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

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

***Part M***

***International marks***

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# 1 Introduction

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

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

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

The Guidelines are not intended to, and cannot, add to or subtract from the substance of [Chapter XIII EUTMR](#). The EUIPO is also bound by the provisions of the [Madrid Protocol](#) and the Regulations under the Protocol relating to the Madrid Agreement. Reference may also be made to the [Guide to the Madrid System International Registration of Marks under the Madrid Protocol](#) published by WIPO, as these Guidelines are not intended to repeat the information stated there.

## 2 The EUIPO as Office of Origin

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

- examining and forwarding international applications;
- examining and forwarding subsequent designations;
- handling notices of irregularity issued by WIPO;
- notifying WIPO of certain facts affecting the basic mark during the 5-year dependency period;
- forwarding certain requests for changes in the International Register.

## 2.1 Examination and forwarding of international applications

[Article 183](#) and [Article 184\(1\) EUTMR](#)

[Article 28 EUTMR](#)

International applications filed with the EUIPO are subject to:

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

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

### 2.1.1 Identification of international applications

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

When an international application is submitted, the Office will issue a receipt quoting the file number.

### 2.1.2 Fees

#### 2.1.2.1 Handling fee

[Article 184\(4\) and \(8\)](#), and [Article 188 EUTMR](#)

[Annex I A\(34\) EUTMR](#)

An international application is only considered to have been filed if the handling fee of EUR 300 has been paid.

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

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

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

If, when examining 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 2 months. If payment is made within the 2-month time limit set by the EUIPO, the date of receipt that the EUIPO will communicate to WIPO will be the date on which the payment reaches the EUIPO. If payment is still not made within the 2-month time limit set by the EUIPO, the EUIPO will inform the applicant that it considers the international application not to have been filed and will close the file.

#### 2.1.2.2 International fees

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

If the applicant uses the [e-filing tool](#), it will have the possibility to indicate directly in the application the amount of the international fees and how they will be paid. If the applicant uses the paper [EM2 form](#), the Fee Calculation Sheet (Annex to WIPO form [MM2](#)) must be submitted in the language in which the international application is to be transmitted to WIPO. Alternatively, the applicant can attach a copy of the payment to WIPO. However, the EUIPO will not examine whether the Fee Calculation Sheet is attached, whether it is correctly filled in, or whether the amount of the international fees has been correctly calculated. Any questions regarding the amount of the international fees and related means of payment should be addressed to WIPO. A [Fee Calculator](#) is available on WIPO's website.

#### 2.1.3 Forms

[Article 184\(1\) to \(3\)](#) and [Article 184\(5\)\(a\) EUTMR](#)

[Article 28 EUTMIR](#)

[Article 65\(2\)\(b\) EUTMDR](#)

The international application must be filed in one of the official languages of the European Union, preferably using the [e-filing tool](#) provided by the Office, as it gives guidance to the applicant and, therefore, will potentially reduce the number of deficiencies and speed up examination.

When the international application is filed using the e-filing tool, it is populated with the data of the basic EUTM registration(s) or application(s) to limit manual data input as much as possible.

The Office also provides paper EM2 forms (the Office's adaptation of WIPO's [MM2 form](#)) in all official languages. Applicants may not use any other forms or change the forms' contents or layout.

If the application is filed in a language that is not one of the MP languages (English, French and Spanish), the applicant must indicate which of these three languages the application should be forwarded to WIPO. In such a case, the applicant will be requested to choose whether it authorises the Office to provide a translation, or whether it wishes to provide its own translation of the goods and services, and of any other textual element forming part of the international application, into the chosen language (English, Spanish or French) for forwarding the application to the International Bureau.

If a representative before the International Bureau has been appointed, all communications from the International Bureau will be sent only to that representative, except for unofficial notice of renewal, notification of non-renewal of an international registration and cancellation of the representative at their request. This will also be sent to the holder of the international registration.

An email address is compulsory for both the applicant and the representative. The email of the representative must be different to the one indicated for the applicant. All correspondence from the International Bureau will be sent electronically only and no paper correspondence will be issued.

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

#### 2.1.3.1 Entitlement to file

[Article 184\(5\)\(f\) EUTMR](#)

[Article 2\(1\)\(ii\) MP](#)

The indication regarding the applicant's entitlement to file an international application is compulsory. An applicant is entitled to file with the EUIPO as office of origin if it is a national of, or has a domicile or a real and effective industrial or commercial establishment in, an EU Member State. The applicant may choose on which criterion/criteria to base its right to file. For example, a Danish national domiciled in Germany can choose to base entitlement to file either on nationality or domicile. A French national domiciled in Switzerland is entitled to file only based on nationality (however, in this case, a representative before the EUIPO must be appointed). A Swiss company with no domicile or real and effective industrial or commercial establishment in an EU Member State is not entitled to file an international application through the EUIPO.

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

The expression 'real and effective industrial or commercial establishment in an EU Member State' is to be interpreted in the same way as in other instances, such as in the context of professional representation (see the Guidelines, [Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation, paragraph 4.4.2 Indirect employment](#)).

A real and effective industrial or commercial establishment in the EU is a branch, agency or any other kind of commercial establishment (including subsidiaries) in the EU that can be considered an extension of the non-EU legal person.

The concept of 'branch, agency or other establishment' implies a place of business that has the appearance of permanency, such as the extension of a parent body, has a management system and is materially equipped to negotiate business with third parties so that the latter, although knowing that there will if necessary be a legal link with the parent body, the office of which is abroad, do not have to deal directly with said parent body but may transact business at the place of business constituting the extension (see definition in 22/11/1978, [C-33/78](#), Somafer, EU:C:1978:205, § 12; 22/09/2016, [T-512/15](#), SUN CALI (fig.), EU:T:2016:527, § 30).

