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

RENEWAL OF REGISTERED COMMUNITY DESIGNS
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1. **Introduction**

There are two ways of applying for a registered Community design: either (i) via a ‘direct filing’ at the Office or a national Office (Article 35 et seq. CDR) or (ii) via an international registration filed with the International Bureau of the World Intellectual Property Organisation and designating the European Union (Article 106a et seq. CDR).

The purpose of the Guidelines is to explain how, in practice, the requirements of the Community Design Regulation\(^1\) (CDR), the Community Design Implementing Regulation\(^2\) (CDIR) and the Fees Regulation\(^3\) (CDFR) are applied by the Office in respect of renewal procedures relating to ‘direct filings’ of Community designs (see paragraphs 3 to 8 below). The Guidelines are not intended to, and cannot, add to or subtract from the legal contents of the Regulations.

Paragraph 9 below makes reference to the relevant instruments applicable to the renewal of international registrations designating the European Union.

2. **FRAUD WARNING**

2.1. **Private companies sending misleading invoices**

The Office is aware that users in Europe are receiving an increasing amount of unsolicited mail from companies requesting payment for trade mark and design services such as renewal.

A list of letters from firms or registers, which users have complained are misleading, is published on the Office website. Please note that these services are not connected with any official trade mark or design registration services provided by IP Offices or other public bodies within the European Union such as OHIM.

If you receive a letter or invoice please check carefully what is being offered to you, and its source. Please note that the **OHIM never sends invoices to users or letters requesting direct payment for services** (see the Guidelines, Part A, General Rules, Section 3, Payment of fees, cost and charges).

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2.2. Renewal by unauthorised third persons

The Office is also aware that fraudsters have targeted the e-renewal module, applying for renewal without proprietors’ consent and thus blocking renewal via the module for persons legitimately authorised to renew in this way. The technical block is designed to prevent a renewal being paid for twice. If, when you file a request for e-renewal, you discover that the mark is ‘blocked’ because renewal has already been requested, please contact the Office.

2.3. Contact

If you have any doubts or detect any new cases, please check with your legal advisers or contact us by telephone on +34 965 139 100 or by e-mail at information@oami.europa.eu

3. Term of Protection

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<th>Articles 12, 38 CDR</th>
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<td>Article 10 CDIR</td>
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The term of protection of a registered Community design (RCD) is five years from the date of filing of the application (Article 12 CDR).

The date of filing of the application is determined according to Article 38 CDR and Article 10 CDIR (see the Guidelines concerning Applications for Registered Community Designs, Section 2, ‘Allocation of a filing date’).

Registration may be renewed for one or more periods of 5 years each, up to a total of 25 years from the date of filing.

4. Notification of Expiry of Registration

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<th>Article 13(2) CDR</th>
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<td>Article 21 CDIR</td>
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At least six months before the expiry of the registration, the Office will inform:

- the holder of the Community design and
- any person having a registered right in respect of the Community design

that the registration is approaching expiry. Persons having a registered right include the holders of a registered licence, the proprietors of a registered right in rem, the creditors of a registered levy of execution or the authority competent to act on behalf of the proprietor in insolvency procedures.

Failure to give such information does not affect the expiry of the registration and does not involve the responsibility of the Office.
5. **Fees and Other Formal Requirements for the Request for Renewal**

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<th>5.1 <strong>Persons who may submit a request for renewal</strong></th>
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**Article 22(8), Articles 65, 66, 67, Article 68(1) (e) CDIR**

The general rules concerning communications to the Office apply, which means that the request for renewal may be submitted as follows:

- by electronic means available on the OHIM Website (e-renewal). Entering the name and surname in the appropriate place on the electronic form is deemed to be a signature. Using e-renewal offers advantages such as the receipt of immediate electronic confirmation of the renewal request automatically or the use of the renewal manager feature to complete the form quickly for as many registered Community designs as needed.

- by transmitting a signed original form by fax, mail, or by any other means. A standard form is available on the OHIM website. Forms have to be signed but annexes need not be.

It is strongly recommended to renew Community design registrations by electronic means ('e-renewal'). The process of electronic renewal automatically checks and validates the requirements laid down in the CDIR.

A single application for renewal may be submitted for two or more designs, whether or not part of the same multiple registration, upon payment of the required fees for each of the designs, provided that the Community design holders or the representatives are the same in each case.

For Fees see paragraph 5.4, for Compliance with formal requirements see paragraph 6.2.2.

**5.1 Persons who may submit a request for renewal**

*Article 13(1) CDR*

Requests for renewal may be submitted by:

- the registered proprietor of a Community design;
- the successor in title where a Community design has been transferred, with effect from when the request for registration of the transfer was received by the Office;
- a person authorised by the proprietor of a Community design to do so. Such a person may, for instance, be a registered licensee, a non-registered licensee or any other person who has obtained the proprietor's authorisation to renew the Community design;
- a representative acting on behalf of any of the above persons.

