



**Guidelines Concerning Proceedings before  
the Office for Harmonization in the Internal Market  
(Trade Marks and Designs)**

**Part M, International Marks**

**Amendments to previous  
Chapter 13 of Examination Guidelines  
(Draft)**

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This is a new part of the Office’s Guidelines concerning international trade marks. It had previously been adopted as Chapter 13 of examination guidelines but it appeared better to create a new part dedicated to International marks including examination, opposition and new issues such as replacement of a CTM by an IR, transformation of a IR designating the EC into a CTM and conversion.

These Guidelines focus on the specific features of the examination of International Marks. For further details on normal procedural aspects, please also consult the relevant guidelines (examination, opposition, cancellation, etc.).

## **1. INTRODUCTION**

1. The purpose of these Guidelines is to explain how, in practice, the link of the CTM with the Madrid Protocol will affect the procedures and standards of examination and opposition at the OHIM. Section 1 deals with the tasks of the OHIM as an Office of Origin, that is, with “outgoing” international applications. Section 2 deals with the tasks of the OHIM as a Designated Office, that is, with “incoming” international registrations, and it reflects how the system will be applied by the Office from the notification of an international registration by WIPO up to the point the final decision to accept or refuse the designation is sent to WIPO.

2. The Guidelines are not intended to, and cannot, add to or subtract from the substance of the new Title XIII CTMR and Rules 102-126 CTMIR. The Office is also bound by the provisions of the Madrid Protocol and the Common Regulations. Examiners shall also consult the “Guide to the International Registration of Marks” issued by WIPO, and these Guidelines attempt at not repeating what is said there. In the event of a conflict between these Guidelines and any of those texts, the latter shall prevail.

3. These Guidelines use the following specific acronyms:

IA: International application filed at the OHIM as the Office of Origin

IR: International registration designating the EC

MPS: Madrid Protocol System (part of our IT system)

FD: Finance Department

CR: Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement

SGP: (First or second) Statement of Grant of Protection

WIPO: World Intellectual Property Organization

IB: International Bureau of the WIPO

MM Forms: Official Forms from the WIPO

EM Forms: Official Forms from the OHIM

AG: Absolute Grounds for refusal

RG: Relative Grounds for refusal

## **SECTION 1: THE OHIM AS OFFICE OF ORIGIN**

The tasks of the OHIM as Office of Origin chiefly comprise:

- the examination and forwarding of international applications;
- the examination and forwarding of subsequent designations;
- the notification to WIPO of certain facts affecting the basic registration during the five-year dependency period;
- the forwarding of certain requests for changes in the International Register.

### **1. *Examination and forwarding of international applications***

International applications may be filed with the OHIM (Article 141 CTMR). They require

- payment of the transmittal fee;
- the existence of a basic CTM registration or application (“basic mark”);
- identity of the international application and the basic mark;
- proper filling out of the MM 2 or EM 2 Form.

#### **1.1. Transmittal fee**

An international application filed at the OHIM is only deemed to have been filed if the transmittal fee of 300 Euro is paid together with the international application; Article 142 (5) CTMR, Article 2 point 31 CTMFR.

Payment must be made to the OHIM and by any of the accepted means of payment (for details, see Part C, Chapter 1, II. 2).

Current account: if the person who makes the international application has a current account with OHIM, this will be debited automatically and the fee will be considered paid in due time. Failure to check the boxes concerning fee payment (Item 0.4 in OHIM Form EM 2) will not affect the validity of any payment made.

Payment by bank transfer: in practice it is almost impossible that the fee arrives on the day of receipt of the international application. This will not have immediate negative consequences if the payment is received by the Office within 10 days. If, however, in the course of the examination of the international application the examiner finds that the fee has not yet arrived, he will inform the applicant by Standard Letter M 104 that the application shall be deemed not to have been filed until the required fee has been paid, and that the date of payment will be the date of receipt which the Office will communicate to WIPO according to Rule 104 (see Rule 103 (1) CTMIR). If payment is still not made within the time limit set by the Office (1 months), the OHIM will inform the applicant that it considered the international application as deemed not to have been filed and close the file.

All other fees must be paid directly to WIPO (Article 145 CTMR) and the OHIM will not forward any fees to WIPO. Rather, any such fees will be returned to the sender.

The Fee Calculation Sheet (Annex to the WIPO Form MM 2) is a necessary element of the international application in the sense that if it is not filled in, WIPO will raise an irregularity. EM 2 EN, FR, ES contain that Sheet in the respective language; to all other versions of EM 2, the applicant must attach the Sheet in the correct language (the language in which the IA is to be transmitted to WIPO). However, OHIM does not examine whether the Fee Calculation Sheet is present, nor whether it is correctly filled in. Rather, the examiner will transmit it *tel quel* to WIPO as a scanned attachment to the e-communication but without any verification of its contents and in the language in which it is filed. Any questions regarding the manner and amount of payment should be addressed to WIPO, or the WIPO fee calculator available on its Website can be used.

Upon receipt of an international application, even when there are irregularities, the examiner will send a receipt (see Rule 102 (3) CTMIR).

## **1.2. Proper completion of the Form**

### 1.2.1. The various versions of the Form

The international application must be filed in one of the official languages of the EC (Article 142 (1) CTMR) and must be forwarded to WIPO in one of the three languages of the Madrid Protocol (FR, EN, ES). The language may be freely chosen by the applicant irrespective of his nationality or the languages chosen for the basic mark. It is compulsory to use the official form (Article 142 (1) CTMR), that is, either the WIPO Form MM 2 (in FR, EN or ES) or the OHIM adaptation of MM 2 (OHIM Form EM 2) which is available in FR, EN, ES as well as in all the other official languages of the EC.

OHIM Form EM 2 FR, EN and ES have the same contents and almost the same layout as WIPO Form MM 2 with the following slight adaptations:

- there is an introductory item 0 which prompts for indication of payment details before the OHIM (item 0.4) and allows indication of the number of pages (item 0.5);
- certain choices are limited down to what is applicable to the OHIM (for example, OHIM is always the Office of Origin, and the nationality of the applicant must be from a Member State of the EC);
- since there is no self-designation possible, the EC is not included in the list of Contracting Parties to be designated;
- the representation of the mark need not and shall not be given but will be included by OHIM from our database.

All other language versions of OHIM Form EM 2 are translations of that Form which contain, in addition:

- check boxes (item 0.1) to indicate the language in which the international application shall be transmitted to WIPO;

- check boxes (item 0.3) by which it must be indicated either that a translation of the list of goods and services is included or that OHIM is authorised to establish the translation;
- check boxes (item 0.2) to opt for the language in which OHIM is to communicate with the applicant in matters concerning the international application, that is, either the language in which the international application is filed or the language in which it is to be transmitted to WIPO (see Article 142 (1), second sentence, CTMR);
- a final item A with check boxes to specify the annexes (attached translations).

Checking the appropriate boxes in item 0.1., 0.2 and 0.3. is compulsory. If 0.2 is not checked, the second language (the language of EM 2) will be used by default.

Use of one of these forms is compulsory (see Rule 83 (2) (b) and Rule 103 (2) (a) CTMIR) and applicants may not use other forms or change the contents and layout of the forms. However, both WIPO MM 2 and OHIM EM 2 are available on the Internet in .doc format so that it is possible to insert as much text in the respective items as needed and to avoid attachment sheets.

The numbering of the items in OHIM EM 2 follows WIPO MM 2 so that the same item has the same number in all versions. Some numbers or letters relating to items which are not applicable in a particular situation or for a particular language are skipped, and that is intentional and not a mistake.

The Form must be filled in in the same language; it is not possible to choose another language than the language of the form.

Unless expressly indicated below, all applicable items in the Form must be completed and failure to do so constitutes a deficiency, Rule 103 (2) (a) CTMIR.

#### 1.2.2. Indications concerning the applicant and representatives

As concerns the applicant (item 2), all applicable indications under item 2.a) – d), f) must be made.

Under item 2 e), a preferred language for correspondence with WIPO may be indicated, which only makes sense if this is not the same language in which the IA is to be forwarded to WIPO and which is not of relevance before the OHIM.

(Note that in all linguistic versions of EM 2 except in EN, FR, ES, the applicant must or may indicate:

- in item 0.1, the language (EN, FR, or ES) in which the IA shall be forwarded to WIPO;
- in item 0.2, the language in which he wants OHIM to correspond with him;
- in item 2 e), the language in which he wants WIPO to correspond with him. OHIM will correspond with WIPO in the language indicated under item 0.1.).

Under item 3, indications regarding the entitlement to file must be made. Entitlement to file with the OHIM as Office of Origin may be based on the nationality of, or the domicile in, or a real and effective industrial or commercial establishment in, an EC Member State; the applicant has the choice on which criterion/criteria he bases the right to file. For example, a Danish national with domicile in Germany may chose the Danish office, the German office or OHIM as the Office of Origin (it being understood that he needs a corresponding basic mark), and if he opts for the OHIM, he has the choice whether he bases his entitlement to file on his nationality or his domicile. If he bases his entitlement to file on the nationality, the address given under item 2.b) need not be in the Community and in that case no other address needs to be given under item 3. b) but a representative before the OHIM must be appointed (Article 88 CTMR). If he bases his entitlement to file on his domicile (if item 3. b) i) is checked), that address needs only be given under item 3.b) if different from the address given under item 2 b). The same, if he bases his entitlement to file on a real and effective industrial or commercial establishment in a Member State of the EC. That term is to be interpreted in the same way as in other instances such as in the context of professional representation (see Part A, 5.3.1.1); e.g., a letterbox or address for correspondence does not suffice.

OHIM checks the entitlement to file on the basis on the indications made in the Form (Rule 103 (2) (f) CTMIR).

OHIM corresponds with the applicant under the address given in item 2) b) or c) if no OHIM representative is appointed.

Under item 4 a), indication of a representative before WIPO is optional. That representative need not be a professional representative in accordance with Article 89 CTMR (see Rule 3 (1) CR). OHIM will not correspond with the representative given under item 4 a) but simply transmit this indication to WIPO. If the intention is that the representative chosen before WIPO shall also be the person with whom OHIM should correspond in matters relating to the international application, item 4 b) must also be completed.

Under item 4 b), a representative before OHIM may and, if the applicant does not have a domicile or establishment in the EC, must be appointed. The representative must fulfil the conditions of Article 89 CTMR (see Part A, Chapter 6). If item 4 b) is not completed but a representative is already on record of the OHIM for the basic mark, the OHIM will automatically correspond with that representative also in matters relating to the international application.

### 1.2.3. The existence of a basic mark

The applicant must be the holder of a basic mark (CTMA or CTM) filed with or registered at the Office of Origin (OHIM), and the international application must be identical to the basic mark.

Identity of persons: identity is required in the strict sense; the international application may not be filed by a licensee or an affiliated company of the holder of the basic mark.

The basic mark may be (see Article 141 (1), (2) CTMR and item 5 of OHIM EM 2):

- a Community trade mark application;
- a registered Community trade mark,
- a Community trade mark application subject to its registration; in this case, the international application is filed at a stage where the CTM application is not registered but is deemed to be received on the date of registration of the CTM, and only thereafter will OHIM treat and eventually forward the international application.

The CTM application or registration must be pending or in force, i.e., it may not have been finally refused, declared invalid or withdrawn.

The number and filing or registration date of the basic mark must be given under item 5; in the case of Article 141 (2) second sentence CTMR, only the number of the CTM application shall be given, and the registration date will be added by OHIM. Applicants should therefore wait to have the number of the CTM before filing the IR application.

#### 1.2.4. Priority claim

If priority is claimed under item 6, the office of earlier filing, the filing number (if available) and the filing date must be indicated. Priority documents are not necessary and should not be added; they will not be forwarded to WIPO. The examination by OHIM is limited to whether the required indications are given under item 6 and does not extend to the validity of the claim.

