Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430

COMMISSION DELEGATED REGULATION (EU) 2018/625

of 5 March 2018

supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430

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 48, Article 49(3), Article 65, Article 73, Article 96(4), Article 97(6), Article 98(5), Article 100(2), Article 101(5), Article 103(3), Article 106(3), Article 121, Article 168, Article 194(3) and Article 196(4) thereof,

Whereas:

(1) Council Regulation (EC) No 40/94[(2)], which was codified as Council Regulation (EC) No 207/2009[(3)], 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 of the Council[(4)] amending Regulation (EC) No 207/2009 aligned the powers conferred therein upon the Commission 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[(5)] and Commission Implementing Regulation (EU) 2017/1431[(6)] were adopted.

(3) Regulation (EC) No 207/2009 was codified as Regulation (EU) 2017/1001. For reasons of clarity and simplification, the references contained in a Delegated Regulation should reflect the renumbering of articles resulting from such a codification of the relevant basic act. Delegated Regulation (EU) 2017/1430 should therefore be repealed and the provisions of that Delegated Regulation should be laid down, with updated references to Regulation (EU) 2017/1001, in this Regulation.

(4) The procedural rules on opposition should ensure an effective, efficient and expeditious examination and registration of EU trade mark applications by the Office using a procedure which is transparent, thorough, fair and equitable. In order to enhance legal certainty and clarity, those opposition rules should take account of the extended relative grounds for refusal laid down in Regulation (EU) 2017/1001, in particular as regards the requirements for admissibility and substantiation of opposition proceedings, and be

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adjusted to better reflect the case-law of the Court of Justice of the European Union and to codify the practice of the Office.

(5) In order to allow for a more flexible, consistent and modern trade mark system in the Union, while ensuring legal certainty, it is appropriate to reduce the administrative burden for the parties in *inter partes* proceedings by relaxing the requirements for the substantiation of earlier rights in cases where the content of the relevant evidence is accessible online from a source recognised by the Office, as well as the requirement of submitting evidence in the language of the proceedings.

(6) In the interest of clarity and legal certainty, it is important to specify the requirements for amending an application for an EU trade mark in a clear and exhaustive manner.

(7) The procedural rules governing the revocation and declaration of invalidity of an EU trade mark should ensure that an EU trade mark can be revoked or declared invalid in an effective and efficient way by means of transparent, thorough, fair and equitable procedures. For the sake of greater clarity, consistency as well as efficiency and legal certainty, the procedural rules governing the revocation and declaration of invalidity of an EU trade mark should be aligned with those applicable to opposition proceedings, retaining only those differences which are required due to the specific nature of revocation and declaration of invalidity proceedings. Furthermore, requests for assignment of an EU trade mark registered in the name of an unauthorised agent should follow the same procedural path as invalidity proceedings, serving in practice as an alternative to invalidating the mark.

(8) According to settled case-law of the Court of Justice[(7)], unless otherwise provided, the Office enjoys discretionary powers when examining belated evidence, submitted for the purpose of either substantiating an opposition or proving genuine use of the earlier mark in the context of opposition or invalidity proceedings. In order to ensure legal certainty the relevant boundaries of such discretion should be accurately reflected in the rules governing opposition proceedings or proceedings for the declaration of invalidity of EU trade marks.

(9) In order to allow for an effective, efficient and, within the scope of the appeal defined by the parties, complete review of decisions taken by the Office in the first instance by means of a transparent, thorough, fair and impartial appeal procedure suited to the specific nature of intellectual property law and taking into account the principles laid down in Regulation (EU) 2017/1001, it is appropriate to reinforce legal certainty and predictability by clarifying and specifying the procedural rules and the parties' procedural guarantees, in particular where a defendant makes use of the right to file a cross appeal.

(10) In order to ensure an effective and efficient organisation of the Boards of Appeal, the President, the chairpersons and the members of the Boards of Appeal should, in the exercise of their respective functions conferred upon them by Regulation (EU) 2017/1001 and by this Regulation, be required to ensure a high quality and consistency of the decisions taken independently by the Boards on appeal as well as the efficiency of the appeal proceedings.

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(11) In order to ensure the independence of the President, the chairpersons and the members of the Boards of Appeal as provided in Article 166 of Regulation (EU) 2017/1001, the Management Board should take the latter Article into account when adopting appropriate implementing rules to give effect to the Staff Regulations and the Conditions of Employment of Other Servants in accordance with Article 110 of the Staff Regulations.

(12) In order to enhance the transparency and predictability of the appeal proceedings, the rules of procedure of the Boards of Appeal originally laid down in Commission Regulation (EC) No 2868/95[(8)] and Commission Regulation (EC) No 216/96[(9)], should be set out in a single text and properly interlinked with the procedural rules applicable to the instances of the Office whose decisions are subject to appeals.

(13) For the sake of clarity and legal certainty, it is required to codify and clarify certain procedural rules governing oral proceedings, in particular relating to the language of such proceedings. It is further appropriate to provide greater efficiency and flexibility by introducing the possibility of taking part in oral proceedings by technical means and of substituting the minutes of oral proceedings by their recording.

(14) In order to further streamline proceedings and render them more consistent, it is appropriate to set out the basic structure and format of evidence to be submitted to the Office in all proceedings, as well as the consequences of not submitting evidence in accordance with that structure and format.

