

GUIDELINES FOR EXAMINATION
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)

PART E

REGISTER OPERATIONS

SECTION 3

EUTMs AND RCDs AS OBJECTS OF
PROPERTY

CHAPTER 1

TRANSFER

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1 Introduction

Article 1(2), Articles 19, 20, and 28, Article 111(1) and Article 111(3)(g) EUTMR
Articles 27, 28 and 34 CDR
Article 23, Article 69(1) and Article 69(3)(i) CDIR

A transfer is the change in ownership of the property rights in a European Union trade mark (EUTM) or an EUTM application from one entity to another. EUTMs and EUTM applications may be transferred from the current proprietor to a new proprietor, primarily by way of assignment or legal succession. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

The transfer may be limited to some of the goods or services for which the mark is registered or applied for (partial transfer). In contrast to a licence or conversion, a transfer of an EUTM cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for **some** territories or Member States.

Both registered Community designs (RCDs) and applications for an RCD may be the subject of a transfer.

The provisions in the CDR and CDIR dealing with the transfer of registered Community designs (RCDs) are almost identical to the equivalent provisions of the EUTMR, EUTMDR and EUTMIR, respectively. **Therefore, the following applies *mutatis mutandis* to RCDs. Exceptions and specifics for RCDs are detailed in paragraph 7 below.**

Upon request, transfers of EUTMs are entered in the EUTM Register.

According to Article 20 EUTMR, registering a transfer is not a condition for its validity. However, if a transfer is not registered by the Office, the successor may not invoke the rights arising from the EUTM. Additionally the new proprietor will not receive communications from the Office, in particular during *inter partes* proceedings or the notification of the renewal term of the mark. Furthermore, according to Article 19 EUTMR, in all aspects of the EUTM as an object of property that are not further defined by provisions of the EUTMR, the proprietor's address defines the applicable subsidiary national law. For all these reasons, it is important to register a transfer at the Office to ensure that entitlement to EUTMs and applications is clear.

1.1 Transfers

Article 20(1) and (2) EUTMR
Article 28 CDR

A transfer of an EUTM involves two aspects, namely the validity of the transfer between the parties and the impact of a transfer on proceedings before the Office, such impact being triggered only after the entry of the transfer in the EUTM Register (see paragraph 1.2 below).

As concerns the validity of the transfer between the parties, the EUTMR allows an EUTM to be transferred independently of any transfer of the undertaking to which it

belongs (judgment of 30/03/2006, C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 45 and 48).

1.1.1 Assignment

Article 20(3) EUTMR Article 28 CDR

When a transfer is made by an assignment, the former is only valid where the assignment is made in writing and is signed by both parties, except where the assignment is the result of a court decision, or decision made by the Office under Article 21 EUTMR. This formal requirement for the validity of the transfer of an EUTM is applicable irrespective of whether, under the national law governing transfers of (national) trade marks, an assignment is valid even without observing a particular form, such as the need for the transfer to be in writing and have the signatures of both parties.

1.1.2 Inheritance

When the proprietor of an EUTM dies, the heirs will become proprietors of the EUTM by way of individual or universal succession. This is also covered by the rules on transfers.

1.1.3 Merger

Similarly, a universal succession exists when there is a merger between two companies that leads to the formation of a new company or an acquisition by one company taking over another. Where the whole of the undertaking to which the mark belongs is transferred, there is a presumption that the transfer includes the EUTM unless, in accordance with the law governing the transfer, an agreement to the contrary was made or unless circumstances clearly dictate otherwise.

1.1.4 Applicable law

Article 19 EUTMR Article 27 CDR

Unless provided otherwise by the EUTMR, transfers are subject to the national law of a Member State determined by Article 19 EUTMR. The national law declared applicable in that provision is the national law in general and, therefore, also includes private international law, which in turn may refer to the law of another State.

1.2 Application to register a transfer

Article 20(5) to (8) EUTMR
Article 13 EUTMIR
Article 28 CDR
Article 23 CDIR

A transfer becomes relevant in proceedings before the Office if an application to register a transfer has been made and the transfer has been entered in the Register.

