



Promoting Intellectual
Property Rights in the
ASEAN Region

THE MADRID PROTOCOL

Protecting your trademarks in the European Union

ERNESTO RUBIO | 6 APRIL 2021



Funded by the European Union



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

EUROPEAN UNION

27 Member States

450 million inhabitants



An attractive market for Malaysian exports ...

... where many companies wish to get TM protection

PROTECTING YOUR MARK IN THE EUROPEAN UNION

A four-tier system for trademark protection in the EU

- National route – at the IPOs of 24 Member States –> national TM
- Benelux route – at the Benelux IP Office (BE, NL, LU) –> BX TM
- European route – at the EUIPO –> EUTM - valid in the whole EU
- International route – through the Madrid system –> IR
which can designate for protection any of the above

DESIGNATING THE EUROPEAN UNION UNDER THE MADRID SYSTEM

1/2

As a national of Malaysia, you can designate the European Union

- in your international application (MM2)



EUROPEAN UNION designation in the International Application form **MM2**, item 11

11. DESIGNATIONS¹⁴

Check the corresponding boxes:

- | | | | |
|--|---|---|---|
| <input type="checkbox"/> AF Afghanistan | <input type="checkbox"/> DZ Algeria | <input type="checkbox"/> KZ Kazakhstan | <input type="checkbox"/> RO Romania |
| <input type="checkbox"/> AG Antigua and Barbuda | <input type="checkbox"/> EE Estonia | <input type="checkbox"/> LA Lao People's Democratic Republic | <input type="checkbox"/> RS Serbia |
| <input type="checkbox"/> AL Albania | <input checked="" type="checkbox"/> EM European Union ^a | <input type="checkbox"/> LI Liechtenstein | <input type="checkbox"/> RU Russian Federation |
| <input type="checkbox"/> AM Armenia | <input type="checkbox"/> ES Spain | <input type="checkbox"/> LR Liberia | <input type="checkbox"/> RW Rwanda |
| <input type="checkbox"/> AT Austria | <input type="checkbox"/> FI Finland | <input type="checkbox"/> LS Lesotho ^b | <input type="checkbox"/> SD Sudan |
| <input type="checkbox"/> AU Australia | <input type="checkbox"/> FR France | <input type="checkbox"/> LT Lithuania | <input type="checkbox"/> SE Sweden |
| <input type="checkbox"/> AZ Azerbaijan | | | <input type="checkbox"/> SG Singapore ^b |

DESIGNATING THE EUROPEAN UNION UNDER THE MADRID SYSTEM

2/2

You can also designate the European Union

- in a subsequent designation (MM4)



EUROPEAN UNION designation as a subsequent designation form **MM4**, item 4

4. DESIGNATIONS⁶

Check the corresponding boxes:

- | | | | |
|--|---|---|---|
| <input type="checkbox"/> AF Afghanistan | <input type="checkbox"/> DZ Algeria | <input type="checkbox"/> KZ Kazakhstan | <input type="checkbox"/> RO Romania |
| <input type="checkbox"/> AG Antigua and Barbuda | <input type="checkbox"/> EE Estonia ^h | <input type="checkbox"/> LA Lao People's Democratic Republic | <input type="checkbox"/> RS Serbia |
| <input type="checkbox"/> AL Albania | <input checked="" type="checkbox"/> EM European Union ^a | <input type="checkbox"/> LI Liechtenstein | <input type="checkbox"/> RU Russian Federation |
| <input type="checkbox"/> AM Armenia | <input type="checkbox"/> ES Spain | <input type="checkbox"/> LR Liberia | <input type="checkbox"/> RW Rwanda |
| <input type="checkbox"/> AT Austria | <input type="checkbox"/> FI Finland | <input type="checkbox"/> LS Lesotho ^b | <input type="checkbox"/> SD Sudan |
| <input type="checkbox"/> AU Australia | <input type="checkbox"/> FR France | <input type="checkbox"/> LT Lithuania | <input type="checkbox"/> SE Sweden |
| <input type="checkbox"/> AZ Azerbaijan | | | <input type="checkbox"/> SG Singapore ^b |

EUROPEAN UNION – DESIGNATION SPECIFIC REQUIREMENTS

Whenever you designate the EU – **two specific requirements**

- **second EUIPO language for certain proceedings (mandatory)**
 - in **MM2** or **MM4** you must indicate: French, German, Italian or Spanish
 - in proceedings with the EUIPO you will in principle use: **English**
 - for opposition, revocation, invalidation (English or 2nd EUIPO language)
- **seniority claim form (optional)**
 - if you wish to claim **seniority** ...
 - along with the EU designation (in your IA or SD) – **MM17**
 - at a later date, directly at the EUIPO

EUROPEAN UNION – DESIGNATION AND RENEWAL FEES

European Union – Designation and renewal fees

- For the first class of goods or services CHF 897
- For the second class CHF 55
- For each additional class CHF 164

Where the mark is a collective or certification mark

- For the first class of goods or services CHF 1531
- For the second class CHF 55
- For each additional class CHF 164

FIRST REPUBLICATION, SEARCHES

Once your EU designation is registered at WIPO, WIPO will notify EUIPO

- EUIPO will then republish the IR in the EUTM Bulletin (Part M.1)
- an opposition period will run as from the date of that republication

