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NOTE

From:	General Secretariat of the Council
To:	Delegations
No. Cion doc.:	8065/13 PI 51 CODEC 710
Subject:	Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark - Presidency compromise proposal

Delegations will find in the Annex a Presidency compromise proposal concerning the above-mentioned Regulation.

At this stage, the Presidency compromise proposal does not touch upon the recitals.

Changes in relation to the Commission proposal (8065/13) are highlighted.

The terms "European trade mark", "Agency", "Executive Director", "Management Board" and "Deputy Executive Director" have been replaced throughout the text by the terms "European Union trade mark", "Office", "President", "Administrative Board" and "Vice-President" respectively. Such replacements have not been highlighted.

Draft

REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL
amending Council Regulation (EC) No 207/2009 on the Community trade mark

(Text with EEA relevance)

NB : *Recitals To be addressed at a later stage*

Article 1

Regulation (EC) No 207/2009 is amended as follows:

- (1) In the title, 'Community trade mark' is replaced by 'European Union_trade mark';
- (2) Throughout the Regulation, the words 'Community trade mark' are replaced by 'European Union trade mark' and any necessary grammatical changes are made;
- (3) Throughout the Regulation, the words 'Community trade mark court' are replaced by 'European Union trade mark court' and any necessary grammatical changes are made;
- (4) Throughout the Regulation, the words 'Community collective mark' are replaced by 'European Union collective mark' and any necessary grammatical changes are made;
- (5) Throughout the Regulation, except in the cases referred to in points (2), (3) and (4), the words 'Community', 'European Community' and 'European Communities' are replaced by 'Union' and any necessary grammatical changes are made;

- (6) Deleted.
- (7) Deleted.
- (8) Deleted.
- (9) Article 4 is replaced by the following:

'Article 4

Signs of which a European Union trade mark may consist

A European Union trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours [...] the shape of goods or of their packaging, or sounds, provided that such signs are capable of

- (a) distinguishing the goods or services of one undertaking from those of other undertakings;
- and
- (b) being represented on the Register of European Union trade marks (hereinafter 'the Register') in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.';

- (10) Article 7(1) is amended as follows:

- (a) points (e), (j) and (k) are replaced by the following:

'(e) signs which consist exclusively of:

- (i) the shape or other characteristics which result from the nature of the goods themselves;
- (ii) the shape or other characteristics of goods which are necessary to obtain a technical result;
- (iii) the shape or other characteristics of goods which gives substantial value to the goods;'

'(j) trade marks which are excluded from registration [...] pursuant to [national or Union legislation or international agreements to which the Union [or the Member State concerned] is party, providing for protection of designations of origin and geographical indications;'

'(k) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine and traditional specialities guaranteed;'

(aa) the following point (l) is added:

(l) trade marks which contain or consist of an earlier variety denomination registered in accordance with Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights or national legislation providing for plant variety denominations with respect to the same type of product.';

(b) Deleted;

(11) Article 8 is amended as follows:

(a) paragraph 3 is replaced by the following:

'3. Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered:

(a) where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action;

[(b) where the trade mark is liable to be confused with an earlier trade mark protected either within or outside the Union, provided that, at the date of the application, the applicant was acting in bad faith.];'

(b) in paragraph 4, the introductory phrase is replaced by the following:

4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to Union legislation [Option 1 : providing for protection of designations of origin and geographical indications], or the law of the Member State governing that sign:'

[Option 2 : “4a. Upon opposition by any beneficiary of the protection of a designation of origin or a geographical indication [or: ... by any person entitled to use the designation of origin or the geographical indication concerned], the trade mark applied for shall not be registered if it is excluded from registration pursuant to the legislation of the Union or a Member State providing for the protection of designations of origin and geographical indications.”]

(c) paragraph 5 is replaced by the following:

5. Upon opposition by the proprietor of an earlier registered trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.';

(12) Article 9 is replaced by the following:

'Article 9

Rights conferred by a European Union trade mark

1. The registration of a European Union trade mark shall confer on the proprietor exclusive rights.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the European Union trade mark, the proprietor of a European Union trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign in relation to goods or services where:
 - (a) the sign is identical with the European Union trade mark and is used in relation to goods or services which are identical with those for which the European Union trade mark is registered [...];
 - (b) the sign is identical, or similar to, the European Union trade mark and is used for goods or services which are identical with or similar to the goods or services for which the European Union trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
 - (c) the sign is identical with, or similar to, the European Union trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the European Union trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the European Union trade mark.

3. The following, in particular, may be prohibited under paragraph 2:
- (a) affixing the sign to the goods or to the packaging thereof;
 - (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
 - (c) importing or exporting the goods under that sign;
 - (d) using the sign as a trade or company name, or as a part thereof, or as a domain name;
 - (e) using the sign on business papers and in advertising;
 - (f) using the sign in comparative advertising in a way which is contrary to Directive 2006/114/EC.
4. [OPTION 1¹: The proprietor of a European Union trade mark shall also be entitled to prevent the importing of goods pursuant to paragraph 3(c) into the Union where only the consignor of the goods acts in the course of trade.] [OPTION 2 (text to be added to Option 1): and where such goods, including packaging, bear without authorisation a trade mark which is identical to the European Union trade mark registered in respect of such goods, or which cannot be distinguished in each essential aspect from that trade mark.]

¹ In the light of the CJEU judgment in Case C-98/13 of 6 February 2014 the original proposal of the Commission should be reconsidered.

5. [OPTION 1 :The proprietor of a European Union trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade , into the [...] Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the European Union trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.]
- [OPTION 2 : Without prejudice to WTO rules, in particular Article V of the GATT on freedom of transit, the proprietor of a European Union trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade , into the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the European Union trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.]²

(13) The following Articles 9a and 9b are inserted:

'Article 9a

Infringement of the rights of the proprietor by use of get-up, packaging or other means

Where the risk exists that the get-up, packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed will be used for goods or services and the use in relation to those goods or services would constitute an infringement of the rights of the proprietor under Article 9(2) and (3), the proprietor of a European Union trade mark shall have the right to prohibit the following:

² Option 2 entails also the rewording of recital 18 as follows : '(18) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively and without prejudice to WTO rules, in particular Article V of the GATT on freedom of transit, the proprietor of a European trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Union without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is essentially identical to the European trade mark registered in respect of such goods. This shall be without prejudice to the smooth transit of generic medicines, in compliance with the international obligations of the European Union, in particular the ‘Declaration on the TRIPS Agreement and Public Health’ adopted by the Doha WTO Ministerial Conference on 14 November 2001.'

- (a) affixing in the course of trade a sign identical with or similar to the European Union trade mark on get-up, packaging labels, tags, security or authenticity features or devices or any other means on which the mark may be affixed;
- (b) offering or placing on the market, or stocking for those purposes, or importing or exporting get-up, packaging labels, tags, security or authenticity features or devices or any other means on which the mark is affixed.

Article 9b

Date of prevailing of rights against third parties

1. The rights conferred by a European Union trade mark shall prevail against third parties from the date of publication of the registration of the trade mark.
2. Reasonable compensation may be claimed in respect of acts occurring after the date of publication of a European Union trade mark application, where those acts would, after publication of the registration of the trade mark, be prohibited by virtue of that publication.
3. The court seized of a case may not decide upon the merits of the case until the registration has been published.';

(14) Article 12 is replaced by the following:

'Article 12

Limitation of the effects of a European Union trade mark

1. A European Union trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:
 - (a) where the third party is a natural person, his own full name or surname or address;
 - (b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services;
 - (c) the trade mark where that is necessary for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular [...] to indicate the intended purpose of a good or service, in particular as accessories or spare parts.

[...] (*second subparagraph moved into (2) below*)

2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters. In particular, the use by a third party shall be considered not to be in accordance with honest practices [...] in any of the following cases:

- (a) it gives the incorrect impression that there is a commercial connection between the third party and the proprietor of the trade mark;
- (b) it takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark without due cause.';

(15) In Article 13(1), the words 'in the Community' are replaced by 'in the European Economic Area';

(16) The following Article 13a is inserted:

'Article 13a

Intervening right of the proprietor of a later registered trade mark as defence in infringement proceedings

1. In infringement proceedings, the proprietor of a European Union trade mark shall not be entitled to prohibit the use of a later registered European Union trade mark where that later trade mark would not be declared invalid pursuant to Articles 53(3) and (4), 54(1) and (2) and 57(2) of this Regulation.
2. In infringement proceedings, the proprietor of a European Union trade mark shall not be entitled to prohibit the use of a later registered national trade mark where that later registered national trade mark would not be declared invalid pursuant to Articles 8, 9(1) and (2) and 48(3) of Directive [xxx].
3. Where the proprietor of a European Union trade mark is not entitled to prohibit the use of a later registered trade mark pursuant to paragraphs 1 or 2 of this Article, the proprietor of that later registered trade mark shall not be entitled to prohibit the use of that earlier European Union trade mark in infringement proceedings.;

(17) In Article 15(1), the second subparagraph is replaced by the following:

'The following shall also constitute use within the meaning of the first paragraph:

- (a) use of the European Union trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered;
- (b) affixing of the European Union trade mark to goods or to the packaging thereof in the Union solely for export purposes.;

(18) In Article 16(1), the introductory sentence is replaced by the following:

'1. Unless Articles 17 to 24 provide otherwise, a European Union trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Union, as a national trade mark registered in the Member State in which, according to the [...] Register:';

(19) Article 17 shall be amended as follows:

(a) paragraph 4 is deleted;

(b) The following paragraph is inserted:³

"5a. An application for registration of a transfer shall contain sufficient information to identify the European Union trade mark, the new proprietor, the goods and services to which the transfer relates, as well as documents duly establishing the transfer. The application shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office.

The Commission shall adopt an implementing act specifying the mandatory elements of the application for registration of the transfer, the documents that shall constitute sufficient proof of transfer and operational rules concerning the processing of such applications. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).

A single application for registration of a transfer may be submitted for two or more marks, provided that the registered proprietor and the successor in title are the same in each case."

[Need to reflect also Rule 32(5)]

³ Rules 31 and 32

(20) Article 18 is replaced by the following:

'Article 18

Transfer of a trade mark registered in the name of an agent

1. Where a European Union trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorisation, the latter shall be entitled to demand the assignment of the European Union trade mark in his favour, unless such agent or representative justifies his action.
2. The proprietor may submit a request for assignment pursuant to paragraph 1 to the following:
 - (a) the Office, instead of an application for a declaration of invalidity based on Article 53(1)(b);
 - (b) a European Union trade mark court as referred to in Article 95, instead of a counterclaim for a declaration of invalidity based on Article 100(1).'

(21) Article 19 is amended as follows:

- (a) paragraph 2 is replaced by the following:
 - '2. On request of one of the parties, the rights referred to in paragraph 1 or the transfer of those rights shall be entered in the Register and published.'
- (b) the following paragraph 3 is added:
 - '3. An entry in the Register effected pursuant to paragraph 2 shall be cancelled or modified on request of one of the parties.'

(22) In Article 20, the following paragraph 4 is added:

- '4. An entry in the Register effected pursuant to paragraph 3 shall be cancelled or modified on request of one of the parties.';

(23) In Article 22, the following paragraph 6 is added:

- '6. An entry in the Register effected pursuant to paragraph 5 shall be cancelled or modified on request of one of the parties.';

(23a) The following Article 22a is inserted :⁴

"Article 22a

Procedure for entering licences and other rights in the Register

1. Article 17(5a) and rules adopted pursuant to it shall apply *mutatis mutandis* to the registration of the creation or transfer of a right *in rem* as referred to in Article 17(5), the levy of execution as referred to in Article 20(3), the involvement in an insolvency procedure as referred to in Article 21(3) as well as to the grant or transfer of a licence as referred to in Article 22(5) subject to the following:

(a) the requirement related to the identification of goods and services to which the transfer relates shall not apply in respect of a request for registration of a right *in rem*, of a levy of execution or of insolvency proceedings ;

(b) the requirement related to the documents proving the transfer shall not apply where the request is made by the proprietor of the European Union trade mark.

⁴Rule 33

2. The application for registration of rights referred to in paragraph 1 shall not be deemed to have been filed until the required fee has been paid. The application shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office.

[Need to reflect also Rule 33(4) and Rule 34]

(24) Deleted

(24a) The following Article 24a is inserted :

"Article 24a

Procedure for cancelling or modifying the entry in the Register of a right *in rem*, levy of execution or a license

1. The application pursuant to Articles 19(3), 20(4) and 22(6) respectively shall contain the registration number of the European Union trade mark concerned and the particulars of the right for which registration is requested to be cancelled or modified. It shall be accompanied by documents showing that the registered right no longer exists or that the licensee or the holder of another right consents to the cancellation or modification of the registration..

2. The application for cancellation of the registration shall not be deemed to have been filed until the required fee has been paid. The application shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office."⁵

⁵ Rule 35.

(25) Article 25 is replaced by the following:

'Article 25

Filing of applications

An application for a European Union trade mark shall be filed at the Office.

The Commission shall adopt an implementing act concerning the modalities for the filing of applications for European Union trade marks. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2)." ⁶

(26) Article 26 is amended as follows:

(a) in paragraph 1, point (d) is replaced by the following:

'(d) a representation of the mark which satisfies the requirements set out in Article 4(b).'

(b) paragraphs 2 and 3 are replaced by the following :

'2. The application for a European Union trade mark shall be subject to the payment of the application fee covering one class of goods or services and, when appropriate, of one or more class fees for each class of goods and services exceeding one to which the goods or services belong in accordance with Article 28 [and where applicable, the search fee].' ⁷

'3. In addition to the requirements referred to in paragraphs 1 and 2, an application for a European Union trade mark shall comply with the formal requirements laid down in this Regulation and in the act adopted pursuant to paragraph 4. If those conditions provide for the trade mark to be represented electronically, the President of the Office may determine the formats and maximum size of such an electronic file.'

