

**GUIDELINES FOR EXAMINATION**

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

**Part E**

**Register operations**

**Section 3**

**EUTMs and RCDs as objects of property**

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Obsolete

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**Chapter 1**

**Transfer**

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Obsolete

## 1 Introduction

Article 1(2), Articles 19, 20, and 28, Article 111(1) and Article 111(3)(g) EUTMR

Articles 27, 28 and 34 CDR

Article 23, Article 69(1) and Article 69(3)(i) CDIR

A transfer is the change in ownership of the property rights in a European Union trade mark (EUTM) or an EUTM application from one entity to another. EUTMs and EUTM applications may be transferred from the current proprietor to a new proprietor, primarily by way of assignment or legal succession. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

The transfer may be limited to some of the goods or services for which the mark is registered or applied for (partial transfer). In contrast to a licence or conversion, the transfer of an EUTM cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for some territories or Member States.

Both registered Community designs (RCDs) and applications for an RCD may also be the subject of a transfer.

The provisions in the CDR and CDIR dealing with the transfer of registered Community designs are almost identical to the equivalent provisions of the EUTMR, EUTMDR and EUTMIR. Therefore, the following applies mutatis mutandis to RCDs. Exceptions and specific provisions for RCDs are detailed in paragraph 7 below.

On request of one of the parties, transfers of EUTMs are entered in the EUTM Register.

According to Article 20 EUTMR, the registration of a transfer is not a condition for its validity. However, if a transfer is not registered by the Office, the successor may not invoke the rights arising from the EUTM. Moreover, the new proprietor will not receive communications from the Office, in particular, during inter partes proceedings, nor the notification of the renewal period of the mark. Furthermore, according to Article 19 EUTMR, in all aspects of the EUTM as an object of property that are not further defined by provisions of the EUTMR, the proprietor's address defines the applicable subsidiary national law. Consequently, it is important to register a transfer at the Office to ensure that entitlement to EUTMs and EUTM applications is clear.

## 1.1 Transfers

Article 20(1) and (2) EUTMR

Article 28 CDR

A transfer of an EUTM involves two aspects, namely the validity of the transfer between the parties and the impact of a transfer on proceedings before the Office, which will only be triggered after the entry of the transfer in the EUTM Register (see paragraph 1.2 below).

Regarding the validity of the transfer between the parties, the EUTMR allows an EUTM to be transferred independently of any transfer of the undertaking to which it belongs (30/03/2006, C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 45 and 48).

### 1.1.1 Assignment

Article 20(3) EUTMR

Article 28 CDR

When a transfer is made by an assignment, it is only valid where the assignment is made in writing and is signed by both parties, except where the assignment is the result of a court decision, or a decision taken by the Office under Article 21 EUTMR. This formal requirement for the validity of the transfer of an EUTM is applicable irrespective of whether, under the national law governing transfers of (national) trade marks, an assignment is valid without observing a particular form, such as the need for the transfer to be in writing and have the signatures of both parties.

### 1.1.2 Inheritance

When the proprietor of an EUTM dies, the heirs will become proprietors of the EUTM by way of individual or universal succession. This is also covered by the rules on transfers.

### 1.1.3 Merger

A universal succession also exists when there is a merger between two companies that leads to the formation of a new company, or an acquisition by one company taking over another. Where the whole of the undertaking to which the mark belongs is transferred, there is a presumption that the transfer includes the EUTM unless, in accordance with the law governing the transfer, an agreement to the contrary was made or unless circumstances clearly dictate otherwise.

#### 1.1.4 Applicable law

Article 19 EUTMR

Article 27 CDR

Unless provided otherwise by the EUTMR, transfers are subject to the national law of a Member State determined by Article 19 EUTMR. The national law applicable under that provision is the national law in general and, therefore, also includes private international law which, in turn, may refer to the law of another State.

### 1.2 Application to register a transfer

Article 20(5) to (8) EUTMR

Article 13 EUTMR

Article 28 CDR

Article 23 CDIR

A transfer becomes relevant in proceedings before the Office if an application to register a transfer has been made and the transfer has been entered in the Register.

Article 20(7) EUTMR

Article 28(c) CDR

However, in the period between the date when the Office receives the application to register a transfer and the date of registering the transfer, the new proprietor may already make submissions to the Office with a view to observing time limits. For example, if a party has applied to register the transfer of an EUTM application against which the Office has raised objections on absolute grounds, the new proprietor may reply to those objections (see paragraph 5 below).

In an application for registration of a transfer, the Office will only examine whether sufficient evidence of the transfer has been submitted.

## 2 Transfers v Changes of Name

Article 55 EUTMR

Article 19 CDIR

A transfer must be distinguished from a change of name of the proprietor.

A change in the name of the proprietor is a change that does not affect the identity of the proprietor, whereas a transfer is a change in the identity of the proprietor.

In particular, no transfer is involved when a natural person changes their name due to marriage, or following an official procedure for changing a name, or when a pseudonym is used instead of the proper name, etc. In all these cases, the identity of the proprietor is not affected.

Where the name or the corporate status of a legal person changes, the criterion for distinguishing a transfer from a mere change of name is whether or not the identity of the legal person remains the same. If the identity remains the same, it will be registered as a change of name (06/09/2010, R 1232/2010-4, Cartier, § 12-14). In other words, where there is no termination of the legal entity (such as would occur in the case of a merger by acquisition, where one company is completely absorbed by the other and ceases to exist) and no start-up of a new legal entity (e.g. as would be the case following the merger of two companies leading to the creation of a new legal entity), there is only a change in the formal corporate organisation that already existed, and not in the actual identity itself. Therefore, the change will be registered as a change of name, where appropriate.

For example, if an EUTM is in the name of Company A and, as the result of a merger, this company is absorbed by Company B, there is a transfer of assets from Company A to Company B.

Likewise, during a division of Company A into two separate entities, one being the original Company A and the other being a new Company B, if the EUTM in the name of Company A becomes the property of Company B, there is a transfer of assets.

Normally, there is no transfer if the company registration number in the national register of companies remains the same.

However, there is in principle the *prima facie* presumption that there is a transfer of assets if there is a change of country (see, however, 24/10/2013, R 546/2012-1, PARFUMS LOVE / LOVE et al.).

If the Office has any doubt about the national law applicable to the legal person concerned, it may require appropriate information from the applicant for registration of the change of name.

Therefore, unless ruled to the contrary under the applicable national law, the change of company type, provided that it is not accompanied by a transfer of assets carried out by means of a merger or an acquisition, will be treated as a change of name and not as a transfer.

However, if the change of company type is the result of a merger, a division or a transfer of assets, depending on which company absorbs or is separated from the other, or on which company transfers which assets to the other, it may be a case of transfer.

## **2.1 Erroneous application to register a change of name**

Articles 55(1), (3) and (5) and 162(1) EUTMR

Article 71 CDR

Article 19(1), (5) and (7) CDIR

When a request is made to register a change of name, but the evidence shows that it is actually a transfer of an EUTM, the Office informs the applicant accordingly and invites it to file an application for registration of a transfer within a specified period. If the applicant agrees or does not submit evidence to the contrary and files the corresponding application to register a transfer, the transfer will be registered. If the applicant does not modify its request and insists on registering the change as a change of name, or if it does not respond, the request to register a change of name will be rejected. The party concerned may file an appeal against this decision.

A new application for the registration of the transfer may be filed at any time.

## **2.2 Erroneous application for the registration of a transfer**

Article 20(5) and (7) EUTMR

Article 23(1) and (5) CDIR

When an application is made to register a transfer, but what is involved is actually a change of name of an EUTM, the Office informs the applicant accordingly and invites it to give, within a specified period, its consent to register the indications concerning the proprietor in the EUTM Register. If the applicant agrees, the change of name will be registered. If the applicant does not agree and insists on registering the change as a transfer, or if it does not respond, the application for the registration of a transfer will be rejected.

## **3 Formal and Substantive Requirements for an Application for Registration of a Transfer**

It is strongly recommended that the application for registration of a transfer for an EUTM be submitted electronically via the Office's website (e-recordals). Using e-recordals has advantages, such as the automatic receipt of electronic confirmation of the application, and the possibility to use the manager feature to complete the form quickly for as many EUTMs as required.

### 3.1 Languages

Article 146(6)(a) EUTMR

Article 80(a) CDIR

The application for the registration of a transfer for an EUTM application must be made in the first or second language of the EUTM application.

Article 146(6) EUTMR

Article 80(c) CDIR

The application for the registration of a transfer for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of a transfer is filed using the form provided by the Office pursuant to Article 65(1)(e) EUTMDR or Article 68 CDIR, according to Article 146(6) EUTMR and Article 80(c) CDIR, the form may be used in any of the official languages of the European Union, provided that it is completed in one of the languages of the Office, as far as textual elements are concerned.

When the application for the registration of the transfer relates to more than one EUTM application, the applicant must select a language for the application that is common to all the EUTMs concerned. If there is no common language, separate applications for registration of the transfer must be filed.

When the application for the registration of the transfer relates to more than one EUTM registration, the applicant must select one of the five languages of the Office as a common language.

Article 24 EUTMIR

Article 81(2) CDIR

Any supporting documents may be filed in any official language of the European Union. This applies to any document submitted as proof of the transfer, such as a countersigned transfer document or a transfer certificate, a deed of assignment or an extract from a trade register or a declaration agreeing to register the successor in title as the new proprietor.

When the supporting documents are submitted in an official language of the European Union that is not the language of the proceedings, the Office may require a translation into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

### 3.2 Application for registration of a transfer filed for more than one mark

Article 20(8) EUTMR

Article 23(6) CDIR

A single application for the registration of a transfer for two or more EUTMs may be submitted only if the registered proprietor and beneficiary, or assignee, are the same in each case.