All the arguments and evidence the applicant deems necessary to support its claim of entitlement, including any evidence to prove the existence and nature of the link between the different entities, must be filed together with the request. If this evidence is not submitted, the Office will issue a deficiency notice.

#### 2.1.3.2 Basic mark

##### [Article 184\(5\)\(b\) to \(e\) EUTMR](#)

Rule [9\(4\)\(a\)\(v\)](#), [\(vii\)](#) and [\(vii bis\) to \(xii\)](#) and Rule [11\(2\)](#) of the Regulations under the Madrid Protocol

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

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

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

The international applicant must be identical to the EUTM applicant/proprietor. The international application may not be filed by a licensee or an affiliated company of

the proprietor of the basic mark(s). A deficiency in this respect may be overcome by transferring the basic mark to the international application applicant, or by recording a change of name, as applicable (see the Guidelines, [Part E, Register operations, Section 3, EUTMs and RCDs as objects of property, Chapter 1, Transfer](#)). Where there are multiple proprietors or applicants in the basic EUTM(s) or EUTM application(s), the international application must be submitted by the same persons.

The reproduction of the mark must be identical. For full details of EUIPO practice for the identity of trade marks filed in black and white and/or greyscale, compared to those filed in colour, see the Guidelines, [Part B, Examination, Section 2, Formalities, paragraph 11.3.2](#) for priority claims, which applies by analogy. Particular attention should be paid to the following.

- Where the basic mark is protected in colour, the international application must include a colour claim.
- If the basic mark is:
  - a **word mark**, the relevant box must be ticked to request that the mark be considered as a mark in standard characters;
  - a **colour mark**, the relevant box must be ticked to declare that the mark consists of a colour or a combination of colours as such;
  - a **shape mark**, the relevant box for a three-dimensional mark must be ticked. If the representation of the basic mark was filed via computer-generated images or animated designs, applicants should consider whether the designated contracting party/ies accept(s) such files (consult the [acceptable formats](#) for representation of a mark before each office);
  - a **sound mark**, the relevant box must be ticked. If the representation of the basic mark was filed via audio file, applicants should consider whether the designated contracting party/ies accept(s) such files (consult the [acceptable formats](#) for representation of a mark before each office);
  - a **motion mark**, and the representation of the basic mark was filed via video file, applicants should consider whether the designated contracting party/ies accept(s) such files (consult the [acceptable formats](#) for representation of a mark before each office);
  - a **multimedia mark**, and the representation of the basic mark was filed via audiovisual file, applicants should consider whether the designated contracting party/ies accept(s) such files (consult the [acceptable formats](#) for representation of a mark before each office);
  - a **hologram mark**, and the representation of the basic mark was filed via video file, applicants should consider whether the designated contracting party/ies accept(s) such files (consult the [acceptable formats](#) for representation of a mark before each office).

Where the basic mark is a figurative mark, a position mark, a pattern mark, a motion mark, a multimedia mark, a hologram mark or any other type of mark (apart from a word mark, colour mark, shape mark and sound mark, mentioned above), no specific indication can be made on the international application form. Therefore, those applications will be processed without any indication of mark type. However, for



clarification purposes, the EUIPO will add the trade mark type of non-traditional trade marks in the voluntary mark description field of the electronic form to be transmitted to WIPO.

- Collective or certification marks: where the basic mark is a collective or certification mark, the relevant box must be ticked.
- Description: if the basic mark includes a description, the same description may be included in the international application. If the basic mark does not include a description, a voluntary description may be added in the international application.
- Disclaimer: a disclaimer may be included even if the basic mark(s) do(es) not include one.
- Transliteration: WIPO requires a transliteration into Latin characters if the mark contains non-Latin characters. If no transliteration is given, WIPO will raise an irregularity, which must be remedied directly by the applicant. This applies to all types of trade marks, not just word marks.
- List of goods and services:
  - the list of goods and services must be identical to, or otherwise included in, the list contained in the basic mark(s) on the day the international application is filed;
  - the list of goods and services must be specified by class;
  - the list may be limited for one, several or all designated Contracting Parties and the limitation in respect of each Contracting Party may be different – it is imperative to indicate with clarity and precision the complete limited list for each Contracting Party, where such a limitation is requested.
- Translation: if the applicant does not provide a translation into the WIPO language it has chosen (Spanish, English or French) but instead authorises the EUIPO to provide the translation or to use the one available for the basic mark(s), it will not be consulted regarding the translation.

#### 2.1.3.3 Priority claim(s)

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

#### 2.1.3.4 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. This form, which contains the declaration of intention to use the mark, is available only in English and must be completed in English irrespective of the language of the international application.

## 2.1.4 Examination of the international application by the EUIPO

[Article 184 EUTMR](#)

[Article 3\(1\) MP](#)

Where examination of the international application reveals deficiencies, the EUIPO will invite the applicant to remedy them within 1 month. In principle, this short time limit should enable the EUIPO to forward the international application to WIPO within 2 months from the date of receipt and thus maintain that date as the date of the international registration.

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

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

As soon as the EUIPO is satisfied that the international application is in order, it will transmit it to WIPO electronically, with the exception of documents such as the Fee Calculation Sheet or the MM18, which will be transmitted as scanned attachments. The electronic transmission will contain the certification by the office of origin referred to in [Article 3\(1\) MP](#).

## 2.1.5 Irregularities found by WIPO

Rule [11\(4\)](#) and Rules [12](#) and [13](#) of the Regulations under the Protocol

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

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

## 2.2 Subsequent designations

[Article 187 EUTMR](#)

[Article 65\(2\)\(b\) EUTMDR](#)

Articles [30](#) and [31](#) EUTMIR

[Article 2\(1\)\(ii\) MP](#)

Rule [1\(xxvibis\)](#) and Rule [24\(2\)](#) of the Regulations under the Protocol

Within the framework of the Madrid System, the holder of an international registration can extend the geographical scope of a registration's protection. There is a specific procedure called 'subsequent designation' of a registration, which extends the scope of the international registration to other members of the Madrid Union. The holder may wish to do this for a number of reasons, for example, to expand into new territories or to add a member that was not party to the Protocol at the time of filing the international application. A subsequent designation may also be used to extend the scope of the goods and/or services of a prior designation, provided that the scope of the international registration is not exceeded. This could be useful in situations where a limitation has previously been recorded.

