

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

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

PART D

CANCELLATION

SECTION 1

PROCEEDINGS

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1 Introduction — General Outline of Cancellation Proceedings

Proceedings in the Office concerning the revocation or invalidity of a registered European Union trade mark (EUTM) are grouped under the general heading of ‘cancellation proceedings’ and are managed in the first instance by the Cancellation Division. The basic rules regarding these proceedings are mainly contained in Articles 58 to 60 and Articles 62 and 64 EUTMR, and in Articles 12 to 20 EUTMDR.

Cancellation proceedings are initiated with the submission of an application for revocation or for a declaration of invalidity (the ‘application for cancellation’) against a registered EUTM. An application for cancellation against an EUTM application that has not yet been registered or a trade mark that is no longer registered is not admissible.

Once the application for cancellation is received, the Office checks that the corresponding cancellation fee has been paid. If the fee has not been paid, the application is deemed not to have been filed. Next, the Office carries out a preliminary assessment of the admissibility requirements, which includes, in particular, those stated under Article 12 EUTMDR. The Office also notifies the EUTM proprietor of the application.

In general, two kinds of admissibility deficiencies can be distinguished:

1. Absolute deficiencies, that is, deficiencies that cannot be remedied after the filing of the application. These deficiencies will automatically lead to the application being considered inadmissible.
2. Relative deficiencies, that is, deficiencies that can be remedied after the filing of the application. The Office invites the cancellation applicant to remedy the deficiency in a non-extendable time limit of two months, failing which the application will be rejected as inadmissible.

Once the application is deemed filed, the Office will make an entry in the Register of the pending cancellation proceedings for the contested EUTM (Article 111(3)(n) EUTMR). This is to inform third parties about them. In parallel, the adversarial part of the proceedings is opened and the parties are invited to submit observations (and, if applicable, proof of use).

There are usually two rounds of observations, after which the adversarial part is closed and the file is ready for a decision. Once the decision becomes final (i.e. if no appeal has been filed within the prescribed time limit, or when the appeal proceedings are closed), the Office will make the corresponding entry in the Register, in accordance with Article 64(6) EUTMR.

In many respects, cancellation proceedings follow the same or analogous procedural rules as those established for opposition proceedings (e.g. friendly settlement, withdrawals of the application for cancellation, correction of mistakes and revocation, time limits, multiple cancellations, change of parties, *restitutio*). For all these matters, see the relevant sections of the Guidelines and in particular Part C, Opposition, Section 1, Procedural Matters. This section of the Guidelines will therefore only focus on those aspects of the cancellation proceedings that are different from opposition proceedings.

2 Applications for Cancellation

2.1 Persons entitled to file an application for cancellation

Articles 46(1) and 63(1) EUTMR

Cancellation proceedings can never be initiated *ex officio* by the Office but only upon receipt of an application from a third party.

Applications for revocation or for invalidity based on absolute grounds (Articles 58 and 59 EUTMR) may be filed by:

1. any natural or legal person, or
2. any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers or services, traders or consumers, which under the terms of the law governing it has the capacity in its own name to sue and be sued.

As regards applications for revocation or for invalidity based on absolute grounds, the applicant does not need to demonstrate an interest in bringing proceedings (judgment of 08/07/2008, T-160/07, Color Edition, EU:T:2008:261, § 22-26, confirmed by judgment of 25/02/2010, C-408/08 P, Color Edition, EU:C:2010:92, § 37-40). This is because, while relative grounds for invalidity protect the interests of proprietors of certain earlier rights, the absolute grounds for invalidity and for revocation aim to protect the general interest (including, in the case of revocations based on lack of use, the general interest in revoking the registration of trade marks that do not satisfy the use requirement) (judgment of 30/05/2013, T-396/11, Ultrafilter International, EU:T:2013:284, § 17-18).

In contrast, applications for invalidity based on relative grounds (Article 60 EUTMR) may only be filed by the persons mentioned in Article 46(1) EUTMR (in the case of applications based on Article 60(1) EUTMR) or by those entitled under Union legislation or under the law of the Member State concerned to exercise the rights in question (in the case of applications based on Article 60(2) EUTMR).

Applications for revocation or invalidity based on Articles 81, 82, 91 or 92 EUTMR (in particular specific revocation and absolute grounds for collective marks and certification marks) follow the same rules, regarding entitlement, as applications for revocation or for invalidity based on absolute grounds (Article 74(3) EUTMR).

2.2 Written applications

Article 63(2) EUTMR

An application for cancellation has to be filed in writing. It is not obligatory to use the forms provided by the Office, as long as all the admissibility requirements are met. However, the use of the official forms is highly recommended. Applications for cancellation may be submitted electronically.

2.3 Payment

Article 63(2) and Article 180(3) EUTMR Articles 15(1) and 18(2) EUTMDR

For general rules on payments, see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

An application for cancellation is not deemed to have been filed until the fee has been paid. For this reason, before examining the admissibility of the application, the Office will first check that the fee has been received.

Where the Office finds that the fee has not been paid, it will invite the applicant to pay it within a given time limit. If the required fee is not paid within the time limit, the Office will inform the applicant that the application for cancellation is deemed not to have been filed. If the fee is paid, but after the specified time limit, it will be refunded to the applicant.

In cases where the fee is received after the expiry of the time limit specified by the Office but the applicant provides proof that, within the time limit, it duly gave an order to a banking establishment to transfer the amount of the payment in a Member State, Article 180(3) EUTMR will be applied, including the payment of a surcharge where applicable (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

The filing date of an application for cancellation is not affected by the date of payment of the fee, since Article 63(2) EUTMR does not establish any consequence as regards the filing date of the application. When the fee is paid before the expiry of the time limit specified by Article 15(1) EUTMDR, the application is deemed to have been filed and the filing date will be that on which the written statement was received by the Office.

As a general principle, the cancellation fee is an application fee due for the filing of the application regardless of the outcome of the proceedings. Therefore, it will not be refunded in cases of inadmissibility.

Neither will the cancellation fee be refunded in cases where the application for cancellation is withdrawn at any stage.

In this context, the only provisions that envisage the refund of the cancellation fee are Article 15(1) EUTMDR, applicable only in cases where the application is deemed not to have been filed as a result of a late payment, and Article 18(2) EUTMDR, which, applying Article 9(4) EUTMDR *mutatis mutandis*, envisages a refund of 50 % of the cancellation fee in the event of multiple applications, provided that the proceedings were suspended before the commencement of the adversarial part of the proceedings.

