

***GUIDELINES FOR EXAMINATION IN THE OFFICE FOR HARMONIZATION IN THE
INTERNAL MARKET (TRADE MARKS AND DESIGNS) ON COMMUNITY TRADE
MARKS***

PART M

INTERNATIONAL MARKS

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This part of the Guidelines focuses specifically on the examination of international marks. For further details on normal 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 Community trade mark (CTM) 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 OHIM. Paragraph 2 deals with OHIM's tasks as an office of origin, that is, with 'outgoing' international applications. Paragraph 3 deals with its tasks as a designated office, that is, with 'incoming' international registrations designating the EU (IR). Paragraph 4 deals with conversion, transformation and replacement.

The Guidelines are not intended to, and cannot, add to or subtract from the substance of new Title XIII CTMR and Rules 102-126 CTMIR. OHIM 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 do not intend to repeat what is said there.

2 OHIM as Office of Origin

The tasks of OHIM as office of origin chiefly 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 146 CTMR Rule 102(3) CTMIR

International applications filed with OHIM are subject to:

- payment of the handling fee;
- the existence of (a) basic CTM registration(s) or application(s) ('basic mark(s)');
- identity between the international application and the basic mark(s);
- proper completion of the MM2 or EM2 form;
- an entitlement to file the international application through OHIM.

2.1.1 Identification of international applications

An international application will be identified in the OHIM database under the basic CTM(A) 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 CTM(A) will be identified by **_02**, **_03**, etc. International applications based on more than one CTM(A) will be identified by the number of the older CTM(A).

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 147(5), Article 150 CTMR
Article 2(31) CTMFR
Rule 103(1), Rule 104 CTMIR

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 OHIM 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, Means of Payment).

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

The means of payment used may be communicated to OHIM 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 OHIM, the date of receipt which OHIM will communicate to WIPO will be the date the payment reaches OHIM. If payment is still not made within the two-month time limit set by OHIM, OHIM 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 OHIM. Any such fees paid by error to OHIM will be reimbursed to the sender.

If the applicant uses EM2 forms, 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, OHIM 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 147(1) CTMR
Rules 83(2)(b), 103(2)(a) CTMIR

Use of one of the official forms is compulsory. The official form is either WIPO form MM2, available in English, French or Spanish, or OHIM form EM2 (OHIM adaptation of MM2), which is available in all official EU languages. Applicants may not use other forms or change the contents and layout of the forms. However, both the WIPO MM2 form and the OHIM EM2 form are available in .doc format allowing as much text as necessary to be entered for each item.

If the application is filed in a language that is not one of the Madrid Protocol languages (English, French, Spanish), the applicant must indicate in which of these three languages the application is to be forwarded to WIPO. All items on the form must be completed in the same language; it is not possible to choose a language other than the language of the form.

OHIM recommends using the OHIM EM2 form. The OHIM EM2 form in English, French and Spanish has almost the same layout and numbering as the WIPO MM2 form but is specifically adapted to the CTM environment:

- applicants can indicate payment details (item 0.4) to OHIM in the introductory item 0 and the number of pages (item 0.5) the application contains;
- certain choices are limited to what is applicable to OHIM (e.g. OHIM 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 OHIM;
- the reproduction of the mark need not be submitted in item 7, as OHIM will use the reproduction available in the basic CTM(A);
- the option of seeking protection for the same goods and services contained in the basic mark by ticking a box 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 OHIM certifies the international application electronically.

Where the applicant chooses the OHIM EM2 form in a language version other than English, French or Spanish, 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 OHIM is to communicate with the applicant on matters concerning the international application, that is, either the language in which the international application is filed or the language in which it is to be transmitted to WIPO (see Article 147(1), second sentence, CTMR);

- tick boxes in item 0.3 for indicating either that a translation of the list of goods and services is included or that OHIM 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 is ticked, OHIM 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.

2.1.3.1 Entitlement to file

Article 2(1)(i) Madrid Protocol (MP)

Under item 3 of the official form, an indication must be given regarding entitlement to file. An applicant is entitled to file with OHIM as office of origin if it is a national of, or has 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 the 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 OHIM 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 OHIM.

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

Rule 103(2)(c), (d), (e) CTMIR Rule 9(4)(a)(v), (vii), (vii bis-xii), Rule 11(2) CR
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The Madrid system is founded on the requirement of a basic national or regional trade mark application or registration. Under the MP, 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 CTMAs and CTMs even where, although containing identical marks, the goods and services covered are different.

