

**GUIDE**

**TO THE INTERNATIONAL REGISTRATION OF MARKS**

**UNDER THE MADRID AGREEMENT**

**AND THE MADRID PROTOCOL**

(updated September 2009)



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## **PREFACE**

This Guide is primarily intended for applicants for, and holders of, international registrations of marks, as well as officials of the competent administrations of the member States of the Madrid Union. It leads them through the various steps of the international registration procedure and explains the essential provisions of the Madrid Agreement, the Madrid Protocol and the Common Regulations.

The Guide is updated from time to time. Readers are encouraged to address to the International Bureau their comments and suggestions for improvements.



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<i>Rule 32(2)</i>	A.04.30, 07.02		
<i>Rule 32(2)(i)</i>	B.II.98.03	<i>A.I. Section 11 (b)</i>	B.I.03.04
<i>Rule 32(2)(iv)</i>	B.I.08.03	<i>A.I. Section 11 (c)</i>	B.I.03.05
<i>Rule 32(2)(v)</i>	B.I.05.03	<i>A.I. Section 12(a)</i>	B.II.07.08
<i>Rule 32(3)</i>	A.07.05	<i>A.I. Section 12(b)</i>	B.II.07.08
<i>Rule 33(1)</i>	A.09.01; B.II.15.04	<i>A.I. Section 12(c)</i>	B.II.07.08
<i>Rule 33(2)</i>	A.09.02; B.II.15.04	<i>A.I. Section 12(d)</i>	B.II.07.09, 07.22
<i>Rule 33(3)</i>	A.09.02, 09.03, 09.04	<i>A.I. Section 14</i>	B.II.18.06
<i>Rule 34(2)</i>	A.04.28	<i>A.I. Section 16</i>	B.II.67.01
<i>Rule 34(2)(a)</i>	B.I.08.02	<i>A.I. Section 17</i>	B.II.68.04
<i>Rule 34(2)(b)</i>	B.I.08.03	<i>A.I. Section 18</i>	B.II.69.04
<i>Rule 34(3)</i>	B.II.07.87, 26.05, 27.02	<i>A.I. Section 19</i>	B.I.08.05
<i>Rule 34(3)(a)</i>	A.04.18		
<i>Rule 34(5)</i>	B.I.08.08		
<i>Rule 34(6)</i>	B.I.08.10		
<i>Rule 34(7)(a)</i>	B.I.08.11		
<i>Rule 34(7)(b)</i>	B.I.08.12		
<i>Rule 34(7)(d)</i>	B.I.08.13; B.II.77.06		
<i>Rule 34(7)(e)</i>	B.I.08.14		
<i>Rule 35(1)</i>	A.04.28; B.I.08.04		
<i>Rule 36(i)</i>	B.I.12.08; B.II.49.01		
<i>Rule 36(ii)</i>	B.II.48.06		
<i>Rule 36(iii)</i>	B.II.56.15		
<i>Rule 36(iv)</i>	B.II.56.15		
<i>Rule 39</i>	A.04.29; B.I.03.06; B.II.102.01		
<i>Rule 39(1)</i>	B.II.102.02		
<i>Rule 39(3)</i>	B.II.102.04		
<i>Rule 39(4)</i>	B.II.102.05		
<i>Rule 40(2)(c)</i>	B.II.75.01		
<i>Rule 40(3)</i>	B.II.75.02		
<i>Rule 40(3)(a)</i>	B.II.41.02		
<i>Rule 40(4)</i>	B.I.07.05; B.II.20.04, 54.06, 63.04, 80.06, 85.04		
<i>Rule 40(5)</i>	B.II.2603		
<i>A.I. Section 2</i>	B.II.07.03-04		
<i>A.I. Section 3</i>	B.II.37.01		
<i>A.I. Section 3(a)</i>	B.II.44.01		
<i>A.I. Section 4</i>	B.II.47.01, 54.01, 63.01		
<i>A.I. Section 4(f)</i>	B.II.94.03		
<i>A.I. Section 4(j)</i>	B.II.07.71		
<i>A.I. Section 5(a)</i>	B.II.49.01		
<i>A.I. Section 6</i>	B.I.02.01, 02.03; B.II.35.02		
<i>A.I. Section 6(a)</i>	B.I.04.04; B.II.35.02		
<i>A.I. Section 6(b)</i>	B.I.02.04; B.II.35.02		
<i>A.I. Section 7</i>	B.I.02.03, 03.09; B.II.07.76, 07.80, 35.02		
<i>A.I. Section 8</i>	B.I.02.01, 02.05, 02.07; B.II.35.02		
<i>A.I. Section 9(a)</i>	B.I.02.06; B.II.07.41, 35.02		
<i>A.I. Section 9(b)</i>	B.II.07.41, 35.02		
<i>A.I. Section 10</i>	B.II.35.02		
<i>A.I. Section 11</i>	B.I.02.01-02		
<i>A.I. Section 11(a)(i)</i>	B.I.03.01; B.II.35.02		

# PART A

## INTRODUCTION

### THE GUIDE

01.01 This is a Guide to both the Madrid Agreement Concerning the International Registration of Marks, hereinafter referred to as “the Madrid Agreement” or “the Agreement” (which was concluded in 1891 and entered into force in 1892), and the Protocol Relating to the Madrid Agreement, hereinafter referred to as “the Madrid Protocol” or “the Protocol” (which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996). Both treaties were adopted at Diplomatic Conferences held in Madrid, Spain. They are conveniently referred to jointly as “the Madrid system”.

01.02 The application of these two treaties is governed by two texts, namely the Common Regulations under the Madrid Agreement and Protocol (hereinafter referred to as “the Common Regulations” or “the Regulations”) and the Administrative Instructions for the Application of the Madrid Agreement and Protocol (hereinafter referred to as “the Administrative Instructions”).

01.03 The Guide is in three Parts. *Part A* gives a brief general introduction to the Madrid system. It includes explanations on how a State (or an intergovernmental organization which maintains its own system for registering marks) can become a member of the Madrid Union along with the texts of the different declarations and notifications which may be made under the Agreement, the Protocol or the Common Regulations. *Part B* deals with procedures, and is in two Chapters. *Chapter I* deals with general questions of procedure, such as the modalities of communications with the International Bureau, the calculation of time limits or the language regime. *Chapter II* describes the international registration procedure, as well as other procedures which may concern an international registration (for example, a subsequent designation or the recording in the International Register of a change in ownership). Finally, *Part C* contains the full texts of the Agreement, the Protocol, the Common Regulations and the Administrative Instructions.

01.04 Wherever possible, the provisions of the Agreement, the Protocol, the Regulations and the Administrative Instructions that are relevant to a particular paragraph of the Guide, are cited in the margin.

01.05 Provisions cited in the margin are noted as follows:

- “*A Article xx*” refers to an Article of the Agreement;
- “*P Article xx*” refers to an Article of the Protocol;
- “*Article xx*” refers to an Article in both the Agreement and the Protocol;

- “*Rule xx*” refers to a Rule of the Regulations;
- “*A.I. Section xx*” refers to a Section of the Administrative Instructions.

01.06 This Guide follows the practice of the Agreement, the Protocol and the Regulations in using the word “mark.” This is to be understood as referring equally to a trademark (for goods) or a service mark.

## **THE MADRID SYSTEM: BASIC FEATURES**

### **The Madrid Agreement and the Madrid Protocol**

02.01 The Madrid system of international registration of marks is administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland.

02.02 Together, the Contracting Parties to the Agreement and the Protocol constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention for the Protection of Industrial Property. (For further details on the members of the Union, and the meaning of “Contracting Party”, see paragraphs A.03.01 to 04.06).

02.03 Every member of the Madrid Union is a member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including the fixing of fees connected with the use of the Madrid system.

### **Who May Use the System?**

02.04 The Madrid system of international registration of marks may be used only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Madrid Agreement or the Madrid Protocol, or who has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a Member State of such an organization.

02.05 The Office of the Contracting Party with respect to which a person or entity fulfills one or more of the above conditions is referred to as the “Office of origin”. A mark may be the subject of an international registration, if it has been registered, or if its registration has been applied for in the Office of origin. However, where the international application is governed exclusively or partly by the Agreement, the mark may be the subject of an international registration only if it has already been registered in the Office of origin.

02.06 An application for international registration must designate one or more Contracting Parties in which the mark is to be protected. It may not designate the Contracting Party whose Office is the Office of origin. Further Contracting Parties may be designated subsequently. A Contracting Party may be designated only if that Contracting Party and the Contracting Party whose Office is the Office of origin are both party to the same treaty (Agreement or Protocol). The Madrid system of international registration cannot be used by a person or entity which does not have the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union. Furthermore, it cannot be used to protect a trademark outside the Madrid Union.

### **Brief Description of the System**

02.07 An application for international registration must be presented to the International Bureau through the Office of origin. Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the *WIPO Gazette of International Marks*.

02.08 The International Bureau notifies each Contracting Party in which protection has been requested, whether in the international application or subsequently. From the date of the international registration or subsequent designation, the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been deposited directly with the Office of that Contracting Party. Each designated Contracting Party has the right to refuse protection, within the time limits specified in the Agreement or Protocol. Unless such a refusal is notified to the International Bureau within the applicable time limit, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party. The time limit for a Contracting Party to notify a refusal is generally one year. Under the Protocol however, a Contracting Party may declare that this period is to be 18 months (or longer, in the case of a refusal based on an opposition).

02.09 For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the Office of origin. If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected. Similarly, where the international registration was based on an application in the Office of origin, it will be cancelled if, and to the extent that, that application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period. After the expiry of this period of five years, the international registration becomes independent of the basic registration or basic application.

02.10 An international registration may be maintained in force indefinitely by the payment, every 10 years, of the prescribed fees.

### **Advantages of the System**

02.11 International registration has several advantages for the owner of the mark. After registering the mark, or filing an application for registration, with the Office of origin, he has to file only one application in one language (English, French or Spanish), and pay fees to one Office instead of filing separately in the trademark Offices of the various Contracting Parties in different languages, and paying a separate fee in each Office.

02.12 Another important advantage for owners of marks lies in the fact that all changes subsequent to the international registration, such as a change in name and/or address of the holder, a (total or partial) change in ownership of the holder or a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties, may be recorded and have effect by means of a single procedure with the International Bureau and the payment of one fee.

02.13 In summary, the main advantages for trademark owners consist of the simplicity of the international registration system and the financial savings made when obtaining and maintaining the protection of their marks abroad.

02.14 International registration is also to the advantage of trademark Offices. For example, they do not need to examine for compliance with formal requirements, or classify the goods or services, or publish the marks. Moreover, part of the fees collected by the International Bureau is transferred to the Contracting Parties in which protection is sought. Furthermore, if the International Registration Service closes its biennial accounts with a profit, the proceeds are divided among the Contracting Parties.

### **Comparison Between the Agreement and the Protocol**

02.15 The Madrid Protocol was adopted in 1989 in order to introduce certain new features into the system of the international registration of marks, with the aim of removing the difficulties preventing certain countries from adhering to the Madrid Agreement. As compared with the Madrid Agreement, the Protocol introduces the following main innovations:

- the applicant may base his application for international registration on an application filed with the Office of origin; under the Agreement, an international application must be based on a registration in the Office of origin;

- each Contracting Party in which the applicant seeks protection may elect for a period of 18 months (instead of one year), and an even longer period in the case of opposition, within which to declare that protection cannot be granted to the mark in its territory;

- the Office of each Contracting Party may receive higher fees than under the Madrid Agreement;



– an international registration which is cancelled, at the request of the Office of origin, for example because the basic application has been refused or the basic registration has been invalidated within five years from the date of the international registration, may be transformed into national (or regional) applications in the respective Contracting Parties in which the international registration had effect, each benefiting from the date of the international registration and, where applicable, its priority date. This possibility does not exist under the Madrid Agreement.

### **Applicable Treaty**

02.16 The Madrid Agreement and the Madrid Protocol are independent, parallel treaties, with separate, but overlapping, memberships. It follows that, as long as all countries party to the Madrid Agreement have not joined the Protocol, there will be three groups of members of the Madrid Union: States party only to the Madrid Agreement, States and organizations party only to the Protocol, and States party to both the Madrid Agreement and the Protocol. The question then arises of which treaty will be binding between States party to both the Agreement and the Protocol.

- (a) Prior to September 1, 2008: Prevalence of the Agreement by Virtue of the Safeguard Clause

*P Article 9sexies(1)* 02.17 Prior to September 1, 2008, paragraph (1) of Article 9*sexies* of the Protocol, which was known as the “safeguard clause”, provided that where, with regard to a given international application or registration, the Office of origin or the Office of the Contracting Party of the holder, was the Office of a State party to both the Agreement and the Protocol, then the designation of a Contracting Party also bound by both treaties would be governed not by the Protocol, but by the Agreement.

02.18 In effect, therefore, in the case of an international application where the Office of origin, or in the case of an international registration the Office of the Contracting Party of the holder, was the Office of a Contracting Party bound by both treaties, a designation (whether in the application, or subsequently) of a Contracting Party bound only by the Protocol would have been governed by the Protocol, a designation of a Contracting Party bound only by the Agreement would have been governed by the Agreement, and, as a consequence of the safeguard clause, a designation of a Contracting Party bound by both treaties would have been governed by the Agreement. (As a whole, such an international registration would then have been an international registration governed by both the Agreement and the Protocol.)

02.19 In its original version, in force prior to September 1, 2008, paragraph (2) of Article 9*sexies* contained a provision that the Assembly of the Madrid Union might, by a three-fourths majority, repeal or restrict the scope of the safeguard clause after the expiry of a period of 10 years from the entry into force of the Protocol, but not before the expiry of a period of five years from the date on which the majority of States party to the Madrid Agreement had become party to the Protocol. These conditions having been fulfilled, the Assembly of the Madrid Union adopted, in

November 2007, an amendment of Article 9*sexies* consisting in a repeal of the safeguard clause accompanied, however, by an additional provision setting aside the application of certain declarations in the mutual relations between Contracting Parties bound by both the Agreement and the Protocol (see paragraphs A.02.21 to 02.25).

02.20 The amendment of Article 9*sexies* came into effect on September 1, 2008.

(b) As of September 1, 2008: Prevalence of the Protocol

02.21 As of September 1, 2008, the situation regarding the mutual relations of Contracting Parties bound by both treaties is regulated by a new provision, paragraph (1)(a) of Article 9*sexies* of the Protocol. Under this provision, where, with regard to a given international application or registration, the Office of origin, or the Office of the Contracting Party of the holder, is the Office of a State party to both the Agreement and the Protocol, then the designation of a Contracting Party also bound by both treaties will be governed not by the Agreement, but by the Protocol, which is the reverse of the situation described in paragraph A.02.17.

02.22 In effect, therefore, in the case of an international application where the Office of origin, or in the case of an international registration the Office of the Contracting Party of the holder, is the Office of a Contracting Party bound by both treaties, a designation (whether in the application, or subsequently) of a Contracting Party bound only by the Protocol will, of course, continue to be governed by the Protocol, a designation of a Contracting Party bound only by the Agreement will, likewise continue to be governed by the Agreement, and now, by virtue of new Article 9*sexies*(1)(a), a designation of a Contracting Party bound by both treaties will, instead of being governed by the Agreement, be governed by the Protocol.

02.23 Amended paragraph (1)(a) of Article 9*sexies* is accompanied by paragraph (1)(b), that renders inoperative a declaration under Article 5(2)(b), Article 5(2)(c) – providing for an extended refusal period – or Article 8(7) – allowing for the application of individual designation fees – of the Protocol, in the mutual relations between States bound by both treaties.

02.24 What this means, in effect, is that in the case of an international application where the Office of origin, or in the case of an international registration the Office of the Contracting Party of the holder, is the Office of a Contracting Party bound by both treaties, a designation (whether in the application, or subsequently) of a Contracting Party bound by both treaties will, while now being governed by the Protocol, and not the Agreement, nevertheless be subject to the standard regime of Article 5(2)(a) and of Articles 7(1) and 8(2) of the Protocol – that is, the time limit of one year for the notification of a provisional refusal, and the payment of supplementary and complementary fees, notwithstanding that the designated Contracting Party in question may have declared an extended period for notifying a provisional refusal or may have declared that it wishes to receive individual fees.

*P Article 9sexies(2)* 02.25 Paragraph (2) of Article 9*sexies* provides that the Assembly of the Madrid Union shall review the application of paragraph (1)(b) of Article 9*sexies* after a period of three years from September 1, 2008. Following this review, the Assembly may either repeal it or restrict its scope, by a three-fourths majority.

### **Change in the Treaty Applicable to the Recorded Designation of a Contracting Party Bound by Both the Agreement and the Protocol**

*Rule Ibis* 02.26 There may be a change in the treaty applicable to the *recorded* designation of a Contracting Party bound by both the Agreement and the Protocol. This would generally result from a specific case of change in ownership (see paragraph B.II.62.01) or, more exceptionally, from a denunciation of the Madrid Agreement by a Contracting Party (as was the case of Uzbekistan, for example, which denounced the Madrid Agreement with effect from January 1, 2008). More importantly, on September 1, 2008, that is, the date of entry into force of the repeal of the safeguard clause (see paragraphs A.02.16 to 02.25), all the designations that had been governed by the Agreement, because of the safeguard clause, (that is, the designations of Contracting Parties bound by both the Agreement and the Protocol and recorded in the name of holders entitled also under both treaties) became governed by the Protocol.

*Rule Ibis(1)(i) and (ii)* 02.27 The first condition for a change of the applicable treaty to occur in respect of a given recorded designation is that the treaty originally applicable ceases to apply in relations between the Contracting Party of the holder and the designated Contracting Party. Secondly, it is necessary that on the date on which the treaty theretofore applicable ceases to apply, both Contracting Parties are bound by the other treaty. It is, however, not necessary that these two Contracting Parties had been already bound by that other treaty on the date of effect of the designation concerned.

02.28 Provided the second condition is met, the change of the applicable treaty takes place at the moment the treaty originally applicable ceases to apply, and the identity of the treaty governing the designation, as a result of the change of the applicable treaty, will be reflected in the data accessible to Offices and third parties.

*Rule 18(1) and (2)* 02.29 As far as the refusal period is concerned, it should be noted that a change of treaty applicable to a given designation does not have an impact on the period in question, even where that period is still running. This results from the fact that the application of paragraph (1) and paragraph (2) of Rule 18 of the Common Regulations (dealing with irregular notifications of provisional refusal) is dependent on the expressions “*Contracting Party designated under the Agreement*” and “*Contracting Party designated under the Protocol*”. By virtue of Rule 1(xvii) and (xviii), these terms are, in turn, defined as *requests* for extension of protection. Thus, the refusal period is determined by reference to the situation which pertained at the time of filing and is unaffected by any subsequent change in the applicable treaty. However, it should be noted that, in that case, pending designations continue to be processed according to the treaty under which they are made, before being changed into designations governed by the other treaty.

*Rule 1(xvii) and (xviii)*

*Rule 25(1)(c)* 02.30 It is recalled that, pursuant to Rule 25(1)(c), a request for the recording of a renunciation or a cancellation which affects any Contracting Party whose designation is governed by the Agreement must be presented to the International Bureau through the Office of the Contracting Party of the holder (see paragraphs B.II.54.02 and 54.03). It should be noted, however, that the wording of Rule 25(1)(c) further specifies that this criterion is to be considered as of the date of receipt of the request by the International Bureau. Thus, a change of applicable treaty will not have any implications for requests for renunciation or cancellation that have been filed and are in the course of being processed by the International Bureau.

02.31 In effect, therefore, the only possible implications for holders, following the change of applicable treaty, will be the amount of fees payable on renewal (depending, of course, on whether a declaration for individual fees has been made) and the possibility of transformation, which is provided for only by the Protocol.

### **BECOMING PARTY TO THE AGREEMENT OR PROTOCOL**

*A Article 14(2)* 03.01 Any State which is a party to the Paris Convention for the Protection of  
*P Article 14(1)(a)* Industrial Property may become a party to the Agreement or the Protocol or both.

*P Article 14(2)* 03.02 A State which has signed the Protocol (which was open for signature until the end of 1989) may become a party by depositing an instrument of ratification, acceptance or approval (hereinafter referred to as an “instrument of ratification”).  
*A Article 14(2)(a)* Otherwise a State may become a party to the Agreement or Protocol by depositing an instrument of accession.

*P Article 14(1)(b)* 03.03 An intergovernmental organization may, by depositing an instrument of accession, become a party to the Protocol (but not the Agreement), provided the following conditions are fulfilled:

– at least one of the member States of the organization is a party to the Paris Convention; and

– the organization has a regional Office for the purpose of registering marks with effect in its territory (provided that such Office is not the subject of a notification under Article 9*quater* of the Protocol (see paragraphs A.04.02 to 04.04)).

*Rule 1(iii)* 03.04 The expression “Contracting Party” includes any country which is a party to the Agreement or any State or intergovernmental organization which is a Party to the Protocol.

*Article 14(3)* 03.05 Instruments of ratification or accession must be deposited with the Director General of WIPO (hereinafter referred to as “the Director General”. The  
*A Article 17(5)* Director General will notify all Contracting Parties of any deposits of instruments of  
*P Article 16(5)* ratification of, or accession to, the treaty (Agreement or Protocol) to which they are a party, and of any declarations which are included in such instruments. With respect

*Article 14(4)(b)* to a given Contracting Party, the Agreement or the Protocol will enter into force three months after the instrument of ratification or accession has been so notified by the Director General, unless (in the case of the Agreement) a later date has been indicated in the instrument of accession.

## DECLARATIONS AND NOTIFICATIONS BY CONTRACTING PARTIES

04.01 The Agreement, Protocol and Regulations provide for the possibility for Contracting Parties to make certain declarations and notifications concerning the operation of the international registration system.

### Common Office of Several States

*Article 9quater* 04.02 Several States which are all party to the Agreement, or all party to the Protocol, and have agreed to adopt uniform legislation on marks, may notify the Director General that a common Office for the registration of marks is to be substituted for the national offices of each of them, and that the whole of their respective territories is to be considered as a single State for the purposes of the Agreement or Protocol. Such a notification takes effect (in the case of the Agreement) six months or (in the case of the Protocol) three months after it has been communicated by the Director General to the other Contracting Parties.

04.03 Where such a notification has been made, the Office concerned is not regarded as the Office of an intergovernmental organization (see paragraph A.03.03); it is the respective States who are parties to the treaty (Agreement or Protocol), not the common Office or any organization under which it is constituted.