However, in the event of the withdrawal of the application for cancellation where the declaration of withdrawal reaches the Office on the same day as the original application, the fee will be refunded.

2.4 Languages and translation of the application for cancellation

2.4.1 Language of the proceedings

Article 146(5) to (7) EUTMR
Article 15(2) and (3) EUTMDR

The application for revocation or invalidity must be filed in one of the five languages of the Office. The rules regarding the language of proceedings are explained in detail in the Guidelines, Part A, General Rules, Section 4, Language of Proceedings.

According to these rules, in cancellation proceedings there are cases where the applicant has a choice between two possible languages of proceedings (the first and second languages of the contested mark, both being languages of the Office), and cases where there is only one possible language of proceedings (when the first language is not one of the five languages of the Office, the language of the cancellation proceedings can only be the second language of the contested mark).

In cases where there is a choice, the language of proceedings will be that expressly indicated in the application for cancellation or, in the absence of an express indication, the language in which the application for cancellation was filed, in both cases provided that it is one of the possible languages of proceedings.

Where the wrong language of the proceedings has been chosen by the applicant, the EUTMR distinguishes between two different scenarios: where the incorrect language is a language of the Office, and where the incorrect language is one of the official languages of the Union (but not of the Office). Depending on which of the above applies, there are different consequences for the applicant and time limits to respect when choosing the correct language of the proceedings and submitting the translation of the application for cancellation.

- If the application has been filed in a **language of the Office** that is not one of the possible languages of the proceedings, of its own motion the applicant has to file a translation of the application into the first language, provided that it is a language of the Office, or into the second language. The translation must be produced **within one month of the filing date of the application for cancellation**, failing which the application will be rejected as inadmissible (Article 146(7) EUTMR; Article 15(2) and (3) EUTMDR).

Article 15(4) EUTMDR, regarding the invitation to the applicant to remedy deficiencies, does not refer to Article 146(7) EUTMR; therefore, in these cases **the Office will not send a deficiency letter**, it will wait for one month from the filing date for the translation of the cancellation application to be submitted.

- If the language chosen by the applicant is **not a language of the Office**, the application will be rejected as inadmissible. Article 146(5) EUTMR applies, as it clearly specifies that the application for cancellation must be filed in a language of the Office. As it has not been filed in a language of the Office, the one-month period to remedy the deficiency of Article 146(7) EUTMR does not apply.

In the event that the language chosen by the applicant is not one of the possible languages of the proceedings, any correspondence issued by the Office in the cancellation proceedings will be in the first language of the contested mark, providing

that it is a language of the Office, or in the second language if the first one is not one of the five languages of the Office.

Concerning the use of official forms, Article 146(6) EUTMR states that when the form provided by the Office is used, it may be used in any official language of the Union, provided that it is completed in one of the languages of the Office as far as textual elements are concerned.

Where the applicant uses the official form in a language that cannot be the language of the proceedings, all textual elements are in the wrong language and a language has been chosen that cannot be the language of the proceedings, the above principles apply: where the incorrect language chosen is a language of the Office, the applicant has one month to file a translation on its own motion; where the incorrect language chosen is not a language of the Office, the deficiency cannot be remedied and the application will be deemed inadmissible.

2.4.2 Translation of the evidence required for admissibility

Articles 15(4) and 16(2) EUTMDR

Where evidence in support of the application is required to evaluate the admissibility of the case (e.g. the particulars of the earlier right on which the application is based), and this evidence is not in the language of the proceedings, or translated into that language, the Office will invite the applicant to remedy the deficiency pursuant to Article 15(4) EUTMDR (decision of 02/03/2007, R 300/2006-4, ACTILON / ACTELION (fig.)). If the deficiency is not remedied, the application for cancellation will be rejected as totally or partially inadmissible (Articles 15(4) and 16(2) EUTMDR).

2.5 Admissibility check

Article 58 and Articles 60(4), 63(3) and 66(2) EUTMR Articles 12, 15 and 16 EUTMDR

Once the Office has established that the corresponding fee has been duly paid, it checks the admissibility of the application.

In contrast to opposition proceedings, there is no cooling-off period and the applicant has until the closure of the adversarial part of the proceedings to submit evidence for substantiation. This means, in particular, that in the case of an application for invalidity based on relative grounds, the proof of the existence, validity and scope of protection of all the earlier rights and the evidence proving the applicant's entitlement to them have to be filed. These documents should preferably be filed together with the application.

The admissibility check may result in the identification of absolute and/or relative admissibility deficiencies in the application.

Absolute admissibility deficiencies are those that cannot be remedied by the applicant and will automatically lead to the application being considered inadmissible. They are described in detail in paragraph 2.5.1 below.

Relative admissibility deficiencies, however, are those that can in principle be remedied by the applicant. They include non-compliance with one or more of the relative admissibility requirements contained in Article 12 EUTMDR (which are described in detail in paragraph 2.5.2 below). In these cases, in accordance with Article 15(4) EUTMDR, the Office will invite the applicant to remedy the deficiency within two months.

Where one or more relative admissibility deficiencies have been found and they are not remedied within the specified time limit, a decision will be issued rejecting the application for cancellation as inadmissible.

Any decision to reject an application for cancellation in its entirety as inadmissible will be communicated to the applicant and the proprietor of the EUTM (Article 15(5) EUTMDR) and can be appealed by the applicant.

However, if the result of the admissibility check is that the application is considered partially admissible (i.e. admissible for at least some of the grounds and/or earlier rights on which it is based), the proceedings will continue. If one of the parties disagrees with the result of the admissibility check, it can appeal against it together with the final decision terminating the proceedings (Article 66(2) EUTMR).

2.5.1 Absolute admissibility requirements

Where an absolute admissibility deficiency is found, the Office will invite the applicant to comment on the inadmissibility within two months. If, after hearing the applicant, the Office still maintains that there is an absolute admissibility deficiency, a decision will be issued rejecting the application for cancellation as inadmissible. This decision will be copied to the EUTM proprietor.

2.5.1.1 Contested mark is not yet registered

The application is filed against an EUTM that has not yet been registered. An application for cancellation can only be filed against a registered EUTM. A request directed against an application that has not yet been registered is premature (decision of 22/10/2007, R 284/2007-4, VISION / VISION).

