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

PART B

EXAMINATION

SECTION 1

PROCEEDINGS
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1 Introduction: General Overview of Examination Proceedings

This part of the Guidelines outlines the examination procedure from filing to publication of the Community trade mark (CTM) application.

Once the CTM application has been filed, a provisional filing date is accorded and the Office issues a receipt. At this early stage, the Office only checks if certain filing date requirements of the Regulation have been fulfilled. The filing date can only be accorded when the application fee has been paid.

The receipt should be carefully checked by the applicant and the Office should be notified as soon as possible of any incorrect data. The applicant can only correct data that have an impact on the filing date, such as the applicant’s name, the representation of the mark and the list of goods and services, if the Office is notified on the same date as the incorrect data was submitted. After this date, any amendment is subject to the provisions of the CTMR and CTMIR, in particular, Article 17 CTMR and Article 43 CTMR. For further details, see Section 5 below and the Guidelines, Part B, Examination, Section 2, Formalities.

After the receipt has been issued, the Office carries out a language check of the verbal elements of the mark in all official EU languages, followed by a Community search.

Payment of the application fee and national search fee (if applicable) is validated at the latest one month after the filing of the CTM application. If the applicant has applied for a national search and paid the relevant fee, the Office forwards the application to the Offices of the Member States that perform national searches. For further information on searches, see Section 2 below. For further information on fees, see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

During examination proceedings the Office examines the following: filing date, formalities, classification, priority and/or seniority where applicable, the regulations governing use of the mark for collective marks, and absolute grounds for refusal. All these examination steps can be carried out in parallel as there is no strict sequence in examination proceedings.

Any deficiency is notified to the applicant, who is given two months within which to remedy the deficiency and/or submit observations. Any decision partially or wholly refusing a CTM application must give the grounds on which the CTM application is refused and inform the applicant of the possibility of appeal. For further details, see paragraphs 3.2. and 3.2.1. below.

Applications that comply with the requirements of the Regulation are accepted for publication and sent for translation into all official EU languages.

The last step in the examination procedure is publication of the application in Part A of the CTM Bulletin. Publication takes place one month after notification of the search reports (Community search and national search if applied for), giving the applicant the opportunity, if it so wishes, to abandon its application. For further details on publication, see Section 4 below.
2 Search

| Article 38 CTMR  
Rule 5a and Rule 10 CTMIR  
Communications 4/99, 5/00 and 4/01 of the President of the Office |

The search report identifies earlier rights that could conflict with the CTM application. However, even if the search report does not indicate any similar earlier rights, an opposition could still be filed against the CTM application after its publication.

The results of the search report are for information purposes only and to give the applicant the option of withdrawing the CTM application before its publication. Surveillance letters inform holders of earlier trade marks about new, similar trade mark applications.

Figurative elements are classified under the Vienna Classification.

2.1 Community search

After issuing the receipt, the Office draws up a Community search report covering:

1. CTM applications with a filing date or priority date earlier than that of the application in question;
2. Community trade marks already registered; and
3. prior international registrations designating the European Union.

The Community search takes into account the filing date, the verbal elements of the trade mark, the figurative elements of the mark (if applicable) and the classes of goods and services according to the Nice Classification. The search is designed to identify similar earlier marks filed for the same classes or classes considered by the Office as containing similar goods and/or services.

The Community search report is sent to the applicant in a standard letter. Once the new application has been published, the Office sends a surveillance letter to the holders of earlier Community trade marks cited in the search report.

2.2 National search

CTM applications that include a valid request for national searches are sent to the participating national offices once a filing date has been accorded and the classification has been validated. A request is deemed valid if it is made at the time of filing and the relevant fee has been paid.

National search reports are prepared by the offices that participate in the search system.

A request for national searches implies that all participating national offices will carry out the search within two months in accordance with Rule 5a CTMIR. This all-or-nothing policy means that the applicant cannot select which participating offices carry out the search.
Holders of international registrations designating the EU that wish to apply for national searches must send the request and pay the relevant fee to OHIM within one month of the date of notification of the IR from WIPO.

Responsibility for the format and content of the national search report lies with the national offices. The Office’s role is limited to receiving the national reports and sending them together with the Community search report. The applicant is free to request further information directly from the national offices.

3 General Principles Concerning Examination Proceedings

This section describes only the procedural aspects of examining Absolute Grounds (AG) for refusal. For substantive aspects of examining Absolute Grounds for refusal, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal and Community Collective Marks.

