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 56 and 57 EUTMR and in Rules 37 to 41 EUTMIR.

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 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 Rule 37 EUTMIR. The Office also notifies the EUTM proprietor of the application. If there are any deficiencies related to relative admissibility requirements, the Office will ask the cancellation applicant (the applicant) to remedy them within a specified time limit.

Once the admissibility check has been completed, the Office will make an entry in the Register of the pending cancellation proceedings for the contested EUTM (Article 87(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 57(6) EUTMR.

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

2.1 Persons entitled to file an application for cancellation

| Articles 41(1) and 56(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 51 and 52 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 show an individual 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 53 EUTMR) may only be filed by the persons mentioned in Article 41(1) EUTMR (in the case of applications based on Article 53(1) EUTMR) or by those entitled under the law of the Member State concerned to exercise the rights in question (in the case of applications based on Article 53(2) EUTMR).

Applications for revocation or invalidity based on Articles 73 or 74 EUTMR (in particular specific revocation and absolute grounds for collective marks) follow the same rules, with regard to entitlement, as applications for revocation or for invalidity based on absolute grounds (Article 66(3) EUTMR).

2.2 Written applications

| Article 56(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.
3 Payment of the Fee

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<td>Rule 39(1) EUTMIR</td>
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<td>Article 144b(3) EUTMR</td>
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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 (in practice usually one month). 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 144b(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 56(2) EUTMR is a rule of order in the context of cancellation proceedings and does not establish any consequence as regards the filing date of the application. Therefore, when the fee is paid before the expiry of the time limit specified by Rule 39(1) EUTMIR, the application is deemed to be 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 provision that foresees the refund of the cancellation fee is Rule 39(1) EUTMIR, applicable only in cases where the application is deemed not to have been filed as a result of a late payment.

4 Admissibility Check

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<td>Rule 37 and Rule 38(1) EUTMIR</td>
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Once the Office has established that the corresponding fee has been duly paid, it proceeds with an admissibility check of the application.
In contrast to opposition proceedings, there is no cooling-off period and no subsequent time limit for substantiation in cancellation proceedings. 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, in principle, 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, such as the following:

- 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 and should be rejected as inadmissible (decision of 22/10/2007, R 0284/2007-4, VISION).

- 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.

- There is a previous final decision by the Office or by a court in a Member State on a cancellation application or counterclaim relating to the same subject matter and cause of action, and involving the same parties that has been adjudicated on its own merits (Article 56(3) EUTMR). For more details on this admissibility deficiency, see the corresponding section in the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions, paragraph 5.

- 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 (Article 53(4) EUTMR). For more details on this admissibility deficiency, see the corresponding section in the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions, paragraph 4.5.2.

- 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 (Article 51 EUTMR).

- An application for cancellation filed without having used the official form, which is neither in the correct language as established in Article 119 EUTMR nor translated into that language within one month of the filing of the application for cancellation (Rule 38(1) EUTMIR).

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.
Relative admissibility deficiencies, on the other hand, 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 Rule 37 EUTMIR (which are described in detail in paragraph 4.1 below). In these cases, in accordance with Rule 39(3) EUTMIR, the Office will invite the applicant to remedy the deficiency within two months (see paragraph 4.2 below).

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 (Rule 39(4) EUTMIR) 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 58(2) EUTMR).

4.1 Relative admissibility requirements (Rule 37 EUTMIR)

The relative admissibility requirements laid down by Rule 37 EUTMIR are set out below.

4.1.1 Registration number of the contested EUTM and name and address of its owner (Rule 37(a)(i) and (ii) EUTMIR)

An application for cancellation must contain the EUTM registration number and the name and address of its proprietor (please note that this is different in opposition proceedings, where Rule 15(2)(a) EUTMIR only requires the opponent to identify the contested EUTM application and the name of the applicant, but not its address).

The Office will check that the proprietor’s name and address correspond to the EUTM identified by its registration number. In the event of discrepancies (or omission of one of these details), a deficiency letter will be sent to the applicant inviting it to remedy this deficiency (see the paragraphs on deficiencies below).

4.1.2 Extent of the application for cancellation (Rule 37(a)(iii) EUTMIR)

The applicant must indicate whether the request is filed against all the goods and services or against part of the goods and services in the contested registration. In the latter case, the applicant will have to clearly identify the specific goods and services in a list.

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).
Please note the difference from opposition proceedings where, for the purposes of admissibility, the extent of the opposition is only an optional indication (Rule 15(3)(a) EUTMIR).

