



Brussels, **XXX**
[...](2016) **XXX** draft

COMMISSION IMPLEMENTING REGULATION (EU) .../...

of **XXX**

**laying down detailed rules for implementing certain provisions of Council Regulation
(EC) No 207/2009 on the European Union trade mark**

COMMISSION IMPLEMENTING REGULATION (EU) .../...

of XXX

laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 207/2009 on the European Union trade mark

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 mark¹, and in particular Article 17(5b), Article 26(4), Article 30(2), Article 33(4), Article 34(5), Article 39(5), Article 44(9), Article 45(3), the second subparagraph of Article 48(3), Article 48a(1), Article 49(8), Article 50(5), Article 67(3), Article 74b(3), the first subparagraph of Article 85(1a), Article 89(4), Article 90(3), Article 113(6), Article 119(10), the second subparagraph of Article 132(2), Article 147(9), Article 148a(2), Article 149(2), Article 153a(6), Article 154(8), Article 158(4), Article 159(10) and Article 161(6) thereof,

Whereas:

- (1) Council Regulation (EC) No 40/94², 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) 2015/2424 of the European Parliament and the Council³ aligns the powers conferred upon the Commission under Regulation (EC) No 207/2009 to Articles 290 and 291 of the Treaty on the Functioning of the European Union. In order to conform with that new legal framework resulting from that alignment, certain rules should be adopted by means of implementing and delegated acts. The new rules should replace the existing rules which are laid down in Commission Regulation (EC) No 2868/95⁴ and aim at implementing Regulation (EC) No 207/2009.
- (3) In the interest of clarity, legal certainty and efficiency, and with a view to facilitating the filing of EU trade mark applications, it is of essential importance to specify the mandatory and optional details to be contained in an application for an EU trade mark in a clear and exhaustive manner, while avoiding unnecessary administrative burdens.
- (4) Regulation (EC) No 207/2009 no longer requires the representation of a mark to be graphic, as long as the representation enables the competent authorities to determine with clarity and precision the subject matter of protection. In order to ensure legal

¹ OJ L 78, 24.3.2009, p. 1.

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

³ 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).

⁴ 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).

certainty, consistency and effectiveness in the process of filing an EU trade mark application, it is appropriate to identify the elements that define the relevant subject matter of protection, and to establish the specific requirements for the representation of each type of trade mark.

- (5) The introduction of technical alternatives to graphic representation, in line with new technologies, derives from the necessity of modernisation, bringing the registration process closer to technical developments. At the same time, the technical specifications for filing a representation of the trade mark including representations filed electronically should be laid down with a view to ensuring that the EU trade mark system remains interoperable with the system established by the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989⁵ (Madrid Protocol). In accordance with Regulation (EC) No 207/2009, and for the sake of increased flexibility and quicker adaptation to technological advances, it should be left to the Executive Director of the Office to lay down the technical specifications for marks filed electronically.
- (6) It is appropriate to streamline proceedings so as to reduce administrative burdens in the filing and process of priority and seniority claims. It should therefore not be necessary any more to submit certified copies of the previous application or registration. Furthermore, the Office should no longer be required to include a copy of the prior EU trade mark application in the file in the case of a priority claim.
- (7) Following the abolition of the requirement of graphic representation of a trade mark, certain types of trade marks can be represented in electronic format and, accordingly, their publication using conventional means is no longer suitable. In order to guarantee the publication of all the information concerning an application, which is required for reasons of transparency and legal certainty, access to the representation of the trade mark by way of a link to the Office's electronic register should be recognised as a valid form of representation of the sign for publication purposes.
- (8) For the same reasons, it should also be permissible for the Office to issue certificates of registration in which the reproduction of the trade mark is substituted by an electronic link. Furthermore, for certificates issued after the registration, and to cater for requests made at a time when registration particulars may have changed, it is appropriate to provide for the possibility of issuing updated versions of the certificate, where relevant subsequent entries in the register are indicated.
- (9) Practical experience in applying the former regime revealed the need of clarifying certain provisions, in particular in relation to partial transfers and partial surrenders, in order to ensure clarity and legal certainty.
- (10) In order to ensure legal certainty, while keeping a certain flexibility, it is necessary to establish a minimum content of the regulations governing the use of EU Collective marks and of EU Certification marks submitted pursuant to Regulation (EC) No 207/2009 respectively, with the purpose of enabling market operators to avail themselves of this new type of trade mark protection.
- (11) Maximum rates for representation costs incurred by the successful party to proceedings before the Office should be specified taking into account the need to ensure that the obligation to bear the costs may not be misused for tactical reasons by the other party.

⁵ OJ L 296, 14.11.2003, p. 22.

- (12) For reasons of efficiency, electronic publications by the Office should be allowed.
- (13) It is necessary to ensure an effective and efficient exchange of information between the Office and the authorities of the Member States in the context of administrative cooperation, taking appropriately into account the restrictions to which the inspection of files is subject.
- (14) The requirements concerning requests for conversion should ensure a smooth and effective interface between the EU trade mark system and the national trade mark systems.
- (15) In order to streamline proceedings before the Office, it should be possible to limit the submission of translations to those parts of documents that are relevant to the proceedings. For the same purpose, the Office should be authorised to require proof that a translation corresponds to the original only in the event of doubt.
- (16) For reasons of efficiency, certain decisions of the Office in relation to oppositions or applications for the revocation or a declaration of invalidity of an EU trade mark should be taken by a single member.
- (17) Due to the accession of the Union to the Madrid Protocol, it is necessary that the detailed requirements governing the procedures concerning the international registration of marks be entirely consistent with the rules of that Protocol.
- (18) The detailed rules laid down in this Regulation relate to 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.
- (19) The measures provided for in this Regulation are in accordance with the opinion of the Committee on Implementation Rules,