Persons obliged to be represented before the Office pursuant to Article 77(2) CDR can submit a request for renewal directly.

When the renewal request is submitted by a person other than the registered proprietor, an authorisation will have to exist in its favour; however, it does not need to be filed with the Office unless the Office requests it. For example, if the Office receives
fees from two different sources, the owner will be contacted in order to know which person is authorised to file the renewal request. Where no reply is received from the owner, the Office will validate the payment that reached the Office first (see, by analogy, judgment of 12/05/2009, T-410/07, ‘Jurado’, paras 16-24).

5.2 Content of the request for renewal

Article 22(1) CDIR

A request for renewal of registration must contain the following:

- The name of the person requesting renewal (that is, the Community design proprietor or an authorised person or representative; see paragraph 5.1). If the Office has allocated an ID number to the applicant for renewal, it is sufficient to indicate this number.
- The registration number of the registered Community design. This number is always composed of a nine-digit root, followed by a four-digit ending (e.g. XXXXXXXX-YYYY).
- In the case of a multiple registration, an indication that renewal is requested for all the designs covered by the multiple registration or, if the renewal is not requested for all the designs, an indication of those for which it is requested.

Where the Community design holder has appointed a representative, the name of the representative should be mentioned. If the representative is already on record, the indication of their ID number is sufficient. If a new representative is appointed in the request for renewal, the name and address must be given in accordance with Article 1(1)(e) CDIR

Payment alone can constitute a valid request for renewal providing such payment timely reaches the Office and contains the name of the payer, the registration number of the Community design and the indication ‘renew’. In such circumstances no further formalities need be complied with (see The Guidelines Concerning Proceedings Before The Office for Harmonization In The Internal Market (Trade Marks And Designs) Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

5.3 Languages

Article 80(b) CDIR

The request for renewal may be filed in any of the five languages of the Office. This language becomes the language of the renewal proceedings. However, when the request for renewal is filed by using the form provided by the Office pursuant to Article 68 CDIR, such a form may be used in any of the official languages of the Community, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.
5.4 Fees

The fees payable for the renewal of a Community design consist of:

- a renewal fee, which, where several designs are covered by a multiple registration, is proportionate to the number of designs covered by the renewal;
- any additional fee applicable for late payment of the renewal fee or late submission of the request for renewal.

The amount of the renewal fee, per design, whether or not included in a multiple registration, is as follows:

- for the first period of renewal: EUR 90
- for the second period of renewal: EUR 120
- for the third period of renewal: EUR 150
- for the fourth period of renewal: EUR 180.

The fee must be paid within a period of six months ending on the last day of the month in which protection ends (see paragraph 5.5 below).

The fee may be paid within a further period of six months following the last day of the month in which protection ends, provided that an additional fee of 25% of the total renewal fee is paid (see paragraph 5.5.2 below).

When the payment is made by transfer or payment to an Office bank account, the date on which payment is deemed to have been made is the date on which the amount is credited to the Office’s bank account.

5.5 Time limits

5.5.1. Six months period for renewal before expiry (basic period)

The request for renewal and the renewal fee must be submitted within a period of six months ending on the last day of the month in which protection ends (hereinafter referred to as ‘the basic period’).

If this time limit expires on a day on which the Office is not open for receipt of documents or on which ordinary mail is not delivered in Alicante, it will extend until the first day thereafter on which the Office is open for receipt of documents and on which ordinary mail is delivered. Other exceptions are provided for at Article 58(2) and (4) CDIR.

For example, where the Community design has a filing date of 01/04/2013, the last day of the month in which protection ends will be 30/04/2018. Therefore, a request for
renewal must be introduced and the renewal fee paid between 01/11/2017 and 30/04/2018 or, where this is a Saturday, Sunday or other day on which the Office is closed or does not receive ordinary mail, the first following working day on which the Office is open to the public and does receive ordinary mail.

5.5.2 Six months grace period following expiry (grace period)

Where the relevant time limit is not met, the request for renewal may still be submitted and the renewal fee may still be paid within a further period (hereinafter the ‘grace period’) of six months following the last day of the month in which the basic period ends, provided that an additional fee of 25% of the total renewal fee is paid within the grace period (see Article 13.3 CDR). Thus, renewal will only be successfully effected if payment of all fees (renewal fees and additional fees for late payment, where applicable) reaches the Office within the grace period.

