

**DECISION 2020-1 OF 27 FEBRUARY 2020  
OF THE PRESIDUM OF THE BOARDS OF APPEAL ON  
THE RULES OF PROCEDURE BEFORE THE BOARDS OF APPEAL**

**(‘Rules of Procedure of the Boards of Appeal’)**

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**THE PRESIDIUUM OF THE BOARDS OF APPEAL,**

Having regard to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark<sup>1</sup> (hereinafter referred to as the ‘EUTMR’), and in particular Article 165, Article 166, Article 167, Article 169 and Article 170 thereof,

Having regard to Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EC) No 2017/1001 of the European Parliament and of the Council on the European Union trade mark and repealing Delegated Regulation 2017/1430 of 18 May 2017 (hereinafter referred to as the ‘EUTMDR’) and in particular Article 46(1)(a), Article 46(1)(f) Article 46(1)(g) thereof,

Having regard to Commission Implementing Regulation (EU) no 2018/626 of 5 March 2018<sup>2</sup> (hereinafter

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<sup>1</sup> OJ L 154, 16.6.2017, p. 1-99

<sup>2</sup> OJ L 104, 24.4.2018, p. 37

referred to as the ‘**EUTMIR**’),

Having regard to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs<sup>3</sup> (hereinafter referred to as the ‘**CDR**’) and in particular Article 106 and Article 108 thereof,

Having regard to Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs<sup>4</sup> (hereinafter referred to as the ‘**CDIR**’),

Having regard to Council Regulation (EC) No 2246/2002 of 16 December 2002 on the fees payable to the Office in respect of the registration of Community designs (hereinafter referred to as the ‘**CDFR**’),

Having regard to Regulation (EU) 2018/1725 of the European Parliament and of the Council of 23 October 2018 on the protection of natural persons with regard to the processing of personal data by the Union institutions, bodies, offices and agencies and on the free movement of such data, and repealing Regulation (EC) No 45/2001 and Decision No 1247/2002/EC<sup>5</sup> (hereinafter referred to as ‘**Regulation (EU) 2018/725**’).

Having regard to the decisions of the Executive Director of the Office, in particular decisions No EX-19-1 of 19 January 2019 on communication by electronic means, No EX-18-4 of 3 September 2018 concerning public notification, No EX-17-7 of 18 September 2017 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges, and No EX-17-6 of 22 September 2017 on the technical specifications for annexes on data carriers.

Whereas:

- (1) According to Article 165(1) EUTMR, the Boards of Appeal are to be responsible for deciding on appeals from decisions of the Office taken pursuant to Article 160 to 164 EUTMR.
- (2) Commission Regulation (EC) No 216/96<sup>6</sup> of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs), has been replaced by the EUTMDR, in particular by Title V, Articles 21 to 47.
- (3) According to Article 106 CDR, in addition to the powers conferred upon it by EUTMR, the Boards of Appeal shall be responsible for deciding on appeals from decisions of the examiners, the Invalidity Divisions and from the decisions of the Administration of Trade Marks and Designs and Legal Division as regards their decisions concerning Community Designs.
- (4) According to Article 108 CDR, the rules of procedure of the Boards of Appeal, shall apply to appeals heard under the CDR without prejudice to any necessary adjustment or additional provision.
- (5) According to Article 166(4)(a) EUTMR, the Presidium of the Boards of Appeal (hereinafter referred to as the ‘**Presidium**’) is responsible for laying down the rules of the Boards.
- (6) According to Article 46(1)(g) EUTMDR, the Presidium shall take any other measure for the purpose of exercising its functions of laying down the rules and organising the work of the Boards of Appeal.

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<sup>3</sup> [OJ L 3, 5.1.2002, p. 1-24 \(unofficial consolidation of 01/07/2013\)](#)

<sup>4</sup> OJ L 341, 12.12.2002, p. 28

<sup>5</sup> [OJ L 295, 21.11.2018, p. 39](#)

<sup>6</sup> [OJ L 104, 24.4.2018, p. 1-36](#)

- (7) According to Article 42(2) and (5) as well as Article 46(1)(f) EUTMDR, the Registrar shall perform the tasks relating to the conduct of appeal proceedings entrusted to it by those provisions, or as delegated or instructed by the Presidium of the Boards of Appeal.
- (8) According to Article 48 EUTMDR, the provisions relating to proceedings before the instance of the Office which adopted the decision subject to appeal shall be applicable to appeal proceedings *mutatis mutandis*.
- (9) According to Article 36(1) CDR, save as otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.
- (10) According to Article 107 EUTMR and Article 68 CDR, in the absence of procedural provisions in said regulations or in acts adopted pursuant to them, the Office shall take into account the principles of procedural law generally recognised in the Member States.
- (11) The EUIPO and its Boards of Appeal is under a duty to exercise its powers in accordance with the general principles of EU law, including the principles of equal treatment and sound administration.
- (12) In light of the foregoing considerations, and in order to ensure an effective, efficient and complete review of decisions of the Office by the Boards of Appeal, it is necessary to supplement the provisions applicable to appeal proceedings, and to specify the adjustments and adaptations needed for design appeal proceedings, with a view to ensuring consistent, transparent, thorough, timely, fair and equitable decision-taking.
- (13) The present Rules of Procedure of the Boards of Appeal, hereinafter the '**Rules**', shall apply to appeal proceedings before the Board of Appeals of the EUIPO concerning both trade mark and design matters unless otherwise specifically provided for.
- (14) The present Rules are without prejudice to what is laid down in the EUTMR, EUTMDR, EUTMIR, CDR, CDIR, which therefore shall prevail in case of doubt.

**HAS ADOPTED THE FOLLOWING DECISION:**

## CHAPTER I – GENERAL PROVISIONS

### *Article 1*

#### **Adversarial nature of appeal proceedings**

1. In inter partes appeal proceedings, the parties to the proceedings shall have access to the documents and items submitted, as well as to decisions taken by the Office pertaining to their case, irrespective of whether they are marked confidential or not.
2. In a design appeal proceedings, where a third party seeks to enter the appeal proceedings as an intervener pursuant to Article 54 CDR, access to the appeal file is granted only after the request to intervene has been accepted.

### *Article 2*

#### **Notifications to the parties**

1. The Registrar shall effect the notification of decisions, summonses and any notice or other communication from which a time limit is calculated, or which otherwise are to be notified to the parties, through the User Area or by other electronic means in accordance with Decision No EX-19-1 of the Executive Director of the Office unless it is impossible for technical reasons.
2. The Registrar shall effect notification by either post or courier where
  - (a) the electronic means are manifestly not operational; or
  - (b) no contact details for communicating by electronic means have been indicated; or
  - (c) the notification is effected in respect of an addressee who has no establishment or domicile within the EEA, as laid down in Article 58(2) EUTMDR and Article 48(2) CDIR.
3. In the event notification is not successful despite having been attempted using one of the available electronic means, and either post or courier, the Registrar shall effect the notification by public notice in accordance with Decision No EX-18-4 of the Executive Director of the Office.

### *Article 3*

#### **Calculation and extension of time limits**

1. Time limits mentioned in these Rules shall be calculated in accordance with Article 101 EUTMR and Articles 67 and 69 EUTMDR, or Articles 56, 57 and 58 CDIR respectively.
2. The time limits for filing a notice of appeal and statement of grounds cannot be extended.
3. A reasoned request for extension of the time limit for filing a response to an appeal or observations on a cross appeal shall be submitted within the original time limit. Where sufficient evidence of the invoked exceptional circumstances referred to in Articles 24(1) and 25(5) EUTMDR is not submitted, the Boards of Appeal may request such evidence if deemed necessary.
4. For all time limits set by the Boards of Appeal, an extension may be granted, in whole or in part, upon a reasoned request submitted within the original time limit.
5. Where a request for extension does not comply with the provisions of paragraphs 3 or 4, the Registrar shall reject it.
6. In inter partes proceedings, the Registrar shall invite the other party to file its observations on the request for extension within one month. Where the other party opposes the extension, the Board shall decide on it, having regard to the interests of the parties.
7. At the joint request of the parties in inter partes proceedings, the Registrar shall grant extensions of the time limit pursuant to paragraphs 3 and 4 above. Such extensions shall not exceed a total of six months, unless the parties justify exceptional circumstances.

