

Information on Procedures before the Office of the designated Contracting party for Madrid Protocol Applicants

April 2017

		EU (EUIPO)
1. When filing an application: Points to be noted when filling an MM2 format		
1.1 Applicant (Item 2 of MM2)		
1.1.1	Points to be noted when writing information about an applicant (Item 2(a), (b) and (f) of MM2 or of any equivalent form or equivalent electronic form)	None
1.2 Claim of priority (Item 6 of MM2)		
1.2.1	Is partial priority allowed, which is a claim of priority based on part of a basic application? (Yes/No)	Yes
1.2.2	Are multiple priorities allowed, which is a claim of priority based on multiple basic applications? (Yes/No)	Yes
1.3 Mark (Item 7 to 9 of MM2)		
1.3.1	Category of marks which can be registered (e.g. collective mark, certification mark guarantee mark)	Collective marks are foreseen by the EUTM Regulation (EUTMR). Certification and guarantee marks are currently NOT foreseen by the EUTMR.
1.3.2	Are there certificates required according to category specified in Item 1.3.1? (Yes/No) If a required certificate exists, time and method of submission	Yes, for collective marks, the holder shall submit Regulations governing use of the mark directly to EUIPO within a period of two months from notification of the designation by the International Bureau (IB) (Article 67 EUTMR and Rule 121 Implementing Regulation (EUTMIR)).
1.3.3	Types of non-traditional trademarks that are eligible for registration (three-dimensional, sound,	3-D marks, sound marks, colour <i>per se</i> marks, position marks, tracer marks, animated marks (movement) and holograms are eligible for registration provided that they have distinctive character and that they can be represented graphically. Marks depicting a pattern are 'figurative' marks in accordance with EUIPO's practice. For position marks, movement marks, hologram marks and colour <i>per se</i> marks for more than one colour, a description of the mark is required to

	single color, position, trade dress, etc) and their requirements.	clarify the scope of protection. Olfactory marks are NOT eligible for registration, as they cannot be represented graphically (see Formalities guidelines) https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-B/02-part_b_examination_section_2_formalities/part_b_examination_section_2_formalities_en.pdf
1.3.4	Is description of a mark required? (Yes/No) If yes, examples of such a description	No, except for position marks, movement marks, colour <i>per se</i> marks for more than one colour and hologram marks.
1.3.5	What an applicant should do if he/she is required to provide a description of his/her mark in question, but such a description cannot be specified in a MM2 format?	Descriptions not appearing in the International Register cannot be added before EUIPO, as EUIPO does not administer a shadow register for International trade marks.
1.3.6	Is there a standard character system? (Yes/No) If yes, what characters belong to the system? (Item 7(c) of MM2)	Yes, Latin, Cyrillic and Greek characters.
1.3.7	Points to be noted for Item 8 of MM2 (COLOR CLAIMED)	None
1.3.8	Points to be noted for Item 9 of MM2 (MISCELLANEOUS INDICATIONS)	9 d), e) and g) must be filled in, when applicable.
1.4 Description of goods and services (Item 10 of MM2)		
1.4.1	Points to be noted for describing designated goods and services	EUIPO does not accept vague terms in the list of goods & services (see Classification guidelines) https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP/Part-B/03-part_b_examination_section_3_classification/part_b_examination_section_3_classification_en.pdf
1.4.2	A link to a website to verify whether indications of goods and services are acceptable to an Office	http://tmclass.tmdn.org/ec2/?lang=en
1.5 Declaration of intention to use marks		
1.5.1	Is a declaration of intention to use a mark in question	No

