

## COMMISSION REGULATION (EC) No 1041/2005

of 29 June 2005

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

(Text with EEA relevance)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

amended: Rule 1(1)(c), Rule 3(2), Rule 61, Rule 72(4), Rule 79, Rule 82, Rule 89(1) and (2).

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark <sup>(1)</sup>, and in particular Article 157 thereof,

Whereas:

- (1) According to Regulation (EC) No 40/94, it is necessary to adopt technical measures to implement dispositions concerning the standard form for the searches reports, division of the application and registration, revocation of decisions, authorisations, and decisions taken by a single member of the Opposition or Cancellation Division.
- (2) After 10 March 2008 the search system will remain compulsory for Community trade marks, but it should be made optional, subject to the payment of a fee, for searches in the trade mark registers of the Member States which notified their own decision to carry out a search. A standard form comprising essential elements for the search report is hereby laid out with a view to improving the quality and uniformity of such search reports.
- (3) The declaration of division and registration must comply with the elements set out in the present regulation. The new *ex officio* revocation of a decision or an entry in the register by the Office for Harmonization in the Internal Market (trade marks and designs) (The Office) must comply with the specific procedure as established in the present regulation. The exceptional cases where an authorisation is mandatory are specified. A list of simple cases where a decision can be taken by a single member of the Opposition or Cancellation Divisions is provided for.
- (4) Furthermore, existing rules should be amended in order to improve or clarify the procedure for registration. In addition, certain procedural points should be amended without changing the substance of the system.
- (5) In order to cover the specificities and facilities of the e-filing procedure, the following provisions are

- (6) The electronic filing and electronic publication of Community trade mark applications should facilitate the filing of trade marks in general and in particular enhance the filing of trade marks consisting of colours per se or sounds by means of a representation of the mark which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The technical conditions, in particular the data format for sound files, should be laid down by the President of the Office. E-filing of trade marks consisting of sounds can be accompanied by an electronic sound file and this file can be included in the electronic publication of the Community trade mark applications to facilitate public access to the sound itself.
- (7) The provisions concerning the opposition procedure should be reframed completely as to specify the admissibility requirements, to specify clearly the legal consequences of deficiencies and to bring the provisions in the chronological order of the proceedings.
- (8) Following the additional competence of the Office for the examination of the admissibility of conversion the refusal of a request for conversion may become partial in the sense that conversion can be acceptable for some Member States but inadmissible for others. In addition, some criteria to be used for examining absolute grounds by reference to the language of a Member State should be added.
- (9) Regarding costs to be born by the losing party in opposition and cancellation procedures, reimbursable costs of the representation should be limited but the present maximum amounts should be increased slightly in view of the time elapsed since adoption of the Implementing Regulation. Where witnesses or experts are summoned, no such maximum rate should be provided but the reimbursable costs shall comprise the actual amounts those witnesses and experts can claim.
- (10) Commission Regulation (EC) No 2868/95 <sup>(2)</sup> should therefore be amended accordingly.

<sup>(1)</sup> OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 422/2004 (OJ L 70, 9.3.2004, p. 1).

<sup>(2)</sup> OJ L 303, 15.12.1995, p. 1. Regulation as amended by Regulation (EC) No 782/2004 (OJ L 123, 27.4.2004, p. 88).

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

HAS ADOPTED THIS REGULATION:

*Article 1*

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

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

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

'(b) the name, address and nationality of the applicant and the State in which he is domiciled or has his seat or an establishment. Names of natural persons shall be indicated by the persons family name and given name(s). Names of legal entities, as well as bodies falling under Article 3 of the Regulation, shall be indicated by their official designation and include the legal form of the entity, which may be abbreviated in a customary manner. The telephone numbers, fax numbers, electronic mail address and details of other data communications links under which the applicant accepts to receive communications may be given. Only one address shall, in principle, be indicated for each applicant. Where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for service;'

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

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

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

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

- (d) point (l) is added:

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

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

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

'2. In cases other than those referred to in paragraph 1 and save where the application is filed by electronic means, the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of

the application appears. The sheet on which the mark is reproduced shall not exceed DIN A4 size (29,7 cm high, 21 cm wide) and the space used for the reproduction (type-area) shall not be larger than 26,2 cm × 17 cm. A margin of at least 2,5 cm shall be left on the left-hand side. Where it is not obvious, the correct position of the mark shall be indicated by adding the word "top" to each reproduction. The reproduction of the mark shall be of such quality as to enable it to be reduced or enlarged to a size not more than 8 cm wide by 16 cm high for publication in the Community Trade Mark Bulletin.';

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

'5. Where registration in colour is applied for, the representation of the mark under paragraph 2 shall consist of the colour reproduction of the mark. The colours making up the mark shall also be indicated in words and a reference to a recognized colour code may be added.

6. Where registration of a sound mark is applied for, the representation of the trade mark shall consist of a graphical representation of the sound, in particular a musical notation; where the application is filed through electronic means, it may be accompanied by an electronic file containing the sound. The President of the Office shall determine the formats and maximum size of the electronic file.';

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

*'Rule 4*

**Fees for the application**

The fees payable for the application shall be:

- (a) the basic fee;
- (b) a class fee for each class exceeding three to which the goods or services belong according to Rule 2;
- (c) where applicable, the search fee.';

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

*'Rule 5a*

**Search report**

The search reports shall be prepared using a standard form which contains at least the following information:

- (a) the name of the central industrial property offices that carried out the search;

- (b) the number of the trademark applications or registrations mentioned in the search report;
- (c) the date of application and if applicable date of priority of the trademark applications or registrations mentioned in the search report;
- (d) the date of registration of the trademarks mentioned in the search report;
- (e) the name and contact address of the holder of the trademarks applications or registrations mentioned in the search report;
- (f) a representation of the trademarks applied for or registered mentioned in the search report;
- (g) an indication of the classes, according to the Nice Classification, for which the earlier national trademarks are applied for or registered or of the goods and services for which the trademarks mentioned in the search report are either applied for or registered.;

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

'If the previous application is a Community trade mark application, the Office shall *ex officio* include a copy of the previous application in the file of the Community trade mark application.';

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

'2. Where the applicant wishes to claim the seniority of one or more earlier registered trade marks as referred to in Article 34 of the Regulation, subsequent to the filing of the application, the declaration of seniority, indicating the Member State or Member States in or for which the mark is registered, the number and the filing date of the relevant registration, and the goods and services for which the mark is registered, shall be submitted within a period of two months from the filing date. The evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of seniority.';

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

*Rule 10*

**Searches by national offices**

1. If the request for a search report referred to in Article 39(2) of the Regulation is not made in the application for a Community trade mark, or if the search fee referred to in Rule 4(c) is not paid within the time limit for paying the basic application fee, the application shall not be subjected to a search by the central industrial property offices.

