

***GUIDELINES FOR EXAMINATION IN THE
EUROPEAN UNION INTELLECTUAL
PROPERTY OFFICE (TRADE MARKS AND
DESIGNS) ON EUROPEAN UNION TRADE
MARKS***

PART E

REGISTER OPERATIONS

SECTION 2

CONVERSION

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1 Introduction

Conversion is the process of turning an EUTMEUTM into one or more national applications. Its main features are laid down in Articles 112 to 114 EUTMEUTMR and Rules 44 to 47 EUTMEUTMIR. If an EUTMEUTM ceases to exist it can, depending on the precise reason for that, be converted into trade marks that are valid in certain Member States. Conversion is particularly useful for overcoming possible problems with the EUTMEUTM's unitary character. For example, if the European Union trade mark faces a registrability problem in only one or certain countries on absolute grounds or due to an opposition based on an earlier right valid in only one country or certain countries, the EUTMEUTM applicant can apply to convert the EUTMEUTM into individual, national trade mark applications in the other countries not affected by these grounds.

The European Union Trade Mark system is based on the principle that the Union and national trade mark systems are complementary. They are notably linked to each other by seniority and conversion procedures. The system is construed in such a way that the earlier filing date of a registered right will always prevail in the territory in which it is valid, irrespective of whether the registered trade mark results from a national filing, an international designation or a EUTMEUTM application (decision of the Grand Board of Appeal, 15/07/2008, R 1313/2006-G, and decision of 22/09/2008, R 0207/2007-2, Restoria, § 34).

Conversion is a two-tier system involving, firstly, the payment of the conversion fee of EUR 200 and the examination of the conversion application before the Office and, secondly, the conversion procedure itself before the national offices. Depending on national law, the converted trade mark will either be registered immediately or enter the national examination, registration and opposition procedure like a normal national trade mark application.

Where the EU is designated in an IR and to the extent that the designation has been withdrawn, refused or has ceased to have effect, a request may also be made for conversion into national trade mark applications in one, more or all of the Member States or through a subsequent designation of the Member States under the Madrid system.

Conversion of IRs designating the EU is not to be confused with 'Transformation', which is a legal feature introduced by the Madrid Protocol (MP) in order to soften the consequences of the five-year dependency period existing under the Madrid Agreement (see Article 6(3) MP). Transformation allows for a centrally attacked mark to be transformed into a direct EUTMEUTM application but it does not allow for the conversion of an EU designation into national filings. For more information on Transformation see the Guidelines, Part M, International Marks.

2 Conversion of EUTMEUTMs and IRs Designating the EU

2.1 Conversion of EUTMEUTMs

Articles 112(1), 113(1), Article 159 EUTMEUTMR
Rule 44(1)(e), (f), Rules 122, 123 EUTMEUTMIR

The applicant of a European Union trade mark (EUTMEUTM) application or proprietor of a registered EUTMEUTM may request the conversion of its EUTMEUTM application or registered EUTM. The request may be into national trade mark applications in one, more or all of the Member States, it being understood that the term 'national applications' or 'national office' includes Benelux trade mark applications or the Benelux Trade Mark Office, as far as Belgium, Luxembourg and The Netherlands are concerned.

Conversion is possible in the following circumstances ('grounds for conversion'):

- where a EUTMEUTM application has been finally refused by the Office (Article 112(1)(a) EUTMEUTMR), in a decision on absolute or relative grounds for refusal during examination or opposition proceedings;
- where a EUTMEUTM application has been withdrawn by the applicant (Article 112(1)(a), Article 44 EUTMEUTMR);
- where a EUTMEUTM application is deemed to be withdrawn, namely when class fees are not paid within the relevant time limit after filing the application (Article 112(1)(a), Article 36(5) EUTMEUTMR);
- where a EUTMEUTM registration ceases to have effect (Article 112(1)(b) EUTMEUTMR), which applies in the following circumstances:
 - where a EUTM registration has been validly surrendered (Article 50 EUTMR);
 - where a EUTM registration has not been renewed (Article 47 EUTMR);
 - where a EUTM registration has been declared invalid by the Office or by a European Union trade mark court (Articles 55 and 100 EUTMR);
 - where the rights of the proprietor of a EUTM registration have been revoked by the Office or by a European Union trade mark court (Article 55 EUTMR) except in the case of revocation due to non-use (Article 112(2) EUTMR).

