

# EU TRADE MARK REFORM

## Summary of changes applying from 1 October 2017

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*The EUIPO Guidelines are the main point of reference for users of the European Union trade mark system and professional advisers who want to make sure they have the latest information on our examination practices.*



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# **1 The European Union Trade Mark Legislative Reform Package**

The European Union trade mark Legislative Reform package comprises two primary legislative instruments: Directive (EU) 2015/2436, which replaces the existing European Union trade mark Directive (harmonising the trade mark laws of the EU Member States), and Regulation (EU) 2015/2424 (Amending Regulation), which amends the existing European Union trade mark regulation (EC) No 207/2009 (setting out the rules applicable to European Union trade marks and to the Office). It culminates the work that has been carried out over the last nine years on the reform of the European Union trade mark (EUTM) system.

## **1.1 The EUTM Legislative Reform package — background**

The starting point of the Legislative Reform can be traced back to the Commission's Communication of 16 July 2008 on an Industrial Property Rights Strategy for Europe, which announced that the Commission would carry out a comprehensive evaluation of the overall functioning of the trade mark system in Europe as a whole, covering Union and national levels and the interrelation between each other. Within this evaluation exercise, a *Study on the overall functioning of the European Trade Mark System*, carried out by the Max Planck Institute for Intellectual Property and Competition Law, at the request of the Commission, was published in March 2011. This was followed by a process of public consultation and impact assessment, which concluded in the Commission issuing two legislative proposals (for the reform of the said Directive and Regulation) in March 2013. Next, the proposals went through the ordinary legislative procedure (including trilogue negotiations between the institutions) and a political compromise was reached in April 2015, with final approval by the Council and by the plenary of the European Parliament at the end of 2015.

## **1.2 Aims of the reform**

The reform acknowledges the success of the existing EUTM system, confirming that its main principles have stood the test of time and continue to meet business needs and expectations. However, it seeks to build on this success by making it more efficient and consistent as a whole and adapting it to the internet era. The Amending Regulation, in particular, seeks to streamline proceedings and increase legal certainty, as well as to clearly define all the tasks of the Office, including the framework for cooperation and convergence of practices between the Office and the intellectual property offices of the Member States. It also entails a revision of the fees payable to the Office, including an overall reduction in their amounts, particularly significant in the case of renewals, and the adoption of a one-class-per-fee system.

## 2 Changes that Apply from 1 October 2017

### 2.1 EUTMR<sup>1</sup>

The second tranche of changes arising from the amended EUTMR apply from 1 October 2017. **The main changes are:**

- (i) introduction of EU certification trade marks;
- (ii) elimination of the requirement of graphical representation for EUTMs;
- (iii) the further transfer of certain provisions from the current secondary legislation to the EUTMR<sup>2</sup>; and
- (iv) other procedural changes.

As the EUTMR has been substantially amended several times, it will be codified from 01/10/2017. Below, **the references to the EUTMR refer to the *codified* version that will apply from 01/10/2017.**

### 2.2 Secondary legislation

The second source of changes arises from the fact that the EUTMR provides for secondary legislation being passed by the European Commission in the form of two separate acts, a Delegated Regulation (EUTMDR) and an Implementing Regulation (EUTMIR), both of which apply from 1 October 2017<sup>3</sup>.

**Annex 1 shows the process and timing of the EUTMDR and EUTMIR.**

Broadly speaking, the EUTMDR covers procedural rules relating to: opposition, revocation and invalidity actions; appeals to the Boards of Appeal; the organisation of the Boards of Appeal; notifications from the Office and communications with the Office; time limits and suspensions; and certain procedures concerning international registrations (IR). The EUTMIR covers matters such as: the contents of EUTM applications; representation of EUTMs; rules on publication and registration; language and translation issues; priority and seniority; transfers and surrenders; EU collective and certification marks; and certain procedures concerning international registrations.

## 3 EU Certification Marks (Articles 83 to 93 EUTMR Article 2(3) and Article 17 EUTMIR)

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<sup>1</sup> Council Regulation (EC) No 207/2009 on the European Union trade mark as amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16th December 2015 and subsequently codified by Regulation (EU) 2017/1001 of the European Parliament and of the Council.

<sup>2</sup> Many provisions from the current secondary legislation were transferred to the EUTMR on 23 March 2016.

<sup>3</sup> Consequently, European Union trade mark implementing regulation (EC) No 2868/95 (CTMIR) will be replaced by the EUTMR, the EUTMIR and the EUTMDR (see the [correlation table](#)).

**Starting on 1 October 2017**, the EUTMR introduces a new kind of EUTM, **certification marks**. These marks exist in some national systems, where they are used to indicate that goods or services comply with the certification requirements of a certifying institution or organisation. Certification marks have much in common with collective marks, but a collective mark indicates that goods or services come from a collective or group, whereas **a certification mark acts as a sign of supervised quality**. The basic fee for a certification mark is EUR 1 800 — (by electronic means, EUR 1 500).

An example of the role of a certification mark would be the use of the mark below to indicate that a product conforms fully with safety, health or environmental requirements set by the European Commission:



The criteria relating to EU certification marks are set out at Articles 83 to 93 EUTMR. They must be accompanied by regulations governing their use, which must be submitted within two months of the date of filing. The minimum content of these regulations is established in Article 2(3) and Article 17 EUTMIR. The criteria largely mirror the rules relating to collective marks, with the following noteworthy aspects.

- The owner of an EU certification mark may be a public body or a private entity, as such, EU certification marks cover both public and private certification schemes. Owners must not, however, carry on a business involving the supply of goods or services of the kind certified by the mark and must make a declaration to this effect (Article 83(2) EUTMR in conjunction with Article 17(b) EUTMIR).
- According to Article 17 EUTMIR, the regulations of use must contain, inter alia:
  - a list of goods and services covered by the mark;
  - the characteristics of the goods or services to be certified by the EU certification mark, such as the material, mode of manufacture of goods or performance of services, quality or accuracy;
  - the conditions governing the use of the EU certification mark including, where applicable, sanctions for non-compliance;
  - the persons authorised to use the EU certification mark;
  - how the certifying body is to test the characteristics and to supervise the use of the EU certification mark.

## 4 EUTM Applications

The main changes and codifications are:

- (1) particulars of EUTM applications;
- (2) elimination of the requirement for a graphical representation;
- (3) specific requirements for an expanded indicative list of types of marks;
- (4) priority and seniority claims;
- (5) formal requirements for applications;
- (6) acquired distinctiveness as a subsidiary claim; and
- (7) changes to particulars for EU collective marks.

#### **4.1 Particulars of EUTM applications (Article 2 EUTMIR)**

Changes regarding the particulars of EUTM applications include:

- an indication of the applicant's nationality is no longer compulsory. Even where nationality remains as a field for technical reasons (e.g. E-filing) it does not appear on the Register. Furthermore, absence of nationality would not be a basis for a deficiency.
- the applicant may now indicate a company identification number;
- the applicant can no longer refer to a previous EUTM to indicate the list of goods and services, but the selection of acceptable terms from a database of acceptable terms made available by the Office (e.g. the Harmonised Database) is now specifically referred to as an option.

#### **4.2 Representation of EUTMs**

##### **4.2.1 Elimination of the requirement for a graphical representation (Article 4 EUTMR and Article 3 EUTMIR)**

Pursuant to Article 4 EUTMR, an EUTM is no longer required to be represented graphically as long as it is represented in a manner that enables the competent authorities to determine the subject matter of protection with clarity and precision. Article 3 EUTMIR takes account of this change by providing that EUTMs may be represented in any appropriate form using generally available technology. On the one hand, it affirms that the precise subject matter of the exclusive right conferred by the registration is defined by the representation of the mark and, on the other, that the representation may be complemented by an indication of the type of mark concerned or, where appropriate, by a description that accords with the representation but that may not extend the scope of that representation.

The result is a 'what you see is what you get' (WYSIWYG) system, which aspires to make the trade mark entries on the EUTM Register clearer, more accessible and easier to search for.