The Community Trade Mark Regulation (CTMR) is intended to enable proprietors to register a right that is valid throughout the European Union insofar as it does not impinge on the rights of others. Although rights can only be conferred in accordance with the provisions of the CTMR, the Office’s function is not to obstruct but rather facilitate applications.

During the examination of each application the trade mark and the goods or services of the application must be taken into account. The Office has to bear in mind the nature of the trade concerned, the manner in which the goods or services are provided and the relevant public, for example whether it consists of specialists or the general public.

3.1 Procedural aspects concerning third-party observations and review of absolute grounds

Article 40 CTMR
Communication 2/09 of the President of the Office

Observations relating to the existence of an absolute ground for refusal can be made by third parties once an application has been published. Third-party observations received before a CTM application is published are dealt with in the course of the examination of absolute grounds for refusal. The Office accepts observations received within the opposition period (three months from the date of publication) or filed before pending oppositions are closed. The observations must be filed in one of the languages of the Office, namely Spanish, German, English, French or Italian.

The Office issues a receipt to the observer confirming that the observations have been received and have been forwarded to the applicant. The observer does not become a party to the proceedings before the Office but can consult the online search tools in order to check the status of the relevant CTM application. The Office does not inform the observer of any action taken, namely of whether or not the observations gave rise to an objection.

All observations are forwarded to the applicant, who is invited to submit comments where appropriate. The Office considers whether the observations are well founded,
that is, whether an absolute ground for refusal exists. If so, the Office issues an objection and may refuse the CTM application if the objection is not overcome by the applicant's comments or by restriction of the list of goods and services.

If an issue raised in observations has already been considered during the examination of an application, it is unlikely to give rise to serious doubts after publication.

The Office may also re-open the examination on absolute grounds on any other ground and at any time prior to registration, for example when third-party observations are filed before publication of the application or when the Office itself finds that a ground for refusal has been overlooked. After publication of the application, this option should be exercised only in clear-cut cases.

3.2 Decisions

In all cases where the Office issues decisions against applicants the grounds for the decision must be given. These must address any arguments raised by the applicant in its observations insofar as they are pertinent. Decisions must not only refer to appropriate parts of the CTMR and CTMIR but also, except in the most self-evident cases (for example where a document is a missing or a fee has not been paid), give explicit reasons.

Where, for example, a decision is given on the basis of internet searches, the Office must provide the applicant with proof of those searches.

3.2.1 Appeals

Applicants have a right to appeal against a decision that terminates proceedings and that adversely affects them. For practical purposes any decision issued by the Office that terminates proceedings and is not accepted by the applicant falls into this category. Any written communication of such a decision must also inform the applicant that the decision can be appealed within two months.

Appeals have suspensive effect. Within the period in which an appeal can be lodged the Office should not take any step that cannot easily be reversed (e.g. publication or entry in the Register). The same goes for the period up until a final decision is taken in the event that the case is brought before the GC or CJEU by an action under Article 65.

3.3 International registrations designating the European Union

Details about examination of a CTM application resulting from the transformation of an international registration designating the European Union are given in the Guidelines, Part M, International Marks.
Publication takes place once the search reports have been sent to the applicant, provided that the application fulfils all the conditions required for acceptance.

Applications are published in all official EU languages.

The examiner must ensure that the following details, where applicable, are available:

(a) application file number
(b) filing date
(c) reproduction of the trade mark
(d) indication of collective mark
(e) indication of the mark type other than word marks, for example, figurative marks, three-dimensional marks, holograms, sound marks, colour per se marks, other marks
(f) description of the mark
(g) colour indication(s)
(h) figurative elements under the Vienna Classification
(i) disclaimer
(j) acquisition of distinctive character through use
(k) applicant’s name, address and nationality
(l) representative’s name and address
(m) first and second language
(n) goods and services under the Nice Classification
(o) priority data if applicable
(p) exhibition priority data
(q) seniority data
(r) transformation data.

Once all these elements are in order and the translation into all EU official languages has been received, the application is dispatched to the Publications Sector.

5 Amendments to the CTM Application

This part of the Guidelines only covers the relevant issues concerning amendments to a CTM application.

For amendments to registered Community trade marks, see the Guidelines, Part E, Register Operations, Section 1, Changes in a registration.
5.1 Withdrawal of the CTM application

Article 43, Articles 58(1), 64(3) and Article 119 CTMR

5.1.1 Declaration of withdrawal

A CTM application can be withdrawn at any time up until a final decision is taken on its subject matter.

