

***GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)***

PART M

INTERNATIONAL MARKS

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The European Union acceded to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks on 01/07/2004.

This part of the Guidelines focuses specifically on the examination of international marks. For further details on general aspects of procedure, please also consult the other relevant parts of the Guidelines (examination, opposition, cancellation, etc.).

1 Introduction

The purpose of this part of the Guidelines is to explain how, in practice, the link between the European Union trade mark (EUTM) and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol or MP) affects procedures and standards of examination and opposition at the EUIPO. Paragraph 2 deals with the EUIPO's tasks as an office of origin, that is to say, with 'outgoing' international applications. Paragraph 3 deals with its tasks as a designated office, that is to say, with 'incoming' international registrations designating the EU (IRs). Paragraph 4 deals with conversion, transformation and replacement.

The Guidelines are not intended to, and cannot, add to or subtract from the substance of Chapter XIII EUTMR. The EUIPO is also bound by the provisions of the Madrid Protocol and the Common Regulations (CR). Reference may also be made to the 'Guide to the International Registration of Marks' published by WIPO, as the Guidelines are not intended to repeat what is said there.

2 The EUIPO as Office of Origin

The tasks of the EUIPO as an office of origin comprise:

- examining and forwarding international applications;
- examining and forwarding subsequent designations;
- handling notices of irregularity issued by WIPO;
- notifying WIPO of certain facts affecting the basic mark during the five-year dependency period;
- forwarding certain requests for changes in the International Register.

2.1 Examination and forwarding of international applications

Article 183 and Article 184(1) EUTMR Article 28 EUTMIR

International applications filed with the EUIPO are subject to:

- payment of the handling fee;
- the existence of (a) basic EUTM registration(s) or application(s) ('basic mark(s)') for an identical mark;
- proper completion of the MM2 or EM2 form (either by e-filing or in paper format);
- an entitlement to file the international application through the EUIPO.

Payment can be made using any of the means of payment accepted by the EUIPO (for details, see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges, paragraph 2).

2.1.1 Identification of international applications

An international application will be identified in the EUIPO database by the basic EUTM/EUTM application number followed by the suffix **_01** (e.g. 012345678_01) if it relates to a first international application. Further applications based on the same basic EUTM/EUTM application will be identified by **_02**, **_03**, etc. International applications based on more than one EUTM/EUTM application will be identified by the number of the earliest EUTM/EUTM application.

Upon receipt of an international application, the examiner will send a receipt to the applicant, quoting the file number.

2.1.2 Fees

2.1.2.1 Handling fee

Article 184(4) and (8), and Article 188 EUTMR Annex I A(34) EUTMR
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An international application is only deemed to have been filed if the handling fee of EUR 300 has been paid.

Payment of the handling fee must be made to the EUIPO by one of the accepted means of payment (for details, see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges, paragraph 2).

Where the applicant chooses to base the international application on an EUTM application once it has been registered, the application for the IR is deemed to have been received on the date of registration of the EUTM; therefore, the handling fee will be due on the date of registration of the EUTM.

When the application is not submitted by e-filing, the means of payment used may be communicated to the EUIPO by ticking the appropriate boxes on the EM2 form or by giving this information in the letter accompanying the MM2 form.

If, in the course of examination of the international application, the examiner finds that the handling fee has not been paid, the examiner will inform the applicant and ask it to pay the fee within two months. If payment is made within the two-month time limit set by the EUIPO, the date of receipt that the EUIPO will communicate to WIPO will be the date the payment reaches the EUIPO. If payment is still not made within the two-month time limit set by the EUIPO, the EUIPO will inform the applicant that it considers the international application not to have been filed and will close the file.

2.1.2.2 International fees

All international fees must be paid directly to WIPO. None of the fees payable directly to WIPO will be collected by the EUIPO. Any such fees paid by error to the EUIPO will be reimbursed to the sender.

If the applicant uses the paper EM2 form, the Fee Calculation Sheet (Annex to WIPO form MM2) must be submitted in the language in which the international application is to be transmitted to WIPO. Alternatively, the applicant can attach a copy of the payment to WIPO. However, the EUIPO will not examine whether the Fee Calculation Sheet is attached, whether it is correctly filled in, or whether the amount of the international fees has been correctly calculated. Any questions regarding the amount of the international fees and related means of payment should be addressed to WIPO. A fee calculator is available on WIPO's website.

2.1.3 Forms

Article 184(1) to (3) and Article 184(5)(a) EUTMR
Article 28 EUTMIR
Article 65(2)(b) EUTMDR

The international application must be filed in one of the official languages of the European Union, using an official form (provided by the EUIPO). The EUIPO also provides an e-filing tool in all official languages, which has the same format as the EUIPO's EM2 form (the EUIPO adaptation of WIPO's MM2 form). Applicants may not use any other forms, or change the contents or layout of the forms. The EUIPO recommends using the e-filing tool insofar as it gives guidance to the applicant, thus potentially reducing the number of deficiencies and speeding up the examination.

All items on the form must be completed in the same language; it is not possible to choose a language other than that of the form.

If the application is filed in a language that is not one of the Madrid Protocol languages (Spanish, English and French), the applicant must indicate in which of these three languages the application is to be forwarded to WIPO.

The EUIPO EM2 form in Spanish, English and French has almost the same layout and numbering as the WIPO MM2 form but is specifically adapted to the EUTM environment:

- applicants can indicate, in introductory item 0, details of payment of the EUIPO fee (item 0.4) and the number of pages the application contains (item 0.5);
- certain choices are limited to what is applicable to the Office (e.g. the EUIPO is always the office of origin (item 1), and the applicant must be a national of an EU Member State (item 3));
- item 4b has been added for including the representative before the EUIPO;
- the reproduction of the mark need not be submitted in item 7, as the EUIPO will use the reproduction available in the basic EUTM/EUTM application;
- the option of ticking a box to seek protection for the same goods and services contained in the basic mark has been added in item 10;
- since self-designation is not possible, the EU is not included in the list of Contracting Parties to be designated in item 11;

- item 13 has been deleted, as the EUIPO certifies the international application electronically.

Where the applicant chooses the EUIPO EM2 form in a language version other than Spanish, English or French, the following additional sections of the form have to be completed:

- tick boxes in item 0.1 for indicating the MP language in which the international application is to be transmitted to WIPO;
- tick boxes in item 0.2 for selecting the language in which the EUIPO is to communicate with the applicant on matters concerning the international application, that is to say, either the language in which the international application is filed or the language in which it is to be transmitted to WIPO (see Article 184(1) EUTMR, third sentence);
- tick boxes in item 0.3 for indicating either that a translation of the list of goods and services is included or that the EUIPO is authorised to produce the translation;
- a final item A with tick boxes for specifying annexes (attached translations).

The appropriate boxes in items 0.1, 0.2 and 0.3 must be ticked. If none of the boxes in item 0.2 are ticked, the EUIPO will communicate with the applicant in the language of the EM2 form.

All applicable items in the form must be completed following the indications provided on the form itself and in the 'Guide to the International Registration of Marks' published by WIPO.

Where an international application is not filed in one of the languages of the Madrid Protocol, the applicant may provide a translation of the goods and services and of any other textual element forming part of the international application into the language chosen (Spanish, English or French) for forwarding the application to the International Bureau. If the applicant does not submit a translation of the goods and services, it must authorise the Office to provide such translation in the international application. Where no translation has been provided in the course of the registration procedure for the EUTM application on which the international application is based, the Office must arrange for a translation without delay. Where the applicant has failed to authorise the Office to include a translation or where it is otherwise unclear on which list of goods and services the international application is to be based, the Office will invite the applicant to make the necessary indications.

2.1.3.1 Entitlement to file

Article 184(5)(f) EUTMR Article 2(1)(ii) MP
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Under item 3 of the official form, an indication must be given regarding entitlement to file. An applicant is entitled to file with the EUIPO as office of origin if it is a national of, or has a domicile or a real and effective industrial or commercial establishment in, an EU Member State. The applicant may choose on which criterion/criteria to base its right to file. For example, a Danish national domiciled in Germany can choose to base entitlement to file either on nationality or domicile. A French national domiciled in Switzerland is entitled to file only based on nationality (however, in this case, a representative before the EUIPO must be appointed). A Swiss company with no

domicile or real and effective industrial or commercial establishment in an EU Member State is not entitled to file an international application through the EUIPO.

Where there are multiple applicants, each must fulfil at least one of the entitlement criteria.

The expression ‘real and effective industrial or commercial establishment in an EU Member State’ is to be interpreted in the same way as in other instances, such as in the context of professional representation (see the Guidelines, Part A, General Rules, Section 5, Professional Representation, paragraph 3.1.1).

2.1.3.2 Basic mark

Article 184(5)(b) to (e) EUTMR
Rule 9(4)(a)(v), (vii) and (vii**bis**) to (xii) and Rule 11(2) CR

The Madrid System is founded on the requirement of a basic national or regional trade mark application or registration. Under the Madrid Protocol, an international application may be based on either a mark that has already been registered (‘basic registration’), or a trade mark application (‘basic application’) at any point in the trade mark examination procedure.

