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## COVER NOTE

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From: Secretary-General of the European Commission,  
signed by Mr Jordi AYET PUIGARNAU, Director

To: Mr Jeppe TRANHOLM-MIKKELSEN, Secretary-General of the Council of  
the European Union

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Subject: COMMISSION DELEGATED REGULATION (EU) .../... of 18.5.2017  
supplementing Council Regulation (EC) No 207/2009 on the European  
Union trade mark and repealing Commission Regulations (EC) No 2868/95  
and (EC) No 216/96

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Delegations will find attached document C(2017) 3212 final.

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Encl.: C(2017) 3212 final



Brussels, 18.5.2017  
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**COMMISSION DELEGATED REGULATION (EU) .../...**

**of 18.5.2017**

**supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96**

## EXPLANATORY MEMORANDUM

### **1. CONTEXT OF THE DELEGATED ACT**

The recent reform of the EU trade mark system aims to streamline procedures to apply and register an EU trade mark at the European Union Intellectual Property Office ('the Office'). It also aims to increase legal certainty by clarifying provisions and removing ambiguities. Under this reform, the powers conferred upon the Commission under Regulation (EC) No 207/2009 on the European Union trade mark ('the EU Trade Mark Regulation')<sup>1</sup> were aligned with Articles 290 and 291 of the Treaty on the Functioning of the European Union (TFEU). The delegated and implementing acts to be adopted on the basis of the new conferrals under the amended EU Trade Mark Regulation are to replace two existing regulations. These are Commission Regulation (EC) 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark,<sup>2</sup> and Commission Regulation (EC) 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonisation in the Internal Market.<sup>3</sup>

### **2. CONSULTATIONS PRIOR TO THE ADOPTION OF THE ACT**

The preparation of this delegated act included a consultation of user associations and an exchange with experts of Member State national offices within the European Trade Mark and Design Network. The draft text of the present delegated act was published for feedback on the Commission's Better Regulation portal. The Commission held several meetings of the relevant expert group, during which the delegated provisions were discussed among Member State experts. Observers from the European Parliament and the Office also participated. This consultation process brought a broad consensus on the draft delegated regulation.

### **3. LEGAL ELEMENTS OF THE DELEGATED ACT**

The provisions adopted under this Regulation aim to enhance the level of transparency, effectiveness and efficiency in proceedings before the Office, and to adapt them to market reality and the everyday needs of users. To fulfil these main goals, the provisions of this Regulation provide a high level of clarity, legal certainty, flexibility, and simplification in comparison with the previous legal framework. They have also been modernised to take account of developments and innovations in communications technology.

#### **3.1. Opposition proceedings (Articles 2, 5, 7 and 8)**

In relation to the procedure for filing and examining oppositions, this text presents, in a structured form, the requirements for admissibility and substantiation of an opposition on the consideration of the earlier marks or rights invoked. The text codifies the Office's practice, which has developed based on well-established case law. It also takes into account the extended relative grounds for refusal introduced by the EU Trade Mark Regulation.

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<sup>1</sup> Council Regulation (EC) No 207/2009 of 26 February on the European Union trade mark (OJ L 78, 24.3.2009, p.1), as amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ L 341, 24.12.2015, p. 21).

<sup>2</sup> Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ L 303, 15.12.1995, p.1).

<sup>3</sup> Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)(OJ L 28, 6.2.1996, p.11).

A noteworthy contribution to the modernisation and simplification of opposition proceedings is introduced in the text. It is the possibility of relying on evidence accessible from online sources recognised by the Office as an alternative method for substantiating some of the earlier marks or rights invoked. The wording of the relevant provision (Article 7(2)) guarantees the reliability of evidence. It also provides for flexibility in future developments of existing tools or the availability of different online tools in the future. By presenting this option, the intention is to extend to national and international marks a practice that has previously worked very efficiently for EU trade marks.

The present text helps to make the structure of the opposition procedure clearer. It distinguishes between two types of opposition: those that are not substantiated from the outset because no evidence to that effect is provided or the evidence submitted within the time limit set for that purpose is manifestly insufficient or irrelevant (Article 8(1)); and those where relevant evidence is initially filed within the time limit (Article 8(2)). This distinction, based on defined criteria inferred from case law of the Court of Justice, improves legal certainty and transparency.

Moreover, this clear structure of the proceedings opens the way to another important contribution built upon relevant case law of the Court of Justice. This is the express conferral of discretionary powers to the Office when considering belated evidence submitted to substantiate the opposition (Article 8(5)). This results in greater predictability and flexibility. The application of this discretionary power should be reasoned and, for legal certainty, some of the factors to be considered are listed within this text.

At the same time, the text codifies the Office's practice developed in the light of the existing case law confirming the availability of discretion. Discretion can be used when examining belated evidence of use, either in opposition proceedings (Article 10(7)) or in proceedings for the revocation or declaration of invalidity of EU trade marks (Article 19(1)).

### **3.2. Proceedings for revocation and declaration of invalidity (Articles 15, 16 and 20)**

As regards proceedings for revocation and declaration of invalidity of EU trade marks, the present text aligns the provisions applicable to such proceedings with those applicable to opposition proceedings. It retains only the differences justified by the different nature of the proceedings in question. In particular, the introduction of a list of admissibility requirements (Article 15) and of a new article on substantiation of these proceedings (Article 16) serves to underline the differences between these two procedural stages. This is recognised by Office practice and case law, including in proceedings for revocation and declaration of invalidity of EU trade marks and in proceedings to do away with ambiguous references contained in the previous law. That alignment with opposition proceedings will simplify the work of both users and examiners, who will no longer have to deal with two different sets of provisions. It will contribute to the goals of clarity, efficiency and increasing legal certainty.

The new assignment process under Article 18(2)(a) of the EU Trade Mark Regulation will follow the same procedural path as invalidity proceedings based on its Article 53(1)(b). Assignment will function in practice as an alternative remedy to invalidating a trade mark (Article 20). That measure simplifies proceedings and ensures high levels of effectiveness and efficiency. The present text also regulates the recording of the assignment in the Register after a decision granting it becomes final. This is required for reasons of legal certainty.

### **3.3. Appeals and organisation of the Boards of Appeal (Articles 21 to 48)**

The Office's 'first' instances (in particular examiners, opposition and cancellation divisions, Register department) take decisions as regards the registration of an EU trade mark according to the rules laid down in the EU Trade Mark Regulation. Some of these decisions can affect

parties adversely. The appeal procedure ensures that parties can request an independent, specialised and relatively inexpensive review of such decisions. To fulfil that important function, the rules on appeal proceedings must provide a particularly high level of legal certainty and predictability.

The present text builds upon the current implementing regulations, the relevant case law of the Court of Justice, and the best practice developed by the Boards of Appeal over the past decade. It specifies the provisions of the EU Trade Mark Regulation. It improves the transparency, legal certainty and efficiency of appeal proceedings, and user-friendliness, in the following respects:

- First, the text brings together in one single and comprehensive text the provisions that are currently spread across three different legal texts. These are the Regulation implementing the Regulation on the Community trade mark, the Regulation on the rules of procedure of the Boards of Appeal and (to a lesser extent) the decisions of the Boards of Appeal on their organisation.
- Second, the text:
  - *clarifies* the current implementing rules where necessary (e.g. with respect to the respective tasks of a Board’s chairperson and rapporteur);
  - *modernises* them in line with the case law of the Court of Justice (e.g. with respect to the admissibility of evidence filed after the expiry of the relevant time limit) and with best practices of the Boards (e.g. re-opening of the examination of a trade mark application on absolute grounds); and
  - where needed, *adapts* them to the changes made in the EU Trade Mark Regulation (e.g. abrogation of revision in *inter partes* cases or the Executive Director’s requests for the Grand Board’s reasoned opinion on questions on a point in law).

Other provisions clarify the procedure for allocating an appeal case, the content of the appellant’s statement of grounds and of the defendant’s response, and the scope of examination of an appeal.

- *Third*, the text creates the procedural framework for the defendant’s ‘cross-appeal’ under the second paragraph of Article 60 of the EU Trade Mark Regulation as amended. This improves legal certainty and transparency.
- *Lastly*, the text is carefully interlinked with the general rules on proceedings before the Office. These are also applicable in appeal proceedings unless specific rules justified by the particular nature of the appeal proceedings apply. This avoids unnecessary duplication of procedural provisions applicable before the Office and limits the corresponding risk of confusion, misinterpretations and ‘accidental’, thus unjustified, divergences.

### **3.4. Language regime (Article 7(4), 10(6) and 13(1))**

As regards the language regime (including translations) applicable to the evidence submitted in all proceedings before the Office, the new text introduces a language regime (including translations) depending on the kind of evidence of substantiation involved. Evidence of substantiation can be in the form of certificates of filing, registration and renewal or provisions of relevant law. Such evidence has to be submitted in the language of the proceedings or its translation within the time limit set for the submission of the original. However, for other evidence, the general provisions set out in Article 24 of Implementing Regulation (EU) .../... would apply. In this case, their translation into the language of the

proceedings will have to be supplied only if the Office so requires and within the period that it determines for the said purpose. This brings the translation requirements for this second set of evidence in line with the regime currently applicable to proof of use. This new system reduces the burden (including cost) on the parties involved and speeds up the treatment of the file, resulting in user-friendly, streamlined proceedings.

### **3.5. Suspension of proceedings (Article 71)**

For the purposes of clarity and harmonisation, a single provision on suspensions applicable to opposition, revocation, declaration of invalidity and appeal proceedings has been introduced. It replaces the former structure of parallel articles in their corresponding titles. For reasons of legal certainty, this new provision identifies the situations where granting a suspension is subject, or not, to the Office's discretion. In suspension requests signed by both parties, limiting the total maximum period for which proceedings may be suspended or requesting a supporting justification for requesting an extension aims to make proceedings more effective. It will also address delaying tactics of parties whilst allowing for a reasonable period of time for negotiations to take place.

### **3.6. Taking of evidence (Article 55)**

The revised provisions on the 'taking of evidence' are meant to apply to all proceedings before the Office. They also aim at improving clarity and harmonisation. In particular, a legal footing is added for the basic structure and format of written evidence submitted. The relevant new provision (Article 55) has a direct impact on the clear identification of the evidence and arguments raised by the party and on the assurance of expeditious proceedings. This improves the efficiency and effectiveness of proceedings and brings legal certainty. It also aims to prevent abuse where massive amounts of unstructured evidence are used to 'swamp' a party.

### **3.7. Notification and communication (Article 56 to 66)**

Finally, means of notification and communication have been reordered and updated to take account of the reality of the market, and especially that electronic communication is the means that is most used by users. Thus, a broad definition of 'electronic means' is provided. It introduces the flexibility needed to encompass future means where submissions are made other than on paper. Those forms of notification that do not correspond to the current practice of the Office or that have become obsolete, namely 'by a letter box at the Office' and 'hand delivery', have been deleted for reasons of clarity and legal certainty. This serves to eradicate functionally redundant forms of communication. In line with the EU Trade Mark Regulation, technical specifications of electronic communications are to be drawn up by the Executive Director in order to maintain legal certainty. This also ensures the flexibility required to respond to the constant development of technology. As a result, the text aims to achieve a balance between the needs of the vast majority of users moving toward the electronic media provided by the Office and toward electronic communications in general, and the needs of users who prefer more traditional media. Some of the major benefits provided by these provisions are efficiency, flexibility, certainty and modernisation.

COMMISSION DELEGATED REGULATION (EU) .../...

of 18.5.2017

supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96

THE EUROPEAN COMMISSION,

Having regard to the Treaty on the Functioning of the European Union,

Having regard to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark<sup>1</sup>, and in particular Article 42a, Article 43(3), Article 57a, Article 65a, Article 77(4), Article 78(6), Article 79(5), Article 79b(2), Article 79c(5), Article 80(3), Article 82a(3), Article 93a, Article 136b, Article 154a(3) and Article 156(4) thereof,

Whereas:

- (1) Council Regulation (EC) No 40/94<sup>2</sup>, which was codified as Regulation (EC) No 207/2009, created a system specific to the Union for the protection of trade marks to be obtained at the level of the Union on the basis of an application to the European Union Intellectual Property Office ('the Office').
- (2) Regulation (EU) No 2015/2424 of the European Parliament and of the Council<sup>3</sup> amending Regulation (EC) No 207/2009 aligns the powers conferred therein upon the Commission to Articles 290 and 291 of the Treaty on the Functioning of the European Union. In order to conform with the new legal framework resulting from that alignment, certain rules should be adopted by means of implementing and delegated acts. The new rules should be applied instead of the existing rules which are laid down in Commission Regulations (EC) No 2868/95<sup>4</sup> and (EC) No 216/96<sup>5</sup> and aim at implementing Regulation (EC) No 207/2009. Regulations (EC) No 2868/95 and (EC) No 216/96 should therefore be repealed.
- (3) The procedural rules on opposition should ensure an effective, efficient and expeditious examination and registration of EU trade mark applications by the Office using a procedure which is transparent, thorough, fair and equitable. In order to enhance legal certainty and clarity, those opposition rules should take account of the extended relative grounds for refusal laid down in Regulation (EC) No 207/2009, in

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<sup>1</sup> OJ L 78, 24.3.2009, p. 1.

<sup>2</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ L 11, 14.1.1994, p. 1).

<sup>3</sup> Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ L 341, 24.12.2015, p. 21).

<sup>4</sup> Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ L 303, 15.12.1995, p. 1).

<sup>5</sup> Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ L 28, 6.2.1996, p. 11).

particular as regards the requirements for admissibility and substantiation of opposition proceedings, and be adjusted to better reflect the case law of the Court of Justice of the European Union and to codify the practice of the Office.

