

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

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

**Part E**

**Register operations**

**Section 2**

**Conversion**

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## 1 Introduction

Conversion is the process of turning a European Union trade mark (EUTM) application or registration into one or more national applications. Its main features are laid down in Articles 139 to 141 EUTMR and Articles 22 and 23 EUTMIR. If an EUTM ceases to exist it can, depending on the specific reason for this, be converted into trade marks that are valid in certain Member States. Conversion is particularly useful for overcoming possible problems with the EUTM's unitary character. For example, if the EUTM faces a registrability problem in only one or several countries on absolute grounds or due to an opposition based on an earlier right valid in only one country or several countries, the EUTM applicant can apply to convert the EUTM into individual, national trade mark applications in the countries not affected by these grounds.

The EUTM system is based on the principle that the European Union and national trade mark systems are complementary. They are notably linked to each other by the 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 an EUTM application (15/07/2008, R 1313/2006-G, CARDIVA (fig.) / CARDIMA (fig.); 22/09/2008, R 207/2007-2, RESTORIA / RESTORIA, § 34).

Conversion is a two-tier system involving, firstly, the payment of the conversion fee and the examination of the request for conversion 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 procedures in the same way as a normal national trade mark application.

Where the EU is designated in an international registration (IR) and to the extent that the designation has been withdrawn, refused or has ceased to have effect, a request may also be made for conversion into national trade mark applications in one, several or all of the Member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 and central attack (ceasing of effect of the basic mark) existing under the Madrid Agreement (see Article 6(3) MP). Transformation allows for a centrally attacked international mark to be transformed into a direct EUTM application, but 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 EUTMs and IRs Designating the EU

### 2.1 Conversion of EUTMs

Articles 139(1) and 140(1) and Article 159 EUTMR

Article 22(e), (f) and Article 35(1) EUTMIR

The applicant for an EUTM or proprietor of a registered EUTM may request the conversion of its EUTM application or registered EUTM. The request may be for conversion into national trade mark applications in one, several or all of the Member States. With regard to Belgium, Luxembourg and the Netherlands, the term 'national trade mark applications' includes Benelux trade mark applications, and 'national office', the Benelux Office for Intellectual Property (BOIP).

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

- where an EUTM application has been finally refused by the Office (Article 139(1)(a) EUTMR) in a decision on absolute or relative grounds for refusal during examination or opposition proceedings;
- where an EUTM application has been withdrawn by the applicant (Article 49, Article 139(1)(a) EUTMR);
- where an EUTM application is considered to be withdrawn, namely when class fees have not been paid within the relevant time limit after filing the application (Article 41(5), Article 139(1)(a) EUTMR);
- where an EUTM registration ceases to have effect (Article 139(1)(b) EUTMR), that is, in the following circumstances:
  - where an EUTM registration has been validly surrendered (Article 57 EUTMR);
  - where an EUTM registration has not been renewed (Article 53 EUTMR);
  - where an EUTM registration has been declared invalid by the Office or by a European Union trade mark court (Articles 62 and 128 EUTMR);
  - where the rights of the proprietor of an EUTM registration have been revoked by the Office or by an EUTM court (Article 62 EUTMR) — except in the case of revocation for non-use, unless the mark was genuinely used under the laws of the Member State for which conversion has been requested (Article 139(2) EUTMR) (see paragraph 4.1 below).

### 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, several or all of the Member States;

- into subsequent designations of one or more Member States under the Madrid Agreement or Protocol ('opting back'), provided that the Member State was a party to either Treaty, not only at the time of the request for conversion, but also on the date of the designation of the EU;
- into national trade mark applications for some Member States and subsequent designations for other Member States. The same Member State may only be selected 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:

