



MADRID SYSTEM REFRESHER SESSION

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TOPICS FOR DISCUSSION

- Limitation of the list of goods and services
- Disclaimers
- Ceasing of effect of the basic mark
- Replacement
- Colour claim
- Sound marks
- Prior registration in the name of a different owner

- The recording of a **limitation** of the list of goods and services may be requested
 - by the applicant, in the **IA form - MM2, item 10(b)**
 - by the IR holder by filing the **MM6 form** (WIPO recommends using the online limitation form)
- If requested **in the IA**, the IB will check that the G&S are correctly classified, but will not examine whether they fall within the scope of the main list or not, as this should be determined by each DCP.
- If requested later, **in the MM6 form**, the IB will simply record the limitation in the International Register and inform the DCP concerned

- The **DCP Office** may declare that the limitation affecting that DCP has no effect in **its territory** because it considers that a term is too broad or too vague or that the change requested is not in fact a limitation but an extension of the list.
- Such objection will take the form of a **declaration of refusal**, resulting in the limitation not being accepted or in a broad or vague term being replaced by a narrower or more precise term in respect of that DCP.
- Any such declaration must be sent to the IB **within 18 months** from the date on which the notification was sent to that DCP.

- In its declaration of refusal, the **DCP Office** shall indicate
 - the **reasons** why the limitation has no effect,
 - where the declaration does not affect all the **goods and services** to which the limitation relates, those which are **affected** by the declaration or those which are not affected by the declaration,
 - the corresponding **essential provisions of the law**, and
 - whether the declaration is subject to **review or appeal**.
- Where the declaration may be subject to **review or appeal**, it is for the holder to ascertain from the DCP Office the time limit for requesting such review or appeal and the authority to which the request must be made.

- **Any final decision** relating to the declaration shall be notified to the IB, which will inform the party that requested the recording of the limitation.
- Any declaration that a limitation has no effect, or any final decision in respect of that declaration, will be **recorded in the International Register**. The relevant information will be **published in the Gazette**.
- The goods and services subject of the limitation remain in the main list of the IR but will no longer have effect in the DCP concerned by the limitation. Any such good or service which has been the subject of a limitation in respect of a DCP **may later be made the subject of a subsequent designation** of that CP.

- When the **EUIPO** is the **Office of Origin** of an IA containing a limitation (MM2)
 - EUIPO examines whether it is covered by the main list of G&S in the IA, which itself should fall within the scope of the list of the basic EUTM
 - if the limitation broadens the scope of protection, EUIPO issues a deficiency letter inviting the applicant to amend or delete the “limited” list in question.
- When the **EUIPO** acts as the **designated Office** in respect of a limited list of G&S,
 - EUIPO checks the limited list and will issue a **provisional refusal** if it deems that the limitation
 - **broadens the scope** of protection of the main list in the IR, or
 - contains terms that **lack sufficient clarity and precision**

“Lack of sufficient clarity and precision” = Article 33(2) EUTMR

Some examples:

- terms such as : “*machines*” (Class 7); “*repair services*” (Class 37) **not accepted as such may be accepted if made more specific** by identifying characteristics, purpose and/or market sector – e.g., “*agricultural machines*”; “*shoe repair*”
- other terms *merchandising articles; lifestyle accessories; souvenirs; gift articles; housewares; memorabilia; wellness goods* **not accepted as such**
- indefinite qualifiers such as: “... *and the like*”; “... *ancillary*”; “... *associated goods*”; “... *and related goods*”; “...*etc.*” **not accepted**
- trademarks (e.g., “*iPods*”; “*Caterpillar*”; “*Blu-Ray discs*”; “*Teflon*”) may not be used as generic terms; **must be replaced** by a generic description

- The limited lists of goods and services are not published as such in the EUIPO Bulletin; the **EUIPO Bulletin only shows the class numbers**, and refers to the WIPO Gazette where the full specification can be consulted
- For more information, you may refer to the EUIPO Guidelines
 - <https://guidelines.euipo.europa.eu/1922895/1788920/trade-mark-guidelines/3-3-3-4-terms-lacking-clarity-and-precision>
 - <https://guidelines.euipo.europa.eu/1922895/1788992/trade-mark-guidelines/3-3-3-5-limited-list-of-goods-and-services-for-the-designation-of-the-eu>