- (4) In order to allow for a more flexible, consistent and modern trade mark system in the Union, while ensuring legal certainty, it is appropriate to reduce the administrative burden for the parties in *inter-partes* proceedings by relaxing the requirements for the substantiation of earlier rights in cases where the content of the relevant evidence is accessible online from a source recognised by the Office, as well as the requirement of submitting evidence in the language of the proceedings.
- (5) In the interest of clarity and legal certainty, it is important to specify the requirements for amending an application for an EU trade mark in a clear and exhaustive manner.
- (6) The procedural rules governing the revocation and declaration of invalidity of an EU trade mark should ensure that an EU trade mark can be revoked or declared invalid in an effective and efficient way by means of transparent, thorough, fair and equitable procedures. For the sake of greater clarity, consistency as well as efficiency and legal certainty, the procedural rules governing the revocation and declaration of invalidity of an EU trade mark should be aligned with those applicable to opposition proceedings, retaining only those differences which are required due to the specific nature of revocation and declaration of invalidity proceedings. Furthermore, requests for assignment of an EU trade mark registered in the name of an unauthorised agent should follow the same procedural path as invalidity proceedings, serving in practice as an alternative to invalidating the mark.
- (7) According to settled case-law of the Court of Justice<sup>6</sup>, unless otherwise provided, the Office enjoys discretionary powers when examining belated evidence, submitted for the purpose of either substantiating an opposition or proving genuine use of the earlier mark in the context of opposition or invalidity proceedings. In order to ensure legal certainty the relevant boundaries of such discretion should be accurately reflected in the rules governing opposition proceedings or proceedings for the declaration of invalidity of EU trade marks.
- (8) In order to allow for an effective, efficient and, within the scope of the appeal defined by the parties, complete review of decisions taken by the Office in the first instance by means of a transparent, thorough, fair and impartial appeal procedure suited to the specific nature of intellectual property law and taking into account the principles laid down in Regulation (EC) No 207/2009, it is appropriate to reinforce legal certainty and predictability by clarifying and specifying the procedural rules and the parties' procedural guarantees, in particular where a defendant makes use of the right to file a cross appeal.

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<sup>6</sup> Judgment of 13 March 2007, Case C-29/05P, *OHIM / Kaul GmbH*, (ARCOL / CAPOL), ECR I-2213, ECLI:EU:C:2007:162, paragraphs 42-44; judgment of 18 July 2013, Case C-621/11P, *New Yorker SHK Jeans GmbH & Co. KG / OHIM*, (FISHBONE / FISHBONE BEACHWEAR), ECLI:EU:C:2013:484, paragraphs 28-30; judgment of 26 September 2013, Case C-610/11P, *Centrotherm Systemtechnik GmbH / OHIM*, (CENTROTHERM), ECLI:EU:C:2013:593, paragraphs 85-90 and 110-113; judgment of 3 October 2013, Case C-120/12P, *Bernhard Rintisch / OHIM*, (PROTI SNACK / PROTI), ECLI:EU:C:2013:638, paragraphs 32 and 38-39; judgment of 3 October 2013, Case C-121/12P, *Bernhard Rintisch / OHIM*, (PROTIVITAL / PROTI), ECLI:EU:C:2013:639, paragraphs 33 and 39-40; judgment of 3 October 2013, Case C-122/12P, *Bernhard Rintisch / OHIM*, (PROTIACTIVE / PROTI), ECLI:EU:C:2013:628; paragraphs 33 and 39-40; judgment of 21 July 2016, Case c-597/14P, *EUIPO / Xavier Grau Ferrer*, paragraphs 26-27.

- (9) In order to ensure an effective and efficient organisation of the Boards of Appeal, the President, the chairpersons and the members of the Boards of Appeal should, in the exercise of their respective functions conferred upon them by Regulation (EC) No 207/2009 and by this Regulation, be required to ensure a high quality and consistency of the decisions taken independently by the Boards on appeal as well as the efficiency of the appeal proceedings.
- (10) In order to ensure the independence of the President, the chairpersons and the members of the Boards of Appeal as provided in Article 136 of Regulation (EC) No 207/2009, the Management Board should take the latter Article into account when adopting appropriate implementing rules to give effect to the Staff Regulations and the Conditions of Employment of Other Servants in accordance with Article 110 of the Staff Regulations.
- (11) In order to enhance the transparency and predictability of the appeal proceedings, the rules of procedure of the Boards of Appeal currently laid down in Regulations (EC) No 2868/95 and (EC) No 216/96, should be set out in a single text and properly interlinked with the procedural rules applicable to the instances of the Office whose decisions are subject to appeals.
- (12) For the sake of clarity and legal certainty, it is required to codify and clarify certain procedural rules governing oral proceedings, in particular relating to the language of such proceedings. It is further appropriate to provide greater efficiency and flexibility by introducing the possibility of taking part in oral proceedings by technical means and of substituting the minutes of oral proceedings by their recording.
- (13) In order to further streamline proceedings and render them more consistent, it is appropriate to set out the basic structure and format of evidence to be submitted to the Office in all proceedings, as well as the consequences of not submitting evidence in accordance with that structure and format.
- (14) In order to modernise the trade mark system in the Union by adapting it to the Internet era, it is further appropriate to provide for a definition of “electronic means” in the context of notifications and for forms of notification that are not obsolete.
- (15) In the interest of efficiency, transparency and user-friendliness, the Office should make available standard forms in all the official languages of the Office for communication in proceedings before the Office, which may be completed online.
- (16) For the purposes of greater clarity, consistency and efficiency, a provision on the suspension of opposition, revocation, invalidity and appeal proceedings should be introduced, laying down also the maximum duration of a suspension requested by both parties.
- (17) The rules governing the calculation and duration of time limits, the procedures for the revocation of a decision or for cancellation of an entry in the Register, the detailed arrangements for the resumption of proceedings, and the details on representation before the Office need to ensure a smooth, effective and efficient operation of the EU trade mark system.
- (18) It is necessary to ensure the effective and efficient registration of international trade marks in a manner that is fully consistent with the rules of the Protocol relating to the Madrid Agreement concerning the international registration of marks.
- (19) The rules laid down in this Regulation supplement provisions of Regulation (EC) No 207/2009 that have been amended by Regulation (EU) 2015/2424 with effect from 1

October 2017. It is therefore necessary to defer the applicability of those rules until the same date.

- (20) Notwithstanding the repeal of Regulations (EC) No 2868/95 and (EC) No 216/96, it is necessary to continue to apply specific provisions of those Regulations to certain proceedings that had been initiated before the abovementioned date until the conclusion of those proceedings.

HAS ADOPTED THIS REGULATION:

## **TITLE I GENERAL PROVISIONS**

### *Article 1 Subject-matter*

This Regulation lays down rules specifying:

- (a) the details of the procedure for filing and examining an opposition to the registration of an EU trade mark at the European Union Intellectual Property Office ('the Office');
- (b) the details of the procedure governing the amendment of an application for an EU trade mark;
- (c) the details governing the revocation and declaration of invalidity of an EU trade mark, as well as the transfer of an EU trade mark registered in the name of an unauthorised agent;
- (d) the formal content of a notice of appeal and the procedure for the filing and the examination of an appeal, the formal content and form of the Boards of Appeal's decisions and the reimbursement of the appeal fee, the details concerning the organisation of the Boards of Appeal, and the conditions under which decisions on appeals are to be taken by a single member;
- (e) the detailed arrangements for oral proceedings and for the taking of evidence;
- (f) the detailed arrangements for notification by the Office and the rules on the means of communication with the Office;
- (g) the details regarding the calculation and duration of time limits;
- (h) the procedure for the revocation of a decision or for the cancellation of an entry in the Register of EU trade marks;
- (i) the detailed arrangements for the resumption of proceedings before the Office;
- (j) the conditions and the procedure for the appointment of a common representative, the conditions under which employees and professional representatives shall file an authorisation, and the content of that authorisation, and the circumstances in which a person may be removed from the list of admitted professional representatives;
- (k) the details of the procedure concerning international registrations based on a basic application or basic registration relating to a collective mark, certification mark or guarantee mark, and the procedure for the filing and examination of an opposition to an international registration.

## **TITLE II PROCEDURE FOR OPPOSITION AND PROOF OF USE**

### *Article 2 Notice of opposition*

1. A notice of opposition may be entered on the basis of one or more earlier marks or other rights within the meaning of Article 8 of Regulation (EC) No 207/2009, provided that the proprietors or authorised persons entering the notice pursuant to

Article 41 of Regulation (EC) No 207/2009 are entitled to do so for all the earlier marks or rights. Where an earlier mark has more than one proprietor (co-ownership) or where an earlier right may be exercised by more than one person, an opposition pursuant to Article 41 of Regulation (EC) No 207/2009 may be filed by any or all of the proprietors or authorised persons.

2. The notice of opposition shall contain:

- (a) the file number of the application against which opposition is entered and the name of the applicant for the EU trade mark;
- (b) a clear identification of the earlier mark or right on which the opposition is based, namely:
  - (i) where the opposition is based on an earlier mark within the meaning of Article 8(2)(a) or (b) of Regulation (EC) No 207/2009, the file number or registration number of the earlier mark, an indication of whether the earlier mark is registered or an application for registration of that mark, as well as an indication of the Member States including, where applicable, the Benelux, in or for which the earlier mark is protected, or, if applicable, the indication that it is an EU trade mark;
  - (ii) where the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of Regulation (EC) No 207/2009, the indication of the Member State(s) where the mark is well-known and a representation of the mark;
  - (iii) where the opposition is based on the absence of the proprietor's consent as referred to in Article 8(3) of Regulation (EC) No 207/2009, an indication of the territory in which the earlier trade mark is protected, the representation of the mark and, if applicable, an indication whether the earlier mark is an application or a registration, in which case the filing or registration number shall be provided;
  - (iv) where the opposition is based on an earlier mark or another sign within the meaning of Article 8(4) of Regulation (EC) No 207/2009, an indication of its kind or nature, a representation of the earlier mark or sign, and an indication of whether the right to the earlier mark or sign exists in the whole Union or in one or more Member States, and if so, an indication of those Member States;
  - (v) where the opposition is based on an earlier designation of origin or geographical indication within the meaning of Article 8(4a) of Regulation (EC) No 207/2009, an indication of its nature, a representation of the earlier designation of origin or geographical indication, and an indication of whether it is protected in the whole Union or in one or more Member States, and if so, an indication of those Member States;
- (c) the grounds on which the opposition is based by means of a statement to the effect that the requirements under Article 8(1), (3), (4), (4a) or (5) of Regulation (EC) No 207/2009 in respect of each of the earlier marks or rights invoked by the opposing party are fulfilled;

- (d) in the case of an earlier trade mark application or registration, the filing date and, where available, the registration date and the priority date of the earlier mark;
  - (e) in the case of earlier rights pursuant to Article 8(4a) of Regulation (EC) No 207/2009, the date of application for registration or, if that date is not available, the date from which protection is granted;
  - (f) in the case of an earlier trade mark application or registration, a representation of the earlier mark as registered or applied for; if the earlier mark is in colour, the representation shall be in colour;
  - (g) an indication of the goods or services on which each of the grounds of the opposition is based;
  - (h) as concerns the opposing party:
    - (i) the identification of the opposing party in accordance with Article 2(1)(b) of Implementing Regulation (EU) .../....;
    - (ii) where the opposing party has appointed a representative, or where representation is mandatory pursuant to Article 92(2) of Regulation (EC) No 207/2009, the name and business address of the representative in accordance with Article 2(1)(e) of Implementing Regulation (EU) .../....;
    - (iii) where the opposition is entered by a licensee or by a person who is entitled under the relevant Union legislation or national law to exercise an earlier right, a statement to that effect and indications concerning the authorisation or the entitlement to file the opposition;
  - (i) an indication of the goods or services against which the opposition is directed; in the absence of such an indication, the opposition shall be considered to be directed against all of the goods or services of the opposed EU trade mark application.
3. Where the opposition is based on more than one earlier mark or earlier right, paragraph 2 shall apply for each of those marks, signs, designations of origin or geographical indications.
  4. The notice of opposition may also contain a reasoned statement on the grounds, the facts and arguments on which the opposition relies, and evidence to support the opposition.

### *Article 3*

#### *Use of languages in opposition proceedings*

The opposing party or the applicant may, before the date on which the adversarial part of the opposition proceedings are deemed to commence pursuant to Article 6(1), inform the Office that the applicant and the opposing party have agreed on a different language for the opposition proceedings pursuant to Article 119(7) of Regulation (EC) No 207/2009. Where the notice of opposition has not been filed in that language, the applicant may request that the opposing party file a translation in that language. Such a request must be received by the Office not later than the date on which the adversarial part of the opposition proceedings are deemed to commence. The Office shall specify a time limit for the opposing party to file a translation. Where that translation is not filed or filed late, the language of the proceedings as

determined in accordance with Article 119 of Regulation (EC) No 207/2009 ('language of proceedings') shall remain unchanged.

#### *Article 4*

##### *Information to the parties to opposition proceedings*

The notice of opposition and any document submitted by the opposing party, as well as any communication addressed to one of the parties by the Office prior to the finding on admissibility shall be sent by the Office to the other party for purposes of informing of the introduction of an opposition.

#### *Article 5*

##### *Admissibility of the opposition*

1. Where the opposition fee has not been paid within the opposition period laid down in Article 41(1) of Regulation (EC) No 207/2009, the opposition shall be deemed not to have been entered. Where the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.
2. Where the notice of opposition has been filed after the expiry of the opposition period, the Office shall reject the opposition as inadmissible.
3. Where the notice of opposition has been filed in a language which is not one of the languages of the Office as required under Article 119(5) of Regulation (EC) No 207/2009, or where it does not comply with Article 2(2)(a), (b) or (c) of this Regulation, and where those deficiencies have not been remedied before the expiry of the opposition period, the Office shall reject the opposition as inadmissible.
4. Where the opposing party does not submit a translation as required under Article 119(6) of Regulation (EC) No 207/2009, the opposition shall be rejected as inadmissible. Where the opposing party submits an incomplete translation, the part of the notice of opposition that has not been translated shall not be taken into account in the examination of admissibility.
5. Where the notice of opposition does not comply with the provisions of Article 2(2)(d) to (h), the Office shall inform the opposing party accordingly and shall invite it to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, the Office shall reject the opposition as inadmissible.
6. The Office shall notify the applicant of any finding pursuant to paragraph 1 that the notice of opposition is deemed not to have been entered and of any decision to reject the opposition on the grounds of inadmissibility under paragraphs 2, 3, 4 or 5. Where an opposition is rejected in its entirety as inadmissible pursuant to paragraphs 2, 3, 4 or 5, prior to the notification of Article 6(1), no decision on costs shall be taken.