⁶ Rule 5

⁷ Rule 4.

4. The Commission shall adopt an implementing act laying down detailed rules regarding the individual items of the content of the application. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

(27) Article 27 is replaced by the following:

'Article 27

Date of filing

The date of filing of a European Union trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Office by the applicant, subject to payment of the application fee, for which the order for payment shall have been given at the latest on that date.';

(28) Article 28 is replaced by the following:

'Article 28

Designation and classification of goods and services

1. Goods and services in respect of which registration is applied for shall be classified in conformity with the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (hereinafter referred to as the 'Nice Classification').

2. The goods and services for which the protection of the trade mark is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought. [...]

3. For the purposes of paragraph 2, the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision.

4. The Office shall reject the application in respect of indications or terms which are unclear or imprecise, if the applicant does not suggest an acceptable wording within a period set by the Office to that effect.
5. The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood.
6. Where the applicant requests registration for more than one class, the applicant shall group the goods and services according to the classes of the Nice Classification, each group being preceded by the number of the class to which that group of goods or services belongs and presented in the order of the classes.
7. [...] Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services shall not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
8. [OPTION 1 : Deleted] [OPTION 2 (including new 8a) : Proprietors of European Union trade marks applied for before 22 June 2012 which are registered solely in respect of the entire heading of a Nice class, may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice classification in force at the date of filing.

Such declaration shall be filed at the Office within 6 months from the entry into force of this Regulation, and shall indicate, in a clear, precise and specific manner, the goods and services, other than those clearly covered by the literal meaning of the indications of the class heading, originally covered by the proprietor's intention. The Office shall take appropriate measures to amend the Register accordingly. This possibility is without prejudice to the application of Articles 15, 42(2), 51(1)(a) and 57(2).

European Union trade marks for which no declaration is filed within the period referred to in the second subparagraph shall be deemed to extend, as from the expiry of that period, only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.;

8a. Where the Register is amended, the exclusive rights conferred on the European Union trade mark under Article 9 shall not prevent any third party from continuing to use a trade mark in relation to goods or services where and to the extent that:

(i) The use of the mark in relation to those goods or services commenced before the register was amended, and

(ii) The use of the mark in relation to those goods or services did not infringe the proprietor's rights based on the literal meaning of the goods and services recorded in the register at that time.

In addition, the amendment of the list of goods or services recorded in the Register shall not give the proprietor of the European Union trade mark the right to oppose or to apply to invalidate a later trade mark where and to the extent that:

(i) the later trade mark was either in use, or an application had been made to register the trade mark, for goods or services before the register was amended, and

(ii) the use of the mark in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the goods and services recorded in the register at that time.]

(29) Article 29 is amended as follows:

(a) in paragraph 5, the following sentence is added:

'If necessary, the President of the Office shall request the Commission to consider enquiring whether a State within the meaning of the first sentence accords that reciprocal treatment. If the Commission determines that reciprocal treatment in accordance with paragraph 1 is accorded, it shall publish a communication to this effect in the Official Journal of the European Union.';

(b) the following paragraphs 6 and 7 are added:

'6. Paragraph 5 shall apply from the date of publication in the Official Journal of the European Union of the communication determining that reciprocal treatment is accorded, unless the communication states an earlier date from which it is applicable. It

shall cease to apply from the date of publication in the Official Journal of the European Union of a communication of the Commission to the effect that reciprocal treatment is no longer accorded, unless the communication states an earlier date from which it is applicable.

7. Communications referred to in paragraphs 5 and 6 shall also be published in the Official Journal of the Office.;⁸

⁸ Rule 101.

(30) Article 30 is replaced by the following:

'Article 30

Claiming priority

1. Priority claims shall be filed together with the European Union trade mark application and shall include the date, number and country of the previous application. The documentation in support of priority claims shall be filed within three months from the filing date.⁹

1a. The Commission shall adopt an implementing act laying down the rules on information, documentation or evidence for claiming the priority of a previous application. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).¹⁰;

2. The President of the Office may determine that the additional information and documentation to be provided by the applicant in support of the priority claim may consist of less than what is required under the rules adopted in accordance with paragraph 1a, provided that the information required is available to the Office from other sources.'

(31) Article 33 is amended as follows:

(a) in paragraph 1, the following sentence is added:

'The priority claim shall be filed together with the European Union trade mark application. ';

(b) paragraph 2 is replaced by the following:

'2. An applicant who wishes to claim priority pursuant to paragraph 1 shall file evidence of the display of goods or services under the mark applied for within three months from the filing date.'¹¹;

⁹ Rule 6

¹⁰ Rule 6.

¹¹ Rule 7

(c) paragraph 3 is added

'3. The Commission shall adopt an implementing act laying down the rules on information, documentation or evidence for claiming an exhibition priority in accordance with paragraph 2. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).

(32) Article 34 is amended as follows:

(a) the following sentence is added to paragraph 1:

'Seniority claims shall either be filed together with the European Union trade mark application or within a period of two months from the filing date of the application.'

(b) paragraph 3 is replaced by the following:

'3. The seniority claimed for the European Union trade mark shall lapse where the earlier trade mark the seniority of which is claimed is declared to be invalid or revoked. Where the earlier trade mark is revoked, the seniority shall lapse provided that the revocation takes effect prior to the filing date or priority date of the European Union trade mark.';

(c) the following paragraphs 4, 5 and 6 are added:

'4. The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the effective claiming of seniority.

5. The Commission shall adopt an implementing act laying down the rules on information, documentation or evidence for claiming the seniority of a national trade mark. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2)'

6. The President of the Office may determine that additional information and documentation to be provided by the applicant in support of the seniority claim may consist of less than what is required under the rules adopted in accordance with paragraph 5, provided that the information required is available to the Office from other sources.¹²

(33) Deleted.

(33a) In Article 35, the following paragraphs 3, 4 and 5 are added:

3. The application pursuant to paragraph 1 shall contain sufficient elements to identify the European Union trade mark, its proprietor, the Member State in or for which the earlier trade mark is registered, the goods and services in respect of which the seniority is claimed as well as a copy of the relevant registration. The application shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office.

4. The Commission shall adopt an implementing act specifying the mandatory elements of the application pursuant to paragraph 1 as well as operational rules regarding the processing of applications. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).

5. Article 34(4) and (6) shall apply."¹³

(34) Article 36 is amended as follows:

(a) point (b) of paragraph (1) is replaced by the following:

'(b) the European Union trade mark application complies with the conditions and requirements laid down in Article 26(4) and acts adopted pursuant to it.';

(b) in paragraph (2) the words "within the prescribed period" are replaced by "two months as from the receipt of the notification".

¹² Rule 8

¹³ Rule 28

(c) the following paragraph 8 is added:

'8. If failure to satisfy the requirements referred to in paragraph 1 points (b) and (c) concern only some of the goods or services, the Office shall refuse the application, or the right of priority or the right of seniority shall be lost, only in so far as those goods and services are concerned.'¹⁴;

(35) Article 37 is amended as follows:

(a) paragraph 2 is deleted.

(b) paragraph 3 is replaced by the following :

"(3). The application shall not be refused before the applicant has been allowed the opportunity of withdrawing or amending the application or of submitting his observations. To this effect, the Office shall notify the applicant of the grounds for refusing registration and shall specify a period within which he may withdraw or amend the application or submit his observations. Where the applicant fails to overcome the grounds for refusing registration, the Office shall refuse registration in whole or in part."¹⁵

(36) [OPTION 1: Article 38 is amended as follows:

(a) in paragraph 1, the following sentence is added:

'The applicant for the European Union trade mark may request not to receive such search report.'

(b) in paragraph 4, the second sentence is replaced by the following:

'Such standard form shall contain at least sufficient information to identify the central industrial property offices that carried out the search, the earlier national trade mark applications or registrations which may be invoked under Article 8 and the holder of those earlier rights.'

¹⁴ Rule 9

¹⁵ Rule 11

The Commission shall adopt an implementing act laying down the mandatory elements of the standard form for the search reports. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2)'

(c) paragraph 7 is replaced by the following:

'7. Upon publication of the European Union trade mark application, which may not take place before the expiry of a period of one month as from the date on which the Office transmits the search reports to the applicant, unless the applicant has requested not to receive the search report, the Office shall inform the proprietors of any earlier European Union trade marks or European Union trade mark applications cited in the European Union search report of the publication of the European Union trade mark application. The latter shall apply whether or not the applicant has requested not to receive the search report.]

[OPTION 2: Article 38 is replaced by the following:

"1. The Office shall provide applicants, free of charge, with a search report citing earlier European Union, national or Benelux trade marks or trade mark applications, which may be invoked under Article 8 against the registration of the European Union trade mark applied for.

2. The modalities of this search and the way of reporting shall be decided by the President of the Office after consultation of the Administrative Board.

3. The Office shall also inform the proprietors of any earlier European Union trade marks or European Union trade mark applications cited in the search report of the publication of the European Union trade mark application".]

(37) Article 39 is amended as follows:

(a) paragraph 1 is replaced by the following:

'1. If the conditions which the application for a European Union trade mark must satisfy have been fulfilled [IF OPTION 1 OF ARTICLE 38 IS RETAINED : "and, where appropriate, if the period referred to in Article 38(8) has expired"], the application shall be published for the purposes of Article 41 to the extent that it has not been refused pursuant to Article 37. The publication of the application shall be without prejudice to information already made available to the public otherwise in accordance with this Regulation or [...] acts adopted pursuant to this Regulation. '

(b) the following paragraphs 3, 4 and 5 are added:

'3. At the request of the applicant or of its own motion, the Office shall correct any mistakes or errors in the publication of the application and publish the correction.

4. The Commission shall adopt an implementing act laying down the details which shall be contained in the publication of the application. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

5. Article 41 (2) of the Regulation shall apply also where the correction concerns the list of goods or services or the representation of the mark.¹⁶

[Need to reflect Rule 14(2)]

¹⁶ Rule 14.

(38) Article 40 is replaced by the following:

'Article 40

Observations by third parties

1. Any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Office written observations, explaining on which grounds under Articles 5 and 7, the trade mark shall not be registered ex officio.

They shall not be parties to the proceedings before the Office.

2. Third party observations shall be submitted before the end of the opposition period or, where an opposition against the trade mark has been filed, before the final decision on the opposition is taken.

3. The submission referred to in paragraph 1 shall be without prejudice to the right of the Office to re-open the examination of absolute grounds of its own initiative any time before registration, where appropriate.

4. The observations referred to in paragraph 1 shall be communicated to the applicant who may comment on them.';

[Need to reflect that examination will be re-opened if absolute grounds exist and that observer will not be informed of action taken]

(39) In Article 41, paragraph 3 is replaced by the following:

'3. Opposition shall be expressed in writing, and shall specify the grounds on which it is made. It shall not be treated as duly entered until the opposition fee has been paid. The notice of opposition shall contain sufficient information to identify the application against which it is entered, the earlier mark or earlier right and the goods and services on which it is based, the opposing party as well as the filing date and, where available, the registration date and the priority date.

The Commission shall adopt an implementing act laying down the mandatory elements of the notice of opposition. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).

4. Within a period fixed by the Office, the opponent may submit facts, evidence and arguments in support of his case.';

(40) In Article 42(2), first sentence, the phrase 'during the period of five years preceding the date of publication' is replaced by 'during the period of five years preceding the date of filing or the date of priority';

(40a) In Article 43, the following paragraphs 3, 4, 5 and 6 are added: ¹⁷

'3. A single request may be made for amendment of the same element in two or more applications of the same applicant.

4. The request shall contain sufficient elements to identify the European Union trade mark application and the applicant. The request shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office.

¹⁷ Rules 13, 13a

The Commission shall adopt an implementing act specifying the mandatory elements of a request for amendment, operational rules regarding processing of such requests as well as rules regarding the possibility of amending two or more applications by means of a single application. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

5. Article 41(2) shall apply to the publications of the amendment."

(41) Article 44 is amended as follows:

(a) in paragraph 2, point (b) is replaced by the following:

'(b) before the date of filing referred to in Article 27 has been accorded by the Office and during the opposition period provided for in Article 41(1).'

(b) paragraph 3 is deleted;

(c) the following paragraphs 8 and 9 are added:

'8. Where the declaration of division relates to an application which has already been published pursuant to Article 39, the division shall be published. The divisional application shall be published. The publication shall not open a new period for the filing of oppositions. The declaration of division shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office.'¹⁸

9. A declaration of the division of the application shall contain sufficient information to identify the application, the applicant and the list of goods and services which shall form the divisional application.

The Commission shall adopt an implementing act concerning the mandatory elements of a declaration of the division of the application and operational rules concerning the processing of such a declaration. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).

¹⁸ Rule 13

(42) Article 45 is replaced by the following:

'Article 45

Registration

1. Where an application meets the requirements of this Regulation and where no notice of opposition has been given within the period referred to in Article 41(1) or where opposition has been rejected by a final decision, the trade mark shall be registered as a European Union trade mark. That registration shall be published.

2. The Office shall issue a certificate of registration. That certificate may be issued by electronic means.

3. Deleted.

4. Deleted.

5. The Commission shall adopt an implementing act concerning the modalities of the publication of the registration referred to in paragraph 1, as well as the content and the modalities of issue of the certificate of registration referred to in paragraph 2. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).¹⁹,

¹⁹ Rules 23(2), 24, 84(2)

(43) In Title IV, the following Section 7 is inserted:

'SECTION 7

Delegation of powers

Article 45a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 concerning:

- (a) Deleted
- (b) Deleted;
- (c) Deleted
- (d) Deleted
- (e) Deleted;
- (f) the additional procedural rules for filing and examining an opposition set out in Articles 41 and 42;
- (g) Deleted;
- (h) the particulars to be recorded in the Register when registering a European Union trade mark [...];

(43a) Article 47(3) is replaced by the following, :

'3. The request for renewal shall be submitted within a period of six months before the expiry of the registration. The basic fee for the renewal, and when appropriate, one or more class fees for each class of goods or services exceeding one in respect of which renewal is applied for shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months following the expiry of registration, provided that an additional fee for late payment of the renewal fee or late submission of the request for renewal is paid within this further period'

(43b) In Article 48, paragraph 3 is replaced by the following:

'3. The application for alteration shall contain sufficient elements to identify the European Union trade mark and the proprietor.

