

International application must comply with the language requirement to the same extent a normal CTM application does.<sup>645</sup> Failure to satisfy the language requirement triggers OHIM provisionally to refuse the international registration. The applicant must overcome all the impediments contained in the notice of provisional refusal; otherwise OHIM enters a final decision refusing the grant of international registration.<sup>646</sup> One of these impediments may be a notice of opposition levelled against the international application.<sup>647</sup>

As it is for opposition, the interested parties have a right under Article 158 of the CTMR to commence proceedings before OHIM with intention to invalidate the effect of international registration in the European Community. The procedure leading to this invalidation is equivalent to that of CTM revocation or invalidation.<sup>648</sup>

Regardless of whether protection of international registration is refused by OHIM or the effect of international registration ceases, still the applicant has two alternative remedies: he may either convert the international registration into the national trademark application in accordance with the provisions of Articles 112 and 114 of the CTMR;<sup>649</sup> or designate the EC Member State which is party to the Madrid Protocol or the Madrid Agreement.<sup>650</sup> A national trademark application or an application designating a member state pursuant to a conversion of an international registration designating the Community retains a priority date of the international registration.<sup>651</sup>

## *II. CTM registration or application as a basis for international registration*

The CTMR provides for a procedure pursuant to which an application for CTM registration or a CTM registration itself may result in an internationally protected trademark. Article 146(1) of the CTMR is clear to this effect: “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”. The applicant for international registration need not wait until the CTM

645 The OHIM’s language regime is regulated under Article 119 of the CTMR and Rule 126 of the CTMIR.

646 Cf. Rule 112(4) of the CTMIR.

647 Cf. Article 156 of the CTMR.

648 Cf. Articles 51 to 53 of the CTMR. See also Section 7 *supra*, which addresses cancellation of CTM.

649 See Chapter five *infra*, where the doctrine of CTM conversion is addressed.

650 See Rules 122 and 123 of the CTMIR.

651 Cf. Articles 3(4) and 3ter(2) of the Madrid Protocol.

registration is granted. He only needs to state whether a CTM application forms a basis for international registration or he waits until the CTM is granted. OHIM will act and submit an application for international registration to the international Bureau according to the trademark proprietor's wishes. In addition to observing the OHIM's official languages, the applicant for international registration must ensure that a translation in the language allowed under the Protocol is submitted. This is a case where the application submitted to OHIM is in a language (though OHIM's language) other than those allowed under the Madrid Protocol.<sup>652</sup>

However, "where a mark that is the subject of a national or regional registration in the Office of a contracting party is also the subject of an international registration and both registrations stand in the name of the same person, the international registration is deemed to replace the national or regional registration".<sup>653</sup>

This legal assumption does not apply if both registrations are not identical in terms of ownership, goods or services and where the national or regional registration is not senior to international registration. On this understanding, an international registration granted based on national or regional application for trademark registration is not useful in the context of replacement.

Although replacing national or regional registration with international registration results in an ostensible cheapness of renewal fees, it is advisable not to forgo earlier national or regional rights until such a period when dependency of rights lapses.<sup>654</sup> Moreover, relying on a CTM application or registration to secure international registration is not completely a safe venture to undertake. In practice many months will elapse before OHIM publishes the examination report. Moreover, a greater proportion of CTM applications are opposed.<sup>655</sup> The likelihood of the international trademark registration being opposed is exacerbated by the fact that, in practice, OHIM does not substantively examine on relative grounds (for conflict with earlier marks),<sup>656</sup> but simply carries out a

652 While OHIM's languages are English, French, German, Italian and Spanish (*cf.* Article 119(2) of the CTMR), the Protocol's languages are English, French and Spanish (*cf.* Rule 6(b) of the Common Regulations under the Agreement and the Protocol).

653 Article 4bis (1) of the Protocol.

654 *Cf.* FIRTH, A., et al, "Trade Marks – Law and Practice" (2nd ed.) 258 (Jordan Publishing, Ltd., Bristol 2005). Regarding dependency of rights refer to Article 6(2) and (3) of the Madrid Protocol.

655 *Cf.* FIRTH, A., et al, "Trade Marks – Law and Practice" (2nd ed.) 260 (Jordan Publishing, Ltd., Bristol 2005).

656 With regard to international registration, OHIM only checks the application in relation to entitlement to file on the basis of indication made in the OHIM form EM2 or WIPO Form MM2(Cf. Rule 103(2)(f) of the CTMIR).

search and reports the outcome.<sup>657</sup> Given the fact that the EU membership ranges to 27 Member States, the scope of opposition against CTM registration is considerable.<sup>658</sup>

657 Cf. Article 38 of the CTMR.

658 Cf. FIRTH, A., et al, “Trade Marks – Law and Practice” (2nd ed.) 260 (Jordan Publishing, Ltd., Bristol 2005).