

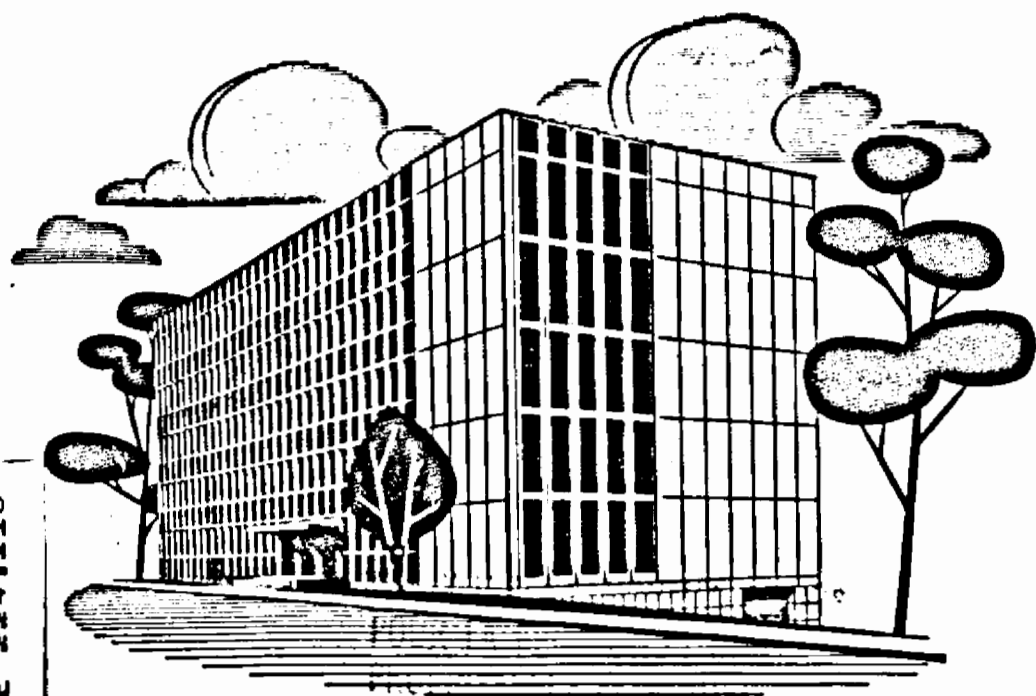
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UNITED INTERNATIONAL BUREAU FOR
THE PROTECTION OF INTELLECTUAL PROPERTY

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MADRID
TRADEMARKS

MADRID AGREEMENT
CONCERNING THE INTERNATIONAL
REGISTRATION OF TRADEMARKS





GENEVA
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MADRID AGREEMENT

CONCERNING THE INTERNATIONAL REGISTRATION OF TRADEMARKS

**OF APRIL 14, 1891,
AS REVISED AT NICE
ON JUNE 15, 1957**

Article 1

(1) The countries to which this Agreement applies form a Special Union concerning the international registration of marks.

(2) Nationals of any of the contracting countries may, in all the other countries parties to this Agreement, secure protection for their marks applicable to goods or services, registered in the country of origin, by filing the said marks at the International Bureau for the Protection of Industrial Property through the intermediary of the Administration of the said country of origin.

(3) Shall be considered as the country of origin the country of the Special Union where the applicant has a real and effective industrial or commercial establishment; if he has no such establishment in a country of the Special Union, the country of the Special Union where he is domiciled; if he has no domicile in the Special Union, the country of his nationality, if he is a national of one of the countries of the Special Union.

Article 2

Nationals of countries which have not acceded to this Agreement, who, within the territory of the Special Union constituted by this Agreement, satisfy the conditions of Article 3 of the Paris Convention for the Protection of Industrial Property, shall be treated in the same manner as nationals of contracting countries.

