

***GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)***

PART E

REGISTER OPERATIONS

SECTION 1

CHANGES IN A REGISTRATION

Table of Contents

1	Surrender	4
1.1	General principles	4
1.2	Legal effect	4
1.3	Formal requirements	5
1.3.1	Form	5
1.3.2	Language.....	5
1.3.3	Fees.....	5
1.3.4	Necessary particulars	5
1.3.5	Partial surrender	6
1.3.6	Signature	6
1.3.7	Representation, authorisation.....	6
1.3.8	Requirements where a licence or other right in the European Union trade mark has been registered.....	6
1.4	Examination	7
1.4.1	Competence	7
2	Alteration of a Trade Mark	8
2.1	General principles	8
2.2	Formal requirements	8
2.2.1	Form and language	8
2.2.2	Fees.....	8
2.2.3	Mandatory indications.....	9
2.3	Substantive conditions for alteration	9
2.3.1	Examples of acceptable alterations.....	10
2.3.2	Examples of unacceptable alterations.....	10
2.4	Publication	11
3	Changes of Name or Address	11
4	Changes in Collective Trade Mark Regulations	13
4.1	Registration of the amended regulations	13
5	Division	14
5.1	General provisions	14
5.2	Formal requirements	14
5.2.1	Form and language	14
5.2.2	Fees.....	14
5.2.3	Mandatory indications.....	14
5.3	Registration	16
5.4	New file, publication	16
6	Post-Registration Seniority Claims	17

6.1	General principles	17
6.2	Legal effect	17
6.3	Formal requirements.....	17
6.3.1	Form	17
6.3.2	Language.....	18
6.3.3	Fees.....	18
6.3.4	Mandatory indications.....	18
6.4	Examination.....	18
6.4.1	Substantive examination	18
6.4.2	Triple identity	20
6.5	Registration and publication	21
6.6	Cancellation of seniority claims	21
7	Replacement of an EUTM Registration by an IR.....	21

1 Surrender

Article 50 EUTMR
Rule 36 EUTMIR

1.1 General principles

At any time after registration a European Union trade mark (EUTM) may be surrendered by its proprietor in respect of some or all of the goods and services. The surrender must be declared to the Office in writing. (For information on the withdrawal of European Union trade mark applications, i.e. prior to registration, please see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1.)

1.2 Legal effect

Article 50(2) EUTMR
Rule 36 EUTMIR

Surrenders only become legally effective on the date of entry in the Register of European Union trade marks (the Register). The registration procedure for the surrender may be suspended during ongoing proceedings (see paragraph 1.4.1 below).

The proprietor's rights in the registered EUTM, as well as those of its licensees and any other holders of rights in the mark, lapse with an *ex nunc* effect on the date of the registration of the surrender in the Register. Therefore, the surrender has no retroactive effect.

The surrender has procedural and substantive effects.

In procedural terms, when the surrender is entered in the Register, the European Union trade mark ceases to exist and any proceedings (with the exception of invalidity or revocation proceedings) involving the mark before the Office terminate.

The substantive effects of surrender vis-à-vis third parties comprise the EUTM proprietor renouncing any rights arising from its mark in the future.

The declarant is bound by the declaration of surrender during its registration procedure, provided that the following circumstances are present.

- a) No revocation of the declaration reaches the Office on the same day as the receipt of the declaration of surrender. That means that if a declaration of surrender and a letter revoking that declaration reach the Office on the same day (regardless of the hour and minute of their receipt), they cancel each other out. Once it becomes effective, the declaration may not be revoked.
- b) The declaration meets all the formal requirements, in particular those identified in paragraph 1.3.8 below.

1.3 Formal requirements

1.3.1 Form

Rules 79, 79a, 80 and 82 EUTMIR
Decision No°EX-11-03 of the President of the Office

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

The declaration of surrender is void where it contains conditions or time limitations. For example, it may not be made under the condition that the Office takes a particular decision or, in *inter partes* proceedings, that the other party makes a procedural declaration. For instance, during cancellation proceedings the mark may not be (partially) surrendered on the condition that the cancellation applicant withdraws its cancellation action. However, this does not exclude the possibility of an agreement between the parties, or that both parties request successive actions (for example, surrender of the trade mark and withdrawal of the cancellation action) in the same letter to the Office.

