

***GUIDELINES FOR EXAMINATION IN THE  
OFFICE FOR HARMONIZATION IN THE  
INTERNAL MARKET (TRADE MARKS AND  
DESIGNS) ON COMMUNITY TRADE MARKS***

***PART D***

***CANCELLATION***

***SECTION 1***

***PROCEEDINGS***

## Table of Contents

<b>1</b>	<b>Introduction: General Outline of Cancellation Proceedings.....</b>	<b><u>34</u></b>
<b>2</b>	<b>Application for Cancellation .....</b>	<b>4</b>
2.1	Persons entitled to file an application for cancellation .....	4
2.2	Written application .....	<u>45</u>
<b>3</b>	<b>Payment of the Fee.....</b>	<b>5</b>
<b>4</b>	<b>Admissibility Check.....</b>	<b><u>56</u></b>
4.1	Relative admissibility requirements (Rule 37 CTMIR).....	<u>78</u>
4.1.1	Registration number of the contested CTM and name and address of its owner (Rule 37(a)(i) and (ii) CTMIR) .....	<u>78</u>
4.1.2	Extent of the application for cancellation (Rule 37(a)(iii) CTMIR) .....	<u>78</u>
4.1.3	Grounds of the application for cancellation and facts, evidence and arguments presented in support of those grounds (Rule 37(b) CTMIR).....	<u>78</u>
4.1.4	Identification of the applicant (Rule 37(c) CTMIR) .....	<u>940</u>
4.2	Invitation to remedy deficiencies .....	<u>940</u>
<b>5</b>	<b>Notification of the Application to the CTM Proprietor and Further Exchanges between the Parties .....</b>	<b><u>1044</u></b>
<b>6</b>	<b>Languages Used in Cancellation Proceedings .....</b>	<b><u>1243</u></b>
6.1	Translation of the application for cancellation.....	<u>1243</u>
6.2	Translation of the evidence submitted by the applicant in support of the application.....	<u>1344</u>
6.3	Translation of observations submitted by the parties in the course of the proceedings.....	<u>1344</u>
6.4	Translation of evidence submitted by the CTM proprietor in the course of the proceedings.....	<u>1445</u>
6.5	Translation of proof of use .....	<u>1445</u>
<b>7</b>	<b>Other Issues.....</b>	<b><u>1546</u></b>
7.1	Continuation of proceedings .....	<u>1546</u>
7.2	Suspensions .....	<u>1546</u>
7.3	Surrenders and withdrawals.....	<u>1647</u>
7.3.1	Surrenders covering all the contested goods and/or services .....	<u>1647</u>
7.3.2	Surrenders covering only a part of the contested goods and/or services.....	<u>1748</u>
7.3.3	Withdrawals .....	<u>1748</u>
7.4	Applications for revocation and for invalidity against the same CTM .....	<u>1748</u>
7.5	Contested international registrations designating the EU .....	<u>1849</u>

## 1 Introduction: General Outline of Cancellation Proceedings

Proceedings in the Office concerning the revocation or invalidity of a registered Community trade mark ('CTM') are grouped under the general heading of 'cancellation proceedings' and are managed in the first instance by the Cancellation Division. The basic rules regarding these proceedings are mainly contained in Articles 56 and 57 CTMR and in Rules 37 to 41 CTMIR.

Cancellation proceedings are initiated with the submission of an application for revocation or for a declaration of invalidity (the 'application for cancellation') against a registered CTM. An application for cancellation against a CTMA which has not yet been registered is not admissible.

Once the application for cancellation is received, the Office checks that the corresponding cancellation fee has been paid. (If the fee has not been paid, the application is deemed not to have been filed). Next, the Office carries out a preliminary assessment of the admissibility requirements, which includes, in particular, those stated under Rule 37 CTMIR. The Office also notifies the CTM proprietor of the application. If there are any deficiencies related to relative admissibility requirements, the Office will ask the applicant to remedy them within a specified time limit.

Once the admissibility check has been completed, the Office will make an entry in the Register of the pending cancellation proceedings for the contested CTM (Rule 84(3)(n) CTMIR). This is to inform third parties about them. In parallel, the adversarial part of the proceedings is opened and the parties are invited to file observations (and, if applicable, proof of use).

