

**GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS**

**EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)**

Part E

Register operations

***Section 1 Changes in a
registration***

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1 Surrender

Article 57 EUTMR

Article 15 EUTMR

1.1 General principles

At any time after registration, a European Union trade mark (EUTM) may be surrendered by its proprietor in respect of some or all of the goods and services. The surrender must be declared to the Office in writing. (For information on the withdrawal of EUTM applications, that is, prior to registration, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1.)

1.2 Legal effect

Article 57(2) EUTMR

Article 15 EUTMR

Surrenders only become legally effective on the date of entry in the EUTM Register. The registration procedure for the surrender may be suspended during ongoing proceedings (see paragraph 1.4 below).

The proprietor's rights in the registered EUTM, as well as those of its licensees and any other holders of rights in the mark, lapse with an ex nunc effect on the date of the registration of the surrender in the EUTM Register. Therefore, the surrender has no retroactive effect.

The surrender has procedural and substantive effects.

In procedural terms, when the surrender is entered in the EUTM Register, the EUTM ceases to exist and any proceedings (with the exception of invalidity or revocation proceedings) involving the mark before the Office terminate.

The substantive effects of surrender vis-à-vis third parties comprise the EUTM proprietor renouncing any rights arising from its mark in the future.

The EUTM proprietor is bound by the declaration of surrender during its registration procedure, provided that the following circumstances are present.

1. No revocation of the declaration reaches the Office on the same day as the receipt of the declaration of surrender. That means that if a declaration of surrender and a communication revoking that declaration reach the Office on the same day (regardless of the hour and minute of their receipt), they cancel each other out. Once it becomes effective, the declaration may not be revoked.

2. The declaration meets all the formal requirements, in particular those identified in paragraph 1.3.7 below.

1.3 Formal requirements

1.3.1 Form and language

Article 146(2) and (6) EUTMR

Article 65 EUTMDR

Article 24 EUTMIR

The proprietor must declare the surrender to the Office in writing. The general rules for communication with the Office apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits).

The declaration of surrender must be submitted in writing in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the declaration of surrender is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may, according to Article 146(6) EUTMR, be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

The declaration of surrender is void where it contains conditions or time limitations. For example, it may not be made under the condition that the Office takes a particular decision or, in inter partes proceedings, that the other party makes a procedural declaration. For instance, during cancellation proceedings the mark may not be (partially) surrendered on the condition that the cancellation applicant withdraws its cancellation action. However, this does not exclude the possibility of an agreement between the parties, or prevent both parties from requesting successive actions (for example, surrender of the trade mark and withdrawal of the cancellation action) in the same communication to the Office.

1.3.2 Fees

There is no fee for a declaration of surrender.

1.3.3 Necessary particulars

Article 15 EUTMIR

The declaration of surrender must contain the particulars referred to in Article 15 EUTMIR. These are:

- the EUTM registration number;
- the EUTM proprietor's name and address or the proprietor's Office ID number together with the proprietor's name;
- where the surrender is only for some of the goods or services for which the mark is registered, either the goods and services for which the surrender is declared or an indication of the goods and services for which the mark is to remain registered or both (see paragraph 1.3.4 below).

1.3.4 Partial surrender

An EUTM may be surrendered in part, that is, for some of the goods and services for which it is registered. A partial surrender only becomes effective on the date it is entered in the EUTM Register.

For a partial surrender to be accepted, the following two conditions relating to the goods and services must be met:

1. the new wording must not constitute an extension of the list of goods and services;
2. the partial surrender must constitute a valid description of goods and services.

For further details on acceptable restrictions and for the practice regarding the declaration referred to in Article 33(8) EUTMR, see the Guidelines, Part B, Examination, Section 3, Classification.

1.3.5 Signature

Except where Article 63(1)(a) EUTMDR allows otherwise, the declaration of surrender must be signed by the EUTM proprietor or its duly appointed representative.

1.3.6 Representation

Articles 119(2) and 120(1) EUTMR

The general rules apply (see the Guidelines, Part A, General Rules, Section 5, Professional Representation).

1.3.7 Requirements where a licence or other right in the EUTM has been registered

A surrender cannot be registered if third parties have registered rights in the EUTM (such as licensees, pledgees, etc.) without first fulfilling certain additional requirements.

