publications and entertainment is contrary to the European Union's public policy, since it contradicts the indivisible, universal values on which the EU is founded, i.e. human dignity, freedom, physical integrity, equality and solidarity, and the principles of democracy and the rule of law (para. 30).	06/02/2015, R 2804/2014-5
MH17 MH370	General consumer	Morality — acronyms of the flights. The intent to seek financial gain from what is universally accepted to be a tragic event that has resulted in the loss of many hundreds of lives, is unacceptable and contrary to accepted principles of morality.	EUTM 13 092 937 EUTM 12 839 486

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Public policy and morality — mafia-type organised crime is a clear and present threat to the whole of the EU. 'la Mafia' is understood world-wide as referring to a criminal organisation originating in Italy, whose activities extend to States other than the Italian Republic, inter alia, within the European Union. The referred criminal organisation resorts to intimidation, physical violence and murder in carrying out its activities, which include, inter alia, drug trafficking, arms trafficking, money laundering and corruption (para. 35). Such criminal activities breach the very values on which the European Union is founded, in particular the values of respect for human dignity and freedom as laid down in Article 2, Treaty of the European Union and Articles 2, 3 and 6 of the Charter of Fundamental Rights of the European Union (para. 36). The association in the mark of the word element 'la mafia' with the other elements of the contested mark is such to convey a globally positive image of the Mafia's activities and, so doing, to trivialise the perception of the criminal activities of that organisation (para. 46). (…) The contested mark is, therefore, likely to shock or offend not only the victims of that criminal organisation and their families, but also any person who, on EU territory, encounters that mark and has average sensitivity and tolerance thresholds (para. 47).	15/03/2018, T-1/17, EU:T:2018:146

Sign	Relevant Consumer	Public policy/morality	Case No
ETA	General consumer	Public policy and morality — 'ETA' will be immediately understood in Europe, in particular in Spain, as designating the terrorist group ETA (para. 2). ETA is included on the list of individuals and groups facilitating, attempting to commit or committing terrorist acts in EU territory (Council Common Position 2001/931/CFSP of 27/12/2001 on the application of specific measures to combat terrorism updated by Council Common Position 2009/468/CFSP) (para. 14). In a commercial context, the term 'ETA' has the inherent tendency to shock any normal person who hears or reads it and, in particular, members of the Spanish public who particularly keep that name in mind. The fact that ETA is not currently considered to be the biggest threat facing Spain according to an extract from a survey conducted in June 2015 provided by the applicant, does not mean that the term will not continue to be associated with the terrorist group in question in the mind of the public (para. 15).	27/06/2016, R 563/2016-2
	General consumer	Public policy and morality — the words 'KRITIKAL BILBO' identify a variety of plant of the 'cannabis' genus — also called 'marihuana' — which, due to its high content of tetrahydrocannabinol (THC), namely 21.47 %, is used to make marihuana (para 19). Cannabis with a high THC content is considered to be a narcotic that is prohibited in a large number of Member States (19/11/2009, T-234/06, Cannabis, EU:T:2009:448). Non-psychoactive substances are legal and the authorities can issue licences for their cultivation for those purposes. However, due to its high THC content, in this case the product concerned is not non-psychoactive, but is a substance for smoking that is strictly controlled in almost all European Union countries (para. 22).	27/10/2016, R 1881/2015-1

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Morality — the sign, containing the term 'weed' and applied for in Class 32, will be understood by the relevant consumer as glorifying the use of a drug (cannabis/marijuana) that is prohibited by law in many European countries.	EUTM 16 961 732
IBIZASKUNK	General consumer	Morality — applied for in Classes 5, 31 and 35. The sign, contains the term 'skunk' which refers to a cannabis strain with high THC. It will be perceived as a motivational/promotional message, which encourages an activity prohibited in many Member States of the EU, namely the consumption or sale of products containing SKUNK, as well as a banalisation of the aforementioned narcotic substance. The term IBIZA (known as a party location) reinforces the recreational message.	EUTM 18 097 102
	General consumer	The sign depicts cannabis leaves and also contains the term 'cannabis'. The application was filed for goods in Classes 30 and 32 and for services in Class 43. The Court considered that the fact that the sign would be perceived by the relevant public as an indication that the food and drink items contained narcotic substances, prohibited in many Member States, was sufficient to justify the refusal of the mark. It was not required that a sign encourage or trivialise the use of an illegal narcotic substance. As regards factors such as the accuracy of the depiction or the intention of the applicant to use the sign only for legal goods, the Court pointed out that the perception of the public was decisive and clarified that the intentions of the applicant did not play a role in the assessment.	EUTM 16 176 968 12/12/2019, T-683/18, EU:T: 2019:855

4.2 Examples of accepted EUTM applications

Sign	Relevant Consumer	Comment	Case No

KURO	General consumer	That a foreign term, name or abbreviation displays certain similarities with an offensive word (like 'kúró') is not in itself sufficient reason to refuse an EUTM application (para. 20). The Hungarian vowels 'ò' and 'ù' are clearly different from the unaccented vowels 'o' and 'u'. Furthermore, Hungarian words never end with an unaccented 'o' (paras 15-18).	R 482/2012-1
SCREW YOU	General consumer (for sex products)	A person entering a sex shop is unlikely to be offended by a trade mark containing crude, sexually charged language (para. 29).	R 495/2005-G
DE PUTA MADRE	General consumer	Although 'puta' means 'whore' in Spanish, the expression 'DE PUTA MADRE' means 'very good' in Spanish (slang).	EUTM 3 798 469 EUTM 4 781 662 EUTM 5 028 477

AIRCURVE	Specialised public (medical personnel; patients with breathing disorders)	The objectionable word 'Curve' ['whore', 'slut' in Romanian] is seamlessly attached to the English word 'AIR' to form 'AIRCURVE', which, as a whole, is entirely fanciful in Romanian. Even if the relevant public understood the English word 'AIR', and analysed the mark by separating it into two elements, the meaning of 'AIRCURVE' would be 'air whores', which, as a concept, and for respiratory apparatus, is sufficiently nonsensical or puzzling to the extent that it would eclipse any notion of being offensive (para. 13 et seq.). With regard to the word 'Curve' on its own, see the abovementioned example in this paragraph (T-266/13).	04/06/2014, R 203/2014-2
	General consumer	For the goods at issue — *rum* (Class 33) — the relevant public will perceive the sign as provocative, transgressive, rebellious, but not as an indicator of criminal origin of the goods (para. 23).	07/05/2015, R 2822/2014-5

ILLICIT	General consumer	The mark is considered acceptable under Article 7(1)(f) EUTMR, as 'illicit' is different from something like 'counterfeit'. The mark would be seen as fanciful on the goods (*cosmetics, and perfumes*) and it could be accepted.	EUTM 13 469 523
	General consumer	The mark evokes a concept that falls within the domain of vulgarity and profanity. However, the effect is attenuated by the fact that the implicit word does not appear in the mark as such. The presence of the initial figurative element 'W', combined with the euphemistic presentation of 'F___', also suppresses the offensive potential of the sign. Consumers with a normal level of sensitivity and tolerance would not be offended or upset by regular commercial exposure to the term in connection with the relevant goods and services in Classes 16, 18, 25, 35, 41, 43 and 44 (para. 31).	29/11/2018 R 1516/2018-5

hemptouch. PREMIUM CANNABIS ESSENTIALS	General consumer	The sign, containing the terms 'hemptouch' and 'cannabis', is applied for in Classes 3 and 5. It will be perceived by the relevant consumer as a reference to the medicinal use of the substance. Hemp is a variety of *Cannabis sativa*, which contains a very low concentration of THC, and cannabis can be used for medicinal purposes.	EUTM 18 000 042

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Section 3

EUTMs and REUDs as objects of property

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Chapter 1

Transfer

1 Introduction

Article 1(2), Articles 19, 20, 27 and 28, Article 111(1) and Article 111(3)(g) EUTMR Articles 27, 28 and 34 EUDR Article 23 and Article 72(3)(j) EUDR

A transfer is the change in ownership of the property rights in a European Union trade mark (EUTM) or an EUTM application from one entity to another. EUTMs and EUTM applications may be transferred from the current proprietor to a new proprietor, primarily by way of assignment or legal succession. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

The transfer may be limited to some of the goods or services for which the mark is registered or applied for (partial transfer). In contrast to a licence or conversion, the transfer of an EUTM cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for **some** territories or Member States.

Both registered European Union designs (REUDs) and applications for an REUD may also be the subject of a transfer.

The provisions in the EUDR and EUDIR dealing with the transfer of registered European Union designs are almost identical to the equivalent provisions of the EUTMR, EUTMDR and EUTMIR. **Therefore, the following applies *mutatis mutandis* to REUDs. Exceptions and specific provisions for REUDs are detailed in paragraphs 3 and 7 below.**

On request of one of the parties, transfers of EUTMs are entered in the EUTM Register.

According to Article 20 EUTMR, the registration of a transfer is not a condition for its validity. However, if a transfer is not registered by the Office, the successor may not invoke the rights arising from the EUTM. Moreover, the new proprietor will not receive communications from the Office, in particular, during *inter partes* proceedings, nor the notification of the renewal period of the mark. Furthermore, according to Article 19 EUTMR, in all aspects of the EUTM as an object of property that are not further defined by provisions of the EUTMR, the proprietor's address defines the applicable subsidiary national law. Consequently, it is important to register a transfer at the Office to ensure that entitlement to EUTMs and EUTM applications is clear.

1.1 Transfers

Article 20(1) and (2) EUTMR

Article 28 EUDR

A transfer of an EUTM involves two aspects, namely the validity of the transfer between the parties and the impact of a transfer on proceedings before the Office, which will only be triggered after the entry of the transfer in the EUTM Register (see paragraph 1.2 below).

Regarding the validity of the transfer between the parties, the EUTMR allows an EUTM to be transferred independently of any transfer of the undertaking to which it belongs (30/03/2006,C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 45 and 48).

1.1.1 Assignment

Article 20(3) EUTMR

Article 28 EUDR

When a transfer is made by an assignment, it is only valid where the assignment is made in writing and is signed by both parties, except where the assignment is the result of a court decision, or a decision taken by the Office under Article 21 EUTMR. This formal requirement for the validity of the transfer of an EUTM is applicable irrespective of whether, under the national law governing transfers of (national) trade marks, an assignment is valid without observing a particular form, such as the need for the transfer to be in writing and have the signatures of both parties.

However, the change of ownership of REUDs due to entitlement proceedings before a national authority are not processed through a transfer but through a change in the ownership resulting from the final decision under Article 15 EUDR.

1.1.2 Inheritance

When the proprietor of an EUTM dies, the heirs will become proprietors of the EUTM by way of individual or universal succession. This is also covered by the rules on transfers.

1.1.3 Merger

A universal succession also exists when there is a merger between two companies that leads to the formation of a new company, or an acquisition by one company taking over another. Where the whole of the undertaking to which the mark belongs is transferred, there is a presumption that the transfer includes the EUTM unless, in accordance with

the law governing the transfer, an agreement to the contrary was made or unless circumstances clearly dictate otherwise.

1.1.4 Applicable law

Article 19 EUTMR
Article 27 EUDR

Unless provided otherwise by the EUTMR, transfers are subject to the national law of a Member State determined by Article 19 EUTMR. The national law applicable under that provision is the national law in general and, therefore, also includes private international law which, in turn, may refer to the law of another State.

1.2 Legal effects of the transfer

Article 20(11) EUTMR
Article 27 EUTMR
Article 13 EUTMIR
Article 28 EUDR
Article 23 EUDIR

As long as the transfer has not been entered in the EUTM or EUD Register, the successor in title may not invoke the rights arising from the registration of the EUTM or the REUD (see *mutatis mutandis* 16/01/2020, T-128/19, Sativa, EU:T:2020:3, § 22, 25-26). The transfer has effects with regard to third parties only after entry in the Register. This does not apply to third parties who acquired rights in the EUTM before the transfer was registered, and knew about the transfer when they acquired those rights.

This also applies to a transfer based on the implementation of a decision, even if the judgment established proprietorship with previous or *ex tunc* effect (see paragraph 7).

However, in the period between the date when the Office receives the application to register a transfer and the date of registering the transfer, the new proprietor may already make submissions to the Office with a view to observing time limits. For example, if a party has applied to register the transfer of an EUTM application against which the Office has raised objections on absolute grounds, the new proprietor may reply to those objections (see paragraph 6).

In an application for registration of a transfer, the Office will only examine whether sufficient evidence of the transfer has been submitted.

For changes of ownership following national entitlement proceedings regarding REUDs, see paragraph 3.

2 Transfers v Changes of Name

Article 55 EUTMR Article 19 EUDIR

A transfer must be distinguished from a change of name of the proprietor.

A change in the name of the proprietor is a change that does not affect the identity of the proprietor, whereas a transfer is a change in the identity of the proprietor.

In particular, no transfer is involved when a natural person changes their name due to marriage, or following an official procedure for changing a name, or when a pseudonym is used instead of the proper name, etc. In all these cases, the identity of the proprietor is not affected.

Where the name or the corporate status of a legal person changes, the criterion for distinguishing a transfer from a mere change of name is whether or not the identity of the legal person remains the same. If the identity remains the same, it will be registered as a change of name (06/09/2010, R 1232/2010-4 , Cartier, § 12-14). In other words, where there is no termination of the legal entity (such as would occur in the case of a merger by acquisition, where one company is completely absorbed by the other and ceases to exist) and no start-up of a new legal entity (e.g. as would be the case following the merger of two companies leading to the creation of a new legal entity), there is only a change in the formal corporate organisation that already existed, and not in the actual identity itself. Therefore, the change will be registered as a change of name, where appropriate.

For example, if an EUTM is in the name of Company A and, as the result of a **merger** , this company is absorbed by Company B, there is a **transfer** of assets from Company A to Company B.

Likewise, during a **division** of Company A into two separate entities, one being the original Company A and the other being a new Company B, if the EUTM in the name of Company A becomes the property of Company B, there is a **transfer** of assets.

Normally, there is no transfer if the company registration number in the national register of companies remains the same.

However, there is in principle the prima facie presumption that there is a transfer of assets if there is a change of country (see, however, 06/11/2013, R 546/2012-1 , PARFUMS LOVE / LOVE et al.).

If the Office has any doubt about the national law applicable to the legal person concerned, it may require appropriate information from the applicant for registration of the change of name.

Therefore, unless ruled to the contrary under the applicable national law, the change of company type, provided that it is not accompanied by a transfer of assets carried out by means of a merger or an acquisition, will be treated as a change of name and not as a transfer.

However, if the change of company type is the result of a merger, a division or a transfer of assets, depending on which company absorbs or is separated from the other, or on which company transfers which assets to the other, it may be a case of transfer.

2.1 Erroneous application to register a change of name

Articles 55(1), (3) and (5) and 162(1) EUTMR Article 71 EUDR Article 19(1), (5) and (7) EUDIR

When a request is made to register a change of name, but the evidence shows that it is actually a transfer of an EUTM, the Office informs the applicant accordingly and invites it to file an application for registration of a transfer within a specified period. If the applicant agrees or does not submit evidence to the contrary and files the corresponding application to register a transfer, the transfer will be registered. If the applicant does not modify its request and insists on registering the change as a change of name, or if it does not respond, the request to register a change of name will be rejected. The party concerned may file an appeal against this decision.

A new application for the registration of the transfer may be filed at any time.

2.2 Erroneous application for the registration of a transfer

Article 20(5) and (7) EUTMR Article 23(1) and (5) EUDIR

When an application is made to register a transfer, but what is involved is actually a change of name of an EUTM, the Office informs the applicant accordingly and invites it to give, within a specified period, its consent to register the indications concerning the proprietor in the EUTM Register. If the applicant agrees, the change of name will be registered. If the applicant does not agree and insists on registering the change as a transfer, or if it does not respond, the application for the registration of a transfer will be rejected.

3 Transfers v changes of ownership due to entitlement proceedings for REUDs

Articles 15 and 16 EUDR

Regarding REUDs, a transfer must be distinguished from a change of ownership following entitlement proceedings.

Pursuant to Article 15 EUDR, REUDs may be the subject of entitlement proceedings. Changes in ownership that arise from a final decision of the competent authority or court of the respective Member State are entered in the EUD Register upon request. For more information, see the Guidelines, Part E Register Operations, Section 3, Chapter 2 Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, paragraph 8.2.

There are, in particular, the following differences between changes of ownership arising out of transfers and entitlement proceedings:

- Request to the Office: The rules regarding the proof for the request are different, see for entitlement proceedings the Guidelines, Part E Register Operations, Section 3, Chapter 2 Licenses, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings, paragraph 8.2. and for transfers, paragraph 4.5, below. Moreover, how the request can be submitted within the user area is different. For entitlement proceedings, the user must chose the 'communications back-up'. For transfers, the user area provides a specific e-action in the 'recordals' section .
- Register entries and their effect: the entries in the EUD Register differ. Entitlement proceedings may be entered in the register as of their initiation. This freezes the REUD and prevents the registered holder from performing any acts that may prevent the legitimate holder from exercising rights over the REUD (e.g. transfers the design) (for the legal effects of transfers see paragraph 1.2).
- Licences: While the registration of a transfer might not affect existing licences, licences will lapse upon the entry into the EUD Register of a change of ownership resulting from entitlement proceedings (Article 16(1) EUDR).

Persons entitled under Article 14 EUDR should inform the Office immediately about the initiation and the result of entitlement proceedings before national courts or authorities.

The option of a claim to entitlement applicable to REUDs does not exist for EUTMs. Judgments on the proprietorship of an EUTM must be implemented by means of a transfer, as seen in paragraph 1.2.

4 Requirements for an application for registration of a transfer

It is strongly recommended that the application for registration of a transfer for an EUTM be submitted electronically via the Office's website (e-recordals). Using

e-recordals has advantages, such as the automatic receipt of electronic confirmation of the application, and the possibility to use the manager feature to complete the form quickly for as many EUTMs as required.

4.1 Languages

Article 146(6)(a) EUTMR Article 80(a) EUDIR

The application for the registration of a transfer for an EUTM application must be made in the first or second language of the EUTM application.

Article 146(6) EUTMR Article 80(c) EUDIR

The application for the registration of a transfer for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of a transfer is filed using the form provided by the Office pursuant to Article 65(1)(e) EUTMDR or Article 68 EUDIR, according to Article 146(6) EUTMR and Article 80(c) EUDIR, the form may be used in any of the official languages of the European Union, provided that it is completed in one of the languages of the Office, as far as textual elements are concerned.

When the application for the registration of the transfer relates to more than one EUTM application, the applicant must select a language for the application that is common to all the EUTMs concerned. If there is no common language, separate applications for registration of the transfer must be filed.

When the application for the registration of the transfer relates to more than one EUTM registration, the applicant must select one of the five languages of the Office as a common language.

Article 24 EUTMIR Article 81(2) EUDIR

Any supporting documents may be filed in any official language of the European Union. This applies to any document submitted as proof of the transfer, such as a countersigned transfer document or a transfer certificate, a deed of assignment or an extract from a trade register or a declaration agreeing to register the successor in title as the new proprietor.

When the supporting documents are submitted in an official language of the European Union that is not the language of the proceedings, the Office may require a translation

into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

4.2 Application for registration of a transfer filed for more than one mark

Article 20(8) EUTMR

Article 23(6) EUDIR

A single application for the registration of a transfer for two or more EUTMs may be submitted only if the registered proprietor and beneficiary, or assignee, are the same in each case.

Separate applications are necessary when the original proprietor and the new one are not exactly identical for each mark. For example, this is the case where there is one successor in title for the first mark and there are multiple successors in title for another mark, even if the successor in title for the first mark is among the successors in title for the other mark. It is immaterial whether the representative is the same in each case.

When a single application is filed in such cases, the Office will issue a deficiency letter. The applicant may overcome the objection either by limiting the application for the registration of the transfer to those EUTMs or EUTM applications for which there is only one and the same original proprietor and only one and the same new proprietor, or by declaring its agreement that the application should be dealt with in two or more separate proceedings. Otherwise, the application for registration of a transfer will be rejected in its entirety. The party concerned may file an appeal against this decision.

4.3 Parties to the proceedings

Article 20(4) and Article 20(6)(b) EUTMR

Article 13(3) EUTMIR

Article 28(2) EUDR

Article 23(4) EUDIR

The application for registration of a **transfer** may be requested at the Office by:

1. the EUTM proprietor(s), or
2. the EUTM proprietor(s) jointly with the assignee(s), or
3. the assignee(s), or
4. a court or authority.

The formal conditions with which the application must comply depend on who submits the application.

4.4 Formal requirements

4.4.1 Indications concerning the EUTM and the new proprietor

Article 20(5) EUTMR Article 2(1)(b) and (e), and Article 13(1) EUTMIR Article 1(1)(b) and (e), and Article 23(1) and (2) EUDIR

The application for registration of a transfer must contain the following information.