04.04 Only one such notification has been made – the Benelux Office for Intellectual Property, which registers marks having effect in Belgium, Netherlands and Luxembourg, has been constituted as a common Office under the Agreement and the Protocol.<sup>1</sup>

### Territorial Effect

*A Article 3bis* 04.05 Any country may, when acceding to the Agreement, or at any time thereafter, notify the Director General that the protection resulting from an international registration will extend to that country only at the express request of the holder. In fact all countries currently party to the Agreement have made such a notification. Thus an international registration will have effect only in those countries which have been expressly designated, either in the international application or subsequently.

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<sup>1</sup> Until September 1, 2006, the Benelux Office for Intellectual Property (BOIP) was known as the Benelux Trademarks Office and the Benelux Designs Office. The BOIP is an institution of the Benelux Organisation for Intellectual Property.

- P Article 3bis* 04.06 There is no provision for such a notification under the Protocol. Thus, protection of an international registration under the Protocol extends only to a Contracting Party which has been expressly designated.

## **Limitation Concerning Existing Marks**

### **Under the Agreement**

- A Article 14(2)(f)* 04.07 A country may also declare, when acceding to the Agreement, that application of the Agreement shall be limited to international registrations effected from the date on which its accession becomes effective. This limitation, however, does not apply where the mark which is the subject of the international registration had already been, at the time of accession, the subject of an earlier identical national registration in the country concerned. Where a country has made this declaration, therefore, an international registration effected prior to the date on which that country became bound by the Agreement can be the subject of a subsequent designation of that country only if the mark had, prior to that date, already been identically registered in that country. If this is not the case, then protection can only be obtained through the Madrid Agreement by submitting a new application for international registration designating that country.

### **Under the Protocol**

- P Article 14(5)* 04.08 Any State or intergovernmental organization may, when ratifying or acceding to the Protocol, declare that no international registration effected under the Protocol before the date of entry into force of the Protocol with respect to that State or organization can be extended to it. Such a declaration cannot be made subsequent to ratification or accession.

## **Extension of Time for Notifying Refusal**

- P Article 5(2)(b)* 04.09 Any Contracting Party to the Protocol may declare that, in connection with an international registration in which it is designated under the Protocol, the time limit for its Office to notify a refusal of protection shall be 18 months instead of one year. Such a declaration may also specify that a refusal of protection which results from an opposition may, under certain conditions, be notified after the expiry of this 18-month period.
- P Article 5(2)(c)*
- P Article 9sexies(1)* 04.10 It is recalled, however, that paragraph (1)(b) of Article 9*sexies* renders inoperative a declaration under Article 5(2)(b) and (c) between States that are both bound by both the Agreement and the Protocol (see paragraphs A.02.21 to 02.25).
- P Article 5(2)(d)* 04.11 A declaration under Article 5(2)(b) and (c) may be made in the instrument of ratification or accession. It may also be made subsequently, in which case it will come into effect three months after its receipt by the Director General.

## Notification of Decisions Following a Provisional Refusal of Protection

*Rule 17(5)(d)* 04.12 The Office of a Contracting Party may declare that, in accordance with its legislation, any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such review has been requested by the holder, and any decision taken on the said review may be the subject of a further review or appeal before the Office.

04.13 Where this declaration applies, and the Office is not in a position to communicate the said decision directly to the holder, the statement (in accordance with Rule 18*ter*(2) or (3)) indicating that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or for some of them, or indicating that the total provisional refusal is confirmed in the Contracting Party concerned, shall be sent by the Office to the International Bureau, notwithstanding the fact that all procedures before the Office have not yet been completed. Any new decision affecting the protection of the mark shall be addressed to the International Bureau, in accordance with Rule 18*ter*(4).

04.14 This declaration is intended for Offices which (for practical or legal reasons) are not in a position to communicate directly to the holder (or his representative) a decision following an *ex officio* review of the provisional refusal. The sending of the decision to the International Bureau, which in turn transmits it to the holder (or representative), means that holders are not deprived of the possibility of requesting further review by the Office.

*Rule 17(5)(e)* 04.15 The Office of a Contracting Party may declare that, in accordance with its legislation, an *ex officio* provisional refusal that is notified to the International Bureau is not open to review before the Office. Where this declaration applies, any *ex officio* provisional refusal issued by the Office shall be deemed to include the statement provided for in Rule 18*ter*(2)(ii) or (3) (which is normally notified only after all procedures before the Office have been completed) indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned, or confirming the total provisional refusal of the protection of the mark in the Contracting Party concerned.

## Individual Fees

*P Article 8(7)(a)* 04.16 Any Contracting Party to the Protocol may declare that, in connection with each international registration in which it is designated under the Protocol (whether in the international application or subsequently), and in connection with the renewal of such registration, it wants to receive a so-called “individual fee”. The amount of any such fee is determined by that Contracting Party and it must be indicated in the declaration; it may be changed by subsequent declarations. It may not be higher than the fee which the Office of the Contracting Party would receive for registering that mark for a period of ten years, or for the renewal of such registration for a period of ten years, after deduction of the savings resulting from the international procedure. Such savings are expected to accrue, because, for example,

the international procedure spares the Offices of Contracting Parties formality examination, the classification of goods and services, or publication of the internationally registered mark.

*P Article 8(7)(b)* 04.17 The declaration concerning individual fees may be made in the instrument of ratification or accession. It may also be made subsequently, in which case it will come into effect three months after its receipt by the Director General, or at a later date indicated in the declaration. In such a case, an individual fee will be payable only in respect of an international registration or subsequent designation whose date is the same as, or later than, the effective date of the declaration.

*Rule 34(3)(a)* 04.18 A Contracting Party that makes or has made a declaration concerning individual fees may also notify the Director General that the individual fee comprises two parts, the first part to be paid at the time of filing the international application or the subsequent designation of that Contracting Party and the second part to be paid at a later date, determined in accordance with the law of that Contracting Party (in practice, when the Office considers, following substantive examination, that the mark fulfills the conditions for protection). This payment in two parts is intended to reflect the procedure for payment applicable in that Contracting Party, namely the fact that, at the national level, an applicant may be required to pay an application fee at the time of filing and, only if the application is accepted, a registration fee.

04.19 There is no provision specifying the date of entry into force of such a notification. That being so, if it is made at the same time as the declaration requiring the payment of an individual fee, it will enter into force at the same time as that declaration. If the notification is made after the declaration concerning an individual fee, it will enter into force on a date agreed between the International Bureau and the Office concerned (taking into account, in particular, the time needed to publish the declaration).

*P Article 8(7)(a)* 04.20 Where a Contracting Party has not made a declaration that it wishes to receive an individual fee, it receives a share in the revenue produced by the supplementary and complementary fees (see paragraphs B.II.07.84 to 07.89). By making a declaration that it wishes to receive individual fees, a Contracting Party agrees to forego such a share.

04.21 An individual fee may be charged only in respect of a designation which is effected under the Protocol and, then again, only to the extent that its application is not set aside by Article 9*sexies*(1)(b) (see paragraphs A.02.23 and 02.24). Where the designation is effected under the Agreement (that is, where the country of origin and the country designated are both party to the Agreement, even if both are also party to the Protocol), it is the complementary fee (and, where applicable, the supplementary fee), and not the individual fee that is payable.



## **Presentation of Subsequent Designations**

*Rule 7(1)* 04.22 Under Rule 7(1), as in force before October 4, 2001, any Contracting Party to the Protocol could notify the Director General that, where its Office was the Office of origin for an international registration, and the holder's address was in its territory, it required subsequent designations under the Protocol to be presented to the International Bureau through its Office. This provision has been deleted by the Assembly of the Madrid Union, with effect from October 4, 2001, with the result that no further notification may be made under this provision. Notifications made before that date, however, remain in force until they are withdrawn. The Assembly recommended that the Contracting Parties concerned should take steps to withdraw their notifications as soon as possible. Such withdrawal may be made at any time and shall take effect on the date of receipt by the Director General of the notice of withdrawal or at any later date indicated in the notice.

04.23 Where no such notification is in force, subsequent designations under the Protocol may be presented by the holder directly to the International Bureau. Whether or not this notification has been made, however, subsequent designations under the Agreement must always be presented through an Office.

## **Declaration of Intention to Use the Mark**

*Rule 7(2)* 04.24 Where a Contracting Party requires a declaration of intention to use the mark whenever it is designated under the Protocol, it must notify that fact to the Director General. Where the Contracting Party requires the declaration to be signed by the applicant himself (that is, a signature by a representative is not sufficient), or to be made on a separate official form annexed to the international application, the notification should contain statements to that effect and should specify the exact wording of the required declaration. Where the Contracting Party requires that the declaration be in a specified one of the three official languages (even where the international application is not in such language), the notification should specify the required language.

*Rule 7(3)(a)* 04.25 Such a notification may be made in the instrument of ratification or accession. It may also be made subsequently, in which case it will come into effect three months after its receipt by the Director General, or at a later date indicated in the notification. The notification may be withdrawn at any time; the withdrawal will have effect upon receipt of the notice of withdrawal, or at a later date indicated in the notice.

*Rule 7(3)(b)*

## **Declaration that the Recording of Licenses in the International Register Has No Effect**

*Rule 20bis(6)(a)* 04.26 The Office of a Contracting Party whose legislation does not provide for the recording of trademark licenses may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party. Such declaration may be made at any time. There is, however, no provision for it to be withdrawn.

- Rule 20bis(6)(b)* 04.27 The Office of a Contracting Party whose legislation *does* provide for the recording of trademark licenses may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party. Such declaration may only be made before the date of entry into force of Rule 20bis (namely April 1, 2002) or before the date on which the Contracting Party becomes bound by the Agreement or the Protocol. It may be withdrawn at any time.

### **Collecting and Forwarding Fees**

- Rule 34(2)* 04.28 Fees which are payable in connection with international registrations may be paid by the applicant or holder directly to the International Bureau. An Office of a Contracting Party may, however, allow an applicant or holder to pay the fees through that Office. An Office which agrees to collect fees and forward them to the International Bureau should notify the Director General of that fact. Any fees paid to the International Bureau should be in Swiss currency, irrespective of the fact that an Office may have collected such fees in another currency.
- Rule 35(1)*

### **Continuation of Effects in Successor State**

- Rule 39* 04.29 Any State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting Party “the predecessor Contracting Party”), may deposit with the Director General a declaration of continuation, the effect of which is that the Agreement, the Protocol, or both the Agreement and the Protocol are applied by the successor State. Where such a declaration has been deposited, the holder of an international registration which had effect in the predecessor Contracting Party before a date notified by the successor State may request that the protection of the international registration continue in the successor State (see also paragraphs B.II.102.01 to 102.05).

### **Publication of Notifications and Declarations**

- Rule 32(2)* 04.30 Any notifications or declarations of the kind referred to above will be published in the periodical gazette issued by the International Bureau.

### **FEE REDUCTION FOR APPLICANTS FROM LEAST DEVELOPED COUNTRIES (LDCS)**

04.31 Applicants having a real and effective industrial or commercial establishment, or a domicile in a least developed country, or being a national of a least developed country (in accordance with the list established by the United Nations), and who file their international applications through the trademark office of such country, as the office of origin, will be required to pay only 10% of the

amount of the basic fee. This is reflected in the Schedule of Fees and has been incorporated in the fee calculator on the Madrid website [www.wipo.int/madrid/en/fees/calculator.jsp](http://www.wipo.int/madrid/en/fees/calculator.jsp)).

04.32 The list of least developed countries is maintained and updated on a regular basis by the United Nations and may be consulted on the United Nations website at [www.un.org](http://www.un.org). The list may also be consulted on the WIPO website ([www.wipo.int/lcds/en/country](http://www.wipo.int/lcds/en/country)).

## **FURTHER INFORMATION ABOUT THE MADRID SYSTEM**

05.01 Much information about the system of international registration of marks is available on WIPO's Internet website ([www.wipo.int](http://www.wipo.int)) under the heading *Trademarks/Madrid System*. As well as general information, this site includes:

- the full text of the Agreement, the Protocol, the Common Regulations and the Administrative Instructions;
- the full text of the present Guide;
- a list of the Contracting Parties to the Agreement and the Protocol, together with an indication of the date on which they became bound by the respective treaties and any declarations they have made under the Agreement or Protocol or with respect to the territorial extent of their ratification of or accession to the treaties;
- information concerning the laws and practices of individual Contracting Parties;
- the official and optional forms issued by the International Bureau;
- the current fees, including individual fees;
- an online fee calculator and a downloadable spreadsheet for calculating the fees (including individual fees) payable in connection with an international application, a subsequent designation or the renewal of an international registration;
- an electronic payment interface (“E-Payment”) for the payment of fees owed with respect to international applications or registrations, as notified in WIPO irregularity letters or any other WIPO communication indicating the amount of the fees due in the relevant time limit. These payments may be made by credit card or through a WIPO current account;
- an electronic interface (“E-Renewal”) for renewing international registrations. The payment of renewal fees may be made by credit card or through a WIPO current account.

- information notices issued by the International Bureau (for example, concerning new accessions or changes to the Regulations);
- annual statistics relating to international registrations;
- information concerning meetings and seminars;
- the daily update files of the ROMARIN database (ROMARIN stands for “**R**ead-**O**nly-**M**emory **A**ctive **R**egistry **I**nformation”);
- the *WIPO Gazette of International Marks*; and
- under the heading *Online Services*, the Madrid Express Database, which includes data on all registrations that are currently in force, or have expired within the past six months, in addition to data relating to international applications and subsequent designations that have been received by the International Bureau but have not yet been recorded in the International Register, and the ROMARIN database, which contains more detailed information on all international registrations in force (see paragraphs A.08.01 and 09.04).

## **PUBLIC INFORMATION ABOUT INTERNATIONAL REGISTRATIONS**

06.01 Anyone wishing to obtain information about the contents of the International Register, or about a particular international registration, or general information about the operation of the system of international registration of marks, has access to the following sources of information:

### **The Gazette**

*Rule 32(1)* 07.01 The *WIPO Gazette of International Marks* (hereinafter referred to as “the Gazette”) is published every week on the Madrid System website ([www.wipo.int/madridgazette/en](http://www.wipo.int/madridgazette/en)). It contains all relevant data on new international registrations, renewals, subsequent designations and changes and other entries affecting international registrations. The bibliographic data is identified by the WIPO INID codes (INID stands for “**I**nternationally agreed **N**umbers for the **I**dentification of **D**ata”), that is, the codes of Standard ST.60 (“**R**ecommendation concerning bibliographic data relating to marks”) and Standard ST.3 (“**R**ecommended standard two-letter code for the representation of States, other entities and international organizations issuing or registering industrial property titles”). The various codes used in the Gazette and the bibliographic data to which they relate are given in each issue of the Gazette.

*Rule 32(2)* 07.02 The Gazette also contains information of general interest such as declarations and notifications made by Contracting Parties under the Agreement, the Protocol or the Regulations regarding particular requirements, the amounts of individual fees under Article 8(7) of the Protocol or information on the days on which

the International Bureau is not scheduled to be open to the public. This latter information and a summary of the declarations and notifications made by Contracting Parties is published in issues Nos. 6, 12, 18 and 24 of the Gazette.

07.03 Since the first edition of 2009, the Gazette is no longer available on paper, this version having been suspended and replaced by an electronic version that is available on the Madrid System website: [www.wipo.int/madridgazette/en](http://www.wipo.int/madridgazette/en). The Gazette is also available on DVD-ROM and online in PDF format, which can be viewed at the same address, namely [www.wipo.int/madridgazette/en](http://www.wipo.int/madridgazette/en). The DVD-ROM edition is published every four weeks and is cumulative, so that the first disc of each year contains all the data published in the first four issues of the paper edition, the second disc contains all the data published in the first eight issues, and so on. It is possible to take out an annual subscription to the Gazette (on DVD-ROM) with the International Bureau. Orders should be addressed to the Marketing and Distribution Section of WIPO or to the WIPO Electronic Library.

07.04 In respect of each year, the International Bureau publishes an index indicating all the international registrations, with the names of the holders, in respect of which an entry was published in the Gazette during that year. This index is available on the DVD-ROM version of the final issue of the Gazette.

*Rule 32(3)* 07.05 The Office of each Contracting Party is entitled to receive a number of free copies of the Gazette (on DVD-ROM) which is dependent on the number of designations of that Contracting Party during the previous year. In addition, the Office may purchase, at half of the subscription price, the same number of copies as it is entitled to receive free of charge.

## **ROMARIN**

08.01 The current status of all international registrations in force is published by the International Bureau on DVD-ROM and on-line (distributed under the mark ROMARIN). This electronic publication comprises one DVD containing the bibliographic data of all international registrations in force and the images of marks registered which consist of or contain special characters or figurative elements; this disc is published every four weeks. Data not yet published on disc is made available through daily ROMARIN update files downloadable from Internet. As from January 1, 2007, the ROMARIN on-line version, which is updated daily, is available to the public, free of charge on the Internet at [www.wipo.int/madrid/en/romarin](http://www.wipo.int/madrid/en/romarin).

08.02 ROMARIN provides a powerful search tool for trademark attorneys and agents. While, however, every effort is made to ensure that the information in ROMARIN accurately reflect the data recorded in the International Register, the only official publication remains the Gazette and the only official statements by the International Bureau regarding the contents of the International Register for a given international registration remain the certified extracts from the Register established on request by the International Bureau (see paragraphs A.10.01 to 10.03).

08.03 The International Bureau continues to seek to improve the scope of the information available to users on ROMARIN. To that end, where relevant, the database contains a statement in respect of the designation of each Contracting Party in an international registration to the effect that, although the time limit for the notification of a provisional refusal has expired, the International Bureau has not recorded any such notification of provisional refusal.

08.04 In addition, since January 1, 2009, the International Bureau has made available on ROMARIN digitalized copies of notifications of provisional refusal, statements of confirmation of total provisional refusal (called, before September 1, 2009, “confirmation of provisional refusal”), statements of grant of protection following a provisional refusal (called, before September 1, 2009, “withdrawal of provisional refusal”), statements of grant of protection where no notification of provisional refusal has been communicated, statements indicating that the *ex officio* examination is completed but that a mark’s protection can still be subject to opposition or observations by third parties, further decisions or further invalidation notifications received by the International Bureau since January 1, 2005 and having a corresponding registration in the international register, are accessible directly by users of the ROMARIN database in PDF format under the corresponding heading and INID code. The abovementioned information and statements are included as well as those received by the International Bureau (and, in particular, only in the language in which they were issued).

### **Electronic Database (Madrid Express)**

- Rule 33(1)* 09.01 The International Bureau maintains an electronic database in which are held all the data both recorded in the International Register and published in the Gazette.
- Rule 33(2)* 09.02 If an international application or subsequent designation is not recorded in the International Register within three working days following its receipt by the International Bureau, the data contained in it will nonetheless be entered forthwith in the electronic database. This is notwithstanding any irregularities that may exist in the international application or designation as received. Data so entered is, however, accompanied by a warning that the International Bureau has not yet made a decision as to whether the international application or subsequent designation complies with applicable requirements.
- Rule 33(3)* 09.03 The electronic database, located at the United Nations International Computing Center in Geneva, is accessible to Offices of Contracting Parties, under arrangements to be made with the International Bureau, for on-line consultation. There is no charge for the consultation of the database; access costs, on the other hand (telecommunication costs and the cost of the computer time used), are to be borne by the user.

*Rule 33(3)* 09.04 For the general public, data concerning the current status of all international registrations in force, as well as international applications and subsequent designations which have not yet been published in the Gazette, is accessible in searchable form on the Internet under the heading *Online Services* (see paragraph A.05.01). A more detailed history of all international registrations in force is available on the ROMARIN database, also available to the public at [www.wipo.int/madrid/en/romarin](http://www.wipo.int/madrid/en/romarin) (see paragraphs A.08.01 to 08.04).

### **Extracts from the International Register**

*Article 5ter(1)* 10.01 On payment of the fee prescribed in the Schedule of Fees, anyone may obtain from the International Bureau a certified copy of the entries in the International Register concerning a given mark. Two types of extracts are available:

– a detailed certified extract contains a photocopy of the international registration as originally published in the Gazette, with details of any subsequent changes, refusals, invalidations, corrections and renewals recorded in the International Register at the time the extract is prepared;

– a simple certified extract consists of certified copies of all entries that have been published in the Gazette concerning the international registration and any notification of refusal received by the International Bureau at the time the extract is prepared.

A request for an extract should indicate the number and date of the international registration with respect to which an extract is requested and the type of extract requested.

*Article 5ter(3)* 10.02 Such extracts from the International Register may be produced in legal proceedings in a Contracting Party. A Contracting Party may not require that the extract be subject to legalization.

10.03 Also on payment of the prescribed fee, anyone may obtain from the International Bureau an attestation or information in writing on any entry in the International Register concerning a given mark.

### **Annual Statistics**

11.01 The International Bureau publishes, for each calendar year, as a supplement to the Gazette, a statistical report summarizing activity under the Madrid Agreement and Protocol during that year, including, in particular, the number of international registrations recorded, broken down according to the Office of origin, the number of times each Contracting Party has been designated and the number of refusals notified by each Contracting Party. For comparison, corresponding figures for preceding years are also given. The annual statistics, together with those for previous years (starting with 1997) are also published on the Internet (see paragraph A.05.01).





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# **PART B**

## **PROCEDURE**

### **CHAPTER I: GENERAL**

#### **INTRODUCTION**

This Chapter is concerned with procedural matters which are of interest both to applicants and holders and also to Offices. It deals with communications with the International Bureau (including the modalities of communication, the calculation of time limits and the language of communication), the payment of fees and with representation before the International Bureau.

#### **COMMUNICATIONS WITH THE INTERNATIONAL BUREAU**

01.01 Three kinds of communications are, in principle, possible:

- between the International Bureau and the Office of a Contracting Party;
- between the International Bureau and the applicant or holder, or his representative;
- between the applicant or holder (or representative) and an Office.

01.02 Communications which do not involve the International Bureau (that is, communications between an Office and an applicant or holder or a representative) are outside the scope of the Agreement and Protocol and of the Regulations. They are a matter for the law and practice of the Contracting Party concerned.

01.03 Communications between the International Bureau and an Office or applicant or holder are governed, as regards the form and the manner of communicating and such matters as language and the effective date of the communication, by the Regulations and the Administrative Instructions. In particular, the Regulations sometimes allow the applicant or holder to choose whether to communicate directly with the International Bureau or through an Office. Often, however, such choice is not given. In particular, an international application must always be filed through the Office of origin.

01.04        Unless otherwise specified, where this Guide refers to a communication being sent to or by an applicant or holder, this is to be understood as meaning that, where a representative is recorded in the International Register for that applicant or holder, the communication will be sent to, or may validly be sent by, that representative (see paragraphs B.I.11.03 to 11.05).

