COMMISSION REGULATION (EC) No 782/2004

of 26 April 2004

amending Regulation (EC) No 2868/95 the accession of the European Community to the Madrid Protocol

(Text with EEA relevance)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [1], and in particular Article 158 thereof,

Whereas:

(1) Following the Council Decision approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27 June 1989 (hereinafter 'Madrid Protocol') [2], it is necessary to adopt technical measures to implement Council Regulation (EC) No 1992/2003 of 27 October 2003 amending Regulation (EC) No 40/94 on the Community trade mark [3].

(2) Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark [4] should therefore be amended according.

(3) The measures provided for in this Regulation are in accordance with the opinion of the Committee on fees, Implementation Rules and the Procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (trade mark and designs),

HAS ADOPTED THIS REGULATION:

Article 1

Article 1 of Regulation (EC) No 2868/95 is amended as follows:

1. In Rule 12 a new subparagraph (m) are added:

'(m) where applicable, a statement that the application results from a transformation of an international registration designating the European Community pursuant to Article 156 of the Regulation, together with the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date on which the territorial extension to the European Community made subsequently to the international registration pursuant to Article 3 ter (2) of the Madrid Protocol was recorded and, where applicable, the date of priority of the international registration.'

2. Rule 84 shall be amended as follows:

(a) In paragraph 2, a new subparagraph (p) is added:

'(p) a statement that the application results from a transformation of an international registration designating the European Community pursuant to Article 156 of the Regulation, together with the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date on which the territorial extension to the European Community made subsequently to the international registration pursuant to Article 3 ter (2) of the Madrid Protocol was recorded and, where applicable, the date of priority of the international registration.'

(b) In paragraph 3, the new subparagraphs (t), (u) and (v) are added:

'(t) the replacement of the Community trade mark by an international registration pursuant to Article 152 of the Regulation;

(u) the date and number of an international registration based on the Community trade mark application which has been registered as a Community trade mark pursuant to Article 143(1) of the Regulation;

(v) the date and number of an international registration based on the Community trade mark pursuant to Article 143(2) of the Regulation.'

3. In Rule 89 a new paragraph 6 is added:

'The files kept by the Office relating to international registrations designating the European Community may be inspected on request as from the date of publication referred to in Article 147(1) of the Regulation, under the conditions laid down in paragraphs (1), (3) and (4) and subject to Rule 88.'

[1] OJ L 11 of 14.1.1994, p. 1.
[2] OJ L 296, 14.11.2003, p. 20.
[3] OJ L 296, 14.11.2003, p. 1.
[4] OJ L 303, 15.12.1995, p. 1.

4. The following Title XIII is added:

'TITLE XIII

PROCEDURES CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Part a

International registration on the basis of applications for a community trade mark and of community trade marks

Rule 102

Filing of an international application

1. The form provided by the Office for the filing of an international application, as referred to in Article 142(1) of the Regulation, shall be an adaptation of the official form provided by the International Bureau of the World Intellectual Property Organisation (hereinafter "the International Bureau") having the same format but including such additional indications and elements as are required or may be appropriate pursuant to these Rules. Applicants may also use the official form provided by the International Bureau.

2. Paragraph 1 shall apply *mutatis mutandis* for the form for a request for territorial extension subsequent to the international registration pursuant to Article 144 of the Regulation.

3. The Office shall inform the applicant filing the international application of the date on which the documents making up the international application are received by the Office.

4. Where the international application is filed in an official language of the European Community other than a language allowed under the Madrid Protocol for the filing of an international application and where the international application does not contain, or is not accompanied by, a translation of the list of goods and services and of any other text matter forming part of the international application in the language in which the application is to be submitted to the International Bureau pursuant to Article 142(2) of the Regulation, the applicant shall authorise the Office to include in the international application a translation of the said list of goods and services and other text matter in the language in which the application is to be submitted to the International Bureau pursuant to Article 142(2) of the Regulation. Where the translation has not yet been established in the course of the registration procedure for the Community trade mark application on which the international application is based, the Office shall without delay arrange for the translation.