HAS ADOPTED THIS REGULATION:

TITLE I

GENERAL PROVISIONS

Article 1 *Subject-matter*

This Regulation lays down rules specifying:

- (a) the details to be contained in an application for an EU trade mark to be filed at the European Union Intellectual Property Office ('the Office');
- (b) the documentation required for claiming the priority of a previous application and for claiming seniority, and the evidence to be filed for claiming an exhibition priority;
- (c) the details to be contained in the publication of an application for an EU trade mark;
- (d) the content of a declaration of division of an application, how the Office has to process such a declaration, and the details to be contained in the publication of the divisional application;
- (e) the content and form of the certificate of registration;
- (f) the content of a declaration of division of a registration and how the Office has to process such a declaration;

- (g) the details to be contained in requests for alteration and for the change of name or address;
- (h) the content of an application for registration of a transfer, the documentation required to establish a transfer, and how to process applications for partial transfers;
- (i) the details to be contained in a declaration of surrender and the required documentation to establish a third party's agreement;
- (j) the details to be contained in the regulations governing use of an EU collective mark and those governing use of an EU certification mark;
- (k) the maximum rates for costs essential to proceedings and actually incurred;
- (l) certain details concerning publications in the European Union Trade Marks Bulletin and the Official Journal of the Office;
- (m) the detailed arrangements as to how the Office and the authorities of the Member States are to exchange information between each other and open files for inspection;
- (n) the details to be contained in requests for conversion and in the publication of a request for conversion;
- (o) the extent to which supporting documents to be used in written proceedings before the Office may be filed in any language of the Union, the need to supply a translation and the requisite standards of translations;
- (p) the decisions to be taken by single members of the opposition and cancellation division;
- (q) concerning the international registration of marks:
 - (i) the form to be used for the filing of an international application;
 - (ii) the facts and decisions of invalidity to be notified to the International Bureau and the relevant time of such notification;
 - (iii) the detailed requirements regarding requests for territorial extension subsequent to international registration;
 - (iv) the details to be contained in a seniority claim for an international registration and the details of the information to be notified to the International Bureau;
 - (v) the details to be contained in the notification of ex officio provisional refusal of protection to be sent to the International Bureau;
 - (vi) the details to be contained in the final grant or refusal of protection;
 - (vii) the details to be contained in the notification of invalidation;
 - (viii) the details to be contained in the requests for conversion of an international registration and in the publication of such requests
 - (ix) the details to be contained in an application for transformation.

TITLE II

APPLICATION PROCEDURE

Article 2

Content of the application

1. The application for an EU trade mark shall contain:

- (a) a request for registration of the trade mark as an EU trade mark;
- (b) the name and address of the applicant and the State in which that applicant is domiciled or has a seat or an establishment. Names of natural persons shall be indicated by the person's family name and given name(s). Names of legal entities, as well as bodies falling under Article 3 of Regulation (EC) No 207/2009, shall be indicated by their official designation and include the legal form of the entity, which may be abbreviated in a customary manner. The company's national identification number may also be specified if available. The Office may require the applicant to provide telephone numbers or other contact details for communication by electronic means as defined by the Executive Director. Only one address shall, in principle, be indicated for each applicant. Where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for service. Where an identification number has already been given by the Office, it shall be sufficient for the applicant to indicate that number and the name of the applicant.
- (c) a list of the goods or services for which the trade mark is to be registered, in accordance with Article 28(2) of Regulation (EC) No 207/2009 or an indication of goods or services selected from a database of pre-acceptable terms made available by the Office;
- (d) a representation of the trade mark in accordance with Article 3 of this Regulation;
- (e) where the applicant has appointed a representative, the name and business address of that representative in accordance with point (b); where the representative has more than one business address or where there are two or more representatives with different business addresses, only the first-mentioned address shall be taken into account as an address for service unless the application indicates which address is to be used as an address for service;
- (f) where the priority of a previous application is claimed pursuant to Article 30 of Regulation (EC) No 207/2009, a declaration to that effect, stating the date on which and the country in or for which the previous application was filed;
- (g) where exhibition priority is claimed pursuant to Article 33 of Regulation (EC) No 207/2009, a declaration to that effect, stating the name of the exhibition and the date of the first display of the goods or services;
- (h) where the seniority of one or more earlier trade marks, registered in a Member State, including a trade mark registered in the Benelux countries or registered under international arrangements having effect in a Member State ('earlier registered trade marks'), as referred to in Article 34 of Regulation (EC) No 207/2009, is claimed together with the application, a declaration to that effect, stating the Member State or Member States in or for which the earlier trade mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods or services for which the trade mark is registered. Such declaration may also be made within the period referred to in Article 34(1a) of Regulation (EC) No 207/2009.
- (i) where applicable, a statement that the application is for registration of an EU collective mark pursuant to Article 66 of Regulation (EC) No 207/2009 or for

registration of an EU certification mark pursuant to Article 74a of Regulation (EC) No 207/2009;

- (j) specification of the language in which the application has been filed, and of the second language pursuant to Article 119(3) of Regulation (EC) No 207/2009;
 - (k) the signature of the applicant or the applicant's representative in accordance with Article 63(1) of Commission Delegated Regulation (EU) .../...⁶;
 - (l) where applicable, the request of a search report referred to in Article 38(1) or (2) of Regulation (EC) No 207/2009.
2. The application may include a claim that the sign has acquired distinctive character through use within the meaning of Article 7(3) of Regulation (EC) No 207/2009, as well as an indication of whether this claim is meant as a principal or subsidiary one. Such claim may also be made within the period referred to in Article 37(3), second sentence, of Regulation (EC) No 207/2009.
 3. The application for an EU collective mark or an EU certification mark may include the regulations governing its use. Such regulations may also be submitted within the period referred to in Article 67(1) and Article 74b(1) of Regulation (EC) No 207/2009.
 4. If there is more than one applicant, the application may contain the appointment of one applicant or representative as common representative.