Where a licence, or another right in the EUTM, is entered in the EUTM Register, the following additional requirements apply.

1. The EUTM proprietor must submit sufficient proof that it has informed the licensee, pledgee, etc. of its intention to surrender.

If the proprietor proves to the Office that the licensee, pledgee, etc. has given its consent to the surrender, the surrender will be registered upon receipt of that notice.

If the EUTM proprietor merely submits proof that it has informed the licensee/pledgee of its intention to surrender, the Office will inform the proprietor that the surrender will be registered three months after the date on which the Office received the evidence (Article 57(3) EUTMR).

The Office will consider a copy of the communication from the proprietor to the licensee/pledgee as sufficient evidence. The same applies to a written statement signed by the licensee/pledgee that it has been informed. An affidavit by the proprietor is not necessary. The term ‘proves’ in Article 57(3) EUTMR does not refer to absolute certainty but to a reasonable probability, as follows from the other language versions of the Regulations (Article 57(3) EUTMR: Italian version: dimostra, German version: glaubhaft macht). The documents may be in any of the 23 official languages of the European Union. However, the Office may require a translation into the language chosen for the declaration of surrender or, at the choice of the declarant, into any of the five languages of the Office.

If no proof has been provided or it is insufficient, the Office will request that it be submitted within two months.

2. Where a levy of execution is entered in the EUTM Register, the declaration of surrender must be accompanied by a declaration of consent to the surrender signed by the authority competent for the levy of execution (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 2, Licences, Rights in Rem, Levies of Execution, Insolvency Proceedings or Similar Proceedings).
3. Where insolvency or similar proceedings are entered in the EUTM Register, the declaration of surrender must be requested by the liquidator (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 2, Licences, Rights in Rem, Levies of Execution, Insolvency Proceedings or Similar Proceedings).

1.4 Examination

Article 57(2) EUTMR

Article 17(4), (5) and (6) EUTMDR

1.4.1 Competence

Where surrender (or a partial surrender) is declared during ongoing revocation or invalidity proceedings against the validity of the EUTM that is being surrendered, the Office will suspend the registration of the surrender and invite the cancellation applicant to indicate whether it wishes to continue with the proceedings. For details concerning the treatment of surrenders received during the course of open cancellation

proceedings, see the Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings, paragraph 4.3.

Where the EUTM is subject to a case pending before the General Court or the Court of Justice, the surrender must be filed at the Office (not before the General Court or the Court of Justice). The Office will then inform the General Court or the Court of Justice whether or not it finds the surrender acceptable and valid. However, the surrender proceedings will be suspended until the General Court or the Court of Justice has rendered a final decision on the issue (16/05/2013, T-104/12, Vortex, EU:T:2013:256).

2 Alteration of a Trade Mark

2.1 General principles

Article 54 EUTMR

Article 10 EUTMIR

This section of the Guidelines and the provisions cited above deal solely with alterations of the EUTM that are requested by the proprietor of its own accord.

There is a difference between an amendment of an EUTM application and an alteration of a registered EUTM. The amendment of an EUTM application is governed by Article 49 EUTMR and Article 11 EUTMDR. The alteration of a registered EUTM is governed by Article 54 EUTMR and Article 10 EUTMIR (for more information on amendments of an EUTM application, see the Guidelines, Part B, Examination, Section 2, Formalities).

This section does not apply to corrections of obvious errors by the Office in its publications or in the EUTM Register; such corrections are made ex officio, or at the proprietor's request, pursuant to Article 44(3) and Article 102 EUTMR (for more information, see the Guidelines, Part A, General Rules, Section 6, Revocation of Decisions, Cancellation of Entries in the Register and Correction of Errors).

The alteration of a mark enables the representation of a mark to be altered, providing the alteration relates to the proprietor's name and/or address and does not substantially affect the identity of the trade mark as originally registered.

The Regulations do not provide for the possibility of altering other elements of the EUTM registration.

