

Table of Contents

Preface	V
List of Authors.....	XV
Abbreviations	XVII

CHAPTER I GENERAL PROVISIONS

Art. 1. EU trade mark.....	1
Art. 2. Office.....	16
Art. 3. Capacity to act.....	19

CHAPTER II LAW RELATING TO TRADE MARKS

Section 1. Definition of an EU trade mark and obtaining an EU trade mark

Art. 4. Signs of which an EU trade mark may consist.....	21
Art. 5. Persons who can be proprietors of EU trade marks	26
Art. 6. Means whereby an EU trade mark is obtained	27
Art. 7. Absolute grounds for refusal	28
Art. 8. Relative grounds for refusal.....	126

Section 2. Effects of an EU trade mark

Art. 9. Rights conferred by an EU trade mark.....	274
Art. 10. Right to prohibit preparatory acts in relation to the use of packaging or other means.....	294
Art. 11. Date from which rights against third parties prevail.....	296
Art. 12. Reproduction of an EU trade mark in a dictionary	299
Art. 13. Prohibition of the use of an EU trade mark registered in the name of an agent or representative.....	303
Art. 14. Limitation of the effects of an EU trade mark.....	310
Art. 15. Exhaustion of the rights conferred by an EU trade mark.....	320
Art. 16. Intervening right of the proprietor of a later registered trade mark as a defence in infringement proceedings	346
Art. 17. Complementary application of national law relating to infringement.....	358

Section 3. Use of an EU trade mark

Art. 18. Use of an EU trade mark.....	361
---------------------------------------	-----

Section 4. EU trade marks as objects of property

Art. 19. Dealing with EU trade marks as national trade marks.....	386
Art. 20. Transfer	394
Art. 21. Transfer of a trade mark registered in the name of an agent	408
Art. 22. Rights in rem	414
Art. 23. Levy of execution	415
Art. 24. Insolvency proceedings.....	418
Art. 25. Licensing	424

VII

Art. 26. Procedure for entering licences and other rights in the Register	441
Art. 27. Effects vis-à-vis third parties	443
Art. 28. The application for an EU trade mark as an object of property	448
Art. 29. Procedure for cancelling or modifying the entry in the Register of licences and other rights	449

CHAPTER III APPLICATION FOR EU TRADE MARKS

Section 1. Filing of applications and the conditions which govern them

Art. 30. Filing of applications	451
Art. 31. Conditions with which applications must comply	455
Art. 32. Date of filing	466
Art. 33. Designation and classification of goods and services	467

Section 2. Priority

Art. 34. Right of priority	475
Art. 35. Claiming priority	481
Art. 36. Effect of priority right	484
Art. 37. Equivalence of Union filing with national filing	484

Section 3. Exhibition priority

Art. 38. Exhibition priority	485
------------------------------------	-----

Section 4. Seniority of a national trade mark

Art. 39. Claiming seniority of a national trade mark in an application for an EU trade mark or subsequent to the filing of the application	489
Art. 40. Claiming seniority of a national trade mark after registration of an EU trade mark	499

CHAPTER IV REGISTRATION PROCEDURE

Section 1. Examination of applications

Art. 41. Examination of the conditions of filing	503
Art. 42. Examination as to absolute grounds for refusal	520

Section 2. Search

Art. 43. Search report	543
------------------------------	-----

Section 3. Publication of the application

Art. 44. Publication of the application	550
---	-----

Section 4. Observations by third parties and opposition

Art. 45. Observations by third parties	556
Art. 46. Opposition	561
Art. 47. Examination of opposition	562
Art. 48. Delegation of powers	601

**Section 5. Withdrawal, restriction, amendment and
division of the application**

Art. 49. Withdrawal, restriction and amendment of the application.....	602
Art. 50. Division of the application	610

Section 6. Registration

Art. 51. Registration.....	615
----------------------------	-----

CHAPTER V

DURATION, RENEWAL, ALTERATION AND DIVISION OF EU TRADE MARKS

Art. 52. Duration of registration.....	619
Art. 53. Renewal	622
Art. 54. Alteration	629
Art. 55. Change of the name or address.....	632
Art. 56. Division of the registration.....	634

CHAPTER VI

SURRENDER, REVOCATION AND INVALIDITY

Section 1. Surrender

Art. 57. Surrender	639
--------------------------	-----

Section 2. Grounds for revocation

Art. 58. Grounds for revocation	643
---------------------------------------	-----

Section 3. Grounds for invalidity

Art. 59. Absolute grounds for invalidity.....	649
Art. 60. Relative grounds for invalidity.....	656
Art. 61. Limitation in consequence of acquiescence.....	662