Article 3

(1) Every application for international registration must be presented on the form prescribed by the Regulations; the Administration of the country of origin of the mark shall certify that the particulars appearing in the application are in accordance with the particulars in the national register, and shall indicate the dates and numbers of the application and registration of the mark in the country of origin and also the date of the application for international registration.

(2) The applicant shall indicate the goods or services in respect of which the protection of the mark is claimed and also, if possible, the corresponding class or classes, according to the classification established by the Nice Agreement concerning the International Classification of Goods and Services to which Trademarks are Applied. If the applicant does not give this indication, the International Bureau shall classify the goods or services in the appropriate classes of the said classification. The indication of the classes given by the applicant shall be subject to control by the International Bureau, which will exercise it in association with the national Administration. In the event of disagreement between the national Administration and the International Bureau, the opinion of the latter shall prevail.

(3) If the applicant claims color as a distinctive feature of his mark, he shall be obliged:

1. to mention this fact, and to accompany his application with a statement indicating the color or the combination of colors claimed;
2. to append to his application copies in color of the said mark, which shall be attached to the notifications made

by the International Bureau. The number of such copies shall be fixed by the Regulations.

(4) The International Bureau shall register immediately the marks filed in accordance with Article 1. The registration shall bear the date of the application for international registration in the country of origin provided that the application has been received by the International Bureau within a period of two months from that date. If the application has not been received within that period, the International Bureau shall register it with the date on which the International Bureau received the application. The International Bureau shall notify the registration without delay to the Administrations concerned. The marks registered shall be published in a periodical journal issued by the International Bureau, utilizing the particulars contained in the application for registration. With regard to marks comprising a figurative element or a special form of writing, the Regulations shall determine whether a printing block must be supplied by the applicant.

(5) In view of the publicity to be given in the contracting countries to registered marks, each Administration shall receive from the International Bureau a number of copies of the said publication free and a number of copies at a reduced price, in proportion to the number of units, according to the provisions of Article 13 (8) of the Paris Convention for the Protection of Industrial Property, under the conditions set out in the Regulations. This publicity shall be considered in all contracting countries as fully sufficient, and no other publicity may be required of the applicant.

Article 3 bis

(1) Any contracting country may, at any time, notify the Government of the Swiss Confederation in writing that the protection resulting from the international registration shall not extend to that country unless the proprietor of the mark expressly requests it.

(2) This notification shall not take effect until six months after the date of its communication by the Government of the Swiss Confederation to the other contracting countries.

However, this period shall not apply in the case of countries which avail themselves, at the time of their ratification or accession, of the faculty provided for in paragraph (1).

Article 3^{ter}

(1) Any request for the extension of the protection resulting from an international registration to a country which has availed itself of the faculty provided for in Article 3^{bis} must be specially mentioned in the application referred to in Article 3 (1).

(2) Any request for territorial extension made subsequently to the international registration must be presented through the intermediary of the Administration of the country of origin on a form prescribed by the Regulations. It shall be immediately registered by the International Bureau, which shall notify it without delay to the Administration or Administrations concerned. It shall be published in the periodical journal issued by the International Bureau. This territorial extension shall be effective from the date on which it is recorded in the International Register; it shall cease to be valid on the expiration of the international registration of the mark to which it relates.

Article 4

(1) From the date of the registration thus effected at the International Bureau in accordance with the provisions of Articles 3 and 3^{ter}, the protection of the mark in each of the contracting countries concerned shall be the same as if the mark had been directly filed there. The indication of the classes of the goods or services provided for in Article 3 shall not bind the contracting countries with regard to the determination of the scope of the protection of the mark.

(2) Every mark which has been the subject of an international registration shall enjoy the right of priority provided by Article 4 of the Paris Convention for the Protection of Industrial Property, without requiring compliance with the formalities provided for in section D of that Article.

Article 4bis

(1) When a mark already filed in one or more contracting countries is subsequently registered by the International Bureau in the name of the same proprietor or his successor in title, the international registration shall be considered as replacing the earlier national registrations, without prejudice to any rights acquired by such earlier registrations.