#### *Article 6*

##### *Commencement of the adversarial part of the opposition proceedings and prior closure of the proceedings*

1. Where the opposition is found admissible pursuant to Article 5, the Office shall send a communication to the parties informing them that the adversarial part of the opposition proceedings shall be deemed to commence two months after receipt of the

communication. That period may be extended to a total of 24 months if both parties request an extension before the two-month period expires.

2. Where, within the period referred to in paragraph 1, the application is withdrawn or restricted to goods or services against which the opposition is not directed, or the Office is informed about a settlement between the parties, or the application is rejected in parallel proceedings, the opposition proceedings shall be closed.
3. Where, within the period referred to in paragraph 1, the applicant restricts the application by deleting some of the goods or services against which the opposition is directed, the Office shall invite the opposing party to state, within such a period as it may specify, whether it maintains the opposition, and if so, against which of the remaining goods or services. Where the opposing party withdraws the opposition in light of the restriction, the opposition proceedings shall be closed.
4. Where, before the expiry of the period referred to in paragraph 1, the opposition proceedings are closed pursuant to paragraphs 2 or 3, no decision on costs shall be taken.
5. Where, before the expiry of the period referred to in paragraph 1, the opposition proceedings are closed following a withdrawal or restriction of the application pursuant to paragraph 2 or following a withdrawal of the opposition pursuant to paragraph 3, the opposition fee shall be refunded.

#### *Article 7*

#### *Substantiation of the opposition*

1. The Office shall give the opposing party the opportunity to submit the facts, evidence and arguments in support of the opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Article 2(4). For that purpose, the Office shall specify a time limit which shall be at least two months, starting on the date on which the adversarial part of the opposition proceedings are deemed to commence in accordance with Article 6(1).
2. Within the period referred to in paragraph 1, the opposing party shall also file evidence of the existence, validity and scope of protection of its earlier mark or right, as well as evidence proving its entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:
  - (a) where the opposition is based on an earlier trade mark within the meaning of Article 8(2)(a) and (b) of Regulation (EC) No 207/2009, which is not an EU trade mark, evidence of its filing or registration, by submitting:
    - (i) a copy of the relevant filing certificate or an equivalent document from the administration with which the trade mark application was filed, if the trade mark is not yet registered; or
    - (ii) where the earlier trade mark is registered, a copy of the relevant registration certificate and, if applicable, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 or any extension thereof, or equivalent documents from the administration by which the trade mark was registered;
  - (b) where the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of Regulation (EC) No 207/2009, evidence showing that that

mark is well known in the relevant territory for the goods or services indicated in accordance with Article 2(2)(g) of this Regulation;

- (c) where the opposition is based on the absence of the proprietor's consent as referred to in Article 8(3) of Regulation (EC) No 207/2009, evidence of the opposing party's proprietorship of the prior trade mark and of its relationship with the agent or representative;
  - (d) where the opposition is based on an earlier right within the meaning of Article 8(4) of Regulation (EC) No 207/2009, evidence showing use of that right in the course of trade of more than mere local significance, as well as evidence of its acquisition, continued existence and scope of protection including, where the earlier right is invoked pursuant to the law of a Member State, a clear identification of the contents of the national law relied upon by adducing publications of the relevant provisions or jurisprudence;
  - (e) where the opposition is based on an earlier designation of origin or geographical indication within the meaning of Article 8(4a) of Regulation (EC) No 207/2009, evidence of its acquisition, continued existence and scope of protection including, where the earlier designation of origin or geographical indication is invoked pursuant to the law of a Member State, a clear identification of the content of the national law relied upon by adducing publications of the relevant provisions or jurisprudence;
  - (f) if the opposition is based on a mark with a reputation within the meaning of Article 8(5) of Regulation (EC) No 207/2009, in addition to the evidence referred to in point (a) of this paragraph, evidence showing that the mark has a reputation in the Union or in the Member State concerned for the goods or services indicated in accordance with Article 2(2)(g) of this Regulation, as well as evidence or arguments showing that use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
3. Where the evidence concerning the filing or registration of the earlier rights referred to in paragraph 2(a) or, where applicable, paragraph 2(d) or (e), or the evidence concerning the contents of the relevant national law, is accessible online from a source recognised by the Office, the opposing party may provide such evidence by making reference to that source.
  4. Any filing, registration or renewal certificates or equivalent documents referred to in paragraph 2(a), (d) or (e), as well as any provisions of the applicable national law governing the acquisition of rights and their scope of protection as referred to in paragraph 2(d) and (e), including evidence accessible online as referred to in paragraph 3, shall be in the language of the proceedings or shall be accompanied by a translation into that language. The translation shall be submitted by the opposing party on its own motion within the time limit specified for submitting the original document. Any other evidence submitted by the opposing party to substantiate the opposition shall be subject to Article 24 of Implementing Regulation (EU) .../.... Translations submitted after the expiry of the relevant time limits shall not be taken into account.
  5. The Office shall not take into account written submissions, or parts thereof, that have not been submitted in or not been translated into the language of the proceedings within the time limit set by the Office in accordance with paragraph 1.

*Article 8*  
*Examination of the opposition*

1. Where, until the expiry of the period referred to in Article 7(1), the opposing party has not provided any evidence, or where the evidence provided is manifestly irrelevant or manifestly insufficient to meet the requirements laid down in Article 7(2) for any of the earlier rights, the opposition shall be rejected as unfounded.
2. Where the opposition is not rejected pursuant to paragraph 1, the Office shall communicate the submission of the opposing party to the applicant and shall invite it to file its observations within a period specified by the Office.
3. Where the applicant submits no observations, the Office shall base its ruling on the opposition on the evidence before it.
4. The observations submitted by the applicant shall be communicated to the opposing party who shall be invited, if the Office considers it necessary, to reply within a period specified by the Office.
5. Where, after the expiry of the period referred to in Article 7(1), the opposing party submits facts or evidence that supplement relevant facts or evidence provided within that period and that relate to the same requirement laid down in Article 7(2), the Office shall exercise its discretion under Article 76(2) of Regulation (EC) No 207/2009 in deciding whether to accept these supplementing facts or evidence. For that purpose, the Office shall take into account, in particular, the stage of proceedings and whether the facts or evidence are, *prima facie*, likely to be relevant for the outcome of the case and whether there are valid reasons for the late submission of the facts or evidence.
6. The Office shall invite the applicant to submit further observations in response if it deems it appropriate under the circumstances.
7. Where the opposition has not been rejected pursuant to paragraph 1 and the evidence submitted by the opposing party is not sufficient to substantiate the opposition in accordance with Article 7 for any of the earlier rights, the opposition shall be rejected as unfounded.
8. Article 6(2) and (3) shall apply *mutatis mutandis* after the date on which the adversarial part of the opposition proceedings is deemed to commence. Where the applicant wishes to withdraw or restrict the contested application, it shall do so by way of a separate document.
9. In appropriate cases, the Office may invite the parties to limit their observations to particular issues, in which case it shall allow them to raise the other issues at a later stage of the proceedings. The Office shall not be required to inform a party of the possibility to produce certain relevant facts or evidence which that party previously failed to produce.

*Article 9*  
*Multiple oppositions*

1. Where a number of oppositions have been entered in respect of the same application for the registration of an EU trade mark, the Office may examine them in one set of proceedings. The Office may subsequently decide to examine those oppositions separately.

2. Where a preliminary examination of one or more oppositions reveals that the EU trade mark for which an application for registration has been filed may be ineligible for registration in respect of some or all of the goods or services for which registration is sought, the Office may suspend the other opposition proceedings relating to that application. The Office shall inform the opposing parties affected by the suspension of any relevant decisions taken in the context of those proceedings which are ongoing.
3. Once a decision rejecting an application as referred to in paragraph 1 has become final, the oppositions for which proceedings have been suspended in accordance with paragraph 2 shall be deemed to have been disposed of and the opposing parties concerned shall be informed accordingly. Such a disposition shall be considered to constitute a case which has not proceeded to judgment within the meaning of Article 85(4) of Regulation (EC) No 207/2009.
4. The Office shall refund 50 % of the opposition fee paid by each opposing party whose opposition is deemed to have been disposed of in accordance with paragraph 3, provided that the suspension of the proceedings relating to that opposition took place before the commencement of the adversarial part of the proceedings.

*Article 10*  
*Proof of use*

1. A request for proof of use of an earlier mark pursuant to Article 42(2) or (3) of Regulation (EC) No 207/2009 shall be admissible if it is submitted as an unconditional request in a separate document within the period specified by the Office pursuant to Article 8(2) of this Regulation.
2. Where the applicant has made a request for proof of use of an earlier mark which complies with the requirements of Article 42(2) or (3) of Regulation (EC) No 207/2009, the Office shall invite the opposing party to provide the proof required within a time limit specified by the Office. Where the opposing party does not provide any evidence or reasons for non-use before the time limit expires or where the evidence or reasons provided are manifestly insufficient or irrelevant, the Office shall reject the opposition in so far as it is based on that earlier mark.
3. The indications and evidence of use shall establish the place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which the opposition is based.
4. The evidence referred to in paragraph 3 shall be filed in accordance with Article 55(2) and Articles 63 and 64 and shall be limited to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 78(1)(f) of Regulation (EC) No 207/2009.
5. A request for proof of use may be filed at the same time as observations on the grounds on which the opposition is based. Such observations may also be filed together with the observations in reply to the proof of use.
6. Where the evidence supplied by the opposing party is not in the language of the opposition proceedings, the Office may require the opposing party to submit a translation of that evidence in that language pursuant to Article 24 of Implementing Regulation (EU) .../...

7. Where after the expiry of the time limit referred to in paragraph 2, the opposing party submits indications or evidence that supplement relevant indications or evidence already submitted before expiry of that time limit and relate to the same requirement laid down in paragraph 3, the Office shall exercise its discretion under Article 76(2) of Regulation (EC) No 207/2009 in deciding whether to accept those supplementing indications or evidence. For that purpose, the Office shall take into account, in particular, the stage of proceedings and whether the indications or evidence are, prima facie, likely to be relevant for the outcome of the case and whether there are valid reasons for the late submission of the indications or evidence.

### **TITLE III**

#### **AMENDMENT OF THE APPLICATION**

##### *Article 11*

##### *Amendment of the application*

1. A request for amendment of an application pursuant to Article 43(2) of Regulation (EC) No 207/2009 shall contain:
  - (a) the file number of the application;
  - (b) the name and address of the applicant in accordance with Article 2(1)(b) of Implementing Regulation (EU) .../....;
  - (c) an indication of the element of the application to be amended, and that element in its amended version;
  - (d) where the amendment relates to the representation of the mark, a representation of the mark as amended, in accordance with Article 3 of Implementing Regulation (EU) .../....
2. Where the requirements for the amendment of the application are not fulfilled, the Office shall communicate the deficiency to the applicant and shall specify a time limit for remedying the deficiency. Where the applicant does not remedy the deficiency within the specified time limit, the Office shall reject the request for amendment.
3. Where the amended trade mark application is published pursuant to Article 43(2) of Regulation (EC) No 207/2009, Articles 2 to 10 of this Regulation shall apply *mutatis mutandis*.
4. A single request for amendment may be made for the amendment of the same element in two or more applications by the same applicant.
5. Paragraphs 1, 2 and 4 shall apply *mutatis mutandis* for applications to correct the name or the business address of a representative appointed by the applicant.

### **TITLE IV**

#### **REVOCATION AND INVALIDITY OR ASSIGNMENT**

##### *Article 12*

##### *Application for revocation or for a declaration of invalidity*

1. An application to the Office for revocation or for a declaration of invalidity pursuant to Article 56 of Regulation (EC) No 207/2009 shall contain:

- (a) the registration number of the EU trade mark in respect of which revocation or a declaration of invalidity is sought and the name of its proprietor;
  - (b) the grounds on which the application is based by means of a statement that the respective requirements laid down in Articles 51, 52, 53, 73, 74, 74i or 74j of Regulation (EC) No 207/2009 are fulfilled;
  - (c) as concerns the applicant:
    - (i) the identification of the applicant in accordance with Article 2(1)(b) of Implementing Regulation (EU) .../....;
    - (ii) where the applicant has appointed a representative or where representation is mandatory within the meaning of Article 92(2) of Regulation (EC) No 207/2009, the name and business address of the representative, in accordance with Article 2(1)(e) of Implementing Regulation (EU) .../....;
  - (d) an indication of the goods or services in respect of which revocation or a declaration of invalidity is sought, in the absence of which the application shall be deemed to be directed against all the goods or services covered by the contested EU trade mark.
2. In addition to the requirements laid down in paragraph 1, an application for a declaration of invalidity based on relative grounds shall contain the following:
- (a) in the case of an application pursuant to Article 53(1) of Regulation (EC) No 207/2009, an identification of the earlier right on which the application is based, in accordance with Article 2(2)(b) of this Regulation, which shall apply *mutatis mutandis* to such an application;
  - (b) in the case of an application pursuant to Article 53(2) of Regulation (EC) No 207/2009, an indication of the nature of the earlier right on which the application is based, its representation and an indication of whether this earlier right exists in the whole of the Union or in one or more Member States, and if so, an indication of those Member States;
  - (c) particulars pursuant to Article 2(2)(d) to (g), which apply *mutatis mutandis* to such an application;
  - (d) where the application is entered by a licensee or by a person who is entitled under the relevant Union legislation or national law to exercise an earlier right, an indication concerning the authorisation or entitlement to file the application.
3. Where the application for a declaration of invalidity pursuant to Article 53 of Regulation (EC) No 207/2009 is based on more than one earlier mark or earlier right, paragraphs 1(b) and 2 of this Article shall apply for each of those marks or rights.
4. The application may contain a reasoned statement on the grounds setting out the facts and arguments on which it is based and supporting evidence.