All the basic CTMA(s) or CTM(s) must have been accorded a filing date, and must be in force.

The international applicant must be identical to the CTM holder/CTMA 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, CTMs as Objects of Property, Chapter 1, Transfer). Where there are multiple holders or applicants in the basic CTM(s) or CTMA(s), the international application must be submitted by the same persons.

The reproduction of the mark must be identical. Particular attention should be paid to the following:

- Item 7 c) of the official form must be ticked if the mark is in standard characters (word mark).
- Item 8 a) of the official form foresees the possibility of making a colour claim. Where the basic CTM(s) or CTMA(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 CTM(s) or CTMA(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 mark for a colour or colour combination as such,
 - a three-dimensional mark,
 - a sound mark, and/or
 - a collective mark,

the international application must be the same, and item 7 d) or 9 d) must be ticked. If the basic mark is a sound mark, only the graphic representation, i.e. the musical notation, will be transmitted to WIPO as WIPO does not accept electronic sound files.

- If the basic mark includes a description, the same description may be included in the international application (item 9 e)). 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 9 g)).
- WIPO requires a transliteration in Latin characters if the mark contains characters other than Latin. If no transliteration is provided, WIPO will raise an irregularity, which must be remedied directly by the applicant. This is true for all types of trade marks, not just word marks.

The list of goods and services must be identical to or narrower than 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 some designated parties.

If the applicant does not provide a translation into the WIPO language chosen by it (English, French or Spanish) but instead authorises OHIM to provide the translation or to use the one available for the basic mark(s), it will not be consulted on 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. The validity of the claim will in principle not be challenged by the examiner, as in most cases either the basic CTM(A) is the first filing for which priority is claimed or the priority of another earlier mark has already been claimed and examined in relation to the basic CTM(A). However, if there is evidence in the file that priority is claimed for a right that is not a first filing, the examiner will object and request that the priority claim be deleted.

2.1.3.4 Designated contracting parties

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

2.1.3.5 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.

2.1.3.6 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, footnote **). This form, which contains the declaration of intention to use the mark, is available only in English and must be submitted in that language irrespective of the language of the international application.

2.1.4 Examination of the international application by OHIM

Article 147 CTMR
Rule 103(2), Rule 104 CTMIR
Article 3(1) MP

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

Examiners may try solving minor deficiencies or seeking clarification over the phone in order to speed up the process.

If the deficiencies are not remedied, OHIM 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 OHIM 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), Rules 12, 13 CR

If WIPO detects irregularities in the application, it will issue an irregularity notice, which will be forwarded to both the applicant and OHIM as office of origin. The irregularities must be remedied by OHIM 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 OHIM.

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 OHIM. In this case, OHIM will forward the applicant's communication just as it is to WIPO, as OHIM 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 make a proposal to remedy the irregularity.

2.2 Subsequent designations

Article 149 CTMR
Rule 1(xxvi bis), Rule 24(2) CR
Article 2(1)(ii) MP
Rule 83(2)(b), Rule 105(1)(a), (c), (d), Rule 105(2), (4) CTMIR

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 to 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.

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.

Where an IR is transferred to a person who is not entitled to make a subsequent designation through OHIM, the application for such a subsequent designation cannot be filed through OHIM, but must instead be filed through WIPO or the corresponding office of origin (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 OHIM.

Subsequent designations must be filed on the official form: the WIPO MM4 form in English, French or Spanish or the OHIM EM4 form in the other EU languages. There is no specific OHIM form in English, French and Spanish as no special indications for OHIM are needed in those languages and the WIPO MM4 form is, therefore, sufficient.

The Fee Calculation Sheet (Annex to the WIPO MM4 form) 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, OHIM 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 the International Bureau. A fee calculator is available on WIPO's website.

In the MM4 or EM4 forms, the indications to be made are limited to indications concerning the applicant and its entitlement to file, indications concerning the representative, the list of goods and services, and the designation of additional Contracting Parties to the Madrid Protocol. These indications must be made in the same way as in the MM2 form. The only difference in the entitlement to file is that a subsequent designation may be filed at OHIM if the international registration is transferred to a person who is a national of an EU Member State or has their domicile or an establishment in the EU (OHIM as 'office of the contracting party of the holder').

A subsequent designation may also be used to extend the scope of the IR to enlarge the goods and/or services coverage of a prior designation

The list of goods and services may be the same as in the international registration (item 5 a) of the official form) or narrower (item 5 b) 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 be subsequently 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 presented for different, subsequently designated, contracting parties.