1.3.2 Language

Rule 95(b) EUTMIR
Article 119(2) EUTMR

The declaration of surrender must be filed in one of the five languages of the Office.

1.3.3 Fees

There is no fee for a declaration of surrender.

1.3.4 Necessary particulars

Rule 36(1) EUTMIR

The declaration of surrender must contain the particulars referred to in Rule 36(1) EUTMIR. These are:

- the EUTM registration number
- the EUTM proprietor's name and address or the proprietor's Office ID number together with the proprietor's name.
- where the surrender is only for some of the goods or services for which the mark is registered, either the goods and services for which the surrender is declared or an indication of the goods and services for which the mark is to remain registered or both (see paragraph 1.3.5, below).

1.3.5 Partial surrender

An EUTM may be surrendered in part, that is, for some of the goods and services for which it is registered. A partial surrender only becomes effective on the date it is entered in the Register.

For a partial surrender to be accepted, the following two conditions relating to the goods and services must be met:

- a) the new wording must not constitute an extension of the list of goods and services;
- b) the partial surrender must constitute a valid description of goods and services.

For further details on acceptable restrictions and for the practice regarding the declaration referred to in Article 28(8) EUTMR, please see the Guidelines, Part B, Examination, Section 3, Classification.

1.3.6 Signature

Except where Rule 79 EUTMIR allows otherwise, the declaration of surrender must be signed by the EUTM proprietor or its duly appointed representative (see paragraph 1.3.7 below).

1.3.7 Representation, authorisation

As far as representation of the EUTM proprietor who is declaring the surrender is concerned, the general rules apply (see the Guidelines, Part A, General Rules, Section 5, Professional Representation).

1.3.8 Requirements where a licence or other right in the European Union trade mark has been registered

Surrender cannot be registered if third parties have registered rights in the EUTM (such as licensees, pledgees, etc.) without first fulfilling certain additional requirements.

Where a licence, or another right in the EUTM, is entered in the Register, the following additional requirements apply.

- a) The EUTM proprietor must submit sufficient proof that it has informed the licensee, pledgee, etc. of its intention to surrender.
If the proprietor proves to the Office that the licensee, pledgee, etc. has given its consent to the surrender, the surrender will be registered upon receipt of that notice.

If the EUTM proprietor merely submits proof that it has informed the licensee/pledgee of its intention to surrender, the Office will inform the proprietor that the surrender will be registered three months after the date on which the Office received the evidence (Rule 36(2) EUTMIR).

The Office will consider a copy of the letter from the proprietor to the licensee/pledgee as sufficient evidence. The same applies to a written statement signed by the licensee/pledgee that it has been informed. An affidavit by the proprietor is not necessary. The term ‘prove’ in Article 50(3) EUTMR does not refer to absolute certainty but to a reasonable probability, as follows from the other language versions of the regulations (French version of Article 50(3): *justifie*, Italian *dimostre*, German *glaubhaft macht*). The documents may be in any of the 23 official languages of the European Union. However, the Office may require a translation into the language chosen for the declaration of surrender or, at the choice of the declarant, into any of the five languages of the Office.

If the proof is missing or insufficient, the Office will ask for it within a time limit of two months.

- b) Where a levy of execution is entered in the Register, the declaration of surrender must be accompanied by a declaration of consent to the surrender signed by the authority competent for the levy of execution (see the Guidelines, Part E, Register Operations, Section 3, EUTMs as Objects of Property, Chapter 4, Levy of Execution).
- c) Where insolvency or similar proceedings are entered in the Register, the declaration of surrender must be requested by the liquidator (see the Guidelines, Part E, Register Operations, Section 3, EUTMs as Objects of Property, Chapter 5, Insolvency).