An applicant may choose to base its international application on several basic marks providing it is the applicant/proprietor of all the basic EUTM applications and EUTMs, even where the marks/applications, although containing identical marks, cover different goods and services.

All the basic EUTM applications or EUTMs must have been accorded a filing date, and must be in force.

The international applicant must be identical to the EUTM holder/ applicant. The international application may not be filed by a licensee or an affiliated company of the holder of the basic mark(s). A deficiency in this respect may be overcome by transferring the basic mark to the international application applicant, or by recording a change of name, as applicable (see the Guidelines, Part E, Register Operations, Section 3, EUTMs as Objects of Property, Chapter 1, Transfer). Where there are multiple holders or applicants in the basic EUTM(s) or EUTM application(s), the international application must be submitted by the same persons.

The reproduction of the mark must be identical. For full details of Office practice for the identity of trade marks filed in black and white and/or greyscale, as compared with those filed in colour, please see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 13.2.2.1, for priority claims, which applies by analogy. Particular attention should be paid to the following.

- Box c in item 7 of the official form must be ticked if the mark is in standard characters (word mark).
- Box a in item 8 of the official form allows a colour to be claimed. Where the basic EUTM(s) or EUTM application(s) contain(s) an indication of colours, the same indication must be made in the international application (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 11). Where the basic

EUTM(s) or EUTM applications(s) is/are in colour but do(es) not contain an indication of colours, the applicant may choose to indicate the colours for the international application.

- If the basic mark is
 - a word mark, the applicant must tick box c in item 7 to request that the mark be considered as a mark in standard characters;
 - a colour mark, the applicant must tick box d in item 7 to declare that the mark consists of a colour or a combination of colours as such;
 - a shape mark, the applicant must tick the box for a three-dimensional mark in item 9d (only shape marks with graphic representations can be extended internationally, as WIPO does not accept computer-generated images or animated designs);
 - a sound mark, the applicant must check the relevant box in item 9d (only sound marks with graphic representations, namely musical notations, can be extended internationally, as WIPO does not accept electronic sound files).

Where the basic mark is a figurative mark, a position mark, a pattern mark, a motion mark, a hologram mark or any other type of mark (apart from a word mark, colour mark, shape mark and sound mark, mentioned above), no specific indication can be made on the international application form. Therefore, those applications will be processed without any indication of mark type. However, for clarification purposes the Office will add the trade mark type in the description field of the electronic form to be transmitted to WIPO.

In addition, only motion marks or hologram marks with graphic representations can be extended internationally, as WIPO does not accept video files. For the same reason, multimedia marks cannot be extended internationally.

Where the basic mark is a collective or certification mark, the applicant must check the relevant box in item 9d.

- If the basic mark includes a description, the same description may be included in the international application (item 9e). However, a description of the mark may not be added in the international application if the basic mark(s) do(es) not contain one.
- A disclaimer may be included even if the basic mark(s) do(es) not include one (item 9g).
- WIPO requires a transliteration in Latin characters if the mark contains non-Latin characters. If no transliteration is given, WIPO will raise an irregularity, which must be remedied directly by the applicant. This applies for all types of trade marks, not just word marks.

The list of goods and services must be identical to or otherwise included in the list contained in the basic mark(s) on the day the international application is filed.

- The applicant must specify the list of goods and services by class (item 10).
- The list may also be limited for one, several or all designated Contracting Parties; the limitation in respect of each Contracting Party may be different.

If the applicant does not provide a translation into the WIPO language chosen by it (Spanish, English or French) but instead authorises the EUIPO to provide the translation or to use the one available for the basic mark(s), it will not be consulted regarding the translation.

2.1.3.3 Priority claim(s)

If priority is claimed under item 6 of the official form, the office of earlier filing, the filing number (if available) and the filing date must be indicated. Priority documents should not be submitted. Where the earlier filing claimed as a priority right in an international application does not relate to all the goods and services, those to which it does relate should be indicated. Where priority is claimed from several earlier filings with different dates, the goods and services to which each earlier filing relates should be indicated. .

2.1.3.4 Signature

Rule 9(2)(b) CR

The signature in item 12 of the official form is optional since the data will be forwarded only electronically to WIPO and not as an original document or facsimile copy of the form.

2.1.3.5 Form for the designation of the USA

Where the United States of America is designated, a duly completed and signed WIPO MM18 form must be attached (see item 11 of the MM2/EM2 form, footnote**). This form, which contains the declaration of intention to use the mark, is available only in English and must be completed in English irrespective of the language of the international application.

2.1.4 Examination of the international application by the EUIPO

Article 184 EUTMR Article 3(1) MP

Where examination of the international application reveals deficiencies, the EUIPO will invite the applicant to remedy them within one month. In principle, this short time limit should enable the EUIPO to forward the international application to WIPO within two months from the date of receipt and thus maintain that date as the date of the international registration.

If the deficiencies are not remedied, the EUIPO will inform the applicant that it refuses to forward the international application to WIPO. The handling fee will not be refunded.

This does not preclude the filing of another international application at a later date.

As soon as the EUIPO is satisfied that the international application is in order, it will transmit it to WIPO electronically, with the exception of documents such as the fee calculation sheet or the MM18, which will be transmitted as scanned attachments. The

electronic transmission will contain the certification by the office of origin referred to in Article 3(1) MP.

2.1.5 Irregularities found by WIPO

Rule 11(4) and Rules 12 and 13 CR

If WIPO detects irregularities in the application, it will issue an irregularity notice, which will be forwarded to both the applicant and the EUIPO as the office of origin. The irregularities must be remedied by the EUIPO or the applicant, depending on their nature. Irregularities relating to the payment of the international fees must be remedied by the applicant. Any of the irregularities mentioned in Rule 11(4) CR must be remedied by the EUIPO.

Where there are irregularities in the classification of the goods and services, in the indication of the goods and services, or in both, the applicant cannot present its arguments directly to WIPO. Instead, they must be communicated through the EUIPO in the language of the proceedings with WIPO. In this case, the EUIPO will forward the applicant's communication to WIPO just as it is, as the EUIPO does not make use of either the option under Rule 12(2) CR to express a different opinion or that under Rule 13(2) CR to propose a remedy to the irregularity.

2.2 Subsequent designations

Article 187 EUTMR Article 65(2)(b) EUTMDR Articles 30 and 31 EUTMIR Article 2(1)(ii) MP Rule 1(xxvibis) and Rule 24(2) CR

Within the framework of the Madrid System, the holder of an international registration can extend the geographical scope of a registration's protection. There is a specific procedure called 'subsequent designation' of a registration, which extends the scope of the international registration to other members of the Madrid Union for whom either no designation has been recorded to date or the prior designation is no longer in effect. A subsequent designation may also be used to extend the scope of the goods and/or services of a prior designation, provided that the scope of the international registration is not exceeded. This could be useful in situations where a limitation has previously been recorded.

Unlike international applications, subsequent designations need not be filed through the office of origin but may be filed directly with WIPO. Direct filing with WIPO is recommended for a speedier process. If a request is filed through the EUIPO, it must be filed in the language in which the international application was filed.

Where an IR is transferred to a person who is not entitled to make a subsequent designation through the EUIPO, the application for such a subsequent designation cannot be filed through the EUIPO, but must instead be filed through WIPO or the office of the Contracting Party of the holder (for more information on entitlement to file, see paragraph 2.1.3.1 above).

Subsequent designations may only be made after an initial international application has been made and has resulted in an international registration.

Subsequent designations are not subject to payment of a handling fee to the EUIPO.

Subsequent designations filed through the EUIPO must be made in the same language as the initial international application, failing which the EUIPO will refuse to forward them to WIPO. Subsequent designations must be filed using the official form: WIPO form MM4 in Spanish, English or French, or EUIPO form EM4 in the other EU languages. There is no specific EUIPO form in Spanish, English and French, as no special indications for the EUIPO are needed in those languages, and the WIPO form MM4 is, therefore, sufficient.

The fee calculation sheet (Annex to WIPO form MM4) must be submitted in the language in which the subsequent designation is to be transmitted to WIPO. Alternatively, the applicant can attach a copy of the payment to WIPO. However, the EUIPO will not examine whether the fee calculation sheet is attached, whether it is correctly filled in, or whether the amount of international fees has been correctly calculated. Any questions regarding the amount of the international fees and related means of payment should be addressed to the International Bureau. A fee calculator is available on WIPO's website.

In the MM4 and EM4 forms, the indications to be made are limited to those concerning the holder, the representative, the list of goods and services, and the designation of additional Contracting Parties to the Madrid Protocol. These indications must be made in the same way as in the MM2 form. If there is a change of holder, in addition the entitlement to file will be checked, namely if the international registration has been transferred to a person who is a national of an EU Member State or has his or her domicile or an establishment in the EU (the EUIPO as 'Office of the Contracting Party of the holder').

The list of goods and services may be the same as in the international registration (item 5a of the official form) or narrower (item 5b or c). It may not be broader than the scope of protection of the international registration even if covered by the basic mark.

For example, an IR for Classes 18 and 25 designating China for Class 25 can subsequently be extended to China for Class 18; however, that same IR could not subsequently be extended to China for Class 9, as this class is not covered by the international registration, even if it is covered by the basic mark.