Rule 103

Examination of international applications

1. Where the Office receives an international application and the fee referred to in Article 142(5) of the Regulation for the international application has not been paid, the Office shall inform the applicant that the international application will be deemed not to have been filed until the fee has been paid.

2. Where the examination of the international application reveals any of the following deficiencies, the Office shall invite the applicant to remedy those deficiencies within such period as it may specify:

(a) the international application is not filed on one of the forms referred to in Rule 102(1), and does not contain all the indications and information required by that form;

(b) the list of goods and services contained in the international application is not covered by the list of goods and services appearing in the basic Community trade mark application or basic Community trade mark;

(c) the mark which is subject to the international application is not identical to the mark as appearing in the basic Community trade mark application or basic Community trade mark;

(d) any indication in the international application as to the mark, other than a disclaimer pursuant to Article 38(2) of the Regulation or a colour claim, does not also appear in the basic Community trade mark application or basic Community trade mark;

(e) if colour is claimed in the international application as a distinctive feature of the mark, the basic Community trade mark application or basic Community trade mark is not in the same colour or colours; or

(f) according to the indications made in the international form, the applicant is not eligible to file an international application through the Office in accordance with Article 2(1)(ii) of the Madrid Protocol,

3. Where the applicant has failed to authorise the Office to include a translation as provided for in Rule 102(4), or where it is otherwise unclear on which list of goods and services the international application shall be based, the Office shall invite the applicant to make the required indications within such a period as it may specify.

4. If the deficiencies referred to in paragraph 2 are not remedied or the required indications referred to in paragraph 3 are not made within the time limit fixed by the Office, the Office will take a decision refusing to forward the international application to the International Bureau.

Rule 104

Forwarding of the international application

The Office shall forward the international application to the International Bureau along with the certification provided for under Article 3(1) of the Madrid Protocol as soon as the international application meets the requirements laid down in Rules 102 and 103 as well as in Articles 141 and 142 of the Regulation.

Rule 105

Subsequent designations

1. The Office shall invite the applicant requesting the territorial extension subsequent to the international registration, as referred to in Article 144 of the Regulation, to remedy any of the following deficiencies within such time limit as it may specify:

(a) the request for territorial extension is not filed on one of the form referred to Rule 102(1) and (2) and does not contain all the indications and information required by that form;

(b) the request for territorial extension does not indicate the number of the international registration to which it relates;

(c) the list of goods and services is not covered by the list of goods and services contained in the international registration; or

(d) according to the indications made in the international form, the applicant requesting the territorial extension is not entitled to make a designation subsequent to the international registration through the Office in accordance with Articles 2(1)(ii) and Article 3 ter (2) of the Madrid Protocol,

2. If the deficiencies referred to in paragraph 1 are not remedied within the time limit fixed by the Office, the Office will take a decision refusing to forward the request for territorial extension made subsequently to the international registration to the International Bureau.

3. The Office shall inform the applicant requesting the territorial extension of the date on which the request for territorial extension is received by the Office.

4. The Office shall forward the request for territorial extension made subsequently to the international registration to the International Bureau as soon as the deficiencies referred to in paragraph 1 of this Rule have been remedied and the requirements of Article 144 of the Regulation are complied with.