- where the effects of an IR designating the EU have been invalidated by the Office or an EUTM court (Article 198 EUTMR, Article 34 EUTMIR);
- where a limitation of the list of goods and services for the EU has been recorded in the International Register (Rule 25(1)(a)(ii), Rule 27(1) Regulations under the Protocol) (see paragraph 6.2.7 below and also Guidelines, Part M, International Marks, Section 3, The EUIPO as Designated Office, paragraph 3.8, Limitations of the list of goods and services);<sup>(75)</sup>
- where a renunciation of the designation of the EU has been recorded in the International Register (Rule 25(1)(a)(iii), Rule 27(1) Regulations under the Protocol);
- where the Office is informed by WIPO that the IR has not been renewed for the EU, provided that the grace period for renewal is over (Rule 31(4)(b) Regulations under the Protocol);
- where an IR designating the EU has been finally refused by the Office (Article 78(5) (b) and (c) EUTMDR, Article 33(2)(b) and (c) EUTMIR);
- where the partial or total cancellation of the IR has been recorded in the International Register (Rule 25(1)(a)(v), Rule 27(1) Regulations under the Protocol);

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

Where the abovementioned act or decision 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 for a part of those goods or services.

'Opting back' may not be requested:

- where the cancellation of the IR has been recorded in the International Register, either totally or partially (Rule 25(1)(a)(v), Rule 27 Regulations under the Protocol); in this case, only national conversion is available for the goods and services affected by the cancellation;
- Where the IR has not been renewed for all the Contracting Parties designated, and the grace period for the renewal is over (Rule 31(4)(a) Regulations under the Protocol);
- where the IR has been cancelled because the basic application, the ensuing registration or the basic registration has ceased to have effect (Rule 22 Regulations

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<sup>75</sup> Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as in force on February 1, 2020)

under the Protocol); only transformation is available in such cases for the goods and services affected by the cancellation (Article 9<sup>quinquies</sup> MP).

### **3 Valid EUTM Application as a Condition for Conversion**

Article 139(1) EUTMR

Where conversion is requested on the basis of an 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 93, Articles 139(2), 140(1), (3) and (4), and 202(6), (7) and (9) EUTMR

Conversion will not take place in the following circumstances:

- in principle, where a registered EUTM or IR designating the EU has been revoked on the grounds of non-use (see paragraph 4.1 below); or
- where the particular ground for which the EUTM application or registered EUTM or IR designating the EU has ceased to have effect 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 will not be admissible in respect of the Member State to which the grounds for refusal, invalidity or revocation apply; or
- without prejudice to Article 139(2) EUTMR, where conversion relates to an application for an EU certification mark or to a registered EU certification mark, and the national law of the Member State concerned does not provide for the registration of guarantee or certification marks pursuant to Article 28 of Directive (EU) 2015/2436 approximating the laws of the Member States relating to trade marks.

Even when the ground for conversion is the withdrawal of an application, if such a withdrawal takes place during the appeal period after a decision to refuse the mark on the basis of a ground that would preclude registration in the Member State concerned and if no appeal has been filed, the request for conversion will be rejected.

Even when the ground for conversion is the surrender of a registration, if such a surrender takes place during the appeal period after a decision to revoke an EUTM or IR on the grounds of non-use, or to refuse the mark on the basis of a ground that would preclude registration in the Member State concerned, and if no appeal has been filed, the request for conversion will be rejected (see paragraph 4.3 below).

## 4.1 Revocation on the grounds of non-use

### Article 139(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 EUTM proprietor or of the IR holder have been revoked on the grounds of non-use, unless the EUTM or IR has been put to use that would be considered genuine use under the laws of the Member State for which conversion is requested.

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

This is because the Office is not in a position to assess use of an EUTM based on the laws of the individual EU Member States.

However, Article 139(2)(a) EUTMR may apply when the owner of the revoked EUTM submits, together with a request for conversion, evidence from an official source, such as a national judgment, establishing genuine use of the mark pursuant to the laws of the Member State for which conversion is requested. However, conversion is allowed only if the following requirements are met:

- the representation of the trade mark in the evidence (e.g. national judgment) and the registered EUTM must be identical;
- the goods and services for which use was found at national level must be covered by the revoked EUTM (see also paragraph 6.2.7 below);
- the relevant period of use in the revocation proceedings before the Office and the period for which use was established in the evidence (e.g. national judgment) must coincide or at least overlap to a certain extent.

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

### Article 139(2)(b) and Article 140(4) EUTMR

The second reason for precluding conversion is related to grounds for refusal, for revocation (other than 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 (05/03/2009, R 1619/2008-2, ORANGE (col.), § 23-24).

