

Summary of Contents

Foreword	V
Preface	VII
List of Authors	XVII
List of Abbreviations	XXI
General Bibliography	XXV

A. Commentary	1
---------------------	---

TITLE I GENERAL PROVISIONS

Article 1	EU trade mark	9
Article 2	Office	41
Article 3	Capacity to act	45

TITLE II THE LAW RELATING TO TRADE MARKS

SECTION 1	Definition of an EU trade mark and obtaining an EU trade mark	54
Article 4	Signs of which an EU trade mark may consist	54
Article 5	Persons who can be proprietors of EU trade marks	69
Article 6	Means whereby an EU trade mark is obtained	74
Article 7	Absolute grounds for refusal	79
Article 8	Relative grounds for refusal	218
SECTION 2	Effects of an EU trade mark	325
Article 9	Rights conferred by an EU trade mark	325
Article 10	Right to prohibit preparatory acts in relation to the use of packaging or other means	422
Article 11	Date from which rights against third parties prevail	423
Article 12	Reproduction of an EU trade mark in a dictionary	425
Article 13	Prohibition of the use of an EU trade mark registered in the name of an agent or representative	428
Article 14	Limitation of the effects of an EU trade mark	428
Article 15	Exhaustion of the rights conferred by an EU trade mark	444
Article 16	Intervening right of the proprietor of a later registered trade mark as a defence in infringement proceedings	459
Article 17	Complementary application of national law relating to infringement	463
SECTION 3	Use of an EU trade mark	465
Article 18	Use of an EU trade mark	465
SECTION 4	EU trade marks as objects of property	494
Article 19	Dealing with EU trade marks as national trade marks	494
Article 20	Transfer	513
Article 21	Transfer of a trade mark registered in the name of an agent	529
Article 22	Rights in rem	536
Article 23	Levy of execution	541
Article 24	Insolvency proceedings	545
Article 25	Licensing	549
Article 26	Procedure for entering licences and other rights in the Register	569
Article 27	Effects vis-à-vis third parties	573
Article 28	The application for an EU trade mark as an object of property	580
Article 29	Procedure for cancelling or modifying the entry in the Register of licences and other rights	581

TITLE III APPLICATION FOR EUTM TRADE MARKS

SECTION 1 Filing of applications and the conditions which govern them	583
Article 30 Filing of applications	583
Article 31 Conditions with which applications must comply	587
Article 32 Date of Filing	598
Article 33 Designation and classification of goods and services	602
SECTION 2 Priority	626
Article 34 Right of priority	626
Article 35 Claiming priority	634
Article 36 Effect of priority right	636
Article 37 Equivalence of Union filing with national filing	636
SECTION 3 Exhibition priority	638
Article 38 Exhibition priority	638
SECTION 4 Claiming the seniority of a national trade mark	642
Article 39 Claiming the seniority of a national trade mark in an application for an EU trade mark or subsequent to the filing of the application	642
Article 40 Claiming seniority of a national trade mark after registration of an EU trade mark	651

TITLE IV REGISTRATION PROCEDURE

SECTION 1 Examination of applications	653
Article 41 Examination of the conditions of filing	653
Article 42 Examination as to absolute grounds for refusal	668
SECTION 2 Search	681
Article 43 Search report	681
SECTION 3 Publication of the application	686
Article 44 Publication of the application	686
SECTION 4 Observations by third parties and opposition	688
Article 45 Observations by third parties	688
Article 46 Opposition	692
Article 47 Examination of opposition	712
Article 48 Delegation of powers	722
SECTION 5 Withdrawal, restriction, amendment and division of the application	723
Article 49 Withdrawal, restriction and amendment of the application	723
Article 50 Division of the application	729
SECTION 6 Registration	735
Article 51 Registration	735

TITLE V DURATION, RENEWAL, ALTERATION AND DIVISION OF EUROPEAN UNION TRADE MARKS

Article 52 Duration of Registration	739
Article 53 Renewal	739
Article 54 Alteration	747
Article 55 Change of name or address	748
Article 56 Division of the registration	750

TITLE VI SURRENDER, REVOCATION AND INVALIDITY

SECTION 1 Surrender	753
Article 57 Surrender	753
SECTION 2 Grounds for revocation	758
Article 58 Grounds for revocation	758
SECTION 3 Grounds for invalidity	768
Article 59 Absolute grounds for invalidity	768
Article 60 Relative grounds for invalidity	776
Article 61 Limitation in consequence of acquiescence	781
SECTION 4 Consequences of revocation and invalidity	784
Article 62 Consequences of revocation and invalidity	784
SECTION 5 Proceedings in the Office in relation to revocation or invalidity	786
Article 63 Application for revocation or for a declaration of invalidity	786
Article 64 Examination of the application	790
Article 65 Delegation of powers	794

