

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:

Rule 103

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.

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 forms referred to in 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.

4. Where the holder of the international registration fails to overcome the ground for refusing protection within the time limit or to comply with the condition laid down in paragraph 2 or, if appropriate, to appoint a representative or to indicate a second language, the Office will take a decision refusing the protection in whole or for a part of the goods and services for which the international registration is registered. The decision shall be subject to appeal in accordance with Article 57 to 63 of the Regulation.

5. Where, until the start of the opposition period referred to in Article 151(2) of the Regulation, the Office has not issued an ex officio notification of provisional refusal pursuant to paragraph 1, the Office shall send a statement of grant of protection to the International Bureau, indicating that the examination of absolute grounds of refusal pursuant to Article 38 of the Regulation has been completed but that the international registration is still subject to oppositions or observations of third parties.

Rule 113

Notification of ex officio provisional refusals to the International Bureau

1. The notification of ex officio provisional refusal of protection of the international registration in whole or in part, pursuant to Rule 112, shall be sent to the International Bureau and shall contain:

- (a) the number of the international registration;
- (b) all the grounds on which the provisional refusal is based together with a reference to the corresponding provisions of the Regulation;
- (c) the indication that the provisional refusal of protection will be confirmed by a decision of the Office if the holder of the international registration does not overcome the grounds for refusal by submitting his observations to the Office within a time limit of two months from the date on which the Office issues the provisional refusal;
- (d) if the provisional refusal relates to only part of the goods and services, the indication of those goods and services.

2. In respect of each notification of ex officio provisional refusal issued pursuant to paragraph 1, and provided that the time limit for entering an opposition has expired and that no provisional refusal based on an opposition has been issued pursuant to Rule 115(1), the Office shall inform the International Bureau as follows:

- (a) where as the result of the proceedings before the Office the provisional refusal has been withdrawn, the fact that the mark is protected in the European Community;
- (b) where a decision to refuse protection of the mark has become final, if applicable, following an appeal under Article 57 of the Regulation or an action under Article

63 of the Regulation, the Office shall inform the International Bureau that protection of the mark is refused in the European Community;

- (c) where the refusal pursuant to subparagraph (a) or (b) concerns only part of the goods and services, the goods and services for which the mark is protected in the European Community.

Rule 114

Opposition proceedings

1. Where opposition is entered against an international registration designating the European Community pursuant to Article 151 of the Regulation, the notice of opposition shall contain:

- (a) the number of the international registration against which opposition is entered;
- (b) an indication of the goods and services listed in the international registration against which opposition is entered;
- (c) the name of the holder of the international registration;
- (d) the indications and elements referred to in Rule 15(2)(b), (c) and (d), and (3).

2. Rules 15(1) and 16 to 22 shall apply, subject to the following:

- (a) any reference to an application for registration of the Community trade mark shall be read as a reference to an international registration;
- (b) any reference to a withdrawal of the application for registration of the Community trade mark shall be read as a reference to the renunciation of the international registration in respect of the European Community;
- (c) any reference to the applicant shall be read as a reference to the holder of the international registration.

3. If the notice of opposition is filed before the expiry of the period of six months referred to in Article 151(2) of the Regulation, the notice of opposition shall be deemed to have been filed on the first day following the expiry of the period of six months. The application of Article 42(3) second sentence of the Regulation shall remain unaffected.

4. 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, and where he has not already appointed a representative within the meaning of Article 89(1) of the Regulation, the communication of the opposition to the holder of the international registration pursuant to Rule 19 shall contain the invitation to appoint a representative within the meaning of Article 89(1) of the Regulation within a period of two months from the date of notification of the communication.

Where the holder of the international registration fails to appoint a representative within this period, the Office will take a decision refusing the protection of the international registration.

5. The opposition procedure shall be stayed if an ex officio provisional refusal of protection is or has been issued pursuant to Rule 112. When the ex officio provisional refusal leads to a decision to refuse protection of the mark which has become final, the Office shall not proceed to judgment and refund the opposition fee, and no decision on the apportionment of costs shall be taken.

Rule 115

Notification of provisional refusals based on an opposition

1. When an opposition against an international registration is entered at the Office pursuant to Article 151(2) of the Regulation, or is deemed to have been entered pursuant to Rule 114(3), the Office shall issue a notification of provisional refusal of protection based on an opposition to the International Bureau.

2. The notification of provisional refusal of protection based on an opposition shall contain:

- (a) the number of the international registration;
- (b) the indication that the refusal is based on the fact that an opposition has been filed, together with a reference to the provisions of Article 8 of the Regulation on which the opposition relies;
- (c) the name and the address of the opposing party.

3. Where the opposition is based on a trademark application or registration, the notification referred to in paragraph 2 shall contain the following indications:

- (i) the filing date, the registration date and, if any, the priority date,
- (ii) the filing number and, if different, the registration number,
- (iii) the name and address of the owner,
- (iv) a reproduction of the mark, and
- (v) the list of goods and services on which the opposition is based.