(2) The national Administration shall, upon request, be required to take note in its registers of the international registration.

Article 5

(1) In countries where the legislation so authorizes, the Administrations notified by the International Bureau of the registration of a mark or a request for extension of protection made in accordance with Article 3ter shall have the faculty to declare that protection cannot be granted to such mark in their territory. Any such refusal can be based only on grounds which would apply, by virtue of the Paris Convention for the Protection of Industrial Property, in the case of marks filed for national registration. However, protection may not be refused, even partially, for the sole reason that national legislation would not permit registration except in a limited number of classes or for a limited number of goods or services.

(2) The Administration exercising this faculty must notify its refusal to the International Bureau, with an indication of all grounds, within the period prescribed by its domestic law and, at the latest, before the expiration of one year calculated from the international registration of the mark or from the request for extension of protection made in accordance with Article 3ter.

(3) The International Bureau shall, without delay, transmit to the Administration of the country of origin and to the proprietor of the mark, or to his agent, if an agent has been indicated to the Bureau by the said Administration, one of the copies of the declaration of refusal thus notified. The interested party shall have the same

remedies as if the mark had been filed by him directly in the country where protection is refused.

(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party requesting them.

(5) Administrations which, within the above-mentioned maximum period of one year, have not communicated to the International Bureau any provisional or final decision of refusal with regard to the registration of a mark or a request for extension of protection shall lose the benefit of the faculty provided in paragraph (1) of this Article with respect to the mark in question.

(6) The invalidation of an international mark may not be pronounced by the competent authorities without the proprietor of the mark having, in good time, been afforded the opportunity of proving his rights. Invalidation shall be notified to the International Bureau.

Article 5bis

Documents showing the legitimacy of the use of certain elements included in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, or names of persons other than the name of the applicant, or other like inscriptions which might be required by the Administrations of contracting countries, shall be exempt from any authentication or certification other than that of the Administration of the country of origin.

Article 5ter

(1) The International Bureau shall issue to any person making application therefor, subject to a fee fixed by the Regulations, a copy of the entries in the Register in connection with a specific mark.

(2) The International Bureau may also, upon payment, undertake searches for anticipation among international marks.

(3) Extracts from the International Register requested with a view to their production in one of the contracting countries shall be exempt from all authentication.

Article 6

(1) Registration of a mark at the International Bureau is effected for twenty years (subject to the provisions of Article 8 concerning cases where the applicant has paid only part of the international fee), with the possibility of renewal according to the conditions set out in Article 7.

(2) On the expiration of a period of five years from the international registration, such registration shall become independent of the national mark previously registered in the country of origin, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it was the subject of a transfer, may no longer be invoked, in whole or in part, if, within five years from the date of the international registration, the national mark, previously registered in the country of origin in accordance with Article 1, no longer enjoys, in whole or in part, legal protection in that country. The same applies if this legal protection has subsequently ceased as the result of an action begun before the expiration of the period of five years.

(4) In the case of voluntary or ex officio cancellation, the Administration of the country of origin shall request the cancellation of the mark at the International Bureau, and the latter shall effect this operation. In the case of judicial action, the said Administration shall send to the International Bureau, ex officio or at the request of the plaintiff, a copy of the complaint or other document showing that an action has been started and also of the final decision of the court; the Bureau shall note them in the International Register.

Article 7

(1) Any registration may be renewed for a period of twenty years, to be counted from the expiration of the preceding period, simply by the payment of the basic fee and, where necessary, of the supplementary and complementary fees provided for in Article 8 (2).

(2) The renewal may not include any change in relation to the previous registration in its latest form.

(3) The first renewal effected after the entry into force of this Act shall include an indication of the classes of the International Classification to which the registration relates.

(4) Six months before the expiration of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the proprietor of the mark and his agent of the exact date of expiration.