4.1.3 Grounds of the application for cancellation and facts, evidence and arguments presented in support of those grounds (Rule 37(b) EUTMIR)

The EUTMR and EUTMIR clearly distinguish between an application for revocation and an application for a declaration of invalidity. Therefore, 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. If an applicant files a single application based on revocation and invalidity grounds, the Office will send a deficiency letter inviting the applicant to choose one or the other type of grounds and will inform the applicant that another cancellation application can be filed subject to the payment of an additional application fee. If the applicant does not indicate which type of grounds it wishes to choose within the time limit specified, the application will be rejected as inadmissible (Rule 39(3) EUTMIR).

An application for cancellation must contain an indication of the grounds on which it is based, that is to say the specific provisions of the EUTMR that justify the requested cancellation. The applicant may limit the grounds on which the application was initially based but may not enlarge the scope of the application by claiming any additional grounds during the course of the proceedings.

In addition, where an application for invalidity is based on relative grounds (Article 53 EUTMR), the application must contain particulars of the right or rights on which the application is based and, if necessary, particulars showing that the applicant is entitled to adduce the earlier right as grounds for invalidity (meaning all the indications contained in Rule 15(b), (d), (e), (f), (g) and (h) EUTMIR, which are applied by analogy).

According to Rule 37(b)(iv) EUTMIR, an application for cancellation must also contain an indication of the facts, evidence and arguments presented in support of the cancellation grounds. This means that the mere submission of an application form in which all the relevant boxes are ticked, but that does not include any explanation on the ground(s) in the relevant box or attach any observations or evidence, such as a certificate, will lead to an admissibility deficiency. The only exception is for applications for revocation based on non-use (Article 51(1)(a) EUTMR), in which the burden of proof is on the EUTM proprietor.

Finally, an important distinction should be drawn between admissibility and substantiation requirements. As already mentioned in the introduction to paragraph 4, even though in invalidity proceedings based on relative grounds there is no time limit for the substantiation of the earlier rights, and 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 together with the application, this does not mean that there is no distinction between admissibility and substantiation requirements. If, for instance, an applicant clearly identifies the earlier mark on which the application is based (Rule 37(b)(ii) EUTMIR) and indicates the evidence or submits some arguments in support of those grounds (Rule 37(b)(iv) EUTMIR), the application will be admissible. If the evidence or arguments provided are later found insufficient to substantiate the
earlier right (e.g. the certificate is not from an official source or not translated into the language of proceedings), the application will be rejected as unfounded (see, by analogy, Rule 20(1) EUTMR) and not as inadmissible (decisions of 12/07/2013, R 1306/2012-4, URB EUROPE, § 21; 12/07/2013, R 1310/2012-4, URB Bearings, § 21; 12/07/2013, R 1309/2012-4, URB, § 20, confirmed by judgment of 07/11/2014, T-506/13, URB, EU:T:2014:940).

However, the absence of a time limit for the substantiation of the earlier rights means that at any subsequent stage of the proceedings (before the closure of the adversarial part) the applicant can remedy, on its own motion, any deficiency as regards substantiation.

Examples to illustrate the difference between admissibility and substantiation, in particular as regards earlier rights:

1) An application for cancellation pursuant to Article 53(1) EUTMR does not contain a representation of the earlier right on which it is based, neither in the corresponding box in the form nor in the attached documentation. Since a representation of the mark (in colour if applicable) is one of the requirements for clearly identifying the earlier right (Rule 15(2)(e) EUTMR by analogy), there will be a relative admissibility deficiency in accordance with Rule 37(b)(ii) EUTMR, which the applicant will be invited to remedy (see paragraph 4.2 below).

2) An application for cancellation pursuant to Article 53(1)(a) in conjunction with Article 8(1)(b) EUTMR includes all the necessary particulars of the earlier national mark (e.g. all the relevant boxes of the corresponding page of the official form are correctly filled in), including the indications as to the entitlement of the applicant. However, the certificate attached to the application indicates that the owner is a different person. In this case the applicant has complied with both Rule 37(b)(ii) and (iv) EUTMR, that is to say it has given particulars of the earlier right and of its entitlement, and submitted evidence in support. Whether the evidence submitted is sufficient to substantiate its claims is not a matter of admissibility, but of substantiation. The applicant will not be invited to remedy the substantiation deficiency, but must do so on its own motion before the closure of the adversarial part of the proceedings (e.g. by submitting evidence that the transfer of the earlier national mark to the applicant had taken place before the filing of the cancellation application).

