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

PART A

GENERAL RULES

SECTION 1

MEANS OF COMMUNICATION, TIME LIMITS
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1 Introduction

This part of the Guidelines includes those provisions which are common to all proceedings before the Office in trade mark matters, except appeals.

In the interest of efficiency and in order to prevent parties encountering dissimilar practices, the Office applies procedural rules consistently.

Proceedings before the Office can be classified in two broad types: ex parte proceedings, which involve only one party, or inter partes proceedings, in which two or more parties are in conflict.

The first category comprises, in particular, applications for registration or renewal of a Community trade mark, entries in the Register related to transfers, licences, levy of execution or bankruptcy, and proceedings related to seniority and conversion.

The second category includes opposition proceedings and cancellation proceedings (revocation or declaration of invalidity of a registered Community trade mark).

2 Procedures for Filing and for Communication with the Office

An application for a Community trade mark (CTM) may be filed directly at the Office or through a national office of a Member State of the European Union, including the Benelux Trade Mark Office.

All other documents may only be filed directly at the Office.

All documents may be sent to the Office by normal post or courier services, handed in personally at the Office’s reception desk (Avenida de Europa, 4, 03008 Alicante) during Office opening hours (Monday to Friday, 8.30 – 13.30 and 15.00 – 17.00), or sent by fax. Applications for CTMs, oppositions and renewals may also be filed electronically via the Office’s official website. As a part of its e-business strategy, the Office will progressively open up electronic communication for filing other documents in all types of proceedings.

The Office has made various forms available to the public, in all official languages of the EU. With one exception, their use is not mandatory but strongly recommended. The exception is the filing of an international application or subsequent designation under the Madrid Protocol, for which either WIPO’s MM 2 or MM 4 or OHIM’s EM 2 or EM 4 form must be used. All these forms can be downloaded from the Office’s official website.

3 Notification and Communication of Documents

The CTMIR distinguishes between documents originating from the parties and addressed to the Office and notifications issued by the Office.
3.1 Communication to the Office

Rules 79, 79a, 80, 82 CTMIR
Decision No EX-13-02 of the President of the Office

3.1.1 By telecopier

Where a document is communicated to the Office by fax, the original should be signed so that the fax received by the Office carries the facsimile of the signature. If a document communicated to the Office is not signed, the Office will invite the party concerned to correct the irregularity and specify a time limit in which they are to do so. If the document is not signed within that time limit, the respective application or request will be declared inadmissible, or the document will not be taken into account, as the case may be.

If, however, the fax was generated electronically on a computer (‘electronic fax’), no signature is needed.

Subsequent confirmation by mail of the fax is not necessary. The Office will acknowledge receipt of the fax only in the cases expressly specified by the CTMIR, namely when a CTM application is filed. The Office will not, therefore, acknowledge receipt of a fax, but if the communication is incomplete or illegible, or the Office has reasonable doubts as to the accuracy of the transmission, the Office will inform the sender accordingly and invite them, within a time limit to be specified, to retransmit the communication. If the retransmission is complete, the date of receipt will be considered to be that of the first transmission, except for the purposes of establishing a filing date for a CTM application. Otherwise the Office will not take into account the transmission at all, or consider only the received and/or legible parts (decision of 04/07/2012, R 2305/2010-4, ‘Houbigant/PARFUMS HOUBIGANT PARIS et al.’).

Where a document in colour is to be transmitted, it suffices if the document is sent by fax and the coloured original is filed within one additional month unless provided otherwise by the CTMR. In this case the date of receipt of the coloured original is deemed to be the date of receipt of the fax by the Office, including for the purposes of obtaining a filing date for a CTM application.

3.1.2 By electronic means

In accordance with Rule 82 CTMIR, if a CTM application is filed through e-filing, or a communication is sent to the Office using any electronic facilities, the name of the applicant is considered as the signature.

3.1.3 By post, service or personal delivery

Documents sent by post should be addressed to the Office at the address indicated in the explanatory notes accompanying the forms provided by the Office.

Documents sent by post, courier service or personal delivery must bear an original signature. If a document sent to the Office is not signed, the Office will invite the party concerned to correct the irregularity and specify a time limit in which they are to do so.
If the document is not signed within that time limit, the respective application or request will be declared inadmissible, or the document will not be taken into account, as the case may be.

