

EUROPEAN COMMUNITIES

Commission Regulation on the Community Trade Mark

Commission Regulation (EC) No.2868/95 of 13 December 1995 Implementing Council Regulation (EC) No.40/94 on the Community Trade Mark, as amended by Commission Regulation (EC) No.355/2009 of 31 March 2009

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Preamble

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,
Having regard to Council Regulation (EC) No 40/94 of 20 December 1993
on the Community trade mark as amended by Regulation (EC) No 3288/94,
and in particular Article 140 (now Article 162) thereof,
Whereas Regulation (EC) No 40/94 (hereinafter 'the Regulation') creates
a new trade mark system allowing a trade mark having effect throughout
the Community to be obtained on the basis of an application to the
Office for Harmonization in the Internal Market (trademarks and designs)
('the Office');

Whereas for this purpose, the Regulation contains the necessary
provisions for a procedure leading to the registration of a Community
trade mark, as well as for the administration of Community trade marks,
for appeals against decisions of the Office and for proceedings for
the revocation or invalidation of a Community trade mark;

Whereas Article 140 (now Article 162) of the Regulation provides that
the rules implementing the Regulation shall be adopted in an implementing
regulation;

Whereas the implementing regulation is to be adopted in accordance
with the procedure laid down in Article 141 (now Article 163) of the
Regulation;

Whereas this implementing regulation therefore lays down the rules
necessary for implementing the provisions of the Regulation on the
Community trade mark;

Whereas these rules should ensure the smooth and efficient operating
of trade mark proceedings before the Office;

Whereas in accordance with Article 116(1) (now Article 120(1)) of the
Regulation, all the elements of the application for a Community trade
mark specified in its Article 26(1) as well as any other information
the publication of which is prescribed by this implementing regulation
should be published in all the official languages of the Community;

Whereas, however, it is not appropriate for the trade mark itself,
names, addresses, dates and any other similar data to be translated
and published in all the official languages of the Community;

Whereas the Office should make available standard forms for proceedings
before the Office in all official languages of the Community;

Whereas the measures envisaged in this Regulation are in accordance
with the opinion of the Committee established under Article 141 (now

Article 163) of the Regulation,

HAS ADOPTED THIS REGULATION:

Article 1

The rules implementing the Regulation shall be as follows:

TITLE I APPLICATION PROCEDURE

Rule 1 Content of the application

(1) The application for a Community trade mark shall contain:

- (a) a request for registration of the mark as a Community trade mark;
- (b) the name, address and nationality of the applicant and the State in which he is domiciled or has his 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 the Regulation, shall be indicated by their official designation and include the legal form of the entity, which may be abbreviated in a customary manner. The telephone numbers, fax numbers, electronic mail address and details of other data communications links under which the applicant accepts to receive communications may be given. 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;
- (c) a list of the goods and services for which the trade mark is to be registered, in accordance with Rule 2, or a reference to the list of the goods and services of a previous Community trade mark application;
- (d) a representation of the mark in accordance with Rule 3;
- (e) if the applicant has appointed a representative, his name and the address of his place of business in accordance with point (b); if the representative has more than one business address or if there are two or more representatives with different business addresses, the application shall indicate which address shall be used as an address for service; where such an indication is not made, only the first-mentioned address shall be taken into account as an address for service;
- (f) where the priority of a previous application is claimed pursuant to Article 30 of the Regulation, 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 the Regulation, 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 (hereinafter referred to as 'earlier registered trade marks', as referred to in Article 34 of the Regulation) is claimed pursuant to Article 34 of the Regulation, a declaration to that effect, stating the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the mark is registered;

(i) where applicable, a statement that the application is for registration of a Community collective mark pursuant to Article 64 (now Article 66) of the Regulation;

(j) specification of the language in which the application has been filed, and of the second language pursuant to Article 115(3) (now Article 119(3)) of the Regulation;

(k) the signature of the applicant or his representative in accordance with Rule 79;

(l) where applicable, the request of a search report referred to in Article 39(2) (now Article 38(2)) of the Regulation.

(2) The application for a Community collective mark may include the regulations governing its use.

(3) The application may include a statement by the applicant that he disclaims any exclusive right to an element of the trade mark which is not distinctive, to be specified by the applicant.

(4) If there is more than one applicant, the application may contain the appointment of one applicant or representative as common representative.

Rule 2 List of goods and services

(1) The common classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, shall be applied to the classification of the goods and services.

(2) The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.

(3) The goods and services shall, in principle, be 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 under that Classification.

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

Rule 3 Representation of the mark

(1) If the applicant does not wish to claim any special graphic feature or colour, the mark shall be reproduced in normal script, as for example, by typing the letters, numerals and signs in the application. The use of small letters and capital letters shall be permitted and shall be followed accordingly in publications of the mark and in the registration by the Office.

(2) In cases other than those referred to in paragraph 1 and save where the application is filed by electronic means, 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) and the space used for the reproduction (type-area) shall not be larger than 26.2 cm x 17 cm. A margin of at least 2.5 cm shall be left on the left-hand side. Where it is not obvious, the correct position of the mark shall be indicated by adding the word 'top' to each reproduction. 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 16 cm high for publication in the Community Trade Mark Bulletin.

(3) In cases to which paragraph 2 applies, the application shall contain an indication to that effect. The application may contain a description of the mark.

(4) Where registration of a three-dimensional mark is applied for, the application shall contain an indication to that effect. The representation shall consist of a photographic reproduction or a graphic

representation of the mark. The representation may contain up to six different perspectives of the mark.

(5) Where registration in colour is applied for, the representation of the mark under paragraph 2 shall consist of the colour reproduction of the mark. The colours making up the mark shall also be indicated in words and a reference to a recognized colour code may be added.

(6) Where registration of a sound mark is applied for, the representation of the trade mark shall consist of a graphical representation of the sound, in particular a musical notation; where the application is filed through electronic means, it may be accompanied by an electronic file containing the sound. The President of the Office shall determine the formats and maximum size of the electronic file.

Rule 4 Fees for the application

The fees payable for the application shall be:

- (a) the basic fee;
- (b) a class fee for each class exceeding three to which the goods or services belong according to Rule 2;
- (c) where applicable, the search fee.

Rule 5 Filing of the application

(1) The Office shall mark the documents making up the application with the date of its receipt and the file number of the application. The Office shall issue to the applicant without delay a receipt which shall include at least the file number, a representation, description or other identification of the mark, the nature and the number of the documents and the date of their receipt.

(2) If the application is filed with the central industrial property office of a Member State or at the Benelux Trade Mark Office in accordance with Article 25 of the Regulation, the office of filing shall number all the pages of the application with Arabic numerals. Before forwarding, the office of filing shall mark the documents making up the application with the date of receipt and the number of pages. The office of filing shall issue to the applicant without delay a receipt which shall include at least the nature and the number of the documents and the date of their receipt.

(3) If the Office receives an application forwarded by the central

industrial property office of a Member State or the Benelux Trade Mark Office, it shall mark the application with the date of receipt and the file number and shall issue to the applicant without delay a receipt in accordance with the second sentence of paragraph 1, indicating the date of receipt at the Office.

Rule 5a Search report

The search reports shall be prepared using a standard form which contains at least the following information:

- (a) the name of the central industrial property offices that carried out the search;
- (b) the number of the trademark applications or registrations mentioned in the search report;
- (c) the date of application and if applicable date of priority of the trademark applications or registrations mentioned in the search report;
- (d) the date of registration of the trademarks mentioned in the search report;
- (e) the name and contact address of the holder of the trademarks applications or registrations mentioned in the search report;
- (f) a representation of the trademarks applied for or registered mentioned in the search report;
- (g) an indication of the classes, according to the Nice Classification, for which the earlier national trademarks are applied for or registered or of the goods and services for which the trademarks mentioned in the search report are either applied for or registered.

Rule 6 Claiming priority

(1) Where the priority of one or more previous applications pursuant to Article 30 of the Regulation is claimed in the application, the applicant shall indicate the file number of the previous application and file a copy of it within three months from the filing date. The copy shall be certified to be an exact copy of the previous application by the authority which received the previous application, and shall be accompanied by a certificate issued by that authority stating the date of filing of the previous application. If the previous application is a Community trade mark application, the Office shall ex officio include a copy of the previous application in the file of the Community trade mark application.

(2) Where the applicant wishes to claim the priority of one or more previous applications pursuant to Article 30 of the Regulation

subsequent to the filing of the application, the declaration of priority, stating the date on which and the country in or for which the previous application was made, shall be submitted within a period of two months from the filing date. The indications and evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of priority.

(3) If the language of the previous application is not one of the languages of the Office, the Office shall require the applicant to file, within a period specified by the Office, which shall be not less than three months, a translation of the previous application into one of these languages.

(4) The President of the Office may determine that the evidence to be provided by the applicant may consist of less than is required under paragraph 1, provided that the information required is available to the Office from other sources.

Rule 7 Exhibition priority

(1) Where the exhibition priority pursuant to Article 33 of the Regulation has been claimed in the application, 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. This certificate shall declare that the mark was in fact used for the goods or services, and shall state the opening date of the exhibition and, where the first public use did not coincide with the opening date of the exhibition, the date of such first public use. The certificate must be accompanied by an identification of the actual use of the mark, duly certified by the abovementioned authority.

(2) Where the applicant wishes to claim an exhibition priority subsequently to the filing of the application, the declaration of priority, indicating the name of the exhibition and the date of the first display of the goods or services, shall be submitted within a period of two months from the filing date. The indications and evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of priority.

Rule 8 Claiming the seniority of a national trade mark

(1) Where the seniority of one or more earlier registered trade marks,

as referred to in Article 34 of the Regulation, has been claimed in the application, the applicant shall, within three months from the filing date, submit a copy of the relevant registration. The copy must be certified by the competent authority to be an exact copy of the relevant registration.

(2) Where the applicant wishes to claim the seniority of one or more earlier registered trade marks as referred to in Article 34 of the Regulation, subsequent to the filing of the application, the declaration of seniority, indicating the Member State or Member States in or for which the mark is registered, the number and the filing date of the relevant registration, and the goods and services for which the mark is registered, shall be submitted within a period of two months from the filing date. The evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of seniority.

(3) The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the effective claiming of seniority.

(4) The President of the Office may determine that the evidence to be provided by the applicant may consist of less than is required under paragraph 1, provided that the information required is available to the Office from other sources.

Rule 9 Examination of requirements for a filing date and of formal requirements

(1) If the application fails to meet the requirements for according a filing date because:

(a) the application does not contain:

(i) a request for registration of the mark as a Community trade mark;

(ii) information identifying the applicant;

(iii) a list of the goods and services for which the mark is to be registered;

(iv) a representation of the trade mark; or

(b) the basic fee for the application has not been paid within one month of the filing of the application with the Office or, if the application has been filed with the central industrial property office of a Member State or with the Benelux Trade Mark Office, with that office,

the Office shall notify the applicant that a date of filing cannot be accorded in view of those deficiencies.

(2) If the deficiencies referred to under paragraph 1 are remedied within two months of receipt of the notification, the date on which all the deficiencies are remedied shall determine the date of filing. If the deficiencies are not remedied before the time limit expires, the application shall not be dealt with as a Community trade mark application. Any fees paid shall be refunded.

(3) Where, although a date of filing has been accorded, the examination reveals that:

(a) the requirements of Rules 1, 2 and 3 or the other formal requirements governing applications laid down in the Regulation or in these Rules are not complied with;

(b) the full amount of the class fees payable under Rule 4(b), read in conjunction with Commission Regulation (EC) No. 2869/95 (hereinafter 'the Fees Regulation') has not been received by the Office;

(c) where priority has been claimed pursuant to Rules 6 and 7, either in the application itself or within two months after the date of filing, the other requirements of the said Rules are not complied with; or

(d) where seniority has been claimed pursuant to Rule 8, either in the application itself or within two months after the date of filing, the other requirements of Rule 8 are not complied with, the Office shall invite the applicant to remedy the deficiencies noted within such period as it may specify.

(4) If the deficiencies referred to in paragraph 3(a) are not remedied before the time limit expires, the Office shall reject the application.

(5) If the outstanding class fees are not paid before the time limit expires, the application shall be deemed to have been withdrawn, unless it is clear which class or classes the amount paid is intended to cover. In the absence of other criteria to determine which classes are intended to be covered, the Office shall take the classes in the order of the classification. The application shall be deemed to have been withdrawn with regard to those classes for which the class fees have not been paid or have not been paid in full.

(6) If the deficiencies referred to in paragraph 3 concern the claim to priority, the right of priority for the application shall be lost.

(7) If the deficiencies referred to in paragraph 3 concern the claim to seniority, the right of seniority in respect of that application shall be lost.

(8) If the deficiencies referred to in paragraph 3 concern only some of the goods and services, the Office shall refuse the application, or the right of priority or the right of seniority shall be lost, only in so far as those goods and services are concerned.

Rule 10 Searches by national offices

(1) If the request for a search report referred to in Article 39(2) (now Article 38(2)) of the Regulation is not made in the application for a Community trade mark, or if the search fee referred to in Rule 4(c) is not paid within the time limit for paying the basic application fee, the application shall not be subjected to a search by the central industrial property offices.

(2) An international registration designating the European Community shall not be subjected to a search by the central industrial property offices if the request for a search report pursuant to Article 39(2) (now Article 38(2)) of the Regulation is not made to the Office within one month starting with the date on which the International Bureau notifies the international registration to the Office, or if the search fee is not paid within the same period.

Rule 11 Examination as to absolute grounds for refusal

(1) Where, pursuant to Article 7 of the Regulation, the trade mark may not be registered for all or any part of the goods or services applied for, the Office shall notify the applicant of the grounds for refusing registration. The Office shall specify a period within which the applicant may withdraw or amend the application or submit his observations.

(2) Where, pursuant to Article 38(2) (now Article 37(2)) of the Regulation, registration of the Community trade mark is subject to the applicant's stating that he disclaims any exclusive right in the non-distinctive elements in the mark, the Office shall notify the applicant thereof, stating the reasons, and shall invite him to submit the relevant statement within such period as it may specify.

(3) Where the applicant fails to overcome the ground for refusing

registration or to comply with the condition laid down in paragraph 2 within the time limit, the Office shall refuse the application in whole or in part.

Rule 12 Publication of the 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 88(3) (now Article 92(3)) of the Regulation; if 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'; if there are two or more representatives with different business addresses, only the address for service determined pursuant to Rule 1(1)(e) shall be published; where an association of representatives is appointed under Rule 76(9), only the name and business address of the association shall be published;
- (c) the reproduction of the mark, together with the elements and descriptions referred to in Rule 3; where the reproduction of the mark is in colour or contains colours, the publication shall be in colour and shall indicate the colour or colours making up the mark, as well as, where applicable, the colour code indicated;
- (d) the list of goods and 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 pursuant to Article 30 of the Regulation;
- (g) where applicable, particulars of the claim of exhibition priority pursuant to Article 33 of the Regulation;
- (h) where applicable, particulars of the claim of seniority pursuant to Article 34 of the Regulation;
- (i) where applicable, a statement that the mark has become distinctive in consequence of the use which has been made of it, pursuant to Article 7(3) of the Regulation;
- (j) where applicable, a statement that the application is for a Community collective mark;
- (k) where applicable, a statement by the applicant disclaiming any

exclusive right to an element of the mark pursuant to Rule 1(3) or Rule 11(2);

(l) the language in which the application was filed and the second language which the applicant has indicated pursuant to Article 115(3) (now Article 119(3)) of the Regulation.