1. The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the registration numbers must be indicated.
2. The details of the new proprietor. In the case of a natural person, the name, address and nationality must be indicated. In the case of a legal entity, the application must indicate the official designation and the legal form of the entity, which may be abbreviated in a customary manner (for example, S.L., S.A., Ltd., PLC). The company's national identification number may also be specified, if available. Both natural persons and legal entities must indicate the State in which they are domiciled or have their seat or an establishment. **The Office strongly recommends US companies to indicate, where applicable, the State of Incorporation, in order for it to differentiate clearly between different owners in its database.** These details correspond to the indications required for an applicant for a new EUTM application. However, where the Office has already assigned an ID number to the new proprietor, it is sufficient to indicate that number together with the name of the new proprietor.
   The form made available by the Office also requests an indication of the original proprietor's name. This indication will facilitate both the Office's and the parties' handling of the file.
3. If the new proprietor designates a representative, the representative's name and ID number assigned by the Office. If the representative has not yet been assigned an ID number, the business address must be indicated.

For additional requirements in cases of partial transfer, see paragraph 5 below.

4.4.2 Representation

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation).

4.4.3 Signatures

Article 20(5), Article 20(6)(b), and Article 119(4) EUTMR

Article 13(2) EUTMIR

Article 23(1) and (4) EUDIR

The requirements concerning the person entitled to file the application for registration of the transfer and the signatures must be considered together with the requirement to submit proof of the transfer. The principle is that the signatures of the original proprietor and the new proprietor must appear together or separately on the application for registration of the transfer or in an accompanying document. In the case of co-ownership, and where the transfer concerns the ownership as a whole, all co-owners must sign or appoint a common representative.

When the original proprietor and the new proprietor both sign the application for registration of the transfer, this is sufficient and no additional proof of the transfer is necessary.

When the original proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration signed by the successor in title stating that it agrees to the registration of the transfer, this is sufficient and no additional proof is necessary.

When the new proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration, signed by the original proprietor, stating that it agrees to the registration of the successor in title as the new proprietor, this is also sufficient and no additional proof is necessary.

When the original proprietor's representative is also appointed as the new proprietor's representative, the representative may sign the application for registration of the transfer on behalf of both the original and the new proprietor, and no additional proof is necessary. However, when the representative signing on behalf of both the original and the new proprietor is not the representative on file (i.e. in an application simultaneously appointing the representative and transferring the EUTM), the Office will contact the applicant for registration of the transfer to request evidence of the transfer (authorisation signed by the original proprietor, proof of transfer, confirmation of the transfer by the original proprietor or its representative on file).

4.4.4 Proceedings affecting the transfer

The examination of the formal requirements for registering a transfer means taking into account facts that may have implications for the legality of that registration including the existence of insolvency proceedings at the national level (22/09/2021, T-169/20, Marina Yachting, EU:T:2021:609, § 68).

Where a judgment declaring the registered proprietor of a mark as insolvent has been entered in the Register, any subsequent application for registration of a transfer

concerning the same mark will be automatically suspended and can only be acted upon with the express authorisation of the liquidator or the national court responsible for the insolvency proceedings. Where the Office registers a transfer but is made aware that the proprietor was insolvent at the relevant time, it may revoke the transfer.

Where the Office receives proof that ownership of a mark is being contested in a competent national court it will suspend any pending transfers until one of the parties has submitted a copy of the final decision of the dispute to the Office.

4.5 Proof of transfer

Article 20(2) and (3) EUTMR
Article 65(1)(e) EUTMDR
Article 13(1)(d) and Article 13(2) EUTMIR
Article 28 EUDR
Article 23(1)(d) and (4)(a) to (c) and Article 68(1)(c) EUDIR

A transfer may be registered only when it is proven by documents duly establishing the transfer, such as a copy of the deed of transfer. However, as already highlighted above, a copy of the deed of transfer is not necessary when:

- the new proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the original proprietor (or its representative) stating that it agrees to the registration of the transfer to the successor in title; or
- the original proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the new proprietor (or its representative) stating that it agrees to the registration of the transfer; or
- the application for registration of the transfer is signed by both the original proprietor (or its representative) and by the new proprietor (or its representative); or
- when the application for registration of the transfer is accompanied by a completed transfer form or document signed by both the original proprietor (or its representative) and by the new proprietor (or its representative).

Where proof of transfer is required, parties to the proceedings may also use the forms established under the Trademark Law Treaty available on WIPO's website (https://wipolex.wipo.int/en/treaties/textdetails/12680). The relevant forms are the 'Transfer Document' – a document conceived as constituting the transfer (assignment) itself – and the 'Certificate of Transfer' – a document in which the parties to a transfer declare that a transfer has taken place. Either of these documents, duly completed, constitutes sufficient proof of transfer.

However, other means of proof are not excluded. Therefore, the agreement (deed) itself or any other document proving the transfer may be submitted.

Regarding confidentiality, the party submitting the proof must bear in mind that the content of files are available for public inspection, and this is particularly relevant where contracts or other documents are submitted as evidence for a transfer, as they may contain sensitive data. Consequently, certain information may be **blacked out** before being submitted to the Office, or certain pages may **be omitted altogether**. The evidence required in support of a transfer does not need to include commercially sensitive items such as the price paid for the EUTM in question.

While omitting the sensitive information is preferable, alternatively, the Regulations do provide for confidentiality to be invoked where the party concerned expresses a special interest in keeping part of the file confidential. For more information on the formal requirements for invoking confidentiality, see the Guidelines, Part E, Register Operations, Section 5, paragraph 5.1.3 'Parts of the file for which the party concerned expressed a special interest in keeping confidential'.

When the mark has been subject to multiple successive transfers and/or changes of the proprietor's name that have not been previously registered in the register, it is sufficient to submit the chain of evidence showing the events leading to the relationship between the original proprietor and the new proprietor without the need to file separate individual applications for each change.

When the transfer of the mark is the consequence of the transfer of the whole of the undertaking of the original proprietor, documents showing the transfer or assignment of the whole undertaking must be submitted.

When the transfer is due to a merger or another universal succession, the original proprietor will not be available to sign the application for registration of transfer. In this case, the application must be accompanied by supporting documents that prove the merger or universal succession, such as extracts from the trade register.

When the transfer of the mark is a consequence of a right *in rem*, a levy of execution or insolvency proceedings, the original proprietor will not be able to sign the application for registration of transfer. In these cases, the application must be accompanied by a final decision issued by a competent national authority transferring the ownership of the mark to the beneficiary.

It is not necessary to legalise supporting documents nor to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient.

If the Office has reason to doubt the accuracy or veracity of the document, it may require additional proof.

The Office will examine the documents only to the extent that they actually confirm what is indicated in the application, namely the identity of the marks concerned and the identity of the parties, and whether a transfer is involved. The Office does not consider or rule on contractual or legal questions arising under national law (09/09/2011,

T-83/09, Craic, EU:T:2011:450, § 27). If doubts arise, the national courts deal with the legality of the transfer itself.

4.5.1 Translation of proof

Article 146(1) EUTMR Article 24 EUTMIR Article 80(a) and (c) and Article 81(2) EUDIR

The evidence must be:

1. in the language of the Office that has become the language of the proceedings for the registration of the transfer; or
2. in any official language of the European Union other than the language of the proceedings. In this case, the Office may require a translation of the document into a language of the Office to be submitted within a period specified by the Office.

Where the supporting documents are submitted in an official language of the European Union that is not the language of the proceedings, the Office may require a translation into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

4.6 Procedure to remedy deficiencies

Article 20(7) and (12) EUTMR Article 28 EUDR Article 23(5) EUDIR

The Office will inform the applicant for registration of the transfer in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, the Office will reject the application for registration of the transfer. .

4.7 Collective and Certification marks

Article 20(5) and (7), and Articles 75, 79, 83, 84 and 88 EUTMR

The Office's practice in dealing with requests for transfer of EU collective marks and EU certification marks follows the principle that any new proprietor of an EU collective

mark or EU certification mark should comply with the same initial requirements the original proprietor was obliged to comply with at the time of filing of the EUTM.

It is understood therefore, that where a request for transfer is submitted in relation to an EU collective mark or an EU certification mark, in addition to the requirements and the documents duly establishing the transfer (Article 20(5) EUTMR), the Office will require the assignee to submit amended regulations of use (Articles 75, 79, 84 and 88 EUTMR). Specifically for EU certification marks, the applicant has to include in the regulations of use a declaration clearly specifying that the conditions of Article 83(2) EUTMR are fulfilled.

If these documents are not attached to the application for registration of the transfer, or if they do not comply with the requirements of Articles 75, 79, 84 and 88 EUTMR, a deficiency will be raised pursuant to Article 20(7) EUTMR, and in the event the deficiency is not remedied, the application for the registration of the transfer will be refused.

For more information on the formal requirements of EU collective marks and EU certification marks, and on the content and requirements of the regulations of use, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraphs 8.2 and 8.3.

5 Partial Transfers

Article 20(1) EUTMR Article 14 EUTMIR

A partial transfer concerns only some of the goods and services in the EUTM and is only applicable to EUTMs (not to REUDs).

It involves the distribution of the original list of goods and services between the remaining EUTM and a new one. When partial transfers are involved, the Office uses particular terminology to identify the marks. At the beginning of the proceedings there is the ‘original’ mark. This is the mark for which a partial transfer has been applied. After the registration of the transfer, there are two marks: one is a mark that now has fewer goods and services, and is called the ‘remaining’ mark, and one is a ‘new’ mark that has some of the goods and services from the original mark. The ‘remaining’ mark retains the EUTM number of the ‘original’ mark while the ‘new’ mark has a new EUTM number.

Transfer cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be ‘partially’ transferred for **some** territories.

When there are doubts as to whether the transfer is partial or not, the Office will inform the applicant for registration of the transfer and invite it to make the necessary clarifications.

Partial transfers may also be involved when the application for registration of the transfer concerns more than one EUTM. The following rules apply for each EUTM included in the application.

5.1 Rules on the distribution of the lists of goods and services

Articles 33 and 49 EUTMR

Article 14(1) EUTMIR

Communication No 1/2016 of the President of the Office of 08/02/2016

In the application for registration of a partial transfer, the goods and services to which the partial transfer relates must be indicated (the list of goods and services for the 'new' registration). The goods and services must be distributed between the original EUTM and the new EUTM so that the goods and services in the original EUTM and the new one do not overlap. The two specifications taken together must not be broader than the original specification.

Therefore, the indications must be clear, precise and unequivocal. For example, when an EUTM for goods or services in several classes is involved, and the 'split' between the original and new registration concerns entire classes, it is sufficient to indicate the respective classes for the new registration or for the remaining one.

When the application to register a partial transfer indicates goods and services that are explicitly mentioned in the original list of goods and services, the Office will automatically retain, in the original EUTM, the goods and services that are not mentioned in the application to register the partial transfer. For example, the original list contains goods A, B and C, and the transfer application relates to C; the Office will keep goods A and B in the original registration and create a new registration for C.

For further details concerning the scope of the list of goods and services, and for the Office's practice regarding the interpretation of general indications of the Nice Classification class headings, please see the Guidelines, Part B, Examination, Section 3, Classification, and Communication No 1/2016 of the President of the Office of 08/02/2016 concerning the implementation of Article 28 EUTMR (now Article 33 EUTMR), and the Annex thereto.

In all cases, it is highly recommended to file a clear and precise list of goods and services to be transferred together with a clear and precise list of goods and services to remain in the original registration. Furthermore, the original list must be clarified. For example, if the original list related to *alcoholic beverages* and the transfer relates to *whisky* and *gin*, the original list must be amended by restricting it to *alcoholic beverages, except whisky and gin.*

5.2 Objections

Article 20(7) EUTMR

When the application for registration of a partial transfer does not comply with the rules explained above, the Office will invite the applicant to remedy the deficiency. If the deficiencies are not remedied, the Office will reject the application for registration of a partial transfer. The party concerned may file an appeal against the decision.

5.3 Creation of a new EUTM

Article 20(6)(c) EUTMR

Article 14(2) EUTMIR

A partial transfer leads to the creation of a new EUTM. For this new EUTM, the Office will establish a separate file, which will consist of a complete copy of the electronic file of the original EUTM, the application for registration of a transfer, and all the correspondence related to the application for registration of the partial transfer. The new EUTM will be given a new file number. It will have the same filing date and, where applicable, date of priority as the original EUTM.

As far as the original EUTM is concerned, the Office will include a copy of the application for registration of a transfer in its files, but will not normally include copies of the further correspondence relating to the transfer application.

6 Transfer During the Course of Other Proceedings and Fees Issues

Article 20(11) and (12) EUTMR

Article 28(6) and (7) EUDR

Without prejudice to the right to act from the time when the application for registration of a transfer is received by the Office where time limits are involved, the new proprietor will automatically become party to any proceedings involving the mark in question from the time the transfer is registered.

The filing of an application for registration of a transfer has no effect on time limits already running or established by the Office, including time limits for the payment of fees. New time limits for payment will not be established. From the date of registration of the transfer, the new proprietor becomes liable to pay any fees due.

Therefore, it is important that, during the period between the filing of the application for registration of a transfer and the Office's confirmation of its actual entry in the EUTM Register or in the file, the original proprietor and the new proprietor actively collaborate in the communication of time limits and correspondence received during *inter partes* proceedings.

6.1 Specific issues of partial transfers

Article 20(10) EUTMR

In cases of partial transfers, the new EUTM will be at the same procedural stage as the original (remaining) EUTM. Any time limit still pending for the original EUTM will be considered to be pending for both the remaining and the new EUTM. After registration of the transfer, the Office will treat each EUTM separately and will decide on them separately.

When an EUTM is subject to the payment of fees and these fees have been paid by the original proprietor, the new proprietor will not be liable to pay any additional fees for the new EUTM. The relevant date is the entry date of the transfer in the EUTM Register. Therefore, when the fee for the original EUTM is paid after an application for registration of a transfer has been filed but before the registration of the transfer itself, no additional fees are due.

Articles 31(2) and 41(5) EUTMR Annex I A(3) and (4), Annex I A(7) and (8) EUTMR

When the partial transfer involves an EUTM application and class fees have not yet been paid or have not been paid in full, the Office will proceed to register the transfer in the files of the remaining EUTM application and to create a new EUTM application as described above.

Where additional class fees have to be paid for an EUTM application, the examiner will deal with such cases after creating a new EUTM application, as described below.

When additional class fees were paid prior to registering the transfer but no additional class fees were due for the remaining EUTM application, no reimbursement will be made because the fees were paid correctly at the time of payment.

In all other cases, the examiner will treat the remaining EUTM application and the new one separately, but will not require an additional basic fee to be paid for the new EUTM application. Class fees for the remaining EUTM application and for the new one will be determined according to the situation after the registration of the transfer. For example, when the original EUTM application had seven classes and, after the transfer, the remaining EUTM application has only one class while the new EUTM application has six, no additional class fees will be due for the remaining EUTM application, but the corresponding additional class fees must be paid for the new EUTM application. When

some of the goods and services of a particular class are transferred and others are not, the fees for that class become payable for both the remaining EUTM application and the new one. When a time limit already set to pay additional class fees has not yet expired, it will be set aside by the Office to allow the determination to be made according to the situation after the registration of the transfer.

Article 53(1), (3) to (5) and (7) to (8) EUTMR

When the application for registration of a partial transfer relates to an EUTM registration that is due for renewal, that is, within 6 months prior to the expiry of the original registration and up to 6 months after that expiry, the Office will proceed to register the transfer and deal with the renewal and renewal fees as described below.

When no request for renewal has been submitted and no fees have been paid prior to the registration of the transfer, the general rules, including the rules relating to the payment of fees, are applicable to both the remaining EUTM registration and the new one (separate requests, separate payment of fees, as necessary).

When a request for renewal has been submitted prior to the registration of the transfer, that request is also valid for the new EUTM. However, while the original proprietor remains a party to the renewal proceedings for the remaining EUTM, the new proprietor automatically becomes party to the renewal proceedings for the new registration.

When a request for renewal has been filed but the relevant fees have not been paid prior to the registration of the transfer, the fees to be paid are determined according to the situation after the registration of the transfer. This means that both the proprietor of the remaining EUTM and the proprietor of the new EUTM must pay the basic renewal fee and any class fees.

When a request for renewal has been filed prior to the registration of the transfer and all the applicable renewal fees have been paid prior to this date, no additional renewal fees are due after the registration of the transfer. No reimbursement is made of any class fees already paid.

6.2 Transfer and *inter partes* proceedings

When an application for registration of a transfer is filed during *inter partes* proceedings, several different situations can arise. For earlier EUTMs on which the opposition/cancellation is based, the new proprietor can only become party to the proceedings (or file observations) once the application for registration of the transfer has reached the Office. The basic principle is that the new proprietor substitutes the original proprietor in the proceedings. The practice of the Office when dealing with transfers in oppositions is described in the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 7.5.

7 Entry in the Register, Notification and Publication

7.1 Publication and Entry in the Register

Article 20(4) and (9), Article 44, and Article 111(3)(g) EUTMR Article 28(2) and Article 49 EUDR Article 23(7) and Article 70(3)(i) EUDIR

The Office will enter the transfer in the EUTM Register and publish it in the EUTM Bulletin. The entry will be published once the EUTM application has been published pursuant to Article 44 EUTMR.

The entry in the EUTM Register will mention the following data:

- the date of registration of the transfer,
- the new proprietor's name and address,
- the name and address of the new proprietor's representative, if any.

For partial transfers, the entry will also contain the following data:

- the number of the original registration and the number of the new registration,
- the list of goods and services remaining in the original registration, and
- the list of goods and services of the new registration.

7.2 Notification

The Office will notify the applicant of the registration of the transfer.

When the application for registration of the transfer was filed by the assignee, the Office will also inform the EUTM proprietor of the registration of the transfer.

8 Transfers for registered European Union designs

Article 1(3) and Articles 27, 28, 33 and 34 and Articles 72(2)(i) and 72(3)(j) EUDR Article 23 and Article 61(2) and Article 68(1)(c) EUDIR.

The legal provisions contained in the EUDR and EUDIR in respect of transfers correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Therefore, both the legal principles and the procedure in respect of the registration of trade mark transfers apply *mutatis mutandis* to REUDs, except for the following specific procedures.

8.1 Rights of prior use for an REUD

Article 22(4) EUDR

The right of prior use for an REUD cannot be transferred except where the third person, who owned the right before the filing or priority date of the application for an REUD, is a business, along with that part of the business in the course of which the act was done or the preparations were made.

9 Transfers for international trade marks

The Madrid System allows for the recording of a 'change of ownership' of an international registration.

All requests to record a change in ownership must be submitted on form MM5:

- directly to the International Bureau by the recorded holder; or
- through the office of the contracting party of the recorded holder or through the office of a contracting party in respect of which the transfer is granted; or
- through the office of the contracting party of the new proprietor (transferee).

The request to record a transfer cannot be submitted directly to the International Bureau by the new proprietor. The Office's own application form should **not** be used.

Detailed information on changes in ownership can be found in paragraph 597 and the following ones of the Guide to the Madrid System. See also the Guidelines, Part M, International Marks.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 3

EUTMs and REUDs as objects of property

Chapter 2

Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings or similar proceedings

1 Introduction

Articles 19 to 29 EUTMR

Articles 27 to 34 EUDR

Articles 23 to 26 EUDIR

Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings

Decision No EX-25-05 of the Executive Director of the Office of 7 April 2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database

Both registered European Union trade marks (EUTMs) and EUTM applications may be the subject of licensing contracts (licences), rights *in rem* or levies of execution, or be affected by insolvency or similar proceedings. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

Both registered European Union designs (REUDs) and applications for an REUD may be the subject of licences, rights *in rem* or levies of execution, or be affected by insolvency or similar proceedings.

The provisions in the EUDR and EUDIR dealing with design licences, rights *in rem* concerning designs, levies of execution concerning designs, and insolvency and similar proceedings concerning designs are almost identical to the corresponding provisions of the EUTMR and EUTMIR respectively. **Therefore, the following applies *mutatis mutandis* to REUDs**. **Exceptions and specific provisions for REUDs are detailed in paragraph 8 below.** Specific procedures for international trade marks are laid down in paragraph 9 below.

This section of the Guidelines deals with the procedures for registering, cancelling or modifying licences, rights *in rem*, levies of execution and insolvency proceedings or similar proceedings.

1.1 Definition of licence contracts

A trade mark licence is a contract by virtue of which the proprietor of a trade mark (the licensor), whilst retaining ownership, authorises a third person (the licensee) to use the trade mark in the course of trade, under the terms and conditions set out in the contract.

A licence refers to a situation where the rights of the licensee to use the EUTM arise from a contractual relationship with the proprietor. The proprietor's consent to, or tolerance of, a third party using the trade mark does not amount to a licence.

1.2 Definition of rights *in rem*

A right *in rem* or 'real right' is a limited property right that is an absolute right. Rights *in rem* refer to a legal action directed towards property, rather than towards a particular person, allowing the owner of the right the opportunity to recover, possess or enjoy a specific object. These rights may apply to trade marks or designs. They may consist, inter alia, in use rights, usufruct or pledges. '*In rem*' is different from '*in personam*', which means directed toward a particular person.

