

Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (Text with EEA relevance) (repealed)

TITLE XIII

INTERNATIONAL REGISTRATION OF MARKS

SECTION I

General provisions

Article 145

Application of provisions

Unless otherwise specified in this title, this Regulation and its Implementing Regulations shall apply to applications for international registrations under the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989 (hereafter referred to as ‘international applications’ and ‘the Madrid Protocol’ respectively), based on an application for a Community trade mark or on a Community trade mark and to registrations of marks in the international register maintained by the International Bureau of the World Intellectual Property Organisation (hereafter referred to as ‘international registrations’ and ‘the International Bureau’, respectively) designating the European Community.

SECTION 2

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

Article 146

Filing of an international application

1 International applications pursuant to Article 3 of the Madrid Protocol based on an application for a Community trade mark or on a Community trade mark shall be filed at the Office.

2 Where an international application is filed before the mark on which the international registration is to be based has been registered as a Community trade mark, the applicant for the international registration must indicate whether the international registration is to be based on a Community trade mark application or registration. Where the international registration is to be based on a Community trade mark once it is registered, the international application shall be deemed to have been received at the Office on the date of registration of the Community trade mark.

Article 147

Form and contents of the international application

1 The international application shall be filed in one of the official languages of the European Community, using a form provided by the Office. Unless otherwise specified by the applicant on that form when he files the international application, the Office shall correspond with the applicant in the language of filing in a standard form.

2 If the international application is filed in a language which is not one of the languages allowed under the Madrid Protocol, the applicant must indicate a second language from among those languages. This shall be the language in which the Office submits the international application to the International Bureau.

3 Where the international application is filed in a language other than one of the languages allowed under the Madrid Protocol for the filing of international applications, the applicant may provide a translation of the list of goods or services in the language in which the international application is to be submitted to the International Bureau pursuant to paragraph 2.

4 The Office shall forward the international application to the International Bureau as soon as possible.

5 The filing of an international application shall be subject to the payment of a fee to the Office. In the cases referred to in the second sentence of Article 146(2), the fee shall be due on the date of registration of the Community trade mark. The application shall be deemed not to have been filed until the required fee has been paid.

6 The international application must fulfil the relevant conditions laid down in the Implementing Regulation.

Article 148

Recordal in the files and in the Register

1 The date and number of an international registration based on a Community trade mark application, shall be recorded in the files of that application. When the application results in a Community trade mark, the date and number of the international registration shall be entered in the Register.

2 The date and number of an international registration based on a Community trade mark shall be entered in the Register.

Article 149

Request for territorial extension subsequent to the international registration

A request for territorial extension made subsequent to the international registration pursuant to Article 3^{ter}(2) of the Madrid Protocol may be filed through the intermediary of the Office. The request must be filed in the language in which the international application was filed pursuant to Article 147.

Article 150

International fees

Any fees payable to the International Bureau under the Madrid Protocol shall be paid direct to the International Bureau.

SECTION 3

International registrations designating the European Community

Article 151

Effects of international registrations designating the European Community

1 An international registration designating the European Community shall, from the date of its registration pursuant to Article 3(4) of the Madrid Protocol or from the date of the subsequent designation of the European Community pursuant to Article 3^{ter}(2) of the Madrid Protocol, have the same effect as an application for a Community trade mark.

2 If no refusal has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the international registration of a mark designating the European Community shall, from the date referred to in paragraph 1, have the same effect as the registration of a mark as a Community trade mark.

3 For the purposes of applying Article 9(3), publication of the particulars of the international registration designating the European Community pursuant to Article 152(1) shall take the place of publication of a Community trade mark application, and publication pursuant to Article 152(2) shall take the place of publication of the registration of a Community trade mark.

Article 152

Publication

1 The Office shall publish the date of registration of a mark designating the European Community pursuant to Article 3(4) of the Madrid Protocol or the date of the subsequent designation of the European Community pursuant to Article 3^{ter}(2) of the Madrid Protocol, the language of filing of the international application and the second language indicated by the applicant, the number of the international registration and the date of publication of such registration in the Gazette published by the International Bureau, a reproduction of the mark and the numbers of the classes of the goods or services in respect of which protection is claimed.

2 If no refusal of protection of an international registration designating the European Community has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the Office shall publish this fact, together with the number of the international registration and, where applicable, the date of publication of such registration in the Gazette published by the International Bureau.

