

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

PART E

REGISTER OPERATIONS

SECTION 6

OTHER ENTRIES IN THE REGISTER

CHAPTER 1

COUNTERCLAIMS

Table of Contents

| | | |
|----------|---|----------|
| 1 | Introduction..... | 3 |
| 2 | Application to Register the Filing of a Counterclaim Before a CTM or CD Court..... | 3 |
| 3 | Application to Register a Judgment on a Counterclaim Before a CTM or CD court..... | 4 |

1 Introduction

Counterclaims, as provided for in Article 100 CTMR or Article 84 CDR, are defence claims of the defendant who is sued for the infringement of a Community trade mark (CTM) or Registered Community Design (RCD). By way of such a counterclaim the defendant asks the Community trade mark court or Community design court to declare the revocation or invalidity of the CTM or the invalidity of the RCD which it is supposed to have infringed.

The purpose of recording the filing and the final judgment of the counterclaim in the Register of the Office lies in the general interest of making all the relevant information on counterclaims concerning CTMs and RCDs, in particular the final judgments thereof, publicly available. In this way the Office may implement these final judgments, in particular those which declare the total or partial revocation or invalidity of a CTM as well as those which declare the total invalidity of RCDs.

By entering such counterclaims and their final judgments in the Register, the Office strives to comply with the principles of conformity to truth, public faith and the legal certainty of a public Register.

2 Application to Register the Filing of a Counterclaim Before a CTM or CD Court

Article 100(4) CTMR
Rule 84(3)(n) CTMIR
Article 86(2) CDR
Article 69(3)(p) CDIR
Communication No 9/05 and No 10/05 of the President

According to Article 100(4) CTMR and Article 86(2) CDR, the Community trade mark and Community design court before which a counterclaim for revocation of a CTM or for a declaration of invalidity of the CTM or RCD has been filed shall inform the Office of the date on which the counterclaim was filed.

Communications No 9/05 and No 10/05 of 28/11/2005 concern the designation of Community trade mark and Community design courts of the Member States (hereinafter, 'CTM or CD courts') pursuant to Article 95(2) CTMR.

The Office also allows any party to the counterclaim proceedings to request the entry of a counterclaim in the Register, if not yet communicated by the CTM or CD court.

The recordal applicant (the CTM or CD court or one of the parties in the counterclaim proceedings) must indicate and submit:

- the date on which the counterclaim was filed,
- the number of the CTM or RCD concerned,
- an indication of whether the request is for revocation or for declaration of invalidity,
- if the recordal applicant is one of the parties, official confirmation from the CTM or CD court that has the authority to take the judgment on the counterclaim including, where possible, the case or reference number from the court.

If the recordal applicant does not submit official confirmation from the CTM or CD court, or if the information submitted by the applicant requires clarification, the Office will request confirmation in writing.

The Office will notify the CTM or RCD proprietor and the CTM or CD court that the counterclaim has been entered in the Register. If the request was made by one of the parties to the counterclaim proceedings, the Office will also inform this party.

The entry in the relevant Register will be published in Part C.9.3. of the CTM Bulletin or Part B.3.1 of the RCD Bulletin.

3 Application to Register a Judgment on a Counterclaim Before a CTM or CD court

| |
|--|
| Article 100(6) CTMR Rule 84(3)(o) CTMIR Article 86(4) CDR Article 69(3)(q) CDIR |
|--|

Where a CTM or CD court has given a judgment, which has become final, on a counterclaim for revocation of a CTM or for invalidity of a CTM or an RCD, a copy of the judgment shall be sent to the Office.

The Office also allows any party to the counterclaim proceedings to request the entry of a judgment on the counterclaim action in the Register, if not yet communicated by the CTM or CD court.

The recordal applicant (the CTM or CD court or one of the parties in the counterclaim proceedings) must indicate and submit:

- a copy of the judgment, together with confirmation from the CTM or CD court that the judgment has become final,
- the date on which the judgment became final,
- the number of the CTM or RCD concerned,
- an indication of whether the request is for revocation or for declaration of invalidity,
- in the event of partial cancellation or invalidity, the list of goods and services affected by the judgment, if relevant.

The Office needs confirmation that the judgment is final (rechtskräftig/adquirido fuerza de cosa juzgada/passée en force de chose jugée, etc.). If the Office requires clarification, it will request confirmation in writing.

Where the final judgment partially cancels a CTM, the Office will alter the list of goods and services according to the CTM court judgment and, where necessary, will send the amended list of goods and services for translation.

The Office will notify the CTM or RCD proprietor and the CTM or CD court that the judgment has been entered in the Register. If the request was made by one of the parties to the counterclaim proceedings, the Office will also inform this party.

The entry in the relevant Register will be published in Part C.9.4. of the CTM Bulletin or Part B.3.2. of the RCD Bulletin.