(5) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be granted for the renewal of the international registration.

Article 8

(1) The Administration of the country of origin may fix, at its own discretion, and collect, for its own benefit, a national fee which it may require from the proprietor of the mark in respect of which international registration or renewal is applied for.

(2) Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which will include:

- (a) a basic fee of 200 Swiss francs for the first mark, and of 150 Swiss francs for each additional mark filed at the same time as the first;
- (b) a supplementary fee of 25 Swiss francs for each class of the International Classification, beyond three, in which the goods or services to which the mark is applied will be placed;
- (c) a complementary fee of 25 Swiss francs per country for any request for extension of protection in accordance with Article 3*ter*.

(3) However, the supplementary fee referred to in paragraph (2) (b) may, without prejudice to the date of registration, be paid within a period fixed by the Regulations if the number of classes of goods or services has been fixed or disputed by the International Bureau. If, upon expiration of the said period, the supplementary

fee has not been paid or the list of goods or services has not been reduced to the required extent by the applicant, the application for international registration shall be considered as abandoned.

(4) The annual returns from the various receipts from international registration, with the exception of those provided for under (b) and (c) of paragraph (2), shall be divided equally among the countries parties to this Act by the International Bureau, after deduction of the expenses and charges necessitated by the carrying out of the said Act.

If, at the time this Act comes into force, a country has not yet acceded either to the Hague Act or to the London Act, it shall be entitled, until the date of entry into force of its accession, only to a share of the excess of receipts calculated on the basis of the earlier Acts.

(5) The amounts derived from the supplementary fees provided for in paragraph (2) (b) shall be divided at the expiration of each year among the countries parties to this Act, in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being affected, in the case of countries which make a preliminary examination, by a coefficient which shall be determined by the Regulations.

(6) The amounts derived from the complementary fees provided for in paragraph (2) (c) shall be divided according to the provisions of paragraph (5) among the countries availing themselves of the faculty provided for in Article 3 *bis*.

(7) With regard to the basic fee, the applicant shall be entitled to pay, at the time of the application for international registration, a basic sum of only 125 Swiss francs for the first mark, and only 100 Swiss francs for each additional mark filed at the same time as the first.

(8) If the applicant avails himself of this faculty, he shall, before the expiration of a period of ten years, counted from the international registration, pay to the International Bureau, as the balance of the basic fee, 100 Swiss francs for the first mark, and 75 Swiss francs for each additional mark filed at the same time as the first, failing

which, at the expiration of this period, he shall lose the benefit of his registration. Six months before such expiration, the International Bureau shall, by sending an unofficial notice, remind the applicant and his agent of the exact date of expiration. If the balance of the basic fee is not paid to the International Bureau before the expiration of this period, the Bureau shall cancel the mark, shall notify this operation to the national Administrations, and shall publish it in its journal. If the balance due for marks filed at the same time is not paid at one and the same time, the applicant shall specify the marks for which he intends to pay the balance and pay 100 Swiss francs for the first mark of each series.

(9) With regard to the above-mentioned period of ten years, the provisions of Article 7 (5) shall apply by analogy.

Article 8bis

The person in whose name the international registration stands may at any time renounce protection in one or more contracting countries by means of a declaration filed with the Administration of his own country, for communication to the International Bureau, which shall notify the countries for which renunciation has been made. Renunciation shall not be subject to any fee.

Article 9

(1) The Administration of the country of the person in whose name the international registration stands shall likewise notify to the International Bureau all annulments, cancellations, renunciations, transfers and other changes made in the entry of the mark in the national register, if such changes also affect the international registration.

(2) The Bureau shall enter these changes in the International Register, shall notify them in turn to the Administrations of the contracting countries, and shall publish them in its journal.

(3) A similar procedure shall be followed when the person in whose name the international registration stands

requests that the list of goods or services to which the mark is applied be reduced.