2.2 Conversion of IRs designating the EU

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

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

IR conversion is possible in the following circumstances ('grounds for conversion') where the designation of the EU in an IR ceases to have effect, which applies in the following circumstances:

- where the effects of an IR designating the EU have been invalidated by the Office or a EUTM court (Article 158 EUTMR, Rule 117 EUTMIR);
- where a renunciation of the designation of the EU has been recorded in the International Register (Rule 25(1), Rule 27 CR¹);
- where a cancellation of the IR has been recorded in the International Register (Rule 25(1), Rule 27 CR): in such cases opting-back conversion is not possible; only national conversion is available where the Office is informed by WIPO that the IR has not been renewed, provided that the grace period for the renewal is over (Rule 31(4)(a) or (b) CR).
- where an IR designating the EU has been definitively refused by the Office (Rules 113(2)(b), (c), 115(5)(b), (c) EUTMIR).

Conversion may be requested for all or for some of the goods or services to which the act or decision mentioned above relates.

Where the abovementioned decision or act relates only to some of the goods and services for which the application was filed or registered, conversion may be requested only for those specific goods or services, or a part of those goods or services.

3 Valid EUTM Application as a Condition for Conversion

Article 112(1) EUTMR

Where conversion is requested on the basis of a EUTM application, conversion is possible only if there is a valid EUTM application (See the Guidelines, Part B, Examination, Section 2, Formalities).

4 Grounds Precluding Conversion

Article 112(2) and Article 159 EUTMR Rules 45 and 123 EUTMIR

Conversion will not take place in the following two cases: first, when a registered EUTM or IR designating the EU is revoked on grounds of non-use (see paragraph 4.1 below) and, second, where the particular ground for which the EUTM application or registered EUTM or IR designating the EU ceasing its effects would preclude registration of the same trade mark in the Member State concerned (see paragraph 4.2 below). Therefore, a request for conversion of a rejected EUTM application will not be

¹ Common Regulations under the Madrid Agreement concerning the IR of Marks and the Protocol relating to that Agreement.

admissible in respect of the Member State to which the grounds of refusal, invalidity or revocation apply.

Even if the ground for conversion is the withdrawal of an application, if such a withdrawal takes place after a decision has been rendered refusing the mark on the basis of a ground that would preclude registration in the Member State concerned, such a request for conversion will be refused if no appeal has been filed.

Even if the ground for conversion is the surrender of a registration, if such a surrender takes place after a decision revoking a EUTM or IR on grounds of non-use, or refusing the mark on the basis of a ground that would preclude registration in the Member State concerned has been rendered, such a request for conversion will be refused if no appeal has been filed (see paragraph 4.3 below).

4.1 Revocation on the grounds of non-use

Article 112(2)(a) EUTMR

The first reason for precluding conversion is when the rights of the EUTM proprietor or IR holder have been revoked on the grounds of non-use.

Conversion will not take place where the rights of the proprietor of the European Union trade mark, or the holder of the IR, have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the European Union trade mark has been put to use that would be considered genuine under the laws of that Member State.

No subsequent allegations by the conversion applicant regarding the substance of the case will be allowed. For instance, if the EUTM was revoked for non-use, the conversion applicant cannot plead before the Office that it is able to prove use in a particular Member State.

4.2 Ground for refusal limited to a Member State or extended to the entire EU

Article 112(2)(b) EUTMR
Rule 45(4) EUTMIR

The second reason for precluding conversion is related to a ground for refusal, for revocation (other than for non-use) or for a declaration of invalidity. It applies when the decision of the Office or of a European Union trade mark court expressly states that the ground for refusal, for revocation or for invalidity applies in respect of a particular Member State, and precludes conversion for that Member State (decision of 05/03/2009, R 1619/2008-2, orange colour mark, § 23-24).

Examples

- Where an absolute ground for refusal exists only for one language, conversion will not take place in respect of Member States where that language is an official language. For example, if an absolute ground for refusal was raised in relation to

the English-speaking public, conversion would not take place in respect of the United Kingdom, Ireland and Malta (see Rule 54(4) EUTMIR).