The most common rights *in rem* for trade marks or designs are pledges or securities. They secure the repayment of a debt of the proprietor of the trade mark or design (i.e. the debtor) in such a way that, where the proprietor cannot repay the debt, the creditor (i.e. the owner of the pledge or security) may receive repayment of the debt by, for example, selling the trade mark or design.

There are two types of right *in rem* for which the applicant can request entry in the EUTM Register:

- rights *in rem* that serve the purpose of guaranteeing securities (pledge, charge, etc.);
- rights *in rem* that do not serve as a guarantee (usufruct).

1.3 Definition of levies of execution

A levy of execution is the act by which a court officer appropriates a debtor's property following a judgment of possession obtained by a plaintiff from a court. In this way, a creditor can recover its claim from all the property of the debtor, including from its trade mark rights.

1.4 Definition of insolvency proceedings or similar proceedings

For the purposes of these Guidelines, 'insolvency proceedings' are understood to be the collective proceedings that entail the partial or total divestment of a debtor and the appointment of a liquidator. They may include winding up by, or under the supervision of, a court, creditors' voluntary winding up (with confirmation by the court), administration, voluntary arrangements under insolvency legislation and bankruptcy. 'Liquidator' is understood as any person or body whose function is to administer or liquidate assets of which the debtor has been divested or to supervise the administration of their affairs, and may include liquidators, supervisors of a voluntary arrangement, administrators, official receivers, trustees and judicial factors. 'Court' is understood to be the judicial body or any other competent body of a Member State empowered to open insolvency proceedings or to take decisions in the course of such proceedings. 'Judgment', in relation to the opening of insolvency proceedings or the appointment of a liquidator, is understood to include the decision of any court

empowered to open such proceedings or to appoint a liquidator (for terminology in other territories, see Regulation (EU) 2015/848 on insolvency proceedings).

1.5 Applicable law

Article 19 EUTMR

Article 27 EUDR

The EUTMR does not establish unified and complete provisions applicable to **licences**, **rights *in rem*** or **levies of execution** for EUTMs or EUTM applications. Instead, Article 19 EUTMR refers to the law of a Member State regarding the acquisition, validity and effects of the EUTM as an object of property, and regarding the procedure for levies of execution. To this end, a licence, a right *in rem* or a levy of execution for an EUTM is, in its entirety and for the whole territory of the European Union, assimilated to a licence, to a right *in rem*, or to a levy of execution for a trade mark registered in the Member State in which the EUTM proprietor has its seat or domicile. If the proprietor does not have a seat or domicile in a Member State, the licence, right *in rem* or levy of execution for an EUTM will be dealt with as a licence, right *in rem* or levy of execution for a trade mark registered in the Member State in which the proprietor has an establishment. If the proprietor does not have an establishment in a Member State, the licence, right *in rem* or levy of execution for an EUTM will be dealt with as a licence, right *in rem* or levy of execution for a trade mark registered in Spain (Member State in which the Office has its seat).

This, however, applies only to the extent that Articles 20 to 28 EUTMR do not provide otherwise.

Article 19 EUTMR is limited to the effects of a licence or right *in rem* as an object of property and does not extend to contract law. Article 19 EUTMR does not govern the applicable law or the validity of a licensing contract or right *in rem* contract, which means that the freedom of the contracting parties to submit the licensing contract or the *right in rem* contract to a given national law is not affected by the EUTMR.

Article 21(1) EUTMR

Article 31(1) EUDIR

Article 3(1) of Regulation (EU) 2015/848 on insolvency proceedings

Furthermore, these Guidelines serve to explain the procedure before the Office for registering the opening, modification or closure of **insolvency proceedings** or **similar proceedings**. In accordance with Article 19 EUTMR, all other provisions are covered by national law. Moreover, Regulation (EU) 2015/848 on insolvency proceedings regulates the provisions on jurisdiction, recognition and applicable law in the area of insolvency proceedings.

The regulations specifically state that an EUTM may only be involved in insolvency proceedings opened in the Member State in the territory of which the debtor has its centre of main interests. The only exception is when the debtor is an insurance undertaking or credit institution, in which case the EUTM may only be involved in those proceedings opened in the Member State where that undertaking or institution has been authorised. The 'centre of main interests' should correspond to the place where the debtor conducts the administration of its interests on a regular basis and is, therefore, ascertainable by third parties (for further information on the 'centre of main interests' see Article 3(1) of Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings).

1.6 Advantages of registration

Article 27 and Article 57(3) EUTMR
Article 33 and Article 51(4) EUDR
Article 27(2) EUDIR

Entry in the EUTM Register of a licence agreement, a right *in rem*, a levy of execution, or the opening, modification and closure of insolvency proceedings is not compulsory. However, such registration has particular advantages.

1. In view of the provision of Article 27(1) and (3) EUTMR, vis-à-vis third parties who might have acquired, or have entered in the EUTM Register, rights in the trade mark that are incompatible with the **registered licence, right *in rem* or levy of execution**, the licensee, pledgee or beneficiary respectively may avail itself of the rights conferred by this licence, right *in rem* or levy of execution only:
   - if it was entered in the EUTM Register;
     or
   - if the third party acquired its rights after the date of any legal acts such as those referred to in Articles 20, 22, 23, 25 and 26 EUTMR (a transfer, a right *in rem*, a levy of execution, or a previous licence), knowing of the existence of the licence, right *in rem* or levy of execution.

     In view of Article 27(4) EUTMR, vis-à-vis third parties that might have acquired or have entered in the EUTM Register rights in the trade mark that are incompatible with the **registered insolvency**, the effects will be governed by the law of the Member State in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.
2. Where a **licence or a right *in rem*** for an EUTM is entered in the EUTM Register, the surrender or partial surrender of that mark by its proprietor will only be entered in the EUTM Register if the proprietor establishes that it has informed the licensee or pledgee respectively of its intention to surrender.

   The holder of a licence or the pledgee of a right *in rem* that is registered has, therefore, the right to be informed in advance by the proprietor of the trade mark of its intention to surrender the trade mark.

On entry in the EUTM Register of **insolvency proceedings or a levy of execution** against an EUTM, the proprietor loses its right to act and, therefore, may not perform any actions before the Office (such as withdraw, surrender, transfer, act in *inter partes* proceedings).

3. Where a **licence, right *in rem*, levy of execution, or insolvency proceedings** for, or against, an EUTM is entered in the EUTM Register, the Office will notify the licensee, pledgee, beneficiary or liquidator, respectively, of the approaching expiry of the registration at least six months beforehand.
4. Registering **licences, rights *in rem*, levies of execution and insolvency proceedings** (and their modification and/or cancellation, where applicable) is important for maintaining the veracity of the EUTM Register, particularly in the event of *inter partes* proceedings.

However,

1. when a party to proceedings before the Office has to prove use of an EUTM, if such use has been made by a licensee, it is not necessary for the **licence** to have been entered in the EUTM Register for that use to be considered to be use with the proprietor's consent pursuant to Article 18(2) EUTMR;
2. registration is not a condition for considering the use of a trade mark by a pledgee under the terms of the **right *in rem*** contract to have been made with the consent of the proprietor pursuant to Article 18(2) EUTMR;
3. the Office strongly recommends that liquidators duly inform the Office of the withdrawal, surrender or transfer of EUTMs subject to **insolvency proceedings** prior to the final winding up.

2 Requirements for an Application for Registration of a Licence, Right *in Rem*, Levy of Execution, and Insolvency Proceedings

Articles 22(2), 23(3), 24(3) and 25(5), Article 26 and Article 111(3) EUTMR
Articles 29(2), 30(3), 31(3), 32(5) and 72 EUDR
Articles 24 and 25 EUDIR

The application for registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings must comply with the following conditions.

2.1 Application form

Article 146(6) EUTMR

Article 65(1)(f) EUTMDR

Article 68(1)(d) and Article 80 EUDIR

It is strongly recommended that the application for registration of a licence, a right *in rem*, a levy of execution or insolvency proceedings for an EUTM be submitted electronically via the Office's website (e-recordals). Using e-recordals has advantages, such as the automatic receipt of electronic confirmation of the application and the possibility to use the manager feature to complete the form quickly for as many EUTMs as required.

Articles 20(8) and 26(1) EUTMR

Articles 23(6) and 24(1) EUDIR

A single application for the registration of a **licence** for two or more EUTMs may be made only if the registered proprietor and the licensee are the same and the contracts have the same conditions, limitations and terms in each case (see paragraph 2.5 below).

A single application for the registration of a **right *in rem* or a levy of execution** for two or more registered EUTMs may be submitted only if the registered proprietor and beneficiary are the same in each case.

2.2 Languages

Article 146(6)(a) EUTMR

Article 80(a) EUDIR

The application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings for an EUTM application must be made in the first or second language of the EUTM application.

Article 146(6)(b) EUTMR

Article 80(c) EUDIR

The application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings is filed using the form provided by the Office pursuant to Article 65(1)(f) EUTMDR and Article 68 EUDIR, the form may be used in any of the official languages of the European Union, provided that it is completed in one of the languages of the Office, as far as textual elements are concerned.

2.3 Fees

Article 26(2) and Annex I A(26) and (27) EUTMR Articles 23(3) and 24(1) EUDIR Annex I point (12) EUDR

The application for the registration of a **licence, a right *in rem*** or **a levy of execution** is considered not to have been made until the fee is paid. The amount of this fee is EUR 200 for each EUTM for which the registration is requested.

However, where several registrations of **licences, rights *in rem*** or **levies of execution** have been applied for in one single application and the registered proprietor and the licensee (and contractual terms), pledgee, or beneficiary are the same in all cases, the fee is limited to a maximum of EUR 1 000.

The same maximum amount applies where several registrations of **licences, rights *in rem* or levies of execution** are applied for at the same time, provided that they could have been filed in one single application and that the registered proprietor and the licensee, pledgee or beneficiary are the same in all cases. Furthermore, for the registration of **licences or rights *in rem***, the contractual terms must be the same. For example, an exclusive licence and a non-exclusive licence cannot be filed in the same application, even if they are between the same parties.

Once the corresponding fee has been paid, it will not be reimbursed if the application for registration is refused or withdrawn.

There is no fee for registering **insolvency proceedings** or similar proceedings.

2.4 Parties to the proceedings

2.4.1 Applicants

Articles 22(2), 23(3), 25(5) and 117(1) EUTMR Articles 29(2), 30(3) and 32(5) EUDR

An application for the registration of a **licence**, of a **right *in rem*** or of a **levy of execution** at the Office may be filed by:

1. the EUTM proprietor(s); or
2. the EUTM proprietor(s) jointly with the licensee(s)/pledgee(s)/beneficiary(ies); or
3. the licensee(s)/pledgee(s)/beneficiary(ies).

Where the Office receives documents relating to such existing rights on EUTMs or REUDs from third parties or authorities such as national Registers or national Courts, it will forward the documents to the EUTM proprietor/REUD holder with a notice indicating that such a right could be entered in the EUTM or EUD Register upon request and payment of the relevant fees. Additionally, if the rights holder (pledgee or beneficiary) is fully identified by its contact details, the same notice will also be sent, for information only, to the pledgee(s)/beneficiary(ies). The document will be incorporated into the files relating to the EUTM or REUD affected.

Article 24(3) EUTMR Article 31(3) EUDR

The application for the registration of **insolvency proceedings** may be requested by:

1. a Court, or
2. competent national authorities, including the liquidator in the insolvency proceedings; or
3. any of the parties.

2.4.2 Mandatory indications concerning the EUTM and the licensee, pledgee, beneficiary or liquidator

Articles 24(2) and 26(1) EUTMR Article 2(1)(b) and (e) EUTMIR Article 13 EUTMDR Article 31 EUDR Article 1(1)(b) and (e), Articles 23 and 24 EUDIR

The application for registration of a licence, a right *in rem*, a levy of execution or insolvency proceedings must contain the following information.

1. The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the registration numbers must be indicated.
   Additionally, for **insolvency proceedings**, the Office will register the **insolvency proceedings** against **all** EUTMs/REUDs linked to the proprietor's ID number at the Office.

   Where the proprietor is the joint proprietor of an EUTM or REUD, the **insolvency proceedings** will apply to the share of the joint proprietor.
2. The licensee's, pledgee's, beneficiary's or liquidator's name, address and nationality (for REUDs only), as well as the State in which it is domiciled or has its seat or an

establishment. However, if the Office has already assigned an ID number to them, it is sufficient to indicate this number together with the name.

3. If the licensee, pledgee, beneficiary or liquidator designates a representative, the representative's name and ID number assigned by the Office. If the representative has not yet been assigned an ID number, the business address must be indicated.

2.4.3 Signatures

Article 63(1)(a) EUTMDR Article 67(4) EUDIR

Where the requirement of a signature is referred to, in electronic communications, the indication of the sender's name is considered to be equivalent to the signature.

The general rules on signatures apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits).

2.4.4 Representation

Articles 119(2) and 120(1) EUTMR Articles 77(2) and 78(1) EUDR

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation).

2.4.5 Proof

Articles 55 and 64 EUTMDR

For the special provisions and specific requirements with regard to proof, see the paragraphs below. These give details based on the type of right being registered: paragraph 4.1 for licences; paragraph 5.1 for rights *in rem*; paragraph 6.1 for levies of execution; paragraph 7.1 for insolvency proceedings.

2.4.6 Translation of proof

Article 146(6) EUTMR Article 24 EUTMIR Article 80 and Article 81(2) EUDIR

Proof must be as follows.

1. In the language of the Office that has become the language of the proceedings for the registration of the licence, right *in rem*, levy of execution or insolvency proceedings, see paragraph 2.2 above.
2. Or in any official language of the European Union other than the language of the proceedings. In this case, the Office may require a translation of the document into a language of the Office to be submitted within a period specified by the Office. The Office will set a time limit for submission of the translation. If the translation is not submitted within that time limit, the document will not be taken into account and will be considered not to have been submitted.

2.5 Examination of the application for registration

2.5.1 Fees

Article 26(2) EUTMR Articles 23(3) and 24(1) EUDIR

Where the required fee has not been received, the Office will notify the applicant that the application is considered not to have been filed because the relevant fee has not been paid. However, a new application may be submitted at any time providing the correct fee is paid from the outset.

There is no fee for applications for the registration of **insolvency proceedings** or similar proceedings.

2.5.2 Examination of the mandatory formalities

Article 24(1) EUTMR Article 31(1) EUDR

For **insolvency proceedings**, the Office will check that there are no other pending recordals and that no insolvency proceedings have already been registered for the proprietor concerned.

Article 26(4) EUTMR Article 24(3) EUDIR

The Office will check whether the application for registration complies with the formal conditions mentioned in paragraph 2.4 above and with the specific requirements given below, based on the type of right being registered (see paragraph 4.1 for licences, paragraph 5.1 for rights *in rem*, paragraph 6.1 for levies of execution, and paragraph 7.1 for insolvency proceedings).

Article 26 and Article 120(1) EUTMR

Article 78(1) EUDR

Article 24 EUDIR

The Office will check whether the application for registration of the **licence, right *in rem*, levy of execution or insolvency proceedings** has been duly signed. Where the application is signed by the licensee's, pledgee's, beneficiary's or liquidator's representative, an authorisation may be required by the Office or, in the case of *inter partes* proceedings, by the other party to the proceedings. In this case, if no authorisation is submitted, the proceedings will continue as if no representative had been appointed.

Where the application for registration of the **licence, right *in rem, insolvency proceedings*** or **levy of execution** is signed by the representative that has already been designated as the proprietor's representative for the EUTM in question, the requirements relating to signatures and authorisations are fulfilled.

Article 26(4) EUTMR

Article 24(3) EUDIR

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the period established in that communication, the Office will reject the application for registration of the right.

For additional specific formalities that concern only **licences** and **rights *in rem***, see the special provisions below (paragraphs 4.3 and 4.4 for licences, and paragraph 5.2 for rights *in rem*).

3 Procedure for Cancellation or Modification of the Registration

Articles 29(1) and 117(1) EUTMR

Article 26(1) EUDIR

The registration of a **licence**, a **right *in rem***, a **levy of execution** or **insolvency proceedings** will be cancelled or modified at the request of an interested party, that is, the applicant or proprietor of the EUTM or the registered licensee, pledgee, beneficiary or liquidator. In **insolvency proceedings**, it may also be the relevant national authority or court.

A registration of a **licence** or **right *in rem*** may also be transferred (see paragraph 4.6 for licences and paragraph 5.4 for rights *in rem*). The application should make a clear distinction between a request for modification and a request for transfer.

The Office will refuse the cancellation, transfer and/or modification of a **licence, sublicence** or **right *in rem*** if the main licence or right *in rem* has not been entered in the EUTM Register.

3.1 Competence, languages, presentation of the request

Article 29(3) and (6), and Article 162 EUTMR

Article 104 EUDR

Article 26(3), (6) and (7) EUDIR

Paragraphs 2.1 and 2.2 above apply.

It is strongly recommended that requests for cancellation or modification of a **licence, right *in rem*, levy of execution or insolvency proceedings** be submitted using the official forms available on the Office's website. Parties to the proceedings may also use WIPO Model International Form No 1, 'Request for Amendment/Cancellation of Recordal of License', (found in the annex to the Joint Recommendation concerning trademark licenses adopted by the Assembly of the Paris Union and the General Assembly of WIPO on 25/09/2000 to 03/10/2000), which can be downloaded at http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf, or a form with a similar content and format.

3.2 Applicant for a cancellation or modification request

Article 29(1) and (6) and Article 117(1) EUTMR

Article 26(1), (4) and (6) EUDIR

Requests for cancellation or modification of a registration may be submitted by the same parties who can file applications for registration (see paragraph 2.4.1 above).

3.2.1 Licences

3.2.1.1 Cancellation of a licence

In the case of a joint request submitted by the EUTM proprietor and the licensee, or of a request submitted by the licensee, no proof of the cancellation of the licence is required, since the request itself implies a statement from the licensee that it consents to the cancellation of the registration of the licence. However, a request for cancellation submitted by the EUTM proprietor alone must be accompanied by proof that the registered licence no longer exists, or by a declaration from the licensee to the effect that it consents to the cancellation.

Where a registered licensee alone submits a request for cancellation, the EUTM proprietor will not be informed thereof.

If the EUTM proprietor alleges fraud on the part of the licensee, it must submit a final decision of the competent authority to this effect. It is not within the remit of the Office to carry out any investigation in that respect.

Where several licences were requested simultaneously, it is possible to cancel them individually.

The entry in the EUTM Register of licences that are limited in time, that is, temporary licences, does not automatically expire but must be cancelled from the EUTM Register.

3.2.1.2 Modification of a licence

In the case of a joint request from the EUTM proprietor and the licensee, no further proof of the modification of the licence is required.

If the request is made by the EUTM proprietor, proof of the modification of the licence is required only where the modification for which entry in the EUTM Register is requested is of such a nature that it would diminish the rights of the registered licensee under the licence. For example, this would be the case if the licensee's name were to change, if an exclusive licence were to become a non-exclusive licence, or if the licence were to become restricted regarding its territorial scope, the period of time for which it is granted, or the goods or services to which it applies.

If the request is made by the registered licensee, proof of the modification of the licence is required only where the modification for which entry in the EUTM Register is requested is of such a nature that it would extend the rights of the registered licensee under the licence. For example, this would be the case if a non-exclusive licence were to become an exclusive licence, or if any registered restrictions of the licence as to its territorial scope, the period of time for which it is granted, or the goods or services to which it applies, were to be cancelled fully or in part.

Where proof of the modification of the licence is necessary, it is sufficient if any of the documents referred to in paragraph 4.1.4 below are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the licence contract and must relate to the registration of the modification of the licence as requested.
- The request for modification or cancellation of a licence must indicate how the licence has been modified.
- The copy or extract of the licence agreement must be of the licence as modified.

3.2.2 Rights *in rem*

3.2.2.1 Cancellation of the registration of a right *in rem*

If the EUTM proprietor and the pledgee submit a joint request, or if the pledgee alone submits a request, no proof of the cancellation of the registration of the right

in rem is required, since the request itself implies a statement by the pledgee that it consents to the cancellation of the registration of the right *in rem*. When the request for cancellation is submitted by the EUTM proprietor, it must be accompanied by proof that the registered right *in rem* no longer exists, or by a declaration by the pledgee that it consents to the cancellation.

Where the registered pledgee submits the request for cancellation by itself, the EUTM proprietor will not be informed thereof.

Where the registration of several rights *in rem* was requested simultaneously, it is possible to cancel them individually.

3.2.2.2 Modification of the registration of a right *in rem*

If the EUTM proprietor and the pledgee submit a joint request, no further proof of the modification of the registration of the right *in rem* is required.

If the request is submitted by the EUTM proprietor or the registered pledgee, proof of the modification of the registration of the right *in rem* is required.

