

NOTE FOR FILING FORM MM16: SUBSEQUENT DESIGNATION RESULTING FROM CONVERSION (EUROPEAN UNION)

Form MM16 (Optional): Request for recording of subsequent designation resulting from conversion (European Union) (Rule 24 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks).

Please refer to our [Guide to the International Registration of Marks](#) for further detailed information concerning the application, registration and management of international marks.

IMPORTANT INFORMATION

PURPOSE OF THE FORM

You may use this form to request the recording of subsequent designation resulting from conversion of a designation of the European Union (EU).

However, given that the request must be submitted to WIPO by the European Union Intellectual Property Office (EUIPO), it is **highly recommended** that holders use the form prepared by the EUIPO available online: <https://euipo.europa.eu/ohimportal/en/online-requests-apply-now>.

WHAT IS CONVERSION?

Where the international registration contains a designation of the EU that ceases to exist under the applicable law, the holder may request that the EU designation be converted into a subsequent designation in one or more countries of the EU¹. This may be beneficial, for example, where the EU designation – which is unitary in nature – has been refused protection following an opposition based on grounds that only apply to one EU country. The holder in that situation may seek to convert the EU designation into individual designations in the EU countries not affected by those grounds. The date of the subsequent designation(s) resulting from conversion will benefit from the date of the designation of the EU, as recorded in the International Register.

Conversion of an EU designation may not always be possible. Therefore, you are advised to check with the EUIPO the grounds precluding conversion before filing a request for the recording of subsequent designation resulting from conversion.

Further, conversion is not to be confused with “transformation”, which is a feature of the Madrid System that applies following the ceasing of effect of the basic mark and the consequential cancellation of the international registration.

For further information, please see: [Information Notice No. 2/2004](#) and Rule 24(7) of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

¹ With the exception of Malta, because it is not yet a member of Madrid System.

HOW TO SUBMIT THIS FORM

You must present a request for conversion directly to the EUIPO. The general time limit for requesting conversion is three months, but the start of the time limit depends on the ground for conversion. You will need to check this with the EUIPO. The EUIPO will examine the request for compliance with the conditions under the EU legislation before transmitting the request to WIPO.

For more information, contact the EUIPO:

European Union Intellectual Property Office (EUIPO)

Address: Avenida de Europa, 4
E-03008 Alicante
Spain

Telephone: +34 965 139 100

Fax: +34 965 131 344

E-mail: information@euipo.europa.eu

Website: <https://euipo.europa.eu/ohimportal/en/contact-us>

FEE INFORMATION

Please use the [Fee Calculator](#) to help you estimate your fees.

The fees for requesting a subsequent designation or designations resulting from conversion will depend on the number of EU countries subsequently designated, their applicable fees and the number of classes of goods and services that you wish to protect your mark for.

Please see the [Schedule of Fees](#) for further information concerning the applicable fees.

HOW TO PAY THE FEES

You can pay the fees:

- by debiting the required amount from a [Current Account at WIPO](#), or
- from funds that you have already transferred to WIPO, or
- by transferring the required fees into WIPO's postal account (within Europe only) or bank account.

E-MAIL ADDRESS OF THE HOLDER AND WIPO'S ONLINE SERVICES

Where you have not already done so, for example, in the international application, you must provide (or update) your e-mail address using [Contact Madrid](#) (under "My request concerns" select the topic "a change in contact details of the holder"). Holders cannot indicate the e-mail address of their representative as their own. Therefore, the e-mail address of the holder and of the representative must be different.

Please note, WIPO will not include the e-mail address of applicants, holders or representatives on the Madrid System online information services (e.g., Madrid Monitor, Madrid Real-time Status) nor publish such information in the *WIPO Gazette of International Marks*.

Where a representative is appointed, WIPO will send all communications **only** to the e-mail address of the representative².

Where a representative is not appointed, WIPO will send all communications to the e-mail address provided for the holder or to the alternative e-mail address for correspondence where one has been provided.

E-mail is the fastest, most efficient and secure means for WIPO to transmit information effectively to its users. You will receive time-sensitive electronic communications from Offices of designated Contracting Parties without delay. If you have already provided an e-mail address, please ensure it is up to date.

WIPO has developed a number of useful online tools and services. To have access to these tools and services you will need a WIPO Account. The WIPO Account will give you access to WIPO's online tools and services that have been designed to help you manage in one place your entire portfolio of internationally registered trademarks that are recorded with the same e-mail address.

Monitoring your request

[Madrid Monitor](#) provides real-time monitoring of requests as they are being processed by WIPO. To monitor the status of your request, click the “Real-time Status” tab when viewing a specific record, or enter your international registration number in the “Real-time Search” tab in Madrid Monitor.