- Where an absolute ground for refusal exists only for one Member State, which may be the case because the trade mark is descriptive or deceptive only in a particular Member State and not in other Member States (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal), conversion will not take place in respect of that Member State, whereas conversion may be requested for all Member States in which the ground for refusal has not been expressly found to exist.
- Where a EUTM application or IR designating the EU has been refused in an opposition based on an earlier national trade mark in a given Member State, conversion will not take place in respect of that Member State. When the opposition is based on a number of earlier rights from different Member States but the final decision rejects the EUTM application or the IR designating the EU on the basis of only one of those earlier rights, conversion may be requested for the remaining Member States. For example, if in an opposition based on a UK, an Italian and a French national right, the opposition is successful insofar as it is based on the UK national right, and there is no analysis of the remaining earlier rights, conversion will not take place for the United Kingdom, but may take place for Italy and France (and all remaining Member States) (judgments of 16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268, and 11/05/2006, T-194/05, Teletch International, EU:T:2006:124).
- According to Rule 45(4) EUTMIR, applicable by analogy to IRs designating the EU in accordance with Rule 123(2) EUTMIR, where a EUTM application has been refused or a EUTM registration has been invalidated on relative grounds based on an earlier EUTM, or, in the cases of invalidation, another European Union industrial property right, this has the effect of excluding conversion for the entire Union, even if likelihood of confusion exists only in part of it

4.3 Withdrawal/surrender after a decision has been rendered

Where, in any of the above cases, the applicant withdraws the EUTMA or the owner surrenders the EUTM, or the holder renounces the designation of the EU before the decision becomes final (i.e. during the appeal period) and subsequently requests conversion of the mark into national trade marks in some or all of the Member States for which a ground for refusal, for revocation or invalidity applies, such a request for conversion will be refused for those Member States.

If the applicant/owner/holder files an appeal and subsequently withdraws the refused application/surrenders the invalidated/revoked EUTM/designation and then requests a conversion, the withdrawal/surrender will be forwarded to the competent Board and may be put on hold pending the outcome of the appeal proceedings (judgment of 24/03/2011, C 552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 43, decisions of 22/10/2010, R 0463/2009-4, MAGENTA, § 25-27 and 07/08/2013, R 2264/2012-2, SHAKEY'S). Only once the withdrawal/surrender is processed will the conversion be forwarded as admissible to all the Member States applied for or refused, depending on the outcome of the case. (See also the Guidelines, Part D, Cancellation and Part E, Register Operations, Section 1, Changes in a Registration).

4.4 Competence to decide on grounds precluding conversion

Article 113(1) and (3) EUTMR

The Office will decide whether the request for conversion fulfils the conditions set out in the Regulations in conjunction with any final decisions (their operative part and reasons) that gave rise to the conversion.

If one of the grounds precluding conversion exists, the Office will refuse to forward the conversion request to the respective national office (or, in the case of an opting-back conversion, will refuse to forward the conversion to WIPO as a subsequent designation for the Member States for which conversion is so precluded). This decision will be subject to appeal.

5 Formal Requirements for the Request of Conversion

5.1 Time limit

A general time limit of three months for requesting conversion applies. The start of the time limit depends on the ground for conversion.

The time limit may not be extended.

Furthermore, continuation of proceedings cannot be requested for this time limit, according to Article 82(2) EUTMR. However, *restitutio in integrum* is, in principle, possible.

5.1.1 Start of time limit where the Office issues a notification

Article 112(4) EUTMR

Where a EUTM application is deemed to be withdrawn, a request for conversion may be filed within three months from the date of the corresponding confirmation from the Office.

The notification will be contained in the communication on the loss of rights.