Within these limitations, different lists may be submitted for different, subsequently designated, contracting parties.

The mark must be the same as in the initial international registration.

If the application is not in Spanish, English or French, the applicant must tick item 0.1 on the EUIPO EM4 form and indicate the language in which the subsequent designation is to be transmitted to WIPO. Items 0.2 and 0.3 regarding the translation of the list of goods and services and the language of correspondence between the applicant and the EUIPO must also be completed.

Where the holder so requests, a subsequent designation may take effect after specific proceedings have been concluded, namely the recording of a change or a partial cancellation in respect of the IR concerned, or the renewal of the IR.

The Office must inform the applicant for territorial extension of the date on which the request for territorial extension was received.

If the request for territorial extension does not comply with the requirements outlined above, the Office will invite the applicant to remedy the deficiencies within a time limit of at least one month. If the deficiencies are not remedied within this time limit, the Office may refuse to forward the request to the International Bureau. However, the Office must not refuse to forward the request to the International Bureau before the applicant has had the opportunity to correct any deficiency detected in it.

The Office will forward the request for territorial extension made subsequent to the international registration to the International Bureau as soon as the requirements referred to above have been satisfied.

2.3 Notification of facts affecting the basic registration

Articles 49, 53, 57 to 62 and 128 EUTMR Article 29 EUTMIR
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If, within five years of the date of the international registration, the basic mark(s) cease(s) to have effect wholly or in part, the international registration is cancelled to the same extent, since it is 'dependent' thereon. This occurs not only in the event of a 'central attack' by a third party, but also if the basic mark(s) lapse(s) due to action or inaction on the part of its proprietor.

For EUTMs, this covers cases where, either fully or partially (i.e. for only some goods or services),

- the EUTM or the EUTM application(s) on which the IR is based is (are) withdrawn, deemed to be withdrawn or refused;
- the EUTM(s) on which the IR is based is (are) surrendered, not renewed, revoked or declared invalid by the EUIPO or, upon a counterclaim in infringement proceedings, by an EUTM court.

Where the above occurs as a result of a decision (by the EUIPO or an EUTM court), the decision must be final.

If the above occurs within the five-year period, the EUIPO must notify WIPO accordingly.

The EUIPO must check that the international application has actually been registered before notifying WIPO that the basic EUTM has ceased to have effect.

WIPO must also be notified in certain cases where a procedure has been initiated prior to expiry of the five-year period but is not finally decided within that period. This notification is to be made at the end of the five-year period. The cases involved are:

- a pending refusal of the basic EUTM application(s) on absolute grounds (including appeals before the Boards of Appeal or the GC/CJEU);
- pending opposition proceedings against the basic EUTM application (including appeals before the Boards of Appeal or the GC/CJEU);

- pending cancellation proceedings before the EUIPO against the basic EUTM (including appeals before the Boards of Appeal or the GC/CJEU);
- where mention has been made in the Register of EU Trade Marks that a counterclaim in infringement proceedings against the basic EUTM has been filed before an EU trade mark court, but no mention has yet been made in the Register of the decision of the EU trade mark court on the counterclaim.

Once a final decision has been taken or the proceedings have been terminated, a further notification must be sent to WIPO stating whether and to what extent the basic mark(s) has (have) ceased to have effect or remained valid.

If, within five years of the date of the international registration, the basic EUTM(s) or EUTM application(s) is (are) divided or partially transferred, WIPO must also be notified of this. However, in those cases, there will be no effect on the validity of the international registration. The purpose of the notification is merely to keep a record of the number of mark(s) on which the IR is based.

No other changes in the basic mark(s) will be reported to WIPO by the EUIPO. Where the applicant/holder wishes to record the same changes in the International Register it should apply for this separately (see paragraph 2.4 below)

2.4 Forwarding of changes affecting the international mark

The International Register is kept at WIPO. The possible changes listed below may only be recorded once the mark has been registered.

The EUIPO will not process requests for renewal or payments of renewal fees.

In principle, most changes relating to international registrations can be filed either directly with WIPO by the holder of the international registration on record or through the office of the Contracting Party of the holder. However, some applications for changes can be filed by another party and through another office, as detailed below.

2.4.1 Cases where applications for changes can be forwarded **without** examination

Rules 20 and 20 <i>bis</i> and Rule 25(1) CR
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The following applications for changes relating to an international registration can be presented to the EUIPO as an ‘Office of the Contracting Party of the holder’:

- WIPO form MM5: change of ownership, either total or partial, submitted by the IR holder on record (in EUTM terminology, this corresponds to a transfer);
- WIPO form MM6: limitation of the list of goods and services for all or some contracting parties;
- WIPO form MM7: renunciation of one or more contracting parties (not all);
- WIPO form MM8: full or partial cancellation of the international registration;
- WIPO form MM9: change of the name or address of the holder;
- WIPO forms MM13/MM14: new licence or amendment to a licence submitted by the IR holder on record;

- WIPO form MM15: cancellation of the recording of a licence;
- WIPO form MM19: restriction of the holder's right of disposal submitted by the IR holder on record (in EUTM terminology, this corresponds to the rights *in rem*, levy of execution, enforcement measures or insolvency proceedings contemplated in Articles 22, 23 and 24 EUTMR).

Such applications made to the EUIPO by the IR holder will simply be forwarded to WIPO without further examination. The provisions under the EUTMR for the corresponding proceedings do not apply. In particular, the language rules applicable are those under the CR, and there is no EUIPO fee to be paid.

These applications can only be filed through the EUIPO if it is the office of origin or if it acquires competence in respect of the holder as a result of the transfer of the international registration (see Rule 1(xxvibis) CR). The applications for which the EUIPO is competent (as office of origin) will simply be forwarded to WIPO. The applications for which the EUIPO is not competent (i.e. when it is not the office of origin) will not be dealt with.

No use will be made of the options provided in Rule 20(1)(a) CR that allow an office of the Contracting Party of the holder to notify the International Bureau of a restriction of the holder's right of disposal on its own motion.

2.4.2 Cases where applications for changes will be forwarded after examination

Article 201 EUTMR Rule 20(1)(a), Rule 20bis(1) and Rule 25(1)(b) CR
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The Common Regulations provide that applications for recording a change of ownership, a licence or a restriction of the holder's right of disposal may only be filed directly with WIPO by the holder of the international registration. It would be practically impossible to record a change of ownership or licence with WIPO where:

- the original holder no longer exists (merger, death), or
- the holder is either not cooperating with its licensee or (even more likely) is the beneficiary of an enforcement measure.

For these reasons, the new holder, licensee or beneficiary of the right of disposal has no choice but to file their application with the office of the Contracting Party of the holder. WIPO will register such applications without any substantive examination, on the basis that they have been transmitted by that office.

To avoid a third person becoming the owner or licensee of an international registration, it is imperative that the EUIPO examine all applications presented by any person other than the holder of the IR, in order to verify that there is proof of the transfer, licence or other right, as provided in Article 201 EUTMR. The EUIPO limits itself to examining proof of the transfer, licence or other right, with Articles 20 and 26 EUTMR and Article 13 EUTMIR and the corresponding parts of the EUIPO Guidelines on transfers, licences, rights *in rem*, levy of execution and insolvency proceedings applying by analogy. If no proof is submitted, the EUIPO will refuse to forward the application to WIPO; this decision can be appealed.

In all other respects, the rules under the EUTMR do not apply. In particular, the application must be in one of the WIPO languages and on the appropriate WIPO form, and no fee is payable to the EUIPO.

3 The EUIPO as Designated Office

3.1 Overview

Any person who is a national of, or has a domicile or commercial establishment in, a state that is 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 applied for or registered (the 'office of origin'), file an international application or a subsequent designation in which they can designate the European Union.

Once it has examined the classification and checked certain formalities (including payment of fees), WIPO will publish the IR in the International Gazette, issue the certificate of registration and notify the designated offices of the international registration. The EUIPO receives the data from WIPO exclusively in electronic form.

International registrations designating the EU are identified by the EUIPO under their WIPO registration number, preceded by a '**W**' and followed by a **0** in the case of a new IR (e.g. **W01** 234 567) and a **1** in the case of a subsequent designation (e.g. **W10** 987 654). Further designations of the EU for the same IR will be identified as **W2**, **W3**, etc. However, when searching in EUIPO databases online, the 'W' should not be entered.

The type of mark displayed in the Office's database by default will depend on whether the indication appears in the International Register under INID code 541 ('Reproduction of the mark where the mark is represented in standard characters'), INID code 550 ('Indication relating to the nature or kind of mark' for three-dimensional mark or sound mark) or INID code 558 ('Mark consisting exclusively of one or several colors'). If none of the above are preselected, the mark will be incorporated as a figurative mark into the Office's database.

The EUIPO has 18 months to inform WIPO of all possible grounds for refusal of the EU designation. The 18-month period starts on the day on which the EUIPO is notified of the designation.

Where corrections are received from WIPO that affect the mark itself, the goods and services or the designation date, it is up to the EUIPO to decide if a new 18-month period is to start running from the new notification date. Where a correction affects only part of the goods and services, the new time limit applies only to that part and the EUIPO would have to republish the IR in part in the EUTM Bulletin and reopen the opposition period only for that part of the goods and services.