In the above example, the grace period during which a request for renewal may still be introduced upon payment of the renewal fee plus the additional fee is counted from the day after 30/04/2018, namely from 01/05/2018, and ends on 31/10/2018 or, if 31/10/2018 is a Saturday, Sunday or other day on which the Office is closed or does not receive ordinary mail, the first following working day on which the Office is open to the public and does receive ordinary mail. This applies even if, in the above example, 30/04/2018 was a Saturday or Sunday; the rule that a time limit to be observed vis-à-vis the Office is extended until the next working day applies only once and to the end of the first period, not to the starting date of the grace period.

Fees which are paid before the start of the first six-month period will not, in principle, be taken into consideration and will be refunded.

5.6 Means of payment

The admissible means of payment are bank transfers, credit cards (only if renewal is applied for electronically via the e-renewal module) and deposits in current accounts held with the Office. Payment cannot be made by cheque. Fees and charges must be paid in euros.

Where the Community design proprietor has a current account at the Office, the fee will be debited automatically from the account once a request for renewal is filed. Unless different instructions are given, the renewal fee will be debited on the last day of the six-month time limit provided for in Article 13(3) CDR, i.e. on the last day of the month in which protection ends.

If a request for renewal is filed late (see paragraph 5.5.2 above), the debit will take place, unless different instructions are given, with effect from the day on which the belated request was filed, and will be subject to a surcharge.

Where the request is submitted by a professional representative within the meaning of Article 78 CDR, who represents the Community design proprietor, and the
representative has a current account before the Office, the renewal fee will be debited from the representative’s current account.

Payment may also be made by the other persons identified in paragraph 5.1 above.

Payment by debiting a current account held by a third party requires explicit authorisation from the holder of the current account that the account can be debited for the fee in question. In such cases, the Office will check if authorisation has been given. If none has been given, a letter will be sent to the renewal applicant asking them to submit the authorisation to debit the third party account. In such cases, payment is considered to be made on the date the Office receives the authorisation.

Where the fees (renewal fees and, where applicable, additional fee for late payment) have been paid, but the registered Community design is not renewed (i.e. where the fee has been paid only after expiry of the grace period, or where the fee paid amounts to less than the basic fee plus the fee for late payment/late submission of the request for renewal, or where certain other deficiencies have not been remedied; see paragraph 6.2.2 below), the fees in question will be refunded.

6 Procedure before the Office

6.1 Competence

Article 104 CDR

The Operations Support Department is responsible for treating renewal requests and entering them in the Register.

6.2 Examination of formal requirements

Examination of a request for renewal is limited to formalities as follows.

6.2.1 Observance of time limits

(a) Before expiry of the basic period

Article 13 CDR
Article 22(3) CDIR
Article 5, Article 6(1) CDFR

Where the request for renewal is filed and the renewal fee paid within the basic period, the Office will record the renewal, provided the other conditions laid down in the CDR and CDIR are fulfilled.

Where no request has been filed before the basic period expires, but the Office receives a payment of the renewal fee that contains the minimum indications (name of the person requesting the renewal and the registration number of the renewed
Community design(s)), this will constitute a valid request and no further formalities will need to be complied with.

However, where no request for renewal has been filed but a renewal fee has been paid that does not contain the minimum indications (name of the person requesting the renewal and the registration number of the renewed Community design(s)), the Office will invite the Community design proprietor to submit a request for renewal and pay, where applicable, the additional fee for late submission of the request for renewal. A letter will be sent out as early as possible after receipt of the fee, so as to enable the request to be filed before the additional fee becomes due.

Where a request has been submitted within the basic period, but the renewal fee has not been paid or has not been paid in full, the Office will invite the person requesting renewal to pay the renewal fee or the remaining part thereof along with the additional fee for late payment.

If the request for renewal is filed by a person authorised by the proprietor of the Community design, the proprietor of the Community design will receive a copy of the notification.

(b) Before expiry of the grace period

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Where a request has been submitted within the additional grace period, but the renewal fee has not been paid or has not been paid in full, the Office will invite the person requesting renewal to pay the renewal fee or the remaining part thereof along with the additional fee for late payment.

Renewal will be effected only if payment of all fees (renewal fees and additional fee for late payment) is made or considered to be made before expiry of the grace period (see paragraphs 5.5 and 5.6 above).

(c) Situation where the proprietor or representative holds a current account

The Office will not debit a current account unless there is an express request for renewal. It will debit the account of the person performing the action (the Community design proprietor, the representative thereof or a third person).

Where the request is filed within the basic period, the Office will debit the renewal fees without any surcharge.

Where the request is filed within the additional period, the Office will debit the renewal fee along with a 25% surcharge (see paragraph 5.4).
6.2.2 Compliance with formal requirements

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Where a request for renewal does not comply with formal requirements (see paragraph 5 Fees and Other Formal Requirements for the Request for Renewal) but such deficiencies can be remedied, the Office will invite the renewal applicant to remedy the deficiencies within a time limit of two months. This time limit applies even if the additional period has already expired.