The Commission shall adopt an implementing act specifying the mandatory elements of the application for alteration. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).

4. The application shall be deemed not to have been filed until the required fee has been paid. If the fee has not been paid or has not been paid in full, the Office shall inform the applicant accordingly. A single application may be made for the alteration of the same element in two or more registrations of the same proprietor. The required fee shall be paid in respect of each registration to be altered. The application for alteration shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office.

5. The publication of the registration of the alteration shall contain a representation of the European Union trade mark as altered. Third parties whose rights may be effected by the alteration may challenge the registration thereof within a period of three months following publication. Article 41 and acts adopted pursuant to it shall apply to the publication of the registration of the alteration.'

(44) Article 49 is amended as follows:

(a) paragraph 3 is replaced by the following:

"3. A declaration of division shall contain sufficient elements to identify the European Union trade mark, its proprietor as well as goods and services subject to division.

3a. If the requirements laid down in paragraph 3 and pursuant to paragraph 8 are not fulfilled or the list of goods and services which shall form the divisional registration overlap with the goods and services which shall remain in the original registration, the division shall be rejected. The declaration of division shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office. ."

(b) The following paragraph 8 is added :

"8. The Commission shall adopt an implementing act specifying the mandatory elements of the declaration of division and operational rules concerning the processing of declarations of division. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2)."²⁰

²⁰ Rule 25a

(45) The following Article 49a is inserted:

'Article 49a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 concerning

- (a) the additional procedural rules governing the renewal of the European Union trade mark pursuant to Article 47 [...],²¹;
- (b) Deleted
- (c) Deleted;

(46) Article 50 is amended as follows:

a) paragraphs 2 and 3 are replaced by the following:

'2. The surrender shall be declared to the Office in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register. The validity of the surrender of a European Union trade mark which is declared to the Office subsequent to the submission of an application for revocation of that trade mark pursuant to Article 56(1) shall be conditional upon the final rejection or withdrawal of the application for revocation.

²¹ Rules 29 and 30

'3. Surrender shall be entered only with the agreement of the proprietor of a right relating to the European Union trade mark and which is entered in the Register. If a licence has been registered, surrender shall be entered in the Register only if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry shall be made on expiry of a period of three months after the date on which the proprietor satisfies the Office that he informed the licensee of his intention to surrender, or before the expiry of that period, as soon as he proves that the licensee has given his consent. The surrender shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office.

(b) the following paragraph 4 is added:

"4. The declaration for surrender shall contain sufficient elements to identify the European Union trade mark and its proprietor.

The Commission shall adopt an implementing act specifying the mandatory elements of a declaration of surrender, of evidence that shall constitute sufficient proof of the third party's agreement as well as operational rules regarding the processing thereof. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2)."

(47) Article 53(1) is amended as follows:

[(a) the following point (d) is added :

"Where there is any earlier designation of origin or a geographical indication referred to in Article 8(4a) and the conditions set out in that paragraph are fulfilled"]²²

(b) the following subparagraph is added :

'The conditions referred to in points (a), (b) , (c) [and (d)] of the first subparagraph shall be fulfilled at the filing date or the priority date of the European Union trade mark.';

²² Linked to the acceptance of Option 2 in Article 8(4).

48) In Article 54(1) and (2), the words 'either' and 'or to oppose the use of the later trade mark' are deleted;

(49) Article 56 is amended as follows:

(a) in point (c) of paragraph 1, 'under the law of the Member State concerned' is replaced by 'under Union law or the law of the Member State concerned';

(b) paragraph 3 is replaced by the following:

'3. An application for revocation or for a declaration of invalidity shall be inadmissible where an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on its merits, either by the Office or by a European Union trade mark court as referred to in Article 95, and the decision of the Office or that court on that application has acquired the authority of a final decision.';

(50) In Article 57(2), second sentence, 'was published' is replaced by 'was filed or at the priority date of the European Union trade mark application';

(51) In Title VI, the following Section 6 is inserted:

'SECTION 6

Delegation of powers

Article 57a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 concerning:

(a) Deleted

(b) the procedures governing the revocation and invalidity of a European Union trade mark referred to in Articles 56 and 57.';

(52) Article 58(1) is replaced by the following:

'1. An appeal shall lie from decisions of any of the decision-making instances of the Office listed in Article 130 points (a) to (d) and, where appropriate, point (f). Those decisions shall take effect only as from the date of expiration of the appeal period referred to in Article 60. [...] The filing of the appeal shall have suspensive effect.';

(52a) Article 60 is replaced by the following :

'1. Notice of appeal shall be filed in writing at the Office within two months after the date of notification of the decision appealed from. The notice shall be deemed to have been filed only when the fee for appeal has been paid. It shall be filed in the language of the proceedings in which the decision subject to appeal was taken. It shall contain sufficient information to identify the appellant, the contested decision and the extent to which amendment or cancellation of the decision is requested. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal shall be filed.

The Commission shall adopt an implementing act specifying the mandatory elements of the notice of appeal. That implementing act shall be adopted in accordance with the examination procedure referred to in Art 163(2).

2. In inter partes proceedings, the defendant may in his response, seek a decision annulling or altering the contested decision on a point not raised in the appeal. Such submissions shall cease to have effect should the appellant discontinue the proceedings.²³

(53) Article 62 is deleted;

²³ Rule 48.

(54) Article 64 is amended as follows:

(a) In paragraph (1) the following subparagraph shall be added:

'A decision of the Board of Appeal shall contain the date when the decision was taken, the names of the members of the Board, the names of the parties and the name of the competent employee of the registry, , a statement of the issues to be decided, a summary of the facts, the order, including, where necessary, a decision on costs, as well as the reasons on which it is based. The decision shall be signed by the Chairman and the other members of the Board of Appeal and by the employee of the registry of the Board of Appeal.'²⁴

(b) paragraph (3) is replaced by the following

'3. The decisions of the Board of Appeal shall take effect only as from the date of expiry of the period referred to in Article 65(5) or, if an action has been brought before the General Court within that period, as from the date of dismissal of such action or of any appeal filed with the Court of Justice against the decision of the General Court.';

(55) Article 65 is amended as follows:

(a) paragraph 1 is replaced by the following:

'1. Actions may be brought before the General Court against decisions of the Boards of Appeal on appeals.';

(b) paragraph 3 is replaced by the following:

'3. The General Court shall have jurisdiction to annul or to alter the contested decision.';

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

'5. The action shall be brought before the General Court within two months of the date of notification of the decision of the Board of Appeal.

6. The Office shall take the necessary measures to comply with the judgment of the General Court or, in case of appeal against that judgment, the Court of Justice.';

²⁴ Rule 50.

(56) The following Article 65a is inserted:

'Article 65a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

- (a) the additional procedural rules for the filing and the examination of an appeal;
- (b) Deleted
- (c) the reimbursement of the appeal fees referred to in Article 60.";

(57) The title of Title VIII is replaced by the following:

**'SPECIFIC PROVISIONS ON EUROPEAN UNION COLLECTIVE MARKS AND
CERTIFICATION MARKS';**

(58) Between the title of Title VIII and Article 66, the following heading is inserted:

'SECTION 1

European Union collective marks';

(59) In Article 66, paragraph 3 is replaced by the following:

'3. Titles I to VII and IX to XIV shall apply to European Union collective marks to the extent that this section does not provide otherwise.';

(60) Article 67(1): is amended as follows:

(a) The words 'within the period prescribed' are replaced by "within a period of two months after the date of filing";

(b) The following paragraph 3 is added:

'3. The Commission shall adopt an implementing act specifying the mandatory elements of the regulations referred to in paragraph 2. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

(61) Article 69 is replaced by the following:

'Article 69

Observations by third parties

Where written observations on a European collective mark are submitted to the Office pursuant to Article 40, those observations may also be based on the particular grounds on which the application for a European collective mark shall be refused pursuant to Article 68.';

(62) Deleted.

(63) In Title VIII, the following Section 2 is added:

'SECTION 2

European Union Certification Marks

Article 74b

European Union certification marks

1. A European Union certification mark shall be a European Union trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of [geographical origin] material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristic from goods and services which are not so certified.

2. Any [natural or] legal person , including institutions, authorities and bodies governed by public law, may apply for European certification marks provided that this person:

- (a) [...] does not carry on a business involving the supply of goods or services of the kind certified;
- (b) [...] is competent to certify the goods or services for which the mark is to be registered.

[3. By way of derogation from Article 7(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute European certification marks within the meaning of paragraph 1. A certification mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided the third party uses them in accordance with honest practices in industrial or commercial matters. A certification mark may not be invoked against a third party who is entitled to use a geographical name.]

4. Titles I to VII and IX to XIV shall apply to European certification marks to the extent that this Section does not provide otherwise.

Article 74c

Regulations governing use of the certification mark

1. An applicant for a European Union certification mark shall submit regulations governing the use of the certification mark within a period of two months after the date of filing .

2. The regulations governing use shall specify the persons authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark as well as the conditions of use of the mark, including sanctions.

The Commission shall adopt an implementing act specifying the mandatory elements of such regulations. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

Article 74d

Refusal of the application

1. In addition to the grounds for refusal of a European Union trade mark application provided for in Articles 36 and 37, an application for a European certification mark shall be refused where Articles 74b and 74c are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.

2. An application for a European certification mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

3. An application shall not be refused if the applicant, as a result of an amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

Article 74e

Observations by third parties

Where written observations on a European certification mark are submitted to the Office pursuant to Article 40, those observations may also be based on the particular grounds on which the application for a European certification mark shall be refused pursuant to Article 74d.

Article 74ea

Use of the certification mark

Use of a European Union certification mark by any person who has authority to use it shall satisfy the requirements of this Regulation, provided that the other conditions which this Regulation imposes with regard to the use of European Union trade marks are fulfilled.

Article 74f

Amendment of the regulations governing use of the mark

1. The proprietor of a European certification mark shall submit to the Office any amended regulations governing use.
2. The amendment shall not be mentioned in the Register where the amended regulations do not satisfy the requirements of Article 74c or involve one of the grounds for refusal referred to in Article 74d.
3. Article 74e shall apply to amended regulations governing use.
4. For the purposes of this Regulation, amendments to the regulations governing use shall take effect only from the date of entry of the mention of the amendment in the Register.

Article 74g

Transfer

By way of derogation from Article 17(1), a European certification mark may only be transferred to a legal person which meets the requirements of Article 74b(2).

Article 74h

Persons who are entitled to bring an action for infringement

1. Only the proprietor of a European certification mark or any person specifically authorised by him to that effect shall be entitled to bring an action for infringement.
2. The proprietor of a European certification mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorised use of the mark.

Article 74i

Grounds for revocation

In addition to the grounds for revocation provided for in Article 51, the rights of the proprietor of a European certification mark shall be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings, where any of the following conditions is fulfilled:

- (a) the proprietor no longer meets the requirements of Article 74b(2);
- (b) the proprietor does not take reasonable steps to prevent the mark being used in a manner incompatible with the conditions of use laid down in the regulations governing use, amendments to which have, where appropriate, been mentioned in the Register;
- (c) the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in Article 74d(2);
- (d) an amendment to the regulations governing use of the mark has been mentioned in the Register in breach of Article 74f(2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of that Article.

Article 74j

Grounds for invalidity

In addition to the grounds for invalidity provided for in Articles 52 and 53, a European certification mark which is registered in breach of Article 74d shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings, unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of Article 74d.'

Article 74k

Delegation of powers

Deleted.

(64) Article 75 is replaced by the following:

'Article 75

Form of decisions and communications of the Office

1. Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

2. Any decision, communication or notice from the Office shall indicate the department or division of the Office as well as the name or the names of the official or officials responsible. They shall be signed by that official or those officials, or, instead of a signature, carry a printed or stamped seal of the Office. The President may determine that other means of identifying the department or division of the Office and the name of the official or officials responsible or an identification other than a seal may be used where decisions, communications or notices from the Office are transmitted by telecopier or any other technical means of communication.

The Commission shall adopt an implementing act specifying the requirements concerning the form of Office's decision. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).²⁵;

(65) In Article 76(1), the following sentence is added:

'In invalidity proceedings pursuant to Article 52, the Office shall limit its examination to the grounds and arguments provided by the parties.';

(65a) In Article 77, the following paragraph 4 is added:²⁶

'4. The Commission shall adopt an implementing act concerning the modalities of oral proceedings. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

(66) Article 78 is amended as follows:

(a) in paragraph 3, the following sentence is added:

'The period of notice given in summons of a party, witness or expert to give evidence shall be at least one month, unless they agree to a shorter period.'

(b) the following paragraphs 5 and 6 are added:

'5. The President of the Office shall determine the amounts of expenses to be paid, including advances, as regards the costs of taking of evidence referred to in this Article ;

6. The Commission shall adopt an implementing act concerning the modalities of taking of evidence. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).';²⁷

²⁵ Rule 52

²⁶ Rule 52

²⁷ Rule 57

(67) Article 79 is replaced by the following:

'Article 79

Notification

1. The Office shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of [...] acts adopted pursuant to this Regulation, or of which notification has been ordered by the President of the Office.