After the Office’s first-instance decision, at appeal level, an application can be withdrawn within the two-month appeal period even if no appeal was actually filed or up until the appeal has been decided by the Board of Appeal; this applies both to ex parte and inter partes proceedings (decision of 27/09/2006, R 0331/2006-G – ‘Optima’).

At the level of the General Court (GC), an application can be withdrawn within the two-month appeal period or up until completion of the appeal process before the GC.

At the level of the Court of Justice (CJEU), an application can be withdrawn within the two-month period for filing an appeal before the CJEU or before the CJEU has issued a final and binding decision (order of 18/09/2012, C-588/11, ‘OMNICARE’).

When the case is pending before the GC or the CJEU, the withdrawal must be requested before the Office (not the GC or CJEU). The Office then informs the GC or CJEU whether or not it finds the withdrawal acceptable and valid, but the withdrawal will not be effected until the GC or the CJEU has rendered a final decision on the issue (by analogy, see judgment of 16/05/2013, T-104/12, ‘VORTEX’).

Any declaration of withdrawal filed after the expiry of the appeal period is inadmissible.

The declaration of withdrawal must be made in writing. No special form is provided by the Office. The declaration is not subject to a fee.

The declaration of withdrawal can be made in the first or second language indicated by the applicant in its CTM application.

The same applies during opposition proceedings. However, for details of procedure where a restriction is made in a language other than the language of the opposition procedure, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters.

For details on restrictions see paragraph 5.2 below.

5.1.2 Unconditional and binding character of the declaration

A declaration of withdrawal becomes effective upon receipt by the Office, provided that no withdrawal of the declaration reaches the Office that same day.

This means that if a declaration of withdrawal and a letter withdrawing that declaration both reach the Office on the same day (regardless of the actual time of receipt), the latter annuls the former.

Once it becomes effective, a declaration cannot be withdrawn.
A declaration of withdrawal is void where it contains conditions or time limitations. For example, it must not require the Office to take a particular decision or, in opposition proceedings, require the other party to make a procedural declaration. Such a requirement is instead seen as a mere suggestion for resolving the case; the Office informs the opponent accordingly and may invite the parties to come to an amicable settlement. Furthermore, a declaration does not become effective if it is made in respect of some goods and/or services (partial withdrawal) on the condition that the Office accepts the application for the remaining goods and/or services. Instead, such a declaration is seen as a suggestion for the Office to arrive at an acceptable list of goods and services.

Where an applicant reacts to an official action by filing a restricted list of goods and services (partial withdrawal), the Office verifies whether the applicant is declaring the unequivocal withdrawal of the remaining goods and services or whether the amended list of goods and services is a proposal or counterproposal by the applicant subject to the Office’s agreement.

5.1.3 Action to be taken

The Office will process a declaration of withdrawal, ensure publication of the full or partial withdrawal in the Bulletin if the CTM application was already published, and close the file of the CTM application in the event of a full withdrawal.

For the consequences of full or partial withdrawal on opposition procedure, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters.

Detailed information concerning the refund of application fees can be found in the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

5.2 Restriction of the list of goods and services in a CTM application

**Articles 43 and 119 CTMR**

The applicant may restrict the list of goods and services of its CTM application at any time, either of its own volition, or in response to an objection regarding classification or absolute grounds, or in the course of opposition proceedings.

In principle, declarations of restrictions follow the same rules as declarations of withdrawals; see paragraph 5.1 above.

When the case is pending before the General Court (GC) or the Court of Justice (CJEU), the restriction must be filed with the Office (not the GC or the CJEU). The Office then informs the GC or the CJEU whether or not it finds the restriction acceptable and valid, but the restriction is not applied until the GC or the CJEU has rendered a final decision on the issue (by analogy, see judgment of 16/05/2013, T-104/12, 'VORTEX').
5.2.1 Procedural admissibility of a restriction

The restriction must be procedurally admissible; see paragraph 5.1.2 above.

As a matter of principle, a restriction becomes effective on the date on which it is received by the Office. The restriction can only be withdrawn if the withdrawal is received on the same date as the restriction itself.