2. An international registration designating the European Community shall not be subjected to a search by the central industrial property offices if the request for a search report pursuant to Article 39(2) of the Regulation is not made to the Office within one month starting with the date on which the International Bureau notifies the international registration to the Office, or if the search fee is not paid within the same period.;

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

'(c) the reproduction of the mark, together with the elements and descriptions referred to in Rule 3; where the reproduction of the mark is in colour or contains colours, the publication shall be in colour and shall indicate the colour or colours making up the mark, as well as, where applicable, the colour code indicated';

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

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

*Rule 13a*

**Division of the application**

1. A declaration of the division of the application pursuant to Article 44a of the Regulation shall contain:

- (a) the file number of the application;
- (b) the name and address of the applicant in accordance with Rule 1(1)(b);
- (c) the list of goods and services which shall form the divisional application, or, where the division into more than one divisional application is sought, the list of goods and services for each divisional application;
- (d) the list of goods and services which shall remain in the original application.

2. Where the Office finds that the requirements laid down in paragraph 1 are not fulfilled or the list of goods and services which shall form the divisional application overlap with the goods and services which shall remain in the original application, it shall invite the applicant to remedy the deficiencies noted within such period as it may specify.

If the deficiencies are not remedied before the time limit expires, the Office shall refuse the declaration of division.

3. The periods as referred to in Article 44a(2)(b) of the Regulation during which a declaration of division of the application is not admissible shall be:

- (a) the period before a date of filing has been accorded;
- (b) the period of three months following the publication of the application provided for in Article 42(1) of the Regulation;
- (c) the period after the date of issue of the notification to pay the registration fee referred to in Rule 23(1).

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

5. The Office shall establish a separate file for the divisional application, which shall consist of a complete copy of the file of the original application, including the declaration of division and the correspondence relating thereto. The Office shall assign a new application number to the divisional application.

6. Where the declaration of division relates to an application which has already been published pursuant to Article 40 of the Regulation, the division shall be published in the Community Trade Marks Bulletin. The divisional application shall be published; the publication shall contain the indications and elements referred to in Rule 12. The publication does not open a new period for the filing of oppositions.;

## 11. Rules 15 to 20 are replaced by the following:

### *Rule 15*

#### **Notice of opposition**

1. A notice of opposition may be entered on the basis of one or more earlier marks within the meaning of Article 8(2) of the Regulation (earlier marks) and one and/or more other earlier rights within the meaning of Article 8(4) of the Regulation (earlier rights), provided that the earlier marks or earlier rights all belong to the same proprietor or proprietors. If an earlier mark and/or an earlier right has more than one proprietor (co-ownership), the opposition may be filed by any or all of them.

2. The notice of opposition shall contain:

- (a) the file number of the application against which opposition is entered and the name of the applicant for the Community trade mark;
- (b) a clear identification of the earlier mark or earlier right on which the opposition is based, namely:
  - (i) where the opposition is based on an earlier mark within the meaning of Article 8(2)(a) or (b) of the Regulation or where the opposition is based on Article 8(3) of the Regulation, the indication of the file number or registration number of the earlier mark, the indication whether the earlier mark is registered or an application for registration, as well as the indication of the Member States including, where applicable, the Benelux, in or for which the earlier mark is protected, or, if applicable, the indication that it is a Community trade mark;
  - (ii) where the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of the Regulation, the indication of the Member State where the mark is well-known and either the indications referred to in point (i) or a representation of the mark;
  - (iii) where the opposition is based on an earlier right within the meaning of Article 8(4), an indication of its kind or nature, a representation of the earlier right, and an indication of whether this earlier right exists in the whole Community or in one or more Member States, and if so, an indication of the Member States;
- (c) the grounds on which the opposition is based, namely a statement to the effect that the respective requirements under Article 8(1), (3), (4) and (5) of the Regulation are fulfilled;
- (d) the filing date and, where available, the registration date and the priority date of the earlier mark, unless it is an unregistered well-known trade mark;
- (e) a representation of the earlier mark as registered or applied for; if the earlier mark is in colour, the representation shall be in colour;
- (f) the goods and services on which the opposition is based;

- (g) where the opposition is based on an earlier mark having a reputation within the meaning of Article 8(5) of the Regulation, an indication of the Member State in which, and the goods and services for which, the mark has a reputation;
- (h) as concerns the opposing party:
- (i) the name and address of the opposing party in accordance with Rule 1(1)(b);
  - (ii) where the opposing party has appointed a representative, the name and business address of the representative in accordance with Rule 1(1)(e);
  - (iii) where the opposition is entered by a licensee or by a person who is entitled under the relevant national law to exercise an earlier right, a statement to that effect and indications concerning the authorisation or entitlement to file the opposition.
3. The notice of opposition may contain:
- (a) an indication of the goods and services against which the opposition is directed; in the absence of such an indication the opposition shall be considered to be directed against all of the goods and services of the opposed Community trade mark application;
  - (b) a reasoned statement setting out the main facts and arguments on which the opposition relies, and evidence to support the opposition.
4. Where the opposition is based on more than one earlier mark or earlier right, paragraphs 2 and 3 shall apply for each of these rights.

#### Rule 16

##### Use of languages in the notice of opposition

1. The time limit referred to in Article 115(6) of the Regulation within which the opposing party has to file a translation of his opposition shall be one month from the expiry of the opposition period.
2. Where the opposing party or the applicant, before the date on which the opposition proceedings are deemed to commence pursuant to Rule 18(1), informs the Office that the applicant and the opposing party have agreed on a different language for the opposition proceedings pursuant to Article 115(7) of the Regulation, the opposing party shall, where the notice of opposition has not been filed in that language, file a translation of the notice of opposition in that language within a period of

one month from the said date. Where the translation is not filed or filed late, the language of the proceedings shall remain unchanged.