Section 4. Consequences of revocation and invalidity

Art. 62. Consequences of revocation and invalidity	667
--	-----

Section 5. Proceedings in the office in relation to revocation or invalidity

Art. 63. Application for revocation or for a declaration of invalidity	670
Art. 64. Examination of the application	675
Art. 65. Delegation of powers.....	690

CHAPTER VII

APPEALS

Art. 66. Decisions subject to appeal.....	693
Art. 67. Persons entitled to appeal and to be parties to appeal proceedings	695
Art. 68. Time limit and form of appeal	698
Art. 69. Revision of decisions in ex parte cases	708
Art. 70. Examination of appeals	710
Art. 71. Decisions in respect of appeals.....	716
Art. 72. Actions before the Court of Justice	722
Art. 73. Delegation of powers.....	757

CHAPTER VIII

SPECIFIC PROVISIONS ON EUROPEAN UNION COLLECTIVE MARKS AND CERTIFICATION MARKS

Section 1. EU collective marks

Art. 74. EU collective marks	759
Art. 75. Regulations governing use of an EU collective mark	765
Art. 76. Refusal of the application	767
Art. 77. Observations by third parties	769
Art. 78. Use of marks	770
Art. 79. Amendment of the regulations governing use of the EU collective mark ...	771
Art. 80. Persons who are entitled to bring an action for infringement	773
Art. 81. Grounds for revocation	774
Art. 82. Grounds for invalidity	775

Section 2. EU certification marks

Art. 83. EU certification marks	776
Art. 84. Regulations governing use of an EU certification mark	788
Art. 85. Refusal of the application	791
Art. 86. Observations by third parties	794
Art. 87. Use of the EU certification mark	794
Art. 88. Amendment of the regulations governing use of the EU certification mark ...	795
Art. 89. Transfer	796
Art. 90. Persons who are entitled to bring an action for infringement	796
Art. 91. Grounds for revocation	798
Art. 92. Grounds for invalidity	802
Art. 93. Conversion	802

CHAPTER IX

PROCEDURE

Section 1. General provisions

Art. 94. Decisions and communications of the Office	805
Art. 95. Examination of the facts by the Office of its own motion	822
Art. 96. Oral proceedings	846
Art. 97. Taking of evidence	851
Art. 98. Notification	871
Art. 99. Notification of loss of rights	882
Art. 100. Communications to the Office	883
Art. 101. Time limits	887
Art. 102. Correction of errors and manifest oversights	893
Art. 103. Revocation of decisions	897
Art. 104. Restitutio in integrum	905
Art. 105. Continuation of proceedings	925
Art. 106. Interruption of proceedings	935
Art. 107. Reference to general principles	941
Art. 108. Termination of financial obligations	943

Section 2. Costs

Art. 109. Costs	946
Art. 110. Enforcement of decisions fixing the amount of costs	960

Section 3. Information which may be made available to the public and to the authorities of the Member States

Art. 111. Register of EU trade marks	963
Art. 112. Database	966
Art. 113. Online access to decisions	968
Art. 114. Inspection of files.....	972
Art. 115. Keeping of files.....	983
Art. 116. Periodical publications.....	984
Art. 117. Administrative cooperation	987
Art. 118. Exchange of publications	989

Section 4. Representation

Art. 119. General principles of representation	989
Art. 120. Professional representatives.....	994
Art. 121. Delegation of powers	1005

CHAPTER 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

Art. 122. Application of Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters.....	1007
---	------

Section 2. Disputes concerning the infringement and validity of EU trade marks

Art. 123. EU trade mark courts	1024
Art. 124. Jurisdiction over infringement and validity.....	1030
Art. 125. International jurisdiction	1037
Art. 126. Extent of jurisdiction	1056
Art. 127. Presumption of validity – Defence as to the merits	1058
Art. 128. Counterclaims.....	1062
Art. 129. Applicable law	1076
Art. 130. Sanctions.....	1085
Art. 131. Provisional and protective measures.....	1100
Art. 132. Specific rules on related actions	1109
Art. 133. Jurisdiction of EU trade mark courts of second instance – Further appeal	1118

Section 3. Other disputes concerning EU trade marks

Art. 134. Supplementary provisions on the jurisdiction of national courts other than EU trade mark courts.....	1120
Art. 135. Obligation of the national court.....	1122

CHAPTER XI EFFECTS ON THE LAWS OF THE MEMBER STATES

Section 1. Civil actions on the basis of more than one trade mark

Art. 136. Simultaneous and successive civil actions on the basis of EU trade marks and national trade marks.....	1125
---	------

Section 2. Application of national laws for the purpose of prohibiting the use of EU trade marks

