



Notes on the Recordal Application Form Mod.008

1. General remarks

It is strongly recommended (but not compulsory) that the OHIM Recordal Application form Mod.008 be used for the application to register recordals (except for requests for conversion for which Mod. TM 010 is available).

1.1 Use of the form

The form may be obtained free of charge from the OHIM and may be downloaded from the OHIM's website (<http://www.oami.europa.eu>). The form may also be freely copied.

Recordal applicants or their representatives may use forms of a similar structure or format, such as forms generated by computers on the basis of the information contained in the application form.

Where such electronically generated forms are used, the use of attachments may be avoided by simply extending the electronic version where the application form does not provide sufficient space.

It is recommended that the form be submitted as complete as possible, at the time of filing. This will facilitate and expedite the handling of the request.

For any information, the OHIM may be contacted on the following telephone number:
(34) 965 139 100.

1.2 Sending forms

Completed forms have to be sent directly to the OHIM in Alicante. Forms (as well as any other communication related to the proceedings) are to be addressed as follows:

Office for Harmonization in the Internal Market
Receiving Unit
Avenida de Europa, 4
E-03008 Alicante, Spain

Communications by fax are to be sent to the following fax number of the OHIM:

+34 965 131 344

Where communications are sent by fax, confirmation copies are not necessary and not recommended. The OHIM will request further information should the communication sent by fax prove to be insufficient.

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1.3 Languages

If the recordal you wish to make involves a Community trade mark (“CTM”) or Registered Community Design (“RCD”) that is still at **application stage** (i.e. it has not yet been registered), you must apply for the recordal using the first or second language of the application, which must be one of the official languages of the European Community.

If the recordal involves a CTM or RCD that is **registered**, you must use one of the five languages of the OHIM (Spanish, German, English, French or Italian).

1.4 Type of industrial property title

Please indicate, by ticking one box only, whether you wish to apply for a recordal affecting one or more CTM(s) or one or more RCD(s). If you wish to apply for recordals affecting both a CTM and RCD, you should use a separate form for each industrial property title.

1.5 Total number of pages (including this one)

Please indicate the total number of pages you are sending the OHIM, including continuation sheets, annexes, schedules and the first page of the recordal form, and insert this figure in the box at the top left-hand side of the first page of the form.

1.6 Applicant/representative reference (not more than 20 characters)

This is the reference that the applicant or the representative wishes the OHIM to use in correspondence addressed to that party. It may consist of letters or numbers (or both) but should not exceed 20 characters.

The OHIM will use this reference to verify fee payment (i.e. a payment corresponds to a given application).

2. The Form

2.1 (BOX 1) Recordal Applicant

The Recordal Applicant is either the registered owner or the other party involved, such as the new owner, the licensee or more generally the beneficiary of a right.

If the recordal applicant has previously been allocated an ID number by the OHIM, it is sufficient to indicate that ID number and the name. Otherwise, the recordal applicant must be identified by indicating its name together with its address and nationality.

Please note that details of the representative of the recordal applicant should be filled in BOX 4.

The recordal Applicant should indicate whether it is a legal entity or equivalent (e.g. a company, a partnership, etc) or a natural person (e.g. individuals). The name of the legal entity should include its legal form (“Limited”, “Sociedad Anónima”, “Aktiengesellschaft”, etc) abbreviated in the customary manner (“Ltd.”, “S.A.”, “AG”, etc). The state (i.e. the country) where the legal entity has its seat must be indicated under “nationality”.

The postal/correspondence address (e.g. a PO box number) need only be given if it is different from the official address.

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2.2 (BOX 2) RCD/CTM owner/applicant (if not recordal applicant)

This should only be completed when different from the recordal applicant. For information on the other details requested in this section, refer to 2.1 above.

2.3 (BOX 3) RCD/CTM assignee or right holder (if not recordal applicant)

You should only complete this where different from the recordal applicant.

Assignees or right holders not having either a seat, domicile, principal place of business or real and effective industrial or commercial establishment within the European Union, must appoint a professional representative to act on their behalf before the OHIM (see 2.4 below) and should tick the “yes” box, indicating that a representative has been appointed.

If neither the assignee nor the right holder is the recordal applicant, the details of the representative appointed to act for the assignee or right holder should be indicated on a continuation sheet to be attached to the recordal application form. Those details should cover all the matters set out in 2.4 below. If no representative has been appointed, tick “no”.