Unlike international applications, subsequent designations need not be filed through the office of origin but may be filed directly with WIPO. Direct filing with WIPO is recommended for a speedier process. The easiest way to submit a subsequent designation to the International Bureau directly is to make use of the Online subsequent designation form available on the WIPO website.

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

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

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

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

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

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

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

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

Within these limitations, different lists may be submitted for different, subsequently designated, Contracting Parties.

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

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

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

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

If the request for territorial extension does not comply with the requirements outlined above, the EUIPO will invite the applicant to remedy the deficiencies within a time limit of at least 1 month. If the deficiencies are not remedied within this time limit, the EUIPO may refuse to forward the request to the International Bureau. However, the EUIPO must not refuse to forward the request to the International Bureau before the applicant has had the opportunity to correct any deficiency detected in it.

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

## 2.3 Notification of facts affecting the basic registration

Articles [49](#), [53](#), [57](#) to [62](#) and [128](#) EUTMR

[Article 29 EUTMIR](#)

If, within 5 years of the date of the international registration, the basic mark(s) cease(s) to have effect wholly or in part, the international registration is cancelled to the same extent, since it is 'dependent' thereon. This occurs not only in the event of a 'central attack' by a third party, but also if the basic mark(s) lapse(s) due to action or inaction on the part of its proprietor.

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

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

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

If the above occurs within the 5-year period, the EUIPO must notify WIPO accordingly.

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

WIPO must also be notified when a procedure has been initiated prior to the expiry of the 5-year period but not finally decided within that period. This notification is to be made at the end of the 5-year period. The cases involved are:

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

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

If, within 5 years of the date of the international registration, the basic EUTM(s) or EUTM application(s) is (are) divided or partially transferred, WIPO must also be notified. However, in those cases, there will be no effect on the international registration's validity. The notification's purpose is merely to keep a record of the number of mark(s) on which the IR is based.

No other changes in the basic mark(s) will be reported to WIPO by the EUIPO. Where the holder wishes to record changes to the international registration, it should apply separately to the International Bureau (see [paragraph 2.4](#) below).

## 2.4 Forwarding of changes affecting the international mark

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

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

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

Most of the changes can be transmitted directly to the International Bureau by using electronic forms available in [eMadrid](#) on the WIPO website.

### 2.4.1 Cases where requests for the recording of changes can be forwarded without examination

Rules <a href="#">20</a> and <a href="#">20bis</a> and Rule <a href="#">25(1)</a> of the Regulations under the Protocol.
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The following requests for the recording of changes relating to an international registration can be presented to the EUIPO as an 'office of the Contracting Party of the holder':

- WIPO form [MM5](#) – change of ownership, either total or partial, submitted by the IR holder on record (in EUTM terminology, this corresponds to a transfer);
- WIPO form [MM6](#) – limitation of the list of goods and services for all or some Contracting Parties;
- WIPO form [MM7](#) – renunciation of one or more Contracting Parties (not all);
- WIPO form [MM8](#) – full or partial cancellation of the international registration;
- WIPO form [MM9](#) – change of the name or address of the holder and/or change in the indication of the legal nature where the holder is a legal entity;



- WIPO forms [MM13/MM14](#) – new licence or amendment to a licence submitted by the IR holder on record;
- WIPO form [MM15](#) – cancellation of the recording of a licence;
- WIPO form [MM19](#) – restriction of the holder's right of disposal submitted by the IR holder on record (in EUTM terminology, this corresponds to the rights in rem, levy of execution, enforcement measures or insolvency proceedings contemplated in Articles [22](#), [23](#) and [24](#) EUTMR).

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

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

No use will be made of the options provided in [Rule 20\(1\)\(a\) of the Regulations under the Protocol](#) 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 requests for the recording of changes will be forwarded after examination**

##### [Article 201 EUTMR](#)

Rule [20\(1\)\(a\)](#), Rule [20bis\(1\)](#) and Rule [25\(1\)\(b\)](#) of the Regulations under the Protocol.

Requests for the recording of a change in ownership, licence or restriction of the holder's right of disposal may be filed directly with WIPO by the international registration holder. However, 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 request with the office of the holder's Contracting Party. WIPO will register such requests, without any substantive examination, on the basis that they have been transmitted by that office.

To avoid a third party becoming the owner or licensee of an international registration, it is imperative that the EUIPO examine all requests presented by any party other than the international registration holder, to verify that there is proof of the transfer, licence or other right, as provided in [Article 201 EUTMR](#). The EUIPO limits itself to

examining proof of the transfer, licence or other right, with Articles [20](#) and [26](#) EUTMR and [Article 13 EUTMR](#) and the corresponding parts of the EUIPO Guidelines on transfers, licences, rights *in rem*, levies of execution and insolvency proceedings or similar proceedings applying by analogy. If no proof is submitted, the EUIPO will refuse to forward the request to WIPO. This decision may be appealed.

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

## 3 The EUIPO as Designated Office

### 3.1 Overview

Any person who is a national of or has a domicile or commercial establishment in a State that is party to the [MP](#) 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 EU.

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

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

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

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

Where corrections are received from WIPO that affect the mark itself, the goods and services or the designation date, it corresponds to the EUIPO to decide if a new 18-month period is to start running from the new notification date. Where a correction



affects only part of the goods and services, the new time limit applies only to that part and the EUIPO has to republish the international registration in part in the [EUTM Bulletin](#) and reopen the opposition period only for that part of the goods and services.