2.5.1.2 Contested mark no longer exists

The application is filed against an EUTM that no longer exists at the time of filing, since it has already been surrendered, has expired, or has been revoked or invalidated by a final decision.

2.5.1.3 Res judicata

Article 63(3) EUTMR

There is a previous final decision by the Office or by a European Union trade mark court as referred to in Article 123 EUTMR on a cancellation application or counterclaim relating to the same subject matter and cause of action, and involving the same parties,

which has been adjudicated on its merits, and the decision has acquired the authority of a final decision.

For more details on this admissibility deficiency, see the corresponding section in the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions, paragraph 5.

2.5.1.4 New application invoking other rights that could have been invoked in support of the first application

Article 60(4) EUTMR

In cases of invalidity based on relative grounds, where the applicant owns several earlier rights and has previously applied for the invalidity of the same EUTM (or made a counterclaim) on the basis of another of those earlier rights that could have been invoked in the previous application or counterclaim.

For more details on this admissibility deficiency, see the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions, paragraph 4.5.2.

2.5.1.5 Revocation on non-use: the mark has been registered for less than five years

Article 58 EUTMR

An application for revocation based on non-use is filed against a trade mark that has not been registered for five years at the date of the application.

2.5.1.6 Application filed in the wrong language

Article 146(5) EUTMR Article 15(2) and (3) EUTMDR
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An application for cancellation is filed without having used the official form, which is neither in the correct language as established in Article 146 EUTMR nor translated into that language within one month of the filing of the application for cancellation. For more detailed information see paragraph 2.4 above.

2.5.1.7 Identification of the contested mark

Article 12(1)(a) EUTMDR

An application for cancellation must contain the EUTM registration number in respect of which revocation or a declaration of invalidity is sought and the name of its proprietor.

For more details on this admissibility deficiency, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.4.1.1, as the same explanations and reasoning apply to cancellation proceedings.

2.5.1.8 Identification of the grounds

Article 12(1)(b) EUTMDR

An application for cancellation must contain an indication of the grounds on which it is based, that is to say, an identification of the specific provisions of the EUTMR that justify the requested cancellation, as laid down in Articles 58, 59, 60, 81, 82, 91 or 92 EUTMR.

The applicant may limit the grounds on which the application was initially based but cannot enlarge the scope of the application by claiming any additional grounds during the course of the proceedings.

Revocation and invalidity grounds cannot be combined in a single application but must be subject to separate applications and entail the payment of separate fees. However, an application for revocation can be based on several revocation grounds, and an application for invalidity can be based on a combination of absolute and relative grounds.

For more details on this admissibility deficiency, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.4.1.3, as the same explanations and reasoning apply to cancellation proceedings.

2.5.1.9 Identification of the earlier marks/rights

Where an application for invalidity is based on relative grounds (Article 60 EUTMR), the application must contain particulars of the right or rights on which the application is based.

Article 60(1) EUTMR Article 12(2)(a) EUTMDR
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Concerning the absolute identification requirements of earlier marks/rights invoked under Article 60(1) EUTMR, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.4.1.2, as cancellation proceedings follow the same rules as oppositions, because Article 12(2)(a) EUTMDR applies the requirements of Article 2(2)(b) EUTMDR *mutatis mutandis*.

Article 60(2) EUTMR Article 12(2)(b) EUTMDR
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Concerning the absolute identification requirements of earlier rights invoked under Article 60(2) EUTMR, such as:

- the right to a name;
- the right to personal portrayal;
- a copyright;
- an industrial property right.

The absolute identification requirements are:

- an indication of the nature of the earlier right;
- a representation of the earlier right;
- an indication of whether this right exists in the whole of the Union or in one or more Member States, and if so, an indication of those Member States.

2.5.2 Relative admissibility requirements

The relative admissibility requirements laid down by Article 15(4) EUTMDR are set out below.

2.5.2.1 Identification of the applicant and/or representative

Article 12(1)(c) EUTMDR

An application for cancellation must contain the applicant's name and address and, if the applicant has appointed a representative, the representative's name and address. If the applicant has previously been allocated an identification (ID) number by the Office, it is sufficient to indicate that ID number and the applicant's name.

Applicants that do not have either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the European Economic Area (EEA) must be represented by a professional representative (Article 119(2) EUTMR). If the representative has been allocated an ID number by the Office, it is sufficient to indicate that ID number and the representative's name. For more information, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

Concerning multiple applicants, applications for invalidity based on relative grounds follow the same rules as oppositions (see the Guidelines, Part C, Opposition, Section 1, Procedural Matters). These rules are directly connected to the entitlement requirements of Articles 46(1) and 63(1) EUTMR (see above).

In contrast, in the case of applications for invalidity based on absolute grounds and for revocation there are no particular requirements regarding multiple applicants, except that they have to be clearly indicated in the application.

Please note that in all cases concerning multiple applicants, Article 73 EUTMDR and Article 18(2) and (3) EUTMIR will be applied (appointment of a common representative and fixing of costs).

2.5.2.2 Other particulars of the earlier marks/rights

Article 12(2)(c) EUTMDR

Dates

Article 2(2)(d) and (e) EUTMDR apply *mutatis mutandis*.

For more details on this admissibility deficiency, see the corresponding section in the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.4.2.1, as the same explanations and reasoning apply to cancellation proceedings.

Representation of earlier marks/signs

Article 2(2)(f) EUTMDR applies *mutatis mutandis*.

For more details on this admissibility deficiency, see the corresponding section in the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.4.2.2, as the same explanations and reasoning apply to cancellation proceedings.

Goods and services

Article 2(2)(g) EUTMDR applies *mutatis mutandis*.

For more details on this admissibility deficiency, see the corresponding section in the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.4.2.3, as the same explanations and reasoning apply to cancellation proceedings.

2.5.2.3 Application entered by a licensee or person entitled under Union legislation or national law

Article 12(2)(d) EUTMDR

It is assumed that the applicant claims to be the owner of the earlier right, unless otherwise stated.

For more details on this admissibility deficiency, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.4.2.5, as the same explanations and reasoning apply to cancellation proceedings.

Article 2(2)(h)(iii) EUTMDR applies *mutatis mutandis*.

