

***GUIDELINES FOR EXAMINATION IN THE
EUROPEAN UNION INTELLECTUAL
PROPERTY OFFICE (TRADE MARKS AND
DESIGNS) ON EUROPEAN UNION TRADE
MARKS***

PART E

REGISTER OPERATIONS

SECTION 3

EUTMs AS OBJECTS OF PROPERTY

CHAPTER 4

LEVY OF EXECUTION

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1 Introduction

Article 20 EUTMR
Rules 33, 35 EUTMIR
Article 29 CDR

Both registered European Union trade marks (EUTMs) and European Union trade mark applications (EUTM applications) may be levied in execution.

Both registered Community designs (RCDs) and registered Community design applications may be levied in execution.

Paragraphs 1 to 3 of this chapter deal with levies of execution concerning EUTMs and EUTM applications. The provisions in the CDR and CDIR dealing with levy of execution concerning designs are almost identical to the equivalent provisions of the EUTMR and EUTMIR respectively. Therefore, the following applies *mutatis mutandis* to Community designs. Procedures specific to Community designs are detailed in paragraph 4 below. Procedures specific to international trade marks are detailed in paragraph 5 below.

A levy of execution is the act by which a court officer appropriates a debtor's property, following a judgment of possession obtained by a plaintiff from a court. In this way a creditor can recover its claim from all the property of the debtor, including from its trade mark rights.

1.1 Applicable Law

Article 16 EUTMR

The EUTMR does not establish unified and complete provisions applicable to the levy of execution for EUTMs or EUTM applications. Rather, Article 16 EUTMR refers to the law of a **Member State**, regarding the procedure for levy of execution. To this end, a levy of execution on a EUTM is, in its entirety and for the whole territory of the **Community**, assimilated to a levy of execution for a trade mark registered in the Member State in which the EUTM proprietor or applicant has its seat or its domicile, or, if this is not the case, to a levy of execution for a trade mark registered in the Member State in which the proprietor has an establishment, or if this is not the case, to a levy of execution for a trade mark registered in Spain (Member State in which the seat of the Office is situated).

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

1.2 Advantages of the registration of a levy of execution

Articles 20(2), 50(3), 23(3) EUTMR
Rule 36(2) EUTMIR

Registration of a levy of execution is not compulsory; however, such a registration has particular advantages:

- a) In view of the provision of Article 23(3) 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 levy of execution, the beneficiary may avail itself of the rights conferred by this levy of execution, if national law so permits, only:
 - if the levy of execution was entered in the Register of European Union trade marks, or
 - in the absence of registration of the levy of execution, if the third party had acquired its rights after the date of the adjudication of the levy of execution knowing of the existence of the levy of execution.
- b) In the event that a levy of execution against a European Union trade mark is entered in the Register, the surrender of that mark by its proprietor will only be entered in the Register if the proprietor establishes that it has informed the beneficiary of its intention to surrender.

The beneficiary of a levy of execution which is registered has, therefore, the right to be informed in advance by the trade mark's proprietor of its intention to surrender the trade mark.

- c) In the event where a levy of execution against a European Union trade mark is entered in the Register, the Office will notify the beneficiary at least six months before the expiry of the registration that the registration is approaching expiry. The Office will also notify the beneficiary of any loss of rights and of the expiry of the registration, where applicable.
- d) Recording a levy of execution is important for maintaining the veracity of the Register, particularly in the event of *inter partes* proceedings.

2 Requirements for a Request for the Registration of a Levy of Execution

Article 20(3) EUTMR
Rule 33, Rule 84(3)(i) EUTMIR

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

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

2.1 Application form and requests for more than one levy of execution

Rule 95(a) and (b) EUTMIR

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

Rules 31(7), 33(1) EUTMIR

A single request for the registration of a levy of execution for two or more registered EUTMs or EUTM applications may be submitted only if the respective registered proprietor and beneficiary are the same in each case.

2.2 Languages

Rule 95(a) EUTMIR

The application for the registration of a levy of execution against a EUTM application may be submitted in the first or second language of the EUTM application.

Rule 95(b) EUTMIR

The application for the registration of a levy of execution against a EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

2.3 Fees

Article 162(2)(c) and (d) EUTMR
Rule 33(1) and (4) EUTMIR
Annex I A (26) EUTMR

The application for the registration of a levy of execution is considered not to have been submitted until the fee is paid. The fee is EUR 200 for each European Union trade mark for which the registration of a levy of execution is requested.

However, where several registrations of levy of execution have been requested in a single request and the registered proprietor and the beneficiary 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 levy of execution are applied for at the same time, provided that they could have been filed in a single request and where the registered proprietor and the beneficiary are the same in all cases.

Once the corresponding fee is paid, the fee will not be reimbursed if the application for registration of the levy of execution is refused or withdrawn (file classified).

Where the recordal applicant (see paragraph 2.4.1 below) is a Court or an Authority, no fee is to be paid and administrative cooperation is applied.