### *Article 13*

#### *Languages used in revocation or invalidity proceedings*

The applicant for revocation or for a declaration of invalidity or the proprietor of the EU trade mark may inform the Office before the expiry of a period of two months from receipt by the EU trade mark proprietor of the communication referred to in Article 17(1), that a different language of proceedings has been agreed pursuant to Article 119(7) of Regulation (EC) No

207/2009. Where the application has not been filed in that language, the proprietor may request that the applicant file a translation in that language. Such a request shall be received by the Office before the expiry of the period of two months from receipt by the EU trade mark proprietor of the communication referred to in Article 17(1). The Office shall specify a time limit for the applicant to file such a translation. Where that translation is not filed or filed late, the language of the proceedings shall remain unchanged.

#### *Article 14*

##### *Information to the parties concerning an application for revocation or for a declaration of invalidity*

An application for revocation or for a declaration of invalidity and any document submitted by the applicant, as well as any communication addressed to one of the parties by the Office prior to the finding on admissibility shall be sent by the Office to the other party for the purposes of informing of the introduction of an application for revocation or for a declaration of invalidity.

#### *Article 15*

##### *Admissibility of an application for revocation or for a declaration of invalidity*

1. Where the fee required under Article 56(2) of Regulation (EC) No 207/2009 has not been paid, the Office shall invite the applicant to pay the fee within a period specified by it. Where the required fee is not paid within the specified period, the Office shall inform the applicant that the application for revocation or for declaration of invalidity is deemed not to have been entered. Where the fee has been paid after the expiry of the specified period, it shall be refunded to the applicant.
2. Where the application has been filed in a language which is not one of the languages of the Office as required under Article 119(5) of Regulation (EC) No 207/2009, or it does not comply with Article 12(1)(a) or (b) or, where applicable, Article 12(2)(a) or (b) of this Regulation, the Office shall reject the application as inadmissible.
3. Where the translation required under the second subparagraph of Article 119(6) Regulation (EC) No 207/2009 is not filed within a period of one month of the date of filing an application for revocation or a declaration of invalidity, the Office shall reject the application for revocation or for declaration of invalidity as inadmissible.
4. Where the application does not comply with the provisions laid down in Article 12(1)(c), Article 12(2)(c) or (d), the Office shall inform the applicant accordingly and shall invite the applicant to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, the Office shall reject the application as inadmissible.
5. The Office shall notify the applicant and the proprietor of the EU trade mark of any finding pursuant to paragraph 1 that the application for revocation or declaration of invalidity is deemed not to have been entered and of any decision to reject the application for revocation or declaration of invalidity on the grounds of inadmissibility under paragraphs 2, 3 or 4. Where an application for revocation or declaration of invalidity is rejected in its entirety as inadmissible pursuant to paragraphs 2, 3 or 4, prior to the notification of Article 17(1), no decision on costs shall be taken.

## Article 16

### *Substantiation of an application for revocation or for a declaration of invalidity*

1. The applicant shall present the facts, evidence and arguments in support of the application up to the closure of the adversarial part of revocation or invalidity proceedings. In particular, the applicant shall provide the following:
  - (a) in the case of an application pursuant to Article 51(1)(b) or (c) or Article 52 of Regulation (EC) No 207/2009, facts, arguments and evidence to support the grounds on which the application for revocation or declaration of invalidity is based;
  - (b) in the case of an application pursuant to Article 53(1) of Regulation (EC) No 207/2009, the evidence required by Article 7(2) of this Regulation and the provisions of Article 7(3) shall apply *mutatis mutandis*;
  - (c) in the case of an application pursuant to Article 53(2) of Regulation (EC) No 207/2009, evidence of acquisition, continued existence and scope of protection of the relevant earlier right as well as evidence proving that the applicant is entitled to file the application, including, where the earlier right is invoked pursuant to national law, a clear identification of the contents of that national law by adducing publications of the relevant provisions or jurisprudence. Where the evidence concerning the filing or registration of an earlier right under Article 53(2)(d) of Regulation (EC) No 207/2009 or the evidence concerning the contents of the relevant national law is accessible online from a source recognised by the Office, the applicant may provide such evidence by making reference to that source.
2. Evidence concerning the filing, registration or renewal of earlier rights or, where applicable, the contents of the relevant national law, including evidence accessible online, as referred to in paragraph 1(b) and (c), shall be filed in the language of the proceedings or a translation into that language shall be filed. The translation shall be submitted by the applicant on the applicant's own motion within one month from the filing of such evidence. Any other evidence submitted by the applicant to substantiate the application or, in case of an application for revocation under Article 51(1)(a) of Regulation (EC) No 207/2009, by the proprietor of the contested EU trade mark, shall be subject to Article 24 of Implementing Regulation (EU) .../.... Translations submitted after the expiry of the relevant time limits shall not be taken into account.

## Article 17

### *Examination on the merits of an application for revocation or for a declaration of invalidity*

1. Where the application is found admissible pursuant to Article 15, the Office shall send a communication to the parties informing them that the adversarial part of the revocation or invalidity proceedings has commenced and inviting the proprietor of the EU trade mark to file observations within a specified period.
2. Where the Office has invited a party in accordance with Article 57(1) of Regulation (EC) No 207/2009 to file observations within a specified period and that party does not submit any observations within that period, the Office shall close the adversarial part of the proceedings and base its ruling on the revocation or invalidity on the basis of the evidence before it.

3. Where the applicant has not submitted the facts, arguments or evidence required to substantiate the application, the application shall be rejected as unfounded.
4. Without prejudice to Article 62, all observations filed by the parties shall be sent to the other party concerned.
5. Where the proprietor surrenders the EU trade mark subject to an application as referred to in Article 12 to cover only goods or services against which the application is not directed, or the EU trade mark is cancelled in parallel proceedings, or expires, the proceedings shall be closed except where Article 50(2) of Regulation (EC) No 207/2009 shall apply or the applicant shows a legitimate interest in obtaining a decision on the merits.
6. Where the proprietor partially surrenders the EU trade mark by deleting some of the goods or services against which the application is directed, the Office shall invite the applicant to state, within such a period as it may specify, whether it maintains the application and if so, against which of the remaining goods or services. Where the applicant withdraws the application in light of the surrender, or the Office is informed about a settlement between the parties, the proceedings shall be closed.
7. Where the proprietor wishes to surrender the contested EU trade mark, it shall do so by way of a separate document.
8. Article 8(9) shall apply *mutatis mutandis*.

#### *Article 18*

##### *Multiple applications for revocation or for a declaration of invalidity*

1. Where a number of applications for revocation or for a declaration of invalidity have been filed relating to the same EU trade mark, the Office may examine them in one set of proceedings. The Office may subsequently decide to examine those applications separately.
2. Article 9(2), (3) and (4) shall apply *mutatis mutandis*.

#### *Article 19*

##### *Proof of use in relation to an application for revocation or for a declaration of invalidity*

1. In the case of an application for revocation based on Article 51(1)(a) of Regulation (EC) No 207/2009, the Office shall invite the proprietor of the EU trade mark to provide proof of genuine use of that mark or of proper reasons for non-use, within such period as it shall specify. Where the proprietor does not provide such proof or reasons for non-use before the time limit expires or the evidence or reasons provided are manifestly insufficient or irrelevant, the EU trade mark shall be revoked. Article 10(3), (4), (6) and (7) of this Regulation shall apply *mutatis mutandis*.
2. A request for proof of use pursuant to Article 57(2) or (3) of Regulation (EC) No 207/2009 shall be admissible if the proprietor of the EU trade mark submits it as an unconditional request in a separate document within the period specified by the Office pursuant to Article 17(1) of this Regulation. Where the proprietor of the EU trade mark has made a request for proof of use of an earlier mark or of proper reasons for non-use which complies with the requirements of Article 57(2) or (3) of Regulation (EC) No 207/2009, the Office shall invite the applicant for a declaration of invalidity to provide the proof required within a time limit specified by the Office. Where the applicant for a declaration of invalidity does not provide such proof or

reasons for non-use before the time limit expires or the evidence or reasons provided are manifestly insufficient or irrelevant, the Office shall reject the application for a declaration of invalidity in so far as it is based on that earlier mark. Article 10(3) to (7) of this Regulation shall apply *mutatis mutandis*.

#### Article 20

##### *Request for assignment*

1. Where the proprietor of a trade mark requests, in accordance with Article 18(1) and (2)(a) of Regulation (EC) No 207/2009, an assignment instead of a declaration of invalidity, the provisions of Articles 12 to 19 of this Regulation shall apply *mutatis mutandis*.
2. Where a request for assignment pursuant to Article 18(2) of Regulation (EC) No 207/2009 is partially or totally granted by the Office or by an EU trade mark court and the decision or judgment has become final, the Office shall ensure that the resulting partial or total transfer of the EU trade mark is entered in the Register and published.

## **TITLE V APPEALS**

#### Article 21

##### *Notice of Appeal*

1. A notice of appeal filed in accordance with Article 60(1) of Regulation (EC) No 207/2009 shall contain the following:
  - (a) the name and address of the appellant in accordance with Article 2(1)(b) of Implementing Regulation ....;
  - (b) where the appellant has appointed a representative, the name and the business address of the representative in accordance with Article 2(1)(e) of Implementing Regulation ...;
  - (c) where representation of the appellant is mandatory pursuant to Article 92(2) of Regulation (EC) No 207/2009, the name and the business address of the representative in accordance with Article 2(1)(e) of Implementing Regulation ....;
  - (d) a clear and unambiguous identification of the decision subject to appeal indicating the date on which it has been issued and the file number of the proceedings to which the decision subject to appeal relates;
  - (e) where the decision subject to appeal is only contested in part, a clear and unambiguous identification of the goods or services in respect of which the decision subject to appeal is contested.
2. Where the notice of appeal is filed in another official language of the Union than the language of proceedings, the appellant shall provide a translation thereof within four months of the date of notification of the decision subject to appeal.
3. Where in *ex parte* proceedings the decision subject to appeal has been taken in an official language other than the language of proceedings, the appellant may file the notice of appeal either in the language of the proceedings or in the language in which the decision subject to appeal was taken; in either case, the language used for the

notice of appeal shall become the language of the appeal proceedings and paragraph 2 shall not apply.

4. As soon as the notice of appeal has been filed in *inter partes* proceedings, it shall be notified to the defendant.

#### *Article 22* *Statement of Grounds*

1. A statement setting out the grounds of appeal filed pursuant to the fourth sentence of Article 60(1) of Regulation (EC) No 207/2009 shall contain a clear and unambiguous identification of the following:
  - (a) the appeal proceedings to which it refers by indicating either the corresponding appeal number or the decision subject to appeal in accordance with the requirements laid down in Article 21(1)(d) of this Regulation;
  - (b) the grounds of appeal on which the annulment of the contested decision is requested within the extent identified in accordance with Article 21(1)(e) of this Regulation ;
  - (c) the facts, evidence and arguments in support of the grounds invoked, submitted in accordance with the requirements set out in Article 55(2).
2. The statement of grounds shall be filed in the language of the appeal proceedings as determined in accordance with Article 21(2) and (3). Where the statement of grounds is filed in another official language of the Union, the appellant has to provide a translation thereof within one month of the date of the submission of the original statement.

#### *Article 23* *Admissibility of an appeal*

1. The Board of Appeal shall reject an appeal as inadmissible in any of the following events:
  - (a) where the notice of appeal has not been filed within two months of the date of notification of the decision subject to appeal;
  - (b) where the appeal does not comply with Articles 58 and 59 of Regulation (EC) No 207/2009, or with those laid down in Article 21(1)(d) and Article 21(2) and (3) of this Regulation, unless those deficiencies are remedied within four months of the date of notification of the decision subject to appeal;
  - (c) where the notice of appeal does not comply with the requirements laid down in Article 21(1)(a), (b), (c) and (e), and the appellant has, despite having been informed thereof by the Board of Appeal, not remedied those deficiencies within the time limit specified by the Board of Appeal to that effect;
  - (d) where the statement of grounds has not been filed within four months of the date of notification of the decision subject to appeal;
  - (e) where the statement of grounds does not comply with the requirements laid down in Article 22(1)(a) and (b), and the appellant has, despite having been informed thereof by the Board of Appeal, not remedied those deficiencies within the time-limit specified by the Board of Appeal to that effect or has not submitted the translation of the statement of grounds within one month of the

date of the submission of the original statement in accordance with Article 22(2).

2. Where the appeal appears to be inadmissible, the chairperson of the Board of Appeal to which the case has been allocated pursuant to Article 35(1) may request the Board of Appeal to decide without delay on the admissibility of the appeal prior to the notification to the defendant of the notice or of the statement of grounds, as the case may be.
3. The Board of Appeal shall declare an appeal as deemed not to have been filed where the appeal fee has been paid after the expiry of the time limit set out in the first sentence of Article 60(1) of Regulation (EC) No 207/2009. In such a case, paragraph 2 of this Article shall apply.

#### *Article 24 Response*

1. In *inter partes* proceedings, the defendant may file a response within two months of the date of notification of the appellant's statement of grounds. In exceptional circumstances, that time-limit may be extended upon reasoned request by the defendant.
2. The response shall contain the name and address of the defendant in accordance with Article 2(1)(b) of Implementing Regulation .../... and shall comply, *mutatis mutandis*, with the conditions laid down in Article 21(1)(b), (c) and (d), Article 22(1)(a) and (c) and Article 22(2) of this Regulation.

#### *Article 25 Cross appeal*

1. Where the defendant seeks a decision annulling or altering the contested decision on a point not raised in the appeal, pursuant to Article 60(2) of Regulation (EC) No 207/2009, that cross appeal shall be filed within the time limit for filing a response in accordance with Article 24(1) of this Regulation.
2. A cross appeal shall be submitted by a document separate from the response.
3. The cross appeal shall contain the name and address of the defendant in accordance with Article 2(1)(b) of Implementing Regulation ... and shall comply *mutatis mutandis* with the conditions laid down in Article 21(1)(b) to (e) and Article 22 of this Regulation.
4. A cross appeal shall be rejected as inadmissible in any of the following events:
  - (a) where it has not been filed within the time-limit laid down in paragraph 1;
  - (b) where it has not been filed in observance of the requirements laid down either in paragraph 2 or Article 21(1)(d);
  - (c) where it does not comply with the requirements referred to in paragraph 3, and the defendant has, despite having been informed thereof by the Board of Appeal, not remedied these deficiencies within the time-limit specified by the Board of Appeal to that effect or has not submitted the translation of the cross appeal and the corresponding statement of grounds within one month of the date of submission of the original.