Art. 137. Prohibition of use of EU trade marks.....	1131
Art. 138. Prior rights applicable to particular localities	1133

Section 3. Conversion into a national trade mark application

Art. 139. Request for the application of national procedure	1135
Art. 140. Submission, publication and transmission of the request for conversion..	1146
Art. 141. Formal requirements for conversion.....	1150

CHAPTER XII THE OFFICE

Section 1. General provisions

Art. 142. Legal status	1153
Art. 143. Staff	1153
Art. 144. Privileges and immunities.....	1154
Art. 145. Liability.....	1154
Art. 146. Languages	1156
Art. 147. Publication and entries in the Register.....	1169
Art. 148. Translation services.....	1170
Art. 149. Transparency	1170
Art. 150. Security rules on the protection of classified and sensitive non-classified information	1171

Section 2. Tasks of the office and cooperation to promote convergence

Art. 151. Tasks of the Office.....	1171
Art. 152. Cooperation to promote convergence of practices and tools.....	1172

Section 3. Management Board

Art. 153. Functions of the Management Board	1173
Art. 154. Composition of the Management Board.....	1175
Art. 155. Chairperson of the Management Board.....	1175
Art. 156. Meetings.....	1176

Section 4. Executive Director

Art. 157. Functions of the Executive Director.....	1176
Art. 158. Appointment and removal of the Executive Director and extension of term of office	1178

Section 5. Implementation of procedures

Art. 159. Competence.....	1179
Art. 160. Examiners	1179
Art. 161. Opposition Divisions	1179
Art. 162. Department in charge of the Register.....	1180
Art. 163. Cancellation Divisions	1180
Art. 164. General Competence.....	1181
Art. 165. Boards of Appeal	1181
Art. 166. Independence of the members of the Boards of Appeal.....	1182
Art. 167. Presidium of the Boards of Appeal and Grand Board.....	1183
Art. 168. Delegation of powers	1184

Art. 169. Exclusion and objection	1184
Art. 170. Mediation centre	1185

Section 6. Budget and financial control

Art. 171. Budget Committee	1187
Art. 172. Budget	1187
Art. 173. Preparation of the budget	1189
Art. 174. Audit and control	1190
Art. 175. Combating fraud	1190
Art. 176. Auditing of accounts	1191
Art. 177. Financial provisions	1191
Art. 178. Fees and charges and due date	1191
Art. 179. Payment of fees and charges	1196
Art. 180. Deemed date of payment	1200
Art. 181. Insufficient payments and refund of insignificant amounts	1203

CHAPTER XIII INTERNATIONAL REGISTRATION OF MARKS

Section 1. General provisions

Art. 182. Application of provisions	1207
---	------

Section 2. International registration on the basis of applications for an EU trade mark and of EU trade marks

Art. 183. Filing of an international application	1211
Art. 184. Form and contents of the international application	1214
Art. 185. Recordal in the files and in the Register	1219
Art. 186. Notification of the invalidity of the basic application or registration	1221
Art. 187. Request for territorial extension subsequent to International Registration	1222
Art. 188. International fees	1225

Section 3. International registrations designating the Union

Art. 189. Effects of International Registrations designating the Union	1226
Art. 190. Publication	1229
Art. 191. Seniority claimed in an international application	1231
Art. 192. Seniority claimed before the Office	1234
Art. 193. Designation of goods and services and examination as to absolute grounds for refusal	1235
Art. 194. Collective and certification marks	1239
Art. 195. Search	1240
Art. 196. Opposition	1241
Art. 197. Replacement of an EU trade mark by an International Registration	1245
Art. 198. Invalidation of the effects of an International Registration	1247
Art. 199. Legal effect of registration of transfers	1248
Art. 200. Legal effect of registration of licences and other rights	1249
Art. 201. Examination of requests for registration of transfers, licences or restrictions of a holder's right of disposal	1250
Art. 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	1251
Art. 203. Use of a mark subject of an International Registration	1255

Art. 204. Transformation	1256
Art. 205. Communication with the International Bureau	1258
Art. 206. Use of languages	1259

CHAPTER XIV

FINAL PROVISIONS

Art. 207. Committee Procedure	1261
Art. 208. Exercise of the delegation	1261
Art. 209. Provisions relating to the enlargement of the Union.....	1262
Art. 210. Evaluation and review	1263
Art. 211. Repeal	1264
Art. 212. Entry into force	1264
Directive 2004/48/EC of the European Parliament and of the Council	1265
Commission Delegated Regulation (EU) 2018/625	1285
Commission Implementing Regulation (EU) 2018/626	1331
Index	1357