The main tasks that the EUIPO performs as designated office are:

- first republication in the EUTM Bulletin;
- examination of formalities, including examination of limited lists for the EU designation, of the clarity and precision of the terms in the specification of goods and services, and of seniority claims;
- examination of absolute grounds;
- examination of oppositions;
- processing of communications from WIPO concerning changes to the IRs;
- second republication in the EUTM Bulletin;
- issue of provisional refusals, grants of protection, final and other decisions affecting the scope of protection of international registrations.

## 3.2 Professional representation

[Article 119\(2\)](#) and [Article 120 EUTMR](#)

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

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

In any of the above situations, where the IR holder has appointed a representative before WIPO who also appears in the database of representatives maintained by the Office, this representative will automatically be considered to be the IR holder's representative before the Office.

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

### 3.3 First republication, searches and formalities

#### 3.3.1 First republication

##### [Article 190 EUTMR](#)

On receipt, international registrations will immediately be republished<sup>(93)</sup> in Part M.1 of the [EUTM Bulletin](#), except where the second language is missing.

Publication will be limited to bibliographic data, the representation of the mark and the class numbers, and will not include the actual list of goods and services. This means, in particular, that the EUIPO will not translate IRs 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 IR publication in the [WIPO Gazette](#), which should be consulted for further information. For more details, reference is made to the [EUTM Bulletin](#) on the EUIPO's website.

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

#### 3.3.2 Searches

##### [Article 195 EUTMR](#)

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

The national search request must be filed directly with the Office. Holders of IRs designating the EU must request the national searches and pay the corresponding fee within a period of 1 month from when WIPO informs the Office of the designation. Late or missing payments of search fees will be dealt with as if the request for national searches had not been filed.

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

<sup>93</sup> IRs are published first in the [WIPO Gazette of International Marks](#) and then 'republished' by the EUIPO.

The holder will not be required to appoint a representative before the EUIPO for the sole purpose of requesting or receiving search reports.

The search reports requested will be sent directly to the IR holder or, if the latter has appointed a representative before the Office, to that representative. When a representative has been considered to be the IR holder's representative before the Office in any of the situations described under paragraph [3.2](#), the search reports will also be sent to that representative.

### 3.3.3 Formalities examination

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

#### 3.3.3.1 Languages

[Article 146\(3\), \(4\) and \(8\)](#), and Articles [193](#) and [206](#) EUTMR

[Rule 9\(5\)\(g\)\(ii\) of the Regulations under the Protocol](#)

[Rule 9\(5\)\(g\)\(ii\) of the Regulations under the Protocol](#) and [Article 206 EUTMR](#) require the applicant for an international application designating the EU to indicate a second language, different from the first one, selected from the four remaining languages of the EUIPO by ticking the appropriate box in the contracting parties' section of WIPO forms [MM2](#) or [MM4](#).

Under the terms of [Article 206 EUTMR](#), the language of filing of the international application is the language of the proceedings within the meaning of [Article 146\(4\) EUTMR](#). If the language chosen by the international registration holder in written proceedings is not the language of the international application, the holder must supply a translation into that language within 1 month from when the original document was submitted. If the translation is not received within this time limit, the original document is considered not to have been received by the EUIPO.

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

Where no second language has been indicated, the examiner will issue a provisional refusal of protection and give the holder 2 months from the day on which the EUIPO issues the provisional refusal pursuant to [Article 193\(5\) EUTMR](#) to remedy

the deficiency. Where necessary, the notification of provisional refusal will invite the IR holder to appoint a representative in compliance with Articles [119](#) and [120](#) EUTMR. This notification will be recorded in the International Register, published in the [Gazette](#) and sent to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

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

If the deficiency has not been remedied and/or a representative, if applicable, has not been appointed, the EUIPO will confirm the refusal to the IR holder. The holder has 2 months within which to lodge an appeal. Once the decision is final, the EUIPO will inform WIPO that the provisional refusal is confirmed.

### 3.3.3.2 Collective and certification marks

Articles [74 to 76](#), [83](#), [84](#) and [194](#) EUTMR

Articles [16](#), [17](#) and [33](#) EUTMIR

[Article 76 EUTMDR](#)

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

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

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

In accordance with [Article 194 EUTMR](#), the holder must submit the regulations governing use of the mark directly to the EUIPO within 2 months of the date on which the International Bureau notified the EUIPO of the designation. These regulations must be submitted in the language of proceedings.

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

If the regulations on use have not yet been submitted or contain irregularities, or the holder does not comply with the requirements of Articles [74](#) or [83](#) EUTMR, the examiner will issue a provisional refusal of protection and give the holder 2 months from the day on which the EUIPO issues the provisional refusal pursuant to [Article 33 EUTMR](#) to remedy the deficiency. Where necessary, the notification of provisional refusal will invite the IR holder to appoint a representative in accordance with Articles [119](#) and [120](#) EUTMR. This notification will be recorded in the International Register, published in the [Gazette](#) and sent to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

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

If the deficiency has not been remedied and/or a representative, if applicable, has not been appointed, the Office will confirm the refusal to the IR holder, and grant a 2-month time limit for lodging an appeal. Once the decision is final, the Office will inform WIPO that the provisional refusal is confirmed.

### 3.3.3.3 Seniority claims

#### Seniority claims filed together with the designation

##### [Article 191 EUTMR](#)

Rule [9\(5\)\(g\)\(i\)](#) and [Rule 21bis](#) of the Regulations under the Protocol

The applicant may, when designating the EU in an international application or a subsequent designation, claim the seniority of an earlier mark registered in a Member State. Such a claim must be submitted by attaching form [MM17](#) to the international application or subsequent designation request, which should include for each claim:

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

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

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

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

If it is necessary to file documentation in support of the seniority claim, or if the claim contains irregularities, the examiner will issue a deficiency letter giving the IR holder

2 months within which to remedy the deficiency. Where necessary, the IR holder will also be invited to appoint a representative before the EUIPO.