TITLE VII APPEALS

Article 66 Decisions subject to appeal	795
Article 67 Persons entitled to appeal and to be parties to appeal proceedings	798
Article 68 Time limit and form of appeal	802
Article 69 Revision of decisions in ex parte cases	807
Article 70 Examination of appeals	808
Article 71 Decisions in respect of appeals	815
Article 72 Actions before the Court of Justice	818
Article 73 Delegation of powers	858

TITLE VIII SPECIFIC PROVISIONS ON EUROPEAN UNION COLLECTIVE MARKS AND CERTIFICATION MARKS

SECTION 1 EU collective marks	860
Article 74 EU collective marks	860
Article 75 Regulations governing use of an EU collective mark	876
Article 76 Refusal of the application	878
Article 77 Observations by third parties	880
Article 78 Use of marks	880
Article 79 Amendment of the regulations governing use of the EU collective mark	881
Article 80 Persons who are entitled to bring an action for infringement	882
Article 81 Grounds for revocation	883
Article 82 Grounds for invalidity	885
SECTION 2 EU certification marks	886
Article 83 EU certification marks	886
Article 84 Regulations governing use of an EU certification mark	899
Article 85 Refusal of the application	904
Article 86 Observations by third parties	908
Article 87 Use of the EU certification mark	908
Article 88 Amendment of the regulations governing use of the EU certification mark	910
Article 89 Transfer	911
Article 90 Persons who are entitled to bring an action for infringement	912
Article 91 Grounds for revocation	914
Article 92 Grounds for invalidity	917
Article 93 Conversion	918

TITLE IX PROCEDURE

SECTION 1 General provisions	919
Article 94 Decisions and communications of the Office	919
Article 95 Examination of the facts by the Office of its own motion	929
Article 96 Oral proceedings	940
Article 97 Taking of evidence	945
Article 98 Notification	959
Article 99 Notification of loss of rights	965
Article 100 Communications to the Office	966
Article 101 Time limits	970
Article 102 Correction of errors and manifest oversights	975
Article 103 Revocation of decisions	977
Article 104 Restitutio in integrum	982
Article 105 Continuation of proceedings	1002
Article 106 Interruption of proceedings	1007
Article 107 Reference to general principles	1009
Article 108 Termination of financial obligations	1013
SECTION 2 Costs	1017
Article 109 Costs	1017
Article 110 Enforcement of decisions fixing the amount of costs	1038
SECTION 3 Information which may be made available to the public and to the authorities of the Member States	1041
Article 111 Register of EU trade marks	1041
Article 112 Database	1047
Article 113 Online access to decisions	1048
Article 114 Inspection of files	1049
Article 115 Keeping of Files	1059
Article 116 Periodical publications	1060
Article 117 Administrative cooperation	1063
Article 118 Exchange of publications	1066
SECTION 4 Representation	1067
Article 119 General principles of representation	1067
Article 120 Professional representatives	1071
Article 121 Delegation of powers	1077

TITLE X JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO EU TRADE MARKS

SECTION 1 Application of Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters	1079
Article 122 Application of Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters	1079
SECTION 2 Disputes concerning the infringement and validity of EU trade marks	1085
Article 123 EU trade mark courts	1085
Article 124 Jurisdiction over infringement and validity	1091
Article 125 International jurisdiction	1094
Article 126 Extent of jurisdiction	1103
Article 127 Presumption of validity – Defence as to the merits	1106
Article 128 Counterclaims	1109
Article 129 Applicable law	1120
Article 130 Sanctions	1124
Article 131 Provisional and protective measures	1128
Article 132 Specific rules on related actions	1139
Article 133 Jurisdiction of EU trade mark courts of second instance – Further appeal	1145

SECTION 3 Other disputes concerning EU trade marks	1147
Article 134 Supplementary provisions on the jurisdiction of national courts other than EU trade mark courts	1147
Article 135 Obligation of the national court	1149

TITLE XI EFFECTS ON THE LAWS OF THE MEMBER STATES

SECTION 1 Civil actions on the basis of more than one trade mark	1151
Article 136 Simultaneous and successive civil actions on the basis of EU trade marks and national trade marks	1151
SECTION 2 Application of national laws for the purpose of prohibiting the use of EU trade marks	1154
Article 137 Prohibition of use of EU trade marks	1154
Article 138 Prior rights applicable to particular localities	1161
SECTION 3 Conversion into a national trade mark application	1163
Article 139 Request for the application of national procedure	1163
Article 140 Submission, publication and transmission of the request for conversion	1177
Article 141 Formal requirements for conversion	1183

