



How to **avoid errors** when filing documents in inter partes proceedings

Expectations vs Reality



+800

Expectations **vs** Reality

Deficiencies cause:

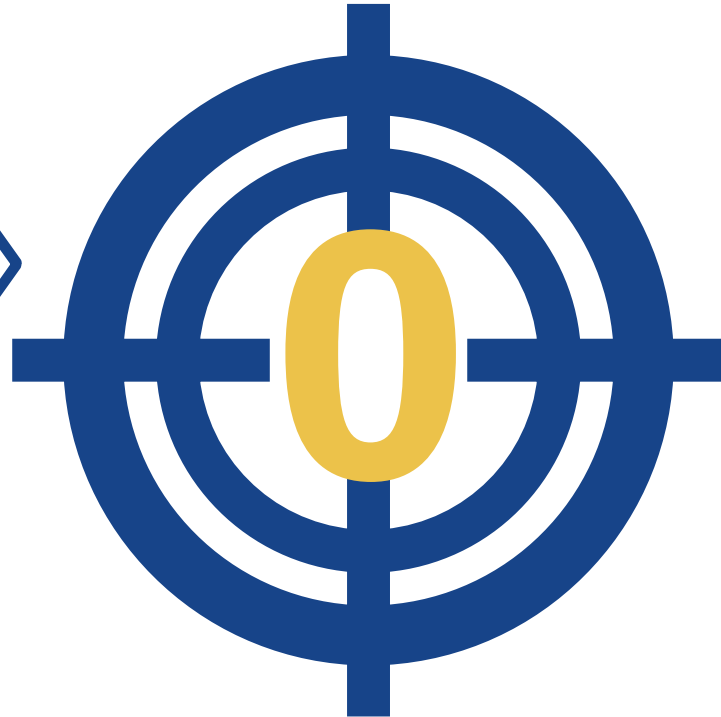
Loss of time

Stress

Refusal



Expectations vs Reality



PROGRAMME

50'
Presentation

- Data carriers
- Annexes on Data Carriers
- Encrypted files
- Confidentiality
- Art. 55 EUTMDR - index and how to put it
- Non static PDFs
- Decision on costs
- Additional sources of practical information

10'
Questions and answers

1

Data Carriers

Data Carriers



DECISION No EX-20-10 of the Executive Director of the Office of 22 December 2020 on technical specifications for annexes submitted on data carriers



Enter into force on **1 March 2021**

Data Carriers



NOT ACCEPTED

Data Carriers



ACCEPTED

Data Carriers - Art. 64(2) EUTMDR

Where a communication with annexes is submitted in accordance with Article 63(1)(b) by a party to proceedings involving more than one party, the party shall submit **as many copies** of the annexes **as there are parties** to the proceedings.