The main tasks performed by the EUIPO as designated office are:

- first republication in the EUTM Bulletin;
- examination of formalities, including examination of limited lists for the EU designation, vague terms in the specification of goods and services, seniority claims;
- examination of absolute grounds;

- examination of oppositions;
- processing of communications from WIPO concerning changes to the IRs;
- second republication in the EUTM Bulletin;
- issue of grants of protection or final decisions.

3.2 Professional representation

Article 119(2) and Article 120 EUTMR

In principle, the IR holder does not need to appoint a representative before the EUIPO.

Holders outside the EEA are, however, required to be represented (a) further to a provisional refusal, (b) for filing seniority claims directly before the EUIPO, or (c) further to an objection to a seniority claim (see the Guidelines, Part A, General Rules, Section 5, Professional Representation, and Articles 119 and 120 EUTMR).

If a non-EEA IR holder has appointed a representative before WIPO who also appears in the database of representatives maintained by the EUIPO, this representative will automatically be considered to be the IR holder's representative before the EUIPO.

Where a non-EEA IR holder has not appointed a representative or has appointed a representative before WIPO who does not appear in the database of representatives maintained by the EUIPO, any notifications of provisional refusal or objection will contain an invitation to appoint a representative in compliance with Articles 119 and 120 EUTMR. For the particularities of representation in each of the proceedings before the EUIPO, see paragraphs 3.3.3, 3.4 and 3.6.6 below.

3.3 First republication, searches and formalities

3.3.1 First republication

Article 190 EUTMR

Upon receipt, IRs will immediately be republished¹ in Part M.1 of the EUTM Bulletin, except where the second language is missing.

Publication will be limited to bibliographic data, the reproduction of the mark and the class numbers, and will not include the actual list of goods and services. This means, in particular, that the EUIPO will not translate international registrations or the list of goods and services. The publication will also indicate the first and second languages of the IR and contain a reference to the publication of the IR in the WIPO Gazette, which should be consulted for further information. For more details, reference is made to the EUTM Bulletin on the EUIPO's website.

The international registration has, from the date of first republication, the same effect as a published EUTM application.

¹ IRs are published first in the International Gazette and then 'republished' by the Office.

3.3.2 Searches

Article 195 EUTMR

Upon request of the IR holder within a period of one month from when WIPO informs the EUIPO of the designation, the EUIPO will draw up a European Union search report for each IR, which will cite similar EUTMs and IRs designating the EU. The owners of the earlier marks cited in the report will receive a surveillance letter in accordance with Article 195(4) EUTMR, unless they ask the Office not to send them such letters. In addition, upon request by the international holder, the EUIPO will send the IR to the participating national offices to have national searches carried out (see the Guidelines, Part B, Examination, Section 1, Proceedings).

The national search request must be filed directly with the EUIPO. Holders of IRs designating the EU must request the national searches and pay the corresponding fee within a period of one month from when WIPO informs the EUIPO of the designation. Late or missing payments of search fees will be dealt with as if the request for national searches had not been filed.

Payment can be made using any of the means of payment accepted by the EUIPO (for details, see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges, paragraph 2).

The search reports requested will be sent directly to the IR holder or, if the latter has appointed a representative before WIPO, to that representative, irrespective of location. The holder will not be required to appoint a representative before the EUIPO for the sole purpose of requesting or receiving search reports.

3.3.3 Formalities examination

The formalities examination carried out by the EUIPO on IRs is limited to whether a second language has been indicated, whether the application is for a collective or a certification mark (which must include the submission of the regulations governing the use of the mark), whether the limited lists for the EU designation fall within the scope of the IR's main list, whether there are any seniority claims and whether the list of goods and/or services meets the requirements of clarity and precision as described in the Guidelines, Part B, Examination, Section 3, Classification.

3.3.3.1 Languages

Article 146(3), (4) and (8), and Articles 193 and 206 EUTMR Rule 9(5)(g)(ii) CR
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Rule 9(5)(g)(ii) CR and Article 206 EUTMR require the applicant for an international application designating the EU to indicate a second language, different from the first one, selected from the four remaining languages of the EUIPO by ticking the appropriate box in the contracting parties' section of WIPO forms MM2 or MM4.

Under the terms of Article 206 EUTMR, the language of filing of the international application is the language of the proceedings within the meaning of Article 146(4) EUTMR. If the language chosen by the international registration holder in written

proceedings is not the language of the international application, the holder must supply a translation into that language within one month from when the original document was submitted. If the translation is not received within this time limit, the original document is deemed not to have been received by the EUIPO.

The second language indicated in the international application must be a second language within the meaning of Article 146(3) EUTMR, that is, a language of proceedings accepted as possible for opposition, revocation or invalidity proceedings before the EUIPO.

Where no second language has been indicated, the examiner will issue a provisional refusal of protection and give the holder two months from the day on which the Office issues the provisional refusal pursuant to Article 193(5) EUTMR to remedy the deficiency. Where necessary, the notification of provisional refusal will invite the IR holder to appoint a representative in compliance with Articles 119 and 120 EUTMR. This notification will be recorded in the International Register, published in the Gazette and sent to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

If the IR holder remedies the deficiency and complies with the requirement, if applicable, to appoint a representative before the EUIPO within the prescribed time limit, the IR will proceed to republication.

If the deficiency has not been remedied and/or a representative, if applicable, has not been appointed, the EUIPO will confirm the refusal to the IR holder. The holder has two months within which to lodge an appeal. Once the decision is final, the EUIPO will inform WIPO that the provisional refusal is confirmed.

3.3.3.2 Collective and certification marks

Articles 74 to 76, 83, 84 and 194 EUTMR Articles 16, 17 and 33 EUTMIR Article 76 EUTMDR

In the EUTM system, there are three kinds of mark: individual marks, collective marks and certification marks (for more details see the Guidelines, Part B, Examination, Section 2, Formalities).

The international application form contains one single indication, grouping collective marks, certification marks and guarantee marks. Therefore, an IR designating the EU that is based on a national certification mark, guarantee mark or collective mark will be entered as either an EU collective mark or an EU certification mark and will entail the payment of higher fees.

The conditions applying to EU collective marks and EU certification marks will also apply to corresponding IRs designating the EU. For more information on the examination requirements, reference is made to the Guidelines, Part B, Examination, Section 2, Formalities (paragraphs 9.2 and 9.3) and the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 15, European Union Collective Marks and Chapter 16, European Union Certification Marks.

In accordance with Article 194 EUTMR, the holder must submit the regulations governing use of the mark directly to the EUIPO within two months of the date on which the International Bureau notified the EUIPO of the designation.

From the examination of the particulars of the mark and the content of the regulations governing use of the mark, the EUIPO will determine if the designation is for a collective or for a certification mark.

If the regulations on use have not yet been submitted or contain irregularities, or the holder does not comply with the requirements of Articles 74 or 83 EUTMR, the examiner will issue a provisional refusal of protection and give the holder two months from the day on which the EUIPO issues the provisional refusal pursuant to Article 33 EUTMR to remedy the deficiency. Where necessary, the notification of provisional refusal will invite the IR holder to appoint a representative in accordance with Articles 119 and 120 EUTMR. This notification will be recorded in the International Register, published in the Gazette and sent to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

If the IR holder remedies the deficiency and complies with the requirement, if applicable, to appoint a representative before the EUIPO within the prescribed time limit, the international registration will proceed.

If the deficiency has not been remedied and/or a representative, if applicable, has not been appointed, the Office will confirm the refusal to the IR holder, and grant a two-month time limit for lodging an appeal. Once the decision is final, the Office will inform WIPO that the provisional refusal is confirmed.

When, in the answer to the provisional refusal, elements are submitted by the IR holder that confirm to the EUIPO that the IR holder is not qualified to be the owner of a European Union collective or certification mark, the EUIPO will examine the designation as an individual mark. The IR holder will be informed accordingly and will also be reimbursed with the difference in euros between the fees for an individual designation of the EU and those for a collective or certification one.

3.3.3.3 Seniority claims

Seniority claims filed together with the designation

Article 191 EUTMR Rule 9(5)(g)(i) and Rule 21 <i>bis</i> CR
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The applicant may, when designating the EU in an international application or a subsequent designation, claim the seniority of an earlier mark registered in a Member State. Such a claim must be submitted by attaching form MM17 to the international application or subsequent designation request, which should include for each claim:

- the EU Member State in which the earlier right is registered;
- the registration number;
- the filing date of the relevant registration.

There is no equivalent provision to Article 39(2) EUTMR applicable to direct EUTM filings.

No certificates or documents in support of the seniority claims should be attached to the MM17 form, as they will not be transmitted to the EUIPO by WIPO.

Seniority claims submitted together with the international application or subsequent designation will be examined in the same way as seniority claims submitted with an EUTM application. For more information, please refer to the Guidelines, Part B, Examination, Section 2, Formalities.

If it is necessary to file documentation in support of the seniority claim, or if the claim contains irregularities, the examiner will issue a deficiency letter giving the IR holder two months within which to remedy the deficiency. Where necessary, the IR holder will also be invited to appoint a representative before the EUIPO.