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

Subsequent designations must be made in the same language as the initial international application, failing which OHIM will refuse to forward the subsequent designation.

If the application is not in English, French or Spanish, the applicant must tick item 0.1 on the OHIM EM4 form and indicate the language in which the subsequent designation is to be transmitted to WIPO. That language may be different from the language of the international registration. 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 OHIM must also be completed.

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

2.3 Notification of facts affecting the basic registration

Articles 44, 49 CTMR Rule 106(1)(a), (b), (c), Rule 106(2), (3), (4) CTMIR

If, within five years of the date of the international registration, the basic mark(s) ceases to exist in whole 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 CTMs, this covers cases where, either fully or partially (for only some goods or services),

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

Where the above occurs as a result of a decision (by OHIM or a CTM court), the decision must be final.

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

OHIM must check that the international application has actually been registered before notifying WIPO that the basic CTM 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 immediately after expiry of the five-year period. The cases involved are:

- a pending refusal of the basic CTMA(s) on absolute grounds (including ensuing appeals before the Boards of Appeal or the GC/CJEU);
- pending opposition proceedings (including ensuing appeals before the Boards or the GC/CJEU);
- pending cancellation proceedings before OHIM (including ensuing appeals before the Boards or the GC/CJEU);
- a counterclaim in infringement proceedings against a CTM, according to the CTM Register, which is pending before a CTM court.

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 exist or remained valid.

If, within five years of the date of the international registration, the basic CTM(s) or CTMA(s) is (are) divided or partially transferred, this must also be notified to WIPO. 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 record of the number of mark(s) on which the IR is based.

No other changes in the basic mark(s) will be notified to WIPO by OHIM. 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

Rule 107 CTMIR

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

OHIM 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 origin. 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, 20 bis, Rule 25(1) CR

The following applications for changes relating to an international registration can be presented to OHIM 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 CTM 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: for cancelling the recording of a license
- WIPO form MM19: restriction of the holder’s right of disposal submitted by the IR holder on record (in CTM terminology, this corresponds to a right *in rem*, levy of execution, enforcement measure or insolvency proceedings contemplated in Articles 19, 20 and 21 CTMR).

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

These applications can only be filed through OHIM if it is the office of origin or if it acquires competence in respect of the holder as the result of a transfer of the international registration (see Rule 1(xxvi bis) CR). However, this condition will not be examined by OHIM because the latter will simply forward the request, which could have been filed with WIPO directly.

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

Rule 20(1)(a), Rule 20 bis(1), Rule 25(1)(b) CR Rule 120 CTMIR

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 OHIM examines 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 Rule 120 CTMIR. OHIM limits itself to examining proof of the transfer, licence or other right, and Rule 31(1), (5) CTMIR and the corresponding parts of the OHIM Guidelines on transfers, licences, rights *in rem*, levy of execution and insolvency proceedings apply by analogy. If no proof is furnished, OHIM will refuse to forward the application to WIPO.

This decision is open to appeal.

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

3 OHIM as Designated Office

3.1 Overview

Since 01/10/2004, any person who is a national of, or has a domicile or commercial establishment in, a State which 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 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. OHIM receives the data from WIPO exclusively in electronic form.

International registrations designating the EU are identified by OHIM 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 OHIM databases online the 'W' should not be indicated.

OHIM 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 OHIM 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 OHIM 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 OHIM would have to re-publish the IR in part in the CTM Bulletin and re-open the opposition period only for that part of the goods and services.

The main tasks performed by OHIM as designated office are:

- first republication of IRs designating the EU;
- drawing up of Community search reports;
- examination of formalities, including seniority claims;
- examination on absolute grounds;
- examination of oppositions against IRs;
- processing of communications from WIPO concerning changes to the IRs.

3.2 Professional representation

Article 92(2) Article 93 CTMR

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

Non-EU holders are, however, obliged to be represented (a) further to a provisional refusal, (b) for filing seniority claims directly before OHIM, or (c) further to an objection on a seniority claim (see the Guidelines, Part A, General Rules, Section 5, Professional Representation and Articles 92 and 93 CTMR).

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

Where the non-EU 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 OHIM, any notifications of provisional refusal or objection will contain an invitation to appoint a representative in compliance with Articles 92 and 93 CTMR. For the particularities of representation in each of the proceedings before OHIM, see paragraphs 3.3.3, 3.4 and 3.6.6 below.