#### 1.2.5. Identity with the basic mark

Items 7 to 9 concern the mark for which the international application is filed and its identity to the basic mark.

In OHIM EM 2 item 7 a) is pre-checked and OHIM will always transmit the representation of the mark as contained in our database for the basic mark. If WIPO MM 2 is used, the representation of the mark must be given which must be identical to the basic mark; OHIM must check that this is the case (Rule 103 (2) (c) CTMIR).

Item 7 c) may only be ticked if the mark is actually in standard characters.

Under item 8 a) a colour claim can be made. Where the basic CTM is filed in colour, it must be accompanied by a description of the colours. The same description must be made in the IA. See Rule 103 (2) (e) CTMIR, Rule 9 (4) (a) (vii) CR.

If the basic mark is

- a mark for a colour or colour combination as such,
- a three-dimensional or sound mark,

- a collective mark,  
the same indication is compulsory in the international application, and item 7 d) or 9 d) must be checked. See Rule 103 (2) (d) CTMIR, Rule 9 (4) (a) (vii bis) – (x) CR.

If the basic mark includes a description, the same description may be included in the international application (item 9 e)). See Rule 103 (2) (d) CTMIR, Rule 9 (4) (a) (xi) CR.

A disclaimer may be included even if the basic mark does not (item 9 g)). See Rule 103 (2) (e) CTMIR, Rule 9 (4) (b) (v) CR.

Under item 9 b) or c), a translation of the mark, or the indication that the mark has no meaning and cannot be translated, may be given. This indication is treated as optional by OHIM (not covered by Rule 103) and also by WIPO (Rule 9 (4) (b) (iii) CR), and it is unknown whether any such indication has legal significance before other designated offices.

Item 9 f) (verbal elements of the mark) has no significance; its purely administrative purpose is explained in the WIPO Guide, B.II.15.08.

Item 9 a) concerns a transliteration of the mark. OHIM will not object to the international application if this item is not checked. See Rule 103 (2) where this point is deliberately not addressed as a possible deficiency. The reason is that except for Greek and Cyrillic characters, OHIM treats marks which do not consist of Latin characters as nothing else than figurative marks and does not ascertain whether in other languages those elements constitute characters at all. However, WIPO requires a transliteration into Latin characters if the mark contains matter in characters other than Latin (see Rule 9 (4) (a) (xii) CR); if not transliteration is given it will raise an irregularity, which must be remedied directly by the applicant to WIPO (see Rule 11 (2) CR).

Yet, items 9 a), b), c) and f) are not omitted in OHIM Form EM 2 because they may be of advantage for applicants in procedures before WIPO or designated offices.

Even if in most cases, an IA is based on a single CTMA/CTM, it can also be based on several identical CTMA/CTMs in the name of the same owner and which together cover the goods and services to which the international application relates.

#### 1.2.6. List of goods and services

Item 10 requires the applicant to specify the list of goods and services, grouped in the order of classes. The list may be identical to or narrower than the basic mark, but not be broader. To this end, the comparison must be made with the list contained in the basic mark at the point in time the international application is filed. Example: The basic application was filed for five classes. Following an opposition, it is registered for class heading 10 only. As from that point in time, the international application may only claim class heading 10 or individual goods falling in class 10.

Within these limitations, the list may be different for different designated offices.

The list of goods and services must always be given in the language of the international application. Where that language is not FR, EN or ES (that is, the language in which the international application is to be transmitted to WIPO), the applicant may attach a translation into that language, (Article 142 (3) CTMR).

If he does so, he must check the first check box under item 0.3 and should check the corresponding box in item A (annex).

Otherwise, he must check the second box under item 0.3 and authorize the OHIM to establish the translation or use an existing translation (Rules 102 (4), 103 (3) CTMIR). In case the authorization is missing (because the box has not been properly checked or because WIPO form has been used), the Office will invite the applicant to remedy the irregularity within such a period it may specify (1 month). It is in the interest of the applicant to have its application corrected as soon as possible in order for the OHIM to forward it to WIPO within a period of two months from its reception and for the IR to bear the date on which it was received at the OHIM (see Article 3 (4) MP).

The translation will be taken from the basic mark wherever available, in particular if the basic mark is a published application or registered CTM. If this is not possible, that is, if the translation for the basic application is not yet available or if the list, albeit narrower, has a different wording than the list for the basic mark or if the applicant has supplied different lists for different designated offices, the list(s) must be sent to the Translation Centre as soon as possible. The Centre has committed itself to establish the translation within 4 working days. The request for translation will include all other text matter, such as colour claims or descriptions, which the applicant has not also translated. To this end, items 8 and 9 must be carefully checked against the indications in item A and against the annexes furnished by the applicant. These translations will not afterwards be included in EUROMARC for the basic application: it would be too risky to overlook differences or subsequent changes in the two lists.

The applicant will not be consulted on the translations established by the OHIM. Where the translation is already available for the basic mark, the applicant knows the translation. In that case it makes no difference if he filed that same translation himself.

The list of goods and services must be properly grouped and correctly classified. This is ensured if the classification of the basic CTM application was already checked. Otherwise the classification made by the applicant or, if he did not classify, the list of goods and services for which international registration is sought should simply be accepted as such for the purposes of forwarding the international application.

#### 1.2.7. Designated Contracting Parties

An international application filed at the OHIM is exclusively governed by the Madrid Protocol. Only Contracting Parties can be designated which are a party to the Protocol, regardless of whether they are also bound by the Madrid Agreement.

The check boxes in item 11 of OHIM EM 2 list all present Contracting Parties of the Madrid Protocol, except the EC because the EC cannot be designated in an international application filed at the OHIM (no self-designation, Article 3bis, second sentence, of the Madrid Protocol). Contracting Parties which join the Protocol after release of the Form can be added under “others”. The Form will be updated as often as appropriate to include new parties to the Protocol in the check box list.

The examiner shall verify that at least one designation has been validly made. If under “others” States are indicated which are not or not yet party to the Protocol, the examiner will not object to this since that does not affect the other designations, so that the application can be forwarded as soon as possible. However, the applicant will certainly face a notice of irregularity from WIPO.

#### 1.2.8. Signature

A signature of the applicant (item 12) is optional. The Community has not made use of the faculty under Rule 9 (2) (b) CR to require a signature of the applicant because what will be forwarded to WIPO are the data and not the original or facsimile of the Form.

#### 1.2.9. Other Forms

Where the United States is designated, the applicant must attach the signed WIPO Form MM 18 (see item 11, footnote \*\*). This must always be in English regardless of the language of the international application. The examiner will not object if MM 18 form is absent or not duly completed as that does not affect the validity of the other designations.

WIPO Form MM 17 allows claiming the seniority of a national trade mark in an international application, where the EC is designated. Since this is not possible in an international application for which the OHIM is the office of origin, such a seniority claim may not be made. Any MM 17 which is nevertheless attached to the international application will be ignored by the examiner and not be forwarded to WIPO.

### **1.3. Forwarding of the international application**

If there are deficiencies which, according to what is outlined above, must be remedied by the applicant, the examiner will issue Standard Letter M 106 and give one month to remedy. If that is not done, the examiner shall refuse to forward the international application by Standard Letter M 100. This does not preclude the filing of another international application at a later point in time. If the language of the international application is not FR, EN or ES, the written correspondence with the applicant will be in the language of the international application unless the first check box of item 0.2 has been ticked (see Article 142 (1), second sentence, CTMR).

Examiners are encouraged to try to resolve problems, in particular minor deficiencies, or to seek clarifications, on the phone in order to speed up the procedure. Also applicants and representatives must be aware that it is risky to exhaust the one- month time limit until the end; they should rather be urged to reply immediately. The earlier the deficiency is remedied, the better the chance that the examiner can forward the international application within two months to keep the date of receipt as the date of the international registration.

As soon as the examiner is satisfied that the international application is in order, he shall forward it to WIPO, (Rule 104 CTMIR). The forwarding will be done electronically, with the exception of documents that cannot be reduced into XML data such as fee calculation sheets or MM 18; those other documents will be transmitted as scanned attachments. The electronic forwarding contains the certification of the Office of Origin referred to in Article 3 (1) of the Madrid Protocol. This is why item 13 of WIPO Form MM 2 does not appear on OHIM EM 2.

OHIM may receive an irregularity notice from WIPO. The irregularity must be remedied by the OHIM or the applicant, depending on their type. The examiner must attempt to remedy any of the irregularities mentioned in Rule 11 (4) CR.

WIPO can also raise irregularities with respect to the classification of the goods and services (Rule 12 CR), with respect to the indication of the goods and services (Rule 13 CR), or both. The applicant is informed at the same time about the irregularity by the IB and may present his views to the OHIM but not directly to the IB.

If WIPO raises an irregularity with respect to the classification of the goods and services (Rule 12 CR), the examiner shall not make use of the faculty under Rule 12 (2) CR to express a differing opinion. The examiner must accept WIPO's proposal. If the holder sends a counter proposal or a confirmation of acceptance, the OHIM will send it *tel quel* to the IB.

If WIPO raises an irregularity with respect to the indication of the goods and services (term too vague for example, see Rule 13 CR), the Office shall not make use of the faculty under Rule 13 (2) CR to make a proposal to remedy the irregularity. If the holder sends a proposal, the OHIM will send it *tel quel* to the IB.

## **2. Subsequent designations**

Unlike international applications, subsequent designations need not be filed through the Office of Origin but may be filed directly with WIPO, (Rule 24 (2) (a) CR).

Presentation of the subsequent designation directly to the International Bureau is recommended.

In case of transfer of the IR to a person who is not entitled to make a subsequent designation through the OHIM, subsequent designations **must** be presented to the IB directly, see Article 2 (1) (ii) MP and Rule 105 (d) CTMIR (ex: French holder of an IR assigned to a Swiss company who wants to make subsequent designation; the Swiss company can not file its subsequent designation before the OHIM because it is not established in the territory of the EC and it must go to WIPO directly).

Subsequent designations may only be made after an initial international application has been made and led to an international registration. If they are received before the International application has been registered, they will be deemed as not filed by the OHIM. Subsequent designations are not subject to a transmittal fee.

Subsequent designations must be made on the official form, (Rule 102 (1), (2), 103 (1) (a) and Rule 83 (2) (b) CTMIR). In FR, EN and ES, this is WIPO Form MM 4. In these languages, no OHIM version exists, as no special indications for the OHIM are needed. In the other official languages of the EC, OHIM Form EM 4 must be used.

The Fee Calculation Sheet (Annex to the WIPO Form MM 4) is a necessary element of the subsequent designation in the sense that if it is not filled in, the IB will raise an irregularity. WIPO forms MM 4 in EN, FR, ES contain that Sheet in the respective language; to all other versions of EM 4, the applicant must attach the Sheet in the correct language (the language in which the Subsequent Designation is to be transmitted to WIPO). However, OHIM does not examine whether the Fee Calculation Sheet is present, nor whether it is correctly filled in. Rather, the examiner will transmit it *tel quel* to WIPO as a scanned attachment to the e-communication but without any verification of its contents and in the language in which it is filed. Any questions regarding the manner and amount of payment should be addressed to WIPO, or the WIPO fee calculator available on its Website can be used.

In MM 4 and EM 4, the indications to be made are quite reduced as compared with MM 2; they are basically limited to indications concerning the applicant and his entitlement to file, indications concerning the representative, the list of goods and services, and the designation of additional Contracting Parties to the Madrid Protocol. These indications must be made basically in the same way as in MM 2, and the examination must basically be made in the same way as well. Standard Letters M 101 and M 100 are also to be used for subsequent designations with the relevant modifications. As regards the entitlement to file there is a difference only insofar as a subsequent designation may be filed at the OHIM when it was not the Office of Origin if the international registration was transferred to a person with nationality of an EC Member State or a domicile or establishment in the EC (the OHIM as “Office of the Contracting Party of the holder”), (see Rules 1 (xxvi bis), 24 (2) CR).