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

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

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

[Article 192 EUTMR](#)

[Article 32 EUTMIR](#)

[Rule 21bis\(2\) of the Regulations under the Protocol](#)

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

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

If it is necessary to submit documentation in support of the seniority claim or if the claim contains irregularities or the appointment of a representative before the EUIPO is required, the examiner will issue a deficiency letter giving the IR holder 2 months within which to remedy the deficiency.

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

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

If the deficiency is not remedied and/or a representative, if applicable, has not been appointed, the right of seniority will be refused and the IR holder will be given 2 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 Terms lacking clarity and precision

Articles [33](#), [41](#), [182](#) and [193](#) EUTMR

[Article 33 EUTMIR](#)

International registrations designating the EU are examined for the specification of terms lacking clarity and precision in the list of goods and services in the same way as direct EUTM applications (see the Guidelines, [Part B, Examination, Section 3, Classification](#)).

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

Where the IR contains terms in the list of goods and/or services, which lack clarity or precision, the EUIPO will issue a provisional refusal of protection and give the holder 2 months from the day on which the EUIPO issues the provisional refusal pursuant to [Article 33 EUTMR](#) and [Article 33 EUTMIR](#) to remedy the deficiency. Where necessary, the notification of provisional refusal will invite the IR holder to appoint a representative in accordance with Articles [119](#) and [120](#) EUTMR. This notification will be recorded in the International Register, published in the [Gazette](#) and sent to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

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

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

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

If the holder fails to overcome the objections or fails to respond to the objection, the provisional refusal will be confirmed. In other words, if the provisional refusal concerned only some of the goods and services, only those goods and services will be



refused but the remaining goods and services will be accepted. The IR holder will be given 2 months within which to lodge an appeal.

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

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

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

Where the limited list for the EU contains terms that are not comprised within the main list of goods and services of the IR, the EUIPO will issue a provisional refusal of protection and give the IR holder 2 months from the day on which the provisional refusal is issued to remedy the deficiency. Where necessary, the notification of provisional refusal will invite the IR holder to appoint a representative in compliance with Articles [119](#) and [120](#) EUTMR. This notification will be recorded in the International Register, published in the [Gazette](#) and sent to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

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

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

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

If the holder fails to overcome the objections or to 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 2 months within which to lodge an appeal.

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



### 3.4 Absolute grounds for refusal

[Article 193 EUTMR](#)

[Article 33 EUTMR](#)

[Rule 18bis\(1\) of the Regulations under the Protocol](#)

International registrations designating the EU will be subject to examination of absolute grounds for refusal in the same way as direct EUTM applications (see the Guidelines, [Part B, Examination, Section 4, Absolute Grounds for Refusal](#)).

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

If the EUIPO finds that the mark is not eligible for protection, it will send a provisional refusal of protection, giving the IR holder 2 months from the day on which the provisional refusal is sent to submit observations. Where necessary, the notification of provisional refusal will also invite the holder to appoint a representative in compliance with Articles [119](#) and [120](#) EUTMR. This notification will be recorded in the International Register, published in the [Gazette](#) and communicated to the IR holder. The reply to the provisional refusal must be addressed to the EUIPO.

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

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

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

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

If the holder fails to overcome the objections or convince the examiner that they are unfounded, or fails to respond to the objection, the refusal will be confirmed. In other words, if the provisional refusal concerned only some of the goods and services, only those goods and services will be refused but the remaining goods and services will be accepted. The IR holder will be given 2 months within which to lodge an appeal.

Once the decision is final and provided that there is a total refusal, the EUIPO will inform WIPO that the provisional refusal is confirmed. If the absolute grounds refusal

is only partial, the communication to WIPO will be issued once all other procedures are terminated or the opposition period is over with no opposition received (see [paragraph 3.9](#) below).

### 3.5 Third-party observations

[Article 45](#) and [Article 193\(7\) EUTMR](#)

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

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

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

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

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

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

### 3.6 Opposition

[Article 196 EUTMR](#)

Articles [77](#) and [78 EUTMDR](#)

#### 3.6.1 Timing

Oppositions may be filed against the international registration between the first month and the fourth month following the date of first republication. For example, if the first

republication is on 15/02/2017, the opposition period starts on 15/03/2017 and ends on 15/06/2017.

The opposition period is fixed and is independent of the outcome of the procedure on absolute grounds. Nevertheless, the start of the opposition procedure depends on the outcome of the *ex officio* examination insofar as the opposition procedure may be suspended if an *ex officio* refusal has been issued in relation to the same goods and services.

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

### 3.6.2 Receipt and informing the international holder

[Article 4](#) and [Article 77\(3\) EUTMDR](#)

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

The EUIPO will also inform the IR holder or the representative before WIPO (if the holder has appointed a representative before WIPO and the EUIPO holds sufficient contact information) of the filing of the opposition and the number of the same, even if the place of business is outside the EEA.

### 3.6.3 Fees

[Article 99](#) and [Article 196\(2\) EUTMR](#)

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

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

### 3.6.4 Admissibility check

[Article 119\(2\) EUTMR](#)

Articles [5](#) and [78](#) EUTMDR

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

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

For full details on opposition proceedings, see the Guidelines, [Part C, Opposition, Section 1, Opposition Proceedings](#).

### 3.6.5 Language of proceedings

[Article 146\(6\) EUTMR](#)

[Article 3 EUTMDR](#)

Oppositions (like requests for cancellation) must be filed in the language of the international registration (the first language) or in the second language that the international holder is obliged to indicate when designating the EU. The opponent may choose either of these two languages as the language of the opposition proceedings. The opposition may also be filed in any of the other three EUIPO languages, provided that a translation into the language of the proceedings is filed within 1 month.