2.5.2.4 Invitation to remedy deficiencies

Article 15(4) and (5) EUTMDR

In accordance with Article 15(4) EUTMDR, if the Office finds that an application for cancellation does not comply with Article 12(1)(c), or (2)(c) or (d) EUTMDR, it will invite the applicant to remedy the deficiencies within a specific time limit. Please note that this only applies to deficiencies regarding admissibility requirements, and not to deficiencies regarding substantiation requirements, which the applicant must remedy of its own motion (see paragraph 3.2 below).

If the deficiencies are not remedied before the expiry of the time limit, the Office will issue a decision rejecting the application as inadmissible. In cases where the application for cancellation is based on several grounds and/or earlier rights and the deficiencies only relate to some of them, the proceedings can continue in relation to the

other grounds or earlier rights for which there are no admissibility deficiencies (partial admissibility).

In the context of Article 15(4) EUTMDR, the fact that the applicant is invited to remedy a deficiency cannot lead to enlargement of the scope of the proceedings (earlier rights, goods and services, etc.) determined by the initial request.

Finally, Article 15(4) EUTMDR is only applicable to the list of relative admissibility requirements contained in Article 12 EUTMDR. Deficiencies in relation to absolute admissibility requirements are not covered by Article 15(4) EUTMDR and cannot be remedied (i.e. they lead to the rejection of the application in question as inadmissible).

2.5.3 Optional indications

2.5.3.1 Extent of the application for cancellation

Article 12(1)(d) EUTMDR

The application may contain an indication of the goods and services against which the application is directed; in the absence of such an indication, the application will be considered to be directed against all of the goods and services of the contested registration.

If the applicant indicates that the application is only directed against part of the goods and services of the contested registration, it will have to list these goods/services clearly. If it does not do so, the application will be considered to be directed against all of the goods and services of the contested registration.

For more details on this optional requirement, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.4.3.1, as the same explanations and reasoning apply to cancellation proceedings.

An applicant is entitled to limit the scope of its application by excluding subcategories of the goods and/or services for which the contested mark is registered (see, as regards applications for revocation, judgment of 09/12/2014, T-307/13, ORIBAY, EU:T:2014:1038, § 25).

2.5.3.2 Reasoned statement and supporting evidence

Article 12(4) EUTMDR

According to Article 12(4) EUTMDR, an application for cancellation may also contain a reasoned statement on the grounds setting out the facts and arguments on which it is based and supporting evidence.

Both the reasoned statement on the grounds and the supporting evidence are optional at the stage of filing the application for revocation or for a declaration of invalidity. When they are necessary to substantiate the application they must be provided before the expiry of the substantiation period, which is the closure of the adversarial part of the revocation or invalidity proceedings (Article 16(1) EUTMDR). They concern the substance, not the admissibility of the application.

2.6 Notification of the application

Article 64(1) EUTMR
 Article 14 and Article 17(1) EUTMDR

Any application for cancellation and any document submitted by the applicant, as well as any communication addressed to one of the parties by the Office prior to the finding on admissibility, will be sent by the Office to the other party for information purposes.

Once the application for cancellation has been found admissible, the Office will invite the proprietor to file its observations within such time limit as it may specify.

The notification of the application to the EUTM proprietor will contain an invitation to file observations (and in the case of an application for revocation based on Article 58(1)(a) EUTMR, an invitation to submit proof of genuine use — see Article 19(1) EUTMDR). In practice, the Office grants the EUTM proprietor two months for its first reply to the application.

According to the judgment of 18/10/2012, C-402/11 P, Redtube, EU:C:2012:649 (applicable by analogy to cancellation proceedings), the notification sent to the parties after the admissibility check informing them that the cancellation is admissible in accordance with Rule 37 of Regulation No 2868/95 read in conjunction with Rule 18(1) of the same Regulation [now Article 17(1) EUTMDR] constitutes a decision that may be appealed together with the final decision on the case as stated in Article 57(2) of Regulation No 40/94 [now Article 66(2) EUTMR]. Consequently, the Office is bound by this decision and may only revoke it at a later stage of the proceedings, provided that the requirements in Article 77a of Regulation No 40/94 [now Article 103 EUTMR] for the revocation of decisions are met. This means that, for instance, if an admissibility deficiency is found after the application has been notified, it should first be determined whether the decision on admissibility can still be revoked and, if so, the Office will issue the corresponding deficiency letter once the previous decision on admissibility has been revoked.

Revocation does not occur where the cause of inadmissibility arises **after** the initial admissibility check (e.g. when an applicant outside the EEA ceases to have a representative and does not appoint one, or when res judicata applies because a pertinent decision becomes final during the cancellation proceedings). In such cases the Office will again check the admissibility and issue the corresponding deficiency letter without revoking the previous admissibility decision (which did not contain any error at the time it was adopted).

3 Adversarial Stage

3.1 Completion of the application

Article 64 EUTMR
 Article 17(2) EUTMDR

According to Article 64(1) EUTMR, the Office may invite the parties to file observations as often as it considers necessary. In practice, and in the interest of avoiding an unnecessary prolongation of the proceedings, the Office will usually grant two rounds

of observations, usually ending with those of the EUTM proprietor (i.e. application for cancellation — EUTM proprietor’s observations — applicant’s observations — EUTM proprietor’s observations). Nevertheless, in cases when one of the parties, within the time limit to file observations, does not submit any evidence or observations and/or indicates that it has nothing more to comment, the Office may proceed directly to closure of the adversarial part of the proceedings, notifying the parties that a decision will be taken.

However, additional rounds of observations may be granted in exceptional cases, in particular when additional relevant evidence, which could not have been filed beforehand, is filed in the last round. It is the Office’s practice to give the parties a time limit of two months to file their observations.

As regards applications for invalidity based on relative grounds, the EUTM proprietor may also file a request for proof of use of the earlier trade marks on which the application is based. If the request is admissible, the Office will invite the applicant to submit the proof (Article 64(2) and (3) EUTMR and Article 19(2) EUTMDR). For more guidance on requests for proof of use, see paragraph 3.4 below.

Once the parties have submitted their observations and/or proof of use (if applicable) the adversarial part is closed and the file is ready for decision.

If at any stage of the proceedings one of the parties does not file observations within the specified time limit, the Office will close the adversarial part and take a decision on the basis of the evidence before it (Article 17(2) EUTMDR).

As regards the rules on time limits, extensions, notification or change of parties in the course of proceedings, etc., see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, as the rules are applicable *mutatis mutandis*.