1.4 Examination

1.4.1 Competence

Where surrender (or a partial surrender covering all the goods and/or services against which the application for cancellation is directed) is declared during ongoing revocation or invalidity proceedings against the validity of the EUTM that is being surrendered, the relevant department (for example, the Cancellation Division) will be informed and the Office will suspend the registration of the surrender. The Cancellation Division will invite the cancellation applicant to indicate whether it wishes to continue with the proceedings and if so, the cancellation proceedings will continue until there is a final decision on substance. After the decision on the cancellation has become final, the surrender will be registered only for the goods and/or services for which the contested EUTM has not been revoked or declared invalid, if any (judgment of 24/03/2011, C-552/09 P, ‘TiMiKinderjoghurt’, para. 39; decision of 22/10/2010, R 0463/2009-4 – ‘MAGENTA’, paras 25-27 and decision of 07/08/2013, R 2264/2012-2 – ‘SHAKEY’S’). (See the Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings, paragraph 7.3).

Where the EUTM is subject to a case pending before the Boards of Appeal (BoA), the competent chamber will decide on the surrender.

Where the EUTM is subject to a case pending before the General Court (GC) or the Court of Justice (CJEU), the surrender must be filed at the Office (not before the GC or the CJEU). The Office will then inform the GC or the CJEU whether or not it finds the surrender acceptable and valid. However, the surrender proceedings will be suspended until the GC or the CJEU has rendered a final decision on the issue (by analogy, see judgment of 16/05/2013, T-104/12, ‘VORTEX’, EU:T:2013:256).

2 Alteration of a Trade Mark

2.1 General principles

Article 48 EUTMR
Rule 25 EUTMIR

This section of the Guidelines and the provisions cited above deal solely with alterations of the EUTM that are requested by the proprietor of its own accord.

There is a difference between an amendment of an EUTM application and an alteration of a registered EUTM. The amendment of an EUTM application is governed by Article 43 EUTMR and Rules 13 and 26 EUTMIR. The alteration of a registered EUTM is governed by Article 48 EUTMR, and Rules 25 and 26 EUTMIR (for more information on amendments of an EUTM application, see the Guidelines, Part B, Examination, Section 2, Examination of Formalities).

This section does not apply to corrections of obvious errors by the Office in its publications or in the EUTM Register; such corrections are made *ex officio*, or at the proprietor's request, pursuant to Rules 14 and 27 EUTMIR (for more information, see the Guidelines, Part A, General Rules, Section 6, Revocation of Decisions and Cancellation of Entries in the Register and Correction of Errors).

The Regulations provide for the possibility of applying for an amendment of the representation of the mark (alteration of the mark) providing such alteration relates to the proprietor's name and/or address **and** does not substantially affect the identity of the trade mark as originally registered.

The Regulations do not provide for the possibility of altering other elements of the EUTM registration.

2.2 Formal requirements

2.2.1 Form and language

Article 48(2) EUTMR

The application to alter the mark, that is, the representation of the mark, must be made in writing in one of the five languages of the Office.

2.2.2 Fees

Article 48 (4) EUTMR
Annex I A(28) EUTMR

The application is subject to a fee of EUR 200; the request is deemed not to have been filed until the fee is paid (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

2.2.3 Mandatory indications

Article 48 (3) EUTMR Rule 25(1) EUTMIR

The application for alteration must contain:

- the EUTM registration number
- the EUTM proprietor's name and address in accordance with Rule 1(1)(b) EUTMIR; or the proprietor's Office ID number together with the proprietor's name
- an indication of the element in the representation of the mark to be altered and the altered version of the element
- a representation of the mark as altered that complies with the formal requirements laid down in Rule 3 EUTMIR.

2.3 Substantive conditions for alteration

Article 48(2) EUTMR allows the alteration of the representation of the mark only under extremely limited conditions, namely only when:





- the EUTM includes the EUTM proprietor's name and/or address, **and**
- these are the elements for which alteration is sought, **and**
- the alteration would not substantially affect the identity of the trade mark as originally registered.

Strict rules apply: where the proprietor's name or address is part of the distinctive elements of the mark, for example, part of a word mark, an alteration is in principle excluded since the identity of the mark would be substantially affected. An exception can only be accepted for usual abbreviations relating to the legal structure of the company. An alteration of the mark may be done if the EUTM proprietor's name or address appears on a figurative mark, for example, the label of a bottle, as a subordinate element in small letters. Such elements would normally not be taken into account in determining the scope of protection or the fulfilment of the use requirement. The rationale of Article 48 EUTMR is precisely to exclude any alteration of the registered EUTM that could affect its scope of protection or the assessment of the use requirement, so that rights of third parties cannot be affected.