3.3 First republication, searches and formalities

3.3.1 First republication¹

Article 152 CTMR

Upon receipt, IRs will immediately be republished in Part M.1 of the CTM 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 OHIM 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 CTM Bulletin on OHIM's website.

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

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

3.3.2 Searches

Article 155 CTMR

As with direct CTM filings, OHIM will draw up a Community search report for each IR, which will cite similar CTMs and IRs designating the EU. The owners of the earlier marks cited in the report will receive a surveillance letter in accordance with Article 155(4) CTMR. In addition, upon request by the international holder, OHIM 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 OHIM. 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 OHIM 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 and then only the Community search report will be drawn up.

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

The search reports 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 OHIM for the sole purpose of receiving the search report or requesting national searches.

3.3.3 Formalities examination

The formalities examination carried out by OHIM on IRs is limited to whether a second language has been indicated, whether the application is for a collective mark, ~~and~~ 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 Part B.3 Classification. ~~OHIM will not review the classification of goods and services performed by WIPO.~~

3.3.3.1 Languages

Article 119(3), (4) CTMR Rule 96(1), Rules 112, 126 CTMIR Rule 9(5)(g)(ii) CR

Rule 9(5)(g)(ii) CR and Rule 126 CTMIR 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 OHIM by ticking the appropriate box in the contracting parties section of WIPO forms MM2/MM3 or MM4.

According to Rule 126 CTMIR, the language of filing of the international application will be the language of the proceedings within the meaning of Article 119(4) CTMR. 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 OHIM.

The second language indicated in the international application will be the second language within the meaning of Article 119(3) CTMR, that is, a possible language of proceedings for opposition, revocation or invalidity proceedings before OHIM.

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 OHIM issues the provisional refusal pursuant to Rule 112 CTMIR to remedy the deficiency. Where the IR holder is obliged to be represented in proceedings before OHIM and its representative before WIPO does not appear in the database of representatives maintained by OHIM, the notification of provisional refusal will invite the holder to appoint a representative in compliance with Articles 92 and 93 CTMR. 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 OHIM.

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

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

3.3.3.2 Collective marks

Articles 66, 67 CTMR Rule 43, Rule 121(1), (2), (3) CTMIR
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In the CTM system, there are only two kinds of mark: individual marks and collective 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, if the IR designating the EU is based on a national certification mark, guarantee mark or collective mark, it will be identified as a collective mark before OHIM; this entails the payment of higher fees.

The conditions applying to Community collective marks will also apply to IRs designating the EU as a collective mark.

According to Rule 121(2) CTMIR, the holder must submit the regulations governing use of the mark directly to OHIM within two months of the date on which the International Bureau notified OHIM of the designation.

If, by then, the regulations on use have not been submitted or contain irregularities, or the holder does not comply with the requirements of Article 66, the examiner will issue a provisional refusal of protection and give the holder two months from the day on which OHIM issues the provisional refusal pursuant to Rule 121(3) CTMIR to remedy the deficiency. Where the IR holder is obliged to be represented in proceedings before OHIM and its representative before WIPO does not appear in the database of representatives maintained by OHIM, the notification of provisional refusal will invite the holder to appoint a representative in compliance with Articles 92 and 93 CTMR. 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 OHIM.

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

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

When, in the answer to the provisional refusal, elements are submitted satisfying OHIM that the basic mark is a certification mark or guarantee mark and the IR holder is not qualified to be the owner of a Community collective mark, OHIM 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 for a collective one.

3.3.3.3 Seniority claims

Seniority claims filed together with the designation

Article 153(1) CTMR Rule 9(3)(d), Rule 9(7), Rule 108, Rule 109(1), (2), (3), (4) CTMIR Rule 9(5)(g)(i), Rule 21 bis CR

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 presented 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 Rule 8(2) CTMIR applicable to direct CTM 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 OHIM by WIPO.

Seniority claims presented together with the international application or subsequent designation will be examined in the same way as seniority claims presented with a Community trade mark 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 the IR holder is obliged to be represented in proceedings before the OHIM and its representative before WIPO does not appear in the database of representatives maintained by OHIM, the holder will also be invited to appoint a representative before OHIM.

