

***GUIDELINES FOR EXAMINATION IN THE
EUROPEAN UNION INTELLECTUAL
PROPERTY OFFICE ON EUROPEAN UNION
TRADE MARKS***

PART E

REGISTER OPERATIONS

SECTION 3

EUTMs AS OBJECTS OF PROPERTY

CHAPTER 1

TRANSFER

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1 Introduction

Articles 1(2), Article 17(1) and Article 24 EUTMR
Article 28 CDR
Article 23 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. 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.

The provisions in the CDR and CDIR dealing with the transfer of designs are almost identical to the equivalent provisions of the EUTMR and EUTMIR, respectively. Therefore, the following applies *mutatis mutandis* to Community designs, with the few exceptions and particularities laid down in paragraph 7 below.

Article 16, Article 17(5), (6) and (8), Article 24 and Article 87(1) to Article 87(3)(g) EUTMR
Rule 31(8) EUTMIR

Upon request, transfers of registered EUTMs are entered in the Register and transfers of EUTM applications are noted in the files.

The rules on registering transfers and on legal effects of transfers apply both to EUTMs and to EUTM applications. The major difference is that the regulations stipulate that when an EUTM application is transferred, the transfer will be recorded in the file of the application rather than in the Register. However, in practice, changes in the ownership of an EUTM application or EUTM are recorded in the same database. While these Guidelines generally make no distinction between the transfer of EUTMs and EUTM applications, special references will be included where the treatment of EUTM applications differs from that of EUTMs.

According to Article 17 EUTMR, registering a transfer is not a condition for its validity. However, if a transfer is not registered by the Office, the entitlement to act remains with the registered proprietor, meaning, *inter alia*, that 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 16 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 17(1) and (2) EUTMR

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 Register (or the files) (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 (see also judgment of 30/03/2006, C-259/04, ‘Elizabeth Emanuel’, paras 45 and 48).

1.1.1 Assignment

Article 17(3) EUTMR

When a transfer is made by an assignment, except where the assignment is the result of a court decision, the former is only valid where the assignment is made in writing and is signed by both parties. 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 or EUTM application dies, the heirs will become proprietors of the registration or application 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 16 EUTMR

Unless provided otherwise by the EUTMR, transfers are subject to the national law of a Member State determined by Article 16 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 record a transfer

Article 17(5) to (8) EUTMR
Rule 31 EUTMIR

A transfer becomes relevant in proceedings before the Office if an application to record a transfer has been made and the transfer has been entered in the Register or, for EUTM applications, recorded in the EUTM application file.

Article 17(7) EUTMR

However, in the period between the date when the Office receives the application to record 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).

This part of the Guidelines covers proceedings relating to the recordal of transfers. In the course of the examination of an application for recordal of a transfer, the Office will only examine whether sufficient evidence of the transfer has been submitted. The Office will not examine whether the transfer itself is valid.

2 Transfers v Changes of Name

Rule 26 EUTMIR and Article 48a EUTMR

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

An application for the change of name of a proprietor of an EUTM registration or application is dealt with in separate proceedings. More information on changes of name see Guidelines, Part B, Examination, Section 2, Formalities, paragraph 7.3.

Rule 26(1) EUTMIR

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) (see decision of 06/09/2010, R 1232/2010-4 – ‘Cartier’, paras 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 0546/2012-1 – ‘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.

On the other hand, 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 record a change of name

Article 133(1) EUTMR Rule 26(1), (5) and (7) EUTMIR and Article 48a EUTMR
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When an application is made to record a change of name, but the evidence shows that what is involved is actually a transfer for an EUTM or EUTM application, the Office informs the recordal applicant accordingly and invites it to file an application to record a transfer, which is free of charge. Such a transfer is, however, subject to the payment of a fee when related to the transfer of a Design (see paragraph 7 below). The communication sets a time limit, in general, of two months starting from the date of its notification. If the recordal applicant agrees or does not submit evidence to the contrary and files the corresponding application to record a transfer, the transfer will be recorded. If the recordal applicant does not modify its request, that is to say if it insists on recording the change as a change of name, or if it does not respond, the application to record a change of name will be rejected. The party concerned may file an appeal

against this decision. (See Decision 2009-1 of 16 June 2009 of the Presidium of the Boards of Appeal regarding Instructions to Parties in Proceedings before the Boards of Appeal).

A new application to record the transfer may be filed at any time.

2.2 Erroneous application to record a transfer

Rule 31(1) and (6) EUTMIR

When an application is made to record a transfer, but what is involved is actually a change of name for an EUTM or EUTM application, the Office informs the recordal applicant accordingly and invites it to give its consent to record the indications concerning the proprietor in the files kept by the Office or in the Register as a change of name. That communication sets a time limit, in general, of two months starting from the date of its notification. If the recordal applicant agrees, the change of name will be recorded. If the recordal applicant does not agree, that is to say, if it insists on recording the change as a transfer, or if it does not respond, the application to record a transfer will be rejected.

3 Formal and Substantive Requirements of an Application to Record a Transfer

The Office strongly recommends that the online Recordal application form be used when applying to record a transfer. The form is free of charge and can be downloaded from the Office's web site (<http://www.oami.europa.eu>).

Since the entry into force of Regulation No 1042/05, which amended the EUTMFR, there is no need to pay a fee to register a transfer.

3.1 Languages

The application for registration of a transfer must be filed:

Rule 95 and Rule 96(1) EUTMIR

- when it relates to an EUTM application, in the first or the second language indicated in the EUTM application;
- when it relates to a registered EUTM, in one of the languages of the Office.

When the application relates to more than one EUTM application, the recordal applicant must select a language for the 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 relates to at least one EUTM registration, the recordal applicant must select one of the five languages of the Office.

Rule 76(3) EUTMIR

When expressly required by the Office, authorisations may be filed in any official language of the Union.

Rule 96(2) EUTMIR

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 record the successor in title as the new proprietor.

Rule 98 EUTMIR

When the supporting documents are not submitted in either an official language of the Union or in the language of the proceedings, the Office may require a translation into the language of the proceedings or, at the choice of the recordal applicant, into any language of the Office. The Office will set a time limit of two months from the date of notification of the respective communication. 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 filed for more than one mark

Rule 31(7) EUTMIR

Provided that both the original proprietor and the new one are the same in each case, then the recordal applicant can file a single application to record a transfer for several EUTMs or EUTM applications. This has the advantages that the various references only have to be given once and that only one decision needs to be taken.

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 recordal applicant may overcome the objection either by limiting the application 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 will be rejected in its entirety. The party concerned may file an appeal against this decision.

3.3 Parties to the proceedings

Article 17(5) EUTMR
Rule 31(5) EUTMIR

The application to record a transfer may be filed by the original proprietor(s) (the EUTM owner(s) as appearing in the Register or the EUTM applicant(s) as appearing in the EUTM application file) or by the new proprietor(s) (the 'successor in title', that is to say, the person(s) who will appear as the proprietor(s) when the transfer is recorded).

The Office will usually communicate with the recordal applicant(s). In cases of doubt, the Office may require clarification from all the parties.

3.4 Formal requirements

Rule 1(1)(b), Rule 31(1) and (2), Rule 79 EUTMIR

An application to record a transfer must contain:

- the registration or application number of the EUTM registration or application;
- the new proprietor's particulars;
- where the new proprietor appoints a representative, the representative's name and business address;
- the signature(s) of the person(s) requesting the recordal;
- proof of the transfer as set out in paragraph 3.5 below.

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

3.4.1 Indication of the registration number

Rule 31(1)(a) EUTMIR

The registration number of the trade mark must be indicated.

3.4.2 Particulars of the new proprietor

Rules 1(1)(b) and 31(1)(b) EUTMIR

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, the recordal applicant 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.). 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.

3.4.3 Name and address of the representative

Rule 77 EUTMIR
Article 93(1) EUTMR
Rule 76(4) EUTMIR

Applications to record a transfer may be filed and signed by representatives on behalf of the EUTM proprietor or the new proprietor.

When the new proprietor appoints a representative, who signs the application, either the Office or, in the context of *inter partes* proceedings, the other party to the proceedings may request an authorisation. In this event, if the representative does not submit an authorisation, the proceedings will continue as if no representative had been appointed.

When the original proprietor's representative is also appointed as the new proprietor's representative, the representative may sign the application on behalf of both the original proprietor and the new one. The representative may also be called upon to file an authorisation signed by the new proprietor.

Articles 92(3) and 93(1) EUTMR

The foregoing applies not only to representatives within the meaning of Article 93 EUTMR (legal practitioners and professional representatives whose names are entered on the list maintained by the Office), but also to any employee acting on behalf of the employer or, under the conditions of Article 92(3) EUTMR, on behalf of a legal person (company) that has economic connections with the employer.

Rule 77 and Rule 83(1)(h) EUTMIR

A general authorisation in the form made available by the Office will be considered sufficient for granting authorisation to file and sign applications for registration of transfers.

An individual authorisation will be checked to see that it does not exclude the authority to apply for a registration of a transfer.

Article 92(2) EUTMR

When the recordal applicant is the new proprietor and that new proprietor does not have either its domicile or its principal place of business or a real and effective

industrial or commercial establishment in the European Economic Area, for the purposes of the procedure to register the transfer it must be represented by a person entitled to represent third parties before the Office (legal practitioner or professional representative whose name is entered on the list maintained by the Office). For details of who may represent, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

3.4.4 Signatures

Article 92(4) EUTMR
Rule 31(1)(d), Rule 31(5) and Rule 79 EUTMIR

The requirements concerning the person entitled to file the application 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 or proprietors and the new proprietor or proprietors must appear together or separately on the application or in an accompanying document. In the case of co-ownership, all co-owners must sign or appoint a common representative.

Rule 31(5)(a) EUTMIR

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

Rule 31(5)(b) EUTMIR

When the new proprietor is the recordal applicant and where the application is accompanied by a declaration signed by the original proprietor that it agrees to the recording 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 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 recordal applicant 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 17(2) and (3) EUTMR
Rules 31(1)(d) and (5)(a) to (c) and 83(1)(d) EUTMIR

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 to record 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 recordal of the transfer; or
- when the application to record the transfer is signed by both the original proprietor (or its representative) and by the new proprietor (or its representative); or
- when the application to record the transfer is accompanied by a completed transfer (recordal) 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 web site (<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 recorded 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 recordal 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. 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. The Office may abstain from requiring additional proof where the facts are already known to the Office, for example in parallel proceedings.

When the transfer of the mark is a consequence of a right *in rem*, levy of execution or insolvency proceedings, the original proprietor will not be able to sign the application. In

these cases, the application must be accompanied by a final court judgment 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 prove 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 (see judgment of 09/09/2011, T-83/09, 'Craic', para. 27). If doubts arise, it is the national courts that deal with the legality of the transfer itself.

3.6 Substantive requirements

Article 17(4) EUTMR

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

For more information on Office practice in relation to Article 7(1)(g) EUTMR, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal.

3.7 Procedure to remedy deficiencies

Article 17(7) EUTMR
Rules 31(6) and 67(1) EUTMIR

Where any of the deficiencies outlined above are noted, the Office will invite the recordal applicant to remedy the deficiency within a time limit of two months, starting from the date of the notification. The notification will be addressed to the person who filed the application to record the transfer or, where that person has appointed a representative, to the representative. The Office will not automatically inform the other party to the transfer, unless this is appropriate under the circumstances.

When the recordal applicant fails to remedy the deficiency or to submit the necessary additional proof, or where it is unable to convince the Office that the objections are not well founded, the Office will reject the application. The party concerned may file an appeal against this decision.

4 Partial Transfers

Article 17(1) EUTMR
Rule 32 EUTMIR

A partial transfer concerns only some of the goods and services in the EUTM or EUTM application. It involves the distribution of the original list of goods and services between the remaining EUTM registration or application 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 transfer recordal applicant and invite it to make the necessary clarifications.

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

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

Articles 28 and 43 EUTMR
Rule 32(1) EUTMIR

In the application to record 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 or EUTM application and a new EUTM or EUTM application so that the goods and services in the original EUTM or EUTM application 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 for 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 transfer application for the original EUTM or EUTM application. 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.

In accordance with Communication No 2/12 of the President of the Office of 20/06/2012, EUTMs filed prior to the 21/06/2012 claiming a particular class heading are considered to cover all the goods and services of the alphabetical list of that class in the edition of the Nice Classification in force at the time when the filing was made (see Communication No 2/12, paras V and VI).

When the application for a partial transfer indicates goods or services that are not expressly mentioned in the original list but fall under the literal meaning of a general indication contained therein, this will be acceptable provided that the list is not broadened. For the assessment of whether there is limitation or a broadening of scope of the list, the rules generally applicable in such situations apply (see the Guidelines, Part B, Examination, Section 3, Classification).

However, marks filed on or after 21/06/2012 claiming only the general indications of a particular class heading will be considered to cover the literal meaning of that class heading and may only be partially transferred accordingly (see Communication No 2/12 paras VII and VIII).

Marks filed after 21/06/2012 claiming the general indications of a particular class heading plus the alphabetical list will be considered to cover the literal meaning of that class heading plus the alphabetical list of goods and services concerned of that class in the edition of the Nice Classification in force at the time when the filing was made and may only be partially transferred accordingly (see Communication No 2/12 paras VII and VIII).

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

Rules 31(6) and 32(3) EUTMIR

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

When the exchange of communications leads to a list of goods and services for the remaining registration that is different from the list filed in the EUTM application, the Office will communicate not only with the new proprietor, if it is the party requesting the registration of the partial transfer, but also with the original proprietor, who remains the person who may dispose of the list of goods and services of the original registration. The Office will make any change to the original list of goods and services subject to the agreement of the original proprietor. If the agreement is not submitted within the time limit set by the Office, the application to record a transfer will be rejected. The party concerned may file an appeal against this decision.

4.3 Creation of a new EUTM application or registration

Article 88 EUTMR
Rule 32(4) EUTMIR

A partial transfer leads to the creation of a new EUTM application or registration. For this ensuing EUTM application or registration, the Office will establish a separate file, which will consist of a complete copy of the electronic file of the original EUTM application or registration, the application for registration of a transfer, and all the correspondence related to the transfer application. The ensuing EUTM application or registration will be given a new file number. It will have the same filing date and, where applicable, priority date as the original EUTM application or registration. If the partial transfer relates to an EUTM application, the ensuing EUTM application is subject to the provisions for inspection of files in Article 88 EUTMR.

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

5 Transfer During the Course of Other Proceedings and Fees Issues

Article 17(6) and (7) EUTMR

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 to record 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 to record a transfer and the Office's confirmation of its actual entry in the 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

Rule 32(5) EUTMIR

In cases of partial transfers, the ensuing EUTM or EUTM application will be at the same procedural stage as the original (remaining) EUTM or EUTM application. Any time limit still pending for the original EUTM or EUTM application will be deemed to be

pending for both the remaining EUTM or application and the new one. After the registration of the transfer the Office will treat each EUTM or EUTM application separately and will decide on them separately.

When an EUTM or EUTM application 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 or EUTM application. The relevant date is the entry date of the transfer in the register or in the files; therefore, when the fee for the original pending EUTM or EUTM application is paid after filing an application to record a transfer but before the recordal of the transfer itself, no additional fees are due.

Article 26(2) EUTMR
Rule 9(3) and (5) EUTMIR
Annex I A(3) and (4), Annex I A(7) and (8) EUTMFR

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 record 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 recording the transfer in the files and creating a new EUTM application, as described below.

When additional class fees were paid prior to recording 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 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 application had seven classes and after the transfer the remaining application has only one class while the new application has six, no additional class fees will be due for the remaining application, but the corresponding additional class fees must be paid for the new application. When some of the goods and services of a particular class are transferred and others are not, then the fees for that class become payable for both the remaining 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 47(1), (3) to (5) and (7) to (8) EUTMR

When the application to record 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 record 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 recording 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 to record a transfer is filed during *inter partes* proceedings, several different situations can arise. For earlier EUTM registrations or applications on which the opposition/cancellation is based, the new proprietor can only become party to the proceedings (or file observations) once the application to record 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 Entry in the Register

Article 17(5) and Article 87(3)(g) EUTMR Rule 31(8) EUTMIR

When the application to record a transfer fulfils all requirements, if it concerns a registered EUTM, the transfer will be entered in the Register, while if it concerns an EUTM application, the Office will record the transfer in the corresponding file.

The entry in the Register will contain 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 recordal applicant of the recordal of the transfer.

If the application for recordal of a transfer is related to at least one EUTM application, the notification will contain the appropriate reference to the relevant recording of the transfer in the files kept by the Office.

As regards notifying the other party, there is a distinction between total transfers and partial transfers.

Articles 17(5) and 87(6) EUTMR

In cases of a total transfer, the notification will be sent to the party who submitted the application to register the transfer, that is to say, to the recordal applicant.

There will be no information to the other party:

- when the original proprietor's representative is also the new proprietor's appointed representative (in such a case the representative will receive one communication on behalf of both parties); or
- when the original proprietor has ceased to exist (death, merger).

In all other cases, the other party will be informed of the outcome of the procedure, that is, the registration of the transfer. The other party will not receive information during the course of the proceedings unless serious doubts arise concerning the legality of the application to record the transfer or the transfer itself.

Rule 32(3) and (4) EUTMIR

In cases of a partial transfer, both the proprietor of the remaining EUTM and the proprietor of the new EUTM must receive notification, because necessarily two EUTM applications or registrations are concerned. Therefore, a separate notification will be sent to the new applicant for each EUTM application that has been transferred partially. In the case of a partial transfer of an EUTM registration, the Office will notify the new proprietor for each registration, containing, as appropriate, indications concerning the payment of renewal fees. A separate notification will be issued to the proprietor of the remaining EUTM registration.

Furthermore, where in the case of a partial transfer the list of goods and services that are to remain in the original EUTM application or registration needs to be clarified or amended, such clarification or amendment requires the agreement of the proprietor of the remaining EUTM application or registration (see paragraph 4.2 above).

6.3 Publication

Article 17(5), Article 87(3)(g) and Article 87a(3) EUTMR

For EUTM registrations, the Office publishes the entry in the Register of transfers in Part C of the European Union Trade Marks Bulletin.

Article 39 EUTMR
Rule 12 and Rule 31(8) EUTMIR

When the application to record a transfer relates to an EUTM application that has been published pursuant to Article 39 EUTMR and Rule 12 EUTMIR, the publication of the registration of the mark and the entry in the Register will mention the new proprietor from the outset. The publication of the registration will contain a reference to the earlier publication.

Article 39 EUTMR
Rule 12 EUTMIR

When the transfer relates to an EUTM application that has not been published, the publication pursuant to Article 39 EUTMR and Rule 12 EUTMIR will contain the name of the new proprietor without any indication that the application has been transferred. This also applies when the transfer of an unpublished EUTM application is a partial 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, 17 CDFR

The legal provisions contained in the CDR, CDIR and CDFR for transfers correspond to the respective provisions in the EUTMR, EUTMIR and EUTMFR.

Therefore, both the legal principles and the procedure for recording trade mark transfers apply *mutatis mutandis* to Community designs.

There are only a few exceptions and specificities, which are detailed below.

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 recording a transfer applies per design and not per multiple application. The same is true for the ceiling of EUR 1 000 if multiple requests are submitted.

Example 1: Out of a multiple application for 10 designs, 6 designs are transferred to the same successor in title. The fee is EUR 1 000, provided either that only one application to record these 6 transfers is filed or that several applications to record transfers are filed on the same day.

Example 2: Out of a multiple application for 10 designs, 5 designs are transferred to the same successor in title. The transfer refers also to another design not contained in that multiple application. The fee is EUR 1 000 provided that:

- only one application to record these 6 transfers is filed or several requests are filed on the same day, and
- the holder of the Community design and the successor in title is the same in all 6 cases.

8 Transfers for International Trade Marks

The Madrid System allows for the ‘change of ownership’ of an international registration. All applications to record a change in ownership should be submitted on form MM5 either directly to the International Bureau by the holder on record or to the national office of the holder on record or to the national office of the new proprietor (transferee). The application to record a transfer cannot be filed directly with the International Bureau by the new proprietor. EUIPO’s own Recordal application form should **not** be used.

Detailed information on changes in ownership can be found in paras B.II.60.01 to 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/).