Article 3 *Representation of the trade mark*

1. The trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject-matter of the protection afforded to its proprietor. The filing of a sample or a specimen shall not constitute a proper representation of the trade mark.
2. The representation of the trade mark shall define the subject matter of the registration, taking into account, where appropriate, the type of trade mark concerned. Where the representation is accompanied by a description pursuant to paragraph 3(d), (e), (f)(ii), (h) or paragraph 4, it shall only be for explanatory purposes.
3. Without prejudice to paragraph 1, the mark shall be represented depending on the type of mark indicated in the application as follows:
 - (a) in the case of a trade mark consisting exclusively of words or letters, numerals, other standard typographic characters or a combination thereof (word mark), the mark shall be represented by submitting a reproduction of the sign for which registration is sought in normal script and layout, without any graphic feature or colour;
 - (b) in the case of a trade mark where a special character stylisation or layout, or a graphic feature or a colour is used (figurative mark), including marks that

⁶ Commission Delegated Regulation (EU) .../... of [...] supplementing Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ L , , p.).

consist exclusively of figurative elements or of a combination of verbal and figurative elements, the mark shall be represented by submitting a reproduction of the sign for which registration is sought showing all its elements and, where applicable, colours;

- (c) in the case of a trade mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance (shape mark), the mark shall be represented by submitting either a graphic reproduction of the shape, including computer-generated images, or a photographic reproduction. The graphic or photographic representation may contain different views;
- (d) in the case of a trade mark consisting of the specific way in which the mark is placed or affixed on the product (position mark), the mark shall be represented by submitting a reproduction which appropriately identifies its size and position of the mark with respect to the relevant goods. The elements which do not form part of the subject-matter of the registration shall be visually disclaimed by broken or dotted lines. The representation may be accompanied by a description detailing further how the sign is affixed on the goods;
- (e) in the case of a trade mark consisting exclusively of a set of graphic elements which are repeated regularly (pattern mark), the mark shall be represented by submitting a reproduction showing all its graphic features and the pattern of repetition. The representation may be accompanied by a description detailing further how its graphic features are repeated regularly;
- (f) in the case of a colour per-se mark,
 - (i) where the trade mark consists exclusively of a single colour, the trade mark shall be represented by submitting a reproduction of the colour, without contours and shall be accompanied by a reference to a generally recognised colour code.
 - (ii) where the trade mark consists exclusively of a combination of colours, the trade mark shall be represented by submitting a reproduction of the colour combination without contours and shall be accompanied by a reference to the corresponding generally recognised colour codes. A description indicating the systematic arrangement of the colours in a uniform and predetermined manner may also be added. In the absence of such a description, the systematic arrangement shall be deemed to correspond to that shown in the representation;
- (g) in the case of a trade mark consisting exclusively of a sound or combination of sounds (sound mark), the mark shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation;
- (h) in the case of a trade mark consisting of a movement or a change in the position of the elements of the mark (motion mark), the mark shall be represented by submitting a video file showing the movement or change of position or by a series of still images depicting the movement which may be accompanied by a description explaining the sequence;
- (i) in the case of a trade mark consisting of the combination of movement and sound (multimedia mark), the mark shall be represented by submitting an audio-visual file containing the combination of the movement and the sound;

- (j) in the case of a trade mark consisting of elements with holographic characteristics (hologram mark), the mark shall be represented by submitting a video file or a graphic or photographic representation containing the views which are necessary to sufficiently identify the holographic effect in its entirety.
4. Where the mark is not covered by any of the types listed in paragraph 3 its representation shall be accompanied by a description clearly specifying the subject matter for which protection is sought.
 5. Where the representation is provided electronically, the Executive Director of the Office shall determine the formats and size of the electronic file as well as any other relevant technical specifications.
 6. Where the representation is not provided electronically, the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of the application appears. The sheet on which the mark is reproduced shall not exceed DIN A4 size (29,7 cm high, 21 cm wide). A margin of at least 2,5 cm shall be left all around.
 7. Where the correct orientation of the mark is not obvious, it shall be indicated by adding the word 'top' to each reproduction.
 8. The reproduction of the mark shall be of such quality as to enable it to be reduced or enlarged to a size not more than 8 cm wide by 8 cm high.
 9. Where the representation is for a shape mark and is not provided electronically, it may contain up to six different views.

Article 4
Claiming priority

1. Where the priority of one or more previous applications is claimed together with the application pursuant to Article 30 of Regulation (EC) No 207/2009, the applicant shall indicate the file number of the previous application and file a copy of it within three months from the filing date. That copy shall be an exact copy of the previous application and state the date of filing of the previous application.
2. Where the language of the previous application for which priority is claimed is not one of the languages of the Office, the applicant shall, if required by the Office, provide the Office with a translation of the previous application into the language of the Office used as the first or second language of the application, within a period specified by the Office.