#### Rule 16a

##### Information of the applicant

Any notice of opposition and any document submitted by the opposing party, as well as any communication addressed to one of the parties by the Office prior to the expiry of the period referred to in Rule 18 shall be sent by the Office to the other party for purposes of informing of the introduction of an opposition.

#### Rule 17

##### Examination of admissibility

1. If the opposition fee has not been paid within the opposition period, the opposition shall be deemed not to have been entered. If the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.
2. If the notice of opposition has not been filed within the opposition period, or if the notice of opposition does not clearly identify the application against which opposition is entered or the earlier mark or the earlier right on which the opposition is based in accordance with Rule 15(2)(a) and (b), or does not contain grounds for opposition in accordance with Rule 15(2)(c), and if those deficiencies have not been remedied before the expiry of the opposition period, the Office shall reject the opposition as inadmissible.
3. Where the opposing party does not submit a translation as required under Rule 16(1), the opposition shall be rejected as inadmissible. Where the opposing party submits an incomplete translation, the part of the notice of opposition that has not been translated shall not be taken into account in the examination of admissibility.
4. If the notice of opposition does not comply with the other provisions of Rule 15, the Office shall inform the opposing party accordingly and shall invite him to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, the Office shall reject the opposition as inadmissible.
5. Any finding pursuant to paragraph 1 that the notice of opposition is deemed not to have been entered and any decision to reject an opposition as inadmissible under paragraphs 2, 3 and 4 shall be notified to the applicant.

*Rule 18***Commencement of opposition proceedings**

1. When the opposition is found admissible pursuant to Rule 17, the Office shall send a communication to the parties informing them that the opposition proceedings shall be deemed to commence two months after receipt of the communication. This period may be extended up to a total of 24 months if both parties submit requests for such an extension before the period expires.

2. If, within the period referred to in paragraph 1, the application is withdrawn or restricted to goods and services against which the opposition is not directed, or the Office is informed about a settlement between the parties, or the application is rejected in parallel proceedings, the opposition proceedings shall be closed.

3. If, within the period referred to in paragraph 1, the applicant restricts the application by deleting some of the goods and services against which the opposition is directed, the Office shall invite the opposing party to state, within such a period as it may specify, whether he maintains the opposition, and if so, against which of the remaining goods and services. If the opposing party withdraws the opposition in view of the restriction the opposition proceedings shall be closed.

4. If before expiry of the period referred to in paragraph 1 the opposition proceedings are closed pursuant to paragraphs 2 or 3, no decision on costs shall be taken.

5. If before expiry of the period referred to in paragraph 1 the opposition proceedings are closed following a withdrawal or restriction of the application or pursuant to paragraph 3, the opposition fee shall be refunded.

*Rule 19***Substantiation of the opposition**

1. The Office shall give the opposing party the opportunity to present the facts, evidence and arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time limit specified by it and which shall be at least 2 months starting on the date on which the opposition proceedings shall be deemed to commence in accordance with Rule 18(1).

2. Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:

(a) if the opposition is based on a trade mark which is not a Community trade mark, evidence of its filing or registration, by submitting:

(i) if the trade mark is not yet registered, a copy of the relevant filing certificate or an equivalent document emanating from the administration with which the trade mark application was filed; or

(ii) if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered;

(b) if the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of the Regulation, evidence showing that this mark is well-known in the relevant territory;

(c) if the opposition is based on a mark with reputation within the meaning of Article 8(5) of the Regulation, in addition to the evidence referred to in point (a) of this paragraph, evidence showing that the mark has a reputation, as well as evidence or arguments showing that 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;

(d) if the opposition is based on an earlier right within the meaning of Article 8(4) of the Regulation, evidence of its acquisition, continued existence and scope of protection of that right;

(e) if the opposition is based on Article 8(3) of the Regulation, evidence of the opposing party's proprietorship and of the nature of his relationship with the agent or representative.

3. The information and evidence referred to in paragraphs 1 and 2 shall be in the language of the proceedings or accompanied by a translation. The translation shall be submitted within the time limit specified for submitting the original document.

4. The Office shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time limit set by the Office.

#### Rule 20

#### Examination of the opposition

1. If until expiry of the period referred to in Rule 19(1) the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, as well his entitlement to file the opposition, the opposition shall be rejected as unfounded.

2. If the opposition is not rejected pursuant to paragraph 1, the Office shall communicate the submission of the opposing party to the applicant and shall invite him to file his observations within a period specified by the Office.

3. If the applicant submits no observations, the Office shall base its ruling on the opposition on the evidence before it.

4. The observations submitted by the applicant shall be communicated to the opposing party who shall be invited by the Office, if it considers it necessary to do so, to reply within a period specified by the Office.

5. Rule 18(2) and (3) shall apply *mutatis mutandis* after the date on which the opposition proceedings are deemed to commence.

6. In appropriate cases, the Office may invite the parties to limit their observations to particular issues, in which case it shall allow the party to raise the other issues at a later stage of the proceedings. In no case shall the Office be required to inform the parties which facts or evidence could be or have not been submitted.

7. The Office may suspend opposition proceedings:

(a) where the opposition is based on an application for registration pursuant to Article 8(2)(b) of the Regulation until a final decision is taken in that proceeding;

(b) where the opposition is based on an application for registration for a geographical indication or designation of origin under Council Regulation (EEC) No 2081/92 (\*) until a final decision is taken in that proceeding; or

(c) where a suspension is appropriate under the circumstances.

(\*) OJ L 208, 24.7.1992, p. 1.;

#### 12. Rule 22 is replaced by the following:

#### 'Rule 22

#### Proof of use

1. A request for proof of use pursuant to Article 43(2) or (3) of the Regulation shall be admissible only if the applicant submits such a request within the period specified by the Office pursuant to Rule 20(2).

2. Where the opposing party has to furnish proof of use or show that there are proper reasons for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, the Office shall reject the opposition.