If the seniority claim is accepted by the EUIPO, the IP offices concerned will be informed. WIPO need not be informed, since no change in the International Register is required.

If the deficiency has not been remedied and/or a representative, if applicable, has not been appointed, the right of seniority will be lost pursuant to Article 191(4) EUTMR. The IR holder may request a decision, which can be appealed. Once the decision is final, the EUIPO will inform WIPO of any loss, refusal or cancellation of the seniority right or of any withdrawal of the seniority claim. Those changes will be recorded in the International Register and published by WIPO.

Seniority claims submitted after acceptance of the EU designation by the EUIPO

Article 192 EUTMR Article 32 EUTMIR Rule 21 <i>bis</i> (2) CR

Upon publication of the final acceptance of the IR in the EUTM Bulletin, the IR holder may claim the seniority of an earlier mark registered in a Member State by filing a request directly with the EUIPO. Any such request filed before WIPO will be deemed not to have been filed.

Any seniority claim submitted in the interval between the filing of the international application and the publication of the final acceptance of the IR will be deemed to have been received by the EUIPO on the date of publication of the final acceptance of the IR and will therefore be examined by the EUIPO after that date.

If it is necessary to submit documentation in support of the seniority claim or if the claim contains irregularities or the appointment of a representative before the EUIPO is required, the examiner will issue a deficiency letter giving the IR holder two months within which to remedy the deficiency.

If the seniority claim is accepted by the Office, it will inform WIPO, which will record this fact in the International Register and publish it.

The IP offices concerned will be informed pursuant to Article 35(4) EUTMR.

If the deficiency is not remedied and/or a representative, if applicable, has not been appointed, the seniority right will be refused and the IR holder will be given two months

within which to lodge an appeal. In such cases, WIPO is not informed. The same applies if the seniority claim is abandoned.

3.3.3.4 Vague terms

Articles 33, 41, 182 and 193 EUTMR Article 33 EUTMIR

International registrations designating the EU are examined for the specification of broad or vague terms in the list of goods and services in the same way as direct EUTM applications (for details please consult the Guidelines, Part B, Examination, Section 3, Classification).

Before filing an IR designating the EU, the content of the Harmonised Database (HDB) can be searched using TMclass (<http://tmclass.tmdn.org>). The HDB brings together terms that are accepted for classification purposes in all EU offices. Users can select these pre-approved terms, provided they fall within the scope of the basic mark, to build their list of goods and services and simultaneously see if they are also included in WIPO's MGS-Madrid Goods and Services Manager (<https://webaccess.wipo.int/mgs/>). All HDB terms will be accepted by the Office automatically. Checking in advance that the goods and/or services are included in both TMclass and the MGS database will help make the trade mark registration process smoother for IRs designating the EU.

Where the IR contains vague terms in the list of goods and/or services, which lack clarity or precision, the Office will issue a provisional refusal of protection and give the holder two months from the day on which the EUIPO issues the provisional refusal pursuant to Article 33 EUTMR and Article 33 EUTMIR to remedy the deficiency. Where necessary, the notification of provisional refusal will invite the IR holder to appoint a representative in accordance with Articles 119 and 120 EUTMR. This notification will be recorded in the International Register, published in the Gazette and sent to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

Once the provisional refusal has been sent, further examination is the same as for a direct EUTM application; there will be direct exchanges with the IR holder or its representative as often as is required. The terms that need to be clarified by the IR holder should always be in the same class as the original wording in the International Register.

If, after re-examining the case, the objection is waived or the IR holder remedies the deficiency and complies with the requirement, if applicable, to appoint a representative before the EUIPO within the prescribed time limit, the Office will issue an interim status of the mark to WIPO, provided that no other *ex officio* provisional refusal is pending and that the opposition period is still running.

Replies received from the IR holder or its representative will not be addressed where both are located outside the EEA.

If the holder fails to overcome the objections or fails to respond to the objection, the provisional refusal will be confirmed. In other words, if the provisional refusal concerned only some of the goods and services, only those goods and services will be refused but the remaining goods and services will be accepted. The IR holder will be given two months within which to lodge an appeal.

Once the decision is final and provided that there is a total refusal, the EUIPO will inform WIPO that the provisional refusal is confirmed. If the refusal is only partial, the communication to WIPO will be issued once all the other procedures have been completed or the opposition period is over without any opposition being received (see paragraph 3.9 below).

3.3.3.5 Limited list of goods and services for the designation of the EU

Where a limited list of goods and services is sought for the designation of the EU, the Office will examine whether the goods and services sought are comprised within the main list of goods and services of the international registration.

Where the limited list for the EU contains terms that are not comprised within the main list of goods and services of the IR, the Office will issue a provisional refusal of protection and give the IR holder two months from the day on which the provisional refusal is issued to remedy the deficiency. Where necessary, the notification of provisional refusal will invite the IR holder to appoint a representative in compliance with Articles 119 and 120 EUTMR. This notification will be recorded in the International Register, published in the Gazette and sent to the IR holder. The reply to the provisional refusal must be addressed to the Office.

Once the provisional refusal has been sent, further examination is the same as for a direct EUTM application; there will be direct exchanges with the IR holder or its representative as often as is required.

If, after re-examining the case, the objection is waived or the IR holder remedies the deficiency and complies with the requirement, if applicable, to appoint a representative before the Office within the prescribed time limit, the Office will issue an interim status of the mark to WIPO, provided that no other *ex officio* provisional refusal is pending and that the opposition period is still running; the IR will then proceed.

Replies received by the IR holder or its representative will not be addressed where both are located outside the EEA.

If the holder fails to overcome the objections or convince the examiner that they are unfounded, or fails to respond to the objection, the provisional refusal will be confirmed. In other words, if the provisional refusal concerned only some of the goods and services, only those goods and services will be refused but the remaining goods and services will be accepted. The IR holder will be given two months within which to lodge an appeal.

Once the decision is final and provided that there is a total refusal, the Office will inform WIPO that the provisional refusal is confirmed. If the refusal is only partial, the communication to WIPO will be issued once all the other procedures have been completed or the opposition period is over without any opposition being received (see paragraph 3.9 below).

3.4 Absolute grounds for refusal

Article 193 EUTMR Article 33 EUTMIR Rule 18bis(1) CR
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International registrations designating the EU will be subject to examination of absolute grounds for refusal in the same way as direct EUTM applications (for details, please consult the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal and Collective Marks).

If the EUIPO finds that the mark is eligible for protection, and provided that no other provisional refusal is pending, it will send an interim status of the mark to WIPO, indicating that the *ex officio* examination has been completed, but that the IR is still open to oppositions or third-party observations. This notification will be recorded in the international register, published in the Gazette and communicated to the IR holder.

If the EUIPO finds that the mark is not eligible for protection, it will send a provisional refusal of protection, giving the IR holder two months from the day on which the provisional refusal is sent to submit observations. Where necessary, the notification of provisional refusal will also invite the holder to appoint a representative in compliance with Articles 119 and 120 EUTMR. This notification will be recorded in the International Register, published in the Gazette and communicated to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

If, after re-examining the case, the objection is waived, the examiner will issue an interim status of the mark to WIPO, provided that no other provisional refusal is pending and the opposition period is still running.

However, the Office still has the possibility of reopening the examination of absolute grounds on its own initiative at any time before the final statement of grant of protection, but not beyond the 18-month period the EUIPO has for informing WIPO of all possible grounds for refusal (see paragraph 3.1 above).

Once the provisional refusal has been sent, further examination is the same as for a direct EUTM application; direct exchanges with the holder or its representative will be held as often as required.

Replies received by the IR holder or its representative will not be addressed where both are located outside the EEA.

If the holder fails to overcome the objections or convince the examiner that they are unfounded, or fails to respond to the objection, the refusal will be confirmed. In other words, if the provisional refusal concerned only some of the goods and services, only those goods and services will be refused but the remaining goods and services will be accepted. The IR holder will be given two months within which to lodge an appeal.

Once the decision is final and provided that there is a total refusal, the EUIPO will inform WIPO that the provisional refusal is confirmed. If the absolute grounds refusal is only partial, the communication to WIPO will be issued once all other procedures are terminated or the opposition period is over with no opposition received (see paragraph 3.9 below).

3.5 Third-party observations

Article 45 and Article 193(7) EUTMR

Third-party observations can be validly filed at the EUIPO from the date of notification of the IR to the EUIPO until at least the end of the opposition period and, if an opposition was filed, as long as the opposition is pending, but not beyond the 18-month period the EUIPO has for informing WIPO of all possible grounds for refusal (see paragraph 3.1 above).

If third-party observations are received before the EUIPO communicates the outcome of the absolute grounds examination to WIPO, and the EUIPO considers the observations justified, a provisional refusal will be issued.

If third-party observations are received after a provisional refusal on absolute grounds has been issued for goods and services other than those to which the observations relate, and the EUIPO considers the observations justified, a further provisional refusal will be issued.

If third-party observations are received after an interim status of the mark has been issued and the EUIPO considers them justified, a provisional refusal further to third-party observations will be issued. The observations will be attached to the provisional refusal.

The further examination procedure is identical to the procedure described in the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 3.1.