TITLE XII THE OFFICE

SECTION 1 General provisions	1187
Article 142 Legal status	1187
Article 143 Staff	1188
Article 144 Privileges and immunities	1192
Article 145 Liability	1196
Article 146 Languages	1199
Article 147 Publication and entries in the Register	1222
Article 148 Translation services	1226
Article 149 Transparency	1227
Article 150 Security rules on the protection of classified and sensitive non-classified information	1230
SECTION 2 Tasks of the office and cooperation to promote convergence	1232
Article 151 Tasks of the Office	1232
Article 152 Cooperation to promote convergence of practices and tools	1234
SECTION 3 Management Board	1237
Article 153 Functions of the Management Board	1237
Article 154 Composition of the Management Board	1240
Article 155 Chairperson of the Management Board	1242
Article 156 Meetings	1244
SECTION 4 Executive Director	1247
Article 157 Functions of the Executive Director	1247
Article 158 Appointment and removal of the Executive Director and extension of term of office	1251
SECTION 5 Implementation of procedures	1254
Article 159 Competence	1254
Article 160 Examiners	1256
Article 161 Opposition Divisions	1258
Article 162 Department in charge of the Register	1260
Article 163 Cancellation Divisions	1263
Article 164 General Competence	1265
Article 165 Boards of Appeal	1267
Article 166 Independence of the members of the Boards of Appeal	1272
Article 167 Presidium of the Boards of Appeal and Grand Board	1278
Article 168 Delegation of powers	1280
Article 169 Exclusion and objection	1282
Article 170 Mediation centre	1285

SECTION 6 Budget and financial control	1289
Article 171 Budget Committee	1289
Article 172 Budget	1292
Article 173 Preparation of the budget	1297
Article 174 Audit and control	1298
Article 175 Combating fraud	1300
Article 176 Auditing of accounts	1302
Article 177 Financial provisions	1304
Article 178 Fees and charges and due date	1305
Article 179 Payment of fees and charges	1307
Article 180 Deemed date of payment	1311
Article 181 Insufficient payments and refund of insignificant amounts	1313

TITLE XIII INTERNATIONAL REGISTRATION OF MARKS

SECTION 1 General provisions	1315
Article 182 Application of provisions	1315
SECTION 2 International registration on the basis of applications for an EU trade mark and of EU trade marks	1326
Article 183 Filing of an international application	1326
Article 184 Form and contents of the international application	1329
Article 185 Recordal in the files and in the Register	1340
Article 186 Notification of the invalidity of the basic application or registration	1341
Article 187 Request for territorial extension subsequent to the international registration	1343
Article 188 International fees	1349
SECTION 3 International registrations designating the Union	1350
Article 189 Effects of international registrations designating the Union	1350
Article 190 Publication	1355
Article 191 Seniority claimed in an international application	1358
Article 192 Seniority claimed before the Office	1361
Article 193 Designation of goods and services and examination as to absolute grounds for refusal	1363
Article 194 Collective and certification marks	1369
Article 195 Search	1370
Article 196 Opposition	1372
Article 197 Replacement of an EU trade mark by an international registration	1377
Article 198 Invalidation of the effects of an international registration	1379
Article 199 Legal effect of registration of transfers	1381
Article 200 Legal effect of registration of licenses and other rights	1382
Article 201 Examination of requests for registration of transfers, licences or restrictions of a holder's right of disposal	1383
Article 202 Conversion of a designation of the Union through an international registration into a national trade mark application or into a designation of Member States	1384
Article 203 Use of a mark subject of an international registration	1389
Article 204 Transformation	1389
Article 205 Communication with the International Bureau	1394
Article 206 Use of languages	1394

TITLE XIV FINAL PROVISIONS

Article 207 Committee Procedure	1395
Article 208 Exercise of the delegation	1396
Article 209 Provisions relating to the enlargement of the Union	1399
Article 210 Evaluation and review	1406
Article 211 Repeal	1408
Article 212 Entry into force	1408

B. Measures under Enforcement Directive 2004/48/EC	1411
C. Litigation in EU Member States	1423
Austria	1423
Belgium	1431
Bulgaria	1439
Croatia	1445
Cyprus	1453
Czech Republic	1459
Denmark	1467
Estonia	1475
Finland	1480
France	1487
Germany	1496
Greece	1502
Hungary	1508
Ireland	1517
Italy	1524
Latvia	1534
Lithuania	1543
Luxembourg	1554
Malta	1564
The Netherlands	1570
Poland	1576
Portugal	1581
Romania	1585
Slovakia	1592
Slovenia	1600
Spain	1609
Sweden	1616
United Kingdom	1622
D. Annexes	1631
Annex 1	DIRECTIVE (EU) 2015/2436 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast) 1631
Annex 2	COMMISSION DELEGATED REGULATION (EU) 2018/625 of 5 March 2018 1653
Annex 3	COMMISSION DELEGATED REGULATION (EU) 2018/625 of 5 March 2018 1684
Annex 4	DIRECTIVE 2004/48/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL 1701
E. Table of Cases	1711
Index	1757