2.2 Formal requirements

2.2.1 Form and language

Article 54 and Article 146(6) EUTMR

The application to alter the mark, that is, the representation of the mark, must be submitted in writing in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of an alteration of the mark is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may, according to Article 146(6) EUTMR, be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

2.2.2 Fees

Article 54(4) and Annex I A(28) EUTMR

The application to alter the mark is considered not to have been filed until the fee has been paid. The amount of this fee is EUR 200 (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

2.2.3 Mandatory indications

Article 54(3) EUTMR

Article 10 EUTMIR

The application for alteration must contain:

- the EUTM registration number;
- the EUTM proprietor's name and address in accordance with Article 2(1)(b) EUTMIR, or the proprietor's Office ID number together with the proprietor's name;
- an indication of the element in the representation of the mark to be altered and the altered version of the element;
- a representation of the mark as altered that complies with the formal requirements laid down in Article 3 EUTMIR.

2.3 Substantive conditions for alteration

Article 54(2) EUTMR allows the alteration of the representation of the mark only under very limited conditions, namely only when:



- the EUTM includes the EUTM proprietor's name and/or address, and
- these are the elements for which alteration is sought, and
- the alteration would not substantially affect the identity of the trade mark as originally registered.



Strict rules apply: where the proprietor's name or address is part of the distinctive elements of the mark, for example, part of a word mark, an alteration is in principle excluded since the identity of the mark would be substantially affected. A mark may be altered if the EUTM proprietor's name or address appears on a figurative mark, for example, the label of a bottle, as a subordinate element in small letters. Such elements would normally not be taken into account in determining the scope of protection or the fulfilment of the use requirement. The rationale of Article 54(2) EUTMR is precisely to exclude any alteration of the registered EUTM that could affect its scope of protection or the assessment of the use requirement, so that rights of third parties cannot be affected.

No other element of the mark may be altered, not even if it is only a subordinate element in small letters of a descriptive nature, such as the indication of the percentage of alcohol on a label of a bottle of wine.

Furthermore, Article 54(2) EUTMR does not allow for the alteration of the list of goods and services (09/07/2008, R 585/2008-2, SAGA, § 16). After registration, the only way to change the list of goods and services is through partial surrender under Article 57 EUTMR (see paragraph 1.3.4 above).

2.3.1 Examples of acceptable alterations

Mark as registered	Proposed alteration
<p>EUTM No 7 389 687</p> 	

Mark as registered	Proposed alteration
<p>EUTM No 4 988 556</p> 	

2.3.2 Examples of unacceptable alterations

Mark as registered	Proposed alteration
<p>EUTM No 11 058 823</p> <p>ROTAM – INNOVATION IN POST PATENT TECHNOLOGY'</p>	<p>ROTAM – INNOVATION IN POST PATENT TECHNOLOGY</p>
<p>EUTM No 9 755 307</p> <p>MINADI MINADI Occhiali</p>	<p>MINADI</p>
<p>EUTM No 10 009 595</p> <p>CHATEAU DE LA TOUR SAINT-ANNE</p>	<p>CHATEAU DE LA TOUR SAINTE-ANNE</p>
<p>EUTM No 9 436 072</p> <p>SLITONE ULTRA</p>	<p>SLITONEULTRA</p>
<p>EUTM No 2 701 845</p> 	
<p>EUTM No 3 115 532</p> 	

Mark as registered	Proposed alteration
EUTM No 7 087 943 	
EUTM No 8 588 329 	

2.4 Publication

Where the alteration of the registration is allowable, it will be registered and published. The publication will contain a representation of the EUTM as altered.

Within three months of the publication of the alteration (Article 54(5) EUTMR), third parties whose rights may be affected by the alteration may challenge the registration thereof. For this procedure, the provisions on the opposition procedure apply mutatis mutandis.

3 Changes of Name or Address

Articles 55 and 111 and Article 146(6) EUTMR

Article 12(a), (b) and (c) EUTMIR

Both registered European Union trade marks (EUTMs) and EUTM applications may be the subject of changes of name and address. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

It is possible to change the name, address or nationality of the proprietor of a registered EUTM or its representative. The application to register the change must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish. The change will be entered in the EUTM Register and published.

Pursuant to Article 12 EUTMIR, the name, including the indication of the legal form, and address of the proprietor or representative may be amended freely, provided that:

- as regards the proprietor's name, the change is not the consequence of a transfer;
- as regards the representative's name, there is no substitution of one representative by another.

Pursuant to Article 111(3)(a) EUTMR, the indication of the nationality or the State of establishment of a legal person may also be altered or added, provided that it is not the consequence of a transfer.