(15) In order to modernise the trade mark system in the Union by adapting it to the internet era, it is further appropriate to provide for a definition of ‘electronic means’ in the context of notifications and for forms of notification that are not obsolete.

(16) In the interest of efficiency, transparency and user-friendliness, the Office should make available standard forms in all the official languages of the Office for communication in proceedings before the Office, which may be completed online.

(17) For the purposes of greater clarity, consistency and efficiency, a provision on the suspension of opposition, revocation, invalidity and appeal proceedings should be introduced, laying down also the maximum duration of a suspension requested by both parties.

(18) The rules governing the calculation and duration of time limits, the procedures for the revocation of a decision or for cancellation of an entry in the Register, the detailed arrangements for the resumption of proceedings, and the details on representation before the Office need to ensure a smooth, effective and efficient operation of the EU trade mark system.

(19) It is necessary to ensure the effective and efficient registration of international trade marks in a manner that is fully consistent with the rules of the Protocol relating to the Madrid Agreement concerning the international registration of marks.

(20) Implementing Regulation (EU) 2017/1431 and Delegated Regulation (EU) 2017/1430 replaced the rules previously laid down in Regulations (EC) No 2868/95 and (EC) No 216/96 which were therefore repealed. Notwithstanding that repeal, it is necessary

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to continue to apply specific provisions of Regulations (EC) No 2868/95 and (EC) No 216/96 to certain proceedings that had been initiated before the date of applicability of Regulation (EU) 2017/1430 until the conclusion of those proceedings,

HAS ADOPTED THIS REGULATION:

TITLE I

GENERAL PROVISIONS

Article 1

Subject matter

This Regulation lays down rules specifying:

(a) the details of the procedure for filing and examining an opposition to the registration of an EU trade mark at the European Union Intellectual Property Office ('the Office');

(b) the details of the procedure governing the amendment of an application for an EU trade mark;

(c) the details governing the revocation and declaration of invalidity of an EU trade mark, as well as the transfer of an EU trade mark registered in the name of an unauthorised agent;

(d) the formal content of a notice of appeal and the procedure for the filing and the examination of an appeal, the formal content and form of the Boards of Appeal's decisions and the reimbursement of the appeal fee, the details concerning the organisation of the Boards of Appeal, and the conditions under which decisions on appeals are to be taken by a single member;

(e) the detailed arrangements for oral proceedings and for the taking of evidence;

(f) the detailed arrangements for notification by the Office and the rules on the means of communication with the Office;

(g) the details regarding the calculation and duration of time limits;

(h) the procedure for the revocation of a decision or for the cancellation of an entry in the Register of EU trade marks;

(i) the detailed arrangements for the resumption of proceedings before the Office;

(j) the conditions and the procedure for the appointment of a common representative, the conditions under which employees and professional representatives shall file an authorisation, and the content of that authorisation, and the circumstances in which a person may be removed from the list of admitted professional representatives;

(k) the details of the procedure concerning international registrations based on a basic application or basic registration relating to a collective mark, certification mark or guarantee mark, and the procedure for the filing and examination of an opposition to an international registration.

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TITLE II

PROCEDURE FOR OPPOSITION AND PROOF OF USE

Article 2

Notice of opposition

1 A notice of opposition may be entered on the basis of one or more earlier marks or other rights within the meaning of Article 8 of Regulation (EU) 2017/1001, provided that the proprietors or authorised persons entering the notice pursuant to Article 46 of Regulation (EU) 2017/1001 are entitled to do so for all the earlier marks or rights. Where an earlier mark has more than one proprietor (‘co-ownership’) or where an earlier right may be exercised by more than one person, an opposition pursuant to Article 46 of Regulation (EU) 2017/1001 may be filed by any or all of the proprietors or authorised persons.

2 The notice of opposition shall contain:

a the file number of the application against which opposition is entered and the name of the applicant for the EU trade mark;

b a clear identification of the earlier mark or right on which the opposition is based, namely:

(i) where the opposition is based on an earlier mark within the meaning of Article 8(2)(a) or (b) of Regulation (EU) 2017/1001, the file number or registration number of the earlier mark, an indication of whether the earlier mark is registered or an application for registration of that mark, as well as an indication of the Member States including, where applicable, the Benelux, in or for which the earlier mark is protected, or, if applicable, the indication that it is an EU trade mark;

(ii) where the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of Regulation (EU) 2017/1001, the indication of the Member State(s) where the mark is well known and a representation of the mark;

(iii) where the opposition is based on the absence of the proprietor's consent as referred to in Article 8(3) of Regulation (EU) 2017/1001, an indication of the territory in which the earlier trade mark is protected, the representation of the mark and, if applicable, an indication whether the earlier mark is an application or a registration, in which case the filing or registration number shall be provided;

(iv) where the opposition is based on an earlier mark or another sign within the meaning of Article 8(4) of Regulation (EU) 2017/1001, an indication of its kind or nature, a representation of the earlier mark or sign, and an indication of whether the right to the earlier mark or sign exists in the whole Union or in one or more Member States, and if so, an indication of those Member States;

(v) where the opposition is based on an earlier designation of origin or geographical indication within the meaning of Article 8(6) of Regulation (EU) 2017/1001, an indication of its nature, a representation of the earlier designation of origin or geographical indication, and an indication of whether it is protected in the whole Union or in one or more Member States, and if so, an indication of those Member States;