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- An applicant may include in its IA a disclaimer for **non-distinctive or generic elements** of a mark to be recorded in the International Register. It may wish to do so in order to avoid a provisional refusal from some CPs that require such a disclaimer to be made.
- The element or elements for which protection is disclaimed should be indicated in the IA form - **MM2, item 9(g)**
- The disclaimer **cannot be made for only some DCPs**; the disclaimer will be in respect of the IR as a whole

- It does not matter if there was no corresponding **disclaimer in the basic mark**; conversely, if there was a disclaimer in the basic mark, this does not make it obligatory to include it in the IA
- A **disclaimer cannot be added** at a later stage after the IR has been recorded in the International Register; and once a disclaimer is recorded in the IR it **cannot be changed or removed**
- WIPO encourages applicants to check with the Offices of the Contracting Parties concerned whether it is possible to submit the disclaimer directly with those Offices (so that they would only apply in those Contracting Parties)

DISCLAIMERS – EUIPO PRACTICE

- Disclaimers in words are **not contemplated in the** current EU Regulation
- As the Madrid Protocol accepts that a disclaimer **may be included in an IA** even if the basic mark does not include one, the EUIPO, as Office of Origin, accepts that disclaimers be included in the IA for the benefit of the DCPs which do accept disclaimers
- On the other hand, if an IR designating the European Union contains a disclaimer, this **will be simply ignored by the EUIPO**

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- For a period of **5 years from the date of the IR**, the protection resulting from the IR remains dependent on the basic mark in the OO (basic registration, basic application, or the registration resulting therefrom) – **Protocol Art 6(3) & (4)**
- If during the **dependency period** (or as a result of an action commenced within that period), **the basic mark ceases to have effect**
 - because the basic registration has been cancelled renounced, revoked, invalidated or has lapsed, or the basic application has been finally rejected or withdrawn
 - in respect of all or only some of the goods or services listed in the IR**the protection of the IR will be restricted accordingly**

- The “**ceasing of effect**” of the basic mark is a broader concept than “**central attack**”. The ceasing of effect does not always result from an action (“attack”) from a third party.
- If the basic mark ceases to have effect, the **Office of Origin shall**
 - **notify the IB** of the relevant facts and decisions affecting it, and
 - **if the decision is final shall request the cancellation of the IR**
- Where **only some G&S are affected**, the notification by the OO shall indicate which goods & services are affected or which are not affected

- For requesting the **cancellation** of an IR, the **Office of Origin** may use **Model Form 9**, which can be downloaded from:
https://www.wipo.int/madrid/en/contracting_parties/model_forms.html
- The notification should not be sent until it is clear that there is no possibility of the ceasing of effect being reversed.
- **Pending proceedings – Rule 22(1)(b) – if the OO is aware that, at the end of dependency period certain actions are pending** that may result in the ceasing of effect of the basic mark, **it shall notify the IB accordingly** asap (it should be made clear that the action in question has not yet resulted in a final decision)

- Pending proceedings that the OO shall notify :
 - judicial action concerning the basic registration
 - an appeal against a decision refusing the basic application
 - an action requesting withdrawal of the basic application
 - an opposition to the basic application
 - an action requesting the revocation, cancellation or invalidation of the basic registration or of the registration resulting from the basic application
- Final decision – Rule 22(1)(c) – as soon as it becomes aware that a final decision has been taken regarding those pending proceedings, the OO shall notify the IB accordingly and shall request the cancellation of the IR to the extent applicable

- The **cancellation** of the IR is **recorded** in the International Register
- **Any IR resulting from a partial change in ownership or division** of the canceled IR, as well as any IR resulting from their **merger, shall also be canceled**
- The cancellation of the IR is **published** in the Gazette
- Any notification by an Office of Origin that an **action** begun before the end of the five-year dependency period is **still pending** at the end of that period is also be **published** in the Gazette