### 3.2 Notification by the Office

<table>
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<tr>
<th>Rules 61-69 CTMIR</th>
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<td>Decision No EX-97-1 of the President of the Office</td>
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Written communications from the Office to the party or parties to proceedings will be ‘notified’. ‘Notification’ means the way a document is transmitted to the addressee, not a formal legal procedure (‘legal service’). Notification means that the document has entered the sphere of the addressee, irrespective of whether they have been apprised of the document. The manner and relevant date of notification depend on the various means of communication.

Except for public notification, and subject to the fact that some means of notification require prior consent of the party, the Office can freely choose the most appropriate means of notification (Rule 61(3) CTMIR).

In practice, wherever feasible and provided that the number of pages to be transmitted is not excessively high, the Office will always opt for notification by electronic means if available.

If the proper procedure of notification has been followed, the document is deemed to have been notified unless the recipient proves that the document did not reach them at all, or reached them at a later point in time. Conversely, where the proper procedure of notification was not followed, the document will nevertheless be considered notified if the Office can prove that the document actually reached the recipient.

The Office will either notify the signed original document, by post, or a copy of the document which need not be signed, as the President of the Office in decision EX-97-1 made use of the power under Rule 55(2) CTMIR to prescribe that the indication of the name(s) of the official(s) suffices.

#### 3.2.1 Notification by telecopier

The Office may use this means of notification if the party has indicated a fax number. All documents can and will be notified this way, including decisions. The Office keeps fax logs to be able to prove transmission time and content.

#### 3.2.2 By normal post

With regard to notification by post, the procedure will vary according to the nature of the document notified.

If the addressee has a place of business or domicile within the EU or has appointed a professional representative, decisions subject to a time limit for appeal, as well as summonses, will be notified by registered letter with a record of delivery.
In all other cases, that is, where the recipient’s address is not in the Union or for any other document to be notified, the Office may and will send the document by normal post. Notification will be deemed to have been effected on the 10th day following the posting of the document. This presumption may only be rebutted by the recipient by proving that they did not receive the document, or that they received it at a later date.

3.2.3 By deposit in a postbox

Notification may be effected to addressees who maintain a postbox at the Office by depositing the notified document therein. The date of deposit will be recorded by the Office. Notification will be deemed to have been effected on the 5th day following the deposit of the document.

3.2.4 By hand delivery

Notification may also be effected by hand delivery of the document to the addressee, if they are personally present at the Office. This way of notification will constitute an exception. A copy of the document, on which a dated and signed acknowledgement of receipt by the addressee appears, will be kept in the file.

3.2.5 Through the Office’s official website

Pursuant to Decision No EX-11-3 of the President of the Office of 18/04/2011, notification may also be made through the Office’s official website if the holder of the electronic account with the Office has accepted this means of notification. Notification consists of placing the electronic document in the holder’s inbox. The document is deemed to have been notified on the 5th day following its posting, irrespective of whether the recipient actually opened and read the document. The date on which the document was placed will be mentioned in the holder’s inbox and will be recorded by the Office (decision of 17/01/2011, R 0956/2010-4 ‘DURAMAXX/DURAMAX’).

3.2.6 By public notification

Public notification will be used for all notifications when the address of the addressee is unknown or when notification by post has been returned to the Office after at least one attempt.

This relates primarily to post returned to the Office by the Post Office annotated ‘not known at the address given’ and post which has not been claimed by its addressee.

The public notifications will be published on the Office’s website. The document will be deemed to have been notified one month after the day on which it is posted on the internet.
3.3 Addressees

Rule 67 CTMIR
Articles 92, 93 CTMR

All notifications will be sent to the representative (judgment of 12/07/2012, T-279/09, ‘100% Capri/CAPRI’) if a professional representative has been duly appointed. ‘Duly appointed’ means that the representative is entitled to represent and has been properly appointed, and that no general obstacle (such as illicit representation of both parties in an inter partes proceeding) exists to preclude representation by that person. Filing an authorisation is not required for the purposes of being the recipient of OHIM’s notifications. For further details see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

Any notification addressed to the representative will have the same effect as if it had been addressed to the represented person. Similarly, any communication addressed to the Office by a representative will be considered to have originated from the represented person.

4 Time Limits

Rules 70-72 CTMIR

Time limits before the Office can be divided into two categories:

- those laid down by the CTMR or CTMIR which are, therefore, mandatory;
- those set by the Office which are, therefore, not mandatory and can be extended under certain circumstances.

4.1 Time limits specified by the Office

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. They are a matter of public policy and rigorous compliance with them is necessary to ensure clarity and legal certainty.