Where proof of the modification of the registration of the right *in rem* is necessary, it is sufficient if any of the documents referred to in paragraph 5.1.4 below are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the right *in rem* agreement and must relate to the registration of the modification of the right *in rem* as requested.
- The request for modification or cancellation of the registration of a right *in rem* must show the right *in rem* in its modified form.
- The copy or extract of the right *in rem* agreement must show the right *in rem* in its modified form.

3.2.3 Levies of execution

3.2.3.1 Cancellation of the registration of a levy of execution

A request for cancellation of the registration of a levy of execution must be accompanied by proof that the registered levy of execution no longer exists. This proof comprises the final decision of the competent authority.

3.2.3.2 Modification of the registration of a levy of execution

A levy of execution may be modified on submission of the corresponding final decision of the competent authority showing such modification.

3.2.4 Insolvency proceedings

3.2.4.1 Cancellation of the registration of an insolvency

A request for the cancellation of the registration of insolvency proceedings must be accompanied by proof that the registered insolvency no longer exists. This proof comprises the final decision of the competent authority.

3.2.4.2 Modification of the registration of an insolvency

The registration of insolvency proceedings may be modified on submission of the corresponding final decision of the competent authority showing such modification.

3.3 Contents of the request

Article 29(1) EUTMR

Article 12 EUTMIR

Articles 19 and 26 EUDIR

Paragraph 2.4 above applies, except that the data concerning the licensee, pledgee, beneficiary or liquidator need not be indicated except in the case of a modification of the registered licensee's, pledgee's, beneficiary's or liquidator's name.

Paragraph 4.2 below applies if a modification of the scope of a **licence** is requested, for example, if a licence becomes a temporary licence or if the geographical scope of a licence is changed.

3.4 Fees

3.4.1 Cancellation

Article 29(3) and Annex I A(27) EUTMR

Article 26(3) EUDIR

For EUTMs, any request for the cancellation of **licences**, **rights *in rem*** and **levies of execution** is considered not to have been made until the fee is paid. The fee is EUR 200 for each EUTM for which cancellation is requested.

However, where several requests for cancellations of licences, rights *in rem* and levies of execution are applied for in one single application or at the same time, and the registered proprietor and the licensee (including contractual terms), pledgee, or

beneficiary are the same in all cases, the cancellation fee is limited to a maximum of EUR 1 000.

This applies irrespective of how the initial applications for registration of these licences, rights *in rem* or levies of execution were filed. This means that, even where the initial applications for registration of these rights were staggered over time and could not, therefore, benefit from the maximum fee of EUR 1 000, they can still benefit from the maximum fee of EUR 1 000 if their cancellation is requested in the same application for cancellation.

Requests for cancellation of the registration of **insolvency proceedings** are not subject to a fee.

For REUDs, requests for the cancellation of **licences**, **rights *in rem,* levies of execution** and **insolvency proceedings** are not subject to a fee.

3.4.2 Modification

Article 29(3) EUTMR

Article 26(6) EUDIR

Modification of the registration of a licence, a right *in rem*, a levy of execution, or insolvency proceedings is not subject to a fee.

3.5 Examination of requests for cancellation or modification

3.5.1 Fees

Article 29(3) EUTMR

For EUTMs, where the required fee for a request for cancellation of a **licence**, a **right *in rem***, or a **levy of execution** has not been received, the Office will notify the applicant that the request for cancellation is considered not to have been filed.

As seen above, requests for cancellation of the registration of **insolvency proceedings** are not subject to a fee.

For REUDs, requests for the cancellation of **licences**, **rights *in rem,* levies of execution** and **insolvency proceedings** are not subject to a fee.

3.5.2 Examination by the Office

Article 29(2) and (4) EUTMR Article 26(2) and (4) EUDIR

For the mandatory elements of the request, paragraph 2.5.2 above applies *mutatis mutandis*, including in respect of proof, to the extent that such proof is required. Additionally, specific formalities apply to **licences** (see paragraph 4.3 below), to **rights *in rem*** (see paragraph 5.2 below), to **levies of execution** (see paragraph 6.1 below) and to **insolvency proceedings** (see paragraph 7.1 below).

The Office will notify the applicant for cancellation or modification of any deficiency, setting a time limit of 2 months. If the deficiencies are not remedied, the Office will reject the request for cancellation or modification.

Article 29(1), (2), (4) and (5), Articles 111(6) and 117(1) EUTMR Article 72(7) EUDR and Article 26(6) EUDIR

Paragraph 4.4 below applies to the extent that modification of the **licence** would affect its nature or its limitation to a part of the goods and services covered by the EUTM.

Registration of the cancellation or modification of a **licence**, a **right *in rem***, a **levy of execution** or **insolvency proceedings** will be communicated to all the parties concerned.

3.6 Registration and publication

Articles 111(3)(s) and 116(1)(a) EUTMR Article 72(3)(t) EUDR and Article 70(2) EUDIR

The creation, cancellation or modification will be entered in the EUTM Register or EUD Register and published in the EUTM Bulletin or EUD Bulletin.

4 Licences - Special Provisions

4.1 Requirements concerning proof

Article 19 and Article 26(1) EUTMR

Articles 2(1)(b) and 13(3)(a) EUTMIR

Article 27 EUDR

Article 1(1)(b) and Articles 23(4) and 24(1) EUDIR

4.1.1 Application made by the EUTM proprietor alone

When an application for the registration of a licence is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

No proof of the licence is necessary.

The Office will inform the licensee when the licence is registered in the EUTM Register.

The licensee may file a statement with the Office to oppose the registration of the licence. The Office will not take any further action on the statement but will register the licence. Following the registration of the licence, any licensee that disagrees with the registration of the licence may request the cancellation or modification of the licence (see paragraph 3 above).

The Office will not take into account whether or not the parties, although having agreed to a licence contract, have agreed to register it at the Office. Any dispute regarding the licence is a matter that must be resolved among the parties concerned under the relevant national law (Article 19 EUTMR).

4.1.2 Application made jointly by the EUTM proprietor and the licensee

When an application for the registration of a licence is made jointly by the EUTM proprietor and its licensee, it must be signed both by the EUTM proprietor and the licensee. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the licence.

Where there is a formal deficiency regarding the signature of the licensee or regarding its representative, the application will still be accepted as long as it would have been acceptable if it had been presented by the EUTM proprietor alone.

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or regarding its representative, but where the application would have been acceptable if it had been presented by the licensee alone.

4.1.3 Application made by the licensee alone

An application for the registration of a licence may also be made by the licensee alone. In this case, it must be signed by the licensee and proof of the licence must be submitted.

4.1.4 Proof of the licence

There is sufficient proof of the licence if the application for registration of the licence is accompanied by any of the following.

- A declaration stating that the EUTM proprietor agrees to the registration of the licence, signed by the EUTM proprietor or its representative.
  According to Article 13(3)(a) EUTMIR, it is also considered sufficient proof if an application for registration of the licence is signed by both parties. This case has already been dealt with in paragraph 4.1.2 above.
- The licence agreement, or an extract therefrom, indicating the parties and the EUTM being licensed, and bearing their signatures.
  In many cases, the parties to the licence agreement will not wish to disclose all the details, which may contain confidential information on the licence royalties or other terms and conditions of the licence. In such cases, it is sufficient if only a part or an extract of the licence agreement is submitted, as long as it identifies the parties to the licence agreement, confirms that the EUTM in question is the subject of a licence and contains the signatures of both parties. All other elements may be omitted or blacked out.
- An uncertified statement of licence using the complete WIPO Model International Form No 1 ‘Request for Recordal of License’. The form must be signed by both the EUTM proprietor, or its representative, and the licensee, or its representative. It can be found at http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf
  It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

4.2 Optional contents of the application

Articles 25(1) and 26(3) EUTMR Article 32(1) EUDR Article 25 EUDIR

Depending on the nature of the licence, an application for registration of the licence may contain the request to register the licence together with other indications, namely those referred to under letters a) to e) below. These indications may be individual or in any combination, for one licence (e.g. an exclusive licence limited in time) or for several licences (e.g. one exclusive licence for A as regards Member State X and another for B as regards Member State Y). They are entered in the EUTM Register by the Office only if the application for registration of the licence itself clearly requests that they be registered. Without such an explicit request, the Office will not enter in the EUTM Register any indications contained in the licence agreement that are submitted, for example, as proof of the licence.

However, if entry in the EUTM Register is requested for one or more of these indications, the following details must be indicated.

1. Where an application for the registration of a licence is limited to only some of the goods or services, the goods or services for which the licence has been granted must be indicated.
2. Where an application is for the registration of a licence as a territorially limited licence, the application must indicate the part of the European Union for which the licence has been granted. A part of the European Union may consist of one or several Member States or one or several administrative districts within a Member State.
3. Where registration of an exclusive licence is sought, a statement to this effect must be made in the application for registration.
4. Where the registration of a licence granted for a limited period of time is sought, the expiry date of the licence must be specified. Furthermore, the date of the commencement of the licence may be indicated.
5. Where the licence is granted by a licensee whose licence is already entered in the EUTM Register, the application for registration may indicate that it is for a sublicence. Sublicences cannot be registered without first registering the main licence.

4.3 Examination of specific formalities (licences)

Article 26(4) EUTMR

Article 24(3) EUDIR

Where an application for the registration of a licence has been made jointly by the EUTM proprietor and the licensee, the Office will communicate with the EUTM proprietor and send a copy to the licensee.

Where the licensee has also made and signed the application, it will not be allowed to contest the existence or scope of the licence.

Where the application for registration of the licence is filed by the EUTM proprietor alone, the Office will not inform the licensee.

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, which will normally be 2 months following the date of the notification, the Office will reject the application.

4.4 Examination of optional elements (licences)

Article 26 EUTMR

Article 25 EUDIR

Where an application for the registration of a licence specifies that the licence be registered as one of the following:

- an exclusive licence;
- a temporary licence;
- a territorially limited licence;
- a licence limited to certain goods or services; or
- a sublicence,

the Office will examine whether the indications mentioned in paragraphs 2.4 and 4.1 above are indicated.

As far as the indication ‘exclusive licence’ is concerned, the Office will accept only this term and not any other wording. If ‘exclusive licence’ is not expressly indicated, the Office will consider the licence to be non-exclusive.

Where an application for registration indicates that it is for a licence limited to certain goods or services covered by the EUTM, the Office will check whether the goods and services are properly grouped and are actually covered by the EUTM.

As far as a sublicence is concerned, the Office will check whether it has been granted by a licensee whose licence has already been entered in the EUTM Register. The

Office will refuse the registration of a sublicence when the main licence has not been entered in the EUTM Register. However, the Office will not check the validity of an application for the registration of a sublicence as an exclusive licence when the main licence is not an exclusive licence. Nor will it examine whether the main licence contract excludes granting sublicences.

It is the duty of the applicant for the registration of a licence not to conclude and register incompatible contracts and to request the cancellation or modification of entries in the Register that are no longer valid. For example, if an exclusive licence has been registered without limitation as to the goods and the territory, and the registration of another exclusive licence is applied for, the Office will register that second licence, even where both licences seem incompatible at first sight.

Parties are, furthermore, encouraged to update all EUTM Register information regularly and swiftly by cancelling or modifying existing licences (see paragraph 3 above).

Article 25(1), and Article 26(3) and (4) EUTMR Article 32(1) EUDR Articles 24(3) and 25 EUDIR

If the indications mentioned in paragraph 4.2 above are missing, the Office will invite the applicant for the registration of the licence to submit the supplementary information. If the applicant does not reply to that communication, the Office will not take into account the abovementioned indications and will register the licence without mentioning them.

4.5 Registration procedure and publication (licences)

Article 25(5) and Articles 111(3)(j) and 116(1)(a) EUTMR Articles 32(5) and 72(3)(t) EUDR Article 70(2) EUDIR

The Office will enter the licence in the EUTM or EUD Register and publish it in the EUTM Bulletin or EUD Bulletin.

Where applicable, the entry in the EUTM or EUD Register will only mention that the licence is:

- an exclusive licence;
- a temporary licence;
- a territorially limited licence;
- a sublicence; or
- a licence limited to certain goods or services covered by the EUTM.

The following details will not be published:

- the period of validity of a temporary licence;

- the territory covered by a territorially limited contract;
- the goods and services covered by a partial licence.

Article 111(6) EUTMR Article 72(6) EUDR

The Office will notify the applicant for a registration of a licence of the registration thereof.

When an application for registration of a licence was filed by the licensee, the Office will also inform the EUTM proprietor or REUD holder of the registration of the licence.

4.6 Transfer of a Licence

4.6.1 Provision for the transfer of a licence

Article 25(5) EUTMR Article 32(5) EUDR

A licence concerning an EUTM may be transferred. The transfer of a licence is different from the transfer of a sublicence insofar as, in the former, the licensee loses all its rights under the licence and is replaced by a new licensee, whereas, in the case of the transfer of a sublicence, the main licence remains in force. Likewise, the transfer of a licence is different from a change of name of the owner where no change of ownership is implied (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and REUDs as Objects of Property, Chapter 1, Transfer).

4.6.2 Applicable rules

Article 26(1) and (5) and Annex I A(26)(b) EUTMR Article 24(1) and (3) EUDIR Annex (12)(b) EUDR

The procedure for the registration of a transfer of a licence follows the same rules as for an application for registration of a licence.

The transfer of a licence is subject to the payment of a fee. Paragraph 2.3 above applies *mutatis mutandis*.

To the extent that a declaration by or signature of the EUTM proprietor is required in accordance with the rules, its place will be taken by a declaration by or signature of the registered licensee (the former licensee).

5 Rights *in Rem* - Special Provisions

5.1 Requirements concerning proof

Article 19 and Article 26(1) EUTMR

Articles 2(1)(b) and 13(3)(a) EUTMIR

Article 27 EUDR

Article 1(1)(b), Articles 23(4) and 24(1) EUDIR

5.1.1 Application submitted by the EUTM proprietor alone

When an application for the registration of a right *in rem* is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

The signature of the EUTM proprietor constitutes proof of the right *in rem*. Consequently, no additional proof of the right *in rem* is necessary.

The Office will inform the pledgee when the right *in rem* is registered in the EUTM Register.

Where the pledgee files a statement with the Office to oppose the registration of the right *in rem*, the Office will forward the statement to the EUTM proprietor for information purposes only. The Office will not take any further action on the statement. Following the registration of the right *in rem*, any pledgee that disagrees with the registration of the right *in rem* may request the cancellation or modification of the registration of the right *in rem* (see paragraph 3 above).

The Office will not take into account whether the parties have agreed to register a right *in rem* contract at the Office. Any dispute regarding the right *in rem* is a matter that must be resolved between the parties concerned under the relevant national law (Article 19 EUTMR).

5.1.2 Application submitted jointly by the EUTM proprietor and the pledgee

When an application for the registration of the right *in rem* is submitted jointly by the EUTM proprietor and the pledgee, it must be signed by both parties. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the right *in rem*.

Where there is a formal deficiency regarding the signature of the pledgee or regarding its representative, the application will still be accepted as long as it would have been acceptable if it had been submitted by the EUTM proprietor alone.

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or its representative, but where the application would have been acceptable if it had been submitted by the pledgee alone.

5.1.3 Application submitted by the pledgee alone

An application may also be submitted by the pledgee alone. In this case, it must be signed by the pledgee and proof of the right *in rem* must be submitted.

5.1.4 Proof of the right *in rem*

There is sufficient proof of the right *in rem* if the application for registration of the right *in rem* is accompanied by any of the following.

- A declaration signed by the EUTM proprietor stating that it agrees to the registration of the right *in rem*.
  According to Article 13(3)(a) EUTMIR, it is also considered sufficient proof if an application for registration of the right *in rem* is signed by both parties. This case has already been dealt with in paragraph 5.1.2 above.
- The right *in rem* contract, or an extract therefrom indicating the EUTM at issue and the parties, and bearing their signatures.
  It is sufficient if the right *in rem* contract is submitted. In many cases, the parties to the right *in rem* contract will not wish to disclose all the details of the contract, which may contain confidential information about the terms and conditions of the pledge. In such cases, it is sufficient if only a part or an extract of the right *in rem* contract is submitted, as long as it identifies the parties to the right *in rem* contract and the EUTM that is subject to a right *in rem*, and bears the signatures of both parties. All other elements may be omitted or blacked out.
- An uncertified statement of a right *in rem*, signed by both the EUTM proprietor and the pledgee.
  It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

5.2 Examination of specific formalities requirements (rights *in rem*)

Article 26(4) EUTMR Article 24(3) EUDIR

Where an application for registration of a right *in rem* has been submitted jointly by the EUTM proprietor and the pledgee, the Office will communicate with the EUTM proprietor and send a copy to the pledgee.

Where the pledgee has also submitted and signed the application, it will not be allowed to contest the existence or scope of the right *in rem* agreement within the Office's proceedings, notwithstanding what could be established by the national laws of the Member States in this regard.

If the EUTM proprietor alleges fraud on the part of the pledgee, it must provide a final decision of the competent authority to this effect. It is not up to the Office to carry out any investigation into such a claim.

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit fixed in that communication, the Office will reject the application.

5.3 Registration procedure and publication (rights *in rem*)

Articles 22(2) and 26(5) and Article 111(3)(h) and Article 111(6) EUTMR Article 29(2) and Article 72(3)(k) and Article (6) EUDR Article 24(4) EUDIR

The Office will enter the right *in rem* in the EUTM or EUD Register and publish it in the EUTM Bulletin or EUD Bulletin.

The Office will notify the applicant for registration of a right *in rem* of the registration thereof.

When an application for registration of a right *in rem* was filed by the pledgee, the Office will also inform the EUTM proprietor or REUD holder of the registration.

5.4 Transfer of a Right *in rem*

Article 26(1) and (5) and Annex I A(26)(d) EUTMR
Article 24(1) EUDIR
Annex I point (12)(d) EUDR

5.4.1 Provision for the transfer of a right *in rem*

A right *in rem* may be transferred.

5.4.2 Applicable rules

The procedure for the registration of a transfer of a right *in rem* follows the same rules as for the registration of a right *in rem*.

The transfer of a right *in rem* is subject to the payment of a fee. Paragraph 2.3 above applies *mutatis mutandis*.

To the extent that a declaration by or signature of the EUTM proprietor is required in accordance with the rules, it must be replaced by a declaration by or signature of the registered pledgee (the former pledgee).

6 Levies of Execution - Special Provisions

6.1 Requirements concerning proof

Article 26(1) EUTMR
Article 2(1)(b) EUTMIR
Article 1(1)(b) and Article 24(1) EUDIR

6.1.1 Application filed by the EUTM proprietor

When an application for the registration of a levy of execution is made by the EUTM proprietor, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

The Office will inform the beneficiary when the levy of execution is registered in the EUTM Register.

The beneficiary may file a statement with the Office to oppose the registration of the levy of execution. The Office will not take any further action on such a statement.

Following the registration of the levy of execution, any beneficiary that disagrees with the registration of the levy of execution may request the cancellation or modification of the registration of the levy of execution (see paragraph 3 above).

Any dispute regarding the levy of execution is a matter that must be resolved between the parties concerned under the applicable national law (Article 19 EUTMR).

6.1.2 Application filed by the beneficiary

An application for registration of a levy of execution may also be filed by the beneficiary. In this case, it must be signed by the beneficiary.

In addition, proof of the levy of execution must be submitted.

6.1.3 Proof of the levy of execution

There is sufficient proof of the levy of execution if the application for registration of a levy of execution is accompanied by a final decision of the competent national authority

In many instances, the parties to the levy of execution proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the levy of execution judgment is submitted, as long as it identifies the parties to the levy of execution proceedings and the EUTM that is subject to the levy of execution, and confirms that the judgment is final. All other elements may be omitted or blacked out.

6.2 Registration procedure and publication (levy of execution)

Articles 111(3)(i) and 116(1)(a) EUTMR Article 72(3)(l) EUDR and Article 70(2) EUDIR

When the right is registered, the levy of execution will be entered in the EUTM or EUD Register and published in the EUTM Bulletin or EUD Bulletin.

The Office will notify the applicant for registration of a levy of execution of the registration thereof.

Where applicable, the EUTM proprietor or REUD holder will also be informed.

7 Insolvency Proceedings - Special Provisions

7.1 Requirements concerning proof

There is sufficient proof of the appointment of a liquidator and of the insolvency proceedings if an application for registration of the insolvency proceedings is accompanied by a final decision of the competent national authority.

It suffices if the insolvency judgment is submitted. In many instances, the parties to the insolvency proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the judgment is submitted, as long as it identifies the parties to the proceedings. All other elements may be omitted or blacked out.

It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

7.2 Registration procedure and publication (insolvency proceedings)

Articles 111(3)(i) and 116(1)(a) EUTMR Article 72(3)(l) EUDR and Article 70(2) EUDIR

When the mark is registered, the insolvency proceedings will be entered in the EUTM Register and published in the EUTM Bulletin. The publication contains the EUTM registration number(s), the name of the authority requesting the entry in the EUTM Register, the date and number of the entry and the publication date of the entry in the EUTM Bulletin.

The Office will notify the applicant for registration of insolvency proceedings of the registration thereof.