- Division or merger of the basic mark during the 5-year dependency period – Rule 23 – if the basic application or registration is divided, or if several basic applications or basic registrations are merged, the OO shall notify the IB accordingly.
- The notification of division or merger of the basic mark is recorded in the International Register, published in the Gazette, and notified to the DCPs and the IR holder
- Such information is particularly pertinent in cases of third-party central attack

CEASING OF EFFECT OF THE BASIC MARK – EUIPO PRACTICE

- EUIPO notifies **all final decisions** regarding the ceasing of effect of the basic mark and **requests cancellation** of the ensuing IR **to the extent applicable**
- EUIPO also notifies **pending proceedings** at the end of the 5-year period that may result in the ceasing of effect of the basic mark (appeal, opposition, revocation, invalidity)
- EUIPO also notifies **divisions** of the basic mark during the dependency period
- For more information, you may refer to the EUIPO Guidelines at <https://guidelines.euipo.europa.eu/1922895/1923426/trade-mark-guidelines/2-3-notification-of-facts-affecting-the-basic-registration>

- Protocol **Article 4bis** – **replacement takes place automatically** where the mark that is the subject of an IR designating a CP is also the subject of a national registration in that CP, provided that
 - the IR is protected in that CP
 - both the IR and the national registration are in the name of the same person
 - the G&S in the national registration are covered by those in the IR in that CP
 - the IR extended its effects to that CP after the date of the national registration in that CP
- The holder may request the Office of the DCP to **take note of replacement** in its Register

- The **DCP Office** shall examine the request to determine whether the conditions for replacement are met and, if so, shall take note of the replacement.
- Where the DCP Office has taken note of a replacement, it shall notify the IB accordingly. The notification shall contain all the indications provided for in Rule 21 IR number, goods and services replaced, filing date and number, and registration date and number of the replaced national registration
- “**Partial replacement**” – Rule 21(3)(d) is likely to be modified as from November 2021 to make it clear that replacement may concern only some G&S listed in the national/regional mark.

- The IR and the national registration that is deemed to be replaced shall be able to coexist. The DCP Office may not require the holder to renounce or request the cancellation of a national registration that is deemed to be replaced.
- The DCP Office may charge a fee for taking note of replacement.

- **EUIPO checks** that the **marks are identical**, that the EUTM has been registered **prior** to the EU designation, and that **all the G&S** listed in the EUTM are listed in the IR designating the EU (the IR list may be broader, but not narrower)
- The **request for taking note** of replacement **may be filed anytime** after WIPO's notification of the EU designation; no fee is charged
- If accepted, **EUIPO takes note** of replacement in the EUTM register and informs WIPO
- **"partial replacement"** will not be implemented until the end of the transitional period (01.02.2025)

- **IR and EUTM may coexist** as long as the IR holder so wishes
- **Very few cases** of requests to take note of replacement
- For more information, please refer to the EUIPO Guidelines at <https://guidelines.euipo.europa.eu/1922895/1923402/trade-mark-guidelines/4-4-replacement>

Regarding the **reproduction of the mark**

- At present, **Rule 9(4)(a)(v)** requires that the **reproduction in MM2 box 7(a)** of the IA be **identical** to the reproduction of the “basic mark”. If the basic mark is in B&W, the reproduction must be in B&W; if its is in color, it must be in color.
- If the applicant **claims color in the IA**, and the reproduction in box 7(a) is in **B&W**, then the applicant must add **a reproduction** of the mark **in color in box 7(b)**
- **This may change** as from Feb 2023, if Rule 9(4)(a)(v) is amended, since the Administrative Instructions would provide for the elimination of box 7(b) and for the **representation** of the mark **in box 7(a) in color whenever color is claimed**

- **In MM2**, color is claimed by checking the box in **item 8(a)** and indicating the color(s) claimed in words. WIPO invites the applicant to also indicate the principal parts of the mark that are in each color, in **item 8(b)**, as this may be required by certain DCPs
- **If color was claimed in the basic mark** - the applicant **shall claim color in the IA** – Rule 9(4)(a)(vii) – MM2 item 8(a) + reproduction in color in box 7(a)
- **If color was not claimed in the basic mark** - the applicant **may claim color in the IA**, provided that
 - the **basic mark was in fact in color** (even though the reproduction of the basic mark is in B&W, for example, because the Office of origin does not provide for registration or publication in color) and
 - the applicant submits a **reproduction in color in box 7(a) or in box 7(b)**

