

***GUIDELINES FOR EXAMINATION***

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

***PART A***

***GENERAL RULES***

***SECTION 1***

***MEANS OF COMMUNICATION, TIME LIMITS***

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## 1 Introduction

This part of the Guidelines includes those provisions that are common to all proceedings before the Office in trade mark and design matters, except appeals.

In the interests of efficiency and in order to prevent parties encountering different practices, the Office applies procedural rules consistently.

Proceedings before the Office can be classified into two broad types: *ex parte* proceedings, which involve only one party, or *inter partes* proceedings, in which two or more parties are in conflict.

The first category comprises, in particular, applications for registration or renewal of a European Union trade mark (EUTM) or a registered Community design (RCD), transfer-related entries in the Register, licences, levy of execution or bankruptcy, insolvency proceedings, priority/seniority claims and conversion proceedings.

The second category includes opposition and cancellation proceedings (revocation or declaration of invalidity of a registered EUTM or an RCD).

## 2 Procedures for Filing and for Communication with the Office

Article 30 EUTMR Articles 63 and 65 EUTMDR Article 35 CDR Articles 65 and 68 CDIR
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Communications addressed to the Office can be submitted by electronic means, post or courier in proceedings relating to EU trade marks and in addition by fax and personal delivery in proceedings relating to Community designs. Notifications issued by the Office can be made by electronic means (including fax), post, courier services or public notification.

An application for an EUTM must be filed directly with the Office.

An application for an RCD may be filed directly with the Office, through a central industrial property office of a Member State or the Benelux Office for Intellectual Property.

E-filing is a recommended means of filing, to the extent that the system gives guidance to the applicant, thus reducing the number of potential deficiencies and speeding up the examination procedure. EUTMs filed through the Office's e-filing system are subject to a reduced fee. The Office also offers the possibility of an accelerated procedure known as Fast Track (for more details, please check the Office's website).

In the event of opting for filing by other means, the Office makes various forms available to the public, in all the official languages of the EU. With one exception, their use is not mandatory but strongly recommended. The exception is when filing an international application or subsequent designation under the Madrid Protocol, for which either the World Intellectual Property Organization's (WIPO) MM 2 or MM 4 form, or the Office's EM 2 or EM 4 form must be used.

Filing RCD applications by fax is not recommended, because the quality of the representation of the design may deteriorate during transmission or on receipt by the Office, and processing such applications may be delayed by up to one month. For further information on filing RCD applications by fax see the Guidelines for Examination of Applications for Registered Community Designs.

### 3 Notification and Communication of Documents

The EUTMDR and the CDIR distinguish between documents originating from the parties and addressed to the Office and notifications issued by the Office.

A document's date of notification or communication is the date on which that document, is **received or is deemed to be received** by the addressee (including the Office) (judgment of 30/01/2014, C-324/13 P, Patrizia Rocha, EU:C:2014:60, § 43). Exactly when receipt is deemed to have taken place will depend on the method of notification or communication.

Any notification addressed to the representative will have the same effect as if it had been addressed to the person represented (Article 60(3) EUTMDR and Article 53 CDIR). Any communication addressed to the Office by a representative will be considered to have originated from the person he/she represents (Article 66 EUTMDR and Article 63 CDIR).

If a professional representative has been duly appointed, the Office will send all notifications solely to the representative (judgments of 12/07/2012, T-279/09, 100% Capri, EU:T:2012:367; 25/04/2012, T-326/11, BrainLAB, EU:T:2012:202). 'Duly appointed' means that the representative is entitled to act as such and has been properly appointed, and that no general obstacle exists to preclude representation by that person, such as illicit representation of both parties in *inter partes* proceedings. Filing an authorisation is not required in order to receive Office notifications.

For further details see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

### 3.1 Communications to the Office in writing or by other means

Article 98(3) EUTMR  
Articles 63 and 64 EUTMDR  
Articles 65 to 67 CDIR  
Decision No EX-17-4 of the Executive Director of the Office concerning communication by electronic means and Conditions of Use of the User Area  
Decision No EX-17-6 of the Executive Director of the Office concerning technical specifications for annexes submitted on data carriers

#### 3.1.1 By electronic means

The accepted means of electronic communication with the Office in procedures relating to EUTMs are:

- (a) the User Area, which is a secure electronic communications platform maintained by the Office that enables users to submit applications and other documents, receive notifications and documents sent by the Office, reply to such notifications and perform other actions,
- (b) fax.