The list of goods and services may be the same as in the international registration (item 5 a)) or may be different from the international registration provided that it is narrower than the international registration (item 5 b) or c)). The list cannot go beyond the international

registration even if covered by the basic mark (see Rule 105 (c) CTMIR). A comparison with the list of the basic mark therefore need not be made.

Within these limitations, different lists may be presented for different States designated subsequently.

The mark is necessarily the same as in the initial international registration.

Subsequent designations must be made in the same language as the initial international application, (Article 144 CTMR), failing which the OHIM will refuse to forward the subsequent designation, (Rule 105 (1) (a), (2), (4)).

If this is not FR, EN or ES, the applicant must check item 0.1 in OHIM EM 4 and indicate the language in which subsequent designation shall be transmitted to WIPO; that language may be different from the language of the international registration. Items 0.2 and 0.3 must also be completed regarding the translation of the list of goods and services and the language of correspondence between the applicant and OHIM; what is said above under B.13. 1.2.1 and 1.2.6 applies.

### **3. Notification of facts affecting the basic registration**

If, within a period of five years starting with the date of the international registration, the basic mark lapses wholly or in part, the international registration is cancelled to the same extent. This is colloquially referred to as the “dependence” of the IR on the basic mark, or the “central attack” although the IR not only falls if a third party attacks the basic mark, but also if the basic mark lapses due to an action or inactivity of its proprietor.

In the case of a CTM, this covers the cases where, either fully or partially (for only some goods or services)

- the CTM application on which the IR was based is withdrawn, deemed to be withdrawn or refused;
- the CTM registration on which the IR was based was surrendered, was not renewed, or was revoked or declared invalid by the OHIM or, upon a counterclaim, by a CTM court.

Where this is due to a decision (of the OHIM or a CTM court), the decision must have entered into final force.

If this occurs within the five years period, the examiner must notify WIPO accordingly with Standard letter W146 (for details, see Rule 106 (1) (a), (b), (2) CTMIR). The examiner must check that the international application was registered before sending any ceasing of effect.

A notification to WIPO must also be made in certain cases where a procedure has been initiated prior to expiry of the five years period, but is not finally decided within that

period; that notification is to be made immediately after expiry of the five years period. The cases where this must be done are:

- a refusal of the basic CTM application on absolute grounds was appealed and the appeal is still pending;
- an opposition procedure is pending (including ensuing appeals before the Boards or the ECJ);
- a cancellation procedure before the OHIM is pending (including ensuing appeals before the Boards or the ECJ);
- according to CTM Register, a counterclaim against a CTM is pending before a CTM court.

For details, see Rule 106 (3) CTMIR.

In these cases, a further notification must be sent to WIPO once there is a final decision or the proceedings are terminated; that is, WIPO must be informed whether and to what extent the basic mark lapses or remains pending or registered (see Rule 103 (4) CTMIR).

Note that such a notification is not to be made if at the date on which the five years period expires,

- the basic CTM application was refused on absolute grounds but there is no appeal, or the appeal is filed after expiry of the five years period;
- an opposition or cancellation request is deemed not to have been filed because the fee was not paid.

Note also that it is not correct to send a notification just upon receipt of an opposition or appeal. For example, oppositions that are closed within the five years period because the opposition was withdrawn are not to be notified. However, if an opposition is closed within the five years period because the CTM applicant withdraws the application, this has to be notified since it falls under Rule 106 (1) (a) CTMIR.

There is yet another case which must be notified to WIPO: if the basic CTM application or registration is divided within the five years period (Rule 106 (1) (c), (2) CTMIR). This may occur as a result of a partial transfer, or under the new Articles 44a or 48a CTMR.

For this notification, there are two differences to the other cases:

- The notification must be made immediately, namely after the divisional application or registration is created in EUROMARC;
- it has no effect on the validity of the international registration; it just serves to keep record of the number of the marks on which the IR is based. See Rule 106 (2) (d) CTMIR where this case is deliberately not mentioned as a ground to cancel the IR.

#### **4. Forwarding of changes affecting the international registration<sup>1</sup>**

The International Register is kept at WIPO. As a matter of principle, an Office of Origin is not concerned with changes in the international registration, and the Designated

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<sup>1</sup> This Chapter is included in Section 1 dedicated to the role of the OHIM as Office of Origin but it also partially deals with the role of the OHIM as designated Office.

Offices are concerned only insofar as they receive notifications from WIPO about such changes with a view to reflect them in their own databases.

The principle is that any changes relating to the international registration shall be filed directly at WIPO by the holder of the international registration. OHIM will not deal with renewal requests or payment of renewal fees, see Rule 107 CTMIR.

#### **4.1. Cases where requests for changes have to be forwarded without examination**

The following requests for recordals relating to an international registration may also be presented to the OHIM as an Office of the Contracting Party of the holder (see Rules 20, 20bis, 25 (1) CR):

- a change of ownership, by filing the WIPO MM5 form (even if only for a part of the goods and services or in respect of some designated offices); (in the CTM terminology, corresponding to a transfer)
- a limitation of the list of goods and services or a renunciation, by filing the WIPO MM6 or 7 form (in the CTM terminology, corresponding to a full or partial surrender);
- a full or partial cancellation of the international registration, by filing the WIPO MM 8 form (which is in fact a limitation or renunciation which applies to all designated offices at the same time);
- a change of the name or address of the holder, by filing the WIPO MM9 form;
- a licence, by filing the WIPO MM13 form;
- a restriction of the holder's right of disposal (in the CTM terminology, corresponding to a right *in rem*, enforcement measure or insolvency proceedings) (no WIPO form available).

Where these requests are presented to the OHIM by the holder of the IR, they will simply be forwarded to WIPO without any examination. The provisions under the CTMR and CTMIR for the corresponding proceedings do not apply. In particular, the language rules are those under the CR, and there is no OHIM fee to be paid.

Such requests can only be filed through the OHIM if it is the Office of the Contracting Party of the holder, that is, the Office of Origin or if it becomes competent for the holder as a result of a transfer of the international registration (see Rule 1 (xxvi bis) CR). However, this condition will not be examined by the OHIM because it will simply forward the request and the request could have been filed at WIPO directly.

To sum up, for such requests, if presented by the holder of the IR, the Office simply acts as a mailbox.

Insofar as Rule 20 (1) CR allows an Office of the Contracting Party of the holder to notify a restriction of the holder's right of disposal on its own motion, and allows a Designated Office to notify a restriction of the holder's right of disposal, this faculty will not be made use of.

#### **4.2. Cases where requests for changes have to be forwarded after limited examination**

Rules 20 (1) (a), 20bis (1) and 25 (1) (b) CR provide that the request for recordal of a change of ownership, of a licence or of a restriction of the holder's right of disposal may only be filed directly at WIPO if it is made by the holder of the international registration. It would be virtually impossible to record a change of ownership or licence at WIPO where

- the original holder no longer exists (merger, death), or
- the holder is uncooperative towards his licensee or (even more likely) the beneficiary of an enforcement measure.

For these reasons, the new holder or the licensee or the beneficiary of the right in rem have no other choice than filing the recordal request with the Office of the Contracting Party of the holder. WIPO will register such requests without any substantive examination on the basis that they have been transmitted by the Office of the Contracting Party of the holder.

To avoid a third person becoming the owner or licensee of an international registration, it is imperative that the OHIM examines all requests for recordal of a change of ownership or licence or restriction of the holder's right of disposal which are not presented by the holder of the international registration as to whether there is proof of the transfer, licence or other right. This is provided in Rule 120 CTMIR. The examination is limited to the proof of the transfer or licence or other right, and Rule 31 (1), (5) CTMIR and the corresponding parts of the OHIM Guidelines on transfers and licences apply by analogy. If the proof is not furnished, the examiner shall refuse to forward the request to WIPO. This decision is open to appeal.

In all other respects, the rules under the CTMR and CTMIR do not apply. In particular, the request must be in one of the WIPO languages and on the appropriate WIPO Form, and no fee is payable to the OHIM.

### **5. *Relationship to the Madrid Agreement***

A designation of the EC is exclusively governed by the Madrid Protocol, and an international application or subsequent designation filed at the OHIM as the Office of Origin is exclusively governed by the Madrid Protocol.

However, if the international registration has been transferred from a person who is a national of a State which is a Contracting Party to the Agreement to a person who is a national of an EC Member State or has his domicile or establishment in the EC, and where thereby the OHIM has become the Office of the Contracting party of the holder, the question arises whether there is room for application of the Madrid Agreement. The answer is:

- If a subsequent designation is presented at the Office in its capacity as the Office of the Contracting Party of the holder, only States which are bound by the Protocol may be designated; States which are only party to the Agreement may not be designated. This follows from Rule 24 (1) (c) CR as the OHIM is bound by the Protocol only.
- If a request for recordal of a change in ownership, licence or other right is presented at the Office in its capacity as the Office of the Contracting Party of the holder, the following is possible: The previous owner was a national of a State bound by the Agreement, and he has designated States bound by the Agreement, including States which are not also bound by the Protocol; he has transferred the international registration to a national of an EC Member State which is bound by the Agreement (e.g., France). The new holder has the choice between the national office of that Member State and the OHIM when filing recordal requests through his Office of the Contracting Party of the holder. The request for recordal of a change may then concern any designation, including the designation of a State which is only bound by the Agreement. This should be taken into account by the examiner when processing requests under [4.1](#) , [4.2](#).

## **SECTION 2: THE OHIM AS DESIGNATED OFFICE**

### **1. Overview**

The main steps before the OHIM as Designated Office are:

- the receipt and first republication of IRs designating the EC;
- the examination on absolute grounds;
- the examination of oppositions against IRs;
- dealing with searches and seniority claims, in parallel with the other examination steps.

If the IR is totally cancelled from the International Register and the OHIM is informed by WIPO, (“death” message received), the file is closed. This can happen at any time of the procedure.

The IR designating the EC may also be the subject of a request for cancellation and this is not dealt with in this part of the Guidelines since there are no specificities, compared with cancellation requests against CTMs.

Professional Representation:

In all procedures between the OHIM and the international holder where an action must be taken, a professional representative shall be appointed before the Office according to normal representation conditions (Article 88 and 89 CTMR). It is not sufficient in particular that there is professional representative appointed before WIPO complying

with the Office's rules. When necessary, the representative must be appointed expressly before the OHIM in particular in the following cases:

- Seniority claim, indication of a second language or collective mark if there must be a written exchange with the Office further to the international application;
- Absolute grounds or relative ground examination in case of provisional refusal, even if the international holder does not have the intention to reply to the Office's objection.

## **2. *The international registration or subsequent designation of the EC***

Any person who is a national of, or has a domicile or commercial establishment in, a State which is a party to the Madrid Protocol and who is the owner of a national application or registration in that same State (a "basic mark") may, through the national office where the basic mark is registered (the "office of origin"), file an international application with the Office of origin or subsequent designation with WIPO in which he can designate other States or international organisations which are parties to the Madrid Protocol (72 States in April 2007).

Since 1 October 2004, he can also designate the European Community, using WIPO's Forms:

- MM2 (Application for IR exclusively governed by the Madrid Protocol),
- MM3 (Application for IR governed by both the Madrid Agreement and the Madrid Protocol) or
- MM4 (Designation subsequent to the IR).

These forms have been modified by WIPO to allow in particular the indication of a second language different from the first one among the four remaining ones of the OHIM when the EC is designated.

As regards seniority claimed in the IA, a separate form has been created to be annexed, to the IA designating the European Community or to the subsequent designation of the European Community:

- MM17 (Claim of Seniority- European Community).

WIPO registers the international application, following the examination of some formalities and on the basis of the certification by the Office of Origin that the international application is the same than the national application or registration on which it is based.

WIPO is also competent to carry out or review the classification; it has the final word on it in case of discrepancy with a national office. Then, WIPO notifies the international registration to the designated offices. The OHIM will not receive or even see WIPO Forms since it will receive the data from WIPO exclusively in electronic form.