If the request for renewal is filed by a person authorised by the proprietor of the Community design, the proprietor of the Community design will receive a copy of the notification.

Where a request for renewal has been submitted by two different persons claiming to be authorised by the proprietor of the Community design, the Office will seek clarification on who is the authorised person by contacting the proprietor directly.

Where the deficiencies are not remedied before the relevant time limit expires, the Office will proceed as follows:

- If the deficiency lies in the fact that there is no indication of the designs of a multiple registration to be renewed, and the fees paid are insufficient to cover all the designs for which renewal is requested, the Office will establish which designs the amount paid is intended to cover. In the absence of any other criteria for determining which designs are intended to be covered, the Office will take the designs in the numerical order in which they are represented. The Office will check that the registration has expired for all designs for which the renewal fees have not been paid in part or in full.

- In the case of other deficiencies, the Office will check that the registration has expired and issue a notification of loss of rights to the proprietor or their representative or, where applicable, to the person requesting renewal and any person recorded in the Register as having rights in the Community design(s).

The proprietor may apply for a decision on the matter under Article 40(2) CDIR within two months.

Where the renewal fees have been paid but the registration is not renewed, those fees will be refunded.

6.3 Items not to be examined

No examination will be carried out on renewal in respect of the registrability of the design or correct classification of the design’s products. Nor will a registration be reclassified that was registered in accordance with an edition of the Locarno Classification no longer in force at the time of renewal. Such reclassification will not even be available at the proprietor’s request.
6.4 Alteration

Article 12(2) CDIR

As a matter of principle, since the representation of a Community design may not be altered after the filing of the application, the submission of additional views or withdrawal of some views at the time of renewal is not accepted.

Other changes that do not alter the representation of the Community design itself (changes of name, address, etc.), and which the owner wishes to have recorded in the Register when the registration is renewed, must be communicated separately to the Office according to the applicable procedures (see the Guidelines concerning Applications for Registered Community Designs, Section 10). They will be included in the data recorded at renewal only if they are recorded in the Register no later than the date of expiry of the Community design registration.

6.5 Restitutio in integrum

Article 67 CDR
Article 15 of the Annex to the CDFR

A party to proceedings before the Office may be reinstated in their rights (restitutio in integrum) if they were unable to observe a time limit vis-à-vis the Office in spite of all due care having been taken as required by the circumstances, 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 a right or means of redress.

Restitutio in integrum is only available upon application to the Office and is subject to a fee (EUR 200).

The application must be made within two months from removal of the cause of non-compliance but in any event not later than one year after expiry of the unobserved time limit. The act omitted must be completed within the same period.

In the case of failure to submit a request for renewal or to pay the renewal fee, the time limit of one year starts on the day on which the protection ends (basic period), not on the date of expiry of the further period of six months (additional period).

7 Entries in the Register

Article 13(4) CDR
Article 40, Article 22(6), Article 69(3)(m), Article 69(5), Article 71 CDIR

Where the request for renewal complies with all the requirements, the renewal will be entered in the Register.

The Office will notify the Community design proprietor or their representative of the renewal of the design, its entry in the Register and the date from which renewal takes effect.
Renewal of Registered Community Designs

The Office, where it has determined that the registration has expired, will inform the Community design proprietor or their representative and any person recorded in the Register as having rights in the Community design of the expiry of the registration and its cancellation from the Register.

The proprietor may apply for a decision on the matter under Article 40(2) CDIR within two months.

8 Date of Effect of Renewal or Expiry

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Renewal will take effect from the day following that on which the existing registration expires.

Where the Community design has expired and is cancelled from the Register, the cancellation will take effect from the day following that on which the existing registration expired.

9 Renewal of International Design Registrations Designating the European Union

| Article 17 of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (the ‘Geneva Act’)
| Article 12 CDR |

International registrations designating the European Union are protected for an initial term of 5 years from the date of the international registration, and may be renewed for additional terms of 5 years, up to a total term of 25 years from the date of registration.

Pursuant to Article 11a of the Annex to the CDFR, the individual renewal fees for an international registration designating the European Union, per design, are as follows:

- for the first period of renewal: EUR 31
- for the second period of renewal: EUR 31
- for the third period of renewal: EUR 31
- for the fourth period of renewal: EUR 31.

International registrations must be renewed directly at the International Bureau of WIPO in compliance with Article 17 of the Geneva Act (Article 22a CDIR). The Office will not deal with renewal requests or payments of renewal fees in respect of international registrations.

The procedure for the renewal of international marks is managed entirely by the International Bureau, which sends out the notice for renewal, receives the renewal fees and records the renewal in the International Register. When international registrations designating the EU are renewed, the International Bureau also notifies the Office.