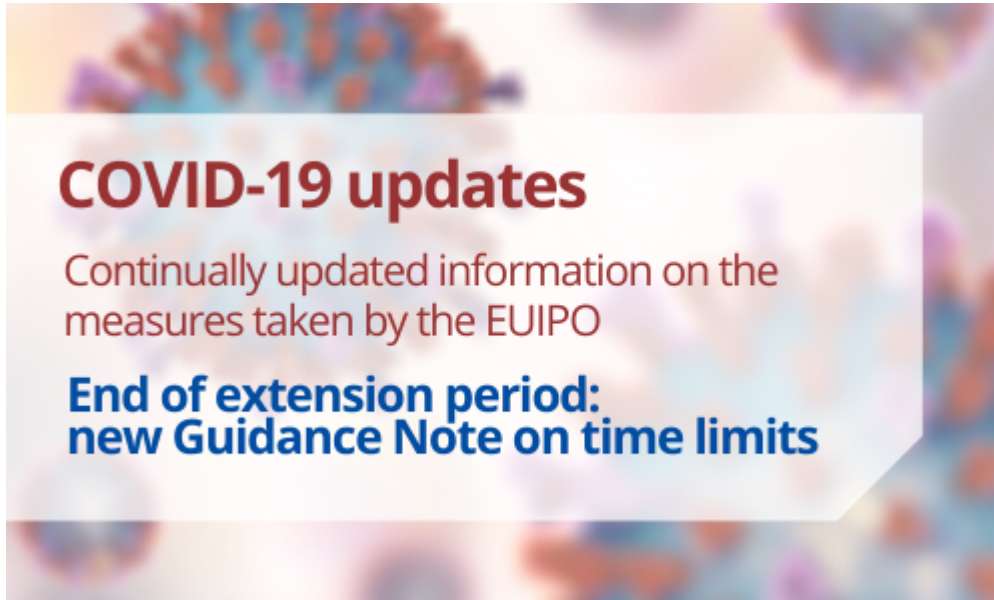


# COVID-19 – Guidance Note on time limits after end of extension period

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As a response to the exceptional circumstances created by the COVID-19 outbreak, the Executive Director of the EUIPO issued [Decision No EX-20-3](#) and the consequent [Decision No EX-20-4](#), both of which concern extension of time limits in proceedings before the Office.

As of 18 May 2020, those extensions come to an end. It is possible that some users may still face difficulties due to the COVID-19 outbreak. To provide them with further guidance on the usual means of dealing with time limits provided for in the applicable Regulations (EUTMR, EUTMDR, EUTMIR, CDR, CDIR), the following clarifications are issued.

## **AVAILABLE REMEDIES**

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. Compliance with them is necessary to ensure clarity and legal certainty. The procedural instruments listed below mitigate the rigorous application of the principle of strict observance of time limits and are available upon request by the parties of proceedings before the Office.

### **I. EXTENSION OF TIME LIMITS (Article 68 EUTMDR and Article 57 CDIR)**

The time limits laid down directly by the Regulations are mandatory and cannot be extended at the request of the parties (although for some exceptions to this rule, please see section IV *Restitutio In Integrum* below). However, time limits determined by the Office in ongoing proceedings can be extended under certain circumstances. Upon receipt of a reasoned request, the

Office may grant an extension of a time limit it has set. The request must be submitted by a party to the proceedings and before the time limit in question expires. An extension can be granted in:

- **ex parte proceedings** (i.e. where one party is involved, such as in the examination of the classification or absolute grounds for refusal of a European Union trade mark application). An extension may be granted upon request of the party, depending on the circumstances of the case. The extension cannot exceed six months for any given request. The first request for an extension will be considered appropriate without a detailed justification. However, this does not prevent parties from asking for an additional extension if exceptional circumstances warrant it.
- **inter partes proceedings** (i.e. where there are two or more parties involved, such as in opposition, invalidity and revocation proceedings). In these types of proceedings the first request for an extension will be considered appropriate without a detailed justification and will be granted for a period one to up to six months. Second and subsequent extensions of the same time limit, for a period of up to six months for each extension, can be granted if the party requesting it can explain the presence of exceptional circumstances that prevent it from observing the time limit. The Office may subject the extension of a time limit to the agreement of the other party.

Difficulties arising from measures taken by public authorities against the pandemic caused by the COVID-19 outbreak or instances of sickness of the party or its representative for the same reason do constitute exceptional circumstances that will be considered appropriate by the Office for granting second and subsequent extensions of the same time limit.