3. The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 4.

4. The evidence shall be filed in accordance with Rules 79 and 79a and shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f) of the Regulation.

5. A request for proof of use may be made with or without submitting at the same time observations on the grounds on which the opposition is based. Such observations may be filed together with the observations in reply to the proof of use.

6. Where the evidence supplied by the opposing party is not in the language of the opposition proceedings, the Office may require the opposing party to submit a translation of that evidence in that language, within a period specified by the Office.'

**13. Rule 24(2) is replaced by the following:**

'2. The Office shall provide certified or uncertified copies of the certificate of registration, upon payment of a fee.;

**14. In Rule 25(1) point (c) is deleted;****15. The following Rule 25a is inserted:**

*Rule 25a*

**Division of a registration**

1. A declaration of the division of a registration pursuant to Article 48a of the Regulation shall contain:

- (a) the registration number;
- (b) the name and address of the proprietor of the trade mark in accordance with Rule 1(1)(b);
- (c) the list of goods and services which shall form the divisional registration, or, where the division into more than one divisional registration is sought, the list of goods and services for each divisional registration;
- (d) the list of goods and services which shall remain in the original registration.

2. Where the Office finds that the requirements laid down in paragraph 1 are not fulfilled or the list of goods and services which shall form the divisional registration overlap with the goods and services which shall remain in the original registration, it shall invite the applicant to remedy the deficiencies noted within such period as it may specify.

If the deficiencies are not remedied before the time limit expires, the Office shall refuse the declaration of division.

3. Where the Office finds, that the declaration of division is inadmissible pursuant to Article 48a of the Regulation, it shall refuse the declaration of division.

4. The Office shall establish a separate file for the divisional registration, which shall consist of a complete copy of the file of the original registration, including the declaration of division and the correspondence relating thereto. The Office shall assign a new registration number to the divisional registration.;

**16. In Rule 26(2), point (d) is deleted;****17. Rule 28(1) is amended as follows:**

(a) point (c) is deleted;

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

'(d) an indication of the Member State or Member States in or for which the earlier mark is registered, the number and the filing date of the relevant registration, and the goods and services for which the earlier mark is registered.;

**18. Rule 30 is replaced by the following:**

*Rule 30*

**Renewal of registration**

1. An application for renewal shall contain:

- (a) the name of the person requesting renewal;
- (b) the registration number of the Community trade mark to be renewed;
- (c) if the renewal is requested for only part of the goods and services for which the mark is registered, an indication of those classes or those goods and services for which renewal is requested or those classes or those goods and services for which renewal is not requested, grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs and presented in the order of the classes of that classification.

2. The fees payable under Article 47 of the Regulation for the renewal of a Community trade mark shall consist of the following:

- (a) a basic fee;
- (b) a class fee for each class exceeding three in respect of which renewal is applied for; and
- (c) where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal, pursuant to Article 47(3) of the Regulation, as specified in the Fees Regulation.



3. It shall be deemed to constitute a request for renewal if the payment referred to in paragraph 2 is made by a means of payment referred to in Article 5(1) of the Fees Regulation, provided that it contains all the indications required under paragraph 1 (a) and (b) of this Rule and Article 7(1) of the Fees Regulation.

4. Where the application for renewal is filed within the periods provided for in Article 47(3) of the Regulation, but the other conditions governing renewal provided for in Article 47 of the Regulation and these Rules are not satisfied, the Office shall inform the applicant of the deficiencies found.

5. Where an application for renewal is not submitted or is submitted after expiry of the period provided for in the third sentence of Article 47(3) of the Regulation, or where the fees are not paid or are paid only after the period in question has expired, or where the deficiencies are not remedied within that period, the Office shall determine that the registration has expired and shall so notify the proprietor of the Community trade mark.

Where the fees paid are insufficient to cover all the classes of goods and services for which renewal is requested, such a determination shall not be made if it is clear which class or classes are to be covered. In the absence of other criteria, the Office shall take the classes into account in the order of classification.

6. Where the determination made pursuant to paragraph 5 has become final, the Office shall cancel the mark from the register. The cancellation shall take effect from the day following the day on which the existing registration expired.

7. Where the renewal fees provided for in paragraph 2 have been paid but the registration is not renewed, those fees shall be refunded.

8. A single application for renewal may be submitted for two or more marks, upon payment of the required fees for each of the marks, provided that the proprietors or the representatives are the same in each case.;

19. **Rule 31(3) and (4) is deleted;**

20. **Rule 32(4) is replaced by the following:**

'4. The Office shall establish a separate file for the new registration, which shall consist of a complete copy of the file of the original registration, including the application for registration of the partial transfer and the correspondence relating thereto. The Office shall assign a new registration number to the new registration.;

21. **Rule 33 is amended as follows:**

(a) paragraph 1 is replaced by the following:

'1. Rule 31(1), (2), (5) and (7) shall apply *mutatis mutandis* to the registration of a licence, of a transfer of a licence, of a right *in rem*, of a transfer of a right *in rem*, of an enforcement measure or of insolvency proceedings, subject to the following:

(a) Rule 31(1)(c) 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) Rule 31(1)(d) and (5) shall not apply where the request was made by the proprietor of the Community trade mark.;

(b) paragraph 2 is replaced by the following:

'2. The application for registration of a licence, a transfer of a licence, a right *in rem*, a transfer of a right *in rem* or an enforcement measure shall not be deemed to have been filed until the required fee has been paid.;

(c) in paragraph 3, 'Articles 19, 20 or 22' is replaced by 'Articles 19 to 22' and 'in paragraphs 1 and 2 above,' is replaced by 'in paragraph 1 of this Rule and in Rule 34(2)';

(d) paragraph 4 is replaced by the following:

'4. Paragraphs 1 and 3 shall apply *mutatis mutandis* to applications for Community trade marks. Licences, rights *in rem*, insolvency proceedings and enforcement measures shall be recorded in the files kept by the Office concerning the Community trade mark application.;

22. **Rule 34 is replaced by the following:**

'Rule 34

**Special provisions for the registration of a licence**

1. The application for registration of a licence may contain a request to record the licence in the Register as one or more of the following:

(a) an exclusive licence;

- (b) a sub-licence in case where the licence is granted by a licensee whose licence is recorded in the Register;
- (c) a licence limited to only a part of the goods or services for which the mark is registered;
- (d) a licence limited to part of the Community;
- (e) a temporary licence.