## 4.2.2 Specific rules for types of marks (Article 3 EUTMIR)

Article 3 EUTMIR lays down specific rules and requirements for the representation of 10 of the most popular types of trade mark, including some technical requirements, in accordance with the trade mark's specific nature and attributes. The objective is to increase legal certainty for users and reduce the objections' rate for formalities' objections.

Type	Definition	Representation	Description	Format
<b>Word</b>	'a trade mark consisting exclusively of words or letters, numerals, other standard typographic characters or a combination thereof ...'.	Reproduction of the sign in standard script and layout, without any graphic feature or colour.	No	N/A
<b>Figurative</b>	'a trade mark where non-standard characters, stylisation or layout, or a graphic feature or a colour are used, including marks that consist exclusively of figurative elements or of a combination of verbal and figurative elements ...'.	<b>Change in practice</b> — colour claims are no longer possible, the representation must contain the colours, where applicable, and all the elements of the sign.  As some countries require an indication of colour in writing for claiming priority, EUIPO will provide an optional field in the e-filing form where colours can be listed. Any information entered will be visible in the EUTM application form but it will not be examined by the EUIPO nor will it be added to EUTM Register. It will not be translated and plays no further role in the EUTM process.	No	JPEG
<b>Shape</b>	a trade mark 'consisting of, or extending to <sup>4</sup> , a three-dimensional shape, including containers, packaging, the product itself or their appearance ...'.	'a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction.' The graphic or photographic reproduction may contain different views, up to six when not provided electronically <sup>5</sup> .	No	JPEG OBJ STL X3D

<sup>4</sup> The term 'extending to' means that the mark may cover not only shapes per se, but also shapes that contain word or figurative elements, labels, etc.

<sup>5</sup> If the electronic representation is not by means of a computer-generated image, it may consist of up to six views that must be submitted in one single JPEG file. Computer-generated images (OBJ, STL X3D files) tend to have multiple files.

Type	Definition	Representation	Description	Format
<b>Position</b> (new as a separate category <sup>6</sup> )	'a trade mark consisting of the specific way in which the mark is placed or affixed on the product ...'.	'a reproduction which appropriately identifies the position of the mark and its size or proportion with respect to the relevant goods'.  Elements that do not form part of the subject matter of the registration 'shall be visually disclaimed preferably by broken or dotted lines.'	Optional (previously <b>mandatory</b> )	JPEG
<b>Pattern</b> (new as a separate category)	'a trade mark consisting exclusively of a set of elements which are repeated regularly ...'.	Representation requires 'a reproduction showing the pattern of repetition.'	Optional	JPEG
<b>Colour (single)</b>	'a trade mark consisting exclusively of a single colour without contours ...'.	'A reproduction of the colour and an indication of that colour by a reference to a generally recognised colour code.' <b>Change in practice</b> — currently a colour code is not obligatory.	No	JPEG
<b>Colour (combination)</b>	'a trade mark consisting exclusively of a combination of colours without contours ...'.	'A reproduction of the colour combination that shows the systematic arrangement of the colour combination in a uniform and predetermined manner and an indication of those colours by a reference to a generally recognised colour code.' <b>Change in practice</b> — currently a colour code is not obligatory.	Optional (previously <b>mandatory</b> )	JPEG
<b>Sound</b>	'a trade mark consisting exclusively of a sound or combination of sounds ...'.	'by submitting an audio file reproducing the sound <b>or</b> by an accurate representation of the sound in musical notation.' <b>Change in practice</b> — current requirements are: (i) musical notation (with optional sound file) or (ii) a sonograph, which must be accompanied by a sound file.	No	JPEG MP3 (max 2 Mb)
<b>Motion</b> (new as a separate category)	'a trade mark consisting of, or extending to, a movement or a change in the position of the elements of the mark ...'.	'A video file showing the movement or change of position, or a series of still sequential images showing the movement, which may be numbered.'	Optional- still images (previously <b>mandatory</b> )	JPEG MP4 (max 20 Mb)
<b>Multimedia</b> (new)	'a trade mark 'consisting of, or extending to, the combination of image and sound ...'.	'an audio-visual file containing the combination of the image and the sound'.	No	MP4 (max 20 Mb)

<sup>6</sup> That is to say, types of marks that are explicitly enumerated for the first time although they were previously covered by broader categories. For example, pattern marks previously came within the broader category of figurative marks.

Type	Definition	Representation	Description	Format
<b>Hologram</b> (new as a separate category)	'a trade mark consisting of elements with holographic characteristics ...'	'a video file or a graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety.'	No	JPEG MP4 (max 20 Mb)

### 4.2.3 Publication and registration: links to electronic files for non-graphic representations (Article 7(c) and Article 9 EUTMIR)

The abolition of the requirement of a graphic representation means that certain types of trade marks that can be represented in electronic format only (e.g. multimedia marks) are now acceptable. It also means that EUTMs that are non-visual or comprise moving images become easier to file by making use of electronic means of reproduction. Publication using conventional means is, however, no longer viable for marks filed in this manner. In order to address this and to guarantee the availability of all the information concerning an application, **a link to the publicly available electronic file on the Office's Register** is now recognised as a valid form of representation for the purposes of publication and for issuing registration certificates.

## 4.3 Priority and seniority claims (Article 35 EUTMR, Article 4 and Article 7(f) EUTMIR and Article 39 EUTMR and Article 6 and Article 7(h) EUTMIR)

### 4.3.1 Priority

The main legislative changes are:

- priority claims must now be filed **on the same date as** the EUTM application (before, such claims could be made subsequent to filing the application);
- the documentation in support of the claim must be filed within **three months of the filing date** (previously within three months of receipt of the declaration of priority);
- If the supporting documentation is not in a language of the Office, it is now **optional** for the Office to request a translation of such documentation.

Article 35 EUTMR gives the Executive Director discretion to relax the requirements relating to the evidence in support of the priority claim to be submitted by the applicant.

A further change in the practice of the Office is that **the priority claim is no longer examined in substance at** the filing stage. At this stage, the Office will only examine whether all formal requirements have been met, namely:

- number, date and country of the purported first filing;
- availability of official online sources to verify the priority data or, where applicable, submission of priority documents and translations.

Consequently, priority remains as a ‘mere’ claim until it is relied upon in proceedings, whereupon it becomes necessary to verify it.

### 4.3.2 Seniority

The current requirement to file a copy of the relevant registration certified by the competent authority has been deleted and Article 6 EUTMIR now merely requires ‘a copy’ of the relevant registration to be submitted. However, under Article 39 EUTMR, the Executive Director had already relaxed the requirements for the relevant documentation. Therefore, there are no material practice changes regarding seniorities.

## 4.4 Formal requirements for an EUTM application (Article 31(3) EUTMR and Article 41(1)(a) EUTMR)

Article 31(1) EUTMR lists the particular conditions that must be met for a filing date to be granted. Article 31(1)(d) EUTMR adds that the representation of the EUTM must be one ‘which satisfies the requirements set out in Article 4(b) EUTMR’<sup>7</sup>. This does not, however, represent a material change to Office practice.

Where an EUTM application is deficient in some aspect, the EUTMR explicitly sets two months from the receipt of the notification from the Office as the deadline for the applicant to remedy this.

## 4.5 Acquired distinctiveness as a subsidiary claim (Article 7(3) EUTMR, Article 2(2) EUTMIR and Article 27(3)(a) EUTMDR)

The new provisions do not modify the assessment of the evidence of use under Article 7(3) EUTMR but:

- Article 27(3)(a) EUTMDR precludes an Article 7(3) EUTMR claim from being made **for the first time before the Boards of Appeal**. Instead, an Article 7(3) EUTMR claim of acquired distinctiveness can be made validly either together with the application, or, at the latest, in reply to a first objection;
- Article 7(3) EUTMR allows the claim to be filed as either a principal or a subsidiary claim.

Where the claim is a **principal** claim, the examiner will take **one** (single) decision on both the application’s inherent distinctiveness and, if such inherent distinctiveness is lacking, on the claim of distinctiveness acquired through use.