2.4 Applicants and mandatory content of the application

2.4.1 Applicants

Article 20(3) EUTMR

The registration of a levy of execution may be requested by:

- a) the proprietor(s) of the EUTM,
- b) the beneficiary of the levy of execution,
- c) a Court or Authority.

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

2.4.2 Mandatory indications concerning the EUTM and the beneficiary

Rule 31, Rule 33(1) EUTMIR

The request for registration of a levy of execution must contain the following information.

Rule 31(1)(a), 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), 31(1)(b), Rule 33(1) EUTMIR

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

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

- c) If the beneficiary designates a representative, the representative's name and business address must be indicated; the indication of the address may be replaced by the indication of the ID number allocated by the Office.

2.4.3 Requirements concerning the person who submits the request – signature, proof of the levy of execution, representation

Rule 79, Rule 82(3) EUTMIR

The requirements concerning signature, proof of the levy of execution and representation vary depending on the person who submits the request. Where the requirement of a signature is referred to, pursuant to Rule 79 and Rule 82(3) EUTMIR, in electronic communications, the indication of the sender's name will be deemed equivalent to the signature.

2.4.3.1 Request submitted by the EUTM proprietor

Rule 1(1)(b), Rule 33(1) EUTMIR

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

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

Where the beneficiary files a statement with the Office in which it opposes the registration of the levy of execution, the Office will forward the statement to the CTM proprietor for information purposes only. The Office will not take any further action on such a statement. Following the registration of the levy of execution, any beneficiary who disagrees with the registration of the levy of execution may request the cancellation or modification of the registration of the levy of execution (see paragraph 3 below).

Any dispute on whether or not and in what manner the levy of execution should be registered is a matter that must be resolved between the parties concerned under the relevant national law (Article 16 EUTMR).

2.4.3.2 Request submitted by the beneficiary

The request may also be submitted by the beneficiary. In this case, it must be signed by the beneficiary.

In addition, proof of the levy of execution must be submitted.

2.4.3.3 Request submitted by a Court or Authority

The request may also be submitted by the Court or Authority issuing the judgment. In this case, it must be signed by the Court or Authority.

In addition, proof of the levy of execution must be submitted.

2.4.3.4 Proof of the levy of execution

There is sufficient proof of the levy of execution if the request for registration of the levy of execution is accompanied by the Court judgment.

In many instances, the parties to the levy of execution proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the levy of execution judgment is submitted, as long as it identifies the parties to the levy of execution proceedings, the EUTM that is subject to the levy of execution and that the judgment is final. All other elements may be omitted or blacked out.

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 unless the Office has reasonable doubts as to the veracity of the documents.

Rule 95(a) and (b), Rule 96(2) EUTMIR

The evidence of the levy of execution must be:

- a) in the language of the Office which has become the language of the proceedings for the registration of the levy of execution, see paragraph 2.2 above.
- b) in any official language of the European Union other than the language of the proceedings; in this case the Office may require a translation of the document into a language of the Office to be filed within a period specified by the Office.

Where the supporting documents are not submitted in either an official language of the European 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 levy of execution, in any language of the Office. The Office will set 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), 93(1) EUTMR

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

2.5 Examination of the request for registration

2.5.1 Fees

Rule 33(2) EUTMIR

Where the required fee has not been received, the Office will notify the recordal applicant (unless the recordal applicant is a Court or Authority, in which case no fee is required, see paragraph 2.3 above) 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.

2.5.2 Examination of the mandatory formalities

Rule 33(3) EUTMIR

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

The validity of the levy of execution judgment will not be examined.

Article 93(1) EUTMR Rules 33, 76, 77 EUTMIR

The Office will check whether the request for registration of the levy of execution has been duly signed. Where the request is signed by the beneficiary'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 levy of execution 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), 93(1) EUTMR

The examination will include whether the recordal applicant (i.e. the EUTM proprietor or the beneficiary) 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 set 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 levy of execution. 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 for registration of the levy of execution is submitted by the EUTM proprietor alone, the Office will not inform the beneficiary. The examination of evidence of the levy of execution will be done *ex officio*. The Office will disregard any statements or allegations of the beneficiary regarding the existence or scope of the levy of execution or its registration; the beneficiary cannot oppose the registration of a levy of execution.

2.6 Registration procedure and publications

Rules 33(4), 84(5) EUTMIR

The levy of execution for EUTM application will be mentioned in the files kept by the Office for the European Union trade mark application concerned.

The Office will notify the recordal applicant of the entry of the levy of execution in the files kept by the Office. Where applicable, the EUTM applicant will also be notified.

Rule 84(3)(i), Rule 85(2) EUTMIR

When the mark is registered, the levy of execution will be published in the European Union Trade Marks Bulletin and entered in the Register of European Union trade marks. The Office will inform the recordal applicant of the registration of the levy of execution. Where applicable, the EUTM proprietor will also be informed.

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

Levies of execution are published in Part C.7. of the Bulletin.

3 Procedure for the Cancellation or Modification of the Registration of a Levy of Execution

Rule 35(1) EUTMIR

The registration of a levy of execution will be cancelled or modified at the request of an interested party, that is, the applicant or proprietor of the EUTM or the registered beneficiary.