2. The President may determine which documents, other than decisions subject to a time limit for appeal and summonses, shall be notified by registered letter with advice of delivery.

3. Notification may be effected by different means, including by electronic means. The details regarding electronic means shall be determined by the President. .²⁸.

4. Where notification shall be effected by public notice, the President shall determine how the public notice is to be given and shall fix the beginning of the one month period on the expiry of which the document shall be deemed to have been notified.'

5. The notifications shall be deemed to be delivered on a date determined in the implementing act taking into account the characteristics of each particular modality of notification.

When a document has reached an addressee, if the Office is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the Office as the date of receipt.²⁹

²⁸ Rules 61, 63, 64, 65, 66
Rule 68.

6. The Commission shall adopt an implementing act specifying the means of notifications referred to in paragraph 2 and 3 and the modalities thereof as well as the related rules concerning the establishment of the date on which the notification shall be deemed to have been effected. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).';³⁰;

(68) The following Articles 79a, 79b, 79c and 79d are inserted:

'Article 79a

Noting of loss of rights

Where the Office finds that the loss of any rights results from this Regulation or [...] acts adopted pursuant to this Regulation without any decision having been taken, it shall communicate this to the person concerned in accordance with Article 79. The latter may apply for a decision on the matter within a period of two months after notification of the communication, if he considers that the finding of the Office is inaccurate. The Office shall adopt such a decision only where it disagrees with the person requesting it; otherwise the Office shall amend its finding and inform the person requesting the decision³¹.

Article 79b

Communications to the Office

Communications addressed to the Office may be effected by electronic means. The President shall determine the extent of and the technical conditions under which those communications may be submitted electronically.

³⁰ Rules 61, 62, 63, 64, 65, 66

³¹ Rule 54.

The Commission shall adopt an implementing act regarding the means of communication, including the electronic means of communication, to be used by the parties to proceedings before the Office and the forms to be made available by the Office. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).

Article 79c

Time limits

1. Time limits shall be laid down in terms of full years, months, weeks or days. Calculation shall start on the day following the day on which the relevant event occurred. The duration of time limits shall not be less than one month and no more than 6 months.

The Commission shall adopt an implementing act regarding the calculation and duration of time-limits. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).³²

2. The President of the Office shall determine, before the commencement of each calendar year, the days on which the Office is not open for receipt of documents or on which ordinary mail is not delivered in the locality in which the Office is located.

3. The President shall determine the duration of the period of interruption in case of a general interruption in the delivery of mail in the Member State where the Office is located or, in case of an actual interruption, of the Office's connection to admitted electronic means of communication.

³² Rules 70, 71.

4. If an exceptional occurrence such as a natural disaster or strike interrupts or dislocates proper communication from the parties to the proceedings to the Office or vice-versa, the President may determine that for parties to the proceedings having their residence or registered office in the Member State concerned or who have appointed a representative with a place of business in the Member State concerned, all time limits that otherwise would expire on or after the date of commencement of such occurrence, as determined by him, shall extend until a date to be determined by him. When determining that date, he shall assess when the exceptional occurrence comes to an end. If the occurrence affects the seat of the Office, such determination of the President shall specify that it applies in respect of all parties to the proceedings.

Article 79d

Correction of errors and manifest oversights

The Office shall correct any linguistic errors or errors of transcription and manifest oversights in its decisions or technical errors attributable to the Office in registering the trade mark or in publishing its registration of its own motion or at the request of a party.;

The Commission shall adopt an implementing act concerning the procedure for the correction of linguistic errors or errors of transcription and manifest oversights in the Office's decisions and technical errors attributable to the Office in registering the trade mark or in publishing its registration. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).;³³

(69) Article 80 is amended as follows:

- (a) in paragraph 1, first sentence, the phrase 'decision which contains an obvious procedural error' is replaced by 'decision which contains an obvious error';

³³ Rules 27 and 53

- (b) in paragraph 2, the second sentence is replaced by the following:

'The cancellation of the entry in the Register or the revocation of the decision shall be effected within one year from the date on which the entry was made in the Register or that decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the European Union trade mark in question that are entered in the Register.';

- (ba) the following paragraph 2a is inserted:

'2a. The Commission shall adopt an implementing act regarding modalities for revocation of a decision or for cancellation of an entry in the Register. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).''³⁴

- (c) paragraph 3 is replaced by the following:

'3. This Article shall be without prejudice to the right of the parties to submit an appeal under Articles 58 and 65, or to the possibility of correcting errors and manifest oversights under Article 79d. Where an appeal has been filed against an Office's decision containing an error, the appeal proceedings shall become devoid of purpose upon revocation by the Office of its decision pursuant to paragraph 1 of this Article. In the latter case, the appeal fee shall be reimbursed to the appellant.'

(70) Article 82 is amended as follows:

- (a) paragraph 2 is replaced by the following:

'2. This Article shall not apply to the time limits laid down in Article 29(1), Article 33(1), Article 36(2), Article 41(1) and (3), Article 47(3), Article 60, Article 65(5), Article 81, Article 112, or to the time limits laid down in paragraph 1 of this Article or the time limit for claiming seniority pursuant to Article 34 after the application has been filed.';

³⁴ Rule 53a

(b) paragraph 4 is replaced by the following:

'4. If the Office accepts the application, the consequences of having failed to observe the time limit shall be deemed not to have occurred. If a decision has been taken between the expiry of the unobserved time limit and the request for continuation of proceedings, the department competent to decide on the omitted act shall review the decision and, where completion of the omitted act itself is sufficient, take a different decision. If the original decision is not to be altered, it shall be confirmed in writing.';

(71) The following Article 82a is inserted:

'Article 82a

Interruption of proceedings

³⁵1. Proceedings before the Office shall be interrupted :

(a) in the event of the death or legal incapacity of the applicant for or proprietor of a European Union trade mark or of his representative or of the person authorized by national law to act on his behalf unless such death or legal incapacity does not affect the authorisation of the representative;

(b) in the event of the applicant for or proprietor of a European Union trade mark , as a result of some action taken against his property, being prevented for legal reasons from continuing the proceedings before the Office.

The time-limits, other than the time limit for paying the renewal fees, shall begin again as from the day on which the proceedings are resumed.

2. The proceedings shall be resumed as soon as the identity of the person authorised to continue the proceedings has been established . The Commission shall adopt an implementing act governing the resumption of proceedings before the Office. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2);

³⁵ Rule 73.

(72) Article 83 is replaced by the following:

'Article 83

Reference to general principles

In the absence of procedural provisions in this Regulation or in [...] acts adopted pursuant to this Regulation, the Office shall take into account the principles of procedural law generally recognised in the Member States.';

(73) Article 85 is amended as follows:

(a) Paragraph 1 is replaced as follows :

'1. The losing party in opposition proceedings, proceedings for revocation, proceedings for a declaration of invalidity or appeal proceedings shall bear the fees incurred by the other party as well as all costs, without prejudice to Article 119(6), incurred by him essential to the proceedings, including travel and subsistence and the remuneration of an agent, adviser or advocate, within the limits of the scales set for each category of costs in the implementing act adopted in accordance with the second subparagraph. Subsistent expenses shall be calculated in accordance with the Staff Regulations. The losing party shall bear the cost for one applicant and, where applicable, one representative only, even where there were several applications or where the successful party is represented by more than one representative.

The Commission shall adopt an implementing act specifying the evidence needed in support of requests for the fixing of costs, except for cases where amount is fixed pursuant to paragraph 6, first sentence, as well as fixing maximum rates for costs essential to the proceedings and actually incurred. When fixing such amount the Commission shall take into account the distance between the place or residence or business of the party, representative or witness or expert and place where oral proceedings are held and the procedural stage at which the costs incur. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

(b) in paragraph 6 'within the prescribed period' is replaced by 'one month after the date of notification of awarding of costs'. The following is added:
'It shall not be deemed to be filed until the fee for reviewing the amount of the costs has been paid.';

(74) In Article 86(2), the second sentence is replaced by the following:

'Each Member State shall designate a single authority responsible for verifying the authenticity of the decision and shall communicate its contact details to the Office, the Court of Justice and the Commission. The order for the enforcement of the decision shall be appended to the decision by that authority, without other formality than verification of the authenticity of the decision.';

(75) Article 87 is replaced by the following:

'Article 87

Register of European Union trade marks

1. The Office shall keep a Register of European Union trade marks. The Register shall contain the following entries relating to European Union trade mark applications and registrations:

- (a) the date of filing the application;
- (b) the file number of the application;
- (c) the date of the publication of the application;
- (d) the name and address of the applicant;
- (e) the name and business address of the representative, other than a representative falling within the first sentence of Article 92 (3);
- (f) the reproduction of the mark, with indications as to its nature; where applicable, a description of the mark;
- (g) an indication of the goods and services by their names;
- (h) particulars of claims of priority pursuant to Article 30;
- (i) particulars of claims of exhibition priority pursuant to Article 33;

- (j) particulars of claims of seniority of an earlier registered trade mark as referred to in Article 34;
- (k) a statement that the mark has become distinctive in consequence of the use which has been made of it, pursuant to Article 7 (3);
- (l) an indication that the mark is a collective mark;
- (m) an indication that the mark is a certification mark;
- (n) the language in which the application was filed and the second language which the applicant has indicated in his application, pursuant to Article 119 (3);
- (o) the date of registration of the mark in the Register and the registration number;
- (p) a statement that the application results from a transformation of an international registration designating the Union pursuant to Article 161, together with the date of the international registration pursuant to Article 3 (4) of the Madrid Protocol or the date on which the territorial extension to the Union made subsequently to the international registration pursuant to Article 3 ter (2) of the Madrid Protocol was recorded and, where applicable, the date of priority of the international registration.

2. The Register shall also contain the following entries, each accompanied by the date of recording of such entry:

- (a) changes in the name, the address or the nationality of the proprietor of a European Union trade mark or in the State in which he is domiciled or has his seat or establishment;
- (b) changes in the name or business address of the representative, other than a representative falling within Article 92 (3), first sentence;
- (c) when a new representative is appointed, the name and business address of that representative;
- (d) amendments and alterations of the mark pursuant to Articles 43 and 48 and corrections of mistakes and errors;

- (e) notice of amendments to the regulations governing the use of the collective mark pursuant to Article 71;
- (f) particulars of claims of seniority of an earlier registered trade mark as referred to in Article 34, pursuant to Article 35;
- (g) total or partial transfers pursuant to Article 17;
- (h) the creation or transfer of a right in rem pursuant to Article 19 and the nature of the right in rem;
- (i) levy of execution pursuant to Article 20 and insolvency proceedings pursuant to Article 21;
- (j) the grant or transfer of a licence pursuant to Article 22 and, where applicable, the type of licence pursuant to Rule 34;
- (k) renewal of the registration pursuant to Article 47, the date from which it takes effect and any restrictions pursuant to Article 47 (4);
- (l) a record of the determination of the expiry of the registration pursuant to Article 47;
- (m) a declaration of withdrawal or surrender by the proprietor of the mark pursuant to Articles 43 and 50;
- (n) the date of submission and the particulars of an opposition pursuant to Article 41 or an application pursuant to Article 56 or of the filing of a counterclaim pursuant to Article 100(4) for revocation or for a declaration of invalidity or of the filing of an appeal pursuant to Article 60;
- (o) the date and content of the decision on an opposition or an application or counterclaim pursuant to Article 57 (6) or the third sentence of Article 100 (6) or on an appeal pursuant to Article 64;
- (p) a record of the receipt of a request for conversion pursuant to Article 113 (2);
- (q) the cancellation of the representative recorded pursuant to paragraph 2 (e);
- (r) the cancellation of the seniority of a national mark;

- (s) the modification or cancellation from the Register of the items referred to in subparagraphs (h), (i) and (j).
- (t) the replacement of the European Union trade mark by an international registration pursuant to Article 157;
- (u) the date and number of an international registration based on the European Union trade mark application which has been registered as a European Union trade mark pursuant to Article 148 (1);
- (v) the date and number of an international registration based on the European Union trade mark pursuant to Article 148 (2);
- (w) the division of a registration pursuant to Article 49 and Rule 25a, together with the items referred to in paragraph 2 in respect of the divisional registration, as well as the list of goods and services of the original registration as amended;
- (x) the revocation of a decision or an entry in the Register pursuant to Article 80, where the revocation concerns a decision or entry which has been published.
- (z) notice of amendments to the regulations governing the use of the certification mark pursuant to Article 74f;

3. The President of the Office may determine that items other than those referred to in paragraphs 1 and 2 shall be entered in the Register, subject to Article 123(4)

4. The Register may be maintained in electronic form. The Office shall collect, organise, make public and store the items referred to in paragraphs 1 and 2, including any personal data, for the purposes laid down in paragraph 7. The Office shall keep the register up to date and easily accessible for public inspection.

5. The proprietor of the European Union trade mark shall be notified of any change in the Register.

6. The Office shall provide certified or uncertified extracts from the Register on request, on payment of a fee.

7. The processing of the data concerning the entries in paragraphs (1) and (2), including any personal data, shall take place for the purposes of:

a) administering the applications and/or registrations as described in this Regulation and acts adopted pursuant to it,

b) maintaining a public register for the inspection and information of public authorities and economic operators, in order to enable them to exercise the rights conferred on them by this Regulation and be informed about the existence of prior rights belonging to third parties, and

c) producing reports and statistics enabling the Agency to optimise its operations and improve the functioning of the system.

8. All the data, including personal data, concerning the entries in paragraphs 1 and 2 are of public interest and can be accessed by any third party. For reasons of legal certainty, the entries in the Register shall be kept for an indefinite period of time.';

(75a) the following Article 87a is inserted:

'Article 87a

Data Base

1. In addition to the obligation to keep a Register of European Union trade marks within the meaning of Article 87, the Office shall collect and store in an electronic data base all the particulars provided by applicants or any other party to the proceedings under this Regulation or acts adopted pursuant to it.