The second (new) option creates the possibility of making the claim as a **subsidiary** claim. Here the claim only crystallises if there is a negative final decision on inherent distinctiveness. Only at this point will there be a decision on

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<sup>7</sup> ‘... being represented on the Register of European Union trade marks (the Register), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor’.

the claim of acquired distinctiveness through use. This allows the applicant, in effect, to exhaust its right of appeal under Article 66 EUTMR on ‘inherent distinctiveness’ before it is required to prove acquired distinctiveness.

Applicants that indicate ‘principal claim’ in the application may request the change to ‘subsidiary claim’ (or vice versa) no later than in the reply to the first objection letter.

#### **4.6 EU collective marks (Articles 74 and 75 EUTMR, Article 2(3) and Article 16 EUTMR and, for IRs, Article 194 EUTMR and Article 76 EUTMDR)**

The regulations of use for EU collective marks have been amended and clarified as follows:

- the regulations must be submitted within two months of the date of filing. Their submission is treated as a **formal** requirement under Article 31(3) EUTMR, and therefore the absence of regulations of use is a relative deficiency that can be remedied under Article 41(2) EUTMR. In practice, if the regulations are not submitted with the application, a deficiency letter will be sent, setting a time limit of two months to submit them. Previously, where regulations were not submitted with the application, they were requested within a time limit set by the Office, so there is **no material change in practice**;
- if the applicant is an association (as opposed to a public body)<sup>8</sup>, the conditions of membership of the association must be specified;
- there is now a requirement to include the representation of the mark in the regulations;
- the goods and services must now be indicated in the regulations.

The above changes mean that the examination of the regulations of use must extend to checking whether they contain a representation of the sign and whether the goods and services have been specified and, if relevant, whether they have been limited consistently with the application.

## **5 EUTM Oppositions/Cancellation Proceedings**

**The main changes in this area are:**

- (1) rules on cancellations are aligned with those applicable to oppositions;
- (2) possible substantiation online;
- (3) a procedure for oppositions not substantiated from the outset;

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<sup>8</sup> Ownership of EU collective marks is limited to (i) associations of manufacturers, producers, suppliers of services, or traders; and (ii) legal persons governed by public law (Article 74 EUTMR).

- (4) consideration of new relative grounds;
- (5) framework rules on the discretion regarding belated evidence;
- (6) assignment of the challenged EUTM as an alternative remedy to invalidation;
- (7) suspension of surrenders, pending revocation (or, where a clear legal interest is demonstrated, invalidity actions); and
- (8) withdrawals and restrictions.

## **5.1 Ordering and alignment of opposition/cancellation proceedings (Articles 2 to 20 EUTMDR)**

The requirements of admissibility and substantiation for relative grounds' actions have been reordered to follow the sequence of the earlier rights (i.e. Articles 8(2) to (4) and (6) EUTMR). They also take into account the separate ground introduced by Article 8(6) EUTMR for geographical indications, which was previously included in Article 8(4) EUTMR).

The provisions applicable to cancellation proceedings are aligned with those applicable to opposition proceedings except where differences are justified by their different nature. The main alignments are:

- Article 15 EUTMDR brings admissibility requirements for cancellation actions more into line with equivalent provisions for opposition<sup>9</sup>. In particular, some previous **relative admissibility deficiencies have been 'requalified' to absolute**, including (but not limited to) the identification of grounds and of earlier rights, which now follow the same rules as oppositions. Cancellation applications that omit these requirements will be inadmissible, whereas, up to now, such deficiencies were remediable;
- Article 16 EUTMDR brings substantiation requirements for invalidity actions into line with equivalent provisions for oppositions to the extent possible. A key difference in invalidity actions, however, is that the substantiation period runs up to the closure of the adversarial part of the proceedings;
- Article 18(2) EUTMDR provides for the possibility of a refund of 50 % of the cancellation fee where there are multiple cancellation actions and the contested EUTM has been rejected in parallel proceedings.

**Annex 2 contains a table showing equivalent opposition and cancellation proceedings.**

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<sup>9</sup> The practice of examining the admissibility of **all** the earlier rights invoked in cancellation proceedings will continue. This differs from oppositions, where only one earlier right is normally examined for admissibility.

## **5.2 Substantiation from online sources (Article 7(3) and Article 16(b) EUTMDR)**

Where evidence concerning earlier rights that are ‘registered’ (e.g. registered trade marks, certain signs used in the course of trade or geographical indications) or the contents of the relevant national law are accessible from an online source recognised by the Office, the opponent or cancellation applicant may provide such evidence by making reference to that source.

For this purpose, the Office ‘recognises’ all of the databases of the national IP offices, and TMview is acceptable as a portal through which the national offices are ‘accessed’. General references to such databases and sources are sufficient, and the use of a direct hyperlink is optional. For example, if the opponent relies on an earlier Spanish trade mark, the Office will accept indications such as ‘the Spanish national intellectual property office’, or ‘OEPM’, or ‘Spanish CEO database’, or ‘www.oepm.es’, or ‘the administration with which the mark was registered’, etc.

## **5.3 Opposition not substantiated at the outset (Article 8(1) and (7) EUTMDR)**

The substantiation section of the EUTMDR distinguishes between:

- (i) oppositions that will be rejected directly either because no evidence is provided within the time limit or the evidence provided is manifestly insufficient or irrelevant; and
- (ii) oppositions where relevant evidence is filed within the time limit that will proceed and for which a full examination of substantiation will be conducted later.

Under Article 8(1) EUTMDR, where, until expiry of the substantiation period, the opponent has not provided any, or has provided only manifestly irrelevant or insufficient evidence of the existence, validity and scope of protection of the earlier mark or right, or of the entitlement to file the opposition, the opposition will be rejected as unfounded without further rounds of observations.

Where the opposition has not been rejected pursuant to Article 8(1) EUTMDR, it will still be rejected as unfounded later in the procedure, if the evidence submitted by the opposing party is not sufficient to substantiate the grounds of the opposition.

## **5.4 New relative grounds — geographical indications (Article 8(6) EUTMR, Article 2(2)(b)(v), Article 2(2)(e) and Article 7(2)(e) EUTMDR)**

Article 8(6) EUTMR includes a specific ground for oppositions based on earlier geographical indications. Article 2(2)(b)(v), Article 2(2)(e) and Article 7(2)(e) EUTMDR include the specific provisions on admissibility and substantiation for this ground. These provisions codify current practice.

## **5.5 Discretion as to belated evidence of substantiation and proof of use (Articles 8(5) and Article 10(7) EUTMDR)**

Articles 8(5) and Article 10(7) EUTMDR give legislative effect to the settled case-law of the Court of Justice of the European Union, which, unless otherwise provided, grants the Office discretionary powers when examining belated supplementary evidence for the purpose of substantiating an opposition or invalidity action, or proving genuine use of an earlier mark.

### **5.5.1 Substantiation (Article 8 EUTMDR)**

Under Article 8(5) EUTMDR where, even after the expiry of the substantiation period, the opponent submits facts or evidence that: (i) supplement relevant facts or evidence already provided within that period, and (ii) relate to the same requirement, the Office will exercise its discretion in deciding whether to accept these supplementary facts or evidence. In so doing, the Office will take into account, in particular, the stage of proceedings and whether the facts or evidence are, on the face of it, likely to be relevant for the outcome of the case; and have not been produced in due time for valid reasons.

In this context, registration certificates that do not contain all the information necessary to establish the existence, scope or validity of the earlier mark concerned would, in principle, be found to be manifestly insufficient, since the required content is precisely and exhaustively established by the Regulations.

Furthermore, the Office will find that the late fact or evidence relates to the same requirement only when both sets of facts or evidence refer to the same earlier mark, to the same ground and, within the same ground, to the same obligation. For example, if **no** facts or evidence were adduced in relation to detriment to reputation under Article 8(5) EUTMR within the initial period, any belated evidence submitted in this respect after the time limit would have to be discounted.