However, fax is not an accepted means of communication for filing applications for the registration of an EU trade mark<sup>1</sup>. Nevertheless, exceptionally, where a technical malfunction prevents the applicant from filing through the User Area, an EUTM application submitted by fax will be deemed to have been received by the Office provided that the applicant resubmits, within three working days of the original fax submission, the application for registration of an EUTM with the same content through the User Area together with a fax receipt clearly identifying the original fax submission. Failure to comply with these conditions will result in the original fax submission being deemed as not having been received.

In procedures relating to Community designs, the only accepted means of electronic communication with the Office is the User Area.

The time of receipt of applications, communications or documents submitted by electronic means is the local time in Alicante (Spain) when the receipt was validated.

Where a communication submitted by electronic means, including fax, is incomplete or illegible, or the Office has reasonable doubts as to the accuracy of the transmission, in accordance with Article 63(3) EUTMDR and Articles 67(3) and 66(2) CDIR, it will advise the sender and invite it to retransmit the communication or to submit a signed original of the document in question to the Office by post or any other available means within a specified deadline. If the retransmission is complete, the date of receipt will be considered to be the date of the first transmission, except for the purposes of establishing a filing date for an application. Otherwise, the Office will not take the transmission into account or will consider only the received and/or legible parts (decision of 04/07/2012, R 2305/2010-4, Houbigant / PARFUMS HOUBIGANT PARIS et al.).

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<sup>1</sup> Applicable as of 01/01/2018.

For further information on the filing date, see the Guidelines, Part B, Examination, Section 2, Formalities and the Guidelines for Examination of Applications for Registered Community Designs.

### 3.1.2 By post or courier service

Documents sent by post or courier service should be sent to the Office's official address.

Documents sent by post or courier service must bear an original signature. If a document sent to the Office is not signed, the Office will invite the party concerned to do so within a specific deadline. If the document is not signed within that time, the application or request will be declared inadmissible, or the document will not be taken into account, as the case may be.

The date of receipt is the date on which the Office receives the communication irrespective of when it was placed in the mail or postal system. The time of receipt is the local time in Alicante (Spain).

For further information on copies of the documents submitted in *inter partes* proceedings, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.2, Substantiation; and the Guidelines for Examination of Design Invalidity Applications, paragraph 4.1, Exchange of communications.

### 3.1.3 Annexes to communications

In EUTM proceedings, any documents or other items of evidence submitted by the party must be contained in an annex to the submission, be numbered, be accompanied by an index with a short description of each item of evidence together with the number of pages, if applicable, and the page number where it is mentioned in the submission.

During the proceedings stage (i) when the evidence is not structured in numbered annexes; (ii) no index is sent (this meaning, when the required content of the index is not identifiable in any form); or (iii) when, on its own motion or after it being questioned by the other party, the Office finds it justified, in particular when it considers that the failure to comply with the relevant requirements significantly impairs the Office's or the other party's ability to review and assess the documents or items of evidence submitted and to understand the relevance of the same, a deficiency will be raised. A deficiency will not be raised if the content of the annexes is included in the text of the observations.

Annexes to communications may be submitted on data carriers.

In *inter partes* proceedings, unless submitted by electronic means, any supporting documents, including any annexes or other evidence must be submitted in duplicate, with one copy to be sent to the other party. Exceptions to this rule are all paper documents (such as loose sheets of evidence) up to and including size A3. However, any other item of evidence (larger than A3 or not on paper, e.g. CDs, DVDs, USB sticks, product samples) that has been submitted to the Office by post or courier must come with a second copy. If no second copy is provided, in proceedings relating to EUTMs, these documents or items of evidence will not be taken into account, whereas

in *inter partes* proceedings relating to Community designs, the Invalidation Division may invite the party to file a second set within a specified deadline.

### 3.1.4 Signature

Article 63(1) EUTMDR Article 65(1) CDIR
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Applications and other communications to the Office must be signed by the sender.

If the application or other communication is filed by electronic means, the indication of the name of the sender is deemed to be equivalent to a signature. In proceedings related to EU trade marks this also covers fax communications being electronic means of communication (see above in paragraph 3.1.1). In proceedings related to Community designs, as fax is a *sui generis* means of communication (see above in paragraph 3.1.1), the indication of the name of the sender is not sufficient but the fax communication must also be signed.

If an application or other communication is not signed, the Office will invite the party concerned to correct the deficiency. If it is not remedied within the set time limit, the application will be rejected or the communication not taken into account.