If the seniority claim is accepted by OHIM, 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 has not been appointed (if applicable), the right of seniority will be lost pursuant to Rule 109(2) CTMIR. The IR holder may request a decision, which can be appealed. Once it is final, OHIM 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 filed directly before OHIM

Article 153(2) CTMR Rule 110(1), (2), (4), (5), (6) CTMIR Rule 21 bis (2) CR
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The IR holder may also claim the seniority of an earlier mark registered in a Member State directly before OHIM upon publication of the final acceptance of the IR. Where the IR holder is obliged to be represented in proceedings before OHIM and its representative before WIPO does not appear in the database of representatives maintained by OHIM, OHIM will invite the holder to appoint a representative in compliance with Articles 92 and 93 CTMR.

The reply to the deficiency letter must be addressed to OHIM.

Any seniority claim presented 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 OHIM on the date of publication of the final acceptance of the IR and will therefore be examined by OHIM after that date.

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 the holder of the international registration is obliged to be represented in proceedings before OHIM and its representative before WIPO does not appear in the database of representatives maintained by OHIM, the holder will also be requested to appoint a representative before OHIM.

If the seniority claim is accepted by OHIM, 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 Rule 110(6) CTMIR.

If the deficiency is not remedied and/or a representative has not been appointed (if applicable), 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

Article 36 and Article 145 CTMR

Rule 2 and Rule 9 CTMIR

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

Where the IR contains vague terms in the list of goods and/or services that lack clarity or precision, the Office will issue a provisional refusal of protection and give the holder two months from the day on which OHIM issues the provisional refusal pursuant to Rule 2 and Rule 9 CTMIR to remedy the deficiency. Where the IR holder is required to be represented in proceedings before OHIM and its representative before WIPO does not appear in the database of representatives maintained by OHIM, the notification of provisional refusal will invite the holder to appoint a representative in compliance with Article 92 and Article 93 CTMR. 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 OHIM.

Once the provisional refusal has been sent, further examination is the same as for a direct CTMA; there will be direct exchanges with the 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 to appoint a representative before OHIM, if applicable, within the prescribed time limit, the Office will issue an interim status of the mark to WIPO, provided that no other 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 EU.

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, OHIM 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 (absolute grounds/oppositions) have been completed or the opposition period is over without any opposition being received (see point 3.9 below).

3.4 Absolute grounds for refusal

Article 154(1) CTMR
Rule 112(5), 113 CTMIR

International registrations designating the EU shall be subject to examination as to absolute grounds for refusal in the same way as direct CTMAs (for details, please consult the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal and Community Collective Marks).

If OHIM 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 OHIM finds that the mark is not eligible for protection, it will send a provisional refusal of protection, giving the holder two months from the day on which the provisional refusal is sent to file observations. Where the holder of the international registration is obliged to be represented in proceedings before OHIM and its representative before WIPO does not appear in the database of representatives maintained by OHIM, the notification of provisional refusal will also invite the holder to appoint a representative in compliance with Articles 92 and 93 CTMR. 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 OHIM.

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.

Where no provisional refusal has been issued by OHIM before the start of the opposition period (six months after republication), the ~~absolute grounds~~-*ex Officio* examination shall be considered concluded. OHIM will, therefore, send an interim status of the mark to WIPO.

Once the provisional refusal has been sent, further examination is the same as for a direct CTMA; 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 EU.

If the holder fails to overcome the objections or convince the examiner that they are unfounded, or refrains from replying to the objection, the refusal will be confirmed to the extent identified in the provisional refusal. In other words, if the provisional refusal concerned only part of the goods and services, only those goods and services will be refused and 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 the refusal is total, OHIM 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 ([specification of goods and services](#)/oppositions) are terminated or the opposition period is over with no opposition received (see point 3.9 below).

3.5 Third-party observations

Article 40 CTMR
Rule 112(5) CTMIR

Third-party observations can be validly filed at OHIM from the date of notification of the IR to OHIM 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 OHIM has for informing WIPO of all possible grounds for refusal (see paragraph 3.1 above).

If third-party observations are received before OHIM communicates the outcome of the absolute grounds examination to WIPO and OHIM considers the observations justified, a provisional refusal will be issued without mentioning the third-party observations.

If third-party observations are received after a provisional refusal on absolute grounds has been issued in relation to goods and services other than those to which the observations relate and the OHIM considers the observations justified, a further provisional refusal will be issued without mentioning the third-party observations.

If third-party observations are received after an interim status of the mark has been issued and the OHIM 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, Procedural aspects concerning observations by third parties and review of absolute grounds.

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

3.6 Opposition

Article 156 CTMR
Rules 114 and 115 CTMIR

3.6.1 Timing

Oppositions may be filed against the international registration between the sixth month and the ninth month following the date of first republication. For example, if the first republication is on 15/02/2012, the opposition period starts on 16/08/2012 and ends on 15/11/2012.