(m) where applicable, a statement that the application results from a transformation of an international registration designating the European Community pursuant to Article 156 (now Article 161) of the Regulation, 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 European Community made subsequently to the international registration pursuant to Article 3 ter(2) of the Madrid Protocol was recorded and, where applicable, the date of priority of the international registration.

Rule 13 Amendment of the application

(1) An application for amendment of the application under Article 44 (now Article 43) of the Regulation shall contain:

(a) the file number of the application;

(b) the name and the address of the applicant in accordance with Rule 1(1)(b);

(c) [deleted]

(d) the indication of the element of the application to be corrected or amended, and that element in its corrected or amended version;

(e) where the amendment relates to the representation of the mark, a representation of the mark as amended, in accordance with Rule 3.

(2) [deleted]

(3) If the requirements governing the amendment of the application are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application for amendment.

(4) Where the amendment is published pursuant to Article 44(2) (now Article 43(2)) of the Regulation, Rules 15 to 22 shall apply mutatis mutandis.

(5) A single application for amendment may be made for the amendment of the same element in two or more applications of the same applicant.

Where the application for amendment is subject to the payment of a fee, the required fee shall be paid in respect of each application to be amended.

(6) Paragraphs 1 to 5 shall apply mutatis mutandis for applications to correct the name or the business address of a representative appointed by the applicant. Such applications shall not be subject to the payment of a fee.

Rule 13a Division of the Application

(1) A declaration of the division of the application pursuant to Article 44a (now Article 44) of the Regulation shall contain:

- (a) the file number of the application;
- (b) the name and address of the applicant in accordance with Rule 1(1)(b);
- (c) the list of goods and services which shall form the divisional application, or, where the division into more than one divisional application is sought, the list of goods and services for each divisional application;
- (d) the list of goods and services which shall remain in the original application.

(2) Where the Office finds that the requirements laid down in paragraph 1 are not fulfilled or the list of goods and services which shall form the divisional application overlap with the goods and services which shall remain in the original application, it shall invite the applicant to remedy the deficiencies noted within such period as it may specify. If the deficiencies are not remedied before the time limit expires, the Office shall refuse the declaration of division.

(3) The periods as referred to in Article 44a(2)(b) (now Article 44(2)(b)) of the Regulation during which a declaration of division of the application is not admissible shall be:

- (a) the period before a date of filing has been accorded;
- (b) the period of three months following the publication of the application provided for in Article 42(1) (now Article 41(1)) of the Regulation;
- (c) [deleted]

(4) Where the Office finds, that the declaration of division is inadmissible pursuant to Article 44a (now Article 44) of the Regulation or pursuant to paragraph 3(a) and (b), it shall refuse the declaration

of division.

(5) 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.

(6) Where the declaration of division relates to an application which has already been published pursuant to Article 40 (now Article 39) of the Regulation, the division shall be published in the Community Trade Marks Bulletin. The divisional application shall be published; the publication shall contain the indications and elements referred to in Rule 12. The publication does not open a new period for the filing of oppositions.

Rule 14 Correction of mistakes and errors in publications

(1) Where the publication of the application contains a mistake or error attributable to the Office, the Office shall correct the mistake or error acting of its own motion or at the request of the applicant.

(2) Where a request as referred to in paragraph 1 is made by the applicant, Rule 13 shall apply mutatis mutandis. The request shall not be subject to the payment of a fee.

(3) The corrections effected under this Rule shall be published.

(4) Article 42(2) (now Article 41(2)) of the Regulation and Rules 15 to 22 shall apply mutatis mutandis where the correction concerns the list of goods or services or the representation of the mark.

TITLE II PROCEDURE FOR OPPOSITION AND PROOF OF USE

Rule 15 Notice of opposition

(1) A notice of opposition may be entered on the basis of one or more earlier marks within the meaning of Article 8(2) of the Regulation (earlier marks) and one and/or more other earlier rights within the meaning of Article 8(4) of the Regulation (earlier rights), provided that the earlier marks or earlier rights all belong to the same proprietor or proprietors. If an earlier mark and/or an earlier right has more than one proprietor (co-ownership), the opposition may be filed by any or all of them.

(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 Community trade mark;

(b) a clear identification of the earlier mark or earlier 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 the Regulation or where the opposition is based on Article 8(3) of the Regulation, the indication of the file number or registration number of the earlier mark, the indication whether the earlier mark is registered or an application for registration, as well as the 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 a Community trade mark;

(ii) where the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of the Regulation, the indication of the Member State where the mark is well-known and either the indications referred to in point (i) or a representation of the mark;

(iii) where the opposition is based on an earlier right within the meaning of Article 8(4), an indication of its kind or nature, a representation of the earlier right, and an indication of whether this earlier right exists in the whole Community or in one or more Member States, and if so, an indication of the Member States;

(c) the grounds on which the opposition is based, namely a statement to the effect that the respective requirements under Article 8(1), (3), (4), and (5) of the Regulation are fulfilled;

(d) the filing date and, where available, the registration date and the priority date of the earlier mark, unless it is an unregistered well-known trade mark,

(e) a representation of the earlier mark as registered or applied for;

if the earlier mark is in colour, the representation shall be in colour;

- (f) the goods and services on which the opposition is based;
- (g) where the opposition is based on an earlier mark having a reputation within the meaning of Article 8(5) of the Regulation, an indication of the Member State in which, and the goods and services for which, the mark has a reputation;
- (h) as concerns the opposing party:
 - (i) the name and address of the opposing party in accordance with Rule 1(1)(b);
 - (ii) where the opposing party has appointed a representative, the name and business address of the representative in accordance with Rule 1(1)(e);
 - (iii) where the opposition is entered by a licensee or by a person who is entitled under the relevant national law to exercise an earlier right, a statement to that effect and indications concerning the authorization or entitlement to file the opposition.

(3) The notice of opposition may contain:

- (a) an indication of the goods and 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 and services of the opposed Community trade mark application;
- (b) a reasoned statement setting out the main facts and arguments on which the opposition relies, and evidence to support the opposition.

(4) Where the opposition is based on more than one earlier mark or earlier right, paragraphs 2 and 3 shall apply for each of these rights.

Rule 16 Use of languages in the notice of opposition

(1) The time limit referred to in Article 115(6) (now Article 119(6)) of the Regulation within which the opposing party has to file a translation of his opposition shall be one month from the expiry of the opposition period.

(2) Where the opposing party or the applicant, before the date on which the opposition proceedings are deemed to commence pursuant to Rule 18(1), informs the Office that the applicant and the opposing party have agreed on a different language for the opposition proceedings pursuant to Article 115(7) (now Article 119(7)) of the Regulation, the opposing party shall, where the notice of opposition has not been filed in that language, file a translation of the notice of opposition

in that language within a period of one month from the said date. Where the translation is not filed or filed late, the language of the proceedings shall remain unchanged.

Rule 16a Information of the applicant

Any 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 expiry of the period referred to in Rule 18 shall be sent by the Office to the other party for purposes of informing of the introduction of an opposition.

Rule 17 Examination of inadmissibility

(1) If the opposition fee has not been paid within the opposition period, the opposition shall be deemed not to have been entered. If the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.

(2) If the notice of opposition has not been filed within the opposition period, or if the notice of opposition does not clearly identify the application against which opposition is entered or the earlier mark or the earlier right on which the opposition is based in accordance with Rule 15(2)(a) and (b), or does not contain grounds for opposition in accordance with Rule 15(2)(c), and if those deficiencies have not been remedied before the expiry of the opposition period, the Office shall reject the opposition as inadmissible.

(3) Where the opposing party does not submit a translation as required under Rule 16(1), 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.

(4) If the notice of opposition does not comply with the other provisions of Rule 15, the Office shall inform the opposing party accordingly and shall invite him 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.

(5) Any finding pursuant to paragraph 1 that the notice of opposition is deemed not to have been entered and any decision to reject an opposition as inadmissible under paragraphs 2, 3 and 4 shall be notified to the

applicant.

Rule 18 Commencement of opposition proceedings

(1) When the opposition is found admissible pursuant to Rule 17, the Office shall send a communication to the parties informing them that the opposition proceedings shall be deemed to commence two months after receipt of the communication. This period may be extended up to a total of 24 months if both parties submit requests for such an extension before the period expires.

(2) If, within the period referred to in paragraph 1, the application is withdrawn or restricted to goods and 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) If, within the period referred to in paragraph 1, the applicant restricts the application by deleting some of the goods and 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 he maintains the opposition, and if so, against which of the remaining goods and services. If the opposing party withdraws the opposition in view of the restriction the opposition proceedings shall be closed.

(4) If before 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) If before expiry of the period referred to in paragraph 1 the opposition proceedings are closed following a withdrawal or restriction of the application or pursuant to paragraph 3, the opposition fee shall be refunded.

Rule 19 Substantiation of the opposition

(1) The Office shall give the opposing party the opportunity to present the facts, evidence and arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time limit specified by it and which shall be at least 2 months starting on the date on which the opposition proceedings shall be deemed to commence in accordance with Rule 18(1).

(2) Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:

(a) if the opposition is based on a trade mark which is not a Community trade mark, evidence of its filing or registration, by submitting:

(i) if the trade mark is not yet registered, a copy of the relevant filing certificate or an equivalent document emanating from the administration with which the trade mark application was filed; or

(ii) if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, 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 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered;

(b) if the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of the Regulation, evidence showing that this mark is well-known in the relevant territory;

(c) if the opposition is based on a mark with reputation within the meaning of Article 8(5) of the Regulation, in addition to the evidence referred to in point (a) of this paragraph, evidence showing that the mark has a reputation, 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;

(d) if the opposition is based on an earlier right within the meaning of Article 8(4) of the Regulation, evidence of its acquisition, continued existence and scope of protection of that right;

(e) if the opposition is based on Article 8(3) of the Regulation, evidence of the opposing party's proprietorship and of the nature of his relationship with the agent or representative.

(3) The information and evidence referred to in paragraphs 1 and 2 shall be in the language of the proceedings or accompanied by a translation. The translation shall be submitted within the time limit specified for submitting the original document.

(4) The Office shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within

the time limit set by the Office.

Rule 20 Examination of the opposition

(1) If until expiry of the period referred to in Rule 19(1) the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, as well his entitlement to file the opposition, the opposition shall be rejected as unfounded.

(2) If 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 him to file his observations within a period specified by the Office.

(3) If 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 by the Office, if it considers it necessary to do so, to reply within a period specified by the Office.

(5) Rule 18(2) and (3) shall apply mutatis mutandis after the date on which the opposition proceedings are deemed to commence.

(6) In appropriate cases, the Office may invite the parties to limit their observations to particular issues, in which case it shall allow the party to raise the other issues at a later stage of the proceedings. In no case shall the Office be required to inform the parties which facts or evidence could be or have not been submitted.

(7) The Office may suspend opposition proceedings:

(a) where the opposition is based on an application for registration pursuant to Article 8(2)(b) of the Regulation until a final decision is taken in that proceeding,

(b) where the opposition is based on an application for registration for a geographical indication or designation of origin under Council Regulation (EEC) No. 2081/92 until a final decision is taken in that proceeding, or

(c) where a suspension is appropriate under the circumstances.

Rule 21 Multiple oppositions

(1) Where a number of oppositions have been entered in respect of the

same application for a Community trade mark, the Office may deal with them in one set of proceedings. The Office may subsequently decide to no longer deal with them in this way.

(2) If a preliminary examination of one or more oppositions reveals that the Community trade mark for which an application for registration has been filed is possibly not eligible 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. The Office shall inform the remaining opposing parties of any relevant decisions taken during those proceedings which are continued.

(3) Once a decision rejecting the application has become final, the oppositions on which a decision was deferred in accordance with paragraph 2 shall be deemed to have been disposed of and the opposing parties concerned shall be informed accordingly. Such disposition shall be considered to constitute a case which has not proceeded to judgment within the meaning of Article 81(4) (now Article 85(4)) of the Regulation.

(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 paragraphs 1, 2 and 3.

Rule 22 Proof of use

(1) A request for proof of use pursuant to Article 43(2) or (3) (now Article 42(2) or (3)) of the Regulation shall be admissible only if the applicant submits such a request within the period specified by the Office pursuant to Rule 20(2).

(2) Where the opposing party has to furnish proof of use or show that there are proper reasons for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, the Office shall reject the opposition.

(3) The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with

paragraph 4.

(4) The evidence shall be filed in accordance with Rules 79 and 79a and shall, in principle, be confined 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 76(1)(f) (now Article 78(1)(f)) of the Regulation.

(5) A request for proof of use may be made with or without submitting at the same time observations on the grounds on which the opposition is based. Such observations may 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, within a period specified by the Office.

TITLE III REGISTRATION PROCEDURE

Rule 23 Registration of the trade mark

[Version before entry into force of Commission Regulation (EC) No. 355/2009 of 31 March 2009]:

(1) The registration fee provided for in Article 45 of the Regulation shall consist of:

- (a) a basic fee; and
- (b) a class fee for each class exceeding three in respect of which the mark is to be registered.

(2) Where no opposition has been entered or where any opposition entered has been finally disposed of by withdrawal, rejection or other disposition, the Office shall request the applicant to pay the registration fee within two months of receipt of the request.

(3) If the registration fee is not paid within due time, it may still be validly paid within two months of notification of a communication pointing out the failure to observe the time limit, provided that within this period the additional fee specified in the Fees Regulations is paid.

(4) On receipt of the registration fee the mark applied for and the particulars referred to in Rule 84(2) shall be recorded in the Register of Community trade marks.

(5) The registration shall be published in the Community Trade Marks Bulletin.

(6) The registration fee shall be refunded if the trade mark applied for is not registered.

[Version after entry into force of Commission Regulation (EC) No. 355/2009 of 31 March 2009]:

1. Where no opposition has been entered or where any opposition entered has been finally disposed of by withdrawal, rejection or other disposition, the trade mark applied for and the particulars referred to in Rule 84(2) shall be recorded in the Register of Community trade marks.

2. The registration shall be published in the Community Trade Marks Bulletin.

Rule 24 Certificate of registration

(1) The Office shall issue to the proprietor of the trade mark a certificate of registration which shall contain the entries in the Register provided for in Rule 84(2) and a statement to the effect that those entries have been recorded in the Register.

(2) The Office shall provide certified or uncertified copies of the certificate of registration, upon payment of a fee.

Rule 25 Alteration of the registration

(1) An application for alteration of the registration pursuant to Article 48(2) of the Regulation shall contain:

- (a) the registration number,
- (b) the name and the address of the proprietor of the mark in accordance with Rule 1(1)(b),
- (c) [deleted]
- (d) the indication of the element in the representation of the mark to be altered and that element in its altered version;
- (e) a representation of the mark as altered, in accordance with Rule 3.

(2) The application shall be deemed not to have been filed until the required fee has been paid. If the fee has not been paid or has not been paid in full, the Office shall inform the applicant accordingly.

(3) If the requirements governing the alteration of the registration are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application.

(4) Where the registration of the alteration is challenged pursuant to Article 48(3) of the Regulation, the provisions on opposition contained in the Regulation and in these Rules shall apply mutatis mutandis.

(5) A single application may be made for the alteration of the same element in two or more registrations of the same proprietor. The required fee shall be paid in respect of each registration to be altered.