For joint requests submitted in one single submission by electronic means in *inter partes* proceedings, the indication of the name of the sender is deemed to be equivalent to its signature, however the signature of the other party must be presented in order for the request to be acceptable.

## 3.2 Notification by the Office

Article 94(2) and Article 98 EUTMR Articles 56 to 62 EUTMDR Article 41(1) and Articles 47 to 53 CDIR Decision No EX-05-6 of the Executive Director of the Office concerning public notification Decision No EX-17-4 of the Executive Director of the Office concerning communication by electronic means
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Written communications from the Office to the party or parties to proceedings will be 'notified'. A document is considered to be **notified** when it has been received or is deemed to have been received by the addressee, irrespective of whether the addressee has been advised of this. Consequently, the date of notification of a document is the date on which that document is **made accessible to or has reached the addressee**, and not the date on which it was sent or the date on which the person to whom it was addressed actually learned of the notification. However, exactly when receipt is deemed to take place will depend on the method of notification.

The Office can choose freely the most appropriate means of notification, apart from public notification, although some means of notification require the party's prior consent.

In practice, the Office will always opt to notify by electronic means, if the party has previously accepted this means of communication, whenever feasible.

If the proper notification procedure has been followed, the document is deemed to have been notified, unless the recipient can prove that it either did not receive the document at all, or received it late. If this is proved, the Office will re-notify the document(s). Conversely, where the proper notification procedure was not followed, the document will still be considered notified if the Office can prove that the document actually reached the recipient (judgment of 13/01/2011, T-28/09, Pine Tree, EU:T:2011:7, § 32).

Any communication or notification from the Office will indicate the department or division of the Office and the name(s) of the official(s) responsible. These documents have to be signed by the official(s) or, if not, bear the Office's printed or stamped seal.

### 3.2.1 Notification by electronic means

#### 3.2.1.1 Notification via the User Area

The User Area offers the option to receive all communications from the Office electronically. If the user selects this option, the Office will send all notifications through the User Area, unless this is impossible for technical reasons.

The document is deemed to have been notified on the fifth calendar day following the day on which the document is placed in the user's inbox irrespective of whether the recipient actually opened and read it.

#### 3.2.1.2 Notification by fax

Where the party has not previously signed up for communication via the User Area, the Office may use notification by fax if the party has indicated a fax number, the exception being notifications that include colour elements.

Notification by fax will be deemed to have taken place on the date on which the recipient's fax receives it. The Office keeps fax logs so that it can prove the transmission time and content. In the absence of any evidence to the contrary or information that casts doubt on the correct transmission of the notification, the date of receipt of a fax may be established by the Office transmission report (judgment of 13/01/2011, T-28/09, Pine Tree, EU:T:2011:7, § 32).

### 3.2.2 Notification by post or courier

The procedure for notification by post or courier will depend on the nature of the document notified.

Decisions subject to a deadline for appeal, summonses and other documents as determined by the Executive Director of the Office will be notified by courier service or registered post, in both cases with advice of delivery.

All other notifications can be sent either by courier service or registered, whether or not with advice of delivery, or by ordinary post, except where the recipient's address is not



in the EEA or the addressee has not appointed a professional representative, the Office will send the document by ordinary post.

Notification will be deemed to have taken place 10 days after the document was posted. The recipient can only rebut this presumption by proving that it did not receive the document or that it received it later. Indications giving rise to reasonable doubt about correct receipt are considered to be sufficient proof (judgment of 25/10/2012, T-191/11, Miura, EU:T:2012:577, § 34). In the event of a dispute, the Office must establish that the notification reached its destination or establish the date on which it was delivered to the addressee.

Notification by registered letter will be deemed to have been effected even if the addressee refuses to accept the letter.

### 3.2.3 Public notification by public notice

Public notification will be used for all notifications where the addressee's address is unknown or where a notification by post has been returned to the Office after at least one failed attempt.

This relates primarily to post returned to the Office by the Post Office marked 'not known at this address' and post that has not been claimed by the addressee.

Public notifications will be published on the Office's website. The document will be deemed to have been notified one month after the day on which it was posted on the internet.

## 4 Time Limits Specified by the Office

Article 101 EUTMR Articles 67 to 69 EUTMDR Articles 56 to 58 CDIR
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Time limits before the Office can be divided into two categories:

- those laid down by the EUTMR, EUTMDR, EUTMIR, CDR or CDIR, which are therefore mandatory;
- those specified by the Office, which are therefore not mandatory and can be extended under certain circumstances.