3.2 Substantiation

Article 16 and Article 17(2), (3) and (4) EUTMDR

The applicant has up to the closure of the adversarial part of the proceedings to present the facts, evidence and arguments in support of the application. This means that it may do so with the application for cancellation, once the Office has informed of the admissibility of the application and invited the EUTM proprietor to file observations (Article 17(1) EUTMDR), or during a time limit set by the Office for the applicant to file observations in response to the EUTM proprietor (pursuant to Article 17(2) EUTMDR and Article 64(1) EUTMR). However, for reasons of procedural economy the Office highly recommends that all facts, evidence and arguments in support of the application (including any necessary translations) are presented together with the initial application for cancellation.

In the case of an application for revocation pursuant to Article 58(1)(a) EUTMR, the onus is on the EUTM proprietor to submit the proof of genuine use or of proper reasons for non-use; therefore, this is the only case where the applicant does not have to substantiate the application (Article 19(1) EUTMDR).

In the case of an application for revocation pursuant to Article 58(1)(b) or (c) EUTMR or an application for invalidity based on absolute grounds pursuant to Article 59 EUTMR,

the applicant must submit facts, arguments and evidence to support the grounds on which the application is based (Article 16(1)(a) EUTMDR).

In the case of an application for invalidity based on relative grounds pursuant to Article 60(1) EUTMR, the applicant must prove the existence, validity and scope of protection of the earlier rights invoked, as well as submit evidence proving its entitlement to file the application for cancellation (Article 16(1)(b) EUTMDR). As regards substantiation requirements of earlier rights, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.2, and the section on invalidity proceedings based on relative grounds in the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions.

In the case of an application for invalidity based on relative grounds pursuant to Article 60(2) EUTMR, the applicant must submit evidence of acquisition, continued existence and scope of protection of the earlier right, as well as evidence proving its entitlement to file the application for cancellation (Article 16(1)(b) EUTMDR).

Furthermore, for grounds invoked pursuant to Article 60(1)(c) and (d) and Article 60(2) EUTMR, where rights are invoked under national law, the applicant must provide the reference to and the wording of the provisions of national law on which it bases its case and make its case under that law. See the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and (6) EUTMR (Article 16(1)(c) EUTMDR).

If the applicant does not submit the facts, arguments or evidence required to substantiate the application, the application will be rejected as unfounded (Article 17(3) EUTMDR).

3.2.1 Online Evidence

3.2.1.1 Earlier trade mark applications and registrations, non-registered trade marks and other signs used in the course of trade, designations of origin and geographical indications (Article 60(1) EUTMR)

According to Article 16(1)(b) EUTMDR, in the case of an application for invalidity based on the relative grounds for invalidity listed in Article 60(1) EUTMR, the evidence required for the substantiation of the claim is the same as that required in opposition proceedings, as Article 7(3) EUTMDR applies *mutatis mutandis*. This also means, that the applicant in invalidity proceedings can rely on online substantiation for evidence of filing or registration of these earlier rights, and, where applicable, the relevant national law.

As the practice of informing the Office of the intention to rely on online evidence, and the identification of the online source is the same as for opposition proceedings, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.2, where the process of 'formal declaration' is explained, and later to each specific paragraph concerning each type of earlier right for the identification of the online sources.

3.2.1.2 Industrial property rights (Article 60(2)(d) EUTMR)

In addition to the above, according to Article 16(1)(c) EUTMDR, second sentence, where evidence concerning the filing or registration of an earlier **industrial property**

right is to be submitted (under Article 60(2)(d) EUTMR), including where evidence concerning the contents of the relevant national law is required under this ground, and this evidence is accessible online from a source recognised by the Office, the applicant may rely on online substantiation.

Reliance on an industrial property right is specific to invalidity proceedings; however, applying the same reasoning and process set out in opposition proceedings, the applicant must formally declare its reliance on online substantiation before the expiry of the substantiation deadline. In addition, the Office will accept the identification of the official publications and/or national databases to the extent that they originate from the government or official body of the respective Member State, and if they are publically accessible and free of charge. For the identification of national law, the same requirements apply as in non-registered trade marks or other signs used in the course of trade (see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.2.4.3).

3.3 Translations and changes of language during cancellation proceedings

3.3.1 Change of language

Article 146(8) EUTMR Article 13 EUTMDR

The language of cancellation proceedings will in general be determined by the applicant in the cancellation application and has to comply with Article 146 EUTMR. See paragraph 2.4.1 above for more details about the choice of language for cancellation proceedings.

However, the parties to cancellation proceedings may also agree on a different official language of the European Union as the language of the proceedings (Article 146(7) EUTMR).

This agreement has to be communicated to the Office within two months of the notification of the application for cancellation to the EUTM proprietor. Where the application has not been filed in that language, the EUTM proprietor may request that the applicant file a translation into that language. The translation request must be received by the Office within the same two-month period. In this case, the applicant will be invited by the Office to file the translation of the application into the language chosen by both parties within a time limit set for this purpose.

Where the translation is formally requested and it is not filed or it is filed late, or where the request to change the language is filed late (after the expiry of the two months), the language of the proceedings will remain unchanged (Article 13 EUTMDR).

3.3.2 Translation of evidence of substantiation submitted by the applicant

Article 24 and Article 25(1) EUTMIR Article 16(2) EUTMDR

3.3.2.1 Evidence of filing, registration or renewal certificates or equivalent documents, any provisions of the applicable national law

Where the application is based on the grounds of Article 60(1) and (2) EUTMR, the evidence concerning the **filing, registration or renewal of earlier marks or rights**, or where applicable, the **contents of the relevant national law** must be filed in the language of the proceedings, or should be translated into the language of the proceedings.

The translation is to be submitted by the applicant of its own motion within **one month** of the filing of such evidence. This applies to all the evidence submitted by the applicant in the course of the proceedings in order to comply with the requirements of Article 16(1)(b) and (c) EUTMDR, whether it is filed together with the application or at a later stage. **The Office will not send a deficiency letter**, and it is up to the applicant to submit the translation of the evidence in support of the application of its own motion.

The requirement of translating the evidence of substantiation also relates to online evidence referred to by the applicant, where the language of the online evidence is not the same as the language of the proceedings. This follows from Article 16(2) EUTMDR, which states that 'evidence accessible online' must also either be in the language of the proceedings, or be accompanied by a translation.