Article 20(7) EUTMR
Article 28(c) CDR

However, in the period between the date when the Office receives the application to register a transfer and the date of registering the transfer, the new proprietor may already make submissions to the Office with a view to observing time limits. If, for example, a party has applied to register the transfer of an EUTM application for which the Office has raised objections on absolute grounds, the new proprietor may reply to the objections (see paragraph 5 below).

In the course of the examination of an application for registration of a transfer, the Office will only examine whether sufficient evidence of the transfer has been submitted.

2 Transfers v Changes of Name

Article 55 EUTMR
Article 19 CDIR

A transfer must be distinguished from a change of name of the proprietor.

A change in the name of the proprietor is a change that does not affect the identity of the proprietor, whereas a transfer is a change in the identity of the proprietor.

In particular, no transfer is involved when a natural person changes their name due to marriage, or following an official procedure for changing a name, or when a pseudonym is used instead of the civil name, etc. In all these cases, the identity of the proprietor is not affected.

Where the name or the corporate status of a legal person changes, the criterion for distinguishing a transfer from a mere change of name is whether or not the identity of the legal person remains the same (in which case it will be registered as a change of name) (decision of 06/09/2010, R 1232/2010-4, Cartier, § 12-14). In other words, where there is no termination of the legal entity (e.g. in the event of a merger by acquisition, where one company is completely absorbed by the other and ceases to exist) and no start-up of a new legal entity (e.g. following the merger of two companies leading to the creation of a new legal entity), there is only a change in the formal corporate organisation that already existed, and not in the actual identity itself. Therefore, the change will be registered as a change of name, where necessary.

For example, if an EUTM is in the name of Company A and as the result of a **merger** this company is absorbed by Company B, there is a **transfer** of assets from Company A to Company B.

Likewise, during a **division** of Company A into two separate entities, one being the original Company A and the other being a new Company B, if the EUTM in the name of Company A becomes the property of Company B, there is a **transfer** of assets.

Normally, there is no transfer if the company registration number in the national register of companies remains the same.

Likewise, there is in principle the prima facie presumption that there is a transfer of assets if there is a change of country (see, however, decision of 24/10/2013, R 546/2012-1, LOVE et al.).

If the Office has any doubt about the applicable national law governing the legal person concerned, it may require appropriate information from the person applying to register the change of name.

Therefore, unless it is ruled to the contrary under the national law concerned, the change of company type, provided that it is not accompanied by a transfer of assets carried out by means of a merger or an acquisition, will be treated as a change of name and not as a transfer.

However, if the change of company type is the result of a merger, a division or a transfer of assets, depending on which company absorbs or is separated from the other or on which company transfers which assets to the other, this may be a case of transfer.

2.1 Erroneous application to register a change of name

Articles 55(1), (3) and (5) and 162(1) EUTMR Article 71 CDR Article 19(1), (5) and (7) CDIR

When an application is made to register a change of name, but the evidence shows that what is involved is actually a transfer for an EUTM, the Office informs the applicant accordingly and invites it to file an application for registration of a transfer. The communication sets a time limit. If the applicant agrees or does not submit evidence to the contrary and files the corresponding application to register a transfer, the transfer will be registered. If the applicant does not modify its request, that is to say if it insists on registering the change as a change of name, or if it does not respond, the application to register a change of name will be rejected. The party concerned may file an appeal against this decision.

A new application for the registration of the transfer may be filed at any time.

2.2 Erroneous application for the registration of a transfer

Article 20(5) and (7) EUTMR Article 23(1) and (5) CDIR

When an application is made to register a transfer, but what is involved is actually a change of name of an EUTM, the Office informs the applicant accordingly and invites it to give its consent to register the indications concerning the proprietor in the EUTM Register. That communication sets a time limit. If the applicant agrees, the change of name will be registered. If the applicant does not agree, that is to say, if it insists on registering the change as a transfer, or if it does not respond, the application for the registration of a transfer will be rejected.