Rule 25a Division of a registration

(1) A declaration of the division of a registration pursuant to Article

48a (now Article 49) of the Regulation shall contain:

- (a) the registration number,
- (b) the name and address of the proprietor of the trade mark in accordance with Rule 1(1)(b),
- (c) the list of goods and services which shall form the divisional registration, or, where the division into more than one divisional registration is sought, the list of goods and services for each divisional registration,
- (d) the list of goods and services which shall remain in the original registration.

(2) Where the Office finds that the requirements laid down in paragraph 1 are not fulfilled or the list of goods and services which shall form the divisional registration overlap with the goods and services which shall remain in the original registration, it shall invite the applicant to remedy the deficiencies noted within such period as it may specify. If the deficiencies are not remedied before the time limit expires, the Office shall refuse the declaration of division.

(3) Where the Office finds, that the declaration of division is inadmissible pursuant to Article 48a (now Article 49) of the Regulation, it shall refuse the declaration of division.

(4) 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.

Rule 26 Change of the name or address of the proprietor of the Community trade mark or of his registered representative

(1) A change of the name or address of the proprietor of the Community trademark which is not an alteration of the Community trade mark pursuant to Article 48(2) of the Regulation and which is not the consequence of a whole or partial transfer of the registered mark shall, at the request of the proprietor, be recorded in the register.

(2) An application for the change of the name or address of the proprietor of the registered mark shall contain:

- (a) the registration number of the mark;
- (b) the name and the address of the proprietor of the mark as recorded

in the register;

(c) the indication of the name and address of the proprietor of the mark, as amended, in accordance with Rule 1(1)(e);

(d) (deleted)

(3) The application shall not be subject to payment of a fee.

(4) A single application may be made for the change of the name or address in respect of two or more registrations of the same proprietor.

(5) If the requirements governing the recording of a change are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application.

(6) Paragraphs 1 to 5 shall apply mutatis mutandis to a change of the name or address of the registered representative.

(7) Paragraphs 1 to 6 shall apply mutatis mutandis to applications for Community trade marks. The change shall be recorded in the files kept by the Office on the Community trade mark application.

Rule 27 Correction of mistakes and errors in the register and in the publication of the registration

(1) Where the registration of the mark or the publication of the registration contains a mistake or error attributable to the Office, the Office shall correct the error or mistake of its own motion or at the request of the proprietor.

(2) Where such a request is made by the proprietor, Rule 26 shall apply mutatis mutandis. The request shall not be subject to payment of a fee.

(3) The Office shall publish the corrections made under this Rule.

Rule 28 Claiming seniority after registration of the Community trade mark

(1) An application pursuant to Article 35 of the Regulation to obtain the seniority of one or more earlier registered trade marks as referred to in Article 34 of the Regulation, shall contain:

(a) the registration number of the Community trade mark;

(b) the name and address of the proprietor of the Community trade mark in accordance with Rule 1(1)(b);

(c) (deleted)

(d) an indication of the Member State or Member States in or for which the earlier mark is registered, the number and the filing date of the relevant registration, and the goods and services for which the earlier mark is registered;

(e) an indication of the goods and services in respect of which seniority is claimed;

(f) a copy of the relevant registration; the copy must be certified as an exact copy of the relevant registration by the competent authority.

(2) If the requirements governing the claiming of seniority are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period specified by the Office, the Office shall reject the application.

(3) The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the effective claiming of seniority.

(4) The President of the Office may determine that the material to be provided by the applicant may consist of less than is required under paragraph 1(f), provided that the information required is available to the Office from other sources.

TITLE IV RENEWAL

Rule 29 Notification of expiry

At least six months before expiry of the registration the Office shall inform the proprietor of the Community trade mark, and any person having a registered right, including a licence, in respect of the Community trade mark, that the registration is approaching expiry. Failure to give such notification shall not affect the expiry of the registration.

Rule 30 Renewal of registration

(1) An application for renewal shall contain:

- (a) the name of the person requesting renewal;
- (b) the registration number of the Community trade mark to be renewed;
- (c) if the renewal is requested for only part of the goods and services for which the mark is registered, an indication of those classes or those goods and services for which renewal is requested or those classes or those goods and services for which renewal is not requested, 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.

(2) The fees payable under Article 47 of the Regulation for the renewal of a Community trade mark shall consist of the following:

- (a) a basic fee;
- (b) a class fee for each class exceeding three in respect of which renewal is applied for; and
- (c) where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal, pursuant to Article 47(3) of the Regulation, as specified in the Fees Regulation.

(3) It shall be deemed to constitute a request for renewal if the payment referred to in paragraph 2 is made by a means of payment referred to in Article 5(1) of the Fees Regulation, provided that it contains all the indications required under paragraph 1(a) and (b) of this Rule and Article 7(1) of the Fees Regulation.

(4) Where the application for renewal is filed within the periods provided for in Article 47(3) of the Regulation, but the other conditions governing renewal provided for in Article 47 of the Regulation and these Rules are not satisfied, the Office shall inform the applicant

of the deficiencies found.

(5) Where an application for renewal is not submitted or is submitted after expiry of the period provided for in the third sentence of Article 47(3) of the Regulation, or where the fees are not paid or are paid only after the period in question has expired, or where the deficiencies are not remedied within that period, the Office shall determine that the registration has expired and shall so notify the proprietor of the Community trade mark. Where the fees paid are insufficient to cover all the classes of goods and services for which renewal is requested, such a determination shall not be made if it is clear which class or classes are to be covered. In the absence of other criteria, the Office shall take the classes into account in the order of classification.

(6) Where the determination made pursuant to paragraph 5 has become final, the Office shall cancel the mark from the register. The cancellation shall take effect from the day following the day on which the existing registration expired.

(7) Where the renewal fees provided for in paragraph 2 have been paid but the registration is not renewed, those fees shall be refunded.

(8) A single application for renewal may be submitted for two or more marks, upon payment of the required fees for each of the marks, provided that the proprietors or the representatives are the same in each case.

TITLE V TRANSFER, LICENCES AND OTHER RIGHTS, CHANGES

Rule 31 Transfer

(1) An application for registration of a transfer under Article 17 of the Regulation shall contain:

- (a) the registration number of the Community trade mark;
- (b) particulars of the new proprietor in accordance with Rule 1(1)(b);
- (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) documents duly establishing the transfer in accordance with Article 17(2) and (3) of the Regulation.

(2) The application may contain, where applicable, the name and business address of the representative of the new proprietor, to be set out in accordance with Rule 1(1)(e).

(3) (deleted)

(4) (deleted)

(5) It shall constitute sufficient proof of transfer under paragraph 1(d):

- (a) that the application for registration of the transfer is signed by the registered proprietor or his representative and by the successor in title or his representative; or,
- (b) that the application, if submitted by the successor in title, is accompanied by a declaration, signed by the registered proprietor or his representative, that he agrees to the registration of the successor in title; or
- (c) that the application is accompanied by a completed transfer form or document, as specified in Rule 83(1)(d), signed by the registered proprietor or his representative and by the successor in title or his representative.

(6) Where the conditions applicable to the registration of a transfer, as laid down in Article 17(1) to (4) of the Regulation, in paragraphs 1 to 4 above, and in other applicable Rules are not fulfilled, the Office shall notify the applicant of the deficiencies. If the deficiencies are not remedied within a period specified by the Office, it shall reject the application for registration of the transfer.

(7) A single application for registration of a transfer may be submitted for two or more marks, provided that the registered proprietor and the successor in title are the same in each case.

(8) Paragraphs 1 to 7 shall apply mutatis mutandis to applications for Community trade marks. The transfer shall be recorded in the files kept by the Office concerning the Community trade mark application.

Rule 32 Partial transfers

(1) Where the application for registration of a transfer relates only to some of the goods and services for which the mark is registered, the application shall contain an indication of the goods and services to which the partial transfer relates.

(2) The goods and services in the original registration shall be distributed between the remaining registration and the new registration so that the goods and services in the remaining registration and the new registration shall not overlap.

(3) Rule 31 shall apply mutatis mutandis to applications for registrations of a partial transfer.

(4) 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.

(5) Any application made by the original proprietor pending with regard to the original registration shall be deemed to be pending with regard to the remaining registration and the new registration. Where such application is subject to the payment of fees and these fees have been paid by the original proprietor, the new proprietor shall not be liable to pay any additional fees with regard to such application.

Rule 33 Registration of licences and other rights

(1) Rule 31(1), (2), (5) and (7) shall apply mutatis mutandis to the registration of a licence, of a transfer of a licence, of a right in rem, of a transfer of a right in rem, of an enforcement measure or of insolvency proceedings, subject to the following:

(a) Rule 31(1)(c) shall not apply in respect of a request for registration

of a right in rem, of a levy of execution or of insolvency proceedings;
(b) Rule 31(1)(d) and (5) shall not apply where the request was made by the proprietor of the Community trade mark.

(2) The application for registration of a licence, a transfer of a licence, a right in rem, a transfer of a right in rem or an enforcement measure shall not be deemed to have been filed until the required fee has been paid.

(3) Where the conditions applicable to registration, as laid down in Articles 19 to 22 of the Regulation, in paragraph 1 of this Rule and in Rule 34(2) and the other applicable Rules are not fulfilled, the Office shall notify the applicant of the irregularity. If the irregularity is not corrected within a period specified by the Office, it shall reject the application for registration.

(4) Paragraphs 1 and 3 shall apply mutatis mutandis to applications for Community trade marks. Licences, rights in rem, insolvency proceedings and enforcement measures shall be recorded in the files kept by the Office concerning the Community trade mark application.

Rule 34 Special provisions for the registration of a licence

(1) The application for registration of a licence may contain a request to record the licence in the Register as one or more of the following:

- (a) an exclusive licence,
- (b) a sub-licence in case where the licence is granted by a licensee whose licence is recorded in the Register,
- (c) a licence limited to only a part of the goods or services for which the mark is registered,
- (d) a licence limited to part of the Community,
- (e) a temporary licence.

(2) Where a request is made to record the licence as a licence pursuant to paragraph 1(c), (d) and (e), the application for registration of a licence shall indicate the goods and services and the part of the Community and the time period for which the licence is granted.

Rule 35 Cancellation or modification of the registration of licences and other rights

(1) A registration effected under Rule 33(1) shall be cancelled at the request of one of the persons concerned.

- (2) The application shall contain:
- (a) the registration number of the Community trade mark; and
 - (b) particulars of the right whose registration is to be cancelled.
- (3) The application for cancellation of a licence, a right in rem or an enforcement measure shall not be deemed to have been filed until the required fee has been paid.
- (4) The application shall be accompanied by documents showing that the registered right no longer exists or by a statement by the licensee or the holder of another right, to the effect that he consents to cancellation of the registration.
- (5) Where the requirements for cancellation of the registration are not satisfied, the Office shall notify the applicant of the irregularity. If the irregularity is not corrected within a period specified by the Office, it shall reject the application for cancellation of the registration.
- (6) Paragraphs 1, 2, 4 and 5 shall apply *mutatis mutandis* to a request for the modification of a registration effected under Rule 33(1).
- (7) Paragraphs 1 to 6 shall apply *mutatis mutandis* to entries made in the files pursuant to Rule 33(4).

TITLE VI SURRENDER

Rule 36 Surrender

(1) A declaration of surrender pursuant to Article 49 (now Article 50) of the Regulation shall contain:

- (a) the registration number of the Community trade mark;
- (b) the name and address of the proprietor in accordance with Rule 1(1)(b);
- (c) (deleted)
- (d) where surrender is declared only for some of the goods and services for which the mark is registered, the goods and services for which the surrender is declared or the goods and services for which the mark is to remain registered.

(2) Where a right of a third party relating to the Community trade mark is entered in the register, it shall be sufficient proof of his agreement to the surrender that a declaration of consent to the surrender is signed by the proprietor of that right or his representative. Where a licence has been registered, surrender shall be registered three months after the date on which the proprietor of the Community trade mark satisfies the Office that he has informed the licensee of his intention to surrender it. If the proprietor proves to the Office before the expiry of that period that the licensee has given his consent, the surrender shall be registered forthwith.

(3) If the requirements governing surrender are not fulfilled, the Office shall communicate the deficiencies to the declarant. If the deficiencies are not remedied within a period to be specified by the Office, the Office shall reject the entry of the surrender in the Register.

TITLE VII REVOCATION AND INVALIDITY

Rule 37 Application for revocation or for a declaration of invalidity

An application to the Office for revocation or for a declaration of invalidity pursuant to Article 55 (now Article 56) of the Regulation shall contain:

- (a) as concerns the registration in respect of which revocation or a declaration of invalidity is sought;
 - (i) the registration number of the Community trade mark in respect of which revocation or a declaration of invalidity is sought;
 - (ii) the name and address of the proprietor of the Community trade mark in respect of which revocation or a declaration of invalidity is sought;
 - (iii) a statement of the registered goods and services in respect of which revocation or a declaration of invalidity is sought;
- (b) as regards the grounds on which the application is based,
 - (i) in the case of an application pursuant to Article 50 (now Article 51) or Article 51 (now Article 52) of the Regulation, a statement of the grounds on which the application for revocation or a declaration of invalidity is based;
 - (ii) in the case of an application pursuant to Article 52(1) (now Article 53(1)) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and if necessary particulars showing that the applicant is entitled to adduce the earlier right as grounds for invalidity;
 - (iii) in the case of an application pursuant to Article 52(2) (now Article 53(2)) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and particulars showing that the applicant is the proprietor of an earlier right as referred to in Article 52(2) (now Article 53(2)) of the Regulation or that he is entitled under the national law applicable to lay claim to that right;
 - (iv) an indication of the facts, evidence and arguments presented in support of those grounds;
- (c) as concerns the applicant,
 - (i) his name and address in accordance with Rule 1(1)(b);
 - (ii) if the applicant has appointed a representative, the name and the business address of the representative, in accordance with Rule 1(1)(e).

Rule 38 Languages used in revocation or invalidity proceedings

(1) The time limit referred to in Article 115(6) (now Article 119(6)) of the Regulation within which the applicant for revocation or a declaration of invalidity has to file a translation of his application shall be one month, starting with the date of the filing of his application, failing which the application shall be rejected as inadmissible.

(2) Where the evidence in support of the application is not filed in the language of the revocation or invalidity proceedings, the applicant shall file a translation of that evidence into that language within a period of two months after the filing of such evidence.

(3) Where the applicant for revocation or for a declaration of invalidity or the proprietor of the Community trade mark inform the Office before the expiry of a period of two months from receipt by the Community trade mark proprietor of the communication referred to in Rule 40(1), that they have agreed on a different language of proceedings pursuant to Article 115(7) (now Article 119(7)) of the Regulation, the applicant shall, where the application was not filed in that language, file a translation of the application in that language within a period of one month from the said date. Where the translation is not filed or filed late, the language of the proceedings shall remain unchanged.

Rule 39 Rejection of the application for revocation or for declaration of invalidity as inadmissible

(1) Where the Office finds that the required fee has not been paid, it shall invite the applicant to pay the fee within a period specified by it. If the required fee is not paid within the period specified by the Office, the Office shall inform the applicant that the application for revocation or for declaration of invalidity is deemed not to have been filed. If the fee has been paid after expiry of the period specified, it shall be refunded to the applicant.

(2) Where the translation required under Rule 38(1) is not filed within the prescribed period, the Office shall reject the application for revocation or for declaration of invalidity as inadmissible.

(3) If the Office finds that the application does not comply with Rule 37, it shall invite the applicant to remedy the deficiencies found within such period as it may specify. If the deficiencies are not remedied before expiry of the time limit, the Office shall reject the application

as inadmissible.