2. Where a request is made to record the licence as a licence pursuant to paragraph 1(c), (d) and (e), the application for registration of a licence shall indicate the goods and services and the part of the Community and the time period for which the licence is granted.;

**23. Rule 35(3) is replaced by the following:**

'3. The application for cancellation of a licence, a right *in rem* or an enforcement measure shall not be deemed to have been filed until the required fee has been paid.;

**24. Point (c) of Rule 36(1) is deleted;**

**25. Rule 38 is amended as follows:**

- (a) paragraph 1 is replaced by the following:

'1. The time limit referred to in Article 115(6) of the Regulation within which the applicant for revocation or a declaration of invalidity has to file a translation of his application shall be one month, starting with the date of the filing of his application, failing which the application shall be rejected as inadmissible.;

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

'Where the translation is not filed or filed late, the language of the proceedings shall remain unchanged.;

**26. Rule 39 is replaced by the following:**

*Rule 39*

**Rejection of the application for revocation or for declaration of invalidity as inadmissible**

1. Where the Office finds that the required fee has not been paid, it shall invite the applicant to pay the fee within a period specified by it. If the required fee is not paid within the period specified by the Office, the Office shall

inform the applicant that the application for revocation or for declaration of invalidity is deemed not to have been filed. If the fee has been paid after expiry of the period specified, it shall be refunded to the applicant.

2. Where the translation required under Rule 38(1) is not filed within the prescribed period, the Office shall reject the application for revocation or for declaration of invalidity as inadmissible.

3. If the Office finds that the application does not comply with Rule 37, it shall invite the applicant to remedy the deficiencies found within such period as it may specify. If the deficiencies are not remedied before expiry of the time limit, the Office shall reject the application as inadmissible.

4. Any decision to reject an application for revocation or declaration of invalidity under paragraph 2 or 3 shall be communicated to the applicant and the proprietor of the Community trade mark.;

**27. Rule 40 is amended as follows:**

- (a) paragraph 1 is replaced by the following:

'1. Every application for revocation or for declaration of invalidity which is deemed to have been filed shall be notified to the proprietor of the Community trade mark. When the Office has found the application admissible, it shall invite the proprietor of the Community trade mark to file his observations within such period as it may specify.'

- (b) paragraph 4 is replaced by the following:

'4. Save where Rule 69 otherwise provides or allows, all observations filed by the parties shall be sent to the other party concerned.;

- (c) paragraph 5 is replaced by the following:

'5. In the case of an application for revocation based on Article 50(1)(a) of the Regulation, the Office shall invite the proprietor of the Community trade mark to furnish proof of genuine use of the mark, within such period as it may specify. If the proof is not provided within the time limit set, the Community trade mark shall be revoked. Rule 22(2), (3) and (4) shall apply *mutatis mutandis*.;

(d) a new paragraph 6 is added:

'6. If the applicant has to furnish proof of use or proof that there are proper reasons for non-use under Article 56(2) or (3) of the Regulation, the Office shall invite the applicant to furnish proof of genuine use of the mark, within such period as it may specify. If the proof is not provided within the time limit set, the application for declaration of invalidity shall be rejected. Rule 22(2), (3) and (4) shall apply *mutatis mutandis*.'

## 28. Rules 44 and 45 are replaced by the following:

### Rule 44

#### Application for conversion

1. An application for conversion of a Community trade mark application or a registered Community trade mark into a national trade mark application pursuant to Article 108 of the Regulation shall contain:

- (a) the name and the address of the applicant for conversion in accordance with Rule 1(1)(b);
- (b) the filing number of the Community trade mark application or the registration number of the Community trade mark;
- (c) the indication of the ground for conversion in accordance with Article 108(1)(a) or (b) of the Regulation;
- (d) the specification of the Member State or the Member States in respect of which conversion is requested;
- (e) where the request does not relate to all of the goods and services for which the application has been filed or for which the trade mark has been registered, the application shall contain an indication of the goods and services for which conversion is requested, and, where conversion is requested in respect of more than one Member State and the list of goods and services is not the same for all Member States, an indication of the respective goods and services for each Member State;
- (f) where conversion is requested pursuant to Article 108(6) of the Regulation, the application shall contain the indication of the date on which the decision of the national court has become final, and a copy of that decision; that copy may be submitted in the language in which the decision was given.

2. The application for conversion shall be filed within the relevant period pursuant to Article 108(4), (5) or (6) of the Regulation. Where conversion is requested following a failure to renew the registration, the period of three months provided for in Article 108(5) of the Regulation shall begin to run on the day following the last day on which the request for renewal can be presented pursuant to Article 47(3) of the Regulation.

### Rule 45

#### Examination of application for conversion

1. Where the application for conversion does not comply with the requirements of Article 108(1) or (2) of the Regulation or has not been filed within the relevant period of three months or does not comply with Rule 44 or other Rules, the Office shall notify the applicant accordingly and specify a period within which he may amend the application or furnish any missing information or indications.

2. Where the conversion fee has not been paid within the relevant period of three months, the Office shall inform the applicant that the application for conversion is deemed not to have been filed.

3. Where the missing indications have not been furnished within the period specified by the Office, the Office shall reject the application for conversion.

Where Article 108(2) of the Regulation applies, the Office shall reject the application for conversion as inadmissible only with respect to those Member States for which conversion is excluded under that provision.

4. If the Office or a Community trade mark court has refused the Community trade mark application or has declared the Community trade mark invalid on absolute grounds by reference to the language of a Member State, conversion shall be excluded under Article 108(2) of the Regulation for all the Member States in which that language is one of the official languages. If the Office or a Community trade mark court has refused the Community trade mark application or has declared the Community trade mark invalid on absolute grounds which are found to apply in the whole Community or on account of an earlier Community trade mark or other Community industrial property right, conversion is excluded under Article 108(2) of the Regulation for all Member States.'