3 Formal and Substantive Requirements for an Application for Registration of a Transfer

It is strongly recommended that the application for registration of a transfer for an EUTM be submitted electronically via the Office's website (e-recordals). Using e-recordals offers additional advantages, such as the automatic receipt of electronic confirmation of the request and the use of the manager feature to complete the form quickly, for as many EUTMs as required.

3.1 Languages

Article 146(6)(a) EUTMR Article 80(a) CDIR

The application for the registration of a transfer for an EUTM application shall be made in the first or second language of the EUTM application.

Article 146(6) EUTMR Article 80(c) CDIR
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The application for the registration of a transfer for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of a transfer is filed using the form provided by the Office pursuant to Article 65(1)(e) EUTMDR or Article 68 CDIR, according to Article 146(6) EUTMR and Article 80(c) CDIR, the form may be used in any of the official languages of the Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

When the application for the registration of the transfer relates to more than one EUTM application, the applicant must select a language for the transfer application that is common to all the EUTMs concerned. If there is no common language, separate applications for transfer must be filed.

When the application for the registration of the transfer relates to more than one EUTM registration, the applicant must select one of the five languages of the Office as a common language.

Article 24 EUTMIR
Article 81(2) CDIR

Any supporting documents may be filed in any official language of the Union. This applies to any document submitted as proof of the transfer such as a countersigned transfer document or a transfer certificate, a deed of assignment or an extract from a trade register or a declaration agreeing to register the successor in title as the new proprietor.

When the supporting documents are submitted in an official language of the Union that is not the language of the proceedings, the Office may require a translation into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be deemed not to have been submitted.

3.2 Application for registration of a transfer filed for more than one mark

Article 20(8) EUTMR
Article 23(6) CDIR

A single application for the registration of a transfer for two or more EUTMs may be submitted only if the respective registered proprietor and beneficiary/assignee are the same in each case.

Separate applications are necessary when the original proprietor and the new one are not strictly identical for each mark. This is the case, for example, where there is one successor in title for the first mark and there are multiple successors in title for another mark, even if the successor in title for the first mark is among the successors in title for the other mark. It is immaterial whether the representative is the same in each case.

When a single application is filed in such cases, the Office will issue a deficiency letter. The transfer applicant may overcome the objection either by limiting the application for the registration of the transfer to those EUTMs or EUTM applications for which there is but one and the same original proprietor and one and the same new proprietor, or by declaring its agreement that its application should be dealt with in two or more different proceedings. Otherwise, the application for registration of a transfer will be rejected in its entirety. The party concerned may file an appeal against this decision.

3.3 Parties to the proceedings

Article 20(4) and Article 20(6)(b) EUTMR Article 13(3) EUTMIR Article 28(a) CDR Article 23(4) CDIR

The application for registration of a **transfer** may be requested at the Office by:

- a) the EUTM proprietor(s), or
- b) the EUTM proprietor(s) jointly with the assignee(s), or
- c) the assignee(s), or
- d) a Court or Authority.

The formal conditions with which the application must comply depend on who submits the application.

3.4 Formal requirements

3.4.1 Indications concerning the EUTM and the new proprietor

Article 20(5) EUTMR Article 2(1)(b) and (e), and Article 13(1) EUTMIR Article 1(1)(b) and (e), and Article 23(1) and (2) CDIR

The application for registration of a transfer must contain the following information.

- a) The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the numbers must be indicated.
- b) The particulars of the new proprietor that have to be indicated are the name, address and nationality in the case of a physical person. In the case of a legal entity, it must indicate the official designation and must include the legal form of the entity, which may be abbreviated in a customary manner (for example, S.L., S.A, Ltd., PLC, etc.). The company's national identification number may also be specified if available. Both natural persons and legal entities must indicate the state in which they are domiciled or have their seat or an establishment. **The Office strongly recommends indicating the State of Incorporation for US companies, where applicable, in order to differentiate clearly between different owners in its database.** These particulars correspond to the indications required in respect of an applicant for a new EUTM application. However, where the Office has already attributed an ID number to the new proprietor, indicating that number together with the name of the new proprietor is sufficient.