## **II. SUSPENSION OF PROCEEDINGS (Article 71 EUTMDR)**

Where *inter partes* proceedings have been suspended, the proceedings are stayed, and no procedural steps are taken (except, where applicable, for the payment of fees). A suspension can be granted:

- **At the reasoned request of one of the parties**, where the suspension is appropriate under the circumstances of the case. Before granting the suspension, the Office will take into account the interest of all the parties and the stage of the proceedings.
- **By joint request of the parties in:**
  - **Trade mark proceedings**, for periods which will not exceed six months. That suspension may be extended upon a request of both parties up to a total maximum of two years.
  - **Design invalidity proceedings**, for periods of six months regardless of the period requested by the parties.

Furthermore, difficulties arising from measures taken by public authorities against the pandemic or instances of sickness of the party or its

representative may constitute appropriate circumstances for requesting a suspension. In addition, financial difficulties preventing the party from obtaining or securing continued professional representation before the Office (within the meaning of Articles 119 and 120 EUTMR, and Articles 77 and 78 CDR) that are caused by the pandemic situation may also constitute a proper reason for granting a suspension.

### III. CONTINUATION OF PROCEEDINGS (Article 105 EUTMR)

Any party in **trade mark proceedings** before the Office that has **missed a time limit** can seek continuation of proceedings, even without giving an explanation or justification. This is however not available in design proceedings. In order to exercise the right to continuation of proceedings, the party must:

- submit a **request within two months** of the expiry of the unobserved time limit;
- carry out **the omitted act** by the time the request is made; and
- pay a **fee of (EUR 400)**.

Once a request for continuation of proceedings has been granted, the time limit is deemed to be observed and the consequences of having failed to meet the time limit will be deemed not to have occurred.

Continuation of proceedings may be requested, for instance, for all the time limits in opposition proceedings, other than the ones for filing an opposition and paying the applicable fee, such as the time limits under Article 146(7) EUTMR to translate the notice of opposition and under Article 10(2) EUTMDR for submitting proof of use, as well as all the time limits that apply in proceedings for revocation or declaration of invalidity.

Continuation of proceedings is not applicable to certain time limits, specified in Article 105(2) EUTMR, namely:

- the time limits for requesting *restitutio in integrum* and paying the fee (Article 104 EUTMR) and the time limits for continuation of proceedings itself (Article 105(1) EUTMR);
- the period of three months within which conversion must be requested and the conversion fee paid (Article 139 EUTMR);
- the time limit for filing an opposition and paying the fee (Article 46(1) and (3) EUTMR);
- the time limits laid down in Article 32 EUTMR (payment of the application fee), Article 34(1) EUTMR (right of priority), Article 38(1) EUTMR (right of exhibition priority), Article 41(2) EUTMR (period to remedy filing deficiencies), Article 53(3) EUTMR (period for renewal), Article 68 EUTMR (appeal) and Article 72(5) EUTMR (appeal before the Court of Justice); and

- the time limits for claiming, after the application has been filed, seniority within the meaning of Article 39 EUTMR.

#### **IV. RESTITUTIO IN INTEGRUM (Article 104 EUTMR and Article 67 CDR)**

The remedy of reinstatement of rights, also called *restitutio in integrum*, allows a party to proceedings before the Office to be reinstated in its rights, when:

- it has **missed a time limit** to perform a procedural act;
- the time limit was missed despite it **taking all due care** required by the circumstances; and
- the non-observance (of the time limit) by the party has the direct consequence of causing the **loss of a right or means of redress**.

In order to exercise the right to *restitutio in integrum*, the party must:

- submit **a request within two months of the removal of the cause of non-compliance** and no later than **one year** after expiry of the missed time limit. In this context:
  - The date when the cause of non-compliance is removed is the first date on which the party knew or should have known about the facts that led to the non-observance of the time limit. If the ground for non-compliance was the absence or illness of the party or the professional representative dealing with the case, the date on which the cause of non-compliance is removed is the date on which the representative returns to work.
- However, if the omitted act is a request for renewal of an EU trade mark registration or a Community design, or payment of the renewal fees (Article 53(3) EUTMR and Article 13(3) CDR), the one-year time limit, specified above, starts on the day on which the protection ends (date of expiry), and not on the date the further six-month time limit (grace period) expires. Once the grace period expires the Office will inform the party about the expiry and the loss of rights.
- **set out the facts** justifying that they have taken **all due care** (required by the circumstances) to perform the omitted act and provide appropriate and proportionate evidence. The circumstances must be exceptional, namely circumstances that cannot be predicted from experience and are therefore unforeseeable and involuntary, such as natural disasters and general strikes. In this regard, failures to comply with time limits caused by operational difficulties arising from measures taken by public authorities against the pandemic or due to instances of sickness of the party or its representative may constitute exceptional circumstances in the above sense. Financial difficulties preventing the party from obtaining or securing continued professional representation before the Office or from paying fees payable to the Office when they were

originally due that are caused by the pandemic situation (i.e. are due to objective circumstances that are beyond the sphere of influence of the party) and have resulted in the loss of right or means of redress may also constitute exceptional circumstances (unless otherwise provided for in the Regulations);