As regards the measures which mitigate the rigorous application of the principle of strict observance of time limits, the Regulations foresee three means depending on whether the time limit is still running or has expired.

If the time limit is still running, the party may request an extension of the time limit pursuant to Rule 71(1) CTMIR.

If the time limit has expired, the party who has missed the time limit still has two possible courses of action: either to seek continuation of proceedings (pursuant to Article 82 CTMR), which only requires meeting certain formal requirements, or to request restitutio in integrum (pursuant to Article 81 CTMR), which requires meeting formal and substantive requirements (such as showing all due care).

Additional information is provided under paragraphs 4.1.4. and 4.1.5 below.
4.1.1 Length of the time limits specified by the Office

With the exception of the time limits expressly specified in the CTMR or CTMIR, the time limits specified by the Office, when the party concerned has its domicile or its principal place of business or an establishment within the European Union, may not be less than one month or longer than six months. When the party concerned does not have its domicile or principal place of business or an establishment within the Union, the time limits may not be less than two months or longer than six months. The general practice is to grant two months.

4.1.2 Expiry of time limits

When a time limit is set in a notification by the Office, the ‘relevant event’ is the date on which the document is notified or deemed notified, depending on the rules governing the means of notification.

Where a time limit is expressed in months, it will expire in the relevant subsequent month on the day which has the same number as the day on which the ‘relevant event’ occurred.

Therefore, if the Office sets a two-month time limit in a communication which is notified by fax on 28 June, the time limit will expire on 28 August. It is immaterial whether the ‘relevant event’ occurred on a working day or holiday or Sunday; that is relevant only for the expiry of the time limit.

Where the relevant subsequent month has no day with the same number or where the day on which the event occurred was the last day of the month, the time limit in question will expire on the last day of that month. A two-month time limit set in a notification on 31 July thus expires on 30 September. Similarly, a two-month time limit set in a notification on 30 June will end on 31 August.

Any time limit will be deemed to expire at midnight on the last day.

A time limit which expires on a day on which the Office is not open for receipt of documents or on which ordinary post is not delivered in the locality in which the Office is located will extend until the first working day thereafter. This refers to Saturdays, Sundays and public holidays. For this purpose, before the start of each calendar year, the President of the Office determines the days on which the Office is closed. The extension is automatic but it applies only at the end of the time limit (decision of 12/05/2011, R 0924/2010-1, ‘whisper power-WHISPER’).

In the event of a general interruption of the postal service in Spain, any time limit that expires during that period will be extended until the first working day after the period of interruption. These periods will be determined by the President of the Office; the extension will apply for all parties to the proceedings.

In the event of an exceptional occurrence (strike, natural disaster, etc.) causing a disturbance in the running of the Office or a serious impediment in its communication with the outside world, time limits may be extended for a period determined by the President of the Office.
4.1.3 Extension of time limits

An extension of the time limits may be granted if the request is made by the party concerned before the original time limit expires.

In *ex parte* proceedings before the Office, if before the expiry of a time limit a request is made for its extension, then a further time limit should be allowed for a period depending on the circumstances of the case, but not exceeding six months.

Where the request for extension of an extendable time limit has been filed before the expiry of this time limit and has not been accepted, the party concerned will be granted at least one day to meet the deadline, even if the request for extension arrived on the last day of the time limit.

For the rules applicable to the extension of time limits in *inter partes* proceedings (i.e. when there are two or more parties involved such as in opposition, invalidity and/or revocation proceedings) see the Guidelines, Part C, Opposition, Section 1, Procedural Matters.

Unless otherwise provided either in the Regulations or in the specific paragraphs in this Guideline, as a general rule any first request for an extension which is received in time will always be granted independently of the explanation given by the party requesting it. However, any subsequent request for an extension of the same time limit will be refused, unless the party requesting it duly explains and justifies the ‘exceptional circumstances’ that prevented it from meeting the original time limit and the first extension and why a further extension is necessary. General, vague or standard explanations will not justify a second extension.

‘Exceptional circumstances’ entail events that are beyond reasonable control of the parties.

The party requesting an extension must explain and justify the exceptional circumstances that (a) prevented it from carrying out the required action during the previous two periods and (b) still prevent it from carrying it out, so that more time is needed.

Examples of justifications that can be accepted

- ‘Evidence is being gathered from distribution channels in several Member States / all our licensees / our suppliers. So far we have gathered documents from some of them but, due to the commercial structure of the company (as shown in the document enclosed), only recently have we been able to get in contact with the rest’.