5. The appellant shall be invited to submit observations on the defendant's cross appeal within two months of the date of notification to the appellant. In exceptional circumstances, that time-limit may be extended by the Board of Appeal upon the reasoned request of the appellant. Article 26 shall apply mutatis mutandis.

#### *Article 26*

##### *Reply and rejoinder in inter partes proceedings*

1. Upon the appellant's reasoned request filed within two weeks following the notification of the response, the Board of Appeal may, pursuant to Article 63(2) of Regulation (EC) No 207/2009, authorise the appellant to supplement the statement of grounds by a reply within a period specified by the Board of Appeal.
2. In such a case, the Board of Appeal shall also authorise the defendant to supplement the response by a rejoinder within a period specified by the Board of Appeal.

#### *Article 27*

##### *Examination of the appeal*

1. In *ex parte* proceedings, and with respect to those goods or services which form part of the subject matter of the appeal, the Board of Appeal, in compliance with Article 40(3) of Regulation (EC) No 207/2009, shall proceed in accordance with Article 37 of Regulation (EC) No 207/2009 where it raises a ground for refusal of the trade mark application which had not already been invoked in the decision subject to appeal in application of that provision.
2. In *inter partes* proceedings, the examination of the appeal and, as the case may be, the cross appeal, shall be restricted to the grounds invoked in the statement of grounds and, as the case may be, in the cross appeal. Matters of law not raised by the parties shall be examined by the Board of Appeal only where they concern essential procedural requirements or where it is necessary to resolve them in order to ensure a correct application of Regulation (EC) No 207/2009 having regard to the facts, evidence and arguments presented by the parties.
3. The examination of the appeal shall include the following claims or requests provided that they have been raised in the statement of grounds of the appeal or, as the case may be, in the cross appeal and provided that they were raised in due time in the proceedings before the instance of the Office which adopted the decision subject to appeal:
  - (a) distinctiveness acquired through use as referred to in Article 7(3) and Article 52(2) of Regulation (EC) No 207/2009;
  - (b) recognition of the earlier trade mark on the market acquired through use for the purposes of Article 8(1)(b) of Regulation (EC) No 207/2009;
  - (c) proof of use pursuant to Article 42(2) and (3) of Regulation (EC) No 207/2009 or Article 57(2) and (3) of Regulation (EC) No 207/2009.
4. In accordance with Article 76(2) of Regulation (EC) No 207/2009, the Board of Appeal may accept facts or evidence submitted for the first time before it only where those facts or evidence meet the following requirements:
  - (a) they are, on the face of it, likely to be relevant for the outcome of the case; and

- (b) they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal.
5. The Board of Appeal shall, at the latest in its decision on the appeal and, as the case may be, the cross appeal, decide on requests for restriction, division or partial surrender of the contested mark declared during the appeal proceedings by the applicant or the proprietor in accordance with Articles 43, 44 or 50 of Regulation (EC) No 207/2009. Where the Board of Appeal accepts the restriction, division or partial surrender, it shall without delay inform the department in charge of the register and the departments dealing with parallel proceedings involving the same mark accordingly.

#### *Article 28*

##### *Communications by the Board of Appeal*

1. Communications by the Board of Appeal in the course of the examination of the appeal or with a view to facilitating an amicable settlement of proceedings shall be prepared by the rapporteur and shall be signed by the rapporteur on behalf of the Board of Appeal, in agreement with the chairperson of the Board of Appeal.
2. Where a Board of Appeal communicates with the parties regarding its provisional opinion on matters of fact or law, it shall state that it is not bound by such a communication.

#### *Article 29*

##### *Comments on questions of general interest*

The Board of Appeal may, on its own initiative or upon the written, reasoned request of the Executive Director of the Office, invite the Executive Director to comment on questions of general interest which arise in the course of proceedings pending before it. The parties shall be entitled to submit their observations on the Executive Director's comments.

#### *Article 30*

##### *Reopening of the examination of absolute grounds*

1. Where, in *ex parte* proceedings, the Board of Appeal considers that an absolute ground for refusal may be applicable to goods or services listed in the trade mark application which do not form part of the subject matter of the appeal, it shall inform the examiner competent for examining that application who may decide to re-open the examination pursuant to Article 40(3) of Regulation (EC) No 207/2009 with respect to those goods or services.
2. Where a decision of the Opposition Division is subject to an appeal, the Board of Appeal may, by means of a reasoned interim decision and without prejudice to Article 58(1) of Regulation (EC) No 207/2009, suspend the appeal proceedings and remit the contested application to the examiner competent for examining that application with a recommendation to re-open the examination pursuant to Article 40(3) of Regulation (EC) No 207/2009, where it considers that an absolute ground for refusal shall apply to some or all of the goods or services listed in the trade mark application.

3. Where the contested application has been remitted in application of paragraph 2, the examiner shall inform the Board of Appeal without delay whether or not the examination of the contested application has been re-opened. Where the examination has been re-opened, the appeal proceedings shall remain suspended until the examiner's decision has been taken and, where the contested application is rejected in whole or in part, until the examiner's decision to this effect has become final.

#### *Article 31*

##### *Examination of an appeal as a matter of priority*

1. Upon reasoned request of the appellant or of the defendant and after hearing the other party, the Board of Appeal may decide, having regard to the particular urgency and the circumstances of the case, to examine the appeal as a matter of priority, without prejudice to the provisions in Articles 23 and 26, including the provisions on time-limits.
2. The request for the examination of the appeal as a matter of priority may be filed at any time in the course of the appeal proceedings. It shall be filed in a separate document and shall be supported by evidence as to the urgency and the particular circumstances of the case.

#### *Article 32*

##### *Formal content of the Board of Appeal's decision*

The Board of Appeal's decision shall contain:

- (a) a statement that it is delivered by the Boards of Appeal;
- (b) the date when the decision was taken;
- (c) the names of the parties and of their representatives;
- (d) the number of the appeal to which it refers and an identification of the decision subject to appeal in accordance with the requirements laid down in Article 21(1)(d);
- (e) an indication as to the formation of the Board of Appeal;
- (f) the name and, without prejudice to Article 39(5), the signature of the chairperson and members which took part in the decision, including an indication who acted as rapporteur in the case, or, where the decision is delivered by a single member, the name and signature of the member who took the decision;
- (g) the name and the signature of the Registrar or, as the case may be, of the member of the Registry signing on the Registrar's behalf;
- (h) a summary of the facts and of the arguments submitted by the parties;
- (i) a statement of the reasons for which the decision has been taken;
- (j) the order of the Board of Appeal, including, where necessary, a decision on costs.

#### *Article 33*

##### *Reimbursement of the appeal fee*

The appeal fee shall be reimbursed by order of the Board of Appeal in either of the following events:

- (a) where the appeal is not deemed to have been filed in accordance with the second sentence of Article 60(1) of Regulation (EC) No 207/2009;
- (b) where the decision-making instance of the Office which adopted the contested decision grants revision pursuant to Article 61(1) of Regulation (EC) No 207/2009 or revokes the contested decision in application of Article 80 of Regulation (EC) No 207/2009;
- (c) where, following re-opening of the examination proceedings within the meaning of Article 40(3) of Regulation (EC) No 207/2009 upon the Board of Appeal's recommendation pursuant to Article 30(2) of this Regulation, the contested application has been rejected by final decision of the examiner and the appeal has become devoid of purpose as a consequence thereof;
- (d) where the Board of Appeal considers such reimbursement equitable by reason of a substantial procedural violation.

#### *Article 34*

##### *Revision and revocation of the decision subject to appeal*

1. Where, in *ex parte* proceedings, the appeal is not rejected pursuant to Article 23(1), the Board of Appeal shall submit the notice of appeal and the statement of grounds of appeal to the instance of the Office which adopted the contested decision for the purposes of Article 61 of Regulation (EC) No 207/2009.
2. Where the instance of the Office which adopted the decision subject to appeal decides to grant revision pursuant to Article 61(1) of Regulation (EC) No 207/2009, it shall inform the Board of Appeal thereof without delay.
3. Where the instance of the Office which adopted the decision subject to appeal has initiated the procedure for revoking the decision subject to appeal pursuant to Article 80(2) of Regulation (EC) No 207/2009, it shall inform the Board of Appeal thereof without delay for the purposes of Article 71 of this Regulation. It shall also inform the Board of Appeal without delay about the final outcome of that procedure.

#### *Article 35*

##### *Allocation of an appeal to a Board and designation of a rapporteur*

1. As soon as the notice of appeal has been filed, the President of the Boards shall allocate the case to a Board of Appeal according to the objective criteria determined by the Presidium of the Boards of Appeal referred to in Article 136(4)(c) of Regulation (EC) No 207/2009.
2. For each case allocated to a Board of Appeal pursuant to paragraph 1, its chairperson shall designate a member of that Board of Appeal, or the chairperson, as rapporteur.
3. Where a case falls under the authority of a single member pursuant to Article 36(1), the Board of Appeal handling a case shall designate the rapporteur as single member pursuant to Article 135(5) of Regulation (EC) No 207/2009.
4. Where a decision of a Board of Appeal on a case has been annulled or altered by a final ruling of the General Court or, as the case may be, of the Court of Justice, the President of the Boards of Appeal shall, with a view to complying with that ruling in accordance with Article 65(6) of Regulation (EC) No 207/2009, re-allocate the case pursuant to paragraph 1 of this Article to a Board of Appeal, which shall not comprise those members which had adopted the annulled decision, except where the

case is referred to the enlarged Board of Appeal ('Grand Board') or where the annulled decision had been taken by the Grand Board.

5. Where several appeals are filed against the same decision, those appeals shall be considered in the same proceedings. Where appeals involving the same parties are filed against separate decisions concerning the same mark, or have other relevant factual or legal elements in common, those appeals may be considered in joined proceedings with the consent of the parties.

#### *Article 36*

##### *Cases falling under the authority of a single member*

1. The Board of Appeal handling the case may designate a single member within the meaning of Article 135(2) of Regulation (EC) No 207/2009 for the purposes of the following decisions:
  - (a) decisions pursuant to Article 23;
  - (b) decisions closing the appeal proceedings following withdrawal, rejection, surrender or cancellation of the contested or the earlier mark;
  - (c) decisions closing the appeal proceedings following withdrawal of the opposition, of the request for revocation or for declaration of invalidity or of the appeal;
  - (d) decisions on measures pursuant to Article 79d(1) and Article 80(2) of Regulation (EC) No 207/2009, provided that the correction or, as the case may be, the revocation of the decision on the appeal concerns a decision taken by a single member;
  - (e) decisions pursuant to Article 81(4) of Regulation (EC) No 207/2009;
  - (f) decisions pursuant to Article 85(3), (4) and (7) of Regulation (EC) No 207/2009;
  - (g) decisions on appeals against decisions in ex parte proceedings taken on the grounds laid down in Article 7 of Regulation (EC) No 207/2009, which are either manifestly unfounded or manifestly well founded.
2. Where the single member considers that the conditions set out in paragraph 1 or in Article 135(5) of Regulation (EC) No 207/2009 are not, or no longer, met, the single member shall refer the case back to the Board of Appeal in its composition of three members by submitting a draft decision pursuant to Article 41 of this Regulation.

#### *Article 37*

##### *Referral to the Grand Board*

1. Without prejudice to the faculty to refer a case to the Grand Board under Article 135(3) of Regulation (EC) No 207/2009, a Board of Appeal shall refer a case allocated to it to the Grand Board if it considers that it must deviate from an interpretation of the relevant legislation given in an earlier decision of the Grand Board, or if it observes that the Boards of Appeal have issued diverging decisions on a point of law which is liable to affect the outcome of the case.
2. All decisions on referrals of appeal cases to the Grand Board shall state the reasons for which the referring Board of Appeal or, as the case may be, the Presidium of the Boards of Appeal considers that this is justified, shall be communicated to the parties to the case and shall be published in the Official Journal of the Office.

3. The Grand Board shall, without delay, refer the case back to the Board of Appeal to which it was originally allocated if it believes that the conditions for the original referral are not, or no longer, met.
4. Requests for a reasoned opinion on questions on a point of law pursuant to Article 128(4)(1) of Regulation (EC) No 207/2009 shall be referred to the Grand Board in writing, shall state the questions of law of which the interpretation is sought, and may also state the Executive Director's view on the different possible interpretations as well as on their respective legal and practical consequences. The request shall be published in the Official Journal of the Office.
5. Where a Board of Appeal has to decide, in a case pending before it, on the same point in law that has already been raised in a referral to the Grand Board pursuant to Article 135(3) or Article 128(4)(1) of Regulation (EC) No 207/2009, it shall suspend the proceedings until the Grand Board has taken its decision or delivered its reasoned opinion.
6. Groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of a case on appeal or a request for a reasoned opinion brought before the Grand Board, may submit written observations within two months following the publication in the Official Journal of the Office of the decision of referral or, as the case may be, the request for a reasoned opinion. They shall not be parties to the proceedings before the Grand Board and shall bear their own costs.

#### *Article 38*

##### *Change in the composition of a Board*

1. Where, after oral proceedings, the composition of a Board of Appeal is changed pursuant to Article 43(2) and (3), all parties to the proceedings shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board of Appeal in its new composition. Fresh oral proceedings shall also be held if the new member so requests and provided that the other members of the Board of Appeal have given their agreement.
2. The new member of a Board of Appeal shall be bound to the same extent as the other members by any interim decision which has already been taken.