The OHIM will then have 18 months to notify all possible grounds for refusal of the EC designation. The 18 months period starts on the day on which the notification of the designation is received by the OHIM. The OHIM will receive designations electronically. It will be indicated in MPS and in the Standard Letters as the “notification date”. In case of corrections affecting the mark itself or the goods and services, the 18 month deadline starts running again as from the new notification date. It is up to the Office to decide in which cases the deadline will start to run again (if new goods that must have been included originally are notified, the deadline will start to run again only for the new goods and the Office will have to re-publish the IR in the CTM Bulletin and re-open the opposition period only for them).

### **3. Receipt, first republication, searches and formalities**

There will be no formality checks to be carried out on the IR save as regards the presence of the second language and of use regulations for collective trade marks; seniority claims will be examined independently.

The Office should therefore rarely have the need to raise objections on formal grounds.

#### **3.1. Reception from WIPO**

A standard electronic format will be used (XML), enabling internal data capture at the OHIM and standard acknowledgement of receipts between WIPO and OHIM.

The processing of the data exchanges between WIPO and OHIM via XML files will use the MECA format (Madrid Electronic Communications).

The processing of MECA notifications (data from WIPO) consists of:

- Downloading XML files and auto extractable compressed file of images (done manually every week);
- Importing XML file in Madrid Protocol Communication, a temporary database;
- Processing of data to be integrated in MPS and pictures.

International registrations coming from WIPO will be identified in our MPS system under the WIPO registration number preceded by a “W” as a reference to the fact that it is an IR followed by 00 in case of a new IR and 01 in case of a subsequent designation.

IRs are therefore imported in MPS without the need of a manual key-in or the issue of a manual receipt. Since they are already registered trade marks, the attribution of a filing date is not relevant either. If the international application was filed claiming the priority of an earlier trade mark, we will not receive priority documents and nor does WIPO (see Rule 9(4)(a)(iv) CR). WIPO also has control on the classification check. Finally, once the international application is registered in the International Register, WIPO will publish the IR in the International Gazette and issue the certificate of international registration.

### **3.2. First republication<sup>2</sup>**

Upon receipt, the IR will be automatically republished in the CTM Bulletin after an automatic check of mandatory fields. Except for those exceptional cases where the second language is not indicated, IRs will therefore be re-published almost immediately upon receipt.

Publication will be limited to bibliographic data, the reproduction of the mark and the class numbers, but will not include the actual list of goods and services. This means in particular that OHIM will not translate international registrations. Publication will contain a reference to the publication of the IR WIPO in the Gazette which should be consulted for the remainder. For more details, refer to new Part M the Vademecum on our Website.

For the purposes of applying article 9(3) CTMR second sentence, the international registration has, as from its first republication, the same effect as a published CTM application.

### **3.3. Languages**

According to Rule 126 CTMIR, the language of filing of the international application shall be the language of the proceedings within the meaning of Article 115 (4) CTMR. If the language chosen by the international holder in written proceedings is not the language of the international application, he shall supply a translation into that language within one month from the date of the submission of the original document (see Rule 96 (1) CTMIR). If the translation is not received within this time limit, the original document is deemed not to have been received by the Office".

Rule 9 (5) (g) (ii) CR and Rule 126 CTMIR require the applicant to indicate in his international application, on the International Form, a second language from among the other four languages of the Office as a possible language for opposition, revocation or invalidity proceedings before the Office.

The new MM2 form (in English in our example) prompts this through a footnote near the check box of the European Community with the following text:

“If the European Community is designated, it is compulsory to indicate a second language before the Office of the European Community, among the following (check one box only):

French  German  Italian  Spanish”

In the unlikely event that WIPO has not secured compliance with the obligation to indicate a second language, and since WIPO does not publish the second language, this obligation must be fulfilled before the Office can republish. It would not be sufficient to

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<sup>2</sup> IRs are first published by WIPO in the International Gazette and then “republished” by the OHIM at two different moments.

allow the opponent to file an opposition in the language he wants, because firstly, this would depart from Article 115 CTMR, for which the IR would not have the authority, and secondly, because the second language is also needed for future cancellation requests.

Therefore it is imperative to check whether the holder of the international registration has indicated the second language, and failure to do so must lead to a provisional refusal of protection.

Upon receipt in our IT system (Madrid Protocol Communication), the mandatory data including the presence of a second language will be automatically parsed.

If the second language has not been indicated properly the IR will appear on the Agenda, and the examiner will postpone the first republication until the second language is properly indicated.

If the problem cannot be resolved on the phone, the examiner will as soon as possible issue a provisional refusal to WIPO giving two months to indicate the second language starting from the date of the letter. This letter will then be forwarded by WIPO to the international holder or to his representative before WIPO. Where applicable, the letter will include a paragraph asking for the appointment of a representative within the same period. As OHIM has its own rules of representation, even in cases where there is a WIPO representative that is also on the OHIM list, it is not enough to comply with the rules. A representative before the OHIM must be formally appointed by the international holder when applicable.

If the second language is indicated within that period and further provided that the holder also complied with the request to appoint a representative, the international application will be republished.

Otherwise, the provisional refusal will be confirmed by a letter sent to the holder and, if the appeal period has expired without an appeal filed, by a letter sent to WIPO.

Once a provisional refusal is sent, it is not possible to send Statements of Grant of Protection (see Rule 17 (6) CR). If a provisional refusal is sent on admissibility deficiencies (lack of indication of a second language for example) and if meanwhile, the deficiency has been solved and the IR has been accepted on absolute grounds, WIPO will only be informed of the final acceptance of the IR once all the proceedings are over (including opposition).

### **3.4. Searches**

Following the first republication, the international application must be sent for search. The procedure is the same as for direct CTM filings: The establishment of a CTM search report, information of the holder of cited earlier rights, and sending the application for search to the national offices (this applies until 2008, when the national search will

become optional). The CTM search report will include similar CTMs and IRs designating the EC. The owners of those earlier marks cited in the report will receive a surveillance letter in accordance with Article 150 (4) CTMR.

The search reports will be sent directly to the holder of the international registration or, if he has appointed a representative before the OHIM, to that representative. The holder will not be required to appoint a representative for the sole purposes of receiving the search report.

### **3.5. Seniority claim**

According to Rule 9 (5) (g) (ii) CR, Articles 34 and 148 CTMR and Rules 8 and 108 CTMIR, the applicant may claim, in an international application, the seniority of an earlier mark under the CTM system (for seniority claimed directly before the OHIM, see under paragraph 8).

Such a claim must be presented on a separate official form (MM17) annexed to the international application, which shall be considered part of the international application, and include:

- the EC Member State(s) in which the earlier right is registered;
- the registration number;
- the filing date of the relevant registration.

Following Decision No EX-05-5 of the President of OHIM of 1 June 2005 concerning the evidence to be provided when claiming priority or seniority, the documentation in support of any such seniority claim will not have to be filed unless so requested by OHIM. When applicable, the requested documentation will consist of a copy of the relevant earlier registration certified by the Office concerned or, following Decision No. EX-03-5 of the President of OHIM, of photocopies of the documentation or printouts from official or officially recognized databases.

Where the holder of the international registration is obliged to be represented in proceedings before the Office, he must appoint a representative before the Office when submitting the relevant documents to the Office. If the holder of the IR did not appoint a representative before the OHIM, the examiner will give him two months to do so, failing which the examiner will declare the loss of the seniority claim in whole pursuant to Rule 109 (2) CTMIR.

For the remainder, seniority claims presented in the international application must be examined in the same way as seniority claims presented in a Community trade mark application pursuant to Rule 9 (3) (d), (7) CTMIR.

If the examination of the seniority claim under Rule 109 CTMIR results in a negative finding, that fact must be communicated to WIPO. The same is true for voluntary withdrawals of a seniority claim, which are possible pursuant to Rule 13 CTMIR until the date of publication referred to in Article 147, or any other decision affecting the seniority

claim. Those changes will be published and communicated to the holder by WIPO, cf. new Rule 21bis CR.

If the Office accepts the seniority claim, it must inform the national offices (including the Benelux Office) concerned of any seniority claim it has accepted; Rule 109 (4) CTMIR. Information of WIPO is not necessary since there is nothing to be changed in WIPO's publications.

No provision is made in Article 148 (2) CTMR to allow for a seniority claim in the interval between the filing of the international application and the expiry of 18 months. In other words, there is no equivalent provision to Rule 8(2) CTMIR since the seniority must be claimed when filing the international application before a national office. However, to allow seniority to be claimed before the Office even before the date referred to in Rule 110 (1), paragraph 2 CTMIR allows presentation of the seniority claim already before that date, but it will only be treated and examined by the Office after that date, and any communication to remedy deficiencies, such as a communication asking for a copy of the relevant registration, will only be issued after that date. Such claims will be dealt with under Rule 110 CTMIR and Article 35 CTMR.

Since seniority claims do not affect the scope of protection of the trade mark even if they are refused, their refusal can be communicated to WIPO at any time (even after the expiry 6 months period allocated for ex-officio examination). In other words, their examination will be carried out in parallel to the examination of the IR on absolute or relative grounds.

### **3.6. Regulations of Use**

The international holder of a collective mark must submit regulations governing its use directly to OHIM. Rule 121 (2) CTMIR gives two months to do so, calculated from the date on which the International Bureau notifies the international registration to the OHIM. If by then the regulations on use have not been submitted, the examiner shall issue a provisional refusal sent to WIPO (Rule 121 (3) (b) CTMIR).

Where the holder of the international registration is obliged to be represented in proceedings before the Office, the notification of provisional refusal will contain the invitation to appoint a representative. If no representative is appointed within the specified time limit, the examiner will confirm the refusal of the collective mark in whole.

If the letter sent to WIPO is not complied with, a letter of refusal will be directly issued to the international holder and, once the refusal becomes final, WIPO will be informed.

### **3.7. Fee Management and Payments**

That the individual fee for the designation of the EC in an international application or subsequent designation has been paid to WIPO, will have been verified by WIPO when

notifying the IRs to the OHIM. WIPO will settle the fee payments on a monthly basis in Swiss Francs with OHIM in a batch.

The settlement of the individual fees is exclusively for the Finance Department and a mere accountancy operation without incidence on the processing of the IRs concerned.

## **4. Absolute grounds for refusal**

For further details on the examination procedure, please consult Examination Guidelines.

### **4.1. Classification**

The classification step is skipped in the examination of an IR. OHIM will not review or re-examine the classification done by WIPO. A decision has been taken not to look at WIPO's classification again and there should be very few differences to our classification practice in particular since OHIM

- accepts all class headings
- would not issue "broadness" or "vagueness" objections on terms which are acceptable under WIPO practice.

The International Bureau will be contacted by phone only in case of obvious mistakes or misspellings so that a correction can be issued.

### **4.2. Absolute grounds examination**

Immediately after first republication, the application will proceed to examination on absolute grounds.

In order to ascertain that the first SGP can be sent (Rule 112 (5) CTMIR), there is the obligation to complete the absolute grounds examination within six months after first republication. This means that within this period,

- if there are objections, they must lead to the sending of a notification of provisional refusal;
- if there are no objections, the mark must be passed on to the status "absolute grounds ok",
- if the examination has not been carried out during the 6 month period, the mark will be put in the status "absolute grounds ok"; this, of course, has to be avoided since the Office is under an obligation to check absolute grounds.

Once the mark is put under status AG ok, the first SGP is automatically issued and sent to WIPO, indicating that the mark has been examined on absolute grounds but is still subject to opposition and third parties observations. WIPO will transmit this to the international holder or to its WIPO representative if applicable, publish it in the International Gazette and enter it in the International Register.

This first SGP informs both the holder and third parties (it is recorded by WIPO) that the Office's examination of absolute grounds has been positive.