For information on the other details requested in this section, refer to 2.1 above.

2.4 (BOX 4) Representative

Representation is mandatory for all **recordal applicants** either natural or legal persons that have neither their domicile or principal place of business nor a real and effective industrial or commercial establishment in the Community. All other persons may represent themselves or choose to appoint a representative.

The representative must indicate its name together with its ID number attributed by the OHIM. Where such an ID number is not available, the appropriate information relating to the existing/newly appointed representative must also be given in the application form.

Representation before the OHIM may be exercised by professional representatives falling into one of the two following categories:

- legal practitioners qualified in a Member State who are entitled to act in that Member State as representative in trade mark or design matters, as the case may be, and who have their place of business in the European Community, or
- professional representatives entered on the list maintained by the OHIM. Professional representatives entered on the list for Community trade marks matters may act for design matters. On the other hand a professional representative entered on the list for Community design matters may not act for trade mark matters.

The recordal applicant may also act through an employee. Where such an employee is appointed, the name of the employee must be indicated in the box “representative”. Employees of legal entities with their domicile or principal place of business or a real and effective industrial or commercial establishment within the European Community may represent other legal entities if (and only if) economic connections exist between the two legal persons, such as common ownership or control. This also applies when the applicant is a legal entity from outside the European Community. In these cases, information relating to the legal entity whose employee acts on behalf of the applicant, and the basis of economic connections (parent company, subsidiary, branch etc.) must be provided in an attachment.

The OHIM will communicate with the professional representative if appointed.

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Filing an authorisation of the representative is not required, except where an employee of the applicant has been appointed as representative.

2.5 (BOX 5) Type of recordal

Only those recordals provided for in Rule 84 of the CTMIR and Article 69 of the RCDIR may be entered respectively on the CTM and RCD registers.

For the sake of clarity, it is recommended that you use one Recordal Application form per recordal application.

Please note that a fee is due in respect of certain types of recordal. Details are given in the sections below and payment methods are specified in section 2.12.

2.5.1. Total or partial transfer

For recordals of transfer, there is no need to send documentary evidence of the transfer (e.g. a deed of assignment) where:

- The representative appointed acts for both the assignor and assignee, in this case obligatorily the relevant part "I am the representative for both parties" in box 10 must be ticked or;
- Both the assignor and assignee apply for the recordal (in which case boxes 10 and 11 must be completed and signed).

In other cases, the recordal application must be accompanied by a declaration, signed by the registered proprietor or his representative, stating that he agrees to the registration of the successor in title.

In addition, you must indicate the following:

- The registration number of the CTM or RCD (see box 8 on the form);
- The assignee's particulars (see box 3 on the form);
- Particulars of the goods and services assigned, if the transfer is partial (see box 7 on the form);
- Where applicable, the name and business address of the representative of the assignee (see box 3 on the form).

The fee for recording a transfer of an RCD is 200 euro per RCD with a ceiling of 1000 euro. This fee must be paid at the outset, otherwise the recordal application will be deemed not filed. There is no fee for recording a transfer of a CTM.

Applications for recordal of transfers may be made in respect of CTMs or RCDs that are still at the application stage. The same rules apply. Partial transfer is not possible in respect of RCDs, at any stage of their existence.

2.5.2. Division

A request for division of an application/registration is subject to a fee of 250 euro, payable at the outset, and may not be requested in respect of goods and services that are the object of opposition or cancellation proceedings, or during the three-month period following the publication of the CTM application for opposition purposes. Division of an application may also not be requested before a filing date has been accorded. You must clearly define the

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goods and services to be divided and take care to ensure that there is no overlap between the goods and services that remain in the original application or registration and those that are divided between the new application(s) or registration(s).

2.5.3. Seniority claims (Post-registration Art. 35 CTMR)

For applications to record seniority claims made after registration of the CTM, evidence must be provided of the existence of an earlier international, regional or national registration taking effect in a Member State of the European Community. This evidence may take the form of a registration or renewal certificate, an extract of the register, an extract of the relevant official bulletin or gazette, an extract or printout of a database or carrier (e.g. CD-ROM) evidencing the registration, or photocopies of the foregoing documents. It is also permissible, as an alternative, to make reference to the website of the relevant IP Office where the registration in question appears.