No other element of the mark may be altered, even if it is only a subordinate element in small letters of a descriptive nature, such as the indication of the percentage of alcohol on a label of a bottle of wine.

Furthermore, Article 48(2) EUTMR does not allow for the alteration of the list of goods and services (see decision of 09/07/2008, R 0585/2008-2 – 'SAGA', para. 16). After registration, the only way to change the list of goods and services is through partial surrender under Article 50 EUTMR (see paragraph 1.3.5 above).

2.3.1 Examples of acceptable alterations

MARK AS REGISTERED	PROPOSED ALTERATION
<p data-bbox="416 315 600 338">EUTM 7 389 687</p> 	
<p data-bbox="416 640 600 663">EUTM 4 988 556</p> 	

2.3.2 Examples of unacceptable alterations

MARK AS REGISTERED	PROPOSED ALTERATION
<p data-bbox="408 1131 608 1153">EUTM 11 058 823</p> <p data-bbox="272 1182 743 1238">ROTAM – INNOVATION IN POST PATENT TECHNOLOGY'</p>	<p data-bbox="847 1182 1326 1238">ROTAM – INNOVATION IN POST PATENT TECHNOLOGY</p>
<p data-bbox="416 1283 600 1305">EUTM 9 755 307</p> <p data-bbox="371 1335 644 1357">MINADI MINADI Occhiali</p>	<p data-bbox="1038 1335 1129 1357">MINADI</p>
<p data-bbox="408 1411 608 1433">EUTM 10 009 595</p> <p data-bbox="296 1462 719 1485">CHATEAU DE LA TOUR SAINT-ANNE</p>	<p data-bbox="863 1462 1305 1485">CHATEAU DE LA TOUR SAINTE-ANNE</p>
<p data-bbox="416 1541 600 1563">EUTM 9 436 072</p> <p data-bbox="411 1592 604 1615">SLITONE ULTRA</p>	<p data-bbox="991 1592 1177 1615">SLITONEULTRA</p>
<p data-bbox="416 1671 600 1693">EUTM 2 701 845</p> 	

<p>EUTM 3 115 532</p> 	
<p>EUTM 7 087 943</p> 	
<p>EUTM 8 588 329</p> 	

2.4 Publication

Where the alteration of the registration is allowable, it will be registered and published in Part C.3.4 of the Bulletin; the publication will contain a representation of the EUTM as altered.

Within three months of the publication of the alteration, third parties whose rights may be affected by the alteration may challenge the registration thereof. For this procedure, the provisions on the opposition procedure apply *mutatis mutandis*.

3 Changes of Name or Address

Articles 48a and 87 EUTMR and Rule 26 EUTMIR

It is possible to change the name, address or nationality of the proprietor of a registered EUTM or its representative. The application to record the change must be made in one of the five languages of the Office. The change will be entered in the Register and published.

Pursuant to Rule 26 EUTMIR, the name, including the indication of the legal form, and address of the proprietor or representative may be amended freely, provided that:

- as regards the proprietor's name, the change is not the consequence of a transfer
- as regards the representative's name, there is no substitution of one representative by another.

Pursuant to Article 87 EUTMR, the indication of the nationality or the State of incorporation of a legal person may also be altered or added, provided that it is not the consequence of a transfer.

A change of the proprietor's name within the sense of Rule 26(1) EUTMIR is a change that does not affect the ownership, whereas a transfer is a change from one proprietor to another. For details and the applicable procedure in case of doubt as to whether the change falls under Article 17 EUTMR, see the Guidelines, Part E, Register Operations, Section 3, EUTMs as Objects of Property, Chapter 1, Transfer.

Likewise, a change of a representative's name within the sense of Rule 26(6) EUTMIR is limited to a change that does not affect the identity of the appointed representative, for example, where the name changes as a result of marriage. Rule 26(6) EUTMIR also applies where the name of an association of representatives changes. Such a change of name has to be distinguished from the substitution of one representative by another, which is subject to the rules governing appointment of representatives; for details, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

To record a change of name and address, the proprietor or its representative must submit an application to the Office. The application must contain the EUTM number as well as the name and address of the proprietor (in accordance with Rule 1(1)(b) EUTMIR) or of the representative (in accordance with Rule 1(1)(e) EUTMIR), both as recorded in the file and as amended.

