

***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 2

LICENCES

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1 Introduction

Articles 22, 23 and 24 EUTMR
Articles 27, 32 and 33 CDR

Both registered EUTMs and EUTM applications may be the subject of licensing contracts (licences).

Both registered Community designs (RCDs) and applications for a registered Community design may be the subject of licences.

Paragraphs 1 to 4 below deal with trade mark licences concerning EUTMs and EUTM applications. The provisions in the CDR and CDIR dealing with design licences are almost identical to the equivalent provisions of the EUTMR and EUTMIR respectively. Therefore, the following applies *mutatis mutandis* to Community designs. Exceptions and specificities to Community designs are detailed in paragraph 5 below. Exceptions and specificities to international trade marks are laid down under paragraph 6 below.

1.1 Licence contracts

A trade mark licence is a contract by virtue of which the proprietor or applicant, (hereinafter referred to as the 'proprietor') of a trade mark (the licensor), whilst retaining his proprietorship, authorises a third person (the licensee) to use the trade mark in the course of trade, under the terms and conditions set out in the contract.

A licence refers to a situation where the rights of the licensee in the EUTM arise from a contractual relationship with the proprietor. The proprietor's consent to, or tolerance of, a third party using the trade mark does not amount to a licence.

1.2 Applicable law

Article 16 EUTMR

The EUTMR does not have the competence to establish unified and complete provisions applicable to licences for EUTMs or EUTM applications. Rather, Article 16 EUTMR refers to the law of a Member State, as far as the acquisition, validity and effects of the EUTM as an object of property are concerned. To this end, a licence for an EUTM is, in its entirety and for the whole territory of the Union, assimilated to a licence for a trade mark registered in the Member State in which the EUTM proprietor or applicant has its seat or its domicile. If the proprietor does not have a seat or domicile in a Member State, it will be dealt with as a licence for a trade mark registered in the Member State in which the proprietor has an establishment. If the proprietor does not have an establishment in a Member State, it will be dealt with as a licence for a trade mark registered in Spain.

This, however, applies only to the extent that Articles 17 to 24 EUTMR do not provide otherwise.

Article 16 EUTMR is limited to the effects of a licence as an object of property and does not extend to contract law. Article 16 EUTMR does not govern the applicable law or the

validity of a licensing contract, which means that the freedom of the contracting parties to submit the licensing contract to a given national law is not affected by the EUTMR.

1.3 Advantages of the registration of a licence

Articles 22(5), 23(1) and (2) and 50(3) EUTMR

It is not compulsory to request an entry in the Register when there is a licence agreement. Moreover, when a party to proceedings before the Office has to prove use of a European Union trade mark, if such use has been made by a licensee, it is not necessary for the licence to have been entered in the Register for that use to be deemed to be use with the proprietor's consent pursuant to Article 15(2) EUTMR. However, such a registration has particular advantages.

- a) In view of the provision of Article 23(1) EUTMR, vis-à-vis third parties who might have acquired, or have entered in the Register, rights in the trade mark which are incompatible with the registered licence, the licensee may avail itself of the rights conferred by this licence only:
- if the licence was entered in the EUTM Register, or
 - in the absence of registration of the licence, if the third party had acquired such rights after the date of any legal acts such as referred to in Articles 17, 19 and 22 EUTMR (such as a transfer, a right in rem or a previous licence) knowing of the existence of the licence.
- b) In the case where a licence for an EUTM is entered in the Register, the surrender or partial surrender of that mark by its proprietor will only be entered in the Register if the proprietor establishes that it has informed the licensee of its intention to surrender.

The holder of a licence which is registered has, therefore, the right to be informed in advance by the proprietor of the trade mark of its intention to surrender the trade mark.

- c) In the case where a licence for a European Union trade mark is entered in the Register, the Office will notify the licensee at least six months before the expiry of the registration that the registration is approaching expiry. The Office will also notify the licensee of any loss of rights and of the expiry of the registration, where applicable.
- d) Registering licences and their modification and/or cancellation is important for maintaining the veracity of the Register, particularly in the event of *inter partes* proceedings.

2 Registration of a Licence for an EUTM or EUTM application

Article 22(5) and Article 87(3) EUTMR
Rules 33 and 34 EUTMIR

Both EUTM applications and EUTMs may be the subject of the registration of a licence.

The application for registration of a licence must comply with the following conditions.