#### *Article 39*

##### *Deliberation, voting and signing of decisions*

1. The rapporteur shall submit to the other members of the Board of Appeal a draft of the decision to be taken and shall set a reasonable time limit within which to oppose it or to ask for changes.
2. The Board of Appeal shall meet to deliberate on the decision to be taken if it appears that its members are not all of the same opinion. Only members of the Board of Appeal shall participate in the deliberations; the chairperson of the Board of Appeal may, however, authorise other officers such as the Registrar or interpreters to attend. Deliberations shall be and remain secret.
3. During the deliberations between members of a Board of Appeal, the opinion of the rapporteur shall be heard first, and, if the rapporteur is not the chairperson, the opinion of the chairperson shall be heard last.

4. If voting is necessary, votes shall be taken in the same sequence, save that the chairperson shall always vote last. Abstentions shall not be permitted.
5. All members of the Board of Appeal taking the decision shall sign it. However, where the Board of Appeal has already reached a final decision and a member is unable to act, that member shall not be replaced and the chairperson shall sign the decision on the member's behalf. Where the chairperson is unable to act, the most senior member of the Board of Appeal as determined in accordance with Article 43(1) shall sign the decision on behalf of the chairperson.
6. Paragraphs 1 to 5 shall not apply where a decision is to be taken by a single member pursuant to Article 135(2) of Regulation (EC) No 207/2009 and Article 36(1) of this Regulation. In such cases, decisions shall be signed by the single member.

#### *Article 40*

##### *Chairperson of a Board of Appeal*

A chairperson shall preside over a Board of Appeal and shall have the following duties:

- (a) designate a member of the Board of Appeal, or himself or herself, as rapporteur for each case allocated to that Board of Appeal in accordance with Article 35(2);
- (b) designate, on behalf of the Board of Appeal, the rapporteur as single member pursuant to Article 135(2) of Regulation (EC) No 207/2009;
- (c) request the Board of Appeal to decide on the admissibility of the appeal in accordance with Article 23(2) of this Regulation;
- (d) direct the preparatory examination of the case carried out by the rapporteur in accordance with Article 41 of this Regulation;
- (e) preside over, and sign the minutes of, oral hearings and the taking of evidence.

#### *Article 41*

##### *Rapporteur to a Board of Appeal*

1. The rapporteur shall carry out a preliminary study of the appeal assigned to the rapporteur, prepare the case for examination and deliberation by the Board of Appeal, and draft the decision to be taken by the Board of Appeal.
2. To that effect, the rapporteur shall, where necessary and subject to the direction of the chairperson of the Board of Appeal, have the following duties:
  - (a) invite the parties to file observations in accordance with Article 63(2) of Regulation (EC) No 207/2009;
  - (b) decide on requests for the extension of time limits and, as the case may be, set time limits within the meaning of Article 24(1), Article 25(5) and Article 26 of this Regulation, and on suspensions pursuant to Article 71;
  - (c) prepare communications in accordance with Article 28 and the oral hearing;
  - (d) sign the minutes of oral proceedings and of the taking of evidence.

## *Article 42*

### *Registry*

1. A Registry shall be set up at the Boards of Appeal. It shall be responsible for the receipt, dispatch, safekeeping and notification of all documents relating to the proceedings before the Boards of Appeal, and for the compilation of the relevant files.
2. The Registry shall be headed by a Registrar. The Registrar shall fulfil the tasks referred to in this Article under the authority of the President of the Boards of Appeal, without prejudice to the provisions in paragraph 3.
3. The Registrar shall ensure that all formal requirements and time limits, laid down in Regulation (EC) No 207/2009, in this Regulation or in decisions of the Presidium of the Boards of Appeal adopted in accordance with Article 136(4)(c) and (d) of Regulation (EC) No 207/2009 are respected. To this effect, the Registrar shall have the following duties:
  - (a) sign the decisions taken by the Boards of Appeal in respect of appeals;
  - (b) take and sign the minutes of oral proceedings and of the taking of evidence;
  - (c) provide, either on its own motion or upon request of the Board of Appeal, reasoned opinions to the Board of Appeal on procedural and formal requirements including on irregularities pursuant to Article 23(2) of this Regulation;
  - (d) submit the appeal, in accordance with Article 34(1) of this Regulation, to the instance of the Office which adopted the contested decision;
  - (e) order, on behalf of the Board of Appeal, in the cases referred to in Article 33(a) and (b) of this Regulation, the reimbursement of the appeal fee.
4. The Registrar shall, upon delegation of the President of the Boards of Appeal, have the following duties:
  - (a) allocate cases in accordance with Article 35(1) and (4);
  - (b) implement, pursuant to Article 136(4)(b) of Regulation (EC) No 207/2009, decisions of the Presidium of the Boards of Appeal relating to the conduct of proceedings before the Boards of Appeal.
5. The Registrar may, upon delegation of the Presidium of the Boards of Appeal made upon proposal of the President of the Boards of Appeal, perform other tasks relating to the conduct of appeal proceedings before the Boards of Appeal and the organisation of their work.
6. The Registrar may delegate the tasks referred to in this Article to a member of the Registry.
7. Where the Registrar is prevented from acting within the meaning of Article 43(4), or where the post of Registrar is vacant, the President of the Boards of Appeal shall appoint a member of the Registry who shall perform the tasks of the Registrar in the Registrar's absence.
8. The members of the Registry shall be managed by the Registrar.

### Article 43

#### *Order of seniority and replacement of members and chairpersons*

1. The seniority of chairpersons and members shall be calculated according to the date on which they took up their duties as specified in the instrument of appointment or, failing that, as fixed by the Management Board of the Office. Where there is equal seniority on that basis, the order of seniority shall be determined by age. Chairpersons and members whose term of office is renewed shall retain their former seniority.
2. Where the chairperson of a Board of Appeal is prevented from acting, that chairperson shall be replaced, on the basis of seniority as determined in accordance with paragraph 1, by the most senior member of that Board of Appeal, or, where no member of that Board of Appeal is available, by the most senior of the other members of the Boards of Appeal.
3. Where a member of a Board of Appeal is prevented from acting, that member shall be replaced, on the basis of seniority as determined in accordance with paragraph 1, by the most senior member of that Board of Appeal, or, where no member of that Board of Appeal is available, by the most senior of the other members of the Boards of Appeal.
4. For the purposes of paragraphs 2 and 3, chairpersons and members of the Boards of Appeal shall be considered to be prevented from acting in case of leave, sickness, inescapable commitments and exclusion pursuant to Article 137 of Regulation (EC) No 207/2009 and Article 35(4) of this Regulation. A chairperson shall also be considered to be prevented from acting where that chairperson acts *ad interim* as President of the Boards of Appeal pursuant to Article 47(2) of this Regulation. Where the post of chairperson or member is vacant, their respective functions shall be exercised *ad interim* pursuant to the provisions in paragraphs 2 and 3 of this Article concerning replacement.
5. Any member considering itself prevented from acting shall without delay inform the chairperson of the Board of Appeal concerned. Any chairperson considering itself prevented from acting shall without delay inform simultaneously that chairperson's alternate determined in accordance with paragraph 2 and the President of the Boards of Appeal.

### Article 44

#### *Exclusion and objection*

1. Before a decision is taken by a Board of Appeal pursuant to Article 137(4) of Regulation (EC) No 207/2009, the chairperson or member concerned shall be invited to present comments as to whether there is a reason for exclusion or objection.
2. Where the Board of Appeal obtains knowledge, from a source other than the concerned member itself or a party to the proceedings, of a possible reason for exclusion or objection under Article 137(3) of Regulation (EC) No 207/2009, the procedure laid down in Article 137(4) of Regulation (EC) No 207/2009 shall be applied.
3. The proceedings concerned shall be suspended until a decision is taken on the action to be taken pursuant to Article 137(4) of Regulation (EC) No 207/2009.

*Article 45*  
*Grand Board*

1. The list comprising the names of all members of the Boards of Appeal other than the President of the Boards of Appeal and the chairpersons of the Boards of Appeal for the purposes of drawing in rotation the members of the Grand Board referred to in Article 136a(2) of Regulation (EC) No 207/2009 shall be drawn up in the order of seniority determined in accordance with Article 43(1) of this Regulation. Where an appeal has been referred to the Grand Board pursuant to Article 135(3)(b) of Regulation (EC) No 207/2009, the Grand Board shall comprise the rapporteur designated prior to the referral.
2. Article 40 shall apply to the President of the Boards of Appeal acting in the capacity of chairperson of the Grand Board. Article 41 shall apply to the rapporteur to the Grand Board.
3. Where the President of the Boards of Appeal is prevented from acting as chairperson of the Grand Board, the President of the Boards of Appeal shall be replaced in that function and, as the case may be, as rapporteur to the Grand Board, on the basis of seniority as determined in accordance with Article 43(1), by the most senior chairperson of the Boards of Appeal. Where a member of the Grand Board is prevented from acting, that member shall be replaced by another member of the Boards of Appeal to be designated pursuant to Article 136a(2) of Regulation (EC) No 207/2009 and paragraph 1 of this Article. Article 43(4) and (5) of this Regulation shall apply *mutatis mutandis*.
4. The Grand Board shall not deliberate or vote on cases, and oral proceedings shall not take place before the Grand Board unless seven of its members are present, including its chairperson and the rapporteur.
5. Article 39(1) to (5) shall apply to the deliberation and voting of the Grand Board. In the event of a tie, the vote of the chairperson shall be decisive.
6. Article 32 shall apply to decisions of the Grand Board and *mutatis mutandis* to its reasoned opinions within the meaning of Article 128(4)(l) of Regulation (EC) No 207/2009.

*Article 46*  
*Presidium of the Boards of Appeal*

1. The Presidium of the Boards of Appeal shall have the following duties:
  - (a) decide on the constitution of Boards of Appeal;
  - (b) determine the objective criteria for the allocation of appeal cases to the Boards of Appeal and rule on any conflict as regards the application thereof;
  - (c) upon proposal of the President of the Boards of Appeal, establish the Boards of Appeal's expenditure requirements with a view to drawing up the Office's expenditure estimates;
  - (d) lay down its internal rules;
  - (e) lay down rules for the processing of exclusion and objection of members pursuant to Article 137 of Regulation (EC) No 207/2009;
  - (f) lay down the working instructions for the Registry;

- (g) take any other measure for the purpose of exercising its functions of laying down the rules and of organising the work of the Boards of Appeal pursuant to Article 135(3)(a) and Article 136(4)(a) of Regulation (EC) No 207/2009.
2. The Presidium may validly deliberate only if at least two-thirds of its members, including the chairperson of the Presidium and half of the chairpersons of the Boards of Appeal, rounded up if necessary, are present. Decisions of the Presidium shall be taken by a majority vote. In the event of a tie, the vote of the chairperson shall be decisive.
  3. The decisions adopted by the Presidium pursuant to Article 43(1), to Article 45(1), and to paragraph 1(a) and (b) of this Article shall be published in the Official Journal of the Office.

#### *Article 47*

#### *President of the Boards of Appeal*

1. Where the President of the Boards of Appeal is prevented from acting within the meaning of Article 43(4), the managerial and organisational functions conferred upon the President of the Boards of Appeal by Article 136(4) of Regulation (EC) No 207/2009 shall be exercised, on the basis of seniority as determined in accordance with Article 43(1) of this Regulation, by the most senior chairperson of the Boards of Appeal.
2. Where the post of the President of the Boards of Appeal is vacant, the functions of that president shall be exercised *ad interim*, on the basis of seniority as determined in accordance with Article 43(1), by the most senior chairperson of the Boards of Appeal.

#### *Article 48*

#### *Applicability to appeal proceedings of provisions relating to other proceedings*

Unless otherwise provided in this title, the provisions relating to proceedings before the instance of the Office which adopted the decision subject to appeal shall be applicable to appeal proceedings *mutatis mutandis*.

### **TITLE VI**

### **ORAL PROCEEDINGS AND TAKING OF EVIDENCE**

#### *Article 49*

#### *Summons to oral proceedings*

1. The parties shall be summoned to oral proceedings provided for in Article 77 of Regulation (EC) No 207/2009 and their attention shall be drawn to paragraph 3 of this Article.
2. When issuing the summons, the Office shall request, where necessary, that the parties provide all relevant information and documents before the hearing. The Office may invite the parties to concentrate on one or more specified issues during the oral proceedings. It may also offer to the parties the possibility to take part in the oral proceedings by video conference or other technical means.
3. If a party who has been duly summoned to oral proceedings before the Office does not appear as summoned, the proceedings may continue without that party.

4. The Office shall ensure that the case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary.

#### *Article 50*

##### *Languages of oral proceedings*

1. Oral proceedings shall be conducted in the language of the proceedings unless the parties agree to use a different official language of the Union.
2. The Office may communicate in oral proceedings in another official language of the Union and it may, upon request, authorise a party to do so provided that simultaneous interpretation into the language of proceedings can be made available. The costs of providing simultaneous interpretation shall be borne by the party making the request or by the Office as the case may be.

#### *Article 51*

##### *Oral evidence of parties, witnesses or experts and inspection*

1. Where the Office considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it shall take an interim decision to that end, stating the means by which it intends to obtain the evidence, the relevant facts to be proved and the date, time and place of hearing or inspection. Where the hearing of oral evidence of witnesses or experts is requested by a party, the Office shall determine in its decision the period within which that party must make known to the Office the names and addresses of the witnesses or experts.
2. The summons of parties, witnesses or experts to give evidence shall contain:
  - (a) an extract from the decision referred to in paragraph 1, indicating the date, time and place of the hearing ordered and stating the facts regarding which the parties, witnesses and experts are to be heard;
  - (b) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke under Article 54(2) to (5).

The summons shall also offer to the witnesses or experts being summoned the possibility to take part in the oral proceedings by video conference or other technical means.

3. Article 50(2) shall apply *mutatis mutandis*.

#### *Article 52*

##### *Commissioning of and opinions by experts*

1. The Office shall decide in what form an opinion is to be submitted by an expert.
2. The terms of reference of the expert shall include:
  - (a) a precise description of the expert's task;
  - (b) the time limit laid down for the submission of the expert opinion;
  - (c) the names of the parties to the proceedings;
  - (d) particulars of the rights which the expert may invoke pursuant to Article 54(2), (3) and (4).