### **Modalities of Communications**

*A.I. Sections 6, 8 and 11*    02.01        Communications between an applicant or holder and the International Bureau must be in writing, and may take place by electronic means, at a time and in a manner and format to be determined by the International Bureau. Communications between an Office and the International Bureau may be in writing or, where an Office so desires, by electronic means in a way agreed upon between the International Bureau and the Office concerned.

#### **Communications in Writing**

- A.I. Sections 8 and 11*    02.02        Communications addressed to the International Bureau may be delivered by hand, sent by mail (through a postal or other delivery service) or by facsimile, or by electronic means.
- A.I. Section 6*        02.03        Any communication in writing which is addressed to the International Bureau must be typed or otherwise printed. Handwritten communications are not acceptable. The communication must be signed. The signature may be handwritten, printed or stamped, or may be replaced by a seal. There is no need to indicate in letters the name of the person whose seal is used.
- A.I. Section 7*
- A.I. Section 6(b)*    02.04        If several documents are mailed to the International Bureau in one envelope, they should be accompanied by a list identifying each one of them. The International Bureau will inform the sender of any discrepancy between the list and what is actually received.

#### ***Facsimile***

- A.I. Section 8*        02.05        Any communication may be sent to the International Bureau by facsimile. Where a communication is required to be presented on an official form, that form must be used for the purposes of any facsimile communication.
- A.I. Section 9(a)*    02.06        Where a communication has been sent to the International Bureau by facsimile, the original document must not be sent, since there is a risk that it will be mistaken for a new communication. There is one exception to this rule: where the international application is sent by the Office of origin to the International Bureau by facsimile, that Office must also send the original of the page of the international application bearing the reproduction(s) of the mark.

*A.I. Section 10(a)* 02.07 Provided the sender can be identified and can be reached by facsimile, the International Bureau will promptly inform him, by facsimile, of the receipt of the facsimile communication, and of any deficiencies in the transmission (for example, if it is incomplete or illegible).

*A.I. Section 10(b)* 02.08 Where, because of a time difference between Geneva and the place from which it was sent, the date on which the transmittal of a communication by facsimile was started is different from the date on which it was received by the International Bureau, the earlier of the two dates shall be considered to be the date of receipt by the International Bureau.

### Electronic Communications

*A.I. Section 11(a)(i)* 03.01 Any communication between an Office and the International Bureau, including the presentation of an international application, may be made by electronic transmission. The modalities for such communication, including the presentation of the content of official forms and the means for self-identification of the sender, are a matter for agreement between each Office and the International Bureau.

03.02 The International Bureau has already established electronic communications with a number of Offices and a substantial proportion of international applications are now transmitted electronically to the International Bureau. Electronic communication is also used by a number of Offices for the transmission of refusals, statements of grant of protection and modifications. In addition, the number of Offices to which the International Bureau sends notifications electronically continues to increase.

*A.I. Section 11(a)(ii)* 03.03 Communications between the International Bureau and applicants and holders may also take place by electronic means, at a time and in a manner and format to be determined by the International Bureau. The particulars of the modality of such communications will be published in the Gazette.

*A.I. Section 11(b)* 03.04 Provided the sender can be identified and can be reached, the International Bureau will promptly, by electronic transmission, confirm receipt of the electronic communication, and of any deficiencies in the transmission (for example, if it is incomplete or illegible).

*A.I. Section 11(c)* 03.05 Where, because of a time difference between the place from where an electronic communication has been sent and Geneva, the date on which the transmittal of a communication by electronic means was started is different from the date on which it was received by the International Bureau, the earlier of the two dates shall be considered to be the date of receipt by the International Bureau.

*Rule 30* 03.06 In 2006, WIPO introduced an online international trademark renewal service enabling users to maintain their trademark rights simply and economically and, more recently, online facilities were made available to users wishing to file a request for the continuation of protection of their trademarks in accordance with *Rule 39* of the Common Regulations.

03.07 Furthermore, the International Bureau offers to users the possibility of receiving electronically a number of communications, such as notifications of provisional refusal, copies of statements of grant of protection and copies of statements of confirmation of total provisional refusal. For that purpose, holders and their representatives are invited to communicate to the International Bureau an e-mail address that they wish the International Bureau to use as the sole address where those communications are to be sent.

03.08 Users may take advantage of this service by sending an e-mail message to *e-marks@wipo.int* indicating the e-mail address which they wish the International Bureau to use for this purpose, as well as the list of all international registrations concerned. Further information in this regard is available in Information Notice No. 15/2007 on the Madrid website (*www.wipo.int*). The International Bureau will commence sending the communications in question by e-mail within one month following receipt of the e-mail address. The notifications concerned are transmitted as attachments in PDF format. It is the intention of the International Bureau to introduce, in due course, a wider range of inbound electronic communications from users.

*A.I. Section 7* 03.09 As regards the electronic communications referred to in Section 11(a)(i) of the Administrative Instructions, a signature may be replaced by a mode of identification agreed upon between the International Bureau and the Office concerned. With respect to the electronic communications referred to in Section 11(a)(ii), a signature may be replaced by a mode of identification to be determined by the International Bureau.

### Official Forms

*Rule 1(xxvii)*  
*A.I. Section 2* 04.01 Where the Agreement, Protocol or Regulations require the use of an official form, this refers to a form established by the International Bureau. Copies of the forms are available from the International Bureau, from Offices of Contracting Parties and on WIPO's website.

04.02 As an alternative to using a form produced by the International Bureau, Offices, applicants or holders may generate their own forms. Such self-generated forms will be acceptable to the International Bureau provided that they have the same contents and format as the official forms. Where, however, such a form is presented through an Office (for example, for an international application), it is for the Office to decide whether it is acceptable (see paragraph B.I.04.07).

04.03 The items in such self-generated forms need not have the same spacing and layout as in the forms established by the International Bureau. Indeed, one advantage of producing such forms is that as much space can be allocated to a given item as is needed; for example, where an international application is in the names of several applicants, or there is a particularly long list of goods and services, use of such self-produced forms can avoid the need for continuation sheets. The following prescriptions must, however, be observed:

- the form must be on A4 paper, written on one side only;
- the form must contain the same items, with their numbering and titles, in the same order, as the official form established by the International Bureau;
- where use of the official form requires a box to be checked, the wording which accompanies the box should be reproduced;
- where an item is not used or is not applicable, the item should not be omitted, but should be included with an appropriate indication, such as “not applicable” or “nil” or “not used”; for example, if an international application submitted on a self-generated form does not include a claim to priority, the form should still include the relevant entry, between items 5 and 7, with an appropriate indication, such as:

“6. Priority: *Not applicable*”;

- in the case of an international application, the reproduction of the mark must be of a size that would fit within the box in the official form (8 cm x 8 cm); where there are two such reproductions (one in black and white and one in color (see paragraph B.II.07.43), they should both be on the same page.

*A.I. Section 6(a)* 04.04 The form must be completed legibly, by means of a typewriter or other machine. Handwritten forms are not acceptable.

### ***Continuation Sheets***

04.05 Where the space available in any part of a form is insufficient (for example, in the case of an international application, because there is more than one applicant, or more than one basic registration or application, or more than one priority application) one or more continuation sheets should be used (unless the use of a self-generated form avoids the need to use such continuation sheets). On the continuation sheet, it is necessary to indicate “Continuation of item number ...”, the information then being presented in the same manner as required in the form itself. The number of continuation sheets used should be indicated in the box provided at the beginning of the form.

### ***Indication of Dates***

04.06 Any indication of a date in an official form must consist of the day in two digits, followed by the number of the month in two digits, followed by the number of the year in four digits, all in Arabic numerals and day, month and year being separated by slashes (/). For example, the date March 9, 2008, is to be written as “09/03/2008”.

### *Optional Forms*

04.07 In addition to the official forms, several optional forms are available, for example, for renewing an international registration. The use of these forms is not compulsory; they are provided by the International Bureau for the convenience of users.

### **Calculation of Time Limits**

05.01 The Agreement, the Protocol and the Regulations lay down time limits within which certain communications must be made. Normally the date on which the time limit expires is the date on which the communication must be received by the International Bureau. An exception to this is the time limit within which the Office of a designated Contracting Party may notify refusal of protection; in this case, it is the date on which the Office sends the notification to the International Bureau which is decisive.

*Rule 4(5)* 05.02 Any communication from the International Bureau which refers to a time limit will indicate the date of expiry of that time limit, calculated in accordance with the following rules:

*Rule 4(1)* – any period expressed in years expires, in the relevant subsequent year, on the same day and month as the event from which the period started to run, except that a period which started on February 29, and ends in a year in which there is no such date, will expire on February 28. For example, a period of 10 years from February 20, 2008, will expire on February 20, 2018; a period of 10 years from February 29, 2008, will expire on February 28, 2018.

*Rule 4(2)* – any period expressed in months expires, in the relevant subsequent month, on the day having the same number as the day of the event from which the period started to run, except that if there is no day with that number, the period expires on the last day of the month. For example, a period of two months which begins on January 31 ends on March 31, while a period of three months which begins on the same date ends on April 30.

*Rule 4(3)* – any period expressed in days starts on the day following the day on which the relevant event occurred. For example, a period of 10 days which is to be reckoned from an event which occurred on the twelfth day of a month will expire on the twenty-second day of that month.

*Rule 4(4)* 05.03 If, in accordance with paragraph 05.02, a period within which a communication must be received by the International Bureau would expire on a day on which the International Bureau is not open to the public, it will expire on the next subsequent day on which the Bureau is open. For example, if a period within which a communication must be received by the International Bureau ends on a Saturday or Sunday, the deadline will be met if the communication is received on the following Monday (assuming that the Monday is not a holiday); and, for example, a period of three months starting from October 1 will not expire on January 1 (which is a holiday at the International Bureau), but on the next working day. A list of the days on which

*Rule 32(2)(v)*

the International Bureau is not scheduled to be open to the public during the current and the following calendar year is published in the *WIPO Gazette of International Marks*.

05.04 Likewise if, in accordance with paragraph 05.02, the period within which a communication (such as a notice of refusal of protection) must be sent by an Office to the International Bureau would expire on a day on which the Office concerned is not open to the public, it will expire on the next subsequent day on which the Office is open. It should be noted that this applies only where the period in question is specified in terms of the communication being sent by an Office within that period. Where the period is specified in terms of the communication being received by the International Bureau within that period, it is paragraph 05.03 that applies; in such a case, late receipt of the communication by the International Bureau cannot be excused on the ground that its dispatch was delayed because the Office which sent it was closed.

### **Irregularities in Postal and Delivery Services**

*Rule 5(1) and (2)* 06.01 Where a time limit is not met because a communication addressed to the International Bureau by an applicant or holder or by an Office is unduly delayed or is lost because of an irregularity in a postal or delivery service, this may be excused, provided due care has been exercised by the sender and the communication was dispatched in good time. The rule is that failure to meet a time limit shall be excused if the party which sent the communication submits evidence showing, to the satisfaction of the International Bureau:

(i) that the communication was mailed or sent to the International Bureau at least five days prior to the expiry of the time limit, or, where the postal or delivery service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed or sent not later than five days after postal or delivery service was resumed;

(ii) that the mailing of the communication was registered, or details of the communication were recorded by the postal or delivery service at the time of mailing; and

(iii) in the case of a communication sent by a postal service from a location from which not all classes of mail normally reach the International Bureau within two days of mailing, that the communication was either mailed by a class of mail which normally reaches the International Bureau within two days of mailing, or was sent by airmail.

*Rule 5(3)* 06.02 Failure to meet a time limit shall be excused only if the evidence referred to in paragraph 06.01, and the communication or a duplicate thereof, are received by the International Bureau not later than six months after the expiry of the time limit.

- Article 3(4),  
Rule 24(6)(b)* 06.03 Where an international application or a subsequent designation is received from an Office by the International Bureau more than two months after it was filed with that Office, the international registration or the designation will normally bear the date on which it was actually received by the Bureau. Where however the Office concerned indicates that the late receipt resulted from an irregularity in the postal or delivery service, the application or designation will be considered to have been received within the time limit (and will therefore be able to keep the date on which it was filed with that Office (see paragraphs B.II.12.01 to 12.02 and 38.02), provided that the circumstances referred to in paragraphs 06.01 and 02 apply.
- Rule 5(4)*

## Languages

### General Principles

#### *Trilingual Regime*

- Rule 6(1)* 07.01 An international application may be filed in English, French or Spanish, according to what is prescribed by the Office of origin. That is, the Office of origin is entitled to restrict the choice of the applicant to only *one* language, or to two languages, or may permit the applicant to choose between any of the three languages.
- Rule 6(2)(i)* 07.02 Any communication concerning an international application or an international registration, which is addressed to the International Bureau by an Office or by an applicant or holder shall be in English, French or Spanish, at the option of the party sending the communication, irrespective of the language in which the international application was filed. However, there are two exceptions to this rule:
- Rule 17(2)(v)  
Rule 17(3)* – where a notification of provisional refusal refers, as a ground for refusal, to an application for a registration or a registration of a conflicting mark, the list of all goods and services or of relevant goods and services covered by that mark, may be in the language of the said application or registration. The same applies as regards a notification of provisional refusal based on an opposition, which refers, as a ground for refusal, to a mark which has been the subject of an application or registration:
- Rule 6(2)(ii)  
Rule 7(2)* – where a Contracting Party has notified the International Bureau that it requires a declaration of intention to use the mark, it may require that the declaration be in a specific one of the three official languages, English, French or Spanish, irrespective of the language in which the international application was received by the International Bureau (see paragraph A.04.24).
- Rule 6(2)(iii)* 07.03 Any notification concerning an application or registration, which is addressed by the International Bureau to an Office, will normally be in the language in which the international application was filed. An Office may however notify the International Bureau that it wishes to receive all notifications concerning international applications or registrations in English, in French or in Spanish, irrespective of the language in which the international application was filed. That would enable an



Office not to accept notifications in a prescribed language (or in two such languages) and to indicate to the International Bureau which other language should be used instead. Where the notification by the International Bureau concerns the recording in the International Register of an international registration, the notification will indicate the language in which the relevant international application was received by the International Bureau.

*Rule 6(2)(iv)* 07.04 Any notification concerning an application or registration, which is addressed by the International Bureau to an applicant or holder, will normally be in the language in which the international application was filed. An applicant or holder may however inform the International Bureau, by checking the relevant box in the international application form, that he wishes to receive all such notifications in English, in French or in Spanish, irrespective of the language in which the international application was filed.

*Rule 40(4)* ***Regime Applicable to Certain International Registrations Resulting from International Applications Made Before April 1, 2004 or International Applications Governed Exclusively by the Agreement Made Between April 1, 2004 and August 31, 2008, Inclusively***

07.05 In accordance with Rule 40(4), Rule 6 as in force before April 1, 2004, shall continue to apply to any international application filed before that date and to any international application governed exclusively by the Agreement filed between that date and August 31, 2008, inclusively, and also to any communication relating thereto and to any communication, recording in the International Register or publication in the Gazette relating to an international registration resulting therefrom. However, where the international registration has been the subject of a subsequent designation under the Protocol between April 1, 2004, and August 31, 2008, or the international registration has been or is the subject of a subsequent designation on or after September 1, 2008, and the subsequent designation is recorded in the International Register, any communication relating to such an international registration, may be in English, French or Spanish subject to the exceptions of Rule 17(2)(v) and (3), and Rule 7(2).

07.06 In other words, before September 1, 2008, an application which was governed exclusively by the Agreement had to be filed in French. In addition, any communication concerning such an international application or an international registration resulting therefrom, which was addressed to the International Bureau by an applicant, holder or an Office, had to be in French, and any communication concerning such an application or registration, which was addressed by the International Bureau to the applicant, holder or an Office also had to be in French. As explained before in paragraph B.I.07.05, as of September 1, 2008, the rule (in accordance with Rule 6, as in force before April 1, 2004) is that all communications relating to an international registration resulting from such an application must likewise be in French. However, where a Contracting Party has been subsequently designated under the Protocol on or after April 1, 2004, or, under the Agreement or the Protocol on or after September 1, 2008, and this subsequent designation is

recorded, paragraphs B.I.07.01 to 07.04 apply instead (i.e. trilingual regime). In the case that a subsequent designation under the Protocol was filed before April 1, 2004, any communication relating to such an international registration can be made in English or French.

07.07 Moreover, an international application governed exclusively by the Protocol or by both the Agreement and the Protocol, which was filed before April 1, 2004, had to be in English or French. Also, any communication concerning such an international application or an international registration resulting therefrom, shall be in English or French. However, where a Contracting Party has been subsequently designated under the Protocol on or after April 1, 2004, or, has been or is subsequently designated under the Agreement or the Protocol on or after September 1, 2008, and this subsequent designation is recorded, paragraphs B.I.07.01 to 07.04 apply instead (i.e., trilingual regime).

## **PAYMENT OF FEES TO THE INTERNATIONAL BUREAU**

08.01 The amounts of the fees payable in connection with an international application or registration are either prescribed in the Schedule of Fees appended to the Regulations or (in the case of individual fees) fixed by the Contracting Party concerned. Information concerning individual fees is published in the Gazette.

*Rule 34(2)(a)* 08.02 Fees may be paid by the applicant or holder directly to the International Bureau. Alternatively, where the Office of origin or the Office of the Contracting Party of the holder agrees to collect and forward such fees, an applicant or holder may pay fees to the International Bureau through that Office. An applicant or holder may not however be *required* to pay the fees through an Office.

*Rule 34(2)(b)* 08.03 An Office which accepts to collect and forward fees to the International Bureau should so notify the Director General of WIPO. Any such notification will be published in the Gazette.  
*Rule 32(2)(iv)*

### **Currency of Payment**

*Rule 35(1)* 08.04 All payments to the International Bureau must be made in Swiss currency. An Office which accepts to collect and forward fees may collect payments from the applicant or holder in another currency, but the payment forwarded to the International Bureau by the Office must be in Swiss currency.

## Mode of Payment

A.I. Section 19 08.05 Fees may be paid to the International Bureau:

- (i) by debit to a current account with the International Bureau;
- (ii) by payment into the Swiss postal account or to any of the specified bank accounts of the International Bureau;
- (iii) by credit card, where, in the context of an electronic communication envisaged in Section 11 of the Administrative Instructions, an electronic interface for online payment has been made available by the International Bureau.

08.06 An electronic interface for the payment of fees (“E-Payment”) due with regard to international applications or registrations, as notified in irregularities letters or other WIPO communications indicating the amount of the fees payable within an applicable time limit, is available on the WIPO Madrid System website under “Online Services”. More precisely, E-Payment may be used in the following situations:

- (a) where an *irregularity notice* has been issued by the International Bureau, and any amount of fee is due with respect to an international application, a subsequent designation, a request for the recording of a change or of a license, a request for amendment of the recording of a license or the renewal of an international registration;
- (b) where a notification concerning the payment of the second part of the individual fee has been issued by the International Bureau in respect of the designation of any Contracting Party;
- (c) where an invitation to request the continuation of effects of international registrations in a successor State has been issued by the International Bureau.

E-Payment can be made by *credit card* or through a *WIPO current account*. An acknowledgement of receipt of payment will be sent automatically

08.07 An applicant, holder or representative (or indeed an Office) having frequent dealings with the International Bureau (possibly also in connection with matters other than international registration of marks, such as applications under the Patent Cooperation Treaty or applications under the Hague Agreement) will find it useful to maintain a current account with the International Bureau. This greatly simplifies the payment of fees and, as explained below, reduces the risk of irregularities due to late or incorrect payment. This method of payment is of course dependent on there being a sufficient balance in the account; the International Bureau will therefore inform the holder of the account whenever the balance has diminished to an extent that there is a danger that it might be insufficient to cover the next fee.

*Rule 34(5)* 08.08 Whenever a fee is paid to the International Bureau, the purpose of the payment must be indicated, together with information identifying the application or registration concerned. This information should include:

- before the mark has been registered as an international registration, the mark to which the payment relates, together with the name of the applicant and, as far as possible, the number of the basic application or registration;
- after international registration, the name of the holder and the international registration number.

08.09 Where payment is made other than by debit from a current account with the International Bureau, the amount being paid should be stated. It is not necessary to do this when payment is made from such an account; instead, it is sufficient to give instructions to the International Bureau (by checking the appropriate box on the fee calculation sheet attached to the official form) to debit whatever is the correct amount for the transaction in question. Indeed one of the advantages of paying by this method is that it avoids the risk of an irregularity if the fees as calculated by the applicant or the holder are incorrect. Where instruction is given to the International Bureau to debit the appropriate amount and an amount is nevertheless indicated, the International Bureau will treat the latter amount as indicative only, will debit the correct amount and will notify accordingly the party (applicant, holder, representative or Office) that gave the instructions.

### **Date of Payment**

*Rule 34(6)* 08.10 Where the International Bureau receives instructions to debit fees from an account with it, and provided the required amount is available in the account, the fees are considered to have been paid:

- in the case of an international application or subsequent designation, on the day on which the application or designation was received by the International Bureau;
- in the case of a request to record a change, on the day on which the request was received by the International Bureau;
- in the case of renewal of the international registration, on the day on which instructions to renew were received by the International Bureau.

Where payment is made by any other method, or where the amount in the current account is insufficient, the fees are considered to have been paid on the date on which the International Bureau received the required amount.

## Change in the Amount of Fee

*Rule 34(7)(a)* 08.11 Where the amount of a fee payable in respect of the filing of an international application changes between the date on which the request to present the international application was received or is deemed to have been received (see paragraphs B.II.07.83 to 07.96) by the Office of origin and the date on which the application was received by the International Bureau, it is the fee that was valid on the earlier date that is applicable.

*Rule 34(7)(b)* 08.12 Where a subsequent designation is presented through an Office and the amount of a fee payable in respect of that designation changes between the date on which the request to present the subsequent designation was received by that Office and the date on which the designation was received by the International Bureau, it is the fee that was valid on the earlier date that is applicable.

*Rule 34(7)(d)* 08.13 Where the amount of a renewal fee changes between the date on which the fee was paid to the International Bureau and the date on which renewal is due, then

– where payment is made not more than three months before the date on which renewal is due, it is the fee that was valid on the date of payment that is applicable;

– where the fee is paid more than three months before the date on which renewal is due, the payment is considered to have been received three months before the due date, and it is the fee that was valid three months before the due date that is applicable.

Where the renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable.

*Rule 34(7)(e)* 08.14 In any other case, the applicable amount is that which was valid on the date on which the payment was received by the International Bureau.

## Fee Reduction for Applicants from Least Developed Countries (LDCs)

08.15 Applicants having a real and effective industrial or commercial establishment, or a domicile in a least developed country, or being a national of a least developed country (in accordance with the list established by the United Nations), and who file their international applications through the trademark office of such country, as the office of origin, will be required to pay only 10% of the amount of the basic fee. This is reflected in the Schedule of Fees and has been incorporated in the fee calculator on the Madrid website ([www.wipo.int/madrid/en/fees/calculator.jsp](http://www.wipo.int/madrid/en/fees/calculator.jsp)).