2 Annexes on Data Carriers

Annexes on Data Carriers – Graphic representations



Annexes on Data Carriers – Graphic representations



Annexes on Data Carriers – Sound and video



Annexes on Data Carriers - Others



3 Encrypted files

Not ACCEPTED

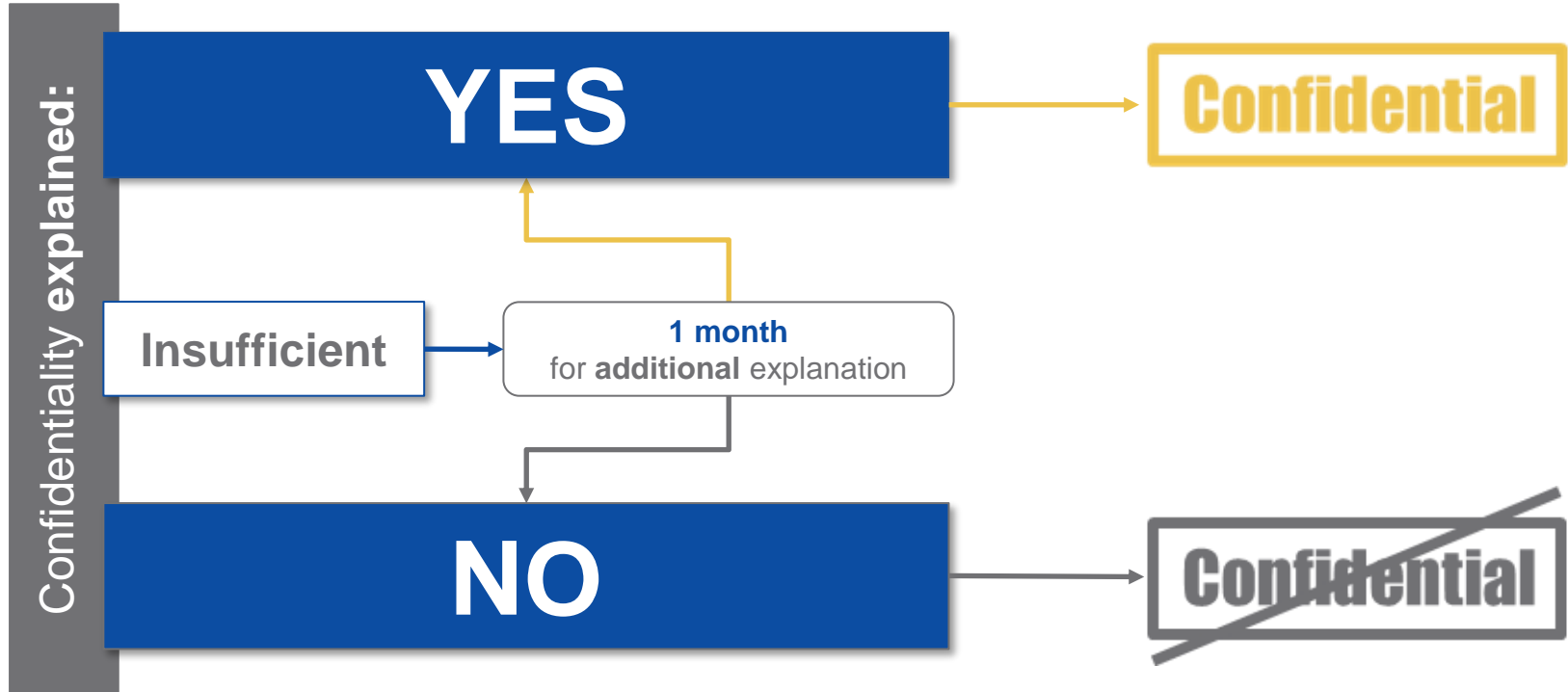
No deficiencies sent

4 Confidentiality

Confidentiality - 114(4) EUTMR

(...) parts of the file which the party concerned **showed a special interest** in keeping confidential before the request for inspection of the files was made, unless inspection of such parts of the file is justified by overriding, legitimate interests of the party seeking inspection, may be withheld from inspection.

Confidentiality – Explanation



Confidentiality - Request

Confidential Request

I hereby submit facts, evidence and arguments in support of the opposition.

Request details

eo.fg.am.pm.lp.12

Documents (FFEA) in support of the opposition

Attachment 1	Part 1.pdf (132 pages) *Confidential*
Attachment 2	Part 2.pdf (29 pages) *Confidential*
Attachment 3	Part 3.pdf (64 pages) *Confidential*
Attachment 4	Part 4.pdf (49 pages) *Confidential*

Confidentiality – 5 tips



Be specific

Make reference to documents filed

Do not repeat art 114(4) EUTMR only

Request confidentiality only when needed

Reply to deficiency within **1 month**

5

Art. 55 EUTMDR - Index and how to put it

Art 55(2) EUTMDR - How to put it?

The documents or other items of evidence shall be contained in annexes to a submission which shall be **numbered consecutively**.

Art 55(2) EUTMDR - How to put it?

The submission shall include an index indicating, for each document or item of evidence annexed:

- (a) the **number of the annex**;
- (b) a **short description** of the document or item and, if applicable, the **number of pages**;
- (c) the **page number** of the submission where the document or item is mentioned.

Art 55(2) EUTMDR - How to put it?

The submitting party may also indicate, in the index of annexes, **which specific parts** of a document it relies upon in support of its arguments.

Art 55(2) EUTMDR – When it applies?