5.1.2 Start of time limit in other cases

Article 112(5) and (6) EUTMR

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

- where the EUTM application is withdrawn, on the day the withdrawal is received by the Office;

- where the EUTM is surrendered, on the day on which the surrender is entered in the EUTM Register (which is the day on which it becomes effective pursuant to Article 50(2) EUTMR);
- where protection of the IR has been limited or renounced with effect for the EU, on the day as of which it has been recorded by WIPO pursuant to Rule 27(1)(b) CR;
- where the EUTM registration was not renewed, on the day following the last day of the period within which a request for renewal may be submitted pursuant to Article 47(3) EUTMR, i.e. six months after the last day of the month in which protection has expired;
- where the IR was not renewed with effect for the EU, on the day following the last day on which renewal may still be effected before WIPO pursuant to Article 7(4) MP;
- where the EUTM application or IR designating the EU is refused, on the day on which the decision becomes final;
- where the EUTM or IR designating the EU is declared invalid or revoked, on the day on which the decision of the Office or the judgment of the EUTM court becomes final.

A decision of the Office becomes final:

- where no appeal is lodged, at the end of the two-month time limit for appeal pursuant to Article 60 EUTMR;
- following a decision of the Boards of Appeal at the end of the time limit for appeal to the General Court, or, where applicable, with the final decision of the Court of Justice.

A decision of a EUTM court becomes final:

- where no appeal is lodged, at the end of the time limit for appeal under national law;
- otherwise, with the final decision of the EUTM court of final (second or third) instance.

For example, if a EUTM is rejected by a decision of the Office on absolute grounds for refusal that is notified on 11/11/2011, the decision becomes final on 11/01/2012. The three-month period for requesting conversion ends on 11/04/2012.

5.2 Request for conversion

Article 113(1) EUTMR Rule 83(2) EUTMIR

The request for conversion will be filed at the Office. The 'Application for Conversion' form can be found on the Office's website. The use of this form is recommended.

The 'Application for Conversion of an IR designating the EC' form can be found on the Office's website. This form may also be used in the event of opting back. WIPO's MM16 form may also be used; however, the Office will send the conversion data to WIPO in electronic format and not the form itself.

Using the forms made available by the Office enables the latter to extract the relevant information concerning the converted EUTM and the data concerning the applicant and representative from its database and to submit them, together with the Conversion Form, to the designated offices.

Rule 44(1) and (2) EUTMIR

Applicants or their representatives may use forms of a similar structure to those made available by the Office provided that the following basic information is submitted:

- the name and address of the applicant for conversion, i.e. the applicant/proprietor of the EUTM application or registration or the holder of the IR;
- the representative's name, if any;
- the filing number of the EUTM application or the registration number of the EUTM or the IR;
- the filing date of the EUTM application or registration or, for an IR designating the EU, the date of the IR or the subsequent designation;
- particulars of any priority or seniority claim;
- the indication of the Member State or the Member States for which conversion is requested; for an IR it must also be indicated whether conversion is requested into a national application for that Member State or into a designation of the Member State under the Madrid Agreement or Protocol. As far as Belgium, the Netherlands and Luxembourg are concerned, conversion may be requested only for these three countries together, and not independently; the conversion form made available by the Office only allows for Belgium, the Netherlands and Luxembourg to be designated together; where the applicant nevertheless indicates only one of these three countries, the Office will take that as a request for conversion for Belgium, the Netherlands and Luxembourg and forward the request to the Benelux Trade Mark Office;
- the indication of the ground on which conversion is requested:
 - where conversion is requested following the withdrawal of the application, the date of withdrawal must be indicated;
 - where conversion is requested following failure to renew the registration, the date on which protection expired must be indicated;
 - where conversion is requested following the surrender of a EUTM, the date on which it was entered in the Register must be indicated;

- where conversion is requested following a partial surrender, the goods/services for which the EUTM no longer has protection and the date on which the partial surrender was entered in the Register must be indicated;
- where conversion is requested following a limitation, the goods/services for which the EUTM application no longer has protection and the date of limitation must be indicated;
- where conversion is requested because the mark ceases to have effect as a result of a decision of a European Union trade mark court, the date on which that decision became final must be indicated, and a copy of that decision, which may be in the language in which the decision was given, must be supplied;
- where conversion is requested because an IR designating the EU has been finally refused by the Office, the date of the decision must be indicated;
- where conversion is requested because the effects of an IR designating the EU have been invalidated by the Office or by a EUTM Court, the date of the decision of the Office or the date on which the judgment of the EUTM Court became final must be indicated together with a copy of the judgment attached;
- where conversion is requested because the designation of the EU has been renounced or cancelled before WIPO, the date on which it has been recorded by WIPO must be indicated;
- where conversion is requested because the IR designating the EU has not been renewed, and provided that the grace period for the renewal is over, the date of expiry of protection must be indicated.