The EUIPO will use:

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

### 3.6.6 Representation of the IR holder

#### 3.6.6.1 Opposition receipts

[Article 4 EUTMDR](#)

If applicable, the EUIPO will, in the opposition receipt, inform the representative before WIPO that if the IR holder does not appoint a representative who complies with the requirements in Articles [119\(3\)](#) or [120](#) EUTMR within 1 month of receipt of the communication, the EUIPO will communicate the formal requirement to appoint

a representative to the IR holder together with the opposition deadlines once the opposition is found admissible.

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

### 3.6.6.2 Notification of commencement of opposition proceedings

#### [Article 6\(1\) EUTMDR](#)

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

- If the IR holder is **not** required to be represented before the EUIPO, the proceedings will continue directly with the IR holder, that is, the IR holder will be sent notification of the admissibility of the opposition and the time limits set for substantiation.
- If the IR holder **is** required to be represented before the EUIPO, the IR holder will be notified of the admissibility of the opposition and will be formally requested to appoint a representative within 2 months of receipt of the communication ([Article 77\(4\) EUTMDR](#)), failing which the IR will be refused with a right to appeal. Once the decision is final, the opposition proceedings will be closed and WIPO will be informed. For the attribution of costs, the normal rules apply. This means that no decision on costs will be taken and the opposition fee will not be refunded.

### 3.6.7 Provisional refusal (based on relative grounds)

#### [Article 78 EUTMDR](#)

Article [5\(1\)](#) and Article [5\(2\)\(a\)](#) and (b) MP

Rule [17\(1\)\(a\)](#) and [\(2\)\(v\)](#) of the Regulations under the Protocol

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

The provisional refusal may be partial or total. It will contain details of the earlier rights invoked, including their representation, the relevant list of goods and services on which

the opposition is based and, in the case of a partial refusal, the list of goods and services against which the opposition is directed.

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

This notification will be recorded in the International Register, published in the [Gazette](#) and communicated to the IR holder. The time limit for commencement of the proceedings will be set in the direct notification to the parties made in parallel by the EUIPO, as in the case of a normal EUTM.

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

Articles [6\(2\)](#) and [77\(5\)](#) EUTMDR

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

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

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

## 3.7 Cancellation of the IR or renunciation of the EU designation

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

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

However, cancellation of the IR at the request of the office of origin (due to a 'central attack' during the 5-year dependency period) is considered equivalent to rejection of the EUTM application in parallel proceedings under [Article 6\(2\) EUTMDR](#). In this case the opposition fee is not reimbursed.

### 3.8 Limitations of the list of goods and services

[Article 9bis\(iii\) MP](#)

[Rule 25 of the Regulations under the Protocol](#)

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

Further to a provisional refusal, limitations can be filed through WIPO or submitted directly to the EUIPO.

The IR holder should inform the Office as soon as it submits the limitation request ([MM6/MM8](#)) to WIPO. The refusal procedure will then be suspended pending receipt of the notification of limitation from WIPO (i.e. once the limitation is entered in WIPO's Register). Provided the limitation allows the objection to be waived, the EUIPO will communicate to WIPO that the provisional refusal is withdrawn.

If, further to a provisional refusal, the IR holder chooses to limit the list of goods and services by submitting its request for limitation to the EUIPO, instead of through WIPO, the EUIPO will simply confirm the provisional refusal. As a consequence, WIPO's Register will reflect the partial refusal, not the limitation as such.

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

**The request for limitation must be submitted through WIPO in all cases where the IR holder wishes to apply for a conversion request.**

Partial cancellations at the request of the office of origin (further to a 'central attack' during the 5-year dependency period) will be recorded, as they are by the EUIPO.

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



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

[Article 33\(2\) EUTMIR](#)

Articles [78\(5\)](#) and [79\(1\)](#) EUTMDR

Rule [18ter\(1\) to \(3\)](#) of the Regulations under the Protocol

If one or several notifications of provisional refusal have been sent to WIPO, the EUIPO must perform either one of the following options once all procedures have been completed and all decisions are final.

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

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

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

The EUIPO will not issue any registration certificate for IRs.

### 3.10 Second republication

Articles [189\(2\) and \(3\)](#) and [190\(2\)](#), and [Article 203 EUTMR](#)

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

The date of the second republication will be the starting point for the 5-year use period and the date from which the registration may be invoked against an infringer.

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

Only the following data will be published in Part M.3.1 of the [EUTM Bulletin](#):

111 - number of the international registration;

460 - date of publication in the Gazette, if applicable;

400 - date(s), number(s) and page(s) of previous publication(s) in the EUTM Bulletin;

450 - date of publication of the international registration or subsequent designation in the EUTM Bulletin.



### 3.11 Transfer of the designation of the EU

#### [Article 201 EUTMR](#)

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

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

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

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

### 3.12 Invalidity, revocation and counterclaims

Articles [58 to 60](#), Articles [189\(2\)](#) and [190\(2\)](#), and Articles [198](#) and [203](#) EUTMR

#### [Article 34 EUTMR](#)

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

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

- An application for declaration of invalidity of an IR designating the EU is only admissible once the designation has been finally accepted by the EUIPO, namely once the statement of grant of protection has been sent.

- an application for revocation on the basis of non-use of an IR designating the EU is only admissible if, at the date of filing the application, the final acceptance of the IR had been republished by the EUIPO at least 5 years earlier (see [Article 203 EUTMR](#), stating that the date of publication pursuant to [Article 190\(2\) EUTMR](#) takes the place of the date of registration for the purpose of establishing the date as from which the mark that is the subject of an IR designating the EU must be put to genuine use in the European Union).

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

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

## 4 Conversion, Transformation, Replacement

### 4.1 Preliminary remarks

Conversion or transformation

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

- When the IR designating the EU is finally refused by the EUIPO 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 because of the basic mark's ceasing of effect during the 5-year dependency period.
- When an IR is cancelled because the basic mark had ceased to have effect during the 5-year dependency period, transformation into a direct EUTM application is possible. Transformation is not available when the IR has been cancelled at the holder's request or the holder has renounced in part, or in its entirety, the designation of the EU. The EU designation must still be effective when the transformation is requested, that is, the EUIPO must not have ultimately refused it; otherwise, there will be nothing left to transform, and conversion of the designation would be the only possibility.