Possible searches

- within one month of WIPO's notification, you may ask the EUIPO to draw up a search report citing similar EUTMs and IRs designating the EU
- even earlier, you may do your own searches for similar trademarks in the European Union by consulting TMview at <https://www.tmdn.org/tmview/#/tmview>

FORMALITIES EXAMINATION

EUIPO will then examine certain formalities, to check whether

- you have indicated a second language for the proceedings
- you have given all the required data in the **MM17** form, if you claim seniority
- all the g&s in your EU designation fall within the scope of the IR's main list
- all the terms used to indicate g&s meet the EUIPO requirements for clarity and precision -> **TIP: check TMclass** <https://euipo.europa.eu/ec2/>

If your IR is for a **collective or certification mark**, the EUIPO will ask you to submit the regulations within two months

If any of those formalities is not complied with, EUIPO will issue a **provisional refusal** and will ask you to remedy the deficiency within 2 months.

If everything is OK, EUIPO will proceed to **substantive examination**

PROFESSIONAL REPRESENTATION

In principle, you will not need to appoint a representative, unless

- the EUIPO issues a provisional refusal of your IR, or
- for filing a seniority claim directly before the EUIPO

In such cases, because of being located outside the European Economic Area, you will be required to appoint a representative who should be a person who appears in the database of representatives maintained by the EUIPO

<https://euipo.europa.eu/eSearch/#advanced/representatives>

EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL

1/2

As soon as the formality check is completed → substantive examination

EUTM Regulation Art. 7(1) – Your mark will be refused if it ...

- does not conform to the EUTM definition
- is non-distinctive
- is descriptive
- is generic
- is functional
- is contrary to public policy or morality
- is deceptive
- is in conflict with flags and other symbols
- is in conflict with DOs, GI, traditional terms for wines, traditional specialities guaranteed, earlier plant variety denominations

EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL

2/2

Once the substantive examination has been completed → EUIPO will issue the relevant notification which may be ...

- **A provisional refusal** – if the sign of your IR is non-eligible for protection

EUIPO will give you two months to submit observations. You may ask for re-examination. EUIPO may decide to confirm the refusal or waive the objection

or

- **An interim status of the mark** – if your mark is eligible for protection

EUIPO will send this notification to WIPO indicating that the *ex officio* examination has been completed but the IR is still open to opposition or third-party observations

OPPOSITION

Any person invoking earlier rights in conflict with your mark may file an **opposition** (between the first and fourth months following the republication)

If someone opposes your IR

- EUIPO will send a notification to WIPO of **provisional refusal based on opposition** and will send you copy of the notice of opposition
- EUIPO will also notify you of the time limit for commencement of the proceedings

In communications with WIPO, EUIPO will use **English** in your case

In communications sent directly to you, EUIPO will use the language of the opposition proceedings chosen by the opponent (which may be **English, or the second language** you have chosen when designating the EU)

AFTER EXPIRY OF OPPOSITION PERIOD

Statement of Grant of Protection

If the formal and substantive examination of your IR were OK and nobody has filed an opposition, EUIPO will issue a statement of grant of protection

If the EUIPO has issued a provisional refusal ...

... the EUIPO will take a **final decision** once all the procedures have been completed

- a confirmation of refusal, or
- a statement of grant of protection following a refusal

EUIPO will specify for which goods and services your mark is accepted

SECOND REPUBLICATION AND PROTECTION IN THE EUROPEAN UNION

Second republication

If your mark becomes protected in the EU (at least in part), EUIPO will republish again your IR (this time in Part M.3 of the EUTM Bulletin).

Protection of your IR in the European Union

- from the date of its second republication, your IR will have the same effects as a registered EUTM; and will be valid in the EU as long as it is renewed
- your rights may be invoked against any infringer in the EU
- you must simply make sure that you put your mark to genuine use in the EU within a five-year period from republication, or you may risk revocation

CONVERSION

If your designation of the EU is withdrawn, refused or ceases to have effect, you may request its conversion

- into a national application filed at the IP Office of any EU Member State, or
- into a subsequent designation of any such State under the Madrid system

keeping the same date of the EU designation in the International Register

If you choose to make a subsequent designation resulting from conversion ...

... the subsequent designation must be forwarded to WIPO through the EUIPO in an official form (MM16) within three months from the date where the EU designation has been refused, or withdrawn, or has ceased to have effect

TRANSFORMATION

If your IR is cancelled because your basic mark in MY has ceased to have effect within the 5-year dependency period, and your IR is still effective in the EU ...

... you may request its transformation into a EUTM for the same goods and services, keeping the date of the original designation of the EU and the same priority, if any

Transformation procedure

- Your EUTM application based on transformation should be filed within three months from the IR cancellation date
- The g&s in the EUTM application should be covered by those in your IR designation of the EU

CONCLUSION

The Madrid System offers you a very user-friendly and cost-effective route to obtain and maintain protection for your mark in the European Union

- you will be able to seek protection in the EU by simply ticking the EM box when you file your IA at MyIPO or when you submit a SD at WIPO
- as soon as your IR is accepted by the EUIPO, you will be able to enforce your TM rights anywhere in the EU
- you will be able to renew your TM rights in the EU every 10 years by simply sending an online communication to WIPO and paying the required fees
- you will gain brand presence in the EU and generate goodwill for your mark, possibly opening franchising or partnership opportunities



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THANK YOU!
ANY QUESTIONS?



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