Article 25(1) EUTMIR requires that the translation reproduces the structure and contents of the original document. In the case of translations of online evidence of substantiation, the submission of the translation without the original will be accepted, as long as the document to which it refers is identified correctly.

Any document in support of the application that is not translated by the applicant into the language of proceedings within the time limit specified in Article 16(2) EUTMDR will be deemed not to have been received by the Office, and therefore will not be taken into account (Article 25(2) EUTMIR) (decision of 05/03/2012, R 826/2010-4, MANUFACTURE PRIM 1949 (fig.), § 25).

3.3.2.2 Other evidence

Any other evidence submitted by the applicant to substantiate the application, such as **evidence showing use in the course of trade or evidence of reputation**, will be subject to Article 24 EUTMIR, namely it will only have to be translated into the language of the proceedings at the Office's request within a period specified to that effect.

3.3.3 Translation of observations submitted by the parties in the course of the proceedings

Article 146(8) EUTMR
Article 25(2)(a) EUTMIR

In written proceedings before the Office, a party who submits observations in a **language of the Office** other than the language of the proceedings has to file a translation of those observations in the language of the proceedings within **one month** of the submission date (Article 146(8) EUTMR).

The Office **will not ask for the translations** and will proceed with the case. It is up to the party to submit the requisite translations.

If the translations are not submitted on the parties' initiative within the time limit of one month, the observations will be deemed not to have been received by the Office, and therefore will not be taken into account (Article 25(2)(a) EUTMIR).

Where a party submits observations in a **language of the European Union** that is **not** a language of the Office, the one-month time limit to translate the observations does not apply. The observations will be deemed not to have been received from the outset, and will not be taken into account.

3.3.4 Translation of evidence submitted by the EUTM proprietor in the course of the proceedings

Article 24 and Article 25(2)(a) EUTMIR

The supporting documents submitted by the EUTM proprietor in the course of the proceedings (except for proof of use, see below) are subject to Article 24 EUTMIR, and therefore may be submitted in any official language of the European Union.

In accordance with this provision, the EUTM proprietor is not automatically obliged to file a translation, but **the Office may require it to do so within a time limit**. When exercising its discretion in this matter, the Office will take into account the nature of the evidence and the interests of the parties.

In cases where the Office does invite the EUTM proprietor to submit translations of the evidence, failure to do so within the specified time limit will mean that the untranslated documents will not be taken into account (Article 25(2)(a) EUTMIR).

3.3.5 Translation of proof of use

Article 24 EUTMIR
Article 19 EUTMDR

According to Article 19(1) EUTMDR (to which Article 10(6) EUTMDR applies *mutatis mutandis*) and to Article 19(2) EUTMDR (to which Article 24 EUTMIR applies directly), evidence of use may be filed in any official language of the Union.

Where the evidence of use is not in the language of the proceedings, the Office **may** require the party to submit a translation of the evidence into that language within a time limit specified by it. In exercising its discretion in this matter, the Office will take into account the nature of the evidence and the interests of the parties. In cases where the Office does invite the party to submit translations of the evidence, failure to do so within the specified time limit will mean that the untranslated documents will not be taken into account.

For further guidance on translation of evidence of use, see the Guidelines, Opposition, Section 6, Proof of Use, paragraph 3.6.

3.4 Requests for proof of use

Article 19(2) EUTMDR

The practice regarding proof of use requests according to Article 64(2) or (3) EUTMR, where the EUTM proprietor wishes to request proof of use of the earlier trade marks on which the application for invalidity is based, has been aligned with opposition proceedings (Article 10(1) EUTMDR). In cancellation proceedings, a request for proof of use must be filed by the EUTM proprietor together with its first reply to the application, within the first time limit set to file observations according to Article 17(1) EUTMDR.

If a request for proof of use is submitted by the EUTM proprietor at a later stage of the proceedings, it will not be admissible.

In addition, according to Article 19(2) EUTMDR, where the EUTM proprietor wishes to request proof of use, it must do so by way of a **separate document**. When defining what a 'separate document' is, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.4.1, as the same principles apply.

For further guidance on requests for proof of use, see the Guidelines, Part C, Opposition, Section 6, Proof of Use, paragraph 3.

4 Other Issues

4.1 Continuation of proceedings

Article 105 EUTMR

According to Article 105(1) EUTMR, any party to proceedings before the Office that has omitted to observe a time limit vis-à-vis the Office may, upon request, obtain the continuation of proceedings, provided that at the time the request is made the omitted act has been carried out. The request for continuation of proceedings will be admissible only if it is presented within two months of the expiry of the unobserved time limit and will not be deemed to have been filed until the corresponding fee has been paid.

This provision is applicable to all the proceedings before the Office. For more details, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

In cancellation proceedings, continuation of proceedings can be requested for any of the different time limits within the cancellation proceedings (except for the time limit established in Article 68(1) EUTMR to file an appeal).

4.2 Suspensions

Article 132 EUTMR
Article 71 EUTMDR

In the matter of suspensions, see in general the Guidelines, Part C, Opposition, Section 1, Procedural Matters (taking into account, however, that in cancellation proceedings there is no cooling-off period). Article 71 EUTMDR applies.

The main particularity of cancellation proceedings in this matter concerns the specific rules on related actions before European Union trade mark courts. According to Article 132(2) EUTMR, the Office, when hearing an application for cancellation will, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, suspend the proceedings where the validity of the contested EUTM is already in issue on account of a counterclaim before a European Union trade mark court.

Article 132(2) EUTMR also states that if one of the parties to the proceedings before the European Union trade mark court so requests, the European Union trade mark court may, after hearing the other parties to these proceedings, suspend the proceedings. The Office will continue the proceedings pending before it in this case.

A request for suspension pursuant to Article 132(2) EUTMR should be supported by relevant evidence. Suspension requests are only considered relevant to the proceedings and might be granted under Article 132(2) EUTMR in cases where they refer to the contested EUTM and not where they refer to other EUTMs contested in parallel cancellation proceedings.

4.3 Surrenders, withdrawals and closure of the proceedings

Article 57(2) EUTMR
Article 17(5), (6), (7) and (8) EUTMDR

4.3.1 Surrenders

In principle, the consequences in cancellation proceedings of a total surrender of the contested EUTM (or of a partial surrender of some of the goods and/or services against which the application for cancellation is directed) are similar to those of the withdrawal of an EUTM application in opposition proceedings.