There are usually two rounds of observations, after which the adversarial part is closed and the file is ready for a decision. Once the decision becomes final (i.e. if no appeal has been filed within the prescribed time limit or when the appeal proceedings are closed), the Office will make the corresponding entry in the Register, in accordance with Article 57(6) CTMR.

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

## 2 Application for Cancellation

### 2.1 Persons entitled to file an application for cancellation

Articles 41(1) and 56(1) CTMR

Cancellation proceedings can never be initiated *ex officio* by the Office but only upon receipt of an application from a third party.

Applications for revocation or for invalidity based on absolute grounds (Articles 51 and 52 CTMR) may be filed by:

1. any natural or legal person, or
2. any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers or services, traders or consumers, which under the terms of the law governing it has the capacity in its own name to sue and be sued.

As regards applications for revocation or for invalidity based on absolute grounds, the applicant does not need to show an individual interest in bringing proceedings (see judgment of 08/07/2008, T-160/07, 'COLOR EDITION', paras 22-26, confirmed by judgment of 25/02/2010, C-408/08 P, 'COLOR EDITION', paras 37-40). This is because, while relative grounds for ~~refusal~~invalidity protect the interests of proprietors of certain earlier rights, the absolute grounds for refusal and for revocation aim to protect the general interest (including, in the case of revocations based on lack of use, the general interest in revoking the registration of trade marks which do not satisfy the use requirement).

In contrast, applications for invalidity based on relative grounds (Article 53 CTMR) may only be filed by the persons mentioned in Article 41(1) CTMR (in the case of applications based on Article 53(1) CTMR) or by those entitled under the law of the Member State concerned to exercise the rights in question (in the case of applications based on Article 53(2) CTMR).

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

### 2.2 Written application

Article 56(2) CTMR

An application for cancellation has to be filed in writing. It is not obligatory to use the forms provided by the Office, as long as all the admissibility requirements are met. However, the use of the official forms is highly recommended.

### 3 Payment of the Fee

Articles 8(3) and 56(2) CTMFR  
Rule 39(1) CTMIR

For general rules on payments, please consult the Guidelines Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

An application for cancellation is not deemed to have been filed until the fee has been paid. For this reason, before examining the admissibility of the application, the Office will first check that the fee has been received.

Where the Office finds that the fee has not been paid, it will invite the applicant to pay it within a given time limit (in practice usually one month). If the required fee is not paid within the time limit, the Office will inform the applicant that the application for cancellation is deemed not to have been filed and (if it was paid, but after the specified time limit) the fee will be refunded to the applicant. In cases where the fee is received after the expiry of the time limit specified by the Office but the applicant provides proof that, within the time limit, it duly gave an order to a banking establishment to transfer the amount of the payment in a Member State, Article 8(3) CTMFR will be applied, including the payment of a surcharge where applicable (see the Guidelines Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

The filing date of an application for cancellation is not affected by the date of payment of the fee, since Article 56(2) CTMFR is a rule of order in the context of cancellation proceedings and does not establish any consequence as regards the filing date of the application. Therefore, when the fee is paid before the expiry of the time limit specified by Rule 39(1) CTMIR, the application is deemed to be filed and the filing date will be that on which the written statement was received by the Office.

As a general principle, the cancellation fee is an application fee due for the filing of the application regardless of the outcome of the proceedings. Therefore, it will not be refunded in cases of inadmissibility.

Neither will the cancellation fee be refunded in cases where the application for cancellation is withdrawn ~~before the admissibility check is done~~ at any stage.

In this context, the only provision which foresees the refund of the cancellation fee is Rule 39(1) CTMIR, applicable only in cases where the application is deemed not to have been filed as a result of a late payment.

### 4 Admissibility Check

Article 51 and Articles 53(4) and 56(3) CTMFR  
Rule 37 and Rule 38(1) CTMIR

Once the Office has established that the corresponding fee has been duly paid, it proceeds with an admissibility check of the application.

In contrast to opposition proceedings, there is no cooling-off period and no subsequent time limit for substantiation in cancellation proceedings. This means, in particular, that

in the case of an application for invalidity based on relative grounds the proof of the existence, validity and scope of protection of all the earlier rights and the evidence proving the applicant's entitlement to them have to be filed, in principle, together with the application.

The admissibility check may result in the identification of absolute and/or relative admissibility deficiencies in the application.