The form made available by the Office also requests an indication of the original proprietor's name. This indication will facilitate both the Office's and the parties' handling of the file.

- c) If the new proprietor designates a representative, the representative's name and ID number allocated by the Office should be indicated. If the representative has not yet been assigned an ID number, the business address must be indicated.

For additional requirements in cases of a partial transfer, see paragraph 4 below.

3.4.2 Representation

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Professional Representation).

3.4.3 Signatures

Article 20(5), Article 20(6)(b), and Article 119(4) EUTMR
Article 13(2) EUTMIR
Article 23(1) and (4) CDIR

The requirements concerning the person entitled to file the application for registration of the transfer and the signature must be seen in conjunction with the requirement to submit proof of the transfer. The principle is that the signatures of the original proprietor and the new proprietor must appear together or separately on the application for registration of the transfer or in an accompanying document. In the case of co-ownership, and where the transfer concerns the ownership as a whole, all co-owners must sign or appoint a common representative.

When the original proprietor and the new proprietor both sign the application for registration of the transfer, this is sufficient and no additional proof of the transfer is necessary.

When the original proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration signed by the successor in title that it agrees to the registration of the transfer, this is sufficient and no additional proof is necessary.

When the new proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration signed by the original proprietor that it agrees to the registration of the successor in title as the new proprietor, this is also sufficient and no additional proof is necessary.

When the original proprietor's representative is also appointed as the new proprietor's representative, the representative may sign the application for registration of the transfer on behalf of both the original proprietor and the new one, and no additional proof is necessary. However, when the representative signing on behalf of both the original and the new proprietor is not the representative on file (i.e. in an application simultaneously appointing the representative and transferring the EUTM), the Office will contact the applicant for registration of the transfer to request evidence of the transfer (authorisation signed by the original proprietor, proof of transfer, confirmation of the transfer by the original owner or its representative on file).

3.5 Proof of transfer

Article 20(2) and (3) EUTMR
Article 13(1)(d) and Article 13(2) EUTMIR
Article 65(1)(e) EUTMDR
Article 28 CDR
Article 23(1)(d) and (4)(a) to (c) and Article 68(1)(c) CDIR

A transfer may be registered only when it is proven by documents duly establishing the transfer, such as a copy of the deed of transfer. However, as already highlighted above, filing a copy of the deed of transfer is not necessary:

- when the new proprietor or its representative submits the application for registration of the transfer on its own and when the application is accompanied by a written declaration signed by the original proprietor (or its representative) that it agrees to the registration of the transfer to the successor in title; or
- when the original proprietor or its representative submits the application for registration of the transfer on its own and when the application is accompanied by a written declaration signed by the new proprietor (or its representative) that it agrees to the registration of the transfer; or
- when the application for registration of the transfer is signed by both the original proprietor (or its representative) and by the new proprietor (or its representative); or
- when the application for registration of the transfer is accompanied by a completed transfer form or document signed by both the original proprietor (or its representative) and by the new proprietor (or its representative).

Parties to the proceedings may also use the forms established under the Trademark Law Treaty available on WIPO's website (<http://www.wipo.int/treaties/en/ip/tlt/forms.html>). These forms are the transfer document — a document conceived as constituting the transfer (assignment) itself — and the transfer certificate — a document in which the parties to a transfer declare that a transfer has taken place. Either of these documents, duly completed, constitutes sufficient proof of transfer.

However, other means of proof are not excluded. Therefore, the agreement (deed) itself or any other document proving the transfer may be submitted.

When the mark has been subject to multiple successive transfers and/or changes of the owner's name and these have not been previously registered in the register, it is sufficient to submit the chain of evidence showing the events leading to the relationship between the old proprietor and the new proprietor without the need to file separate individual applications for each change.

When the transfer of the mark is the consequence of the transfer of the whole of the undertaking of the original proprietor, and unless proof is provided as indicated above, the document showing the transfer or assignment of the whole undertaking must be submitted.