Where documents are submitted, they must indicate the Member State(s) where the earlier mark is registered; the application date; the number of the earlier registration; the name of the proprietor of the earlier registration; the representation of the earlier trade mark (in colour, if appropriate) and an indication of the goods and services.

No fee is payable for this type of recordal.

For further information on seniorities, please refer to the Decisions of the President of the OHIM EX-03-05 and Communication No 2/00, which may be consulted on-line at www.oami.europa.eu.

2.5.4. Cancellation of seniority claims

Where cancellation of a previously recorded seniority claim is sought, you should complete box 6 and use continuation sheets if necessary.

No fee is payable for this type of recordal.

2.5.5. Right in rem

For applications to record rights in rem (e.g. charges, securities, pledges and guarantees), the following information must be provided:

- The registration number of the CTM or RCD (see box 8 on the form);
- The right holder's particulars (see box 3 on the form);
- Particulars of the goods and services affected by the recordal, if applicable (see box 7 on the form);
- Where applicable, the name and business address of the representative of the right holder (see box 3 on the form).

The fee for recording a right in rem is 200 euro per CTM or RCD but, where multiple requests are submitted in the same application or at the same time, the fee will not exceed a total of 1000 euro. This fee must be paid at the outset, otherwise the recordal application will be deemed not filed.

Applications for recordal of rights in rem may be made in respect of CTMs or RCDs that are still at the application stage. The same rules apply.

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2.5.6. Cancellation of rights in rem

An application for recordal of the cancellation of a right in rem may be made by the owner of the CTM or RCD or the right holder. In either case, the following information must be provided:

- The registration number of the CTM or RCD (see box 8 on the form);
- The particulars of the right to be cancelled (to be provided on a continuation sheet attached to the recordal application form);
- Documentary evidence showing that the registered right no longer exists or a statement by the right holder to the effect that he consents to cancellation of the recordal.

The fee for recording cancellation of a right in rem is 200 euro per CTM or RCD but, where multiple requests are submitted in the same application or at the same time, the fee will not exceed a total of 1000 euro. This fee must be paid at the outset, otherwise the recordal application will be deemed not filed.

Applications for recordal of cancellations of rights in rem may be made in respect of CTMs or RCDs that are still at the application stage. The same rules apply.

2.5.7. Alteration of the mark

A Community trade mark may only be altered where:

- The CTM includes the name and address of the proprietor;
- The proposed alteration concerns either the name or the address of the proprietor;
- The proposed alteration does not substantially affect the identity of the trade mark as originally registered;
- The application for recordal of the alteration is made by the CTM proprietor or his representative.

You must attach, by way of a continuation sheet, a specification of the mark as altered.

The fee for recording an alteration is 200 euro per CTM.

2.5.8. Levy of execution

For applications to record levies of execution (i.e. enforcement measures), the following information must be provided:

- The registration number of the CTM or RCD (see box 8 on the form);
- The judgment creditor's particulars (see box 3 on the form);
- Particulars of the goods and services affected by the recordal, if applicable (see box 7 on the form);
- Where applicable, the name and business address of the representative of the judgment creditor (see box 3 on the form).

The fee for recording a levy of execution is 200 euro per CTM or RCD but, where multiple requests are submitted in the same application or at the same time, the fee must not exceed a total of 1000 euro. This fee must be paid at the outset, otherwise the recordal application will be deemed not filed.

Applications for recordal of levies of execution may be made in respect of CTMs or RCDs that are still at the application stage. The same rules apply.

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2.5.9. Licences

For applications to record licences, the following information must be provided:

- The registration number of the CTM or RCD (see box 8 on the form);
- The licensee's particulars (see box 3 on the form);
- Particulars of the goods and services affected by the recordal, if applicable (see box 7 on the form);
- Where applicable, the name and business address of the representative of the licensee (see box 3 on the form).
- Where the recordal application is made by the licensee alone, a copy of the licence agreement or proof that the licensor agrees to the recordal of the licence should be attached to the application.

You must indicate whether the licence to be recorded is exclusive or non-exclusive. If you fail to do this it will be deemed to be exclusive.

Any limitation of the goods and services to be covered by the licence recordal must be indicated in section 7.

If the licence is limited to a Member State, this should be indicated by ticking the appropriate box and listing the Member State(s) concerned in 6. below and on a continuation sheet attached to the Recordal Form, if necessary.