- ‘In order to show that the mark has acquired distinctiveness through use we started market polls at the beginning of the period (on date X). The fieldwork was, however, only concluded recently (as shown in the enclosed documents); as a consequence, we need a second extension to finish the analysis and prepare our submissions to the Office.’

- ‘Death’ is also considered an ‘exceptional circumstance’. The same applies to serious illness, provided that no reasonable substitution was available.
• Finally, ‘exceptional circumstances’ also include ‘force majeure’ situations. ‘Force majeure’ is defined as a natural and unavoidable catastrophe that interrupts the expected course of events. It includes natural disasters, wars and terrorism, and unavoidable events that are beyond the party's control.

4.1.4 Continuation of proceedings

| Article 82 CTMR |
| Communication CTMR No 6/05 of the President of the Office |

The expressions ‘further processing’ and ‘continuation of proceedings’ are equivalent and are used indistinctly in these Guidelines.

Article 82 CTMR provides for the availability of further processing when time limits have been missed.

Communication No 6/05 of the President of the Office of 16/09/2005 on further processing indicates that Article 82 CTMR excludes various time limits laid down in certain articles of the CTMR. With a few exceptions, most of these references are self-explanatory.

• By excluding the time limits laid down in Article 81 CTMR, Article 82 CTMR excludes double relief for the same time limit.

• By excluding the time limits referred to in Article 112 CTMR, Article 82 CTMR provides that the three-month time limit within which conversion must be requested and the conversion fee must be paid is not available for further processing. All other time limits fixed by the Office in the course of a conversion procedure are available.

• Article 82 CTMR further excludes the time limits laid down in Articles 41 and 42 CTMR.
  ○ The reference to Article 41 CTMR is to be interpreted in the same way as in Article 81(5) CTMR. Therefore, as regards Article 41 CTMR, only the opposition period and the time limit to pay the opposition fee is excluded from further processing, in accordance with the general rule that time limits which are not available for restitutio are also unavailable for further processing.
  ○ Article 42(1) CTMR lays down that the Office sets time limits for the parties to submit observations within the opposition procedure. Therefore, all the time limits set by the Office on the basis of Article 42(1) CTMR are excluded from further processing. This exclusion covers the time limits for the opponent to substantiate their opposition under Rule 19 CTMIR, the time limit laid down in Rule 20(2) CTMIR for the applicant to reply, the time limit under Rule 20(4) CTMIR for the opponent to rebut, as well as the time limits for any further exchange of arguments, if allowed by the Office (decision of 07/12/2011, R 2463/2010-1, ‘Pierre Robert/Pierre Robert’).
Pursuant to Rule 50(1), 2nd sentence CTMIR, these (or the corresponding) 
time limits remain excluded in second instance proceedings before the 
Boards of Appeal.

None of the other time limits during the opposition procedure are referred to in 
Article 42 CTMR and, therefore, they are not excluded from further processing. Consequently, the Office will grant further processing for:

- the time limit under Article 119(6) CTMR and Rule 16(1) CTMIR to translate 
  the notice of opposition;
- the time limit under Rule 17(4) CTMIR to remedy deficiencies that affect the 
  admissibility of the opposition;
- the time limit under Rule 22(1) CTMIR for the applicant to request that the 
  opponent proves the use of its earlier mark;
- the time limit under Rule 22(2) CTMIR for the opponent to submit proof of 
  use of its earlier mark;
- the time limit under Rule 22(6) CTMIR to translate proof of use.

- Article 82 CTMR does not exclude any of the time limits that apply in proceedings 
  for revocation or declaration of invalidity.

The party seeking continuation of proceedings must make the request, which is subject 
to a fee as established in the CTMFR, within two months of the expiry of the original 
time limit and complete the omitted act by the time the request for continuation is 
received.

There can be no extension or continuation of the two-month deadline. There is no 
substantive requirement to be fulfilled such as when requesting restitutio in integrum.

4.1.5 Restitutio in integrum

A party to proceedings before the Office may be reinstated in its rights (restitutio in 
integrum) if it was, in spite of all due care required by the circumstances having been 
taken, unable to observe a time limit vis-à-vis the Office, provided that the failure to 
observe the time limit had the direct consequence, by virtue of the provisions of the 
Regulations, of causing the loss of any right or means of redress.

For further information see the Guidelines, Part A, General Rules, Section 8, Restitutio 
in Integrum.