If the EUIPO considers the observations unjustified, they will simply be forwarded to the applicant without WIPO being informed.

3.6 Opposition

Article 196 EUTMR
Articles 77 and 78 EUTMDR

3.6.1 Timing

Oppositions may be filed against the international registration between the first month and the fourth month following the date of first republication. For example, if the first republication is on 15/02/2017, the opposition period starts on 16/03/2017 and ends on 15/06/2017.

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 *ex officio* examination insofar as the opposition procedure may be suspended if an *ex officio* refusal has been issued in relation to the same goods and services.

Oppositions filed after the republication 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.

3.6.2 Receipt and informing the international holder

Article 4 and Article 77(3) EUTMDR

The EUIPO will issue a receipt to the opponent. If the opposition has been received before the beginning of the opposition period, a letter will be sent to the opponent, informing it that the opposition will be deemed to have been received on the first day of the opposition period and that the opposition will be put on hold until then.

The EUIPO will also send a copy of the notice of opposition to the IR holder or, if the latter has appointed a representative before WIPO, and the EUIPO holds sufficient contact information, to that representative, even if the place of business is outside the EEA, for information purposes.

3.6.3 Fees

Article 99 and Article 196(2) EUTMR

The opposition will not be treated as duly entered until the opposition fee has been paid. If payment of the fee within the opposition period cannot be established, the opposition will be deemed not to have been entered.

If the opponent disagrees with this finding, it has the right to request a formal decision on loss of rights. If the EUIPO decides to confirm the finding, both parties will be informed thereof. If the opponent appeals this decision, the EUIPO will issue a provisional refusal to WIPO, even if incomplete, for the sole purpose of meeting the 18-month time limit. If the decision becomes final, the provisional refusal will be reversed. Otherwise, the opposition procedure will start in the normal manner.

3.6.4 Admissibility check

Article 119(2) EUTMR
Articles 5 and 78 EUTMDR

The EUIPO will examine whether the opposition is admissible and whether it contains the particulars required by WIPO.

If the opposition is considered inadmissible, the EUIPO will inform the IR holder accordingly and no provisional refusal based on an opposition will be sent to WIPO.

For full details on opposition proceedings see the Guidelines, Part C, Opposition, Section 1, Procedural Matters.

3.6.5 Language of proceedings

Article 146(6) EUTMR
Article 3 EUTMDR

Oppositions (like cancellation requests) must be filed in the language of the international registration (the first language) or in the second language that the international holder is obliged to indicate when designating the EU. The opponent may choose either of these two languages as the language of the opposition proceedings. The opposition may also be filed in any of the other three EUIPO languages, provided that a translation into the language of the proceedings is filed within one month.

The EUIPO will use:

- the language of the opposition proceedings chosen by the opponent 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, for instance, the provisional refusal.

3.6.6 Representation of the IR holder

3.6.6.1 Opposition receipts

Article 4 EUTMDR

If applicable, the EUIPO will, in the opposition receipt, inform the representative before WIPO that if the IR holder does not appoint a representative who complies with the requirements stipulated in Articles 119(3) or 120 EUTMR within one month of receipt of the communication, the EUIPO will communicate the formal requirement to appoint a representative to the IR holder together with the opposition deadlines once the opposition is found admissible.

Where the IR holder has a WIPO representative **within** the EU who does not appear in the database of representatives maintained by the EUIPO, the EUIPO will inform this representative that if they wish to represent the IR holder before the EUIPO, they must specify the basis of their entitlement (i.e. whether they are a legal practitioner or professional representative within the meaning of Article 120(1)(a) or (b) EUTMR or an employee representative within the meaning of Article 119(3) EUTMR) (see also the Guidelines, Part A, General Rules, Section 5, Professional Representation).

3.6.6.2 Notification of commencement of opposition proceedings

Article 6(1) EUTMDR

If the opposition has been found admissible and where, despite the invitation pursuant to paragraph 3.6.6.1 above, the IR holder fails to appoint a representative before the opposition has been found admissible, further processing of the file will depend on whether or not the **IR holder** is required to be represented before the EUIPO pursuant to Article 119(2) EUTMR.

- If the IR holder is **not** required to be represented before the EUIPO, the proceedings will continue directly with the IR holder, that is to say, the IR holder will be sent notification of the admissibility of the opposition and the time limits set for substantiation.
- If the IR holder **is** required to be represented before the EUIPO, the IR holder will be notified of the admissibility of the opposition and will be formally requested to appoint a representative within two months of receipt of the communication (Article 77(4) EUTMDR), failing which the IR will be refused with a right to appeal. Once the decision is final, the opposition proceedings will be closed and WIPO will be informed. For the attribution of costs, the normal rules apply. This means that no decision on costs will be taken and the opposition fee will not be refunded.

3.6.7 Provisional refusal (based on relative grounds)

Article 78 EUTMDR Article 5(1) and Article 5(2)(a) and (b) MP Rule 17(1)(a) and (2)(v) CR

Any opposition that is deemed to have been entered and is admissible will lead to a notification of provisional refusal being sent to WIPO based on the pending opposition. WIPO will be informed of every admissible opposition duly entered within the opposition period by means of a separate provisional refusal for each opposition.

The provisional refusal may be partial or total. It will contain the earlier rights invoked, the relevant list of goods and services on which the opposition is based and, in the case of a partial refusal, the list of goods and services against which the opposition is directed.

The opponent must provide the list of goods and services on which the opposition is based in the language of the opposition proceedings. The EUIPO will send this list to WIPO in that language and will not translate it into the language in which the international registration was registered.

This notification will be recorded in the International Register, published in the Gazette and communicated to the IR holder. It will not, however, contain any time limit, as the time limit for commencement of the proceedings will be set in the direct notification to the parties made in parallel by the EUIPO, as in the case of a normal EUTM.

3.6.8 Suspension of opposition where there is a pending *ex officio* provisional refusal

Articles 6(2) and 77(5) EUTMDR

If the opposition was filed after the EUIPO had already issued one or more *ex officio* provisional refusal(s) for the same goods and services, the EUIPO will inform WIPO of the provisional refusal based on the opposition and communicate to the parties that, as from the date of the communication, the opposition procedure is suspended until a final decision has been issued in relation to the *ex officio* refusals.

If the *ex officio* provisional refusal(s) lead(s) to a final refusal of protection for all goods and services or for those contested by the opposition, the opposition procedure is closed without proceeding to a decision and the opposition fee is refunded.

If the *ex officio* refusal(s) is/are not maintained or is/are only partially maintained, the opposition procedure is resumed for the remaining goods and services.

3.7 Cancellation of the IR or renunciation of the EU designation

If, further to an *ex officio* provisional refusal or a provisional refusal on relative grounds, the holder requests the cancellation of the IR from the International Register or renounces its designation of the EU, the file is closed upon receipt of the notification by WIPO. Therefore, it is strongly recommended that the holder inform the Office at the same time as submitting its request to WIPO. The Office will then suspend the refusal procedure pending receipt of the notification of cancellation or renunciation from WIPO.

If this happens before the start of the adversarial part of the opposition proceedings, the opposition fee is reimbursed to the opponent, since it is equivalent to withdrawal of the EUTM application. The IR holder must submit such requests to WIPO (or through the office of origin) using the official form (MM7/MM8). The EUIPO cannot act as an intermediary and will not forward these requests to WIPO.

However, cancellation of the IR at the request of the office of origin (due to a 'central attack' during the five-year dependency period) is considered equivalent to rejection of the EUTM application in parallel proceedings under Article 6(2) EUTMDR, in which case the opposition fee is not reimbursed.

3.8 Limitations of the list of goods and services

Article 9 <i>bis</i> (iii) MP Rule 25 CR

The EUIPO cannot communicate limitations as such to WIPO.

Therefore, further to a provisional refusal on the specification of goods and services and/or absolute or relative grounds, the IR holder can choose to limit the list of goods or services:

- either through WIPO, using the appropriate form (MM6/MM8) (in which case, provided the limitation allows the objection to be waived, the EUIPO will communicate to WIPO that the provisional refusal is withdrawn), or
- directly with the EUIPO. In this case the EUIPO will simply confirm the provisional refusal. In other words, WIPO's register will reflect the partial refusal, not the limitation as such. As a consequence, conversion may not be possible, in so far as the ground of refusal applies in the Member States pursuant to Article 202 and Article 139(2)(b) EUTMR.

Where there is no provisional refusal pending, all limitations can be filed only through WIPO. The same applies to limitations filed during invalidity/revocation procedures. WIPO will record the limitation and forward it to the EUIPO for examination.

If, further to a provisional refusal, the IR holder chooses to limit the list of goods and services through WIPO, they should inform the Office as soon as they submit the request. The refusal procedure will then be suspended pending receipt of the notification of limitation from WIPO.

Limitations will be examined in the same way as limitations or partial surrenders of an EUTM or an EUTM application (see the Guidelines, Part B, Examination, Section 3, Classification, and Part E, Register Operations, Section 1, Changes in a Registration). When the limitation has been submitted through WIPO and is considered unacceptable by the EUIPO, a declaration that the limitation has no effect in the territory of the EU will be issued pursuant to Rule 27(5) CR. This declaration will not be subject to review or appeal.