Article 5
Exhibition priority

Where an exhibition priority is claimed together with the application pursuant to Article 33(1) of Regulation (EC) No 207/2009, the applicant shall, within three months from the filing date, file a certificate issued at the exhibition by the authority responsible for the protection of industrial property at the exhibition. That certificate shall attest that the mark was used for the goods or services covered by the application. It shall also state the opening date of the exhibition and the date of first public use, if different from the opening date of the exhibition. The certificate shall be accompanied by an identification of the actual use of the mark, duly certified by the authority.

Article 6

Claiming seniority of a national trade mark before registration of the EU trade mark

Where the seniority of an earlier registered trade mark, as referred to in Article 34(1) of Regulation (EC) No 207/2009, is claimed pursuant to Article 34(1a) of Regulation (EC) No 207/2009, the applicant shall submit a copy of the relevant registration within three months from the receipt of the seniority claim by the Office.

Article 7

Content of the publication of an application

The publication of the application shall contain:

- (a) the applicant's name and address;
- (b) where applicable, the name and business address of the representative appointed by the applicant other than a representative falling within the first sentence of Article 92(3) of Regulation (EC) No 207/2009. Where there is more than one representative with the same business address, only the name and business address of the first-named representative shall be published and it shall be followed by the words 'and others'. Where there are two or more representatives with different business addresses, only the address for service determined pursuant to Article 2(1)(e) of this Regulation shall be published. Where an association of representatives is appointed in accordance with Article 74(8) of Delegated Regulation (EU) .../..., only the name and business address of the association shall be published;
- (c) the representation of the mark, together with the elements and descriptions referred to in Article 3 where applicable. Where the mark has been provided in the form of an electronic file, the representation may be substituted by an electronic link to that file;
- (d) the list of goods or services, grouped according to the classes of the Nice Classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs, and presented in the order of the classes of that classification;
- (e) the date of filing and the file number;
- (f) where applicable, particulars of the claim of priority filed by the applicant pursuant to Article 30 of Regulation (EC) No 207/2009;
- (g) where applicable, particulars of the claim of exhibition priority filed by the applicant pursuant to Article 33 of Regulation (EC) No 207/2009;
- (h) where applicable, particulars of the claim of seniority filed by the applicant pursuant to Article 34 of Regulation (EC) No 207/2009;
- (i) where applicable, a statement pursuant to Article 7(3) of Regulation (EC) No 207/2009 that the mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it;
- (j) where applicable, a statement that the application is for an EU collective mark or an EU certification mark;
- (k) an indication of the language in which the application was filed and of the second language which the applicant has indicated pursuant to Article 119 (3) of Regulation (EC) No 207/2009;

- (l) where applicable, a statement that the application results from a transformation of an international registration designating the Union pursuant to Article 161(2) of Regulation (EC) No 207/2009, together with the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date on which the territorial extension to the Union made subsequently to the international registration pursuant to Article 3 ter (2) of the Madrid Protocol was recorded and, where applicable, the priority date of the international registration.

Article 8

Division of the application

1. A declaration of the division of the application pursuant to Article 44 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 this Regulation;
 - (c) the list of goods or services subject to the divisional application, or, where the division into more than one divisional application is sought, the list of goods or services for each divisional application;
 - (d) the list of goods or services which are to remain in the original application.
2. The Office shall establish a separate file for the divisional application, which shall consist of a complete copy of the file of the original application, including the declaration of division and the correspondence relating thereto. The Office shall assign a new application number to the divisional application.
3. The publication of the divisional application shall contain the indications and elements laid down in Article 7.

TITLE III

REGISTRATION PROCEDURE

Article 9

Certificate of registration

The certificate of registration issued in accordance with Article 45(2) of Regulation (EC) No 207/2009 shall contain the entries in the Register listed in Article 87(2) of Regulation (EC) No 207/2009 and a statement to the effect that those entries have been recorded in the Register. Where the mark is provided in the form of an electronic file, the entry concerning the reproduction of the mark may be substituted by an electronic link to that file. The certificate shall be complemented, where applicable, by an extract showing all entries to be recorded in the Register in accordance with Article 87(3) of Regulation (EC) No 207/2009 and a statement to the effect that those entries have been recorded in the Register.

Article 10

Content of the request for alteration of a registration

A request for alteration of the registration pursuant to Article 48(2) of Regulation (EC) No 207/2009 shall contain:

- (a) the registration number of the EU trade mark;

- (b) the name and the address of the proprietor of the EU trade mark in accordance with Article 2(1)(b) of this Regulation;
- (c) an indication of the element in the representation of the EU trade mark to be altered and that element in its altered version in accordance with Article 48(3) of Regulation (EC) No 207/2009;
- (d) a representation of the EU trade mark as altered, in accordance with Article 3 of this Regulation.

Article 11

Declaration of the division of a registration

1. A declaration of the division of a registration pursuant to Article 49(1) of Regulation (EC) No 207/2009 shall contain:
 - (a) the registration number of the EU trade mark;
 - (b) the name and address of the proprietor of the EU trade mark in accordance with Article 2(1)(b) of this Regulation;
 - (c) the list of goods or services which are to form the divisional registration, or, where the division into more than one divisional registration is sought, the list of goods or services for each divisional registration;
 - (d) the list of goods or services which are to remain in the original registration.
2. The Office shall establish a separate file for the divisional registration, which shall consist of a complete copy of the file of the original registration, including the declaration of division and the correspondence relating thereto. The Office shall assign a new registration number to the divisional registration.