(4) Any decision to reject an application for revocation or declaration of invalidity under paragraph 2 or 3 shall be communicated to the applicant and the proprietor of the Community trade mark.

Rule 40 Examination of the application for revocation or for a declaration of invalidity

(1) Every application for revocation or for declaration of invalidity which is deemed to have been filed shall be notified to the proprietor of the Community trade mark. When the Office has found the application admissible, it shall invite the proprietor of the Community trade mark to file his observations within such period as it may specify.

(2) If the proprietor of the Community trade mark files no observations, the Office may decide on the revocation or invalidity on the basis of the evidence before it.

(3) Any observations filed by the proprietor of the Community trade mark shall be communicated to the applicant, who shall be requested by the Office, if it sees fit, to reply within a period specified by the Office.

(4) Save where Rule 69 otherwise provides or allows, all observations filed by the parties shall be sent to the other party concerned.

(5) In the case of an application for revocation based on Article 50(1)(a) (now Article 51(1)(a)) of the Regulation, the Office shall invite the proprietor of the Community trade mark to furnish proof of genuine use of the mark, within such period as it may specify. If the proof is not provided within the time limit set, the Community trade mark shall be revoked. Rule 22(2), (3) and (4) shall apply mutatis mutandis.

(6) If the applicant has to furnish proof of use or proof that there are proper reasons for non-use under Article 56(2) or (3) (now Article 57(2) or (3)) of the Regulation, the Office shall invite the applicant to furnish proof of genuine use of the mark, within such period as it may specify. If the proof is not provided within the time limit set, the application for declaration of invalidity shall be rejected. Rule 22(2), (3) and (4) shall apply mutatis mutandis.

Rule 41 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 Community trade mark, the Office may deal with them in one set of proceedings. The Office may subsequently decide no longer to deal with them in this way.

(2) Rule 21(2), (3) and (4) shall apply mutatis mutandis.

TITLE VIII COMMUNITY COLLECTIVE MARKS

Rule 42 Application of provisions

The provisions of these Rules shall apply to Community collective marks, subject to Rule 43.

Rule 43 Regulation governing Community collective marks

(1) Where the application for a Community collective trade mark does not contain the regulations governing its use pursuant to Article 65 (now Article 67) of the Regulation, those regulations shall be submitted to the Office within a period of two months after the date of filing.

(2) The regulations governing Community collective marks shall specify:

- (a) the name of the applicant and his office address;
- (b) the object of the association or the object for which the legal person governed by public law is constituted;
- (c) the bodies authorized to represent the association or the said legal person;
- (d) the conditions for membership;
- (e) the persons authorized to use the mark;
- (f) where appropriate, the conditions governing use of the mark, including sanctions;
- (g) where appropriate, the authorization referred to in the second sentence of Article 65(2) (now Article 67(2)) of the Regulation.

TITLE IX CONVERSION

Rule 44 Application for conversion

(1) An application for conversion of a Community trade mark application or a registered Community trade mark into a national trade mark application pursuant to Article 108 (now Article 112) of the Regulation shall contain:

(a) the name and the address of the applicant for conversion in accordance with Rule 1(1)(b);

(b) the filing number of the Community trade mark application or the registration number of the Community trade mark;

(c) the indication of the ground for conversion in accordance with Article 108(1)(a) or (b) (now Article 112(1)(a) or (b)) of the Regulation;

(d) the 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 and services for which the application has been filed or for which the trade mark has been registered, the application shall contain an indication of the goods and services for which conversion is requested, and, where conversion is requested in respect of more than one Member State and the list of goods and services is not the same for all Member States, an indication of the respective goods and services for each Member State;

(f) where conversion is requested pursuant to Article 108(6) (now Article 112(6)) of the Regulation, the application shall contain the indication of the date on which the decision of the national court has become final, and a copy of that decision; that copy may be submitted in the language in which the decision was given.

(2) The application for conversion shall be filed within the relevant period pursuant to Article 108(4), (5) or (6) (now Article 112(4), (5) or (6)) of the Regulation. Where conversion is requested following a failure to renew the registration, the period of three months provided for in Article 108(5) (now Article 112(5)) of the Regulation shall begin to run on the day following the last day on which the request for renewal can be presented pursuant to Article 47(3) of the Regulation.

Rule 45 Examination of application for conversion

(1) Where the application for conversion does not comply with the requirements of Article 108(1) or (2) (now Article 112(1) or (2)) of

the Regulation or has not been filed within the relevant period of three months or does not comply with Rule 44 or other Rules, the Office shall notify the applicant accordingly and specify a period within which he may amend the application or furnish any missing information or indications.

(2) Where the conversion fee has not been paid within the relevant period of three months, the Office shall inform the applicant that the application for conversion is deemed not to have been filed.

(3) Where the missing indications have not been furnished within the period specified by the Office, the Office shall reject the application for conversion. Where Article 108(2) (now Article 112(2)) of the Regulation applies, the Office shall reject the application for conversion as inadmissible only with respect to those Member States for which conversion is excluded under that provision.

(4) If the Office or a Community trademark court has refused the Community trade mark application or has declared the Community trade mark invalid on absolute grounds by reference to the language of a Member State, conversion shall be excluded under Article 108(2) (now Article 112(2)) of the Regulation for all the Member States in which that language is one of the official languages. If the Office or a Community trade mark court has refused the Community trade mark application or has declared the Community trade mark invalid on absolute grounds which are found to apply in the whole Community or on account of an earlier Community trade mark or other Community industrial property right, conversion is excluded under Article 108(2) (now Article 112(2)) of the Regulation for all Member States.

Rule 46 Publication of application for conversion

(1) Where the application for conversion relates to a Community trade mark application which has already been published in the Community Trade Marks Bulletin pursuant to Article 40 (now Article 39) of the Regulation or where the application for conversion relates to a Community trade mark, the application for conversion shall be published in the Community Trade Marks Bulletin.

(2) The publication of the application for conversion shall contain:
(a) the filing number or the registration number of the trade mark in respect of which conversion is requested;

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

Rule 47 Transmission to central industrial property offices of the Member States

Where the application for conversion complies with the requirements of the Regulation and these Rules, the Office shall transmit the application for conversion and the data referred to in Rule 84(2), to the central industrial property offices of the Member States, including the Benelux Trade Mark Office, for which the application has been found admissible. The Office shall inform the applicant of the date of transmission.

TITLE X APPEALS

Rule 48 Content of the notice of appeal

(1) The notice of appeal shall contain:

- (a) the name and address of the appellant in accordance with Rule 1(1)(b);
- (b) where the appellant has appointed a representative, the name and the business address of the representative in accordance with Rule 1(1)(e);
- (c) a statement identifying the decision which is contested and the extent to which amendment or cancellation of the decision is requested.

(2) The notice of appeal shall be filed in the language of the proceedings in which the decision subject to the appeal was taken.

Rule 49 Rejection of the appeal as inadmissible

(1) If the appeal does not comply with Articles 57, 58 and 59 (now Articles 58, 59 and 60) of the Regulation and Rule 48(1)(c) and (2), the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 59 (now Article 60) of the Regulation has expired.

(2) If the Board of Appeal finds that the appeal does not comply with other provisions of the Regulation or other provisions of these Rules, in particular Rule 48(1)(a) and (b), it shall inform the appellant accordingly and shall request him to remedy the deficiencies noted within such period as it may specify. If the appeal is not corrected in good time, the Board of Appeal shall reject it as inadmissible.

(3) If the fee for appeal has been paid after expiry of the period for the filing of appeal pursuant to Article 59 (now Article 60) of the Regulation, the appeal shall be deemed not to have been filed and the appeal fee shall be refunded to the appellant.

Rule 50 Examination of appeals

(1) Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.

In particular, when the appeal is directed against a decision taken in opposition proceedings, Article 78a (now Article 82) of the Regulation shall not be applicable to the time limits fixed pursuant to Article

61(2) (now Article 63(2)) of the Regulation.

Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74(2) (now Article 76(2)) of the Regulation.

(2) The Board of Appeal's decision shall contain:

- (a) a statement that it is delivered by the Board;
- (b) the date when the decision was taken;
- (c) the names of the Chairman and of the other members of the Board of Appeal taking part;
- (d) the name of the competent employee of the registry;
- (e) the names of the parties and of their representatives;
- (f) a statement of the issues to be decided;
- (g) a summary of the facts;
- (h) the reasons;
- (i) the order of the Board of Appeal, including, where necessary, a decision on costs.

(3) The decision shall be signed by the Chairman and the other members of the Board of Appeal and by the employee of the registry of the Board of Appeal.

Rule 51 Reimbursement of appeal fees

The appeal fee shall only be reimbursed by order of either of the following:

- (a) the department whose decision has been impugned, where it grants revision pursuant to Article 60(1) (now Article 61(1)) or Article 60a (now Article 62) of the Regulation,
- (b) the Board of Appeal, where it allows the appeal and considers such reimbursement equitable by reason of a substantial procedural violation.

TITLE XI GENERAL PROVISIONS

PART A Decisions and communications of the Office

Rule 52 Form of decisions

(1) Decisions of the Office shall be in writing and shall state the reasons on which they are based. Where oral proceedings are held before the Office, the decision may be given orally. Subsequently, the decision in writing shall be notified to the parties.

(2) Decisions of the Office which are open to appeal shall be accompanied by a written communication indicating that notice of appeal must be filed in writing at the Office within two months of the date of notification of the decision from which appeal is to be made. The communications shall also draw the attention of the parties to the provisions laid down in Articles 57, 58 and 59 (now Articles 58, 59 and 60) of the Regulation. The parties may not plead any failure to communicate the availability proceedings.

Rule 53 Correction of errors in decisions

Where the Office becomes aware, of its own motion or at the instance of a party to the proceedings, of a linguistic error, error of transcription or obvious mistake in a decision, it shall ensure that error or mistake is corrected by the department or division responsible.

Rule 53a Revocation of a decision or entry in the Register

(1) Where the Office finds of its own motion or pursuant to corresponding information by the parties to the proceedings that a decision or entry in the Register is subject to revocation pursuant to Article 77a (now Article 80) of the Regulation, it shall inform the party affected about the intended revocation.

(2) The affected party may submit observations on the intended revocation within a period specified by the Office.

(3) Where the affected party agrees to the intended revocation or where he does not submit any observations within the period, the Office shall revoke the decision or entry. If the affected party does not agree to the revocation, the Office shall take a decision on the revocation.

(4) Paragraphs 1, 2 and 3 shall apply mutatis mutandis if the revocation

is likely to affect more than one party. In these 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 under paragraphs 1 to 4 shall lie with the department or unit which took the decision.

Rule 54 Noting of loss of rights

(1) If the Office finds that the loss of any rights results from the Regulation or these Rules without any decision having been taken, it shall communicate this to the person concerned in accordance with Article 77 (now Article 79) of the Regulation, and shall draw his attention to the substance of paragraph 2 of this Rule.

(2) If the person concerned considers that the finding of the Office is inaccurate, he may, within two months after notification of the communication referred to in paragraph 1, apply for a decision on the matter by the Office. Such decision shall be given only if the Office disagrees with the person requesting it; otherwise the Office shall amend its finding and inform the person requesting the decision.

Rule 55 Signature, name, seal

(1) Any decision, communication or notice from the Office shall indicate the department or division of the Office as well as the name or the names of the official or officials responsible. They shall be signed by the official or officials, or, instead of a signature, carry a printed or stamped seal of the Office.

(2) The President of the Office may determine that other means of identifying the department or division of the Office and the name of the official or officials responsible or an identification other than a seal may be used where decisions, communications or notices are transmitted by telecopier or any other technical means of communication.

PART B Oral proceedings and taking of evidence

Rule 56 Summons to oral proceedings

(1) The parties shall be summoned to oral proceedings provided for in Article 75 (now Article 77) of the Regulation and their attention shall be drawn to paragraph 3 of this Rule. At least one month's notice of the summons shall be given unless the parties agree to a shorter period.

(2) When issuing the summons, the Office shall draw attention to the points which in its opinion need to be discussed in order for the decision to be taken.

(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 him.

Rule 57 Taking of evidence by the Office

(1) Where the Office considers it necessary to hear the oral evidence of parties, of witnesses or of experts or to carry out an inspection, it shall take a decision to that end, stating the means by which it intends to obtain evidence, the relevant facts to be proved and the date, time and place of hearing or inspection. If oral evidence of witnesses and experts is requested by a party, the decision of the Office shall determine the period of time within which the party filing the request must make known to the Office the names and addresses of the witnesses and experts whom the party wishes to be heard.

(2) The period of notice given in the summons of a party, witness or expert to give evidence shall be at least one month, unless they agree to a shorter period. The summons shall contain:

(a) an extract from the decision mentioned in paragraph 1, indicating in particular 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 proceedings and particulars of the rights which the witnesses or experts may invoke under Rule 59(2) to (5).

Rule 58 Commissioning of experts

(1) The Office shall decide in what form the report made by an expert

whom it appoints shall be submitted.

(2) The terms of reference of the expert shall include:

- (a) a precise description of his task;
- (b) the time limit laid down for the submission of the expert report;
- (c) the names of the parties to the proceedings;
- (d) particulars of the claims which he may invoke under Rule 59(2), (3) and (4).

(3) A copy of any written report shall be submitted to the parties.

(4) The parties may object to 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 132(1) and (3) (now Article 137(1) and (3)) of the Regulation. The department of the Office concerned shall rule on the objection.

Rule 59 Costs of taking of evidence

(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. An advance for these expenses may be granted to them by the Office. The first sentence shall apply also to witnesses and experts who appear before the Office without being summoned by it and are heard as witnesses or experts.

(3) Witnesses entitled to reimbursement under paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts to fees for their work. These payments shall be made 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 the advances for expenses to be paid pursuant to paragraphs 1, 2 and 3 shall be determined by the President of the Office and shall be published in the Official Journal of the Office. The amounts shall be calculated on the same basis as laid in the Staff Regulations

of the Officials of the European Communities and Annex VII thereto.

(5) Final liability for the amounts due or paid pursuant to paragraphs 1 to 4 shall lie with:

(a) the Office where the Office, at its own initiative, considered it necessary to hear the oral evidence of witnesses or experts; or
(b) the party concerned where that party requested the giving of oral evidence by witnesses or experts, subject to the decision on apportionment and fixing of costs pursuant to Articles 81 and 82 (now Articles 85 and 86) of the Regulation and Rule 94. Such party shall reimburse the Office for any advances duly paid.

Rule 60 Minutes of oral proceedings

(1) Minutes of oral proceedings or the taking of evidence shall be drawn up, containing:

(a) the date of the proceedings,
(b) the names of the competent officials of the Office, the parties, their representatives, and of the witnesses and experts who are present,
(c) the applications 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 Community trade mark application or registration. The parties shall be provided with a copy of the minutes.

(3) Where witnesses, experts or parties are heard in accordance with Article 76(1)(a) or (d) (now Article 78(1)(a) or (d)) of the Regulation or Rule 59(2), their statements shall be recorded.

PART C Notifications

Rule 61 General provisions on notifications

(1) In proceedings before the Office, notifications to be made by the Office shall take the form of transmitting the original document, an uncertified copy thereof or a computer print-out in accordance with Rule 55, or, as concerns documents emanating from the parties themselves, duplicates or uncertified copies.

(2) Notifications shall be made:

(a) by post in accordance with Rule 62;

- (b) by hand delivery in accordance with Rule 63;
- (c) by deposit in a post box at the Office in accordance with Rule 64;
- (d) by telecopier and other technical means in accordance with Rule 65;
- (e) by public notification in accordance with Rule 66.