Normally no proof or evidence of the change is necessary. However, in the event of doubt, the examiner may ask for proof such as a certificate from a trade register. The application to record the change of name or address is not subject to a fee.

Legal persons can only have one official address. In the event of doubt, the examiner may ask for evidence of the legal form or the address in particular. The official name and address are also used as the address for service by default. A proprietor should have only one address for service. For the sake of the principles of veracity and correctness of the Register, a change in the proprietor's official designation or official address will be registered for all EUTMs, RCDs and pending proceedings of this entity in the name of that proprietor. A change in the official designation or address cannot be recorded just for specific portfolios of rights, contrary to the address for service. These rules apply to representatives by analogy.

4 Changes in Collective Trade Mark Regulations

Article 71 EUTMR

According to Article 71 EUTMR, the proprietors of European Union collective marks must submit to the Office any amended regulations governing use.

The application to enter in the Register an amendment of the regulations governing the use of a collective trade mark must be made in writing in one of the five languages of the Office.

4.1 Registration of the amended regulations

Article 67(2), Articles 68 and 69 EUTMR, Article 71(3) and (4) and Article 87 EUTMR

The amendment will not be entered in the Register if the amended regulations do not satisfy the requirements of Article 67(2) EUTMR or involve one of the grounds for refusal referred to in Article 68 EUTMR.

Where the registration of the amendment of the regulations is accepted, it will be registered and published.

The recordal applicant will specify the part of the amended regulations to be entered in the Register, which can be:

- the applicant's name and office address
- the purpose of the association or the purpose for which the legal person governed by public law is constituted
- the bodies authorised to represent the association or the legal person
- the conditions for membership
- the persons authorised to use the mark
- where appropriate, the conditions governing use of the mark, including sanctions
- if the mark designates the geographical origin of goods or services, authorisation for any person whose goods or services originate in the geographical area concerned to become a member of the association.

Within three months of the publication of the amended regulations, third parties whose rights may be affected by the amendment may challenge the registration thereof. For this procedure, the provisions on third party observations apply *mutatis mutandis*.

5 Division

5.1 General provisions

Article 49 EUTMR
Rule 25a EUTMIR
Annex I A(25) EUTMR

A registration can be split into different parts not only as the result of a partial transfer (see the Guidelines, Part E, Register Operations, Section 3, EUTMs as Objects of Property, Chapter 1, Transfer), but also on the EUTM proprietor's own motion. A division of a trade mark is particularly useful in order to isolate a disputed trade mark for certain goods or services and maintain the registration for the remainder. For information on the division of EUTM applications, see the Guidelines, Part B, Examination, Section 1, Proceedings.

Whereas a partial transfer is free of charge but involves a change of proprietorship, the request for division of a trade mark is subject to a fee of EUR 250 and the trade mark remains in the hands of the same proprietor. If the fee is not paid, the request is deemed not to have been filed. The request must be made in one of the five languages of the Office.

Division is not available for international registrations under the Madrid Protocol designating the EU. The Register of International Registrations is kept exclusively at WIPO. The Office does not have the authority to divide an international registration.

5.2 Formal requirements

5.2.1 Form and language

The application to divide the EUTM must be made in writing in one of the five languages of the Office.

5.2.2 Fees

Annex I A(25) EUTMR

The application is subject to a fee of EUR 250; the request is deemed not to have been filed until the fee is paid (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

5.2.3 Mandatory indications

Article 48 (4) EUTMR
Rule 25a EUTMIR

The request must contain:

- the registration number of the EUTM to be divided
- the proprietor's name and address; if the proprietor has previously been allocated an ID number by the Office, it is sufficient to indicate that ID number together with the proprietor's name
- the list of goods and services for the divisional registration, or, if more than one new registration is to be created, for each divisional registration
- the list of those goods and services that will remain in the original EUTM.

The goods and services must be distributed between the original EUTM and the new EUTM so that the goods and services in the original and the new EUTM do not overlap. The two specifications taken together must not be broader than the original specification.

Therefore, the indications must be clear, precise and unequivocal. For example, when a EUTM for goods or services in several classes is involved, and the 'split' between the old and new registration concerns whole classes, it is sufficient to indicate the respective classes for the new registration or for the remaining one.