Separate applications are necessary when the original proprietor and the new one are not exactly identical for each mark. For example, this is the case where there is one successor in title for the first mark and there are multiple successors in title for another mark, even if the successor in title for the first mark is among the successors in title for the other mark. It is immaterial whether the representative is the same in each case.

When a single application is filed in such cases, the Office will issue a deficiency letter. The applicant may overcome the objection either by limiting the application for the registration of the transfer to those EUTMs or EUTM applications for which there is only one and the same original proprietor and only one and the same new proprietor, or by declaring its agreement that the application should be dealt with in two or more separate proceedings. Otherwise, the application for registration of a transfer will be rejected in its entirety. The party concerned may file an appeal against this decision.

### 3.3 Parties to the proceedings

Article 20(4) and Article 20(6)(b) EUTMR

Article 13(3) EUTMIR

Article 28(a) CDR

Article 23(4) CDIR

The application for registration of a transfer may be requested at the Office by:

1. the EUTM proprietor(s), or
2. the EUTM proprietor(s) jointly with the assignee(s), or
3. the assignee(s), or
4. a court or authority.

The formal conditions with which the application must comply depend on who submits the application.

### 3.4 Formal requirements

#### 3.4.1 Indications concerning the EUTM and the new proprietor

Article 20(5) EUTMR

Article 2(1)(b) and (e), and Article 13(1) EUTMIR

Article 1(1)(b) and (e), and Article 23(1) and (2) CDIR

The application for registration of a transfer must contain the following information.

1. The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the registration numbers must be indicated.
2. The details of the new proprietor. In the case of a natural person, the name, address and nationality must be indicated. In the case of a legal entity, the application must indicate the official designation and the legal form of the entity, which may be abbreviated in a customary manner (for example, S.L., S.A., Ltd., PLC). The company's national identification number may also be specified, if available. Both natural persons and legal entities must indicate the State in which they are domiciled or have their seat or an establishment. The Office strongly recommends US companies to indicate, where applicable, the State of Incorporation, in order for it to differentiate clearly between different owners in its database. These details correspond to the indications required for an applicant for a new EUTM application. However, where the Office has already assigned an ID number to the new proprietor, it is sufficient to indicate that number together with the name of the new proprietor.  
The form made available by the Office also requests an indication of the original proprietor's name. This indication will facilitate both the Office's and the parties' handling of the file.
3. If the new proprietor designates a representative, the representative's name and ID number assigned by the Office. If the representative has not yet been assigned an ID number, the business address must be indicated.

For additional requirements in cases of partial transfer, see paragraph 4 below.

#### 3.4.2 Representation

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

### 3.4.3 Signatures

Article 20(5), Article 20(6)(b), and Article 119(4) EUTMR

Article 13(2) EUTMIR

Article 23(1) and (4) CDIR

The requirements concerning the person entitled to file the application for registration of the transfer and the signatures must be considered together with the requirement to submit proof of the transfer. The principle is that the signatures of the original proprietor and the new proprietor must appear together or separately on the application for registration of the transfer or in an accompanying document. In the case of co-ownership, and where the transfer concerns the ownership as a whole, all co-owners must sign or appoint a common representative.

When the original proprietor and the new proprietor both sign the application for registration of the transfer, this is sufficient and no additional proof of the transfer is necessary.

When the original proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration signed by the successor in title stating that it agrees to the registration of the transfer, this is sufficient and no additional proof is necessary.

When the new proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration, signed by the original proprietor, stating that it agrees to the registration of the successor in title as the new proprietor, this is also sufficient and no additional proof is necessary.

When the original proprietor's representative is also appointed as the new proprietor's representative, the representative may sign the application for registration of the transfer on behalf of both the original and the new proprietor, and no additional proof is necessary. However, when the representative signing on behalf of both the original and the new proprietor is not the representative on file (i.e. in an application simultaneously appointing the representative and transferring the EUTM), the Office will contact the applicant for registration of the transfer to request evidence of the transfer (authorisation signed by the original proprietor, proof of transfer, confirmation of the transfer by the original proprietor or its representative on file).

### 3.5 Proof of transfer

Article 20(2) and (3) EUTMR

Article 65(1)(e) EUTMDR

Article 13(1)(d) and Article 13(2) EUTMIR

Article 28 CDR

Article 23(1)(d) and (4)(a) to (c) and Article 68(1)(c) CDIR

A transfer may be registered only when it is proven by documents duly establishing the transfer, such as a copy of the deed of transfer. However, as already highlighted above, a copy of the deed of transfer is not necessary when:

- the new proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the original proprietor (or its representative) stating that it agrees to the registration of the transfer to the successor in title; or
- the original proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the new proprietor (or its representative) stating that it agrees to the registration of the transfer; or
- the application for registration of the transfer is signed by both the original proprietor (or its representative) and by the new proprietor (or its representative); or
- when the application for registration of the transfer is accompanied by a completed transfer form or document signed by both the original proprietor (or its representative) and by the new proprietor (or its representative).

Parties to the proceedings may also use the forms established under the Trademark Law Treaty available on WIPO's website (<http://www.wipo.int/treaties/en/ip/tlt/forms.html>). The relevant forms are the 'Transfer Document' — a document conceived as constituting the transfer (assignment) itself — and the 'Certificate of Transfer' — a document in which the parties to a transfer declare that a transfer has taken place. Either of these documents, duly completed, constitutes sufficient proof of transfer.

However, other means of proof are not excluded. Therefore, the agreement (deed) itself or any other document proving the transfer may be submitted.

When the mark has been subject to multiple successive transfers and/or changes of the proprietor's name that have not been previously registered in the register, it is sufficient to submit the chain of evidence showing the events leading to the relationship between the original proprietor and the new proprietor without the need to file separate individual applications for each change.

When the transfer of the mark is the consequence of the transfer of the whole of the undertaking of the original proprietor, and unless proof is submitted as indicated above,

the document showing the transfer or assignment of the whole undertaking must be submitted.

When the transfer is due to a merger or another universal succession, the original proprietor will not be available to sign the application for registration of transfer. In this case, the application must be accompanied by supporting documents that prove the merger or universal succession, such as extracts from the trade register.

When the transfer of the mark is a consequence of a right in rem, a levy of execution or insolvency proceedings, the original proprietor will not be able to sign the application for registration of transfer. In these cases, the application must be accompanied by a final decision issued by a competent national authority transferring the ownership of the mark to the beneficiary.

It is not necessary to legalise supporting documents nor to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient.

If the Office has reason to doubt the accuracy or veracity of the document, it may require additional proof.

The Office will examine the documents only to the extent that they actually confirm what is indicated in the application, namely the identity of the marks concerned and the identity of the parties, and whether a transfer is involved. The Office does not consider or rule on contractual or legal questions arising under national law (09/09/2011, T-83/09, Craic, EU:T:2011:450, § 27). If doubts arise, the national courts deal with the legality of the transfer itself.

### 3.5.1 Translation of proof

Article 146(1) EUTMR

Article 24 EUTMIR

Article 80(a) and (c) and Article 81(2) CDIR

The evidence must be:

1. in the language of the Office that has become the language of the proceedings for the registration of the transfer; or
2. in any official language of the European Union other than the language of the proceedings. In this case, the Office may require a translation of the document into a language of the Office to be submitted within a period specified by the Office.

Where the supporting documents are submitted in an official language of the European Union that is not the language of the proceedings, the Office may require a translation into that language. The Office will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

### 3.6 Procedure to remedy deficiencies

Article 20(7) and (12) EUTMR

Article 28 CDR

Article 23(5) CDIR

The Office will inform the applicant for registration of the transfer in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, the Office will reject the application for registration of the transfer. The party concerned may file an appeal against the decision.

## 4 Partial Transfers

Article 20(1) EUTMR

Article 14 EUTMIR

A partial transfer concerns only some of the goods and services in the EUTM and is only applicable to EUTMs (not to RCDs).

It involves the distribution of the original list of goods and services between the remaining EUTM and a new one. When partial transfers are involved, the Office uses particular terminology to identify the marks. At the beginning of the proceedings there is the 'original' mark. This is the mark for which a partial transfer has been applied. After the registration of the transfer, there are two marks: one is a mark that now has fewer goods and services, and is called the 'remaining' mark, and one is a 'new' mark that has some of the goods and services from the original mark. The 'remaining' mark retains the EUTM number of the 'original' mark while the 'new' mark has a new EUTM number.

Transfer cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for some territories.

When there are doubts as to whether the transfer is partial or not, the Office will inform the applicant for registration of the transfer and invite it to make the necessary clarifications.

Partial transfers may also be involved when the application for registration of the transfer concerns more than one EUTM. The following rules apply for each EUTM included in the application.

## 4.1 Rules on the distribution of the lists of goods and services

Articles 33 and 49 EUTMR

Article 14(1) EUTMR

Communication No 1/2016 of the President of the Office of 08/02/2016

In the application for registration of a partial transfer, the goods and services to which the partial transfer relates must be indicated (the list of goods and services for the 'new' registration). The goods and services must be distributed between the original EUTM and the new EUTM so that the goods and services in the original EUTM and the new one 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 original and new registration concerns entire classes, it is sufficient to indicate the respective classes for the new registration or for the remaining one.

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

For further details concerning the scope of the list of goods and services, and for the Office's practice regarding the interpretation of general indications of the Nice Classification class headings, please see the Guidelines, Part B, Examination, Section 3, Classification, and Communication No 1/2016 of the President of the Office of 08/02/2016 concerning the implementation of Article 28 EUTMR (now Article 33 EUTMR), and the Annex thereto.

In all cases, it is highly recommended to file a clear and precise list of goods and services to be transferred 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 transfer relates to whisky and gin, the original list must be amended by restricting it to alcoholic beverages, except whisky and gin.

## 4.2 Objections

Article 20(7) EUTMR

When the application for registration of a partial transfer does not comply with the rules explained above, the Office will invite the applicant to remedy the deficiency. If the deficiencies are not remedied, the Office will reject the application for registration of a partial transfer. The party concerned may file an appeal against the decision.

## 4.3 Creation of a new EUTM

Article 20(6)(c) EUTMR

Article 14(2) EUTMIR

A partial transfer leads to the creation of a new EUTM. For this new EUTM, the Office will establish a separate file, which will consist of a complete copy of the electronic file of the original EUTM, the application for registration of a transfer, and all the correspondence related to the application for registration of the partial transfer. The new EUTM will be given a new file number. It will have the same filing date and, where applicable, date of priority as the original EUTM.

As far as the original EUTM is concerned, the Office will include a copy of the application for registration of a transfer in its files, but will not normally include copies of the further correspondence relating to the transfer application.

## 5 Transfer During the Course of Other Proceedings and Fees Issues

Article 20(11) and (12) EUTMR

Article 28(b) and (c) CDR

Without prejudice to the right to act from the time when the application for registration of a transfer is received by the Office where time limits are involved, the new proprietor will automatically become party to any proceedings involving the mark in question from the time the transfer is registered.

The filing of an application for registration of a transfer has no effect on time limits already running or established by the Office, including time limits for the payment of fees. New time limits for payment will not be established. From the date of registration of the transfer, the new proprietor becomes liable to pay any fees due.

Therefore, it is important that, during the period between the filing of the application for registration of a transfer and the Office's confirmation of its actual entry in the EUTM Register or in the file, the original proprietor and the new proprietor actively collaborate in the communication of time limits and correspondence received during inter partes proceedings.

## 5.1 Specific issues of partial transfers

### Article 20(10) EUTMR

In cases of partial transfers, the new EUTM will be at the same procedural stage as the original (remaining) EUTM. Any time limit still pending for the original EUTM will be considered to be pending for both the remaining and the new EUTM. After registration of the transfer, the Office will treat each EUTM separately and will decide on them separately.

When an EUTM is subject to the payment of fees and these fees have been paid by the original proprietor, the new proprietor will not be liable to pay any additional fees for the new EUTM. The relevant date is the entry date of the transfer in the EUTM Register. Therefore, when the fee for the original EUTM is paid after an application for registration of a transfer has been filed but before the registration of the transfer itself, no additional fees are due.

### Articles 31(2) and 41(5) EUTMR

### Annex I A(3) and (4), Annex I A(7) and (8) EUTMR

When the partial transfer involves an EUTM application and class fees have not yet been paid or have not been paid in full, the Office will proceed to register the transfer in the files of the remaining EUTM application and to create a new EUTM application as described above.

Where additional class fees have to be paid for an EUTM application, the examiner will deal with such cases after creating a new EUTM application, as described below.

When additional class fees were paid prior to registering the transfer but no additional class fees were due for the remaining EUTM application, no reimbursement will be made because the fees were paid correctly at the time of payment.

In all other cases, the examiner will treat the remaining EUTM application and the new one separately, but will not require an additional basic fee to be paid for the new EUTM application. Class fees for the remaining EUTM application and for the new one will be determined according to the situation after the registration of the transfer. For example, when the original EUTM application had seven classes and, after the transfer, the remaining EUTM application has only one class while the new EUTM application has six, no additional class fees will be due for the remaining EUTM application, but the corresponding additional class fees must be paid for the new EUTM application. When

some of the goods and services of a particular class are transferred and others are not, the fees for that class become payable for both the remaining EUTM application and the new one. When a time limit already set to pay additional class fees has not yet expired, it will be set aside by the Office to allow the determination to be made according to the situation after the registration of the transfer.

Article 53(1), (3) to (5) and (7) to (8) EUTMR

When the application for registration of a partial transfer relates to an EUTM registration that is due for renewal, that is, within six months prior to the expiry of the original registration and up to six months after that expiry, the Office will proceed to register the transfer and deal with the renewal and renewal fees as described below.

When no request for renewal has been submitted and no fees have been paid prior to the registration of the transfer, the general rules, including the rules relating to the payment of fees, are applicable to both the remaining EUTM registration and the new one (separate requests, separate payment of fees, as necessary).

When a request for renewal has been submitted prior to the registration of the transfer, that request is also valid for the new EUTM. However, while the original proprietor remains a party to the renewal proceedings for the remaining EUTM, the new proprietor automatically becomes party to the renewal proceedings for the new registration.

When a request for renewal has been filed but the relevant fees have not been paid prior to the registration of the transfer, the fees to be paid are determined according to the situation after the registration of the transfer. This means that both the proprietor of the remaining EUTM and the proprietor of the new EUTM must pay the basic renewal fee and any class fees.

When a request for renewal has been filed prior to the registration of the transfer and all the applicable renewal fees have been paid prior to this date, no additional renewal fees are due after the registration of the transfer. No reimbursement is made of any class fees already paid.

## **5.2 Transfer and inter partes proceedings**

When an application for registration of a transfer is filed during inter partes proceedings, several different situations can arise. For earlier EUTMs on which the opposition/cancellation is based, the new proprietor can only become party to the proceedings (or file observations) once the application for registration of the transfer has reached the Office. The basic principle is that the new proprietor substitutes the original proprietor in the proceedings. The practice of the Office when dealing with transfers in oppositions is described in the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 6.5.

## **6 Entry in the Register, Notification and Publication**

### **6.1 Publication and Entry in the Register**

Article 20(4) and (9), Article 44, and Article 111(3)(g) EUTMR

Article 28(a) and Article 49 CDR

Article 23(7) and Article 70(3)(i) CDIR

The Office will enter the transfer in the EUTM Register and publish it in the EUTM Bulletin. The entry will be published once the EUTM application has been published pursuant to Article 44 EUTMR.

The entry in the EUTM Register will mention the following data:

- the date of registration of the transfer,
- the new proprietor's name and address,
- the name and address of the new proprietor's representative, if any.

For partial transfers, the entry will also contain the following data:

- the number of the original registration and the number of the new registration,
- the list of goods and services remaining in the original registration, and
- the list of goods and services of the new registration.

### **6.2 Notification**

The Office will notify the applicant of the registration of the transfer.

When the application for registration of the transfer was filed by the assignee, the Office will also inform the EUTM proprietor of the registration of the transfer.

## **7 Transfers for Registered Community Designs**

Article 1(3) and Articles 27, 28, 33 and 34 and Article 107(2)(f) CDR

Article 23 and Article 61(2) and Articles 68(1)(c) and 69(2)(i) CDIR

Annexes No 16 and No 17 CDFR

The legal provisions contained in the CDR, CDIR and CDFR in respect of transfers correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Therefore, both the legal principles and the procedure in respect of the registration of trade mark transfers apply mutatis mutandis to RCDs, except for the following specific procedures.

## 7.1 Rights of prior use for an RCD

Article 22(4) CDR

The right of prior use for an RCD cannot be transferred except where the third person, who owned the right before the filing or priority date of the application for an RCD, is a business, along with that part of the business in the course of which the act was done or the preparations were made.

## 7.2 Fees

Annexes No 16 and No 17 CDFR

The fee of EUR 200 for the registration of a transfer applies per design and not per multiple application. This is also the case for the ceiling of EUR 1 000 if multiple applications for registration of transfers are submitted.

## 8 Transfers for International Trade Marks

The Madrid System allows for the recording of a 'change of ownership' of an international registration.

All requests to record a change in ownership must be submitted on form MM5:

- directly to the International Bureau by the recorded holder, or
- through the office of the contracting party of the recorded holder or through the office of a contracting party in respect of which the transfer is granted, or
- through the office of the contracting party of the new proprietor (transferee).

The request to record a transfer cannot be submitted directly to the International Bureau by the new proprietor. The Office's own application form should not be used.

Detailed information on changes in ownership can be found in paragraphs B.II.60.01-67.02 of the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol ([www.wipo.int/madrid/en/guide/](http://www.wipo.int/madrid/en/guide/)). See also the Guidelines, Part M, International marks.

**GUIDELINES FOR EXAMINATION**

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

**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**

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Obsolete

## 1 Introduction

Articles 19 to 29 EUTMR

Articles 27 to 34 CDR

Articles 23 to 26 CDIR

Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings

Both registered European Union trade marks (EUTMs) and EUTM applications may be the subject of licensing contracts (licences), rights in rem or levies of execution, or be affected by insolvency or similar proceedings. Unless otherwise provided, the practice applicable to EUTMs is also applicable to EUTM applications.

Both registered Community designs (RCDs) and applications for an RCD may be the subject of licences, rights in rem or levies of execution, or be affected by insolvency or similar proceedings.

The provisions in the CDR and CDIR dealing with design licences, rights in rem concerning designs, levies of execution concerning designs, and insolvency and similar proceedings concerning designs are almost identical to the corresponding provisions of the EUTMR and EUTMIR respectively. Therefore, the following applies mutatis mutandis to RCDs. Exceptions and specific provisions for RCDs are detailed in paragraph 8 below. Specific procedures for international trade marks are laid down in paragraph 9 below.

This section of the Guidelines deals with the procedures for registering, cancelling or modifying licences, rights in rem, levies of execution and insolvency proceedings or similar proceedings.

### 1.1 Definition of licence contracts

A trade mark licence is a contract by virtue of which the proprietor of a trade mark (the licensor), whilst retaining ownership, authorises a third person (the licensee) to use the trade mark in the course of trade, under the terms and conditions set out in the contract.

A licence refers to a situation where the rights of the licensee to use the EUTM arise from a contractual relationship with the proprietor. The proprietor's consent to, or tolerance of, a third party using the trade mark does not amount to a licence.

## 1.2 Definition of rights in rem

A right in rem or 'real right' is a limited property right that is an absolute right. Rights in rem refer to a legal action directed towards property, rather than towards a particular person, allowing the owner of the right the opportunity to recover, possess or enjoy a specific object. These rights may apply to trade marks or designs. They may consist, inter alia, in use rights, usufruct or pledges. 'In rem' is different from 'in personam', which means directed toward a particular person.

The most common rights in rem for trade marks or designs are pledges or securities. They secure the repayment of a debt of the proprietor of the trade mark or design (i.e. the debtor) in such a way that, where the proprietor cannot repay the debt, the creditor (i.e. the owner of the pledge or security) may receive repayment of the debt by, for example, selling the trade mark or design.

There are two types of right in rem for which the applicant can request entry in the EUTM Register:

- rights in rem that serve the purpose of guaranteeing securities (pledge, charge, etc.);
- rights in rem that do not serve as a guarantee (usufruct).

## 1.3 Definition of levies of execution

A levy of execution is the act by which a court officer appropriates a debtor's property following a judgment of possession obtained by a plaintiff from a court. In this way, a creditor can recover its claim from all the property of the debtor, including from its trade mark rights.

## 1.4 Definition of insolvency proceedings or similar proceedings

For the purposes of these Guidelines, 'insolvency proceedings' are understood to be the collective proceedings that entail the partial or total divestment of a debtor and the appointment of a liquidator. They may include winding up by, or under the supervision of, a court, creditors' voluntary winding up (with confirmation by the court), administration, voluntary arrangements under insolvency legislation and bankruptcy or sequestration. 'Liquidator' is understood as any person or body whose function is to administer or liquidate assets of which the debtor has been divested or to supervise the administration of their affairs, and may include liquidators, supervisors of a voluntary arrangement, administrators, official receivers, trustees and judicial factors. 'Court' is understood to be the judicial body or any other competent body of a Member State empowered to open insolvency proceedings or to take decisions in the course of such proceedings. 'Judgment', in relation to the opening of insolvency proceedings or the appointment of a liquidator, is understood to include the decision of any court

empowered to open such proceedings or to appoint a liquidator (for terminology in other territories, see Regulation (EU) 2015/848 on insolvency proceedings).

## 1.5 Applicable law

Article 19 EUTMR

Article 27 CDR

The EUTMR does not establish unified and complete provisions applicable to licences, rights in rem or levies of execution for EUTMs or EUTM applications. Instead, Article 19 EUTMR refers to the law of a Member State regarding the acquisition, validity and effects of the EUTM as an object of property, and regarding the procedure for levies of execution. To this end, a licence, a right in rem or a levy of execution for an EUTM is, in its entirety and for the whole territory of the European Union, assimilated to a licence, to a right in rem, or to a levy of execution for a trade mark registered in the Member State in which the EUTM proprietor has its seat or domicile. If the proprietor does not have a seat or domicile in a Member State, the licence, right in rem or levy of execution for an EUTM will be dealt with as a licence, right in rem or levy of execution for a trade mark registered in the Member State in which the proprietor has an establishment. If the proprietor does not have an establishment in a Member State, the licence, right in rem or levy of execution for an EUTM will be dealt with as a licence, right in rem or levy of execution for a trade mark registered in Spain (Member State in which the Office has its seat).

This, however, applies only to the extent that Articles 20 to 28 EUTMR do not provide otherwise.

Article 19 EUTMR is limited to the effects of a licence or right in rem as an object of property and does not extend to contract law. Article 19 EUTMR does not govern the applicable law or the validity of a licensing contract or right in rem contract, which means that the freedom of the contracting parties to submit the licensing contract or the right in rem contract to a given national law is not affected by the EUTMR.

Article 21(1) EUTMR

Article 31(1) CDIR

Article 3(1) of Regulation (EU) 2015/848 on insolvency proceedings

Furthermore, these Guidelines serve to explain the procedure before the Office for registering the opening, modification or closure of insolvency proceedings or similar proceedings. In accordance with Article 19 EUTMR, all other provisions are covered by national law. Moreover, Regulation (EU) 2015/848 on insolvency proceedings regulates the provisions on jurisdiction, recognition and applicable law in the area of insolvency proceedings.

The regulations specifically state that an EUTM may only be involved in insolvency proceedings opened in the Member State in the territory of which the debtor has its centre of main interests. The only exception is when the debtor is an insurance undertaking or credit institution, in which case the EUTM may only be involved in those proceedings opened in the Member State where that undertaking or institution has been authorised. The 'centre of main interests' should correspond to the place where the debtor conducts the administration of its interests on a regular basis and is, therefore, ascertainable by third parties.

## 1.6 Advantages of registration

Article 27 and Article 57(3) EUTMR

Article 33 and Article 51(4) CDR

Article 27(2) CDIR

Entry in the EUTM Register of a licence agreement, a right in rem, a levy of execution, or the opening, modification and closure of insolvency proceedings is not compulsory. However, such registration has particular advantages.

1. In view of the provision of Article 27(1) and (3) EUTMR, vis-à-vis third parties who might have acquired, or have entered in the EUTM Register, rights in the trade mark that are incompatible with the registered licence, right in rem or levy of execution, the licensee, pledgee or beneficiary respectively may avail itself of the rights conferred by this licence, right in rem or levy of execution only:

- • if it was entered in the EUTM Register;
- or

- • if the third party acquired its rights after the date of any legal acts such as those referred to in Articles 20, 22, 23, 25 and 26 EUTMR (a transfer, a right in rem, a levy of execution, or a previous licence), knowing of the existence of the licence, right in rem or levy of execution.

In view of Article 27(4) EUTMR, vis-à-vis third parties that might have acquired or have entered in the EUTM Register rights in the trade mark that are incompatible with the registered insolvency, the effects will be governed by the law of the Member State in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.

1. Where a licence or a right in rem for an EUTM is entered in the EUTM Register, the surrender or partial surrender of that mark by its proprietor will only be entered in the EUTM Register if the proprietor establishes that it has informed the licensee or pledgee respectively of its intention to surrender.

The holder of a licence or the pledgee of a right in rem that is registered has, therefore, the right to be informed in advance by the proprietor of the trade mark of its intention to surrender the trade mark.

On entry in the EUTM Register of insolvency proceedings or a levy of execution against an EUTM, the proprietor loses its right to act and, therefore, may not perform any actions before the Office (such as withdraw, surrender, transfer, act in inter partes proceedings).

2. Where a licence, right in rem, levy of execution, or insolvency proceedings for, or against, an EUTM is entered in the EUTM Register, the Office will notify the licensee, pledgee, beneficiary or liquidator, respectively, of the approaching expiry of the registration at least six months beforehand.
3. Registering licences, rights in rem, levies of execution and insolvency proceedings (and their modification and/or cancellation, where applicable) is important for maintaining the veracity of the EUTM Register, particularly in the event of inter partes proceedings.

However,

1. when a party to proceedings before the Office has to prove use of an EUTM, if such use has been made by a licensee, it is not necessary for the licence to have been entered in the EUTM Register for that use to be considered to be use with the proprietor's consent pursuant to Article 18(2) EUTMR;
2. registration is not a condition for considering the use of a trade mark by a pledgee under the terms of the right in rem contract to have been made with the consent of the proprietor pursuant to Article 18(2) EUTMR;
3. the Office strongly recommends that liquidators duly inform the Office of the withdrawal, surrender or transfer of EUTMs subject to insolvency proceedings prior to the final winding up.

## **2 Requirements for an Application for Registration of a Licence, Right in Rem, Levy of Execution, and Insolvency Proceedings**

Articles 22(2), 23(3), 24(3) and 25(5), Article 26 and Article 111(3) EUTMR

Articles 29(2), 30(3), 31(3) and 32(5) CDR

Articles 24 and 25 CDIR

The application for registration of a licence, a right in rem, a levy of execution, or insolvency proceedings must comply with the following conditions.

## 2.1 Application form

Article 146(6) EUTMR

Article 65(1)(f) EUTMDR

Article 68(1)(d) and Article 80 CDIR

It is strongly recommended that the application for registration of a licence, a right in rem, a levy of execution or insolvency proceedings for an EUTM be submitted electronically via the Office's website (e-recordals). Using e-recordals has advantages, such as the automatic receipt of electronic confirmation of the application and the possibility to use the manager feature to complete the form quickly for as many EUTMs as required.

Articles 20(8) and 26(1) EUTMR

Articles 23(6) and 24(1) CDIR

A single application for the registration of a licence for two or more EUTMs may be made only if the registered proprietor and the licensee are the same and the contracts have the same conditions, limitations and terms in each case (see paragraph 2.5 below).

A single application for the registration of a right in rem or a levy of execution for two or more registered EUTMs may be submitted only if the registered proprietor and beneficiary are the same in each case.

## 2.2 Languages

Article 146(6)(a) EUTMR

Article 80(a) CDIR

The application for the registration of a licence, a right in rem, a levy of execution, or insolvency proceedings for an EUTM application must be made in the first or second language of the EUTM application.

Article 146(6)(b) EUTMR

Article 80(c) CDIR

The application for the registration of a licence, a right in rem, a levy of execution, or insolvency proceedings for an EUTM must be submitted in one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

However, when the application for the registration of a licence, a right in rem, a levy of execution, or insolvency proceedings is filed using the form provided by the Office pursuant to Article 65(1)(f) EUTMDR and Article 68 CDIR, the form may be used in any of the official languages of the European Union, provided that it is completed in one of the languages of the Office, as far as textual elements are concerned.

## 2.3 Fees

Article 26(2) and Annex I A(26) and (27) EUTMR

Articles 23(3) and 24(1) CDIR

Annex (18) CDFR

The application for the registration of a licence, a right in rem or a levy of execution is considered not to have been made until the fee is paid. The amount of this fee is EUR 200 for each EUTM for which the registration is requested.

However, where several registrations of licences, rights in rem or levies of execution have been applied for in one single application and the registered proprietor and the licensee (and contractual terms), pledgee, or beneficiary are the same in all cases, the fee is limited to a maximum of EUR 1 000.

The same maximum amount applies where several registrations of licences, rights in rem or levies of execution are applied for at the same time, provided that they could have been filed in one single application and that the registered proprietor and the licensee, pledgee or beneficiary are the same in all cases. Furthermore, for the registration of licences or rights in rem, the contractual terms must be the same. For example, an exclusive licence and a non-exclusive licence cannot be filed in the same application, even if they are between the same parties.

Once the corresponding fee has been paid, it will not be reimbursed if the application for registration is refused or withdrawn.

In the case of a levy of execution where the applicant for the registration (see paragraph 2.4.1 below) is a court or an authority, no fee is to be paid and administrative cooperation is applied.

There is no fee for registering insolvency proceedings or similar proceedings.

## 2.4 Parties to the proceedings

### 2.4.1 Applicants

Articles 22(2), 25(5) and 117(1) EUTMR

Articles 29(2) and 32(5) CDR

The application for the registration of a licence or of a right in rem at the Office may be filed by:

1. the EUTM proprietor(s); or
2. the EUTM proprietor(s) jointly with the licensee(s)/pledgee(s); or
3. the licensee(s)/pledgee(s); or
4. a court or authority.

Articles 23(3) and 24(3) EUTMR

Articles 30(3) and 31(3) CDR

The application for the registration of a levy of execution or of insolvency proceedings may be requested by:

1. the EUTM proprietor(s), or
2. the beneficiary of the levy of execution/the liquidator in the insolvency proceedings;  
or
3. a court or authority.

The formal conditions with which the application must comply depend on who files the application.

### 2.4.2 Mandatory indications concerning the EUTM and the licensee, pledgee, beneficiary or liquidator

Articles 24(2) and 26(1) EUTMR

Article 2(1)(b) and (e) EUTMIR

Article 13 EUTMDR

Article 31 CDR

Article 1(1)(b) and (e), Articles 23 and 24 CDIR

The application for registration of a licence, a right in rem, a levy of execution or insolvency proceedings must contain the following information.

1. The registration number of the EUTM concerned. If the application relates to several EUTMs, each of the registration numbers must be indicated.

Additionally, for insolvency proceedings, the Office will register the insolvency proceedings against all EUTMs/RCDs linked to the proprietor's ID number at the Office.

Where the proprietor is the joint proprietor of an EUTM or RCD, the insolvency proceedings will apply to the share of the joint proprietor.

2. The licensee's, pledgee's, beneficiary's or liquidator's name, address, nationality and the State in which it is domiciled or has its seat or an establishment. However, if the Office has already assigned an ID number to them, it is sufficient to indicate this number together with the name.
3. If the licensee, pledgee, beneficiary or liquidator designates a representative, the representative's name and ID number assigned by the Office. If the representative has not yet been assigned an ID number, the business address must be indicated.

### 2.4.3 Signatures

Article 63(1)(a) EUTMDR

Article 67(4) CDIR

The requirements concerning signatures, proof and representation vary depending on the person filing the application. Where the requirement of a signature is referred to, in electronic communications, the indication of the sender's name is considered to be equivalent to the signature.

The general rules on signatures apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits).

### 2.4.4 Representation

Articles 119(2) and 120(1) EUTMR

Articles 77(2) and 78(1) CDR

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

### 2.4.5 Proof

For the special provisions and specific requirements with regard to proof, see the paragraphs below. These give details based on the type of right being registered: paragraph 4.1 for licences; paragraph 5.1 for rights in rem; paragraph 6.1 for levies of execution; paragraph 7.1 for insolvency proceedings.

## 2.4.6 Translation of proof

Article 146(6) EUTMR

Article 24 EUTMR

Article 80 and Article 81(2) CDIR

Proof must be as follows.

1. In the language of the Office that has become the language of the proceedings for the registration of the licence, right in rem, levy of execution or insolvency proceedings, see paragraph 2.2 above.
2. Or in any official language of the European Union other than the language of the proceedings. In this case, the Office may require a translation of the document into a language of the Office to be submitted within a period specified by the Office. The Office will set a time limit for submission of the translation. If the translation is not submitted within that time limit, the document will not be taken into account and will be considered not to have been submitted.

## 2.5 Examination of the application for registration

### 2.5.1 Fees

Article 26(2) EUTMR

Articles 23(3) and 24(1) CDIR

Where the required fee has not been received, the Office will notify the applicant (unless the applicant is a court or authority, in which case no fee is required, see paragraph 2.3 above) that the application is considered not to have been filed because the relevant fee has not been paid. However, a new application may be submitted at any time providing the correct fee is paid from the outset.

There is no fee for applications for the registration of insolvency proceedings or similar proceedings.

### 2.5.2 Examination of the mandatory formalities

Article 24(1) EUTMR

Article 31(1) CDR

For insolvency proceedings, the Office will check that there are no other pending recordals and that no insolvency proceedings have already been registered for the proprietor concerned.

Article 26(4) EUTMR

Article 24(3) CDIR

The Office will check whether the application for registration complies with the formal conditions mentioned in paragraph 2.4 above and with the specific requirements given below, based on the type of right being registered (see paragraph 4.1 for licences, paragraph 5.1 for rights in rem, paragraph 6.1 for levies of execution, and paragraph 7.1 for insolvency proceedings).

Article 26 and Article 120(1) EUTMR

Article 78(1) CDR

Article 24 CDIR

The Office will check whether the application for registration of the licence, right in rem, levy of execution or insolvency proceedings has been duly signed. Where the application is signed by the licensee's, pledgee's, beneficiary's or liquidator's representative, an authorisation may be required by the Office or, in the case of inter partes proceedings, by the other party to the proceedings. In this case, if no authorisation is submitted, the proceedings will continue as if no representative had been appointed.

Where the application for registration of the licence, right in rem, insolvency proceedings or levy of execution is signed by the representative that has already been designated as the proprietor's representative for the EUTM in question, the requirements relating to signatures and authorisations are fulfilled.

Article 26(4) EUTMR

Article 24(3) CDIR

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the period established in that communication, which will normally be two months following the date of the notification, the Office will reject the application for registration of the right. The party concerned may file an appeal against this decision.

For additional specific formalities that concern only licences and rights in rem, see the special provisions below (paragraphs 4.3 and 4.4 for licences, and paragraph 5.2 for rights in rem).

### **3 Procedure for Cancellation or Modification of the Registration**

Articles 29(1) and 117(1) EUTMR

Article 26(1) CDIR

The registration of a licence, a right in rem, a levy of execution or insolvency proceedings will be cancelled or modified at the request of an interested party, that is, the applicant or proprietor of the EUTM or the registered licensee, pledgee, beneficiary or liquidator, or of the relevant national authority or court.

A registration of a licence or right in rem may also be transferred (see paragraph 4.6 for licences and paragraph 5.4 for rights in rem). The application should make a clear distinction between a request for modification and a request for transfer.

The Office will refuse the cancellation, transfer and/or modification of a licence, sublicense or right in rem if the main licence or right in rem has not been entered in the EUTM Register.

#### **3.1 Competence, languages, presentation of the request**

Article 29(3) and (6), and Article 162 EUTMR

Article 104 CDR

Article 26(3), (6) and (7) CDIR

Paragraphs 2.1 and 2.2 above apply.

It is strongly recommended that requests for cancellation or modification of a licence, right in rem, levy of execution or insolvency proceedings be submitted using the official forms available on the Office's website. Parties to the proceedings may also use WIPO Model International Form No 1, 'Request for Amendment/Cancellation of Recordal of License', (found in the annex to the Joint Recommendation concerning trademark licenses adopted by the Assembly of the Paris Union and the General Assembly of WIPO on 25/09/2000 to 03/10/2000), which can be downloaded at <http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf>, or a form with a similar content and format.

## 3.2 Applicant for a cancellation or modification request

Article 29(1) and (6) and Article 117(1) EUTMR

Article 26(1), (4) and (6) CDIR

Requests for cancellation or modification of a registration may be submitted by the same parties who can file applications for registration (see paragraph 2.4.1 above).

### 3.2.1 Licences

#### 3.2.1.1 Cancellation of a licence

In the case of a joint request submitted by the EUTM proprietor and the licensee, or of a request submitted by the licensee, no proof of the cancellation of the licence is required, since the request itself implies a statement from the licensee that it consents to the cancellation of the registration of the licence. However, a request for cancellation submitted by the EUTM proprietor alone must be accompanied by proof that the registered licence no longer exists, or by a declaration from the licensee to the effect that it consents to the cancellation.

Where a registered licensee alone submits a request for cancellation, the EUTM proprietor will not be informed thereof.

If the EUTM proprietor alleges fraud on the part of the licensee, it must submit a final decision of the competent authority to this effect. It is not within the remit of the Office to carry out any investigation in that respect.

Where several licences were requested simultaneously, it is possible to cancel them individually.

The entry in the EUTM Register of licences that are limited in time, that is, temporary licences, does not automatically expire but must be cancelled from the EUTM Register.

#### 3.2.1.2 Modification of a licence

In the case of a joint request from the EUTM proprietor and the licensee, no further proof of the modification of the licence is required.

If the request is made by the EUTM proprietor, proof of the modification of the licence is required only where the modification for which entry in the EUTM Register is requested is of such a nature that it would diminish the rights of the registered licensee under the licence. For example, this would be the case if the licensee's name were to change, if an exclusive licence were to become a non-exclusive licence, or if the licence were to become restricted regarding its territorial scope, the period of time for which it is granted, or the goods or services to which it applies.

If the request is made by the registered licensee, proof of the modification of the licence is required only where the modification for which entry in the EUTM Register is requested is of such a nature that it would extend the rights of the registered licensee under the licence. For example, this would be the case if a non-exclusive licence were to become an exclusive licence, or if any registered restrictions of the licence as to its territorial scope, the period of time for which it is granted, or the goods or services to which it applies, were to be cancelled fully or in part.

Where proof of the modification of the licence is necessary, it is sufficient if any of the documents referred to in paragraph 4.1.4 below are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the licence contract and must relate to the registration of the modification of the licence as requested.
- The request for modification or cancellation of a licence must indicate how the licence has been modified.
- The copy or extract of the licence agreement must be of the licence as modified.

### 3.2.2 Rights in rem

#### 3.2.2.1 Cancellation of the registration of a right in rem

If the EUTM proprietor and the pledgee submit a joint request, or if the pledgee alone submits a request, no proof of the cancellation of the registration of the right in rem is required, since the request itself implies a statement by the pledgee that it consents to the cancellation of the registration of the right in rem. When the request for cancellation is submitted by the EUTM proprietor, it must be accompanied by proof that the registered right in rem no longer exists, or by a declaration by the pledgee that it consents to the cancellation.

Where the registered pledgee submits the request for cancellation by itself, the EUTM proprietor will not be informed thereof.

Where the registration of several rights in rem was requested simultaneously, it is possible to cancel them individually.

#### 3.2.2.2 Modification of the registration of a right in rem

If the EUTM proprietor and the pledgee submit a joint request, no further proof of the modification of the registration of the right in rem is required.

If the request is submitted by the EUTM proprietor or the registered pledgee, proof of the modification of the registration of the right in rem is required.

Where proof of the modification of the registration of the right in rem is necessary, it is sufficient if any of the documents referred to in paragraph 5.1.4 below are submitted, subject to the following requirements.

- The written agreement must be signed by the other party to the right in rem agreement and must relate to the registration of the modification of the right in rem as requested.
- The request for modification or cancellation of the registration of a right in rem must show the right in rem in its modified form.
- The copy or extract of the right in rem agreement must show the right in rem in its modified form.

### 3.2.3 Levies of execution

#### 3.2.3.1 Cancellation of the registration of a levy of execution

A request for cancellation of the registration of a levy of execution must be accompanied by proof that the registered levy of execution no longer exists. This proof comprises the final decision of the competent authority.

#### 3.2.3.2 Modification of the registration of a levy of execution

A levy of execution may be modified on submission of the corresponding final decision of the competent authority showing such modification.

### 3.2.4 Insolvency proceedings

#### 3.2.4.1 Cancellation of the registration of an insolvency

A request for the cancellation of the registration of insolvency proceedings must be accompanied by proof that the registered insolvency no longer exists. This proof comprises the final decision of the competent authority.

#### 3.2.4.2 Modification of the registration of an insolvency

The registration of insolvency proceedings may be modified on submission of the corresponding final decision of the competent authority showing such modification.

### 3.3 Contents of the request

Article 29(1) EUTMR

Article 12 EUTMR

Articles 19 and 26 CDIR

Paragraph 2.4 above applies, except that the data concerning the licensee, pledgee, beneficiary or liquidator need not be indicated except in the case of a modification of the registered licensee's, pledgee's, beneficiary's or liquidator's name.

Paragraph 4.2 below applies if a modification of the scope of a licence is requested, for example, if a licence becomes a temporary licence or if the geographical scope of a licence is changed.

### 3.4 Fees

#### 3.4.1 Cancellation

Article 29(3) and Annex I A(27) EUTMR

Article 26(3) CDIR

Annex (19) CDFR

Any request for the cancellation of licences, rights in rem and levies of execution is considered not to have been made until the fee is paid. The fee is EUR 200 for each EUTM for which cancellation is requested.

However, where several requests for cancellations of licences, rights in rem and levies of execution are applied for in one single application or at the same time, and the registered proprietor and the licensee (including contractual terms), pledgee, or beneficiary are the same in all cases, the cancellation fee is limited to a maximum of EUR 1 000.

This applies irrespective of how the initial applications for registration of these licences, rights in rem or levies of execution were filed. This means that, even where the initial applications for registration of these rights were staggered over time and could not, therefore, benefit from the maximum fee of EUR 1 000, they can still benefit from the maximum fee of EUR 1 000 if their cancellation is requested in the same application for cancellation.

Requests for cancellation of the registration of insolvency proceedings are not subject to a fee.

### 3.4.2 Modification

Article 29(3) EUTMR

Article 26(6) CDIR

Modification of the registration of a licence, a right in rem, a levy of execution, or insolvency proceedings is not subject to a fee.

## 3.5 Examination of requests for cancellation or modification

### 3.5.1 Fees

Article 29(3) EUTMR

Article 26(3) CDIR

Where the required fee for a request for cancellation of a licence, a right in rem, or a levy of execution has not been received, the Office will notify the applicant that the request for cancellation is considered not to have been filed.

As seen above, requests for cancellation of the registration of insolvency proceedings are not subject to a fee.

### 3.5.2 Examination by the Office

Article 29(2) and (4) EUTMR

Article 26(2) and (4) CDIR

For the mandatory elements of the request, paragraph 2.5.2 above applies mutatis mutandis, including in respect of proof, to the extent that such proof is required. Additionally, specific formalities apply to licences (see paragraph 4.3 below), to rights in rem (see paragraph 5.2 below), to levies of execution (see paragraph 6.1 below) and to insolvency proceedings (see paragraph 7.1 below).

The Office will notify the applicant for cancellation or modification of any deficiency, setting a time limit of 2 months. If the deficiencies are not remedied, the Office will reject the request for cancellation or modification.

Article 29(1), (2), (4) and (5), Articles 111(6) and 117(1) EUTMR

Articles 26(6) and 69(6) CDIR

Paragraph 4.4 below applies to the extent that modification of the licence would affect its nature or its limitation to a part of the goods and services covered by the EUTM.

Registration of the cancellation or modification of a licence, a right in rem, a levy of execution or insolvency proceedings will be communicated to all the parties concerned.

### **3.6 Registration and publication**

Articles 111(3)(s) and 116(1)(a) EUTMR

Article 69(3)(t) and Article 70(2) CDIR

The creation, cancellation or modification will be entered in the EUTM Register and published in the EUTM Bulletin.

## **4 Licences — Special Provisions**

### **4.1 Requirements concerning proof**

Article 19 and Article 26(1) EUTMR

Articles 2(1)(b) and 13(3)(a) EUTMIR

Article 27 CDR

Article 1(1)(b) and Articles 23(4) and 24(1) CDIR

#### **4.1.1 Application made by the EUTM proprietor alone**

When an application for the registration of a licence is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

No proof of the licence is necessary.

The Office will inform the licensee when the licence is registered in the EUTM Register.

The licensee may file a statement with the Office to oppose the registration of the licence. The Office will not take any further action on the statement but will register the licence. Following the registration of the licence, any licensee that disagrees with the registration of the licence may request the cancellation or modification of the licence (see paragraph 3 above).

The Office will not take into account whether or not the parties, although having agreed to a licence contract, have agreed to register it at the Office. Any dispute regarding the licence is a matter that must be resolved among the parties concerned under the relevant national law (Article 19 EUTMR).

#### 4.1.2 Application made jointly by the EUTM proprietor and the licensee

When an application for the registration of a licence is made jointly by the EUTM proprietor and its licensee, it must be signed both by the EUTM proprietor and the licensee. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the licence.

Where there is a formal deficiency regarding the signature of the licensee or regarding its representative, the application will still be accepted as long as it would have been acceptable if it had been presented by the EUTM proprietor alone.

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or regarding its representative, but where the application would have been acceptable if it had been presented by the licensee alone.

#### 4.1.3 Application made by the licensee alone

An application for the registration of a licence may also be made by the licensee alone. In this case, it must be signed by the licensee and proof of the licence must be submitted.

#### 4.1.4 Proof of the licence

There is sufficient proof of the licence if the application for registration of the licence is accompanied by any of the following.

- A declaration stating that the EUTM proprietor agrees to the registration of the licence, signed by the EUTM proprietor or its representative.  
According to Article 13(3)(a) EUTMR, it is also considered sufficient proof if an application for registration of the licence is signed by both parties. This case has already been dealt with in paragraph 4.1.2 above.
- The licence agreement, or an extract therefrom, indicating the parties and the EUTM being licensed, and bearing their signatures.  
In many cases, the parties to the licence agreement will not wish to disclose all the details, which may contain confidential information on the licence royalties or other terms and conditions of the licence. In such cases, it is sufficient if only a part or an extract of the licence agreement is submitted, as long as it identifies the parties to the licence agreement, confirms that the EUTM in question is the subject of a licence and contains the signatures of both parties. All other elements may be omitted or blacked out.

- An uncertified statement of licence using the complete WIPO Model International Form No 1 'Request for Recordal of License'. The form must be signed by both the EUTM proprietor, or its representative, and the licensee, or its representative. It can be found at <http://www.wipo.int/edocs/pubdocs/en/marks/835/pub835.pdf>  
It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

## 4.2 Optional contents of the application

Articles 25(1) and 26(3) EUTMR

Article 32(1) CDR

Article 25 CDIR

Depending on the nature of the licence, an application for registration of the licence may contain the request to register the licence together with other indications, namely those referred to under letters a) to e) below. These indications may be individual or in any combination, for one licence (e.g. an exclusive licence limited in time) or for several licences (e.g. one exclusive licence for A as regards Member State X and another for B as regards Member State Y). They are entered in the EUTM Register by the Office only if the application for registration of the licence itself clearly requests that they be registered. Without such an explicit request, the Office will not enter in the EUTM Register any indications contained in the licence agreement that are submitted, for example, as proof of the licence.

However, if entry in the EUTM Register is requested for one or more of these indications, the following details must be indicated.

1. Where an application for the registration of a licence is limited to only some of the goods or services, the goods or services for which the licence has been granted must be indicated.
2. Where an application is for the registration of a licence as a territorially limited licence, the application must indicate the part of the European Union for which the licence has been granted. A part of the European Union may consist of one or several Member States or one or several administrative districts within a Member State.
3. Where registration of an exclusive licence is sought, a statement to this effect must be made in the application for registration.
4. Where the registration of a licence granted for a limited period of time is sought, the expiry date of the licence must be specified. Furthermore, the date of the commencement of the licence may be indicated.

5. Where the licence is granted by a licensee whose licence is already entered in the EUTM Register, the application for registration may indicate that it is for a sublicense. Sublicences cannot be registered without first registering the main licence.

### **4.3 Examination of specific formalities (licences)**

Article 26(4) EUTMR

Article 24(3) CDIR

Where an application for the registration of a licence has been made jointly by the EUTM proprietor and the licensee, the Office will communicate with the EUTM proprietor and send a copy to the licensee.

Where the licensee has also made and signed the application, it will not be allowed to contest the existence or scope of the licence.

Where the application for registration of the licence is filed by the EUTM proprietor alone, the Office will not inform the licensee.

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, which will normally be 2 months following the date of the notification, the Office will reject the application. The party concerned may file an appeal against this decision.

### **4.4 Examination of optional elements (licences)**

Article 26 EUTMR

Article 25 CDIR

Where an application for the registration of a licence specifies that the licence be registered as one of the following:

- an exclusive licence;
- a temporary licence;
- a territorially limited licence;
- a licence limited to certain goods or services; or
- a sublicense,

the Office will examine whether the indications mentioned in paragraphs 2.4 and 4.1 above are indicated.

As far as the indication 'exclusive licence' is concerned, the Office will accept only this term and not any other wording. If 'exclusive licence' is not expressly indicated, the Office will consider the licence to be non-exclusive.

Where an application for registration indicates that it is for a licence limited to certain goods or services covered by the EUTM, the Office will check whether the goods and services are properly grouped and are actually covered by the EUTM.

As far as a sublicense is concerned, the Office will check whether it has been granted by a licensee whose licence has already been entered in the EUTM Register. The Office will refuse the registration of a sublicense when the main licence has not been entered in the EUTM Register. However, the Office will not check the validity of an application for the registration of a sublicense as an exclusive licence when the main licence is not an exclusive licence. Nor will it examine whether the main licence contract excludes granting sublicences.

It is the duty of the applicant for the registration of a licence not to conclude and register incompatible contracts and to request the cancellation or modification of entries in the Register that are no longer valid. For example, if an exclusive licence has been registered without limitation as to the goods and the territory, and the registration of another exclusive licence is applied for, the Office will register that second licence, even where both licences seem incompatible at first sight.

Parties are, furthermore, encouraged to update all EUTM Register information regularly and swiftly by cancelling or modifying existing licences (see paragraph 3 above).

Article 25(1), and Article 26(3) and (4) EUTMR

Article 32(1) CDR

Articles 24(3) and 25 CDIR

If the indications mentioned in paragraph 4.2 above are missing, the Office will invite the applicant for the registration of the licence to submit the supplementary information. If the applicant does not reply to that communication, the Office will not take into account the abovementioned indications and will register the licence without mentioning them. The applicant will be notified of this and may file an appeal against the decision.

#### **4.5 Registration procedure and publication (licences)**

Article 25(5) and Articles 111(3)(j) and 116(1)(a) EUTMR

Article 32(5) CDR

Article 69(3)(t) and Article 70(2) CDIR

The Office will enter the licence in the EUTM Register and publish it in the EUTM Bulletin.

Where applicable, the entry in the EUTM Register will only mention that the licence is:

- an exclusive licence;

- a temporary licence;
- a territorially limited licence;
- a sublicense; or
- a licence limited to certain goods or services covered by the EUTM.

The following details will not be published:

- the period of validity of a temporary licence;
- the territory covered by a territorially limited contract;
- the goods and services covered by a partial licence.

Article 111(6) EUTMR

Article 69(5) CDIR

The Office will notify the applicant for a registration of a licence of the registration thereof.

When an application for registration of a licence was filed by the licensee, the Office will also inform the EUTM proprietor of the registration of the licence.

## **4.6 Transfer of a Licence**

### **4.6.1 Provision for the transfer of a licence**

Article 25(5) EUTMR

Article 32(5) CDR

A licence concerning an EUTM may be transferred. The transfer of a licence is different from the transfer of a sublicense insofar as, in the former, the licensee loses all its rights under the licence and is replaced by a new licensee, whereas, in the case of the transfer of a sublicense, the main licence remains in force. Likewise, the transfer of a licence is different from a change of name of the owner where no change of ownership is implied (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer).

### **4.6.2 Applicable rules**

Article 26(1) and (5) and Annex I A(26)(b) EUTMR

Article 24(1) and (3) CDIR

Annex (18)(b) CDFR

The procedure for the registration of a transfer of a licence follows the same rules as for an application for registration of a licence.

The transfer of a licence is subject to the payment of a fee. Paragraph 2.3 above applies mutatis mutandis.

To the extent that a declaration by or signature of the EUTM proprietor is required in accordance with the rules, its place will be taken by a declaration by or signature of the registered licensee (the former licensee).

## **5 Rights in Rem — Special Provisions**

### **5.1 Requirements concerning proof**

Article 19 and Article 26(1) EUTMR

Articles 2(1)(b) and 13(3)(a) EUTMIR

Article 27 CDR

Article 1(1)(b), Articles 23(4) and 24(1) CDIR

#### **5.1.1 Application submitted by the EUTM proprietor alone**

When an application for the registration of a right in rem is made by the EUTM proprietor alone, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

The signature of the EUTM proprietor constitutes proof of the right in rem. Consequently, no additional proof of the right in rem is necessary.

The Office will inform the pledgee when the right in rem is registered in the EUTM Register.

Where the pledgee files a statement with the Office to oppose the registration of the right in rem, the Office will forward the statement to the EUTM proprietor for information purposes only. The Office will not take any further action on the statement. Following the registration of the right in rem, any pledgee that disagrees with the registration of the right in rem may request the cancellation or modification of the registration of the right in rem (see paragraph 3 above).

The Office will not take into account whether the parties have agreed to register a right in rem contract at the Office. Any dispute regarding the right in rem is a matter that must be resolved between the parties concerned under the relevant national law (Article 19 EUTMR).

### 5.1.2 Application submitted jointly by the EUTM proprietor and the pledgee

When an application for the registration of the right in rem is submitted jointly by the EUTM proprietor and the pledgee, it must be signed by both parties. In the case of co-ownership, all co-owners must sign or appoint a common representative.

In this case, the signature of both parties constitutes proof of the right in rem.

Where there is a formal deficiency regarding the signature of the pledgee or regarding its representative, the application will still be accepted as long as it would have been acceptable if it had been submitted by the EUTM proprietor alone.

The same applies where there is a deficiency regarding the signature of the EUTM proprietor or its representative, but where the application would have been acceptable if it had been submitted by the pledgee alone.

### 5.1.3 Application submitted by the pledgee alone

An application may also be submitted by the pledgee alone. In this case, it must be signed by the pledgee and proof of the right in rem must be submitted.

### 5.1.4 Proof of the right in rem

There is sufficient proof of the right in rem if the application for registration of the right in rem is accompanied by any of the following.

- A declaration signed by the EUTM proprietor stating that it agrees to the registration of the right in rem.  
According to Article 13(3)(a) EUTMIR, it is also considered sufficient proof if an application for registration of the right in rem is signed by both parties. This case has already been dealt with in paragraph 5.1.2 above.
- The right in rem contract, or an extract therefrom indicating the EUTM at issue and the parties, and bearing their signatures.  
It is sufficient if the right in rem contract is submitted. In many cases, the parties to the right in rem contract will not wish to disclose all the details of the contract, which may contain confidential information about the terms and conditions of the pledge. In such cases, it is sufficient if only a part or an extract of the right in rem contract is submitted, as long as it identifies the parties to the right in rem contract and the EUTM that is subject to a right in rem, and bears the signatures of both parties. All other elements may be omitted or blacked out.
- An uncertified statement of a right in rem, signed by both the EUTM proprietor and the pledgee.  
It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

## 5.2 Examination of specific formalities requirements (rights in rem)

Article 26(4) EUTMR

Article 24(3) CDIR

Where an application for registration of a right in rem has been submitted jointly by the EUTM proprietor and the pledgee, the Office will communicate with the EUTM proprietor and send a copy to the pledgee.

Where the pledgee has also submitted and signed the application, it will not be allowed to contest the existence or scope of the right in rem agreement within the Office's proceedings, notwithstanding what could be established by the national laws of the Member States in this regard.

If the EUTM proprietor alleges fraud on the part of the pledgee, it must provide a final decision of the competent authority to this effect. It is not up to the Office to carry out any investigation into such a claim.

The Office will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit fixed in that communication, which will normally be two months following the date of the notification, the Office will reject the application. The party concerned will have the possibility of filing an appeal against this decision.

## 5.3 Registration procedure and publication (rights in rem)

Articles 22(2) and 26(5) and Article 111(3)(h) and Article 111(6) EUTMR

Article 29(2) CDR

Article 24(4) and Article 69(3)(j) and (5) CDIR

For EUTMs, the Office will enter the right in rem in the EUTM Register and publish it in the EUTM Bulletin. The entry will not be published in the case of EUTM applications.

The Office will notify the applicant for registration of a right in rem of the registration thereof.

When an application for registration of a right in rem was filed by the pledgee, the Office will also inform the EUTM proprietor of the registration.

## 5.4 Transfer of a Right in rem

Article 26(1) and (5) and Annex I A(26)(d) EUTMR

Article 24(1) CDIR

Annex (18)(d) CDFR

### 5.4.1 Provision for the transfer of a right in rem

A right in rem may be transferred.

### 5.4.2 Applicable rules

The procedure for the registration of a transfer of a right in rem follows the same rules as for the registration of a right in rem.

The transfer of a right in rem is subject to the payment of a fee. Paragraph 2.3 above applies mutatis mutandis.

To the extent that a declaration by or signature of the EUTM proprietor is required in accordance with the rules, it must be replaced by a declaration by or signature of the registered pledgee (the former pledgee).

## 6 Levies of Execution — Special Provisions

### 6.1 Requirements concerning proof

Article 26(1) EUTMR

Article 2(1)(b) EUTMIR

Article 1(1)(b) and Article 24(1) CDIR

#### 6.1.1 Application filed by the EUTM proprietor

When an application for the registration of a levy of execution is made by the EUTM proprietor, it must be signed by the EUTM proprietor. In the case of co-ownership, all co-owners must sign or appoint a common representative.

The Office will inform the beneficiary when the levy of execution is registered in the EUTM Register.

The beneficiary may file a statement with the Office to oppose the registration of the levy of execution. The Office will not take any further action on such a statement.

Following the registration of the levy of execution, any beneficiary that disagrees with the registration of the levy of execution may request the cancellation or modification of the registration of the levy of execution (see paragraph 3 above).

Any dispute regarding the levy of execution is a matter that must be resolved between the parties concerned under the applicable national law (Article 19 EUTMR).

#### 6.1.2 Application filed by the beneficiary

An application for registration of a levy of execution may also be filed by the beneficiary. In this case, it must be signed by the beneficiary.

In addition, proof of the levy of execution must be submitted.

#### 6.1.3 Application filed by a court or authority

An application for registration of a levy of execution may also be filed by the court or authority issuing the judgment. In this case, it must be signed by the court or authority.

In addition, proof of the levy of execution must be submitted.

#### 6.1.4 Proof of the levy of execution

There is sufficient proof of the levy of execution if the application for registration of a levy of execution is accompanied by a final decision of the competent national authority

In many instances, the parties to the levy of execution proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the levy of execution judgment is submitted, as long as it identifies the parties to the levy of execution proceedings and the EUTM that is subject to the levy of execution, and confirms that the judgment is final. All other elements may be omitted or blacked out.

## 6.2 Registration procedure and publication (levy of execution)

Articles 111(3)(i) and 116(1)(a) EUTMR

Article 69(3)(k) and Article 70(2) CDIR

When the mark is registered, the levy of execution will be entered in the EUTM Register and published in the EUTM Bulletin.

The Office will notify the applicant for registration of a levy of execution of the registration thereof.

Where applicable, the EUTM proprietor will also be informed.

## **7 Insolvency Proceedings — Special Provisions**

### **7.1 Requirements concerning proof**

There is sufficient proof of the appointment of a liquidator and of the insolvency proceedings if an application for registration of the insolvency proceedings is accompanied by a final decision of the competent national authority.

It suffices if the insolvency judgment is submitted. In many instances, the parties to the insolvency proceedings will not wish to disclose all the details of the judgment, which may contain confidential information. In these cases it suffices if only a part or an extract of the judgment is submitted, as long as it identifies the parties to the proceedings. All other elements may be omitted or blacked out.

It is not necessary to submit the original of a document. Original documents become part of the file and, therefore, cannot be returned to the person who submitted them. Simple photocopies are sufficient. The original document or photocopy does not need to be authenticated or legalised unless the Office has reasonable doubts as to its veracity.

### **7.2 Registration procedure and publication (insolvency proceedings)**

Articles 111(3)(i) and 116(1)(a) EUTMR

Article 69(3)(k) and Article 70(2) CDIR

When the mark is registered, the insolvency proceedings will be entered in the EUTM Register and published in the EUTM Bulletin. The publication contains the EUTM registration number(s), the name of the authority requesting the entry in the EUTM Register, the date and number of the entry and the publication date of the entry in the EUTM Bulletin.

The Office will notify the applicant for registration of insolvency proceedings of the registration thereof.

The liquidator's contact details are recorded as the EUTM proprietor's 'correspondence address' in the Office's database, and third parties may consult the full details of the insolvency proceedings through an application for inspection of files (see the Guidelines, Part E, Register Operations, Section 5, Inspection of Files).

## 8 Procedures for Registered Community Designs

Articles 27, 29, 30, 31, 32, and 33 and Article 51(4) CDR

Articles 24 to 26 and Article 27(2) CDIR

Annex (18) and (19) CDFR

The legal provisions contained in the CDR, CDIR and CDFR in respect of licences, rights in rem, levies of execution and insolvency proceedings correspond to the respective provisions in the EUTMR, EUTMDR and EUTMIR.

Therefore, both the legal principles and the procedure in respect of the registration, cancellation or modification of trade mark licences, rights in rem, levies of execution or insolvency proceedings apply *mutatis mutandis* to RCDs, except for the following specific procedures.

### 8.1 Multiple applications for RCDs

Article 37 CDR

Article 24(1) CDIR

An application for the registration of licences, rights in rem and levies of execution for an RCD may be in the form of a multiple application containing several designs.

For the purposes of the legal effect of licences, rights in rem and levies of execution, as well as of the procedure for registering licences, rights in rem and levies of execution, the individual designs contained in a multiple application will be dealt with as if they were separate applications. This continues to apply after registration of the designs contained in the multiple application.

In other words, each design contained in a multiple application may be licensed, pledged or levied independently of the others.

For licences specifically, the optional indications as to the kind of licence and the procedure for their examination referred to in paragraphs 4.2 and 4.4 above (with the exception of a licence limited to some products, which is not possible), apply to each of the individual designs contained in a multiple application separately and independently.

Annex (18) and (19) CDFR

The fee of EUR 200 for the registration of a licence, a right in rem, or a levy of execution; the transfer of a licence or right in rem; or the cancellation of a licence, a right in rem, or levy of execution applies per design and not per multiple application. The same is true for the ceiling of EUR 1 000 if multiple applications are submitted.

## 8.2 Other entries in the Register for RCDs

Additionally, the following entries in the Register are specific to RCDs:

- institution of entitlement proceedings before a Community design court;
- final decisions on entitlement proceedings before a Community design court;
- change of ownership after a decision of a Community design court.

## 9 Procedures for International Trade Marks

Rules 20 and 20bis [Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement](#) (CR)

### 9.1 Recording of licences

The Madrid System allows for the recording of licences against an international registration.

All requests for the recording of a licence should be submitted on form [MM13](#) either:

- directly to the International Bureau by the recorded holder; or
- through the office of the contracting party of the recorded holder or through the office of a contracting party in respect of which the licence is granted; or
- through the office of the licensee.

The request cannot be submitted directly to the International Bureau by the licensee. The Office's application form should not be used.

Detailed information on the recording of licences can be found in Sections B.II.93.01-99.04 of the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol ([www.wipo.int/madrid/en/guide/](http://www.wipo.int/madrid/en/guide/)). For further information on international trade marks, see the Guidelines, Part M, International Marks.

### 9.2 Recording of rights in rem, levies of execution or insolvency proceedings

The Madrid System allows for the recording of rights in rem, levies of execution or insolvency proceedings against an international registration (see Rule 20 [CR](#)). For the convenience of users, form [MM19](#) is available for requesting the recording of a restriction of the holder's right of disposal in the International Register. The use of this form is strongly recommended to avoid irregularities.

Requests should be submitted either:

- directly to the International Bureau by the recorded holder, or

- to the office of the contracting party of the registered holder or
- to the office of a contracting party to whom the right in rem, levy of execution or insolvency is granted; or
- to the office of the contracting party of the pledgee, beneficiary or liquidator.

The request cannot be submitted directly to the International Bureau by the pledgee, beneficiary or liquidator. The Office's application form should not be used.

Detailed information on the registration of rights in rem, levies of execution or insolvency proceedings can be found in Part B, Chapter II, paragraphs 92.01-92.04 of the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol ([www.wipo.int/madrid/en/guide](http://www.wipo.int/madrid/en/guide)). For further information on international trade marks, see the Guidelines, Part M, International Marks.

Obsolete