	required? (Yes/No) If required, how to submit such a declaration	
1.6 Additional features		
1.6.1	(If any [ex. Seniority])	The applicant may, when designating the EU in an international application or as a subsequent designation, claim the seniority of an earlier mark registered in an EU Member State. Such a claim must be presented by attaching form MM17 to the international application or subsequent designation request. No certificates or documents in support of the seniority claims should be attached. Alternatively, the IR holder may also claim the seniority of an earlier mark registered in an EU Member State directly before EUIPO upon publication of the final acceptance of the IR.
2. Procedures after a notification of the territorial extension is received at an Office of a Contracting Party		
2.1 Gazettes published by an Office		
2.1.1	Are gazettes published by an Office? (Yes/No)	Yes, the EUTM Bulletin.
2.1.2	If yes, what are included in gazettes?	Please see link to the “Vademecum” to the EUTM Bulletin at the following link: http://euipo.europa.eu/pdf/mark/vademecum-ctm-en.pdf
2.1.3	If yes, is there a link to a website?	https://euipo.europa.eu/eSearch/#advanced/bulletins (under ‘advanced search’ option, ‘Daily publication’)
2.2 Substantive examination		
2.2.1	Does an Office conduct substantive examination? (Yes/No)	Yes
2.2.2	If substantive examination is conducted, will there be an <i>ex officio</i> examination under i) absolute and ii) relative grounds for refusal be examined by <i>ex officio</i> ?	<i>Ex officio</i> examination is only conducted on absolute grounds during the registration procedure
2.2.3	Does an Office issue partial refusals?	Yes
2.2.4	Information on examination standards (a link to a website)	The different sections of the current trade mark practice on Absolute Grounds for refusal and EU collective marks can be found online at https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines , in Section 4.
2.3 Opposition		
2.3.1	i) A starting date and ii) a period to file an opposition	Oppositions may be filed against the IR between the first month and the fourth month following the date of first republication in the EUTM Bulletin.
2.3.2	Who can raise an opposition?	The proprietor of an earlier trade mark or its authorized licensee, and proprietors of earlier signs or rights pursuant to Article 8(4) and (4a) EUTMR, including persons authorized under national law or EU legislation.
2.3.3	Can an opposition be filed before or after a statement of grant of protection is sent? Such a statement is	No, after the issuance of the Statement of Grant of protection, only the invalidation of the effects of the IR is available based on an invalidity action or a counterclaim in infringement proceedings (Articles 53 and 158 EUTMR)

	based on Rule 18ter of the Common Regulations.	
2.4 Third party observations/ Information submission system		
2.4.1	Is there third party observations/ information submission system?	Yes
2.4.2	If yes, i) A starting date and ii) a period to submit observations/ Information?	Until the end of the opposition period and, if an opposition has been filed, as long as the opposition proceedings are open, but not beyond the 18-month time limit for notifying refusals to the IB.
2.4.3	If yes, Person who can submit observations/information?	Any natural or legal person (Article 40 EUTMR).
2.5 Notification of provisional refusal		
2.5.1	Languages used to notify a provisional refusal	The language of filing the International application notified by the IB will be used by EUIPO for issuing provisional refusals. It can be English, French or Spanish.
2.5.2	A period between a day when a notification of territorial extension was sent to an Office and a day when a notification of a provisional refusal is sent (12/18 months)	18 months
2.5.3	Is there a declaration made in accordance with Article 5(2)(c) of the Madrid Protocol? (Yes/No) Note: Notification of that such a provisional refusal may be notified based on opposition after the lapse of period of 18-month	No
2.5.4	An average processing time between a day when territorial extension is notified and a day when a First Office Action is made	15 days
2.5.5	i) A starting date, ii) a period and iii) an ending day of a time limit to respond to a notification of	i) The time limit starts on the day on which EUIPO issues the provisional refusal (Rule 112(1) EUTMIR). ii) Two months iii) Two months starting on the day following the notification of the provisional refusal letter. The time limit shall expire on the day of the relevant month having the same number. Where the time limit expires at the end of a month and where the relevant subsequent month has

	<p>a provisional refusal. Note: Examples of “i) a day on which the computation begins” are a day when an Office sent a notification of a provisional refusal; a day when the International Bureau sent a notification of a provisional refusal; and a day when a holder received a notification of a provisional refusal. Note: Examples of “iii) an ending day” are a day when a holder sent his/her response; and a day when an Office received a response.</p>	<p>no day with the same number, the period shall expire on the last day of that month (Rule 70 EUMIR). Any time limit will be deemed to expire at midnight on the final day, local time in Alicante (Spain).</p>
2.5.6	<p>Is it possible to extend a time limit to respond to a notification of a provisional refusal? (Yes/No) If yes, how long such a time limit can be extended, and how can such an extension be requested?</p>	<p>Yes, in principle for another two months. Under certain circumstances further extensions could be granted. The request must be made in writing before the expiry of the time limit. For more information see paragraph 4 of the Guidelines, Part A, General Rules, Section 1: Means of Communication and Time Limits: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-A/01-part_a_general_rules_section%201_means_of_communication_time_limits/part_a_general_rules_section%201_means_of_communication_time_limits_en.pdf</p>
2.5.7	<p>Is it always necessary to arrange a local representative when responding to a notification of a provisional refusal? (Yes/No)</p>	<p>Yes, unless the IR holder is located in the territory of the EEA.</p>
2.5.8	<p>Can a holder directly submit his/her response to an Office when responding to a notification of a provisional refusal? (Yes/No)</p>	<p>Yes, if he is located in the territory of the EEA.</p>