HOW TO FILL IN FORM MM16

The form must be typed. WIPO cannot accept handwritten forms.

NUMBER OF CONTINUATION SHEETS

If the space available in any part of the form is not sufficient, please use a “Continuation Sheet” at the last page of the form and indicate the number of continuation sheets attached here.

Where there is more than one holder, please complete the dedicated “Continuation Sheet for Several Holders”.

² Where a representative has been appointed, WIPO will not send communications directly to the applicant or holder. There are a few exceptions to this rule:

- where the appointment of a representative is irregular, WIPO will inform both the applicant or holder and the purported representative;
- six months before the expiry of the term of protection, WIPO will send an unofficial notice to both the holder and the representative;
- where insufficient fees are paid for the purpose of renewal, WIPO will notify both the holder and the representative;
- where an international registration is not renewed or is not renewed in respect of a designated Contracting Party, WIPO will send a notification to the holder and the representative;
- where cancellation of the appointment is requested by the representative, WIPO will, until such time as the cancellation becomes effective, send communications to both the applicant or holder and the representative.

REFERENCE NUMBERS

The holder and the EUIPO may indicate their own internal file reference number. WIPO will include these reference numbers in any further communication concerning this form.

ITEM 1: INTERNATIONAL REGISTRATION NUMBER

Indicate the full international registration number, for example 123456 or 123456A.

You can only indicate one international registration number per form MM16.

ITEM 2: HOLDER OF THE INTERNATIONAL REGISTRATION

If there is more than one holder, indicate the total number of holders and then the name and address for the first holder only. Please provide the name(s) and address(es) of the additional holder(s) in the “Continuation Sheet for Several Holders” attached.

Item 2(a): Name

Indicate the holder’s name exactly as recorded in the International Register.

Item 2(b): Address

Indicate the holder’s address exactly as recorded in the International Register.

If you wish to add, update or delete your e-mail address, phone number or your address for correspondence, you must submit a request to WIPO using [Contact Madrid](#) (under “My request concerns”, select the topic “a change in contact details of the holder”) for this purpose.

ITEM 3: GROUND FOR THE CONVERSION OF THE DESIGNATION OF THE EUROPEAN UNION

You must indicate the ground for conversion by checking the appropriate box.

Where the designation of the EU:

- *has been the subject of a final refusal:* Check this box if the designation of the EU has been totally or partially refused by the EUIPO. The time limit of three months for requesting conversion starts from the date of the final decision refusing protection.
- *has not been renewed before WIPO and the possibility to renew the mark has lapsed:* Check this box if the designation of the EU has not been renewed and the six months grace period (following the due date for renewal) has expired. The time limit of three months for requesting conversion starts from the date of expiry of the grace period.
- *has been the subject of a partial cancellation:* Check this box if the designation of the EU has been the subject of a partial cancellation (some of the goods and services have been removed). The time limit of three months for requesting conversion starts from the date of the recording of the partial cancellation in the International Register.

- *has been subject of an invalidation by the EUIPO or the European Union Trade Mark (EUTM) Court:* Check this box if the designation of the EU has been invalidated by the EUIPO or the EUTM Court. The time limit of three months for requesting conversion starts from the date of the decision or date the judgement is final.
- *has been the subject of a renunciation:* Check this box if the designation of the EU has been renounced (before WIPO) and the renunciation is recorded in the International Register. The time limit of three months for requesting conversion starts from the date of the recording of the renunciation in the International Register.

ITEM 4: DESIGNATED CONTRACTING PARTIES

You must indicate the designated Contracting Parties (countries) for which protection for the mark is sought by checking the corresponding boxes³.

By indicating Ireland (IE), the holder has declared an intention to use the mark in that country in connection with the goods and services identified in the respective designation.

ITEM 5: GOODS AND SERVICES

Please check only **one** box.

Item 5(a)

Check this box, if the subsequent designation is for all designated Contracting Parties (EU countries selected in this request) for all the goods and services of the EU designation.

Item 5(b)

Check this box if the subsequent designation is for all the designated Contracting Parties (EU countries selected in this request), but for only some of the goods and services covered by the designation of the EU. The goods and services concerned must be listed in the continuation sheet (grouped together according to the Nice Classification).

Item 5(c)

Check this box, if the subsequent designation is for only some of the Contracting Parties (EU countries selected in this request) for only some of the goods and services covered by the designation of the EU. Use the continuation sheet to identify the EU countries and goods and services concerned (grouped according to the Nice Classification). Any Contracting Parties (EU countries) selected in Item 4 not listed in the continuation sheet will be designated for all goods and services covered by the designation of the EU.