### **5.5.2 Proof of use (PoU) (Article 10(1) and (7) EUTMDR)**

The requirement that a request for PoU must be ‘unconditional’ is now explicit. This reflects current practice. Additionally, the request must now be contained in a ‘separate document’.

Article 10(7) EUTMDR, which deals with belated evidence of PoU, is similar in structure to Article 8(5) EUTMDR, which was explained above. It refers to ‘indications or evidence’ (instead of ‘facts or evidence’ under Article 8(5) EUTMDR); however, the same concepts are maintained, namely, that the Office’s discretion only applies where late evidence is ‘supplementary’ and that it relates to the ‘same requirement’.

In the context of belated evidence of PoU, the ‘same requirement’ refers to indications and evidence of the place, time, extent or nature of use for the same earlier trade mark. Accordingly, supplementary evidence can complement earlier evidence of place, time, extent or nature of use in relation to an earlier trade mark, but supplementary evidence

cannot make up for the complete absence of timely evidence for **any** of these individual requirements. For example, if no indications or evidence related to the place of use were submitted within the relevant time limit, any belated evidence submitted in this respect after the time limit would have to be discounted.

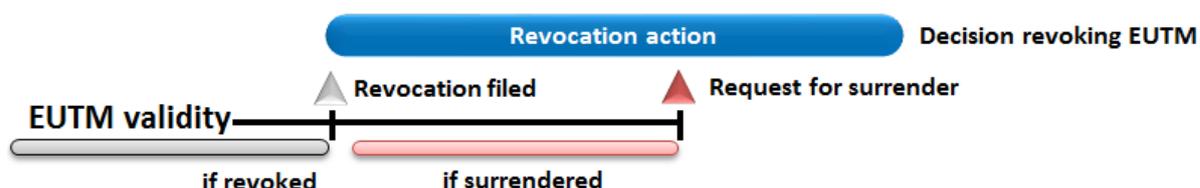
## 5.6 Assignment of EUTM as a remedy (Article 21(2)(a) EUTMR and Article 20 EUTMDR)

Where an agent or representative registers an EUTM without the proprietor's authorisation, the proprietor is now entitled to demand the assignment of the EUTM (unless the said agent or representative justifies his or her actions). Previously, the remedy for the proprietor under the EUTMR was to invalidate the EUTM. The new assignment process will follow the same procedural path as invalidity proceedings based on Article 60(1)(b) EUTMR.

Article 21 EUTMR makes clear that, before an EU trade mark court<sup>10</sup>, the proprietor may also submit a request for assignment instead of a counterclaim for a declaration of invalidity.

## 5.7 Suspension of surrenders, closure/continuation of pending revocation or invalidity actions (Article 57(2) EUTMR and Article 17(5) and (6) EUTMDR)

For some time there has been a certain amount of friction in the area of surrenders during pending revocation actions. Whilst the surrender of an EUTM becomes effective on the date on which the surrender is registered, a decision revoking an EUTM produces effects from the date on which the revocation request was filed. If a request for surrender were acted upon when a revocation action is pending, the validity of the EUTM could be prolonged beyond the filing date of the revocation request.



Consequently, the practice of the Office has recognised that, even where the EUTM is surrendered, a revocation applicant can still have a legitimate interest in continuing the cancellation proceedings in order to obtain a decision on substance<sup>11</sup>.

The legislature has now addressed the issue. The combined effects of Article 57(2) EUTMR and Article 17(5) and (6) EUTMDR follow below.

<sup>10</sup> As referred to in Article 123 EUTMR.

<sup>11</sup> Judgment of 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 39.

### 5.7.1 EUTM subject to revocation proceedings

- In cases of a total surrender of an EUTM that is subject to revocation proceedings or a partial surrender that affects the challenged goods and services, the registration of the surrender will be suspended pending a final decision or withdrawal of the revocation action. In such cases, the existence of a legitimate interest on the part of the revocation applicant is presumed.
- Where, after the revocation action has been filed, there is a total revocation in parallel proceedings or total expiry of the EUTM subject to revocation proceedings, or where that EUTM partially expires or is partially cancelled<sup>12</sup> for all the goods and services that are challenged, proceedings will be closed unless the revocation applicant demonstrates a legitimate interest in obtaining a decision on the merits.

### 5.7.2 EUTM subject to invalidity proceedings

- In the case of a total (i) surrender, (ii) revocation in parallel proceedings<sup>13</sup>, or (iii) expiry of an EUTM that is subject to invalidity proceedings or surrender, revocation or expiry for all the goods and services that are challenged, the proceedings will be closed unless the invalidity applicant demonstrates a legitimate interest in obtaining a decision on the merits.

Importantly, only cases of real, direct and existing conflicts supported by evidence will be considered as providing a 'legitimate interest' in continuing proceedings.

## 5.8 Separate document – withdrawals, restrictions, proof of use (Article 8(8) EUTMDR)

Where the applicant wishes to withdraw or restrict the contested application, it must do so by means of a separate document. This is to avoid situations where such requests are included as conditional elements or included in general observations, where they can only be detected by fully reviewing such observations in detail (which is not appropriate given the serious procedural impact of such requests). The request must therefore be 'separate' from other submissions: it may be filed simultaneously with other submissions, however, it must be presented separately (on a separate sheet). Consequently, a request will never be accepted where it is 'merged' into observations, even when it is included under a separate section, paragraph or header.

When such request is made electronically by selecting the specific option: 'submit a restriction of goods and services', or 'withdrawal', the automatic cover page generated will be considered as equivalent to a request in a 'separate document'.

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<sup>12</sup> If the challenged mark is invalidated totally (or for all the goods and services challenged) proceedings will simply be closed because there can be no legitimate interest in continuing because the mark is void *ab initio*.

<sup>13</sup> See footnote 12. In addition, parallel invalidity actions might raise issues of *res judicata*.

The same applies to requests for proof of use of an earlier mark pursuant to Article 47 (2) or (3) EUTMR, these are admissible if they are submitted as an unconditional request in a separate document within the period specified by the Office pursuant to Article 8(2) EUTMDR.

## **6 Horizontal Rules, Languages, Translation and Communications**

**Several changes were made to horizontal rules and to rules on communications by and with the Office to enhance transparency, effectiveness and to adapt to market realities. The principal changes relate to:**

- (1) time limits and suspensions;
- (2) continuation of proceedings;
- (3) languages and translation;
- (4) communications;
- (5) rules on presenting written evidence;
- (6) correction of errors and revocation of decisions.

### **6.1 Time limits and suspensions (Article 71 EUTMDR)**

The distinction in the minimum duration of time limits depending on whether a party is established within or outside the EEA has been eliminated.

A single provision on suspensions applicable to all proceedings has been introduced to replace the former approach of rules dispersed among specific provisions. The new provision identifies situations where the Office has discretion over granting a suspension (i.e. where it is on the Office's own motion or is based on a unilateral request). In *inter partes* proceedings, the Office will grant a suspension where both parties request it. The suspension can be up to six months, which may not be extended beyond a total of two years. This approach strikes a balance between discouraging delaying tactics whilst allowing parties a reasonable period for negotiations.

### **6.2 Continuation of proceedings (Article 105 EUTMR)**

According to Article 105 EUTMR, continuation of proceedings is now applicable to certain time limits where it was previously excluded, in particular, it now applies to the time limits set by the Office for the parties to submit observations within the opposition procedure, including the time limit for the opponent to substantiate its opposition.

## **6.3 Languages and translation (Article 24 EUTMIR, Article 7(4), Article 10(6) and Article 13(1) EUMTDR)**

### **6.3.1 Translations and standards of translation**

The requirements for translation have been simplified by the general provisions set out in Article 24 EUTMIR. Where the language used for evidence of substantiation (except certificates of filing, registration and renewal or provisions of relevant law) is not the language of the proceedings, a translation will now be required only where requested by the Office – of its own motion or upon reasoned request by the other party. Evidence of acquired distinctiveness or reputation would fall within this category.