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. They are a matter of public policy and rigorous compliance with them is necessary to ensure clarity and legal certainty.

The regulations foresee three measures that mitigate the rigorous application of the principle of strict observance of time limits (deadlines), depending on whether they are still running or have expired.

If the time limit is still running, the party may *request an extension* of the time limit pursuant to Article 68 EUTMDR and Article 57(1) CDIR.

In RCD proceedings, if the time limit has expired, the party that has missed it can request *restitutio in integrum* (pursuant to Article 67 CDR), which requires meeting formal and substantive requirements (such as showing all due care).

In EUTM proceedings, if the time limit has expired, the party that has missed it has two possible courses of action: it can either seek *continuation of proceedings* (pursuant to Article 105 EUTMR), which only requires meeting certain formal requirements, or it can request *restitutio in integrum* (pursuant to Article 104 EUTMR), which requires meeting formal and substantive requirements (such as showing all due care).

Additional information is provided under paragraphs 4.4 and 4.5 below.

#### **4.1 Length of the time limits specified by the Office**

Regarding EUTM proceedings, with the exception of the time limits expressly specified in the EUTMR, EUTMDR, or EUTMIR, the time limits specified by the Office may not be less than one month or longer than six months.

Regarding RCD proceedings, with the exception of the time limits expressly specified in the CDR or CDIR, the time limits specified by the Office, when the party concerned has its domicile or its principal place of business or an establishment within the EU may not be less than one month or longer than six months. When the party concerned does not have its domicile or principal place of business or an establishment within the EU, the time limits may not be less than two months or longer than six months.

The general practice is to grant two months.

For further information, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

#### **4.2 Expiry of time limits**

Where the Office sets a time limit in a notification, the ‘relevant event’ is the date on which the document is notified or deemed notified, depending on the rules governing the means of notification.

Where a time limit is expressed in months, it will expire in the relevant subsequent month on the same day as the day on which the ‘relevant event’ occurred.

For example, if the Office sets a two-month time limit in a communication that is notified by fax on 28 June, the time limit will expire on 28 August. It is immaterial whether the ‘relevant event’ occurred on a working day, a holiday or a Sunday; that is relevant only for the expiry of the time limit.

Where the relevant subsequent month has no day with the same number or where the day on which the event occurred was the last day of the month, the time limit in question will expire on the last day of that month. A two-month time limit specified in a notification on 31 July will therefore expire on 30 September. Similarly, a two-month time limit set in a notification on 30 June will expire on 31 August.

The same applies to time limits expressed in weeks or years.

Any time limit will be deemed to expire at midnight on the final day (local time in Alicante (Spain)).

A time limit that expires on a day on which the Office is not open for receipt of documents or on which ordinary post is not delivered in the locality in which the Office is located (Saturdays, Sundays and public holidays) will be extended to the first working day thereafter. For this purpose, the Executive Director of the Office determines the days on which the Office is closed before the start of each calendar year. The extension is automatic but it applies only at the end of the time limit (decision of 12/05/2011, R 924/2010-1, whisper power (fig.) / WHISPER).

In the event of a general interruption to the postal service in Spain or to the Office's connection to authorised electronic means of communication, any time limit that expires during that period will be extended to the first working day after the period of interruption. These periods will be determined by the Executive Director of the Office; the extension will apply to all parties to the proceedings.

In the event of an exceptional occurrence (strike, natural disaster, etc.) causing a disruption to the running of the Office or a serious impediment to its communication with the outside world, time limits may be extended for a period determined by the Executive Director of the Office.

### 4.3 Extension of time limits

In **ex parte proceedings** before the Office, if a request is made for an extension before the time limit expires, then a further period should be allowed, depending on the circumstances of the case, but not exceeding six months.

For the rules applicable to the extension of time limits in **inter partes proceedings** (i.e. where there are two or more parties involved, such as in opposition, invalidity and/or revocation proceedings), see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, and the Guidelines for Examination of Design Invalidity Applications.

As a general rule the first request for an extension that is received in time will be considered appropriate and will be granted for a period of two months (or less if requested). However, any subsequent request for an extension of the same time limit will be refused unless the party requesting it can explain and justify the 'exceptional circumstances' that (a) prevented it from carrying out the required action during the previous two periods (i.e. the original time limit plus the first extension) and (b) still prevent the requester from carrying it out, so that more time is needed.