Article 12

Content of a request for the change of the name or address of the proprietor of an EU trade mark

A request for the change of the name or address of the proprietor of a registered mark pursuant to Article 48a (1) of Regulation (EC) No 207/2009 shall contain:

- (a) the registration number of the EU trade mark;
- (b) the name and the address of the proprietor of the EU trade mark as recorded in the Register, unless an identification number has already been given by the Office to the proprietor, in which case it shall be sufficient for the applicant to indicate that number and the proprietor's name;
- (c) the indication of the new name or address of the proprietor of the EU trade mark, in accordance with Article 2(1)(b) of this Regulation.

TITLE IV TRANSFER

Article 13

Application for registration of a transfer

1. An application for registration of a transfer under Article 17(5a) of Regulation (EC) No 207/2009 shall contain:

- (a) the registration number of the EU trade mark;
 - (b) particulars of the new proprietor in accordance with Article 2(1)(b) of this Regulation;
 - (c) where not all the registered goods or services are included in the transfer, particulars of the registered goods or services to which the transfer relates;
 - (d) evidence duly establishing the transfer in accordance with Article 17(2) and (3) of Regulation (EC) No 207/2009;
 - (e) where applicable, the name and business address of the representative of the new proprietor, to be set out in accordance with Article 2(1)(e) of this Regulation.
2. For the purposes of paragraph 1(d), any of the following shall constitute sufficient evidence of transfer:
- (a) the signing of the application for registration of the transfer by the registered proprietor or a representative of that proprietor, and by the successor in title or a representative of that successor;
 - (b) where the application for registration is submitted by the successor in title, a declaration, signed by the registered proprietor or a representative of that proprietor, that the registered proprietor agrees to the registration of the successor in title;
 - (c) the signing of a completed transfer form or document, as laid down in Article 65(1)(e) of Delegated Regulation (EU) .../..., by the registered proprietor or a representative of that proprietor and by the successor in title or a representative of that successor.

Article 14
Processing of applications for partial transfer

1. Where the application for registration of a transfer relates only to some of the goods or services for which the mark is registered, the applicant shall distribute the goods or services in the original registration between the remaining registration and the application for partial transfer so that the goods or services in the remaining registration and the new registration do not overlap.
2. The Office shall establish a separate file for the new registration, which shall consist of a complete copy of the file of the original registration, including the application for registration of the partial transfer and the correspondence relating thereto. The Office shall assign a new registration number to the new registration.

TITLE V
SURRENDER

Article 15
Surrender

1. A declaration of surrender pursuant to Article 50(2) of Regulation (EC) No 207/2009 shall contain:
 - (a) the registration number of the EU trade mark;

- (b) the name and address of the proprietor in accordance with Article 2(1)(b) of this Regulation;
 - (c) where surrender is declared only for some of the goods or services for which the mark is registered, an indication of the goods or services for which the mark is to remain registered.
2. Where a right of a third party relating to the EU trade mark is entered in the register, a declaration of consent to the surrender, signed by the proprietor of that right or a representative of that proprietor, shall be sufficient proof of the third party's agreement to the surrender.

TITLE VI

EU COLLECTIVE MARKS AND CERTIFICATION MARKS

Article 16

Content of regulations governing the use of EU collective marks

The regulations governing EU collective marks referred to in Article 67(1) of Regulation (EC) No 207/2009 shall specify:

- (a) the name and address of the applicant for the EU collective mark;
- (b) the object of the association or the object for which the legal person governed by public law is constituted;
- (c) the bodies authorised to represent the association or the legal person governed by public law;
- (d) in the case of an association, the conditions for membership;
- (e) the representation of the EU collective mark;
- (f) the persons authorised to use the EU collective mark;
- (g) where appropriate, the conditions governing use of the EU collective mark, including sanctions;
- (h) the goods or services covered by the EU collective mark including, where appropriate, any limitation introduced as a consequence of the application of Article 7(1)(j), (k) or (l) of Regulation (EC) No 207/2009;
- (i) where appropriate, the authorisation referred to in the second sentence of Article 67(2) of Regulation (EC) No 207/2009.

Article 17

Content of regulations governing the use of EU certification marks

The regulations governing use of EU certification marks referred to in Article 74b of Regulation (EC) No 207/2009 shall specify:

- (a) the name and office address of the applicant ;
- (b) a declaration that the applicant complies with the requirements laid down in Article 74a(2) of Regulation (EC) No 207/2009;
- (c) the representation of the EU certification mark;
- (d) the goods or services covered by the EU certification mark;

- (e) the characteristics of the goods or services to be certified by the EU certification mark, such as the material, mode of manufacture of goods or performance of services, quality or accuracy.
- (f) where appropriate, the conditions governing the use of the EU certification mark, including sanctions;
- (g) the persons authorised to use the EU certification mark;
- (h) how the certifying body is to test those characteristics and to supervise the use of the EU certification mark.

TITLE VII COSTS

Article 18 *Maximum rates for costs*

1. Costs referred to in the first subparagraph of Article 85(1a) of Regulation (EC) No 207/2009 shall be borne by the losing party on the basis of the following maximum rates:
 - (a) where the successful party is not represented, the travel and subsistence costs of that party for one person for the outward and return journey between the place of residence or the place of business and the place where oral proceedings are held pursuant to Article 49 of Delegated Regulation (EU) No .../..., as follows:
 - (i) the cost of the first-class rail-fare including usual transport supplements where the total distance by rail does not exceed 800 km or the cost of the tourist-class air-fare where the total distance by rail exceeds 800 km or the route includes a sea-crossing;
 - (ii) subsistence costs as laid down in Article 13 of Annex VII to the Staff Regulations of Officials of the Union and the Conditions of Employment of Other Servants of the Union, laid down in Council Regulation (EEC, Euratom, ECSC) No 259/68⁷;
 - (b) travel costs of representatives pursuant to Article 93(1) of Regulation (EC) No 207/2009, at the rates provided for in point (a)(i) of this paragraph;
 - (c) cost of representation, within the meaning of Article 93(1) of Regulation (EC) No 207/2009, incurred by the successful party, as follows:
 - (i) in opposition proceedings: EUR 300;
 - (ii) in proceedings relating to the revocation or invalidity of an EU trade mark: EUR 450;
 - (iii) in appeal proceedings: EUR 550;
 - (iv) where oral proceedings have taken place to which the parties have been summoned pursuant to Article 49 of Delegated Regulation (EU) .../..., the amount referred to in points (i), (ii) or (iii) increased by EUR 400.