3. Where an expert is appointed, the expert opinion shall be submitted in the language of the proceedings or accompanied by a translation into that language. A copy of any written opinion, and of the translation if needed, shall be submitted to the parties.
4. The parties may object to the appointment of an expert on grounds of incompetence or on the same grounds as those on which objection may be made to an examiner or to a member of a Division or Board of Appeal pursuant to Article 137(1) and (3) of Regulation (EC) No 207/2009. Any objection to the appointment of an expert shall be submitted in the language of the proceedings, or accompanied by a translation into that language. The department of the Office concerned shall rule on the objection.

#### *Article 53*

##### *Minutes of oral proceedings*

1. Minutes of oral proceedings or the taking of oral evidence shall be drawn up, containing:
  - (a) the number of the case to which the oral proceedings relate and the date of the oral proceedings;
  - (b) the names of the officials of the Office, the parties, their representatives, and of the witnesses and experts who are present;
  - (c) the submissions and requests made by the parties;
  - (d) the means of giving or obtaining evidence;
  - (e) where applicable, the orders or the decision issued by the Office.
2. The minutes shall become part of the file of the relevant EU trade mark application or registration. They shall be notified to the parties.
3. Where oral proceedings or the taking of evidence before the Office are recorded, the recording shall replace the minutes and paragraph (2) shall apply mutatis mutandis.

#### *Article 54*

##### *Costs of taking of evidence in oral proceedings*

1. The taking of evidence by the Office may be made conditional upon deposit with it, by the party who has requested the evidence to be taken, of a sum which shall be fixed by reference to an estimate of the costs.
2. Witnesses and experts who are summoned by and appear before the Office shall be entitled to reimbursement of reasonable expenses for travel and subsistence where such expenses are incurred. An advance for such expenses may be granted to them by the Office.
3. Witnesses entitled to reimbursement pursuant to paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts to fees for their work. That compensation shall be paid to the witnesses and experts after they have fulfilled their duties or tasks, where such witnesses and experts have been summoned by the Office of its own initiative.
4. The amounts and advances for expenses to be paid pursuant to paragraphs 1, 2 and 3 shall be determined by the Executive Director and shall be published in the Official Journal of the Office. The amounts shall be calculated on the same basis as laid down in the Staff Regulations of the Officials of the Union and the Conditions of

Employment of Other Servants of the Union, laid down in Council Regulation (EEC, Euratom, ECSC) No 259/68<sup>7</sup> and Annex VII thereto.

5. Liability for the amounts due or paid pursuant to paragraphs 1 to 4 shall lie with:
  - (a) the Office where it, at its own initiative, has summoned the witnesses or experts;
  - (b) the party concerned where that party has requested the giving of oral evidence by witnesses or experts, subject to the decision on apportionment and fixing of costs pursuant to Articles 85 and 86 of Regulation (EC) No 207/2009 and Article 18 of Implementing Regulation (EU) No ..... Such party shall reimburse the Office for any advances duly paid.

*Article 55*  
*Examination of written evidence*

1. The Office shall examine any evidence given or obtained in any proceedings before it to the extent necessary to take a decision in the proceedings in question.
2. The documents or other items of evidence shall be contained in annexes to a submission which shall be numbered consecutively. The submission shall include an index indicating, for each document or item of evidence annexed:
  - (a) the number of the annex;
  - (b) a short description of the document or item and, if applicable, the number of pages;
  - (c) the page number of the submission where the document or item is mentioned.The submitting party may also indicate, in the index of annexes, which specific parts of a document it relies upon in support of its arguments.
3. Where the submission or the annexes do not comply with the requirements set out in paragraph 2, the Office may invite the submitting party to remedy any deficiency, within a period specified by the Office.
4. Where the deficiency is not remedied within the period specified by the Office, and where it is still not possible for the Office to clearly establish to which ground or argument a document or item of evidence refers, that document or item shall not be taken into account.

**TITLE VII**  
**NOTIFICATIONS BY THE OFFICE**

*Article 56*  
*General provisions on notifications*

1. In proceedings before the Office, notifications to be made by the Office shall be in accordance with Article 75(2) of Regulation (EC) No 207/2009 and shall consist in the transmission of the document to be notified to the parties concerned. Transmission may be effected by providing electronic access to that document.
2. Notifications shall be made by one of the following means:

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<sup>7</sup> OJ L 56, 4.3.1968, p. 1.

- (a) electronic means pursuant to Article 57;
  - (b) post or courier pursuant to Article 58;
  - (c) public notification pursuant to Article 59.
3. Where the addressee has indicated contact details for communicating with the addressee through electronic means, the Office shall have the choice between those means and notification by post or courier.

#### *Article 57*

##### *Notification by electronic means*

1. Notification by electronic means covers transmissions by wire, by radio, by optical means or by other electromagnetic means, including the internet.
2. The Executive Director shall determine the details regarding the specific electronic means to be used, the manner in which electronic means will be used, and the time limit for notification by electronic means.

#### *Article 58*

##### *Notification by post or courier*

1. Notwithstanding Article 56(3), decisions subject to a time limit for appeal, summons and other documents as determined by the Executive Director shall be notified by courier service or registered post, in both cases with advice of delivery. All other notifications shall be either by courier service or registered post, whether or not with advice of delivery, or by ordinary post.
2. Notwithstanding Article 56(3), notifications in respect of addressees having neither their domicile nor their principal place of business or a real and effective industrial or commercial establishment in the European Economic Area ("EEA") and who have not appointed a representative as required by Article 92(2) of Regulation (EC) No 207/2009 shall be effected by posting the document requiring notification by ordinary post.
3. Where notification is effected by courier service or registered post, whether or not with advice of delivery, it shall be deemed to be delivered to the addressee on the tenth day following that of its posting, unless the letter has failed to reach the addressee or has reached the addressee at a later date. In the event of any dispute, it shall be for the Office to establish that the letter has reached its destination or to establish the date on which it was delivered to the addressee, as the case may be.
4. Notification by courier service or registered post shall be deemed to have been effected even if the addressee refuses to accept the letter.
5. Notification by ordinary post shall be deemed to have been effected on the tenth day following that of its posting.

#### *Article 59*

##### *Public Notification by public notice*

Where the address of the addressee cannot be established or where after at least one attempt notification in accordance with Article 56(2)(a) and (b) has proved impossible, notification shall be effected by public notice.

*Article 60*  
*Notification to representatives*

1. Where a representative has been appointed or where the applicant first named in a common application is considered to be the common representative pursuant to Article 73(1), notifications shall be addressed to that appointed or common representative.
2. Where a single party has appointed several representatives, notification shall be effected in accordance with Article 2(1)(e) of Implementing Regulation (EU) No ..... Where several parties have appointed a common representative, notification of a single document to the common representative shall be sufficient.
3. A notification or other communication addressed by the Office to the duly authorised representative shall have the same effect as if it had been addressed to the represented person.

*Article 61*  
*Irregularities in notification*

Where a document has reached the addressee and where the Office is unable to prove that it has been duly notified or where provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established as the date of receipt.

*Article 62*  
*Notification of documents in the case of several parties*

Documents emanating from parties shall be notified to the other parties as a matter of course. Notification may be dispensed with where the document contains no new pleadings and the matter is ready for decision.

**TITLE VIII**  
**WRITTEN COMMUNICATIONS AND FORMS**

*Article 63*  
*Communications to the Office in writing or by other means*

1. Applications for the registration of an EU trade mark as well as any other application provided for in Regulation (EC) No 207/2009 and all other communications addressed to the Office shall be submitted as follows:
  - (a) by transmitting a communication by electronic means, in which case the indication of the name of the sender shall be deemed to be equivalent to the signature;
  - (b) by submitting a signed original of the document in question to the Office by post or courier.
2. In proceedings before the Office, the date on which a communication is received by the Office shall be considered to be its date of filing or submission.
3. Where a communication received by electronic means is incomplete or illegible or where the Office has reasonable doubts as to the accuracy of the transmission, the Office shall inform the sender accordingly and shall invite the sender, within a period to be specified by the Office, to retransmit the original or to submit it in accordance

with paragraph (1)(b). Where that request is complied with within the period specified, the date of receipt of the retransmission or of the original shall be deemed to be the date of the receipt of the original communication. However, where the deficiency concerns the granting of a filing date for an application to register a trade mark, the provisions on the filing date shall apply. Where the request is not complied with within the period specified, the communication shall be deemed not to have been received.

#### *Article 64*

##### *Annexes to communications by post or courier*

1. Annexes to communications may be submitted on data carriers in accordance with the technical specifications determined by the Executive Director.
2. Where a communication with annexes is submitted in accordance with Article 63(1)(b) by a party in a proceeding involving more than one party, the party shall submit as many copies of the annexes as there are parties to the proceedings. Annexes shall be indexed in accordance with the requirements laid down in Article 55(2).

#### *Article 65*

##### *Forms*

1. The Office shall make forms available to the public free of charge, which may be completed online, for the purposes of:
  - (a) filing an application for an EU trade mark, including, where appropriate, requests for the search reports;
  - (b) entering an opposition;
  - (c) applying for revocation of rights;
  - (d) applying for a declaration of invalidity or the assignment of an EU trade mark;
  - (e) applying for the registration of a transfer and the transfer form or document referred to in Article 13(3)(d) of Implementing Regulation (EU) No .../...;
  - (f) applying for the registration of a licence;
  - (g) applying for the renewal of an EU trade mark;
  - (h) making an appeal;
  - (i) authorising a representative, in the form of an individual authorisation or a general authorisation;
  - (j) submitting an international application or a subsequent designation pursuant to the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989<sup>8</sup> to the Office.
2. Parties to the proceedings before the Office may also use:
  - (a) forms established under the Trademark Law Treaty or pursuant to recommendations of the Assembly of the Paris Union for the Protection of Industrial Property;

<sup>8</sup>

OJ L 296, 14.11.2003, p. 22.

- (b) with the exception of the form referred to in point (i) of paragraph 1, forms with the same content and format as those referred to in paragraph 1.
3. The Office shall make the forms referred to in paragraph 1 available in all the official languages of the Union.

#### *Article 66*

##### *Communications by representatives*

Any communication addressed to the Office by the duly authorised representative shall have the same effect as if it originated from the represented person.

### **TITLE IX TIME LIMITS**

#### *Article 67*

##### *Calculation and duration of time limits*

1. The calculation of a time limit shall start on the day following the day on which the relevant event occurred, either a procedural step or the expiry of another time limit. Where that procedural step is a notification, the event shall be the receipt of the document notified, unless otherwise provided for.
2. Where a time limit is expressed as one year or a certain number of years, it shall expire on the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the relevant event occurred. Where the relevant month has no day with the same number, the time limit shall expire on the last day of that month.
3. Where a time limit is expressed as one month or a certain number of months, it shall expire on the relevant subsequent month on the day which has the same number as the day on which the relevant event occurred. Where the relevant subsequent month has no day with the same number, the time limit shall expire on the last day of that month.
4. Where a time limit is expressed as one week or a certain number of weeks, it shall expire on the relevant subsequent week on the day having the same name as the day on which the said event occurred.

#### *Article 68*

##### *Extension of time limits*

Subject to specific or maximum time limits laid down in Regulation (EC) No 207/2009, Implementing Regulation (EU) .../... or this Regulation, the Office may grant an extension of a time limit upon reasoned request. Such request shall be submitted by the party concerned before the time limit in question expires. Where there are two or more parties, the Office may subject the extension of a time limit to the agreement of the other parties.

#### *Article 69*

##### *Expiry of time limits in special cases*

1. Where a time limit expires on a day on which the Office is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary post is not delivered in the locality in which the Office is located, the time

limit shall be extended until the first day thereafter on which the Office is open for receipt of documents and on which ordinary mail is delivered.

2. Where a time limit expires on a day on which there is a general interruption in the delivery of mail in the Member State where the Office is located, or, if and to the extent that the Executive Director has allowed communications to be sent by electronic means pursuant to Article 79b(1) of Regulation (EC) No 207/2009, on which there is an actual interruption of the Office's connection to those electronic means of communication, the time limit shall be extended until the first day thereafter on which the Office is open for receipt of documents and on which ordinary mail is delivered or the Office's connection to those electronic means of communication is restored.

## **TITLE X**

### **REVOCAION OF A DECISION**

#### *Article 70*

#### *Revocation of a decision or entry in the Register*

1. Where the Office finds of its own motion or pursuant to corresponding information provided by the parties to the proceedings that a decision or entry in the Register is subject to revocation pursuant to Article 80 of Regulation (EC) 207/2009, it shall inform the affected party about the intended revocation.
2. The affected party shall submit observations on the intended revocation within a time limit specified by the Office.
3. Where the affected party agrees to the intended revocation or does not submit any observations within the time limit, the Office shall revoke the decision or entry. If the affected party does not agree to the intended revocation, the Office shall take a decision on the intended revocation.
4. Where the intended revocation is likely to affect more than one party, paragraphs 1, 2 and 3 shall apply *mutatis mutandis*. In those cases the observations submitted by one of the parties pursuant to paragraph 3 shall always be communicated to the other party or parties with an invitation to submit observations.
5. Where the revocation of a decision or an entry in the Register affects a decision or entry that has been published, the revocation shall also be published.
6. Competence for revocation pursuant to paragraphs 1 to 4 shall lie with the department or unit which took the decision.

## **TITLE XI**

### **SUSPENSION OF PROCEEDINGS**

#### *Article 71*

#### *Suspension of proceedings*

1. As regards opposition, revocation and declaration of invalidity and appeal proceedings, the competent department or Board of Appeal may suspend proceedings:
  - (a) on its own motion where a suspension is appropriate under the circumstances of the case;

- (b) at the reasoned request of one of the parties in *inter partes* proceedings where a suspension is appropriate under the circumstances of the case, taking into account the interests of the parties and the stage of the proceedings.
2. At the request of both parties in *inter partes* proceedings, the competent department or Board of Appeal shall suspend the proceedings for a period which shall not exceed six months. That suspension may be extended upon a request of both parties up to a total maximum of two years.
3. Any time limits related to the proceedings in question, other than the time limits for the payment of the applicable fee, shall be interrupted as from the date of suspension. Without prejudice to Article 137a(5) of Regulation (EC) No 207/2009, the time limits shall be recalculated to begin again as from the day on which the proceedings are resumed.
4. Where appropriate under the circumstances of the case, the parties may be invited to submit their observations as regards the suspension or resumption of the proceedings.