When the transfer is due to a merger or another universal succession, the original proprietor will not be available to sign the application for registration of transfer. In these cases, the application must be accompanied by supporting documents that prove the merger or universal succession, such as extracts from the trade register, etc.

When the transfer of the mark is a consequence of a right *in rem*, levies of execution or insolvency proceedings, the original proprietor will not be able to sign the application for registration of transfer. In these cases, the application must be accompanied by a final decision issued by a competent national authority transferring the ownership of the mark to the beneficiary.

Supporting documents need not be legalised, nor is it necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient.

If the Office has reason to doubt the accuracy or veracity of the document, it may require additional proof.

The Office will examine the documents only to the extent that they actually confirm what is indicated in the application, namely the identity of the marks concerned and the identity of the parties, and whether a transfer is involved. The Office does not consider or rule on contractual or legal questions arising under national law (judgment of 09/09/2011, T-83/09, Craic, EU:T:2011:450, § 27). If doubts arise, it is the national courts that deal with the legality of the transfer itself.

3.5.1 Translation of proof

Article 146(1) EUTMR Article 24 EUTMIR Article 80(a) and (c) and Article 81(2) CDIR

The evidence must be:

- a) in the language of the Office that has become the language of the proceedings for the registration of the transfer;
- b) in any official language of the European Union other than the language of the proceedings; in this case the Office may require a translation of the document into a language of the Office to be filed within a period specified by the Office.

Where the supporting documents are submitted in an official language of the Union that is not the language of the proceedings, the Office may require a translation into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be deemed not to have been submitted.

3.6 Procedure to remedy deficiencies

Article 20(7) and (12) EUTMR
Article 28 CDR
Article 23(5) CDIR

The Office will inform the applicant for registration of the transfer in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit fixed in that communication, the Office will reject the application for registration of the transfer. The party concerned may file an appeal against the decision.

4 Partial Transfers

Article 20(1) EUTMR
Article 14 EUTMIR

A partial transfer concerns only some of the goods and services in the EUTM, and it is only applicable to EUTMs (not to RCDs).

It involves the distribution of the original list of goods and services between the remaining EUTM and a new one. When partial transfers are involved, the Office uses particular terminology to identify the marks. At the beginning of the proceedings there is the 'original' mark. This is the mark for which a partial transfer has been applied for. After the registration of the transfer, there are two marks: one is a mark that now has fewer goods and services, and is called the 'remaining' mark, and one is a 'new' mark that has some of the goods and services from the original mark. The 'remaining' mark retains the EUTM number of the 'original' mark while the 'new' mark has a new EUTM number.

Transfer cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for **some** territories.

When there are doubts as to whether the transfer is partial or not, the Office will inform the applicant for registration of the transfer and invite it to make the necessary clarifications.

Partial transfers may also be involved when the application for registration of the transfer concerns more than one EUTM. The following rules apply for each EUTM included in the application.

4.1 Rules on the distribution of the lists of goods and services

Articles 33 and 49 EUTMR
Article 14(1) EUTMIR
Communication No 1/2016 of the President of the Office of 08/02/2016

In the application to register a partial transfer, the goods and services to which the partial transfer relates must be indicated (the list of goods and services for the 'new' registration). The goods and services must be distributed between the original EUTM

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

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

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

For further details concerning the scope of the list of goods and services, and for the Office’s practice regarding the interpretation of general indications of the Nice Classification class headings, please see the Guidelines, Part B, Examination, Section 3, Classification, and Communication No 1/2016 of the President of the Office of 08/02/2016 concerning the implementation of Article 28 EUTMR (now Article 33 EUTMR), and the Annex thereto.

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

4.2 Objections

Article 20(7) EUTMR

When the application for registration of a partial transfer does not comply with the rules explained above, the Office will invite the applicant to remedy the deficiency. If the deficiencies are not remedied, the Office will reject the application for registration of a partial transfer. The party concerned may file an appeal against this decision.