2.1 Form, requests for more than one licence

Rule 83(1)(e) and Rule 95(a) and (b) EUTMIR

It is strongly recommended that the request for registration of a licence for an EUTM be submitted on the Office's Recordal Application form. This form is available free of charge in the official languages of the Union. It can be downloaded from the EUIPO website.

Any language version of this form may be used, provided that it is completed in one of the languages referred to in paragraph 2.2 below. This concerns, in particular, the list of goods and services and/or the territory.

Rules 31(7) and 33(1) EUTMIR

A single request for the registration of a licence in respect of two or more registered EUTMs or EUTM applications may be made only if the respective registered proprietor and the licensee are the same and the contracts have the same conditions, limitations and terms in each case (see paragraph 2.5 below).

2.2 Languages

Rule 95(a) EUTMIR

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

Rule 95(b) EUTMIR

The application for the registration of a licence for a registered EUTM must be made in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

2.3 Fees

Rule 33(1) and (4) EUTMIR
Annex I A(26) EUTMR

The application for the registration of a licence is considered not to have been made until the fee is paid. The amount of this fee is EUR 200 for each EUTM for which the registration of a licence is requested.

However, where several registrations of licences have been requested in one single request and the respective registered proprietor and the licensee are the same and the contractual terms are the same in all cases, the fee is limited to a maximum of EUR 1 000.

The same maximum amount applies where several registrations of licences are applied for at the same time, provided that they could have been filed in one single request and where the respective registered proprietor and the licensee are the same in all cases. Furthermore, the contractual terms must be the same. For example, an exclusive licence and a non-exclusive licence cannot be filed in the same request, even if they are between the same parties.

Once the corresponding fee is paid, the fee will not be reimbursed if the application for registration of the licence is refused or withdrawn.

2.4 Applicants and mandatory content of the application

2.4.1 Applicants

Article 22(5) EUTMR

The registration of a licence may be requested at the Office by:

- a) the proprietor(s) of the EUTM, or
- b) the proprietor(s) of the EUTM jointly with the licensee(s), or
- c) the licensee(s).

The formal conditions with which the request must comply depend on who is making the request. It is recommended that the first or the second of these options be used, since these allow for a speedier and smoother treatment of the request for registration of the licence.

2.4.2 Mandatory indications concerning the licensed EUTM and the licensee

Rule 31 and Rule 33(1) EUTMIR

The request for registration of a licence must contain the following information:

Rule 31(1)(a) and Rule 33(1) EUTMIR

- a) the registration number of the EUTM concerned. If the request relates to several EUTMs, each of the numbers must be indicated.

Rules 1(1)(b) and 31(1)(b) and Rule 33(1) EUTMIR

- b) the licensee's name, address and nationality and the State in which it is domiciled or has its seat or an establishment.

Rule 1(1)(e) and Rules 31(2) and 33(1) EUTMIR

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

2.4.3 Requirements concerning the person who makes the request – Signature, proof of the licence, representation

Rule 79 and Rule 82(3) EUTMIR

The requirements concerning signature, proof of the licence and representation vary depending on the person who makes the request. Where the requirement of a signature is referred to, in electronic communications, the indication of the sender's name will be deemed to be equivalent to the signature.

2.4.3.1 Request made by the EUTM proprietor alone

Rule 1(1)(b) and Rule 33(1) EUTMIR

When a request is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

No proof of the licence is necessary.

The Office will not inform the licensee that the registration of the licence has been requested. It will, however, inform the licensee when the licence is recorded in the Register.

Where the licensee files a statement with the Office in which it opposes the registration of the licence, the Office will transmit the statement to the EUTM proprietor for information purposes only. The Office will not take any further action on the statement but will register the licence. Following the registration of the licence, any licensee who disagrees with the registration of the licence may use the procedure for requesting the cancellation or amendment of the licence (see paragraph 3 below).

The Office will not take into account whether or not the parties, although having agreed on a licence contract, have agreed to register it at the Office. Any dispute on whether or not and in what manner the licence will be registered is a matter that must be resolved among the parties concerned under the rules of the relevant national law (Article 16 EUTMR).

2.4.3.2 Request made jointly by the EUTM proprietor and the licensee

When the request is made jointly by the EUTM proprietor and its licensee, it must be signed both by the EUTM proprietor and the licensee. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the licence.