*Article 4*

**Time limits applicable to parties outside of the EEA in design appeals**

Where these Rules provide for a time limit to be set by the Board or Registrar, a minimum time limit of two months shall be set for a party to a design appeal with no establishment or domicile within the EEA.

*Article 5*

**Mandatory representation of parties outside of the EEA**

1. A party having no establishment or domicile within the EEA, must be represented before the Boards in accordance with Article 119(2) EUTMR or Article 78(1) CDR.
2. Where, during appeal proceedings, the Boards of Appeal are informed that the representative of such a party:
  - (a) does not fulfil the requirements laid down in Article 120(1) EUTMR, or Article 78(1) CDR; or
  - (b) has relinquished the representation of that party;and no new representative has been appointed, the Registry shall invite the party to remedy the deficiency within two months.
3. If no new representative has been appointed within the prescribed two-month time limit, the Registrar shall inform the party that any submission, document or item filed on behalf of, or by a party having no establishment or domicile within the EEA, risks being deemed not to have been filed, and shall invite the party to submit its observations thereon within two months.
4. In the event the deficiency is not remedied, within the aforementioned time limits, the Registry shall consider any submission, document or item filed on behalf of, or by that party, as being deemed not to have been filed and give its reasoned opinion pursuant to Article 42(3)(c) EUTMDR to the Board, which shall decide on the admissibility of the submission, document or item.
5. The foregoing provisions are without prejudice to any on-going procedural time limits.

*Article 6*

**Confidential information**

1. A party may request that specific information in a submitted document or item is kept confidential. A request for confidentiality shall be explicit, defined as to its scope, and it shall include a justification of the party's special interest in keeping the document or item confidential.
2. Where confidentiality is requested, two versions of the document containing the information subject to the request pursuant to paragraph 1 shall concurrently be submitted: The unaltered version and a public version in which only the information subject to the request pursuant to paragraph 1 has been removed, unless demonstrated that total confidentiality is justified.
3. Where a request fulfils said requirements the Registrar shall mark as confidential the document or item containing information for which confidentiality is requested by the party.
4. Where a request does not contain reasons, the Registrar shall reject it.
5. Where a request does not comply with the other formal requirements laid down in paragraphs 1 and 2, the Registrar shall invite the party to remedy the deficiency within a specified time limit. Where a request is not remedied within the prescribed time limit, the Registrar may reject the request or remit it to a Chairperson or the Board.
6. Where a request for confidentiality has been rejected by the Registrar, the party concerned may demand that the Board shall decide on the request, in which case the Registrar shall mark the document as

confidential until the Board has taken its decision.

7. Where confidentiality is requested towards the other party, the Registrar shall invite the requesting party to withdraw either the request, or the document for which confidentiality is requested.
8. Where confidential information is communicated to the other party, such party shall keep that information confidential.

*Article 7*

**Sensitive personal data**

Where a document or item contains data concerning a natural person's racial, ethnic origin, political opinions, religious or philosophical beliefs, trade union membership, genetic data, biometric data, data concerning health, sex life or sexual orientation, the Registrar shall of its own motion or on request of the competent Board mark the document in question as confidential.

*Article 8*

**Confidentiality of internal documents**

1. All drafts, written opinions, notes, correspondence within the Boards of Appeal, as well as any other internal documents or items used for the preparation of deliberations and decisions, in particular opinions on admissibility, preliminary reports, deliberation minutes and draft decisions, shall be and remain secret.
2. No documents or items mentioned in the foregoing paragraph may be subject to inspection pursuant to Article 114 EUTMR or Article 74 CDR.
3. Documents relating to exclusion or objection pursuant to Article 169 EUTMR or 72(a) CDR shall be excluded from inspection.

*Article 9*

**Information not to be disclosed in design appeal proceedings**

Prior to the publication of a design, whether deferred pursuant to Article 50 CDR or not, the entire appeal file shall be considered information not to be disclosed. The Registrar shall of its own motion mark all documents and items contained in the aforementioned appeal file as confidential.



## CHAPTER II – WRITTEN PROCEEDINGS

### *Article 10* **Notice of Appeal**

1. Upon receipt of a notice of appeal, the Registrar shall examine whether it complies with the requirements laid down in Articles 66 to 68 EUTMR and 21 EUTMDR.
2. Where a notice of appeal does not comply with Article 68(1) EUTMR, the Registrar shall invite the appellant to file its observations on the admissibility of the appeal within one month.
3. Where a notice of appeal does not comply with Articles 66, 67 EUTMR or Article 21(1)(d), (2) and (3) EUTMDR, the Registrar shall inform the appellant of those deficiencies.
4. Where the notice of appeal does not comply with the requirements laid down in Article 21(1)(a), (b), (c) or (e) EUTMDR, the Registrar shall invite the appellant to remedy those deficiencies within one month pursuant to Article 23(1)(c) EUTMDR.
5. The notice of appeal shall be filed in the language of the proceedings.
6. Where the notice of appeal is filed in an official language of the EU other than the language of proceedings, the applicant shall, within four months of the date of notification of the contested decision, provide a translation into the language of proceedings in accordance with Article 21(2) EUTMDR.
7. Where the time limits referred to in the foregoing paragraphs are not complied with, the Registrar shall give its reasoned opinion pursuant to Article 42(3)(c) EUTMDR to the Board, which shall decide on the admissibility of the appeal.
8. Should the Board declare the appeal admissible, the file shall without delay be remitted to the Registrar for further prosecution.

### *Article 11* **Appeal Fee**

1. In the event of insufficient payment of the appeal fee pursuant to Article 68(1) EUTMR or Article 57 CDR respectively, or lack of payment within the prescribed time limit, the Registrar shall invite the appellant to file its observations on admissibility of the appeal within one month.
2. Where no observations are filed, or the appellant is unable to prove due payment was made within the prescribed time limit, the Registrar shall without delay remit the case to the competent Board for decision.
3. In the event the observations filed within the prescribed time limit prove the due payment of the appeal fee, or that payment has been made in accordance with the requirements laid down in Article 180(3) EUTMR or Article 7(3)(a)(ii) and 7(b) CDFR respectively, the Registrar shall consider the appeal deemed to have been filed, and continue written proceedings.

### *Article 12* **Reimbursement of appeal fee in trade mark appeal proceedings**

1. The Registrar shall pursuant to Article 42(3)(e) EUTMDR order, on behalf of the Boards, reimbursement of the appeal fee where a notice of appeal is deemed not to have been filed as referred to in Article 33(a) EUTMDR; or where the contested decision is revised or revoked by the decision making instance as referred to in Article 33(b) EUTMDR.
2. The Board shall order reimbursement of appeal fee where the contested decision has become devoid of purpose as referred to in Article 33(c) EUTMDR; or where it considers such reimbursement

equitable due to a substantial procedural violation as referred to in Article 33(d) EUTMDR.

3. In the aforementioned circumstances, reimbursement of the appeal fee may be granted regardless of whether it has been requested.