Rule 106

Dependence of the international registration on the basic application or registration

1. The Office shall notify the International Bureau where, within a period of five years from the date of the international registration,

(a) the Community trade mark application on which the international registration was based has been withdrawn, is deemed to be withdrawn or has been refused by a final decision;

(b) the Community trade mark on which the international registration was based has ceased to have effect because it is surrendered, has not been renewed, has been revoked, or has been declared invalid by the Office by a final decision or, on the basis of a counterclaim in infringement proceedings, by a Community trade mark court;

(c) the Community trade mark application or the Community trade mark on which the international registration was based has been divided into two applications or registrations,

2. The notification referred to in paragraph 1 shall include:

(a) the number of the international registration;

(b) the name of the holder of the international registration;

(c) the facts and decisions affecting the basic application or registration, as well as the effective date of those facts and decisions;

(d) in the case referred to in paragraph 1(a) or (b), the request to cancel the international registration;

(e) where the act referred to in paragraph 1(a) or (b) affects the basic application or basic registration only with respect to some of the goods and services, those goods and services, or the goods and services which are not affected;

(f) in the case referred to in paragraph 1(c), the number of each Community trade mark application or registration concerned.

3. The Office shall notify the International Bureau where, at the end of a period of five years from the date of the international registration,

(a) an appeal is pending against a decision of an examiner to refuse the Community trade mark application on which the international registration was based pursuant to Article 38 of the Regulation;

(b) an opposition is pending against the Community trade mark application on which the international registration was based;

(c) an application for revocation or an application for declaration of invalidity is pending against the Community trade mark on which the international registration was based;

(d) mention has been made in the Register of Community Trade Marks that a counterclaim for revocation or for declaration of invalidity has been filed before a Community trade mark court against the Community trade mark on which the international registration was based, but no mention has yet been made in the Register of the decision of the Community trade mark court on the counterclaim;

4. Once the proceedings referred to in paragraph 3 have been concluded by means of a final decision or an entry in the register, the Office shall notify the International Bureau accordingly with paragraph 2.

5. Any reference in paragraphs 1 and 3 to a Community trade mark on which the international registration was based shall include a Community trade mark registration resulting from a Community trade mark application on which the international application was based.

Rule 107

Renewals

The international registration shall be renewed directly at the International Bureau.

Part b

International registrations designating the European Community

Rule 108

Seniority claimed in an international application

1. Where the seniority of one or more earlier registered trade marks, as referred to in Article 34 of the Regulation, has been claimed in an international application pursuant to Article 148(1) of the Regulation, the holder shall, within three months from the date on which the International Bureau notifies the international registration to the Office, submit a copy of the relevant registration to the Office. The copy must be certified by the competent authority to be an exact copy of the relevant registration.

2. Where the holder of the international registration is obliged to be represented in proceedings before the Office pursuant to Article 88(2) of the Regulation, the communication as referred to in paragraph 1 shall contain the appointment of a representative within the meaning of Article 89(1) of the Regulation.

3. The President of the Office may determine that the evidence to be provided by the holder may consist of less than is required under paragraph 1, provided that the information required is available to the Office from other sources.

Rule 109

Examination of seniority claims

1. Where the Office finds that the seniority claim under Rule 108(1) does not comply with Article 34 of the Regulation, or does not comply with the other requirements of Rule 108, it shall invite the holder to remedy the deficiencies within such period as it may specify.

2. If the requirements referred to in paragraph 1 are not satisfied within the time limit, the right of seniority in respect of that international registration shall be lost. If the deficiencies concern only some of the goods and services, the right of seniority shall be lost only in so far as those goods and services are concerned.

3. The Office shall inform the International Bureau of any declaration of a loss of the right of seniority pursuant to paragraph 2. It shall also inform the International Bureau of any withdrawal or restriction of the seniority claim.

4. The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the claiming of seniority, unless the right of seniority is declared lost pursuant to paragraph 2.

Rule 110

Seniority claimed before the Office

1. The holder of an international registration designating the European Community may claim, directly before the Office, the seniority of one or more earlier registered trade marks as referred to in Article 35 of the Regulation as from the date on which the Office has, pursuant to Article 147(2) of the Regulation, published the fact that no refusal for protection of the international registration designating the European Community has been notified or if any such refusal has been withdrawn, as provided for in Article 148(2) of the Regulation.