Where there is a formal deficiency regarding the signature of the licensee or regarding the representative, the request will still be accepted as long as it would have also been acceptable if it had been presented by the EUTM proprietor alone.

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or regarding its representative but where the request would have been acceptable if it had been presented by the licensee alone.

2.4.3.3 Request made by the licensee alone

The request may also be made by the licensee alone. In this case, it must be signed by the licensee.

In addition, proof of the licence must be submitted.

2.4.3.4 Proof of the licence

There is sufficient proof of the licence if the request for registration of the licence is accompanied by any of the following evidence.

- A declaration that the EUTM proprietor agrees to the registration of the licence, signed by the EUTM proprietor or its representative.

In accordance with Rule 31(5)(a) EUTMIR, it is also considered sufficient proof if the request for registration of the licence is signed by both parties. This case has already been dealt with in paragraph 2.4.3.2 above.

- The licence agreement, or an extract therefrom, indicating the parties and the EUTM being licensed and bearing their signatures.

It suffices if the licence agreement is filed. In many instances, the parties to the licence agreement will not wish to disclose all the details, which may contain confidential information on the licence royalties or other terms and conditions of the licence. In these cases, it suffices if only a part or an extract of the licence agreement is submitted, as long as it contains the identification of the persons who are parties to the licence agreement, the fact that the EUTM in question is

the subject of a licence and the signatures of both parties. All other elements may be omitted or blacked out.

- An uncertified statement of licence using the complete WIPO Model International Form for the Request for Recordal of a Licence (found in the annex to the Joint Recommendation concerning trade mark licences adopted by The Assembly of the Paris Union and the General Assembly of WIPO on 25/09-03/10/2000). The form must be signed by both the EUTM proprietor, or its representative, and the licensee, or its representative. It can be found at:

http://www.wipo.int/export/sites/www/about-ip/en/development_iplaw/pdf/pub835a.pdf.

It suffices if an uncertified statement of licence on the WIPO model form is filed.

Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original or photocopy does not need to be authenticated or legalised.

Rule 95 and Rule 96(2) EUTMIR

The evidence of the licence must be:

- a) in the language of the Office which has become the language of the proceedings for the registration of the licence, see paragraph 2.1 above;
- b) in any official language of the Union other than the language of the proceedings; in this case the Office may require a translation of the document into a language of the Office to be filed within a period specified by the Office.

Where the supporting documents are 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 party requesting the registration of the licence, into any language of the Office. The Office will fix a time limit of two months from the date of notification of that communication. If the translation is not submitted within that time limit, the document will not be taken into account and will be deemed not to have been submitted.

2.4.4 Representation

Articles 92(2) and 93(1) EUTMR

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

Where the recordal applicant has no domicile or principal place of business or a real and effective industrial or commercial establishment inside the European Economic Area and has made the request alone, failure to fulfil the requirement of representation will lead to the request not being processed. The recordal applicant will be notified in the form of an information letter and any fees paid will be refunded. The recordal applicant is then free to submit a new request.

2.5 Optional contents of the request

Rule 34 EUTMIR

Depending on the nature of the licence, the request for registration may contain the request to register the licence together with other indications, namely those referred to under paragraphs a) to e) below. These indications may be individual or in any combination, for one licence (e.g. an exclusive licence limited in time) or for several licences (e.g. one exclusive licence for A as regards Member State X and another for B as regards Member State Y). They are entered in the Register by the Office only if the request for registration of the licence itself clearly requests that they be registered. Without such an explicit request, the Office will not enter in the Register any indications contained in the licence agreement that are submitted, for example, as evidence of the licence.

However, if one or more of these indications are requested to be entered in the Register, the following details must be indicated.

Rule 34(1)(c) and Rule 34(2) EUTMIR

- a) Where registration of a licence limited to only some of the goods or services is requested, the goods or services for which the licence has been granted must be indicated.

Rule 34(1)(d) and Rule 34(2) EUTMIR

- b) Where the request is to register the licence as a territorially limited licence, the request must indicate the part of the Union for which the licence has been granted. A part of the Union may consist of one or several Member States or one or several administrative districts in a Member State.

Article 22(1) EUTMR Rule 34(1)(a) EUTMIR

- c) Where registration of an exclusive licence is sought, a statement to this effect must be made in the request for registration.