(3) Where the addressee has indicated his telecopier number or contact details for communicating with him through other technical means, the Office shall have the choice between any of these means of notification and notification by post.

Rule 62 Notification by post

(1) Decisions subject to a time limit for appeal, summonses and other documents as determined by the President of the Office shall be notified by registered letter with advice of delivery. All other notifications shall be by ordinary mail.

(2) Notifications in respect of addresses having neither their domicile nor their principal place of business nor an establishment in the Community and who have not appointed a representative in accordance with Article 88(2) (now Article 92(2)) of the Regulation shall be effected by posting the document requiring notification by ordinary mail to the last address of the addressee known to the Office. (deleted)

(3) Where notification is effected by registered letter, whether or not with advice of delivery, this shall be deemed to be delivered to the addressee on the 10th day following that of its posting, unless the letter has failed to reach the addressee or has reached him 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 registered letter, with or without advice of delivery, shall be deemed to have been effected even if the addressee refuses to accept the letter.

(5) Notification by ordinary mail shall be deemed to have been effected on the tenth day following that of its posting.

Rule 63 Notification by hand delivery

Notification may be effected on the premises of the Office by hand delivery of the document to the addressee, who shall on delivery acknowledge its receipt.

Rule 64 Notification by deposit in a post box at the Office

Notification may also be effected to addressees who have been provided with a post box at the Office, by depositing the document therein. A written notification of deposit shall be inserted in the files. The date of deposit shall be recorded on the document. Notification shall be deemed to have taken place on the fifth day following deposit of the document in the post box at the Office.

Rule 65 Notification by telecopier and other technical means

(1) Notification by telecopier shall be effected by transmitting either the original or a copy, as provided for in Rule 61(1), of the document to be notified. Notification shall be deemed to have been taken place on the date on which the communication was received by the telecopying device of the recipient.

(2) Details of notification by other technical means of communication shall be determined by the President of the Office.

Rule 66 Public notification

(1) If the address of the addressee cannot be established or if after at least one attempt, notification in accordance with Rule 62 has proved impossible, notification shall be effected by public notice.

(2) The President of the Office shall determine how the public notice is to be given and shall fix the beginning of the one month period on the expiry of which the document shall be deemed to have been notified.

Rule 67 Notification to representatives

(1) If a representative has been appointed or where the applicant first named in a common application is considered to be the common representative pursuant to Rule 75(1), notifications shall be addressed to that appointed or common representative.

(2) If several representatives have been appointed for a single interested party, notification to any one of them shall be sufficient, unless a specific address for service has been indicated in accordance

with Rule 1(1)(e).

(3) If several interested parties have appointed a common representative, notification of a single document to the common representative shall be sufficient.

Rule 68 Irregularities in notification

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

Rule 69 Notification of documents in the case of several parties

Documents emanating from parties which contain substantive proposals, or a declaration of withdrawal of a substantive proposal, 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.

PART D Time limits

Rule 70 Calculation of time limits

(1) Periods shall be laid down in terms of full years, months, weeks or days.

(2) Calculation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where that procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.

(3) Where a period is expressed as one year or a certain number of years, it shall expire in 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 said event occurred. Where the relevant month has no day with the same number the period shall expire on the last day of that month.

(4) Where a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day

which has the same number as the day on which the said event occurred. Where the day on which the said event occurred was the last day of a month or where the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

(5) Where a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred.

Rule 71 Duration of time limits

(1) Where the Regulation or these Rules provide for a period to be specified by the Office, such period shall, when the party concerned has its domicile or its principal place of business or an establishment within the Community, be not less than one month, or, when those conditions are not fulfilled, not less than two months, and no more than six months. The Office may, when this is appropriate under the circumstances, grant an extension of a period specified if such extension is requested by the party concerned and the request is submitted before the original period expired.

(2) Where there are two or more parties, the Office may extend a period subject to the agreement of the other parties.

Rule 72 Expiry of time limits in special cases

(1) If 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 mail is not delivered in the locality in which the Office is located, the time limit shall extend until the first day thereafter on which the Office is open for receipt of documents and on which ordinary mail is delivered. The days referred to in the first sentence shall be as determined by the President of the Office before the commencement of each calendar year.

(2) If 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 President of the Office has allowed communications to be sent by electronic means pursuant to Rule 82, on which there is an actual interruption of the Office's connection to these electronic means of communication, the time limit shall extend until the first day following that interruption on which the Office is open for the receipt of documents and on which ordinary

mail is delivered. The duration of the period of interruption shall be determined by the President of the Office.

(3) Paragraphs 1 and 2 shall apply mutatis mutandis to the time limits provided for in the Regulation or these Rules in the case of transactions to be carried out with the competent authority within the meaning of Article 25(1)(b) of the Regulation.

(4) If an exceptional occurrence such as a natural disaster or strike interrupts or dislocates proper communication from the parties to the proceedings to the Office or vice-versa, the President of the Office may determine that for parties of the proceedings having their residence or registered office in the State concerned or who have appointed a representative with a place of business in the State concerned, all time limits that otherwise would expire on or after the date of commencement of such occurrence, as determined by him, shall extend until a date to be determined by him. If the occurrence affects the seat of the Office, such determination of the President shall specify that it applies in respect of all parties to the proceedings.

PART E Interruption of proceedings

Rule 73 Interruption of proceedings

(1) Proceedings before the Office shall be interrupted:

(a) in the event of the death or legal incapacity of the applicant for or proprietor of a Community trade mark or of the person authorized by national law to act on his behalf. To the extent that the above events do not affect the authorization of a representative appointed under Article 89 (now Article 93) of the Regulation, proceedings shall be interrupted only on application by such representative;

(b) in the event of the applicant for or proprietor of a Community trade mark, as a result of some action taken against his property, being prevented for legal reasons from continuing the proceedings before the Office;

(c) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a Community trade mark or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the Office.

(2) When, in the cases referred to in paragraph 1(a) and (b), the Office has been informed of the identity of the person authorized to continue

the proceedings before the Office, the Office shall communicate to such person and to any interested third parties that the proceedings shall be resumed as from a date to be fixed by the Office.

(3) In the case referred to in paragraph 1(c), the proceedings shall be resumed when the Office has been informed of the appointment of a new representative of the applicant or when the Office has notified to the other parties the communication of the appointment of a new representative of the proprietor of the Community trade mark. If, three months after the beginning of the interruption of the proceedings, the Office has not been informed of the appointment of a new representative, it shall inform the applicant for or proprietor of the Community trade mark:

(a) where Article 88(2) (now Article 92(2)) of the Regulation is applicable, that the Community trade mark application will be deemed to be withdrawn if the information is not submitted within two months after this communication is notified; or

(b) where Article 88(2) (now Article 92(2)) of the Regulation is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the Community trade mark as from the date on which this communication is notified.

(4) The time limits, other than the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the Community trade mark at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed.

PART F Waiving of enforced recovery procedures

Rule 74 Waiving of enforced recovery procedures

The President of the Office may waive action for the enforced recovery of any sum due where the sum to be recovered is minimal or where such recovery is too uncertain.

PART G Representation

Rule 75 Appointment of a common representative

(1) If there is more than one applicant and the application for a Community trade mark does not name a common representative, the applicant first named in the application shall be considered to be the common representative. However, if one of the applicants is obliged to appoint

a professional representative, such representative shall be considered to be the common representative unless the applicant named first in the application has appointed a professional representative. The same 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 a Community trade mark.

(2) If, during the course of proceedings, transfer is made to more than one person, and such persons have not appointed a common representative, paragraph 1 shall apply. If such application is not possible, the Office shall require such persons to appoint a common representative within two months. If this request is not complied with, the Office shall appoint the common representative.

Rule 76 Authorizations

(1) Legal practitioners and professional representatives entered on the list maintained by the Office pursuant to Article 89(2) (now Article 93(2)) of the Regulation shall file with the Office a signed authorization for insertion in the files only if the Office expressly requires it, or where there are several parties to the proceedings in which the representative acts before the Office, if the other party expressly asks for it.

(2) Employees acting on behalf of natural or legal persons pursuant to Article 88(3) (now Article 92(3)) of the Regulation shall file with the Office a signed authorization for insertion in the files.

(3) The authorization may be filed in any official language of the Community. It may cover one or more applications or registered trade marks or may be in the form of a general authorization authorizing the representative to act in respect of all proceedings before the Office to which the person giving the authorization is a party.

(4) Where it is required, pursuant to paragraphs 1 or 2, that a signed authorization be filed, the Office shall specify a time limit within which such authorization shall be filed. If the authorization is not filed in due time, proceedings shall be continued with the represented person. Any procedural steps other than the filing of the application taken by the representative shall be deemed not to have been taken if the represented person does not approve them within a period specified by the Office. The application of Article 88(2) (now Article 92(2))

of the Regulation shall remain unaffected.

(5) Paragraphs 1 to 3 shall apply mutatis mutandis to a document withdrawing an authorization.

(6) Any representative who has ceased to be authorized shall continue to be regarded as the representative until the termination of his authorization has been communicated to the Office.

(7) Subject to any provisions to the contrary contained therein, an authorization shall not terminate vis-à-vis the Office upon the death of the person who gave it.

(8) 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 Rule 1(1)(e). Where a representative acts before the Office who has already been appointed, he shall indicate his name and preferably the identification number attributed to him by the Office. Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorizations, act either jointly or singly.

(9) The appointment or authorization of an association of representatives shall be deemed to be an appointment or authorization of any representative who practices within that association.

Rule 77 Representation

Any notification or other communication addressed by the Office to the duly authorized representative shall have the same effect as if it had been addressed to the represented person. Any communication addressed to the Office by the duly authorized representative shall have the same effect as if it originated from the represented person.

Rule 78 Amendment of the list of professional representatives

(1) The entry of a professional representative in the list of professional representatives, as referred to in Article 89 (now Article 93) of the Regulation, shall be deleted at his request.

(2) 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 a Member State, unless the President of the Office has granted an exemption under Article 89(4)(b) (now Article 93(4)(b)) of the Regulation;

(c) where the professional representative no longer has his place of business or employment in the Community;

(d) where the professional representative no longer possesses the entitlement referred to in the first sentence of Article 89(2)(c) (now Article 93(2)(c)) of the Regulation.

(3) The entry of a professional representative shall be suspended of the Office's own motion where his entitlement to represent natural or legal persons before the central industrial property office of the Member State as referred to in the first sentence of Article 89(2)(c) (now Article 93(2)(c)) has been suspended.

(4) A person whose entry has been deleted shall, upon request pursuant to Article 89(3) (now Article 93(3)) of the Regulation, be reinstated in the list of professional representatives if the conditions for deletion no longer exist.

(5) The Benelux Trade Mark Office and the central industrial property offices of the Member States concerned shall, where they are aware thereof, promptly inform the Office of any relevant events under paragraphs 2 and 3.

(6) The amendments of the list of professional representatives shall be published in the Official Journal of the Office.

PART H Written communications and forms

Rule 79 Communication in writing or by other means

Applications for the registration of a Community trade mark as well as any other application provided for in the Regulation and all other communications addressed to the Office shall be submitted as follows:

(a) by submitting a signed original of the document in question at the Office, such as by post, personal delivery, or by any other means;

(b) by transmitting a document by telecopier in accordance with Rule 80;

(c) (deleted)

(d) by transmitting the contents of the communication by electronic means in accordance with Rule 82.

Rule 79a Annexes to written communications

Where a document or an item of evidence is submitted in accordance with Rule 79 point (a) by a party in a proceeding before the Office involving more than one party to the proceedings, the document or item of evidence, as well as any annex to the document, shall be submitted in as many copies as the number of parties to the proceedings.

Rule 80 Communication by telecopier

(1) Where an application for a Community trade mark is submitted to the Office by telecopier and the application contains a reproduction of the mark pursuant to Rule 3(2) which does not satisfy the requirements of that Rule, the required reproduction suitable for publication shall be submitted to the Office in accordance with Rule 79(a). Where the reproduction is received by the Office within a period of one month from the date of receipt of the telecopy, the reproduction shall be deemed to have been received by the Office on the date on which the telecopy was received.

(2) Where a communication received by telecopier 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 him, within a period to be specified by the Office, to retransmit the original by telecopy or to submit the original in accordance with Rule 79(a). Where this request is complied with within the period specified, the date of the receipt of the retransmission or of the original shall be deemed to be the date of the receipt of the original communication, provided that 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.

(3) Any communication submitted to the Office by telecopier shall be considered to be duly signed if the reproduction of the signature appears on the printout produced by the telecopier. Where the communication has been sent by telecopier electronically, the indication of the name of the sender shall be equivalent to the signature.

(4) [deleted]

Rule 81 [deleted]

Rule 82 Communication by electronic means

(1) The President of the Office shall determine whether, to what extent and under what technical conditions communications may be sent to the Office by electronic means.

(2) Where a communication is sent by electronic means, Rule 80(2) shall apply mutatis mutandis.

(3) Where a communication is sent to the Office by electronic means, the indication of the name of the sender shall be deemed to be equivalent to the signature.

(4) (deleted)

Rule 83 Forms

(1) The Office shall make available to the public free of charge forms for the purposes of:

(a) filing an application for a Community trade mark, including where appropriate a request for the search report;

(b) entering an opposition;

(c) applying for revocation or declaration of invalidity;

(d) applying for the registration of a transfer and the transfer form and transfer document provided for in Rule 31(5);

(e) applying for the registration of a licence;

(f) applying for the renewal of a Community trade mark;

(g) making an appeal;

(h) authorizing a representative, in the form of an individual authorization or a general authorisation;

(i) submitting an international application or a subsequent designation under the Madrid Protocol 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;

(b) with the exception of the form referred to in point (i) of paragraph 1, forms with the same content and format.

(3) The Office shall make available the forms referred to in paragraphs (1) in all the official languages for the Community.

PART I Information of the public

Rule 84 Register of Community Trade Marks

(1) The Register of Community Trade Marks may be maintained in the form of an electronic database.

(2) The Register of Community Trade Marks shall contain the following entries:

- (a) the date of filing the application;
- (b) the file number of the application;
- (c) the date of the publication of the application;
- (d) the name and address of the applicant;
- (e) the name and business address of the representative, other than a representative falling within the first sentence of Article 88(3) (now Article 92(3)) of the Regulation; where there is more than one representative, only the name and business address of the first named representative, followed by the words 'and others', shall be recorded; where an association of representatives is appointed, only the name and address of the association shall be recorded;
- (f) the reproduction of the mark, with indications as to its nature, unless it is a mark falling under Rule 3(1); where the registration of the mark is in colour, the indication 'in colour' with an indication of the colour or colours making up the mark; where applicable, a description of the mark;
- (g) an indication of the goods and services by their names, grouped according to the classes of the Nice Classification; each group shall be preceded by the number of the class of that classification to which that group of goods and services belongs and shall be presented in the order of the classes of that classification;
- (h) particulars of claims of priority pursuant to Article 30 of the Regulation;
- (i) particulars of claims of exhibition priority pursuant to Article 33 of the Regulation;
- (j) particulars of claims of seniority of an earlier registered trade mark as referred to in Article 34 of the Regulation;
- (k) a statement that the mark has become distinctive in consequence of the use which has been made of it, pursuant to Article 7(3) of the Regulation;

(l) a declaration by the applicant disclaiming any exclusive right to some element of the mark pursuant to Article 38(2) (now Article 37(2)) of the Regulation;

(m) an indication that the mark is a collective mark;

(n) the language in which the application was filed and the second language which the applicant has indicated in his application, pursuant to Article 115(3) (now Article 119(3)) of the Regulation;

(o) the date of registration of the mark in the Register and the registration number.