(4) These operations may be subject to a fee, which shall be fixed by the Regulations.

(5) The subsequent addition of new goods or services to the said list can be obtained only by filing a new application in accordance with the provisions of Article 3.

(6) The substitution of one of the goods or services for another shall be treated as an addition.

Article 9^{bis}

(1) When a mark entered in the International Register is transferred to a person established in a contracting country other than the country of the person in whose name the international registration stands, the transfer shall be notified to the International Bureau by the Administration of the latter country. The International Bureau shall record the transfer, shall notify it to the other Administrations, and shall publish it in its journal. If the transfer has been effected before the expiration of a period of five years from the international registration, the International Bureau shall seek the consent of the Administration of the country of the new proprietor, and shall publish, if possible, the date and registration number of the mark in the country of the new proprietor.

(2) No transfer of a mark recorded in the International Register for the benefit of a person who is not entitled to file an international mark shall be recorded.

(3) When it has not been possible to record a transfer in the International Register, either because the country of the new proprietor has refused its consent or because it has been made for the benefit of a person who is not entitled to apply for international registration, the Administration of the country of the former proprietor shall have the right to demand that the International Bureau cancel the mark in its Register.

Article 9^{ter}

(1) If the assignment of an international mark for part only of the registered goods or services is notified

to the International Bureau, the Bureau shall record it in its Register. Each of the contracting countries shall have the right to refuse to recognize the validity of the assignment if the goods or services included in the part thus assigned are similar to those in respect of which the mark remains registered for the benefit of the assignor.

(2) Similarly, the International Bureau shall record an assignment of the international mark for only one or several of the contracting countries.

(3) If, in the above cases, a change in the country of the proprietor takes place, the Administration of the country to which the new proprietor belongs shall, if the international mark has been transferred before the expiration of a period of five years from the international registration, give the consent required by Article 9*bis*.

(4) The provisions of the preceding paragraphs are applicable subject to Article 6*quater* of the Paris Convention for the Protection of Industrial Property.

Article 9*quater*

(1) If several countries of the Special Union agree to effect the unification of their domestic laws relating to marks, they may notify the Government of the Swiss Confederation:

- (a) that a common Administration is substituted for the national Administration of each of them, and
- (b) that the whole of their respective territories must be considered as a single country for the purposes of the application of all or part of this Agreement.

(2) This notification shall not take effect until six months after the date of its communication by the Government of the Swiss Confederation to the other contracting countries.

Article 10

(1) The Administrations shall by common accord regulate the details for carrying out this Agreement.

(2) There shall be established, at the International Bureau, a Committee of the Directors of the National

Industrial Property Offices of the Special Union. It shall meet upon convocation by the Director of the International Bureau or at the request of five countries, parties to the Agreement, at intervals of not more than five years. It shall appoint from among its members a limited Council to which specified tasks may be assigned and which shall meet at least once a year.

(3) The functions of this Committee are consultative.

(4) However:

- (a) subject to the general jurisdiction of the High Supervisory Authority, it may, on the reasoned proposal of the Director of the International Bureau, and with the unanimous consent of the countries represented, change the amounts of the fees provided for in Article 8 of this Agreement;
- (b) it shall establish and amend, with the unanimous consent of the countries represented, the Regulations of this Agreement;
- (c) the Directors of the National Industrial Property Offices may delegate their powers to the representative of another country.

Article 11

(1) The countries of the Union for the Protection of Industrial Property which have not participated in this Agreement shall be permitted to accede to it at their request and in the form prescribed by Article 16 of the Paris Convention for the Protection of Industrial Property. This accession shall be valid only for the Act of the Agreement as last revised.

(2) As soon as the International Bureau is informed that a country, or the whole or part of the countries or territories for the external relations of which it is responsible, has acceded to this Agreement, it shall address to the Administration of that country, in accordance with Article 3, a collective notification of the marks which, at that moment, enjoy international protection.