Rule 34(1)(e) EUTMIR

- d) Where the registration of a licence granted for a limited period of time is requested, the expiry date of the licence must be specified. In addition, the date of the commencement of the licence may be indicated.

Rule 34(1)(b) EUTMIR

- e) Where the licence is granted by a licensee whose licence is already entered in the Register of EUTMs, the request for registration may indicate that it is for a sub-licence. Sub-licences cannot be recorded without first recording the parent licence.

2.6 Examination of the request for registration

2.6.1 Fees

Rule 33(2) EUTMIR

Where the required fee has not been received, the Office will notify the recordal applicant that the request is deemed not to have been filed because the relevant fee has not been paid. However, a new request may be submitted at any time providing the correct fee is paid from the outset.

2.6.2 Examination of the mandatory formalities

Rule 33(3) EUTMIR

The Office will check whether the request for registration of the licence complies with the formal conditions mentioned in paragraph 2.4 above (indication of the EUTM number(s), the required information concerning the licensee, the representative of the licensee where applicable).

The validity of the licence agreement will not be examined.

Article 93(1) EUTMR Rules 33 and 77 EUTMIR

The Office will check whether the request for registration of the licence has been duly signed. Where the request is signed by the licensee's representative, an authorisation may be required by the Office or, in the context of *inter partes* proceedings, by the other party to those proceedings. In this event, if no authorisation is submitted, the proceedings will continue as if no representative had been appointed. Where the request for registration of the licence is signed by the proprietor's representative who has already been designated as the representative for the EUTM in question, the requirements relating to signature and authorisations are fulfilled.

Articles 92(2) and 93(1) EUTMR

The examination will include whether the recordal applicant (i.e. the EUTM proprietor or the licensee) is obliged to be represented before the Office (see paragraph 2.4.4 above).

Rule 33(3) EUTMIR

The Office will inform the recordal applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit fixed in that communication, which will normally be two months following the date of the notification, the Office will reject the request for registration of the licence. 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).

Where the request has been made jointly by the EUTM proprietor and the licensee, the Office will communicate with the EUTM proprietor and send a copy to the licensee.

Where the licensee has also made and signed the request, it will not be allowed to contest the existence or scope of the licence.

Where the request for registration of the licence is filed by the EUTM proprietor alone, the Office will not inform the licensee of the recordal request. The examination of proof of the licence will be done *ex officio*. The Office will disregard any statements or allegations of the licensee regarding the existence or scope of the licence or its registration; the licensee cannot oppose the registration of a licence.

Rule 33(3) EUTMIR

If the request is filed by the licensee on the basis of a copy of the licence contract, and where the Office has reasonable doubts as to the veracity of the documents, it will write to the licensee inviting it to remove those doubts. The licensee will then have the burden of proving that the licence exists, that is, it has to convince the Office of the veracity of the documents and their contents. In such a case, the Office may, within the scope of its *ex officio* power of examination (Article 76(1) EUTMR), invite the EUTM proprietor to submit observations. If the proprietor claims that the documents are falsified, this will be enough for the Office to reject the registration of a licence unless the licensee produces a final Court order from an EU Member State in its favour. Where the doubts cannot be removed, the registration of the licence will be refused. In such a case, the procedure always remains *ex parte* even though the EUTM proprietor is heard; it is not a party to the proceedings.

2.6.3 Examination of optional elements

Article 22a(3) EUTMR and Rule 34 EUTMIR

Where it is requested that the licence be registered as one of the following:

- an exclusive licence,
- a temporary licence,
- a territorially limited licence,
- a licence limited to certain goods or services, or
- a sub-licence,

the Office will examine whether the particulars mentioned in paragraph 2.4 above are indicated.

Rule 34(1) and (2) EUTMIR

As concerns the indication 'exclusive licence', the Office will only accept this term and will not accept any other wordings. If 'exclusive licence' is not expressly indicated, the Office will consider the licence to be non-exclusive.

Where the request for the registration indicates that it is for a licence limited to certain goods or services covered by the EUTM, the Office will check whether the goods and services are properly grouped and are actually covered by the EUTM.

Rule 34(1)(b) EUTMIR

As concerns a sub-licence, the Office will check whether it has been granted by a licensee whose licence is already entered in the Register. The Office will refuse the registration of a sub-licence when the main licence has not been entered in the Register. However, the Office will not check the validity of the request for the registration of a sub-licence as an exclusive licence when the main licence is not an exclusive licence nor will it examine whether the main licence contract excludes granting sub-licences.