When the application for a division indicates goods and services which are explicitly mentioned in the original list of goods and services, the Office will automatically retain the goods and services which are not mentioned in the division application for the original EUTM. For example, the original list contains goods A, B, and C and the division application relates to C; the Office will keep goods A and B in the original registration and create a new registration for C.

For the assessment of whether there is limitation or a broadening of scope of the list, the rules generally applicable in such situations apply (see the Guidelines, Part B, Examination, Section 3, Classification).

In all cases it is highly recommended to file a clear and precise list of goods and services to be divided as well as a clear and precise list of goods and services to remain in the original registration. Furthermore, the original list must be clarified. For example, if the original list related to *alcoholic beverages* and the division relates to *whisky* and *gin*, the original list must be amended by restricting it to *alcoholic beverages, except whisky and gin*.

There are also certain periods during which, for procedural economy or to safeguard third party rights, a declaration of division is not admissible. These periods are prescribed by Article 49(2) EUTM and Rule 25a(3) EUTMIR and are the following.

- As long as cancellation proceedings are pending before the Office (application for revocation or declaration of invalidity), only those goods and services against which the cancellation request is not directed may be divided from the original EUTM. The Office interprets Article 49(2)(a) EUTMR as not only excluding a division where some of the contested goods are divided from the original EUTM, with the effect that the cancellation proceedings would have to be split, but also as excluding that all the contested goods are divided from the original EUTM. However, in this case, the EUTM proprietor will be given the opportunity to amend the declaration of division by dividing the other goods and services from the original EUTM, that is, those which are not contested in the cancellation proceedings.

- As long as proceedings are pending before the Boards of Appeal, the General Court or the European Court of Justice only those goods and services not affected by the proceedings may be divided from the original EUTM due to the suspensive effect of the proceedings.
- Likewise, as long as a counterclaim for revocation or declaration of invalidity is pending before a EUTM court, the same conditions apply. This covers the period starting on the day the counterclaim was lodged before the EUTM court and ending on the date on which the Office mentions the EUTM court's judgment in the EUTM Register pursuant to Article 100(6) EUTMR.

5.3 Registration

If the Office accepts the declaration of division, a new registration is created as of that date and not retroactively as from the date of the declaration.

The new registration keeps the filing date as well as any priority or seniority dates, depending on the goods and services; the seniority effect may become partial.

All requests and applications submitted and all fees paid prior to the date on which the Office receives the declaration of division are also deemed to have been made or paid for the resulting divisional registration. However, fees duly paid for the original registration will not be refunded (Article 49(6) EUTMR). The practical effects of this provision can be exemplified as follows.

- Where an application for the registration of a licence was submitted and the payment of the fee for its registration was received by the Office prior to the declaration of division, the licence will be recorded in the Register of both the original and the divisional EUTM if the licence covers goods and/or services in the original and divisional EUTM. No further fees need to be paid.
- Where an EUTM registration containing two classes is to be divided into two registrations, no additional class fees for the renewal are payable as from the date on which the division is entered in the Register, but instead two basic renewal fees will be payable, one for each registration.

5.4 New file, publication

Article 87 (3) EUTMR

A new file has to be created for the divisional registration. It must contain all the documents which were on file for the original registration, plus all the correspondence related to the declaration of division, as well as all future correspondence for the new registration. The division will be published in the EUTM Bulletin. In the case of EUTM applications the entry will not be published.

6 Post-Registration Seniority Claims

Article 35 EUTMR
Rule 28 EUTMIR
Communication No 2/00 of 25/02/2000
Decision No EX-03-5 of 20/01/2003
Decision No EX-05-5 of 01/06/2005

6.1 General principles

The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered under international arrangements having effect in a Member State, who holds an identical EUTM for goods or services which are identical with or contained within those for which the earlier trade mark has been registered, may claim for the EUTM the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

Seniority may be claimed at any time after the registration of the EUTM.

6.2 Legal effect

Seniority has the sole effect that where the holder of an EUTM surrenders their earlier national trade mark registration or allows it to lapse, they will be deemed to continue to have the same rights as they would have had if the earlier trade mark had continued to be registered.