A change of the proprietor's name within the sense of Article 12 EUTMIR is a change that does not affect the ownership, whereas a transfer is a change from one proprietor to another. In case of doubt as to whether the change falls under Article 20 EUTMR, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer for details and the applicable procedure.

Likewise, a change of a representative's name within the sense of Article 55(4) EUTMR and Article 12 EUTMIR is limited to a change that does not affect the identity of the appointed representative; for example, where the name changes as a result of marriage. Article 55(4) EUTMR and Article 12 EUTMIR also apply where the name of an association of representatives changes. Such a change of name must be distinguished from the substitution of one representative by another, which is subject to the rules governing the appointment of representatives. For details, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

To register a change of name and address, the proprietor must submit an application to the Office. The application must contain the EUTM number as well as the name and address of the proprietor (Article 2(1)(b) EUTMIR) or of the representative (Article 2(1)(e) EUTMIR), both as registered in the file and as amended.

Normally no proof or evidence of the change is necessary. However, in case of doubt, the examiner may ask for proof such as a certificate from a trade register. The application to register the change of name or address is not subject to a fee.

Legal persons may only have one official address. In case of doubt, the examiner may ask for evidence of the legal form or of the address in particular. The official name and address are also used as the address for service by default. A proprietor should have only one address for service. In order to ensure the veracity and correctness of the Register, a change in the proprietor's official name or official address will be registered for all EUTMs, RCDs and pending proceedings of this entity in the name of that proprietor. Unlike the address for service, a change in the official name or address cannot be registered solely for specific portfolios of rights. These rules apply to representatives by analogy.

4 Changes in Collective and Certification Trade Mark Regulations

Articles 79 and 88 and Article 146(6) EUTMR

According to Articles 79 and 88 EUTMR, the proprietors of EU collective and certification marks must submit to the Office any amended regulations governing use.

The application to enter in the EUTM Register an amendment of the regulations governing the use of a collective or certification trade mark must be submitted in writing in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

4.1 Registration of the amended regulations

Article 75(2), Articles 76 and 77, Article 79(3) and (4) and Articles 84, 85 and 88 and 111 EUTMR

The amendment of the regulations governing the use of a collective or certification trade mark will not be entered in the EUTM Register if the amended regulations do not satisfy the requirements of Article 75(2) or Article 84 EUTMR, or if they involve one of the grounds for refusal referred to in Article 76 or 85 EUTMR.

Where the registration of the amendment of the regulations is accepted, it will be registered and published.

The applicant for the amendment will specify the part of the amended regulations to be entered in the EUTM Register, which can be as follows.

For collective marks:

- the EUTM proprietor's name and address;
- the purpose of the association or the purpose for which the legal person governed by public law is constituted;
- the bodies authorised to represent the association or the legal person;
- the conditions for membership;
- the persons authorised to use the mark;
- where appropriate, the conditions governing use of the mark, including sanctions;
- if the mark designates the geographical origin of goods or services, authorisation for any person whose goods or services originate in the geographical area concerned to become a member of the association.

For certification marks:

- the EUTM proprietor's name and address;
- a declaration that the proprietor complies with the requirements laid down in Article 83(2) EUTMR;

- the characteristics of the goods or services to be certified by the EU certification mark, such as the material, mode of manufacture of goods or performance of services, quality or accuracy;
- the conditions governing the use of the EU certification mark, including sanctions;
- the persons authorised to use the EU certification mark;
- how the certifying body is to test those characteristics and to supervise the use of the EU certification mark.

Within three months of the publication of the amended regulations, third parties whose rights may be affected by the amendment may challenge the registration thereof. For this procedure, the provisions on third party observations apply *mutatis mutandis*.

5 Division

5.1 General provisions

Article 56 and Annex I A(25) EUTMR

Article 11 EUTMR

A registration can be split into different parts not only as the result of a partial transfer (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer), but also on the EUTM proprietor's own motion. A division of a trade mark is particularly useful in order to isolate a disputed trade mark for certain goods or services and maintain the registration for the remainder. For information on the division of EUTM applications, see the Guidelines, Part B, Examination, Section 1, Proceedings.

Whereas a partial transfer is free of charge and involves a change of ownership, the declaration of division of a trade mark is subject to a fee and the trade mark remains in the hands of the same proprietor. If the fee has not been paid, the declaration of division is considered not to have been filed. The declaration must be made in one of the five languages of the Office.