Proof of use

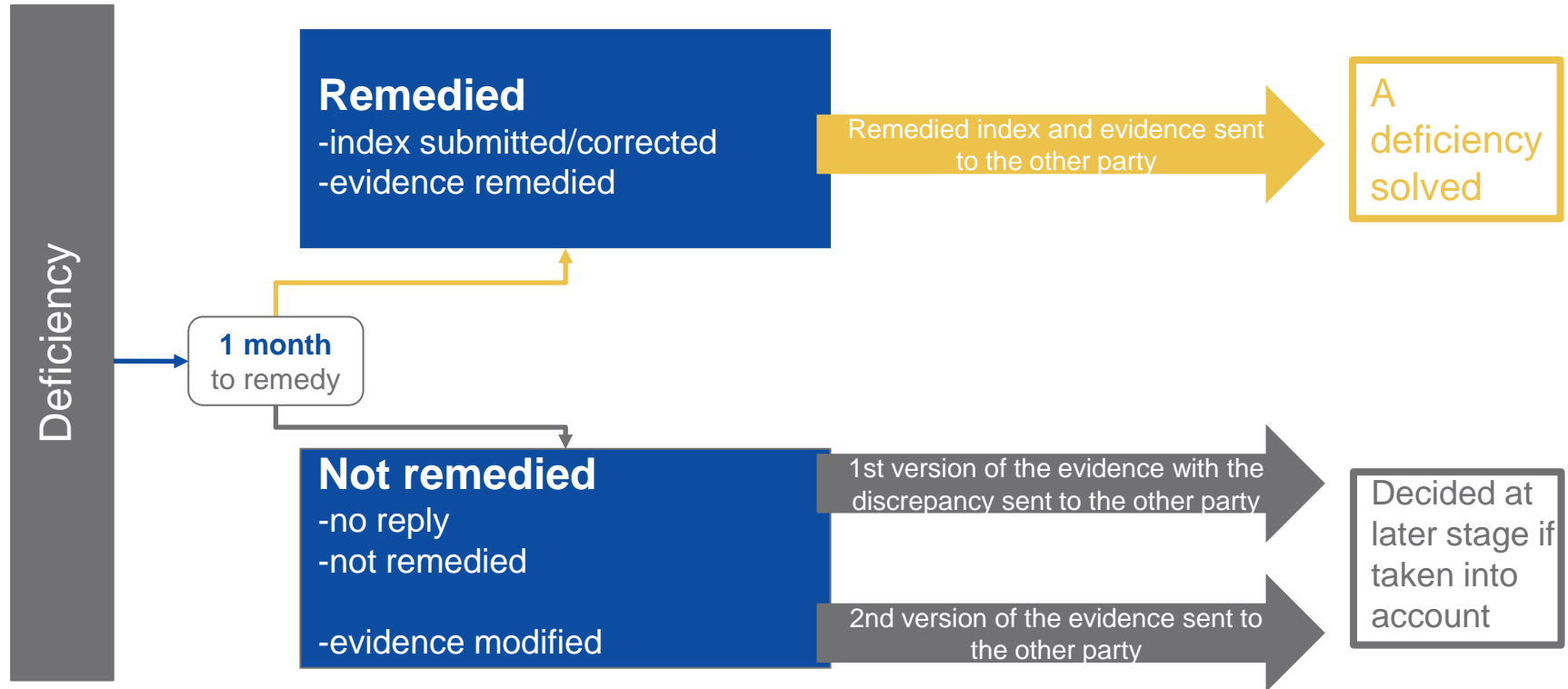
Further facts, evidence and arguments

Applicant's observations

Notice of opposition

...

Art 55(4) EUTMDR – How do we work?