However, evidence of substantiation (certificates of filing, registration and renewal or provisions of relevant law) must still be submitted in the language of the proceedings (or translated into this language) within the time limit set for substantiation.

Furthermore, the ‘standard of translation’ under Article 25 EUTMIR is less onerous than previously to the extent that, where a party has indicated that only parts of the document are relevant, the translation may be limited to those parts.

**Annex 3 contains a table setting out the language and translation regime.**

These changes will bring very tangible benefits to users, as they facilitate procedural economy, simplification and lower costs all round.

### **6.3.2 Opposition proceedings (Article 3 EUTMDR)**

Where, pursuant to Article 146(8) EUTMR, the opponent and the applicant agree upon a language for the opposition proceedings that is different to the default languages, the translation of the notice of opposition into the agreed language is required only if requested by the applicant.

### **6.3.3 Oral hearings (Article 50 EUTMDR)**

The language regime has been greatly simplified. Oral proceedings will be conducted in the language of the proceedings unless the parties agree to use a different official language of the EU. There is the possibility for parties or participants to communicate during the oral proceedings in any other official EU language subject to them bearing the costs of interpretation.

### **6.3.4 Second language validation**

From 1st October 2017, the Office will no longer invite comments from the applicant on the Office’s translation of the list of G&S into the second language<sup>14</sup>.

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<sup>14</sup> This obligation was contained in old Rule 85(6) CTMIR but has been deleted.

## 6.4 Communications

### 6.4.1 Notifications by the Office and communication with the Office (Articles 56 to 66 EUTMDR)

The means of communication by and with the Office have been changed to take account of developments in information technology. In particular:

- obsolete forms of communication have been removed, namely, hand delivery and deposit in a postbox at the Office;
- ‘electronic means’ is defined broadly so that it now covers fax and potentially many other types of media. The Executive Director will determine to what extent and under which technical conditions those media may be used (see information on Decision No EX-17-4 below);
- specific mention of ‘tele copier and other technical means’ of communication — which covers faxes — has been removed from secondary legislation (but see the previous point on ‘electronic means’<sup>15</sup>);
- ‘courier’ has been introduced specifically as a means of communication by and with the Office, alongside communications by post.

[Decision No EX-17-4](#) of the Executive Director of EUIPO, of 16 August, 2017, sets out the accepted means of electronic communication with the Office including an Annex setting out the technical requirements, size and formats for attachments to electronic filing and communication.

The Decision takes into account the legislative reform changes applying from 1 October 2017 and the changing communications landscape, in particular on the **use of fax**.

- From 1 October 2017, along with the User Area (e-filing), fax falls within the definition of communication by ‘electronic means’, meaning that the **discounted fee** for EUTM applications and renewals by electronic means in Annex I EUTMR will apply to fax.
- From 1 January 2018, however, fax will **no longer be accepted for filing EUTM applications or renewals** except as a **backup** system if technical malfunctions prevent e-filing. In such a case applicants can secure a filing date by fax if: (i) for EUTM applications, they resubmit the same application by e-filing within three working days; (ii) for EUTM renewals, they submit the renewal application by fax within the last three working days before the expiry of the initial or extended statutory time limit for renewal.

This change recognises the massive shifts away from fax for EUTM applications and renewals (less than 1% and 2% of the totals, respectively), but also recognises the reassurance that fax provides as a ‘backup’ system even for users who have switched

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<sup>15</sup> Article 57 EUTMDR: ‘Notification by electronic means covers transmissions by wire, by radio, by optical means or by other electromagnetic means, including the internet.’

to e-filing. Moreover, the change is a further step towards the Office's objective of becoming fully electronic by the end of the Strategic Plan 2020.

Finally, **from 1 October 2017**, applications for trade marks where the representation **has a colour component** (including figurative marks) **cannot be filed by fax** because there are no legal provisions that facilitate the subsequent filing of a representation in colour.

## **6.5 Structure and presentation of evidence (Articles 55 and 64 EUTMDR)**

A new provision (which mirrors the General Court Rules) introduces formal requirements on the structure and format of evidence attached to submissions, and requires that such evidence must be clearly identified, indexed and referenced. If parties fail to do this, the Office may invite them to remedy such deficiencies. Non-compliance could result in evidence, or part of it, being set aside.

Article 64 EUTMDR allows for annexes to communications submitted to the Office by post or courier to be contained on data carriers (CD-ROMs, DVDs, USB sticks, etc.) in accordance with technical specifications determined by the Executive Director. These annexes must comply with Article 55(2) EUTMDR.

## **6.6 Correction of errors and revocation of decisions (Article 102 EUTMR and Article 103 EUTMR)**

There have been some changes to the wording of the provisions dealing with correction of errors. Article 102 EUTMR now refers to 'manifest oversights in its decisions' as opposed to the previous wording 'obvious mistake in a decision'<sup>16</sup>. This is not considered by the Office to imply a change in practice. Likewise, the previous 'mistake or error' in publications and registrations has become 'technical errors'.

As regards revocation, the main changes are:

- the new time limit for revocation is one year instead of six months. The new wording states that the decision revoking the previous decision or cancelling the entry in the Register has to be **effected** within one year. 'Effected' is understood to mean **notification of the decision** revoking the erroneous decision or entry in the Register;
- revocation is now possible even where there are open appeal proceedings;
- revocation is no longer limited to 'obvious procedural errors' but only to 'obvious errors'. However, this new wording is not seen as extending the scope of revision to substantive issues but instead aims to clarify that revision also applies to instances entailing a distortion of facts or substantial procedural violations.

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<sup>16</sup> From Rule 53 EUTMIR.

## 7 Boards of Appeal

**Title V of the EUTMDR consolidates provisions relating to the Boards of Appeal that were previously spread across various sources:** the European Union trade mark Implementing Regulation (EC) No 2868/95; Commission Regulation (EC) No 216/96 (Rules of Procedure of the Boards of Appeal) and (to a lesser extent) decisions of the Presidium of the Boards of Appeal on the organisation of the Boards.

**The principal clarifications and changes relate to:**

- (1) content of the statement of grounds and of the response;
- (2) detailed framework for ‘cross appeals’;
- (3) claims raised and facts or evidence filed for the first time before the Board of Appeal;
- (4) new absolute grounds raised by the Board of Appeal;
- (5) expedited proceedings;
- (6) procedural framework for Executive Director’s requests to the Grand Board on points of law;
- (7) organisation of the Boards of Appeal.

### 7.1 Statement of grounds and of the response (Articles 22 and 24 EUTMDR)

The key clarifications and changes relate to the requirements for the statement of grounds, which must be filed within four months of the notification of the decision subject to appeal. It must include, inter alia, a clear and unambiguous identification of: (a) the decision subject to appeal; (b) grounds of the appeal; (c) the goods and services to which it relates (which must not be broader than those listed in the notice of appeal); and (d) the facts, evidence and arguments in support of the grounds invoked.

If the appellant fails to comply with the requirements of (a) and (b) within the time limit, despite having been informed by the Board of Appeal of the deficiency, the appeal will be inadmissible (Article 23(1)(e) EUTMDR).

In *inter partes* proceedings, the defendant may file a response within two months of the date of notification of the appellant’s statement of grounds. In exceptional circumstances, that time limit may be extended. The response must, inter alia, identify the decision subject to appeal and the facts, evidence, and arguments in support of the defence.

### 7.2 Cross appeals (Article 68 EUTMR and Article 25 EUTMDR)

Article 25 EUTMDR sets out a detailed framework for the lodging of a cross appeal by defendants. The time limit for filing a cross appeal is the same as for filing the response. The cross appeal must be submitted on a document that is **separate from the response** and must include, inter alia, a clear and unambiguous identification of: (a) the decision subject to appeal; (b) grounds for the appeal and the goods and services to which it relates; and (c) the facts, evidence and arguments in support of the grounds invoked in the cross appeal. If the defendant fails to comply with the requirements of (a), (b) and (c) within the time limit, despite having been informed by the Board of Appeal of the deficiency, the cross appeal will be inadmissible (Article 25(4)(c) EUTMDR).