08.16 The list of least developed countries is maintained and updated on a regular basis by the United Nations and may be consulted on the United National website at [www.un.org](http://www.un.org). The list may also be consulted on the WIPO website at [www.wipo.int/lDCs/en/country](http://www.wipo.int/lDCs/en/country).

## REPRESENTATION BEFORE THE INTERNATIONAL BUREAU

*Rule 3(1)(a)* 09.01 The applicant or holder may appoint a representative to act on his behalf before the International Bureau. This may or may not be the same representative that he uses before the Office of origin.

09.02 References in the Regulations, the Administrative Instructions or in this Guide to representation relate only to representation before the International Bureau. The questions of the need for a representative before the Office of origin or the Office of a designated Contracting Party (for example, in the event of a refusal of protection issued by such an Office), who may act as a representative in such cases and the method of appointment, are outside the scope of the Agreement, Protocol and Regulations and are governed by the law and practice of the Contracting Party concerned.

### Appointment of Representative

10.01 With regard to who may be appointed as a representative before the International Bureau, the Madrid system does not provide for any requirement as to professional qualification, nationality, residence or domicile.

### Method of Appointment

#### *In International Application, Subsequent Designation or Request to Record a Change*

*Rule 3(2)(a)* 10.02 A representative may be appointed in an international application, simply by indicating his name and address in the appropriate part of the official form. Similarly a representative may be appointed by giving his name and address in the official form for presenting a subsequent designation or for requesting the recording of a change, provided that the form is signed by the holder or is presented through an Office. Where a representative is appointed in this way, no further formality is necessary; in particular, no power of attorney should be sent to the International Bureau.

#### *In a Separate Communication*

*Rule 3(2)(b)* 10.03 The appointment of a representative may also be made at any time in a separate communication. Such separate communication may be presented to the International Bureau:

– by the applicant, holder or representative, in which case it must be signed by the applicant or holder;

– by the Office of the Contracting Party of the holder, in which case it must be signed either by the applicant or holder or by the Office through which it is presented.

The communication may be a simple letter. It suffices that it clearly identifies the person making the appointment, the appointed representative and the international application or registration concerned. An optional (MM12) form for appointing a representative is, nevertheless, available from the International Bureau for the convenience of applicants and holders.

10.04 Such an appointment may relate to any number of specified international applications or registrations, provided they are all clearly and individually identified. The International Bureau cannot accept, as an appointment of a representative, a communication which simply refers to “all” international applications and registrations in the name of the same applicant or holder.

### ***Only One Representative***

*Rule 3(1)(b) and (c)* 10.05 The International Bureau will recognize only one representative in respect of a given international application or registration. Where a document in which a representative is appointed indicates the names of more than one representative, only the one indicated first will be considered to have been appointed. Where, however, a partnership or firm of attorneys or patent or trademark agents has been indicated, this will be regarded as a single representative.

### **Irregular Appointment**

*Rule 3(3)(a)* 10.06 Where the appointment of a representative was not made in accordance with the requirements referred to above, the International Bureau will consider the appointment to be irregular. It will notify accordingly the applicant or holder and the purported representative and, if the sender or transmitter is an Office, that Office.

*Rule 3(3)(b)* 10.07 Where the appointment is regarded as irregular or as not having been made, the International Bureau will send all relevant communications to the applicant or holder himself.

### **Recording and Notification of Appointment**

*Rule 3(4)(a)* 11.01 If the appointment complies with the applicable requirements, the International Bureau will record the fact that the applicant or holder has a representative, and his name and address, in the International Register. The effective date of the appointment is the date on which the International Bureau has received the communication (international application, subsequent designation, request to record a change or separate communication) in which the appointment was made.

*Rule 3(4)(b)* 11.02 The International Bureau will notify both the applicant or holder and the representative of the fact that the appointment has been recorded in the International Register. Where the appointment was made in a separate communication presented through an Office, that Office will also be notified.

### Effect of the Appointment

*Rule 3(5)* 11.03 Unless the Regulations expressly require otherwise, a duly recorded representative may always sign a communication, or carry out any other procedural step, in place of the applicant or holder. Any communication addressed by the representative to the International Bureau has the same effect as if it had been addressed to the International Bureau by the applicant or holder. Similarly, where a representative has been recorded, the International Bureau will send to him any invitation, notification or other communication which, in the absence of a representative, would have been sent to the applicant or holder. Any such communication has the same effect as if it had been addressed to the applicant or holder.

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

*Rule 3(3)* – where the International Bureau finds that the appointment of a representative is irregular, it will so inform both the applicant or holder and the purported representative;

*A Article 7(4)* – six months before the expiry of the term of protection, the  
*P Article 7(3)* International Bureau will send an unofficial notice to both the holder and his representative;

*Rule 30(3)* – where insufficient fees are paid for the purpose of renewal, the International Bureau will notify both the holder and his representative;

– where cancellation of the appointment is requested by the representative, the International Bureau will, until such time as the cancellation becomes effective, send communications to both the applicant or holder and the representative (see paragraphs B.I.12.05 and 12.06).

11.05 Apart from these exceptions, whenever this Guide refers to anything being sent to, or done by, an applicant or holder, this should be understood as a reference to it being sent to, or allowed to be done by, a duly recorded representative.

### Cancellation of Appointment

*Rule 3(6)(a)* 12.01 The recording of a representative will be cancelled upon receipt of a request signed by the applicant, holder or representative. Cancellation may be requested by means of a simple letter. The cancellation of the recording may be effected for all the international applications or registrations of the same applicant or holder in respect of which the representative had been duly appointed, or any specified international applications or registrations of that applicant or holder.



*Rule 3(6)(a)* 12.02 The recording will also be cancelled *ex officio* by the International Bureau where a new representative has been duly appointed. As already noted (see paragraph B.I.10.05), only one representative may be recognized at any one time; *the appointment of a new representative is therefore assumed to replace any representative previously appointed.*

12.03 The recording of a representative will also be cancelled *ex officio* by the International Bureau where a change in ownership has been recorded, unless the representative is expressly re-appointed by the new holder of the international registration.

*Rule 3(6)(b)* 12.04 As a general rule, the cancellation becomes effective from the date on which the International Bureau receives the communication leading to the cancellation. Where however the cancellation is requested by the representative, the following paragraphs apply.

#### ***Cancellation at the Request of the Representative***

*Rule 3(6)(d)* 12.05 Where the International Bureau receives a request from the representative for cancellation of the recording of his appointment, it will immediately notify the applicant or holder of this fact, and will include copies of all communications sent to the representative, or received from him, during the six months preceding the date of the notification. The effective date of the cancellation will be the earlier of the following:

*Rule 3(6)(c)*

– the date on which the International Bureau receives a communication appointing a new representative, or

– the date of the expiry of a period of two months counted from the date on which the International Bureau received the communication from the representative requesting cancellation of the recording of his appointment.

12.06 Until the cancellation has become effective, all communications which normally would be addressed to the representative only will be addressed to the representative and to the applicant or holder. The interests of an applicant or holder are therefore safeguarded when a representative has requested the cancellation of the recording of his appointment without informing, or contrary to the wishes of, his client.

#### ***Notification of Cancellation***

*Rule 3(6)(e)* 12.07 Once the cancellation has become effective, the International Bureau will notify the cancellation and its effective date to the representative whose recording has been cancelled, to the applicant or holder and, where the appointment of the representative had been presented through an Office, that Office. It will send all future communications either to the new representative or, where no new representative has been recorded, to the applicant or holder.

**No Fee for Recording**

*Rule 36(i)* 12.08 The recording of the appointment of a representative, of any change concerning the representative or of the cancellation of the recording of the appointment of a representative are exempt from the payment of a fee.

## **PART B**

### **CHAPTER II: THE INTERNATIONAL PROCEDURE**

#### **INTRODUCTION**

This Chapter describes the procedures under the Agreement, the Protocol, the Common Regulations and the Administrative Instructions.

It also provides explanations concerning the forms which may be required to be used, or which the International Bureau may provide for the convenience of the users of the system, and on how these forms should be completed.

The Chapter follows, as far as possible, the life of an international registration, starting with the international application and proceeding through to the recording of the international registration. It then deals with the various events which can occur following international registration, such as refusal of protection, subsequent designation, requests for limitation of the list of goods and services, etc.

#### **THE INTERNATIONAL APPLICATION**

##### **Substantive Requirements**

###### **Basic Registration or Application**

01.01 The Madrid system is founded on the requirement of a basic national or regional registration or application for registration. Under the Agreement, an applicant for the international registration of a mark must have already obtained registration of the mark in the country of origin (basic registration). Under the Protocol, an international application may be based on either a registration with the Office of origin (basic registration) or on an application for registration filed with that Office (basic application). The international application may relate only to goods and services covered by the basic application or registration.

01.02 In most cases, the international application will be based on a single registration or application which covers the goods and services listed in the international application. It is, however, possible to base an international application on several registrations (under the Agreement) or on several applications and/or registrations (under the Protocol) which together cover the goods and services to which the international application relates. The basic applications and/or registrations must all be in the name of the person filing the international application and must have been made with the same Office. For the sake of simplicity, the following text refers only to a basic application or basic registration, it being understood that this includes the possibility of several basic applications and/or registrations.

### The Office of Origin

02.01 Before filing an international application, the potential applicant must establish which Office or Offices may be the Office of origin for the international application in question. This will depend on whether the international application will be governed by the Agreement or by the Protocol or by both – which, in turn, depends on which Contracting Parties are to be designated (see paragraphs B.II.03.01 to 03.03).

*Rule 1(viii), (xxv)  
and (xxvi)  
A Article 1(3)* 02.02 To the extent that an international application is governed *by the Agreement*, the Office of origin is defined as the Office in charge of the registration of marks in, or on behalf of, the applicant's country of origin. The applicant's country of origin is defined (Article 1(3) of the Agreement) as:

(a) Any country, party to the Agreement, in which he has a real and effective industrial or commercial establishment; or

(b) *if he has no establishment in such a country*, the country, party to the Agreement, in which he has his domicile; or

(c) *if he has neither an establishment nor a domicile in such a country*, the country, party to the Agreement, of which he is a national.

The applicant must follow this so-called “cascade”; he therefore does not have a free choice of Office of origin. He cannot, for example, base his international application on a registration in the country of his domicile if, in fact, he has an industrial or commercial establishment in *another* country which is a party to the Agreement.

*P Article 2(2)  
Rule 1(ix),(xxv)  
and (xxvi)  
Rule 2(1)(i)(ii)* 02.03 In contrast, where the international application is governed *exclusively by the Protocol*, no such cascade applies. “Office of origin” is defined (Article 2(2) of the Protocol) in a way which means that the applicant may freely choose his Office of origin on the basis of establishment, domicile or nationality, it being understood that there can be only *one* Office of origin. Thus, in the case of the Office of a country, an international application may be filed by anyone who is a national of that country or is domiciled or has a real and effective industrial or commercial establishment in that country. In the case of the Office of a Contracting Organization, an international application may be filed by anyone who is a national of a member State of that organization or who is domiciled or has a real and effective industrial or commercial establishment in the territory of that organization.

02.04 The interpretation of “national”, “domicile” and “real and effective commercial or industrial establishment” is a matter for the laws of the Contracting Parties to determine, each as far as it is concerned. This Guide can therefore only give some guidance.

02.05 “National”, under the Agreement and Protocol, is intended to have the same meaning as in Article 2 of the Paris Convention. It is taken to be capable of including both natural and legal persons. The question as to whether a natural person is a national of a particular country, and the criteria (for example, place of incorporation or headquarters) for deciding whether a legal entity is regarded as a

national of that country, are matters for the law of that country. Likewise it is for the law of a Contracting Party to determine what are the criteria for either a natural person or a legal entity to be regarded as domiciled in that Contracting Party. In practice, the question of the nationality or domicile of a legal entity will arise infrequently, since its entitlement to file an international application will usually be based on the existence of an establishment in the country of origin.

02.06 The expression “real and effective industrial or commercial establishment” is taken from Article 3 of the Paris Convention, to which it was added at the first conference for the revision of the Convention, which took place in Brussels in 1897 - 1900. It was felt that the original provision, which simply referred to “an establishment”, was too broad and should be restricted. The intention was that, by using the French term “*sérieux*” (“real” in English), fraudulent or fictitious establishments would be excluded. The term “effective” makes it clear that, while the establishment must be one at which some industrial or commercial activity takes place (as distinct from a mere warehouse), it need not be the principal place of business (in the Brussels Conference, the proposal by one of the States party to the Madrid Agreement to narrow down the requirement for establishment to the principal place of business was not adopted).

02.07 It is therefore to be understood that an enterprise may have several real and effective industrial or commercial establishments in different States that are party to the Agreement or Protocol. In such a case, any of the Offices of the respective States may qualify as the Office of origin, both under the Agreement and under the Protocol.

02.08 Where the Contracting State of which an applicant is a national, or in which he is domiciled or has an establishment, is also a member State of a Contracting Organization, there is the possibility of basing an international application on either a national or a regional application or registration.

### **What Kind of International Application?**

03.01 Three kinds of international application are possible. An international application may be (a) governed exclusively by the Agreement, (b) governed exclusively by the Protocol, or (c) governed by both the Agreement and the Protocol, depending on which treaty or treaties (Agreement or Protocol) are applicable to, on the one hand, the Office of origin and, on the other, the Contracting Parties designated in the application (see also paragraphs A.02.16 to 02.25). The principles are as follows:

- Rule 1(viii)* (a) *where the Office of origin is the Office of a country which is bound by the Agreement only, then only countries which are also party to the Agreement may be designated; the international application will be governed exclusively by the Agreement;*

Rule 1(ix) (b) *where the Office of origin is the Office of a country which is bound by the Protocol only or, is the Office of a Contracting Organization bound by the Protocol, then only countries or organizations which are also party to the Protocol may be designated; the international application will be governed exclusively by the Protocol;*

Rule 1(viii), (ix) and (x) (c) *where the Office of origin is the Office of a country which is bound by both the Agreement and the Protocol, then any country which is a party to either the Agreement or the Protocol (or to both), or any organization which is a party to the Protocol, may be designated; in this case:*

– *where only countries are designated and all the designated countries are party to the Agreement but not to the Protocol, the international application will be governed exclusively by the Agreement;*

– *where all the designated Contracting Parties are party to the Protocol, irrespective of whether or not they are also party to the Agreement, the application will be governed exclusively by the Protocol;*

– *where the international application designates at least one country party to the Agreement but not to the Protocol and at least one Contracting Party which is a party to the Protocol, whether or not that Contracting Party is also party to the Agreement, the application will be governed by both the Agreement and the Protocol.*

03.02 It is important for an applicant to know into which of these categories his application falls, since this determines such matters as the form to be used and the fees which are payable. Moreover, where the international application will be governed exclusively by the Agreement or by both the Agreement and the Protocol it must be based on a registration (as distinct from an application) with the Office of origin.

03.03 To summarize:

(a) The international application is *governed exclusively by the Agreement* if:

– the Office of origin is the Office of a State bound only by the Agreement, or

– the Office of origin is the Office of a State bound by both the Agreement and the Protocol, where only countries are designated and all the designated countries are bound by the Agreement but not by the Protocol.

The international application must be based on a registration in the Office of origin.

(b) The international application is *governed exclusively by the Protocol* if:

– the Office of origin is the Office of a Contracting Party bound only by the Protocol, or

– the Office of origin is the Office of a Contracting Party bound by both the Agreement and the Protocol, and all the designated Contracting Parties are party to the Protocol irrespective of whether or not they are also party to the Agreement.

The international application may be based on *either an application or a registration* in the Office of origin.

(c) The international application is *governed by both the Agreement and the Protocol* if the Office of origin is the Office of a Contracting Party bound by both the Agreement and the Protocol, and the applicant has designated at least one State bound by the Agreement but not by the Protocol and at least one State bound by the Protocol (whether or not that State is also bound by the Agreement) or one intergovernmental organization bound by the Protocol.

The international application must be based on a *registration* in the Office of origin.

### Several Applicants

*Rule 8* 04.01 Two or more parties (whether natural persons or legal entities) may jointly file an international application, provided that the basic application or registration is also jointly owned by them, and that

– where the international application will be governed exclusively by the Agreement, or by both the Agreement and the Protocol, the country of origin (as defined in paragraph B.II.02.02) is the same for each of the applicants;

– where the international application will be governed exclusively by the Protocol, each of the applicants has the necessary connection through establishment, domicile or nationality with the Contracting Party whose Office is the Office of origin.

04.02 It is not necessary for the nature of the connection (nationality, domicile or establishment) to be the same for each applicant, but all must be entitled to file an international application with the Office of the same Contracting Party.

### Presentation of the International Application

*A Article 1(2)* 05.01 The international application must be filed through the Office of origin.  
*P Article 2(2)* The first contact that an Office will have with an international application, therefore,  
*Article 8(1)* is when a request is made to it to present an international application to the International Bureau. It is possible that an Office which receives a request to present an international application governed by both the Agreement and the Protocol will not be the correct Office of origin under the Agreement, but would be the correct Office of origin under the more liberal rule in the Protocol. In such a case, the Office

should inform the applicant that the application cannot be forwarded as it stands, but that it could proceed as an application governed exclusively by the Protocol if all designations of States party to the Agreement but not to the Protocol were cancelled.

*Rule 11(7)* 05.02 An international application which, instead of being presented through an Office, is presented by the applicant directly to the International Bureau will not be considered to be an international application. It will be returned to the sender without being examined in any way and any fees paid will be reimbursed to the party having paid them.

05.03 In such case, the International Bureau is not obliged to acknowledge receipt of an international application except where transmitted by facsimile or by electronic communication (see paragraphs B.I.02.07 and 03.04).

### **Language of the International Application**

*Rule 6(1)* 06.01 An international application may be filed in English, French or Spanish, subject to what is prescribed by the Office of origin. That is, the Office of origin is entitled to restrict the choice of the applicant to only *one* language, or to two languages, or could permit the applicant or holder to choose between any of the three languages.

*Rule 11(7)* 06.02 An international application which does not comply with these requirements concerning language will not be considered as such by the International Bureau, which will return it to the Office which forwarded it, without examining the application in any way and all fees paid will be reimbursed to the party which effected such payment.

### **The Application Form**

*Rule 9(2)(a)* 07.01 An international application must be presented to the International Bureau on the official form.

07.02 Whether the applicant can or must complete the official international application form or whether the form is completed by the Office of origin on the basis of information supplied by the applicant depends on the practice of the Office concerned. The Offices of some Contracting Parties provide forms for requesting the presentation of an international application, which are different from the official international application form and which applicants may be permitted or required to use, as prescribed by the law of the Contracting Party. Where the language(s) allowed before the Office of origin is not English, French or Spanish, the Office may require the applicant to provide the necessary information (in particular, the list of goods and services) in the language of the international application (English, French or Spanish), or it may itself translate the information into that language.



A.I. Section 2 07.03 There are three different official forms (MM1, MM2 and MM3 respectively) for presenting an international application, depending on whether the application is governed exclusively by the Agreement, exclusively by the Protocol, or by both the Agreement and the Protocol. The official forms are available on WIPO's website under the heading *Trademarks/Madrid System/Forms*.

A.I. Section 2 07.04 The Office of origin must ensure that the correct form is used. Where the Office is the Office of a Contracting Party bound only by the Agreement, or only by the Protocol, only one of these forms will ever be used for applications presented by that Office. Where, however, the Office is bound by both the Agreement and the Protocol, the correct form is determined by which Contracting Parties have been designated (see earlier "*What Kind of International Application*", paragraphs B.II.03.01 to 03.03).

07.05 The general remarks concerning official forms (see paragraphs B.I.04.01 to 04.04) should be studied. In particular, the form must be completed legibly, with the use of a typewriter or other machine; handwritten forms are not acceptable by the International Bureau. Where, instead of using forms produced by the International Bureau, applicants produce their own form, the guidance set out in paragraph B.I.04.03 must be followed.

#### ***Item 1: Contracting Party Whose Office Is the Office of Origin***

07.06 The name of the State or intergovernmental organization whose Office is the Office of origin should be given, e.g. "Japan", "European Union", etc. In the case of a common Office under Article 9*quater* of the Agreement or the Protocol, the name of the single State that the Contracting Parties concerned are deemed to constitute should be given, e.g. "Benelux".

07.07 Where there is more than one applicant, the name of only one Contracting Party whose Office is the Office of origin should be indicated.

#### ***Item 2: Applicant***

##### *Name*

A.I. Section 12(a),  
(b) and (c) 07.08 Where the applicant is a natural person, the name to be indicated is the family (or principal) name and the given (or secondary) name(s) of the natural person as customarily used by that person and in the order in which they are customarily used. Where the applicant is a legal entity, its full official designation must be given. Where the name of the applicant is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application; where the applicant is a legal entity, the transliteration may be replaced by a translation into the language of the international application.

*Address*

- A.I. Section 12(d) 07.09 The address of the applicant must be given in such a way as to satisfy the customary requirements for prompt postal delivery. In addition, telephone or facsimile numbers and an e-mail address may be given.

*Address for Correspondence*

07.10 Where the name and address of a representative has been given in item 4, all communications which are required to be sent by the International Bureau to the applicant or holder will be sent to that address. Where no address of a representative is given in item 4, such communications will be sent to the address of the applicant given in item 2(b). Where communications are to be sent to an address other than that indicated in item 2(b), an address for correspondence may, at the option of the applicant, be indicated in this space; otherwise the field "address for correspondence" should be left blank.

*Phone and Facsimile Numbers: E-mail Address*

07.11 The numbers or e-mail address given should be those of the person whom the International Bureau should contact when it needs to get in touch with the applicant.

*Application in the Names of More than One Applicant*

07.12 Where there is more than one applicant, the name and address of each applicant should be given, if necessary using a continuation sheet.

07.13 Where the international application is jointly filed by two or more applicants with different addresses, and neither the name and address of a representative nor an address for correspondence has been indicated, communications will be sent to the address of the applicant first named in the international application.

*Preferred Language for Correspondence*

- Rule 6(2)(iv) 07.14 In the case of an international application, the applicant may (by checking the appropriate box) indicate whether he wishes to receive communications from the International Bureau in English, in French or in Spanish. It is not necessary to check this box if the applicant wishes to receive communications in the language in which the international application was filed. It should be noted that this applies only to communications *originating from the International Bureau*; communications from Offices that are simply transmitted by the International Bureau, such as notifications of refusal, are sent in the language in which they are received from the Office.