(p) a statement that the application results from a transformation of an international registration designating the European Community pursuant to Article 156 (now Article 161) of the Regulation, 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 European Community made subsequently to the international registration pursuant to Article 3 ter (2) of the Madrid Protocol was recorded and, where applicable, the date of priority of the international registration.

(3) The Register of Community Trade Marks shall also contain the following entries, each accompanied by the date of recording of such entry:

(a) changes in the name, the address or the nationality of the proprietor of a Community trade mark or in the State in which he is domiciled or has his seat or establishment;

(b) changes in the name or business address of the representative, other than a representative falling within Article 88(3) (now Article 92(3)), first sentence, of the Regulation;

(c) when a new representative is appointed, the name and business address of that representative;

(d) alterations of the mark pursuant to Article 48 of the Regulation and corrections of mistakes and errors;

(e) notice of amendments to the regulations governing the use of the collective mark pursuant to Article 69 (now Article 71) of the Regulation;

(f) particulars of claims of seniority of an earlier registered trade mark as referred to in Article 34 of the Regulation, pursuant to Article 35 of the Regulation;

(g) total or partial transfers pursuant to Article 17 of the Regulation;

(h) the creation or transfer of a right in rem pursuant to Article 19 of the Regulation and the nature of the right in rem;

(i) levy of execution pursuant to Article 20 of the Regulation and insolvency proceedings pursuant to Article 21 of the Regulation;

(j) the grant or transfer of a licence pursuant to Article 22 of the Regulation and, where applicable, the type of licence pursuant to Rule 34;

(k) renewal of the registration pursuant to Article 47 of the Regulation, the date from which it takes effect and any restrictions pursuant to Article 47(4) of the Regulation;

(l) a record of the determination of the expiry of the registration pursuant to Article 47 of the Regulation;

(m) a declaration of surrender by the proprietor of the mark pursuant to Article 49 (now Article 50) of the Regulation;

(n) the date of submission of an application pursuant to Article 55 (now Article 56) of the Regulation or of the filing of a counterclaim pursuant to Article 96(4) (now Article 100(4)) of the Regulation for revocation or for a declaration of invalidity;

(o) the date and content of the decision on the application or counterclaim pursuant to Article 56(6) (now Article 57(6)) or the third sentence of Article 96(6) (now Article 100(6)) of the Regulation;

(p) a record of the receipt of a request for conversion pursuant to Article 109(2) (now Article 113(2)) of the Regulation;

(q) the cancellation of the representative recorded pursuant to paragraph 2(e);

(r) the cancellation of the seniority of a national mark;

(s) the modification or cancellation from the Register of the items referred to in subparagraphs (h), (i) and (j).

(t) the replacement of the Community trade mark by an international registration pursuant to Article 152 (now Article 157) of the Regulation;

(u) the date and number of an international registration based on the Community trademark application which has been registered as a Community trade mark pursuant to Article 143(1) (now Article 148(1)) of the Regulation;

(v) the date and number of an international registration based on the Community trade mark pursuant to Article 143(2) (now Article 148(2)) of the Regulation;

(w) the division of a registration pursuant to Article 48a (now Article 49) of the Regulation and Rule 25a, together with the items referred to in paragraph 2 in respect of the divisional registration, as well as the list of goods and services of the original registration as amended;

(x) the revocation of a decision or an entry in the Register pursuant to Article 77a (now Article 80) of the Regulation, where the revocation

concerns a decision or entry which has been published.

(4) The President of the Office may determine that items other than those referred to in paragraphs 2 and 3 shall be entered in the Register.

(5) The proprietor of the trade mark shall be notified of any change in the Register.

(6) The Office shall provide certified or uncertified extracts from the Register on request, on payment of a fee.

PART J Community Trade Marks Bulletin and Official Journal of the Office

Rule 85 Community Trade Marks Bulletin

(1) The Community Trade Marks Bulletin shall be published in the manner and frequency determined by the President of the Office.

(2) The Community Trade Marks Bulletin shall contain publications of applications and of entries made in the Register as well as other particulars relating to applications or registrations of trade marks whose publication is prescribed by the Regulation or by these Rules.

(3) Where particulars whose publication is prescribed in the Regulation or in these Rules are published in the Community Trade Marks Bulletin, the date of issue shown on the Bulletin shall be taken as the date of publication of the particulars.

(4) 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.

(5) The elements of the application for a Community trade mark, as set out in Article 26(1) of the Regulation as well as any other information the publication of which is prescribed in Rule 12 shall, where appropriate, be published in all the official languages of the Community.

(6) The Office shall take into account any translation submitted by the applicant. If the language of the application is not one of the languages of the Office, the translation into the second language

indicated by the applicant shall be communicated to the applicant. The applicant may propose changes to the translation within a period to be specified by the Office. If the applicant does not respond within this period or if the Office considers the proposed changes to be inappropriate, the translation proposed by the Office shall be published.

Rule 86 Official Journal of the Office

(1) The Official Journal of the Office shall be published in periodic editions. The Office may make available to the public editions of the Official Journal on CD-ROM or in any other machine-readable form.

(2) The Official Journal shall be published in the languages of the Office. The President of the Office may determine that certain items shall be published in all the official languages of the Community.

Rule 87 Data bank

(1) The Office shall maintain an electronic data bank with the particulars of applications for registration of trade marks and entries in the Register. The Office may also make available the contents of this data bank on CD-ROM or in any other machine-readable form.

(2) The President of the Office shall determine the conditions of access to the data bank and the manner in which the contents of this data bank may be made available in machine-readable form, including the charges for these acts.

PART K Inspection of files and keeping of files

Rule 88 Parts of the file excluded from inspection

The parts of the file which shall be excluded from inspection pursuant to Article 84(4) (now Article 88(4)) of the Regulation shall be:

- (a) documents relating to exclusion or objection pursuant to Article 132 (now Article 137) of the Regulation;
- (b) draft decisions and opinions, and all other internal documents used for the preparation of decisions and opinions;
- (c) parts of the file which the party concerned showed a special interest in keeping confidential before the application for inspection of the files was made, unless inspection of such part of the file is justified by overriding legitimate interests of the party seeking inspection.

Rule 89 Procedures for the inspection of files

(1) Inspection of the files of Community trade mark applications and of registered Community trade marks shall either be of the original document, or of copies thereof, or of technical means of storage if the files are stored in this way. The means of inspection shall be determined by the President of the Office. Where inspection takes place as provided for in paragraphs 3, 4 and 5, the request for inspection of the files shall not be deemed to have been made until the required fee has been paid. No fee is payable if inspection of technical means of storage takes place online.

(2) Where inspection of the files of a Community trade mark application which has not yet been published pursuant to Article 40 (now Article 39) of the Regulation is requested, the request shall contain an indication and evidence to the effect that the applicant has consented to the inspection or has stated that after the trade mark has been registered he will invoke the rights under it against the party requesting the inspection.

(3) Inspection of the files shall take place on the premises of the Office.

(4) On request, inspection of the files shall be effected by means of issuing copies of file documents. Such copies shall incur fees.

(5) The Office shall issue on request certified or uncertified copies of the application for a Community trade mark or of those file documents of which copies may be issued pursuant to paragraph 4 upon payment of a fee.

(6) The files kept by the Office relating to international registrations designating the European Community may be inspected on request as from the date of publication referred to in Article 147(1) (now Article 152(1)) of the Regulation, under the conditions laid down in paragraphs (1), (3) and (4) and subject to Rule 88.

Rule 90 Communication of information contained in the files

Subject to the restrictions provided for in Article 84 (now Article 88) of the Regulation and Rule 88, the Office may, upon request, communicate information from any file of a Community trade mark applied for or of a registered Community trade mark, subject to payment of

a fee. However, the Office may require the exercise of the option to obtain inspection of the file itself should it deem this to be appropriate in view of the quantity of information to be supplied.

Rule 91 Keeping of files

(1) The President of the Office shall determine the form in which the files shall be kept.

(2) Where files are kept electronically, these electronic files, or back-up copies thereof, shall be kept without time limitation. The original documents filed by parties to the proceedings which form the basis of such electronic files shall be disposed of after a period following their reception by the Office, which shall be determined by the President of the Office.

(3) Where and to the extent that files or parts of the files are kept in any other form than electronically, documents or items of evidence constituting part of such files shall be kept for at least five years from the end of the year in which any of the following occurrences takes place:

- (a) the application is rejected or withdrawn or is deemed to be withdrawn;
- (b) the registration of the Community trade mark expires completely pursuant to Article 47 of the Regulation;
- (c) the complete surrender of the Community trade mark is registered pursuant to Article 49 (now Article 50) of the Regulation;
- (d) the Community trade mark is completely removed from the Register pursuant to Article 56(6) (now Article 57(6)) or Article 96(6) (now Article 100(6)) of the Regulation.

PART L Administrative cooperation

Rule 92 Exchange of information and communications between the Office and the authorities of the Member States

(1) The Office and the central industrial property offices of the Member States shall, upon request, communicate to each other relevant information about the filing of applications for Community trade marks or national marks and about proceedings relating to such applications and the marks registered as a result thereof. Such communications shall not be subject to the restrictions provided for in Article 84 (now Article 88) of the Regulation.

(2) Communications between the Office and the courts or authorities of the Member States which arise out of the application of the Regulation or these Rules shall be effected directly between these authorities. Such communication may also be effected 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, which shall be exempt from fees.

Rule 93 Inspection of files by or via courts or authorities of the Member States

(1) Inspection of files relating to Community trade marks applied for or registered Community trade marks by courts or authorities of the Member States shall be of the original documents or of copies thereof, otherwise Rule 89 shall not apply.

(2) Courts or Public Prosecutors' Offices of the Member States may, in the course of proceedings before them, open files or copies thereof transmitted by the Office to inspection by third parties. Such inspection shall be subject to Article 84 (now Article 88) of the Regulation. The Office shall not charge any fee for such inspection.

(3) The Office shall, at the time of transmission of the files or copies thereof to the courts or Public Prosecutors' Offices of the Member States, indicate the restrictions to which the inspection of files relating to Community trade marks applied for or registered Community trade marks is subject pursuant to Article 84 (now Article 88) of the Regulation and Rule 88.

PART M Costs

Rule 94 Apportionment and fixing of costs

(1) Apportionment of costs pursuant to Article 81(1) and (2) (now Article 85(1) and (2)) of the Regulation shall be dealt with in the decision on the opposition, the decision on the application for revocation or for a declaration of invalidity of a Community trade mark, or the decision on the appeal.

(2) Apportionment of costs pursuant to Article 81(3) and (4) (now Article 85(3) and (4)) of the Regulation shall be dealt with in a decision

on costs by the Opposition Division, the Cancellation Division or the Board of Appeal.

(3) Where the amount of the costs has not been fixed pursuant to Article 81(6) (now Article 85(6)), first sentence, of the Regulation, the request for the fixing of costs shall be accompanied by a bill and supporting evidence. For the costs of representation referred to in paragraph 7(d) of this Rule, an assurance by the representative that the costs have been incurred shall be sufficient. For other costs, it shall be sufficient if their plausibility is established. Where the amount of the costs is fixed pursuant to Article 81(6) (now Article 85(6)), first sentence, of the Regulation, representation costs shall be awarded at the level laid down in paragraph 7(d) of this Rule and irrespective of whether they have been actually incurred.

(4) The request provided for in the third sentence of Article 81(6) (now Article 85(6)) of the Regulation for a review of the decision of the registry on the fixing of costs, stating the reasons on which it is based, must be filed at the Office within one month after the date of notification of the awarding of costs. It shall not be deemed to be filed until the fee for reviewing the amount of the costs has been paid.

(5) The Opposition Division, the Cancellation Division or the Board of Appeal, as the case may be, shall take a decision on the request referred to in paragraph 4 without oral proceedings.

(6) The fees to be borne by the losing party pursuant to Article 81(1) (now Article 85(1)) of the Regulation shall be limited to the fees incurred by the other party for opposition, for an application for revocation or for a declaration of invalidity of the Community trade mark and for appeal.

(7) Subject to paragraph 3 of this Rule, costs essential to the proceedings and actually incurred by the successful party shall be borne by the losing party in accordance with Article 81(1) (now Article 85(1)) of the Regulation on the basis of the following maximum rates:

(a) where the party is not represented by a representative, travel and subsistence expenses of one 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 Rule 56,

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;
- (ii) the cost of the tourist-class air-fare where the total distance by rail exceeds 800 km or the route includes a sea-crossing;
- (iii) subsistence expenses as laid down in Article 13 of Annex VII to the Staff Regulations of Officials of the European Communities;
- (b) travel expenses of representatives within the meaning of Article 89(1) (now Article 93(1)) of the Regulation, at the rates provided for in point (a)(i) and (ii) of this Rule;
- (c) travel expenses, subsistence expenses, compensation for loss of earnings and fees to which witnesses and experts are entitled to be reimbursed pursuant to Rule 59(2), (3) or (4), to the extent that final liability lies with a party to the proceedings pursuant to Rule 59(5)(b);
- (d) cost of representation, within the meaning of Article 89(1) (now Article 93(1)) of the Regulation,
 - (i) of the opposing party in opposition proceedings:
300 euro;
 - (ii) of the applicant in opposition proceedings:
300 euro;
 - (iii) of the applicant in proceedings relating to revocation or invalidity of a Community trade mark:
450 euro;
 - (iv) of the proprietor of the trade mark in proceedings relating to revocation or invalidity of a Community trade mark:
450 euro;
 - (v) of the appellant in appeal proceedings:
550 euro;
 - (vi) of the defendant in appeal proceedings:
550 euro;
 - (vii) where an oral proceedings have taken place to which the parties have been summoned pursuant to Rule 56, the amount referred to in the points (i) to (vi) shall be incremented by 400 euro;
- (e) where there are several applicants or proprietors of the Community 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 point (a) for one such person only;
- (f) where the successful party is represented by more than one representative within the meaning of Article 89(1) (now Article 93(1))

of the Regulation, the losing party shall bear the costs referred to in points (b) and (d) of this Rule for one such person only;
(g) the losing party shall not be obliged to reimburse the successful party for any costs, expenses and fees other than those referred to in points (a) to (f).

PART N Languages

Rule 95 Applications and declarations

Without prejudice to Article 115(5) (now Article 119(5)) of the Regulation,

(a) any application or declaration relating to a Community trade mark application may be filed in the language used for filing the application for a Community trade mark or in the second language indicated by the applicant in his application;

(b) any application or declaration relating to a registered Community trade mark may be filed in one of the languages of the Office. However, when the application is filed by using any of the forms provided by the Office pursuant to Rule 83, such forms may be used in any of the official languages of the Community, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

Rule 96 Written proceedings

(1) Without prejudice to Article 115(4) and (7) (now Article 119(4) and (7)) of the Regulation, and unless otherwise provided for in these Rules, in written proceedings before the Office any party may use any language of the Office. If the language chosen is not the language of the proceedings, the party shall supply a translation into that language within one month from the date of the submission of the original document. Where the applicant for a Community trade mark is the sole party to proceedings before the Office and the language used for the filing of the application for the Community trade mark is not one of the languages of the Office, the translation may also be filed in the second language indicated by the applicant in his application.

(2) Unless otherwise provided for in these Rules, documents to be used in proceedings before the Office may be filed in any official language of the Community. 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 or, at the choice

of the party to the proceeding, in any language of the Office.