4.3 Creation of a new EUTM

Article 20(6)(c) EUTMR
Article 14(2) EUTMIR

A partial transfer leads to the creation of a new EUTM. For this new EUTM, the Office will establish a separate file, which will consist of a complete copy of the electronic file of the original EUTM, the application for registration of a transfer, and all the correspondence related to the application for registration of the partial transfer. The

new EUTM will be given a new file number. It will have the same filing date and, where applicable, priority date as the original EUTM.

As far as the original EUTM is concerned, the Office will include a copy of the application for registration of a transfer in its files, but will generally not include copies of the further correspondence relating to the transfer application.

5 Transfer During the Course of Other Proceedings and Fees Issues

Article 20(11) and (12) EUTMR Article 28(b) and (c) CDR
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Without prejudice to the right to act from the time when the application for registration of a transfer is received by the Office where time limits are involved, the new proprietor will automatically become party to any proceedings involving the mark in question from the time the transfer is registered.

The filing of an application for registration of a transfer has no effect on time limits already running or set by the Office, including time limits for the payment of fees. New time limits for payment will not be set. From the date of registration of the transfer, the new proprietor becomes liable to pay any fees due.

Therefore, during the period between filing the application for registration of a transfer and the Office's confirmation of its actual entry in the EUTM Register or in the file, it is important that the original proprietor and the new proprietor actively collaborate in communicating time limits and correspondence received during *inter partes* proceedings.

5.1 Specific issues of partial transfers

Article 20(10) EUTMR

In cases of partial transfers, the new EUTM will be at the same procedural stage as the original (remaining) EUTM. Any time limit still pending for the original EUTM will be deemed to be pending for both the remaining EUTM and the new one. After the registration of the transfer the Office will treat each EUTM separately and will decide on them separately.

When an EUTM is subject to the payment of fees and these fees have been paid by the original proprietor, the new proprietor will not be liable to pay any additional fees for the new EUTM. The relevant date is the entry date of the transfer in the EUTM Register; therefore, when the fee for the original EUTM is paid after filing an application for registration of a transfer but before the registration of the transfer itself, no additional fees are due.

Article 31(2) and Article 41(5) EUTMR
Annex I A(3) and (4), Annex I A(7) and (8) EUTMR

When the partial transfer involves an EUTM application and class fees have not yet been paid or have not been paid in full, the Office will proceed to register the transfer in the files of the remaining EUTM application and to create a new EUTM application as described above.

Where additional class fees have to be paid for an EUTM application, the examiner will deal with such cases after creating a new EUTM application, as described below.

When additional class fees were paid prior to registering the transfer but no additional class fees were due for the remaining EUTM application, no reimbursement will be made because the fees were paid correctly at the time of payment.

In all other cases, the examiner will treat the remaining EUTM application and the new one separately, but without requesting a further basic fee to be paid for the new EUTM application. Class fees for the remaining EUTM application and for the new one will be determined pursuant to the situation existing after the registration of the transfer. For example, when the original EUTM application had seven classes and after the transfer the remaining EUTM application has only one class while the new EUTM application has six, no additional class fees will be due for the remaining EUTM application, but the corresponding additional class fees must be paid for the new EUTM application. When some of the goods and services of a particular class are transferred and others are not, the fees for that class become payable for both the remaining EUTM application and the new one. When a time limit to pay additional class fees has already been set but not yet expired, it will be set aside by the Office to allow the determination to be made on the basis of the situation after the registration of the transfer.

Article 53(1), (3) to (5) and (7) to (8) EUTMR

When the application for registration of a partial transfer relates to an EUTM registration that is due for renewal, that is, within six months prior to the expiry of the original registration and up to six months after that expiry, the Office will proceed to register the transfer and deal with the renewal and renewal fees as described below.

When no renewal request has been filed and no fees have been paid prior to the registration of the transfer, the general rules including the rules relating to payment of fees are applicable both to the remaining EUTM registration and to the new one (separate requests, separate payment of fees, as necessary).

When a renewal request has been filed prior to the registration of the transfer, that request is also valid for the new EUTM. However, while the original proprietor remains a party to the renewal proceedings for the remaining EUTM, the new proprietor automatically becomes party to the renewal proceedings for the new registration.