⁷ OJ L 56, 4.3.1968, p. 1.

2. Where there are several applicants or proprietors of the EU trade mark application or registration or where there are several opposing parties or applicants for revocation or declaration of invalidity who have filed the opposition or application for revocation or declaration of invalidity jointly, the losing party shall bear the costs referred to in paragraph 1(a) for one such person only.
3. Where the successful party is represented by more than one representative within the meaning of Article 93(1) of Regulation (EC) No 207/2009, the losing party shall bear the costs referred to in paragraph 1(b) and (c) of this Article for one such person only.
4. The losing party shall not be obliged to reimburse the successful party for any costs, expenses and fees other than those referred to in paragraphs 1, 2 and 3.

TITLE VIII

PERIODICAL PUBLICATIONS

Article 19

Periodical publications

1. Where particulars are published in the EU Trade Marks Bulletin in accordance with Regulation (EC) No 207/2009, Delegated Regulation (EU) .../... or this Regulation, the date of issue shown on the Bulletin shall be taken as the date of publication of the particulars.
2. To the extent that the entries regarding the registration of a trade mark contain no changes as compared to the publication of the application, the publication of such entries shall be made by way of a reference to the particulars contained in the publication of the application.
3. The Office may make editions of the Official Journal of the Office publicly available by electronic means.

TITLE IX

ADMINISTRATIVE COOPERATION

Article 20

Exchange of information between the Office and the authorities of the Member States

1. Without prejudice to Article 123c of Regulation (EC) No 207/2009, the Office and the central industrial property offices of the Member States, including the Benelux Office for Intellectual Property, shall, upon request, communicate to each other relevant information about the filing of applications for EU trade marks or national marks and about proceedings relating to such applications and the marks registered as a result thereof.
2. The Office and the courts or authorities of the Member States shall exchange information for the purposes of Regulation (EC) No 207/2009 directly or through the central industrial property offices of the Member States.
3. Expenditure in respect of communications under paragraphs 1 and 2 shall be chargeable to the authority making the communications. Such communications shall be exempt from fees.

Article 21
Opening of files for inspection

1. Inspection of files relating to EU trade mark applications or registered EU trade marks by courts or authorities of the Member States shall be of the original documents or of copies thereof, or of technical means of storage if the files are stored in this way.
2. The Office shall, at the time of transmission of files relating to EU trade marks applied for or registered, or copies thereof, to the courts or Public Prosecutors' Offices of the Member States, indicate the restrictions to which the inspection of those files is subject pursuant to Article 88 of Regulation (EC) No 207/2009.
3. Courts or Public Prosecutors' Offices of the Member States may, in the course of proceedings before them, open files or copies thereof transmitted to them by the Office to inspection by third parties. Such inspection shall be subject to Article 88 of Regulation (EC) No 207/2009.

TITLE X
CONVERSION

Article 22
Content of a request for conversion

A request for conversion of an EU trade mark application or a registered EU trade mark into a national trade mark application pursuant to Article 112 of Regulation (EC) No 207/2009 shall contain:

- (a) the name and the address of the applicant for conversion in accordance with Article 2(1)(b) of this Regulation;
- (b) the filing number of the EU trade mark application or the registration number of the EU trade mark;
- (c) an indication of the ground for conversion in accordance with Article 112(1)(a) or (b) of Regulation (EC) No 207/2009;
- (d) a specification of the Member State or the Member States in respect of which conversion is requested;
- (e) where the request does not relate to all of the goods or services for which the application has been filed or for which the EU trade mark has been registered, an indication of the goods or services for which conversion is requested, and, where conversion is requested in respect of more than one Member State and the list of goods or services is not the same for all Member States, an indication of the respective goods or services for each Member State;
- (f) where conversion is requested, pursuant to Article 112(6) of Regulation (EC) No 207/2009, on the grounds that an EU trade mark has ceased to have effect as a result of a decision of an EU trade mark court, an indication of the date on which that decision became final, and a copy of the decision, which may be submitted in the language in which the decision was given.

Article 23

Content of the publication of a request for conversion

The publication of a request for conversion in accordance with Article 113(2) of Regulation (EC) No 207/2009 shall contain:

- (a) the filing number or the registration number of the EU trade mark in respect of which conversion is requested;
- (b) a reference to the previous publication of the request or to the registration in the EU Trade Marks Bulletin;
- (c) an indication of the Member State or Member States in respect of which conversion has been requested;
- (d) where the request does not relate to all of the goods or services for which the application has been filed or for which the EU trade mark has been registered, an indication of the goods or services for which conversion is requested;
- (e) where conversion is requested in respect of more than one Member State and the list of goods or services is not the same for all Member States, an indication of the respective goods or services for each Member State;
- (f) the date of the request for conversion.

TITLE XI LANGUAGES

Article 24

Filing of supporting documents in written proceedings

Unless otherwise provided for in this Regulation or in Delegated Regulation (EU) .../..., supporting documents to be used in written proceedings before the Office may be filed in any official language of the Union. Where the language of such documents is not the language of the proceedings, the Office may require that a translation be supplied, within a period specified by it, in that language.