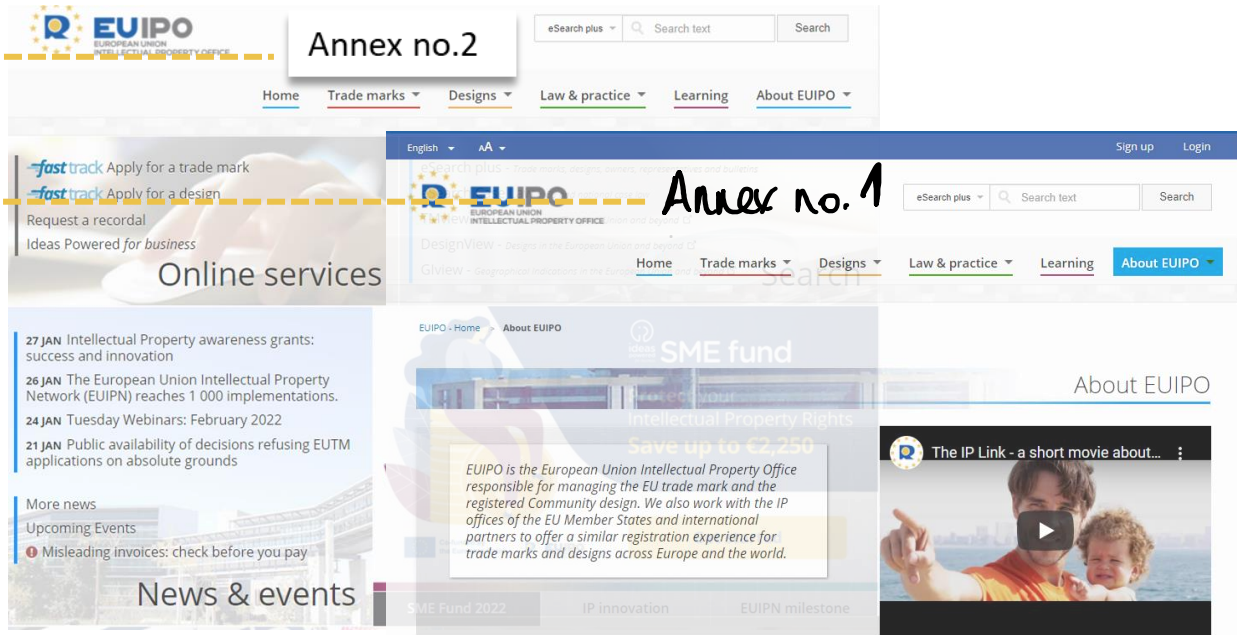
Art 55(2) EUTMDR – Model index

MODEL INDEX			
Documents and items submitted physically, electronically or using a data carrier			
Annex No	Description of the Annex ⁽¹⁾	No of pages ⁽²⁾	Page number (of the submission in question) where the document or item is mentioned
1.	Letter of 10/12/2017, from Mr Green to Ms Smith	3	p. 2
2.	25 invoices, Jan. 2017–Jun. 2018, NewCo Ltd	60	pp. 7-11, 13, 14
3.	40 invoices, Jan. 2016–Jun. 2018, ABC Ltd	50	pp. 15-17
4.	Affidavit of 24/08/2018, from Ms Green, CEO of NewCo Ltd	1	pp. 17-211, 23, 24
5.	Article by Dr Blue published 12/12/2017 in GO magazine 4/2017: <i>Confusing brand X with Y</i> , addressing the inherent distinctiveness of brand X on p. 12 ⁽³⁾	23	pp. 30, 32
6.	Printout of 01/01/2019 of webpage www.webpage1.com	5	p. 41
7.	Video showing (at running time 00:07:42) use of EUTM X No 123 456 789 at the <i>Exhibition of Consumer Products 2018</i> (file 'vid1.mp4' submitted on a USB flash drive)	n/a	p. 45