**Absolute admissibility deficiencies** are those that cannot be remedied by the applicant and will automatically lead to the application being considered inadmissible, such as the following:

- The application is filed against a CTM which has not yet been registered. An application for cancellation can only be filed against a registered CTM. A request directed against an application which has not yet been registered is premature and should be rejected as inadmissible (see decision of 22/10/2007, R 0284/2007-4, 'VISION').
- ~~There is *res judicata* (Article 56(3) CTMR), that is, For example, when there is a previous final decision by the Office Cancellation Division or by a court in a Member State, in the context of a counterclaim, relating to the same subject matter and cause of action and involving trade mark, the same goods and/or services and the same parties.~~
- In cases of invalidity based on relative grounds, where the applicant owns several earlier rights and has already applied for the invalidity (also counterclaims) of the same CTM on the basis of another of those earlier rights (Article 53(4) CTMR).
- An application for revocation based on non use is filed against a trade mark that has not been registered for five years at the date of the application (Article 51 CTMR).
- An application for cancellation is ~~not~~ but not filed using the official form and it is neither in the correct language as established in Article 119 CTMR nor translated into that language within one month of the filing of the application for cancellation (Rule 38(1) CTMIR).

Where an absolute admissibility deficiency is found, the Office will invite the applicant to comment on the inadmissibility within two months. If, after hearing the applicant, the Office still maintains that there is an absolute admissibility deficiency, a decision will be issued rejecting the application for cancellation as inadmissible.

**Relative admissibility deficiencies**, on the other hand, are those that can in principle be remedied by the applicant. They include non-compliance with one or more of the relative admissibility requirements contained in Rule 37 CTMIR (which are described in detail in paragraph 4.1 below). In these cases, in accordance with Rule 39(3) CTMIR, the Office will invite the applicant to remedy the deficiency within two months (see paragraph 4.2 below).

Where one or more relative admissibility deficiencies have been found and they are not remedied within the specified time limit, a decision will be issued rejecting the application for cancellation ~~(or the part of it affected by the deficiency)~~ as inadmissible.

Any decision to reject an application for cancellation in its entirety as inadmissible will be communicated to the applicant and the proprietor of the CTM (Rule 39(4) CTMIR) and can be appealed by the applicant.

However, if the result of the admissibility check is that the application is considered partially admissible (i.e. admissible for at least some of the grounds and/or earlier rights on which it is based), the proceedings will continue. If one of the parties disagrees with the result of the admissibility check, it can appeal against it together with the final decision terminating the proceedings (Article 58(2) CTMR).

#### **4.1 Relative admissibility requirements (Rule 37 CTMIR)**

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

##### **4.1.1 Registration number of the contested CTM and name and address of its owner (Rule 37(a)(i) and (ii) CTMIR)**

An application for cancellation must contain the CTM registration number and the name and address of its proprietor (please note that this is different in opposition proceedings, where Rule 15(2) only requires the opponent to identify the contested CTMA and the name of the applicant, but not its address). ~~The reason for this provision is the need to ensure correct identification of the contested CTM.~~

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

##### **4.1.2 Extent of the application for cancellation (Rule 37(a)(iii) CTMIR)**

~~An application for cancellation must indicate the registered goods and services for which revocation or a declaration of invalidity is sought. Therefore, the The applicant must indicate if the request is filed against all the goods and services or against part of the goods and services in the contested registration. If the applicant indicates the request is directed against only part of the goods and services of the contested CTM, it~~In the latter case, the applicant~~ will have to clearly identify the specific goods and services in a list.~~

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

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

The CTMR and CTMIR clearly distinguish between an application for revocation and an application for a declaration of invalidity. Therefore, revocation and invalidity grounds cannot be combined in a single application but must be subject to separate applications and entail the payment of separate fees. However, an application for revocation can be based on several revocation grounds and an application for invalidity can be based on a combination of absolute and relative grounds. If an applicant files a single application

based on revocation and invalidity grounds, the Office will send a deficiency letter inviting the applicant to choose one or the other type of grounds and will inform the applicant that another cancellation application can be filed subject to the payment of an additional application fee. If the applicant does not indicate which type of grounds it wishes to choose, the application will be rejected as inadmissible (Rule 39(3) CTMIR).