#### Examples

- Where an absolute ground for refusal exists only for one language, conversion will not take place in respect of the 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 Article 140(4) EUTMR).
- Where an absolute ground for refusal exists only for one Member State, which may be 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, but may be requested for all the Member States in which the ground for refusal has not been found to exist.
- Where an EUTM application or IR designating the EU has been refused in an opposition based on an earlier national trade mark in a specific 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 an opposition based on a French, an Italian, and a United Kingdom national right is successful with regard to the United Kingdom national right, and if there is no analysis of the other earlier rights, conversion will not take place for the United Kingdom, but may take place for Italy and France (and all other Member States) (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, T-194/05, Teletch International, EU:T:2006:124).
- According to Article 140(4) EUTMR, applicable by analogy to IRs designating the EU in accordance with Article 202(8) EUTMR, where an EUTM application has been refused or an EUTM registration has been declared invalid on relative grounds based on an earlier EUTM or another European Union industrial property right, this has the effect of excluding conversion for the entire European Union, even if likelihood of confusion exists only in part of it.

Where an EUTM or IR designating the EU has been declared invalid in invalidity proceedings on the grounds of Article 59(1)(b) EUTMR ('bad faith'), this has the effect of excluding conversion for the entire European Union.

### **4.3 Withdrawal/surrender after a decision has been rendered**

Where the applicant withdraws the EUTM application or the owner surrenders the EUTM, or where 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, the request for conversion will be rejected for those Member States.

If the applicant or owner or holder files an appeal and subsequently withdraws or limits the refused application or surrenders, partially or totally, the invalidated or revoked EUTM or designation and then requests a conversion, the withdrawal, limitation or

surrender will be forwarded to the competent Board and may be put on hold pending the outcome of the appeal proceedings (24/03/2011, C-552/09 P, TIMIKinderjoghurt, EU:C:2011:177, § 43; 22/10/2010, R 463/2009-4, MAGENTA (col.), § 25-27; 07/08/2013, R 2264/2012-2, SHAKEY'S). Only once the withdrawal, limitation or surrender has been processed will the conversion be forwarded as admissible to all the Member States in respect of which conversion is requested, or refused, depending on the outcome of the case (see also the Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings and Part E, Register Operations, Section 1, Changes in a Registration).

For information on the suspension of the registration of surrenders during cancellation proceedings, see the Guidelines, Part D, Cancellation, Section 1, Cancellation Proceedings, paragraph 4.3.

#### **4.4 Competence to decide on grounds precluding conversion**

Article 140(1) and (3) EUTMR
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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 request for conversion 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 precluded. This decision may be appealed.

### **5 Formal Requirements for the Request for Conversion**

#### **5.1 Time limit**

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

The time limit may not be extended.

Furthermore, the continuation of proceedings cannot be requested for this time limit (Article 105(2) EUTMR). However, *restitutio in integrum* is, in principle, possible.

### 5.1.1 Start of time limit where the Office issues a notification

Article 139(4) EUTMR
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Where an EUTM application is considered to be withdrawn, a request for conversion may be filed within three months from the date of the corresponding notification 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 139(5) and (6) EUTMR
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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, that is, the day on which it becomes effective pursuant to Article 57(2) EUTMR;
- where protection of the IR has been limited or renounced with effect for the EU, on the day on which it is 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 have been submitted pursuant to Article 53(3) EUTMR, that is, six months after the expiry of the registration;
- where the IR was not renewed with effect for the EU, on the day following the last day on which renewal was still possible before WIPO, pursuant to Article 7(4) MP;
- where the EUTM application or IR designating the EU is rejected, 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:

- when no appeal has been lodged, at the end of the two-month time limit for appeal pursuant to Article 68 EUTMR;
- following a decision of the Boards of Appeal, at the end of the time limit for an appeal to the General Court, or, where applicable, with the final decision of the Court of Justice.

A decision of an EUTM court becomes final:

- when no appeal has been lodged, at the end of the time limit for appeal under national law;

- in all other cases, with the final decision of the EUTM court of final (second or third) instance.

For example, if an 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 140(1) EUTMR

Article 65(2)(a), (b) EUTMDR

The request for conversion must be filed at the Office. The online form can be found on the Office's website at: <https://euipo.europa.eu/ohimportal/en/forms-and-filings>.