Recommended

Art 55(2) EUTMDR – Annexes numbered consecutively

Number of the annex inserted or handwritten on the page

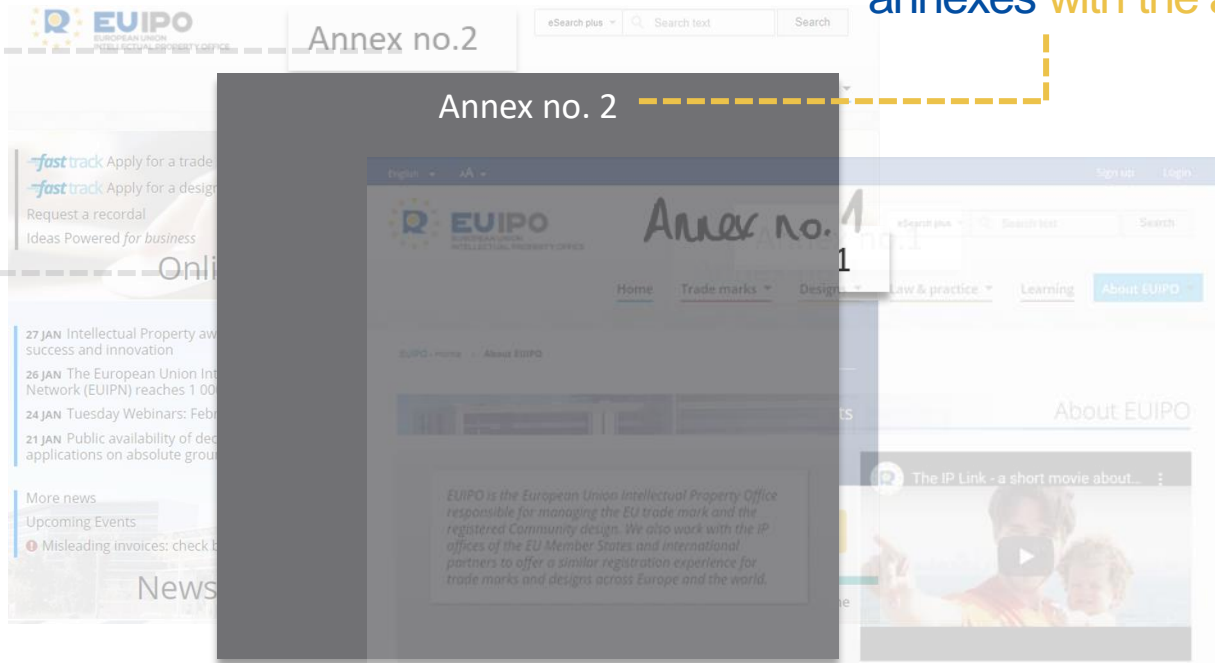


The screenshot displays the EUIPO website interface. At the top left is the EUIPO logo. A search bar is located at the top right. The main navigation menu includes 'Home', 'Trade marks', 'Designs', 'Law & practice', 'Learning', and 'About EUIPO'. Below the navigation, there are sections for 'Online services' (with 'fast track' options for trade marks and designs), 'News & events' (with a list of recent news items), and 'SME fund' (with a 'Save up to €2,250' offer). A video player for 'The IP Link - a short movie about...' is visible at the bottom right. Two annotations are present: a white box labeled 'Annex no.2' pointing to the 'Designs' menu item, and a handwritten black label 'Annex no. 1' pointing to the 'DesignView' link in the 'Designs' dropdown menu.

Art 55(2) EUTMDR – Annexes numbered consecutively

Number of the annex inserted or handwritten on the page

Separate sheet inserted between the annexes with the annex No.




6

Non static PDFs

Non static PDFs

24.4.2018 EN Official Journal of the European Union Annex 1 L 104/1

II
(Non-legislative acts)

REGULATIONS 

COMMISSION DELEGATED REGULATION (EU) 2018/625
of 5 March 2018

supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430





THE EUROPEAN COMMISSION, **APPROVED**

Having regard to the Treaty on the Functioning of the European Union, *Arkadiusz Makar*

Having regard to Regulation (EU) 2017/1001 of the European Parliament and [redacted] on the European Union trade mark (1), and in particular Article 48, Article 49(3), Article 65, Article 73, Article 96(4), Article 97(6), Article 98(5), Article 100(2), [redacted] Article 106(3), Article 121, Article 168, Article 194(3) and Article 196(4) thereof,

4 comments

PAGE 1 4

-  **MAKARAR** 16:58
Main legal act regarding trade marks in EU
-  **MAKARAR** 16:57
Applied Stamp
-  **MAKARAR** 16:55
Highlighted Text
-  **MAKARAR** 16:59
Pencil

Non static PDFs - Consequences

Formatting lost when documents forwarded by eComm

Formatting not shown in eSearch

2 different versions of the same document

Confidential text and data revealed

Electronic signatures are lost

Make PDF static – Practice tip

Webinar_clean.pdf - Adobe Acrobat Reader DC (32-bit)

File

- Open... Ctrl+O
- Reopen PDFs from last session
- Save Ctrl+S
- Save As... Shift+Ctrl+S
- Save as Other ▶
- Share File
- Revert
- Close File Ctrl+W
- Properties... Ctrl+D
- Print...** Ctrl+P

Webinar_clean.pdf x

1 / 36

acts)

