

DECISION No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means

The Executive Director of the European Union Intellectual Property Office (the Office),

Having regard to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark ⁽¹⁾ (EUTMR) and in particular Article 157(4)(a) thereof, pursuant to which the Executive Director must take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the Office,

Having regard to 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 ⁽²⁾,

Having regard to Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431 ⁽³⁾,

Having regard to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, as amended ⁽⁴⁾ (CDR), and in particular Article 100 thereof, concerning the supplementary powers of the Executive Director, and to Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing the Council Regulation, as amended ⁽⁵⁾, (CDIR),

Having regard to Regulation (EU) 2018/1725 of the European Parliament and of the Council of 23 October 2018 on the protection of natural persons with regard to the processing of personal data by the Union institutions, bodies, offices and agencies and on the free movement of such data, and repealing Regulation (EC) No 45/2001 and Decision No 1247/2002/EC ⁽⁶⁾,

Whereas:

- (1) Pursuant to Article 98(3) EUTMR and Article 57 EUTMDR, notifications by the Office may be effected by different means, including by electronic means. Notification by electronic means covers transmissions by wire, by radio, by optical means or by other electromagnetic means, including the internet. The Executive

⁽¹⁾ OJ L 154, 16.6.2017, p. 1.

⁽²⁾ OJ L 104, 24.4.2018, p. 1.

⁽³⁾ OJ L 104, 24.4.2018, p. 37.

⁽⁴⁾ OJ L 386, 29.12.2006, p. 14.

⁽⁵⁾ OJ L 193, 25.7.2007, p. 13.

⁽⁶⁾ OJ L 295, 21.11.2018, p. 39-98.

Director will determine the details regarding the specific electronic means to be used, the manner in which electronic means will be used, and the time limit for notification by electronic means.

- (2) Pursuant to Article 51 CDIR, details of fax transmissions and of notifications by other technical means will be determined by the Executive Director.
- (3) Pursuant to Article 100(1) EUTMR and Article 63(1)(a) EUTMDR, applications for the registration of an EU trade mark as well as any other application provided for in the EUTMR and all other communications addressed to the Office may be submitted by electronic means. The Executive Director will determine to what extent and under which technical conditions those communications may be submitted electronically.
- (4) Pursuant to Article 67(1) and (2) CDIR, applications for registration of a Community design may be submitted by electronic means, including the representation of the design. The conditions for filing applications for registration of a Community design by electronic means and the requirements for communication by electronic means, such as the equipment to be used, technical details of communication, and methods of identifying the sender will be determined by the Executive Director.
- (5) Pursuant to Article 114(5) EUTMR and Article 74 CDIR, inspection of the files of EU trade mark applications, of registered EU trade marks and of registered Community designs, will include technical means of storage if the files are stored in this way. The Executive Director will determine the means of inspection.
- (6) Pursuant to Article 31(3) EUTMR and Article 3(5) EUTMIR, where the representation of an EUTM application is provided electronically, the Executive Director will determine the formats and size of the electronic file as well as any other relevant technical specifications.
- (7) Pursuant to Article 67(1) CDR and Article 4(1)(d) CDIR, where the representation of an RCD application is filed by electronic means, the Executive Director will determine the formats of the electronic file as well as the manner of identifying the different designs contained in a multiple application, or the different views.
- (8) In recent times, communications by fax have experienced repeated failures and malfunctions, due to the unforeseeable limitations of the relevant technologies and infrastructures that lie beyond the Office's control. These disruptions show that fax has proven to no longer be a smooth, effective and efficient means of communication. Considering the risk of the Office's users not being able to effectively submit communications via fax, and the potentially severe consequences that come with it – such as missing deadlines and the delay of proceedings – fax as a means of communication before the Office can no longer be offered as a matter of due diligence.
- (9) To address the above issues affecting communications by fax, it is necessary to review the framework that applies to the accepted means of electronic communication with the Office in procedures relating to EU trade marks and Community designs.
- (10) Technical details and requirements may undergo frequent changes in order to facilitate use of the systems and such changes need not be reflected in this decision, but will be made available on the Office's website in a separate document on conditions of use,

HAS ADOPTED THE FOLLOWING DECISION:

Article 1

Means of electronic communication

- (1) The accepted means of electronic communication with the Office in procedures relating to EU trade marks is a secure electronic communications platform maintained by the Office that enables account holders to submit applications and other documents, receive notifications and documents sent by the Office, reply to such notifications and perform other actions (User Area);
- (2) In procedures relating to the registration of Community designs, the User Area is the accepted other technical means of communication with the Office, within the meaning of Article 51(2) CDIR.