The request for conversion may contain:

- an indication that it relates only to a part of the goods and services for which the application was filed or registered, in which case the goods and services for which conversion is requested must be indicated;
- an indication that conversion is requested for different goods and services with respect to different Member States, in which case the respective goods and services must be indicated for each Member State.

The request for conversion may also contain an appointment of a representative before a designated national office, by ticking the relevant boxes in the Annex to the Conversion Form. This indication is voluntary and not of relevance for the conversion procedure before the Office but will be useful for the national offices once they receive the conversion request, so that they can immediately communicate with a representative who is authorised to practise before that national office (see paragraph 6 below).

5.3 Language

Rule 95(a), Rule 126 EUTMIR

Where the request for conversion is made in respect of a EUTM application, it must be filed in the language in which the EUTM application was filed or in the second language indicated therein.

Where the request for conversion is made in respect of an IR designating the EU before the point in time when a statement of grant of protection was issued pursuant to Rule 116 EUTMIR, the request must be filed in the language in which the international application was filed with WIPO or in the second language indicated therein.

Rule 95(b), Rule 126 EUTMIR

Where the request is made in respect of a EUTM registration, it may be filed in any of the five languages of the Office.

Where the request for conversion is made in respect of an IR designating the EU after a statement of grant of protection has been issued, the request may be filed in any of the five languages of the Office, except in the case of an 'opting-back' conversion, when the request must be filed in English, French or Spanish.

However, when the request for conversion is filed by using the form provided by the Office pursuant to Rule 83 EUTMIR, the form may be used in any of the official languages of the Union, provided that the form is completed in one of the languages of the Office as far as textual elements are concerned. This concerns, in particular, the list of goods and services in the event of a request for partial conversion.

5.4 Fee

Article 113(1) EUTMR
Rule 45(2) EUTMIR
Article 144b(3) and Annex I A (23) EUTMR

The request for conversion is subject to payment of a fee of EUR 200, including for conversion of an IR designating the EU. The request will not be deemed to be filed until the conversion fee has been paid. This means that the conversion fee has to be paid within the abovementioned time limit of three months. A payment made after the expiry of the period will be considered to have been made in due time if the person concerned submits evidence that, in a Member State and within the period of three months, the payment had been made to a bank or a transfer order placed, and if at the same time of payment a surcharge of ten per cent of the total amount due was paid (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).

6 Examination by the Office

6.1 Stages of the procedure, competence

The Office will deal with requests for conversion by:

Article 113(2) and (3) EUTMR
Rules 45-47 EUTMIR

- examining them;
- publishing them; and
- submitting them to the designated offices.

6.2 Examination

The examination of the request for conversion by the Office relates to the following points:

- fees;
- time limit;
- language;
- formalities;
- grounds;
- representation;
- partial conversion.

6.2.1 Fees

Rules 45(2) and 122(3) EUTMIR

The Office will examine whether the conversion fee has been paid within the applicable time limit.

Where the conversion fee has not been paid within the applicable time limit, the Office will inform the applicant that the application for conversion will be deemed not to have been filed. Any fees paid late will be reimbursed.

6.2.2 Time limit

Rules 45(1) and 122(3) EUTMIR

The Office will examine whether the request has been filed within the time limit of three months.

The Office will reject the request for conversion where the request was not filed within the relevant time limit of three months. Any fees paid late will not be reimbursed.

6.2.3 Language

Rule 95(a), Rule 126 EUTMIR

The Office will examine whether the request has been filed in the correct language.

When the request is filed in a language which is not one of the acceptable languages for the conversion procedure (see paragraph 5.3 above), the Office will send a deficiency letter to the applicant and specify a period within which it may amend the application for conversion. If the applicant fails to respond, the request will not be dealt with and will be considered not to have been filed. Any fees paid will not be reimbursed.

6.2.4 Formalities

Rule 44(1)(b), (d) and (e) EUTMIR

The Office will examine whether the request complies with the formal requirements of the Implementing Regulation (see paragraph 5 above).