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

In addition, where an application for invalidity is based on relative grounds (Article 53 CTMR), the application must contain particulars of the right or rights on which the application is based and, if necessary, particulars showing that the applicant is entitled to adduce the earlier right as grounds for invalidity (meaning all the indications contained in Rule 15(b), (d), (e), (f), (g) and (h) CTMIR, which are applied by analogy). ~~For applications based on Article 53(2) CTMR, exact provisions of national laws should be indicated showing that the applicant is entitled under the national law applicable to lay claim to that right.~~

According to Rule 37(b)(iv) CTMIR, an application for cancellation must also contain an indication of the facts, evidence and arguments presented in support of the cancellation grounds. This means that the mere submission of an application form in which all the relevant boxes are ticked, but which does not include, or at least indicate, any facts, evidence and arguments to support it, will normally lead to an admissibility deficiency. The only exception is for applications for revocation based on non-use (Article 51(1)(a) CTMIR), in which the burden of proof is on the CTM proprietor.

Finally, an important distinction should be drawn between admissibility and substantiation requirements. As already mentioned in the introduction to paragraph 4, even though in invalidity proceedings based on relative grounds there is no time limit for the substantiation of the earlier rights, and the proof of the existence, validity and scope of protection of all the earlier rights and the evidence proving the applicant's entitlement to them have to be filed together with the application, this does not mean that there is no distinction between admissibility and substantiation requirements. If, for instance, an applicant clearly identifies the earlier mark on which the application is based (Rule 37(b)(ii) CTMIR) and indicates the evidence in support of those grounds (Rule 37(b)(iv) CTMIR), the application will be admissible. If the evidence provided is later found insufficient to substantiate the earlier right (e.g. certificate is not from an official source or not translated into the language of proceedings), the application will be rejected as unfounded (see, by analogy, Rule 20(1) CTMIR), and not as inadmissible. (see decision of 12/07/2013, R 1306/2012-4, 'URB EUROPE', para. 21, decision of 12/07/2013, R 1310/2012-4, 'URB Bearings', para. 21 and decision of 12/07/2013, R 1309/2012-4, 'URB', para. 20).

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

As regards substantiation requirements of earlier rights, see the section on proof of existence of earlier rights in the Guidelines Part C, Opposition, Section 1, Procedural



Matters and the section on invalidity proceedings based on relative grounds in the Guidelines Part D, Cancellation, Section 2, Substantive Provisions.

#### 4.1.4 Identification of the applicant (Rule 37(c) CTMIR)

An application for cancellation must contain the applicant's name and address and, if it has appointed a representative, the representative's name and address. Applicants who do not have either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the European Union must be represented by a professional representative (Article 92(2) CTMR). For more information, see the Guidelines Part A, General Rules, Section 5, Professional Representation.

Concerning multiple applicants, applications for invalidity based on relative grounds follow the same rules as oppositions (see the Guidelines Part C, Opposition, Section 1, Procedural Matters). These rules are directly connected to the entitlement requirements of Article 56(1) CTMR and Article 41(1) CTMR (see above).

In contrast, in the case of applications for invalidity based on absolute grounds and for revocation there are no particular requirements regarding multiple applicants, except that they have to be clearly indicated in the application.

Please note that in all cases concerning multiple applicants, Rule 75 and Rule 94(7)(e) CTMIR will be applied (appointment of a common representative and fixing of costs).

## 4.2 Invitation to remedy deficiencies

Rule 39(3), (4) CTMR
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In accordance with Rule 39(3) CTMIR, if the Office finds that an application for cancellation does not comply with Rule 37 CTMIR, it will invite the applicant to remedy the deficiencies within a specific time limit (in the practice of the Office, two months). This will be done as soon as the deficiency is found, whether or not within the context of the admissibility check. Please note that this only applies to deficiencies as regards admissibility requirements, and not to deficiencies as regards substantiation requirements, which the applicant must remedy on its own motion (see paragraph 4.1.3 above).

If the deficiencies are not remedied before the expiry of the time limit, the Office will issue a decision rejecting the application as inadmissible. In cases where the application for cancellation is based on several grounds and/or earlier rights and the deficiencies only relate to some of them, the proceedings can continue in relation to the other grounds or earlier rights for which there are no admissibility deficiencies (partial admissibility).