**29. Rule 47 is replaced by the following:**

*Rule 47*

**Transmission to central industrial property offices of the Member States**

Where the application for conversion complies with the requirements of the Regulation and these Rules, the Office shall transmit the application for conversion and the data referred to in Rule 84(2), to the central industrial property offices of the Member States, including the Benelux Trade Mark Office, for which the application has been found admissible. The Office shall inform the applicant of the date of transmission.;

**30. In Rule 50(1) the following is added:**

In particular, when the appeal is directed against a decision taken in opposition proceedings, Article 78a of the Regulation shall not be applicable to the time limits fixed pursuant to Article 61(2) of the Regulation.

Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74(2) of the Regulation.;

**31. Rule 51 is replaced by the following:**

*Rule 51*

**Reimbursement of appeal fees**

The appeal fee shall only be reimbursed by order of either of the following:

- (a) the department whose decision has been impugned, where it grants revision pursuant to Article 60(1) or Article 60a of the Regulation;
- (b) the Board of Appeal, where it allows the appeal and considers such reimbursement equitable by reason of a substantial procedural violation.;

**32. Rule 53 is replaced by the following:**

*Rule 53*

**Correction of errors in decisions**

Where the Office becomes aware, of its own motion or at the instance of a party to the proceedings, of a linguistic

error, error of transcription or obvious mistake in a decision, it shall ensure that error or mistake is corrected by the department or division responsible.'

**33. The following Rule 53a is inserted:**

*Rule 53a*

**Revocation of a decision or entry in the Register**

1. Where the Office finds of its own motion or pursuant to corresponding information by the parties to the proceedings that a decision or entry in the Register is subject to revocation pursuant to Article 77a of the Regulation, it shall inform the party affected about the intended revocation.

2. The affected party may submit observations on the intended revocation within a period specified by the Office.

3. Where the affected party agrees to the intended revocation or where he does not submit any observations within the period, the Office shall revoke the decision or entry. If the affected party does not agree to the revocation, the Office shall take a decision on the revocation.

4. Paragraphs 1, 2 and 3 shall apply *mutatis mutandis* if the revocation is likely to affect more than one party. In these cases the observations submitted by one of the parties pursuant to paragraph 3 shall always be communicated to the other party or parties with an invitation to submit observations.

5. Where the revocation of a decision or an entry in the Register affects a decision or entry that has been published, the revocation shall also be published.

6. Competence for revocation under paragraphs 1 to 4 shall lie with the department or unit which took the decision.;

**34. Rule 59(4) is replaced by the following:**

'4. The amounts and the advances for expenses to be paid pursuant to paragraphs 1, 2 and 3 shall be determined by the President of the Office and shall be published in the Official Journal of the Office. The amounts shall be calculated on the same basis as laid in the Staff Regulations of the Officials of the European Communities and Annex VII thereto.;

**35. Rule 60 is replaced by the following:**

*Rule 60*

**Minutes of oral proceedings**

1. Minutes of oral proceedings or the taking of evidence shall be drawn up, containing:

- (a) the date of the proceedings;
- (b) the names of the competent officials of the Office, the parties, their representatives, and of the witnesses and experts who are present;
- (c) the applications and requests made by the parties;
- (d) the means of giving or obtaining evidence;
- (e) where applicable, the orders or the decision issued by the Office.

2. The minutes shall become part of the file of the relevant Community trade mark application or registration. The parties shall be provided with a copy of the minutes.

3. Where witnesses, experts or parties are heard in accordance with Article 76(1)(a) or (d) of the Regulation or Rule 59(2), their statements shall be recorded.;

**36. Rule 61 is amended as follows:**

- (a) paragraph 1 is replaced by the following:

'1. In proceedings before the Office, notifications to be made by the Office shall take the form of transmitting the original document, an uncertified copy thereof or a computer print-out in accordance with Rule 55, or, as concerns documents emanating from the parties themselves, duplicates or uncertified copies.;

- (b) the following paragraph 3 is added:

'3. Where the addressee has indicated his telecopier number or contact details for communicating with him through other technical means, the Office shall have the choice between any of these means of notification and notification by post.;

**37. Rule 62 is amended as follows:**

- (a) paragraph 1 is replaced by the following:

'1. Decisions subject to a time limit for appeal, summonses and other documents as determined by the President of the Office shall be notified by

registered letter with advice of delivery. All other notifications shall be by ordinary mail.;

- (b) the second sentence of paragraph 2 is deleted;

- (c) paragraph 5 is replaced by the following:

'5. Notification by ordinary mail shall be deemed to have been effected on the tenth day following that of its posting.;

**38. In Rule 65(1), the second sentence is replaced by the following:**

'Notification shall be deemed to have been taken place on the date on which the communication was received by the telecopying device of the recipient.;

**39. Rule 66(1) is replaced by the following:**

'1. If the address of the addressee cannot be established or if after at least one attempt, notification in accordance with Rule 62 has proved impossible, notification shall be effected by public notice.;

**40. Rule 72(2) is replaced by the following:**

'2. If a time limit expires on a day on which there is a general interruption in the delivery of mail in the Member State where the Office is located, or, if and to the extent that the President of the Office has allowed communications to be sent by electronic means pursuant to Rule 82, on which there is an actual interruption of the Offices connection to these electronic means of communication, the time limit shall extend until the first day following that interruption on which the Office is open for the receipt of documents and on which ordinary mail is delivered. The duration of the period of interruption shall be determined by the President of the Office.;

**41. Rule 72(4) is replaced by the following:**

'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 of the Office may determine that for parties of the proceedings having their residence or registered office in the State concerned or who have appointed a representative with a place of business in the 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. 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.;

**42. Rule 76 is amended as follows:**

(a) paragraphs 1 to 4 are replaced by the following:

'1. Legal practitioners and professional representatives entered on the list maintained by the Office pursuant to Article 89(2) of the Regulation shall file with the Office a signed authorisation for insertion in the files only if the Office expressly requires it, or where there are several parties to the proceedings in which the representative acts before the Office, if the other party expressly asks for it.

2. Employees acting on behalf of natural or legal persons pursuant to Article 88(3) of the Regulation shall file with the Office a signed authorisation for insertion in the files.