The liquidator's contact details are recorded as the EUTM proprietor's 'correspondence address' in the Office's database, and third parties may consult the full details of the insolvency proceedings through an application for inspection of files (see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files).

8 Procedures for registered European Union designs

Articles 27, 29, 30, 31, 32, 32a, 33, 33a and 51(4) EUDR

Articles 24 to 26 and Article 27(2) EUDIR

The legal provisions contained in the EUDR and EUDIR in respect of licences, rights *in rem*, levies of execution and insolvency proceedings correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Therefore, both the legal principles and the procedure in respect of the registration, cancellation or modification of trade mark licences, rights *in rem*, levies of execution or insolvency proceedings apply *mutatis mutandis* to REUDs, except for the following specific procedures.

8.1 Multiple applications for REUDs

Article 37 EUDR

Article 24(1) EUDIR

An application for the registration of licences, rights *in rem* and levies of execution for an REUD may be in the form of a multiple application containing several designs.

For the purposes of the legal effect of licences, rights *in rem* and levies of execution, as well as of the procedure for registering licences, rights *in rem* and levies of execution, the individual designs contained in a multiple application will be dealt with as if they were separate applications. This continues to apply after registration of the designs contained in the multiple application.

In other words, each design contained in a multiple application may be licensed, pledged or levied independently of the others.

For **licences** specifically, the optional indications as to the kind of licence and the procedure for their examination referred to in paragraphs 4.2 and 4.4 above (with the exception of a licence limited to some products, which is not possible), apply to each of the individual designs contained in a multiple application separately and independently.

Point (12) of the Annex to the EUDR

The fee of EUR 200 for the registration of a licence, a right in rem or a levy of execution, or for the transfer of a licence or right in rem applies per design and not per multiple application. However, the ceiling of EUR 1 000 applies where multiple requests are submitted in the same application for registration of a licence or another right.

8.2 Entitlement proceedings for REUDs

Articles 15, 16 and 19 EUDR and Article 72(3)(g), (h) and (i) EUDR

Article 80(c) EUDIR

REUD applications and registrations may be the subject of entitlement proceedings.

Regarding the differences between the registration of a change of ownership following a transfer or entitlement proceedings, see the Guidelines, Part E Register operations, Section 3, Chapter 1 Transfers, paragraph 3.

If an REUD has been applied for or registered in the name of a person who is not entitled to it under Article 14 EUDR, the person entitled to it under that provision, namely the designer or their successor, may claim recognition as the REUD's legitimate holder.

A distinction must be made between proceedings before national courts or authorities and proceedings before the Office.

Entitlement claims must be brought before the competent national court (e.g. specialised courts authorised to handle matters of entitlement in cases of employment or family matters) or the competent national authority (e.g. administrative offices or specialised bodies) in the relevant Member State.

Where a person is jointly entitled to the REUD, that person may, in accordance with Article 15(2) EUDR, claim recognition as joint holder.

Regarding the applicable law for these proceedings, see paragraph 1.5.

The Office is only competent to register the following entries in the EUD Register:

- the mention that legal entitlement proceedings have been initiated before the competent court or authority of the Member State concerned;
- the date and particulars of the final decision of the competent court or authority or any other termination of the entitlement proceedings;
- any change in the REUD's ownership resulting from the final decision of the competent court or authority.

The application for registration must comply with the conditions laid down inparagraph 8.2.1.

The effects of the different entries in the Register are described in paragraph 8.2.3.

8.2.1 Requirements for an application for registration of entries relating to entitlement proceedings

Application form and language of proceedings

An application for registration of entitlement proceedings can be submitted through the 'communications back-up' option in the User Area.

Regarding the language of proceedings, see paragraph 2.2, above.

Fees

There is no fee for registering any of the entries relating to entitlement proceedings.

Parties to the proceedings

A request for the registration of an entry in the Register under Article 15(5) EUDR (the initiation or result of entitlement proceedings) may be filed by:

- the REUD holder(s);
- the person(s) claiming to be the legitimate holder in the entitlement proceedings; or
- the competent national court or authority.

Where the Office receives documents relating to such proceedings from anyone other than the registered REUD holder, it will forward the documents to the holder.

Additionally, if the request does not originate from the person recognised as the legitimate holder but this person is fully identified by their contact details, the Office will also forward the documents to that person.

Mandatory indications

The request for the mention in the Register that entitlement proceedings have been initiated, or terminated, must contain the following information:

- the registration number of the REUD concerned. If the application relates to several REUDs, each of the registration numbers must be indicated;
- the holder's name, address and nationality, as well as the State in which it is domiciled or has its seat or an establishment. However, if the Office has already assigned an ID number to the holder, it is sufficient to indicate this number together with the name.

The application for a change of ownership must additionally contain the following information:

- the name, address and nationality of the person recognised as the legitimate holder of the REUD as well as the State in which it is domiciled or has its seat or an establishment. However, if the Office has already assigned an ID number to the legitimate holder, it is sufficient to indicate this number together with the name.

Regarding signature and representation, see paragraphs 2.4.3 and 2.4.4.

8.2.2 Requirements concerning proof

For entry of the initiation of entitlement proceedings in the Register, the application must be accompanied by evidence that shows the court or authority of the Member State before which entitlement proceedings have been initiated.

For the entry of the final decision or other termination of entitlement proceedings in the Register, the application must be accompanied by evidence that the entitlement proceedings have concluded, such as a final decision of the competent authority or court of the Member State.

8.2.3 Effects of the entries in the Register

Article 16(2) and Article 17 EUDR

Initiation of entitlement proceedings – effects on subsequent requests

The entry of the initiation of entitlement proceedings in the Register freezes the REUD, meaning that any subsequent request for a transfer, licences, levies, insolvencies or rights in rem filed will be suspended.

The proceedings are resumed upon the following entries in the Register:

- an entry indicating the change of ownership as a result of the entitlement proceedings; or
- an entry of the final decision of the competent court or authority rejecting the claim of entitlement or terminating the proceedings in a way that does not change the entitlement over the REUD.

Change of ownership – effect on licences

Where there is a complete change of ownership of an REUD as a result of entitlement proceedings under Article 15(1) EUDR, licences and other rights lapse upon the entering in the Register of the new REUD holder.

Upon registration of the new holder, the Office will inform:

- the new holder that they may request the cancellation of an already registered licence;
- the registered licensee about:
  - the date of registration of the new owner;
  - that the registered licence may be cancelled upon request since it lapsed according to Article 16(1) EUDR; and
  - that the licensee may ask the new holder to grant a new non-exclusive licence within 3 months of the registration of the new holder according to Article 16(2) EUDR.

Upon request of the holder or the licensee, the Office will:

- cancel the registered licence; or
- enter a modification of the already registered licence if the licensee requested a new licence from the new holder under Article 16(2) EUDR.

If the licensee requests a modification of the licence, it must provide proof that the new holder granted a new licence.

The Office will not interfere in arranging the period and terms of the licence between the previous holder/licensee and the new holder. Any dispute regarding the licence is a matter that must be resolved among the parties concerned under the relevant national law (Article 27 EUDR).

Change of ownership – effect on ongoing proceedings

As long as the change of ownership has not been entered in the Register, the allegedly entitled person may not invoke the rights arising from the registration of the REUD (see Article 17 EUDR).

Where there are time limits to be observed vis-à-vis dealings with the Office, the new holder may make the corresponding statements to the Office once the application for registration of the change of ownership has been received by the Office.

9 Procedures for international trade marks

Rules 20 and 20bis Regulations under the Madrid Protocol.

9.1 Recording of licences

The Madrid System allows for the recording of **licences** against an international registration.

All requests for the recording of a licence should be submitted on form MM13 either:

- directly to the International Bureau by the recorded holder; or
- through the office of the contracting party of the recorded holder or through the office of a contracting party in respect of which the licence is granted; or
- through the office of the licensee.

The request cannot be submitted directly to the International Bureau by the licensee. The Office's application form should **not** be used.

Detailed information on the recording of licences can be found in paragraph 703 and the following ones of the Guide to the Madrid System. For further information on international trade marks, see the Guidelines, Part M, International Marks.

9.2 Recording of rights *in rem*, levies of execution or insolvency proceedings

The Madrid System allows for the recording of **rights *in rem***, **levies of execution** or **insolvency proceedings** against an international registration (see Rule 20 of Regulations under the Madrid Protocol). For the convenience of users, form MM19 is available for requesting the recording of a restriction of the holder's right of disposal in the International Register. The use of this form is strongly recommended to avoid irregularities.

Requests should be submitted either:

- directly to the International Bureau by the recorded holder; or
- to the office of the contracting party of the registered holder; or
- to the office of a contracting party to whom the right *in rem*, levy of execution or insolvency is granted; or

- to the office of the contracting party of the pledgee, beneficiary or liquidator.

The request cannot be submitted directly to the International Bureau by the pledgee, beneficiary or liquidator. The Office's application form should **not** be used.

Detailed information on the registration of rights *in rem*, levies of execution or insolvency proceedings can be found in paragraphs 698 and the following ones of the Guide to the Madrid System. For further information on international trade marks, see the Guidelines, Part M, International Marks.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 4

Renewal

1 Fraud Warning

1.1 Private companies sending misleading invoices

The Office is aware that users are receiving an increasing amount of unsolicited mail from companies requesting payment for trade mark and design services such as renewal.

A list of letters from firms or registers that users have complained are misleading is published on the Office website. These services are not connected with any official trade mark or design registration services provided by IP offices or other public bodies within the European Union such as the EUIPO.

If a user receives a letter or invoice, he or she should carefully check what is being offered, and its source. It must be pointed out that the **EUIPO never sends invoices to users or letters requesting direct payment for services** (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

1.2 Renewal by unauthorised third persons

The Office is also aware that fraudsters have targeted the e-renewal module. If, upon filing a request for e-renewal, a user discovers that the mark is 'blocked', as renewal has already been requested, they should contact the Office.

2 Terms of Registration of European Union Trade Marks

Articles 1, 32, 52 and Article 41(5) and (8) EUTMR

The term of registration of a European Union trade mark (EUTM) is 10 years from the **filing date** of the application. For example, an EUTM with a filing date of 16/04/2020 will expire on 16/04/2030.

The filing date of the application is determined according to Articles 31 and 32 EUTMR and Article 41(5) and (8) EUTMR.

A registration may be renewed indefinitely for further periods of 10 years.

3 Terms of Protection of Registered European Union Designs

Articles 12, 38 and 45 EUDR

The term of protection of a registered European Union design (REUD) is 5 years from the **date of filing** of the application (Article 12 EUDR). For example, an REUD with a filing date of 16/04/2020 will expire on 16/04/2025.

The date of filing of the application is determined according to Article 38 EUDR and Article 45 EUDR (see the Guidelines for Examination of Registered European Union Designs, Examination of Applications for Registered European Union Designs, paragraph 3, Allocation of a Filing Date).

A registration may be renewed for periods of 5 years each, up to a total of 25 years from the date of filing.

4 Notification of Expiry of Registration

Article 53(2) EUTMR

Article 60(3) and Article 66 EUTMDR

Article 13(2) EUDR

Articles 21 and 63 EUDIR

At least 6 months before the expiry of the registration, the Office will inform:

- the registered proprietor/holder of the EUTM/REUD, and
- any person having a registered right in respect of the EUTM/REUD

that the registration is approaching expiry. Persons having a registered right include the holders of a registered licence, the proprietors of a registered right *in rem*, the creditors of a registered levy of execution or the authority competent to act on behalf of the proprietor/holder in insolvency procedures.

Failure to give such information does not affect the expiry of the registration and does not involve the responsibility of the Office.

5 Renewal of an EUTM Application

Article 53(2) EUTMR Annex I A(19) EUTMR

In the exceptional circumstance where an application has not yet matured to registration because of pending proceedings, the Office will not send the notice referred to in Article 53(2) EUTMR. The applicant is not obliged to renew its application during proceedings that last for more than 10 years and where the outcome of registration is uncertain. Only once the trade mark is registered will the Office invite the owner to renew the EUTM and pay the relevant renewal fees due. The owner will then have 4 months to pay the renewal fee (including any additional class fees). The surcharge for the renewal fee of 25 % pursuant to Annex I A(19) EUTMR does not apply. If the renewal fee is not paid within the time limit given, the Office will issue a notice that the registration has expired. The expiry will take effect from the date of registration of the EUTM.

6 Renewal of an REUD application

Article 13(2) EUDR Annex to the EUDR point 8

In the exceptional circumstance where an application has not yet matured to registration because of pending proceedings, the Office will not send the notice referred to in Article 13(2) EUDR. The applicant is not obliged to renew its application during proceedings that last for more than 5 years and where the outcome of registration is uncertain. The Office will only invite the owner to renew the REUD and pay the renewal fee once the design has been registered. The owner will then have 4 months to pay the renewal fee. The surcharge for the renewal fee of 25 % pursuant to point 8 of the Annex to the EUDR does not apply. If the renewal fee is not paid within the time limit given, the Office will issue a notice that the registration has expired. The expiry will take effect from the date of registration of the REUD.

7 Fees and other formal requirements for the request for renewal

Articles 63 and 64 EUTMDR

Article 22(8) and Articles 65, 66 and 67 and Article 68(1)(e) EUDIR

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

The general rules concerning communications to the Office apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits), which means that the request may be submitted in the following ways.

- By electronic means available on the EUIPO website (e-renewal available via the User Area). For EUTMs, there is a reduction of EUR 150 on the basic renewal fee for an individual mark using e-renewal (EUR 300 for a collective mark). Entering the name and surname in the appropriate place on the electronic form is deemed to be a signature. In addition, using e-renewal offers additional advantages such as the receipt of immediate electronic confirmation of the renewal request automatically or the use of the renewal manager feature to complete the form quickly for as many EUTMs/REUDs as needed.
- By transmitting a signed original form electronically, by post or by courier (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits). A standard form is available on request to the Office. Forms have to be signed but annexes need not be signed.

Following Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023, EUTM and REUD renewals must be made via e-renewal, post or courier. In cases where technical malfunction prevents e-renewal, renewals by one of the two alternative electronic back-up measures will be treated by the Office only when received within the last three working days before the expiry of: (i) the deadline for renewal or (ii) the extended deadline for renewal.

A single application for renewal may be submitted for two or more EUTMs/REUDs (including REUDs that form part of the same multiple registration), upon payment of the required fees for each EUTM/REUD.

7.1 Persons who may submit a request for renewal

Articles 20(12) and 53(1) EUTMR

Article 50d(1) and Article 28(7) EUDR

The request for renewal may be submitted by:

1. the registered proprietor/holder of the EUTM/REUD;
2. where the EUTM/REUD has been transferred, the successor in title as from the point in time a request for registration of the transfer has been received by the Office;
3. any person expressly authorised by the proprietor/holder of the EUTM/REUD to do so. Such a person may, for instance, be a registered licensee, a non-registered licensee or any other person who has obtained the authorisation of the proprietor/holder to renew the EUTM/REUD.

Professional representation is not mandatory for renewal.

When the renewal request is submitted by a person other than the registered proprietor/holder or its representative on file, an authorisation will have to exist in its favour; however, it does not need to be filed with the Office unless the Office requests it.

When a person other than the proprietor/holder or its representative on file sends a direct payment or submits a request for renewal with the indication that payment will be made by bank transfer, the proprietor/holder will be informed that the renewal will be processed once payment has been received. If no reply is received from the proprietor/holder, or no objection is raised to the renewal, the Office will validate the payment once it reaches the Office and the renewal will be processed.

If the Office receives fees from two different sources, neither of which is the proprietor/holder or its representative on file, the proprietor/holder will be contacted in order to ascertain who is authorised to file the renewal request. Where no reply is received from the proprietor/holder, the Office will validate the payment that reached the Office first (12/05/2009, T-410/07, Jurado, EU:T:2009:153, § 33-35; 13/01/2008, R 989/2007-4, ELITE GLASS-SEAL, § 17-18).

7.2 Content of the request for renewal

Article 53(4) EUTMR Article 50d EUDR

The request for renewal must contain the following: name and address of the person requesting renewal and the registration number of the EUTM/REUD to be renewed. In the case of an EUTM renewal, the extent of the renewal is deemed to cover the full specification by default.

Payment alone can constitute a valid request for renewal, providing such payment reaches the Office and contains the name of the payer, the registration number of the EUTM/REUD and an indication that it is a request for renewal. In such circumstances, no further formalities need to be complied with (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges). Where this option is relied on in EUTM renewals, the payment must be of the renewal fee laid out in Annex I A,

paragraphs (11) or (15) EUTMR and not of the discounted fee for renewal by electronic means pursuant to Annex I A, paragraphs (12) or (16).

Consequently, payment alone cannot constitute a valid request for e-renewal. The discounted fee may only be relied on where a renewal application is submitted by electronic means, as such payment must be accompanied by a valid e-renewal application form.

7.2.1 Name and address and other particulars of the person submitting a request for renewal

Article 2(1)(b) and (e) EUTMIR

Article 50d(4)(a) EUDR

7.2.1.1 Request filed by the proprietor/holder

Where the request is filed by the EUTM/REUD proprietor/holder, its name must be indicated.

7.2.1.2 Request filed by a person authorised to do so by the proprietor/holder

Where the request for renewal is filed by a person authorised by the proprietor/holder to do so, the name and address or the ID number and name of the authorised person in accordance with Article 2(1)(e) EUTMIR or Article 50d(4)(a) EUDR must be indicated.

If the selected payment method is bank transfer, a copy of the renewal request is sent to the proprietor/holder.

7.2.2 Registration number

Article 53(4)(b) EUTMR

Article 50d(4)(b) EUDR

The EUTM/REUD registration number must be indicated.

7.2.3 Indication as to the extent of the renewal

Article 53(4) EUTMR

Article 50d(4)(c) EUDR

For EUTMs, renewal is deemed to cover the entire specification of goods and/or services of the EUTM by default.

Where renewal is requested for only some of the goods or services for which the mark is registered:

- those classes or those goods and services for which renewal is requested must be indicated in a clear and unequivocal way.

Or, alternatively:

- those classes or those goods and services for which renewal is not requested must be indicated in a clear and unequivocal way.

The e-renewal platform only allows for deleting (i.e. not renewing) entire classes; it does not allow for the partial renewal of only some goods or services within a class (i.e. it does not allow the deletion of some of the goods or services listed in a specific class at the time of the renewal). Therefore, where renewal is required for only **some goods or services within a class**, the renewal application can *either* be submitted using any other means of communication accepted by the Office, *or*, the whole class can be renewed through e-renewal and a request for partial surrender can be submitted pursuant to Article 57 EUTMR for those goods or services that the proprietor wishes to remove from the EUTM.

For REUDs, in the case of a multiple registration, an indication that renewal is requested for all the designs covered by the multiple registration or, if the renewal is not requested for all the designs, an indication of the file number for which it is requested. If nothing is indicated, the renewal is deemed to be for all the designs by default.

7.3 Languages

Article 146(6) EUTMR Article 68 and Article 80(b) and (c) EUDIR

The request for renewal may be filed in any of the five languages of the Office. The chosen language becomes the language of the renewal proceedings. However, when the request for renewal is filed by using the form provided by the Office pursuant to Article 65(1)(g) EUTMDR or Article 68(1)(e) EUDIR, such a form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned. This concerns, in particular, the list of goods and services in the event of a partial renewal of an EUTM.

7.4 Time limits

Article 52 and Article 53(3) EUTMR

Article 69(1) EUTMDR

Article 50d(3) EUDR

Articles 56 and 58 EUDIR

Communication No 3/2024 of the Executive Director of the Office of 11 December 2024

7.4.1 Six-month period for renewal before expiry (basic period)

The request for renewal and the renewal fee must be submitted in the 6-month period prior to the expiry of the registration ('the basic period').

For example, where the EUTM has a filing date of 10/06/2021, the day on which protection ends will be 10/06/2031. Therefore, a request for renewal must be introduced and the renewal fee paid as from 11/12/2030 until 10/06/2031 or, where this is a Saturday, Sunday or other day on which the Office is closed, or does not receive ordinary mail within the meaning of Article 69(1) EUTMDR, the first following working day on which the Office is open to the public and does receive ordinary mail.

For example, where the REUD has a filing date of 10/06/2021, the day on which protection ends will be 10/06/2026. Therefore, a request for renewal must be introduced and the renewal fee paid as from 11/12/2025 until 10/06/2026 or, where the latter date is a Saturday, Sunday or other day on which the Office is closed or does not receive ordinary mail within the meaning of Article 58(1) EUDIR, the first following working day on which the Office is open to the public and does receive ordinary mail.

7.4.2 Six-month period following expiry (grace period)

Where the EUTM/REUD is not renewed within the basic period, the request may still be submitted and the renewal fee may still be paid, upon payment of an additional fee (see paragraph 7.5), within a further period of 6 months ('the grace period').