³ If you wish to protect your mark in Malta, you will need to file a national conversion with the EUIPO, as it is not a member of the Madrid Protocol.

When the request concerns only some of the goods and services covered by the EU designation

You must expressly indicate all the goods and services for which you seek protection of your mark in the designated countries concerned. If you only indicate goods and services in a particular class, WIPO will consider that you do not seek protection for the other classes covered by the EU designation.

Version and Edition of the Nice Classification

When your request concerns only some of the goods and services covered by the EU designation, you must not reclassify those goods and services in accordance with the edition and version of the Nice Classification in force on the date of the subsequent designation. Instead, the list must follow the classification with which the mark was registered.

For example, the list of goods and services in an international registration recorded in the year 2000 would have been classified according to the edition of the Nice Classification in force that year (i.e., the seventh edition). Any subsequent designation for a limited list of goods and services would have to follow that classification, regardless of the date on which that subsequent designation is made.

WIPO will not reclassify the list of goods and services of a subsequent designation to match the latest version and edition of the Nice Classification.

ITEM 6: SIGNATURE BY THE OFFICE OF THE EUROPEAN UNION (EUIPO)

This item should only be filled out by the Office (EUIPO) presenting the form.

FEE CALCULATION SHEET

You must complete the “Fee Calculation Sheet” annexed to the form. You will need to calculate and indicate the amount of fees (unless the fee is to be debited from a Current Account at WIPO) and provide details of your chosen method of payment.

Where no payment or insufficient payment has been received by WIPO, the holder and the holder’s representative (where applicable) will be notified of an irregularity.

(a) Instructions to Debit from a Current Account

Where the fee is to be debited from a Current Account at WIPO, check the box and indicate the following:

Holder of the account

Indicate the name of the holder of the Current Account.

Account number

Insert the five-digit account number.

Identity of the party giving the instructions

Indicate the name of the party giving the payment instructions, which could be the holder, representative or third party.

There is no need to calculate and indicate the amount of fees to be debited from a Current Account at WIPO.

If you choose this method of payment, WIPO will debit the required amount, subject to the availability of sufficient funds. This method of payment avoids the risk of making an insufficient payment.

To know how to open a Current Account at WIPO, please, use the following link: [Current Account at WIPO](#).

(b) Amount of Fees

If you have not provided any instructions above to debit the required fee from a Current Account at WIPO, please use the [Fee Calculator](#) to help you estimate the amount of fees to pay.

The amount of fees payable will depend on the number of Contracting Parties subsequently designated as a result of conversion, their applicable fees and the number of classes of goods and services.

Applicable fees

When requesting a subsequent designation resulting from conversion of a designation of the EU, you must pay a basic fee of 300 Swiss francs.

In addition to the basic fee, you will need to pay the fees for each of the Contracting Parties you wish to convert into subsequent designations, which can be either complementary fees, or individual fees.

Complementary fees

A complementary fee of 100 Swiss francs for each designated Contracting Party is payable where the Contracting Parties designated have not declared for individual fees.

Individual fees

Some Contracting Parties charge an individual fee. Where an individual fee has been declared, you will pay that fee instead of the complimentary fee, except where the designated Contracting Party and the Contracting Party of the holder are both States bound by the Protocol and the Agreement, in which case, a complementary fee is payable. Please check the amount of the individual fee here: [Individual Fees](#).

Do not forget to indicate the Grand Total in the form (in Swiss francs).

(c) Method of Payment

Identity of the party effecting the payment

It is important to identify the party who is making the payment (name of the holder, the representative, or a third party).

Payment received and acknowledged by WIPO

Check this box where funds were previously received and acknowledged by WIPO. You need to provide the identity of the party who made the payment and the WIPO receipt number (issued when WIPO acknowledged your transfer).

Payment made to WIPO Bank Account or Postal Account (within Europe only)

Where the fee is transferred to a WIPO bank or postal account, check the respective box and indicate the following:

Payment identification

When transferring funds to WIPO (bank or postal transfers), please provide your bank or post office with the following details, and enter this information in the “Payment identification” field in the form:

- ✓ Name of the party making the payment and complete address;
- ✓ [Transaction code](#): enter the code (EX) for subsequent designations;
- ✓ The mark or verbal elements of mark (if available);
- ✓ Name of the holder (if different than the name of the party making the payment).

dd/mm/yyyy

Indicate the date of the payment, in day, month and year.

[End of Note for Filing Form MM16]