*Other Indications*

*Rule 9(4)(b)(i) and (ii)* 07.15 Where the applicant is a natural person, he may indicate the State of which he is a national. Where the applicant is a legal entity, the nature of the legal entity may be indicated, together with the name of the State (and, where appropriate, the territorial unit within that State) in which it is incorporated. There is no provision for these indications to be given in the form which is to be used for an international application which is governed exclusively by the Agreement.

07.16 Such indications are not required by the Agreement, Protocol or Regulations, but may be included in the international application in order to forestall objections in designated Contracting Parties which require them.

*Item 3: Entitlement to File*

*Rule 9(5)(a)* 07.17 Where the international application is *governed (in whole or in part) by the Agreement* (and is therefore filed on form MM1 or MM3), the applicant should check only one of the boxes (i), (ii) and (iii) under item 3(a), in that order of priority. That is:

– where the applicant has a real and effective industrial or commercial establishment in the country through whose Office the international application is presented, box (i) must be checked;

– if the applicant has no establishment in a country party to the Agreement, but is domiciled in the country through whose Office the international application is presented, box (ii) must be checked;

– if the applicant has neither an establishment nor a domicile in any country party to the Agreement but is a national of the country through whose Office the international application is presented, box (iii) must be checked.

*Rule 9(5)(b)* 07.18 Where the international application is *governed exclusively by the Protocol* (filed on form MM2), the application should give one of the following indications concerning the applicant's connection with the Contracting Party through whose Office the international application is being presented, using the appropriate box or space in item 3(a):

– (where the Contracting Party is a State) that the applicant is a national of that State;

– (where the Contracting Party is an organization) the name of the member State of that organization of which the applicant is a national;

– that the applicant is domiciled in that Contracting Party;

– that the applicant has a real and effective industrial or commercial establishment in that Contracting Party.

Only one of these indications need be given, though more may be given if the applicant so wishes.

07.19 The Office through which the international application is presented may ask for evidence where it has reasonable grounds to doubt the veracity of the indications given. In general, it may be presumed that the address given in item 2(b) is the address of the applicant's establishment or domicile. Even if this address is in the territory of the Contracting Party through whose Office the international application is presented, it is still necessary to check at least one box under item 3(a); if this is not done, it is not possible to determine the nature of the applicant's entitlement to file.

*Rule 9(5)(c)* 07.20 In general, it is sufficient to provide the information described in paragraphs B.II.07.17 and 07.18 (by naming a State or checking a box). Where however the applicant indicates, by checking the appropriate box(es) in item 3(a), that he has an establishment or domicile in the territory of the Contracting Party through whose Office the international application is presented, but his address (as given in item 2(b)) is not in that territory, the applicant must in addition indicate, in item 3(b), the address of his establishment or domicile in that territory.

07.21 As indicated in paragraph B.II.04.01, where the international application is jointly filed by two or more applicants, the requirements as to entitlement to file the international application must be satisfied in respect of *each* applicant. Where appropriate therefore, information concerning the entitlement of each applicant must be given; unless a self-generated form is used, this information should be given in a continuation sheet.

#### ***Item 4: Appointment of a Representative***

*Rule 9(4)(a)(iii)* 07.22 If the applicant wishes to be represented before the International Bureau, the name and address of the representative should be given in this part of the form.  
*A.I. Section 12(d)* The information should be sufficient to enable correspondence to be sent to the representative, and should preferably include telephone and facsimile numbers and any e-mail address. (See also paragraphs B.I.09.01 to 11.02).

07.23 Where the name of the representative is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application. Where the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international application.

07.24 Giving the name and address of the representative in the international application is all that is necessary to effect his appointment; no power of attorney or other separate document should be sent to the International Bureau.

07.25 With respect to who may be appointed as representative, the Madrid system does not provide for any requirement as to professional qualification, nationality, residence or domicile. As long as the more general requirements concerning the appointment of the representative are not complied with, the International Bureau sends all communications to the applicant.

07.26 The appointment of a representative in the international application only empowers him to act before the International Bureau. It may subsequently become necessary to appoint one or more further representatives to act before the Offices of designated Contracting Parties, for example, in the event of a refusal of protection issued by such an Office. The appointment of a representative in such a case will be governed by the requirements of the Contracting Party concerned.

#### *Item 5: Basic Registration or Basic Application*

*A Article 1(2)* 07.27 An international application which is governed (in whole or in part) by the Agreement must be based on the registration of a mark (or on several registrations of the same mark) by the Office of origin. An international application which is governed exclusively by the Protocol may be based either on a registration by the Office of origin or on an application for registration filed with that Office; equally, it may be based on several applications or registrations (or a combination thereof).

*Article 3(1)*  
*Rule 9(5)(a) and (b)* 07.28 A *basic registration* effected by the Office of origin must be indicated by its registration number and its date of registration. This date should be the date which, under the law which governs the Office concerned, is regarded as the date of registration, which will not necessarily be the date on which the mark was actually recorded by the Office in its register; for instance if, under the law applicable to that Office, a mark is registered as of the date of filing, that is the date that should be given here. Where an international application is based on a *registration* with the Office of origin, **the number of the application from which the said registration resulted should not be given, because it is liable to be confused with a basic application.**

*Rule 9(5)(b)* 07.29 A *basic application* filed with the Office of origin must be indicated by its application number and date of filing. A basic application may be indicated only when the international application is governed exclusively by the Protocol.

07.30 Where there is more than one basic registration or more than one basic application, and all numbers and dates do not fit in the space provided, then (unless a self-generated form is used) the one(s) with the earliest date(s) should be given in item 5, and the remaining ones should be indicated in a continuation sheet.

#### *Item 6: Priority Claimed*

*Article 4(2)* 07.31 Priority of an earlier filing may be claimed under Article 4 of the Paris Convention. That earlier filing will normally be the basic application or the application which resulted in the basic registration. However it may also be:

– another application made either in a country party to the Paris Convention or in a Member of the World Trade Organization (WTO) even if the latter is not a party to the Paris Convention<sup>1</sup>; or

– an application which, under a bilateral or multilateral treaty concluded between countries of the Paris Union, is equivalent to a regular national filing<sup>2</sup>.

*Rule 9(4)(a)(iv)* 07.32 Where priority is claimed, there must be indicated the name of the national or regional Office with which the earlier filing was made, together with the date of filing and (where available) the number of the application. No copy of the earlier filing is needed.

07.33 Where priority is claimed from more than one earlier filing, and all relevant indications do not fit in the space provided, then (unless a self-generated form is used) the one(s) with the earliest date are to be given in item 6, with the remaining ones indicated in a continuation sheet.

07.34 Where the earlier filing does not relate to all of the goods and services listed in item 10 of the international application form, there should be indicated in item 6 the goods and services to which the earlier filing relates. Where several earlier filings with different dates are indicated, the goods and services to which each relates should be indicated.

*Rule 14(2)(i)* 07.35 The International Bureau will disregard any claimed priority date which is more than six months earlier than the date of the international registration and will so inform the applicant and Office of origin. Such a date will therefore not be recorded in the International Register. However, in accordance with Article 4(C)(3) of the Paris Convention, where the last day of the six-month period from the claimed priority date is a day when the Office of origin is not open for the receipt of requests to present international applications, the six-month period will, where the international registration bears the date of the receipt by the Office of origin of the said request, be extended until the first following working day at the Office of origin; similarly, where the international registration bears the date of the receipt of the international application by the International Bureau, or a subsequent date, and the last day of the six-month period is a day when the International Bureau is not open to the public, the six-month period will be extended until the first following working day at the International Bureau. (For the date of the international registration, see paragraphs B.II.12.01 to 12.06).

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<sup>1</sup> This results from the fact that Members of the WTO are obliged by Article 2(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) to comply with Article 4 of the Paris Convention. However, the members of the Madrid Union that are not Members of the WTO are not obliged to recognize the effects of a priority claim based on an application filed in a Member of the WTO that is not party to the Paris Convention. However, the Office of origin should not decline to transmit such a claim. Otherwise, a designated State which is a Member of the WTO would be hindered from fulfilling its obligation to recognize the priority claim.

<sup>2</sup> This results from Article 4A(2) of the Paris Convention. On this basis, the International Bureau records claims to priority from applications for Community Trade Marks filed with the Office for Harmonization in the Internal Market.

*Rule 14(2)(i)* 07.36 As described in paragraphs B.II.12.03 to 12.06, deficiencies or delays may cause the international registration to have a date which is later than the date on which the international application was received by the Office of origin. If the result is that the date of international registration is more than six months after any priority date claimed, the claim to priority will be lost, and no data in respect of priority will be recorded by the International Bureau.

***Item 7: The Mark***

*Rule 9(4)(a)(v)* 07.37 A reproduction of the mark must be provided in *box (a)* in item 7 of the form. Such a reproduction must consist of a two-dimensional graphic (including photographic) representation of the mark. This reproduction must be identical with the mark as it appears in the basic application or registration. In particular, where the mark in the basic registration or application is in black and white, so must the reproduction in this box; likewise where the basic mark is in color, the reproduction in this box must also be in color.

07.38 The boxes in this item of the application form measure 8cm x 8cm, which is the standard size for publication of a mark in the *WIPO Gazette of International Marks*. Where a self-generated form is used, the reproduction of the mark must nonetheless be of a size that would fit in the box, that is, it must not exceed 8 cm x 8 cm. Moreover where, in accordance with paragraph B.II.07.43, two reproductions of the mark are provided, both reproductions must be on the same page.

07.39 The reproduction(s) of the mark must be sufficiently clear for the purposes of recording, publication and notification. If this is not the case, the International Bureau will treat the international application as irregular.

07.40 The reproduction(s) of the mark may be typed, printed, pasted or reproduced by any other means, at the option of the applicant and subject to what may be prescribed by the Office of origin. Since the image used for publication is produced by scanning the application form, *the mark will be published in the Gazette exactly as it appears on the form*. For example, if it is simply typed on the form, that is what will appear in the Gazette.

*A.I. Section 9(a)* 07.41 Where the application is communicated by facsimile, the original of that page of the official form which bears the reproduction of the mark must also be sent to the International Bureau. *Only this page should be sent; the whole application must not be sent, since it may be mistaken for a new application*. There must be included on the page sufficient indications (the number of the basic application or basic registration or the Office reference number contained in the international application) to enable the international application to be identified; the Office must also sign the page. The International Bureau will, in its confirmation of receipt of the facsimile communication, remind the Office that sent it of the need to send the original of the page bearing the mark. The International Bureau will not examine the application until the original has been received or until a period of one month has elapsed since the facsimile was received, whichever is the earlier. This is because it is only when a clear reproduction of the mark is received that the International Bureau may be able to identify certain

*A.I. Section 9(b)*

irregularities. The Office of origin should therefore ensure that the original is sent without delay (preferably on the same day as the facsimile is sent), in order to avoid these adverse consequences for the applicant.

### *Special Kinds of Mark*

07.42 Where the mark is of an unusual kind (for example, a three-dimensional mark or a sound mark), then the reproduction in *box (a)* should correspond exactly with the graphical representation of the mark which appears in the basic application or registration. If the representation in the basic application or registration consists of, for example, a perspective view of a three-dimensional mark, or a representation in conventional musical notation or a description in words of a sound mark, then this is what should appear in *box (a)* under item 7. Any description which is supplementary to this graphic representation of the mark should be given under item 9 (see paragraph B.II.07.53). Non-graphical representations of such marks (such as samples of three-dimensional marks, or recordings of sound marks) must *not* be included.

### *International Registration to Be in Color*

Article 3(3)  
Rule 9(4)(a)(vii)

07.43 Where the applicant claims color as a distinctive feature of the mark but the reproduction of the mark in the basic registration or basic application was in black and white (for example, because the Office of origin did not provide for registration or publication in color), a reproduction of the mark in color must be provided in *box (b)*, in addition to the black and white reproduction to be provided in *box (a)*. Otherwise *box (b)* should be left empty.

### *Standard Characters*

Rule 9(4)(a)(vi)

07.44 Where the applicant wishes that the mark be considered as a mark in standard characters, *box (c)* should be checked. A mark in standard characters is equivalent in some countries to what is known as a “word mark”, as opposed to a “figurative” mark. This declaration does not legally bind the Office or courts of a designated Contracting Party, which are free to determine what effect (if any) such a declaration has in their territory. In particular, they may consider that the mark is not in standard characters if it contains elements such as accents which are not standard in the language(s) used in that Contracting Party.

07.45 This box should not be checked where the mark contains special characters or figurative elements. Although the International Bureau will not question a declaration concerning standard characters, the applicant should be aware that if the Office of a designated Contracting Party considers that the mark is not in standard characters, it may issue a refusal, for example, on the ground that the international registration covers two marks (one in standard characters and one in special characters) or that it is simply not clear for what protection is sought.



*Rule 9(4)(a)(viibis)* 07.46 Where the mark that is the subject of the basic registration or basic application consists of a color or a combination of colors as such, that fact should be indicated by checking the appropriate box. This is without prejudice to the fact that a designated Contracting Party may refuse protection on the ground that such marks are not recognized under its law.

#### ***Item 8: Color(s) Claimed***

*Article 3(3)* 07.47 Where color has been claimed as a distinctive feature of the mark in the  
*Rule 9(4)(a)(vii)* basic application or basic registration, such a claim should be reflected in the international application by checking the appropriate box, and the color or combination of colors must be indicated in words. Color may also be claimed in an international application despite the fact that there is not a corresponding claim in the basic application or basic registration. Where there is no such claim in the basic application or basic registration, the basic mark must be in the color or combination of colors claimed in the international application. Finally, where color is claimed, the  
*Rule 9(4)(b)(iv)* applicant may, in addition, give an indication in words of the principal parts of the mark that are in that color, in respect of each of the colors claimed (see also paragraph B.II.07.78).

#### ***Item 9: Miscellaneous Indications***

##### ***(a) Transliteration***

*Rule 9(4)(a)(xii)* 07.48 Where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals, a transliteration into Latin characters or Arabic numerals must be provided. The transliteration into Latin characters must follow the phonetics of the language of the international application.

##### ***(b) Translation***

*Rule 9(4)(b)(iii)* 07.49 Where the mark consists of or contains words which may be translated, such a translation may be provided. The translation may be into English and/or French and/or Spanish, irrespective of the language of the international application. The provision of a translation is at the option of the applicant, and is intended to forestall requests for a translation by the Office of a designated Contracting Party. The International Bureau will not check the accuracy of any translation of the mark,  
*Rule 6(4)(b)* nor will it question the absence of a translation or provide a translation of its own.

##### ***(c) Indication that the Mark Cannot Be Translated***

07.50 Where the applicant believes that the word or words appearing in the mark cannot be translated (that is, they are made-up words), this may be indicated by checking the appropriate box. This is intended to forestall a request by the Offices of designated Contracting Party for translation or for confirmation that no translation is possible.

(d) *Special Type or Category of Mark*

*Rule 9(4)(a)(viii) to (x)* 07.51 Where the mark is a three-dimensional mark, a sound mark or a collective, certification or guarantee mark, this should be indicated by checking the appropriate box. Such an indication may be given only if it appears in the basic registration or basic application.

07.52 In the case of a collective, certification or guarantee mark, regulations governing the use of the mark are not required as part of the international application, and should *not* be sent to the International Bureau with the international application. A designated Contracting Party may however ask for such regulations to be filed. In order to forestall a refusal by such a Contracting Party, an applicant may wish to send the required documents directly to the Office of that Contracting Party as soon as he receives the certificate of international registration.

(e) *Description of the Mark*

*Rule 9(4)(a)(xi)* 07.53 Where the basic application or basic registration contains a description of the mark, the same description may, if the applicant so wishes or if the Office of origin so requires, be included in the appropriate space. Such a description may also indicate that the mark is of a kind not covered by the types or categories mentioned on the form (see paragraph B.II.07.51), such as a hologram mark, provided that such an indication is present in the basic application or registration. Where the description in the basic application or basic registration is in a language other than the language of the international application, the description in this item must be given in the language of the international application.

07.54 It must be stressed that a description may be included in the international application *only if that description was included in the basic registration or basic application*. Moreover it must be a description *of the mark* and not, for example, a statement concerning the use of the mark or its reputation.

(f) *Verbal Elements of the Mark*

07.55 The International Bureau captures (from the reproduction in item 7) what appears to it to be the essential verbal elements of the mark. This is included in the ROMARIN database and is used in notifications and correspondence in order to confirm the identity of the resulting international registration. Where however the mark is in special characters or in handwriting, there is a risk that the words or letters may be misinterpreted by the International Bureau. Moreover, where the mark contains a great deal of verbal matter (for example, where the mark consists of a label), it may not be apparent what should be captured. The applicant may therefore wish to indicate what he considers to be the essential verbal elements of the mark. Any such indication is, however, entirely for information and is not intended to have any legal effect. This indication should not be given where the box in item 7 for standard characters has been checked.

(g) *Disclaimer*

*Rule 9(4)(b)(v)* 07.56 Where the applicant wishes to disclaim protection for any verbal element of the mark, the appropriate box should be checked and the element or elements for which protection is disclaimed should be indicated. The purpose of this is to forestall requests from designated Contracting Parties for such a disclaimer to be included in the International Register. If however a disclaimer is included in the international application, it must be in respect of the international registration as a whole; it cannot be made for only some of the designated Contracting Parties.

07.57 It does not matter if there was no corresponding disclaimer in the basic registration or basic application. Conversely, if there was a disclaimer in the basic registration or basic application, this does not make it obligatory to include it in the international application. There is not any possibility for the making of a disclaimer once the mark has been registered by the International Bureau.

***Item 10: Goods and Services for Which International Registration Is Sought***

*Rule 9(4)(a)(xiii)* 07.58 There must be indicated the names of the goods and services for which the international registration of the mark is sought. These must be grouped in the appropriate classes of the International Classification of Goods and Services, each group being preceded by the number of the class, and presented in the order of the classes of that Classification. The goods and services must be indicated in precise terms, preferably using words appearing in the Alphabetical List of the International Classification. If necessary, a continuation sheet should be used and the appropriate box should be checked.

07.59 This list of goods and services may be narrower than the list in the basic registration or application. It may not however be broader or contain different goods and services. This does not mean that exactly the same terms must be used; the terms used in the international application must however be equivalent to, or fall within the scope of, those used in the basic registration or application.

07.60 The Office of origin must check that all the goods and services listed are covered by those appearing in the basic application or basic registration, so that it can make the declaration referred to in paragraph B.II.07.78. The Office should also check that the classification and grouping of the goods and services is correct, in order to avoid the need for the International Bureau to notify it of any irregularity in this regard (see paragraphs B.II.09.03 to 09.13).

*Rule 9(4)(b)(v)* 07.61 The international application may contain limitations of the list of goods and services in respect of one or more designated Contracting Parties. Such limitations should be indicated in item 10(b). The limitation may be different in respect of different Contracting Parties. A limitation with respect to a designated Contracting Party for which an individual fee is payable will be taken into account in calculating the amount of that fee. In contrast, a limitation will not affect the number of supplementary fees to be paid. Even if a limitation is made for all the designated

Contracting Parties, the goods and services named in item 10(a) are nonetheless included in the international registration and may be the subject of a subsequent designation.

*Rule 6(4)(a)* 07.62 A translation of the list of goods and services into English, French or Spanish, as the case may be, may be annexed to the international application. Although the International Bureau is not bound to accept such a translation as correct (see paragraph B.II.16.02), it may assist the Bureau in ensuring that the translation reflects the applicant's intentions, particularly where the list in the basic registration or basic application is in a language other than English, French or Spanish.

### ***Item 11: Designated Contracting Parties***

*Rule 9(4)(a)(xv)* 07.63 Those States or organizations in which the applicant wishes the mark to be protected should be indicated by checking the appropriate boxes in item 11. Where a self-generated form is used, the names of the Contracting Parties to be designated should be written in.

07.64 The name of a Contracting Party for which there is no box on the official form, because it has ratified or acceded to the Agreement or Protocol since the form was printed, may be written in, provided that the ratification or accession has entered into force.

07.65 Where a State or organization which has been designated has ratified the relevant treaty, or acceded to it, but the ratification or accession has not yet come into force, the Office of origin may cancel the designation and so inform the applicant; alternatively it may ask the applicant whether he wishes the designation to be cancelled or whether he would prefer the request to be put on one side and be deemed to have been received on the date on which the ratification or accession in question comes into force.

07.66 Only States or organizations which are party to the same treaty (Agreement or Protocol) as the Contracting Party whose Office is the Office of origin may be designated. Where a State or an organization which the applicant has designated

– is a party to the Protocol only, while the Contracting Party whose Office is the Office of origin is a party to the Agreement only,

– is a State party to the Agreement only, while the Contracting Party whose Office is the Office of origin is a party to the Protocol only, or

– is not a party to either the Agreement or the Protocol,

the designations will be disregarded by the International Bureau, which will so inform the applicant.

*Indication of a Second Language (Where the European Union Is Designated)*

*Rule 9(5)(g)(ii)* 07.67 Where the European Union is designated in an international application, the applicant must, in addition to the language of the application itself, indicate a second working language before the Office of that Contracting Organization. The indication of this second language must be chosen among one of the (five) official languages of OHIM, namely, English, French, German, Italian or Spanish. With regard to the designation of the European Union in a subsequent designation, refer to paragraph B.II.37.09.

07.68 This second language serves exclusively as a language in which third parties may lodge opposition and cancellation proceedings before OHIM.

07.69 Where the European Union has been designated and the indication of the second language is missing or is incorrect, this does not prevent the International Bureau from proceeding to the international registration and notifying it to OHIM. In such a case, however, a provisional refusal based on this ground will be notified by OHIM and will have to be overcome by the holder directly before OHIM.

*Seniority Claim (Where the European Union Is Designated)*

*Rule 9(5)(g)(i)* 07.70 Under the Community Trade Mark system, the proprietor of a mark already registered in or for a member State of the European Union who applies for registration of an identical mark with OHIM for goods or services which are covered by the earlier mark, may claim the seniority of that earlier mark in respect of the Member State concerned. The effect of such seniority claim is that where the proprietor of the Community trademark surrenders the earlier mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier mark had continued to be registered.

*A.I. Section 4* 07.71 Applicants wishing to claim seniority in respect of a designation of the European Union under the Madrid Protocol are required to indicate the following elements in a *separate* official form (MM17), to be annexed to the international application form:

- each Member State 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.

07.72 With respect to the treatment of seniority claims by the International Bureau and to various operations which may arise in relation to such claims (such as the withdrawal, refusal or cancellation), see paragraphs B.II.101.01 to 101.04.

*Declaration of Intention to Use the Mark*

*Rule 9(5)(f)* 07.73 Where a Contracting Party designated under the Protocol, is one which has notified the Director General of WIPO, under Rule 7(2), that it requires a declaration of intention to use the mark on a separate form, that declaration should be annexed to the international application. Any additional requirements of that Contracting Party concerning the language or the signing of the declaration must also be complied with. In particular, a Contracting Party may require that the declaration be signed by the applicant himself.