(3) This notification, of itself, shall assure to the said marks the benefits of the foregoing provisions in the territory of the acceding country, and shall mark the com-

mencement of the period of one year during which the Administration concerned may make the declaration referred to in Article 5.

(4) However, any country when acceding to this Agreement may declare that, except in the case of international marks which have already been the subject in that country of an earlier identical national registration still in force, and which shall be immediately recognized upon the request of the interested parties, the application of this Act shall be limited to marks registered from the date when its accession has entered into force.

(5) Such a declaration shall dispense the International Bureau from making the collective notification referred to above. The International Bureau shall notify only the marks in respect of which it receives, within a period of one year from the accession of the new country, a request, with the necessary particulars, for the admission of the exception referred to in the preceding paragraph.

The International Bureau shall not make the collective notification to countries which, in acceding to the Madrid Agreement, declare that they are availing themselves of the faculty provided for in Article 3*bis*. These countries may also declare at the same time that the application of this Act shall be limited to marks registered from the day on which their accessions enter into force; however, this limitation shall not affect international marks which have already been the subject of an earlier identical national registration in these countries, and which could give rise to requests for extension of protection made and notified in conformity with Article 3*ter* and Article 8 (2) (c).

(6) Registrations of marks which have been the subject of one of the notifications provided for in this Article shall be regarded as replacing registrations directly effected in the new contracting country before the date of entry into force of its accession.

(7) The provisions of Article 16*bis* of the Paris Convention for the Protection of Industrial Property shall apply to this Agreement.

Article 11bis

In the event of denunciation of this Agreement, the provisions of Article 17bis of the Paris Convention for the Protection of Industrial Property shall apply. International marks registered up to the date on which denunciation becomes effective, and not refused within the period of one year referred to in Article 5, shall continue, throughout the period of international protection, to enjoy the same protection as if they had been directly filed in the denouncing country.

Article 12

(1) This Agreement shall be ratified and the ratifications shall be deposited at Paris as soon as possible.

(2) It shall come into force between the countries by which it has been ratified or acceded to in accordance with Article 11 (1), when twelve countries at least have ratified or acceded to it, two years after the deposit of the twelfth instrument of ratification or accession has been notified to them by the Government of the Swiss Confederation, and it shall have the same force and duration as the Paris Convention for the Protection of Industrial Property.

(3) In the case of countries which deposit their instrument of ratification or accession after the deposit of the twelfth instrument of ratification or accession, it shall enter into force in accordance with the provisions of Article 16 of the Paris Convention. However, this entry into force shall be subject in all cases to the expiration of the period provided for in the preceding paragraph.

(4) This Act shall, in all the relations among the countries by which it has been ratified or acceded to, replace, as from the day on which it enters into force with respect to them, the Madrid Agreement of 1891, in its texts earlier than this Act. However, any country which has ratified this Act or has acceded to it shall remain bound by the earlier texts in its relations with countries which have not ratified or acceded to it, unless that country has expressly declared that it no longer wishes to be bound by those texts. This declaration shall be notified to the Govern-

ment of the Swiss Confederation. It shall not be effective until twelve months after its receipt by the said Government.

(5) The International Bureau shall, in agreement with the countries concerned, provide for the administrative measures of adaptation which will be called for with a view to carrying out the provisions of this Agreement.

**MEMBER STATES OF THE MADRID UNION
(TRADEMARKS)**

(May 1, 1967)

Austria	Netherlands
Belgium	Portugal
Czechoslovakia	Rumania
France	San Marino
Germany (Fed. Rep.) ¹	Spain
Hungary	Switzerland
Italy	Tunisia
Liechtenstein	United Arab Republic
Luxembourg	Viet-Nam
Monaco	Yugoslavia
Morocco	

¹ Member States disagree on the question of whether East Germany or the German Democratic Republic is to be considered as a party to this Agreement.