2. The electronic data base may include personal data, beyond those included in the Register pursuant to Article 87, to the extent that such particulars are required by this Regulation or acts adopted pursuant to it. The collection, storage and processing of such data shall serve the purposes of:

a) administering the applications and/or registrations as described in this Regulation and acts adopted pursuant to it;

b) accessing the information necessary for conducting the relevant proceedings more easily and efficiently;

c) communicating with the applicants and other parties to the proceedings;

d) producing reports and statistics enabling the Agency to optimise its operations and improve the functioning of the system.

3. The President of the Agency shall determine the conditions of access to the electronic data base and the manner in which its contents, other than the personal data referred to under paragraph 2 but including those listed in Article 87, may be made available in machine-readable form, including the charge for these acts.

4. Access to the personal data referred to under paragraph 2 shall be restricted and shall not be made publicly available unless the party concerned has given its express consent.

5. The data shall be kept indefinitely. The party concerned may request the suppression of any personal data from the database after 6 months from the expiry of the trade mark or the closure of the relevant inter partes procedure. It shall have the right to obtain the correction of inaccurate or erroneous data at any time.'

(76) Article 88 is amended as follows:

(a) the title 'Inspection of files' is replaced by 'Inspection and keeping of files';

(b) paragraph 4 is replaced by the following:

'4. Where the files are inspected pursuant to paragraphs 2 or 3, certain documents in the file relating to exclusion or objection pursuant to Article 137, used for the preparation of decisions and opinions as well as those in respect of which the party concerned showed a special interest in keeping confidential, unless inspection of such part of the file is justified by overriding legitimate interests of the party seeking inspection³⁶ may be withheld from inspection. The President shall determine the means of inspection.

5. The Office shall keep the files of any procedure relating to a European Union trade mark application or European Union trade mark registration. The President shall determine the form in which those files shall be kept. Where the files are kept in electronic format, the original documents forming the basis of such electronic files shall be disposed of after a period following their reception by the Office, which shall be determined by the President.';

[Need to reflect also Rules 89, 90 and 91(3)]

³⁶ Rule 88.

(77) Article 89 is replaced by the following:

'Article 89

Periodical publications³⁷

1. The Office shall periodically publish:

- (a) a European Union trade marks Bulletin containing entries made in the Register as well as other particulars the publication of which is prescribed by this Regulation or by [...] acts adopted pursuant to it;
- (b) an Official Journal containing notices and information of a general character issued by the President of the Office, as well as any other information relevant to this Regulation or its implementation.

The publications referred to in points (a) and (b) may be effected by electronic means.

2. The European Union trade marks Bulletin shall be published in the manner and frequency determined by the President.

3. The Official Journal shall be published in the languages of the Office. However, the President may determine that certain items shall be published in the Official Journal in all the official languages of the Union.';

4. The Commission shall adopt an implementing act concerning the modalities of publications referred to in paragraph 1. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).';³⁸

³⁷ Opinion of European Data Protection Supervisor: As a minimum, a substantive provision should clarify what kind of personal data may be made public and for what purpose(s). See points 22, 23, 24, 25, 26

³⁸ Rules 85, 86.

(77a) In Article 90, the following subparagraph is added:

'The Office shall not charge fees in respect of such communication or for inspections referred to in the first subparagraph . The Commission shall adopt an implementing act concerning modalities of the exchange of information and communications between the Office and the authorities of the Member States. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'³⁹

(78) Article 92 is amended as follows:

(a) paragraph 2 is replaced by the following:

'2. Without prejudice to paragraph 3, second sentence, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Union shall be represented before the Office in accordance with Article 93(1) in all proceedings provided for by this Regulation, other than in filing an application for a European Union trade mark.'

(b) paragraph 4 is replaced by the following:

'4. Where there is more than one applicant or more than one third party acting in common, a common representative shall be appointed. If the applicant or a third party fail to name it, the common representative shall be appointed in accordance with rules adopted pursuant to the second subparagraph.'⁴⁰

The Commission shall adopt an implementing act concerning the appointment of a common representative in the above circumstances. That implementing act shall be adopted in accordance with the examination procedure referred to Article 163(2). '

³⁹ [from Rules 92, 93]

⁴⁰ Rule 75

(c) the following paragraph 5 is added:

'5. Employees referred to in paragraph 3 shall file with the Office, within a time limit specified by it, a signed authorisation for insertion in the files in any official language of the Union. Legal practitioners and professional representatives referred to in Article 93 shall do so only at the express request of the Office or the other party. ⁴¹

The Commission shall adopt an implementing act specifying the details related to the filing and the effects of that authorisation as well as the content thereof. That implementing act shall be adopted in accordance with the examination procedure referred to Article 163(2);

(79) Article 93 is amended as follows:

(a) paragraph 1 is replaced by the following:

'1. Representation of natural or legal persons before the Office may only be undertaken by:

- (a) any legal practitioner qualified in a Member State and having his place of business within the Union, to the extent that he is entitled, within the said State, to act as a representative in trade mark matters;
- (b) professional representatives whose names appear on the list maintained for this purpose by the Office.

Representatives acting before the Office shall, on request by the Office, file with it a signed authorisation for insertion on the files.';

(b) paragraph 4 is replaced by the following:

'4. The President of the Office may grant exemption from:

- (a) the requirement of paragraph 2(c), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way;

⁴¹Rule 76

(b) the requirement of paragraph 2(a) in case of highly qualified professionals, provided that the requirements of paragraphs 2(b) and (c) are fulfilled.';

(c) paragraph 5 is replaced by the following:

'5. A person may be removed from the list of professional representatives at his request or when no longer in capacity to represent.⁴²

The Commission shall adopt an implementing act specifying cases when a representative loses the capacity to represent. That implementing act shall be adopted in accordance with the examination procedure referred to Article 163(2).';

(80) Deleted.

(81) In Title X, the title of Section 1 is replaced by the following:

'Application of the Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters';

(82) Article 94 is amended as follows:

(a) the title is replaced by the following:

'Application of the Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters';

(b) in paragraph 1, 'Regulation (EC) No 44/2001' is replaced by 'the Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters';

⁴² [Rule 78]

(c) the following paragraph 3 is added:

'3. References in this Regulation to Regulation (EC) No 44/2001 shall include, where appropriate, the Agreement between the European Community and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters done on 19 October 2005.';

(83) In Article 96(c), 'Article 9(3), second sentence' is replaced by 'Article 9b(2)';

(84) In Article 99, paragraph 3 is replaced by the following:

'3. In the actions referred to in Article 96(a) and (c), a plea relating to revocation of the European Union trade mark submitted otherwise than by way of a counterclaim shall be admissible in so far as the defendant claims that the rights of the proprietor of the European Union trade mark could be revoked for lack of genuine use at the time the infringement action was brought.';

(85) Article 100 is amended as follows:

(a) paragraph 4 is replaced by the following:

'4. The European Union trade mark court with which a counterclaim for revocation or for a declaration of invalidity of the European Union trade mark has been filed shall not proceed with the examination of the counterclaim, until either the interested party or the court have informed the Office of the date on which the counterclaim was filed. The Office shall record that information in the Register. If an application for revocation or for a declaration of invalidity of the European Union trade mark had already been filed before the Office before the claim was filed, the court shall be informed thereof by the Office and stay the proceedings until the decision on the application is final or the application is withdrawn.';

(b) paragraph 6 is replaced by the following:

'6. Where a European Union trade mark court has given a judgment which has become final on a counterclaim for revocation or for invalidity of a European Union trade mark, a copy of the judgment shall be sent to the Office without delay, either by the court or by any of the parties to the national proceedings. The Office or any other interested party may request information about such transmission. The Office shall mention the judgment in the Register and shall take the necessary measures to comply with its operative part.';

(85a) In Article 101, paragraph 2 is replaced by the following

'2. On all matters not covered by this Regulation, a European Union trade mark court shall apply the applicable national law.';

(86) In Article 102, paragraph 2 is replaced by the following:

'2. The European Union trade mark court may also apply measures or orders available under the applicable law which it deems appropriate under the circumstances of the case.';

(87) Article 108 is deleted;

(88) Article 113 is amended as follows:

(a) in paragraph 1, the first sentence shall be replaced by the following:

'A request for conversion shall be filed with the Office and shall identify the applicant, the European Union trade mark application or registration, specify the Member State in respect of which the conversion is requested, the grounds for conversion, goods and services subject to conversion, and where applicable, the decision of the national court.'⁴³

(b) in paragraph 2, the following text shall be added at the end 'in European Union Trade Marks Bulletin.'⁴⁴

⁴³ [Rule 44]

⁴⁴ [Rule 46]

(c) Paragraph 3 is replaced by the following :

'3. The Office shall check whether the conversion requested fulfils the conditions set out in this Regulation, in particular Article 112(1), (2), (4), (5) and (6), and paragraph 1 of this Article, together with the formal requirements specified in the implementing act adopted pursuant to the second subparagraph. If the requirements governing the application are not fulfilled, , the application shall be rejected. The conversion shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office. If these requitremements are fulfilled, the Office shall transmit the request for conversion to the industrial property offices of the Member States specified therein.

The Commission shall adopt an implementing act specifying the mandatory element of the application as well as details of its examination. That implementing act shall be adopted in accordance with the examination procedure referred to Article 163(2).'

(89) In Article 114(2), the words 'the Implementing Regulation' are replaced by 'implementing acts adopted pursuant to this Regulation';

(90) Deleted

(91) In Article 116, paragraph 2 is replaced by the following:

'2. Without prejudice to paragraph 1, the Office may make use of seconded national experts or other staff not employed by the Office. The Administrative Board shall adopt a decision laying down rules on the secondment to the Office of national experts.';

(92) In Article 117, the words 'to the Office' are replaced by 'to the Office and its staff';

(93) Article 119 is amended as follows:

(a) in paragraph 6, second subparagraph, the second sentence is replaced by the following:

'The translation shall be produced within one month from the expiry of the opposition period or from the date of filing application;

(b) the following paragraph 8 is added:

'8. The President shall determine the manner in which translations shall be certified.';

(94) In Article 120(1), the words 'the Implementing Regulation' are replaced by 'an [...] act adopted pursuant to this Regulation';

(95) [Article 122 is deleted;]

(96) Article 123 is replaced by the following:

'Article 123

Transparency

1. Regulation (EC) No 1049/2001 of the European Parliament and of the Council (*) shall apply to documents held by the Office.

2. The Administrative Board shall adopt the detailed rules for applying Regulation (EC) No 1049/2001.

3. Decisions taken by the Office under Article 8 of Regulation (EC) No 1049/2001 may form the subject of a complaint to the Ombudsman or of an action before the Court of Justice of the European Union, under the conditions laid down in Articles 228 and 263 of the Treaty respectively.

4. The processing of personal data by the Office shall be subject to Regulation (EC) No 45/2001 of the European Parliament and of the Council (**).

(*) OJ L 145, 31.5.2001, p. 43.

(**) OJ L 8, 12.1.2001, p. 1.';

(97) The following Article 123a is inserted:

'Article 123a

Security rules on the protection of classified and sensitive non-classified information

The Office shall apply the security principles contained in the Commission's security rules for protecting European Union Classified Information (EUCI) and sensitive non-classified information, as set out in the annex to Commission Decision 2001/844/EC, ECSC, Euratom (*). Applying the security principles shall cover, inter alia, provisions for the exchange, processing and storage of such information.

(*) OJ L 317, 3.12.2001, p. 1.';

(98) In Title XII, the following Section 1a is inserted:

'SECTION 1a

Tasks of the Office and cooperation to promote convergence

Article 123b

Tasks of the Office

1. The Office shall have in particular the following tasks:

- (a) administration and promotion of the European Union trade mark system established in this Regulation;

- (b) administration and promotion of the European design system established in Council Regulation (EC) No 6/2002 (*);
- (c) promoting convergence of practices and tools in the fields of trade marks and designs in cooperation with the central industrial property offices in the Member States, including the Benelux Intellectual Property Office;
- (d) the tasks referred to in Regulation (EU) No 386/2012 of the European Parliament and of the Council (**);
- (e) the tasks referred to in Directive 2012/28/EU of the European Parliament and of the Council.

2. The Office shall cooperate with institutions, authorities, bodies, industrial property offices, international and non-governmental organisations in relation to the tasks laid down in paragraph 1.

3. The Office may provide voluntary mediation and arbitration services for the purpose of assisting parties in reaching an amicable settlement .

Article 123c

Cooperation to promote convergence of practices and tools

1. The Office and the industrial property offices of the Member States and the Benelux Office for Intellectual Property shall cooperate with each other on a voluntary basis to promote convergence of practices and tools in the field of trade marks and designs.

This cooperation shall in particular cover the following areas of activity:

- (a) the development of common examination standards;
- (b) the creation of common or connected databases and portals for Union-wide consultation, search and classification purposes;

- (c) the continuous provision and exchange of data and information, including the feeding of the databases and portals referred to in point (b);
- (d) the establishment of common standards and practices, with a view to ensuring interoperability between procedures and systems throughout the Union and enhancing their consistency, efficiency and effectiveness;
- (e) the sharing of information on industrial property rights and procedures, including mutual support to helpdesks and information centres;
- (f) the exchange of technical expertise and assistance in relation to the areas laid down in points (a) to (e).

2. On the basis of a proposal by the President of the Office, the Administrative Board shall define, elaborate and coordinate projects of interest to the Union and the Member States with regard to the areas referred to in paragraph 1. The project definition shall contain the specific obligations and responsibilities of each participating industrial property office of the Member States and the Benelux Office for Intellectual Property.

3. The industrial property offices of the Member States and the Benelux Office for Intellectual Property shall participate effectively in the [...] projects referred to in paragraph 2 with a view to ensuring their development, functioning, interoperability, and keeping up to date.