Where the conversion applicant has not used the Conversion Form made available by the Office and where the deficiency lies in not having indicated the elements referred to in Rule 44(1)(b), (d) or (e) EUTMIR, the conversion applicant will be invited to either submit the missing indications or, where such indications may be readily ascertained from data available to the Office, will be considered as having authorised the Office to make available to the designated offices the relevant extracts from its database.

6.2.5 Grounds

The Office will examine:

- whether one of the grounds for conversion mentioned in paragraph 2 above exists;
- whether one of the grounds precluding conversion referred to in paragraph 4 above exists;

Rule 123(2) EUTMIR

- for an opting-back conversion, whether it would have been possible at the date of the IR to designate the Member State concerned in an international application;
- for partial conversion, whether the goods and services to be converted were in fact contained in, and do not go beyond, the goods and services of the EUTM or IR designating the EU at the point in time when it lapsed or ceased to have effect (see paragraph 6.3 below);

- for partial conversion in the sense that part of the EUTM or IR designating the EU remains alive, whether the goods and services to be converted overlap with the goods and services for which the mark remains alive (see paragraph 6.3 below).

The aim of these last two examination steps is to avoid conversion for more or broader goods and services than have been refused or cancelled.

When the request for conversion does not comply with any of the other mandatory elements and indications referred to in paragraphs 4 and 5.2 above, the Office will send a deficiency letter to the applicant and specify a period within which it may amend the application for conversion. If the applicant fails to respond, the request will not be dealt with and will be considered not to have been filed. Any fees paid will not be reimbursed.

6.2.6 Representation

Rule 76(1)-(4) EUTMIR

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Professional Representation). The person requesting conversion may appoint a new or an additional representative (legal practitioner or Office professional representative) for the conversion procedure.

Any authorisation to act on behalf of the applicant or proprietor extends only to acts before the Office. Whether a representative appointed for proceedings before the Office may act before the national office in respect of the resulting national application and, if so, whether they need to present an additional authorisation, is determined by the national law concerned. In the event of an opting-back conversion, the name of the representative appointed before the Office will be submitted to WIPO.

6.2.7 Partial conversion

Article 112(1) EUTMR Rule 44(1)(e) EUTMIR
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Where conversion is requested only for some of the goods and services, or for different goods and services for different Member States ('partial conversion'), the Office will examine whether the goods and services for which conversion is requested are contained within the goods and services for which the ground of conversion applies. For this assessment the same criteria apply as in similar procedural situations, such as restriction of an application or partial refusal in an opposition proceeding.

Where an application is refused in part or a registration is invalidated or revoked in part, conversion may be requested only for the goods or services for which the application was refused or the registration was invalidated or revoked, and not for the goods or services for which the application or registration remains valid.

Where an application is limited, or a registration is partially surrendered, conversion may be requested only for the limited/partially surrendered goods or services, and not

for the goods or services for which the application or registration remains valid. However, please refer to paragraph 4.3 above when such a limitation/partial surrender takes place following a decision.

The applicant must indicate in the abovementioned cases the goods and services for which conversion is requested. Expressing the limitation in a negative way, such as by using expressions of the type ‘beverages with the exception of ...’, is admissible in the same way that such an expression is admissible when filing or restricting a EUTM application or partially surrendering a EUTM registration (see the Guidelines, Part B, Examination, Section 3, Classification).

6.3 Publication of the request and entry in the Register

Article 113(2) EUTMR
Rule 84(3)(p) EUTMIR

Upon acceptance of a request for conversion that is deemed to have been filed because the required fee has been paid, the Office will make an entry in the Register of European Union Trade Marks recording the receipt of the request for conversion, provided that the request for conversion is of a published EUTMA or a registered EUTM.

Article 113(2) EUTMR
Rule 46(1) EUTMIR

After having examined the request for conversion and having found it in order, the Office will register and publish the request for conversion in the European Union Trade Marks Bulletin in Part E.1. for EUTMs and Part E.3. for IRs designating the EC. However, no such publication will be made when the request for conversion is submitted at a time when the EUTM application has not already been published in accordance with Article 39 EUTMR.

Rule 46 EUTMIR

The request for conversion is published only after the Office has completed examination of it and found it to be in order. The request is not in order if there is no payment.