Article 153

Seniority

1 The applicant for an international registration designating the European Community may claim, in the international application, the seniority of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, as provided for in Article 34.

2 The holder of an international registration designating the European Community may, as from the date of publication of the effects of such registration pursuant to Article 152(2), claim at the Office the seniority of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, as provided for in Article 35. The Office shall notify the International Bureau accordingly.

Article 154

Examination as to absolute grounds for refusal

1 International registrations designating the European Community shall be subject to examination as to absolute grounds for refusal in the same way as applications for Community trade marks.

2 Protection of an international registration shall not be refused before the holder of the international registration has been allowed the opportunity to renounce or limit the protection in respect of the European Community or of submitting his observations.

3 Refusal of protection shall take the place of refusal of a Community trade mark application.

4 Where protection of an international registration is refused by a decision under this Article which has become final or where the holder of the international registration has renounced the protection in respect of the European Community pursuant to paragraph 2, the Office shall refund the holder of the international registration a part of the individual fee to be laid down in the Implementing Regulation.

Article 155

Search

1 Once the Office has received a notification of an international registration designating the European Community, it shall draw up a Community search report as provided for in Article 38(1).

2 As soon as the Office has received a notification of an international registration designating the European Community, the Office shall transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks as provided for in Article 38(2).

3 Article 38(3) to (6) shall apply *mutatis mutandis*.

4 The Office shall inform the proprietors of any earlier Community trade marks or Community trade mark applications cited in the Community search report of the publication of the international registration designating the European Community as provided for in Article 152(1).

Article 156

Opposition

1 International registration designating the European Community shall be subject to opposition in the same way as published Community trade mark applications.

2 Notice of opposition shall be filed within a period of three months which shall begin six months following the date of the publication pursuant to Article 152(1). The opposition shall not be treated as duly entered until the opposition fee has been paid.

3 Refusal of protection shall take the place of refusal of a Community trade mark application.

4 Where protection of an international registration is refused by a decision under this Article which has become final or where the holder of the international registration has renounced the protection in respect of the European Community prior to a decision under this Article which has become final, the Office shall refund the holder of the international registration a part of the individual fee to be laid down in the Implementing Regulation.

Article 157

Replacement of a Community trade mark by an international registration

The Office shall, upon request, enter a notice in the Register that a Community trade mark is deemed to have been replaced by an international registration in accordance with Article 4*bis* of the Madrid Protocol.

Article 158

Invalidation of the effects of an international registration

1 The effects of an international registration designating the European Community may be declared invalid.

2 The application for invalidation of the effects of an international registration designating the European Community shall take the place of an application for a declaration of revocation as provided for in Article 51 or for a declaration of invalidity as provided for in Article 52 or Article 53.

Article 159

Conversion of a designation of the European Community through an international registration into a national trade mark application or into a designation of Member States

1 Where a designation of the European Community through an international registration has been refused or ceases to have effect, the holder of the international registration may request the conversion of the designation of the European Community:

- a into a national trade mark application pursuant to Articles 112, 113 and 114;
- b into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 14 April 1891, as revised and amended (hereafter referred to as the ‘Madrid Agreement’), provided that on the date when conversion was requested it was possible to have designated that Member State directly under the Madrid Protocol or the Madrid Agreement. Articles 112, 113 and 114 shall apply.

2 The national trade mark application or the designation of a Member State party to the Madrid Protocol or the Madrid Agreement resulting from the conversion of the designation of the European Community through an international registration shall enjoy, in respect of the Member State concerned, the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date of the extension to the European Community pursuant to Article 3ter(2) of the Madrid Protocol if the latter was made subsequently to the international registration, or the date of priority of that registration and, where appropriate, the seniority of a trade mark of that State claimed under Article 153.

3 The request for conversion shall be published.

Article 160

Use of a mark subject of an international registration

For the purposes of applying Article 15(1), Article 42(2), Article 51(1)(a) and Article 57(2), the date of publication pursuant to Article 152(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is the subject of an international registration designating the European Community must be put to genuine use in the Community.

Article 161

Transformation

1 Subject to paragraph 2, the provisions applicable to Community trade mark applications shall apply *mutatis mutandis* to applications for transformation of an international registration into a Community trade mark application pursuant to Article 9quinquies of the Madrid Protocol.

2 When the application for transformation relates to an international registration designating the European Community the particulars of which have been published pursuant to Article 152(2), Articles 37 to 42 shall not apply.