4. The Office shall provide financial support to the [...] projects [...] referred to in paragraph 2 to the extent this is necessary to ensure the effective participation of the industrial property offices of the Member States and the Benelux Office for Intellectual Property in the projects within the meaning of paragraph 3. That financial support shall take the form of grants. The total amount of funding shall not exceed [OPTION 1 : 20% of the yearly income] [OPTION 2 : 50% of the yearly renewal fees income] of the Office. The beneficiaries of grants shall be the industrial property offices of the Member States and the Benelux Office for Intellectual Property. Grants may be awarded without calls for proposals in accordance with the financial rules applicable to the Office and with the principles of grant procedures contained in the Financial Regulation (EU) No 966/2012 of the European Parliament and of the Council (***) and in the Commission delegated Regulation (EU) No 1268/2012 (****)The industrial property offices of the Member States and the Benelux Office for Intellectual Property may object, where individual projects are concerned, that due to limited budgetary means, the cooperation must be restricted or temporarily suspended because of a lack of financial or staffing resources.

(*) OJ L 3, 5.1.2002, p. 1.

(**) OJ L 129, 16.5.2012, p. 1.

(***) OJ L 298, 26.10.2012, p. 1.

(****) OJ L 362, 31.12.2012, p. 1.;

(99) In Title XII, Sections 2 and 3 are replaced by the following:

'SECTION 2

Administrative Board

Article 124

Functions of the Administrative Board

1. Without prejudice to the functions attributed to the Budget Committee in Section 5, the Administrative Board shall have the following functions:
 - (a) on the basis of a draft submitted by the President in accordance with Article 128(4)(c), the Administrative Board shall adopt the annual work programme of the Office for the coming year, taking into account the opinion of the Commission, and shall forward the adopted annual work programme to the European Parliament, the Council and the Commission;
 - (b) on the basis of a draft submitted by the President in accordance with Article 128(4)(d) and taking into account the opinion of the Commission, the Administrative Board shall adopt a multi-annual strategic programme for the Office, including the Office's strategy for international cooperation, following an exchange of views between the President and the relevant committee in the European Parliament, and shall forward the adopted multi-annual strategic programme to the European Parliament, the Council and the Commission;
 - (c) on the basis of a draft submitted by the President in accordance with Article 128(4)(f), the Administrative Board shall adopt the annual report and shall forward the adopted annual report to the European Parliament, the Council, the Commission and the Court of Auditors;

- (d) on the basis of a draft submitted by the President in accordance with Article 128(4)(g), the Administrative Board shall adopt the multiannual staff policy plan;
- (da) it shall exercise the powers conferred to it by Article 123c(2);
- (e) the Administrative Board shall adopt rules on the prevention and management of conflicts of interest in the Office;
- [(f) in accordance with paragraph 2, it shall exercise, with respect to the staff of the Office, the powers conferred by the Staff Regulations on the Appointing Authority and by the Conditions of Employment of Other Servants on the Authority Empowered to Conclude Contract of Employment ("the appointing authority powers");]
- (g) the Administrative Board shall adopt appropriate implementing rules to the Staff Regulations and the Conditions of Employment of Other Servants in accordance with Article 110 of the Staff Regulations;
- (h) the Administrative Board shall draw up the list of candidates provided for in Article 129(2) ;
- (i) the Administrative Board shall ensure adequate follow-up to the findings and recommendations stemming from the internal or external audit reports and evaluations referred to in Article 165a, as well as from investigations of the European Anti-fraud Office (OLAF);
- (j) the Administrative Board shall be consulted before adoption of the guidelines for examination in the Office and in the other cases provided for in this Regulation;
- (k) the Administrative Board may deliver opinions and requests for information to the President and to the Commission where it considers that this is necessary.

[2. The Administrative Board shall adopt, in accordance with Article 110 of the Staff Regulations and 142 of the Conditions of Employment of Other Servants, a decision based on Article 2(1) of the Staff Regulations and on Article 6 of the Conditions of Employment of Other Servants, delegating the relevant appointing authority powers to the President and defining the conditions under which this delegation of powers can be suspended.

The President shall be authorised to sub-delegate those powers.

Where exceptional circumstances so require, the Administrative Board may by way of a decision temporarily suspend the delegation of the appointing authority powers to the President and those sub-delegated by the latter and exercise them itself or delegate them to one of its members or to a staff member other than the President.]

Article 125

Composition of the Administrative Board

1. The Administrative Board shall be composed of one representative of each Member State and one representative of the Commission and their alternates.
2. The members of the Administrative Board may, subject to its rules of procedure, be assisted by advisers or experts.
3. Deleted.

Article 126

Chairperson of the Administrative Board

1. The Administrative Board shall elect a chairperson and a deputy chairperson from among its members. The deputy chairperson shall ex officio replace the chairperson in the event of his being prevented from attending to his duties.

2. The duration of the terms of office of the chairperson and the deputy chairperson shall be four years. The terms of office shall be renewable once. If, however, their membership of the Administrative Board ends at any time during their term of office, their term of office shall automatically expire on that date also.

Article 127

Meetings

1. Meetings of the Administrative Board shall be convened by its chairperson.
2. The President shall take part in the deliberations, unless the Administrative Board decides otherwise.
3. The Administrative Board shall hold an ordinary meeting once a year. In addition, it shall meet on the initiative of its chairperson or at the request of the Commission or of one-third of the Member States.
4. The Administrative Board shall adopt rules of procedure.
5. The Administrative Board shall take its decisions by simple majority of its members. However, a majority of two-thirds of its members shall be required for the decisions which the Administrative Board is empowered to take under Article 124(1)(a) and (b), Article 126(1) and Article 129(2) and (4). In both cases each member shall have one vote.
6. The Administrative Board may invite observers to attend its meetings.
7. The Secretariat for the Administrative Board shall be provided by the Office.

SECTION 2a

Executive Board

Article 127a

Establishment

Deleted;

Article 127b

Functions and organisation

Deleted

SECTION 3

President

Article 128

Functions of the President

1. The Office shall be managed by the President. The President shall be accountable to the Administrative Board.
2. Without prejudice to the powers of the Commission, the Administrative Board, and the Budget Committee, the President shall be independent in the performance of the duties and shall neither seek nor take instructions from any government or from any other body.
3. The President shall be the legal representative of the Office.

4. The President shall have in particular the following functions:

- (a) he shall take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the Office;
- (b) he shall implement the decisions adopted by the Administrative Board;
- (c) he shall prepare a draft annual work programme indicating estimated human and financial resources for each activity, and submit it to the Administrative Board after consultation of the Commission;
- (ca) he shall submit to the Administrative Board proposals pursuant to Article 123c(2);
- (d) he shall prepare a draft multiannual strategic programme, including the Office's strategy for international cooperation, and submit it to the Administrative Board after consultation of the Commission and following an exchange of views with the relevant committee in the European Parliament;
- (e) he shall implement the annual work programme and the multiannual strategic programme and report to the Administrative Board on their implementation;
- (f) he shall prepare the annual report on the Office's activities and present it to the Administrative Board for approval;
- (g) he shall prepare a draft multiannual staff policy plan and submit it to the Administrative Board after consultation of the Commission;
- (h) he shall prepare an action plan following-up on the conclusions of the internal or external audit reports and evaluations, as well as from investigations of the European Anti-fraud Office (OLAF), and shall report on progress twice a year to the Commission and to the Administrative Board;

- (i) he shall protect the financial interests of the Union by the application of preventive measures against fraud, corruption and any other illegal activities, by effective checks and, if irregularities are detected, by the recovery of the amounts wrongly paid and, where appropriate, by imposing effective, proportionate and dissuasive administrative and financial penalties;
- (j) he shall prepare an anti-fraud strategy of the Office and shall present it to the Budget Committee for approval;
- (k) in order to ensure uniform application of the Regulation, he may refer to the enlarged Board of Appeal questions on a point of law, in particular if the Boards of Appeal have issued diverging decisions on that point;
- (l) he shall draw up estimates of the revenue and expenditure of the Office and shall implement the budget;
- (m) he shall exercise the powers entrusted to him in respect of the staff by the Administrative Board under Article 124(1)(f);
- (n) he shall exercise the powers conferred to him by Articles 26(3), 29(5), 30(2), 45(3), 75(2), 78(5), 79, 79b, 79c, 87(3), 88, 89, 93(4), 119(8) and 144 in accordance with the criteria set out in this Regulation and in the delegated acts adopted pursuant to this Regulation;
- (o) he may delegate his functions;

5. The President shall be assisted by one or more Vice-Presidents. If the President is absent or indisposed, the Vice-President or one of the Vice-Presidents shall replace him in accordance with the procedure laid down by the Administrative Board.

Appointment and removal of the President and extension of his term of office

1. The President shall be engaged as a temporary agent of the Office under Article 2(a) of the Conditions of Employment of Other Servants.

2. The President shall be appointed by the Council [by simple majority], from a list of candidates proposed by the Administrative Board, following an open and transparent selection procedure. Before being appointed, the candidate selected by the Administrative Board may be invited to make a statement before any competent European Parliament committee and to answer questions put by its members. For the purpose of concluding the contract with the President, the Office shall be represented by the chairperson of the Administrative Board.

The President may be removed from office only upon a decision of the Council acting on a proposal from the Administrative Board .

3. The term of office of the President shall be five years. By the end of that period, the Administrative Board shall undertake an assessment which takes into account an evaluation of the performance of the President and the Office's future tasks and challenges.

4. The Council, [...] taking into account the assessment referred to in paragraph 3, may extend once the term of office of the President for no more than five years.

5. A President whose term of office has been extended may not participate in another selection procedure for the same post at the end of the overall period.

6. The Vice-President or Vice-Presidents shall be appointed or removed from office as provided for in paragraph 2, after consultation of the President and, where applicable, the President elect. The term of office of the Vice-President shall be five years. It may be extended once for no more than five years by the Council, after consultation of the President.';

(100) Article 130 is amended as follows:

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

'(c) a department entrusted with the keeping of the Register;'

(b) the following point (f) is added:

'(f) any other unit or person appointed by the President to that effect.';

(100a) In Article 131, the reference to 'Articles 36, 37 and 68' is replaced by 'Articles 36, 37, 68 and 74d'.

(101) In Article 132(2)

(a) the third sentence is replaced by the following:

'Decisions relating to costs or to procedure shall be taken by a single member.

(b) the following additional subparagraph is added :

'The Commission shall adopt an implementing act specifying the types of decisions that shall be taken by a single member. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2). ';

(102) Article 133 is replaced by the following:

'Article 133

Department entrusted with the keeping of the Register

1. The Department entrusted with the keeping of the Register shall be responsible for taking decisions in respect of entries in the Register.

2. It shall also be responsible for keeping the list of professional representatives referred to in Article 93(2).

3. The decisions of the Department shall be taken by one member.';

(103) Article 134 is amended as follows:

(a) Paragraph 1 is replaced by the following:

'1. A Cancellation Division shall be responsible for taking decisions in relation to:

- (a) an application for the revocation or declaration of invalidity of a European Union trade mark,
- (b) a request for the assignment of a European Union trade mark as provided for in Article 18.';

(b) In paragraph 2,

(i) the third sentence is replaced by the following:

Decisions relating to costs or to procedure shall be taken by a single member.(ii) the following additional subparagraph is added :

'The Commission shall adopt an implementing act specifying the types of decisions that shall be taken by a single member. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2). ';

';

(104) The following Article 134a is inserted:

'Article 134a

General Competence

Decisions required by this Regulation which do not fall within the competence of an examiner, an Opposition Division, a Cancellation Division or the Department entrusted with the keeping of the Register, shall be taken by any official or unit appointed by the President for that purpose.';

(105) Article 135 is amended as follows:

(a) paragraph 1 is replaced by the following:

'1. The Boards of Appeal shall be responsible for deciding on appeals from decisions taken pursuant to Articles 131 to 134a.';

(b) in paragraph 3, point (a) is replaced by the following:

'(a) by the authority of the Boards of Appeal referred to in Article 136(4)(a);
or';

(c) paragraph 4 is replaced by the following:

'4. The enlarged Board shall also be responsible for giving reasoned opinions on questions of law referred to it by the President pursuant to Article 128(4)(k).';

(d) In paragraph 5, the last sentence is deleted and a new subparagraph is added:

The Commission shall adopt an implementing act specifying cases which the Boards of Appeal may devolve to a single member as well as procedural arrangements governing such a devolution. That implementing act shall be adopted in accordance with the examination procedure referred to Article 163(2);

(106) Article 136 is replaced by the following:

'Article 136

Independence of the members of the Boards of Appeal

1. The President of the Boards of Appeal and the chairpersons of the Boards shall be appointed, in accordance with the procedure laid down in Article 129 for the appointment of the President, for a term of five years. They shall not be removed from office during this term, unless there are serious grounds for such removal and the Court of Justice, on application by the institution which appointed them, takes a decision to this effect.

2. The term of office of the President of the Boards of Appeal may be extended once for one additional five-year period, or until retirement age if this age is reached during the new term of office, after a prior positive evaluation of his performance by the Administrative Board.

3. The term of office of the chairpersons of the Boards may be extended for additional five-year periods, or until retirement age if this age is reached during the new term of office, after a prior positive evaluation of their performance by the Administrative Board, after consulting the President of the Boards of Appeal.

4. The President of the Boards of Appeal shall have in particular the following managerial and organisational functions:

- (a) chairing the authority of the Boards of Appeal responsible for laying down the rules and organising the work of the Boards;
- (b) ensuring the implementation of the authority's decisions;
- (c) allocating cases to a Board on the basis of objective criteria determined by the authority of the Boards of Appeal;

- (d) establishing and forwarding to the President the expenditure requirements of the Boards, with a view to drawing up the expenditure estimates.