4. If the provisional refusal relates to only part of the goods and services, the notification referred to in paragraph 2 shall indicate those goods and services.

5. The Office shall inform the International Bureau as follows:

- (a) where as the result of the opposition proceeding the provisional refusal has been withdrawn, the fact that the mark is protected in the European Community;

- (b) where a decision to refuse protection of the mark has become final, if applicable, following an appeal under Article 57 of the Regulation or an action under Article 63 of the Regulation, the fact that protection of the mark is refused in the European Community;

- (c) where the refusal pursuant to subparagraph (a) or (b) concerns only part of the goods and services, the goods and services for which the mark is protected in the European Community.

6. Where for one and the same international registration, more than one provisional refusal has been issued pursuant to Rule 112(1), (2) or paragraph 1 of this Rule, the communication referred to in paragraph 5 of this Rule shall relate to the total or partial refusal of protection of the mark as it results from all the procedures under Article 149 and 151 of the Regulation.

Rule 116

Statement of grant of protection

1. Where the Office has not issued an ex officio notification of provisional refusal pursuant to Rule 112 and no opposition has been received by the Office within the opposition period referred to in Article 151(2) of the Regulation and the Office has not issued an ex officio notification of provisional refusal as a result of the third party observations filed, the Office shall send a further statement of grant of protection to the International Bureau, indicating that the mark is protected in the European Community.

2. For the purposes of Article 146(2) of the Regulation, the further statement of grant of protection referred to in paragraph 1 shall have the same effect as a statement by the Office that a notice of refusal has been withdrawn.

Rule 117

Notification of invalidation to the International Bureau

1. Where, pursuant to Article 56 or 96 and Article 153 of the Regulation, the effects of an international registration designating the European Community have been declared invalid and where that decision has become final, the Office shall notify the International Bureau accordingly.

2. The notification shall be dated and shall contain:

- (a) the indication that the invalidation has been pronounced by the Office, or the indication of the Community trade mark court which has pronounced the invalidation;
- (b) the indication whether invalidation has been pronounced in the form of revocation of the rights of the holder of the international registration, of a declaration that the trade mark is invalid on absolute grounds, or of a declaration that the trade mark is invalid on relative grounds;
- (c) the indication of the fact that the invalidation is no longer subject to appeal;
- (d) the number of the international registration;

- (e) the name of the holder of the international registration;
- (f) if the invalidation does not concern all the goods and services, those goods and services in respect of which the invalidation has been pronounced or those in respect of which the invalidation has not been pronounced;
- (g) the date on which the invalidation has been pronounced, together with the indication whether the invalidation is effective as of that date or *ex tunc*.

Rule 118

Legal effect of registration of transfers

For the purposes of Article 17, and also in conjunction with Article 23(1) or (2) and Article 24, of the Regulation, recordal of a change in the ownership of the international registration on the International Register shall replace the entry of a transfer in the Register of Community Trade Marks.

Rule 119

Legal effect of registration of licenses and other rights

For the purposes of Articles 19, 20, 21 and 22, and also in conjunction with Article 23 and Article 24, of the Regulation, recordal of a license or a restriction of the holder's right of disposal in respect of the international registration on the International Register shall replace the registration of a license, a right in rem, a levy of execution or insolvency proceedings in the Register of Community Trade Marks.

Rule 120

Examination of requests for registrations of transfers, licenses or restrictions of the holder's right of disposal

1. Where a request to register a change in ownership, a license or a restriction of the holder's right of disposal is filed through the Office by a person other than the holder of the international registration, the Office shall refuse to transmit the request to the International Bureau if the request is not accompanied by proof of the transfer, license or the restriction of the right of disposal.
2. Where a request to register the amendment or cancellation of a license or the removal of a restriction of the holder's right of disposal is filed through the Office by the holder of the international registration, the Office will take a decision refusing to transmit the request to the International Bureau if the request is not accompanied by proof that the license no longer exists or has been amended, or that the restriction of the right of disposal has been removed.

Rule 121

Collective marks

1. Where the international registration indicates that it is based on a basic application or basic registration which relates to a collective mark, certification mark or guarantee

mark, the international registration designating the European Community shall be dealt with as a Community collective mark.

2. The holder of the international registration shall submit the regulations governing use of the mark as provided for in Article 65 of the Regulation and Rule 43 directly to the Office within a period of two months from the date on which the International Bureau notifies the international registration to the Office.

3. A notification of *ex officio* provisional refusal pursuant to Rule 112 shall also be issued:

- (a) if one of the grounds for refusal foreseen in Article 66(1) or (2), in conjunction paragraph 3 of that Article, of the Regulation exists;
- (b) where the regulations governing use of the mark have not been submitted in accordance with paragraph 2.