As mentioned above in connection with the grounds of the application, in the context of Rule 39(3) CTMIR the fact that the applicant is invited to remedy a deficiency cannot lead to enlarging the scope of the proceedings (earlier rights, goods and services, etc.) determined by the initial request. For example, if the application for cancellation indicates that it is directed against part of the goods and services in the contested registration and the Office invites the applicant, in accordance with Rule 39(3) CTMIR,

to specify which specific goods and services of the CTM the application is directed against, ~~an answer stating that it is directed against all the goods and services for which the CTM is registered would not be considered an appropriate remedy for the deficiency (since it enlarges the scope of the application). The Office will explain this legal situation to the applicant and invite it to file an indication which does not contain all goods and services within two months. An answer must clearly list the part of the goods and services against which the application for cancellation is directed.~~ If the applicant does not respond appropriately, the Office will issue a decision rejecting the application as inadmissible.

Finally, Rule 39(3) CTMIR is only applicable to the list of relative admissibility requirements contained in Rule 37 CTMIR. Deficiencies in relation to absolute admissibility requirements (e.g. the lack of translation of the application in accordance with Rule 38(1) CTMIR, the existence of *res judicata* or of a previous application for invalidity based on another earlier right from the same proprietor, or non-compliance with the five-year period between a revocation request and the registration of the contested CTM) are not covered by Rule 39(3) CTMIR and cannot be remedied (i.e. they lead to the rejection of the application in question as inadmissible).

## 5 Notification of the Application to the CTM Proprietor and Further Exchanges between the Parties

Article 57 CTMR Rule 40 CTMIR
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Rule 40(1) CTMIR states that every application for cancellation which is deemed to have been filed must be notified to the proprietor of the contested CTM and that when the Office has found the application admissible, it will invite the proprietor to file its observations within such time limit as it may specify.

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

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

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

According to the judgment of the Court of Justice of 18/10/2012 in case C-402/11 P, 'REDTUBE' (applicable by analogy to cancellation proceedings), the notification sent to the parties after the admissibility check informing them that the cancellation is admissible in accordance with Rule 37 CTMIR constitutes a decision that may be appealed together with the final decision on the case as stated in Article 58(2) CTMR.

Consequently, the Office is bound by this decision and may only revoke it at a later stage of the proceedings provided that the requirements stated in Article 80 CTMR for the revocation of decisions are met.

According to Article 57(1) CTMR, the Office may invite the parties to file observations as often as it considers this necessary. In practice, and in the interest of avoiding an unnecessary prolongation of the proceedings, the Office will usually grant two rounds of observations, usually ending with those of the CTM proprietor (i.e. application for cancellation – CTM proprietor’s observations – applicant’s observations – CTM proprietor’s observations). Nevertheless, in cases when one of the parties, within the time limit to file observations, does not submit any evidence or observations and/or indicates that it has nothing more to comment, the Office may directly proceed to closure of the adversarial part of the proceedings, notifying the parties that a decision will be taken.

However, additional rounds of observations may be granted in exceptional cases, in particular when additional relevant evidence, which could not have been filed beforehand, is filed in the last round. It is the Office’s practice to give the parties a time limit of two months to file their observations (except for the first submission of the CTM proprietor, see above).

As regards applications for invalidity based on relative grounds, the CTM proprietor may also file a request for proof of use of the earlier trade marks on which the application is based. If the request is admissible (for the rules on the admissibility of a request for proof of use, see the Guidelines Part C, Opposition, Section 6, Proof of Use), the Office will invite the applicant to submit the proof (Article 57(2) and (3) CTMR and Rule 40(6) CTMIR). In contrast to opposition proceedings (Rule 22(1) CTMIR), in cancellation proceedings the request can be filed by the CTM proprietor together with its first response to the application or in any of the subsequent rounds of observations.

~~In addition, where an application for invalidity is based on Article 53(1) CTMR in connection with Article 8(1)(b) CTMR, there is no provision requiring the applicant to claim that its earlier marks have acquired enhanced distinctiveness through use or to file the corresponding evidence together with the application. Therefore, this claim can be made at a later stage of the adversarial part of the proceedings (see judgment of 07/02/2012, T-424/10, ‘Représentation d’éléphants dans un rectangle’, paras 60-62). This should be distinguished, however, from a claim based on Article 8(5) CTMR, which is a specific ground separate from Article 8(1)(b) CTMR and, in accordance with Rule 37(b)(ii) CTMIR, should be contained (together with the corresponding proof of reputation) in the application for cancellation.~~

Once the parties have submitted their observations and/or proof of use (if applicable), the adversarial part is closed and the file is ready for decision.