Division is not available for international registrations under the Madrid Protocol designating the EU. The Register of International Registrations is kept exclusively at WIPO. The Office does not have the authority to divide an international registration.

5.2 Formal requirements

5.2.1 Form and language

Article 146(6) EUTMR

A declaration of division of an EUTM must be submitted in writing in one of the five languages of the Office namely, English, French, German, Italian or Spanish.

However, when the declaration of division of an EUTM is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

5.2.2 Fees

Annex I A(25) EUTMR

The declaration is subject to a fee of EUR 250; the declaration is considered not to have been filed until the fee has been paid (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

5.2.3 Mandatory indications

Article 54(4) and Article 56 EUTMR

Article 11 EUTMR

The declaration of division must contain:

- the registration number of the EUTM to be divided;
- the proprietor's name and address; if the proprietor has previously been allocated an ID number by the Office, it is sufficient to indicate that ID number together with the proprietor's name;
- the list of goods and services for the divisional registration, or, if more than one new registration is to be created, for each divisional registration;
- the list of goods and services that will remain in the original EUTM.

The goods and services must be distributed between the original EUTM and the new EUTM so that the goods and services in the original and the new EUTM do not overlap. The two specifications taken together must not be broader than the original specification.

Therefore, the indications must be clear, precise and unequivocal. For example, when an EUTM for goods or services in several classes is involved, and the 'split' between

the old and new registration concerns whole classes, it is sufficient to indicate the respective classes for the new registration or for the remaining one.

When the declaration of division indicates goods and services that are explicitly mentioned in the original list of goods and services, the Office will automatically keep the goods and services that are not mentioned in the declaration of division in the original EUTM. For example, the original list contains goods A, B, and C and the declaration of division relates to C; the Office will keep goods A and B in the original registration and create a new registration for C.

For the assessment of whether there is a limitation or a broadening of scope of the list, the rules generally applicable in such situations apply (see the Guidelines, Part B, Examination, Section 3, Classification).

In all cases it is highly recommended to submit a clear and precise list of goods and services to be divided, together with a clear and precise list of goods and services to remain in the original registration. Furthermore, the original list must be clarified. For example, if the original list related to alcoholic beverages and the division relates to whisky and gin, the original list must be amended by restricting it to alcoholic beverages, except whisky and gin.

There are also certain periods during which, for procedural economy or to safeguard third-party rights, a declaration of division is not admissible. These periods are prescribed by Article 56(2) EUTM and are as follows.

- While cancellation proceedings are pending before the Office (application for revocation or declaration of invalidity), only those goods and services against which the cancellation request is not directed may be divided from the original EUTM. The Office interprets Article 56(2)(a) EUTMR as not only excluding a division where some of the contested goods are divided from the original EUTM, with the effect that the cancellation proceedings would have to be split, but also as excluding the division of all the contested goods from the original EUTM. However, in this case, the EUTM proprietor will be given the opportunity to amend the declaration of division by dividing the other goods and services from the original EUTM, that is, those that are not contested in the cancellation proceedings.
- While proceedings are pending before the Boards of Appeal, the General Court or the Court of Justice, only those goods and services not affected by those proceedings may be divided from the original EUTM, due to the suspensive effect of the proceedings.
- Likewise, while a counterclaim for revocation or declaration of invalidity is pending before an EUTM court, the same conditions apply. This covers the period starting on the day the counterclaim was lodged before the EUTM court and ending on the date on which the Office records the EUTM court's judgment in the EUTM Register pursuant to Article 128(6) EUTMR.

5.3 Registration

Article 56(5), (6) and (7) EUTMR

If the Office accepts the declaration of division, a new registration is created as of that date and not retroactively from the date of the declaration.

The new registration keeps the filing date and, depending on the goods and services, any priority or seniority dates; the seniority effect may become partial.

All requests and applications submitted and all fees paid prior to the date on which the Office receives the declaration of division are also deemed to have been made or paid for the resulting divisional registration. However, fees duly paid for the original registration will not be refunded. The practical effects of this provision can be illustrated by the following examples.