Rule 97 Oral proceedings

(1) Any party to oral proceedings before the Office may, in place of the language of proceedings, use one of the other official languages of the Community, on condition that he makes provision for interpretation into the language of proceedings. Where the oral proceedings are held in a proceeding concerning the application for registration of a trade mark, the applicant may use either the language of the application or the second language indicated by him.

(2) In oral proceedings concerning the application for registration of a trade mark, the staff of the Office may use either the language of the application or the second language indicated by the applicant. In all other oral proceedings, the staff of the Office may use, in place of the language of the proceedings, one of the other languages of the Office, on condition that the party or parties to the proceedings agree to such use.

(3) In the case of taking of evidence, any party to be heard, witness or expert who is unable to express himself adequately in the language of proceedings, may use any of the official languages of the Community. Should the taking of evidence be decided upon following a request by a party to the proceedings, parties to be heard, witnesses or experts who express themselves in languages other than the language of proceedings may be heard only if the party who made the request makes provision for interpretation into that language. In proceedings concerning the application for registration of a trade mark, in place of the language of the application, the second language indicated by the applicant may be used. In any proceedings with only one party the Office may on request of the party concerned permit derogations from the provisions in this paragraph.

(4) If the parties and Office so agree, any official language of the Community may be used in oral proceedings.

(5) The Office shall, if necessary, make provision at its own expense for interpretation into the language of proceedings, or, where appropriate, into its other languages, unless this interpretation is the responsibility of one of the parties to the proceedings.

(6) Statements by staff of the Office, by parties to the proceedings and by witnesses and experts, made in one of the languages of the Office during oral proceedings shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the language of proceedings. Amendments to the text of the application for or the registration of a Community trade mark shall be entered in the minutes in the language of proceedings.

Rule 98 Translations

(1) When a translation of a document is to be filed, the translation shall identify the document to which it refers and reproduce the structure and contents of the original document. The Office may require the filing, within a period to be specified by it, of a certificate that the translation corresponds to the original text. The President of the Office shall determine the manner in which translations shall be certified.

(2) Save where the Regulation or these Rules provide otherwise, a document for which a translation is to be filed shall be deemed not to have been received by the Office

(a) where the translation is received by the Office after expiry of the relevant period for submitting the original document or the translation;

(b) in the case of paragraph 1, where the certificate is not filed within the period specified.

Rule 99 Legal authenticity of translations

In the absence of evidence to the contrary, the Office may assume that a translation corresponds to the relevant original text.

PART O Organization of the Office

Rule 100 Decisions taken by a single member

(1) The cases in which pursuant to Article 127(2) (now Article 132(2)), or Article 129(2) (now Article 134(2)), of the Regulation a single member of the Opposition Division or of the Cancellation Division may take a decision shall be the following:

(a) decisions on the apportionment of costs;

(b) decisions to fix the amount of the costs to be paid pursuant to Article 81(6) (now Article 85(6)), first sentence, of the Regulation;

(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 Rule 18(1),
- (e) decisions to stay proceedings;
- (f) decisions to join or separate multiple oppositions pursuant to Rule 21(1).

TITLE XII RECIPROCITY

Rule 101 Publication of reciprocity

(1) If necessary, the President of the Office shall request the Commission to enquire whether a State which is not party to the Paris Convention or to the Agreement establishing the World Trade Organization accords reciprocal treatment within the meaning of Article 29(5) of the Regulation.

(2) If the Commission determines that reciprocal treatment in accordance with paragraph 1 is accorded, it shall publish a communication to this effect in the Official Journal of the European Union.

(3) Article 29(5) of the Regulation shall apply from the date of publication in the Official Journal of the European Union of the communication referred to in paragraph 2, unless the communication states an earlier date from which it is applicable. It shall cease to apply from the date of publication in the Official Journal of the European Union of a communication of the Commission to the effect that reciprocal treatment is no longer accorded, unless the communication states an earlier date from which it is applicable.

(4) Communications referred to in paragraphs 2 and 3 shall also be published in the Official Journal of the Office.

TITLE XIII PROCEDURES CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

PART A International registration on the basis of applications for a Community trade mark and of Community trade marks

Rule 102 Filing of an international application

(1) The form provided by the Office for the filing of an international application, as referred to in Article 142(1) (now Article 147(1)) of the Regulation, shall be an adaptation of the official form provided by the International Bureau of the World Intellectual Property Organisation (hereinafter "the International Bureau") having the same format but including such additional indications and elements as are required or may be appropriate pursuant to these Rules. Applicants may also use the official form provided by the International Bureau.

(2) Paragraph 1 shall apply mutatis mutandis for the form for a request for territorial extension subsequent to the international registration pursuant to Article 144 (now Article 149) of the Regulation.

(3) The Office shall inform the applicant filing the international application of the date on which the documents making up the international application are received by the Office.

(4) Where the international application is filed in an official language of the European Community other than a language allowed under the Madrid Protocol for the filing of an international application and where the international application does not contain, or is not accompanied by, a translation of the list of goods and services and of any other text matter forming part of the international application in the language in which the application is to be submitted to the International Bureau pursuant to Article 142(2) (now Article 147(2)) of the Regulation, the applicant shall authorise the Office to include in the international application a translation of the said list of goods and services and other text matter in the language in which the application is to be submitted to the International Bureau pursuant to Article 142(2) (now Article 147(2)) of the Regulation. Where the translation has not yet been established in the course of the registration procedure for the Community trade mark application on which the international application is based, the Office shall without delay arrange for the translation.

Rule 103 Examination of international applications

(1) Where the Office receives an international application and the fee referred to in Article 142(5) (now Article 147(5)) of the Regulation for the international application has not been paid, the Office shall inform the applicant that the international application will be deemed not to have been filed until the fee has been paid.

(2) Where the examination of the international application reveals any of the following deficiencies, the Office shall invite the applicant to remedy those deficiencies within such period as it may specify:

(a) the international application is not filed on one of the forms referred to in Rule 102(1), and does not contain all the indications and information required by that form;

(b) the list of goods and services contained in the international application is not covered by the list of goods and services appearing in the basic Community trade mark application or basic Community trade mark;

(c) the mark which is subject to the international application is not identical to the mark as appearing in the basic Community trade mark application or basic Community trade mark;

(d) any indication in the international application as to the mark, other than a disclaimer pursuant to Article 38(2) (now Article 37(2)) of the Regulation or a colour claim, does not also appear in the basic Community trade mark application or basic Community trade mark;

(e) if colour is claimed in the international application as a distinctive feature of the mark, the basic Community trade mark application or basic Community trade mark is not in the same colour or colours; or

(f) according to the indications made in the international form, the applicant is not eligible to file an international application through the Office in accordance with Article 2(1)(ii) of the Madrid Protocol,

(3) Where the applicant has failed to authorise the Office to include a translation as provided for in Rule 102(4), or where it is otherwise unclear on which list of goods and services the international application shall be based, the Office shall invite the applicant to make the required indications within such a period as it may specify.

(4) If the deficiencies referred to in paragraph 2 are not remedied or the required indications referred to in paragraph 3 are not made within the time limit fixed by the Office, the Office will take a decision

refusing to forward the international application to the International Bureau.

Rule 104 Forwarding of the international application

The Office shall forward the international application to the International Bureau along with the certification provided for under Article 3(1) of the Madrid Protocol as soon as the international application meets the requirements laid down in Rules 102 and 103 as well as in Articles 141 and 142 (now Articles 146 and 147) of the Regulation.

Rule 105 Subsequent designations

(1) The Office shall invite the applicant requesting the territorial extension made subsequently to remedy the deficiencies noted within such time-limit as it may specify, where a request for territorial extension made subsequently to the international registration, as referred to in Article 144 (now Article 149) of the Regulation, is filed at the Office, and where the Office finds that:

- (a) the request for territorial extension is not filed on one of the forms referred to in Rule 102(1) and (2) and does not contain all the indications and information required by that form;
- (b) the request for territorial extension does not indicate the number of the international registration to which it relates;
- (c) the list of goods and services is not covered by the list of goods and services contained in the international registration; or
- (d) according to the indications made in the international form, the applicant requesting the territorial extension is not entitled to make a designation subsequent to the international registration through the Office in accordance with Articles 2(1)(ii), and Article 3 ter(2) of the Madrid Protocol.

(2) If the deficiencies referred to in paragraph 1 are not remedied within the time limit fixed by the Office, the Office will take a decision refusing to forward the request for territorial extension made subsequently to the international registration to the International Bureau.

(3) The Office shall inform the applicant requesting the territorial extension of the date on which the request for territorial extension is received by the Office.

(4) The Office shall forward the request for territorial extension made subsequently to the international registration to the International Bureau as soon as the deficiencies referred to in paragraph 1 of this Article have been remedied and the requirements of Article 144 (now Article 149) of the Regulation are complied with.

Rule 106 Dependence of the international registration on the basic application or registration

(1) The Office shall notify the International Bureau where, within a period of five years from the date of the international registration, (a) the Community 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) the Community 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 Community trade mark court;

(c) the Community trade mark application or the Community 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 and services, those goods and services, or the goods and services which are not affected;

(f) in the case referred to in paragraph 1(c), the number of each Community trade mark application or registration concerned.

(3) The Office shall notify the International Bureau where, at the end of a period of five years from the date of the international registration,

(a) an appeal is pending against a decision of an examiner to refuse the Community trade mark application on which the international

registration was based pursuant to Article 38 (now Article 37) of the Regulation;

(b) an opposition is pending against the Community trademark application on which the international registration was based;

(c) an application for revocation or an application for declaration of invalidity is pending against the Community trade mark on which the international registration was based;

(d) mention has been made in the Register of Community Trade Marks that a counterclaim for revocation or for declaration of invalidity has been filed before a Community trade mark court against the Community trade mark on which the international registration was based, but no mention has yet been made in the Register of the decision of the Community 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 accordingly with paragraph 2.

(5) Any reference in paragraphs 1 and 3 to a Community trade mark on which the international registration was based shall include a Community trade mark registration resulting from a Community trade mark application on which the international application was based.

Rule 107 Renewals

The international registration shall be renewed directly at the International Bureau.

PART B International registrations designating the European Community

Rule 108 Seniority claimed in an international application

(1) Where the seniority of one or more earlier registered trade marks, as referred to in Article 34 of the Regulation, has been claimed in an international application pursuant to Article 148(1) (now Article 153(1)) of the Regulation, the applicant shall, within three months from the date on which the International Bureau notifies the international registration to the Office, submit a copy of the relevant registration to the Office. The copy must be certified by the competent authority to be an exact copy of the relevant registration.

(2) Where the holder of the international registration is obliged to be represented in proceedings before the Office pursuant to Article

88(2) (now Article 92(2)) of the Regulation, the communication as referred to in paragraph 1 shall contain the appointment of a representative within the meaning of Article 89(1) (now Article 93(1)) of the Regulation.

(3) The President of the Office may determine that the evidence to be provided by the applicant may consist of less than is required under paragraph 1, provided that the information required is available to the Office from other sources.

Rule 109 Examination of seniority claims

(1) Where the Office finds that the seniority claim under Rule 108(1) does not comply with Article 34 of the Regulation, or does not comply with the other requirements of Rule 108, it shall invite the applicant to remedy the deficiencies within such period as it may specify.

(2) If the requirements referred to in paragraph 1 are not satisfied within the time limit, the right of seniority in respect of that international registration shall be lost. If the deficiencies concern only some of the goods and services, the right of seniority shall be lost only in so far as those goods and services are concerned.

(3) The Office shall inform the International Bureau of any declaration of a loss of the right of seniority pursuant to paragraph 2. It shall also inform the International Bureau of any withdrawal or restriction of the seniority claim.

(4) The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the claiming of seniority, unless the right of seniority is declared lost pursuant to paragraph 2.

Rule 110 Seniority claimed before the Office

(1) The holder of an international registration designating the European Community may claim, directly before the Office, the seniority of one or more earlier registered trade marks as referred to in Article 35 of the Regulation as from the date on which the Office has, pursuant to Article 147(2) (now Article 152(2)) of the Regulation, published the fact that no refusal for protection of the international registration designating the European Community has been notified or if any such refusal has been withdrawn, as provided for in Article 148(2) (now

Article 153(2)) of the Regulation.

(2) Where seniority is claimed before the Office before the date referred to in paragraph 1, the seniority claim shall be deemed to have been received by the Office on the date referred to in paragraph 1.

(3) An application to claim seniority pursuant to Article 148(2) (now Article 153(2)) of the Regulation and paragraph 1 shall contain:

(a) an indication that the seniority claim is made for an international registration under the Madrid Protocol;

(b) the registration number of the international registration;

(c) the name and address of the holder of the international registration in accordance with Rule 1(1)(b);

(d) where the holder has appointed a representative, the name and the business address of the representative in accordance with Rule 1(1)(e);

(e) an indication of the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the earlier mark is registered;

(f) where seniority is claimed for less than all the goods and services contained in the earlier registration, the indication of the goods and services in respect of which seniority is claimed;

(g) a copy of the relevant registration; certified by the competent authority as being an exact copy;

(h) where the holder of the international registration is obliged to be represented in proceedings before the Office pursuant to Article 88(2) (now Article 92(2)) of the Regulation, the appointment of a representative within the meaning of Article 89(1) (now Article 93(1)) of the Regulation.

(4) If the requirements governing the claiming of seniority referred to in paragraph 3 are not fulfilled, the Office shall invite the holder of the international registration to remedy the deficiencies. If the deficiencies are not remedied within a period specified by the Office, the Office shall reject the application.

(5) Where the Office has accepted the application to claim seniority, it shall inform the International Bureau accordingly by communicating

(a) the number of the international registration concerned,

(b) the name of the Member state or Member States in or for which the earlier mark is registered,

- (c) the number of the relevant registration, and
- (d) the date from which the relevant registration was effective.

(6) The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the application to claim seniority once it has been accepted by the Office.

(7) The President of the Office may determine that the evidence to be provided by the holder of the international registration may consist of less than is required under paragraph 3(g), provided that the information required is available to the Office from other sources.

Rule 111 Decisions affecting seniority claims

Where a seniority claim which has been made in accordance with Article 148(1) (now Article 153(1)) of the Regulation, or which has been communicated pursuant to Rule 110(5), has been withdrawn or cancelled by the Office, the Office shall inform the International Bureau accordingly.

Rule 112 Examination as to absolute grounds for refusal

(1) Where, in the course of the examination pursuant to Article 149(1) (now Article 154(1)) of the Regulation, the Office finds that pursuant to Article 38(1) (now Article 37(1)) of the Regulation, the trade mark which is subject to the territorial extension to the European Community is ineligible for protection for all or any part of the goods or services for which it has been registered by the International Bureau, the Office shall issue an ex officio provisional notification of refusal pursuant to Article 5(1), and (2) of the Madrid Protocol and Rule 17(1) of the Common Regulations to the International Bureau. Where the holder of the international registration is obliged to be represented in proceedings before the Office pursuant to Article 88(1) (now Article 92(1)) of the Regulation, the notification shall contain an invitation to appoint a representative within the meaning of Article 89(1) (now Article 93(1)) of the Regulation. The notification of provisional refusal shall state the reasons on which it is based, and shall specify a time limit within which the holder of the international registration may submit his observations and, if appropriate, must appoint a representative. The time limit shall start on the day on which the Office issues the provisional refusal.