The opposition period is fixed and is independent of the outcome of the procedure on absolute grounds. Nevertheless, the start of the opposition procedure depends on the outcome of the absolute grounds examination insofar as the opposition procedure may be suspended if an absolute grounds refusal is issued.

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.

For full details on the opposition procedure, please consult the Guidelines, Part C, Opposition, Section 1, Procedural Matters.

3.6.2 Receipt and informing the international holder

Rule 16a, Rule 114(3) CTMIR

OHIM 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.

OHIM 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 OHIM holds sufficient contact information, to that representative, irrespective of location, for information purposes.

3.6.3 Fees

Article 156(2) CTMR
Rule 54 CTMIR

The opposition shall 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 OHIM decides to confirm the finding, both parties will be informed thereof. If the opponent appeals this decision, OHIM 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 92(2) CTMR
Rules 17, 115 CTMIR

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

If the opposition is considered inadmissible, OHIM 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 119(6) CTMR
Rule 16(1) CTMIR

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 one of these two languages as the language of the opposition proceedings. The opposition may also be filed in any of the other three OHIM languages provided that a translation into the language of the proceedings is filed within one month.

OHIM 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, e.g. the provisional refusal.

3.6.6 Representation of the IR holder

3.6.6.1 Opposition receipts

Rule 16a CTMIR

If applicable, in the opposition receipts OHIM will inform the IR holder that if it does not appoint a representative who complies with the requirements stipulated in Articles 92(3) or 93 CTMR within one month of receipt of the communication, OHIM 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 OHIM, OHIM will inform this representative that if they wish to represent the IR holder before OHIM they must specify the basis of their entitlement (i.e. whether they are a legal practitioner or professional representative within the meaning of Article 93(1)(a) or (b) CTMR or an employee representative within the meaning of Article 92(3) CTMR) (see also the Guidelines, Part A, General Rules, Section 5, Professional Representation).

3.6.6.2 Notification of commencement of opposition proceedings

Rule 18(1) CTMIR

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 an EU representative before the opposition has been notified as admissible, further processing of the file will depend on whether or not the *IR holder* is obliged to be represented before OHIM pursuant to Article 92(2) CTMR.

- If the IR holder is *not* obliged to be represented before OHIM, the proceedings will continue directly with the IR holder, i.e. 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* obliged to be represented before OHIM, the IR holder will be notified of the admissibility of the opposition and will be formally requested to appoint an EU representative within two months of receipt of the communication (Rule 114(4) CTMIR), 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 the costs will be taken and the opposition fee will not be refunded.

3.6.7 Provisional refusal (based on relative grounds)

Article 156(2) CTMR
Rule 18, Rule 115(1) CTMIR
Article 5(1), Article 5(2)(a), (b) MP
Rule 17(1)(a), (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 will contain the list of goods and services against which the opposition is directed, the earlier rights invoked, and the relevant list of goods and services on which the opposition is based.

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

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 OHIM, as in the case of a normal CTM.

3.6.8 Suspension of opposition where there is a pending provisional refusal on [the specification of goods and services and/or](#) absolute grounds

Rule 18(2), 20 (7) CTMIR

If the opposition was filed after OHIM had already sent a notification of provisional refusal on [the specification of goods and services and/or](#) absolute grounds in relation to the same goods and services, OHIM will inform WIPO of the provisional refusal and communicate to the parties that, as from the date of the communication, the opposition procedure is suspended until a final decision on [the specification of goods and services and/or](#) absolute grounds is issued.

If the provisional refusal on [the specification of goods and services and/or](#) absolute grounds leads 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 refusal on [the specification of goods and services and/or](#) absolute grounds is not maintained or is 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 a provisional refusal on [the specification of goods and services and/or](#) absolute or 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. 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 CTMA. The IR holder must submit such requests to WIPO (or through the office of origin) using the official form (MM7/MM8). OHIM 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 CTMA in parallel proceedings under Rule 18(2) CTMIR, in which case the opposition fee is not reimbursed.

3.8 Limitations of the list of goods and services

OHIM 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, OHIM will communicate to WIPO that the provisional refusal is withdrawn), or
- directly with OHIM. In this case OHIM will communicate the limitation to WIPO by confirming the provisional refusal. In other words, WIPO's register will reflect the partial refusal, not the limitation as such.