Where recordal of a cancellation of a licence is sought, the following information must be provided:

- The registration number of the CTM or RCD (see box 8 on the form);
- The particulars of the licence to be cancelled (to be provided on a continuation sheet attached to the recordal application form);
- Documentary evidence showing that the registered right no longer exists or a statement by the licensee to the effect that he consents to cancellation of the recordal.

The fee for recording or cancelling a licence is 200 euro per CTM or RCD but, where multiple requests are submitted in the same application or at the same time, the fee will not exceed a total of 1000 euro. This fee must be paid at the outset, otherwise the recordal application will be deemed not filed.

Applications for recordal or cancellation of licences may be made in respect of CTMs or RCDs that are still at the application stage. The same rules apply.

2.5.10. Other recordals

Please refer to Rule 84 of the CTMIR and Article 69 of the RCDIR for other types of recordal that may be entered on the register. If a recordal is not indicated in the form, you may tick the box in 5. and use the blank box at the bottom right-hand corner of that section to insert relevant particulars. If more space is required, you may use continuation sheets and attach them to the Recordal Application form.

2.6 (BOX 6) Post-registration seniority claims

You must specify the Member States where an earlier identical mark to the CTM is registered or takes effect, using a continuation sheet if necessary.

The registration number(s) of the earlier mark(s) should be inserted, Use continuation sheets if necessary.

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Finally, you should indicate the application date(s) (i.e. the filing date(s)) of the earlier mark(s). Use continuation sheets if necessary.

Refer to section 2.5.3 for further information on the recordal of seniority claims.

2.7 (BOX 7) List of goods and services involved

Where a recordal application only involves certain goods and services covered by the registration or application in question, you should list these in the box provided and use a continuation sheet if necessary. This section will principally involve the types of recordal indicated in box 5 and preceded by a reference to footnote number (1).

2.8 (BOX 8) Application/registration number(s) of CTM(s) or RCD(s) involved

For every recordal application, you must indicate the application or registration number(s) of the industrial property rights involved by inserting them in the box provided and by using a continuation sheet, if necessary. However, you should not mix CTMs and RCDs. If you wish to apply for recordals that affect both types of industrial property right, you should use a separate recordal application form.

2.9 (BOX 9) Payment of fees (if applicable)

Payment (all bank charges to be met by the payer who should instruct the bank accordingly) can be effected by:

2.9.1 Recordal fee related to Community trade mark matters

- Debiting a current account held with the OHIM, indicating the number of that account;
- Making a transfer, in euro, to a bank account of the OHIM, indicating the name, address and reference number of the applicant or representative, and the inspection to which the payment refers as well as the date on which the transfer was made.

2.9.2 Recordal fee related to Community design matters

- Debiting a current account held with the OHIM, indicating the number of that account;
- Making a transfer, in euro, to a bank account of the OHIM, indicating the name, address and reference number of the applicant or representative, and the inspection to which the payment refers as well as the date on which the transfer was made;

Current accounts may be opened by applying in writing to the OHIM. Please use the Current Account Application and Declaration Form.

Transfers should be made to one of the following OHIM bank accounts:

Banco Bilbao Vizcaya Argentaria
0182-5596-90-0092222222 Swift code (BIC): BBVAESMM XXX
IBAN ES88 0182 5596 9000 9222 2222

La Caixa
2100-2353-01-0700000888 Swift code (BIC): CAIXESBB XXX
IBAN ES03 2100 2353 0107 0000 0888

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3. (BOX 10) Signature

The recordal application form must be signed and the name of the signatory (recordal applicant) must be indicated; otherwise the OHIM will not be able to process it.

Where the representative appointed by the original proprietor is also appointed as representative of the assignee or beneficiary, the representative may sign the request both on behalf of the original and of the new proprietor. To avoid signing twice in box 10 and 11, he may tick the box "I am the representative for both parties".

4. (BOX 11) Signature of any other party involved

Where a recordal involves two parties (e.g. transfers, rights in rem and licences, etc), the signatures of both parties on the recordal application form will avoid the need to submit documentary evidence. In these circumstances, the other party to the recordal should indicate his name in the box provided and show, by ticking the appropriate box, whether he is an assignee, CTM or RCD applicant, proprietor or holder or a right holder. That party must then sign in the space provided.

For more details on this point, refer to 2.5.1 above under the sub-heading "Total or Partial Transfers".