The 'Application for Conversion of an IR designating the EU' form can be found on the Office's website at: <https://euipo.europa.eu/ohimportal/en/international-application-forms>. This form may also be used for opting back. The Office will send the conversion data to WIPO in electronic format.

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

Article 140(1) EUTMR

Article 22 EUTMIR

Applicants or their representatives must provide the following information (Article 22 EUTMIR).

- The name and address of the applicant for conversion, that is, the applicant or proprietor of the EUTM application or registration, or the holder of the IR;
- The filing number of the EUTM application or the registration number of the EUTM or of the IR;
- 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 an EUTM, the date on which it was entered in the Register must be indicated;
  - where conversion is requested following a partial surrender, the goods or 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 or 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 submitted;
  - 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 declared invalid by the Office or by an 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, 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 was 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 renewal is over, the date on which the protection expired must be indicated.
- 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. With regard to Belgium, the Netherlands and Luxembourg, conversion may be requested only for these three countries together, not separately. The conversion form made available by the Office only allows for Belgium, the Netherlands and Luxembourg to be designated together. If the applicant indicates only one of these three countries, the Office will consider it to be a request for conversion for Belgium, the Netherlands and Luxembourg and will forward the request to the Benelux Office for Intellectual Property (BOIP);
  - Where the request does not relate to all of the goods or services for which the application has been filed or for which the EUTM has been registered, an indication that it relates only to a part of the goods and services for which the application was filed or registered together with an indication of the goods and services for which conversion is requested;
  - An indication that conversion is requested for different goods and services with respect to different Member States, together with an indication of the respective goods and services for each Member State.

The request for conversion may also contain the appointment of a representative before a designated national office, if the relevant boxes in the Annex to the Conversion Form are ticked. This indication is voluntary and is not relevant for the conversion procedure before the Office. However, it will be useful for the national offices when they receive the request for conversion, as they will be able to communicate immediately with a representative who is authorised to practise before them (see paragraph 6 below).

### 5.3 Language

Article 146(6) and Article 206 EUTMR

Where the request for conversion is made in respect of an 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 a statement of grant of protection has been issued pursuant to Article 79 EUTMDR, the request must be filed in the language in which the international application was filed with WIPO or in the second language indicated therein.

Article 146(6) and Article 206 EUTMR

Where the request is made in respect of an 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 using the form provided by the Office pursuant to Article 65 EUTMDR, the form may be used in any of the official languages of the Union, provided that textual elements are completed in one of the languages of the Office. This concerns, in particular, the list of goods and services in a request for partial conversion. In the event of a partial 'opting-back' conversion, the list of goods and services must be filed in English, French or Spanish.

### 5.4 Fees

Articles 140(1) and (3), 180(3) and Annex I A(23) EUTMR

The request for conversion, including for conversion of an IR designating the EU, is subject to payment of a fee of EUR 200. The request will not be considered to be filed until the conversion fee has been paid. This means that the conversion fee must be paid within the abovementioned time limit of three months. A payment made after expiry of that period will be considered to have been made in due time if the person concerned submits evidence that the payment was made to a bank or a transfer order placed, in a Member State and within the period of three months and if, at the time of payment, a surcharge of 10 % 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**

Article 140 EUTMR

Article 23 EUTMIR

The Office will deal with requests for conversion by:

- examining them,
- publishing them, and
- transmitting 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**

Articles 140(3) and 202(6) EUTMR

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 request for conversion is considered not to have been filed. Any fees paid late will be reimbursed.

#### **6.2.2 Time limit**

Articles 140(3) and 202(6) EUTMR

When the request for conversion is considered to have been filed because the conversion fee has been paid within the applicable time limit (see paragraph 6.2.1

above), the Office will examine if the request has been filed within the time limit of three months.

Where the request for conversion was not filed within the relevant time limit but payment was received on time, the Office will reject the request as inadmissible. Any fees paid will not be reimbursed.

### 6.2.3 Language

Article 146(6) and Article 206 EUTMR

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

When the request is filed in a language that 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 request 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

Article 22(b), (d) and (e) EUTMIR

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

Where the applicant for conversion has not used the Conversion Form made available by the Office, and where the deficiency lies in the applicant not having indicated the elements referred to in Article 22(b), (d) or (e) EUTMIR, either the applicant will be invited to submit the missing information or, where the information may be readily ascertained from data available to the Office, the Office will be considered as having been authorised to make available the relevant extracts from its database to the designated offices.