However, unlike what occurs with the withdrawal of an EUTM application, the effects of the surrender of a registered EUTM are not the same as those of the decision on the substance terminating the proceedings in question. While the surrender of an EUTM only becomes effective on the date on which the surrender is registered, a decision cancelling the EUTM produces its effects from an earlier date, be it from the outset (in the case of invalidity) or from either the date on which the cancellation request was

filed or which was fixed in the Office's decision at the request of one of the parties pursuant to Article 62(1) EUTMR (in the case of revocation). Consequently, despite the declaration of surrender of the contested EUTM, the applicant may still claim to have a legitimate interest in continuing the cancellation proceedings in order to obtain a decision on the substance (judgment of 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 39 and decision of 22/10/2010, R 463/2009-4, MAGENTA (col.), § 25-27). However, the claim of legitimate interest must be declared and proven by the applicant (see paragraph 4.3.1.2 below).

In practice, when there is a total or partial surrender of an EUTM that is subject to cancellation proceedings, and this surrender affects the scope of the proceedings, the Office will suspend the registration of the surrender and, in parallel, will notify the cancellation applicant of the surrender, inviting it to inform the Office whether it withdraws the application in view of the declared surrender. The consequence for the parties and the Office will depend not only on the reply of the applicant, but also on the type of cancellation proceedings in question, that is to say, whether the cancellation action is an application for revocation or whether it is an application for a declaration of invalidity.

4.3.1.1 Application for revocation pending

If, in reply to the Office's letter, the applicant replies by withdrawing the application for revocation as a consequence of the surrender, the surrender will be recorded and the proceedings will be closed without a decision on the substance. The application will be withdrawn.

If the applicant does not reply, the suspension of the surrender will be maintained and the cancellation proceedings will continue until there is a final decision on the substance.

After the decision on the cancellation has become final, the surrender will be recorded only for the goods and/or services for which the contested EUTM has not been revoked, if any.

4.3.1.2 Application for a declaration of invalidity pending

If, in reply to the Office's letter, the applicant replies by withdrawing the application for a declaration of invalidity as a consequence of the surrender, the surrender will be recorded and the proceedings will be closed without a decision on the substance. The application will be withdrawn.

If the applicant does not reply, the surrender will be recorded and the cancellation proceedings will continue for the remaining goods and/or services against which the cancellation is directed that were not removed by the partial surrender, if any. If all of the contested goods are removed by the surrender, the invalidity proceedings will be closed without a decision on the substance. The application will be closed due to the surrender.

If the applicant replies and declares to have a **legitimate interest** in obtaining a decision on the substance, the Office will assess the request. A claim to a legitimate interest will only be accepted where the applicant claims and proves why a decision on the substance of the declaration of invalidity is required, and why the surrender of the

contested mark is not sufficient. Claims without any supporting evidence and without any explanation as to why the surrender of the mark is insufficient (as opposed to a declaration of invalidity) will be rejected. In addition, the legitimate interest must be real, direct and present. Requests based on possible future conflicts or presumed conflict arising from the conversion of the contested EUTM to a national registration will be rejected. As cases where a legitimate interest is claimed will mostly involve pending court proceedings, the party claiming this interest must lay out the relief sought in these court proceedings.

Only in cases where a legitimate interest is claimed and proven by the applicant, will the Office maintain the suspension of the surrender. In all other cases, the surrender will be recorded and the cancellation proceedings will continue for the remaining goods and/or services against which the cancellation is directed that were not removed by the partial surrender, if any. If all of the contested goods are removed by the surrender, the invalidity proceedings will be closed without a decision on the substance. The application will be closed due to the surrender.

4.3.1.3 The surrender predates the cancellation application

Where surrender is declared before the filing of the cancellation action, but had not yet been entered into the Register at the time of filing the application, the Office will take note of the surrender and enter it in the Register, irrespective of the filing of any later cancellation actions, including applications for revocation where the cancellation applicant asks for an earlier date to be fixed pursuant to Article 62(1) EUTMR.

For the Office to suspend the entry in the Register of the surrender as explained above, it must have been declared subsequent to the submission of the cancellation application.

4.3.1.4 Partial surrender does not affect the extent of the cancellation

Where a partial surrender does not affect any of the contested goods and/or services, the partial surrender will be registered as described in the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration, and the applicant in the cancellation proceedings will not be informed.

4.3.1.5 Surrender to be filed by way of a separate document

According to Article 17(8) EUTMDR, during the course of cancellation proceedings, where the EUTM proprietor wishes to surrender the contested mark, it must do so by way of a separate document.

When defining what a 'separate document' is, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.4.1, as the same principles apply.

4.3.2 Withdrawals

The cancellation applicant can withdraw its application for cancellation at any time of the proceedings. The Office will inform the EUTM proprietor about the withdrawal and close the proceedings.

4.3.3 Contested mark expires or is cancelled in parallel proceedings

Similarly to the process explained above in paragraph 4.3.1.2, where some (or all) of the contested goods and services are removed as a consequence of the final expiry of the contested EUTM, or as a consequence of a refusal in parallel revocation proceedings, the Office will inform the applicant and invite it to inform the Office whether it has a legitimate interest in obtaining a decision on the merits from an earlier date. The same applies as has already been explained in paragraph 4.3.1.2, where a legitimate interest will have to be claimed and proven by the applicant.

If a legitimate interest is not claimed or proven, or where the contested mark was invalidated from the outset in the parallel invalidity proceedings, the proceedings will be closed without a decision on the substance.

The application will be closed due to the expiry or cancellation of the contested mark in the parallel case.

In the event that the expiry or the cancellation in parallel proceedings does not remove all of the contested goods, and a legitimate interest has not been claimed or proven, the proceedings will continue for the remaining goods and/or services against which the cancellation is directed that were not removed.

4.3.4 Decision on the apportionment of costs

Article 109(4) and (6) EUTMR

The party that terminates the proceedings by withdrawing the application for revocation or the application for a declaration of invalidity, or by not renewing registration of the EUTM, or by surrendering the EUTM, will bear the fees and the costs incurred by the other party (Article 109(4) EUTMR), except in cases where the withdrawal is a consequence of a surrender (see paragraphs 4.3.1.1 and 4.3.1.2 above), in which case the costs will be borne by the EUTM proprietor.