Partial cancellations at the request of the office of origin (further to a 'central attack' during the five-year dependency period) will be recorded, as they are by the EUIPO.

If the limitation is submitted before the start of the adversarial part of the opposition proceedings and allows the opposition proceedings to be terminated, the opposition fee is reimbursed to the opponent.

3.9 Confirmation or withdrawal of provisional refusal and issuance of statement of grant of protection

Article 33(2) EUTMIR Article 78(5) and 79(1) EUTMDR Rule 18 ter (1) to (3) CR
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If one or several notifications of provisional refusal have been sent to WIPO, the EUIPO must, once all procedures have been completed and all decisions are final,

- either confirm the provisional refusal(s) to WIPO, or
- send a statement of grant of protection to WIPO indicating that the provisional refusal(s) is/are partially or totally withdrawn. The statement of grant of protection must specify for which goods and services the mark is accepted.

If, upon expiry of the opposition period, the IR has not been the subject of any provisional refusal, the EUIPO will send a statement of grant of protection to WIPO for all the goods and services.

The statement of grant of protection must include the date on which the IR was republished in Part M.3 of the EUTM Bulletin.

The EUIPO will not issue any registration certificate for IRs.

3.10 Second republication

Articles 189(2) and (3) and 190(2), and Article 203 EUTMR

The second republication by the EUIPO will take place when, upon conclusion of all procedures, the IR is (at least in part) protected in the EU.

The date of the second republication will be the starting point for the five-year use period and the date from which the registration may be invoked against an infringer.

From the date of second republication, the IR has the same effects as a registered EUTM. These effects may therefore come into force before the 18-month time limit has elapsed.

Only the following data will be published in Part M.3.1 of the EUTM 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 EUTM Bulletin;
- 450 Date of publication of the international registration or subsequent designation in the EUTM Bulletin.

3.11 Transfer of the designation of the EU

Article 201 EUTMR

The IR represents a single registration for administrative purposes since it is one entry in the International Register. However, in practice, it is a bundle of national (regional) marks with regard to substantive effects and the trade mark as an object of property. As regards the link with the basic mark, while the IR must originally be in the name of the proprietor of the basic mark, it may thereafter be transferred independently of the basic mark.

In fact, a 'transfer of the international registration' is nothing more than a transfer of the mark with effect for one, several or all designated Contracting Parties, and for all or some goods and services. In other words, it is equivalent to a transfer of the corresponding number of national (regional) marks.

Transfers may not be submitted directly to the EUIPO in its capacity as designated office; they must be submitted to WIPO or through the office of the Contracting Party of the holder using the WIPO form MM5. Once recorded by WIPO, the change of ownership of the designation of the EU will be notified to the EUIPO and automatically integrated into the EUIPO database.

In its capacity as designated office, the EUIPO has nothing to examine in relation to the transfer. Rule 27(4) CR allows a designated office to declare to WIPO that, as far as its designation is concerned, a change of ownership has no effect. However, the EUIPO does not apply this provision since it does not have the authority to re-examine whether the change in the International Register was based on proof of the transfer.

3.12 Invalidity, revocation and counterclaims

Articles 58 to 60, Articles 189(2) and 190(2), and Articles 198 and 203 EUTMR
Article 34 EUTMIR

The effects of an IR designating the EU may be declared invalid; the application for invalidation of the effects of an IR designating the EU corresponds to an application for declaration of revocation or for invalidity in EUTM terminology.

There is no time limit for filing an application for invalidity/revocation, with the following exceptions:

- an application for invalidity of an IR designating the EU is only admissible once the designation has been finally accepted by the EUIPO, namely once the statement of grant of protection has been sent.
- an application for revocation on the basis of non-use of an IR designating the EU is only admissible if, at the date of filing the request, the final acceptance of the IR had been republished by the EUIPO at least five years earlier (see Article 203 EUTMR, stating that the date of publication pursuant to Article 190(2) EUTMR takes the place of the date of registration for the purpose of establishing the date as from which the mark that is the subject of an IR designating the EU must be put to genuine use in the European Union).

The EUIPO will examine the request as if it were directed against a direct EUTM (for further information, see the Guidelines, Part D, Cancellation).

If the IR designating the EU is totally or partially invalidated/revoked further to a final decision or a counterclaim action, the EUIPO will notify WIPO according to Article 5(6) MP and Rule 19 CR. WIPO will record the invalidation/revocation and publish it in the International Gazette.

4 Conversion, Transformation, Replacement

4.1 Preliminary remarks

Conversion or transformation

Both apply when an IR designating the EU ceases to have effect, but for different reasons.

- When the IR designating the EU is finally refused by the Office or ceases to have effect for reasons independent of the basic trade mark, only **conversion** is available. Conversion is possible within the prescribed time limit even if, in the meanwhile, the IR has also been cancelled from the International Register at the request of the office of origin, that is, via a 'central attack'.
- When an IR ceases to have effect because the basic mark has been the subject of a 'central attack' during the five-year dependency period, **transformation** into a direct EUTM application is possible. Transformation is not available when the IR has been cancelled at the holder's request or the holder has renounced in part or in whole the designation of the EU. The EU designation must still be effective

when the transformation is requested, that is to say, it must not have been finally refused by the EUIPO; otherwise, there will be nothing left to transform, and conversion of the designation would be the only possibility.

4.2 Conversion

Articles 139 to 141 and 202 EUTMR
Rule 24(2)(a)(iii) CR

The legal option of conversion² has its origins in the EUTM system, which has been adapted to allow a designation of the EU through an IR to be converted into a national trade mark application, just like for a direct EUTM. The EUTM system and Madrid System have also been adapted to allow for conversion into a designation of Member States party to the Madrid System (known as ‘opting back’). Malta is not party to the Madrid System.

In the latter case, a request for subsequent designation of the Member State(s) is forwarded to WIPO. This type of subsequent designation is the only one that, instead of being filed with the office of origin or with WIPO directly, has to be filed through the designated office.

For full details on conversion, see the Guidelines, Part E, Register Operations, Section 2, Conversion.

4.3 Transformation

Article 111(2)(p) and Article 204 EUTMR
Article 36 EUTMIR
Article 6(3) and Article 9*quinquies* MP

4.3.1 Preliminary remarks

Transformation has its origins solely in the Madrid Protocol. It was introduced in order to soften the consequences of the five-year dependency period already set in place by the Madrid Agreement. Where an IR is cancelled in whole or in part because the basic mark has ceased to have effect, and the holder files an application for the same mark and same goods and services as the cancelled registration with the office of any contracting party for which the IR had effect, that application will be treated as if it had been filed on the date of the IR or, where the contracting parties had been designated subsequently, on the date of the subsequent designation; it will also enjoy the same priority, if any.

² In English, ‘conversion’ is used to describe a specific legal provision of the EUTM system (Article 139 et seq. EUTMR) while ‘transformation’ is used to describe that in Article 9*quinquies* MP. In other languages, only one word is used to describe these two different legal provisions (e.g. in Spanish ‘transformación’). In order to avoid confusion, the English word ‘conversion’ could be used in parentheses when, for example, the Spanish word ‘transformación’ is used within the meaning of Article 139 EUTMR.

This filing is not governed by the Madrid Protocol, nor is WIPO involved in any way. Unlike conversion, transformation of the EU designation into national applications is not possible. Nor is it possible to transform an EU designation into individual Member State designations. If the EU has been designated, the IR has effect in the EU and not in individual Member States as such.

The EU designation must still be effective when the transformation is requested, that is to say, it must not have been finally refused by the EUIPO; otherwise, there will be nothing left to transform, and conversion of the designation would be the only possibility.

4.3.2 Principle and effects

Article 32 EUTMR

Following a **cancellation in whole or in part of an IR designating the EU at the request of the office of origin** under Article 9*quinquies* MP (i.e. following a ‘central attack’ during the five-year dependency period), the holder may file a ‘direct’ EUTM application for the same mark, and for the same goods and services as the cancelled mark.

The application resulting from the transformation will be treated by the EUIPO as if it had been filed on the date of the original IR or, where the EU was designated subsequently to the IR, on the date of the subsequent designation; it will also enjoy the same priority, if any.

The date of the IR or of the subsequent designation will not become the filing date of the European Union trade mark application. Article 32 EUTMR, which applies *mutatis mutandis*, lays down clear conditions for the granting of a filing date, subject also to payment of the application fee within one month. However, the date of the IR or subsequent designation will be the date that determines the ‘earlier right effect’ of the EUTM for the purposes of priority searches, oppositions, etc.

Unlike for priority and seniority claims (Article 41(8) EUTMR), it is not possible to have a ‘split’ or ‘partial’ date, with one date being only for those goods that were contained in the IR and the filing date of the European Union trade mark application being the relevant date for the additional goods and services. No such partial transformation effect is contemplated in Article 9*quinquies* of the Madrid Protocol or Article 204 EUTMR.

Renewal starts to run from the filing date of the transformed EUTM.

4.3.3 Procedure

The conditions for invoking a transformation right under Article 9*quinquies* MP are that:

- the application is filed within a period of three months from the date on which the IR was cancelled in whole or in part, and
- the goods and services of the ensuing application are in fact covered by the list of goods and services of the designation of the EU.