*Article 13*

**Reimbursement of the appeal fee in design proceedings**

1. The Registrar shall order, on behalf of the Boards, reimbursement of the appeal fee where, a notice of appeal is deemed not to have been filed pursuant to Article 57 CDR.
2. The Board shall order reimbursement where it considers such reimbursement equitable due to a substantial procedural violation as referred to in Article 37 CDIR.
3. In the aforementioned circumstances, reimbursement of the appeal fee may be granted regardless of whether it has been requested.

*Article 14*

**Statement of Grounds**

1. Upon receipt of a statement of grounds, the Registrar shall examine whether it complies with the requirements laid down in the fourth sentence of Article 68(1) EUTMR and Article 22 EUTMDR.
2. The scope and subject of appeal identified in the notice of appeal as referred to in Article 21(d) and (e) EUTMDR cannot be extended in the statement of grounds. In the event of contradiction, only the scope and subject identified in a duly filed notice of appeal shall be taken into account.
3. Where a statement of grounds does not comply with the relevant time limit laid down in Article 68 EUTMR, the Registrar shall invite the appellant to file its observations on the admissibility of the appeal within one month.
4. Where a statement of grounds does not comply with the requirements of identification pursuant to Article 22(1)(a) EUTMDR, the Registrar shall invite the appellant to remedy those deficiencies within one month pursuant to Article 23(1)(e) EUTMDR, unless the statement of grounds can be unambiguously matched to the relevant notice of appeal.
5. Where, according to Article 22(1)(b) EUTMDR, the contested decision is appealed in part, and the grounds of appeal are unclear and ambiguous with regard to the goods and services to which they refer, the Registrar shall invite the appellant to remedy that deficiency within one month pursuant to Article 23(1)(e) EUTMDR.
6. Where a statement of grounds is filed in an official language of the EU other than the language of proceedings, the appellant shall, within one month of the submission of the original, provide a translation into the language of proceedings in accordance with Article 22(2) EUTMDR.
7. Where a statement of grounds does not comply with the relevant language requirements laid down in Article 22(2) EUTMDR, the Registrar shall invite the appellant to file its observations on the admissibility of the appeal within one month.
8. Where the deficiencies referred to in the foregoing paragraphs are not remedied within the prescribed time limit, the Registrar shall give his reasoned opinion pursuant to Article 42(3)(c) EUTMDR to the Board on the admissibility of the appeal.
9. At the Chairperson's initiative, the Board shall decide without delay on the admissibility of the appeal. Should the Board declare the appeal admissible, the file may be remitted to the Registrar for further prosecution.

*Article 15*

**Admissibility of an Appeal**

1. An appeal shall be rejected as inadmissible unless both a notice of appeal pursuant to Article 10 of these Rules and a statement of grounds pursuant to Article 14 of these Rules have been duly filed within their respective time limits.
2. Where the deficiencies referred to in Articles 10 and 14 of these Rules are not remedied within the prescribed time limit, the Registrar shall without delay give his reasoned opinion pursuant to Article 42(3)(c) EUTMDR to the Board on the admissibility of the appeal.
3. At the Chairperson's initiative, the Board shall decide without delay on the admissibility of the appeal. Should the Board, however, declare the appeal admissible, the appeal proceedings shall continue.

*Article 16*

**Revision and interlocutory revision of decisions in ex parte appeal proceedings**

1. In ex parte proceedings, the Registrar shall, unless the appeal is rejected as inadmissible, remit the appeal to the instance which took the contested decision.
2. Where the instance which took the contested decision grants revision in accordance with Article 69(1) EUTMR or interlocutory revision in accordance with Article 58 CDR, the Registrar shall, on behalf of the Board, close appeal proceedings, reimburse the appeal fee in accordance with Articles 12 or 13 of these Rules, and inform the parties thereof.
3. Where the instance which took the contested decision, pursuant to Article 69(2) EUTMR or Article 58(2) CDR, remits the appeal to the Boards of Appeal without rectifying the contested decision, the Registrar shall continue the proceedings.

*Article 17*

**Response**

1. Upon receipt of a response, the Registrar shall examine whether it complies with the time limits laid down in Article 24 EUTMDR.
2. Where a response is submitted outside the time limit laid down in Article 24(1) EUTMDR, the Registrar shall invite the defendant to file its observations on the admissibility of the response within one month.
3. Where a response does not contain the contact information of a representative pursuant to Article 21(1)(b) or (c) EUTMDR as referred to in Article 24(2) EUTMDR, the Registrar shall invite the defendant to remedy that deficiency within one month.
4. Where a response does not contain a clear and unambiguous identification of the appeal proceedings to which it refers pursuant to Article 22(1)(a) EUTMDR in conjunction with Article 24(2) EUTMDR, the Registrar shall invite the defendant to remedy that deficiency within one month, unless the response can be matched to the relevant appeal.
5. Where a response is filed in an official language of the EU other than the language of proceedings, the defendant shall, within one month of the submission of the original, provide a translation into the language of proceedings in accordance with Article 22(2) EUTMDR, as referred to in Article 24(2) EUTMDR.
6. Where a response does not comply with the relevant language requirements laid down in Article 22(2) EUTMDR, the Registrar shall invite the defendant to file its observations within one month.

*Article 18*  
**Renewal certificates**

1. Where an earlier right is relied upon in appeal proceedings, the Registrar shall record its expiry date in the final procedural check foreseen in Article 24(3) of these Rules.
2. A party may at any time submit renewal certificates or equivalent documents concerning an earlier right relied upon.
3. Where the renewal certificate is in a language other than the language of proceedings, the right holder shall submit a translation of the certificate into the language of proceedings within one month.
4. If the party concerned has relied on online substantiation of an earlier right pursuant to Articles 7(3) and 16(2) EUTMDR, the Registrar shall verify the renewal in the online database relied upon.
5. Where it appears that the earlier right has expired without being renewed, or the online substantiation is not available, the Registrar, or, where the appeal file has been remitted to the Board for decision, the Rapporteur, shall invite the party to submit proof of renewal of that earlier right within one month.
6. Where proof of renewal has been submitted, the Registrar shall communicate it to the other party.

*Article 19*  
**Cross appeal**

1. A cross appeal pursuant to Articles 68(2) EUTMR and Article 25 EUTMDR, shall be submitted in a separate document within the original or extended time limit for filing a response. The cross appeal shall contain a clear and unambiguous identification of the subject and the scope of the cross appeal, as well as the corresponding grounds.
2. The cross appeal shall cease to have effect where the appellant discontinues the main appeal proceedings, or where the main appeal proceedings are otherwise closed.
3. Upon receipt of a cross appeal, the Registrar shall examine whether it complies with the requirements laid down in Articles 68(2) EUTMR and Article 25 EUTMDR.
4. Where the cross appeal:
  - (a) is submitted outside of the aforementioned time limit for filing; or
  - (b) is not submitted in a separate document pursuant to Article 25(2) EUTMDR; or
  - (c) does not clearly and unambiguously identify the contested decision in accordance with Article 21(1)(d) EUTMDR, as referred to in Article 25(4)(b) EUTMDR;the Registrar shall invite the defendant to file its observations on the admissibility of the cross appeal within one month.
5. If the cross appeal exclusively concerns a point already raised in the appeal, the Registrar, upon instruction of the Board, shall invite the defendant to file its observations on the admissibility of the cross appeal within one month.
6. Where a cross appeal does not contain the contact information of a representative pursuant to Article 21(1)(b), or (c) EUTMDR as referred to in Article 25(3) EUTMDR, the Registrar shall, pursuant to Article 25(4)(c) EUTMDR, invite the defendant to remedy that deficiency within one month.
7. Where a decision is contested only in part by a cross appeal in accordance with Article 21(1)(e) EUTMDR as referred to in Article 25(3) EUTMDR, and the grounds of the cross appeal are unclear and ambiguous with regard to the goods and services to which they refer, the Registrar shall invite the defendant to remedy that deficiency within one month.
8. Where a cross appeal is filed in an official language of the EU other than the language of proceedings, the defendant shall, within one month of the submission of the original, provide a translation into the language of the proceedings in accordance with Article 22(2) EUTMDR, as referred to in 25(4)(c) EUTMDR.
9. Where a cross appeal does not comply with the relevant language requirements laid down in Article 22(2) EUTMDR, the Registrar shall invite the defendant to file its observations within one month.
10. Where the deficiencies referred to in the foregoing paragraphs are not remedied within the prescribed

time limit, the Registrar shall give a reasoned opinion pursuant to Article 42(3)(c) EUTMDR to the Board on the admissibility of the cross appeal.