Article 2

No fax service

- (1) Due to technical limitations and malfunctions affecting the reliability and preventing the uninterrupted functioning of communications by fax (and that lie beyond the Office's control), fax can no longer be offered and will no longer be used, as a means of communication in procedures before the Office.
- (2) The Office's official fax numbers, identified in Annex I of the Decision of the Executive Director No EX-19-1, will be disabled on the date of entry into force of the present decision.

Article 3

User account

- (1) The User Area can be accessed via a personal account (user account) by registering on the Office's website. An account holder may register for sub-accounts that are dependent on an existing user account. The user account and its dependent sub-accounts shall only be used directly by the registered account holder or by other members of the account holder's organisation who operate under the registered account holder's direct control, responsibility and supervision.
- (2) The account holder is responsible for the proper use and maintenance of confidentiality as regards their account, passwords, the administrative email account associated with the user account and, where appropriate, corresponding sub-accounts. The account holder must not inform anybody of their credentials for accessing the User Area.
- (3) Account holders can request the deactivation of their user account at any time. The account will be deactivated as soon as technically possible.
- (4) The Office may deactivate a user account where it is unused for a period of 3 years. The user account can be reactivated on request.

Article 4

Communication by the Office through the User Area

- (1) The User Area is the sole platform through which the Office will issue notifications by electronic means, and account holders may not opt out of this means of receiving electronic communications from the Office as long as the User Area account remains active. This applies equally to new and existing user account holders, including those that may have previously opted out under the former rules as set out in Article 3(1) of the Decision of the Executive Director No EX-19-1.
- (2) As from the date of entry into force of this decision, if a recipient of a communication or notification from the Office has a User Area account, the Office will send all notifications through the User Area by electronic means, unless this is impossible for technical reasons, in which case notification shall be by post or courier pursuant to Article 58 EUTMDR and Article 48 CDIR.
- (3) Additionally, account holders have the option of receiving an alert for each notification sent to them through the User Area. This alert only serves to inform the account holder that a document has been placed in their inbox and does not constitute a notification. Failure or an error in the alert shall not be the Office's responsibility and shall not affect the date of notification or the calculation of the relevant time limits.
- (4) The date on which the document is placed in an account holder's inbox will be recorded by the Office and mentioned in the User Area.
- (5) Notification will be deemed to have taken place on the fifth calendar day following the day on which the Office placed the document in the user's inbox.

Article 5

Communication with the Office through the User Area

- (1) Account holders can submit applications, communications and other documents to the Office and reply to notifications received from the Office electronically through the User Area.
- (2) When submitting an EU trade mark application through the User Area, the list of goods and services applied for must be entered solely in the field provided for that purpose. If the goods and services applied for are not entered solely in the field provided for that purpose, instead being submitted in a separate document as an annex or being filed subsequently, the application will not be considered as an application filed by electronic means and the corresponding fee for applications not filed by electronic means will apply.
- (3) The contents of applications, communications and other documents submitted electronically will be imported into the Office's database upon receipt. These electronic documents constitute part of the file and can be subject to inspection. Online inspection of files can only be carried out through the User Area.
- (4) Once an application, communication or other document submitted via the User Area has been received by the Office's electronic data processing system, an electronic receipt will be issued, which may be in the form of (i) a confirmation screen on the account holder's device, (ii) a communication via the User Area, where available, or (iii) another form of receipt as specified in the conditions of use.

The time an electronic document was submitted is to be considered the time that the electronic receipt was issued by the Office's system.

Article 6

Back-up in cases of malfunction

- (1) In the event of a malfunction during the electronic transmission of an application, communication or other document through the specific e-operation or e-filing tool in the User Area, the transmission must be resubmitted using one of the other accepted means of communication or the back-up solutions provided for in paragraph (2). The relevant time limits are not affected.
- (2) In order to facilitate resubmission, the Office will make two electronic back-up alternatives available:
 - i) an upload solution, which is located in the Communications section of the User Area; this is a general upload platform that allows documents to be attached and sent to the Office.
 - ii) a file-sharing solution, outside the User Area; the Office will provide the account holder with access to a secure file-sharing location where the document(s) in question can be uploaded.

Technical details on the accessibility and functionality of both back-up alternatives are available in the 'Conditions of Use of the User Area'.