07.74 In the case of a Contracting Party which requires a declaration of intention to use the mark under Rule 7(2), but without requiring that it be on a separate form, no special action is needed, as the statement on the international application form indicates that by designating such a Contracting Party, the applicant declares that he has the intention that the mark will be used by him or with his consent in that Contracting Party for the goods and services covered by the international application.

*Item 12: Signature by Applicant or Representative*

*Rule 9(2)(b)* 07.75 The Office of origin may require or permit the applicant or his representative to sign the international application. The International Bureau will not question the absence of a signature from item 12.

*A.I. Section 7* 07.76 Any signature by the applicant or the representative may be replaced by the affixing of a seal. In that case, an indication in letters of the name of the natural person whose seal was used is not needed. As regards electronic communications, *A.I. Section 11(a)(ii)* the signature may be replaced by a mode of identification to be determined by the International Bureau.

*Item 13: Certification and Signature by Office of Origin*

*Rule 9(2)(b)* 07.77 The Office of origin must sign the international application and must *Rule 9(5)(d)(i)* certify the date on which it received the request to present the international application (or is deemed to have received the application (see paragraphs B.II.08.02 and 08.04). This date is important because, in principle, it will become the date of the international registration (see paragraph B.II. 12.01). The Office of origin must also certify certain facts concerning the relationship between the international application and the basic registration or basic application.

07.78 The declaration of the Office of origin in item 13 of the application form must certify:

*Rule 9(5)(d)(ii)* (a) that the applicant for the international registration is the same as the holder of the basic registration or the applicant named in the basic application mentioned in item 5; where the international application is filed jointly by several applicants, they must all also be joint holders of the basic registration or applicants for the basic application;

*Rule 8*

*Rule 9(5)(d)(iv)* (b) that the mark indicated in item 7 is identical to the mark in the basic registration or application mentioned in item 5; where the Office of origin allows a mark to be altered (whether during the application stage or after registration), the declaration may be made provided that the mark that is the subject of the international application is identical to the mark in the basic registration or application at the time when the Office certifies the international application;

*Rule 9(5)(d)(iii)*

(c) that, where any of the following indications appears in the international application:

– an indication that the mark is a three-dimensional mark, a sound mark or a collective, certification or guarantee mark;

– a description, in words, of the mark;

*Rule 9(5)(d)(v)*

– an indication that the mark consists of colors or a combination of colors as such, the same indications appear also in the basic registration or application (it being understood that any description in the international application must however be in the language of the international application);

(d) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed;

*Rule 9(5)(d)(vi)*

(e) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic registration or application at the time when the Office certifies the international application; that is, each of the goods and services mentioned in the international application must either appear in the list in the basic registration or application, or must fall within a broader term included in that list; the list of goods and services in the international application may of course be narrower than that in the basic application or registration.

*Rule 9(5)(e)* 07.79 Where the international application is based on two or more basic applications and/or registrations, this declaration may be made only if the statements under (a), (b), (c) and (d) in paragraph B.II.07.78 are true for each of them. As far as the statement under (e) is concerned, the Office of origin may make this declaration provided that the goods and services mentioned in the basic application(s) and/or registration(s), taken together, cover those listed in the international application.

*Rule 9(2)(b)* 07.80 The international application must be signed by the Office of origin. *A.I. Section 7* This signature may be handwritten, printed or stamped, or may be replaced by a seal. In the latter case, an indication in letters of the name of the natural person whose seal is used is not needed. Where the application is transmitted to the International Bureau by electronic means, the signature is replaced by a mode of identification agreed with the International Bureau.

07.81 The declaration to be signed by the Office of origin and referred to in paragraph B.II.07.78 is printed on the official form. The Office of origin, by signing the form, is deemed to affirm the truth of the declaration. Where, for example, an international application contains a description or an indication which is covered by the declaration but is not present in the basic registration or basic application, or the international application includes goods and services not covered by the basic registration or application, the Office is unable to do this. It must ask the applicant to correct any discrepancy (for example, by deleting the description or indication or by restricting the list of goods and services so that it falls within the list contained in the basic registration or application). Until this has been done, the application must not be forwarded to the International Bureau.

07.82 The Office of origin should check the content of the form to the extent that this is necessary in order to avoid any irregularities for which it would be responsible (see paragraphs B.II.09.18 and 09.19). Any such examination should, however, not unduly delay the forwarding of the application to the International Bureau, as this could affect the date of the international registration (see paragraph B.II.12.02).

### ***Fee Calculation Sheet***

*The following paragraphs should be read in conjunction with the general remarks in paragraphs B.I.08.01 to 08.14 concerning the payment of fees to the International Bureau.*

*Rule 9(4)(a)(xiv)* 07.83 There must be indicated, in the fee calculation sheet contained in the official form:

– the authorization to debit the required amount from an account opened with the International Bureau and the identification of the party giving the instructions; or

– the amount of the fees being paid, the method by which payment is being made and the identification of the party making the payment.



*Fees Due*

07.84 The fees payable in connection with the filing of an international application consist of the basic fee, one or more complementary or individual fees, depending on the Contracting Parties designated and possibly one or more supplementary fees, depending on the number of classes of goods and services covered.

*Article 8(2)* 07.85 Article 8(2) of the Agreement and Article 8(2) of the Protocol provide that the fees payable in connection with an international application consist of:

- the basic fee;
- a complementary fee for each Contracting Party designated;
- a supplementary fee for each class of goods and services in excess of three.

*P Article 8(7)* 07.86 Article 8(7) of the Protocol however provides that a Contracting Party may declare that, instead of a share in the revenue produced by the supplementary and complementary fees, it wishes to receive an individual fee. Nevertheless, Article 9*sexies*(1)(b) renders inoperative a declaration under Article 8(7) in the mutual relations between Contracting Parties to both the Agreement and Protocol. In other words, where the designated Contracting Party having made the declaration is a party to both the Agreement and the Protocol and the Contracting Party whose Office is the Office of origin is also a party to both treaties, it follows from Article 9*sexies*(1)(b) (see paragraph A.04.21) that the supplementary and complementary fees, and not the individual fee, are payable.

*Rule 34(3)* 07.87 A Contracting Party that requires an individual fee may also require that the fee comprises two parts, one part to be paid at the time of filing the international application and the second part to be paid at a later date determined in accordance with the law of the Contracting Party concerned. In practice, the second part will be payable when the Office concerned is satisfied that the mark qualifies for protection. In other words, payment of the second part of the individual fee is analogous to payment of a registration fee in the case of a national application. At the stage of filing the international application, the only practical effect of this requirement is that the amount to be paid corresponds to the first part of the individual fee. The holder will be notified by the International Bureau when the second part of the fee becomes due.

07.88 In summary, the fees payable for an international application are:

- the basic fee;
- an individual fee for the designation of each designated Contracting Party that has made the relevant declaration (see paragraph B.II.07.86) and is designated under the Protocol, except where that designated Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a designation, a complementary fee is payable);

– a complementary fee for each designated Contracting Party in respect of which no individual fee is payable;

– a supplementary fee for each class of goods and services in excess of three; where however all the Contracting Parties designated are ones in respect of which an individual fee is payable, no supplementary fee is required.

07.89 The amounts of the basic, complementary and supplementary fees are set out in the Schedule of Fees. It should be noted that the amount of the basic fee depends on whether the mark is in color; where the reproduction of the mark, or one of the reproductions (see paragraph B.II.07.43), is in color, a higher fee is payable. The amounts of the current individual fees are available under the heading *Trademarks/ Madrid System/Fees / Fee Calculator* on WIPO's website. A fee calculator that takes account of all possible permutations of designations of Contracting Parties and number of classes of goods and services (including limitations in respect of particular Contracting Parties) is also available on this site.

#### *Fee Reduction for Applicants from Least Developed Countries (LDC)*

07.90 Applicants having a real and effective industrial or commercial establishment, or a domicile in a least developed country, or being a national of a least developed country (in accordance with the list established by the United Nations), and who file their international applications through the trademark office of such country, as the Office of origin, will be required to pay only 10% of the amount of the basic fee. This is reflected in the Schedule of Fees and has been incorporated in the fee calculator on the Madrid website ([www.wipo.int/madrid/en/fees/calculator.jsp](http://www.wipo.int/madrid/en/fees/calculator.jsp)).

07.91 The list of least developed countries is maintained and updated on a regular basis by the United Nations and may be consulted on the United Nations website at [www.un.org](http://www.un.org). The list may also be consulted on the WIPO website at [www.wipo.int/lpcs/en/country](http://www.wipo.int/lpcs/en/country).

#### *Payment by Debit from an Account with the International Bureau*

07.92 Where payment is to be made by debit of the required amount from an account opened with the International Bureau, the box in part (a) of the fee calculation sheet should be checked; furthermore, the holder of the account, the account number and the party giving the instructions to debit should be indicated. Where this method of payment is being used, the amount to be debited need not be indicated; indeed one of the advantages of paying by this method is that it avoids the risk of an irregularity if the fees, as calculated by the applicant or the representative, are incorrect. It is nevertheless possible to give instructions to the International Bureau to debit a specified amount from an account opened with it. In that case, the details conducting to the total amount being paid should be indicated in part (b) of the fee calculation sheet, and the instruction to debit that amount from an account with WIPO should be indicated in that same part (b) of the said sheet.

*Payment Otherwise than by Debit from an Account with the International Bureau*

07.93 The total amount being paid must be indicated in the appropriate box in part (b) of the fee calculation sheet. In addition, amounts and, preferably, the numbers of fees being paid should be indicated in the spaces provided in that part of the fee calculation sheet, in order to assist the International Bureau in identifying the error if the total is incorrect.

07.94 The identity of the party (applicant, representative or Office of origin) making the payment should be indicated in the appropriate space in part (c) of the fee calculation sheet. It is important to indicate who is making the payment, since it is that party that will be notified if the International Bureau finds that the payment is insufficient or that will be totally or partially reimbursed if the application is considered as abandoned, is not considered as such, or is withdrawn.

07.95 Where the fees are not being paid through the Office of origin, the Office should draw the attention of the applicant to the fact that international registration cannot take place until the necessary fees have been received by the International Bureau. The Office is not required to check that payment has been made, though it may do so if it thinks fit, for example by asking to see a receipt issued by the International Bureau before transmitting the international application.

07.96 The method by which the fees are being paid (see paragraph B.I.08.05) should be indicated by checking the appropriate box in part (c) of the fee calculation sheet.

### **Premature Request for International Application**

08.01 Under the Agreement, an international application can be based only on a registration of the mark recorded in the register of the Office of origin. Where an Office receives a request to present an international application that will be governed (exclusively or in part) by the Agreement, before it has registered the mark on which the international application is based, the Office will treat the request as premature. It will be dealt with as follows.

*Rule 11(1)(a)* 08.02 Where the international application will be governed *exclusively by the Agreement*, there is no possibility of it proceeding in respect of any of the designated countries until the basic mark has been registered. The Office of origin will therefore put the international application aside until it has registered the basic mark. The request is then deemed to have been received *on the date on which the basic mark was actually recorded in the register of the Office of origin*. Under the Agreement, this is a frequent practice. Applicants in States whose Offices register applications for protection in their territory relatively quickly, or whose laws provide for an accelerated procedure where the applicant intends to file an international application on the basis of the national registration, sometimes find it convenient to send to the Office of origin, on the same day, an application for the basic registration and a request to present an international application to the International Bureau once the basic mark is registered.

08.03 Where the international application will be governed *both by the Agreement and the Protocol*, the request is not premature as far as those designations that are made under the Protocol are concerned. The Office of origin is therefore required to delete those designations that would be governed by the Agreement and allow the international application to proceed as an application governed exclusively by the Protocol, *unless the applicant has explicitly requested that the application be treated as one which is governed by both the Agreement and the Protocol*. In the latter case, the international application can only proceed once the basic mark has been registered; it will therefore be treated as described in the above paragraph.

Rule 11(1)(b)

Rule 11(1)(c)

08.04 If the designations made under the Agreement have been deleted, the date of the international registration will, for those Contracting Parties which have been designated under the Protocol, be the date on which the Office of origin received the request to present the international application (provided the international application is received by the International Bureau within two months from that date, and subject to any irregularity which may affect the date of international registration). Those countries whose designations (under the Agreement) have been deleted may be the subject of subsequent designations under Rule 24, once the basic mark has been registered; the provisions of Rule 24(6) concerning the effective date of a subsequent designation will apply. On the other hand, if the applicant has explicitly requested that the application be treated as one under the Agreement and the Protocol, so that the Office of origin will put the application on one side until the basic mark has been registered, the effective date of *all* designations will be the date on which the basic mark is actually recorded in the register of the Office of origin (provided that the international application is received by the International Bureau within two months from that date, and subject to any irregularity that may affect the date of international registration).

08.05 A person who wishes to file an international application in which some designations will be governed by the Agreement and some by the Protocol, but whose basic mark has not yet been registered by the Office of origin, should therefore weigh up the relative advantages and disadvantages of these two courses before filing the request for an international application with the Office of origin.

08.06 Paragraphs B.II.08.01 to 08.05 apply in any case where the international application is based on an application, even if it is also based on a registration. It cannot proceed as an international application governed (exclusively or in part) by the Agreement until the (or each) application has resulted in a registration. Alternatively, the applicant could decide to delete the reference to the application and the goods and services to which it relates.

08.07 These problems cannot arise where the international application is governed *exclusively by the Protocol*.

### **Irregularities in the International Application**

09.01 Whenever the International Bureau considers that there is an irregularity in an international application forwarded to it, it will communicate this fact both to the Office of origin and to the applicant. Whether the responsibility for remedying it lies with the Office or with the applicant will depend on its nature.

09.02 There are three distinct kinds of irregularity, the remedying of which follow different Rules. These are:

- irregularities with respect to the classification of goods and services;
- irregularities with respect to the indication of goods and services;
- other irregularities.

#### ***Irregularities with Respect to the Classification of Goods and Services***

09.03 Final responsibility for the classification and grouping of goods and services as listed in the international application lies with the International Bureau, although the International Bureau must try to resolve any disagreement with the Office of origin. In so doing, it will, by supplying appropriate information to the applicant, give him the possibility of intervening with that Office.

*Rule 12(1)(a)* 09.04 If the International Bureau considers that the goods and services are not grouped in the appropriate class or classes, or if they are not preceded by the number of the class or classes, or if that number is not correct, it will make its own proposal, which it notifies to the Office of origin and copies to the applicant. Where a particular product or service could be classified in more than one class but only one of the applicable classes has been indicated, the International Bureau will not regard this as an irregularity. It will be assumed that the reference is only to the product or service falling in that class. Such an interpretation does not, however, bind a designated Contracting Party with regard to the determination of the scope of the protection of the mark.

*A Article 4(1)*  
*P Article 4(1)(b)*

*Rule 12(1)(b)* 09.05 That notification will also state the amount, if any, of the fees due as a consequence of the proposed amended classification and grouping. If the International Bureau considers that the goods and services indicated in the international application belong to more classes of the International Classification than indicated in the international application, additional supplementary and/or individual fees may be payable to cover the additional classes. Furthermore, an amount (specified in item 4 of the Schedule of Fees) must be paid in order to cover the work of the International Bureau in grouping the goods and services in classes and in reclassifying terms appearing in wrong classes. However, where the total amount due under this item is less than a threshold specified in the Schedule of Fees (currently 150 Swiss francs), that amount will not have to be paid.

09.06 The procedure following this notification is entirely the responsibility of the International Bureau and of the Office of origin. The information given to the applicant enables him to intervene with the Office of origin. The International Bureau cannot however accept proposals or suggestions directly from the applicant.

*Rule 12(2)* 09.07 The Office of origin may, within three months of the date of notification of this proposal, communicate its opinion on the proposed classification and grouping to the International Bureau. This opinion may originate from or be influenced by the applicant who, following the information which he received from the International Bureau, may have intervened with the Office of origin or may have been invited to give his opinion. The Office of origin is, however, not obliged to give an opinion on the proposal.

*Rule 12(3)* 09.08 If, within two months of the date of notification of the proposal, the Office of origin has not communicated an opinion on the proposal, the International Bureau will send to both the Office and the applicant a reminder, reiterating the proposal. The sending of this reminder does not affect the three-month period referred to in the above paragraph.

*Rule 12(4) to (6)* 09.09 If the Office of origin gives an opinion on the proposal of the International Bureau, the latter may, having considered this opinion, either withdraw, modify or confirm its proposal. It will notify the Office of origin accordingly and, at the same time, inform the applicant. Where the International Bureau decides to modify its proposal, the communication to that effect will also indicate any change in the amount of any fees due. Where the International Bureau withdraws its proposal, any additional amount previously claimed will not be due and, if already paid, will be reimbursed to the party having paid it.

*Rule 12(7)(c)*

*Rule 12(7)(a) and (b)* 09.10 Any additional fees that may have to be paid as a consequence of the proposed reclassification must be paid:

– where the Office of origin has communicated no opinion on the proposal of the International Bureau, within a period of four months from the date of the notification of that proposal; or

– where the Office of origin has communicated an opinion, within a period of three months from the date on which the International Bureau notified its decision to modify or confirm its proposal.

If these fees are not paid within the period prescribed, the international application will be considered abandoned. In that case, the International Bureau will notify the Office of origin and inform the applicant accordingly. If the applicant decides to withdraw one or more classes from the international application instead of paying additional individual or supplementary fees, such decision should be communicated to the International Bureau by the Office of origin.

09.11 This shows that the applicant cannot always remain inactive. When an additional amount of fees is due and, two months after the first notification (of which he was informed), he receives the reminder of the International Bureau, he should intervene with the Office of origin in order to check whether the Office intends to communicate an opinion on the proposal. He should also ensure that the payment of

the additional amount or the instructions to withdraw one or more classes (or a combination thereof) is received by the International Bureau before the expiry of the period prescribed. Even if the Office of origin agrees to collect fees and to transmit them to the International Bureau it may, under certain circumstances, be preferable to pay the amount directly to the International Bureau.

*Rule 12(8)* 09.12 If, as a consequence of non-payment of any additional amount of fees, the international application is considered abandoned, the International Bureau refunds the fees already paid for the international application to the party which had paid the fees, after deducting an amount corresponding to one half of the basic fee due for a registration in black and white.

*Rule 12(9)* 09.13 Where the International Bureau has made a proposal for the classification and grouping of the goods and services, it will, whether or not an opinion on the proposal has been communicated by the Office of origin, register the mark with the classification and grouping that it considers to be correct.

#### ***Irregularities with Respect to the Indication of Goods and Services***

*Rule 13(1)* 09.14 If the International Bureau considers that a term used in the list of goods and services is too vague for the purposes of classification, is incomprehensible, or is linguistically incorrect, it will notify the Office of origin and inform the applicant at the same time. It may suggest either a substitute term or the deletion of the term.

*Rule 13(2)(a)* 09.15 The Office of origin may, within three months of the notification, make a proposal for remedying the irregularity. The applicant may communicate his views to the Office, or the Office may seek the views of the applicant. If this proposal by the Office is acceptable, or if the Office agrees to accept any suggestion which the International Bureau may have made, the International Bureau will change the term accordingly. If the proposal made by the Office is acceptable but irregular with respect to the classification of goods and services, the procedure described above applies (see paragraphs B.II.09.03 to 09.13).

*Rule 13(2)(b)* 09.16 Where no proposal acceptable to the International Bureau is made within the time limit, there are two possibilities. If the Office of origin has specified the class in which it considers that the term should be classified, the International Bureau will include the term in the international registration just as it appears in the international application, but the international registration will contain an indication to the effect that, in the opinion of the International Bureau, the term is too vague for the purposes of classification, or is incomprehensible, or is linguistically incorrect, as the case may be. If, however, no class has been indicated, the International Bureau will delete the term and will notify the Office of origin and inform the applicant accordingly.

#### ***Other Irregularities***

09.17 Certain irregularities can only be remedied by the Office of origin and not by the applicant, while for others, the Regulations provide for either the Office or the applicant to rectify the irregularity.

*Irregularities to be Remedied by the Office of Origin*

*Rule 11(4)* 09.18 There are a number of irregularities which have to be remedied by the Office of origin within three months after notification, failing which the international application will be considered abandoned, and the Office of origin will be notified accordingly. The applicant will be informed of such a notification.

*Rule 11(4)(a)* 09.19 Remedying of the following irregularities is the responsibility of the Office of origin, since an international application containing such defects should not have been forwarded to the International Bureau by that Office:

(a) application not presented on the correct official form, or not typed or otherwise printed, or not signed by the Office of origin;

(b) in the case of an application sent to the International Bureau by facsimile, the original of the page bearing the mark has not been received (see paragraph B.I.02.06);

(c) irregularities concerning the entitlement of the applicant to file the international application; for example, on the face of the information contained in the application, the applicant does not appear to fulfill the conditions in Article 1(3) of the Agreement or, as the case may be, Article 2(1) of the Protocol with regard to the Office of origin through which the application was filed (see paragraphs B.II.02.02 and 02.03); this would be the case if, for example, the applicant has indicated (in item 3(a)) that he has an establishment or domicile in the territory of the Contracting Party whose Office is the Office of origin, while his address (given in item 2(b)) is not in that territory, but no address has been given under item 3(b) (see paragraph B.II.07.20), or the address given is also not in that territory; or the applicant's address is in the territory of that Contracting Party but it has not been indicated whether the applicant's entitlement is based on an establishment or a domicile;

(d) one or more of the following elements is missing from the application as received by the International Bureau:

– indications allowing the identity of the applicant to be established and sufficient to contact him or his representative;

– indications concerning the applicant's connection with the Office of origin (see paragraphs B.II.07.17 to 07.21);

– the date and the number of the basic registration or the basic application;

– a reproduction of the mark;

– the list of goods and services for which registration of the mark is sought;

– an indication of the Contracting Parties designated;



– the declaration by the Office of origin (see paragraph B.II.07.78).

If, therefore, the International Bureau considers that the international application is irregular in any of the above respects, it will so notify the Office of origin, and at the same time inform the applicant.

09.20 Some of these irregularities are a straightforward matter for the Office of origin. Others might necessitate consultation with the applicant – for example, if the International Bureau considers that there are irregularities relating to the entitlement of the applicant to file an international application (see paragraphs B.II.07.19 and 07.20).

*Irregularities Which Can Be Remedied by the Office of Origin or by the Applicant*

*Rule 11(3)* 09.21 This rule relates only to fees and contemplates only the case where the fees for the international application have been paid through the Office of origin. Where, in such a case, the International Bureau considers that the amount of fees received is less than the amount required, it will notify both the Office of origin and the applicant, specifying the missing amount. Normally, the Office of origin will leave it to the applicant to arrange for the necessary payment (either directly to the International Bureau or again through the Office). Alternatively the Office may itself pay the missing amount and make its own arrangements to recover the amount from the applicant. If the missing amount is not paid within three months from the date of the notification, the international application is considered abandoned and the International Bureau will notify both the Office and the applicant accordingly.