*Article 20*

**Response to the cross appeal**

1. Where a cross appeal has been duly filed, the Registrar shall invite the appellant to submit its observations thereon within two months of the date of the notification to the appellant.
2. Where a response to a cross appeal is filed in an official language of the EU other than the language of proceedings, the appellant shall, within one month of the submission of the original, provide a translation into the language of proceedings.
3. Where a response to the cross appeal has been filed late or in an incorrect language, the Registrar shall invite the appellant to file its observations on the admissibility of the cross appeal within one month.
4. The Registrar shall communicate the duly submitted observations of the appellant to the defendant.

*Article 21*

**Claims of acquired distinctiveness and request for proof of use**

A claim of distinctiveness acquired through use, a claim of recognition of the earlier mark acquired through use, or a request for proof of use shall only be examined if:

- (a) it is made in the statement of grounds or, as the case may be, in the cross appeal; and
- (b) it was first raised in due time before the instance of the Office which took the contested decision.

*Article 22*

**Second round of written submissions**

1. Upon a reasoned request submitted by the other party within two weeks of notification of a response, or the response to a cross appeal as the case may be, the Board may where necessary having regard in particular to the right to be heard, grant a second round of written submissions pursuant to Articles 26 EUTMDR and the last sentence of Article 25(5) EUTMDR.
2. Where a request for a second round of written submissions is not reasoned, the Registrar shall reject it.
3. Where a request for a second round of written submissions is submitted outside of the relevant time limit, the Registrar shall invite the requesting party to file its observations on the admissibility of the request within one month.
4. Where a second round of written submissions is granted, the Registrar shall invite the requesting party to supplement the statement of grounds, or the cross appeal respectively, by submitting a reply within one month.
5. Upon receipt of the reply, the Registrar shall invite the other party to supplement its response, or its response to the cross appeal as the case may be, by submitting a rejoinder within one month.

*Article 23*

**Written observations by interested parties in proceedings before the Grand Board**

1. A group or body representing manufacturers, producers, suppliers of services, traders or consumers, invoking an interest in the result of a case before the Grand Board may, pursuant to Article 37(6)

EUTMDR, file written observations in the language of proceedings within two months following the publication in the Official Journal of the referral to the Grand Board.

2. Where the written observations are filed in an official language of the EU other than the language of proceedings, the Registrar shall invite the aforementioned groups or bodies to submit a translation within one month.
3. No account shall be taken of written observations which do not comply with the aforementioned requirements.
4. Where written observations have been duly filed, the Registrar shall invite the parties to file their comments on those observations within one month.

*Article 24*

**Closure of written proceedings and final procedural check**

1. Written ex parte proceedings are closed when the time limit for filing a statement of grounds pursuant to Article 14 of these Rules has expired.
2. Unless otherwise specified by the Chairperson of the competent Board, written inter partes proceedings are closed:
  - (a) when the time limit for filing a response to the statement of grounds pursuant to Article 17 of these Rules has expired; or
  - (b) where a cross appeal has been filed pursuant to Article 19 of these Rules, when the time limit for filing observations has expired; or
  - (c) where a second round of written submissions is granted pursuant to Article 22 of these Rules, when the time limit for the reply has expired without the submission of a writ, or when the time limit for the rejoinder has expired.
3. Where written proceedings are closed, the Registrar shall conduct a final procedural check and provide a reasoned opinion to the Board on the admissibility of the appeal.

*Article 25*

**Invitation to file further observations**

Notwithstanding Articles 22 and 24 of these Rules, the Board may of its own motion, invite a party to file observations within one month on communications or submissions by the other party, or on any other subject that it deems necessary.

*Article 26*

**Reopening of written proceedings**

The Board may, at any time before the notification of the decision on the appeal, reopen written proceedings as and when necessary.

## CHAPTER III – ORAL PROCEEDINGS

### *Article 27*

#### **Ordering an oral hearing**

1. At the request of a party or of its own motion, the Board may decide to hold oral proceedings where it considers it to be expedient in accordance with Article 96 EUTMR or Article 64 CDR respectively.
2. Any request for an oral hearing made by a party must state the reasons for why that party wishes to be heard, or, as the case may be, why it considers it necessary to hear witnesses or experts.
3. Where the Board has decided to hold an oral hearing, the Registrar shall communicate it to the parties and issue the necessary summons accordingly.

### *Article 28*

#### **Date of the oral hearing**

1. The Chairperson of the Board shall fix the date of the oral hearing.
2. The Chairperson may, in exceptional circumstances, of his own motion or at the reasoned request of a party, adjourn the oral hearing to another date.
3. Where an oral hearing is ordered, the Board shall give at least two months' notice of the summons to the parties.
4. The Board may, together with the notice of summons, issue a communication drawing the attention of the parties to questions considered to be of particular significance to the case.

### *Article 29*

#### **Absence from an oral hearing**

1. Where a party duly summoned informs the Board that it will not be present at the hearing, or is absent without excuse, the hearing shall proceed in the absence of the party concerned.
2. Where all of the parties indicate to the Board that they will not be present at the hearing, the Chairperson shall decide whether the oral part of the procedure shall be closed.

### *Article 30*

#### **Running of an oral hearing**

1. Where an oral hearing has been ordered, oral proceedings are conducted in accordance with Article 96 EUTMR and Articles 49 to 54 EUTMDR, or Article 64 CDR and Articles 42 to 45 CDIR.
2. Without prejudice to Article 96(3) EUTMR and Article 64(2) CDR, oral hearings shall be public.
3. The Board may deliver the operative part of its decision orally at the end of the hearing. Where the operative part of the decision is delivered orally, the Board shall issue a reasoned written decision in a timely manner.

*Article 31*

**Minutes**

1. The Registrar shall draw up and sign the minutes of oral hearings in accordance with Article 53 EUTMDR, and Article 46 CDIR respectively, in the language of the proceedings.
2. The Registrar shall communicate the minutes to the parties.
3. In the case the hearing of witnesses or experts is not recorded, the Registrar shall, before signing the minutes, give to the witness or expert the opportunity to check their content and to sign them.
4. Where the oral hearing is recorded, the recording replaces the minutes or, if appropriate, becomes an integral part of the minutes.



## CHAPTER IV – ALTERNATIVE DISPUTE RESOLUTION

### *Article 32*

#### **Amicable settlement**

If before the Board has given its decision on the appeal, the parties in inter partes proceedings settle their dispute and as a consequence, the appeal proceedings are either rendered devoid of purpose as laid down in Article 42 of these Rules, or the appeal, opposition, invalidity or revocation claims are withdrawn, the Board shall close the proceedings, and where necessary, give a decision on the costs having regard to the agreement or any joint proposals made by the parties.