- carry out **the omitted act** within the abovementioned period (e.g. submit the observations for which the time limit was missed, pay the missing renewal fee and any surcharges); and
- pay a **fee (EUR 200)**.

Granting *restitutio in integrum* has the retroactive legal effect that the time limit that was not met will be considered to have been observed, and that any loss of rights in the interim will be deemed never to have occurred.

*Restitutio in integrum* is available, for instance, when the party has missed one of the time limits, laid down in: Article 32 EUTMR (payment of the application fee), Article 34(1) EUTMR (right of priority), Article 38(1) EUTMR (right of exhibition priority), Article 41(2) EUTMR (period to remedy filing deficiencies), Article 53(3) EUTMR (the period for renewal) subject to the specific provision in Article 104(2) EUTMR, Article 68 EUTMR (appeal), Article 139 EUTMR (request for conversion into a national trade mark) and Article 39 EUTMR (the time limit for claiming seniority after the application has been filed).

*Restitutio in integrum* is not applicable to certain time limits specified in Article 104(5) EUTMR and Article 67(5) CDR, namely:

- the priority period, which is the six-month time limit for filing an application claiming the priority of a previous design or utility model application (Article 41(1) CDR);
- the time limit for filing an opposition and paying the opposition fee (Article 46(1) and (3) EUTMR);
- the time limits for *restitutio in integrum* itself (Article 104(2) EUTMR and Article 67(2) CDR);
- the time limit for requesting continuation of proceedings and paying the fee (Article 105(1) EUTMR);
- the two-month time limit to file an appeal against a decision of the Boards of Appeal before the General Court (Article 72(5) EUTMR).

As a general rule, a fee must be paid for each application for *restitutio in integrum* (i.e. one fee per individual right). Nevertheless, in certain cases exceptions may apply. The minimum conditions (all of which must be met) for applying these exceptions are the following:

- all the rights should relate to the same rights holder;

- all the rights should be of the same type (e.g. EUTMs, RCDs);
- the unobserved time limit should be the same for all rights (e.g. missed time limit for renewal);
- the loss of all rights concerned should be the result of the same circumstances.

If the abovementioned conditions are met, the application for *restitutio in integrum* relating to multiple rights can be subject to a single fee. For instance, when a party has missed renewing multiple EU trade mark registrations, it can file a single request for *restitutio in integrum* for the renewal of all of its marks and pay a single *restitutio in integrum* fee. Otherwise, an individual fee must be paid for each right concerned.

### CONDITIONS FOR APPLICATION

The Office's Guidelines for examination of European Union trade marks (Trade Mark Guidelines) and the Guidelines for examination of registered Community designs (Design Guidelines) are applicable to all the above listed time limit instruments. They will be interpreted in the light of this communication insofar as they relate to exceptional circumstances caused by the ongoing pandemic. The same applies to the Rules of Procedure of the Office's Boards of Appeal. Further information is available for:

- **extension of time limits** at: [Trade mark and Design guidelines, Means of communication, time limits](#); [Trade mark and Design guidelines, Extension of time limits](#); [Trade mark guidelines, Extension of time limits in opposition proceedings](#); [Trade mark guidelines, Extension of the cooling-off period](#) and [Design guidelines, Extension of time limits](#).
- **suspension of proceedings** at: [Trade mark guidelines, Opposition proceedings, Suspension](#); [Trade mark guidelines, Friendly settlement](#); [Trade mark guidelines, Cancellation, Proceedings, Suspensions](#) and [Design guidelines, Suspension](#).
- **continuation of proceedings** at: [Trade mark and Design guidelines, Continuation of proceedings](#).
- ***restitutio in integrum*** at: [Trade mark and Design guidelines, Restitutio in integrum](#).
- **Rules of Procedure of the Boards of Appeal** at: [Decision 2020-1 of 27 February 2020 of the Presidium of the Boards of Appeal](#).