### 6.2.5 Grounds

Articles 139(2) and 202(8) EUTMR

The Office will examine:

- whether one of the grounds for conversion referred to in paragraph 2 above exists;
- whether one of the grounds precluding conversion referred to in paragraph 4 above exists;
- 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 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 valid, whether the goods and services to be converted overlap with the goods and services for which the mark remains valid (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 request 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

Articles 119(3) and 120(1) EUTMR

Article 74(1) to (3) EUTMDR

The general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, Professional Representation). The applicant for 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 submit an additional authorisation, is determined by the national law concerned.

#### 6.2.7 Partial conversion

Article 139(1) EUTMR

Article 22(e) EUTMIR

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 for conversion applies. The same criteria apply for this assessment as for similar procedural situations, such as the restriction of an application or partial refusal in opposition proceedings.

Where an application is refused in part or a registration is declared invalid or revoked in part, conversion may be requested only for the goods or services for which the

application was refused or the registration was declared invalid 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 or 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 or 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 an EUTM application or partially surrendering an EUTM registration (see the Guidelines, Part B, Examination, Section 3, Classification).

### **6.3 Publication of the request and entry in the Register**

Article 111(3)(p) and Article 140(2) EUTMR

On acceptance of a request for conversion that is considered to have been filed because the required fee has been paid, and provided that the request for conversion is of a published EUTM application or a registered EUTM, the Office will make an entry in the Register of European Union trade marks recording the receipt of the request for conversion.

Article 140(2) EUTMR

Once the Office has completed examination of the request for conversion and has found it to be in order, it will register and publish it in the EUTM Bulletin. However, the request for conversion will not be published if it is submitted when the EUTM application has not yet been published in accordance with Article 44 EUTMR.

Article 140(1) and (2) EUTMR

Article 23 EUTMIR

The request for conversion is published only after the Office has completed examination of it and found it to be in order and the required fee has been paid.

Article 23 EUTMIR

The publication of the application for conversion must contain the indications referred to in Article 23 EUTMIR and, unless it concerns an IR designating the EU, must include a reference to the previous publication in the EUTM Bulletin and the date of the application for conversion.

Articles 40(1) and 202(5), (6), (7) and (8) EUTMR

Article 23 EUTMIR

The lists of goods and services for which conversion is requested will not be published if the conversion is for an IR designating the EU.

## 6.4 Transmission to designated offices

Articles 140(3) and (5) and 141(1) EUTMR

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

The Office will send a copy of the request for conversion to the designated offices and make available to them an extract of its database containing the data referred to in Article 111(2) EUTMR of the converted EUTM or IR. Any central industrial property office to which the request for conversion is transmitted may obtain from the Office any additional information concerning the request, which will enable that office to make a decision regarding the national trade mark resulting from the conversion.

Article 140(5) EUTMR

At the same time, the Office will inform the applicant for conversion of the date of transmission to the designated 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 141(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 of the request and its accompanying documents in one of the official languages of the Member State in question. 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 in the Conversion Form to indicate a representative for the purposes of the procedure before a specific national office, that national office will be in a position to communicate directly with that representative so no separate communication to appoint a domestic representative will be necessary.

Article 141(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 EUTM Regulations.

## 7 Effects of Conversion

Article 139(3) EUTMR

In each Member State concerned, the national trade mark application resulting from the conversion will enjoy the filing date or the date of priority, if any, of the EUTM application, as well as the seniority of an earlier trade mark with effect for that Member State validly claimed for the EUTM application or registration under Article 39 or 40 EUTMR. For information on conversion of an 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) and (7) CR will enjoy the original date of the IR designating the EU, that is, either the actual date of the IR (including, if appropriate, its priority date) or the date of the subsequent designation of the EU.

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 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 (application) are considered to come into existence as soon as a valid request for conversion is filed. Therefore, in opposition proceedings, such rights will be considered properly identified for admissibility purposes under Article 2(2)(b)(i) EUTMDR if the opponent indicates the number of the EUTM (application) 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 an 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 (15/07/2008, R 1313/2006-G, *cardiva (fig.) / cardima (fig.)*) (see also the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.2.2.2).

Obsolete