3.1 Competence, languages, submission of the request

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

Paragraphs 2.1 and 2.2 above apply.

There is no Office form for registering the cancellation or modification of a levy of execution.

3.2 Person submitting the request

Rule 35(1) EUTMIR

The request for the cancellation or modification of the registration of a levy of execution may be submitted by:

- a) the EUTM applicant/proprietor and the beneficiary jointly,
- b) the EUTM applicant/proprietor, or
- c) the registered beneficiary.

3.2.1 Cancellation of the registration of a levy of execution

Rule 35(4) EUTMIR

The request for cancellation of the registration of a levy of execution must be accompanied by evidence establishing that the registered levy of execution no longer exists. This proof comprises the final Court judgment.

Where the registered beneficiary alone submits the request for cancellation, the EUTM applicant/proprietor will not be informed of this request. Any observations filed by the proprietor will be forwarded to the beneficiary but will not preclude the cancellation of the registration of the levy of execution. Paragraph 2.4.3.1 above applies *mutatis mutandis*.

Where the registration of several levies of execution has been requested simultaneously, it is possible to cancel one of these registrations individually. In such an event, a new recordal number will be created for the cancelled levy of execution.

3.2.2 Modification of the registration of a levy of execution

Rule 35(6) EUTMIR

A levy of execution may be modified upon submission of the corresponding Court judgment showing such a modification.

3.3 Contents of the request

Rule 35 EUTMIR

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

3.4 Fees

3.4.1 Cancellation of the registration of a levy of execution

Article 162(2) EUTMR
Rule 35(3) EUTMIR
Annex I A (27) EUTMR

The request for the cancellation of the registration of a levy of execution is not deemed to have been filed until the required fee of EUR 200 per cancellation is paid (unless the recordal applicant is a Court or Authority, in which case no fee is required, see paragraph 2.3 above). Where several cancellations are requested simultaneously or within the same request, and where the EUTM applicant/proprietor and the beneficiary 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 the registration of a levy of execution

Rule 35(6) EUTMIR

The modification of the registration of a levy of execution 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 the registration of a levy of execution 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), (4) EUTMIR

Paragraph 2.5.2 applies *mutatis mutandis* to the mandatory elements of the request, even for proof of the levy of execution, 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 registering the cancellation or modification.

Rules 35(6), 84(5) EUTMIR

The registration of the cancellation or modification of the levy of execution will be communicated to the person who submitted the request; if the request was submitted by the beneficiary, the EUTM applicant/EUTM proprietor will receive a copy of the communication.

3.6 Registration and publication

Rule 84(3)(s), Rule 85(2) EUTMIR

In the case of a registered EUTM, the creation, cancellation or modification of a registration of a levy of execution will be entered in the Register of European Union trade marks and published in the European Union Trade Marks Bulletin under C.7.

In the case of a EUTM application, the cancellation or modification of the levy of execution will be mentioned in the files of the EUTM application concerned. When the registration of the EUTM is published, no publications will be made for levies of execution that have been cancelled, and if a levy of execution has been modified, the data as modified will be published under C.7.2.

4 Levy of Execution for Registered Community Designs

Articles 27, 30, 33, Article 51(4) CDR
Articles 24, 26, Article 27(2) CDIR
Annex (18) and (19) CDFR

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

Therefore, both the legal principles and the procedure in respect of the registration, cancellation or modification of trade mark levies of execution apply *mutatis mutandis* to Community designs, except for the following specific procedures.

4.1 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, applying for several designs.

For the purposes of the legal effect of a levy of execution, as well as of the procedure for registering a levy of execution, 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 levied independently of the others.

Annex (18), (19) CDFR

The fee of EUR 200 for the registration of a levy of execution or the cancellation of a levy of execution 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 levied, in favour of the same beneficiary. The fee is EUR 1 000 provided that either a single request for registration of these 6 levies of execution is submitted or several requests are submitted on the same day.

Example 2

Out of a multiple application for 10 designs, 5 designs are levied, in favour of the same beneficiary. The registration of a levy of execution is also requested for another design not contained in that multiple application. The fee is EUR 1 000 provided that

- either a single request for registration of these 6 levies of execution is submitted, or several requests are submitted on the same day, and
- the holder of the Community design and the beneficiary are the same in all 6 cases.

5 Levy of Execution for International Trade Marks

The Madrid System allows for the recording of a levy of execution against an international registration (see Rule 20 Common Regulations [under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement](#)). For the convenience of the users, the [MM19](#) form is available for requesting that a restriction of the holder's right of disposal be entered in the International Register. The use of this form is strongly recommended to avoid

irregularities. Requests should be submitted either directly to the International Bureau by the holder or to the national IP Office of the recorded holder or to the Office of a contracting party to whom the levy of execution is granted or to the Office of the beneficiary. The request cannot be submitted directly to the International Bureau by the beneficiary. EUIPO's own Recordal Application form must not be used.

Detailed information on the recording of levies of execution can be found in Part B, Chapter II, paragraphs 92.01 to 92.04 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, International Marks.