Appellants may submit observations within two months of the notification of the cross appeal to them. In exceptional circumstances, the time limit may be extended.

### **7.3 Claims made, and facts or evidence filed, for the first time (Article 27 EUTMDR)**

#### **7.3.1 Grounds**

The examination of the appeal and, as the case may be, the cross appeal, will be restricted to the grounds invoked in the statement of grounds and the cross appeal. Therefore, if an opposition is based on Article 8(1)(b) and Article 8(5) EUTMR and the statement of grounds in the appeal or cross appeal very clearly relates only to Article 8(1)(b) EUTMR, the Board of Appeal will not examine Article 8(5) EUTMR.

#### **7.3.2 Claims**

Article 27 EUTMDR makes clear that the Board of Appeal will only examine the following claims provided that they have been raised in the statement of grounds for the appeal or, as the case may be, in the cross appeal, **and** provided that they were raised in due time in the proceedings before the first instance of the Office.

- (a) Distinctiveness acquired through use as referred to in Articles 7(3) and Article 59(2) EUTMR.
- (b) Recognition of the earlier trade mark on the market acquired through use for the purposes of Article 8(1)(b) EUTMR.
- (c) Proof of use pursuant to Article 47(2) and (3) EUTMR or Article 64(2) and (3) EUTMR.

#### **7.3.3 Facts or evidence**

The Board of Appeal may accept facts or evidence submitted for the first time before it only where those facts or evidence are, on the face of it, likely to be relevant for the outcome of the case, and where they have not been produced in due time for valid reasons. This is particularly the case where they are merely supplementing relevant facts and evidence that had already been submitted in due time, or are filed to contest

findings made or examined by the first instance of its own motion in the decision subject to appeal.

#### **7.4 Recommendation by a Board of Appeal to reopen examination of absolute grounds (Article 30 EUTMDR)**

Article 45(3) EUTMR makes clear that the Office may reopen the examination of absolute grounds of refusal at any time before registration. In the context of appeals, Article 30 EUTMDR provides a procedural framework for that practice. Thus, the Board of Appeal may recommend reopening the examination of absolute grounds:

- in *ex parte* cases, if the Board of Appeal considers that an absolute ground of refusal may apply to goods and services that do not form part of the subject matter of the appeal, it will decide to inform the examiner, who may reopen the examination regarding those goods and services.
- Where the appeal relates to an opposition, if the Board of Appeal considers that an absolute ground of refusal applies to some or all of the goods and services of the EUTM application, it may suspend the appeal proceedings and remit the EUTM application with a recommendation that the examination of absolute grounds be reopened. If the examination is reopened, the appeal proceedings will remain suspended until the examiner's decision has become final.

#### **7.5 Expedited proceedings (Article 31 EUTMDR)**

The appellant or defendant in an appeal may submit a reasoned request at any time during proceedings, asking the Board of Appeal to examine the appeal as a matter of urgency. This does not impose an obligation on the Boards of Appeal but envisages that, considering all of the circumstances, it may deem it appropriate to prioritise the case.

#### **7.6 Executive Director's requests to the Grand Board (Article 157(4)(I) EUTMR and Article 37(4) EUTMDR)**

In order to ensure uniform application of the EUTMR, the Executive Director of the Office can refer questions on a point of law to the Grand Board. The procedure for such referrals requires that the Executive Director's referral to the Grand Board:

- be in writing;
- state the questions of law of which the interpretation is sought;
- may also state the Executive Director's view on the different possible interpretations as well as on their respective legal and practical consequences;
- be published in the Official Journal of the Office.

## 7.7 Organisation of the Boards of Appeal (Articles 35 to 47 EUTMDR)

The EUTMDR addresses the organisation of the Boards of Appeal. **The key clarifications and changes in this area relate to:**

- requiring that cases annulled or altered by the Court of Justice or the General Court **must** be reallocated to a Board (not comprising those members who had adopted the annulled decision), so that a final formal decision on appeal is always taken by the Board of Appeal (Article 35(4) EUTMDR)<sup>17</sup>. Previously, the requirement for a final decision was not always clear;
- the composition of the Grand Board (Article 45 EUTMDR) and the rules on referrals to it (Article 37 EUTMDR);
- the conditions under which decisions are to be taken by a single member in accordance with Article 165(2) and (5) EUTMR. Article 36 EUTMDR now sets out the conditions under which a case is to be taken by a single member;
- clarification of the tasks of chairpersons and rapporteurs (Articles 40 and 41 EUTMDR);
- the main tasks of the Presidium are set out in Article 46 EUTMDR. Article 46(1) EUTMDR restates and clarifies the general competence of the Presidium laid down in Article 166(4)(a) EUTMR and contains an indicative list of tasks to be carried out by the Presidium under its general competence. These are:
  - a. to decide on the constitution of the Boards of Appeal;
  - b. to determine the objective criteria for the allocation of appeal cases to the Boards of Appeal and rule on any conflict as regards the application thereof;
  - c. upon proposal of the President of the Boards of Appeal, to establish the Boards of Appeal's expenditure requirements with a view to drawing up the Office's expenditure estimates;
  - d. to lay down its internal rules;
  - e. to lay down rules for the processing of exclusion and objection of members pursuant to Article 169 EUTMR;
  - f. to lay down the working instructions for the Registry;
  - g. to take any other measure for the purpose of exercising its functions of laying down the rules and of organising the work of the Boards of Appeal pursuant to Article 165(3)(a) EUTMR and Article 166(4)(a) EUTMR.

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<sup>17</sup> This provision substitutes Article 1(d) of the Rules of Procedure of the Boards of Appeal.

- Article 46(2) EUTMDR defines the Presidium's decision-making rules.

## 8 Transitional Provisions (Articles 37 and 38 EUTMIR and Articles 80 and 81 EUTMDR)

Both the EUTMIR and the EUTMDR apply from 1 October 2017. The legislation that they replace, Commission Regulation (EC) No 2868/95 and Commission Regulation (EC) No 216/96 is repealed from that date. However, it is appropriate to continue to apply specific provisions of those Regulations to certain proceedings that had been initiated before 1 October 2017 until the conclusion of those proceedings. Consequently, both the EUTMIR and the EUTMDR contain detailed transitional provisions that set out when the new procedural rules apply to proceedings. As a general rule, both Regulations apply to ongoing proceedings from 1 October 2017 unless otherwise provided.

