Implementation of Madrid Protocol at EUIPO

Patricia López | Alicante | 16 November 2021
Best practice sharing - Operation and Challenges
Tips in designating the EU

EUIPO as Office of Origin
EUIPO as designated Office
Tool

- Evolution of IT system:
  All rights together. From different databases, now one single database with different modules for each entity:
  
  - EUTMs, international applications, subsequent designations and for EU designations

- Communication with other satellite systems (Fees Management, Correspondence Tool, Appeals Tool, Publications Tool, etc.)

- Automatic detection of ceasings of effects of basic marks for international applications
Communication with WIPO

- Nearly integral transfer of data and communications to and from WIPO through MECA XML (except some less frequent transactions transmitted via Madrid Office Portal)

- International applications transmitted electronically to WIPO since Day 1 (no application form attached)

- Content of designations, as well as other communications from WIPO (limitations, renunciations, corrections, changes of name, etc.) downloaded from WIPO platform weekly (transactions)
Templates

- Letters attached to electronic transactions to WIPO (correction requests, ceasings of effects notifications, replies to irregularities, etc.)

- Communications to applicants
  → templates for IAs in all EU languages
EUIPO has developed its own e-filing for International applications in 2017.
Staff - Examination area

- 11 part-time examiners
- Theoretical training on the particularities of Madrid System and on-the-job training with coach
- Profile: good understanding of Nice classification, appropriate linguistic profile (EN/DE/FR/ES/IT/NL)
- Assets: motivated, responsible, precise, able to work under time pressure, good team spirit
Deadlines

- Time limit for deficiencies: one month in order to respect as far possible the two-month time limit for certification

- Deadlines are monitored by each examiner through tasks and further controlled by managers through daily reports
WIPO irregularities

- On fees (for the applicant to solve)
- On classification/list of goods and services, the EUIPO does not make use of the faculty to express a different opinion or to make proposals
  → applicants’ proposals forwarded as received to WIPO
9-month deadline for corrections of errors made by Office of origin (from date of publication of the erroneous entry in the International Register)
Post-registration

- Detection of ceasings of effect by tracking changes to final statuses of basic EUTM(s) (refused/withdrawn/expired, etc) and of new versions of list of Goods and Services, as well as ongoing actions at the end of the 5 years dependency
  - notification to WIPO
Post-registration

- Transmission to WIPO of change requests affecting the international registration submitted through our Office as Office of Origin (changes of ownership, renunciations, limitations, etc.)
  
  ➔ Forms uploaded through Madrid Office Portal
EUIPO as DESIGNATED OFFICE

Protection in all EU Member States

Work Programme: 30,526 IRs in 2021
Examination of formal requirements/limited lists/vague terms: 16 part-time examiners

Objections on absolute grounds for refusal: 22 part-time examiners

Wipo incoming manual transactions and manual Grants of Protection: 7 examiners

Opposition proceedings: 8 examiners

Cancellation proceedings: 5 examiners

Opposition and cancellation decisions: all examiners taking decisions on relative grounds

Finance examiners
Experienced examiners fully familiar with Office of origin work also deal with the treatment of incoming and outgoing manual transactions for designations, give assistance to substance examiners and attend internal/external queries (mailbox).

Substance examination performed by selected examiners after a basic training on the particularities of Madrid system.
Weekly download of XML files directly imported into our back office
No national number allocated to the IRs meaning that they do no form part of our Register (WIPO administers the International Register).

Designations identified by IR No. preceded by W0 for a first designation, W1 for a subsequent designation, etc. (ex.: W01194708 / W10868220)
System tasks

Automatic pre-publication check

Publication in our Bulletin

- Type of mark
- Second Language
- Limitation for EU
Provisional refusals

- Time limit: two months from issuance of the provisional refusal by EUIPO.
- Extension of time limit and continuation of proceedings possible (similarly to direct EUTMs).
Professional representation

- Appointment of representative (complying with Art. 120 EUTMR) required only in case of provisional refusal. Representative before WIPO appointed in a file, if included in EUIPO representative database, shall become automatically representative before EUIPO.

- Where no reply is received in case of partial *ex officio* provisional refusal and therefore no representative has been appointed, only the goods and services object of the partial provisional refusal will be finally refused.
Relative grounds

- No examination ex-officio of relative grounds
- Three-month opposition period open to owners of earlier rights
- No declaration under Art. 5(2)(c) of the Protocol
- Opposition procedure suspended if ex-officio provisional refusal also issued
Limitation or renunciation

- Limitations must be requested before WIPO or can be submitted directly with EUIPO in reply to a provisional refusal.
- Renunciation of the EU designation must be filed through Wipo (no direct withdrawal).
IR granted

All accepted designations are republished in part M.3 of our Bulletin >> starting point of the five years use period from which the registration may be invoked against an infringer.
Grant of protection

- If no *ex officio* refusal issued and no opposition received
  → Statement of Grant of Protection sent **automatically** to WIPO
    (no certificate of registration)

- If one or more provisional refusals issued,
  → Final decision of total refusal sent **manually** to WIPO, **OR**
  → Statement of Grant of Protection sent **manually** to WIPO (total/partial)
    once all proceedings are completed and appeals exhausted.
Transformation

- Central attack
- 3 months from WIPO recording the (partial) cancellation of the IR at the request of the Office of origin

by filing a new EUTM application claiming the transformation right
Automatic transactions

Automatic update of files

- Renunciations / Cancellations / Non-renewals
- Renewals
- Change of names - transfers
EUIPO receives more than 3000 every year all together

Examination of limitations → Declaration that limitation has no effect
Invalidation

- Revocation applications before the Office
- Invalidity applications based on absolute grounds before the Office
- Invalidity applications based on relative grounds before the Office
- or on the basis of a counterclaim in infringement proceedings

- Notification to WIPO, once procedure is final and total/partial invalidation is confirmed
Thank you