2. Where seniority is claimed before the Office before the date referred to in paragraph 1, the seniority claim shall be deemed to have been received by the Office on the date referred to in paragraph 1.

3. An application to claim seniority pursuant to Article 148(2) of the Regulation and paragraph 1 shall contain:

(a) an indication that the seniority claim is made for an international registration under the Madrid Protocol;

(b) the registration number of the international registration;

(c) the name and address of the holder of the international registration in accordance with Rule 1(1)(b);

(d) where the holder has appointed a representative, the name and the business address of the representative in accordance with Rule 1(1)(e);

(e) an indication of the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the earlier mark is registered;

(f) where seniority is claimed for less than all the goods and services contained in the earlier registration, the indication of the goods and services in respect of which seniority is claimed;

(g) a copy of the relevant registration; certified by the competent authority as being an exact copy;

(h) where the holder of the international registration is obliged to be represented in proceedings before the Office pursuant to Article 88(2) of the Regulation, the appointment of a representative within the meaning of Article 89(1) of the Regulation.

4. If the requirements governing the claiming of seniority referred to in paragraph 3 are not fulfilled, the Office shall invite the holder of the international registration to remedy the deficiencies. If the deficiencies are not remedied within a period specified by the Office, the Office shall reject the application.

5. Where the Office has accepted the application to claim seniority, it shall inform the International Bureau accordingly by communicating

(a) the number of the international registration concerned,

(b) the name of the Member state or Member States in or for which the earlier mark is registered,

(c) the number of the relevant registration, and

(d) the date from which the relevant registration was effective.

6. The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the application to claim seniority once it has been accepted by the Office.

7. The President of the Office may determine that the evidence to be provided by the holder of the international registration may consist of less than is required under paragraph 1(g), provided that the information required is available to the Office from other sources.

Rule 111

Decisions affecting seniority claims

Where a seniority claim which has been made in accordance with Article 148(1) of the Regulation, or which has been communicated pursuant to Rule 110(5), has been withdrawn or cancelled by the Office, the Office shall inform the International Bureau accordingly.

Rule 112

Examination as to absolute grounds for refusal

1. Where, in the course of the examination pursuant to Article 149(1) of the Regulation, the Office finds that pursuant to Article 38(1) of the Regulation, the trade mark which is subject to the territorial extension to the European Community is ineligible for protection for all or any part of the goods or services for which it has been registered by the International Bureau, the Office shall issue an ex officio notification of provisional refusal pursuant to Article 5(1), and (2) of the Madrid Protocol and Rule 17(1) of the Common Regulations to the International Bureau.

Where the holder of the international registration is obliged to be represented in proceedings before the Office pursuant to Article 88(1) of the Regulation, the notification shall contain an invitation to appoint a representative within the meaning of Article 89(1) of the Regulation.

The notification of provisional refusal shall state the reasons on which it is based, and shall specify a time limit within which the holder of the international registration may submit his observations and, if appropriate, must appoint a representative.

The time limit shall start on the day on which the Office issues the provisional refusal.

2. Where, in the course of the examination pursuant to Article 149(1) of the Regulation, the Office finds that pursuant to Article 38(2) of the Regulation, registration of the mark must be subject to the statement by the holder of the international registration that he disclaims any exclusive rights in a non-distinctive element of the mark, the notification of ex officio refusal of provisional protection pursuant to paragraph 1 shall state that the international registration will be refused protection if the relevant statement is not submitted within the specified time limit.

3. Where, in the course of the examination pursuant to Article 149(1) of the Regulation, the Office finds that the international registration designating the European Community does not contain the indication of a second language pursuant to Rule 126 of the present Regulation and Rule 9(5)(g) (ii) of the Common Regulations, the Office shall issue an ex officio notification of provisional refusal pursuant to Article 5(1), and (2) of the Madrid Protocol and Rule 17(1) of the Common Regulations to the International Bureau. Paragraph 1, second, third and fourth sentence, shall apply.