## 4.2 Conversion

Articles [139 to 141](#) and [202](#) EUTMR

[Rule 24\(2\)\(a\)\(iii\) of the Regulations under the Protocol](#)

The legal option of conversion <sup>94</sup> has its origins in the EUTM system, which has been adapted to allow a designation of the EU through an IR to be converted into a national trade mark application, just like for a direct EUTM. The EUTM system and Madrid System have also been adapted to allow for conversion into a designation of Member States party to the Madrid System (known as 'opting back'). Malta is not party to the Madrid System.

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

For full details on conversion, see the Guidelines, [Part E, Register Operations, Section 2, Conversion](#).

## 4.3 Transformation

[Article 111\(2\)\(p\)](#) and [Article 204 EUTMR](#)

[Article 36 EUTMR](#)

[Article 6\(3\)](#) and [Article 9 quinquies MP](#)

### 4.3.1 Preliminary remarks

Transformation has its origins solely in the [MP](#). It was introduced in order to soften the consequences of the 5-year dependency period already set in place by the [Madrid Agreement](#). Where an IR is cancelled in whole or in part because the basic mark has ceased to have effect, and the holder files an application for the same mark and same goods and services as the cancelled registration with the office of any Contracting Party for which the IR had effect, that application will be treated as if it had been filed on the date of the IR or, where the Contracting Parties had been designated subsequently, on the date of the subsequent designation. It will also enjoy the same priority, if any.

<sup>94</sup> In English, 'conversion' is used to describe a specific legal provision of the EUTM system ([Article 139 et seq. EUTMR](#)) while 'transformation' is used to describe that in [Article 9 quinquies MP](#). In other languages, only one word is used to describe these two different legal provisions (e.g. in Spanish 'transformación'). In order to avoid confusion, the English word 'conversion' could be used in parentheses when, for example, the Spanish word 'transformación' is used within the meaning of [Article 139 EUTMR](#).

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

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

### 4.3.2 Principle and effects

#### [Article 32 EUTMR](#)

Following a **cancellation in whole or in part of an IR designating the EU at the request of the office of origin** under [Article 9quinquies MP](#) because of the ceasing of effect of the basic mark during the 5-year dependency period, the holder may file a 'direct' EUTM application for the same mark and for the same goods and services as the cancelled mark.

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

**The date of the IR or of the subsequent designation will not become the filing date of the EUTM application.** [Article 32 EUTMR](#), which applies *mutatis mutandis*, lays down clear conditions for the granting of a filing date, subject also to payment of the application fee within 1 month. However, the date of the IR or subsequent designation will be the date that determines the 'earlier right effect' of the EUTM for the purposes of priority searches and oppositions.

Unlike for priority and seniority claims ([Article 41\(8\) EUTMR](#)), it is not possible to have a 'split' or 'partial' date, with one date being only for the goods that were contained in the IR and the filing date of the EUTM application being the relevant date for the additional goods and services. No such partial transformation effect is contemplated in [Article 9quinquies of the MP](#) or [Article 204 EUTMR](#).

Renewal starts to run from the transformed EUTM's filing date.

### 4.3.3 Procedure

The conditions for invoking a transformation right under [Article 9quinquies MP](#) are that:

- the application is filed within a period of 3 months from the date on which the IR was cancelled in whole or in part, and
- the goods and services of the ensuing application are in fact covered by the list of goods and services of the designation of the EU.

The Office will refuse any EUTM application resulting from an IR transformation filed prematurely, that is to say, before the cancellation of the IR is recorded by WIPO.

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

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

The Office will invite the applicant to remedy any deficiencies detected within a period of 2 months.

If the deficiencies are not remedied, the right to the date of the IR or the territorial extension and, if any, of the priority of the IR will be lost. In other words, if the transformation is finally refused, the EUTM application will be examined as a 'normal' application.

#### **4.3.4 Examination**

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

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

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

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

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

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

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

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

According to [Article 182 EUTMR](#), unless there are specific provisions to the contrary, the provisions of the EUTMR and the acts adopted pursuant to it apply *mutatis mutandis* to IRs designating the EU. This includes, inter alia, [Article 18\(1\) EUTMR](#), which imposes on EUTM proprietors the obligation to use the mark within a period of 5 years following registration. According to [Article 203 EUTMR](#), the date of the second republication of an IR designating the EU is the date taken for calculating its grace period. The reasoning behind the 5-year grace period is to give the trade mark proprietor 5 years from registration to prepare use of the mark. Since the situation of an IR designating the EU that has been transformed into an EUTM registration after its second republication is no different from that of an EUTM registration filed directly with the EUIPO, there is no reason for any different treatment either.

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

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

#### 4.3.5 Transformation and seniority

If seniority claims have been accepted by the EUIPO and are registered by WIPO in the file for the transformed IR designating the EU, there is no need to claim seniority again in the EUTM resulting from transformation. This is not explicitly set out in

[Article 36 EUTMIR](#) (only priority is mentioned under (d)) but is extended by analogy to seniority in view of the fact that:

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

### 4.3.6 Fees

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

The basic fee for the EUTM application must be paid to the EUIPO within 1 month of the filing of the EUTM requesting transformation in order for the request to comply with [Article 32 EUTMR](#) and [Article 9quinquies\(iii\) MP](#) and for the transformation to be accepted. For example, if the end of the 3-month time limit for transformation is 01/04/2012 and transformation into an EUTM application is filed on 30/03/2012, the deadline for payment of the basic fee is 30/04/2012. If payment occurs after that date, the conditions for transformation are not met, the transformation right will be lost and the filing date given to the EUTM application will be the date of the payment.