It is up to the licensor to pay attention not to conclude and to register incompatible contracts and to cancel or modify records that are no longer valid. For example, if an exclusive licence has been registered without limitation as to the goods and the territory, and the registration of another exclusive licence is requested, the Office will register that second licence, even though both licences seem incompatible at first sight. It is to be assumed that the second licence contract is compatible with the first licence contract either from the very beginning (and the recordal is simply not precise as to the territory or the goods) or following a change in the contractual situation that was not communicated to the Register for European Union trade marks.

Parties are, however, encouraged to update all register information regularly and swiftly by means of the cancellation or modification of existing licences (see paragraph 3 below).

Article 22(1) EUTMR
Rule 33(3) and Rule 34 EUTMIR

If the particulars mentioned in paragraph 2.5 are missing, the Office will invite the recordal applicant for registration of the licence to submit the supplementary information. If the recordal applicant does not reply to that communication, the Office will not take into account the abovementioned indications and will register the licence without mentioning them. The recordal applicant will be notified of this by an appealable decision.

2.7 Registration procedure and publications

Rule 33(4) EUTMIR

As concerns EUTM applications, the licence will be mentioned in the files kept by the Office for the European Union trade mark application concerned.

Article 87(3) EUTMR
Rule 85(2) EUTMIR

When the mark is registered, the licence will be published in the European Union Trade Marks Bulletin and mentioned in the Register of European Union trade marks.

Article 87(6) EUTMR

The Office will notify both parties of the entry of the licence in the files kept by the Office. Where both parties have named a common representative, this representative will be notified.

Articles 22(5) and 87(3) EUTMR
Rule 85(2) EUTMIR

As concerns EUTMs, the Office will enter the licence in the Register of European Union trade marks and publish it in the European Union Trade Marks Bulletin.

Where applicable, the entry in the Register will mention that the licence is:

- an exclusive licence,
- a temporary licence,
- a territorially limited licence,
- a sub-licence, or
- a licence limited to certain goods or services covered by the EUTM.

Only these bare facts will be mentioned. The following details will not be published:

- the period of validity of a temporary licence,
- the territory covered by a territorially limited contract,
- the goods and services covered by a partial licence.

Access to this information may be obtained through inspection of files (see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files).

Licences are published in part C.4. of the European Union Trade Marks Bulletin.

Article 87(6) EUTMR

The Office will inform the recordal applicant of the registration of the licence. When the request for registration of the licence was filed by the licensee, the Office will also inform the EUTM proprietor of the registration.

3 Cancellation or Modification of a Licence for an EUTM or an EUTM application

Rule 35(1) EUTMIR

The registration of a licence will be cancelled or modified on the request of an interested party, that is, the applicant or proprietor of the EUTM or the registered licensee.

The Office will refuse the cancellation, transfer and/or modification of a licence or a sub-licence when the main licence has not been entered in the Register.

3.1 Competence, languages, presentation of the request

Article 133 EUTMR
Rule 35(3), (6) and (7) EUTMIR

Paragraphs 2.1 and 2.2 above are applicable.

It is strongly recommended that the request for cancellation of a licence be presented on the Recordal Application form. This form is available free of charge in the official languages of the Union. It can be downloaded from the EUIPO website. Parties to the proceedings may also use the WIPO Model International Form No 1, Request for Amendment/Cancellation of a License, which can be downloaded at http://www.wipo.int/export/sites/www/about-ip/en/development_iplaw/pdf/pub835a.pdf, or a form with a similar content and format.

3.2 Person making the request

Rule 35(1) EUTMIR

The request for the cancellation or modification of the registration of a licence may be filed by:

- a) the applicant or proprietor of the EUTM and the licensee jointly,
- b) the applicant or proprietor of the EUTM, or
- c) the registered licensee.

3.2.1 Cancellation of a licence

Rule 35(4) EUTMIR

In the case of a joint request filed by the EUTM applicant or proprietor and the licensee, or of a request filed by the licensee, no proof for the cancellation of the licence is required since this implies a statement from the licensee that it consents to the cancellation of the registration of the licence. When the request for cancellation is filed by the EUTM applicant or proprietor, alone, the request must be accompanied by evidence establishing that the registered licence no longer exists or by a declaration from the licensee to the effect that it consents to the cancellation.