Rule 46(2) EUTMIR

The publication of the application for conversion must contain the indications referred to in Rule 46(2) EUTMIR and, unless it concerns an IR designating the EC, include a reference to the previous publication in the European Union Trade Marks Bulletin and the date of the application for conversion.

Rule 46(2), Rules 122 and 123 EUTMIR

Lists of goods and services for which conversion is requested will not be published if the conversion is for an IR designating the EC.

6.4 Submission to designated offices

Articles 113(3) and 114(1) EUTMR
Rule 47 EUTMIR

Once the Office has completed examination of the request for conversion and has found it to be in order, it will submit the request without delay to the designated offices. The submission will be made irrespective of whether any required publication has already taken place.

The Office will send a copy of the request for conversion and make available an extract of its database containing the data referred to in Rule 84(2) EUTMIR of the converted EUTM or IR. Any central industrial property office to which the request for conversion is submitted may obtain from the Office any additional information concerning the request, enabling that office to make a decision regarding the national trade mark resulting from the conversion.

Rule 47 EUTMIR

At the same time, the Office will inform the conversion applicant of the date of submission to national offices.

In the case of an opting-back conversion, WIPO will deal with the request as a subsequent designation in accordance with Rule 24(6), (7) CR.

If a national office is the designated office, conversion will result in a national application or registration.

Article 114(3) EUTMR

The national law in force for the Member States concerned may provide that the request for conversion be subject to one, or all, of the following requirements:

- payment of a national application fee;
- filing of a translation in one of the official languages of the Member State in respect of the request and its accompanying documents; in particular, for applications for conversion prior to publication of the EUTM, the national office will usually require a translation of the list of goods and services;
- indication of an address for service in the Member State in question;
- submission of a representation of the mark in a number of copies specified by that Member State.

National rules on the appointment of a domestic representative remain applicable. Where use is made of the option to indicate, in the Conversion Form, a representative for the purposes of the procedure before a given national office, that national office will be in a position to communicate directly with that representative so that no separate communication to appoint a domestic representative will be necessary.

Article 114(2) EUTMR

National law may not subject the request for conversion to any formal requirements different from or additional to the requirements provided for in the EUTMR and EUTMIR.

7 Effects of Conversion

Article 112(3) EUTMR

In each Member State concerned, the national trade mark application resulting from the conversion will enjoy the filing date or, if any, the priority date of the EUTM application, as well as the seniority of an earlier trade mark with effect for that State validly claimed for the EUTM application or registration under Article 34 or 35 EUTMR. For information on conversion of a EUTM into national trade mark applications for new Member States see the Guidelines, Part A, General Rules, Section 9, Enlargement.

In the event of an opting-back conversion, the international application resulting from the subsequent designation of the Member State under Rule 24(6)(e), (7) CR will enjoy the original date of the IR designating the EC, that is, either the actual date of the IR (including, if appropriate, its priority date) or the date of the subsequent designation of the EC.

However, there is no harmonised procedure for how national offices will proceed with the examination of the converted EUTM. As mentioned in the introduction, the conversion procedure is a two-tier system, where the second tier, the conversion procedure itself, is dealt with by the national trade mark and patent offices. Depending on national law, the converted trade mark will either be registered immediately or will enter the national examination, registration and opposition procedure like any other national trade mark application.

National applications deriving from the conversion of an earlier EUTM(A) are considered to come into existence as soon as a valid conversion request is filed. Therefore, in opposition proceedings, such rights will be considered properly identified for admissibility purposes under Rule 18(1) EUTMIR if the opponent indicates the number of the EUTM(A) under conversion and the countries for which it has requested conversion.

When, during opposition or invalidity proceedings on relative grounds, the EUTM application (or EUTM) on which the opposition is based ceases to exist (or the list of goods and services is restricted), but at the same time a request for conversion is filed, the opposition or invalidity proceedings can continue. This is because national trade mark registrations resulting from a conversion of a EUTM application (or EUTM) can constitute the basis of the opposition or invalidity procedure originally made on the basis of that EUTM application or registration (see decision of the Grand Board of Appeal in R 1313/2006-G) (see also the Guidelines, Part C, Opposition, Section 1, Procedural Matters).