



Promoting Intellectual  
Property Rights in the  
ASEAN Region

# Implementation of Madrid Protocol at EUIPO

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Funded by the European Union



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# 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

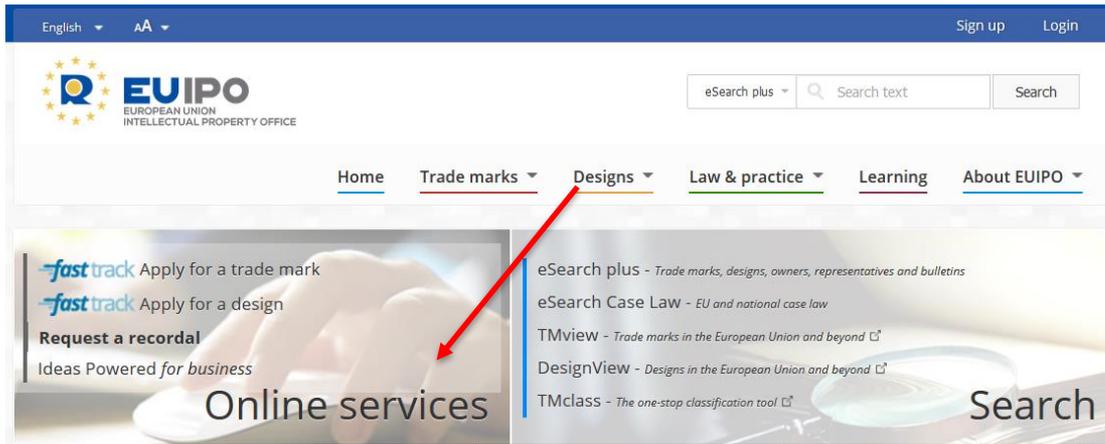
- Nearly integral transfer of data and communications to and from WIPO through MECA XML (except some less frequent transactions transmitted via Madrid Office Portal)
- International applications transmitted electronically to WIPO since Day 1 (no application form attached)
- Content of designations, as 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

## International applications – IA e-filing

EUIPO has developed its own e-filing for International applications in 2017



The screenshot shows the EUIPO website interface. At the top, there is a navigation bar with 'English' and 'AA' on the left, and 'Sign up' and 'Login' on the right. Below this is the EUIPO logo and a search bar labeled 'eSearch plus' with a search text input and a 'Search' button. A horizontal menu contains 'Home', 'Trade marks', 'Designs', 'Law & practice', 'Learning', and 'About EUIPO'. The 'Designs' menu item is highlighted with a red arrow. Below the menu, there is a 'fast track' section with links to 'Apply for a trade mark' and 'Apply for a design', and a 'Request a recordal' link. A large 'Online services' banner is visible at the bottom left. On the right side, there is a list of services: 'eSearch plus - Trade marks, designs, owners, representatives and bulletins', 'eSearch Case Law - EU and national case law', 'TMview - Trade marks in the European Union and beyond', 'DesignView - Designs in the European Union and beyond', and 'TMclass - The one-stop classification tool'. A 'Search' button is located at the bottom right of this list.

File an **International Trade mark Application** based on **EUTM/A(s)**

**Apply online**



## 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

## Post-registration

**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

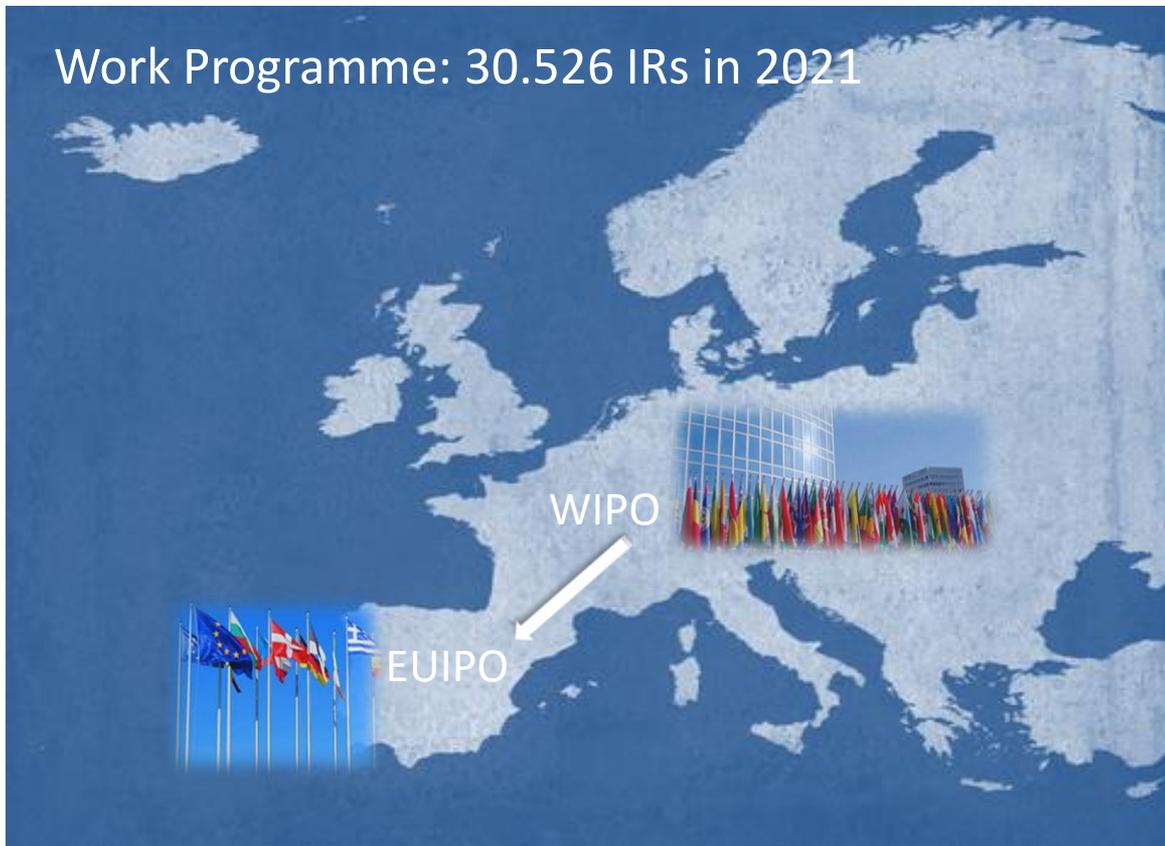
## Post-registration

- 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



## Staff

- 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

## Staff

- 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

## WIPO batches



Weekly download of XML files directly imported into our back office

## Numbering of files

- No national number allocated to the IRs meaning that they do not 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.: **W0**1194708 / **W1**0868220)

## 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.

	EUTM 0612396	Part M.3.1
M.3.		
M.3.1.	111 1508386	
	460 09/01/2020	
	400 10/01/2020 - 2020/005 - M.1	
	450 11/12/2020	

### Bulletins download

Type

EUTM

Year

2020

Number

2020/237 - 11/12/2020

Language

English

Download bulletin

Download index

## 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

## Limitations – Total/Partial cancellations – Total/Partial ceasings of effect

- 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

# QUESTIONS





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THANK YOU



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