If at any stage of the proceedings one of the parties does not file observations within the specified time limit, the Office will close the adversarial part and take a decision on the basis of the evidence before it (Rule 40(2) CTMIR, applicable by analogy to both parties).

As regards the rules on time limits, extensions, notification or change of parties in the course of proceedings, etc., see the procedural matters section of the Guidelines Part C, Opposition, Section 1, Procedural Matters as the rules are applicable *mutatis mutandis*.

## 6 Languages Used in Cancellation Proceedings

Article 119(5), (6) and (7) CTMR  
Rules 38(1), (3), 39(2), (3) and 96(1), (2) CTMIR

For detailed rules on use of languages in the proceedings, see the procedural section of the Guidelines Part C, Opposition, Section 1, Procedural Matters. This section will only address the specific rules which are applicable to cancellation proceedings.

~~According to Article 119(5) CTMR, an application for cancellation has to be filed in one of the languages of the Office (i.e. English, French, German, Italian or Spanish).~~

The parties to cancellation proceedings may also agree on a different official language of the European Union as the language of the proceedings (Article 119(7) CTMR). This agreement has to be communicated to the Office within two months of the notification of the application for cancellation to the CTM proprietor. In this case, the applicant must file a translation of the application into the language chosen by both parties (where it was not already filed in that language) within one month of the date on which the agreement is communicated to the Office. Where the translation is not filed or filed late, the language of the proceedings will remain unchanged (Rule 38(3) CTMIR).

### 6.1 Translation of the application for cancellation

Article 119(6) CTMR  
Rules 38(1), (3) and 39(2) CTMIR

If the application is filed in a language of the Office that is one of the two languages of the contested CTM, that language will automatically become the language of the proceedings.

If the application is filed in a language of the Office that is not one of the two languages of the contested CTM, and the official form is not used, on its own motion the applicant has to file a translation into the correct language (either of the two languages of the contested CTM, if they are both languages of the Office, or the second language of the contested CTM, when the first is not a language of the Office) within one month of the filing date of the application for cancellation. The language into which the application has been translated will then become the language of the proceedings.

If the applicant does not file a translation into the appropriate language within the time limit, the application for cancellation will be rejected as inadmissible (Article 119(6) CTMR, Rules 38(1) and 39(2) CTMIR).

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

Where the applicant uses the official form for revocation or invalidity, and this form is in the wrong language, there may be exceptions concerning the translation and the indication of the language of the proceedings. Please see the different scenarios on pages 11 to 12 of the Guidelines Part C, Opposition, Section 1, Procedural Matters.

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

Rules 38(2) and 39(3) CTMIR

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

The Office will not send a deficiency letter and it is up to the applicant to submit the translation of the evidence in support of the application on its own motion.

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

If the applicant does not provide translations for the other evidence, which would not affect the admissibility of the case, any document in support of the application which is not translated by the applicant into the language of proceedings within the time limit specified in Rule 38(2) CTMIR will be deemed not to have been received by the Office and, therefore, will not be taken into account (Rule 98(2) CTMIR) (see decision of 05/03/2012, R 0826/2010-4, 'MANUFACTURE PRIM 1949 (FIG.MARK)', para. 25).

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

Rules 96(1) and 98(2) CTMIR

A party who submits observations in a language of the Office other than the language of the proceedings has to file a translation of those observations in the language of the proceedings within one month of the submission date (Rule 96(1) CTMIR).

The Office will not ask for the translations and will proceed with the case. It is up to the party to submit the requisite translations.

If the translations are not submitted within the time limit of one month, the observations will be deemed not to have been received by the Office and, therefore, will not be taken into account (Rule 98(2) CTMIR).

## 6.4 Translation of evidence submitted by the CTM proprietor in the course of the proceedings

Rules 96(2) and 98(2) CTMIR

The documents submitted by the CTM proprietor in the course of the proceedings (except for proof of use, see below) are subject to Rule 96(2) CTMIR and, therefore, may be submitted in any official language of the European Union.