3) An application for cancellation pursuant to Article 53(1)(c) and (d) in conjunction with Article 8(4) and (4a) EUTMR includes all the necessary particulars about the earlier right and also contains evidence in support of the cancellation grounds, but the evidence is clearly insufficient (e.g. the applicant does not provide any indication regarding the applicable national law). Again, and for the same reasons as in the previous example, the application would be admissible but unsubstantiated, unless the applicant were to remedy the substantiation deficiency on its own motion before the closure of the adversarial part of the proceedings.

As regards substantiation requirements of earlier rights, see the section on proof of existence of earlier rights in the Guidelines, Part C, Opposition, Section 1, Procedural Matters and the section on invalidity proceedings based on relative grounds in the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions.
4.1.4 Identification of the applicant (Rule 37(c) EUTMR)

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. 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 92(2) EUTMR). 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 41(1) and 56(1) EUTMR (see above).

In contrast, in the cases 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, Rule 75 and Rule 94(7)(e) EUTMR will be applied (appointment of a common representative and fixing of costs).

4.2 Invitation to remedy deficiencies

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In accordance with Rule 39(3) EUTMR, if the Office finds that an application for cancellation does not comply with Rule 37 EUTMR, it will invite the applicant to remedy the deficiencies within a specific time limit. Please note that this only applies to deficiencies as regards admissibility requirements, and not to deficiencies as regards substantiation requirements, which the applicant must remedy on its own motion (see paragraph 4.1.3 above).

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).

As mentioned above in connection with the grounds of the application, in the context of Rule 39(3) EUTMR, 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, Rule 39(3) EUTMR is only applicable to the list of relative admissibility requirements contained in Rule 37 EUTMR. Deficiencies in relation to absolute admissibility requirements are not covered by Rule 39(3) EUTMR and cannot be remedied (i.e. they lead to the rejection of the application in question as inadmissible).
5 Notification of the Application to the EUTM Proprietor and Further Exchanges between the Parties

Article 57 EUTMR
Rule 40 EUTMIR

Rule 40(1) EUTMIR states that every application for cancellation that is deemed to have been filed must be notified to the proprietor of the contested EUTM and that when the Office has found the application admissible, it will invite the proprietor to file its observations within such time limit as it may specify.

Therefore, once the Office has verified that payment has been received (and thus the application is deemed to have been filed) and has carried out the admissibility check, it notifies the EUTM proprietor of the application for cancellation.

If no deficiencies are detected in the admissibility check, the notification of the application to the EUTM proprietor will also contain an invitation to file observations (and in the case of an application for revocation based on Article 51(1)(a) EUTMR, an invitation to submit proof of genuine use — see Rule 40(5) EUTMIR). In practice, the Office grants the EUTM proprietor three months for its first reply to the application.

If the admissibility check reveals that there are deficiencies to be remedied, the EUTM proprietor will still be notified of the application and will be informed of the deficiencies that the applicant has to remedy. However, in this case just the notification of the application is sent and the Office will not invite the EUTM proprietor to file observations (or, where applicable, proof of use) until the applicant has remedied the deficiencies.

According to the judgment of the Court of Justice of 18/10/2012 in case 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 EUTMIR constitutes a decision that may be appealed together with the final decision on the case as stated in Article 58(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 stated in Article 80 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).

According to Article 57(1) EUTMR, the Office may invite the parties to file observations as often as it considers this 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 directly proceed 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 (except for the first submission of the EUTM proprietor, see above).

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 (for the rules on the admissibility of a request for proof of use, see the Guidelines, Part C, Opposition, Section 6, Proof of Use), the Office will invite the applicant to submit the proof (Article 57(2) and (3) EUTMR and Rule 40(6) EUTMIR). In contrast to opposition proceedings (Rule 22(1) EUTMIR), in cancellation proceedings, the request can be filed by the EUTM proprietor together with its first reply to the application or in any of the subsequent rounds of observations.

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 (Rule 40(2) EUTMIR, applicable by analogy to both parties).

In cases of invalidity based on relative grounds, before the Office issues a decision, it will check whether any of the earlier rights invoked that were correctly substantiated by the applicant have become due for renewal afterwards. If so, and provided it could be relevant for the outcome of the proceedings, the Office will invite the applicant to prove the renewal of the earlier right. If the applicant does not submit the proof, the application will be rejected as non-substantiated to the extent it is based on the earlier right.

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.

### 6 Languages Used in Cancellation Proceedings

| Article 119(5), (6) and (7) EUTMR  
| Rules 38(1) and (3); 39(2) and (3); 96(1) and (2) EUTMIR |

The language of cancellation proceedings will in general be determined by the applicant in the cancellation application and has to comply with Article 119 EUTMR (i.e. it has to be one of the five languages of the Office and one of the two languages chosen by the EUTM proprietor when it applied for the contested trade mark). For
detailed rules on how to determine the language of proceedings, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.3.

The parties to cancellation proceedings may also agree on a different official language of the European Union as the language of the proceedings (Article 119(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. In this case, the applicant must file a translation of the application into the language chosen by both parties (where it was not already filed in that language) within one month of the date on which the agreement is communicated to the Office. Where the translation is not filed or filed late, and 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 (Rule 38(3) EUTMIR).

6.1 Translation of the application for cancellation

Article 119(6) EUTMR  
Rules 38(1) and (3) and 39(2) EUTMIR

If the application is filed in a language of the Office that is not one of the two languages of the contested EUTM, on its own motion the applicant has to file a translation into the correct language (either of the two languages of the contested EUTM, if they are both languages of the Office, or the second language of the contested EUTM, when the first is not a language of the Office) within one month of the filing date of the application for cancellation, failing which the application will be rejected as inadmissible (Article 119(6) EUTMR, Rules 38(1) and 39(2) EUTMIR).

Rule 39(3) EUTMIR, regarding the invitation to the applicant to remedy deficiencies, does not refer to Rule 38(1) EUTMIR and, therefore, in these cases the Office will not send a deficiency letter and will wait for one month after the filing date for the translation of the cancellation application to be submitted.

Where the applicant uses the official form for revocation or invalidity, and this form is in the wrong language, there may be exceptions concerning the translation of the application. Please see the different scenarios described in the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 2.3.

6.2 Translation of the evidence submitted by the applicant in support of the application

Rules 38(2) and 39(3) EUTMIR

According to Rule 38(2) EUTMIR, where the evidence in support of the application is not filed in the language of the revocation or invalidity proceedings, the applicant must file, on its own motion, a translation into that language within two months of the filing date of the evidence in support of the application. This applies to all the evidence submitted by the applicant in the course of the proceedings, 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 on its own motion.

If the applicant does not file a translation of evidence in support of the application that is required to evaluate the admissibility of the case (e.g. the particulars of the earlier right on which the application is based, or the indication of the facts, evidence and arguments in support of the grounds are not translated), the Office will invite the applicant to remedy the deficiency pursuant to Rule 39(3) EUTMIR (decision of 02/03/2007, R 0300/2006-4, ACTILON/AC TELION). If the deficiency is not remedied, the application for cancellation will be rejected as totally or partially inadmissible (Article 119(6) EUTMR, Rules 38(2) and 39(3) EUTMIR).

If the applicant does not provide translations for the other evidence, which would not affect the admissibility of the case, 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 Rule 38(2) EUTMIR will be deemed not to have been received by the Office and, therefore, will not be taken into account (Rule 98(2) EUTMIR) (decision of 05/03/2012, R 0826/2010-4, MANUFACTURE PRIM 1949 (fig.), § 25).

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

Rules 96(1) and 98(2) EUTMIR

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 (Rule 96(1) EUTMIR).

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 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 (Rule 98(2) EUTMIR).

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

Rules 96(2) and 98(2) EUTMIR

The documents submitted by the EUTM proprietor in the course of the proceedings (except for proof of use, see below) are subject to Rule 96(2) 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. 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 EUTM proprietor to submit translations of the evidence, failure to do so within the specified time limit will mean that the non-translated documents will not be taken into account (Rule 98(2) EUTMIR).

6.5 Translation of proof of use

Rule 22(6) EUTMIR

Although Rule 40(5) and (6) EUTMIR only expressly refer to Rule 22(2), (3) and (4) EUTMIR, it is considered that Rule 22(6) EUTMIR should also be applied by analogy in cancellation proceedings, since the underlying logic is the same, that is to say to request translation of evidence, which for proof of use tends to be quite lengthy, only to the extent to which it is considered necessary (decision of 11/03/2010, R 0167/2009-1, INA/INA (fig.), § 24-25). Consequently, Rule 22(6) EUTMIR applies as lex specialis, vis-à-vis the lex generalis contained in Rule 38(2) EUTMIR (evidence submitted by the applicant) and Rule 96(2) EUTMIR (evidence submitted by the EUTM proprietor), as regards proof of use submitted by either of the parties (judgment of 13/02/2015, T-287/13, HUSKY, EU:T:2015:99, § 55).

According to Rule 22(6) EUTMIR, where the evidence of use filed by one of the parties is not in the language of the proceedings, the Office may require the party that filed it to submit a translation of the evidence in that language within a time limit of two months. 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 EUTM proprietor to submit translations of the evidence, failure to do so within the specified time limit will mean that the non-translated documents will not be taken into account (except those that are considered to be self-explanatory). For further guidance on the application of Rule 22(6) EUTMIR, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters and Part C, Opposition, Section 6, Proof of Use.

7 Other Issues

7.1 Continuation of proceedings

Article 82 EUTMR

According to Article 82(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.

However, the reason why it is specifically mentioned in relation to cancellation proceedings is to highlight the difference with opposition proceedings. As regards opposition, Article 82(2) EUTMR establishes that continuation of proceedings is not
Proceedings applicable, inter alia, to the time limits laid down in Articles 41 and 42 EUTMR (period for filing notice of opposition, time limits given by the Office to file facts, evidence and arguments or observations). In cancellation proceedings, by contrast, 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 60(1) EUTMR to file an appeal).

7.2 Suspensions

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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). Rule 20(7) EUTMIR is applicable by analogy.

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 104(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 104(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 in this case continue the proceedings pending before it.

A request for suspension pursuant to Article 104(2) EUTMR should be supported by relevant evidence. Suspension requests are only considered relevant to the proceedings and might be granted under Article 104(2) EUTMR in cases where they refer to the contested EUTM and not where they refer to other EUTMs contested in parallel cancellation proceedings.

7.3 Surrenders and withdrawals

The Office’s practice on the surrender of EUTMs is described in the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration.

7.3.1 Surrenders covering all the contested goods and/or services

In principle, the consequences in cancellation proceedings of a total surrender of the contested EUTM (or of a partial surrender covering all 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 happens 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 the date on which the cancellation request was filed (in the case of revocation). Consequently, as a rule, and despite the surrender of the contested EUTM, the applicant is deemed still 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, TiMi KINDERJOGHURT, EU:C:2011:177, § 39 and decision of 22/10/2010, R 0463/2009-4, MAGENTA, § 25-27).

In practice, when there is a surrender of an EUTM that is subject to cancellation proceedings, the Office will suspend the registration of the surrender and, in parallel, the Cancellation Division will notify the cancellation applicant of the surrender, inviting it to submit observations within two months and to indicate whether it wishes to continue the proceedings or whether it agrees to the closure of the proceedings without a decision on the substance. This letter will also inform the applicant that, if it does not reply, the cancellation proceedings will be closed without a decision on the substance.

If the applicant replies and expressly agrees with the closure of the proceedings, the surrender will be recorded, the cancellation action will be deemed to have been withdrawn and the proceedings will be closed without a decision on the substance. The costs will be borne by the EUTM proprietor (Article 85(3) EUTMR).

If the applicant does not submit any observations on the closure of the cancellation proceedings, the Cancellation Division will send both parties a letter closing the proceedings and informing the applicant of its possible loss of rights for the purposes of Rule 54(2) EUTMIR. If the applicant does not explicitly apply for a decision on the matter within the time limit established in this rule, the surrender will be recorded in the Register.

If the applicant does request the continuation of the cancellation proceedings (either in reply to the Office’s invitation to submit observations or when applying for a decision under Rule 54(2) EUTMIR), the cancellation proceedings will continue until there is a final decision on the substance. In these cases, the costs will be borne by the losing party and not necessarily the party terminating proceedings as indicated in Article 85(3) EUTMR. 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 or declared invalid, if any.

7.3.2 Surrenders covering only a part of the contested goods and/or services

The EUTM proprietor may partially surrender its EUTM for part of the contested goods and/or services. In such cases the Office will notify the cancellation applicant and will invite it to indicate if it wishes to maintain its cancellation application. If the cancellation applicant does request the continuation of proceedings and maintains its application for cancellation, proceedings will continue despite the partial surrender of the EUTM in the Register. If the cancellation applicant does not wish to maintain its application for cancellation, the Office will close the proceedings and take a decision on costs indicating that each party will bear its own costs (Article 85(2) EUTMR).
7.3.3 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, close the proceedings and take a decision on costs, which will be borne by the applicant (Article 85(3) EUTMR), except in cases where the withdrawal immediately follows a surrender (see above).

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.

7.4 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 is 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 be automatically closed since they no longer have any object. The costs are at the discretion of the Office (Article 85(4) EUTMR), which will usually conclude that each party has to bear its own costs.

However, taking into account the different effects of a 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.

7.5 Contested international registrations designating the EU

| Article 152(2) and Article 158 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 152(1) of the 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 93 EUTMR.

Where the WIPO representative of the IR holder does not comply with the criteria of Article 93 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 93 EUTMR within three months of its receipt. In cases of obligatory representation (Article 92(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).