For example, where the EUTM has a filing date of 10/06/2021, the day on which protection ends will be 10/06/2031. Therefore, the grace period during which a request for renewal may still be introduced upon payment of the renewal fee plus the additional fee is counted from the day after 10/06/2031, namely from 11/06/2031, and ends on 10/12/2031 or, if 10/12/2031 is a Saturday, Sunday or other day on which the Office is closed, or does not receive ordinary mail within the meaning of Article 69(1) EUTMDR, the first following working day on which the Office is open to the public and receives ordinary mail. This also applies if in the above example 11/06/2031 was a Saturday or Sunday; the rule that a time limit to be observed vis-à-vis the Office is extended until

the next working day applies only once and to the end of the basic period, and not to the starting date of the grace period. The same approach applies to REUD renewals albeit that the period of protection is 5 years and not 10.

During the 6-month grace period, the only action that may be carried out in an EUTM or REUD is the payment of the renewal fee (including the payment of the additional fee for late payment). In the event the Office receives any other request during the grace period, such as a transfer, registration of a licence, surrender, change of name, etc. or any other request for entry into the Registers, the Office will put the request on hold until the renewal fee is paid. Only once the renewal fee is paid in full, and the EUTM or REUD is officially renewed, will the Office examine any requests that had been placed on hold.

7.4.3 Transitional arrangements for calculating the basic and grace periods for REUDs

The EUDR changed the calculation of the renewal periods for REUDs, which is now aligned with those for EUTMs. Now, the basic period for renewal of REUDs ends on the date of expiry of the registration (previously the last day of the month in which expiry occurred). The 6-month grace period for renewal, therefore, starts on the day after the expiry of the registration.

The practice of the Office reflecting the transitional arrangements is laid down in Communication No 3/2024 of the Executive Director of the Office of 11 December 2024 concerning the caluclation of the Registered Community Design renewal fees and the basic and grace period for renewal in view of the entry into force of the Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002.

This practice is that where the basic 6-month period for renewal started to run **before** the applicability date of the EUDR, the provisions contained in the former Article 13(3) EUDR (before amendment) will apply for calculating both the basic period and, where applicable, the grace period.

For example, where the REUD has a filing date of 15/03/2020, the basic renewal period will run up to and include the last day of the month in which protection ends, namely 31/03/2025. Therefore, a request for renewal must be introduced and the renewal fee paid between 01/10/2024 and 31/03/2025 (both dates inclusive). The grace period would then run from 01/04/2025 up to and including 30/09/2025.

Where the basic 6-month period for renewal starts to run on or after the applicability date of the EUDR, the provisions contained in Article 50d EUDR will apply for calculating both the basic period and, where applicable, the grace period.

For example, where the REUD has a filing date of 24/11/2020, it will expire on 24/11/2025. The basic period for renewal will run from 25/05/2025 up to and including 24/11/2025 (date of expiry). The grace period would then run from 25/11/2025 up to and including 24/05/2026.

7.5 Fees

As regards the calculation of the amount of the renewal fees, the due date for the renewal fees is the date of expiry of the registration (Article 53(3) EUTMR and Article 50d(3) EUDR). This principle applies regardless of the moment at which renewal is actually requested and paid for, with the exception of the transitional arrangements for REUD renewals (see paragraph 7.5.3).

7.5.1 Fees payable for EUTMs

Article 53(3) and Annex I A(11), (12), (13), (14), (15), (16), (17), (18) and (19) EUTMR Communication No 2/16 of the President of the Office of 20/01/2016

The fees payable for the renewal of an EUTM consist of:

- a basic fee that covers the first class of goods/services;
- one or more class fees for each class of goods/services exceeding the first one;
- any additional fee applicable for late payment of the renewal fee or late submission of the request for renewal.

The amount of the renewal fee is as follows.

Basic fee (by e-renewal):

- for an individual mark: EUR 850, and
- for a collective or certification mark: EUR 1 500.

Basic fee (other than by e-renewal):

- for an individual mark: EUR 1 000, and
- for a collective or certification mark: EUR 1 800.

Class fees:

- for the second class: EUR 50,
- for each class exceeding two: EUR 150.

The fee must be submitted in the 6-month period prior to the expiry of the registration (see paragraph 7.4 above).

The additional fee for late payment or late submission is:

- 25% of the belated renewal fee, subject to a maximum of EUR 1 500.

7.5.2 Fees payable for REUDs

Article 50d(3) EUDR Article -106ac and Annex I to the EUDR points 6 and 8

The fees payable for the renewal of an REUD consist of:

- a renewal fee;
- any additional fee applicable for late payment of the renewal fee or late submission of the request for renewal.

The amount of the renewal fee, per design, whether or not included in a multiple registration, is as follows:

- for the first renewal: EUR 150;
- for the second renewal: EUR 250;
- for the third renewal: EUR 400;
- for the fourth renewal: EUR 700.

The fee must be paid within a period of 6 months prior to the expiry of the registration (see paragraph 7.4 above).

The additional fee for late payment or late submission is:

- 25% of the renewal fee.

7.5.3 Transitional arrangements for calculating the amount of REUD renewal fees

The practice of the Office laid down in Communication No 3/2024 is that the fees applied to each renewal will depend on the **DATE OF REQUEST** of the renewal.

For example:

- if the request for renewal is received **on or after** the applicability date of the legal reform, the fees set out in Annex I of the EUDR will apply, regardless of the payment method and whether it is debit now or debit later;
- if a renewal request is received **before** the applicability date of the legal reform, the fees set out in the Annex to the CDFR will apply.

Holders are encouraged to check whether a renewal before or after the applicability is more beneficial to them and act accordingly.

7.5.4 Time limit for payment

Articles 53(3) and 180(3) and Annex I A(19) EUTMR Article 50d(3) EUDR and Annex I to the EUDR points 6 and 8 Article 8(c) and (h) of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025.

The fee must be paid within a basic period of 6 months (for calculation of the period, see paragraphs 7.4.1 and 7.4.3 above).

The fee may be paid within a further grace period of 6 months (see paragraph 7.4.2 and 7.4.3 above), provided that an additional fee for late payment is paid, which amounts to 25 % of the total renewal fee, including any class fees.

Renewal will be effected only if payment of **all** fees reaches the Office within the grace period, this includes all renewal fees, additional fees for payment within the grace period, and surcharges for late payment by bank transfer (see Part A, Section 3, Payment of Fees, Costs and Charges, paragraph 4.1.1) where applicable.

Fees that are paid **before** the start of the basic period of 6 months will not, in principle, be taken into consideration and will be refunded.

7.5.5 Payment by third parties

Article 5 of Decision No EX-25-06 of the Executive Director of the Office of 07/04/2025.

Payment may also be made by the other persons identified in paragraph 7.1 above.

Payment by debiting a current account held by a third party requires an explicit authorisation of the holder of the current account that the account can be debited for the benefit of the particular fee. In such cases, the Office will check if there is an authorisation. If there is no authorisation, a letter will be sent to the renewal applicant asking them to submit the authorisation to debit the account held by a third party. In such cases, payment is considered to be effected on the date the Office receives the authorisation.

7.5.6 Fee refund

Article 53(8) EUTMR Article 50d(8) EUDR

Renewal fees and, where applicable, the additional fee for late payment may be refunded under certain circumstances. For more information, please see the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

8 Procedure Before the Office

8.1 Examination of formal requirements

The examination of the request for renewal is limited to formalities and relates to the following points.

8.1.1 Observation of time limits

Article 53(3), (4) and (8) EUTMR

Article 50d(3), (4) and (8) and Article -106ab(1) and (4) EUDR

8.1.1.1 Payment during the basic period or the grace period

Where the request for renewal is filed and the renewal fee is paid within the basic period, the Office will record the renewal, provided that the other conditions laid down in the EUTM or REUD Regulations are fulfilled (see paragraph 8.1.2).

Where no request for renewal has been filed, but the payment of a renewal fee reaches the Office that contains the minimum identification elements (see paragraph 7.2), this constitutes a valid request and no further formalities need be complied with. This is pursuant to Article 53(4) EUTMR, last sentence and Article 50d(4) EUDR, last sentence.

Where this option is relied on in EUTM renewals, the payment must be of the renewal fee laid out in Annex I A, paragraphs (11) or (15) EUTMR and **not of the discounted fee for renewal by electronic means** pursuant to Annex I A, paragraphs (12) or (16). Consequently, as payment alone cannot constitute a valid request for e-renewal, the fee discount may only be relied on where a renewal application is submitted by electronic means. The requester will either have to submit a valid e-renewal application form, or pay the difference in the basic fee, in all cases before the expiry of the renewal period. Furthermore, if this is carried out during the grace period, the additional fee for late payment will also be due.

Where no request for renewal has been filed but a renewal fee has been paid that does not contain the minimum identification elements, the Office will invite the person requesting renewal to provide the missing indications. A letter will be sent out as early as is reasonably possible after receipt of the fee, so as to enable the request to be filed before the additional fee becomes due.

Where a request for renewal has been submitted but the renewal fee has not been paid in full, the Office will, where possible, remind the person requesting renewal to pay the remaining part thereof within the basic renewal period and the additional fee for late payment if within the grace period.

The lack of payment is not a remediable deficiency that the Office will set the party a time limit to remedy.

In the case of incomplete payment of an EUTM renewal fee, the proprietor may, instead of paying the missing amount, restrict its request for renewal to the corresponding number of classes.

In the case of incomplete payment of an REUD renewal fee, the holder may, instead of paying the missing amount, restrict its request for renewal to the corresponding number of multiple designs.

8.1.1.2 Insufficient payments and payment after the expiry of the grace period

Article 53(5) and (8) and Article 99 EUTMR

Article 50d(5) and (8) EUDR

Where a request for renewal has not been submitted or is submitted only after the expiry of the grace period, or the fees have not been paid, the Office will determine that the registration has expired and will issue a notification on loss of rights to the proprietor/holder.

Where the fees received in the grace period are not paid in full (i.e. the fee received amounts to less than the required basic fee and the additional fee for late payment) or are received only after expiry of the grace period, the Office will determine that the registration has expired and will issue a notification on loss of rights to the proprietor/holder.

For EUTMs, where the insufficient fee received in the grace period covers the basic fee and the additional fee for late payment, but not all class fees, the Office will only renew the registration for some classes. The determination of which classes of goods and services are to be renewed will be made according to the following criteria.

- Where the request for renewal is expressly limited to particular classes, only those classes will be renewed.
- Where it is otherwise clear from the request which class or classes are to be covered by the request, that class or those classes will be renewed.
- The Office may contact the proprietor to ask for the class preferences in the event of partial payment.
- In the absence of other criteria, the Office will take the classes into account in the numerical order of classification, beginning with the class having the lowest number.

Where not all class fees are paid and the Office determines that the registration has expired for some of the classes of goods or services, it will issue the renewal confirmation to the proprietor, as well as a notification of loss of rights for those classes of goods or services to the proprietor. If the person concerned considers that the finding of the Office is inaccurate, he or she may, within 2 months of the notification of the loss of rights, apply for a decision on the matter.

For REUDs, where the fee paid covers the basic fee and the fee for late payment, but the fees paid are insufficient to cover all designs identified in the renewal application, the Office will only renew the registration for some designs. In the absence of an indication of the designs to be renewed, or of any other criteria for determining which designs are intended to be covered, the Office will determine the designs to be renewed by taking them in numerical order.

8.1.1.3 Situation where the requester holds a current account

The Office will not debit a current account unless there is an express request for renewal. It will debit the account of the person requesting renewal.

Where the renewal applicant has a current account at the Office, the renewal fee will only be debited once a request for renewal has been filed and the renewal fee (including any class fees) will be debited on the day of receipt of the request, unless other instructions are given. In the event the request for renewal is filed during the 6-month grace period, the renewal fee and the additional fee for late payment will both be debited from the current account.

For payment by third parties, see paragraph 7.5.4 above.

8.1.2 Compliance with formal requirements

8.1.2.1 Renewal requested by an authorised person

Article 53(1) EUTMR Article 50d(1) EUDR

Where a renewal request is filed on behalf of the proprietor/holder, there is no need to file an authorisation. However, such an authorisation should exist in favour of the person filing the request should the Office request it.

8.1.2.2 Further requirements

Article 53(4) and (7) EUTMR Article 22(3) and (4) EUDIR

Where the request for renewal does not comply with other formal requirements, namely where the name and address of the person requesting renewal has not been sufficiently indicated, where the registration number has not been indicated, where it has not been properly signed or, for EUTMs, if partial renewal was requested but the goods and services to be renewed have not been properly indicated, the Office will inform the person requesting renewal of the deficiencies found.

The Office will consider the request to be made for the renewal for all goods and services or all the designs covered by the multiple registration, unless partial renewal is expressly requested. In the event of a partial renewal, please refer to paragraph 7.2.3 above.

If the request for renewal is filed by a person authorised by the proprietor/holder (see paragraph 7.1(c) above), the proprietor/holder will receive a copy of the deficiency notification.

Article 53(5), (8) and Article 99 EUTMR

Article 22(5) and Article 40 EUDIR

Where these deficiencies are not remedied before the expiry of the relevant time limit, the Office will proceed as follows.

- If the deficiency consists of failing to indicate the goods and services of the EUTM to be renewed, the Office will renew the registration for all the classes for which the fees have been paid, and if the fees paid do not cover all the classes of the EUTM registration, the determination of which classes are to be renewed will be made according to the criteria set out in paragraph 8.1.1.2 above. The Office will issue, at the end of the grace period, a notification of loss of rights for those classes of goods or services the Office deems expired to the proprietor.
- If the deficiency consists of the proprietor's/holder's failure to respond to a request for clarification of who the authorised person is, the Office will accept the request for renewal filed by the authorised representative on file. If neither of the requests for renewal has been filed by an authorised representative on file, the Office will accept the renewal request that was first received by the Office.
- If the deficiency lies in the fact that there is no indication of the designs to be renewed, and the fees paid are insufficient to cover all the designs for a multiple application for which renewal is requested, the determination of which designs are to be renewed will be made according to the criteria set out in paragraph 8.1.1.2 above. The Office will determine that the registration has expired for all designs for which the renewal fees have not been paid in part or in full.
- In the case of the other deficiencies, it will determine that the registration has expired and will issue a notification of loss of rights to the proprietor/holder and, where applicable, the person requesting renewal.

The person concerned may apply for a decision on the matter under Article 99 EUTMR or Article 40(2) EUDIR within 2 months.

8.2 Items not to be examined

No examination will be carried out on renewal for the registrability of the mark or design, nor will any examination be carried out as to whether the EUTM has been put to genuine use.

No examination will be carried out by the Office on renewal as to the correct classification of the EUTM, nor will a registration be reclassified that has been registered in accordance with an edition of the Nice Classification that is no longer in force at the point in time of renewal. All of this is without prejudice to the application of Article 57 EUTMR.

The Office will not examine the product classification of the REUD nor will an REUD be reclassified that was registered in accordance with an edition of the Locarno

Classification no longer in force at the time of renewal. Such reclassification will not even be available at the holder's request.

9 Partial Renewals of EUTMs

Article 53(4)(c) and Article 53(8) EUTMR Annex I A(19) EUTMR

An EUTM may be renewed in part for some of the goods and/or services for which it has been registered.

A partial renewal is not a partial surrender for those goods and/or services for which the EUTM has not been renewed.

An EUTM may be partially renewed several times during the initial basic renewal period of 6 months or during the 6-month grace period. See to this extent 22/06/2016, C-207/15 P, CVTC, EU:C:2016:465.

For each partial renewal, the full amount of the corresponding fee has to be paid, and in the event a partial renewal request is submitted within the grace period, the additional fee for the late payment of the renewal fee must also be paid, namely 25 % of the belated renewal fee (subject to a maximum of EUR 1 500).

For example:

An EUTM registration has 10 classes.

If within the basic period the Office receives an e-renewal request for 5 classes (out of the 10) the fees payable would be:

Basic e-renewal fee (including 1 class):	EUR 850
Second class:	EUR 50
Remaining classes (150 EUR x 3):	EUR 450
Total renewal fee:	**EUR 1 350**

If, within the grace period, the Office receives a new renewal request for two more classes of the registration, the fees payable would be:

Additional classes (EUR 150 x 2):	EUR 300
25 % surcharge of the belated fee:	EUR 75
Total additional fees payable:	**EUR 375**

Total additional fees payable: EUR 375.

Using the same example, at the end of the grace period the Office would issue a notification to the proprietor of loss of rights for the remaining three classes of goods or services which were not renewed, for which registration is deemed expired.

10 Entries in the Register

Articles 53(5), 111(6) and Article 111(3)(k) EUTMR

Article 50d(6) and Article 72(3)(n) and Article 72(6) EUDR

Where the request for renewal complies with all the requirements, the renewal will be registered.

The Office will notify the proprietor/holder of the renewal of the EUTM/REUD, of its entry in the Register, and the date from which renewal takes place. Where the renewal applicant is a person other than the registered proprietor/holder or its representative on file, they will also be informed of the renewal.

Where renewal has taken place only for some of the goods and services contained in the registration, the Office will notify the proprietor of the goods and services for which the registration has been renewed and the entry of the renewal in the Register and of the date from which renewal takes effect (see paragraph 11 below). After the expiry of the grace period, the Office will notify the proprietor of expiry of the registration for the remaining goods and services and of their removal from the Register.

Where only some of the designs contained in a multiple application have been renewed, the Office will notify the holder of the designs for which the registration has been renewed, of the entry of the renewal in the Register and of the date from which renewal takes effect (see paragraph 11 below). After the expiry of the grace period, the Office will notify the holder of expiry of the registration for the remaining designs and of their removal from the Register.

Article 53(5), (8) and Article 99 EUTMR

Article 50d(6) and (8) EUDR

Article 40(2) EUDIR

Where the Office has made a determination pursuant to Article 53(8) EUTMR or Article 50d(8) EUDR that the registration has expired, the Office will cancel the mark/design in the Register and notify the proprietor/holder accordingly. The proprietor/holder may apply for a decision on the matter under Article 99 EUTMR or Article 40(2) EUDIR within 2 months.

11 Date of Effect of Renewal or Expiry, Conversion

11.1 Date of effect of renewal

Article 53(6) and (8) EUTMR

Article 67(2) EUTMDR

Article 12 and Article 50d(6) EUDR

Renewal will take effect from the day following the date on which the existing registration expires.

For example:

- Where the filing date of the EUTM registration is 01/04/2010, the registration will expire on 01/04/2020. Therefore, renewal takes effect from the day following 01/04/2020, namely 02/04/2020. Its new term of registration is 10 years from this date, which will end on 01/04/2030.
- Where the filing date of the REUD is 01/04/2015, the registration will expire on 01/04/2020. Therefore, renewal takes effect from the day following 01/04/2020, namely 02/04/2020. Its new term of registration is five years from this date, which will end on 01/04/2025.

It is immaterial whether any of these days is a Saturday, Sunday or an official holiday. Even in cases where the renewal fee is paid within the grace period, the renewal takes effect from the day following the date on which the existing registration expires.

Where the EUTM or REUD has expired and is removed from the Register, the cancellation will take effect from the day following the date on which the existing registration expired. Using the same two examples listed above, the removal from the Register would take effect on 02/04/2020 (for the EUTM) and 02/04/2020 (for the REUD).

11.2 Conversion of lapsed EUTMs

Articles 53(3) and 139(5) EUTMR

Where the owner wants to convert its lapsed EUTM into a national mark, the request must be filed within 3 months from the day following the last day of the 6-month grace period. The time limit of 3 months for requesting conversion starts automatically without notification (see the Guidelines, Part E, Register Operations, Section 2, Conversion).

12 Renewal of International Marks Designating the EU

Article 202(1) EUTMR

The procedure for renewal of international marks is managed entirely by the International Bureau. The Office will not deal with renewal requests or payment of renewal fees. The International Bureau will send notice for renewal, receive the renewal fees and record the renewal in the International Register. The effective date of the renewal is the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register. Where an international registration designating the EU is renewed, the Office will be notified by the International Bureau.

If the international registration is not renewed for the designation of the EU, it can be converted into national marks or into subsequent designations of Member States under the Madrid Protocol. The 3-month time limit for requesting conversion starts on the day following the last day on which renewal may still be effected before WIPO pursuant to Article 7(4) of the Madrid Protocol (see the Guidelines, Part E, Register Operations, Section 2, Conversion).

13 Renewal of International Design Registrations Designating the EU

Article 106a EUDR
Article 106g EUDR

International registrations must be renewed directly at the International Bureau of WIPO in compliance with Article 17 of the Geneva Act. The Office will not deal with renewal requests or payments of renewal fees in respect of international registrations.

The procedure for the renewal of international design registrations is managed entirely by the International Bureau, which sends out the notice for renewal, receives the renewal fees and records the renewal in the International Register. When international registrations designating the EU are renewed, the International Bureau also notifies the Office.

GUIDELINES FOR EXAMINATION

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part E

Register operations

Section 5

Inspection of files

1 General Principles

Article 111(1) and (5), Article 114, Article 117(1) and (2) and Annex 1 A(30) EUTMR
Articles 20 and 21 EUTMIR
Articles 72, 74, 74a, 74b and 75 EUDR
Articles 77 and 78 EUDIR

ED Decision concerning the keeping of files and the inspection of files

The principle established under the European Union trade mark and design system is that:

- the 'Register of European Union trade marks' and the 'Register of European Union designs' contain all particulars relating to European Union trade mark (EUTM) applications, applications for registered European Union designs, registered EUTMs and registered European Union designs (REUDs); and
- the 'files' contain all correspondence and decisions relating to those trade marks and designs.

