Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431

COMMISSION IMPLEMENTING REGULATION (EU) 2018/626

of 5 March 2018

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THE EUROPEAN COMMISSION,

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

Having regard to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark[(1)], and in particular Article 20(6), Article 31(4), Article 35(2), Article 38(4), Article 39(6), Article 44(5), Article 50(9), Article 51(3), the second subparagraph of Article 54(3), the second subparagraph of Article 55(1), Article 56(8), Article 57(5), Article 75(3), Article 84(3), the first subparagraph of Article 109(2), Article 116(4), Article 117(3), Article 140(6), Article 146(11), the second subparagraph of Article 161(2), Article 184(9), Article 186(2), Article 187(2), Article 192(6), Article 193(8), Article 198(4), Article 202(10) and Article 204(6) thereof,

Whereas:

(1) Council Regulation (EC) No 40/94[(2)], which was codified as Regulation (EC) No 207/2009, created a system specific to the Union for the protection of trade marks to be obtained at the level of the Union on the basis of an application to the European Union Intellectual Property Office (‘the Office’).

(2) Regulation (EU) 2015/2424 of the European Parliament and the Council[(3)] aligned the powers conferred upon the Commission under Regulation (EC) No 207/2009 with Articles 290 and 291 of the Treaty on the Functioning of the European Union. In order to conform with the new legal framework resulting from that alignment, Commission Delegated Regulation (EU) 2017/1430[(4)] and Commission Implementing Regulation (EU) 2017/1431[(5)] were adopted.

(3) Council Regulation (EC) No 207/2009[(6)] was codified as Regulation (EU) 2017/1001. For reasons of clarity and simplification, the references contained in an Implementing Regulation should reflect the renumbering of Articles resulting from such a codification of the relevant basic act. Implementing Regulation (EU) 2017/1431 should therefore be repealed and the provisions of that Implementing Regulation should be laid down, with updated references to Regulation (EU) 2017/1001, in this Regulation.

(4) In the interest of clarity, legal certainty and efficiency, and with a view to facilitating the filing of EU trade mark applications, it is of essential importance to specify, in a

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clear and exhaustive manner while avoiding unnecessary administrative burdens, the mandatory and optional particulars to be contained in an application for an EU trade mark.

(5) Regulation (EU) 2017/1001 no longer requires the representation of a mark to be graphic, as long as it enables the competent authorities and the public to determine with clarity and precision the subject matter of protection. It is therefore necessary, in order to ensure legal certainty, to clearly affirm that the precise subject matter of the exclusive right conferred by the registration is defined by the representation. The representation should, where appropriate, be complemented by an indication of the type of the mark concerned. It may be complemented by a description of the sign in appropriate cases. Such an indication or description should accord with the representation.

(6) Moreover, in order to ensure consistency in the process of filing an EU trade mark application and in order to enhance the effectiveness of clearance searches, it is appropriate to establish general principles to which the representation of every mark must conform, as well as lay down specific rules and requirements for the representation of certain types of trade mark, in accordance with the trade mark's specific nature and attributes.

(7) The introduction of technical alternatives to graphic representation, in line with new technologies, derives from the necessity of modernisation, bringing the registration process closer to technical developments. At the same time, the technical specifications for filing a representation of the trade mark, including representations filed electronically, should be laid down with a view to ensuring that the EU trade mark system remains interoperable with the system established by the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989[7] (Madrid Protocol). In accordance with Regulation (EU) 2017/1001, and for the sake of increased flexibility and quicker adaptation to technological advances, it should be left to the Executive Director of the Office to lay down the technical specifications for marks filed electronically.

(8) It is appropriate to streamline proceedings so as to reduce administrative burdens in the filing and process of priority and seniority claims. It should therefore not be necessary any more to submit certified copies of the previous application or registration. Furthermore, the Office should no longer be required to include a copy of the prior trade mark application in the file in the case of a priority claim.

(9) Following the abolition of the requirement of a graphic representation of a trade mark, certain types of trade marks can be represented in electronic format and accordingly, their publication using conventional means is no longer suitable. In order to guarantee the publication of all the information concerning an application, which is required for reasons of transparency and legal certainty, access to the representation of the trade mark by way of a link to the Office's electronic Register should be recognised as a valid form of representation of the sign for publication purposes.

(10) For the same reasons, it should also be permissible for the Office to issue certificates of registration in which the reproduction of the trade mark is substituted by an electronic

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link. Furthermore, for certificates issued after the registration, and to cater for requests made at a time when registration particulars may have changed, it is appropriate to provide for the possibility of issuing updated versions of the certificate, where relevant subsequent entries in the Register are indicated.

(11) Practical experience in applying the former regime revealed the need to clarify certain provisions, in particular in relation to partial transfers and partial surrenders, in order to ensure clarity and legal certainty.

(12) In order to ensure legal certainty, while keeping a certain level of flexibility, it is necessary to establish a minimum content of the regulations governing the use of EU collective marks and of EU certification marks submitted pursuant to Regulation (EU) 2017/1001, with the purpose of enabling market operators to avail themselves of this new type of trade mark protection.