When the result of AG examination is positive but no first SGP can be sent (because previously a formality refusal had been raised even if the deficiency has been resolved in the meanwhile), the Office must wait until all procedures (including opposition) are over before informing WIPO and finally send the letter lifting the formality refusal. The international holder is nevertheless informed directly by the Office of the positive issue of the AG examination.

### **4.3. Procedure in case of provisional refusal on AG**

If the examiner detects an absolute ground for refusal, he must send a notice of provisional refusal to WIPO, containing a reasoned objection (as in a normal CTM case) plus the invitation to appoint a professional representative before the OHIM, if the holder of the international registration is not from the EC. The time limit set is two months, which will start on the date of issue of the provisional refusal (unlike in a normal CTM case, where the date of receipt is controlling). See Rule 112 (1) last sentence CTMIR.

WIPO will transmit this notification of provisional refusal to the holder (or to its representative before WIPO is applicable). The holder will have to reply directly to the OHIM or if applicable through a representative appointed before the OHIM. It is not enough that there is a representative appointed before WIPO that also complies with OHIM representation rules and the appointment of a representative before the OHIM must be explicitly communicated to the OHIM.

It is important that the notice of provisional refusal is sent to WIPO within 6 months following the date of first republication, since in case the examination is not completed by then, the mark will be put in status "absolute grounds ok".

Once the provisional refusal has been sent to WIPO, the further examination procedure is the same as for a CTM application: there will be a direct exchange with the holder as often as required. For cases where it might be necessary, the Office may issue a further letter. It is not within the competence of WIPO to intervene in any way in the settlement of substantive issues raised by a refusal.

If the holder fails to overcome the objections, or to convince the examiner that they were unfounded, the Office issues a negative decision to the holder directly, which is subject to appeal pursuant to Article 57 CTMR and, as the case may be, to an action before the Court of Justice pursuant to Article 63 CTMR.

If a representative is not duly appointed, protection will be refused in total irrespective of whether the holder intended to accept the objections. In other words, it is not sufficient to remain silent and it is necessary in all cases to appoint a representative before the Office (Rule 112 (4) CTMIR). The Office will then monitor whether an appeal has been filed and if so, what the outcome is. Once the decision to refuse or accept the mark is final, a

final notification will be sent to WIPO, indicating whether and for which goods and services the mark has been finally refused or accepted.

If there is a provisional refusal on absolute grounds but no opposition is filed, the procedure concerning absolute grounds simply goes on. Neither a first nor a second SGP is sent.

## **5. Observations by third parties**

### **5.1. Timing**

Third party observations (Article 41 CTMR, Rule 112 (5) CTMIR) can be validly filed at the OHIM from the date of notification of the IR to the OHIM at least until the end of the opposition period and if an opposition was filed, until the end of the 18 month period.

### **5.2. Examination**

If the third party observations arrive prior to the sending of a communication to WIPO about the result of the AG examination (before expiry of 6 months), and the Office considers them justified, the notice of provisional refusal sent to WIPO is drafted in a normal way, irrespective of whether the reason for it was an observation of a third party.

If the third party observations arrive after the sending of a communication to WIPO about the result of the AG examination (in general the First Statement of Grant of Protection but could also be a partial refusal on goods and services other than those “attacked” by the third party) and the Office considers them well-founded, it will send a notice of provisional refusal on absolute grounds to WIPO, even if a first SGP has already been sent to WIPO. This is the only case where the absolute grounds examination can validly be re-opened. The procedure with WIPO and the holder is the same as for a “normal” provisional refusal.

If the first SGP has been sent and no oppositions were received, observations will be accepted until the second SGP is ready for sending but not thereafter.

If the Office considers the observations unjustified, that is, that they do not give rise to doubts as to the existence of absolute grounds for refusal, nothing will be notified to WIPO.

### **5.3. Information of the holder and the observer**

Irrespective of a provisional refusal, third party observations must also be dealt with as such in the normal way; that is, they must be properly communicated to the holder, and the observer must be informed in accordance with Communication No 03/02 of the President of the Office.

All third party observations received shall be communicated to the holder and a feedback must be given to the observer on the outcome of the procedure (provisional refusal with a letter and/or final outcome with another letter).

If the Office raises serious doubts (is convinced that the observations are justified), the first step is to send the notice of provisional refusal to WIPO , and thereafter the Office will inform the holder of the IR of the observations received and the observer of the provisional refusal based on its observations. In that case, the Office will also inform the observer about the outcome of the proceedings, namely whether or not the Office has confirmed the provisional refusal.

## **6. Opposition**

Opposition against the international registration may be filed between the sixth month and the ninth month following the date of first republication. Example: First republication done on 15.2.2005, opposition period starts on 16.8.2005 and ends on 15.11.2005. The opposition period is fixed and is independent of the outcome of the procedure on absolute grounds. Nevertheless, the start of the opposition procedure depends on the outcome of the absolute grounds examination.

For further details on the opposition procedure, please consult Opposition Guidelines.

### **6.1. No opposition and AG OK (first statement of grant of protection sent)**

If at the time the opposition period is over, the trade mark has been accepted on absolute grounds (first SGP sent) and no opposition has been received, the second SGP provided for in Rule 116 (1) CTMIR is sent to WIPO.

The second SGP is sent to WIPO after the examiner has checked if observations by third parties have been received in the meantime.

Once the second SGP is issued, the second publication will take place (Article 147 (2) CTMR), and the holder of the international registration is sure that the designation of the European Community can no longer be refused at all. Details of the second re-publication in part M.3.1 of the Bulletin can be consulted on-line and searched through CTM-ONLINE by putting the number of the IR and choosing “IR designating the EC as “trade mark basis”. As from that date, the international application has the same effects as a registered Community trade mark (Rule 116 (2) CTMIR in conjunction with Article 146 (2) CTMR). This effect will therefore arise before the 18 months time limit has passed.

### **6.2. No opposition and provisional refusal on AG pending**

If a mark faces a notice of refusal on absolute grounds but no opposition, no second SGP will be sent, even where a provisional refusal on absolute grounds can be lifted before the end of the 18 months period. If a provisional refusal is waived, the final acceptance will

be sent to the international holder and to WIPO simultaneously. Since the final acceptance is total by definition (otherwise, it will be a confirmation of a provisional refusal), it is a positive decision and it is not necessary to wait for the two months of appeal before sending the letter to WIPO.

In that case, the second SGP cannot be sent to WIPO in order to notify that the IR has not been opposed since a provisional refusal on absolute grounds has been previously sent to WIPO.

### **6.3. An opposition is filed**

#### 6.3.1. Timing

Oppositions filed after the re-publication of the IR but prior to the start of the opposition period will be kept on hold and be deemed to have been filed on the first day of the opposition period. If the opposition is withdrawn before that date, the opposition fee is refunded.

#### 6.3.2 Receipt and information of the international holder

The Office will issue a receipt to the opponent. If the opposition has been received before the beginning of the opposition period (Rule 114 (3)), a letter will be sent to the opponent, informing him that the opposition will be deemed received on the first day of the opposition period and that the opposition will be on hold until then.

The examiner will also send a copy of the opposition notice to the holder of the IR for information (Rule 16a CTMIR).

#### 6.3.3. Payment check

The opposition shall not be treated as duly entered until the opposition fee has been paid (Article 151 (2) CTMR). This is checked directly by the FD. If the payment can not be validated, a standard letter is sent to the opponent inviting him to explain the situation. If the receipt of the fee within the opposition period cannot be established, an examiner must send a standard letter declaring the opposition deemed not to have been entered.

If the opponent disagrees with this finding, he has the right to request a formal decision pursuant to Rule 54 (loss of rights). The decision of the Office to confirm this finding will be notified to both parties. If the opponent appeals the decision, the Office shall issue a provisional refusal to WIPO, even if incomplete, for the sole purpose of meeting the 18 months time limit. If the decision becomes final, the provisional refusal will be reversed. Otherwise, the opposition procedure will start in the normal manner.

#### 6.3.4. Admissibility check

The Office will examine whether the opposition is admissible in terms of Rule 17, whether the opponent has appointed a representative in accordance with Article 88 (2) CTMR, and whether it contains the data mentioned in Rule 115 which are the data

required by WIPO. If the opponent is not properly represented, this also constitutes a ground for inadmissibility. In the course of this examination, the Office may have to communicate directly with the opponent. If the opposition is considered not admissible, the OHIM will inform the holder of the IR of the decision accordingly (Rule 17 (5) CTMIR). In this case, no provisional refusal based on an opposition is sent to WIPO.

There are three main categories of deficiencies that can lead to the rejection of the opposition as inadmissible ex officio.

The first, relating mainly to the rights of the parties, may be remedied only within the 3 months of opposition period (Rule 15 (2) (a) to (c) CTMIR).

The second, relating mainly to the formal conditions of the notice, may be remedied within a period of two months, which can not be extended, from the notification of these deficiencies (Rule 15 (2) (d) to (h) CTMIR).

A third case arises when the notice of opposition is not filed in the first or the second language of the IR: the opponent has one month from the expiry of the opposition period to translate the opposition into the first or second language (Rule 16 (1) CTMIR).

#### 6.3.5. Language of proceedings

Oppositions (like cancellation requests) must be filed in the language of the international application (the first language) or in the second language which the international applicant is obliged to indicate when designating the EC. The opponent may choose one of the two languages that will become the language of the opposition proceedings. The opposition may also be filed in any of the other three Office languages provided that within a month a translation into the language of the proceedings is filed; Article 115 (6) CTMR and Rule 16 (1) CTMIR apply directly.

OHIM will use

- the language of the opposition proceedings in all communications made directly to the parties;
- the language in which the IR was registered by WIPO (first language) in all communications with WIPO (e.g., the provisional refusal).

#### 6.3.6. Representation of the holder

Where the holder of the international registration is obliged to be represented pursuant to Article 88 (2) CTMR, and where he has not already appointed a representative before the OHIM, the communication of the opposition pursuant to Rule 16a shall be done and the letter shall contain the invitation to appoint a representative within the meaning of Article 89 (1) CTMR within a period of two months from the date of notification of the communication (Rule 114 (4) CTMIR) (see below).

Where the holder of the international registration fails to appoint a representative before the OHIM within this period, the Office shall refuse the protection of the international registration.

The refusal of protection because of failure to appoint a representative will terminate the opposition proceedings. For the attribution of costs, the normal rules apply. This means that no decision on the costs will be taken and the opposition fee will not be refunded, unless the holder of the international registration has formally renounced the international registration before the provisional refusal was issued.

If he does appoint a representative, this will have no impact on the commencement of the cooling-off period pursuant to Rule 18 CTMIR.

#### **6.4. Provisional Refusal (based on admissible oppositions)**

Any opposition which is deemed to have been entered, and provided it is admissible, will lead to a provisional notification of refusal based on an opposition in accordance with Article 5 (1), (2) (a) and (b) of the Madrid Protocol and Rule 17 (1) (a) CR. Rule 115 (1) CTMIR makes provision for this.

The Office will send a notice of provisional refusal based on an opposition to WIPO. Each opposition duly entered within the opposition period will be notified to WIPO in a separate communication.

WIPO needs the list of goods and services against which the opposition is directed (that is, which are concerned by the notice of refusal) as well as the relevant list of goods and services on which the opposition is based (the list of goods and services for which the earlier mark is protected is not needed in case where the opposition is based on all the goods and services for which the earlier mark is protected).

The opponent must give the list of goods and services on which the opposition is based in the language of the opposition proceedings. The OHIM will send this list to WIPO in that language and will not translate it into the language in which the International Registration was registered (see Rule 17 (2) (v) CR).

WIPO then notifies the refusal based on an opposition to the international holder (or to its representative before WIPO if applicable). This does not replace the notification of the opposition as such to the holder (or to his representative before the OHIM if he has already and expressly been appointed), which has to be made separately by the OHIM, as in the case of a normal CTM pursuant to Rule 18 CTMIR.