*Irregularities Which Must Be Remedied by the Applicant*

*Rule 11(2)(a)* 09.22 If the International Bureau considers that there is any irregularity other than those listed for remedying by the Office of origin, or by the Office of origin or the applicant, such irregularity must be remedied by the applicant. In such a case, the International Bureau will notify the applicant and at the same time inform the Office of origin. Such irregularities may, for example, relate to the following:

– the information given concerning the applicant or representative does not comply with all the requirements but is sufficient for the International Bureau to identify the applicant and to contact the representative; for example, the address is incomplete, or any necessary transliteration is missing;

– the indications given concerning the claiming of priority are not sufficient; for example, no filing date of the earlier application is given or the priority claim purports to relate to goods and services not covered by the international application;

- the reproduction of the mark is not sufficiently clear;
- the international application contains a color claim, but no color reproduction of the mark appears in item 7 of the form;
- the mark consists of, or contains, matter in characters other than Latin characters, or numerals other than Arabic numerals, and the international application contains no transliteration;
- the international application contains, in respect of one or more of the designated Contracting Parties, a limitation of the list of goods and services, and that limitation refers to goods and services not covered by the main list of goods and services;
- the amount of fees paid directly to the International Bureau by the applicant or his representative is insufficient;
- instructions have been given to pay the fees by debit to an account opened with the International Bureau, but the necessary amount is not available in the account;
- no fees at all have been paid.

*Rule 11(2)(b)* 09.23 Any such irregularity may be remedied by the applicant within three months from the date on which the notification of the irregularity was sent by the International Bureau. Where the irregularity relates to a deficiency in the indications concerning a claim to priority and this is not corrected within this period, the priority claim will not be recorded in the International Register. In any other case, where the international application does not comply with the requirements of the Regulations, the international application is considered abandoned if the irregularity is not remedied within the period allowed; the International Bureau will inform accordingly the applicant and the Office of origin.

*Rule 11(5)* 09.24 Where failure to remedy an irregularity leads to the abandonment of the international application, the International Bureau will refund the fees paid, after deducting an amount corresponding to one half of the basic fee for a registration in black and white.

09.25 Where the international application purports to designate a Contracting Party that may not be designated (for example, because it is a party only to the Protocol and the Office of origin is the Office of a country party only to the Agreement, or where the applicant has attempted to designate the Contracting Party whose Office is the Office of origin), the International Bureau will disregard the designation and will inform accordingly the Office of origin.

*Irregularities Concerning a Declaration of Intention to Use the Mark*

*Rule 11(6)(a)* 09.26 Where a Contracting Party that has been designated under the Protocol is one which requires a declaration of intention to use the mark *which is on a separate form annexed to the international application* and the International

- Rule 11(6)(b)* Bureau finds that the declaration is missing or does not comply with the applicable requirements, the International Bureau will promptly notify the applicant and the Office of origin. Provided that the missing or corrected declaration is received by the International Bureau within a period of two months from the date on which the request to present the international application was received by the Office of origin, the declaration will be deemed to have been duly filed, and the date of the international registration will be unaffected by the irregularity.
- Rule 11(6)(c)* 09.27 If however the missing or corrected declaration is not received within that period, the designation of the Contracting Party in question will be deemed not to have been made. The International Bureau will so notify both the applicant and the Office of origin and will reimburse any fee paid in connection with the designation of that Contracting Party. The International Bureau will also point out that the designation in question may be effected as a subsequent designation, provided that such designation is accompanied by the required declaration of intent to use.

### **Registration, Notification and Publication**

- Rule 14(1)* 10.01 Where the International Bureau finds that the international application conforms to the applicable requirements, it registers the mark in the International Register. It also notifies the Offices of the designated Contracting Parties of the international registration, informs the Office of origin and sends a certificate to the holder. Where however the Office of origin so wishes and has informed the International Bureau accordingly, the certificate will be sent to the holder through the Office of origin. The certificate of international registration is not considered to be a notification and will always be in the language of the international application even if the applicant has expressed the wish referred to in paragraph B.II.07.14.
- Rule 32(1)(a)(i)* 10.02 The international registration is published in the Gazette.

## **THE INTERNATIONAL REGISTRATION**

### **Effects of the International Registration**

- Articles 3bis and 3ter* 11.01 The effects of the international registration extend to the Contracting Parties expressly designated by the applicant in the international application.
- Article 4(1)* 11.02 From the date of international registration, the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been filed directly with the Office of that Contracting Party. If no refusal is notified to the International Bureau within the prescribed time limit, or a refusal so notified is not regarded as such or is subsequently withdrawn, the protection of the mark in the Contracting Party concerned is the same, as from the date of the international registration, as if the mark had been registered by the Office of that Contracting Party.

### **Date of the International Registration**

*Article 3(4)* 12.01 The international registration resulting from an international application will, as a rule, bear the date on which the international application was received by the Office of origin (or, in the case of a premature international application, was deemed to have been received; see paragraphs B.II.08.01 to 08.04).

12.02 Where, however, the international application is not received by the International Bureau within a period of two months from the date on which it was received (or deemed to have been received) by the Office of origin, the international registration will instead bear the date on which the application was actually received by the International Bureau. Where, however, it is established that the late receipt resulted from an irregularity in a postal or delivery service (see paragraphs B.I.06.01 to 06.03), the international registration may still bear the date on which the international application was received or deemed to have been received by the Office of origin.

#### ***Irregularities: Date in Special Cases***

*Rule 15(1)* 12.03 The date of international registration may be affected if any of the following important elements is missing from the international application:

- indications allowing the identity of the applicant to be established and sufficient to contact him or his representative;
- designation of the Contracting Parties where protection is sought;
- a reproduction of the mark;
- the indication of the goods and services for which registration of the mark is sought.

If the date on which the last missing element reached the International Bureau is still within the two-month period referred to in Article 3(4), the international registration will bear the date on which the defective international application was originally received (or is deemed to have been received) by the Office of origin. Where any of these elements does not reach the International Bureau until after the expiry of this two-month period, the international registration will bear the date on which that element has reached the International Bureau.

*Rule 11(4)* 12.04 The remedying of any of the above deficiencies is the responsibility of the Office of origin. The applicant will however have been informed of the irregularity, and may wish to contact the Office in order to ensure that the deficiency is rectified as speedily as possible. If it is not rectified within three months of the date on which the Office of origin was notified of the irregularity, the application will be considered abandoned.

12.05 The combined application of these rules may be illustrated with the following example:

An international application is filed with the Office of origin on April 1, and is received by the International Bureau on May 1. The International Bureau notices that no Contracting Party is designated in the international application; on May 5, the International Bureau notifies the Office of origin of the irregularity and invites it to remedy the irregularity before August 5;

– if the Office remedies the deficiency on or before June 1, the date of the international registration will be April 1;

– if the Office remedies the deficiency after June 1 but on or before August 5, the date of the international registration will be the date on which the missing information was received by the International Bureau;

– if the Office does not remedy the irregularity on or before August 5, the international application will be considered abandoned.

*Rule 15(2)* 12.06 The date of an international registration is not affected by any deficiencies other than those referred to in paragraph B.II.12.03 (such as the late payment of fees or irregularities concerning the classification of goods and services).

### **Period of Validity**

*P Article 6(1)* 13.01 Under the Protocol, registration of the mark is effected for 10 years from  
*P Article 7(1)* the date of international registration, with the possibility of renewal for further periods of 10 years.

*A Article 6(1)* 13.02 The Agreement provides for registration and renewal to be effected for  
*A Article 7(1)* periods of 20 years. Under the Regulations however, the fees due in the case of an international application governed by the Agreement must be paid in two installments of 10 years. In respect of the payment of the second installment, the procedures and requirements which apply to the renewal of a registration are applicable. For all practical purposes therefore, any international registration can be regarded as due for renewal every 10 years. (See paragraphs B.II.73.01 *et seq.*)  
*Rule 10*  
*Rule 30(4)*

## **Registration in the International Register**

### **Content of the International Registration**

*Rule 14(2)* 14.01 The international registration contains:

- all the data contained in the international application (except data relating to an invalid claim to priority – that is, where the date of the earlier filing is more than six months before the date of the international registration);
- the date and the number of the international registration;

– where the mark can be classified according to the International Classification of Figurative Elements (Vienna Classification), the relevant classification symbols as determined by the International Bureau; when however the international application contains a declaration to the effect that the applicant wishes that the mark be considered as a mark in standard characters, symbols from the Vienna Classification will *not* be applied;

– an indication, with respect to each designated Contracting Party, as to whether it is designated under the Agreement or designated under the Protocol;

– indications relating to a seniority claim (see paragraphs B.II.07.70 to 07.72), concerning the Member State or Member States in or for which the earlier mark, for which seniority is claimed, is registered, the date from which the registration of that earlier mark was effective and the number of the relevant registration.

### **Publication of the International Registration**

*Rule 32(1)(a)(i)* 15.01 The international registration is published in the Gazette.

*Rule 32(1)(b)* 15.02 The reproduction of the mark is scanned from the international application form and is therefore published exactly as it appears in the international application. Thus, for example, where the mark has been typed on the form, this is what will be published in the Gazette. Where the applicant has made a declaration that he wishes that the mark be considered as a mark in standard characters, the publication will include an indication of that fact.

*Rule 32(1)(c)* 15.03 Concerning the PDF version only, where a color reproduction of the mark has been furnished, the main entry of the Gazette will contain a reproduction of the mark in black and white, while the reproduction in color will be published in a separate section at the end of the Gazette. Where the international application contained both a reproduction in black and white and a reproduction in color, the black and white reproduction in the main entry will be accompanied by the indication “see color reproduction at the end of this issue.” Where the reproduction of the mark in the international application was only in color, a black and white reproduction will be prepared by the International Bureau for the purposes of publication in the main entry in the Gazette and will be accompanied by the indication “see original in color at the end of this issue.”

*Rule 33(1) and (2)* 15.04 If an international application is not recorded in the International Register within three working days following the receipt by the International Bureau, the data will nonetheless be entered forthwith in the database. This data will contain any irregularities that exist in the international application. (For more information concerning this database, see paragraphs A.09.01 to 09.04).

### Language of Registration and Publication

- Rule 6(3)* 16.01 An international registration will be recorded and published in English, French and Spanish.
- Rule 6(4)(a)* 16.02 The translations needed for recording and publication are prepared by the International Bureau. The applicant may annex to the international application a translation of any text contained in the international application. The International Bureau is, however, not bound to accept this translation; if it considers the proposed translation not to be correct, it will correct it, after inviting the applicant to make, within one month, observations on the proposed corrections. If no observation is sent with the prescribed time limit, the proposed translation is corrected by the International Bureau. This procedure will not affect the date of the international registration.
- Rule 6(4)(b)* 16.03 The mark will not be translated by the International Bureau, nor will any translation of the mark which the applicant has given be checked by the International Bureau.

## REFUSAL OF PROTECTION

### Grounds for Refusal

- Article 5(1)* 17.01 Each designated Contracting Party has the right to refuse the protection of the international registration in its territory. Such refusal may be based on any grounds that are supported by a provision of the Paris Convention, or that are not prohibited by a provision of the Convention, and any such refusal will generally be subject to review or appeal, depending upon the laws and practice of the Contracting Party concerned.
- 17.02 A refusal may thus be based on the grounds that would apply under Article 6*quinquies*(B) of the Paris Convention. Strictly speaking, Article 6*quinquies* of the Paris Convention applies only where the mark concerned is *registered* in its country of origin. This is necessarily the case where the international registration is based on a registration (as must always be so where the designation of the Contracting Party concerned is governed by the Agreement). In principle, therefore, where an international registration is based on an application in the country of origin, an Office would be entitled to refuse protection on grounds other than those mentioned in Article 6*quinquies*. There are, however, good reasons for not following that course. Firstly, having such a dual regime would be generally inconvenient, both for the Office and the holder. Secondly, one reason why Article 6*quinquies* applies only where the mark is actually registered in the country of origin is in order to prevent the benefits of the provision being enjoyed by marks which would not be eligible for protection in that country. If, however, the mark is in due course held by the Office of origin not to be eligible for protection (or to be eligible for protection only for a narrower range of goods and services), then the Office of origin will request that a corresponding cancellation be made of the international registration (see later paragraphs B.II.84.01 to 85.13); this will be reflected in the scope of the protection sought in the designated

Contracting Party. Moreover, even if the mark has not yet been registered by the Office of origin, the obligation to limit objections to the grounds mentioned in Article 6*quinquies* would apply if the mark has been registered in another country which is a party to the Paris Convention, even if that country is not a party to either the Agreement or Protocol.

17.03 A Contracting Party may not refuse protection of an international registration, even partially, on the ground that the applicable legislation permits registration only in a limited number of classes or for a limited number of goods or services. Even if that legislation requires that an application made directly to that Office must be in one class only, the Office must accept that an international registration may be protected in that Contracting Party where it relates to several (or even all 45) classes of goods and services.

17.04 The notification of the designation may include a declaration that the holder wishes the mark to be considered as a mark in standard characters. The question of standard characters is a difficult one, because of the additional indications (such as accents) which may be standard in one language but not in another. It is therefore entirely up to each designated Contracting Party to decide what is the effect of such a declaration. An Office (and the courts) may, for example, decide to ignore such a declaration when determining such matters as the extent of protection or conflict with another mark. In that case, the Office of the Contracting Party concerned would be free, for its own purposes, to assign a classification symbol of the Vienna Classification to the mark in respect of which an international registration is effected (where the standard character declaration has been made, the International Bureau will not have applied the Vienna Classification).

17.05 The International Bureau will already have established, before notifying the designation to the Contracting Party, that all applicable formal requirements of the Agreement or of the Protocol and the Common Regulations have been complied with. An Office should therefore never have occasion to raise objections on formal or presentational grounds. Where the Contracting Party is one which requires a declaration of intention to use the mark which is on a separate form signed by the applicant, the International Bureau will have established that this has been supplied before it notified the international registration or the subsequent designation to the Contracting Party. Where the Contracting Party requires a declaration of intention to use, but does not require that this be on a separate form then, as the rubric on the international application form or subsequent designation form indicates, the applicant or holder is deemed, in designating that Contracting Party, to have made the required declaration. Moreover, provision is made for an international application or subsequent designation to contain various other indications which may be required by particular Contracting Parties.

17.06 Nor is it appropriate for an Office to object to the classification of the goods and services in the international registration. Even if an Office disagrees with the classification (which will of course have been approved by the International Bureau), an objection on such grounds would have no effect, since the classification in the International Register remains unchanged. An Office may of course use its own interpretation of the classification, for example, in order to



*A Article 4(1)* carry out a search for earlier conflicting marks; indeed it is explicitly provided that  
*P Article 4(1)(b)* the indication of the classes does not bind Contracting Parties with regard to the determination of the scope of the protection of the mark.

17.07 An Office may object if it considers that a term is too broad or too vague; such objection might take the form of a partial refusal, resulting in the replacement of the broad or vague term by a more narrow or precise term in the entry in the International Register as it applies to that Contracting Party – in effect, a limitation of protection for that Contracting Party.

### Time Limits for Refusal

18.01 Refusal must be notified to the International Bureau within a prescribed time limit. Any refusal sent after that time limit will not be considered as such by the International Bureau (see paragraph B.II.21.02). It is not necessary that a final decision on the refusal be taken within the applicable time limit; it is sufficient that all grounds for refusal are notified within the time limit. In other words, what must be sent within the applicable time limit is a *provisional* refusal. An Office may notify additional grounds with respect to that particular international registration in further notifications of refusal, provided that it sends such further notifications to the International Bureau within the time limit. However, the Office may not base a confirmation of total provisional refusal or a statement of grant of protection indicating the goods and services for which the protection of a mark is granted on a ground which was not mentioned in a notification of provisional refusal made within the applicable time limit.

*A Article 5(2)* 18.02 The normal time limit for the notification of a provisional refusal is one  
*P Article 5(2)(a)* year from the date on which the International Bureau has notified the international registration or the subsequent designation to the Office of the designated Contracting Party, unless the legislation of that Contracting Party provides for a shorter period.

*P Article 5(2)(b)* 18.03 However, any Contracting Party to the Protocol may declare that, for international registrations in which it is designated under the Protocol, the time limit of one year is replaced by 18 months (see paragraph B.II.18.05).

*P Article 5(2)(c)* 18.04 In that declaration, the Contracting Party may also specify that a refusal of protection resulting from an opposition may be notified to the International Bureau after the expiry of the period of 18 months. The Office of a Contracting Party that has made this declaration may, with respect to a given international registration in which that Contracting Party is designated under the Protocol, notify, after the expiry of the 18-month time limit, a refusal of protection resulting from an opposition, but only if

– before the expiry of the 18-month time limit, it has informed the International Bureau of the possibility that oppositions with respect to this international registration may be filed after the expiry of the 18-month period, and

– the notification of refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.

*P Article 9sexies* 18.05 Notwithstanding the general principle that the Protocol applies between States bound by both the Agreement and the Protocol (see paragraphs A.02.16 to 02.25), paragraph (1)(b) of Article 9sexies renders inoperative a declaration under Article 5(2)(b) and (c) in the mutual relations between States bound by both treaties. What this means, in effect, is that in the case of an international application where the Office of origin is the Office of a Contracting Party bound by both treaties, a designation of a Contracting Party bound by both treaties will, while being governed by the Protocol, and not the Agreement, nevertheless be subject to the standard regime of Article 5(2)(a) – that is, the time limit of one year for the notification of a provisional refusal, notwithstanding that the designated Contracting Party in question may have declared an extended period for notifying a provisional refusal.

*A.I. Section 14* 18.06 In order to determine whether a notification of provisional refusal was sent within the appropriate time limit, the date of sending of a notification sent by post will be determined by the postmark. If the postmark is illegible or missing, the International Bureau treats the notification as having been sent 20 days before the date on which it was actually received by the International Bureau; if, however, this date would be earlier than the date of any refusal or date of sending mentioned in the notification, the notification is treated as having been sent on the latter date. In the case of a notification sent through a delivery service, the date of sending is determined by the information recorded by the delivery service.

*Rule 16(1)(b)* 18.07 When an Office informs the International Bureau, in connection with a given international registration, of the possibility that oppositions may be filed after the expiry of the 18 months period, it must, where the dates on which the opposition period begins and ends are known, indicate those in the communication. If such dates are, at that time, not yet known, they must be communicated to the International Bureau once they become known. If the opposition period is renewable, the Office may only communicate the date from which this period begins. The International Bureau will record this information in the International Register, transmit it to the holder of the international registration and publish it in the Gazette.

*Rule 16(2)*  
*Rule 32(1)(a)(ii)*

18.08 Provided that the warning concerning the possibility of later oppositions has been given, as described in the preceding paragraph, an Office may notify a refusal based on an opposition after the end of the 18-month period. An example may help in understanding the operation of these provisions:

– An international registration designates a particular Contracting Party in respect of goods (X + Y + Z).

– Upon examination, the Office considers that a mark should be refused protection for some of the goods concerned (X + Y), but may be protected for the remaining goods (Z) and, nine months after the date on which the notification of the designation was sent to it, issues a notification provisionally refusing protection for goods (X + Y). This notification states that the holder should inform the Office within six months if he wishes to request review of this refusal; it also informs him that, once the position has been resolved *vis-à-vis* the objections raised by the Office, there is a possibility of an opposition being filed by a third party, even if this is after the end of the period of 18 months from the

notification of the designation; it also states that, if the holder does not respond within this period of six months, the mark will be regarded as protected in the Contracting Party concerned for goods (Z) but refused for goods (X + Y), that the Office will publish a notice to this effect and that an opposition to the protection in respect of goods (Z) may be filed within the four months following the publication of that notice.

– The holder responds within the six-month period, requesting a review of the provisional refusal in respect of goods (X + Y); following such a review, a decision is issued, refusing protection for goods (X) but allowing protection for goods (Y); the Office publishes a notice to the effect that the mark is to be protected for goods (Y + Z), and that any opposition to this may be filed within four months of the date of publication of the notice; the communication informing the holder of the decision also indicates that this notice is being published, together with its date and the duration of the opposition period.

– Alternatively, the holder does not respond within the period prescribed by the Office to the notification refusing protection for goods (X + Y); at the end of this period, the Office publishes a notice to the effect that the mark is to be protected for goods (Z) and that any opposition to this may be filed within four months of the date of publication of the notice; at the same time, the holder is informed that this notice is being published, together with its date and the duration of the opposition period.

This example is merely indicative. Many variants are possible, and the details will of course vary, depending on the legislation of each Contracting Party.

18.09 In summary, upon the expiry of one year the holder will know whether his mark is protected in a given Contracting Party, or whether there is a possibility that protection will be refused and, if so, for what reasons, in the following situations:

- for all designations that are governed by the Agreement;
- for all designations that are governed by the Protocol, where the designated Contracting Party has not made a declaration extending the refusal period to 18 months; and
- for all designations that are governed by the Protocol where the designated Contracting Party has made a declaration extending the refusal period to 18 months, *but* the Contracting Party through which the holder was entitled to make that designation and the designated Contracting Party are both party to the Agreement (by virtue of Article 9*sexies*(1)(b) of the Protocol) (see also paragraphs A.02.16 to 02.25).

18.10 In respect of any designation, governed by the Protocol, of a Contracting Party that has made the declaration extending the time limit to 18 months and in respect of which the derogation provided for in paragraph (1)(b) of Article 9*sexies* does not apply, the holder will know, upon the expiry of 18 months, whether his mark is protected in that designated Contracting Party, or whether there is a possibility that protection will be refused and, if so, for what reasons. Where that designated Contracting Party has also made the declaration allowing for the possibility of

notifying, after the period of 18 months, provisional refusals resulting from an opposition, the holder will know, after the expiry of 18 months, whether there is a possibility that oppositions may be filed at a later stage.

18.11 A change may occur in the treaty applicable to the *recorded* designation of a Contracting Party bound by both the Agreement and the Protocol (see paragraphs A.02.26 to 02.31). However, such a change will not have an impact on the refusal period, even where that period is still running. This results from the fact that the application of paragraph (1) and paragraph (2) of Rule 18 of the Common Regulations (dealing with irregular notifications of provisional refusal) is dependent on the expressions “*Contracting Party designated under the Agreement*” and “*Contracting Party designated under the Protocol*”. By virtue of Rule 1(xvii) and (xviii), these terms are defined as *requests* for extension of protection. Thus, the refusal period is determined by reference to the situation which pertained at the time of filing and is unaffected by any subsequent change in the applicable treaty.