(13) Maximum rates for representation costs incurred by the successful party to proceedings before the Office should be specified, taking into account the need to ensure that the obligation to bear the costs may not be misused, inter alia, for tactical reasons by the other party.

(14) For reasons of efficiency, electronic publications by the Office should be allowed.

(15) It is necessary to ensure an effective and efficient exchange of information between the Office and the authorities of the Member States in the context of administrative cooperation, taking appropriate account of the restrictions to which the inspection of files is subject.

(16) The requirements concerning requests for conversion should ensure a smooth and effective interface between the EU trade mark system and the national trade mark systems.

(17) In order to streamline proceedings before the Office, it should be possible to limit the submission of translations to those parts of documents that are relevant to the proceedings. For the same purpose, the Office should be authorised to require proof that a translation corresponds to the original only in the event of doubt.

(18) For reasons of efficiency, certain decisions of the Office in relation to oppositions or applications for the revocation or a declaration of invalidity of an EU trade mark should be taken by a single member.

(19) Due to the accession of the Union to the Madrid Protocol, it is necessary that the detailed requirements governing the procedures concerning the international registration of marks be entirely consistent with the rules of that Protocol.

(20) Implementing Regulation (EU) 2017/1431 replaced the rules previously laid down in Commission Regulation (EC) No 2868/95[(8)] which was therefore repealed. Notwithstanding that repeal, certain proceedings initiated before the date of applicability of Implementing Regulation (EU) 2017/1431 should continue to be governed until their conclusion by specific provisions of Regulation (EC) No 2868/95.

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(21) The measures provided for in this Regulation are in accordance with the opinion of the Committee on Implementation Rules,

HAS ADOPTED THIS REGULATION:

TITLE I

GENERAL PROVISIONS

Article 1

Subject matter

This Regulation lays down rules specifying:

(a) the details to be contained in an application for an EU trade mark to be filed at the European Union Intellectual Property Office (‘the Office’);

(b) the documentation required to claim the priority of a previous application and to claim seniority, and the evidence to be filed to claim an exhibition priority;

(c) the details to be contained in the publication of an application for an EU trade mark;

(d) the content of a declaration of division of an application, how the Office has to process such a declaration, and the details to be contained in the publication of the divisional application;

(e) the content and form of the certificate of registration;

(f) the content of a declaration of division of a registration and how the Office has to process such a declaration;

(g) the details to be contained in requests for alteration and for the change of name or address;

(h) the content of an application for registration of a transfer, the documentation required to establish a transfer, and how to process applications for partial transfers;

(i) the details to be contained in a declaration of surrender and the required documentation to establish a third party's agreement;

(j) the details to be contained in the regulations governing use of an EU collective mark and those governing use of an EU certification mark;

(k) the maximum rates for costs essential to proceedings and actually incurred;

(l) certain details concerning publications in the European Union Trade Marks Bulletin and the Official Journal of the Office;

(m) the detailed arrangements as to how the Office and the authorities of the Member States are to exchange information between each other and open files for inspection;

(n) the details to be contained in requests for conversion and in the publication of a request for conversion;

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(o) the extent to which supporting documents to be used in written proceedings before the Office may be filed in any official language of the Union, the need to supply a translation and the requisite standards of translations;

(p) the decisions to be taken by single members of the Opposition and Cancellation Divisions;

(q) concerning the international registration of marks:

(i) the form to be used for the filing of an international application;

(ii) the facts and decisions of invalidity to be notified to the International Bureau of the World Intellectual Property Organisation ('the International Bureau') and the relevant time of such notification;

(iii) the detailed requirements regarding requests for territorial extension subsequent to international registration;

(iv) the details to be contained in a seniority claim for an international registration and the details of the information to be notified to the International Bureau;

(v) the details to be contained in the notification of ex officio provisional refusal of protection to be sent to the International Bureau;

(vi) the details to be contained in the final grant or refusal of protection;

(vii) the details to be contained in the notification of invalidation;

(viii) the details to be contained in the requests for conversion of an international registration and in the publication of such requests;

(ix) the details to be contained in an application for transformation.

TITLE II

APPLICATION PROCEDURE

Article 2

Content of the application

1 The application for an EU trade mark shall contain:

a a request for registration of the trade mark as an EU trade mark;

b the name and address of the applicant and the State in which that applicant is domiciled or has a seat or an establishment. Names of natural persons shall be indicated by the person's family name(s) and given name(s). Names of legal entities, as well as bodies falling under Article 3 of Regulation (EU) 2017/1001, shall be indicated by their official designation and include the legal form of the entity, which may be abbreviated in a customary manner. The company's national identification number may also be specified if available. The Office may require the applicant to provide telephone numbers or other contact details for communication by electronic means as defined by the Executive Director. Only one address shall, in principle, be indicated for each applicant. Where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for