The President of the Boards of Appeal shall chair the enlarged Board.

5. The members of the Boards of Appeal shall be appointed by the Administrative Board for a term of five years. Their term of office may be extended for additional five-year periods, or until retirement age if that age is reached during the new term of office after a prior positive evaluation of their performance by the Administrative Board, after consulting the President of the Boards of Appeal.

6. The members of the Boards of Appeal shall not be removed from office unless there are serious grounds for such removal and the Court of Justice, after the case has been referred to it by the Administrative Board on the recommendation of the President of the Boards of Appeal, after consulting the chairperson of the Board to which the member concerned belongs, takes a decision to this effect.

7. The President of the Boards of Appeal and the chairpersons and members of the Boards of Appeal shall be independent. In their decisions they shall not be bound by any instructions.

8. Decisions taken by an enlarged Board on appeals or opinions on questions of law referred to it by the President pursuant to Article 135 shall be binding on the decision-making instances of the Office referred to in Article 130.

9. The President of the Boards of Appeal and the chairpersons and members of the Boards of Appeal shall not be examiners or members of the Opposition Divisions, the Department entrusted with the keeping of the Register or Cancellation Divisions.';

[(106a) The following Article 137a is inserted:

'Article 137a

Mediation and arbitration centre

1. In application of Article 123b(3), the Office may establish a Mediation and Arbitration Centre which is independent of the decision-making instances listed in Article 130.

2. Any natural or legal person may use the Centre's services on a voluntary basis with the aim of resolving disputes covered by this Regulation and by Directive ... by mutual agreement.

3. The Office may also start an arbitration procedure on its own initiative with a view to giving parties the opportunity to reach an agreement by common consent.

4. In case the mediation or arbitration relates to disputes pending before any decision making instance of the Office, the parties may agree to suspend the proceedings at any time, in order to enter into mediation or arbitration proceedings.

5. Any agreement reached as a result of mediation or arbitration shall be binding on the decision making instances of the Office. The effect of the agreement on disputes pending before third entities shall be subject to the rules applicable to these bodies.

6. The Centre shall be led by a Director who shall be responsible for the centre's activities.

7. The Director shall be appointed by the Administrative Board.

8. The Centre shall draw up rules governing mediation and arbitration procedures and rules governing the centre's work. The rules governing mediation and arbitration procedures and the rules governing the Centre's work shall be ratified by the Administrative Board, upon proposal of the President of the Boards of Appeal.

9. The Centre shall establish a register of mediators and arbitrators who support parties in resolving disputes. They must possess relevant skills and experience. The register shall require the approval of the Administrative Board.

10. Mediators and arbitrators shall be impartial in the exercise of their duties and shall declare any real or perceived conflict of interest upon their designation. Examiners and members of the Division of the Office or Boards of Appeal may not take part mediation or arbitration concerning a case in which they have:

- (a) any prior involvement in the procedures undergoing mediation or arbitration;
- (b) any personal interest; or
- (c) been previously involved as a representative of one of the parties.

11. No person called to testify as a member of an arbitration or mediation panel may be involved in the objection, annulment or proceedings which gave rise to the mediation or arbitration process.

12. The Centre may cooperate with other recognised national or international bodies dealing with mediation or arbitration.]

(107) Article 138 is replaced by the following:

'Article 138

Budget Committee

1. The Budget Committee shall have the functions assigned to it in this Section.

2. Articles 125, 126 and 127(1) to (4), (6) and (7) shall apply to the Budget Committee mutatis mutandis.

3. The Budget Committee shall take its decisions by simple majority of its members. However, a majority of two-thirds of its members shall be required for the decisions which the Budget Committee is empowered to take under Article 140(3) and Article 143. In both cases each member shall have one vote. ';

(108) In Article 139, the following paragraphs 04,4 and 4a are added:

"04. Expenditure shall include reimbursement to the Commission of the complementary contribution due by the latter to the European School of Alicante in accordance with Article 25(2) of the Convention defining the Statute of the European Schools of 21 June 1994, as revised and amended, with the exception of the pro rata of the contribution corresponding to pupils depending on persons employed in European Union institutions, agencies or bodies other than the Office. Not later than 31 January in each year, the Commission shall inform the Office of the expenditure expected for the following year so the Office may include it in the estimate budget in accordance to in article 140(1). The Commission shall regularly inform the Office of the matters of interest of the Administrative Board of thw School of Alicante, as well as of the Boards of Governors of the European Schools concerning the European School of Alicante.

4. The Office shall prepare on a biannual basis a report to the Commission on its financial situation. On the basis of this report, the Commission shall review the financial situation of the Office.

4a. The Office shall provide for a reserve fund covering one year of its operational expenditure to ensure the continuity of its operations and the execution of its tasks.';

(109) The following Article 141a is inserted:

'Article 141a

Combating fraud

1. In order to facilitate combating fraud, corruption and other unlawful activities under Regulation (EC) No 1073/1999 the Office shall accede to the Interinstitutional Agreement of 25 May 1999 concerning internal investigations by the European Anti-fraud Office (OLAF) and adopt the appropriate provisions applicable to all the employees of the Office using the template set out in the Annex to that Agreement.
2. The European Court of Auditors shall have the power of audit, on the basis of documents and on the spot, over all grant beneficiaries, contractors and subcontractors who have received Union funds from the Office.
3. OLAF may carry out investigations, including on-the-spot checks and inspections, in accordance with the provisions and procedures laid down in Regulation (EC) No 1073/1999 and Regulation (Euratom, EC) No 2185/96 with a view to establishing whether there has been fraud, corruption or any other illegal activity affecting the financial interests of the Union in connection with a grant or a contract funded by the Office.
4. Without prejudice to paragraphs 1, 2 and 3, cooperation agreements with third countries and international organisations, contracts, grant agreements and grant decisions of the Office shall contain provisions expressly empowering the European Court of Auditors and OLAF to conduct such audits and investigations, according to their respective competences.
5. The Budget Committee shall adopt an anti-fraud strategy, which is proportionate to the fraud risks having regard to the cost-benefit of the measures to be implemented.';

(110) Article 144 is replaced by the following:

'Article 144

Fees

1. In addition to the fees provided for in Articles 22a(2), 24a(2), 26(2), 36(1)(c), 41(3), 44(4), 47(1) and (3), 48(4), 49(4), 56(2), 60, 81(3), 82(1), 87(6), 88, 113(1) and 147(5), fees shall be charged in the following cases:

- (a) issue of a copy of the certificate of registration;
- (b) registration of a license or another right in respect of a European trade mark;
- (c) registration of a license or another right in respect of an application for a European trade mark;
- (d) cancellation of the registration of a license or another right;
- (e) alteration of a registered European trade mark;
- (f) issue of an extract from the Register;
- (g) inspection of the files;
- (h) issue of copies of file documents;
- (i) issue of certified copies of the application;
- (j) communication of information in a file;
- (k) review of the determination of the procedural costs to be refunded.

2. The amounts of the fees [...] shall be fixed at the levels set out in Annex I so as to ensure that:

a) the revenue in respect thereof is in principle sufficient for the budget of the Office to be balanced, and

b) there is coexistence and complementarity between the European Union trade mark and the national trade mark systems, also taking into account the size of the market covered by European Union trade marks.

3. Without prejudice to Article 139(4a), budgetary surpluses are to be used, following due assessment of the circumstances, to promote projects of interest to the Union and the Member States serving to promote and protect intellectual property.

4. The President may take the following measures with the consent of the Budget Committee:

(a) he may establish which specific methods of payment may be used in particular by means of deposits in current accounts held with the Office;

(b) he may determine the amounts below which an excessive sum paid to cover a fee or a charge shall not be refunded;

(c) he may waive action for the enforced recovery of any sum due where the sum to be recovered is minimal or where such recovery is too uncertain.

Where the methods of payment referred to in point (a) may be used, the President shall establish the date on which such payments are to be considered to have been made to the Office. The methods of payment laid down by the President shall be published in the Official Journal of the Office.

5. The President shall lay down the amount to be charged for any services rendered by the Office other than those mentioned in Annex 1, as well as the amount to be charged for the European Union Trade Marks Bulletin, the Official Journal of the Office and any other publications issued by the Office. The amounts of charges shall be laid down in euros and shall be published in the Official Journal of the Office. The amount of the charge shall not exceed what is necessary to cover the costs of the specific service rendered by the Agency.

[Need to reflect Articles, 4 to 10 of the Fees Regulation]

(111) The following Section 6 is inserted:

'SECTION 6

Delegation of powers

Article 144a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 in order to establish:

(a) Deleted;

(b) Deleted

(c) the details on the organisation of the Boards of Appeal, including the setting up [...] of the authority of the Boards of Appeal referred to in Article 135(3)(a), the composition of the enlarged Board and the rules on referrals to it as referred to in Article 135(4) [...]

(d) Deleted;

(112) In Article 145, the words 'its Implementing Regulations' are replaced by 'the [...] acts adopted pursuant to this Regulation';

(113) Article 147 is amended as follows:

(a) in paragraph 1, at the end of the first sentence, the following is added:

'which shall be based on the official form provided by the International Bureau of the World Intellectual Property Organisation (hereinafter: "the International Bureau"),⁴⁵.

(b) paragraphs 4, 5 and 6 are replaced by the following:

'3a. The international application shall contain sufficient information to establish the identity between the trade mark subject to the international application and the trade mark as appearing in the basic European Union trade mark application or registration and to verify the eligibility to file an international application in accordance with the Madrid Protocol. The Office shall not refuse to forward the international application to the International Bureau before the applicant has had the opportunity to correct any deficiency detected in the application.

4. The filing of an international application shall be subject to the payment of a fee to the Office. Where the international registration is to be based on a European Union trade mark once it is registered, the fee shall be due on the date of registration of the European Union trade mark. The application shall be deemed not to have been filed until the required fee has been paid.

5. The international application shall fulfil the formal requirements laid down in paragraphs 1 to 4 and in the act adopted pursuant to paragraph 8.

6. The Office shall examine whether the international application meets the requirements referred to in Article 146 and in paragraphs 1, 3 and 5 of this Article.

7. The Office shall forward the international application to the International Bureau as soon as the international application meets the requirements referred to in paragraph 6.;

⁴⁵ Rule 102(1)

8. The Commission shall adopt an implementing act specifying the requirements for the international application, the procedure regarding the examination of such applications as well as the forwarding thereof to the International Bureau. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

(114) The following Article 148a is inserted:

'Article 148a

Notification of the invalidity of the basic application or registration

1. Within a period of five years from the date of the international registration, the Office shall notify the International Bureau of the facts and decisions affecting the validity of the European Union trade mark application or the European Union trade mark registration on which the international registration was based.

2. The Commission shall adopt an implementing act specifying facts and decisions subject to the notification obligation as well as the formats/contents of such notifications . That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).';

(115) In Article 149,

(a) the second sentence is replaced by the following:

'The request must be filed in a form referred to in Article 147(1) and in the language in which the international application was filed pursuant to Article 147. It shall contain sufficient information to identify the international registration to which it relates and to verify the eligibility for a subsequent designation in accordance with the Madrid Protocol. The Office shall not refuse to forward the request to the International Bureau before the applicant has had the opportunity to correct any deficiency detected in the request.

(b) the following subparagraph is added:

'The Commission shall adopt an implementing act specifying the requirements regarding the request, the procedure for the examination of such requests as well as the forwarding thereof to the International Bureau. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

(115a) In Article 153(2):

(a) the following sentence shall be added:

'When the seniority is claimed before the date referred to in the first sentence, the seniority claim shall be deemed to have been received by the Office on that date.'⁴⁶

(b) The following paragraphs 3, 4, 5 and 6 shall be added:

"3. The seniority claim referred to in paragraph 1 shall fulfill the requirements referred to in Article 34 and the procedural formalities as specified in an act adopted pursuant to paragraph 6. The right of seniority shall not be lost before the applicant has had the opportunity to remedy the deficiencies detected by the Office. The Office shall inform the International Bureau of any declaration of loss of the right of seniority and of any withdrawal or restriction of the seniority claim.

4. The application for seniority claim referred to in paragraph 2 shall fulfill the requirements referred to in Article 35. It shall contain sufficient information to enable its examination against those requirements. The application shall not be rejected before the applicant has had the opportunity to remedy the deficiencies detected by the Office.

5. Where a seniority claim has been withdrawn or cancelled by the Office, the Office shall inform the International Bureau accordingly.

⁴⁶ Rule 110(2)

6. The Commission shall adopt an implementing act specifying the procedure for filing the seniority claims in accordance with this Article, including the information to be notified as referred to in paragraph 2 and the mandatory elements of the application referred to in para 4. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2)."

(116) Article 154 is amended as follows :

(a) The title is replaced by the following:

"Designation of goods and services and examination as to absolute grounds for refusal"

(b) Paragraph 1 is replaced by the following :

'(1). International registrations designating the Union shall be subject to examination as to their conformity with Article 28(2) to (4) and to absolute grounds for refusal in the same way as applications for European Union trade marks. Where the international registration designating the Union is ineligible for protection for all or any part of the goods and services for which it has been registered by the International Bureau, the Office shall issue an ex officio notification of provisional refusal in accordance with the Madrid Protocol to the International Bureau."

(c) in paragraph 2 the following sentence shall be added:

"The decision refusing the protection shall be subject to appeal in accordance with this Regulation."

(d) paragraph 4 is replaced by the following:

"4. The Commission shall adopt an implementing act laying down the procedure for the examination of absolute grounds for refusal, including rules regarding the necessary communications to be made to the International Bureau. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2)."

