Changes to legislation: *Commission Regulation (EC) No 1041/2005 is up to date with all changes known to be in force on or before 28 February 2022. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

Commission Regulation (EC) No 1041/2005 of 29 June 2005 amending Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark (Text with EEA relevance)

COMMISSION REGULATION (EC) No 1041/2005

of 29 June 2005

amending Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark

(Text with EEA relevance)

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[(1)], and in particular Article 157 thereof,

Whereas:

(1) According to Regulation (EC) No 40/94, it is necessary to adopt technical measures to implement dispositions concerning the standard form for the searches reports, division of the application and registration, revocation of decisions, authorisations, and decisions taken by a single member of the Opposition or Cancellation Division.

(2) After 10 March 2008 the search system will remain compulsory for Community trade marks, but it should be made optional, subject to the payment of a fee, for searches in the trade mark registers of the Member States which notified their own decision to carry out a search. A standard form comprising essential elements for the search report is hereby laid out with a view to improving the quality and uniformity of such search reports.

(3) The declaration of division and registration must comply with the elements set out in the present regulation. The new *ex officio* revocation of a decision or an entry in the register by the Office for Harmonization in the Internal Market (trade marks and designs) (The Office) must comply with the specific procedure as established in the present regulation. The exceptional cases where an authorisation is mandatory are specified. A list of simple cases where a decision can be taken by a single member of the Opposition or Cancellation Divisions is provided for.

(4) Furthermore, existing rules should be amended in order to improve or clarify the procedure for registration. In addition, certain procedural points should be amended without changing the substance of the system.

(5) In order to cover the specificities and facilities of the e-filing procedure, the following provisions are amended: Rule 1(1)(c), Rule 3(2), Rule 61, Rule 72(4), Rule 79, Rule 82, Rule 89(1) and (2).

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(6) The electronic filing and electronic publication of Community trade mark applications should facilitate the filing of trade marks in general and in particular enhance the filing of trade marks consisting of colours per se or sounds by means of a representation of the mark which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The technical conditions, in particular the data format for sound files, should be laid down by the President of the Office. E-filing of trade marks consisting of sounds can be accompanied by an electronic sound file and this file can be included in the electronic publication of the Community trade mark applications to facilitate public access to the sound itself.

(7) The provisions concerning the opposition procedure should be reframed completely as to specify the admissibility requirements, to specify clearly the legal consequences of deficiencies and to bring the provisions in the chronological order of the proceedings.

(8) Following the additional competence of the Office for the examination of the admissibility of conversion the refusal of a request for conversion may become partial in the sense that conversion can be acceptable for some Member States but inadmissible for others. In addition, some criteria to be used for examining absolute grounds by reference to the language of a Member State should be added.

(9) Regarding costs to be born by the losing party in opposition and cancellation procedures, reimbursable costs of the representation should be limited but the present maximum amounts should be increased slightly in view of the time elapsed since adoption of the Implementing Regulation. Where witnesses or experts are summoned, no such maximum rate should be provided but the reimbursable costs shall comprise the actual amounts those witnesses and experts can claim.

(10) Commission Regulation (EC) No 2868/95[(2)] should therefore be amended accordingly.

(11) The measures provided for in this Regulation are in accordance with the opinion of the Committee on Fees, Implementation Rules and the Procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (trade marks and designs),

HAS ADOPTED THIS REGULATION:

Article 1

Article 1 of Regulation (EC) No 2868/95 is amended as follows:

1. **Rule 1(1) is amended as follows:**

(a) point (b) is replaced by the following:

(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 persons 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

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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;

(b) in point (c), the following is added:

‘, or a reference to the list of the goods and services of a previous Community trade mark application;’

(c) point (k) is replaced by the following:

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

(d) point (l) is added:

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

2. **Rule 3 is amended as follows:**

(a) paragraph 2 is replaced by the following:

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 × 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.;

(b) paragraphs 5 and 6 are replaced by the following:

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.;

3. **Rule 4 is replaced by the following:**

Rule 4 Fees for the application

The fees payable for the application shall be:

(a) the basic fee;

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(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.;

4. **The following Rule 5a is inserted:**

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.;

5. **In Rule 6(1) the following sentence is added:**

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.;

6. **Rule 8(2) is replaced by the following:**

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.;

7. **Rule 10 is replaced by the following:**

Rule 10 Searches by national offices

1. If the request for a search report referred to in Article 39(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.

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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) 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.;

8. **Point (c) of Rule 12 is replaced by the following:**

(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;

9. **In Rule 13, point (c) of paragraph 1, and paragraph 2 are deleted;**

10. **The following Rule 13a is inserted:**

Rule 13a Division of the application

1. A declaration of the division of the application pursuant to Article 44a 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) 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) of the Regulation;

(c) the period after the date of issue of the notification to pay the registration fee referred to in Rule 23(1).

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