In accordance with this provision, the CTM proprietor is not automatically obliged to file a translation, but the Office may require it to do so within a time limit. In exercising its discretion in this matter, the Office will take into account the nature of the evidence and the interests of the parties.

In cases where the Office does invite the CTM proprietor to submit translations of the evidence, failure to do so within the specified time limit will mean that the non-translated documents will not be taken into account (Rule 98(2) CTMIR).

## 6.5 Translation of proof of use

Rule 22(6) CTMIR

Although Rule 40(5) and (6) CTMIR only expressly refers to Rule 22(2), (3) and (4) CTMIR, it is considered that Rule 22(6) CTMIR should also be applied by analogy in cancellation proceedings, since the underlying logic is the same, that is, to request translation of evidence, which for proof of use tends to be quite lengthy, only to the extent to which it is considered necessary (see decision of 11/03/2010, R 0167/2009-1, 'INA/INA (figurative mark)' paras 24-25). Consequently, Rule 22(6) CTMIR applies as *lex specialis*, vis-à-vis the *lex generalis* contained in Rule 38(2) CTMIR (evidence submitted by the applicant) and Rule 96(2) CTMIR (evidence submitted by the CTM proprietor), as regards proof of use submitted by either of the parties.

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

## 7 Other Issues

### 7.1 Continuation of proceedings

Article 82 CTMR
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According to Article 82(1) CTMR, any party to proceedings before the Office who has omitted to observe a time limit vis-à-vis the Office may, upon request, obtain the continuation of proceedings, provided that at the time the request is made the omitted act has been carried out. The request for continuation of proceedings will be admissible only if it is presented within two months of the expiry of the unobserved time limit and will not be deemed to have been filed until the corresponding fee has been paid.

This provision is applicable to all the proceedings before the Office. For more details, see the [Manual Guidelines](#) Part A, General Rules, Section 1, Means of Communication, Time Limits.

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

### 7.2 Suspensions

Article 104 CTMR
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In the matter of suspensions, see in general the Guidelines Part C, Opposition, Section 1, Procedural Matters (taking into account, however, that in cancellation proceedings there is no cooling-off period). Rule 20(7) CTMIR is applicable by analogy.

The main particularity of cancellation proceedings in this matter concerns the specific rules on related actions before Community trade mark courts. According to Article 104(2) CTMR, the Office, when hearing an application for cancellation will, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, suspend the proceedings where the validity of the contested CTM is already in issue on account of a counterclaim before a Community trade mark court.

Article 104(2) CTMR also states that if one of the parties to the proceedings before the Community trade mark court so requests, the Community trade mark court may, after hearing the other parties to these proceedings, suspend the proceedings. The Office will in this case continue the proceedings pending before it.

A request for suspension pursuant to Article 104(2) CTMR should be supported by relevant evidence. Suspension requests are only considered relevant to the proceedings and might be granted under Article 104(2) CTMR in cases where they

refer to the contested CTM and not where they refer to other CTMs contested in parallel cancellation proceedings.

### 7.3 Surrenders and withdrawals

The Office's practice on the surrender of CTMs is described in the [Manual Guidelines](#) Part E, Register Operations, Section 1, Changes in a Registration.

#### 7.3.1 Surrenders covering all the contested goods and/or services

In principle, the consequences in cancellation proceedings of a total surrender of the contested CTM (or of a partial surrender covering all the goods and/or services against which the application for cancellation is directed) are similar to those of the withdrawal of a CTM application in opposition proceedings.

However, unlike what happens with the withdrawal of a CTM application, the effects of the surrender of a registered CTM are not the same as those of the decision on the substance terminating the proceedings in question. While the surrender of a CTM only becomes effective on the date on which it is registered, a decision cancelling the CTM produces its effects from an earlier date, be it the registration date of the CTM (in the case of invalidity) or the date on which the cancellation request was filed (in the case of revocation). Consequently, as a rule and despite the surrender of the contested CTM, the applicant is deemed to still have a legitimate interest in continuing the cancellation proceedings in order to obtain a decision on the substance (see judgment of 24/03/2011, C-552/09 P, 'TiMi KiNDERJOGHURT', para. 39 and decision of 22/10/2010, R 0463/2009-4, 'MAGENTA', paras 25-27).