In addition, the parties may indicate that a surrender or a withdrawal is a consequence of an agreement they have reached, and that a decision on costs is not necessary. The Office will not issue a decision on costs if such a request is received together with a request for surrender or withdrawal and is signed by both parties. Such a request can also be sent in two separate letters to the Office. In cases where no indication is given as to whether the parties have agreed on the costs, the Office will take a decision on costs immediately. The decision on costs already issued will not be revised by the Office in the event that the parties provide such information after the date of the decision. It is left to the parties to respect the agreement and not to 'execute' the Office's decision on costs.

For more details on the Office's practice of apportionment and fixing of costs in *inter partes* proceedings, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraphs 5.5 and 5.6.

Article 15(5) EUTMDR

Where an application for revocation or declaration of invalidity is rejected in its entirety as inadmissible pursuant to Article 15(2), (3) or (4) EUTMDR, prior to the notification of the application under Article 17(1) EUTMDR, no decision on costs will be taken.

4.4 Applications for revocation and for invalidity against the same EUTM

If the same EUTM is subject to both revocation and invalidity proceedings, the Office has the power of discretion to decide in each case, taking into account the principles of economy of proceedings and administrative efficiency, whether one of the proceedings has to be suspended until the other has terminated, or in which order the proceedings should be decided.

If it is first decided that the EUTM is totally invalid (or partially, but for all the goods/services against which the revocation is directed), and once this decision becomes final, the parallel revocation proceedings will automatically be closed, as they no longer have any object. The costs are at the discretion of the Office (Article 109(5) EUTMR), which will usually conclude that each party has to bear its own costs.

However, taking into account the different effects of revocation (*ex nunc*) and of a declaration of invalidity (*ex tunc*), when it is first decided that the EUTM should be totally revoked (or partially, but for all the goods/services against which the invalidity is directed), the Office will inform the applicant of this decision when it becomes final and will invite it to submit its observations on the closure of the invalidity proceedings. If the applicant demonstrates a sufficient legal interest in obtaining a declaratory invalidity decision, the proceedings will continue.

4.5 Contested international registrations designating the EU

Article 190(2) and Article 198 EUTMR

Cancellation proceedings can also be directed against international registrations (IRs) designating the European Union. The specific rules that are applicable in these cases (in particular in connection with the filing date and the relevant time limit for proof of use) can be found in the Guidelines, Part M, International Marks.

A cancellation application against an IR may be filed after the date of the publication of the IR designating the European Union in the Official Bulletin of the Office (M.3.1. - International registrations with or without amendments since their publication under Article 190(1) EUTMR).

As regards WIPO representatives of the holders of contested IRs, the Office will as a general rule communicate with them, irrespective of the IR holder's location, when they comply with the criteria of Article 120 EUTMR.

Where the WIPO representative of the IR holder does not comply with the criteria of Article 120 EUTMR, the notification of the cancellation application will be sent directly

to the IR holder, and a copy will be sent to its WIPO representative for information purposes.

The notification of the cancellation application will also invite the IR holder to appoint a professional representative in accordance with Article 120 EUTMR within two months of its receipt. In cases of obligatory representation (Article 119(2) EUTMR), the notification will indicate the consequences of not complying with this requirement (namely, that any communications sent by the IR holder in the course of the proceedings will not be taken into account).

4.6 Assignment

Article 21(1) and (2)(a) EUTMR
Article 20 EUTMDR

The cancellation applicant may request an assignment of the EUTM as an alternative to a declaration of invalidity if the conditions of Article 21(1) and (2)(a) EUTMR are fulfilled. In summary, the cancellation applicant will become the proprietor of the EUTM if the claim is successful. As the request is dealt with in the context of a procedure for a declaration of invalidity pursuant to Article 60(1)(b) EUTMR, the rules of such proceedings apply.

Assignment will apply only in the case of an application for invalidity based on Article 60(1)(b) EUTMR in conjunction with Article 8(3) EUTMR, namely where an EUTM is registered in the name of an unauthorised agent, without the proprietor's authorisation. For these cases, the applicant in the invalidity proceedings may request **either** the invalidity of the mark (pursuant to Article 60(1)(b) EUTMR), **or** the assignment of the EUTM in the applicant's favour (pursuant to Article 21 EUTMR and Article 20(1) EUTMDR).

If the contested EUTM survives the action in part, either because the action was directed against part of the goods and services only or was partly unsuccessful, the mark will be split. The part for the successful applicant will be given a new trade mark registration number with the new proprietor, its representative from the invalidity proceedings and the list of goods and services for which the claim was successful. All other particulars of the mark remain as in the original mark.

4.6.1 Admissibility of the request

When filing an application for invalidity based on Article 60(1)(b) EUTMR in conjunction with Article 8(3) EUTMR, in the application form the cancellation applicant must indicate the relief sought, which can be:

- i) a declaration of invalidity; **or**
- ii) assignment pursuant to Article 21(2)(a) EUTMR.

A request for assignment cannot be invoked cumulatively with a request for invalidating the EUTM under the same ground of Article 60(1)(b) EUTMR. If the cancellation applicant does so erroneously, the Office will invite the applicant to choose one type of relief or the other. The party will be informed that in the absence of a reply, the Office

will assume that the cancellation applicant wishes to rely on the relief of assignment (and not a declaration of invalidity).

4.6.2 Priority of examination of the request for assignment

If the applicant invokes Article 60(1)(b) EUTMR with relief seeking the assignment of the contested EUTM and Article 59(1)(a) EUTMR (registration contrary to the provisions of Article 7 EUTMR), the Office will first examine the absolute grounds for invalidity due to the public interest underlying that provision. If an absolute ground for invalidity applies, the Office cannot grant the assignment of the EUTM.

If the applicant invokes Article 60(1)(b) EUTMR with relief seeking the assignment of the contested EUTM and any other ground for invalidity (i.e. bad faith pursuant to Article 59(1)(b) EUTMR, or any other relative ground pursuant to Article 60(1)(a), (c), (d), or Article 60(2) EUTMR), the Office will first examine the request for assignment. The alternative relief stipulated in Article 21(2)(a) EUTMR would lose its useful effect if the Office had the discretion to invalidate the EUTM, contrary to the express intention of the applicant. In addition, while the winning applicant's legal situation would be substantially different if, instead of assignment, the EUTM were invalidated, the losing proprietor's legal situation would be the same whatever the outcome.

For more details on assignment in invalidity proceedings, see the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions.