

Council Regulation (EC) No 40/94 of 20 December
1993 on the Community trade mark (repealed)

TITLE IX

PROCEDURE

SECTION 1

GENERAL PROVISIONS

Article 73

Statement of reasons on which decisions are based

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

Article 74

Examination of the facts by the Office of its own motion

- 1 In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.
- 2 The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

Article 75

Oral proceedings

- 1 If the Office considers that oral proceedings would be expedient they shall be held either at the instance of the Office or at the request of any party to the proceedings.
- 2 Oral proceedings before the examiners, the Opposition Division and the Administration of Trade Marks and Legal Division shall not be public.
- 3 Oral proceedings, including delivery of the decision, shall be public before the Cancellation Division and the Boards of Appeal, in so far as the department before which the proceedings are taking place does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

Status: Point in time view as at 27/12/2004.

Changes to legislation: There are currently no known outstanding effects for the Council Regulation (EC) No 40/94 (repealed), TITLE IX. (See end of Document for details)

Article 76

Taking of evidence

1 In any proceedings before the Office, the means of giving or obtaining evidence shall include the following:

- a hearing the parties;
- b requests for information;
- c the production of documents and items of evidence;
- d hearing witnesses;
- e opinions by experts;
- f statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.

2 The relevant department may commission one of its members to examine the evidence adduced.

3 If the Office considers it necessary for a party, witness or expert to give evidence orally, it shall issue a summons to the person concerned to appear before it.

4 The parties shall be informed of the hearing of a witness or expert before the Office. They shall have the right to be present and to put questions to the witness or expert.

Article 77

Notification

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

[^{F1}Article 77a

Revocation of decisions

1 Where the Office has made an entry in the Register or taken a decision which contains an obvious procedural error attributable to the Office, it shall ensure that the entry is cancelled or the decision is revoked. Where there is only one party to the proceedings and the entry or the act affects its rights, cancellation or revocation shall be determined even if the error was not evident to the party.

2 Cancellation or revocation as referred to in paragraph 1 shall be determined, ex officio or at the request of one of the parties to the proceedings, by the department which made the entry or took the decision. Cancellation or revocation shall be determined within six months from the date on which the entry was made in the Register or the decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the Community trade mark in question that are entered in the Register.

Status: Point in time view as at 27/12/2004.

Changes to legislation: There are currently no known outstanding effects for the Council Regulation (EC) No 40/94 (repealed), TITLE IX. (See end of Document for details)

3 This Article shall be without prejudice to the right of the parties to submit an appeal under Articles 57 and 63, or to the possibility, under the procedures and conditions laid down by the Implementing Regulation referred to in Article 157(1), of correcting any linguistic errors or errors of transcription and obvious errors in the Office's decisions or errors attributable to the Office in registering the trade mark or in publishing its registration.]

Textual Amendments

- F1** Inserted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

Article 78

Restitutio in integrum

1 The applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit *vis-à-vis* the Office shall, upon application, have his rights reestablished if the non-observance in question has the direct consequence, by virtue of the provisions of this Regulation, of causing the loss of any right or means of redress.

2 The application must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-submission of the request for renewal of registration or of non-payment of a renewal fee, the further period of six months provided in Article 47 (3), third sentence, shall be deducted from the period of one year.

3 The application must state the grounds on which it is based and must set out the facts on which it relies. It shall not be deemed to be filed until the fee for re-establishment of rights has been paid.

4 The department competent to decide on the omitted act shall decide upon the application.

[^{F25} This Article shall not be applicable to the time limits referred to in paragraph 2 of this Article, Article 42(1) and (3) and Article 78a.]

6 Where the applicant for or proprietor of a Community trade mark has his rights re-established, he may not invoke his rights *vis-à-vis* a third party who, in good faith, has put goods on the market or supplied services under a sign which is identical with or similar to the Community trade mark in the course of the period between the loss of rights in the application or in the Community trade mark and publication of the mention of re-establishment of those rights.

7 A third party who may avail himself of the provisions of paragraph 6 may bring third party proceedings against the decision re-establishing the rights of the applicant for or proprietor of a Community trade mark within a period of two months as from the date of publication of the mention of re-establishment of those rights.

8 Nothing in this Article shall limit the right of a Member State to grant *restitutio in integrum* in respect of time limits provided for in this Regulation and to be observed *vis-à-vis* the authorities of such State.

Status: Point in time view as at 27/12/2004.

Changes to legislation: There are currently no known outstanding effects for the Council Regulation (EC) No 40/94 (repealed), TITLE IX. (See end of Document for details)

Textual Amendments

- F2** Substituted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

f^{F1} Article 78a

Continuation of proceedings

1 An applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who has omitted to observe a time limit vis-à-vis the Office may, upon request, obtain the continuation of proceedings, provided that at the time the request is made the omitted act has been carried out. The request for continuation of proceedings shall be admissible only if it is presented within two months following the expiry of the unobserved time limit. The request shall not be deemed to have been filed until the fee for continuation of the proceedings has been paid.

2 This Article shall not be applicable to the time limits laid down in Article 25(3), Article 27, Article 29(1), Article 33(1), Article 36(2), Article 42, Article 43, Article 47(3), Article 59, Article 60a, Article 63(5), Article 78, Article 108, or to the time limits laid down in this Article or the time limits laid down by the Implementing Regulation referred to in Article 157(1) for claiming priority within the meaning of Article 30, exhibition priority within the meaning of Article 33 or seniority within the meaning of Article 34 after the application has been filed.

3 The department competent to decide on the omitted act shall decide upon the application.

4 If the Office accepts the application, the consequences of having failed to observe the time limit shall be deemed not to have occurred.

5 If the Office rejects the application, the fee shall be refunded.]

Textual Amendments

- F1** Inserted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

Article 79

Reference to general principles

In the absence of procedural provisions in this Regulation, the Implementing Regulation, the fees regulations or the rules of procedure of the Boards of Appeal, the Office shall take into account the principles of procedural law generally recognized in the Member States.

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Changes to legislation: There are currently no known outstanding effects for the Council Regulation (EC) No 40/94 (repealed), TITLE IX. (See end of Document for details)

Article 80

Termination of financial obligations

1 Rights of the Office to the payment of a fee shall be extinguished after four years from the end of the calendar year in which the fee fell due.

2 Rights against the Office for the refunding of fees or sums of money paid in excess of a fee shall be extinguished after four years from the end of the calendar year in which the right arose.

3 The period laid down in paragraphs 1 and 2 shall be interrupted in the case covered by paragraph 1 by a request for payment of the fee and in the case covered by paragraph 2 by a reasoned claim in writing. On interruption it shall begin again immediately and shall end at the latest six years after the end of the year in which it originally began, unless, in the meantime, judicial proceedings to enforce the right have begun; in this case the period shall end at the earliest one year after the judgement has acquired the authority of a final decision.

SECTION 2

COSTS

Article 81

Costs

1 The losing party in opposition proceedings, proceedings for revocation, proceedings for a declaration of invalidity or appeal proceedings shall bear the fees incurred by the other party as well as all costs, without prejudice to Article 115 (6), incurred by him essential to the proceedings, including travel and subsistence and the remuneration of an agent, adviser or advocate, within the limits of the scales set for each category of costs under the conditions laid down in the Implementing Regulation.

2 However, where each party succeeds on some and fails on other heads, or if reasons of equity so dictate, the Opposition Division, Cancellation Division or Board of Appeal shall decide a different apportionment of costs.

3 The party who terminates the proceedings by withdrawing the Community trade mark application, the opposition, the application for revocation of rights, the application for a declaration of invalidity or the appeal, or by not renewing registration of the Community trade mark or by surrendering the Community trade mark, shall bear the fees and the costs incurred by the other party as stipulated in paragraphs 1 and 2.

4 Where a case does not proceed to judgment the costs shall be at the discretion of the Opposition Division, Cancellation Division or Board of Appeal.

5 Where the parties conclude before the Opposition Division, Cancellation Division or Board of Appeal a settlement of costs differing from that provided for in the preceding paragraphs, the department concerned shall take note of that agreement.

[^{F26} The Opposition Division or Cancellation Division or Board of Appeal shall fix the amount of the costs to be paid pursuant to the preceding paragraphs when the costs to be paid are

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limited to the fees paid to the Office and the representation costs. In all other cases, the registry of the Board of Appeal or a member of the staff of the Opposition Division or Cancellation Division shall fix the amount of the costs to be reimbursed on request. The request is admissible only within two months of the date on which the decision for which an application was made for the costs to be fixed became final. The amount so determined may be reviewed by a decision of the Opposition Division or Cancellation Division or Board of Appeal on a request filed within the prescribed period.]

Textual Amendments

- F2** Substituted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

Article 82

Enforcement of decisions fixing the amount of costs

- 1 Any final decision of the Office fixing the amount of costs shall be enforceable.
- 2 Enforcement shall be governed by the rules of civil procedure in force in the State in the territory of which it is carried out. The order for its enforcement shall be appended to the decision, without other formality than verification of the authenticity of the decision, by the national authority which the Government of each Member State shall designate for this purpose and shall make known to the Office and to the Court of Justice.
- 3 When these formalities have been completed on application by the party concerned, the latter may proceed to enforcement in accordance with the national law, by bringing the matter directly before the competent authority.
- 4 Enforcement may be suspended only by a decision of the Court of Justice. However, the courts of the country concerned shall have jurisdiction over complaints that enforcement is being carried out in an irregular manner.

SECTION 3

INFORMATION OF THE PUBLIC AND OF THE OFFICIAL AUTHORITIES OF THE MEMBER STATES

Article 83

Register of Community trade marks

The Office shall keep a register to be known as the Register of Community trade marks, which shall contain those particulars the registration or inclusion of which is provided for by this Regulation or by the Implementing Regulation. The Register shall be open to public inspection.

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Article 84

Inspection of files

1 The files relating to Community trade mark applications which have not yet been published shall not be made available for inspection without the consent of the applicant.

2 Any person who can prove that the applicant for a Community trade mark has stated that after the trade mark has been registered he will invoke the rights under it against him may obtain inspection of the files prior to the publication of that application and without the consent of the applicant.

3 Subsequent to the publication of the Community trade mark application, the files relating to such application and the resulting trade mark may be inspected on request.

4 However, where the files are inspected pursuant to paragraphs 2 or 3, certain documents in the file may be withheld from inspection in accordance with the provisions of the Implementing Regulation.

Article 85

Periodical publications

The Office shall periodically publish:

- (a) a Community Trade Marks Bulletin containing entries made in the Register of Community trade marks as well as other particulars the publication of which is prescribed by this Regulation or by the Implementing Regulation;
- (b) an Official Journal containing notices and information of a general character issued by the President of the Office, as well as any other information relevant to this Regulation or its implementation.

Article 86

Administrative cooperation

Unless otherwise provided in this Regulation or in national laws, the Office and the courts or authorities of the Member States shall on request give assistance to each other by communicating information or opening files for inspection. Where the Office lays files open to inspection by courts, Public Prosecutors' Offices or central industrial property offices, the inspection shall not be subject to the restrictions laid down in Article 84.

Article 87

Exchange of publications

1 The Office and the central industrial property offices of the Member States shall despatch to each other on request and for their own use one or more copies of their respective publications free of charge.

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2 The Office may conclude agreements relating to the exchange or supply of publications.

SECTION 4

REPRESENTATION

Article 88

General principles of representation

1 Subject to the provisions of paragraph 2, no person shall be compelled to be represented before the Office.

2 Without prejudice to paragraph 3, second sentence, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the Office in accordance with Article 89 (1) in all proceedings established by this Regulation, other than in filing an application for a Community trade mark; the Implementing Regulation may permit other exceptions.

3 [^{F2}Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee.] An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community.

[^{F14} The Implementing Regulation shall specify whether and under what conditions an employee must file with the Office a signed authorisation for insertion on the file.]

Textual Amendments

- F1** Inserted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).
- F2** Substituted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

Article 89

Professional representatives

1 Representation of natural or legal persons before the Office may only be undertaken by;

- a any legal practitioner qualified in one of the Member States and having his place of business within the Community, to the extent that he is entitled, within the said State, to act as a representative in trade mark matters; or

[^{F2}b professional representatives whose names appear on the list maintained for this purpose by the Office. The Implementing Regulation shall specify whether and under what

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conditions the representatives before the Office must file with the Office a signed authorisation for insertion on the file.]

Representatives acting before the Office must file with it a signed authorization for insertion on the files, the details of which are set out in the Implementing Regulation.

2 Any natural person who fulfils the following conditions may be entered on the list of professional representatives:

- a he must be a national of one of the Member States;
- b he must have his place of business or employment in the Community;
- [^{F2}c he must be entitled to represent natural or legal persons in trade mark matters before the central industrial property office of a Member State. Where, in that State, the entitlement is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act in trade mark matters before the central industrial property office of the said State must have habitually so acted for at least five years. However, persons whose professional qualification to represent natural or legal persons in trade mark matters before the central industrial property office of one of the Member States is officially recognized in accordance with the regulations laid down by such State shall not be subject to the condition of having exercised the profession.]

3 Entry shall be effected upon request, accompanied by a certificate furnished by the central industrial property office of the Member State concerned, which must indicate that the conditions laid down in paragraph 2 are fulfilled.

4 The President of the Office may grant exemption from:

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

5 The conditions under which a person may be removed from the list of professional representatives shall be laid down in the Implementing Regulation.

Textual Amendments

- F2** Substituted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

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