The further procedure depends on the outcome of the absolute grounds examination.

##### **6.4.1. Staying of the opposition when AG not ok**

If the opposition was filed when the Office had already sent a provisional notification of refusal on absolute grounds, the Office shall communicate the complete opposition to the holder but shall inform him that as from now the opposition procedure is stayed until there is a final decision on absolute grounds. An adapted version of the normal letter shall be sent.

If the provisional refusal on absolute grounds leads to a final refusal of protection for all goods and services or for those which are contested by the opposition, the opposition procedure is closed, does not proceed to judgement, and the opposition fee is refunded. If the refusal on the absolute grounds is not maintained (for example, the holder succeeds on an appeal), the opposition procedure is resumed.

If the IR is cancelled from the International Register and the OHIM is informed by WIPO, (death message), the file is closed. If the IR has been cancelled for the EC further to a request of the holder, the opposition fee is reimbursed to the opponent since it is equivalent to a withdrawal of the CTMA (See Rule 114 (2) (b) and Rule 18(2) CTMIR). If the IR itself has been cancelled (and not only the EC designation) further, for example, to a request of the Office of Origin because the basic mark has been withdrawn, it is equivalent to a rejection of the CTMA in parallel proceedings under Rule 18 (2) CTMIR and the opposition fee is not reimbursed in that case.

#### 6.4.2. Examination of the opposition when AG ok

If the opposition was found admissible (letter sent to WIPO) and there was no provisional refusal on absolute grounds, i.e. after a first SGP was sent, a letter is sent in order to fix the time limits for the opponent to complete his opposition. The Office also sends a letter to the international holder in order to give him a time limit to reply to the opposition at the end of the cooling-off period, in the same way as for a direct CTM case (Rule 18 CTMIR).

The subsequent opposition procedure is the same as for a normal CTM. Pursuant to Article 151 CTMR, international registrations designating the European Community shall be subject to opposition in the same way as published Community trade mark applications. Rules 15 to 22 CTMIR apply to the opposition proceedings subject to the special implementing rules provided in Rule 114 CTMIR.

### **6.5. Confirmation or withdrawal of provisional refusal**

If one or several notifications of provisional refusal have been sent to WIPO, the OHIM must, once all procedures have been completed (eventually after an appeal or a further appeal in Luxembourg),

- check whether reimbursement of the equivalent of the registration and class fees are due, then
- send to WIPO a statement indicating whether the provisional refusal has been confirmed or totally or partially reversed by the examiner, the Board of Appeal or the Court of Justice.

There is no intermediate notification to WIPO on the outcome of the procedure on examination on absolute or relative grounds.

If there is a partial refusal on absolute grounds and an opposition on the remaining goods and services, one sole communication will be sent to WIPO once all the procedures are over (which may be due to a renunciation of the remaining goods or services, or due to the final opposition decision). This communication will indicate

- that the provisional refusal is withdrawn (i.e. for all the goods and services) or
- that the mark is refused or renounced (for all the goods and services) or, as the case may be,
- the goods and services for which the mark is finally accepted (i.e., which remain protected after all the procedures on absolute and relative grounds for refusal).

The final list will be created in Euromarc (opposition module) and it will then have to be imported into MPS.

Example: The international registration contains three classes. The goods in class 1 are the subject of an ex officio provisional refusal because the mark is considered descriptive in respect of these goods only. The refusal is confirmed by the Boards of Appeal (after the 18 months period). Meanwhile an opposition has been entered against the goods in classes 2 and 3. The opposition procedure starts once the decision to refuse class 1 has become final. The holder of the international registration renounces before the OHIM class 2 in view of the opposition. In respect of class 3, the opposition is then rejected by final decision of the Boards of Appeal. Once this decision becomes final, the Office will send one single communication to WIPO that the mark is protected in the EC in respect of the goods in class 3.

As illustrated on the above example, it is possible to partially renounce goods and services before the OHIM in case a provisional refusal has been issued. In this case, the OHIM will be able to communicate to WIPO that some goods and services have been finally accepted. It is irrelevant for WIPO to know the reasons of the final acceptance (partial withdrawal or refusal).

On the contrary, if the international holder wishes to totally withdraw its designation of the EC (renunciation of protection in respect of the EC for all the goods and services), he must have it recorded with WIPO (see Rule 25 (1) (b) Common Regulations). A request to record a renunciation must be presented to the International Bureau by the International holder on the appropriate official form (MM7) established by the IB or on a form having the same contents and formats. The OHIM can not act as an intermediary to forward the request to WIPO.

Payment check of the equivalent of the registration fee and class fees (FD):

A reimbursement is to be made if and to the extent the international registration designating the EC is not finally accepted see Article 149 (4) and 151 (4) CTMR, and Article 13 (3) CTMFR.

A reimbursement is necessary:

- when the refusal of the IR was confirmed in total; the reimbursement will consist of the amount of 850 Euro corresponding to the registration fee plus 150 Euro for each class beyond three contained in the original IR;
- depending on the number of classes in cases where the refusal of the IR was confirmed only in part; the reimbursement will consist of 150 Euro for each class beyond three which is finally refused. That is, the class fees for the registration are due only to the extent that the mark remains protected.
- when the IR has been renounced before WIPO.

Example: The IR designating the EC covers 5 classes. The holder withdraws class 1 before the OHIM. For only some goods falling into class 2, the opposition division finds likelihood of confusion. The provisional refusal is confirmed to WIPO for class 1 as a whole (in fact it has been withdrawn but WIPO is interested only in the consequence of the procedure) and for some goods falling into class 2. The IR remains protected as a CTM for four classes (even if one class has been limited). 150 Euro shall be refunded.

The refund is made in Euro and to the holder of the IR or, if he has appointed a representative before OHIM, to that representative (Article 13 (4) CTMFR). To this end, FD sends a Standard Letter inviting to supply bank details. The reimbursement will then be made by bank transfer. The Office does not take into account whether a representative before WIPO has been appointed.

## **7. Second publication**

The second publication done by the OHIM will take place when as the result of the procedure the IR remains protected for the EC, i.e. either

- if a second SGP has been sent, or
- if all provisional refusals have been withdrawn or reversed (at least in part).

The date of the second publication will be the starting point for the five years use period (Article 155 CTMR) and from which the registration may be invoked against an infringer (Article 146 (3) CTMR).

According to Article 147 (2) CTMR, only the following data will be published in part M.3.1 of the Bulletin:

111	Number of the international registration
460	Date of publication in the International Gazette (if applicable)
400	Date(s), number(s) and page(s) of previous publication(s) in the CTM Bulletin

450 Date of publication of the international registration or subsequent designation in the CTM Bulletin

The date of the second re-publication can be searched through CTM-ONLINE by putting the number of the IR and choosing “IR designating the EC as “trade mark basis”.

## **8. Seniority claims before the OHIM**

Article 35 CTMR provides for the possibility to claim seniority following registration of the Community trade mark. Article 148 (2) CTMR allows to make such a seniority claim in respect of an international registration after the second publication. Rule 110 CTMIR implements this and provides for a similar procedure for the examination of such seniority claims.

If the seniority claim does not contain all the elements mentioned in Rule 110 (3) CTMIR, the sanction is the refusal of the application to claim seniority.

Only accepted seniority claims are notified to WIPO (Rule 21bis (1) CR, Rule 110 (5) CTMIR). The data to be notified are:

- Country;
- Registration number;
- Filing date;

In parallel, the national offices concerned are to be informed of the seniority claim (Rule 110 (6) CTMIR).

Where the application to claim seniority is rejected by the Office, no communication to WIPO is necessary.

## **9. Subsequent designations**

There are no differences in the proceedings from OHIM’s perspective. The term “international registrations designating the European Community” covers both territorial extensions pursuant to Article 3 ter (1) of the Madrid Protocol and subsequent territorial extensions pursuant to Article 3 ter (2) of the Madrid Protocol, and Rules 112 - 117 CTMIR apply to both.

## **10. Transfer of the designation of the EC**

The international registration effected by WIPO is one registration in administrative terms (as an entry in the International Register and the subject of WIPO publications), but it is actually a bundle of national (regional) marks when looking at the substantive effects and the trade mark as an object of property. As regards the nexus to the basic mark, the

international registration must originally be in the name of the proprietor of the basic mark but may thereafter be transferred independently of the basic mark. The international registration is dependent on the basic mark but its designations are independent from each other.

In fact, a “transfer of the international registration” is but a transfer of the mark with effect for one, several or all designated Contracting Parties, that is, equal to a transfer of the corresponding number of national (regional) marks.

A recordal of a change of ownership of an IR in respect of the designation of the EC may have been made by WIPO on the basis of a request filed at WIPO, or a request filed at any other office. This will be notified by WIPO to OHIM and will be automatically integrated in our data base, i.e. in MPS (Madrid Protocol System). This notification is of immediate concern for OHIM because in pending and future procedures before OHIM (e.g., provisional refusals, cancellation requests), we must correspond with the new holder.

A request for recordal of a change of ownership of an IR may also be filed at the OHIM but only if the OHIM is the competent Office of the Contracting Party of the holder. There are two sub-cases:

(1) In 99 % of the cases the OHIM will also be the Office of Origin. In these cases the request for recordal will necessarily concern other designated offices only because there is no designation of the EC (no self-designation).

(2) In rare cases the Office of Origin will be another office but the OHIM has become the Office of the Contracting Party of the holder because another transfer (not the one for which the request is made) has been registered and the current holder of the IR has nationality, domicile or establishment in the EC. In these cases the transfer may concern the designation of the EC and/or other designations.

In both cases the OHIM has to deal with the request as outlined in 4.1 (if the request is made by the holder) or in 4.2.

This also applies in the second case; which designated offices are concerned by the transfer, does not matter.

In the second case the OHIM will still be notified by WIPO in its capacity as designated office. This is independent from where the request for recordal of the change was filed.

In its capacity as a designated office, the OHIM has nothing to examine as regards the transfer. Rule 27 (4) CR allows a Designated Office to send a declaration to WIPO that as far as its designation is concerned, a change of ownership has no effect, but this provision is not applied by OHIM. The reasons are: the OHIM does not have the authority to re-examine whether the change in the International Register was based on proof of the transfer. There is no reason to examine the transfer as to potential deceptiveness (Article 17 (4) CTMR), since that can be raised in a cancellation proceeding.

Changes of ownership may not be presented directly to the OHIM in its capacity as designated office. Changes of ownership in the basic mark are not relevant for the international registration.

## **11. Cancellation**

The effects of an international registration designating the EC may be declared invalid and the application for invalidation of the effects of an international registration designating the EC shall take the place of an application for declaration of revocation as provided for in Article 50 or for invalidation as provided for in Article 51 or 52 CTMR (see Article 153 CTMR).

There is no time limit for filing an application for cancellation in general. However:

- an application for cancellation of an international registration designating the EC is only admissible once the designation has been finally accepted by the Office, namely once a Second Statement of Grant of Protection has been sent or a provisional refusal withdrawn (see Article 146 (2) CTMR).
- an application for revocation on the basis of non-use of an international registration designating the EC is only admissible if at the date of filing the request, the final acceptance of the IR has been re-published by the Office at least five years earlier (see Article 155 CTMR stating that the date of publication pursuant to Article 147(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is subject of an IR designating the EC must be put to genuine use in the Community).

Then, the Office will examine the request as if it was directed against direct CTMs (please refer to cancellation guidelines).

If the IR designating the EC is cancelled totally or partially, the Office will notify WIPO according to Article 5(6) Madrid Protocol and Rule 19 Common Regulations. The International Bureau will record what is called an "invalidation" and publish it in the International Gazette.