Rules 112(2), (3) and 113 shall apply.

4. Notice of amendments to the regulations governing use of the mark pursuant to Article 69 of the Regulation shall be published in the Community Trade Marks Bulletin.

Rule 122

Conversion of an international registration into a national trade mark application

1. An application for conversion of an international registration designating the European Community into a national trade mark application pursuant to Articles 108 and 154 of the Regulation shall contain:

- (a) the registration number of the international registration;
- (b) the date of the international registration or the date of the designation of the European Community made subsequently to the international registration pursuant to Article 3 ter (2) of the Madrid Protocol and, where applicable, particulars of the claim to priority for the international registration pursuant to Article 154(2) of the Regulation and particulars of the claim to seniority pursuant to Articles 34, 35 and 148 of the Regulation;
- (c) the indications and elements referred to in Rule 44(1) (a), (b), (f) and (g) and, where applicable, (h) and (k), and (2).

2. Where conversion is requested pursuant to Article 108(5) and 154 of the Regulation following a failure to renew the international registration designating the European Community, the application referred to in paragraph 1 shall contain an indication to that effect, and the date on which the protection has expired. The period of three months provided for in Article 108(5) of the Regulation shall begin to run on the day following the last day on which the renewal may still be effected pursuant to Article 7 (4) of the Madrid Protocol;

3. Rules 45, 46(2) (a) and (c), and 47 shall apply *mutatis mutandis*.

Rule 123

Conversion of an international registration into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement

1. An application for conversion of an international registration designating the European Community into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement pursuant to Article 154 of the Regulation shall contain the indications and elements referred to in Rule 122(1) and (2).

2. Rule 45 shall apply *mutatis mutandis*. The Office shall also reject the application for conversion where the conditions to designate the Member State which is a party to the Madrid Protocol or to the Madrid Agreement were not fulfilled both on the date of the designation of the European Community and the date on which the application for conversion was received or, pursuant to the second sentence of Article 109(1) of the Regulation, is deemed to have been received by the Office.

3. Rule 46(2)(a) and (c) shall apply *mutatis mutandis*. The publication of the application for conversion shall also contain the indication that conversion has been requested into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement pursuant to Article 154 of the Regulation.

4. Where the application for conversion complies with the requirements of the Regulation and these Rules, the Office shall transmit it without delay to the International Bureau. The Office shall inform the holder of the international registration of the date of transmission.

Rule 124

Transformation of an international registration designating the European Community into a Community trade mark application

1. In order to be considered a transformation of an international registration which has been cancelled at the request of the office of origin by the International Bureau pursuant to Article 9 quinquies of the Madrid Protocol and in accordance with Article 156 of the Regulation, a Community trade mark application must contain an indication to that effect. That indication must be made on filing of the application.

2. The application shall contain, in addition to the indications and elements referred to in Rule 1,

- (a) the indication of the number of the international registration which has been cancelled;
- (b) the date on which the international registration was cancelled by the International Bureau;
- (c) as appropriate, the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date of recordal of the territorial extension to the European Community made subsequently to the international registration pursuant to Article 3 ter (2) of the Madrid Protocol;

(d) where applicable, the date of priority claimed in the international application as entered in the International Register kept by the International Bureau.

3. Where, in the course of the examination in accordance with Rule 9(3), the Office finds that the application was not filed within three months from the date on which the international registration was cancelled by the International Bureau; or the goods and services for which the Community trade mark is to be registered are not contained in the list of goods and services for which the international registration was registered in respect of the European Community, the Office shall invite the applicant to remedy the deficiencies noted and in particular to restrict the list of goods and services to those goods and services which have been contained in the list of goods and services for which the international registration was registered in respect of the European Community, within such a period as it may specify.

4. If the deficiencies referred to in paragraph 3 are not remedied within the time limit, the right to the date of the international registration or to the date of the territorial extension and, if any, to the date of the priority of the international registration shall be lost.

Part c

Communications

Rule 125

Communications with the International Bureau and electronic forms

1. Communications with the International Bureau shall be in a manner and format agreed on between the International Bureau and the Office, preferably by electronic means.

2. Any reference to forms shall be construed as including forms made available in electronic format.

Rule 126

Use of languages

For the purposes of applying the Regulation and these Rules to international registrations designating the European Community, the language of filing of the international application shall be the language of the proceedings within the meaning of Article 115(4) of the Regulation, and the second language indicated in the international application shall be the second language within the meaning of Article 115(3) of the Regulation.'

Article 2

This Regulation shall enter into force on the date on which the Madrid Protocol enters into force with respect to the European Community. The date of entry into force of this Regulation shall be published in the *Official Journal of the European Union*.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 26 April 2004.

For the Commission
Frederik BOLKESTEIN
Member of the Commission