IONS

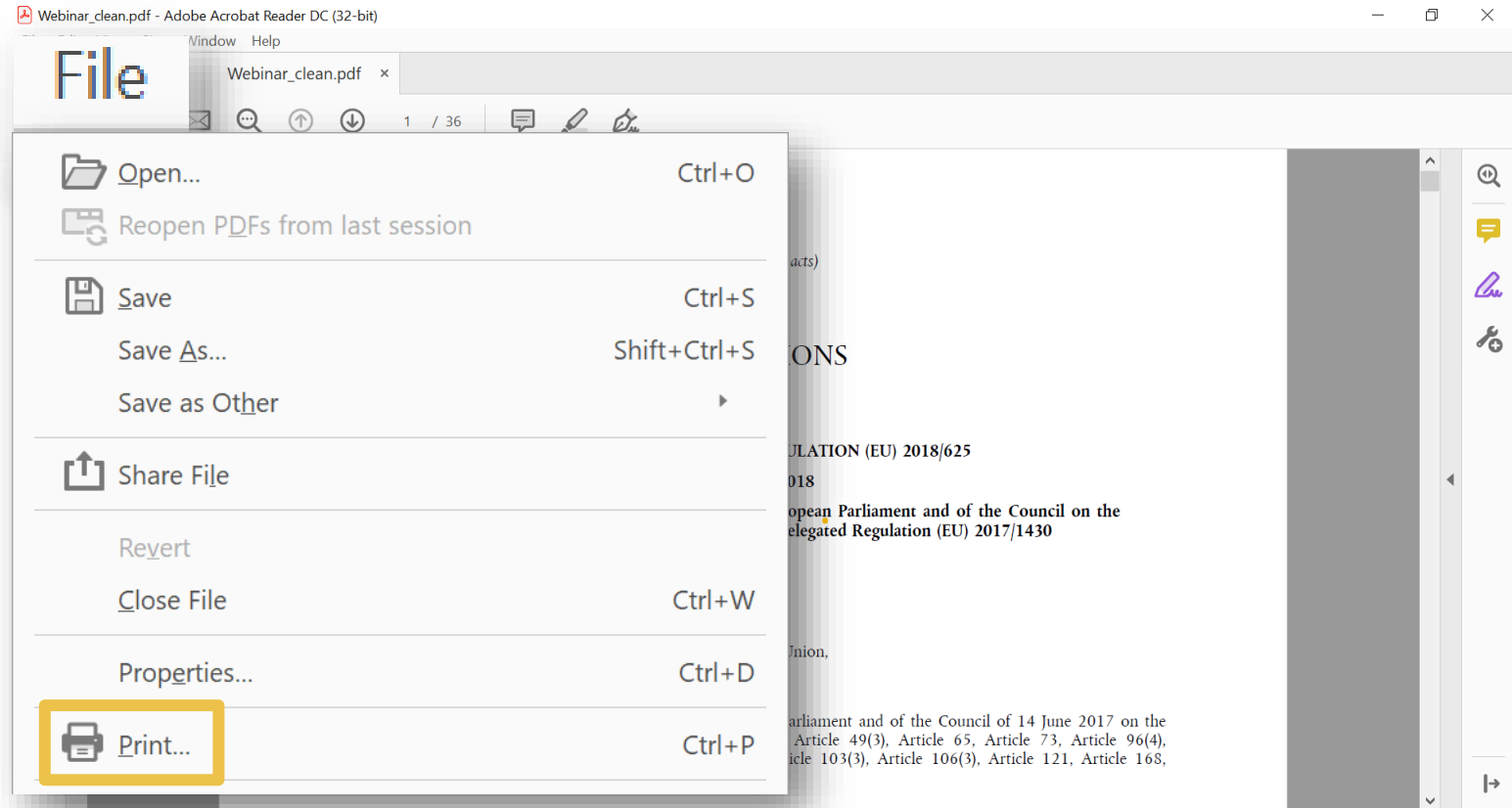
ULATION (EU) 2018/625

018

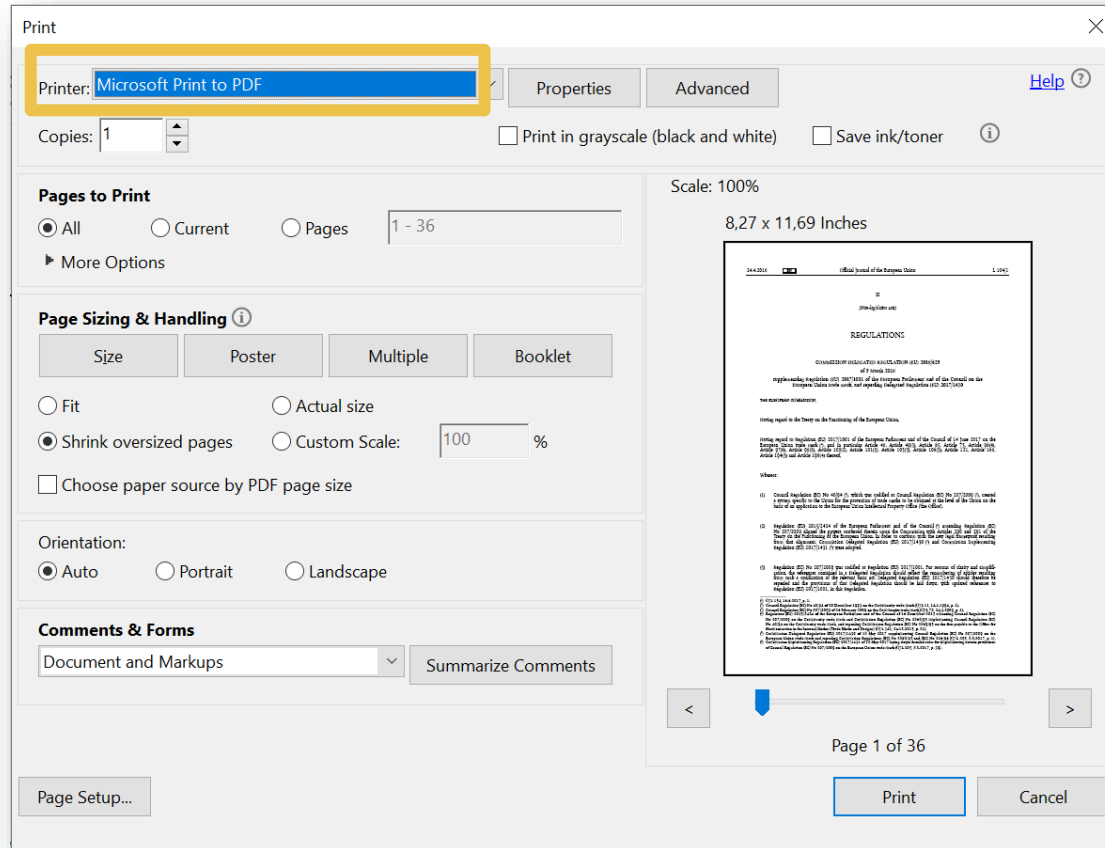
European Parliament and of the Council on the
delegated Regulation (EU) 2017/1430