### *Article 33*

#### **Conciliation**

1. In inter partes proceedings, the Board may at any time take measures of conciliation in accordance with the applicable decision of the Presidium of the Boards of Appeal on the organisation of the Boards. Those measures may in particular consist of encouraging the parties to put an end to the dispute, requesting information, and, if appropriate, submitting proposals for a friendly settlement. The Board shall not be bound by any such measures.
2. No opinion expressed, suggestion made, proposal put forward, concession made or document drawn up for the purposes of the friendly settlement may be relied on as evidence by the Board or the parties, nor shall they be binding in any way in contentious proceedings.
3. The Board is not liable for the outcome of the conciliation, the compliance with the friendly settlement reached by the parties, or the legality and enforceability of the settlement agreement.
4. The Registrar shall mark documents or items submitted solely in the course of conciliation as confidential. Such documents or items shall not be subject to inspection of third parties pursuant to Articles 114 EUTMR or Article 74 CDR respectively.

### *Article 34*

#### **Mediation in inter partes proceedings**

1. In inter partes proceedings, mediation may be initiated by joint request of the parties at any time subsequent to the filing of the notice of appeal. Where such a request has been made, appeal proceedings shall be suspended in accordance with Article 44(6) of these Rules.
2. In inter partes proceedings, one of the parties, or the Rapporteur, may propose mediation at any time subsequent to the filing of the notice of appeal. Where such a proposal has been accepted by all parties concerned, mediation shall be initiated and appeal proceedings shall be suspended in accordance with Article 44(6) of these Rules.
3. Before the commencement of mediation, the parties shall sign an agreement on mediation, including clauses ensuring the authorization to negotiate a friendly settlement; an express undertaking on confidentiality including the confidentiality of the mediation agreement itself shall also be signed by the parties.
4. Mediation shall be conducted in accordance with the corresponding decisions of the Presidium of the Boards of Appeal.
5. In the event that mediation fails, the appeal proceedings shall be resumed.

## CHAPTER V – DISCONTINUANCE AND OTHER SPECIAL TYPES OF PROCEEDINGS

### *Article 35*

#### **Withdrawal**

1. An application for a EUTM or a registered design, an opposition, an application for revocation or for a declaration of invalidity, or an appeal, may be withdrawn, at any time before the Boards decision closing the appeal proceedings has become final, by means of an express, unequivocal and unconditional written declaration submitted in a separate document.
2. Where a declaration of withdrawal has been submitted before the decision on the appeal has been notified to the parties, and the appeal proceedings become devoid of purpose, the Board shall, as a matter of priority, close the proceedings without deciding on the merits of a case.
3. The party withdrawing shall bear the fees and costs, unless an agreement to the contrary signed by the parties has been submitted.
4. Where appeal proceedings have been closed due to a withdrawal of the appeal, the contested decision shall become final, including the order on fees and costs; in all other cases of withdrawal, the contested decision shall cease to have legal effect.

### *Article 36*

#### **Restriction of an EU trade mark application**

1. An application for an EU trade mark may be subject to a restriction at any time during appeal proceedings before the decision has become final, by means of an express, unequivocal and unconditional written declaration made in a separate document.
2. Where a restriction does not fulfil the formal requirements pursuant to paragraph 1, the Registrar shall invite the party to remedy the deficiency within one month. Where the deficiency is not remedied within the prescribed time limit, the Board may reject the restriction at the latest in its decision on the appeal.
3. Where a restriction appears to be otherwise unacceptable, the Board shall invite the party to remedy the deficiency within one month. Where the deficiency is not remedied within the prescribed time limit, the Board may reject the restriction at the latest in its decision on the appeal.
4. Where the restriction is admissible and acceptable, the Board shall inform the party accordingly and it shall be entered into the Register of European Union Trade Marks.
5. The aforementioned paragraphs shall apply regardless of whether the appeal is found inadmissible.
6. In inter partes proceedings, the Registrar shall invite the other party to state whether and to what extent it intends to continue its action in light of the recorded restriction.

### *Article 37*

#### **Transfer of title during appeal proceedings**

1. Where the contested EU trade mark or Registered Community Design has been transferred pursuant to Articles 20 EUTMR or 28 CDR respectively, or an earlier right on which the opposition or invalidity action is based has been transferred in accordance with the applicable law, the successor in title shall have legal standing in the appeal proceedings:
  - (a) where the transfer concerns an EU trade mark or a Registered Community Design, once that transfer has been entered into the register;
  - (b) where the transfer concerns a national registered right, once that transfer has been entered into the national register and evidence thereof has been submitted;
  - (c) where the transfer concerns an unregistered right recognised by national or EU law, once

- evidence of a duly made transfer in accordance with the applicable law has been submitted.
2. Paragraph 1 shall apply *mutatis mutandis* where an application for an EU trade mark, or a national trade mark has been transferred during appeal proceedings.
  3. Where a request for transfer of an EU trade mark or a Registered Community Design has been filed during appeal proceedings in accordance with Article 20 EUTMR or Article 28 CDR respectively, the Registrar shall invite the parties to submit their observations.
  4. Where a party submits a certificate of the transfer of an earlier national right, the Registrar shall invite the other party to submit its observations.
  5. Provided that a statement of grounds has been filed, once a request for transfer of an EU trade mark or a Registered Community Design has been filed in accordance with Article 20 EUTMR or Article 28 CDR respectively, the appeal proceedings may be suspended pursuant to Article 71(1)(a) EUTMR, until that transfer has been entered into the Register or the request has been rejected. Where appeal proceedings are suspended, any time limit related to the proceedings in question other than the time limit for the payment of the appeal fee, is interrupted. The time limit shall be recalculated to begin in full as from the day the transfer has been entered into the Register or rejected.
  6. The aforementioned provisions are without prejudice to Articles 50(2) and 56(2) EUTMR.

*Article 38*  
**Surrender**

1. A registered EU trade mark or a registered Community design may be fully or partially surrendered at any time before the Boards decision on the appeal has become final, by means of an express, unequivocal and unconditional written declaration submitted in separate document.
2. Where a declaration of surrender does not fulfil the formal requirements laid down in paragraph 1, the Registrar shall invite the party to remedy the deficiency within one month. Where the deficiency is not remedied within the prescribed time limit, the Board may reject the surrender at the latest in its decision on the appeal.
3. Where a declaration of surrender appears to be otherwise unacceptable, the Board shall invite the party to remedy the deficiency within one month. Where the deficiency is not remedied within the prescribed time limit, the Board may reject the surrender at the latest in its decision on the appeal.
4. In invalidity proceedings, where the declaration of a partial surrender is admissible and acceptable, it shall be entered into the Register of EU Trade Marks, or the Community Design Register. The Registrar shall invite the other party to state whether and to what extent it intends to continue its action in light of that surrender.
5. In revocation proceedings, where the declaration of surrender of an EU trade mark is admissible and acceptable, the surrender shall, pursuant to Article 57(2) EUTMR, be without effect until the application for revocation is rejected or withdrawn. The Registrar shall invite the revocation applicant to state whether and to what extent it intends to continue its action in light of the surrender.
6. Where applicable, the surrender shall only be entered into the register once proof has been received that all licensees of the EU trade mark being surrendered have been informed in accordance with Article 57(3) EUTMR.

*Article 39*  
**Division of EU trade mark applications and registrations**

1. Where during appeal proceedings, a request to divide an EU trade mark application or an EU trade mark registration has been submitted in accordance with Articles 50 or 56 EUTMR, the Board shall decide on the admissibility of the request for division at the latest in its decision on the appeal.
2. The Registrar shall inform the department in charge of the Register, and the departments dealing with parallel proceedings involving the same EU trade mark immediately after the notification of the

decision.

*Article 40*

**Conversion of an EU trade mark application or EU trade mark**

1. Where an earlier EU trade mark application, or an earlier EU trade mark, on which the opposition, application for revocation, or for a declaration for invalidity is based, is subject to conversion in accordance with Articles 139, 140, and 141 EUTMR during appeal proceedings, the resulting national earlier rights may be maintained as a basis for the opposition, application for revocation, or for a declaration for invalidity.
2. The Board shall take such national earlier rights into account, provided that the proprietor has submitted evidence substantiating those earlier rights in accordance with Articles 7(4) or 16(2) EUTMDR respectively.