Article 25

Standard of translations

1. Where a translation of a document is to be filed with the Office, the translation shall identify the document to which it refers and reproduce the structure and contents of the original document. Where a party has indicated that only parts of the document are relevant, the party may limit the translation to those parts.
2. Unless otherwise provided for in Regulation (EC) No 207/2009, in Delegated Regulation (EU) .../... or in this Regulation, a document for which a translation is to be filed shall be deemed not to have been received by the Office in the following cases:
 - (a) where the translation is received by the Office after the expiry of the relevant period for submitting the original document or the translation;
 - (b) where the certificate referred to in Article 26 of this Regulation is not filed within the period specified by the Office.

Article 26
Legal authenticity of translations

In the absence of evidence to the contrary, the Office shall assume that a translation corresponds to the relevant original text. In the event of doubt, the Office may require the filing, within a specific period, of a certificate that the translation corresponds to the original text.

TITLE XII
ORGANISATION OF THE OFFICE

Article 27
Decisions of an Opposition Division or a Cancellation Division taken by a single member

Pursuant to Article 132(2) or Article 134(2) of Regulation (EC) No 207/2009, a single member of an Opposition Division or of a Cancellation Division shall take the following types of decisions:

- (a) decisions on the apportionment of costs;
- (b) decisions to fix the amount of the costs to be paid pursuant to the first sentence of Article 85(6) of Regulation (EC) No 207/2009;
- (c) decisions to close the file or not to proceed to judgment;
- (d) decisions to reject an opposition as inadmissible before expiry of the period referred to in Article 6(1) of Delegated Regulation (EU) ...;
- (e) decisions to stay proceedings;
- (f) decisions to join or separate multiple oppositions pursuant to Article 9(1) of Delegated Regulation (EU) .../....

TITLE XIII
PROCEDURES CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Article 28
Form to be used for the filing of an international application

The form made available by the Office for the filing of an international application, as referred to in Article 147(1) of Regulation (EC) No 207/2009 shall include all the elements of the official form provided by the International Bureau of the World Intellectual Property Organisation (“the International Bureau”). Applicants may also use the official form provided by the International Bureau.

Article 29
Facts and decisions on invalidity to be notified to the International Bureau

1. The Office shall notify the International Bureau within a period of five years from the date of the international registration in the following cases:
 - (a) where the EU trade mark application on which the international registration was based has been withdrawn, is deemed to be withdrawn or has been refused by a final decision;
 - (b) where the EU trade mark on which the international registration was based has ceased to have effect because it is surrendered, has not been renewed, has been

- revoked, or has been declared invalid by the Office by a final decision or, on the basis of a counterclaim in infringement proceedings, by a EU trade mark court;
- (c) where the EU trade mark application or the EU trade mark on which the international registration was based has been divided into two applications or registrations.
2. The notification referred to in paragraph 1 shall include:
- (a) the number of the international registration;
 - (b) the name of the holder of the international registration;
 - (c) the facts and decisions affecting the basic application or registration, as well as the effective date of those facts and decisions;
 - (d) in the case referred to in paragraph 1(a) or (b), the request to cancel the international registration;
 - (e) where the act referred to in paragraph 1(a) or (b) affects the basic application or basic registration only with respect to some of the goods or services, those goods or services, or the goods or services which are not affected;
 - (f) in the case referred to in paragraph 1(c), the number of each EU trade mark application or registration concerned.
3. The Office shall notify the International Bureau at the end of a period of five years from the date of the international registration in the following cases:
- (a) where an appeal is pending against a decision of an examiner to refuse the EU trade mark application on which the international registration was based pursuant to Article 37 of Regulation (EC) No 207/2009;
 - (b) where an opposition is pending against the EU trade mark application on which the international registration was based;
 - (c) where an application for revocation or an application for declaration of invalidity is pending against the EU trade mark on which the international registration was based;
 - (d) where mention has been made in the Register of EU Trade Marks that a counterclaim for revocation or for declaration of invalidity has been filed before an EU trade mark court against the EU trade mark on which the international registration was based, but no mention has yet been made in the Register of the decision of the EU trade mark court on the counterclaim.
4. Once the proceedings referred to in paragraph 3 have been concluded by means of a final decision or an entry in the register, the Office shall notify the International Bureau in accordance with paragraph 2.
5. For the purposes of paragraphs 1 and 3, an EU trade mark on which the international registration was based shall include an EU trade mark registration resulting from an EU trade mark application on which the international application was based.

Article 30

Request for territorial extension subsequent to international registration

1. A request for territorial extension filed at the Office pursuant to Article 149(1) of Regulation (EC) No 207/2009 shall meet the following requirements:
 - (a) it is filed using one of the forms referred to in Article 28(1) and (2) of this Regulation and contains all the indications and information required by the form used;
 - (b) it indicates the number of the international registration to which it relates;
 - (c) the list of goods or services is covered by the list of goods or services contained in the international registration;
 - (d) the applicant is entitled, based on the indications made in the international form, to make a designation subsequent to the international registration through the Office in accordance with Article 2(1)(ii), and Article 3ter(2) of the Madrid Protocol.
2. Where a request for territorial extension does not meet all of the requirements laid down in paragraph 1, the Office shall invite the applicant to remedy the deficiencies within such time-limit as it may specify.