Union,

Parliament and of the Council of 14 June 2017 on the
Article 49(3), Article 65, Article 73, Article 96(4),
Article 103(3), Article 106(3), Article 121, Article 168,



Make PDF static – Practice tip



Print

Printer: **Microsoft Print to PDF** Properties Advanced Help ?

Copies: 1 Print in grayscale (black and white) Save ink/toner ⓘ

Pages to Print

All Current Pages 1 - 36

▶ More Options

Page Sizing & Handling ⓘ

Size Poster Multiple Booklet

Fit Actual size

Shrink oversized pages Custom Scale: 100 %

Choose paper source by PDF page size

Orientation:

Auto Portrait Landscape

Comments & Forms

Document and Markups Summarize Comments

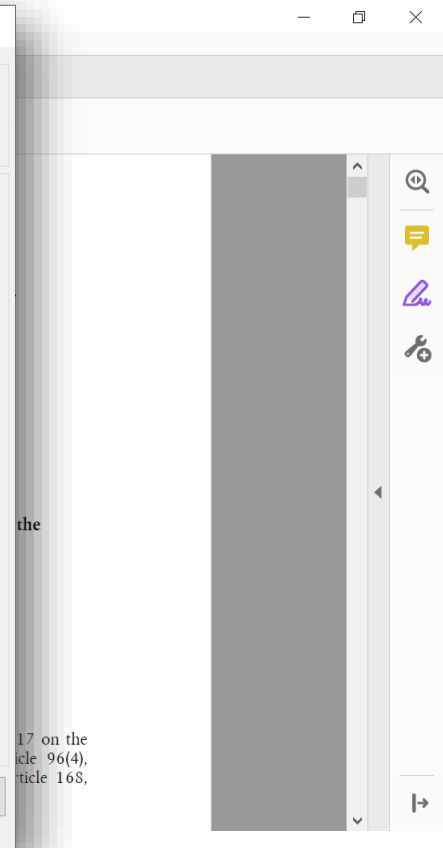
Page Setup...

Scale: 100%

8,27 x 11,69 Inches


Page 1 of 36

Print Cancel



the

17 on the
icle 96(4),
article 168,



7 Decision on costs

Decision on costs



Decision on costs

Request

I hereby request the EUIPO to withdraw the above referenced opposition (after the commencement of the adversarial part of the proceedings).