## **TITLE XII**

### **INTERRUPTION OF PROCEEDINGS**

#### *Article 72*

#### *Resumption of proceedings*

1. Where proceedings before the Office have been interrupted pursuant to Article 82a(1) of Regulation (EC) No 207/2009, the Office shall be informed of the identity of the person authorised to continue the proceedings before it pursuant to Article 82a(2) of Regulation (EC) No 207/2009. The Office shall communicate to that person and to any interested third parties that the proceedings shall be resumed as from a date to be fixed by the Office.
2. Where, three months after the beginning of the interruption of the proceedings pursuant to Article 82a(1)(c) of Regulation (EC) No 207/2009, the Office has not been informed of the appointment of a new representative, it shall inform the applicant for or proprietor of the EU trade mark that:
  - (a) where Article 92(2) of Regulation (EC) No 207/2009 shall apply, the EU trade mark application shall be deemed to be withdrawn if the information is not submitted within two months after the communication is notified;
  - (b) where Article 92(2) of Regulation (EC) No 207/2009 does not apply, the proceedings will be resumed with the applicant for or proprietor of the EU trade mark as from the date on which this communication is notified.
3. The time limits in force as regards the applicant for or proprietor of the EU trade mark at the date of interruption of the proceedings, other than the time limit for paying the renewal fees, shall begin again as from the day on which the proceedings are resumed.

## TITLE XIII REPRESENTATION

### *Article 73*

#### *Appointment of a common representative*

1. Where there is more than one applicant and the application for an EU trade mark does not name a common representative, the first applicant named in the application having the domicile or principal place of business or a real and effective industrial or commercial establishment in the EEA, or its representative if appointed, shall be considered to be the common representative. Where all of the applicants are obliged to appoint a professional representative, the professional representative who is named first in the application shall be considered to be the common representative. This shall apply *mutatis mutandis* to third parties acting in common in filing notice of opposition or applying for revocation or for a declaration of invalidity and to joint proprietors of an EU trade mark.
2. Where, during the course of proceedings, transfer is made to more than one person and those persons have not appointed a common representative, paragraph 1 shall apply. Where such an appointment is not possible, the Office shall require those persons to appoint a common representative within two months. If that request is not complied with, the Office shall appoint the common representative.

### *Article 74*

#### *Authorisations*

1. Employees who represent natural or legal persons within the meaning of Article 92(3) of Regulation (EC) No 207/2009, as well as legal practitioners and professional representatives entered on the list maintained by the Office pursuant to Article 93(2) of Regulation (EC) No 207/2009, shall file a signed authorisation with the Office for insertion in the files pursuant to Article 92(3) and Article 93(1) of Regulation (EC) No 207/2009 only where the Office expressly requires it or where there are several parties to the proceedings in which the representative acts before the Office and the other party expressly asks for it.
2. Where it is required, pursuant to Article 92(3) or Article 93(1) of Regulation (EC) No 207/2009, that a signed authorisation be filed, such an authorisation may be filed in any official language of the Union. It may cover one or more applications or registered trade marks or may be in the form of a general authorisation authorising the representative to act in respect of all proceedings before the Office to which the person giving the authorisation is a party.
3. The Office shall specify a time limit within which such an authorisation shall be filed. Where the authorisation is not filed in due time, proceedings shall be continued with the represented person. Any procedural steps taken by the representative other than the filing of the application shall be deemed not to have been taken if the represented person does not approve them within a time limit specified by the Office.
4. Paragraphs 1 and 2 shall apply *mutatis mutandis* to a document withdrawing an authorisation.
5. Any representative who has ceased to be authorised shall continue to be regarded as the representative until the termination of that representative's authorisation has been communicated to the Office.

6. Subject to any provisions to the contrary contained therein, an authorisation shall not automatically cease to be valid *vis-à-vis* the Office upon the death of the person who gave it.
7. Where the appointment of a representative is communicated to the Office, the name and the business address of the representative shall be indicated in accordance with Article 2(1)(e) of Implementing Regulation (EU) .../... Where a representative who has already been appointed appears before the Office, that representative shall indicate the name and the identification number attributed to the representative by the Office. Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorisations, act either jointly or singly.
8. The appointment or authorisation of an association of representatives shall be deemed to be an appointment or authorisation of any representative who practices within that association.

#### *Article 75*

##### *Amendment of the list of professional representatives*

1. Pursuant to Article 93(5) of Regulation (EC) No 207/2009, the entry of a professional representative shall be deleted automatically:
  - (a) in the event of the death or legal incapacity of the professional representative;
  - (b) where the professional representative is no longer a national of one of the Member States of the EEA, unless the Executive Director has granted an exemption under Article 93(4)(b) of Regulation (EC) No 207/2009;
  - (c) where the professional representative no longer has the place of business or employment in the EEA;
  - (d) where the professional representative no longer possesses the entitlement referred to in the first sentence of Article 93(2)(c) of Regulation (EC) No 207/2009.
2. The entry of a professional representative shall be suspended of the Office's own motion where the representative's entitlement to represent natural or legal persons before the Benelux Office for Intellectual Property or the central industrial property office of a Member State as referred to in the first sentence of Article 93(2)(c) of Regulation (EC) No 207/2009 has been suspended.
3. Where the conditions for deletion no longer exist, a person whose entry has been deleted shall, upon request, accompanied by a certificate pursuant to Article 93(3) of Regulation (EC) No 207/2009, be reinstated in the list of professional representatives.
4. The Benelux Office for Intellectual Property and the central industrial property offices of the Member States concerned shall, where they are aware of any relevant events referred to in paragraphs 1 and 2, promptly inform the Office thereof.

## TITLE XIV

### PROCEDURES CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

#### *Article 76* *Collective and certification marks*

1. Without prejudice to Article 154 of Regulation (EC) No 207/2009, where an international registration designating the Union is dealt with as an EU collective mark or as an EU certification mark pursuant to Article 154a(1) of Regulation (EC) No 207/2009, a notification of an *ex officio* provisional refusal shall also be issued in accordance with Article 33 of Implementing Regulation (EU) .../... in the following cases:
  - (a) where one of the grounds for refusal provided for in Article 68(1) or (2) of Regulation (EC) No 207/2009, in conjunction with paragraph 3 of that Article, or in Article 74c(1) or (2) of Regulation (EC) No 207/2009, in conjunction with paragraph 3 of that Article exists;
  - (b) where the regulations governing use of the mark have not been submitted in accordance with Article 154a(2) of Regulation (EC) No 207/2009.
2. Notice of amendments to the regulations governing the use of the mark pursuant to Articles 71 and 74f of Regulation (EC) No 207/2009 shall be published in the European Union Trade Marks Bulletin.

#### *Article 77* *Opposition proceedings*

1. Where opposition is entered against an international registration designating the Union pursuant to Article 156 of Regulation (EC) No 207/2009, the notice of opposition shall contain:
  - (a) the number of the international registration against which opposition is entered;
  - (b) an indication of the goods or services listed in the international registration against which opposition is entered;
  - (c) the name of the holder of the international registration;
  - (d) the requirements laid down in Article 2(2)(b) to (h) of this Regulation.
2. Article 2(1), (3) and (4) and Articles 3 to 10 of this Regulation shall apply for the purposes of opposition proceedings relating to international registrations designating the Union, subject to the following conditions:
  - (a) any reference to an application for registration of the EU trade mark shall be read as a reference to an international registration;
  - (b) any reference to a withdrawal of the application for registration of the EU trade mark shall be read as a reference to the renunciation of the international registration in respect of the Union;
  - (c) any reference to the applicant shall be read as a reference to the holder of the international registration.
3. Where the notice of opposition is filed before the expiry of the period of one month referred to in Article 156(2) of Regulation (EC) No 207/2009, the notice of

opposition shall be deemed to have been filed on the first day following the expiry of the period of one month.

4. Where the holder of the international registration is obliged to be represented in proceedings before the Office pursuant to Article 92(2) of Regulation (EC) No 207/2009, and where the holder of the international registration has not already appointed a representative within the meaning of Article 93(1) of Regulation (EC) No 207/2009, the communication of the opposition to the holder of the international registration pursuant to Article 6(1) of this Regulation shall contain a request for the appointment of a representative within the meaning of Article 93(1) of Regulation (EC) No 207/2009 within a time limit of two months from the date of notification of the communication.

Where the holder of the international registration fails to appoint a representative within that time limit, the Office shall take a decision refusing the protection of the international registration.

5. The opposition procedure shall be stayed where an *ex officio* provisional refusal of protection is issued pursuant to Article 154 of Regulation (EC) No 207/2009. Where the *ex officio* provisional refusal has led to a decision to refuse protection of the mark which has become final, the Office shall not proceed to a decision and refund the opposition fee and no decision on the apportionment of costs shall be taken.

#### *Article 78*

##### *Notification of provisional refusals based on an opposition*

1. Where a notice of opposition against an international registration is entered at the Office pursuant to Article 156(2) of Regulation (EC) No 207/2009, or where an opposition is deemed to have been entered pursuant to Article 77(3) of this Regulation, the Office shall issue a notification of provisional refusal of protection based on an opposition to the International Bureau of the World Intellectual Property Organisation ("the International Bureau").
2. The notification of provisional refusal of protection based on an opposition shall contain:
  - (a) the number of the international registration;
  - (b) the indication that the refusal is based on the fact that an opposition has been filed, together with a reference to the provisions of Article 8 of Regulation (EC) No 207/2009 upon which the opposition relies;
  - (c) the name and the address of the opposing party.
3. Where the opposition is based on a trade mark application or registration, the notification referred to in paragraph 2 shall contain the following indications:
  - (a) the filing date, the registration date and the priority date, if any;
  - (b) the filing number and, the registration number, if different;
  - (c) the name and address of the owner;
  - (d) a reproduction of the mark;
  - (e) the list of goods or services upon which the opposition is based.
4. Where the provisional refusal relates to only part of the goods or services, the notification referred to in paragraph 2 shall indicate those goods or services.

5. The Office shall inform the International Bureau of the following:
  - (a) where as a result of the opposition proceedings the provisional refusal has been withdrawn, the fact that the mark is protected in the Union;
  - (b) where a decision to refuse protection of the mark has become final following an appeal pursuant to Article 58 of Regulation (EC) No 207/2009 or an action pursuant to Article 65 of Regulation (EC) No 207/2009, the fact that protection of the mark is refused in the Union;
  - (c) where the refusal referred to in point (b) concerns only part of the goods or services, the goods or services for which the mark is protected in the Union.
6. Where more than one provisional refusal has been issued for one international registration pursuant to Article 154(2) of Regulation (EC) No 207/2009 or paragraph 1 of this Article, the communication referred to in paragraph 5 of this Article shall relate to the total or partial refusal of protection of the mark pursuant to Articles 154 and 156 of Regulation (EC) No 207/2009.

#### *Article 79*

#### *Statement of grant of protection*

1. Where the Office has not issued an *ex officio* provisional notification of refusal pursuant to Article 154 of Regulation (EC) No 207/2009 and no opposition has been received by the Office within the opposition period referred to in Article 156(2) of Regulation (EC) No 207/2009 and the Office has not issued an *ex officio* provisional refusal as a result of the third party observations submitted, the Office shall send a statement of grant of protection to the International Bureau indicating that the mark is protected in the Union.
2. For the purposes of Article 151(2) of Regulation (EC) No 207/2009, the statement of grant of protection referred to in paragraph 1 of this Article shall have the same effect as a statement by the Office that a notice of refusal has been withdrawn.

### **TITLE XV**

### **FINAL PROVISIONS**

#### *Article 80*

#### *Repeal*

Regulations (EC) No 2868/95 and (EC) No 216/96 are repealed. However, they shall continue to apply to ongoing proceedings where this Regulation does not apply in accordance with its Article 81, until such proceedings are concluded.

#### *Article 81*

#### *Entry into force and application*

1. This Regulation shall enter into force on the day following that of its publication in the *Official Journal of the European Union*.
2. It shall be applicable from 1 October 2017, subject to the following exceptions:
  - (a) Articles 2 to 6 shall not apply to notices of opposition entered before the abovementioned date;

- (b) Articles 7 and 8 shall not apply to opposition proceedings, the adversarial part of which has started before the abovementioned date;
- (c) Article 9 shall not apply to suspensions made before the abovementioned date;
- (d) Article 10 shall not apply to requests for proof of use made before the abovementioned date;
- (e) title III shall not apply to requests for amendment entered before the abovementioned date;
- (f) Articles 12 to 15 shall not apply to applications for revocation or for a declaration of invalidity or requests for assignment entered before the abovementioned date;
- (g) Articles 16 and 17 shall not apply to proceedings, the adversarial part of which has started before the abovementioned date;
- (h) Article 18 shall not apply to suspensions made before the abovementioned date;
- (i) Article 19 shall not apply to requests for proof of use made before the abovementioned date;
- (j) title V shall not apply to appeals entered before the abovementioned date;
- (k) title VI shall not apply to oral proceedings initiated before the abovementioned date or to written evidence where the period for its presentation has started before that date;
- (l) title VII shall not apply to notifications made before the abovementioned date;
- (m) title VIII shall not apply to communications received and to forms made available before the abovementioned date;
- (n) title IX shall not apply to time limits set before the abovementioned date;
- (o) title X shall not apply to revocations of decisions taken or entries in the Register made before the abovementioned date;
- (p) title XI shall not apply to suspensions requested by the parties or imposed by the Office before the abovementioned date;
- (q) title XII shall not apply to proceedings interrupted before the abovementioned date;
- (r) Article 73 shall not apply to EU trade mark applications received before the abovementioned date;
- (s) Article 74 shall not apply to representatives appointed before the abovementioned date;
- (t) Article 75 shall not apply to entries on the list of professional representatives made before the abovementioned date;
- (u) title XIV shall not apply to designations of the EU trade mark made before the abovementioned date.

3. This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels,

*For the Commission  
The President  
Jean-Claude Juncker*