Where there is no provisional refusal pending, all limitations must be filed only through WIPO.

Limitations will be examined in the same way as limitations or partial surrenders of a CTM(A) (see the Guidelines, Part B, Examination, Section 3, Classification, and the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration). When the limitation has been submitted through WIPO and is considered unacceptable by OHIM, 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 OHIM.

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 issue of Statement of Grant of Protection

Rules 113(2)(a), 115(5)(a), 116(1) CTMIR

If one or several notifications of provisional refusal have been sent to WIPO, OHIM 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, OHIM 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 CTM Bulletin.

OHIM will not issue any registration certificate for IRs.

3.10 Second republication

Articles 151(2),(3), 152(2), Article 160 CTMR
Rule 116(2) CTMIR

The second republication by OHIM 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 international application has the same effects as a registered CTM. 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 CTM Bulletin:

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

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

3.11 Transfer of the designation of the EU

Rule 120 CTMIR

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. In other words, it is equivalent to a transfer of the corresponding number of national (regional) marks.

Transfers may not be presented directly to OHIM 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 MM5 form. Once recorded by WIPO, the change of ownership of the designation of the EU will be notified to OHIM and automatically integrated into the OHIM database.

In its capacity as designated office, OHIM has nothing to examine for 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, OHIM 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. Furthermore, OHIM does not re-examine the mark for potential deceptiveness either (Article 17(4) CTMR) unless the transfer is filed during the absolute grounds examination phase.

3.12 Invalidity, revocation and counterclaims

Articles 51, 52, 53, Articles 151(2), 152(2), Articles 158, 160 CTMR
Rule 117 CTMIR

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, in CTM terminology, to an application for declaration of revocation or for invalidity.

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 OHIM, 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 OHIM at least five years earlier (see Article 160 CTMR, stating that the date of publication pursuant to Article 152(2) 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).

OHIM will examine the request as if it were directed against a direct CTM (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, OHIM will notify WIPO according to Article 5(6) Madrid Protocol and Rule 19 CR. WIPO will record the invalidation/revocation and publish it in the International Gazette.

3.13 Fee management

As a consequence of setting the equivalent of the registration fee at zero for direct CTMs and the application of this change to Madrid fees on 12/08/2009, there will no longer be any reimbursement of part of the individual fee for IRs designating the EU with a designation date later than the above date that are finally refused or for which the IR holder has renounced protection in respect of the EU prior to the refusal decision becoming final pursuant to Articles 154 and 156 CTMR.

Pursuant to Article 3 (last paragraph) of Commission Regulation (EC) No 355/2009 of 31/03/2009 amending Commission Regulation (EC) No 2869/95 of 13/12/1995 on the fees payable to OHIM, designations of the EU filed before 12/08/2009 will continue to benefit from a refund of the registration fee in the event of refusal or withdrawal as per Article 13 CTMFR in the version in force prior to the entry into force of Commission Regulation No 355/2009.

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 an IR ceases to have effect because the mark of origin has been the subject of a 'central attack' during the five-year dependency period, **transformation** into a direct CTM 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, it must not have been finally refused by OHIM; otherwise, there will be nothing left to transform and conversion of the designation would be the only possibility.
- When the IR designating the EU is finally refused by OHIM 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, i.e. via a 'central attack'.

4.2 Conversion²

Articles 112 to 114, 159 CTMR
Rule 24(2)(a)(iii) CR

The legal option of conversion has its origins in the CTM 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 CTM. The CTM 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.

The latter is forwarded to WIPO as a request for subsequent designation of the Member State(s). 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 6(3), Article 9 quinquies MP
Article 161 CTMR
Rule 84(1)(p), Rule 124 CTMIR

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 shall also enjoy the same priority, if any.

This filing is not governed by the 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.

² In English, ‘conversion’ is used to describe a specific legal provision of the CTM System (Article 112 *et seq.*) while ‘transformation’ is used to describe that in Article 9 quinquies of the Madrid Protocol. 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 112 CTMR.

The EU designation must still be effective when the transformation is requested, that is, it must not have been finally refused by OHIM; 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 27 CTMR

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* of the Protocol (i.e. following a 'central attack' during the five-year dependency period), the holder may file a 'direct' CTM application for the same mark and same goods and services as the cancelled mark.

The application resulting from the transformation will be treated by OHIM 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 shall 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 Community trade mark application. Article 27 CTMR, 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 CTM for the purposes of priority searches, oppositions, etc.