## **12. Differences to the direct route**

The following existing tasks for direct CTMs will not be carried out by the OHIM for IRs designating the EC:

- scanning
- mail dispatch
- key-in
- receipt
- filing date
- priority check
- classification check
- translation
- registration

- registration certificate
- records of changes in the Register
- renewals

Furthermore, the second publication will take place only if the mark remains protected (that is, if no refusal has been issued, if a refusal has been withdrawn or otherwise waived, or if the mark is partially accepted). Refusals will not be published (see Article 147(2) CTMR).

On the other hand, the OHIM will also have a few additional tasks such as:

- notifications to WIPO
- reception and admissibility examination of oppositions even when there was an absolute grounds refusal
- refund of the equivalent of the registration fee in case the designation is not (or not totally) accepted.

## **SECTION 3: CONVERSION, TRANSFORMATION, REPLACEMENT**

### **1. Preliminary Remarks**

#### **1.1. Conversion<sup>3</sup>**

The legal possibility to convert finds its origin in the CTM System (Article 108 to 110 CTMR). The CTM System has been adapted in order to allow converting a designation of the EC through an IR into national trade mark application, just as possible for a direct CTM. The CTM System and Madrid System have also been adapted in order to allow for conversion into a designation of Member States party to the Madrid System (the so called “opting back” type of conversion).

In order to allow this second type of conversion, it has been imagined that what the Office usually receives as a request for conversion will become a request for subsequent designation of the Member State (Contracting Party) concerned when forwarded to WIPO. This will be a unique type of subsequent designation that instead of being filed with the Office of Origin or with WIPO directly, will have to be filed through the Designated Office (see Rule 24 (2) (a)(iii) CR).

#### **1.2. Transformation**

Transformation is a legal feature that finds its origin in the Madrid Protocol only. It has been introduced in order to soften the consequences of the five years dependency period already existing under the Madrid Agreement and dreaded by the users (see Article 6(3) MP). Where an IR is cancelled as a consequence of the ceasing of effect of the basic mark and the holder files an application for the same mark with the Office of any Contracting Parties in which the IR had effect, such application will be treated as if had been filed on the date of the IR.

#### **1.3. Replacement**

Replacement is a legal feature that finds its origin in the Madrid Agreement and in the Madrid Protocol. A mark that is registered in the Office of a Contracting Party is under certain conditions deemed to be replaced by an international registration of the same mark without prejudice of the rights acquired (earlier date). The wording of Article 4 4 bis (1) MP clearly provides that the replacement is deemed to take place automatically, without any action by the holder being necessary and without any record having to be made of the replacement. Nevertheless, since 1/4/1996, it is possible upon request to ask the Office to take note in its Register of the replacement (Rule 21 CR). The purpose of this procedure is to ensure that the relevant information concerning the replacement is

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<sup>3</sup> Normal type of Conversion of a CTM which served as a basis for an IA is also possible but since there is nothing particular about this type of conversion, it is left out of the present guidelines. For more details, please refer to Conversion Guidelines. It is only mentioned in order to illustrate that Conversion of the direct CTM and Replacement of the IR based on the CTM can be asked in parallel.

made available to third parties in the national or regional registers as well as in the International Register. In other words, it is not an obligation to have the replacement registered in order to be able to invoke it but it can be useful.

Apart from the qualification relating to the earlier acquired rights, neither the Agreement nor the Protocol elaborates further on replacement. Divergent views and practices as regards conditions and effects of replacement is certainly one of the reasons why it has been rarely used by international holders (700 recordings in the International Register from 1/4/ 1996 till 31/12/2005).

#### **1.4. What right did I have (national, international or community trade mark), what right will I get (national, international or community trade mark)?**

**Conversion** involves a designation of the EC that has been withdrawn, refused or ceased to have effect under CTM Regulations on the one side and national trade mark application(s) in the Member States and/or subsequent designations of the Member States on the other side. By definition, an EC designation cannot be converted into a direct CTM, but into national applications or into designations of contracting parties within the IR.

**Transformation** involves a mark of origin and an international trade mark designating the EC which is cancelled at the request of the Office of origin on the one side and a direct CTMA on the other side. This filing is not governed by the Protocol or the Regulations, nor is the International Bureau involved in any way. It was up to the Community legislator to determine the modalities for giving effect to such transformation into a CTMA. Unlike conversion, transformation of the EC designation into national applications is not possible.

**Replacement** involves a direct CTM on the one side and a designation of the EC through an IR on the other side.

#### **1.5. Conversion or Transformation?**

Both apply when the IR designating the EC ceases to have effect but for different reasons:

- When the IR and its designations cease to have effect because the mark of origin has been “centrally attacked” during the 5 years dependency period, transformation into a direct CTM application is possible. Transformation is not available when the IR has been canceled at the request of the holder.

The EC designation must still be effective at the moment the transformation is requested, that is, it must not have been finally refused by the Office, otherwise, there will be nothing left to transform and conversion of the designation would be the only possibility.

- When the IR designating the EC is finally refused by the Office or ceases to have effect for reasons independent of the basic trade mark, only conversion is available.

In case the designation was finally refused by the Office and then the international mark is cancelled from the International Register at the request of the Office of Origin, a

conversion request in accordance with article 154 (2) CTMR may however be filed within a time limit of three months following the day on which the refusal decision becomes final. There is no choice between converting or transforming. Transformation is no longer possible since the designation does not exist anymore. This is why conversion should be opened even if in the meanwhile, the IR has been cancelled from the International Register at the request of the Office of Origin.

A conversion under article 154 (2) CTMR would also be possible if the cancellation of the IR is requested by the holder or by another Office, in other words, when transformation under article 9 *quinquies* of MP and article 156 of CTMR is not available.

### **1.6. Conversion and Transformation**

When a CTMA has been used as basic trade mark for an international application and it is then refused by the Office during the five years dependency period, the CTM applicant will be able to ask for the “normal” conversion of his CTMA into national applications **and** to ask for the Transformation of his cancelled IR into national applications of the designated countries. These transformation requests have to be filed with the national offices and the OHIM will not be involved as it was Office of Origin in this case.

### **1.7. Replacement and Transformation**

If the IR which replaced the direct CTM ceases to have effects following a “central attack” and provided that the conditions prescribed by Article 9 *quinquies* of the Protocol are met, the holder can request a transformation of the IR under Article 9 *quinquies* while maintaining the effects of the replacement of the CTM and its earlier date effects including priority or seniority if applicable.

### **1.8. Replacement and Conversion**

The IR and the national registration should co-exist on the date of the IR for the Replacement to be effective. Therefore, if the IR which replaces the direct CTM is finally refused by the Office (further to an opposition for example), the holder can request the conversion of the designation of the EC and should be able to maintain the effects of the replacement of the CTM and its earlier date effects, including priority or seniority if applicable.

## **2. Conversion<sup>4</sup>**

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<sup>4</sup> In English, the term “Conversion” is used to qualify a specific legal provision of the CTM System (Article 108 and following) while the term “Transformation” is used to qualify another legal provision in Article 9 *quinquies* of the Madrid Protocol. In other languages, the same word is used to qualify the two different legal provisions in both systems (in Spanish “Transformación” for example). In order to avoid confusion, it would be useful to use the English word “Conversion” in parenthesis when “Trasformación” in Spanish for example is used in the sense meant by Article 108 CTMIR.

## 2.1. Principles

The holder of an IR designating the EC may request the conversion of a designation of the EC:

- into national trade mark applications in one, more or all of the Member States;
- into subsequent designations of one or more Member States under the Madrid Agreement or Protocol (the so-called “opting-back” type of conversion), provided that the Member State was a party to either Treaty not only at the point in time of the conversion request, but already on the date the IR designated the EC;
- into national trade mark applications for some Member States and subsequent designations for other Member States, it being understood that any of the Member State can only be designated once.

## 2.2. Grounds

Conversion is possible where the designation of the EC in an IR

- has been finally totally or partially **refused by the Office** (Rule 113 (2)(b), (c), 115 (5) (b) (c) CTMIR);
- totally or partially **ceases to have effect** in the following circumstances :
  - where the effects of an IR designating the EC have been **invalidated** by the Office or a CTM Court (Article 153 CTMR, Rule 117 CTMIR);
  - where a **renunciation** of the designation of the EC or a **cancellation** of the IR has been recorded in the International Register (Rule 25 (1), 27 CR);
  - where the Office is informed by WIPO that the IR has **not been renewed provided that the grace period for the renewal is over** (Rule 31 (4) (a) or (b) CR).

In all these cases, the time limit of three months for requesting conversion starts automatically, namely,

- where the IR designating the EC is refused, **on the day on which the decision becomes final**<sup>5</sup>;
- where the IR designating the EC is declared invalid or revoked, **on the day on which the decision of the Office or the judgment of the CTM Courts becomes final**<sup>6</sup>.
- where protection of the IR has been limited or renounced with effect for the EC, **on the day as of which it has been recorded by WIPO pursuant to Rule 27 (1) CR.**

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<sup>5</sup> A decision of the Office becomes final

- where no appeal is lodged, at the end of the time limit for appeal of two months;  
- otherwise, at the end of the time limit for action before the Court of First Instance, or, where applicable, with the final decision of the Court of Justice.

<sup>6</sup> A decision of a CTM Court becomes final,

- where no appeal is lodged, at the end of the time limit for appeal under national law;  
- otherwise with the final decision of the CTM Court of last instance.

- where the IR was not renewed with effect for the EC, **on the day following the last day on which renewal may still be effected before WIPO pursuant to Article 7 (4) MP (after the six month grace period).**

### **2.3. Effects**

In the case of a conversion into a national trade mark in a Member State, the mark will enjoy the original date of the designation of the EC through an IR, including, if appropriate, of its priority or seniority date.

In the case of an opting-back conversion, the subsequent designation of the Member State under Rule 24 (6) (e), (7) of the Common Regulations will enjoy the original date of the designation of the EC through the IR, including, if appropriate, of its priority or seniority date.

### **2.4. Conversion and Seniority**

As explicitly foreseen in Article 154 (2) CTMIR, and as for a normal type of conversion of a direct CTM, the national mark application or the designation of the Member State through an IR resulting from the conversion shall enjoy the seniority of a trade mark in that State. In case of a subsequent designation resulting from an “opting back” type of conversion, the data related to the seniority claims will therefore be forwarded to WIPO as they are forwarded to national Offices in the normal type of conversion.

### **2.5. Procedure**

**The application for conversion has to be submitted to the Office in all cases,** included for an opting back and when the ceasing of effects of the EC designation results from the renunciation of the designation before WIPO.

OHIM’s IR Conversion Form should be used if conversion of an IR designating the EC is requested, including in the case of an opting-back. WIPO Form MM 16 “Subsequent Designation Resulting from Conversion (EC)” may also be used but this is not recommended because it can only be used for the “opting-back” type of conversion and also because OHIM’s IR Conversion Form is more detailed.

For further details on conversion, please also consult Conversion Guidelines Part E section 2.

### **2.6. Fees**

The fee to be paid to the Office for requesting the conversion an IR designating the EC is 200 €

Since an “opting back” type of conversion is treated by WIPO as a subsequent designation, all fees related to the subsequent designation will have to be paid directly to

WIPO. WIPO Fee Calculation Sheet should therefore be enclosed exactly as it should be for an international application or a “normal” subsequent designation.

## **2.7. Professional Representation:**

As for all procedures before the Office, specific rules on professional representation apply (Article 88 and 89 CMTR).

In the case of an opting back conversion, WIPO will use the representative appointed before it for the IR. In case the Office representative wants to be appointed for procedures before WIPO relating to the subsequent designation resulting from the conversion, he must say so and his name will be transmitted to WIPO by the Office.

## **2.8. Service responsible at the OHIM:**

All types of conversion requests are examined by the Register and Related Databases Service (also called “the Register”).

For the Office, the opting back kind of conversion will bring no changes except that instead of sending the request to different national Offices, it will be send to WIPO. In particular, the Office will not interfere in payments that will have to be made to WIPO (using the Fee Calculation Sheet) but it will only deal with the payment of the 200 € fee for conversion, exactly as it does for conversion of direct CTMs.