Two requirements must be met in order for a restriction to be acceptable:

1. The new wording must not constitute an extension of the list of goods and services.

2. The restriction must constitute a valid description of goods and services and apply only to acceptable goods or services that appear in the original CTM application. For further details on restrictions of a CTM application, see the Guidelines, Part B, Examination, Section 3, Classification.

Otherwise, the Office must refuse the proposed restriction and the list of goods and services will remain unchanged.

5.3 Other amendments

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<th>Article 43 CTMR</th>
<th>Rules 13 and 26 CTMIR</th>
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This section and the legal provisions cited above solely concern amendments of the CTM application requested by the applicant on its own motion and not amendments or restrictions made as the consequence of an examination, opposition or appeal procedure by virtue of the decision of an examiner, Opposition Division or Board of Appeal.

Likewise, this section does not apply to the correction of errors in the Office’s publications, which is carried out ex officio pursuant to Rule 14 CTMIR.

Amendments require a written request in the first or second language indicated by the applicant in its CTM application. They are not subject to any fees.

The following elements of a CTM application may be amended:

- the name and address of the applicant or representative (see paragraph 5.3.1 below);
- errors of wording or of copying, or obvious mistakes, provided that correction does not substantially change the trade mark (for further details on such amendments, see the Guidelines, Part B, Examination, Section 2, Formalities);
- the list of goods and services (see paragraph 5.2 above).
5.3.1 Name, address and nationality of applicant or representative

Rule 1(1)(b) and (e), Rules 26 and 84 CTMIR
Article 1(1)(b), Article 19(7) and Article 69(2)(d) CDIR

The name and address of an applicant or representative may be amended freely, provided that

- as regards the name of an applicant, the change is not the consequence of a transfer,

and

- as regards the name of a representative, the representative is not being substituted by another representative.

The indication of the nationality of a legal person may also be amended freely, provided that it is not the consequence of a transfer.

A change in an applicant's name that does not affect the applicant's identity is an acceptable change, whereas a change in the applicant's identity is a transfer. For details and the applicable procedure in the event of doubt as to whether the change is considered to be a transfer, see the Guidelines, Part E, Register Operations, Section 3, CTMs as Objects of Property, Chapter 1, Transfer.

Changes to a representative's name are also limited to those that do not affect the identity of the appointed representative, for example where there is a change in the name (through marriage/divorce) of a representative or the name of an association of representatives. Such changes of name must be distinguished from the substitution of one representative by another, which is subject to the rules governing the appointment of representatives. For details concerning representatives, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

Changes of name, address or nationality may be the result of changed circumstances or of an error made at the time of filing.

The change of name and address must be requested by the applicant or its representative and must contain the CTM application number, as well as the name and address of the applicant or the representative, both as recorded on the file and as amended.

No proof or evidence of the change is necessary. Requests for change of name or address are not subject to any fees.

The applicant must indicate its name and official address in an application in a specific format according to the above-cited legal provisions, and may change it later using the same format. Both the name and the address will be registered.

Legal persons can only have one official address. In case of doubt, the Office may ask for evidence of the legal form, the State of Incorporation and/or the address. The official name and address are copied as the address for service by default. Ideally, an applicant should have only one address for service. Changes to the applicant's official designation or official address will be registered for all CTM applications, registered
Community trade marks and Registered Community Designs and, unlike the address for service, cannot be recorded just for specific portfolios of rights. In principle, these rules apply for representatives by analogy.

5.3.2 Other elements of an application

Other elements of a CTM application may also be changed, such as the representation, the type of mark, the description of the mark and the disclaimers.

For example, in priority claims, obvious mistakes in the indication of the country in which, and the date on which, the earlier mark was filed may be corrected, since the priority document will obviously show the correct version.

For further details on these changes, see the Guidelines, Part B, Examination, Section 2, Formalities.

5.3.3 Recordal and publication of amendments

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<th>Article 41(2) CTMR</th>
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If an amendment is allowed, it will be recorded in the file.

Where the CTM application has not yet been published, it is published in the CTM Bulletin in the amended form.

Where the CTM application has already been published and (only) if the amendment concerns the list of goods and services or the representation of the mark, the CTM application is published in its amended form in the CTM Bulletin. The publication of the amended application opens a new opposition period of three months.

Any other amendments are not published separately but appear in the publication of the registration.