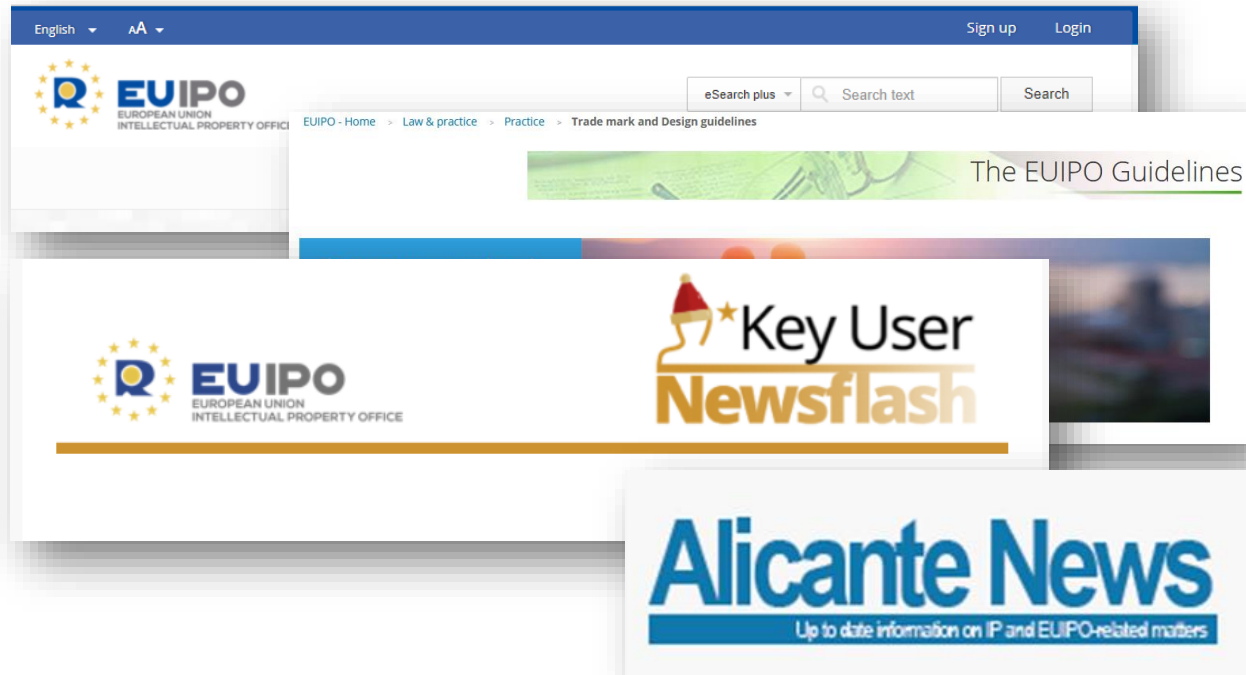
Request details

Decision on costs requested


+ AGREEMENT/CONFIRMATION

8 Additional sources of practical information

Sources




English ▾ AA ▾ Sign up Login


 **EUIPO**
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

eSearch plus ▾

[EUIPO - Home](#) > [Law & practice](#) > [Practice](#) > [Trade mark and Design guidelines](#)

The EUIPO Guidelines

 **EUIPO**
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

 **Key User
Newsflash**

Alicante News
Up to date information on IP and EUIPO-related matters

Expectations vs Reality



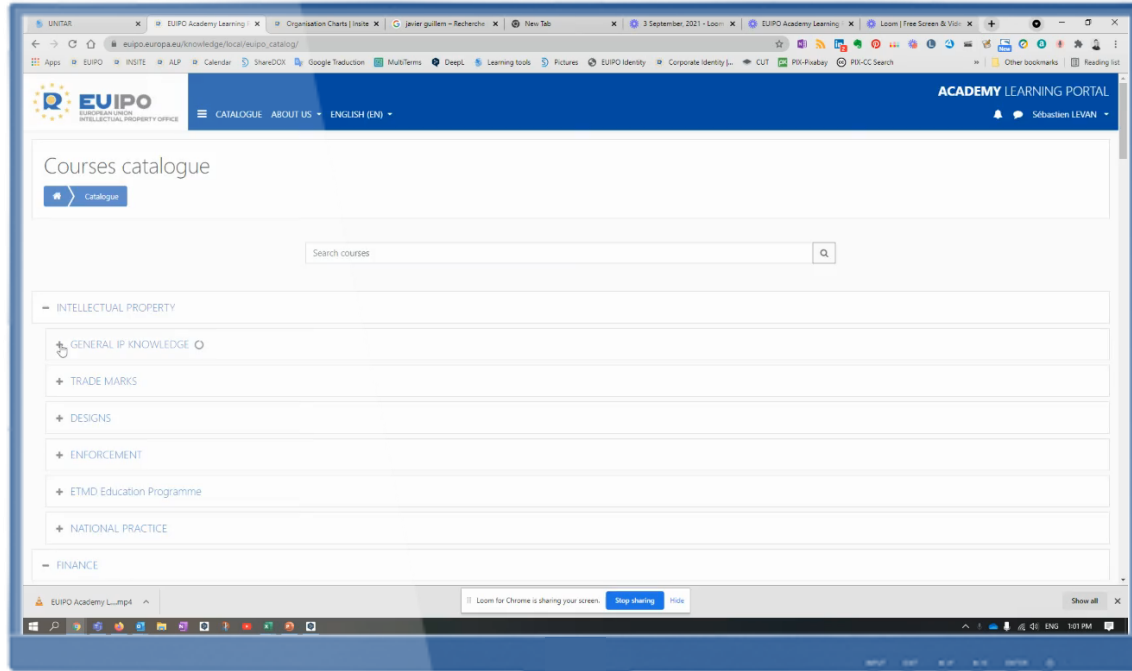
Avoiding errors causes:

Time gains

Less stress

Success

Keep in touch with EUIPO Academy



Speaker presentation

2 speakers from EUIPO



Arkadiusz MAKAR
Operations Department

Stanislava STOYANOVA-ATANASOVA
Operations Department