Both the Registers and the files of the Office are, in principle, open to inspection by the public. However, before publication of an EUTM application, an REUD or when an REUD is subject to deferred publication, inspection of files is possible only in exceptional cases (see paragraphs 4.2.1 and 4.2.2 below).

This section of the Guidelines deals specifically with inspection of files.

Inspection of the files may involve:

- inspection of the Registers;
- obtaining certified or uncertified extracts of the Registers;
- inspection of the content of the file(s);
- the communication of information contained in the files, implying communication of specific information contained in the files without supplying the actual file document(s);
- obtaining certified or uncertified copies of documents contained in the files.

In these Guidelines, the term 'inspection of the files' is used to cover all of the abovementioned forms of inspection of files, unless otherwise stated.

The provisions in the EUDR and EUDIR dealing with the inspection of files of European Union designs are almost identical to the equivalent provisions of the EUTM Regulations. Therefore, the following applies *mutatis mutandis* to European Union designs. Where the procedure is different, the differences are specified under a separate sub-heading.

2 The Registers of EUTMs and European Union designs

Article 111(1) and (5) EUTMR

Article 72 and 72a EUDR

Decision EX-25-05 of the Executive Director of the Office of 07/04/2025 on the Register of EU trade marks, the Register of EU Designs, the database of proceedings before the Office, and on the case-law database.

The Registers are maintained electronically. The Registers can be publicly inspected through the eRegisters, which can be accessed through the eSearch Plus database on the Office website. The eRegisters are also accessible through the Office's TMview and DesignView tools, except, in the case of European Union designs, where Article 50(2) EUDR provides otherwise. Insofar as some data contained in the Registers is not yet available online, the only means of access is by a request for information or by obtaining certified or uncertified extracts or copies of the file documents from the Registers.

3 Inspection of the Registers

3.1 Information contained in the Registers

3.1.1 The Register of EUTMs

Article 111(2), (3) and (4) EUTMR

Decision EX-25-05 of the Executive Director of the Office of 07/04/2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database, and its Annex I and Annex II.

The Register of EUTMs contains the information specified in Article 111(2) and (3) EUTMR and any other items determined by the Executive Director of the Office pursuant to Article 111(4) EUTMR.

3.1.2 The Register of European Union designs

Articles 50, 72 and Article 74(5) EUDR Decision EX-25-05 of the Executive Director of the Office of 07/04/2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database, and its Annex I and Annex II.

The Register of European Union designs contains the information specified in Article 72 EUDR and any other items determined by the Executive Director of the Office.

In accordance with Article 74(5) EUDR, where the REUDs are subject to a deferment of publication pursuant to Article 50(1) EUDR, access to the Register to persons other than the holder shall be limited to the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred.

The particulars that are recorded in the eRegisters are specified in Annexes I and II of Decision EX-25-05 of the Executive Director of the Office on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database.

For EUDs, the street, postal code and province/county of **holders** are no longer recorded in the Register. Entries that existed in the Register before the entry into force of the new Regulation will not be amended so they will continue to show the full address details. The full addresses of representatives remain visible. For EUTMs, the full address of proprietors and representatives is recorded in the Register.

The nationality of parties and representatives is no longer recorded in the Register but remains visible for cases that existed on the Register before the entry into force of the new Regulation.

4 Inspection of Files

4.1 Persons/Entities authorised to request access to the files

The rules and degree of access to the files vary according to who requests inspection.

The Regulations differentiate between the following three categories:

- the applicant/proprietor of the EUTM or REUD;
- third parties;
- courts or authorities of the Member States.

Inspection of the files by courts or authorities of the Member States is covered by the system of administrative cooperation with the Office (see paragraph 7 below).

4.2 Documents that constitute the files

The files relating to an EUTM or REUD consist of all correspondence between the parties and the Office and all documents (and their related annexes) established in the course of examination, as well as any correspondence concerning the ensuing EUTM or REUD. The file does not include trade mark search reports provided by national offices.

Documents relating to opposition, cancellation, invalidity and appeal proceedings before the Office or other proceedings, such as recordals (transfer, licence, etc.), also form part of the files.

All original documents submitted become part of the file and, therefore, cannot be returned to the person who submitted them. When submitting documents, simple photocopies are sufficient. They do not need to be authenticated or legalised.

Where the parties make use of the mediation services offered by the Office in accordance with the Decision of the Executive Director of the Office on the administration of mediation processes ('Rules on Mediation'), all correspondence relating to that mediation are excluded from inspection of files.

Article 115 EUTMR Article 74c EUDR

Decision EX-25-04 of the Executive Director of the Office of 07/04/2025 on the keeping of files and the inspection of files

Even where an EUTM application is no longer pending, or an EUTM registration or REUD registration ceases to have effect, inspection of the respective files remains possible. An EUTM application or REUD application ceases to be pending when it is rejected, or when the application has been withdrawn or is considered to have been withdrawn. An EUTM registration or REUD registration ceases to have effect when it expires or is surrendered, declared invalid or revoked and, where applicable, the period for conversion is over.

Where the files are kept in electronic format, the electronic files, or back-up copies thereof, will be kept indefinitely. The Executive Director established when originals should be disposed of by the Office in his decision on the keeping and inspection of files. This decision states that the Office may dispose of original documents submitted by the parties, which have been digitised in the electronic files, 5 years after the Office received them. Where files or part of files are not kept electronically, the Office will keep the relevant documents or items of evidence for at least 5 years from the end of the year in which:

- the EUTM/REUD application is rejected or withdrawn;
- the EUTM/REUD registration expires definitely;
- the surrender of the registered EUTM or REUD is entered in the Register; or
- the registered EUTM or REUD is removed from the Register.

4.2.1 The files relating to EUTM applications

Articles 44 and 114 EUTMR

Article 7 EUTMIR

The files relating to EUTM applications are available for inspection once the application has been published by the Office in the EUTM Bulletin. The day of publication is the date of issue shown in the EUTM Bulletin and is reflected under the INID code 442 in the Register. The dissemination of data relating to unpublished EUTM applications by means of online access or otherwise does not constitute publication of the application within the meaning of Article 44 EUTMR and Article 7 EUTMIR.

Before the publication of the application, inspection of the files is restricted and possible only if one of the following conditions is fulfilled:

- the applicant for inspection is the EUTM applicant; or
- the EUTM applicant has consented to inspection of the file relating to the EUTM application (see paragraph 6.12.1 below); or
- the applicant for inspection can prove that the EUTM applicant has stated that it will invoke the rights under the EUTM, once registered, against the applicant for inspection (see paragraph 6.12.2 below).

Article 41(3) and Article 115 EUTMR

The applicant always has access to the files relating to its own EUTM application. This comprises the following:

- the EUTM application, even where the Office has refused to attribute a filing date to it or where the application does not fulfil the minimum requirements for the attribution of a filing date, in which case the application will not be dealt with as an EUTM application and, legally speaking, there is no EUTM application;
- the files for as long as they are kept (see paragraph 4.2), even after the EUTM application has been rejected or withdrawn.

4.2.2 The files relating to REUD applications

Articles 50, 74 and Article 74a(2) EUDR

Article 70 EUDIR

The files relating to REUD applications, or an REUD still subject to deferment of publication, including those that have been surrendered, are only available for inspection if one of the following conditions is fulfilled:

- the applicant for inspection is the REUD applicant/holder; or
- the applicant for the REUD has consented to inspection of the file relating to the REUD application; or

- the applicant for inspection has established a legitimate interest in the inspection of the REUD application, in particular where the applicant for the REUD has stated that after the design has been registered he/she will invoke the rights under it against the person requesting the inspection.

In the case of an application for multiple REUDs, this inspection restriction will only apply to information relating to the REUDs subject to deferment of publication, or to those that are not eventually registered, either due to rejection by the Office or withdrawal by the applicant.

4.2.3 The files relating to registered EUTMs

The files relating to EUTMs after registration are available for inspection.

4.2.4 The files relating to REUDs

The files relating to REUDs are available for inspection once the registration has been published by the Office in the European Union Designs Bulletin. The day of publication is the date of issue shown in the European Union Designs Bulletin and is reflected under the INID code 45 in the Register.

For inspection of the files relating to an REUD that is subject to deferment of publication, please see paragraph 4.2.2., above.

4.2.5 The files relating to international registrations designating the European Union

Articles 114(8), Articles 189 and 190 EUTMR

Articles 72a and 106(d) EUDR

International registrations are exclusive rights administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva according to the Madrid Protocol (in the case of trade marks) and the Geneva Act (in the case of designs). WIPO processes the applications and then sends them to the Office for examination in accordance with the conditions specified in the EUTMR and in the EUDR. These registrations have the same effect as applying directly for an EUTM or an REUD.

The files kept by the Office relating to international trade mark registrations designating the EU may be inspected on request as from the date of publication referred to in Articles 114(8) and 190(1) EUTMR. The same rules apply as for the inspection of EUTMs.

The Office provides information on international registrations of designs designating the EU in the form of an electronic link to the searchable database maintained by the International Bureau (http://www.wipo.int/designdb/hague/en/). The files kept by the Office may relate to the refusal of the international design pursuant to Article 106e EUDR and the invalidation of the international design pursuant to Article 106f

EUDR. They may be inspected subject to the restrictions pursuant to Article 74 EUDR (see paragraph 5 below) and subject to the same limitations as explained in paragraphs 4.2.2 and 4.2.4 above.

5 Parts of the File Excluded from Inspection

5.1 Excluded documents

Article 114(4) and Article 169 EUTMR

Article 74 EUDR

Certain documents contained in the files are excluded from inspection of files, namely:

- documents relating to the exclusion of or objection to Office staff, for example, on the grounds of suspicion of partiality;
- draft decisions and opinions and all other internal documents used for preparing decisions and opinions;
- parts of the file for which the party concerned expressed a special interest in keeping confidential;
- documents relating to the invitation of the Office to find a friendly settlement, except those that have an immediate impact on the trade mark or design, such as limitations, transfers, etc., and have been declared to the Office. (For mediation proceedings, see paragraph 4.2).

The files relating to requests for entry on the Office's list of professional representatives or designs list, including all decisions taken therein, are not open to public inspection because the files do not relate to EUTM or REUD proceedings as such (see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 4.3.5).

In principle, documents of a personal nature such as **passports or other identification documents**, which are submitted in particular as evidence in relation to requests for transfer, evidence of '**health data**', which is submitted in particular as evidence in relation to *restitutio in integrum* or as supporting evidence for extension requests, and **bank account extracts**, which may, for example, be attached to applications and requests as evidence of fee payment, because of their inherent personal nature, confidentiality vis-à-vis any third parties is justified, and, in principle, overrides any third-party interest.

5.1.1 Documents relating to exclusion or objection

Article 114(4) EUTMR

Article 74(4)(a) EUDR

This exception relates to documents in which an examiner states that they consider themselves excluded from participating in the case, and documents in which such a person makes observations about an objection by a party to the proceedings on the basis of a ground for exclusion or suspicion of partiality. However, it does not relate to letters in which a party to the proceedings raises, either separately or together with other statements, an objection based on a ground for exclusion or suspicion of partiality, or to any decision on the action to be taken in the cases mentioned above. The decision taken by the competent instance of the Office, without the person who withdraws or has been objected to, will form part of the files.

5.1.2 Draft decisions and opinions and internal documents

Article 114(4) EUTMR

Article 74(4)(b) EUDR

This exception relates to documents used for preparing decisions and opinions, such as reports and notes drafted by an examiner that contain considerations or suggestions for dealing with or deciding on a case, or annotations containing specific or general instructions on dealing with certain cases.

Documents that contain a communication, notice or final decision by the Office in relation to a particular case are not included in this exception. Any document to be notified to a party to the proceedings will take the form of either the original document or a copy thereof, certified by or bearing the seal of the Office, or a computer printout bearing that seal. The original communication, notice or decision or copy thereof will remain in the file.

The Notes and the Guidelines of the Office relating to general procedure and treatment of cases, such as these Guidelines, do not form part of the files. The same is true for measures and instructions concerning the allocation of duties.

5.1.3 Parts of the file for which the party concerned expressed a special interest in keeping confidential

Article 114(4) EUTMR

Article 74(4)(c) EUDR

Point in time for the request

Keeping all or part of a document confidential may be requested on its submission or at a later stage, as long as there is no pending request for an inspection of files. During inspection of files proceedings confidentiality may not be requested.

Parts of the file for which the party concerned expressed a special interest in keeping confidential before the application for inspection of files was made are excluded from inspection of files, unless their inspection is justified by an overriding legitimate interest of the party seeking inspection.

Invoking confidentiality and expressing a special interest

The party concerned must have expressly invoked, and sufficiently justified, a special interest in keeping the document confidential (see 08/11/2018, R 722/2018-5, nume (fig.) / Numederm, § 16). Where any request is submitted on an Office form (paper or e-filing format), the form itself cannot be marked as confidential. However, any attachments thereto may be excluded from inspection of files. This applies to all proceedings as the form includes the minimum information, which is later included in the publicly available Register, and is, therefore, incompatible with a declaration of confidentiality.

If a special interest in keeping a document confidential is invoked, the Office must check whether that special interest is sufficiently demonstrated. The documents falling into this category must originate from the party concerned (e.g. EUTM/REUD applicant, opponent).

Confidentiality invoked and special interest claimed

Where special interest is invoked and elaborated upon, the special interest must be due to the confidential nature of the document or its status as a trade or business secret. This may be the case, for example, where the applicant has submitted underlying documentation as evidence in respect of a request for registration of a transfer or licence.

Where the Office concludes that the requirements for keeping documents confidential are not met because the special interests claimed do not justify maintaining the confidentiality of the document, prior to lifting the confidentiality it will communicate with the person who filed the documents and make a decision. In reply, the applicant may submit evidence in such a way that avoids revealing parts of the document or information that the applicant considers confidential, as long as the parts of the document submitted contain the required information. For example, where contracts or other documents are submitted as evidence for a transfer or licence, certain information may be blacked out before being submitted to the Office, or certain pages may be omitted altogether.

Confidentiality invoked with no attempt to claim any special interest

Where a claim for confidentiality has been submitted by the party by use of a standard ‘confidential’ stamp on the cover page of the submission, or by ticking the ‘confidential’ tick-box when using the electronic communication platform, but the documents enclosed contain no explanation nor indication of any special interest nor

any attempt on behalf of the party to justify the confidential nature or status of the submission, the Office will remove this indication.

This applies to all submissions where the party claims confidentiality 'by default', yet provides no justification in support of its claim. The party can at any time before the receipt of a request for inspection of files, invoke and sufficiently justify a special interest in keeping the document confidential.

In the event that the Office invites the parties to opposition, cancellation or invalidity proceedings to consider a friendly settlement, all corresponding documents referring to those proceedings are considered confidential and, in principle, not open to inspection of files.

Access to documents that the Office has accepted as being confidential and thus, excluded from inspection, may nevertheless be granted to a person who demonstrates an overriding legitimate interest in inspecting the document. The overriding legitimate interest must be that of the person requesting inspection.

If the file contains such documents, the Office will inform the applicant for inspection of files about the existence of such documents within the files. The applicant for inspection of files may then decide whether or not it wants to file a request invoking an overriding legitimate interest. Each request must be analysed on its own merits.

The Office must give the party requesting inspection the opportunity to present its observations.

Before taking a decision, the request, as well as any observations, must be sent to the party concerned, who has a right to be heard.

Article 67 EUTMR Article 56 EUDR

The Office must make a decision as to whether to grant access to such documents. Such a decision may be appealed by the adversely affected party.

5.2 Access for applicant or proprietor to excluded documents

Article 114(4) EUTMR Article 74 EUDR

Where an applicant or proprietor requests access to their own file, this will mean all documents forming part of the file, excluding only those documents referred to in Article 114(4) EUTMR and Article 74(4)(a) and (b) EUDR.

In *inter partes* proceedings, where the one concerned (the opponent or applicant for revocation or declaration of invalidity) has shown a special interest in keeping its document confidential vis-à-vis third parties, it will be informed that the documents cannot be kept confidential with respect to the other party to the proceedings and it will

be invited to either disclose the documents or withdraw them from the proceedings. If it confirms the confidentiality, the documents will not be sent to the other party and will not be taken into account by the Office in the decision.

If, on the other hand, it wants the documents to be taken into account but not available for third parties, the documents can be forwarded by the Office to the other party to the proceedings, but will not be available for inspection by third parties (for opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.4.4).

6 Procedures before the Office Relating to Applications for Inspection of Files

6.1 Certified or uncertified extracts of the Registers

Article 111(7) EUTMR

Article 63 EUTMDR

Articles 50 and 72 and Article 74(5) EUDR

Decision EX-25-05 of the Executive Director of the Office of 07/04/2025 on the register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database.

The Office will provide certified or uncertified extracts from the EUTM or EUD Register. For deferred designs, such excerpts are subject to the conditions laid down in Article 74(5) EUDR.

Where registration is subject to a deferment of publication, pursuant to Article 50(1) EUDR, certified (or uncertified) extracts from the Register should only contain the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred.

Extracts from the EUTM and EUD Registers can be obtained through the following methods.

1. The eRegister: on entering the eRegister repository of an IP right, a user who is logged into their User Area account has the option of downloading a certified copy of the extract from the Register for this IP right. Generating this extract directly from the eRegister is free of charge.
2. An online request in the User Area: where this is carried out online through the User Area account, the user will be redirected to the eRegister repository (see point 1) to download a certified copy of the extract immediately and free of charge.

3. Only for EUTMs: the user may request the Office send an extract, or a similar request, by post in the User Area. The Office will send the user the certified or uncertified extract that is retrieved from, and corresponds to, the extracts retrievable online through the eRegister. The request is subject to the payment of a fee pursuant to Article 111(7) EUTMR and point A.29 of Annex I EUTMR. Requests cannot be made for extracts of the EUD Register because Article 72(7) EUDR only allows the issuing of extracts by electronic means.

Extracts downloaded from the eRegister for any IP right are authentic extracts from the EUTM and EUD Registers. They are certified by default and bear an identification code that may be used to verify the authenticity of certified copies online.

6.2 Certified or uncertified copies of file documents

The Office will provide certified or uncertified copies of documents constituting the EUTM or REUD files (see paragraph 4.2). Downloadable (certified) copies are free of charge (see paragraph 6.4).

In addition, requests for certified or uncertified copies of documents may be submitted using the online form, which can be found on the EUIPO website at https://euipo.europa.eu/ohimportal/en/forms-and-filings, or any equivalent request.

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 6.7.

Certified copies of the EUTM application or the REUD registration certificate will only be available when a filing date has been accorded (for EUTM filing date requirements, see the Guidelines, Part B, Examination, Section 2, Formalities; for REUD filing date requirements, see the Guidelines on Examination of Applications for Registered European Union Designs).

In the case of an application for multiple designs, certified copies of the application will only be available for those designs that have been accorded a filing date.

Where the EUTM application or REUD registration has not yet been published, a request for certified or uncertified copies of the file documents will be subject to the restrictions listed in paragraphs 4.2.1 to 4.2.4 above.

It should be borne in mind that the certified copy of the application or registration only reflects the data on the date of application or registration. The trade mark or design may have been the subject of a transfer, surrender, partial surrender or other act affecting its scope of protection, which will not be reflected in the certified copy of the EUTM application form or EUTM/REUD registration certificate. Up-to-date information is available from the electronic database or by requesting a certified extract of the Register (see paragraph 6.1 above).

6.3 Online access to the files

The contents of the EUTM files are available in the 'Correspondence' section of the file in the Office's online tool on the Office's website.

Providing the EUTM application or the REUD registration (not subject to a deferment) has been published, registered users of the website can consult these files free of charge.

6.4 Downloadable certified copies

Decision No EX-23-13 of the Executive Director of the Office of 15 December 2023 on communication by electronic means, and its Annex I.

Decision EX-25-05 of the Executive Director of the Office of 7 April 2025 on the Register of EU trade marks, the Register of EU designs, the database of proceedings before the Office, and on the case-law database, Article 5, and its Annex I and Annex II.

Article 51(2) EUTMR

Certified and uncertified copies of EUTM and REUD applications, registration certificates, extracts of the Register and copies of the documents in the file (available only for EUTMs) can be automatically generated and downloaded:

- when the user is logged in via a direct link from the EUIPO website using the Office's online eSearch Plus tool or from the eRegisters;
- from within the Inspection of Files e-filing form;
- from within the files for a selected EUTM or REUD; and
- certified copies of application forms and registration certificates can also be downloaded from the TMview and DesignView databases.

The copy of the document will be made available in PDF format, and will be composed of a cover page in the five Office languages, introducing the certified document and followed by the certified document itself. The document contains a unique identification code. Each page of the document should bear a header and footer containing important elements in order to guarantee the authenticity of the certified copy: a unique identification code, a 'copy' stamp, the signature of the Office staff member responsible for issuing certified copies, the date of the certified copy, the EUTM/REUD number and page number. The date indicated is the date when the certified copy was automatically generated.