## 4.4 Replacement

[Article 111\(3\)\(t\)](#) and [Article 197 EUTMR](#)

[Article 4bis MP](#)

[Rule 21 of the Regulations under the Protocol](#)

### 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, considered to be replaced by an international registration of the same mark without prejudice to the rights already acquired (earlier date). The wording of [Article 4bis\(1\) MP](#) clearly provides that replacement is considered 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 request the EUIPO to take note of the replacement in its Register ([Rule 21 of the Regulations under the Protocol](#)). The purpose of this procedure is to ensure that the relevant information concerning the replacement is made available to third parties in the national or regional registers as



well as in the International Register. In other words, it is not an obligation to have the replacement registered in order to be able to invoke it, but it can be useful.

Apart from the qualification relating to earlier acquired rights, neither the [Madrid Agreement](#) nor the [Madrid Protocol](#) elaborates further on replacement.

#### **4.4.2 Principle and effects**

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

#### **4.4.3 Procedure**

A request to record a replacement may be filed at the EUIPO by the international holder at any time after notification of the EU designation by WIPO. Replacement can be total or partial.

Once a request to record a replacement has been received, the EUIPO will carry out a formal examination, checking:

- that the marks are identical;
- that the parties are identical;
- that the EUTM was registered prior to the designation of the EU;
- the goods and services concerned by the replacement.

It is sufficient for recording the replacement in the Register if the IR and EUTM coexist on the date of the IR. The EUIPO will not wait for the final acceptance of the IR before recording the replacement.

The IR does not need to have an identical list of goods and services as the EUTM. The list may be broader or narrower. If the list of the IR is narrower, the replacement of the EUTM by the IR will be partial and will be limited to the goods and services identically covered by both marks.

If all conditions are met, the EUIPO will record the replacement in the EUTM Register and inform WIPO that an EUTM has been replaced by an IR in accordance with [Rule 21 of the Regulations under the Protocol](#), indicating:

- the IR number;
- the EUTM number;
- the EUTM application date;
- the EUTM registration date;
- the priority date(s), if relevant;
- the seniority number(s), filing date(s) and country/countries, if relevant;



- in case of total the replacement, an indication to this effect;
- in case of partial replacement, the goods and services of the EUTM covered by the IR.

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

According to [Rule 21\(2\) of the Regulations under the Protocol](#), WIPO will record the indications notified under [paragraph \(1\)](#) of that Rule in the International Register. It will publish them and inform the holder to ensure that the relevant information on replacement is made available to third parties. Nevertheless, the EUIPO is under no obligation to communicate further changes affecting the replaced EUTM.

#### **4.4.4 Fees**

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

#### **4.4.5 Publication**

[Article 111\(3\)\(t\)](#) and [Article 116 EUTMR](#)

The replacement is entered in the EUTM Register and published in the [EUTM Bulletin](#) under Part C.3.7.

#### **4.4.6 Replacement and seniority**

[Article 4bis\(1\) MP](#)

Since replacement occurs ‘without prejudice to any rights acquired’ by virtue of the earlier registration, the EUIPO will include information on the seniority claims contained in the replaced EUTM registration within the content of the notification to be sent to WIPO under [Rule 21 of the Regulations under the Protocol](#).

#### **4.4.7 Replacement and transformation**

If an IR that replaces a direct EUTM is cancelled because of the basic mark’s ceasing of effect during the 5-year dependency period, and provided the conditions laid down by [Article 9quinquies of the MP](#) are met, the holder can request a transformation of the IR under [Article 9quinquies of the MP](#) while maintaining the effects of the EUTM replacement and its earlier date effects, including priority or seniority, if applicable.

#### 4.4.8 Replacement and conversion

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

## 5 Division

Articles [50](#) and [56](#) EUTMR

Articles [8](#) and [11](#) EUTMIR

[Rule 27bis of the Regulations under the Protocol](#)

### 5.1 Preliminary remarks

In October 2016 the Madrid Union Assembly adopted amendments to the [Regulations under the Protocol](#), including the introduction with effect from **1 February 2019** of a new [Rule 27bis](#) on the division of IRs. As from that date, IR holders have had the same option of dividing their marks as EUTM proprietors.

The divisional IR keeps the designation date and any priority date of the original IR. If seniority claims have been accepted by the EUIPO and are registered by WIPO in the original IR, there is no need to claim seniority again in the divisional IR.

### 5.2 Procedure

The request must be submitted to the EUIPO using WIPO official form [MM22](#) in the language of the IR.

All relevant fields of [MM22](#) must be filled in:

- the name of the Contracting Party of the Office presenting the request;
- the name of the Office presenting the request;
- the number of the international registration;
- the name of the holder;
- the names of the goods and services to be set apart, grouped in the appropriate classes of the International Classification of Goods and Services;
- the method of payment of the international fee, or instructions to debit the required amount from an account opened with the International Bureau, and the identity of the party effecting the payment or giving the instructions.

**In addition**, the list of goods and services to remain in the original registration must be indicated on an additional page.

The EUIPO will check that the request contains all these elements and examine whether the request complies with the requirements of Articles [50](#) and [56](#) EUTMR and Articles [8](#) and [11](#) EUTMIR.

For full details on division, see the Guidelines, [Part B, Examination, Section 1, Proceedings, Paragraph 5.4, Division of an EUTM application](#).

Once satisfied that the request is complete and complies with the relevant Regulations, the EUIPO forwards it to WIPO. If the request fulfils the requirements of [Rule 27bis of the Regulations under the Protocol](#), and once the international fee has been paid, WIPO will record the division, create the divisional IR in the International Register and notify the EUIPO accordingly.

The EUIPO will then create the divisional IR.

### **5.3 Fees**

The EUIPO will not charge any fee for examining requests for division of IRs.

However, requests are subject to an international fee of CHF 177, to be paid directly to WIPO. Any such fee paid by error to the EUIPO will be reimbursed.

Obsolete

Obsolete