**Annex 4 sets out all of the transitional provisions for the EUTMIR and EUTMDR.**

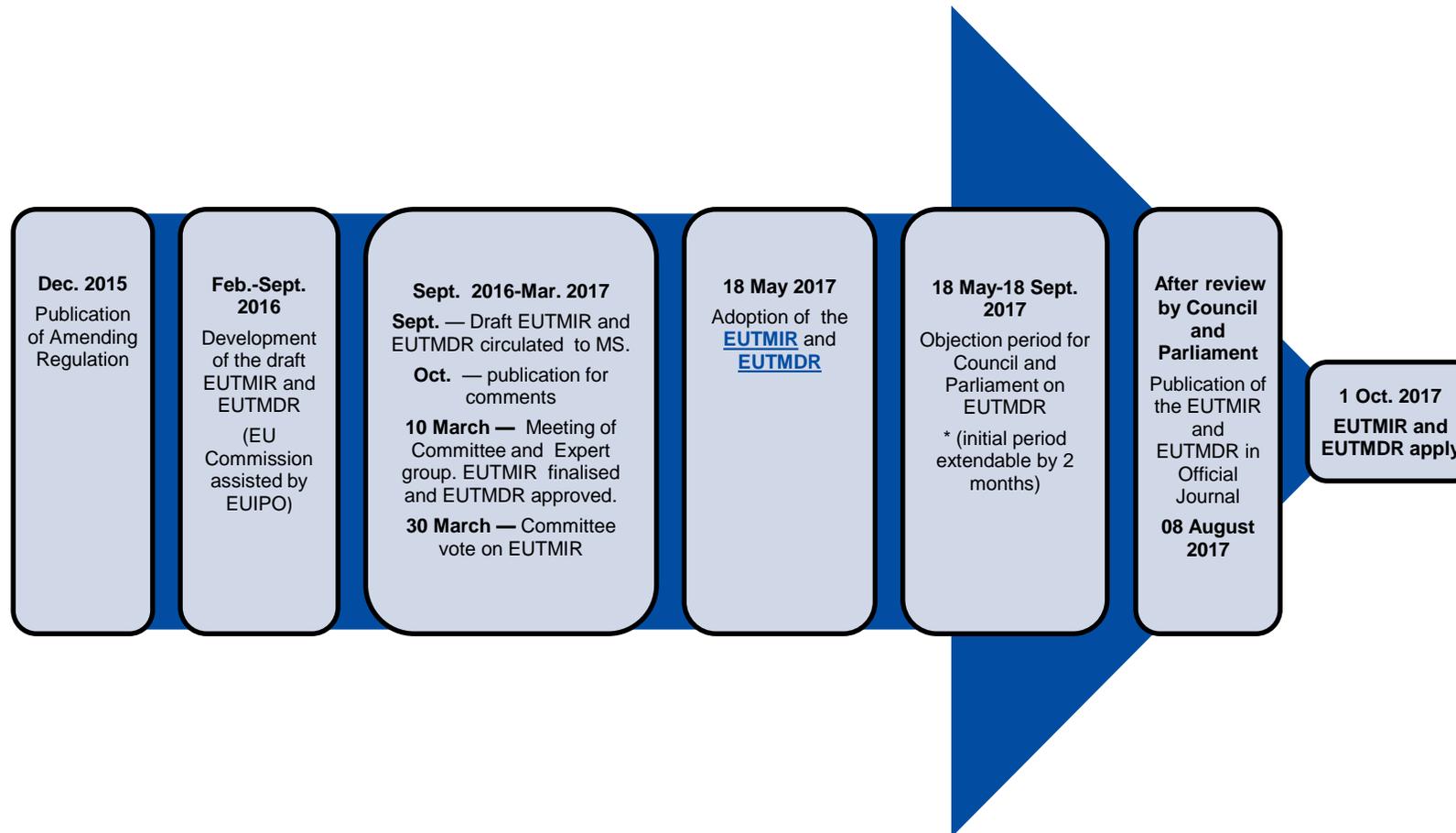
The following may be of particular interest.

New rules on:	Apply to	
<ul style="list-style-type: none"> <li>• Content of the EUTM application</li> <li>• Representation of the EUTM</li> <li>• Types of mark</li> <li>• Priority</li> </ul>	Applications for an EUTM <b>entered on or after 01/10/2017.</b>	EUTMIR
<ul style="list-style-type: none"> <li>• Certificate of registration</li> </ul>	EUTMs <b>registered on or after 01/10/2017.</b>	EUTMIR
<ul style="list-style-type: none"> <li>• Languages and Translations</li> </ul>	Supporting documents or translations <b>entered on or after 01/10/2017.</b>	EUTMIR
<ul style="list-style-type: none"> <li>• Substantiation and examination of oppositions/invalidity</li> <li>• Online substantiation</li> <li>• Belated evidence</li> </ul>	Proceedings for which the adversarial part started <b>on or after 01/10/2017.</b>	EUTMDR
<ul style="list-style-type: none"> <li>• Appeals</li> </ul>	Appeals entered <b>on or after 01/10/2017.</b>	EUTMDR
<ul style="list-style-type: none"> <li>• Structure and presentation of evidence</li> </ul>	Where the period for presentation of the evidence started <b>on or after 01/10/2017.</b>	EUTMDR
<ul style="list-style-type: none"> <li>• Notifications by the Office and communication with the Office</li> </ul>	Notifications and communication made <b>on or after 01/10/2017.</b>	EUTMDR
<ul style="list-style-type: none"> <li>• Suspension of proceedings</li> </ul>	Suspensions requested or imposed by the Office <b>on or after 01/10/2017.</b>	EUTMDR

## Annex 1

### EUTMIR and EUTMDR

	Procedure	European Commission (with)	European Parliament	EU Council
<b>EUTMIR</b>	<b>Comitology</b> Article 5 of Regulation No 182/2011 (Examination procedure)	<b>Committee of Member States</b> (vote by qualified majority)		<b>Right of scrutiny</b> Can indicate (at any time before adoption) that the draft act exceeds the European Commission's implementing powers, in which case the Commission is obliged to review its proposed action and inform the Parliament or Council of its reasons for deciding to maintain, amend or withdraw the act.
<b>EUTMDR</b>	<b>Article 290 TFEU</b>	<b>Expert group</b> (no vote) <ul style="list-style-type: none"> <li>• Member States;</li> <li>• Representative from Parliament;</li> <li>• EUIPO as observer.</li> </ul>		Can object within <b>2 months of adoption</b> * (Parliament by <b>absolute</b> majority/Council by <b>qualified</b> majority), in which case, it is the end of process for that particular proposal.



## Annex 2

### Alignment of opposition and cancellation proceedings

	EUTMDR	
<b>Notice of Opposition/Application for Cancellation</b>	Article 2	Article 12
<b>Entitlement to file, authorised persons</b>	Article 2(1)	Article 12(1)(c)
<b>Specific ground for geographical indication as earlier rights</b>	Articles 2(2)(b)(v) and Article 2(2)(e)	Article 12(2)(a)
<b>Identifying the ground for each earlier mark/right invoked</b>	Article 2(2)(c)	Article 12(3)
<b>Indication of the challenged goods and services in the Notice of Opposition/Cancellation</b>	Article 2(2)(i)	Article 12(1)(d)
<b>Language of the Office absolute requirement</b>	Article 5(3)	Article 15(2)
<b>Information to the parties concerning an application/deemed not to have been filed</b>	Article 5(6)	Article 14 and Article 15(5)
<b>Online evidence of substantiation</b>	Article 7(3)	Article 16(b)
<b>Language regime for evidence of substantiation</b>	Article 7(4)	Article 16(2)
<b>Evidence of substantiation is insufficient</b>	Article 8(7)	Article 17(3)
<b>Request for limitation or withdrawal of EUTM application on a separate document</b>	Article 8(8)	Article 17(4)
<b>Request for PoU on separate document, insufficient and belated evidence</b>	Article 10(1), (2) and (7)	Article 19(1) and (2)

## Annex 3

### Table on Languages and Translations

General provisions on languages and translations	
Areas	Changes
Written proceedings (observations) (Article 146(9) EUTMR)	No change
Supporting documents (Article 24 EUTMIR)	Changes below
Standard of translation (Article 25 EUTMIR)	<b>Change:</b> May limit translation only to relevant parts

### Specific provisions applicable to *inter partes* proceedings

Areas	Changes	Time limit	
<b>1. Written submissions</b>	Language of the proceedings	No change. Oppositions/cancellations must be filed in an Office language that is either the 1st or 2nd language of the contested EUTM.  (Articles 5(1) and 15(2) EUTMDR; Article 146(5) EUTMR)	If it is neither the 1st or 2nd language of the contested EUTM a translation must be produced within <b>1 month</b> of expiry of the opposition period or of the date of filing an application for revocation or a declaration for invalidity.  (Article 146(7) EUTMR)
	Translation of the notice of opposition/application for cancellation	<b>Change of practice</b> regarding the translation of the notice of opposition following a change of language. (Articles 3 and 16 EUTMDR)	Article 3 EUTMDR: Office to specify a time limit; Article 13(1) EUTMDR: 1 month.
	Further facts and evidence (observations)	No change. In oppositions, they must be submitted in the language of the proceedings or translated within the time limit for substantiation (Article 7(5) EUTMDR).  In cancellations, they must be submitted in the language of the proceedings within the time limit for substantiation, which is before the closure of the adversarial part of the proceedings. Where they are submitted in an <b>Office language</b> that is not the language of the proceedings they must be translated at the latest within one month of filing the original (Article 146(9) EUTMR).  Where they are submitted in an <b>EU language</b> (that is not an Office language) they will be rejected as the above <b>one month translation rule does not apply</b> .	Article 7(5) EUTMDR: time limit for substantiation.  Before the closure of the adversarial part.  submitted in an <b>Office language</b> that is <b>not the language of the proceedings</b> : they must be translated at the latest within <b>one month</b> of filing the original.
	1.4. Others (requests for suspensions, extensions, other observations, etc.)	No change where they are submitted in any language of the Office.	Translation must be submitted in <b>one month</b> . Article 146(9) EUTMR.