2.5.9	Can submitting a MM6 form to request a limitation be regarded as a domestic procedure for amendment? (Yes/No)	The IR holder should forward a copy of the MM6 that he has transmitted to the IB within the time limit for replying to the provisional refusal.
2.5.10	If a MM6 submission is regarded as a response to a provisional refusal, are there any points to be noted such as a time limit for submission? (For example, such points may include that a MM6 form must be filled and submitted to the IB within a time limit to respond to a notification of a provisional refusal, or that a notification of a limitation must be sent from the IB to an Office within a time limit of response.	Upon receipt of the copy of the MM6, the file will be put on hold until the limitation is recorded by the IB and notified to EUIPO.
2.6 Trial/Appeal against examiner's decision of refusal		
2.6.1	When can demand for an appeal against examiner's decision of refusal be made?	Within two months from notification of the refusal decision.
2.6.2	What is the competent authority for such appeal?	Boards of Appeal
2.6.3	Information on appeal against examiner's decision of refusal (a link to a website)	https://euipo.europa.eu/ohimportal/en/appeal
3. Procedures after confirmation of grant of protection in designated contracting parties		
3.1 Registration		
3.1.1	Other than a statement of grant of protection which is a notification based on Rule 18ter of the Common	No

	Regulations, is any notification of a decision of registration sent based on domestic laws? (Yes/No) If yes, to whom (a holder/an IB representative) will it be sent?	
3.1.2	i) Is a registration certificate automatically issued? (Yes/No) If yes, to whom (a holder/ an IB representative) will it be sent? ii) If a certificate is not issued automatically, is it possible to make a request so that a certificate will be issued? (Yes/No) If yes, how will it be requested?	i) No ii) No
3.1.3	Points to be noted for registration (For example, payment of fee)	None
3.1.4	Points to be noted for the purpose of maintaining the registration such as submitting a affidavits of continued use in commerce	The IR holder has to put into genuine use the mark within a period of five years following acceptance of the mark.
3.2 Replacement		
3.2.1	Does an Office require a request to operate procedure for 'taking note' of an international registration?	Yes
3.2.2	Timing when a request to operate procedure for 'taking note' of an international registration is allowed (while an	At any time after notification of the EU designation by the IB.

	application being processed, post-registration, etc.)	
3.2.3	Does it cost to “take note”?	No, it is free of charge.
3.2.4	When will it be decided to replace a registration in question?	The replacement is entered into the EUTM Register and published in the EUTM Bulletin. In parallel, the IB will be informed and will publish it in the Gazette.
3.2.5	Can a replaced national registration and an international registration coexist?	Yes
4. Others		
4.1 Trial/Appeal for invalidation		
4.1.1	Time period for filing an invalidation	An application for invalidity may be filed at any time once the Grant of Protection has been issued.
4.1.2	Person who can demand a trial/appeal for invalidation	An invalidity based on absolute grounds for refusal may be filed by any natural or legal person. An invalidity based on relative grounds for refusal may be filed by the right holder or licensee or as determined by the applicable national law. There are more earlier rights on the basis of which an invalidity proceeding may be launched than in opposition proceedings. An invalidity action may also be invoked as a counterclaim in an infringement procedure.
4.1.3	What is the competent authority for such trial/appeal?	The invalidity may be requested directly before EUIPO. In case of an invalidity request made as a counterclaim in an infringement procedure, the EUTM Court which deals with the infringement proceeding will be the competent authority.
4.1.4	Procedure relating to a trial/appeal for invalidation (a link to a website)	Once admissible, the adversarial stage of the proceedings begins which consists of the exchange of observations between the parties. After the end of the proceedings the Cancellation Division issues the First instance decision which may be appealed before the Board of Appeal. For more detailed information on the Cancellation process (invalidity) please see the Guidelines ‘Part D’: Section 1: Cancellation Proceedings https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-D/01-part_d_cancellation_section_1_proceedings/part_d_cancellation_section_1_proceedings_en.pdf Section 2: Substantive Provisions https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-D/02-part_d_cancellation_section_2_substantive_provisions/part_d%20cancellation_section_2_substantive_provisions_en.pdf
4.2 Trial/Appeal for cancellation of registered trademark not in use		
4.2.1	Time period for filing a non-use cancellation	An application for revocation based on non-use may be filed only after five years from the publication of the acceptance of IR.
4.2.2	Person who can demand a	Any natural/legal person.