The automatically generated certified copies have the same value as certified copies sent on paper upon request in EUTM proceedings, and can be used in either their electronic or printed format.

When an authority receives a certified copy, it can verify the original document online using the unique identification code given in the certified copy. A link 'Verify certified copies' is available under the 'Databases' section of the Office's website. Clicking on the link will bring up a screen with a box in which the unique identification code can be entered in order to retrieve and display the original document from the Office's online systems.

The authenticity of certified copies of application or registration certificates downloaded from TMview or DesignView can also be verified in TMview or DesignView.

For further information on the availability and content of the certificates, see paragraph 6.2.

6.5 Online applications for inspection of files

Users may access the application form online through their user account, where they will be invited to log in and complete the application for inspection of files requesting certified or uncertified copies of specific documents.

6.6 Written applications for inspection of files

Article 63 EUTMDR Article 65 EUDIR

Online inspection within eSearch plus (correspondence section) is strongly recommended. This type of online inspection is immediate and free of charge once the user is logged into the User Area.

For any files that are not subject to online inspection in eSearch plus, applications for inspection, or any equivalent requests, may be submitted using the online form, which can be found on the EUIPO website at https://euipo.europa.eu/ohimportal/en/forms-and-filings. The following explains the conditions for a request for inspection.

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 6.7 below.

Article 63 EUTMDR Article 67 EUDIR

An application for inspection of files may be submitted as an original signed form by electronic means (see paragraph 6.5 above).

For EUTMs, the request may also be submitted by post or courier. For REUDs, only inspection by electronic means is possible.

6.7 Languages

Applications for inspection of files must be filed in one of the languages indicated below.

6.7.1 For EUTM or REUD applications

Article 146(6) and (9) EUTMR

Article 25 EUTMIR

Articles 80, 81, 83 and 84 EUDIR

Where the application for an inspection of files relates to a EUTM application or REUD application, whether already published or not, it must be filed in the language in which the EUTM application or REUD application was filed (the 'first' language) or in the second language indicated by the EUTM applicant or REUD applicant in their application (the 'second' language).

Where the application for inspection is filed in a language other than indicated above, the applicant for inspection must, of its own motion, submit a translation into one of the languages indicated above within 1 month. If such a translation is not submitted within the deadline, the application for inspection of files will be considered not to have been filed.

This does not apply where the applicant for inspection could not have been aware of the languages of the EUTM application or REUD application. This can be the case only where such information is not available in the online Register and the application can immediately be dealt with. In this case, the application for inspection may be filed in any of the five languages of the Office.

6.7.2 For registered EUTMs or REUDs

Article 146(6) and (9) EUTMR

Article 25 EUTMIR

Article 80(b), Articles 81, 83 and 84 EUDIR

Where the application for inspection of files relates to a registered EUTM or REUD, it must be filed in one of the five languages of the Office.

The language in which the application for inspection was filed will become the language of the inspection proceedings.

Where the application for inspection of files is made in a language other than indicated above, the party requesting inspection must, on its own motion, submit a translation

into one of the languages indicated above within one month, or the application for inspection of files will be considered not to have been filed.

6.8 Representation and authorisation

Representation is not mandatory for filing an application for inspection of files.

Where a representative is appointed, the general rules for representation and authorisation apply. See the Guidelines, Part A, General Rules, Section 5, Professional Representation.

6.9 Contents of the application for inspection of files

The application for inspection of files mentioned in paragraphs 6.5 and 6.6 above must contain the following.

- An indication of the file number or registration number for which inspection is applied.
- The name and address of the applicant for inspection of files.
- If appropriate, an indication of the document or information for which inspection is applied (applications may be made to inspect the whole file or specific documents only). In the case of an application to inspect a specific document, the nature of the document (e.g. 'application', 'notice of opposition') must be stated. Where communication of information from the file is applied for, the type of information needed must be specified. Where the application for inspection relates to an EUTM application that has not yet been published, the application for an REUD that has not yet been published or an REUD that is subject to deferment of publication in accordance with Article 50 EUDR or which, being subject to such deferment, has been surrendered before or on the expiry of that period, and inspection of the files is applied for by a third party, an indication and evidence to the effect that the third party concerned has a right to inspect the file.
- As a general rule, the Office only provides electronic copies of files which are notified through the User Area. Where copies can be requested, an indication of the number of copies requested, whether or not they should be certified and, if the documents are to be presented in a third country requiring an authentication of the signature (legalisation), an indication of the countries for which authentication is needed.
- The applicant's signature in accordance with Article 63(1) EUTMDR and Article 65 EUDIR.

6.10 Deficiencies

Where an application for inspection of the files fails to comply with the requirements concerning the contents of applications, the applicant for inspection will be invited to

remedy the deficiencies. If deficiencies are not remedied within the established time limit, the application for inspection will be refused.

6.11 Fees for inspection and communication of information contained in the files

Any fees payable are due on the date of receipt of the application for inspection.

6.11.1 Communication of information contained in a file

Article 114(9) and Annex I A(32) EUTMR

For EUTMs, communication of information in a file is subject to payment of a fee of EUR 10.

6.11.2 Inspection of the files

Article 114(6) and Annex I A(30) EUTMR

For EUTMs, a request for inspection of the files on the Office's premises is subject to payment of a fee of EUR 30. Since all files are electronic, the Office will only provide electronic access to the files at the Office's premises. Therefore, inspection of the files on the Office's premises has de facto become obsolete for EUTM files.

For REUD files, no inspection on the Office's premises is available.

Article 114(7) and Annex I A(31)(a) EUTMR

Where inspection of an EUTM file is done by the Office issuing **uncertified** copies of file documents, these copies are subject to the payment of a EUR 10 fee plus EUR 1 for every page exceeding ten.

Article 51(2) EUTMR

Articles 111(7), 114(7) and Annex I A(29)(a) EUTMR

An **uncertified** copy of an EUTM application, an **uncertified** copy of the certificate of registration, an **uncertified** extract from the Register or an **uncertified** extract of the EUTM application from the database is subject to the payment of a EUR 10 fee per copy or extract.

However, registered users of the website can obtain electronic **uncertified** copies of EUTM or REUD applications or registration certificates free of charge through the website.

Article 114(7) and Annex I A(31)(b) EUTMR

Where inspection of an EUTM file is obtained through the issuing of **certified** copies of file documents, those copies are subject to payment of a fee of EUR 30 plus EUR 1 for every page exceeding ten.

Article 51(2) EUTMR

Articles 111(7), 114(7) and Annex I A(29)(b) EUTMR

A **certified** copy of an EUTM application, a **certified** copy of the certificate of registration, a **certified** extract from the Register or a **certified** extract of the EUTM application from the database is subject to the payment of a EUR 30 fee per copy or extract.

However, registered users of the website can obtain electronic **certified** copies of EUTM applications or registration certificates free of charge through the website.

6.11.3 Consequences of failure to pay

Article 114(6) EUTMR

Regarding the inspection of an EUTM file, an application for inspection of files will be considered not to have been filed until the fee has been paid. The fees apply not only where the application for inspection has been filed by a third party, but also where it has been filed by the EUTM applicant or proprietor. The Office will not process the inspection application until the fee has been paid.

However, if the fee is not paid or is not paid in full, the Office will notify the applicant for inspection:

- if no payment is received by the Office for a certified or uncertified copy of an EUTM application, a certificate of registration or an extract from the Register or from the database;
- if no payment is received by the Office for inspection of the files obtained through the issuing of certified or uncertified copies of file documents;
- if no payment is received by the Office for the communication of information contained in a file.

The Office will issue a letter indicating the amount of fees to be paid. If the exact amount of the fee is not known to the applicant for inspection because it depends on the number of pages, the Office will either include that information in the standard letter or inform the applicant for inspection by other appropriate means.

6.11.4 Refund of fees

Where an application for inspection of EUTM files is rejected, the corresponding fee is not refunded. However, where, after the payment of the fee, the Office finds that not all the certified or uncertified copies requested may be issued (e.g. if the request concerns confidential documents and the applicant has not proven an overriding legitimate interest), any fees paid in excess of the amount actually due will be refunded.

6.12 Requirements concerning the right to obtain inspection of files concerning an unpublished EUTM application, or a deferred REUD filed by a third party

Article 114(1) and (2) EUTMR

Articles 74 and 74a(2) EUDR

Where an application for inspection of files for an EUTM application that has not yet been published, or for files relating to an REUD subject to deferment of publication in accordance with Article 50 EUDR, or for those which, subject to such deferment, have been surrendered before or on the expiry of that period, (see paragraphs 4.2.1 and 4.2.2 above) is filed by a third party (i.e. by a person other than the EUTM or REUD applicant or its representative), different situations may arise.

If the application by a third party is based on the grounds specified in Article 114(1) and (2) EUTMR (see paragraph 4.2.1 above), or in Articles 74(2) or 74a(2) EUDR (see paragraph 4.2.2 above), it must contain an indication and evidence to the effect that the EUTM applicant or REUD applicant or holder has consented to the inspection, or has stated that it will invoke the rights under the REUD, once registered, against the applicant for inspection.

6.12.1 Consent

The consent of the EUTM applicant or REUD applicant or holder must be in the form of a written statement in which it consents to the inspection of the particular file(s). Consent may be limited to inspection of certain parts of the file, such as the application, in which case the application for inspection of files may not exceed the scope of the consent.

Where the applicant for inspection of files does not submit a written statement from the EUTM applicant, REUD applicant or holder consenting to the inspection of the files, the applicant for inspection will be notified and given 2 months from the date of notification to remedy the deficiency.

If, after expiry of the time limit, no consent has been submitted, the Office will reject the application for inspection of files. The applicant for inspection will be informed of the decision to reject the application for inspection.

The decision may be appealed by the applicant for inspection (Articles 67 and 68 EUTMR and Article 56 EUDR).

6.12.2 Statement that EUTM or REUD rights will be invoked

Article 114(2) EUTMR

Articles 74(2) and 74a(2) EUDR

Where the application relies on the allegation that the EUTM or REUD proprietor will invoke the rights under the EUTM or REUD, once registered, it is up to the applicant for inspection to prove this allegation. The proof to be submitted must take the form of documents, such as, statements by the EUTM applicant or REUD applicant or holder for the EUTM application, REUD application or registered and deferred REUD in question, business correspondence, etc. Filing an opposition based on an EUTM application against a national mark constitutes a statement that the EUTM will be invoked. Mere assumptions on the part of the applicant for inspection of the file will not constitute sufficient proof.

The Office will first examine whether the proof is sufficient.

If so, the Office will send the application for inspection of files and the supporting documents to the EUTM applicant or REUD applicant or holder and invite it to comment within two months. If the EUTM applicant or REUD applicant or holder consents to an inspection of the files, it will be granted. If the EUTM applicant or REUD applicant or holder submits comments contesting inspection of the files, the Office will send the comments to the applicant for inspection. Any further statement by the applicant for inspection will be sent to the EUTM applicant or REUD applicant or holder and vice versa. The Office will take into account all submissions made on time by the parties and decide accordingly. The Office's decision will be notified to both the applicant for inspection of the files and the EUTM applicant or REUD applicant or holder. It may be appealed by the adversely affected party (Articles 67 and 68 EUTMR and Article 56 EUDR).

6.13 Grant of inspection of files, means of inspection

When inspection is granted, the Office will send the requested copies of file documents, or requested information, as appropriate, to the applicant for inspection or invite it to inspect the files at the Office's premises. The Office will not forward the requested documents to any third parties.

6.13.1 Communication of information contained in a file

Article 114(9) EUTMR

Article 74b EUDR

Information regarding the file can be inspected by the user via eSearch Plus free of charge.

However, the Office may, on request, communicate information contained in any file relating to EUTM or REUD applications or registrations.

Information contained in the files will be provided without an application for inspection, inter alia, where the party concerned wishes to know whether a given EUTM application has been filed by a given applicant, the date of such application, or whether the list of goods and services has been amended in the period between the filing of the application and its publication.

Having obtained this information, the party concerned may then decide whether or not to request copies of the relevant documents, or to apply for inspection of the file.

Where the party concerned wishes to know, inter alia, which arguments an opponent has brought forward in opposition proceedings, which seniority documents have been filed, or the exact wording of the list of goods and services as filed, such information will not be provided. Instead the Office will advise the party to apply for inspection of the file.

In such cases, the quantity and complexity of the information to be supplied would exceed reasonable limits and create an undue administrative burden.

6.13.2 Copies of file documents

Where inspection of the files is by means of the Office providing certified or uncertified copies of file documents, the party will be sent the requested documents.

Where inspection of EUTM files is granted on the Office premises, the applicant will be given an appointment to inspect the files. However, it is strongly recommended to refrain from an inspection on the Office's premises, since the exact same information can be made available online or sent to the user through the user area (see paragraph 6.11.2).

6.13.3 Specific interest concerning the inspection applicant

Where a party shows a specific interest in knowing whether its file has been inspected and by whom, there should be a compromise between the general interest of the public to be able to inspect files of proceedings before the Office with a minimum of formalities and the parties' specific interest to know who has inspected the file in exceptional, duly justified circumstances.

Considering that online inspection requests are not communicated as a matter of course to the party whose file has been inspected, that party must put forward a reasoned and substantiated request showing that there are legitimate reasons for being informed if its file has been inspected, and by whom. The Office will not automatically grant such a request. Instead, on a case-by-case basis, it will balance these reasons against the explanations provided by the person who made the inspection within a period set by the Office to that effect, before any such request is granted.

7 Procedures to Give Access to the Files to Courts or Authorities of the Member States

Article 117(1) EUTMR

Article 75(1) EUDR

Articles 20 and 21 EUTMIR

Articles 77 and 78 EUDIR

For the purposes of administrative cooperation, the Office will, on request, assist the courts or authorities of the Member States by communicating information or opening files for inspection.

For the purposes of administrative cooperation, the Office will also, on request, communicate relevant information about the filing of EUTM or REUD applications and proceedings relating to such applications, and the marks or designs registered as a result thereof, to the central industrial property offices of the Member States.

7.1 No fees

Article 20(3) and Article 21(1) and (3) EUTMIR

Article 75(2) EUDR

Article 77(3) and Article 78(3) EUDIR

Inspection of files and communication of information from the files requested by the courts or authorities of the Member States are not subject to the payment of fees.

Article 21(3) EUTMIR

Article 78(2) EUDIR

Courts or public prosecutors' offices of a Member State may open to inspection by third parties files, or copies thereof, that have been transmitted to them by the Office. The Office will not charge any fee for such inspection.

7.2 No restriction as to unpublished applications

Articles 114(4) and 117(1) EUTMR

Article 20(1) EUTMIR

Articles 74 and 75(1) EUDR

Article 77(1) EUDIR

Inspection of files and communication of information from the files requested by the courts or authorities of the Member States is not subject to the restrictions contained in Article 114 EUTMR and Article 74 EUDR. Consequently, these bodies may be granted access to files relating to unpublished EUTM applications (see paragraph 4.2.1 above) and REUDs subject to deferment of publication (see paragraph 4.2.2 above), as well as to parts of the files for which the party concerned has expressed a special interest in keeping confidential. However, documents relating to exclusion and objection, as well as the documents referred to in Article 114(4) EUTMR and Article 74(4)(b) EUDR, will not be made available to these bodies.

Article 114(4) EUTMR

Article 21(3) EUTMIR

Article 74 EUDR

Article 78(2) EUDIR

Courts or public prosecutors' offices of the Member States may open to inspection by third parties files or copies that have been transmitted to them by the Office. Such subsequent inspection shall be subject to the restrictions contained in Article 114(4) EUTMR or Article 74 EUDR, as if the inspection had been requested by a third party.

Article 21(2) EUTMIR

Article 78(4) EUDIR

When transmitting files or copies thereof to the courts or public prosecutors' offices of the Member States, the Office will indicate the restrictions imposed on inspection of files relating, on the one hand to EUTM applications or registrations pursuant to Article 114 EUTMR, and on the other hand to REUD applications or REUD registrations pursuant to Article 74 EUDR.

7.3 Means of inspection

Article 21(1) EUTMIR

Article 78(1) EUDIR

Inspection of the files relating to EUTM/REUD applications or registrations by courts or authorities of the Member States may be granted by providing copies of the original documents. As the files contain no original documents as such, the Office will provide printouts from the electronic system.

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Chapter 1

Counterclaims

1 Introduction

Counterclaims, as provided for in Article 128 EUTMR or Article 84 EUDR, are defence claims made by a defendant that is being sued for the infringement of an EUTM or registered European Union design (REUD). By way of such a counterclaim, the defendant asks the European Union trade mark court (EUTM court) or European Union design court (EUD court) to declare the revocation or invalidity of the EUTM or the invalidity of the REUD that it is alleged to have infringed.

The purpose of recording the filing and the final judgment of the counterclaim in the Office Register lies in the general interest of making all the relevant information on counterclaims concerning EUTMs and REUDs, in particular the final judgments thereof, publicly available. In this way, the Office can implement these final judgments, in particular those that declare the total or partial revocation or invalidity of an EUTM, as well as those that declare the total invalidity of an REUD.

By entering such counterclaims and their final judgments in the Register, the Office strives to comply with the principles of conformity to truth, public faith and the legal certainty of a public register.

Application to register the filing of a counterclaim before an EUTM or an EUD court

Article 111(3)(n) and Article 128(4) EUTMR Articles 84, 84(5) and 72(3)(q) EUDR Communications No 9/05 and No 10/05 of the President of the Office of 28/11/2005

According to Article 128(4) EUTMR and Article 86(2) EUDR, the EUTM or EUD court before which a counterclaim for revocation of an EUTM or for a declaration of invalidity of an EUTM or REUD has been filed must inform the Office of the date on which the counterclaim was filed.

The Regulations provide that the court with which a counterclaim for revocation of an EUTM or for a declaration of invalidity of an EUTM or REUD has been filed must not proceed with the examination of the counterclaim until either the interested party or the court has informed the Office of the date on which the counterclaim was filed.

Communications No 9/05 and No 10/05 of the President of the Office of 28/11/2005 concern the designation of EUTM and EUD courts in the Member States pursuant to Article 123 EUTMR and Article 80 EUDR.

The Office also allows any party to the counterclaim proceedings to request the entry of a counterclaim in the Register, if not yet communicated by the EUTM or EUD court.

The applicant should:

- indicate the date on which the counterclaim was filed;
- quote the number of the EUTM or REUD concerned;
- state whether the application is for revocation or for a declaration of invalidity;
- submit evidence that the counterclaim has been raised before the EUTM or EUD court with authority to rule on the counterclaim, including, where possible, the case or reference number from the court.

If the above is not submitted, or if the information submitted by the applicant requires clarification, the Office will issue a deficiency letter. If the deficiencies are not remedied, the Office will reject the application for registration of the counterclaim. The party concerned may file an appeal against this decision.

The Office will notify the EUTM or REUD proprietor and the EUTM or EUD court that the counterclaim has been entered in the Register. If the request was made by the other party to the counterclaim proceedings, the Office will also inform this party.

If an application for revocation or for a declaration of invalidity of an EUTM had already been filed with the Office before the counterclaim was filed, the Office will inform the courts before which a counterclaim is pending in respect of the same mark. The courts will stay the proceedings in accordance with Article 132(1) EUTMR and Article 91(1) EUDR until the decision on the application is final or the application is withdrawn.

3 Application to register a judgment on a counterclaim before an EUTM or an EUD court

Article 111(3)(o) and Article 128(6) EUTMR

Articles 86(3) and 72(3)(r) EUDR

Where an EUTM or a EUD court has delivered a judgment that has become final on a counterclaim for revocation of an EUTM or for a declaration of invalidity of an EUTM or REUD, a copy of the judgment must be sent to the Office.

The Office also allows any party to the counterclaim proceedings to request the entry of a judgment on the counterclaim action in the Register, if not yet communicated by the EUTM or EUD court.

The applicant should:

- submit a copy of the judgment, together with confirmation from the EUTM or EUD court that the judgment has become final;
- indicate the date on which the judgment was issued;
- quote the number of the EUTM or REUD concerned;
- state whether the request is for revocation or for a declaration of invalidity;
- in the event of partial cancellation or invalidity, indicate the list of goods and services affected by the judgment, if relevant.

In order to enter the counterclaim in the Register, the Office needs confirmation that the judgment **is final** (passée en force de chose jugée/rechtskräftig/adquirido fuerza de cosa juzgada, etc.). If the Office requires clarification, it may request this in writing.

The Office must mention the judgment in the Register and take the necessary measures to comply with its operative part.

Where the final judgment partially cancels an EUTM, the Office will alter the list of goods and services according to the EUTM court judgment and, where necessary, send the amended list of goods and services for translation.

The Office will notify the EUTM or REUD proprietor and the EUTM or EUD court that the judgment has been entered in the Register. If the request was made by the other party to the counterclaim proceedings, the Office will also inform this party.