Examples of justifications that can be accepted:

- 'Evidence is being gathered from distribution channels/all our licensees/our suppliers in several Member States. So far, we have gathered documents from some of them but, due to the commercial structure of the company (as shown in the document enclosed), we have only recently been able to contact the rest.'
- 'In order to show that the mark has acquired distinctiveness through use we started carrying out market research at the beginning of the period (on date X). However, the fieldwork has only recently been concluded (as shown in the

enclosed documents); consequently, we need a second extension in order to finish the analysis and prepare our submissions to the Office.'

- 'Death' is also considered an 'exceptional circumstance'. The same applies to serious illness, provided that no reasonable substitution was available.
- Finally, 'exceptional circumstances' also include 'force majeure' situations. 'Force majeure' is defined as a natural and unavoidable catastrophe that interrupts the expected course of events. It includes natural disasters, wars and terrorism, and unavoidable events that are beyond the party's control.

Where a request is filed for an extension to an extendable time limit before this time limit expires and is not accepted, the party concerned will be granted at least one day to meet the deadline, even if the request for an extension arrives on the last day of the time limit.

#### **4.4 Continuation of proceedings**

Article 105 EUTMR
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Continuation of proceedings is not available in RCD proceedings.

The expressions 'further processing' and 'continuation of proceedings' have the same meaning.

Article 105 EUTMR provides for the continuation of proceedings where time limits have been missed but excludes various time limits laid down in certain articles of the EUTMR.

The excluded time limits are the following:

- those laid down in Article 104 EUTMR, avoiding double relief for the same time limits;
- those referred to in Article 139 EUTMR, that is to say, the three-month period within which conversion must be requested and the conversion fee paid;
- the opposition period and the time limit for paying the opposition fee laid down in Article 46 EUTMR;

None of the other time limits during the opposition procedure are referred to in Article 105 EUTMR and, therefore, they are not excluded from further processing. Consequently, the Office will grant further processing for:

- the time limit under Article 146(7) EUTMR to translate the notice of opposition;
- the time limit under Article 5(5) EUTMDR to remedy deficiencies that affect the admissibility of the opposition;
- the time limits for the opponent to substantiate its opposition under Article 7 EUTMDR;

- the time limit laid down in Article 8(2) EUTMDR for the applicant to reply;
  - the time limit under Article 8(4) EUTMDR for the opponent to reply;
  - the time limits for any further exchange of arguments, if allowed by the Office (decision of 07/12/2011, R 2463/2010-1, Pierre Robert / Pierre Robert (fig.);
  - the time limit under Article 10(1) EUTMDR for the applicant to request that the opponent prove use of its earlier mark;
  - the time limit under Article 10(2) EUTMDR for the opponent to submit proof of use of its earlier mark;
  - the time limit under Article 10(6) EUTMDR to translate proof of use.
- those laid down in Article 32, Articles 34(1), 38(1), 41(2) and 53(3), Article 68 and Article 72(5) EUTMR, and the time limits laid down by the EUTMIR for claiming, after the application has been filed, seniority within the meaning of Article 39 EUTMR.

Article 105 EUTMR does not exclude any of the time limits that apply in proceedings for revocation or declaration of invalidity.

The party seeking continuation of proceedings must make the request, for which a fee is charged as established in Annex I of the EUTMR, within two months of the expiry of the original time limit and complete the omitted act by the time the request for continuation is received. A request for an extension of time does not constitute the completion of the 'omitted act'.

There can be no extension or continuation of the two-month deadline. There is no substantive requirement to be fulfilled such as when requesting *restitutio in integrum*.

If the Office accepts the request for continuation of proceedings, the consequences of having failed to observe the time limit will be deemed not to have occurred. If a decision has been taken between the expiry of that time limit and the request for the continuation of proceedings, the department competent to decide on the omitted act will review the decision and, where completion of the omitted act itself is sufficient, take a different decision. If, following the review, the Office concludes that the original decision does not need to be altered, it will confirm that decision in writing.

#### **4.5 *Restitutio in integrum***

A party to proceedings before the Office may be reinstated in its rights (*restitutio in integrum*) if, in spite of all due care required by the circumstances having been taken, it was unable to meet a time limit vis-à-vis the Office, provided that the failure to meet the time limit had the direct consequence, by virtue of the provisions of the Regulations, of causing the loss of any right or means of redress.

For further information see the Guidelines, Part A, General Rules, Section 8, *Restitutio in Integrum*.