*Article 41*

**Revocation of the contested decision**

Where, during the appeal proceedings, the contested decision is revoked by the decision making instance pursuant to Article 103 EUTMR, the Registrar shall inform the parties and the Board shall close the appeal proceedings and order a reimbursement of the appeal fee.

*Article 42*

**Appeal proceedings rendered devoid of purpose**

1. Without prejudice to Articles 35 to 41 of these Rules, an appeal is rendered devoid of purpose where:
  - (a) the earlier rights on which the opposition or invalidity action is based have been declared invalid, revoked, or are restricted, transferred, surrendered or the term of protection has expired with regard to the goods and services relevant to the appeal proceedings;
  - (b) an initially successful contested application has been rejected after revision pursuant to Article 34 EUTMDR, or a reopening of the examination on absolute grounds pursuant to Article 30 EUTMDR;
  - (c) an interlocutory revision has been granted pursuant to Article 58 CDR; or
  - (d) the appellant otherwise no longer has a legal interest in maintaining appeal proceedings.
2. In the aforesaid situations the Board shall, having heard the parties, close the proceedings without giving a decision on the appeal.

*Article 43*

**Expedited examination of an appeal**

1. Having regard to the particular circumstances of a case, the Chairperson of the Board to which that case is allocated may:
  - (a) at the request of a party, and having heard the other party; or
  - (b) upon request of a national court dealing with trade mark or design matters;decide to examine an appeal as a matter of priority.
2. The request of a party for expedited examination may be filed at any time during the proceedings, and

shall:

- (a) give reasons for the urgency and be supported by evidence of the same;
  - (b) be unconditional and unequivocal; and
  - (c) be made in a separate document.
3. Where the request does not fulfil the requirement laid down in paragraph 2(c), the Registrar shall invite the party to remedy the deficiency within one month.
4. The Registrar shall communicate the Chairperson's decision to the parties and, where applicable, to the requesting national court.
5. The granting of the request shall have the following effects:
  - (a) the Board shall examine the appeal as a matter of priority;
  - (b) the Board shall apply any means available to it, including alternative dispute resolution, for resolving the case in the most efficient and timely manner;
  - (c) the Board may not suspend the appeal proceedings by remitting the contested application for re-opening of the examination of absolute grounds pursuant to Article 45(2) of these Rules unless the Rapporteur finds that there are particular reasons justifying such remittal; and
  - (d) the Board may not grant a second round of written submissions pursuant to Article 22 of these Rules unless the Rapporteur finds that there are particular reasons justifying such a second round.
6. Following the examination of the allowability of the appeal the Board shall exercise, as the case may be, any power within the competence of the department which took the decision appealed.

#### *Article 44*

#### **Suspension**

1. Prior to the final procedural check pursuant to Article 24(3) of these Rules, the Registrar shall grant a suspension for a total period not exceeding six months
  - (a) at the reasoned request of a party; or
  - (b) at the joint request of both parties.
2. Where suspension is requested for a total period exceeding six months, the Registrar shall remit the request to the Chairperson for decision.
3. After the final procedural check pursuant to Article 24(3) of these Rules, the Board may
  - (a) at the reasoned request of a party; or
  - (b) at the joint request of both parties; or
  - (c) of its own motionsuspend the proceedings for a specified time period.
4. A request for extension of the suspension for a period exceeding six months may be granted by the Board if it is justified by the particular circumstances of the case having regard to the interests of the parties.
5. A request for suspension shall be submitted in a separate document and indicate the period for which suspension is requested. In the event no period is indicated, suspension may be granted by default for 2 months.
6. Suspension may not be granted prior to the due filing of a statement of grounds of appeal, unless the parties have submitted a mutual request for mediation pursuant to Article 170(4) EUTMR.
7. Where appropriate under the circumstances of the case, the Registrar shall invite the other party to file its observations on a request for suspension or resumption within one month. Where the other party opposes the suspension or resumption, the Board shall decide on the matter having regard to the competing interests of the parties.

*Article 45*

**Re-opening of the examination on absolute grounds in trade mark proceedings**

1. Where in ex parte proceedings, the Board considers that an absolute ground is applicable to goods and services outside the scope of appeal, the Board shall, in accordance with Article 30(1) EUTMDR, inform the instance which took the contested decision by reasoned letter. Where the first instance informs the Boards of Appeal that the examination of absolute grounds will be reopened, the Board suspends the appeal proceedings if appropriate.
2. In appeals on a decision of the opposition division, the Board may at any time, by means of a reasoned remittal decision in accordance with Article 30(2) EUTMDR, refer the EU trade mark application to the instance which took the contested decision, with the recommendation to reopen the examination on absolute grounds.
3. Where the Board has remitted an application in accordance with paragraph 2, the Registrar shall suspend the appeal proceedings until the instance which took the contested decision either:
  - (a) informs the Boards of Appeal that the examination of absolute grounds will not be re-opened, or,
  - (b) takes a new decision following the re-opening of the examination and informs the Boards of Appeal accordingly.
4. Where the decision of the examiner following a re-opened examination of absolute grounds is appealed, the Registrar shall allocate that appeal to the Board which recommended the re-opening in accordance with paragraphs 1 or 2.
5. Appeal proceedings concerning a decision of the Opposition Division shall be resumed once the decision on absolute grounds has become final.

*Article 46*

**Referral to the Grand Board**

1. Where the case is referred to the Grand Board in accordance with Article 37 EUTMDR, the Registrar shall communicate the decision on referral to the parties and take the necessary steps to have it published in the Official Journal of the Office.
2. Following such a referral the President of the Boards shall take a decision on the composition of the Grand Board in accordance with Article 45(1) EUTMDR; the Registrar shall notify that decision to the parties as well as any subsequent changes in the composition.
3. Following the referral, or upon the closure of written proceedings where observations pursuant to Article 37(6) EUTMDR have been submitted, the Rapporteur shall submit a preliminary report on the case.
4. Immediately following the distribution of the preliminary report, the Chairperson of the Grand Board shall schedule a first deliberation meeting.
5. Where the Grand Board refers a case back to the Board to which it was originally allocated, the Registrar shall inform the parties accordingly, and remit the appeal file to that Board.

*Article 47*

**Restitutio in Integrum**

1. A request for Restitutio in Integrum concerning an omitted act to be performed before the Boards of Appeal within a set time limit shall be filed in the language of proceedings.
2. Where the fee foreseen in Article 104(3) EUTMR or Article 67(3) CDR has not been paid, the Registrar shall inform the party that the request is deemed not to have been filed.
3. Where such request is deemed to have been filed, the Registrar shall examine whether it complies with

- the admissibility requirements laid down in Article 104 EUTMR or Article 67 CDR respectively.
4. The Registrar shall remit the request to the Board for decision, together with a reasoned opinion on its admissibility.
  5. Where the request concerns a time limit for filing an appeal foreseen in Article 68(1) EUTMR or Article 57(1) CDR respectively, the Registrar shall remit the file to the Board to decide on the admissibility of the appeal. Where the appeal is found to be admissible, the Board shall remit the appeal to the Registrar for further prosecution of the written proceedings.
  6. Where the request concerns a time limit other than those provided for in paragraph 5, the Registrar shall continue the written proceedings and inform the parties that the Board shall decide on the request after the closure of the written proceedings.
  7. Where following the granting of a request, the requesting party has had its rights re-established, written proceedings shall be reopened at the stage at which the obstacle to compliance occurred.
  8. Where a decision has already been taken, that decision shall be deemed to be void and the Registrar shall take the necessary steps to remove it from public access.