Unlike for priority and seniority claims (Rule 9(8) CTMIR), it is not possible to have a 'split' or 'partial' date, with one date being only for those goods which were contained in the IR and the filing date of the Community trade mark application being the relevant date for the additional goods and services. No such partial transformation effect is foreseen in Article 9 *quinquies* of the Madrid Protocol or Article 161 CTMR.

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

4.3.3 Procedure

The conditions for invoking a transformation right under Article 9 *quinquies* of the Madrid Protocol 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
- that 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 CTM e-filing or CTM application form. The following indications must be given in this section:

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.

OHIM 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, should the transformation be finally refused, the CTMA will be examined as a 'normal' application.

4.3.4 Examination

4.3.4.1 Application for transformation of 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 152(2) CTMR (in other words that has not been finally accepted by OHIM), the CTM resulting from transformation will be treated as a normal CTM application; it will be examined as to classification, formalities and absolute grounds and published for opposition purposes. Nothing in the regulations allows OHIM to omit the examination process.

Nevertheless, since this case presupposes that an IR designating the EU had already existed, OHIM can take advantage of the classification of the list of goods and services of the cancelled IR (as far as it complies with OHIM rules) as well as the Community search reports already issued for that IR (since the date of the ensuing CTM application is the same as the date of the original IR, the search report must by definition come to the same results).

The CTM will be published in Part A of the CTM 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 CTM 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 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 152(2) CTMR, the examination and opposition stage are omitted (Article 37 to 42 CTMR).

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

4.3.5 Transformation and Seniority

If seniority claims have been accepted by OHIM 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 CTM resulting from transformation. This is not explicitly foreseen in Rule 124(2) CTMIR (only priority is mentioned under (d)) but is extended by analogy to seniority in view of the fact that:

- OHIM has already accepted the claims and WIPO has published them,
- where the owner had let the earlier marks lapse in the meanwhile, it would not be able to file new claims before OHIM (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 CTM application resulting from the transformation of the IR designating the EU is subject to the same fees as a 'normal' CTM application, namely the basic fee.

The basic fee for the CTM application must be paid to OHIM within one month of the filing of the CTM requesting transformation in order for the request to comply with Article 27 CTMR and Article 9 *quinquies* (iii) and the transformation to be accepted. For example, if the end of the three-month time limit for transformation is 01/04/2012 and transformation into a CTMA is filed on 30/3/2012, 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, transformation will be refused and the filing date given to the CTMA will be the date of the payment.

4.4 Replacement

Article 157 CTMR Rule 84(2) CTMIR Article 4 bis MP Rule 21 CR
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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 OHIM 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 Agreement nor the Protocol elaborates further on replacement.

4.4.2 Principle and effects

In accordance with Article 4 bis of the Agreement and the Protocol, the holder **may** request OHIM to take note in its Register that **a CTM registration is replaced by a corresponding IR. The holder's rights in the EU should be deemed to start from the date of the earlier CTM registration.** A reference will therefore be introduced in the CTM Register that a direct CTM 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 OHIM 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, OHIM will carry out a formal examination, checking that the marks are identical, that all the goods and services listed in the CTM are listed in the IR designating the EU, that the parties are identical and that the CTM 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.

OHIM considers it sufficient for noting the replacement in the Register if the IR and CTM coexist on the date of the IR. In particular, should the designation of the EU through an IR not yet be finally accepted, OHIM 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, OHIM will note the replacement in the CTM Register and inform WIPO that a CTM has been replaced by an IR as per Rule 21 CR, indicating:

- the number of the IR
- the CTM number
- the CTM application date
- the CTM 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 CTM is maintained normally in the Register as long as the holder renews it. In other words, there is coexistence between the replaced CTM in force and the IR designating the EU.

According to Rule 21(2) of the Common Regulations under the Madrid Agreement and Protocol, 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 OHIM to communicate further changes affecting the replaced CTM.

4.4.4 Fees

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

4.4.5 Publication

Rule 84(2), Rule 85 CTMIR

The replacement is entered in the CTM Register and published in the CTM 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, OHIM will include information on the seniority claims contained in the replaced CTM registration within the content of the notification to be sent to WIPO under Rule 21 CR.

4.4.7 Replacement and transformation

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

4.4.8 Replacement and conversion

The IR and the CTM should coexist on the date of the IR if the replacement is to be effective. Therefore, if the IR that replaces the direct CTM is finally refused by OHIM (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 CTM and its earlier date effects, including priority or seniority if applicable.