In these situations, when a renewal request has been filed but the relevant fees have not been paid prior to the registration of the transfer, the fees to be paid are determined pursuant to the situation after the registration of the transfer. This means that both the proprietor of the remaining EUTM and the proprietor of the new EUTM must pay the basic renewal fee and any class fees.

When not only a renewal request has been filed prior to the registration of the transfer but also all the applicable renewal fees have been paid prior to this date, no additional renewal fees are due after the registration of the transfer. Furthermore, no reimbursement is made of any class fees already paid.

5.2 Transfer and *inter partes* proceedings

When an application for registration of a transfer is filed during *inter partes* proceedings, several different situations can arise. For earlier EUTMs on which the opposition/cancellation is based, the new proprietor can only become party to the proceedings (or file observations) once the application for registration of the transfer has reached the Office. The basic principle is that the new proprietor substitutes the original proprietor in the proceedings. The practice of the Office when dealing with transfers in oppositions is described in the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 6.5.

6 Entry in the Register, Notification and Publication

6.1 Publication and Entry in the Register

Article 20(4) and (9), Article 44, and Article 111(3)(g) EUTMR
Article 28(a) and Article 49 CDR
Article 23(7) and Article 70(3)(i) CDIR

The Office will enter the transfer in the EUTM Register and publish it in the EUTM Bulletin. The entry will be published once the EUTM application has been published pursuant to Article 44 EUTMR.

The entry in the EUTM Register will mention the following data:

- the registration date of the transfer,
- the new proprietor's name and address,
- the name and address of the new proprietor's representative, if any.

For partial transfers, the entry will also contain the following data:

- a reference to the number of the original registration and the number of the new registration,
- the list of goods and services remaining in the original registration, and
- the list of goods and services of the new registration.

6.2 Notification

The Office will notify the transfer applicant of the registration of the transfer.

When the application for registration of the transfer was filed by the assignee, the Office will also inform the EUTM proprietor of the registration of the transfer.

7 Transfers for Registered Community Designs

Article 1(3) and Articles 27, 28, 33 and 34 and Article 107(2)(f) CDR
Article 23 and Article 61(2) and Articles 68(1)(c) and 69(2)(i) CDIR
Annex Nos 16 and 17 CDFR

The legal provisions contained in the CDR, CDIR and CDFR in respect of transfers correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Therefore, both the legal principles and the procedure in respect of the registration of trade mark transfers apply *mutatis mutandis* to RCDs, except for the following specific procedures.

7.1 Rights of prior use for an RCD

Article 22(4) CDR

The right of prior use for an RCD cannot be transferred except where the third person, who owned the right before the filing or priority date of the application for an RCD, is a business, along with that part of the business in the course of which the act was done or the preparations were made.

7.2 Fees

Annex Nos 16 and 17 CDFR

The fee of EUR 200 for the registration of a transfer applies per design and not per multiple application. The same is true for the ceiling of EUR 1 000 if multiple applications for registration of transfers are submitted.

7.3 Substantive requirements

Article 28 CDR

The Office will not register the transfer where it is clear from the transfer documents that because of the transfer the RCD is likely to mislead the public concerning the nature, quality or geographical origin of the products for which it is registered unless the new proprietor agrees to limit the registration of the RCD to products for which it is not likely to be misleading.

8 Transfers for International Trade Marks

The Madrid System allows for the recording of 'change of ownership' of an international registration.

All applications for registration of a change in ownership should be submitted on form MM5:

- directly to the International Bureau by the recorded holder, or
- through the office of the recorded holder or through the office of a contracting party in respect of which the transfer is granted, or
- through the office of the new proprietor (transferee).

The request to record a transfer cannot be submitted directly to the International Bureau by the new proprietor. The Office's own application form should **not** be used.

Detailed information on changes in ownership can be found in paragraphs B.II.60.01-67.02 of the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol (www.wipo.int/madrid/en/guide/). See also the Guidelines, Part M, International marks.