*Article 48*

**Continuation of proceedings on trade mark appeals**

1. A request for continuation of trade mark proceedings before the Boards of Appeal shall be filed in the language of proceedings.
2. Where such a request has been filed, the Registrar shall examine whether it complies with the requirements laid down in Article 105 EUTMR.
3. The Registrar may grant an application for continuation of proceedings where the foregoing requirements have been complied with.
4. Where the request does not comply with one or more of the formal requirements laid down in Article 105 EUTMR, or is not in the language of the proceedings, the Registrar shall remit the request to the Chairperson of the Board for decision.
5. The Registrar shall notify the parties of the decision on continuation of proceedings.

## CHAPTER VI – EVIDENCE

### *Article 49*

#### **Means of providing written evidence**

1. Evidence shall, in accordance with Decision No EX-19-1 of the Executive Director of the Office, be submitted using the electronic communications platform maintained by the Office or by using the only official fax indicated in the aforementioned decision.
2. Evidence may be given on data carriers in accordance with the technical specifications laid down in Decision No EX-17-6 of the Executive Director of the Office. Where evidence does not comply with those technical specifications, the Registry shall invite the party to remedy the deficiency within one month. Where the deficiency is not remedied within the prescribed time limit, the evidence shall be deemed not to have been filed pursuant to Article 4 of said decision of the Executive Director.
3. Alternatively, evidence can be submitted by post or courier. Where post or courier is used, evidence shall be submitted in as many copies as there are parties to the proceedings. The copies must be clearly identified.
4. Where a party provides evidence pursuant to Articles 7(3), 16(1)(c) and 16(2) EUTMDR by making reference to a freely accessible online source recognised by the Office, the party shall expressly indicate the specific information it puts forward as evidence from that source.
5. Where evidence does not comply with paragraphs 3 to 4, the Registrar shall invite the submitting party to remedy the deficiency within one month indicating that where the request is not remedied within the prescribed time limit, the Board shall not take into account the evidence in question.

### *Article 50*

#### **Types of written evidence**

1. In the substantiation of earlier rights, a party may rely on registration certificates or extracts from:
  - (a) Official databases of the EU;
  - (b) Databases maintained by organisations of the EU or international organisations, for example WIPO Global Brand Database, TMview, DesignView;
  - (c) Extracts from official bulletins of the relevant national or regional trade mark office and WIPO;
  - (d) Databases maintained by the national or regional IP offices or other national authorities of Member States;provided that they contain sufficient data to determine all the relevant particulars of the earlier right.
2. In the substantiation of the content of national law, a party must produce such elements thereof which enable the Board to correctly and unequivocally identify and verify the relevant provisions of the applicable national law including their interpretation by the national courts. In doing so a party may in particular rely on:
  - (a) Excerpts of legislative acts and translations thereof published by a public body;
  - (b) Relevant jurisprudence,
  - (c) Excerpts from official publication; legal commentaries, legal encyclopaedias;
  - (d) Databases maintained by the national or regional IP offices or other national authorities of Member States;
  - (e) Publications in official gazettes published by national or regional IP offices;
3. Where required to show use of a trade mark, or in substantiating acquired or enhanced distinctiveness, or reputation, a party may rely in particular on:
  - (a) supporting documents such as packages, labels, price lists, catalogues, photographs, newspaper advertisements;
  - (b) Market surveys representative of the relevant public and relevant time period, which



specifically target the recognition of the mark in question by use of neutral non suggestive questions;

- (c) Promotional material for which the scope of use is clearly established.
  - (d) Invoices linked to the trade mark or design in question and referring to the relevant period;
  - (e) Quotations of the trade mark in lists and publications of associations of the relevant profession;
  - (f) Sworn or affirmed statements in writing pursuant Article 97(1)(f) EUTMR;
- provided that they establish the place, time, extent and nature of use of the trade mark for the goods and services in respect of which it is registered and opposition or application for a declaration of invalidity or revocation is based.

#### *Article 51*

#### **Structure of written evidence**

1. Evidence shall comply with Article 55(2) EUTMDR. In particular, both the annexes and the pages of written evidence shall be consecutively numbered. The parties shall, for voluminous documents or items, indicate in the index of annexes which specific part of the document supports the facts grounds and arguments relied upon by the party.
2. Where the evidence or the index of annexes does not comply with the aforementioned requirements, the Registrar shall invite the submitting party to remedy the deficiency within one month indicating the consequences laid down in paragraph 3.
3. Where the deficiency is not remedied within the prescribed time limit, the evidence will not be taken into account, unless the Board finds that it is possible to clearly establish to which ground or argument a document or evidence refers.

#### *Article 52*

#### **Translation of evidence**

1. Where evidence pursuant the first sentences of Articles 7(4) or 16(2) EUTMDR, or Article 29(5) and (6) CDIR is not filed in the language of proceedings within time limits referred to in said Articles, the Registrar shall invite the appellant to file its observations on the admissibility of said evidence within one month, indicating that the Board shall not take into account the evidence in question in accordance with Articles 7(4), 7(5) or 16(2) EUTMDR.
2. In accordance with Article 24 EUTMIR, or Article 81(2) CDIR, the Board may
  - (a) at the reasoned request of the other party; or
  - (b) of its own motion,require that supporting documents other than evidence mentioned in the foregoing paragraphs, is translated into the language of proceedings within a specified time limit.
3. If the party fails to submit the translation as required in paragraphs 1 or 2, within the relevant time limit, the documents concerned will not be taken into account in accordance with Article 7(5) EUTMDR and the last sentence of Article 16(2) EUTMDR.

#### *Article 53*

#### **Incomplete or illegible evidence**

1. Where evidence submitted in accordance with Article 49 of these rules or translation of evidence submitted in accordance with Article 52 of these rules, is incomplete, illegible, cannot be opened, or where the Registrar has reasonable doubts as to the accuracy of the transmission, the Registrar shall invite the submitting party to retransmit the original within one month. Where the request is complied

- with, the date of receipt shall be deemed to be the date of the original. Where the request is not complied with within the prescribed time limit, the evidence shall not be taken into account.
2. Where in connection to an aforementioned retransmission, evidence is altered or new evidence is added after the original time limit, such new or altered evidence will not be taken into account.

*Article 54*

**Evidence filed in appeal proceedings**

1. Facts or evidence submitted for the first time before the Boards of Appeal shall be disregarded by the Board, unless such facts or evidence are prima facie likely to be relevant for the outcome of the case and:
  - (a) are merely supplementing relevant facts or evidence which had already been submitted in due time; or
  - (b) are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal; or
  - (c) were not available before or at the time the contested decision was taken; or
  - (d) are justified by any other valid reason.
2. Where facts or evidence pursuant to paragraph 1 are submitted to the Boards of Appeal, the Registrar shall forward them to the other party and inform both parties that the Board will decide on whether those facts or evidence are to be taken into account.

## CHAPTER VII – DECISIONS TAKEN BY THE BOARDS

### *Article 55*

#### **Treatment of information marked confidential in decisions**

1. The decision of the Board shall, to the extent possible while clearly indicating the grounds, facts and evidence integrally affecting the resolution, be drafted without expressing:
  - (a) confidential data pursuant to Article 6 and sensitive personal data pursuant to Article 7 of these Rules;
  - (b) in design cases, unpublished designs pursuant to Article 9 of these Rules, views, Locarno Classes, indications or descriptions of the product concerned; and
  - (c) personal data, where a party has requested its removal pursuant to Article 59 of these Rules.
2. The Board may reject a request for confidentiality insofar as it concerns information for which a special interest for confidentiality does not apply. The Board may disregard the request without hearing the parties where it concerns information for which a special interest for confidentiality is manifestly unfounded.
3. Where a request for confidentiality is not rejected or disregarded pursuant paragraph 2 and it is necessary for the decision to express information laid down in paragraph 1(a) to (c), the Board shall make a redacted version of the decision by removing that information.
4. Subsequent to the rejection of a request for confidentiality, the Registrar shall accordingly update the confidentiality status of the concerned document. Where a decision is redacted, the Registrar shall mark the unaltered version of the decision as confidential.