This means that the EUTM represents a prolongation of earlier national registrations. If a proprietor claims seniority from one or more earlier registered national marks, the owner may decide not to renew the earlier national registrations but still be in the same position as if the earlier trade mark had continued to be registered in those Member States where the earlier marks were registered. The Office recommends the proprietor to wait until it receives confirmation of the acceptance of the seniority claim before allowing the national mark to lapse (see also paragraph 6.4.2, below).

Seniority may be claimed not only for earlier national registrations, but also for an international registration designating an EU country. However, no seniority claim is possible for an earlier EUTM registration or local registrations, even if the territory is part of the European Union (e.g. Gibraltar).

6.3 Formal requirements

6.3.1 Form

Rules 79, 79a, 80 and 82 EUTMIR
Decision No°EX-11-03 of the President of the Office

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

6.3.2 Language

Rule 95(b) EUTMIR

The seniority claim must be filed in one of the five languages of the Office.

6.3.3 Fees

There is no fee for an application for a seniority claim.

6.3.4 Mandatory indications

Rule 28 EUTMIR Decision No EX-05-5 of 01/06/2005

The application must indicate:

- the EUTM registration number
- the EUTM proprietor's name and address in accordance with Rule 1(1)(b) EUTMIR; if the proprietor has previously been allocated an ID number by the Office, it is sufficient to indicate that ID number and the proprietor's name
- the Member State or Member States of the European Union in or for which the earlier mark, for which seniority is claimed, is registered
- the registration number and filing date of the relevant earlier registration(s).

Pursuant to Decision No EX-05-5 of 01/06/2005, the proprietor is not required to file a copy of the registration if the required information is available to the Office on the website of the respective national office. If the copy of the registration is not submitted, the Office will first search for the necessary information on the respective website and only if the information is not available there will it ask the proprietor for a copy. Pursuant to Article 3 of Decision No EX-03-5, the copy of the relevant registration must consist of a copy (simple photocopies suffice) of the registration and/or renewal certificate or extract from the Register, or an extract from the relevant national Gazette, or an extract or printout from a database. Examples of extracts that are not accepted are DEMAS, MARQUESA, COMPUSERVE, THOMSON, OLIVIA, PATLINK or COMPUMARK, SAEGIS.

6.4 Examination

6.4.1 Substantive examination

Seniority may only be claimed from an earlier **registration**, not an earlier application. The date of the earlier trade mark must be before the respective dates of the EUTM (filing date or, if available, the priority date).

The examiner must check both that the earlier mark was registered and that it had not lapsed at the moment the claim was made (on the duration of protection of national marks see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.2.3.4).

If the earlier registration had lapsed at the moment the claim was made, seniority cannot be claimed, even if the relevant national trade mark law provides for a six-month grace period for renewal. While some national legislations allow for a 'grace' period, if the renewal is not paid the mark is considered to have lapsed from the day it was due for renewal. Therefore, the seniority claim is acceptable only if the applicant shows that it has renewed the earlier registration(s).

In the context of an **enlargement** of the EU, the following details have to be borne in mind. Where a national trade mark of, or an international registration with effect in, a new Member State was registered before the seniority claim is made, **seniority may be claimed even though the priority, filing or registration date of the EUTM to which the seniority claim relates predates the priority, filing or registration date of the national mark/IR with effect in the new Member State**. This is because the EUTM at issue only has effect in the new Member State from the date of accession. The national trade mark/IR with effect in the new Member State for which seniority is claimed is therefore 'earlier' than the EUTM within the sense of Article 35 EUTMR, **provided** the national trade mark/IR with effect in the new Member State enjoys a priority, filing or registration date **prior to the accession date** (see the Guidelines, Part A, General Rules, Section 9, Enlargement, Annex 1).

Examples of acceptable seniority claims for new Member States				
EUTM	Filing date	Seniority claim country	Accession date	Filing date of earlier right
2 094 860 TESTOCAPS	20/02/2001	Cyprus	01/05/2004	28/02/2001
2 417 723 PEGINTRON	19/10/2001	Hungary	01/05/2004	08/11/2001
352 039 REDIPEN	02/04/1996	Bulgaria	01/01/2007	30/04/1996
7 073 307 HydroTac	17/07/2008	Croatia	01/07/2013	13/10/2009

Explanation: In all cases, although the filing date of the EUTM application is earlier than the filing date of the mark for which seniority is claimed, all the countries concerned acceded to the European Union after the filing date of the EUTM application. It is from the accession date that the EUTM application has protection in those Member States. Therefore, seniority can be claimed for any national marks filed prior to the date of accession.