- Proposed amendments to Rule 9(4)(a)(v) & (vii) (to take effect as from Feb 2023, if approved) and Administrative Instructions would
 - prescribe that the representation of the mark in 7(a) “...shall be in color where color is claimed ..” (instead of requiring, as at present, that the reproduction of the mark in 7(a) be in B&W if the basic mark reproduction was in B&W)
 - eliminate box 7(b) no longer necessary
 - make it clearer that the applicant may claim color in the IA, if it has not claimed color in the basic mark, provided that “... the mark contained in the basic application or basic registration is in color or is applied to be or is protected in color, ...” (even though it might have been published in B&W)

Office of origin – certification

- When checking an IA, the **OO must certify** - Rule 9(5)(d)(v) - that
 - **if color claimed** in the basic mark, the **same claim is included in the IA**
 - if color is claimed **in the IA without** having being claimed in the basic mark, **the basic mark is in fact in the color or combination of colors claimed**
- **Proposed modification of Rule 9(5)(d)(v)** – (to take effect in February 2023, if approved), would require the OO to certify that **a color claim is included in the IA** not only where color is claimed in the basic mark but **also when the basic mark is applied to be in color or is protected in color**

Proposed modification of Rule 9(5)

[Additional Contents of the International Application]

[...]

(d) The international application shall contain a declaration by the Office of origin certifying

[...]

(v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, **or the mark in the basic application or the basic registration is applied to be or is protected in color, [the same] a color claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having being claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and ...**

Office of the Designated Contracting Party (DCP)

- **May** require that the IR contain a **color claim** if the **reproduction** of the mark is **in color**

COLOR CLAIM – EUIPO PRACTICE

- As Office of Origin, EUIPO checks that the **reproduction** of the mark **in MM2 box 7(a)** be **identical** as in the basic mark (either in B&W or in color)
- If **color** is **claimed** in the basic mark (*e.g.*, for position, pattern, **colour**, movement marks), the **same claim** and indication of color(s) **must** appear in the IA
- If **color** is **not claimed** in the basic mark (*e.g.*, for figurative, 3D, hologram marks), but the applicant so wishes, the **applicant may claim color** in the IA; the colors **must be the same** as the ones in the representation

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SOUND MARKS

- The Madrid System requires a **graphic representation** of the mark
- Where the mark is a sound mark, the **reproduction in MM2 box 7(a)** should correspond exactly with the graphical representation of the mark which appears in the basic mark (*e.g.*, **a musical notation; a description in words**)
- **Non-graphical representations** (e.g., recordings) are not allowed in the IA
- The **“Sound mark” box** in **MM2 item 9(d)** shall be checked only if such indication also appears in the basic mark
- The IA may also contain a **supplementary description** in **MM2 item 9(e)(i)** (compulsory if required by the OO) or in **item 9(e)(ii)** (voluntary)

SOUND MARKS – EUIPO PRACTICE

- In the EU, a **sound mark** must be represented by submitting
 - an **audio file (MP3)** reproducing the sound or
 - an **accurate musical notation** representing the sound
- As audio files are not accepted under the Madrid System, a **musical notation** is the **only acceptable graphic representation** of a sound mark for the EUIPO
- An IA or IR containing any other type of graphic representation (e.g., description in words) is not accepted; a **refusal** on these grounds **cannot be remedied**
- The **situation may change** as from Feb 2023 if Rule 9(4)(a)(v) and Administrative Instructions are amended to allow for non-graphic representations of the mark

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PRIOR REGISTRATIONS IN THE NAME OF A DIFFERENT OWNER – EUIPO PRACTICE

- Under the Madrid System, the Office of a DCP **may undertake an *ex officio* examination** of the IR on relative grounds, to determine whether the mark may conflict with prior rights in the name of a third person, and may issue a refusal on that basis.
- The EUTM Regulation does not require the EUIPO to undertake an *ex officio* examination of relative grounds (prior rights); so, the **EUIPO does not undertake such examination**

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THANK YOU



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