- (3) Submissions made through either of the two back-up solutions identified in paragraph (2) will be deemed to have been made on the date the relevant application, communication or other document are uploaded to the relevant platform. However, in the case of applications for the registration or renewal of EUTMs and RCDs, that filing date can be secured only if:
 - (a) the applicant resubmits, within three working days, the application for registration of an EUTM or an RCD with the same content through the Office's EUTM or RCD e-filing form accessible through the User Area; failure to comply with this requirement will result in the original submission being deemed as not having been received;
 - (b) the owner/holder submits the application for renewal of an EUTM or RCD through either of the two back-up solutions within the last three working days before the expiry of the initial or extended statutory time limit for renewal; any submission for a renewal of an EUTM or RCD through either of the two back-up solutions outside the respective three-working-day period will be deemed not to have been received.

Article 7

Conditions of Use of the User Area

- (1) The electronic tools available through the User Area, the conditions of their use and the technical conditions of electronic communication with and by the Office are set out in Annex I to this decision, namely the 'Conditions of Use of the User Area'.
- (2) Only applications, communications or other documents submitted electronically that comply with these conditions will be accepted.

- (3) Non-compliance with these conditions may also entail further sanctions as provided for in the present Decision.

Article 8

Technical requirements of the representation of an EUTM application

- (1) Where the representation of an EUTM application is provided electronically, the size of the electronic file is the following:

- maximum size per attachment: 2 MB (20 MB for MP4, OBJ, STL and X3D);
- maximum total size of attachments: 20 MB;
- name length restriction for attachment files: 25 characters.

- (2) Where the representation of an EUTM application is provided electronically, the formats of the electronic file are the following:

(a) JPEG

This is the standard file format to be used for representing the mark applied for (available for all trade mark types except for word and multimedia marks), and should conform to the following standards:

- maximum image size: 2835 x 2010 pixels;
- printing resolution: min 96, max 300 DPI;
- colour mode: RGB, Grayscale, BW or CMYK.

Images are automatically scaled to 250 x 250 pixels. The uploaded image will be displayed as it will appear later in the registration certificate.

CMYK images will be converted before being displayed into RGB images using specific software for the conversion. In some CMYK images converted to RGB, certain colours might look different from the original. Therefore, it is advisable to change the colour mode before uploading the image in order to keep its original colours.

(b) MP3:

This file format can be used when applying for the registration of a sound mark (together with JPEG), and should conform to the following requirements:

- sampling rate: 8 kHz for voice only, 11.025 kHz for sound effects, 22.05 kHz or 44.1 kHz for music;
- bit depth: 8 or 16 bits;
- channels: 1=Mono; 2=Stereo.

(c) OBJ, STL and X3D:

These file formats can be used when applying for the registration of a shape mark.

X3D cannot be uploaded using Internet Explorer under version 11.

(d) MP4:

This file format can be used when applying for the registration of motion, multimedia and hologram marks, and should conform to the following requirements:

- ISO standard: ISO/IEC 14496-14:2003 (MPEG-4 Part 14);
- video codecs: MP4 accepts different video codecs (MPEG-1, MPEG-2, MPEG-4, VP6, VP5, H.263, etc), but the recommended codec to use is H.264;
- audio codecs: MP4 accepts different audio codecs (MP3, MP2, WMA, WMA Pro, PCM, WAV) but the recommended codec to use is AAC-LC;
- frame rate between 24 and 30 fps;
- a bit rate between 1 200 and 8 000 Kbps;
- media types: video/MP4, audio/MP4, application/MP4.

Article 9

Technical requirements of the representation of an RCD application

- (1) Where the representation of an RCD application is provided electronically, the size of the electronic file is the following:
 - maximum size per attachment: 2 MB (20 MB for OBJ, STL and X3D);
 - maximum total size of attachments: 20 MB;
 - name length restriction for attachment files: 25 characters.
- (2) Where the representation of an RCD application is provided electronically, the formats of the electronic file are the following:

(a) JPEG

This is the standard file format to be used for representing the design applied for, and should conform to the following standards:

- maximum image size: 5000 x 5000 pixels;
- printing resolution: min 72, max 300 DPI;
- colour modes: CMYK (which will be converted to RGB), Grayscale, BW or RGB;
- JPEG progressive images will be converted to baseline images;
- uploading of 3D dynamic views AND other static views is restricted.

(b) OBJ, STL and X3D

These formats can be used to upload one 3D dynamic view for additional information and as a source for static images when registering designs.

X3D cannot be uploaded using Internet Explorer under version 11.

Article 10

Repeal

Decision No EX-19-1 of the Executive Director of the Office of 18 January 2020 concerning communication by electronic means, is repealed as from the date of entry into force of the present decision.

Article 11
Entry into force

This Decision will enter into force on **1 March 2021** and will be published in the Official Journal of the Office.

Done at Alicante, 3 November 2020



Christian Archambeau
Executive Director

Annex I – Conditions of Use of the User Area