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

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

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

If the applicant does request the continuation of the cancellation proceedings (either in reply to the Office's invitation to submit observations or when applying for a decision under Rule 54(2) CTMIR), the cancellation proceedings will continue until there is a final decision on the substance. In these cases, the costs will be awarded to the winning party and not necessarily to the party terminating proceedings, as indicated in



Article 85(3) CTMR. After the decision on the cancellation has become final, the surrender will be recorded only for the goods and/or services for which the contested CTM has not been revoked or declared invalid, if any.

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

The CTM proprietor may partially surrender its CTM for part of the contested goods and/or services. In such cases the Office will notify the cancellation applicant and will invite it to indicate if it wishes to maintain its cancellation application. If the cancellation applicant does request the continuation of proceedings and maintains its application for cancellation, proceedings will continue despite the partial surrender of the CTM in the Register. If the cancellation applicant does not wish to maintain its application for cancellation, the Office will close the proceedings and take a decision on costs indicating that each party will bear its own costs (Article 85 (2) CTMR).

### 7.3.3 Withdrawals

The cancellation applicant can withdraw its application for cancellation at any time of the proceedings. The Office will inform the CTM proprietor about the withdrawal, close the proceedings and take a decision on costs, which will be awarded to the CTM proprietor (Article 85(3) CTMR), except in cases where the withdrawal immediately follows a surrender (see above).

The parties may indicate that a surrender or a withdrawal is a consequence of an agreement they have reached and that a decision on costs is not necessary. The Office will not issue a decision on costs if such a request is received together with a request for surrender or withdrawal and is signed by both parties. Such a request can also be sent in two separate letters to the Office. In cases where no indication is given as to whether the parties have agreed on the costs, the Office will take a decision on costs immediately. The decision on costs already issued will not be revised by the Office in the event that the parties provide such information after the date of the decision. It is left to the parties to respect the agreement and not to 'execute' the Office's decision on costs.

## 7.4 Applications for revocation and for invalidity against the same CTM

If the same CTM is subject to both revocation and invalidity proceedings, the Office has the power of discretion to decide in each case, taking into account the principles of economy of proceedings and administrative efficiency, whether one of the proceedings has to be suspended until the other is terminated or in which order the proceedings should be decided.

If it is first decided that the CTM is totally invalid (or partially but for all the goods/services against which the revocation is directed), and once this decision becomes final, the parallel revocation proceedings will be automatically closed since they no longer have any object. The costs are at the discretion of the Office (Article 85(4) CTMR), which will usually conclude that each party has to bear its own costs.

However, taking into account the different effects of a revocation (*ex nunc*) and of a declaration of invalidity (*ex tunc*), when it is first decided that the CTM should be totally revoked (or partially but for all the goods/services against which the invalidity is directed), the Office will inform the applicant of this decision when it becomes final and will invite it to submit its observations on the closure of the invalidity proceedings. If the applicant demonstrates a sufficient legal interest in obtaining a declaratory invalidity decision, the proceedings will continue.

## 7.5 Contested international registrations designating the EU

Article 152(2) and Article 158 CTMR

Cancellation proceedings can also be directed against international registrations (IRs) designating the European Union. The specific rules that are applicable in these cases (in particular in connection with the filing date and the relevant time limit for proof of use) can be found in the [Manual Guidelines](#), Part M, International Marks.

A cancellation application against an IR may be filed after the date of the publication of the IR designating the European Union in the Official Bulletin of the Office (M.3.1. – International registrations with or without amendments since their publication under Article 152(1) of the CTMR).

As regards WIPO representatives of the holders of contested IRs, as a general rule the Office will communicate with them, irrespective of the IR holder's location, when they comply with the criteria of Article 93 CTMR.

Where the WIPO representative of the IR holder does not comply with the criteria of Article 93 CTMR, the notification of the cancellation application will be sent directly to the IR holder, and a copy will be sent to its WIPO representative for information purposes.

The notification of the cancellation application will also invite the IR holder to appoint a professional representative in accordance with Article 93 CTMR within three months of its receipt. In cases of obligatory representation (Article 92(2) CTMR), the notification will indicate the consequences of not complying with this requirement (namely, that any communications sent by the IR holder in the course of the proceedings will not be taken into account).