3. The authorisation may be filed in any official language of the Community. It may cover one or more applications or registered trade marks or may be in the form of a general authorisation authorising the representative to act in respect of all proceedings before the Office to which the person giving the authorisation is a party.

4. Where it is required, pursuant to paragraphs 1 or 2, that a signed authorisation be filed, the Office shall specify a time limit within which such authorisation shall be filed. If the authorisation is not filed in due time, proceedings shall be continued with the represented person. Any procedural steps other than the filing of the application taken by the representative shall be deemed not to have been taken if the represented person does not approve them within a period specified by the Office. The application of Article 88(2) of the Regulation shall remain unaffected.;

(b) paragraphs 8 and 9 are replaced by the following:

'8. Where the appointment of a representative is communicated to the Office, the name and the business address of the representative shall be indicated in accordance with Rule 1(1)(e). Where a representative acts before the Office who has already been appointed, he shall indicate his name and preferably the identification number attributed to him by the Office. Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorisations, act either jointly or singly.

9. The appointment or authorisation of an association of representatives shall be deemed to be an appointment or authorisation of any representative who practices within that association.;

**43. Rule 79 is amended as follows:**

(a) points (a) and (b) are replaced by the following:

'(a) by submitting a signed original of the document in question at the Office, such as by post, personal delivery, or by any other means;

(b) by transmitting a document by telecopier in accordance with Rule 80.;

(b) point (c) is deleted;

**44. The following Rule 79a is inserted:**

*Rule 79a*

**Annexes to written communications**

Where a document or an item of evidence is submitted in accordance with Rule 79 point (a) by a party in a proceeding before the Office involving more than one party to the proceedings, the document or item of evidence, as well as any annex to the document, shall be submitted in as many copies as the number of parties to the proceedings.'

**45. Rule 80 is amended as follows:**

(a) paragraph 1 is replaced by the following:

'1. Where an application for a Community trade mark is submitted to the Office by telecopier and the application contains a reproduction of the mark pursuant to Rule 3(2) which does not satisfy the requirements of that Rule, the required reproduction suitable for publication shall be submitted to the Office in accordance with Rule 79(a). Where the reproduction is received by the Office within a period of one month from the date of receipt of the telecopy, the reproduction shall be deemed to have been received by the Office on the date on which the telecopy was received.;

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

'Where the communication has been sent by telecopier electronically, the indication of the name of the sender shall be equivalent to the signature.;

(c) paragraph 4 is deleted;

**46. Rule 81 is deleted;****47. Rule 82 is amended as follows:**

(a) paragraph 1 is replaced by the following:

'1. The President of the Office shall determine whether, to what extent and under what technical conditions communications may be sent to the Office by electronic means.'

(b) paragraph 4 is deleted;

**48. Rule 83 is replaced by the following:**

*Rule 83*

**Forms**

1. The Office shall make available to the public free of charge forms for the purposes of:

- (a) filing an application for a Community trade mark, including where appropriate a request for the search report;
- (b) entering an opposition;
- (c) applying for revocation or declaration of invalidity;
- (d) applying for the registration of a transfer and the transfer form and transfer document provided for in Rule 31(5);
- (e) applying for the registration of a licence;
- (f) applying for the renewal of a Community trade mark;
- (g) making an appeal;
- (h) authorising a representative, in the form of an individual authorisation or a general authorisation;
- (i) submitting an international application or a subsequent designation under the Madrid Protocol to the Office.

2. Parties to the proceedings before the Office may also use

- (a) forms established under the Trademark Law Treaty or pursuant to recommendations of the Assembly of the Paris Union for the Protection of Industrial Property;
- (b) with the exception of the form referred to in point (i) of paragraph 1, forms with the same content and format.

3. The Office shall make available the forms referred to in paragraph 1 in all the official languages for the Community.;

**49. Rule 84 is amended as follows:**

(a) in Paragraph 2 point (d) is replaced by the following:

'(d) the name and address of the applicant;'

(b) paragraph 3 is amended as follows:

(i) point (i) is replaced by the following:

'(i) levy of execution pursuant to Article 20 of the Regulation and insolvency proceedings pursuant to Article 21 of the Regulation;'

(ii) the following points (w) and (x) are added:

'(w) the division of a registration pursuant to Article 48a of the Regulation 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 77a of the Regulation, where the revocation concerns a decision or entry which has been published.;

**50. Rule 85(1) is replaced by the following:**

'1. The Community Trade Marks Bulletin shall be published in the manner and frequency determined by the President of the Office.;

**51. Rule 89(1) and (2) is replaced by the following:**

'1. Inspection of the files of Community trade mark applications and of registered Community trade marks shall either be of the original document, or of copies thereof, or of technical means of storage if the files are stored in this way. The means of inspection shall be determined by the President of the Office.

Where inspection takes place as provided for in paragraphs 3, 4 and 5, the request for inspection of the files shall not be deemed to have been made until the required fee has been paid. No fee is payable if inspection of technical means of storage takes place online.

2. Where inspection of the files of a Community trade mark application which has not yet been published pursuant to Article 40 of the Regulation is requested, the request shall contain an indication and evidence to the effect that the applicant has consented to the inspection or has stated that after the trade mark has been registered he will invoke the rights under it against the party requesting the inspection.’;

**52. Rule 91 is replaced by the following:**

*Rule 91*

**Keeping of files**

1. The President of the Office shall determine the form in which the files shall be kept.

2. Where files are kept electronically, these electronic files, or back-up copies thereof, shall be kept without time limitation. The original documents filed by parties to the proceedings which form 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 of the Office.