Where the registered licensee makes the request for cancellation alone, the EUTM applicant or proprietor will not be informed of this request. Any observations filed by the proprietor will be forwarded to the licensee but will not preclude the cancellation of the licence. Paragraph 2.4.3.1 applies *mutatis mutandis*.

If the EUTM proprietor alleges fraud on the part of the licensee, it must provide a final Court order to this effect. In fact it is not up to the Office to carry out any investigation in that respect.

Where several licences have been requested simultaneously, it is possible to cancel one of these licences individually. In such a case a new entry number will be created in respect of the cancelled licence.

The entry in the Register of licences which are limited in time, that is, temporary licences, does not automatically expire and must instead be cancelled from the Register.

3.2.2 Modification of a licence

Rule 35(6) EUTMIR

In the case of a joint request from the EUTM applicant or proprietor and the licensee, no further proof for the amendment of the licence is required.

If the request is made by the EUTM applicant or proprietor, proof of the amendment of the licence is required only where the amendment for which entry in the Register is sought is of such a nature that it would diminish the rights of the registered licensee under the licence. This would be the case, for example, where the licensee's name were to change, where an exclusive licence were to become a non-exclusive licence, or where the licence were to become restricted regarding its territorial scope, the period of time for which it is granted, or the goods or services to which it applies.

If the request is made by the registered licensee, proof of the amendment of the licence is required only where the amendment for which entry in the Register is sought is of such a nature that it would extend the rights of the registered licensee under the licence. This would be the case, for example, where a non-exclusive licence were to become an exclusive licence, or where any registered restrictions of the licence as to its territorial scope, to the period of time for which it is granted, or to the goods or services to which it applies, were to be cancelled fully or in part.

If proof of the amendment of the licence is necessary, it is sufficient if any of the documents referred to above in paragraph 2.4.3.4 are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the licence contract and must relate to the registration of the amendment of the licence as requested.
- The Request for Amendment/Cancellation of a Licence must indicate how the licence has been amended.
- The copy or extract of the licence agreement must be of the licence as amended.

3.3 Contents of the request

Rules 26 and 35 EUTMIR

Paragraph 2.4 applies, save that the data concerning the licensee need not be indicated except in the case of a modification of the registered licensee's name.

Paragraph 2.5 applies if a modification of the scope of the licence is requested, for example, if a licence becomes a temporary licence or if the geographical scope of a licence is changed.

3.4 Fees

3.4.1 Cancellation of a licence

Rule 35(3) EUTMIR
Annex I A(27) EUTMR

The request for the cancellation of the registration of a licence is not deemed to have been filed until the required fee is paid, which amounts to EUR 200 for each EUTM for which the cancellation is requested. Where several cancellations are requested simultaneously or within the same request, and where the respective EUTM applicant or proprietor and the licensee are the same in each case, the fee is limited to a maximum of EUR 1 000.

Once the corresponding fee has been paid, the fee will not be reimbursed if the request is refused or withdrawn.

3.4.2 Modification of a licence

Rule 35(6) EUTMIR

The modification of the registration of a licence is not subject to a fee.

3.5 Examination of the request

3.5.1 Fees

Rule 35(3) EUTMIR

Where the required fee for the request for the cancellation of a licence has not been received, the Office will notify the recordal applicant that the request is deemed not to have been filed.

3.5.2 Examination by the Office

Rule 35(2) and (4) EUTMIR

As for the mandatory elements of the request, paragraph 2.6.2 applies *mutatis mutandis*, including in respect of proof of the licence, to the extent that such proof is required.

The Office will notify the recordal applicant of any deficiency, setting a time limit of two months. If the deficiencies are not remedied, the Office will refuse the request for cancellation or modification.

Article 87(6) EUTMR
Rule 35(6) EUTMIR

Paragraph 2.6.3 above applies to the extent that the modification of the licence would affect its nature or its limitation to a part of the goods and services covered by the EUTM/EUTM application.

The registration of the cancellation or modification of the licence will be communicated to the person who made the request; if the request was filed by the licensee, the EUTM applicant or proprietor will receive a copy of that communication.

3.6 Registration and publication

Article 87(3)(s) EUTMR
Rule 85(2) EUTMIR

In the case of a registered EUTM, the creation, cancellation or modification will be entered in the Register of European Union trade marks and published in the European Union Trade Marks Bulletin under C.4.