Article 31

Form to be used for a request for territorial extension

The form made available by the Office for a request for territorial extension subsequent to international registration, as referred to in Article 149(1) of Regulation (EC) No 207/2009 shall include all the elements of the official form provided by the International Bureau. Applicants may also use the official form provided by the International Bureau.

Article 32

Seniority claims before the Office

1. Without prejudice to Article 34(6) of Regulation (EC) No 207/2009, a seniority claim pursuant to Article 153a(1) of Regulation (EC) No 207/2009 shall contain:
 - (a) the registration number of the international registration;
 - (b) the name and address of the holder of the international registration in accordance with Article 2(1)(b) of this Regulation;
 - (c) an indication of the Member State or Member States in or for which the earlier trade mark is registered;
 - (d) the number and the filing date of the relevant registration;
 - (e) an indication of the goods or services for which the earlier trade mark is registered and those in respect of which seniority is claimed;
 - (f) a copy of the relevant registration certificate.
2. 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, the seniority claim shall contain the appointment of a representative within the meaning of Article 93(1) of Regulation (EC) No 207/2009.

3. Where the Office has accepted the seniority claim, it shall inform the International Bureau accordingly by communicating the following:
 - (a) the number of the international registration concerned;
 - (b) the name of the Member State or Member States in or for which the earlier trade mark is registered;
 - (c) the number of the relevant registration;
 - (d) the date from which the relevant registration was effective.

Article 33

Notification of ex officio provisional refusals to the International Bureau

1. The notification of an *ex officio* provisional refusal of protection of the international registration in whole or in part to be issued to the International Bureau pursuant to Article 154(2) and (5) of Regulation (EC) No 207/2009 shall, without prejudice to the requirements laid down in Article 154(3) and (4) of that Regulation, contain the following:
 - (a) the number of the international registration;
 - (b) a reference to the provisions of Regulation (EC) No 207/2009 which are relevant for the provisional refusal;
 - (c) an indication that the provisional refusal of protection will be confirmed by a decision of the Office if the holder of the international registration does not overcome the grounds for refusal by submitting observations to the Office within a time limit of two months from the date on which the Office issues the provisional refusal;
 - (d) where the provisional refusal relates to only part of the goods or services, an indication of those goods or services.
2. In respect of each notification of an *ex officio* provisional refusal to the International Bureau, and provided that the time limit for entering an opposition has expired and that no notification of provisional refusal based on an opposition has been issued pursuant to Article 78(1) of Delegated Regulation (EU) .../..., the Office shall inform the International Bureau of the following:
 - (a) where as a result of the proceedings before the Office 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, if applicable, following an appeal under Article 58 of Regulation (EC) No 207/2009 or an action under Article 65 of Regulation (EC) No 207/2009, the fact that protection of the mark is refused in the Union;
 - (c) where the refusal pursuant to point (b) concerns only part of the goods or services, the goods or services for which the mark is protected in the Union.

Article 34

Notification of invalidation of the effects of an international registration to the International Bureau

The notification referred to in Article 158(3) of Regulation (EC) No 207/2009 shall bear a date and shall contain:

- (a) the indication that the invalidation has been pronounced by the Office, or the indication of the EU trade mark court which has pronounced the invalidation;
- (b) an indication of whether invalidation has been pronounced in the form of revocation of the rights of the holder of the international registration, of a declaration that the trade mark is invalid on absolute grounds, or of a declaration that the trade mark is invalid on relative grounds;
- (c) a statement to the effect that the invalidation is no longer subject to appeal;
- (d) the number of the international registration;
- (e) the name of the holder of the international registration;
- (f) where the invalidation does not concern all the goods or services, an indication of the goods or services in respect of which the invalidation has been pronounced or those in respect of which the invalidation has not been pronounced;
- (g) the date on which the invalidation has been pronounced, together with an indication of whether the invalidation is effective as of that date or as from the date of the international registration subject to the invalidation.

Article 35

Request for conversion of an international registration into a national trade mark application

1. A request for conversion of an international registration designating the Union into a national trade mark application pursuant to Articles 112 and 159 of Regulation (EC) No 207/2009 shall, without prejudice to the requirements laid down in Article 159(4), (5), and (6) of that Regulation, contain:
 - (a) the registration number of the international registration;
 - (b) the date of the international registration or the date of the designation of the Union made subsequently to the international registration pursuant to Article 3ter(2) of the Madrid Protocol and, where applicable, particulars of the claim to priority for the international registration pursuant to Article 159(2) of Regulation (EC) No 207/2009, and particulars of the claim to seniority pursuant to Articles 34, 35 or 153 of Regulation (EC) No 207/2009;
 - (c) the indications and elements referred to in Article 113(1) of Regulation (EC) No 207/2009 and Article 22(a), (c) and (d) of this Regulation.
2. The publication of a request for conversion referred to in paragraph 1 shall contain the details laid down in Article 23.

Article 36

Transformation of an international registration designating the Union into an EU trade mark application

An application for transformation pursuant to Article 161(3) of Regulation (EC) No 207/2009 shall contain, in addition to the indications and elements referred to in Article 2 of this Regulation, the following:

- (a) the number of the international registration which has been cancelled;
- (b) the date on which the international registration was cancelled by the International Bureau;

- (c) as appropriate, the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date of recordal of the territorial extension to the Union made subsequently to the international registration pursuant to Article 3ter(2) of the Madrid Protocol;
- (d) where applicable, the date of priority claimed in the international application as entered in the International Register kept by the International Bureau.

TITLE XIV

FINAL PROVISIONS

Article 37

Entry into force and application

This Regulation shall enter into force on the twentieth day following that of its publication in the *Official Journal of the European Union*.

It shall apply as from 1 October 2017.

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