	trial/appeal for cancellation of registered trademark not in use	
4.2.3	What is the competent authority for such trial/appeal?	EUIPO, or in case of a revocation made as a counterclaim in an infringement procedure the EUTM Court which deals with the infringement proceeding will be the competent authority.
4.2.4	Procedure relating to a trial/appeal for cancellation of registered trademark not in use (a link to a website)	Once admissible, the adversarial stage of the proceedings begins which consists of the exchange of observations between the parties. After the end of the proceedings the Cancellation Division issues the First instance decision which may be appealed before the Board of Appeal. For more detailed information on the Cancellation process (revocation) please see the Guidelines 'Part D': Section 1: Cancellation Proceedings https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-D/01-part_d_cancellation_section_1_proceedings/part_d_cancellation_section_1_proceedings_en.pdf Section 2: Substantive Provisions https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-D/02-part_d_cancellation_section_2_substantive_provisions/part_d%20cancellation_section_2_substantive_provisions_en.pdf
4.3 Trial/Appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee		
4.3.1	Time period for filing an unfair use cancellation	There is only a procedure for revocation for misleading use.
4.3.2	Person who can demand a trial/appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee	Any natural/legal person
4.3.3	What is the competent authority for such trial/appeal?	EUIPO or in case of a counterclaim in an infringement procedure the EUTM Court which deals with the infringement proceeding will be the competent authority.
4.3.4	Procedure relating to a trial/appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee	With the valid request begins the contradictory procedure with the exchange between the parties. After the end of the proceedings the Cancellation Division issues the First instance decision which may be appealed before the Board of Appeal.
4.4 Other information relating to a trial/appeal		
4.4.1	Other information relating to a trial/appeal	
4.5 Invalidation of the effects of an international registration in part or in whole		
4.5.1	Where the effects of an	As soon as the decision is final.

	international registration in a designated Contracting Party are cancelled in part or in whole because of a trial/appeal for invalidation etc, the timing when a notification of invalidation per Rule 19 of the Common Regulations will be sent to the International Bureau	
4.6 Transformation of an international registration into national or regional applications under Article 9quinquies of Madrid Protocol		
4.6.1	Points to be noted for transformation (If any) An amount of a fee if such a fee needs to be paid	Following the cancellation in whole or in part of an IR designating the EU at the request of the office of origin under Article 9quinquies Madrid Protocol, the holder may file a ‘direct’ EUTM application for the same mark and the same goods and services as the cancelled mark. This transformation may be filed within three months from the recordal by the IB of the cancellation at the request of the Office of origin. The fee is the normal filing fee for a new EUTM application. If the EU designation under the cancelled IR had already been accepted by EUIPO when the cancellation occurs, the new EUTM resulting from the transformation will not be reexamined again nor will it be published for opposition purposes. The date of the original EU designation will not become the filing date of the new EUTM application, however it will be the date that determines the ‘earlier right effect’ of the EUTM for the purposes of inter partes proceedings (oppositions, cancellations), etc.
4.7 Additional features		
4.7.1	(If any [ex. Conversion])	The option of conversion allows an EU designation through an IR to be converted into a national trade mark application, just like for a direct EUTM. Where the EU designation has been refused or ceases to have effect, it may be converted into national trademark applications in the EU Member States or designations of Member States party to the Madrid Protocol enjoying the date of designation of the EU or the date of priority, if any (Article 159 EUTMR).
5. Madrid Protocol declarations		
5.1	Article 5(2)(b) of the Protocol (extension to 18 months of the refusal period) (Yes/No)	Yes
5.2	Article 5(2)(c) of the Protocol (possible notification of refusals based on an opposition after the 18-month time limit) (Yes/No)	No
5.3	Article 8(7)(a) of the Protocol (individual fees) (Yes/No)	Yes
5.4	Article 9quater of the	No

	Agreement and that of the Protocol (Common Office of several Contracting States) (Yes/No)	
5.5	Article 14(2)(d) of the Agreement (in respect of international registrations effected under the Agreement prior to the date of accession of the Contracting Party concerned, no subsequent designation) (Yes/No)	No
5.6	Article 14(5) of the Protocol (in respect of international registrations effected under the Protocol prior to the date of accession of the Contracting Party concerned, no subsequent designation) (Yes/No)	No
5.7	Rule 7(2) of the Common Regulations (declaration of intention to use the mark) (Yes/No)	No
5.8	Rule 17(5)(d) of the Common Regulations (notwithstanding the fact that all procedures before the Office may not have been completed, notification to the International Bureau by the Office of decisions concerning refusals) (Yes/No)	No
5.9	Rule 17(5)(e) of the Common Regulations (<i>ex officio</i> provisional refusals)	No

	not open to review before the Office) (Yes/No)	
5.10	Rule 20bis(6)(a) of the Common Regulations (recording of licenses not provided for in the domestic law, so that the recording of licenses in the International Register has no effect) (Yes/No)	No
5.11	Rule 20bis(6)(b) of the Common Regulations (recording of licenses provided for in the domestic law, but the recording of licenses in the International Register has no effect) (Yes/No)	No
5.12	Rule 34(2)(b) of the Common Regulations (the Office accepts to collect and forward fees to the International Bureau) (Yes/No)	No
5.13	Rule 34(3)(a) of the Common Regulations (individual fee payable in two parts) (Yes/No)	No