In the case of an EUTM application, the cancellation or modification of the licence will be mentioned in the files of the EUTM application concerned. When the registration of the EUTM is published, no publications will be made in respect of licences that have been cancelled, and in the case of the modification of the licence, the data as modified will be published under C.4.

4 Transfer of a Licence for an EUTM or EUTM application

4.1 Definition of the transfer of a licence

Article 22(5) EUTMR

A licence concerning an EUTM application or an EUTM may be transferred. The transfer of a licence is different from a sub-licence insofar as the former licensee loses all its rights under the licence, and will be replaced by a new licensee, whereas in the case of a transfer of sub-licence, the main licence remains in force. Likewise, the transfer of a licence is different to a change of name of the owner where no change of ownership is implied (see the Guidelines, Part E, Section 3, EUTMs as Objects of Property, Chapter 1, Transfer).

4.2 Applicable rules

Rule 33(1) EUTMIR

The procedure for the registration of a transfer of a licence follows the same rules as the registration of a licence set out in paragraphs 2 and 3 above.

Rule 33(1) and (4) EUTMIR
Annex I A(26)(b) EUTMR

The transfer of a licence is subject to the payment of a fee. Paragraph 2.3 above applies *mutatis mutandis*.

To the extent that a declaration or a signature of the EUTM applicant or EUTM proprietor is required in accordance with the rules, its place will be taken by a declaration or signature of the registered licensee (the former licensee).

5 Registration of Licences for Registered Community Designs

Articles 27, 32 and 33 and Article 51(4) CDR
Articles 24, 25 and 26 and Article 27(2) CDIR
Annex Nos 18 and 19 CDFR

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

Therefore, both the legal principles and the procedure for the registration, cancellation or amendment of trade mark licences apply *mutatis mutandis* to Community designs, save for the following exceptions and specificities.

5.1 Registered Community designs

There is no use requirement in the Community design law, so that the issue of whether use by a licensee is use with the consent of the right holder does not arise.

The CDR and CDIR require the indication of the products in which the design is intended to be incorporated or applied.

It is not possible to register a licence for a registered Community design for only part of the products it covers.

Any such limitations of the scope of the licence will be disregarded by the Office, and the licence will be registered as if the restriction were not present.

5.2 Multiple applications for registered Community designs

Article 37 CDR
Article 24(1) CDIR

An application for a registered Community design may be in the form of a multiple application containing several designs.

For the purposes of the legal effect of licences, as well as of the procedure for registering licences, the individual designs contained in a multiple application will be

dealt with as if they were separate applications, and the same continues to apply after registration of the designs contained in the multiple application.

In other words, each design contained in a multiple application may be licensed independently of the others.

The optional indications as to the kind of licence and the procedure for their examination referred to above in paragraphs 2.5 and 2.6.1 (with the exception of a licence limited to some products, which is not possible) apply to each of the individual designs contained in a multiple application separately and independently.

Annex Nos 18 and 19 CDFR

The fee of EUR 200 for the registration of a licence, the transfer of a licence or the cancellation of a licence 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 licensed, in favour of the same licensee. The fee is EUR 1 000 provided that one single request for registration of these 6 licences is submitted or several requests are submitted on the same day. The request may indicate that for three out of these six designs the licence is an exclusive licence, without affecting the fees to be paid.

Example 2: Out of a multiple application for 10 designs, 5 designs are licensed in favour of the same licensee. A licence is also granted for another design not contained in that multiple application. The fee is EUR 1 000 provided that

- one single request for registration of these 6 licences is submitted or several requests are submitted on the same day, and
- the holder of the Community design and the licensee are the same in all 6 cases.

6 Registration of Licences for International Trade Marks

The Madrid System allows for the recording of licences against an international registration. All requests for recording a licence should be submitted on form MM13 either directly to the International Bureau by the recorded holder or through the Office of the recorded holder or through the Office of a contracting party in respect of which the licence is granted or through the Office of the licensee. The request cannot be submitted directly to the International Bureau by the licensee. The Office's own Recordal Application form should not be used.

Detailed information on the recording of licences can be found in Sections B.II.93.01 to 99.04 of the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol (www.wipo.int/madrid/en/guide/). For further information on international trade marks, see the Guidelines, Part M.