(2) Where, in the course of the examination pursuant to Article 149(1)

(now Article 154(1)), the Office finds that pursuant to Article 38(2) (now Article 37(2)) of the Regulation, registration of the mark must be subject to the statement by the holder of the international registration that he disclaims any exclusive rights in a non-distinctive element of the mark, the notification of ex officio provisional refusal of protection pursuant to paragraph 1 shall state that the international registration will be refused protection if the relevant statement is not submitted within the specified time limit.

(3) Where, in the course of the examination pursuant to Article 149(1) (now Article 154(1)), the Office finds that the international application designating the European Community does not contain the indication of a second language pursuant to Rule 126 and Rule 9(5)(g)(ii) of the Common Regulations, the Office shall issue an ex officio provisional notification of refusal pursuant to Article 5(1), and (2) of the Madrid Protocol and Rule 17(1) of the Common Regulations to the International Bureau. Paragraph 1, second, third and fourth sentence, shall apply.

(4) Where the holder of the international registration fails to overcome the ground for refusing protection within the time limit or to comply with the condition laid down in paragraph 2 or, if appropriate, to appoint a representative or to indicate a second language, the Office will take a decision refusing the protection in whole or for a part of the goods and services for which the international registration is registered. The decision shall be subject to appeal in accordance with Article 57 to 63 (now Article 58 to 65).

(5) Where, until the start of the opposition period referred to in Article 151(2) (now Article 156(2)) of the Regulation, the Office has not issued an ex officio provisional notification of refusal pursuant to paragraph 1, the Office shall send a statement of grant of protection to the International Bureau, indicating that the examination of absolute grounds of refusal pursuant to Article 38 (now Article 37) of the Regulation has been completed but that the international registration is still subject to oppositions or observations of third parties.

Rule 113 Notification of ex officio provisional refusals to the International Bureau

(1) The notification of ex officio provisional refusal of protection of the international registration in whole or in part, pursuant to

Rule 112, shall be sent to the International Bureau and shall contain:

- (a) the number of the international registration;
- (b) all the grounds on which the provisional refusal is based together with a reference to the corresponding provisions of the Regulation;
- (c) the 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 his observations to the Office within a time limit of two months from the date on which the Office issues the provisional refusal;
- (d) if the provisional refusal relates to only part of the goods and services, the indication of those goods and services.

(2) In respect of each notification of ex officio provisional refusal issued pursuant to paragraph 1, and provided that the time limit for entering an opposition has expired and that no provisional refusal based on an opposition has been issued pursuant to Rule 115(1), the Office shall inform the International Bureau as follows:

- (a) where as the result of the proceedings before the Office the provisional refusal has been withdrawn, the fact that the mark is protected in the European Community;
- (b) where a decision to refuse protection of the mark has become final, if applicable, following an appeal under Article 57 (now Article 58) of the Regulation or an action under Article 63 (now Article 65) of the Regulation, the Office shall inform the International Bureau that protection of the mark is refused in the European Community;
- (c) where the refusal pursuant to subparagraph (b) concerns only part of the goods and services, the goods and services for which the mark is protected in the European Community.

Rule 114 Opposition proceedings

(1) Where opposition is entered against an international registration designating the European Community pursuant to Article 151 (now Article 156) of the Regulation, the notice of opposition shall contain:

- (a) the number of the international registration against which opposition is entered;
- (b) an indication of the goods and services listed in the international registration against which opposition is entered;
- (c) the name of the holder of the international registration;
- (d) the indications and elements referred to in Rule 15(2)(b) to (h).

(2) Rules 15(1), (3) and (4) and 16 to 22 shall apply, subject to the

following:

- (a) any reference to an application for registration of the Community 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 Community trade mark shall be read as a reference to the renunciation of the international registration in respect of the European Community;
- (c) any reference to the applicant shall be read as a reference to the holder of the international registration.

(3) If the notice of opposition is filed before the expiry of the period of six months referred to in Article 151(2) (now Article 156(2)) of the Regulation, the notice of opposition shall be deemed to have been filed on the first day following the expiry of the period of six months. The application of Article 42(3) (now Article 41(3)) second sentence of the Regulation shall remain unaffected.

(4) Where the holder of the international registration is obliged to be represented in proceedings before the Office pursuant to Article 88(2) (now Article 92(2)) of the Regulation, and where he has not already appointed a representative within the meaning of Article 89(1) (now Article 93(1)) of the Regulation, the communication of the opposition to the holder of the international registration pursuant to Rule 19 shall contain the invitation to appoint a representative within the meaning of Article 89(1) (now Article 93(1)) of the Regulation within a period of two months from the date of notification of the communication. Where the holder of the international registration fails to appoint a representative within this period, the Office will take a decision refusing the protection of the international registration.

(5) The opposition procedure shall be stayed if an ex officio provisional refusal of protection is or has been issued pursuant to Rule 112. When the ex officio provisional refusal leads to a decision to refuse protection of the mark which has become final, the Office shall not proceed to judgment and refund the opposition fee, and no decision on the apportionment of costs shall be taken.

Rule 115 Notification of provisional refusals based on an opposition

(1) When an opposition against an international registration is entered at the Office pursuant to Article 151(2) (now Article 156(2)) of the Regulation, or is deemed to have been entered pursuant to Rule 114(3),

the Office shall issue a notification of provisional refusal of protection based on an opposition to 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 on which the opposition relies;
- (c) the name and the address of the opposing party.

(3) Where the opposition is based on a trademark application or registration, the notification referred to in paragraph 2 shall contain the following indications:

- (i) the filing date, the registration date and, if any, the priority date,
- (ii) the filing number and, if different, the registration number,
- (iii) the name and address of the owner,
- (iv) a reproduction of the mark, and
- (v) the list of goods and services on which the opposition is based.

(4) If the provisional refusal relates to only part of the goods and services, the notification referred to in paragraph 2 shall indicate those goods and services.

(5) The Office shall inform the International Bureau as follows:

- (a) where as the result of the opposition proceeding the provisional refusal has been withdrawn, the fact that the mark is protected in the European Community;
- (b) where a decision to refuse protection of the mark has become final, if applicable, following an appeal under Article 57 (now Article 58) of the Regulation or an action under Article 63 (now Article 65) of the Regulation, the fact that protection of the mark is refused in the European Community;
- (c) where the refusal pursuant to subparagraph (b) concerns only part of the goods and services, the goods and services for which the mark is protected in the European Community.

(6) Where for one and the same international registration, more than one provisional refusal has been issued pursuant to Rule 112(1), (2) 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 as it results from all the procedures under Article 149 and 151 (now Article 154 and 156) of the Regulation.

Rule 116 Statement of grant of protection

(1) Where the Office has not issued an ex officio provisional notification of refusal pursuant to Rule 112 and no opposition has been received by the Office within the opposition period referred to in Article 151(2) (now Article 156(2)) of the Regulation and the Office has not issued an ex officio provisional refusal as a result of the third party observations filed, the Office shall send a [further] statement of grant of protection to the International Bureau, indicating that the mark is protected in the European Community.

(2) For the purposes of Article 146(2) (now Article 151(2)) of the Regulation, the further statement of grant of protection referred to in paragraph 1 shall have the same effect as a statement by the Office that a notice of refusal has been withdrawn.

Rule 117 Notification of invalidation to the International Bureau

(1) Where, pursuant to Article 56 or 96 (now Article 57 or 100) and Article 153 (now Article 158) of the Regulation, the effects of an international registration designating the European Community have been declared invalid and where that decision has become final, the Office shall notify the International Bureau accordingly.

(2) The notification shall be dated and shall contain:

(a) the indication that the invalidation has been pronounced by the Office, or the indication of the Community trade mark court which has pronounced the invalidation;

(b) the indication 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) the indication of the fact 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) if the invalidation does not concern all the goods and services, those goods and 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 the indication whether the invalidation is effective as of that date or ex tunc.

Rule 118 Legal effect of registration of transfers

For the purposes of Article 17, and also in conjunction with Article 23(1) or (2) and Article 24, of the Regulation, recordal of a change in the ownership of the international registration on the International Register shall replace the entry of a transfer in the Register of Community Trade Marks.

Rule 119 Legal effect of registration of licenses and other rights

For the purposes of Articles 19, 20, 21 and 22, and also in conjunction with Article 23 and Article 24, of the Regulation, recordal of a license or a restriction of the holder's right of disposal in respect of the international registration in the International Register shall replace the registration of a license, a right in rem, a levy of execution or insolvency proceedings in the Register of Community Trade Marks.

Rule 120 Examination of requests for registrations of transfers, licenses or restrictions of the holder's right of disposal

(1) Where a request to register a change in ownership, a license or a restriction of the holder's right of disposal is filed through the Office by a person other than the holder of the international registration, the Office shall refuse to transmit of the request to the International Bureau if the request is not accompanied by proof of the transfer, license or the restriction of the right of disposal.

(2) Where a request to register the amendment or cancellation of a license or the removal of a restriction of the holder's right of disposal is filed through the Office by the holder of the international registration, the Office will take a decision refusing to transmit of the request to the International Bureau if the request is not accompanied by proof that the license no longer exists or has been amended, or that the restriction of the right of disposal has been removed.

Rule 121 Collective marks

(1) Where the international registration indicates that it is based

on a basic application or basic registration which relates to a collective mark, certification mark or guarantee mark, the international registration designating the European Community shall be dealt with as a Community collective mark.

(2) The holder of the international registration shall submit the regulations governing use of the mark as provided for in Article 65 (now Article 67) of the Regulation and Rule 43 directly to the Office within a period of two months from the date on which the International Bureau notifies the international registration to the Office.

(3) A notification of ex officio provisional refusal pursuant to Rule 112 shall also be issued:

(a) if one of the grounds for refusal foreseen in Article 66(1) or (2) (now Article 68(1) or (2)), in conjunction paragraph 3 of that article, of the Regulation exists;

(b) where the regulations governing use of the mark have not been submitted in accordance with paragraph 2. Rules 112(2), (3) and 113 shall apply.

(4) Notice of amendments to the regulations governing use of the mark pursuant to Article 69 (now Article 71) of the Regulation shall be published in the Community Trade Marks Bulletin.

Rule 122 Conversion of an international registration into a national trade mark application

(1) An application for conversion of an international registration designating the European Community into a national trade mark application pursuant to Articles 108 and 154 (now Articles 112 and 159) of the Regulation shall contain:

(a) the registration number of the international registration;

(b) the date of the international registration or the date of the designation of the European Community made subsequently to the international registration pursuant to Article 3 ter(2) of the Madrid Protocol and, where applicable, particulars of the claim to priority for the international registration pursuant to Article 154(2) (now Article 159(2)) of the Regulation and particulars of the claim to seniority pursuant to Articles 34, 35 and 148 (now Articles 34, 35 and 153) of the Regulation;

(c) the indications and elements referred to in Rule 44(1)(a), (c), (d), (e) and (f).

(2) Where conversion is requested pursuant to Article 108(5) and 154 (now Article 112(5) and 159) of the Regulation following a failure to renew the international registration, the application referred to in paragraph 1 shall contain an indication to that effect, and the date on which the protection has expired. The period of three months provided for in Article 108(5) (now Article 112(5)) of the Regulation shall begin to run on the day following the last day on which the renewal may still be effected pursuant to Article 7(4) of the Madrid Protocol;

(3) Rules 45, 46(2)(a) and (c), and 47 shall apply mutatis mutandis.

Rule 123 Conversion of an international registration into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement

(1) An application for conversion of an international registration designating the European Community into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement pursuant to Article 154 (now Article 159) of the Regulation shall contain the indications and elements referred to in Rule 122(1) and (2).

(2) Rule 45 shall apply mutatis mutandis. The Office shall also reject the application for conversion where the conditions to designate the Member State which is a party to the Madrid Protocol or to the Madrid Agreement were not fulfilled both on the date of the designation of the European Community and the date on which the application for conversion was received or, pursuant to the second sentence of Article 109(1) (now Article 113(1)) of the Regulation, is deemed to have been received by the Office.

(3) Rule 46(2)(a) and (c) shall apply mutatis mutandis. The publication of the application for conversion shall also contain the indication that conversion has been requested into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement pursuant to Article 154 (now Article 159) of the Regulation.

(4) Where the application for conversion complies with the requirements of the Regulation and these Rules, the Office shall transmit it without delay to the International Bureau. The Office shall inform the holder of the international registration of the date of transmission.

Rule 124 Transformation of an international registration designating the European Community into a Community trade mark application

(1) In order to be considered a transformation of an international registration which has been cancelled at the request of the office of origin by the International Bureau pursuant to Article 9 quinquies of the Madrid Protocol and in accordance with Article 156 (now Article 161) of the Regulation, a Community trade mark application must contain an indication to that effect. That indication must be made on filing of the application.

(2) The application shall contain, in addition to the indications and elements referred to in Rule 1,

(a) the indication of 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 European Community made subsequently to the international registration pursuant to Article 3 ter(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.

(3) Where, in the course of the examination in accordance with Rule 9(3), the Office finds that the application was not filed within three months from the date on which the international registration was cancelled by the International Bureau; or the goods and services for which the Community trade mark is to be registered are not contained in the list of goods and services for which the international registration was registered in respect of the European Community, the Office shall invite the applicant to remedy the deficiencies noted and in particular to restrict the list of goods and services to those goods and services which have been contained in the list of goods and services for which the international registration was registered in respect of the European Community, within such a period as it may specify.

(4) If the deficiencies referred to in paragraph 3 are not remedied within the time limit, the right to the date of the international registration or the territorial extension and, if any, of the priority

of the international registration shall be lost.

PART C Communications

Rule 125 Communications with the International Bureau and electronic forms

(1) Communications with the International Bureau shall be in a manner and format agreed on between the International Bureau and the Office, preferably by electronic means.

(2) Any reference to forms shall be construed as including forms made available in electronic format.

Rule 126 Use of languages

For the purposes of applying the Regulation and these Rules to international registrations designating the European Community, the language of filing of the international application shall be the language of the proceedings within the meaning of Article 115(4) (now Article 119(4)) of the Regulation, and the second language indicated in the international application shall be the second language within the meaning of Article 115(3) (now Article 119(3)) of the Regulation.

Article 2 Transitional Provisions

(1) Any application for registration of a Community trade mark filed within three months prior to the date determined pursuant to Article 143(3) of the Regulation shall be marked by the Office with the filing date determined pursuant to that provision and with the actual date of receipt of the application.

(2) With regard to the application, the priority period of six months provided for in Articles 29 and 33 of the Regulation shall be calculated from the date determined pursuant to Article 143(3) of the Regulation.

(3) The Office may issue a receipt to the applicant prior to the date determined pursuant to Article 143(3) of the Regulation.

(4) The Office may examine the applications prior to the date determined pursuant to Article 143(3) of the Regulation and communicate with the applicant with a view to remedying any deficiencies prior to that date. Any decisions with regard to such applications may be taken only after that date.

(5) With regard to the application, the Office shall not carry out any search pursuant to Article 39(1) (now Article 38(1)) of the Regulation, regardless of whether or not a priority was claimed for such application pursuant to Articles 29 or 33 of the Regulation.

(6) Where the date of receipt of an application for the registration of a Community trade mark by the Office, by the central industrial property office of a Member State or by the Benelux Trade Mark Office is before the commencement of the three months period specified in Article 143(4) of the Regulation the application shall be deemed not to have been filed. The application shall be informed accordingly and the application shall be sent back to him.

Article 3 Entry into force

This Regulation shall enter into force on the seventh day following that of its publication in the Official Journal of the European Communities.

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

Done at Brussels, 13 December 1995.