Areas			Changes	Time limit
<b>2. Supporting documents</b>	2.1. Evidence of substantiation (opposition, invalidity)	2.1.1. Filing, registration or renewal certificates or equivalent documents, and any provisions of the applicable national law	No change in opposition. Translations must be submitted in the substantiation time limit. Article 7(4) EUTMDR.  <b>Change of practice</b> in invalidity proceedings.	Translations must be submitted in the substantiation time limit. Article 7(4) EUTMDR.  Translation must be submitted within one month of filing the evidence. Article 16(2) EUTMDR.
		2.1.2. Any other evidence submitted by the opposing party to substantiate the opposition, cancellation action	<b>Change of practice.</b> Originals can be filed in an EU language.	Translations to be submitted only on request of the Office. Article 7(4), 16(2) EUTMDR and Article 24 EUTMIR.
	2.2. Evidence of use (revocation)	2.1.3. Evidence of use filed in case of application for revocation under Article 58(1)(a) EUTMR.	No change. Originals can be filed in an EU language.	Translations to be submitted only on request of the Office Article 16(2) EUTMDR and Article 24 EUTMIR.
	2.3. Other than substantiation	Proof of use	No change. Originals can be filed in an EU language.	Translations to be submitted only on request of the Office. Articles 10(6), 19(2) EUTMDR and Article 24 EUTMIR.
<b>3. Standard translation</b>	<b>of</b> Filing, registration or renewal certificates or equivalent documents (opposition and invalidity)	<b>Change of practice.</b> Where only parts of the document are relevant, the party may limit the translation to those parts only. Article 25 EUTMIR.		

## Annex 4

### Transitional Provisions

#### EUTMIR

##### *Article 38*

##### *Entry into force and application*

This Regulation shall enter into force on ...

It shall apply from 1 October 2017, subject to the following exceptions:

- |   |  |
|---|--|
| <ul style="list-style-type: none"><li>a) Title II shall not apply to applications for an EU trade mark entered before the abovementioned date, as well as to international registrations for which the designation of the Union was made before that date;</li><li>b) Article 9 shall not apply to EU trade marks registered before the abovementioned date;</li><li>c) Article 10 shall not apply to requests for alteration entered before the abovementioned date;</li><li>d) Article 11 shall not apply to declarations of division entered before the abovementioned date;</li><li>e) Article 12 shall not apply to requests for the change of name or address entered before the abovementioned date;</li><li>f) Title IV shall not apply to applications for registration of a transfer entered before the abovementioned date;</li><li>g) Title V shall not apply to declarations of surrender entered before the abovementioned date;</li><li>h) Title VI shall not apply to applications for EU collective marks or EU certification marks entered before the abovementioned date, as well as to international registrations for which the designation of the Union was made before that date;</li><li>i) Title VII shall not apply to costs incurred in proceedings initiated before the abovementioned date;</li><li>j) Title VIII shall not apply to publications made before the abovementioned date;</li></ul> | <ul style="list-style-type: none"><li>• Content of the application</li><li>• Representation of the trade mark</li><li>• Types of mark</li><li>• Priority</li><br/><li>• Certificate of registration</li><br/><li>• Content of the request for alteration of a registration</li><br/><li>• Declaration of the division of a registration</li><br/><li>• Content of a request for the change of the name or address of the proprietor</li><br/><li>• Transfer</li><br/><li>• Surrender</li><br/><br/><li>• EU collective marks and certification marks</li><br/><br/><li>• Costs</li><br/><br/><li>• Periodical publications</li></ul> |
|---|--|

- k) Title IX shall not apply to requests for information or inspection entered before the abovementioned date;
- l) Title X shall not apply to requests for conversion entered before the abovementioned date;
- m) Title XI shall not apply to supporting documents or translations entered before the abovementioned date;
- n) Title XII shall not apply to decisions taken before the abovementioned date;
- o) Title XIII shall not apply to international applications, notifications of facts and decisions on invalidity of the EU trade mark application or registration on which the international registration was based, requests for territorial extension, seniority claims, notification of *ex officio* provisional refusals, notifications of invalidation of the effects of an international registration, requests for conversion for an international registration into a national trade mark application and applications for transformation of an international registration designating the Union into an EU trade mark application entered or made before the abovementioned date, as the case may be.

- Administrative cooperation
- Conversion
- Languages and translations
- Organisation of the Office
  
- Procedures concerning the international registration of marks

## Transitional Provisions

### EUTMDR

#### *Article 81*

#### *Entry into force and application*

1. This Regulation shall enter into force on ...
  2. It shall be applicable from 1 October 2017, subject to the following exceptions:
    - a) Articles 2 to 6 shall not apply to notices of opposition entered before the abovementioned date;
    - b) Articles 7 and 8 shall not apply to opposition proceedings, the adversarial part of which has started before the abovementioned date;
    - c) Article 9 shall not apply to suspensions made before the abovementioned date;
    - d) Article 10 shall not apply to requests for proof of use made before the abovementioned date;
    - e) Title III shall not apply to requests for amendment entered before the abovementioned date;
    - f) Articles 12 to 15 shall not apply to applications for revocation or for a declaration of invalidity or requests for assignment entered before the abovementioned date;
    - g) Articles 16 and 17 shall not apply to proceedings, the adversarial part of which has started before the abovementioned date;
    - h) Article 18 shall not apply to suspensions made before the abovementioned date;
    - i) Article 19 shall not apply to requests for proof of use made before the abovementioned date;
    - j) Title V shall not apply to appeals entered before the abovementioned date;
- Notice of opposition
  - Languages in oppositions
  - Admissibility of oppositions
  - Commencement of the adversarial part
  - Substantiation and examination of oppositions:
    - Online substantiation
    - Belated evidence
  - Multiple oppositions
  - Proof of use in oppositions
  - Belated evidence
  - Amendment of the application.
  - Application for revocation/invalidity
  - Languages revocation/invalidity
  - Admissibility Revocation/invalidity
  - Substantiation revocation/Invalidity
  - Examination on the merits revocation/Invalidity
  - Suspension of pending revocation invalidity actions
  - Multiple applications for revocation or for a declaration of invalidity
  - Proof of use for revocation
  - Appeals

- k) Title VI shall not apply to oral proceedings initiated before the abovementioned date or to written evidence where the period for its presentation has started before that date;
- l) Title VII shall not apply to notifications made before the abovementioned date;
- m) Title VIII shall not apply to communications received and to forms made available before the abovementioned date;
- n) Title IX shall not apply to time limits set before the abovementioned date;
- o) Title X shall not apply to revocations of decisions taken or entries in the Register made before the abovementioned date;
- p) Title XI shall not apply to suspensions requested by the parties or imposed by the Office before the abovementioned date;
- q) Title XII shall not apply to proceedings interrupted before the abovementioned date;
- r) Article 73 shall not apply to EU trade mark applications received before the abovementioned date;
- s) Article 74 shall not apply to representatives appointed before the abovementioned date;
- t) Article 75 shall not apply to entries on the list of professional representatives made before the abovementioned date;
- u) Title XIV shall not apply to designations of the EU trade mark made before the abovementioned date.

- Oral proceedings and Structure and presentation of evidence
- Notifications by the Office
- Written communications and forms
- Time limits and extensions
- Revocation of a decision
- Suspension of proceedings
- Interruption of proceedings
- Appointment of a common representative
- Authorisations
- Amendment of the list of professional representatives
- Procedures concerning the international registration of marks

## EU TRADE MARK REFORM

Summary of changes applying from 1 October 2017