The applicant needs to claim this right in the relevant section provided in the EUTM application form. The following indications must be given:

1. number of the IR that has been cancelled in whole or in part;
2. date on which the IR was cancelled in whole or in part by WIPO;
3. date of the IR pursuant to Article 3(4) MP or date of territorial extension to the EU made subsequently to the IR, pursuant to Article 3~~ter~~(2) MP;
4. date of priority claimed in the IR, if any.

The EUIPO will invite the applicant to remedy any deficiencies detected within a period of two months.

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 will be lost. In other words, if the transformation is finally refused, the EUTM application will be examined as a 'normal' application.

4.3.4 Examination

4.3.4.1 Application for transformation of an IR designating the EU where no particulars have been published

When the application for transformation relates to an IR designating the EU for which the particulars have not been published pursuant to Article 190(2) EUTMR (in other words that has not been finally accepted by the EUIPO), the EUTM resulting from transformation will be treated as a normal EUTM application; it will be examined as to classification, formalities and absolute grounds and published for opposition purposes. Nothing in the regulations allows the EUIPO to omit the examination process.

Nevertheless, since this case presupposes that an IR designating the EU had already existed, the EUIPO can take advantage of the classification of the list of goods and services of the cancelled IR (as far as it complies with the EUIPO rules).

The EUTM will be published in Part A of the EUTM Bulletin for opposition purposes, with an additional field under INID code 646 mentioning the details of the transformation. The remainder of the procedure will be the same as for a normal EUTM filing, including if an opposition procedure had already been initiated against the IR designating the EU without reaching the final decision stage. In such a case, the previous opposition procedure would be closed and a new opposition would need to be filed.

4.3.4.2 Application for transformation of an IR designating the EU where particulars have been published

When the application for transformation relates to an IR designating the EU for which the particulars have already been published pursuant to Article 190(2) EUTMR, the examination and opposition stage are omitted (Articles 42 to 47 EUTMR).

Nevertheless, the list of goods and services will have to be translated into all languages. The EUTM will then be published in Part B.2 of the EUTM Bulletin with the translations and the additional INID code 646, and the registration certificate will be issued immediately.

According to Article 204(2) EUTMR, in the event of the transformation of an IR after second republication, the full rights emanating from the IR designating the EU will continue to apply without interruption to the registered EUTM, meaning that the latter will, for the purposes of the determination of an 'earlier mark' within the meaning of Articles 8 and 9 EUTMR, benefit from the filing (or priority) date of the IR or the subsequent designation.

According to Article 182 EUTMR, unless there are specific provisions to the contrary, the provisions of the EUTMR and the acts adopted pursuant to it apply *mutatis mutandis* to IRs designating the EU. This includes, inter alia, Article 18(1) EUTMR, which imposes on EUTM proprietors the obligation to use the mark within a period of five years following registration. According to Article 203 EUTMR, the date of the second republication of an IR designating the EU is the date taken for calculating its grace period. The reasoning behind the five-year grace period is to give the trade mark proprietor five years from registration to prepare use of the mark. Since the situation of an IR designating the EU that has been transformed into an EUTM registration after its second republication is no different from that of an EUTM registration filed directly with the EUIPO, there is no reason for any different treatment either.

Furthermore, from the equity point of view, a trade mark owner that enjoys the full rights of trade mark protection without interruption is also under the corresponding obligations as set out by the law, including inter alia the obligation to use the trade mark concerned.

Consequently, the transformation of an IR designating the EU after the first republication has no impact on the calculation of the grace period, which commences as provided for in Article 203 EUTMR with the second republication, namely on the date of the second republication of the original EU designation in part M.3 of the EUTM Bulletin.

4.3.5 Transformation and seniority

If seniority claims have been accepted by the EUIPO and are registered by WIPO in the file for the transformed IR designating the EU, there is no need to claim seniority again in the EUTM resulting from transformation. This is not explicitly set out in Article 36 EUTMR (only priority is mentioned under (d)) but is extended by analogy to seniority in view of the fact that:

- the EUIPO has already accepted the claims and WIPO has published them;
- if the owner had let the earlier marks lapse in the meanwhile, it would not be able to file new claims before the EUIPO (one condition of a valid seniority claim being that the earlier right is both registered and in force when the claim is made).

4.3.6 Fees

There is no specific 'transformation' fee. The EUTM application resulting from the transformation of the IR designating the EU is subject to the same fees as a 'normal' EUTM application.

The basic fee for the EUTM application must be paid to the EUIPO within one month of the filing of the EUTM requesting transformation in order for the request to comply with Article 32 EUTMR and Article 9*quinquies*(iii) MP and for the transformation to be

accepted. For example, if the end of the three-month time limit for transformation is 01/04/2012 and transformation into an EUTM application is filed on 30/03/2012, the deadline for payment of the basic fee is 30/04/2012. If payment occurs after that date, the conditions for transformation are not met, the transformation right will be lost and the filing date given to the EUTM application will be the date of the payment.

4.4 Replacement

Article 111(3)(t) and Article 197 EUTMR
Article 4*bis* MP
Rule 21 CR

4.4.1 Preliminary remarks

Replacement has its origins in the Madrid Agreement and Madrid Protocol. A mark that is registered with the office of a contracting party is, under certain conditions, deemed to be replaced by an international registration of the same mark without prejudice to the rights already acquired (earlier date). The wording of Article 4*bis*(1) MP clearly provides that replacement is deemed to take place automatically, without the need for any action by the holder and without any record having to be made of the replacement. Nevertheless, it is possible to ask the EUIPO to take note of the replacement in its Register (Rule 21 CR). The purpose of this procedure is to ensure that the relevant information concerning the replacement is 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 earlier acquired rights, neither the Madrid Agreement nor the Madrid Protocol elaborates further on replacement.

4.4.2 Principle and effects

In accordance with Article 4*bis* of the Madrid Protocol, the holder may request the EUIPO to take note in its Register of the international registration that replaces an EUTM. The holder's rights in the EU should be deemed to start from the filing date of the earlier EUTM registration. An entry will therefore be made in the EUTM Register to the effect that a direct EUTM has been replaced by a designation of the EU through an IR and published.

4.4.3 Procedure

A request for replacement may be filed at the EUIPO by the international holder at any time after notification of the EU designation by WIPO.

Once a request to record a replacement has been received, the EUIPO will carry out a formal examination, checking that the marks are identical, that all the goods and services listed in the EUTM are listed in the IR designating the EU, that the parties are identical and that the EUTM has been registered prior to the designation of the EU. The IR need not have an identical list of goods and services: the list may be broader in scope. It cannot, however, be narrower. If the list is narrower, a deficiency will be

issued. This deficiency can normally be overcome by partially surrendering the goods and services of the EUTM that fall outside the scope of the IR.

The EUIPO considers it sufficient for noting the replacement in the Register if the IR and EUTM coexist on the date of the IR. In particular, should the designation of the EU through an IR not yet be finally accepted, the EUIPO will not wait for final acceptance before recording the replacement. It is up to the international holder to decide when to request the replacement.

If all conditions are met, the EUIPO will note the replacement in the EUTM Register and inform WIPO that an EUTM has been replaced by an IR in accordance with Rule 21 CR, indicating:

- the number of the IR;
- the EUTM number;
- the EUTM application date;
- the EUTM registration date;
- the priority date(s) (if relevant);
- the seniority number(s), filing date(s) and country/countries (if relevant);
- the list of goods and services of the replacement (if relevant).

After the replacement has been recorded, the EUTM is maintained normally in the Register as long as the holder renews it. In other words, there is coexistence between the replaced EUTM in force and the IR designating the EU.

According to Rule 21(2) of the Common Regulations, WIPO will record the indications notified under paragraph (1) of that Rule in the International Register, publish them and inform the holder accordingly, in order to ensure that the relevant information concerning replacement is made available to third parties. Nevertheless, there is no obligation for the EUIPO to communicate further changes affecting the replaced EUTM.

4.4.4 Fees

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

4.4.5 Publication

Articles 111(3)(t) and Article 116 EUTMR

The replacement is entered in the EUTM Register and published in the EUTM Bulletin under Part C.3.7.

4.4.6 Replacement and seniority

Article 4*bis*(1) MP

Since replacement occurs 'without prejudice to any rights acquired' by virtue of the earlier registration, the EUIPO will include information on the seniority claims contained

in the replaced EUTM registration within the content of the notification to be sent to WIPO under Rule 21 CR.

4.4.7 Replacement and transformation

If an IR that replaces a direct EUTM ceases to have effect following a 'central attack', and provided that the conditions laid down by Article 9*quinquies* MP are met, the holder can request transformation of the IR under Article 9*quinquies* MP while maintaining the effects of the replacement of the EUTM and its earlier date effects, including priority or seniority if applicable.

4.4.8 Replacement and conversion

The IR and the EUTM should coexist on the date of the IR if the replacement is to be effective. Therefore, if the IR that replaces the direct EUTM is finally refused by the EUIPO (e.g. further to an opposition), the holder can request conversion of the designation of the EU and should be able to maintain the effects of the replacement of the EUTM and its earlier date effects, including priority or seniority if applicable.