### *Article 56*

#### **Remittal to the instance which took the contested decision**

1. Where, pursuant to Article 71(1) and (2) EUTMR, or Article 60(1) and (2) CDR respectively, the Board decides to annul the contested decision and remits the case to the instance which took the decision, the Registrar shall make the case file available to that instance.
2. Unless justified by exceptional circumstances, a decision on remittal shall not be subject to a separate appeal to the extent it does not terminate examination, opposition or cancellation proceedings.

### *Article 57*

#### **Publication of decisions**

1. Upon notifying a decision to the parties, the Registrar shall undertake the necessary steps to make it available online.
2. Where a decision is redacted pursuant to Article 55(3) of these Rules, only the redacted version shall be published.
3. Without prejudice to paragraph 3 and notwithstanding the right to inspection pursuant Articles 114 and 117(1) EUTMR and Articles 74 and 75 CDR, the Board may exceptionally decide not to publish a decision where a redaction would severely limit or distort its informational value, in particular where:
  - (a) a request for removal of personal data pursuant Article 58(2) of these Rules is granted; or
  - (b) a decision of the first instance rejecting an application for a registered Community design for non-compliance with formal requirements is confirmed; or
  - (c) the deferral period pursuant Article 50 CDR has not yet expired.
4. Where a decision is taken in an official language of the EU other than English, an unofficial translation

into English shall be published online. Where available, unofficial translations in other languages shall also be published online.

*Article 58*

**Request for removal of personal data**

1. A party to the appeal proceedings may request that any personal data as defined in Article 3(1) of Regulation (EU) 2018/1725, is removed from the published decision. A request for removal shall be explicit and specify the data to be removed.
2. Where a request for removal is granted, the Registrar shall take the necessary steps to remove the data concerned from the decision in question.
3. A request to remove a trade mark or a trade mark number, as well as a design or a design number respectively, shall not be granted.

*Article 59*

**Correction of errors and manifest oversights**

1. At the reasoned request of a party, or of its own motion, the Board shall at any time correct errors in spelling or grammatical errors, errors of transcription, technical errors, or other errors which are so obvious that nothing other than the wording as corrected could have been understood in its decision, in accordance with Article 102 EUTMR or Article 39 CDIR respectively.
2. The aforementioned errors and manifest oversights in decisions are corrected by sending a reasoned corrigendum to the parties.
3. Once the corrigendum has been notified, the Registrar shall undertake the necessary steps to make sure that the corrections are reflected in the decision as published.
4. A corrigendum shall not affect the date of the corrected decision.

*Article 60*

**Revocation of a trade mark decision of the Board of Appeal**

1. Where a decision on a trade mark appeal contains an obvious error attributable to the Board which took the decision, the latter may, at the reasoned request of a party, or of its own motion in accordance with Article 103 EUTMR, revoke its decision within one year of the date on which it was taken.
2. Prior to the revocation of a decision, the Rapporteur shall invite the other party, or, as the case may be, both parties, to submit observations on the intended revocation within one month.
3. The Registrar shall keep records of any such revocation, and take the necessary steps to remove the revoked decision from public access.

*Article 61*

**Revocation of a design decision of the Board of Appeal**

Article 60 of these Rules shall apply where a decision on a design appeal contains an obvious error attributable to the Board.

## CHAPTER VIII – COSTS

### *Article 62*

#### **Recoverability and apportionment of costs**

1. Fees paid to the Office, representation costs and other costs essential to the proceedings shall be apportioned between the parties in accordance with Article 109 EUTMR or Article 70 CDR.
2. A party who has not been represented in the appeal proceedings, shall not be awarded reimbursement of costs.
3. Representation costs may be recovered where the party is represented by a professional representative as defined in Article 120(1) EUTMR or Article 78(1) CDR.
4. Where a party is represented by an employee representative according to Article 119(3) EUTMR, there shall be no entitlement to representation costs even if that representative is also listed as professional representative.
5. The Board shall take note of any agreement on costs reached by the parties provided that evidence of such agreement has been filed.

### *Article 63*

#### **Decisions on costs in trade mark appeal proceedings**

1. The Board shall, of its own motion, decide on the apportionment of costs limited to fees paid to the Office and representation costs, and fix those costs in the decision on the appeal.
2. Pursuant to the second sentence of Article 109(7) EUTMR, the amount of costs essential to the proceedings other than those mentioned in the foregoing paragraph shall be fixed separately at the request of a party filed within the two months following the date on which the decision closing the appeal proceedings becomes final.
3. Any such request for fixing the amount of costs must be made in the language of proceedings, and shall unequivocally specify the appeal proceedings to which it refers.
4. That request must be accompanied by an invoice and supporting evidence.
5. The Registry shall decide on the request, having heard the other party, after the decision of the Board has become final.
6. The rates for the various categories of costs shall be calculated in accordance with Article 18 EUTMR.

### *Article 64*

#### **Decisions on costs in design appeal proceedings**

1. At the request of a party, the Board shall decide on the apportionment of costs consisting of fees paid to the Office and representation costs.
2. The amount of costs other than those consisting of fees paid to the Office and representation costs shall be fixed by the Registry in accordance with Article 65 of these Rules.
3. The rates for the various categories of costs shall be calculated in accordance with Article 79(6) and (7) CDR.

*Article 65*

**Request for fixing the amount of other essential costs in design appeals**

1. The Registry shall, at the request of a party, and having heard the other party, fix the amount of essential costs to be reimbursed other than representation costs and fees paid to the Office.
2. In order to be admissible, such a request shall be filed after the decision closing the appeal proceedings has become final.
3. That request must be accompanied by an invoice and supporting evidence, such as receipts and invoices issued to the requesting party or its representative.
4. Any request for fixing the amount of costs must be made in the language of proceedings, and shall unequivocally specify the appeal proceedings to which it refers.

*Article 66*

**Review of a decision on costs**

1. At the reasoned request of a party submitted in the language of proceedings within one month of the notification of the awarding of costs, and upon payment of the corresponding fee within said time, the Board shall review a decision on costs in accordance with Article 109(8) EUTMR or the second sentence of Article 70(6) CDIR.
2. Where the request is filed in an official language of the EU other than the language of proceedings, the Registrar shall invite the party to submit a translation within one month.
3. The Registrar shall reject the request where:
  - (a) it has been filed outside of the time limit laid down in paragraph 1; or
  - (b) the fee has not been paid in full, or is paid outside of the time limit laid down in paragraph 1;or
  - (c) a translation is not filed within the time limit laid down in paragraph 2.
4. Where a request pursuant to paragraph 1 has been duly filed, the Registrar shall invite the other party to submit its observations within one month.
5. Upon receipt of the observations of the other party, the Registry shall remit the request to the Board for decision.
6. Costs or fees incurred in the review procedure cannot be recovered or reimbursed.

**CHAPTER IX – FINAL PROVISIONS**

*Article 67*

**Repeal**

Decision 2009-1 concerning instructions to the parties and Decision 2014-2 on Conciliation are repealed.

*Article 68*

**Implementation**

In accordance with Article 166(4)(b) EUTMR, the President of the Boards of Appeal is entrusted with the implementation of the present decision.

*Article 69*

**Entry into force**

The present decision shall enter into force on 27 February 2020.

Done at Alicante, 27 February 2020

*For the Presidium*  
*The President of the Boards*  
Théophile M. MARGELLOS