3. Where and to the extent that files or parts of the files are kept in any other form than electronically, documents or items of evidence constituting part of such files shall be kept for at least five years from the end of the year in which any of the following occurrences takes place:

- (a) the application is rejected or withdrawn or is deemed to be withdrawn;
- (b) the registration of the Community trade mark expires completely pursuant to Article 47 of the Regulation;
- (c) the complete surrender of the Community trade mark is registered pursuant to Article 49 of the Regulation;
- (d) the Community trade mark is completely removed from the Register pursuant to Article 56(6) or Article 96(6) of the Regulation.’;

**53. Rule 94 is amended as follows:**

(a) paragraph 3 is replaced by the following:

‘3. Where the amount of the costs has not been fixed pursuant to Article 81(6), first sentence, of the Regulation, the request for the fixing of costs shall be

accompanied by a bill and supporting evidence. For the costs of representation referred to in paragraph 7(d) of this Rule, an assurance by the representative that the costs have been incurred shall be sufficient. For other costs, it shall be sufficient if their plausibility is established. Where the amount of the costs is fixed pursuant to Article 81(6), first sentence, of the Regulation, representation costs shall be awarded at the level laid down in paragraph 7(d) of this Rule and irrespective of whether they have been actually incurred.’;

(b) in paragraph 4, the words ‘the second sentence of Article 81(6)’ are replaced by ‘the third sentence of Article 81(6)’;

(c) paragraph 7 is replaced by the following:

‘7. Subject to paragraph 3 of this Rule, costs essential to the proceedings and actually incurred by the successful party shall be borne by the losing party in accordance with Article 81(1) of the Regulation on the basis of the following maximum rates:

- (a) where the party is not represented by a representative, travel and subsistence expenses of one party for one person for the outward and return journey between the place of residence or the place of business and the place where oral proceedings are held pursuant to Rule 56, as follows:
  - (i) the cost of the first-class rail-fare including usual transport supplements where the total distance by rail does not exceed 800 km;
  - (ii) the cost of the tourist-class air-fare where the total distance by rail exceeds 800 km or the route includes a sea-crossing;
  - (iii) subsistence expenses as laid down in Article 13 of Annex VII to the Staff Regulations of Officials of the European Communities;
- (b) travel expenses of representatives within the meaning of Article 89(1) of the Regulation, at the rates provided for in point (a)(i) and (ii) of this Rule;

(c) travel expenses, subsistence expenses, compensation for loss of earnings and fees to which witnesses and experts are entitled to be reimbursed pursuant to Rule 59(2), (3) or (4), to the extent that final liability lies with a party to the proceedings pursuant to Rule 59(5)(b);



- (d) cost of representation, within the meaning of Article 89(1) of the Regulation,
- (i) of the opposing party in opposition proceedings:
- EUR 300;
- (ii) of the applicant in opposition proceedings:
- EUR 300;
- (iii) of the applicant in proceedings relating to revocation or invalidity of a Community trade mark:
- EUR 450;
- (iv) of the proprietor of the trade mark in proceedings relating to revocation or invalidity of a Community trade mark:
- EUR 450;
- (v) of the appellant in appeal proceedings:
- EUR 550;
- (vi) of the defendant in appeal proceedings:
- EUR 550;
- (vii) where an oral proceedings have taken place to which the parties have been summoned pursuant to Rule 56, the amount referred to in the points (i) to (vi) shall be incremented by EUR 400;
- (e) where there are several applicants or proprietors of the Community trade mark application or registration or where there are several opposing parties or applicants for revocation or declaration of invalidity who have filed the opposition or application for revocation or declaration of invalidity jointly, the losing party shall bear the costs referred to in point (a) for one such person only;
- (f) where the successful party is represented by more than one representative within the meaning of Article 89(1) of the Regulation, the losing party shall bear the costs referred to in points (b) and (d) of this Rule for one such person only;
- (g) the losing party shall not be obliged to reimburse the successful party for any costs, expenses and fees other than those referred to in points (a) to (f).;

**54. Rule 98 is replaced by the following:**

*Rule 98*

**Translations**

1. When a translation of a document is to be filed, the translation shall identify the document to which it refers and reproduce the structure and contents of the original document. The Office may require the filing, within a period to be specified by it, of a certificate that the translation corresponds to the original text. The President of the Office shall determine the manner in which translations shall be certified.

2. Save where the Regulation or these Rules provide otherwise, a document for which a translation is to be filed shall be deemed not to have been received by the Office

(a) where the translation is received by the Office after expiry of the relevant period for submitting the original document or the translation;

(b) in the case of paragraph 1, where the certificate is not filed within the period specified.;

**55. Rule 100 is replaced by the following:**

*Rule 100*

**Decisions taken by a single member**

The cases in which pursuant to Article 127(2), or Article 129(2), of the Regulation a single member of the Opposition Division or of the Cancellation Division may take a decision shall be the following:

(a) decisions on the apportionment of costs;

(b) decisions to fix the amount of the costs to be paid pursuant to Article 81(6), first sentence, of the Regulation;

(c) decisions to close the file or not to proceed to judgment;

(d) decisions to reject an opposition as inadmissible before expiry of the period referred to in Rule 18(1);

(e) decisions to stay proceedings;

(f) decisions to join or separate multiple oppositions pursuant to Rule 21(1).;

56. **Paragraphs 1, 2 and 3 of Rule 101 are replaced by the following:**

1. If necessary, the President of the Office shall request the Commission to enquire whether a State which is not party to the Paris Convention or to the Agreement establishing the World Trade Organization accords reciprocal treatment within the meaning of Article 29(5) of the Regulation.

2. 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*.

3. Article 29(5) of the Regulation shall apply from the date of publication in the *Official Journal of the European Union* of the communication referred to in paragraph 2, 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.;

57. **Rule 114 is amended as follows:**

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

Done at Brussels, 29 June 2005.

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

'(d) the indications and elements referred to in Rule 15(2)(b) to (h).';

(b) in paragraph 2, the introductory phrase is replaced by the following:

'Rules 15(1), (3) and (4) and 16 to 22 shall apply, subject to the following:';

58. **Point (c) of Rule 122(1) is replaced by the following:**

'(c) the indications and elements referred to in Rule 44(1)(a), (c), (d), (e) and (f)'.

*Article 2*

1. This Regulation shall enter into force on the 20th day following its publication in the *Official Journal of the European Union*.

2. In Article 1 point (1)(d), point (3), point (4) and point (7) shall apply from 10 March 2008, as shall the second part, commencing with the word 'including', of point (a) of Rule 83(1), set out at point 48 of Article 1 of this Regulation.

*For the Commission*

Charlie McCREEVY

*Member of the Commission*

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