For example, it will be checked that the person requesting the conversion is the holder of the IR as recorded in the International Register at the time of the request); The Office will also have to certify that the goods and services are within the scope of the goods and services that were refused on the CTM.

In addition to the conditions applicable to the normal types of conversion requests (see Conversion Guidelines at <http://oami.europa.eu/en/mark/marque/direc.htm>),

- Before sending a request for conversion to WIPO, the Office will check that the cause of the ceasing of effect of the CTM has been duly communicated to WIPO beforehand. If it is not the case, this will have to be done immediately.
- The examiner will also have to check an additional condition mentioned in Rule 123: *“the Office shall also reject the application for conversion where the conditions to designate the Member State which is party to the Madrid Protocol or the Madrid Agreement were not fulfilled both on the date of the designation of the EC and on the date on which the application for conversion was received”*.

This condition is linked to the fact that there is not necessarily a coincidence between membership of EC and membership to the Madrid Protocol. If we take the example of Malta, it is member of the EC but not member of the Madrid system yet. Until Malta joins the Protocol, the Office will not be able to accept an “opting back” conversion for a subsequent designation of Malta. When Malta will join the Protocol, the Office will have to check if it was member of the Protocol not only at the moment of the conversion

request but also at the moment of the original designation of the EC. This condition has been added in order not to grant retroactive effect to Madrid membership (i.e. with a date of effect prior to the ratification of the Madrid Protocol by a Member State).

## **2.9. Publication**

The Office will publish the conversion in part E5 of the Bulletin (see Vademecum on line on our Website at <http://oami.europa.eu/en/Office/diff/default.htm>).

## **3. Transformation**

Article 9 quinquies MP, Art. 156 CTMR, Rule 84 (1) (p) and Rule 124 CTMIR
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### **3.1. Principle and effects**

Following a **cancellation of an IR designating the EC at the request of the Office of origin** under Article 9 quinquies of the Protocol (i.e., following the so-called “central attack” during the five years dependency period), the holder may file a “direct” CTM application for the same mark with the Office under Article 9 quinquies of the Protocol.

It is not possible to transform an EC designation into individual Member States designations, although their territory is included in the geographical scope of protection of the EC designation (in fact, some national marks like French or UK marks have different geographic scope of protection). If the EC has been designated, the IR had effect in the EC and not in individual Member States as such. It must be reminded that the reason of introduction of transformation into the Protocol is to soften the effects of the so-called “central attack” and not to allow a “conversion” of an EC designation into national filing.

The application shall be treated by the Office as though it had been filed on the date of the IR or where the EC was designated subsequently to the IR, the date of the subsequent designation.

### **3.2. Procedure**

A) Examination of the request for transformation itself:

The conditions under Article 9 quinquies of the Madrid Protocol for keeping that date are

- that the application is filed within a period of three months from the date on which the IR was cancelled, and
- that the goods and services of the ensuing application are in fact covered by the list of goods and services contained in the IR “in respect of the Contracting Party concerned”, that means, as in force for the European Community (because the IR may be for different goods and services in respect of different Contracting Parties).

The applicant needs to make the claim in the CTM application form. The CTM application form has been amended as follow in order to allow the following indications:

- (1) Indication of the number of the IR which has been cancelled; The OFFICE will then be able to retrieve details of the IR in order to check that the list of goods and services of the CTM is covered by the IR in respect of the EC.
- (2) Date on which the IR was cancelled by the International Bureau; This date will be used to check that the CTM application is filed within a period of three months from the date on which the IR was cancelled
- (3) Date of the IR pursuant to Article 3 (4) of the Madrid Protocol or the date of recordal of the territorial extension to the European Community made subsequently to the IR pursuant to Article 3 ter (2) of the Madrid Protocol; The date of the IR will not become the filing date of the Community trade mark application within the meaning of Article 27 of the Regulation, but will be the date determining the “earlier right effect” of the Community trade mark.
- (4) Where applicable, date of priority or seniority claimed in the international application/registration as entered in the International Register kept by the International Bureau.

If any deficiency is noted, the Office will invite the applicant to remedy within a time limit of 2 months. The remedy may consist of restricting the list of goods and services of the CTM application or of convincing the Office that the three months time limit was actually met.

Unlike the case of priority and seniority claims (cf. Rule 9 (8) CTMIR), a “split” or “partial” date of the IR for only those goods which were contained in the IR, with the filing date of the Community trade mark application being the relevant date for the additional goods and services, is not possible. Such a partial transformation effect is not foreseen in Article 9 quinquies of the Madrid Protocol, nor in Article 156 CTMR.

If the deficiencies are not remedied, the right to the date of the IR or the territorial extension and, if any, of the priority of the IR shall be lost, in the same way as will be done in cases where the Office does not accept a priority or seniority claim (Rule 9 (6), (7) CTMIR). In other words, should the transformation be finally refused, the CTMA will be examined as a “normal” application.

B) Examination of the CTMA resulting from the transformation of an IR:

In the CTM Regulations, transformation is governed by Article 156 CTMR and Rule 124 CTMIR.

- (1) When the application for transformation relates to an IR designating the European Community the particulars of which have not been published pursuant to Article 147(2) CTMR (it has not been finally accepted by the Office), the CTM resulting from transformation will be treated as a normal CTM application and will be examined as to absolute grounds and published for oppositions purposes. Nothing in the regulations allows the Office to skip the examination process.

Nevertheless, since this case presupposes a situation where an IR designating the Community had already existed, the Office can take advantage of the classification of the list of goods and services of the cancelled IR, (as far as it complies with our rules) and also of the search reports which had already been issued for that IR (because the date of the ensuing CTM application is the same as the date of the original IR, so that the search report must by definition come to the same results). If the IR had already been accepted on absolute grounds, the same result should be confirmed. Then, the CTM will be published in part A of the Bulletin for opposition purposes with an additional field under INID code 646 mentioning the details of the transformation.

The rest of the procedure will be the same as for a normal CTM including if the opposition procedure had already started against the IR designating the EC without reaching the final decision stage. In that case, the previous procedure has been closed and the application has to re-start again from the beginning (confirmation of AG examination, new publication for opposition, etc.).

Article 9 quinquies MP mentions that the transformed application “*shall be treated as if it had been filed on the date of the IR*”. This does not mean that transformation date will become the filing date of the CTMA (in fact, Article 27 CTMR which applies *mutatis mutandis*, fixes clear conditions for the granting of a filing date, subject also to the payment of the application fee within one month) but will be used to determine the earlier date effect for purposes of priority searches, oppositions, etc.

Renewal will start to run as from the filing date of the transformed CTM, which is a solution favourable to the applicant, this date being by definition later than the date of the international registration. In fact, the transformation mechanism is similar to seniority claims under the CTM System and similar solutions can be adopted where possible.

- (2) When the application for transformation relates to an IR designating the European Community the particulars of which have already been published pursuant to Article 147(2) CTMR, the examination and opposition stage are skipped (Article 38 to 43 CTMR).

Nevertheless, the list of goods and services will have to be translated in all languages, published in part A.2 of the Bulletin with the INID code 646. Then the Office will invite payment of the registration fee and once the fee paid, the CTM will be normally published in part B.1. of the Bulletin and a certificate issued.

### **3.3. Transformation and Seniority**

If there are seniority claims accepted by the Office and registered by WIPO in the file of the transformed IR designating the EC, it will not be necessary to claim them again in the CTM resulting from transformation. This solution is not explicitly foreseen in Rule 124(2) CTMIR (only priority is mentioned under (d)) but it seems fair considering that the condition is that:

- the Office had already accepted the claims and WIPO has published them,
- in the case where their owner had let the earlier marks lapse in the meanwhile, they will not be able to file new claims before the Office (a condition of a valid seniority claim being that the earlier right is registered and in force at the moment the claim is made).

### **3.4. Service responsible at the OHIM**

The examiner in charge of the CTMA will carry on both types of examination.

### **3.5. Fees**

There are no specific “transformation” fees and the request for transformation is free.

The CTM application resulting from the transformation of the IR designating the EC is submitted to the same fees as for a direct CTM application, namely application fees and registration fees.

The CTM application fee must be paid to the Office within one month of the filing of the CTM requesting transformation in order for the request to comply with Article 27 CTMR and Article 9 quinquies (iii) and the transformation to be accepted (example: end of the 3 month time limit to transform 1/4/2006, filing of the CTMA requesting transformation on 30/3/2006, deadline for payment of the CTM application fee 30/4/2006. If payment occurs after that date, the conditions for transformation will not be met, it will be refused and the CTMA will be given as filing date the date of the payment).

## **4. Replacement**

Article 4 bis MP, Rule 21 CR, Article 152 CTMR, Rule 84(2) CTMIR
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### **4.1. Principle and Effects**

In accordance with Article *4bis* of the Agreement and the Protocol, the holder **may** request the Office to take note in its Register that **a CTM registration is replaced by a corresponding IR. The holder’s rights in the EC should be deemed to start from the date of the earlier CTM registration.** A reference will therefore be introduced in the Register that a direct CTM has been replaced by a designation of the EC through an IR and published.

## 4.2. Procedure

A request for replacement may be filed at the Office at any time after the notification by the International Bureau of the IR designating the EC replacing the direct CTM.

Once a request to record a replacement will be directly sent at the Office by the international holder, we will take note in our Register that the replacement is asked after a formal check equivalent to the one that is done for seniority claims.

In other words, the Office will:

- check that the marks are the same,
- check that the CTM has been registered prior to the designation of the EC,
- check that there are G&S in common in the CTM and in the IR,
- will not check that the marks are in the name of the same persons since an assignment may occur after we have taken note of the replacement.

The Office considers that it is enough that the IR and the CTM co-exist on the date of the IR for taking note of the Replacement in the Register. In particular, should the designation of the EC through an IR not being finally accepted yet, the Office will not wait for its final acceptance in order to record the replacement. It is up to the international holder to decide the timing of requesting the replacement.

More generally, it is considered that it is for the holder to satisfy himself whether the conditions for replacement are fulfilled.

Then, as per Rule 21 CR, the Office will have to notify WIPO that a CTM has been replaced by an IR indicating:

- the number of the IR,
- the CTM number
- the CTM application date
- the CTM registration date
- priority date(s) (if relevant)
- seniority date(s) and countries (if relevant)
- list of goods and services of the replacement (if relevant)

After the CTM has been replaced by the IR and note of the replacement has been taken, as so requested by the holder, in the CTM Register, the CTM is maintained normally in the Register as long as the holder renews it. In other words, there is coexistence between the replaced CTM in force and the IR designating the EC. It would be in the interest of the holder that the CTM is not allowed to lapse and is renewed during the five-year period during which the IR is dependant on the fate of the basic mark (dependency period).

According to Rule 21(2) of the Common Regulations under the Madrid Agreement and Protocol, the International Bureau shall record the indications notified under paragraph (1) in the International Register, publish them and shall inform the holder accordingly.

The purpose of these procedures is to ensure that the relevant information concerning the replacement is made available to third parties. Nevertheless, there is no obligation for the Office to communicate further changes affecting the replaced CTM.

#### **4.3. Fees**

The request for taking note of a replacement is free of charge.

#### **4.4. Publication**

According to Rule 84(2) CTMIR, the replacement is entered in the Register and Rule 85 CTMIR foresees that all entries made in the Register must be published in the CTM Bulletin. The replacement will therefore be published in the CTM Bulletin under part C.3.7 (for more details, see Vademecum on line on our Website at <http://oami.europa.eu/en/Office/diff/default.htm>).

#### **4.5. Replacement and Seniority**

Since replacement occurs “*without prejudice to any rights acquired*” (Article 4 bis (1) MP) by virtue of the earlier registration, the Office will include information on the seniority claims contained in the replaced CTM registration within the content of the notification to be sent to WIPO under Rule 21 of the Common Regulations.