If the claim to seniority is in order, the Office will accept it and - once the EUTM application has been registered - inform the relevant central industrial property office(s) of the Member State(s) concerned (Rule 8(3) EUTMIR).

6.4.2 Triple identity

A valid seniority claim requires triple identity:

- the registered mark must be identical to the European Union trade mark
- the goods and services of the EUTM must be identical or contained within those for which the mark is registered
- the proprietor must be the same.

(See judgment of 19/01/2012, T-103/11, 'Justing', EU:T:2012:19.)

Examination of seniority claims is limited to the formal requirements and to the identity of the marks (see Communication of the President No 2/00 of 25/02/2000).

It is up to the owner to make certain that the triple identity requirements are met. The Office will normally only examine whether the marks are identical. The identity of owner, goods and services will not be examined.

As regards the identity of the marks, word marks will generally be considered without reference to the typeface in which they are registered. In considering whether word marks are identical the Office will not object if, for example, one mark is in uppercase and the other in lowercase. The addition or subtraction of a single letter in a word mark is sufficient for marks not to be considered identical. As far as figurative marks are concerned, the General Court has held that

Even although the objectives of Article 8(1)(a) and of Article 34 of that regulation [EUTMR] are not the same, it is a condition for the application of both of them that the marks at issue must be identical ...

It must be stated at the outset that the fact that a mark is registered in colour or, on the contrary, does not designate any specific colour cannot be regarded as a negligible element in the eyes of a consumer. The impression left by a mark is different according to whether that mark is in colour or does not designate any specific colour.

(See judgment of 20/02/2013, T-378/11 'Medinet', EU:T:2013:83, paras 40 and 52).

For full details of Office practice in relation to identity between trade marks filed in black and white and/or greyscale as compared to those filed in colour for the purposes of seniority claims, please see the Guidelines, Part B, Examination, Section 2 Formalities, paragraph 14.2.1, in relation to priority claims, which applies by analogy.

If the claim to seniority does not satisfy the formal requirements or if the marks are not identical, the Office will notify the proprietor and give it two months to remedy the deficiency or submit observations.

If the deficiency is not remedied, the Office will inform the proprietor that the right to claim seniority has been rejected.

For examples of acceptable and unacceptable seniority claims see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 16.6.

6.5 Registration and publication

Article 87(3)(f) EUTMR

If the claim to seniority is acceptable, the Office will register it and inform the relevant central industrial property office(s) of the Member State(s) concerned (Rule 8(3) EUTMR).

The seniority claim will be published in the EUTM Bulletin.

The publication will contain the following data:

- the EUTM registration number
- the seniority claim details: country, registration number, registration date, filing date, date of priority
- the date and number of the entry of the seniority claim
- the date the entry is published in the EUTM Bulletin.

6.6 Cancellation of seniority claims

The EUTM proprietor may at any time request the cancellation of the seniority claim from the Register of its own motion.

Seniority claims may also be cancelled by a decision of a national court (see Article 14 Directive 2008/95/EC).

The cancellation of the seniority claim will be published in the EUTM Bulletin. Article 87(3)(f) EUTMR provides that the cancellation of seniority will be registered.

7 Replacement of an EUTM Registration by an IR

Article 157 EUTMR
Article 87(3)(t) EUTMR
Article 4 bis MP
Rule 21 Common Regulations under the Madrid Agreement and Protocol (CR)

In accordance with Article 4 *bis* of the Madrid Agreement and the Protocol, the holder of an international registration designating the European Union (IR) may request the Office to take note in its Register that an EUTM registration is replaced by a corresponding IR. The holder's rights in the EU will be deemed to start from the date of the earlier EUTM registration. Therefore, the Office will enter in the Register that an EUTM has been replaced by a designation of the EU through an IR and that entry will be published in the EUTM Bulletin.

For more information on replacement, see the Guidelines, Part M, International Marks.