(117) The following Article 154a is inserted:

'Article 154a

Collective and certification marks

Where an international registration is based on a basic application or basic registration relating to a collective mark, certification mark or guarantee mark, the Office shall comply[need to reflect Rule 121].';

(118) [OPTION 1: Article 155 is amended as follows:

(a) in paragraph 1, the following half sentence is added:

'unless the holder of the international registration requests not to receive such search report.';

(b) in paragraph 2, the following is added:

'provided that a request for a search report pursuant to Article 38(2) is made to the Office within one month as from the date of notification and the search fee is paid within the same period.';

[OPTION 2: In Article 155, paragraphs 2 and 3 are deleted;]

(119) Article 156 is amended as follows:

(a) in paragraph 2 the following sentence is added:

" Where an opposition against international registration is entered at the Office, the Office shall issue a notification of provisional refusal of protection based on an opposition to the International Bureau."

(aa) in paragraph 2, the words 'six months' are replaced by 'one month' and the following sentence is added:

"The notice of opposition shall contain sufficient information to identify the international registration against which opposition is entered as well as all the mandatory elements adopted pursuant to Article 41(3).

The Commission shall adopt an implementing act specifying the mandatory elements of the notice of opposition, the procedure for the examination of an opposition, including rules regarding the necessary communications to be made to the International Bureau. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).";

(b) paragraph 4 is deleted;

(119a) In Article 158, the following paragraph 3 is added:

'3. Where the effects of an international registration have been declared invalid by means of a final decision, the Office shall notify the International Bureau accordingly. The Commission shall adopt an implementing act laying down the cases subject to the notifications to be made to the International Bureau and the information that they shall contain. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).'

(120) The following Articles 158a, 158b and 158c are inserted:

'Article 158a

Legal effect of registration of transfers

The recordal of a change in the ownership of the international registration on the International Register shall have the same effect as the entry of a transfer in the Register pursuant to Article 17.

Article 158b

Legal effect of registration of licenses and other rights

The recordal of a license or a restriction of the holder's right of disposal in respect of the international registration in the International Register shall have the same effect as the registration of a license, a right in rem, a levy of execution or insolvency proceedings in the Register pursuant to Articles 19, 20, 21 and 22 respectively.

Article 158c

Examination of requests for registration of transfers, licenses or restrictions of the holder's right of disposal

The Office shall transmit requests to register a change in ownership, a license or a restriction of the holder's right of disposal, the amendment or cancellation of a license or the removal of a restriction of the holder's right of disposal which have been filed with it to the International Bureau if accompanied by the appropriate proof of the transfer, license, a restriction of the right of disposal or by proof that the license no longer exists or that it has been amended;

(121) Article 159 is amended as follows:

(a) in paragraph 1, point (b) is replaced by the following:

'(b) into a designation of a Member State party to the Madrid Protocol, provided that on the date when conversion was requested it was possible to have designated that Member State directly under the Madrid Protocol. Articles 112, 113 and 114 shall apply.';

(b) in paragraph 2, the words 'or the Madrid Agreement' are deleted;

(c) the following paragraphs 4 and 5 are added:

'4. The application for conversion shall contain sufficient information and indications to identify the international registration as well as mandatory elements laid down in an act adopted pursuant to Article 113(3) . Where conversion is requested pursuant to this Article and Article 112(5) of this Regulation following a failure to renew the international registration, the application shall contain an indication to that effect and the date on which the protection has expired. The period of three months provided for in Article 112(5) shall begin to run on the day following the last day on which the renewal may still be effected pursuant to Article 7(4) of the Madrid Protocol.

The rules governing the examination of the application pursuant to Article 113(3) shall apply.

The Commission shall adopt an implementing act laying down the mandatory elements of the request for conversion. That implementing act shall be adopted in accordance with the examination procedure referred to in Article 163(2).

5. Where the application for conversion complies with the requirements of this Regulation and rules adopted pursuant to it, the Office shall transmit it without delay to the International Bureau and shall inform the holder of the international registration of the date of transmission.'⁴⁷;

(121a) The following Articles 161a and 161b are inserted:

'Article 161a

Communication with the International Bureau

Communication with the International Bureau shall be in a manner and format agreed on between the International Bureau and the Office, preferably by electronic means. Any reference to forms shall be construed as including forms made available in electronic format.⁴⁸

Article 161b

Use of languages

For the purpose of applying this Regulation and rules adopted pursuant to it to international registrations designating the Union, the language of filing of the international application shall be the language of the proceedings within the meaning of Article 119(4), and the second language indicated in the international application shall be the second language within the meaning of Article 119(3).';⁴⁹

⁴⁷ Rule 123(4)

⁴⁸ Rule 125

⁴⁹ Rule 126

(122) In Title XIII the following Section 4 is inserted:

'SECTION 4

Conferral of powers

Article 161c

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 concerning:

- (a) Deleted.;
- (b) Deleted.
- (c) Deleted;
- (d) Deleted.;
- (e) Deleted.
- (f) Deleted.
- (g) Deleted.;
- (h) Deleted.;
- (i) Deleted.
- (j) the mandatory elements and indications of an application for transformation referred to in Article 161 and the procedure for such a transformation;
- (k) Deleted.';

(123) Article 162 is deleted;

(124) Article 163 is replaced by the following:

'Article 163

Committee Procedure

1. The Commission shall be assisted by a Committee on Fees, Implementation Rules and the Procedure of the Boards of Appeal of the Office for Harmonisation in the Internal Market (trade marks and designs). That committee shall be a committee within the meaning of Regulation (EU) No 182/2011.

2. Where reference is made to this paragraph, Article 5 of Regulation (EU) No 182/2011 shall apply.'

(125) The following Article 163a is inserted:

'Article 163a

Exercise of the delegation

1. The power to adopt delegated acts is conferred on the Commission subject to the conditions laid down in this Article.

2. The power to adopt delegated acts referred to in Articles [...] 45a, 49a, 57a, 65a, [...]144a and 161c shall be conferred for an indeterminate period of time.

3. The delegation of power referred to in paragraph 2 may be revoked at any time by the European Parliament or by the Council. A decision of revocation shall put an end to the delegation of the power specified in that decision. It shall take effect the day following the publication of the decision in the *Official Journal of the European Union* or at a later date specified therein. It shall not affect the validity of any delegated acts already in force.

4. As soon as it adopts a delegated act, the Commission shall notify it simultaneously to the European Parliament and to the Council.

5. A delegated act adopted pursuant to Articles [...]45a, 49a, 57a, 65a, [...] , 144a and 161c shall enter into force only if no objection has been expressed either by the European Parliament or the Council within a period of 2 months of notification of that act to the European Parliament and the Council or if, before the expiry of that period, the European Parliament and the Council have both informed the Commission that they will not object. That period shall be extended by 2 months at the initiative of the European Parliament or the Council.';

(126) Article 164 is deleted;

(127) The following Article 165a is inserted:

'Article 165a

Evaluation and review

1. By 2019, and every five years thereafter, the Commission shall commission an evaluation on the implementation of this Regulation.

2. The evaluation shall review the legal framework for cooperation between the Office and the central industrial property offices of the Member States and the Benelux Office for Intellectual Property, with a particular attention to the financing mechanism. The evaluation shall further assess the impact, effectiveness and efficiency of the Office and its working practices. The evaluation shall, in particular, address the possible need to modify the mandate of the Office, and the financial implications of any such modification.

3. The Commission shall forward the evaluation report together with its conclusions drawn on the report to the European Parliament, the Council and the Administrative Board. The findings of the evaluation shall be made public.

4. On the occasion of every second evaluation, there shall be an assessment of the results achieved by the Office having regard to its objectives, mandate and tasks. [...]

Article 2

This Regulation shall enter into force on [specify date 90 days after its publication in the Official Journal of the European Union].

Article(*to be completed*) shall apply from [specify the first day of the first month after 18 months following the date specified in the first paragraph].

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels,

For the European Parliament
The President

For the Council

The President

Amount of fees**A. Fees to be paid to the Office**

The fees to be paid to the Office under this Regulation shall be as follows (in EUR):

1. Basic fee for the application for an individual mark (Article 26(2))

[OPTION 1 : 925] [OPTION 2 : 1050]

2. Basic fee for the application for an individual mark by electronic means (Article 26(2), Rule 4(a)):

[OPTION 1 : 775] [OPTION 2 : 900]

[3. Basic fee for the application for an individual mark by electronic means and using the online classification database (Article 26(2)) : 725]

4. Fee for the second class of goods and services for an individual mark (Article 26(2))	50
5. Fee for the third class of goods and services for an individual mark (Article 26(2))	75
6. Fee for each class of goods and services exceeding three for an individual mark (Article 26(2))	150
7. Basic fee for the application for a collective mark (Article 26(2) and Article 66(3))	1000
8. Basic fee for the application for a collective mark by electronic means and using the online classification database (Article 26(2) and Article 66(3))	950

9. Fee for the second class of goods and services for a collective mark (Article 26(2) and Article 66(3))	50
10. Fee for the third class of goods and services for a collective mark (Article 26(2) and Article 66(3))	75
11. Fee for each class of goods and services exceeding three for a collective mark (Article 26(2) and 66(3))	150
12. Opposition fee (Article 41(3))	350
<u>13. Basic fee for the renewal of an individual mark (Article 47(1)):</u>	
<u>[OPTION 1: 1150] [OPTION 2 : 1050]</u>	
<u>14. Basic fee for the renewal of an individual mark by electronic means (Article 47(1)):</u>	
<u>[OPTION 1: 1000] [OPTION 2 : 900]</u>	
<u>15. Fee for the renewal of the second class of goods and services for an individual mark (Article 47(1)):</u>	
<u>[OPTION 1: 100] [OPTION 2 : 50]</u>	
<u>16. Fee for the renewal of the third class of goods and services for an individual mark (Article 47(1)):</u>	
<u>[OPTION 1: 150] [OPTION 2 : 75]</u>	
<u>17. Fee for the renewal of each class of goods and services exceeding three for an individual mark (Article 47(1)):</u>	
<u>[OPTION 1: 300] [OPTION 2 : 150]</u>	
18. Basic fee for the renewal of a collective mark (Article 47(1) and Article 66(3))	1275

19. Fee for the renewal of the second class of goods and services for a collective mark (Article 47(1) and Article 66(3))	100
20. Fee for the renewal of the third class of goods and services for a collective mark (Article 47(1) and Article 66(3))	150
21. Fee for the renewal of each class of goods and services exceeding three for a collective mark (Article 47(1) and Article 66(3))	300
22. Additional fee for the late payment of the renewal fee or the late submission of the request for renewal (Article 47(3))	
25% of the belated renewal fee, subject to a maximum of 1150 EUR	
23. Fee for the application for revocation or for a declaration of invalidity (Article 56(2))	700
24. Appeal fee (Article 60)	800
25. Fee for the application of restitution in integrum (Article 81(3))	200
26. Fee for the application for the conversion of a European Union trade mark application or a European Union trade mark (Article 113(1), also in conjunction with Article 159(1))	
(a) into a national trade mark application	
(b) into a designation of Member States under the Madrid Protocol	200
27. Fee for continuation of proceedings (Article 82(1))	400

28. Fee for the declaration of division of a registered European Union trade mark (Article 49(4) or an application for
European Union trade mark (Article 44(4)) 250

29. Fee for the application for the registration of a license or another right in respect of a registered European Union trade mark (Article 22a(2)) or an application for a European Union trade mark (Article 22a(2)):

- a) grant of a license
- b) transfer of a license
- c) creation of a right in rem
- d) transfer of a right in rem
- e) levy of execution

200 EUR per registration, but where multiple requests are submitted in the same application or at the same time, not to exceed a total of 1000 EUR

30. Fee for the cancellation of the registration of a license or other right (Article 24a(2))

200 EUR per cancellation, but where multiple requests are submitted in the same application or at the same time, not to exceed a total of 1000 EUR

31. Fee for the alteration of a registered European Union trade mark
(Article 48(4)) 200

B. Fees to be paid to the International Bureau

I. Individual fee for an international registration designating the Union

1. The applicant for an international application designating the Union shall be required to pay to the International Bureau an individual fee for the designation of the Union in accordance with Article 8(7) of the Madrid Protocol.

2. The holder of an international registration who files a request for territorial extension designating the Union made subsequently to the international registration shall be required to pay to the International Bureau an individual fee for the designation of the Union in accordance with Article 8(7) of the Madrid Protocol.

3. The amount of the fee under paragraph 1 or 2 shall be the equivalent in Swiss Francs, as established by the Director General of the World Intellectual Property Organization pursuant to Rule 35(2) of the Common Regulations under the Madrid Agreement and Protocol, of the following amounts:

(a) for an individual mark: EUR **950** plus, where applicable, EUR **100** for the second class of goods and services, EUR **150** for the third class of goods and services, and EUR **300** for each class of goods and services **contained in the international registration** exceeding three;⁵⁰

(b) for a collective mark: EUR 950 plus, where applicable, EUR 50 for the second class of goods and services, EUR 75 for the third class of goods and services, and EUR 150 for each class of goods or services exceeding three.

II. Individual fee for a renewal of an international registration designating the Union

1. The holder of an international registration designating the Union shall be required to pay to the International Bureau, as a part of the fees for a renewal of the international registration, an individual fee for the designation of the Union in accordance with Article 8(7) of the Madrid Protocol.

2. The amount of the fee referred to in paragraph 1 shall be the equivalent in Swiss Francs, as established by the Director General of the World Intellectual Property Organization pursuant to Rule 35(2) of the Common Regulations under the Madrid Agreement and Protocol, of the following amounts:

⁵⁰ It will depend upon the level of renewal fees.

(a) for an individual mark: EUR 950 plus, where applicable, EUR 100 for the second class of goods and services, EUR 150 for the third class of goods and services, and EUR 300 for each class of goods and services contained in the international registration exceeding three;

(b) for a collective mark: EUR 1225 plus, where applicable, EUR 100 for the second class of goods and services, EUR 150 for the third class of goods and services, and EUR 300 for each class of goods and services contained in the international registration exceeding three.