5.4 Division of the CTM application

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<th>Article 44 CTMR</th>
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<td>Rule 13a CTMIR</td>
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A CTM application can be divided into different parts not only as the result of a partial transfer (see the Guidelines, Part E, Register Operations, Section 3, CTMs as Objects of Property, Chapter 1, Transfer), but also on the CTM applicant’s own motion. Division is particularly useful for isolating a disputed CTM application for certain goods or services while maintaining the original application for the remainder. For information on the division of CTMs, see the Guidelines, Part E, Register Operations, Section 1, Changes in a registration.

Whereas a partial transfer is free of charge and involves a change of ownership, a request for the division of a CTM application is subject to a fee and the CTM application remains in the hands of the same applicant. If the fee is not paid, the
request is deemed not to have been filed. The request can be made in the first or second language indicated by the applicant in its CTM application.

Division is not an option for international registrations under the Madrid Protocol designating the EU. The international register is kept at WIPO, and OHIM does not have the authority to divide an international registration designating the EU.

5.4.1 Requirements

A request for division must contain the following information:

- the file number of the CTM application to be divided;
- the name and address or name and ID number of the applicant;
- the list of goods and services for the divisional application, or, if more than one new application is to be created, for each divisional application;
- the list of the goods and services that will remain in the original CTM application.

Furthermore, the goods and services of the divisional application must not overlap with the list of goods and services of the original application.

The applicant will be notified of any deficiency in this regard and given two months to remedy it. If the deficiency is not remedied within this time limit, the request for division will be refused.

There are certain periods during which, for procedural economy or to safeguard third-party rights, division is not admissible. These periods are outlined below.

1. While an opposition is pending, only the non-contested goods and services may be divided off. The same applies if the case is pending before the Boards of Appeal or the Courts. The Office interprets the legal provisions cited above as preventing the applicant from dividing off some or all of the contested goods to form a new application, with the effect that the opposition proceedings have to be split. If such a request for division is made, the applicant is given the opportunity to amend it by dividing off the non-contested goods and services.

2. Division is not admissible during the three-month opposition period following publication of the application. Allowing a division during this time would counteract the aim of not splitting an opposition procedure and frustrate third parties, who have to rely on the CTM Bulletin to know what to oppose.

3. Division is not admissible during the period before a filing date has been accorded either. This does not necessarily coincide with the first month following filing. For further details on the filing date, see the Guidelines, Part B, Examination, Section 2, Formalities.

For all practical purposes, in the period following publication of the application, a division is only admissible if an opposition has been entered against the application and only for the non-contested part. The aim of the provisions cited is to allow the
applicant to register its mark for the non-contested goods quickly without having to wait for the outcome of a lengthy opposition procedure.

5.4.2 Acceptance

Article 44(6) CTMR

If the Office accepts the declaration of division, a new application is created as of the date of acceptance and not retroactively as of the date of the declaration.

The new application keeps the filing date as well as any priority and seniority dates. The seniority effect will then become partial.

All requests and applications submitted, and all fees paid, prior to the date on which the Office receives the declaration of division are deemed to have been made or paid also for the divisional application. Fees duly paid for the original application are, however, not refunded.

The practical effects of this provision can be exemplified as follows:

- Where an application for the registration of a licence was made and payment of the registration fee was received by the Office prior to the declaration of division, the licence will be registered against the original registration and recorded in the file of the new registration. No further fees need be paid.

- Where a CTM application claiming six classes is to be divided into two applications of three classes each, no class fees are payable as from the date the Office receives the declaration of division. However, fees paid prior to that date cannot be refunded.

Where the division is not accepted, the old application remains unchanged. It does not matter whether:

- the declaration of division was deemed not to have been filed because no fee had been paid;

- the declaration was refused because it failed to comply with the formal requirements;

- the declaration was found inadmissible because it was filed during one of the periods in which division is not admissible.

The worst-case scenario for the applicant is that the declaration of division is not accepted, but this never affects the original application. The applicant can repeat the declaration of division later, subject to a new fee.

5.4.3 New file and its publication

A new file has to be created for the divisional application, to contain all the documents that were on file for the original application, all correspondence related to the
declaration of division and all future correspondence for the new application. Inspection of this file will be unrestricted under general rules.

If the declaration of division concerns a CTM application that is not yet published, both the divisional and the original application are published separately and in the normal way, without any express reference to each other.

If the declaration of division concerns a CTM application that is already published, the fact that there has been a division is published with reference to the original application. The new application must also be published with all the usual particulars; however, no new opposition period will be opened. Division is admissible only for goods for which an opposition period has already opened but not been made use of.