- Where an application for the registration of a licence was submitted and the payment of the fee for its registration was received by the Office prior to the declaration of division, the licence will be registered in the EUTM Register for both the original and the divisional EUTM if the licence covers goods and/or services in the original and divisional EUTM. No further fees need to be paid.
- Where an EUTM registration containing two classes is to be divided into two registrations, no additional class fees for the renewal are payable as from the date on which the division is entered in the EUTM Register but, instead, two basic renewal fees will be payable, one for each registration.

5.4 New file, publication

Article 111(3) EUTMR

A new file must be created for the divisional registration. It must contain all the documents that were on file for the original registration, plus all the correspondence related to the declaration of division, as well as all correspondence for the new registration. The division will be published in the EUTM Bulletin. In the case of EUTM applications the entry will not be published.

6 Post-Registration Seniority Claims

Article 40 EUTMR

Decision EX-17-3 of the Executive Director of the Office concerning the formal requirements of a priority claim for a European Union trade mark or a seniority claim for a European Union trade mark or a designation of the European Union under the Madrid Protocol

6.1 General principles

The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered under international arrangements having effect in a Member State, that holds an identical EUTM for goods or services that are identical with or contained in those for which the earlier trade mark has been registered, may claim for the EUTM the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

Seniority may be claimed at any time after the registration of the EUTM.

6.2 Legal effect

Concerning the legal effects of a seniority claim, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 13, which applies by analogy to post-registration seniority claims.

6.3 Formal requirements

6.3.1 Form and language

Article 40 and Article 146(6) EUTMR

The seniority claim must be declared to the Office in writing and must be submitted in one of the five languages of the Office namely, English, French, German, Italian or Spanish.

However, when the seniority claim is filed using the form provided by the Office pursuant to Article 65 EUTMDR, the form may be used in any of the official languages of the European Union, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

6.3.2 Fees

There is no fee for an application for a seniority claim.

6.3.3 Mandatory indications

Article 40 EUTMR

Decision EX-17-3 of the Executive Director of the Office concerning the formal requirements of a priority claim for a European Union trade mark or a seniority claim for a European Union trade mark or a designation of the European Union under the Madrid Protocol

A valid claim must contain the indications as listed in paragraph 13.2 of the Guidelines, Part B, Examination, Section 2, Formalities, which applies equally to post-registration seniority claims.

6.4 Examination

Seniority may only be claimed from an earlier registration, not an earlier application. The date of the earlier trade mark must be before the respective dates of the EUTM (filing date or, if available, priority date).

For details of the examination of seniority claims, the triple identity requirements and examples of acceptable and unacceptable seniority claims, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraphs 13.2, 13.3, 13.4 and 13.6, which apply equally to post-registration seniority claims.

If the claim to seniority does not satisfy the formal requirements or if the marks are not identical, the Office will notify the proprietor and give it 2 months to remedy the deficiency or submit observations.

If the deficiency is not remedied, the Office will inform the proprietor that the right to claim seniority has been rejected.

6.5 Registration and publication

Articles 39(5) and 40(4) and Article 111(3)(f) EUTMR

If the claim to seniority is acceptable, the Office will register it and inform the central industrial property office(s) of the Member State(s) concerned.

The seniority claim will be published in the EUTM Bulletin.

6.6 Cancellation of seniority claims

The EUTM proprietor may at any time request cancellation of the seniority claim from the EUTM Register of its own motion.

Seniority claims may also be cancelled by a decision of a national court (see Article 14 Directive 2008/95/EC).

The cancellation of the seniority claim will be published in the EUTM Bulletin. Article 111(3)(f) EUTMR provides that the cancellation of seniority will be registered.

7 Replacement of an EUTM Registration by an IR

Article 111(3)(t) and Article 157 EUTMR

Article 4bis Madrid Agreement and Protocol

Rule 21 Common Regulations under the Madrid Agreement and Protocol (CR)

In accordance with Article 4bis of the Madrid Agreement and Protocol, the holder of an international registration designating the European Union (IR) may request the Office to take note in its Register that an EUTM registration is replaced by a corresponding IR. The holder's rights in the European Union will be considered to start from the date of the earlier EUTM registration. Therefore, the Office will enter in the EUTM Register that an EUTM has been replaced by a designation of the EU through an IR, and that entry will be published in the EUTM Bulletin.

For more information on replacement, see the Guidelines, Part M, International Marks.