18.12 Where the time limit for the notification of a provisional refusal has expired without the International Bureau having recorded a notification of provisional refusal in respect of the designation of any given Contracting Party, then a statement to that effect will appear on the ROMARIN database.

## **Procedure for Refusal of Protection**

### **Notification of Refusal of Protection**

*Rule 17(1)* 19.01 The notification of refusal is sent by the Office concerned to the International Bureau. It may comprise a declaration stating the grounds on which the Office considers that protection cannot be granted (“*ex officio* provisional refusal”), or stating that protection cannot be granted because an opposition has been filed (“provisional refusal based on an opposition”) or both. A notification of refusal must relate to only one international registration.

### ***Contents of the Notification***

*Rule 17(2)* 19.02 A notification of provisional refusal that is not based on an opposition must contain the following information and indications:

- the Office making the notification;
- the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number;
- all the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law;
- if the grounds on which the refusal is based refer to an application for registration, or a registration, of a mark with which the mark that is the subject of

the international registration appears to be in conflict, all relevant data concerning that mark, including the filing or registration date and number, the priority date (if any), a reproduction of the mark (which may, if the mark contains no figurative elements, be simply typed), the name and address of the owner of the mark and a list of all the goods or services covered by that mark or of the relevant goods or services; this list may be in the language of the said application or registration;

– either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are affected, or are not affected, by the provisional refusal;

– the time limit, reasonable under the circumstances, for filing a request for review of or appeal against the provisional refusal or for filing a response to the opposition, and the authority to which such request for review or appeal shall lie; if such request for review or appeal must be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal, this will also be indicated.

19.03 The requirement according to which all grounds on which the provisional refusal is based must be indicated, together with a reference to the corresponding essential provisions of the law, is of particular importance for the holder. In practice, refusals are generally communicated by the Office concerned on a special form on which are printed all the relevant provisions of the law applicable to that Office which could constitute a ground for refusal (those provisions being translated, where necessary, into the language which is used by the Office for sending communications to the International Bureau). The grounds applicable in a particular case are mentioned in the notification, with a reference to the corresponding provision or provisions of the law as reproduced on the form.

19.04 If the notification of provisional refusal specifies that a local representative must be appointed, the requirements for appointment will be governed by the law and practice of the Contracting Party concerned. These are likely to be different from the requirements for the appointment of a representative before the International Bureau.

#### ***Additional Contents of the Notification when Provisional Refusal Based on Opposition***

*Rule 17(3)* 19.05 Where the provisional refusal of protection is based on an opposition or on an opposition and on other grounds, the notification will indicate that fact. In addition to the indications referred to in paragraph B.II.19.02, it will contain the name and address of the opponent and, where the opposition is based on a mark which has been the subject of an application or registration, a list of the goods and services on which the opposition is based. The Office may, in addition, communicate the complete list of goods and services of that earlier application or registration. These lists may be in the language of the earlier application or registration (even if that language is neither English nor French nor Spanish).

***Recording and Publication of the Provisional Refusal: Transmittal to the Holder***

- Rule 17(4)* 20.01 The provisional refusal is recorded in the International Register, together with an indication of the date on which the notification was sent (or is regarded as having been sent – see paragraph B.II.21.05). The provisional refusal is also published in the Gazette, with an indication as to whether the refusal is total (i.e., relates to all the goods and services covered by the designation of the Contracting Party concerned) or partial (i.e., relates to only some of those goods and services). In the latter case, the classes affected (or not affected) by the provisional refusal are published but not the goods and services themselves. These are not published until the proceedings before the Office have been completed. The grounds for refusal are not published.
- Rule 32(1)(a)(iii)*
- Rule 17(4)* 20.02 The International Bureau then transmits a copy of the notification to the holder. It also transmits to the holder any information sent by the Office of a designated Contracting Party concerning the possible filing of an opposition after the expiry of the 18 month time limit, as well as any information concerning the dates on which the opposition period begins and ends. In addition, since January 1, 2009, the International Bureau has made available to users digitalized copies of notifications of provisional refusal on the ROMARIN database.
- Rule 16(2)*

***Language of the Notification of Provisional Refusal***

- Rule 6(2)* 20.03 The provisional refusal may be notified to the International Bureau in English, French or Spanish (at the option of the Office making the notification). The refusal will be recorded and published in all three languages. The required translation of the data to be recorded and published is prepared by the International Bureau. The holder will receive from the International Bureau a copy of the notification of refusal, in the language in which it was sent by the Office of the designated Contracting Party. The communication by the International Bureau forwarding the copy of the notification of refusal will however be in the language in which the international application was filed (or the language in which the holder has asked to receive communications from the International Bureau – see paragraph B.I.07.04).
- Rule 6(3)*
- Rule 6(4)*
- Rule 40(4)* 20.04 It should be noted, in the context of refusals, that for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of the first subsequent designation:
- if governed exclusively by the Agreement, French will continue as the sole language of communication, recording and publication.
  - if governed wholly or partly by the Protocol, English and French will continue as the language of communication, recording and publication.

For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of the first subsequent designation:

– if governed exclusively by the Agreement, then, as above, French will continue as the sole language of communication, recording and publication. Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004.

### **Irregular Notifications of Provisional Refusal**

21.01 There are two kinds of irregular refusals, those which can be remedied and those which entail that the notification of refusal will not be considered as such by the International Bureau.

*Rule 18(1)(a) and (2)* 21.02 A notification of provisional refusal will not be regarded as such by the International Bureau if:

– it does not contain any international registration number (unless other indications contained in the notification permit the International Bureau to identify the international registration concerned);

– it does not indicate any grounds for refusal; or

– it was sent too late to the International Bureau; that is, it was sent after the expiry of the relevant time limit of one year or 18 months referred in paragraphs B.II.18.02 to 18.03 (and 18.05) or, in the case of a refusal based on an opposition issued by the Office of a Contracting Party that has made the declaration referred to in paragraphs B.II.18.04 and 18.05, it was sent after the expiry of 18 months without the Office having, within the time limit of 18 months, informed the International Bureau that there was a possibility of oppositions being filed after the expiry of that period. In this regard, see also paragraph B.II.18.11, concerning a change in the applicable treaty.

*Rule 18(1)(b) and (2)(c)* 21.03 In all these cases, the International Bureau will nevertheless transmit a copy of the notification to the holder and inform him (and at the same time the Office that sent it) that it does not regard the notification of refusal as such, and indicate the reasons therefor.

*Rule 18(1)(c)* 21.04 If the notification is irregular in other respects (for example, if the indication of the goods and services that are affected, or not affected, by the refusal is missing, or if the notification does not contain a reproduction of a conflicting earlier mark, or if other relevant details relating to the earlier mark, including the name and address of its owner are missing), the International Bureau will (except in the circumstances referred to in the following paragraph) nonetheless record the provisional refusal in the International Register. It will then invite the Office to rectify its notification within two months. At the same time, it will send to the holder copies of the irregular notification of refusal and of the invitation sent to the Office.

*Rule 18(1)(d)* 21.05 Where however the notification does not contain the prescribed indications concerning the time limit for filing a request for review or an appeal or a response to an opposition and the authority to which this should be addressed, the provisional refusal will not be recorded in the International Register. If the Office

sends a rectified notification within the two-month period referred to in the invitation, the International Bureau will, for the purposes of Article 5(2) of the Agreement and of the Protocol, regard this rectified notification as having been sent on the date on which the defective notification had been sent to it. That is, if the defective notification had been sent within the period applicable under Article 5(2) of the Agreement or Protocol, a rectified notification which is sent within the two-month time limit mentioned in the invitation will be regarded as having met the requirements of that provision. If however the Office does not, within this two-month time limit, rectify its notification which is defective in this respect, it will not be regarded as a notification of provisional refusal. The International Bureau will inform the holder and the Office that it does not regard the notification as such, indicating the reasons therefor.

*Rule 18(1)(e)* 21.06 Where an Office rectifies a notification of refusal that specified a period for requesting review or appeal, it should also, where it is appropriate, specify a new period (for example, starting from the date on which the rectified notification was sent to the International Bureau), preferably with an indication of the date on which the said time limit expires.

*Rule 18(1)(f)*

21.07 The International Bureau will send a copy of any rectified notification to the holder.

21.08 It is useful for the holder of the international registration that the International Bureau transmits to him copies of any irregular notification of provisional refusal and, in the case of irregularities that can be remedied, of the invitation sent to the Office to remedy it. In most of the latter cases, that Office will remedy the irregularity, but the holder will have had more time to analyze the grounds for refusal and perhaps to start negotiations with holders of prior rights which have been cited *ex officio* or who may have opposed the international registration.

21.09 Even if a notification of provisional refusal is not regarded as such by the International Bureau, and is consequently not recorded in the International Register, the holder should be aware that this does not necessarily mean that there are no problems concerning the protection of the mark in the Contracting Party concerned. It may be possible for a third party to initiate an invalidation action against the designation, based on the same grounds as were cited by the Office in the defective notification of refusal. Depending on the irregularity contained in the notification of provisional refusal, the holder may find it advisable to request from the Office concerned complete information in respect of the grounds for refusal of protection.

### **Procedure Following Provisional Notification of Refusal**

*Article 5(3)* 22.01 Where the holder of an international registration receives, through the International Bureau, a notification of refusal (including an irregular notification of refusal under Rule 18(1)(c), see paragraphs B.II.21.04 to 21.05), he has the same rights and remedies (such as review of, or appeal against, the refusal) as if the mark had been deposited directly with the Office that issued the notification of refusal. The international registration is, therefore, with respect to the Contracting Party concerned, subject to the same procedures as would apply to an application for registration filed with the Office of that Contracting Party.



22.02 When lodging a request for review or an appeal against a decision of refusal of registration or responding to an opposition, the holder may, even if this is not required by the law of the Contracting Party concerned, find it useful to employ a local representative who is familiar with the law and practice (and the language) of the Office that pronounced the refusal. The appointment of such a representative is entirely outside the scope of the Agreement, Protocol and Common Regulations, and is governed by the law and practice of the Contracting Party concerned.

22.03 It is not within the competence of the International Bureau to express an opinion as to the justification of a refusal of protection or to intervene in any way in the settlement of the substantive issues raised by such a refusal.

### **Status of a Mark in a Designated Contracting Party**

23.01 Rules 18*bis* and 18*ter* of the Common Regulations, as in force since September 1, 2009, are concerned with the status, in a designated Contracting Party, of a mark that has been the subject of an international registration, and the communication to the International Bureau, by an Office, of such status.

#### **Interim Status of a Mark**

*Rule 18bis(1)(a)* 24.01 By virtue of Rule 18*bis*(1)(a), in force since September 1, 2009, an Office which has not communicated a notification of provisional refusal within the applicable time limit, may send to the International Bureau a statement to the effect that the *ex officio* examination has been completed and that the Office has found no grounds for refusal, but that the protection of the mark is still subject to opposition or observations by third parties. The Office should indicate also the date by which such oppositions or observations may be filed.

*Rule 18bis(1)(b)* 24.02 It may also be in the interest of the holder of the international registration concerned, or of third parties, to have information relating to the status of a mark when the Office in question has given notification of a provisional refusal, before reaching a favorable conclusion for the holder, following the completion of the *ex officio* examination. In such case, the Office may also send to the International Bureau a statement to the effect that the *ex officio* examination has been completed but that the protection of the mark is still subject to opposition or observations by third parties (see Rule 18*bis*(1)(b)). Equally, in its statement, the Office shall indicate the date by which such oppositions and observations may be filed.

24.03 The sending by an Office of a statement under Rule 18*bis*(1)(a) or (b) to the International Bureau is optional. There is, therefore, no obligation for an Office that has completed its examination to send a statement to this effect to the International Bureau.

*Rule 18bis(2)* 24.04 The International Bureau shall record any statement received under Rule 18*bis*(1)(a) or (b) in the International Register, inform the holder of the international registration concerned and, where the statement was communicated, or can be reproduced, in the format of a specific document, transmit a copy of that

document to the holder. For the purpose of this rule, the International Bureau accepts from Offices lists of international registration numbers, which it will convert into individual communications transmitted to the holders of the international registrations concerned.

24.05 If the Office of a Contracting Party designated in an international registration has sent a statement under Rule 18*bis*(1)(a) or (b) to the International Bureau, that Office must, in due course, either:

– communicate to the International Bureau a notification of provisional refusal of protection in accordance with Rule 17(1), if an opposition or observations are filed during the applicable refusal period; or

– in the absence of opposition or observations having been filed during the applicable refusal period, send to the International Bureau a statement of grant of protection in accordance with Rule 18*ter*(1) or (2).

### **Final Disposition on the Status of a Mark**

*Rule 18ter* 25.01 Paragraphs (1), (2) and (3) of Rule 18*ter*, which entered into force on September 1, 2009, require the Office of a Contracting Party designated in an international registration to send a statement to the International Bureau informing it of the final status of a mark in the Contracting Party concerned, as soon as all the procedures concerning the protection of the mark before this Office have been completed.

25.02 There are three different types of final dispositions on the status of a mark, which are described below.

#### **Statement of Grant of Protection where no Notification of Provisional Refusal has been Communicated**

*Rule 18ter(1)* 26.01 Firstly, where, before the expiry of the applicable refusal period under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all the procedures before the Office of a Contracting Party designated in an international registration have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible, and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned. Regarding the period within which a notification of provision refusal is required to be sent, see paragraphs B.II.18.01 to 18.12. Generally, this situation may occur when the Office uses an examination system without opposition or observations or when the opposition or observations period begins at the same time as the examination.

26.02 Thus, insofar as there is no ground for the Office of a designated Contracting Party to refuse protection and when all the procedures before that Office are completed, the holders of international registrations and third parties are then informed, as soon as possible, and before the expiry of the refusal period, of

the outcome of the procedure in that designated Contracting Party. Rule 18ter(1) reduces the disadvantages linked to what is known as the principle of “tacit acceptance”. However, this principle remains applicable.

*Rule 18ter(1)* 26.03 Rule 18ter(1), which entered into force on September 1, 2009, makes it  
*Rule 40(5)* obligatory to send a statement of grant of protection. However, in order to facilitate the work of Offices which might need time for the implementation of the Rule, the transitional provision which is contained in Rule 40(5) states that the obligation to send a statement of grant of protection under Rule 18ter(1) does not in fact come into full effect until January 1, 2011.

26.04 A statement of grant of protection under Rule 18ter(1) may concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of those international registrations. However, where that is the case, the International Bureau will convert such a list into individual communications that it transmits to the holders of the international registrations concerned.

*Rule 34(3)* 26.05 When Rule 34(3) is applicable, the sending of a statement of grant of protection shall be subject to payment of the second part of the fee.

26.06 It is to be noted that no legal consequences flow from the fact that a statement of grant of protection has not been sent by an Office. The principle remains that, in the absence of the communication of a notification of provisional refusal within the period applicable under Article 5(2) of the Agreement and the Protocol, the mark is automatically protected in the Contracting Party concerned, for all the goods and services in question.

### **Statement of Grant of Protection Following a Provisional Refusal**

*Rule 18ter(2)* 27.01 Unless it confirms a total provisional refusal (see paragraph B.II.28.01, below), the Office of a Contracting Party, designated in an international registration, which has communicated a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau either:

*Rule 18ter(2)(i)* – a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or

*Rule 18ter(2)(ii)* – a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned.

*Rule 34(3)* 27.02 Equally in this case, when Rule 34(3) is applicable, the sending of a statement of grant of protection shall be subject to payment of the second part of the fee.

### **Confirmation of Total Provisional Refusal**

*Rule 18ter(3)* 28.01 Finally, the Office of a Contracting Party designated in an international registration which has communicated a notification of total provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed and the Office has decided to confirm refusal of the protection of the mark in the Contracting Party concerned for all goods and services, send to the International Bureau a statement to that effect.

### **Further Decision**

*Rule 18ter(4)* 29.01 A statement under Rule 18ter(2) or (3) should be sent as soon as all possibilities of review or appeal before the Office have been exhausted, or the time for requesting review or appeal before the Office has expired. The Office, therefore, should not wait to see whether an appeal is lodged with a tribunal or other body external to the Office. The reason for this is that the Office may not necessarily be aware whether or not such an appeal has been filed; the Office is therefore not able to know with certainty whether or not a decision issued by it has become final. Nor is the Office necessarily aware of the outcome of any such appeal. Although this statement may not reflect the definitive result regarding the protection of the mark in the Contracting Party concerned, the fact that, in many instances, a statement under paragraph (2) or (3) of Rule 18ter will be recorded and published at an early stage (as soon as the procedures before the Office have been completed) will have advantages for both holders and third parties.

29.02 Where, following the sending of a statement in accordance with Rule 18ter(2) or (3), the Office becomes aware of any further decision that affects the protection of the mark (for example, a decision resulting from an appeal to an authority outside that Office), it will send to the International Bureau a further statement indicating the goods and services for which the mark is now protected, insofar as the Office is informed of this decision.

### **Recording, Information to the Holder and Transmittal of Copies**

*Rule 18ter(5)* 30.01 The International Bureau shall record any statement received under Rule 18ter in the International Register and shall inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder. Any statement received under Rule 18ter shall also be published in the Gazette. In addition, since January 1, 2009, the International Bureau has made available on ROMARIN digitalized copies of those statements, which are then accessible directly to users of the database (see paragraph A.08.04).

*Rule 32(1)(a)(iii)*

### **New Rules and amendments to the Common Regulations, which came into effect on September 1, 2009**

31.01 For further information concerning the new Rules and amendments to the Common Regulations, which came into effect on September 1, 2009, reference may be made to Information Notice No. 27/2008, which is available on WIPO's website at the following url: <http://www.wipo.int/madrid/en/notices/>.

## **SUBSEQUENT DESIGNATION**

*Article 3ter(2)* 32.01 If the effects of an international registration do not extend to a Contracting Party (for example, because protection in that Contracting Party was not requested at the time of international registration or because the mark is no longer protected in that Contracting Party as a result of a final decision subsequent to a refusal, an invalidation or a renunciation), the extension of protection to that Contracting Party may be effected by filing a subsequent designation. The holder may wish to do this where, for example, the grounds for such refusal, invalidation or renunciation no longer exist.

32.02 Another reason for making a subsequent designation may be that, at the time of filing the international application, the Contracting Party in question was not a party to either the Agreement or the Protocol, or that it was not bound by the same treaty (Agreement or Protocol) as the Contracting Party of the holder. The term "Contracting Party of the holder" means either the Contracting Party whose Office is the Office of origin (i.e., the Office through which the international application was filed) or, where there has been a change in the ownership of the international registration, the Contracting Party with respect to which the new holder fulfills the conditions to be the holder.

32.03 A subsequent designation may be made for part only of the goods and services recorded in the International Register. A given Contracting Party may therefore be the subject of several subsequent designations, each referring to a different part of the list of goods and services recorded in the International Register.

32.04 When, following a limitation of the list of goods and services, a partial refusal of protection or a partial invalidation, the protection resulting from the international registration covers, in a given Contracting Party, only part of the goods and services recorded in the International Register, a subsequent designation may be made for all or some of the remaining goods and services.

### **Entitlement to Make the Subsequent Designation**

*Rule 24(1)(a)* 33.01 A Contracting Party may be the subject of a subsequent designation where, at the time of the designation, the holder fulfills the conditions (of nationality, domicile or establishment) to be the holder of an international registration.

33.02 The designation of a particular Contracting Party will be made either under the Agreement or under the Protocol. It is important to know which is the governing treaty, since this will determine such matters as the fees which are payable.

*Rule 24(1)(b)*  
*and (c)*

33.03 The position is as follows:

– where the Contracting Party of the holder is a party only to the Agreement, a country which is also a party to the Agreement may be designated; the designation is made *under the Agreement*;

– where the Contracting Party of the holder is a party only to the Protocol, only a Contracting Party to the Protocol may be designated; the designation is made *under the Protocol*;

– where the Contracting Party of the holder is a party to both the Agreement and the Protocol, the designation of any Contracting Party which is a party to the Protocol (even if that Contracting Party is also a party to the Agreement) will be made *under the Protocol*, while the designation of any country party to the Agreement only will be made *under the Agreement*. In applying the above principles, the question of whether a country is a party to the Agreement or to the Protocol or whether an organization is a party to the Protocol is to be determined as of the date of the subsequent designation.

33.04 A further consideration arises where a country is designated under the Agreement in respect of an international registration resulting from an international application which was governed exclusively by the Protocol. Under the Agreement, an international application must be based on a registration in the country of origin. If the international application was based on an application filed with the Office of origin, a subsequent designation under the Agreement can be made only after the basic application has resulted in a registration.

### **No Subsequent Designations Possible in Certain Cases**

*A Article 14(2)*  
*P Article 14(5)*

34.01 In principle, a subsequent designation may be made with respect to any Contracting Party which is bound by the same treaty as the Contracting Party of the holder. However, there is an exception from this principle; when acceding to the Agreement or to the Protocol, any State or (in the case of the Protocol) any intergovernmental organization may declare that the protection resulting from an international registration effected under that treaty before the date on which it entered into force with respect to that State or organization cannot be extended to it.

34.02 A subsequent designation of a country which has made a declaration under Article 14(2) of the Agreement is however possible if the holder of the international registration is also the holder of an earlier national registration of the same mark in that country. A subsequent designation of such a country should therefore be accompanied by the number and date of such earlier national registration; otherwise the International Bureau will not be able to record the subsequent designation of that country. Where no such earlier national registration exists, the only way to protect a mark in a country concerned through international registration is to file a new international application designating that country.

## Presentation of the Subsequent Designation

- Rule 24(2)(a)* 35.01 Subject to the exceptions mentioned below, the holder may present the subsequent designation either directly to the International Bureau or through the Office of the Contracting Party of the holder. However:
- Rule 24(2)(a)(ii)* – the subsequent designation must be presented to the International Bureau by the Office of the Contracting Party of the holder where any of the Contracting Parties to which it relates is a country which is designated under the Agreement;
- Rule 24(2)(a)(i)* – the subsequent designation must be presented to the International Bureau by the Office of origin where Rule 7(1), as in force before October 4, 2001, applies; that is, where the Contracting Party whose Office is the Office of origin has declared that, where the holder's address is in its territory, subsequent designations must be presented to the International Bureau by that Office.
- A.I. Sections 6 to 11(a)* 35.02 A subsequent designation may be transmitted to the International Bureau by mail, by facsimile (no confirmation is needed) or by electronic means (see paragraphs B.I.03.01 to 03.05 and 03.09).
- Rule 24(10)* 35.03 Where a subsequent designation should have been presented through an Office (see paragraph B.II.35.01) but is presented directly to the International Bureau, that subsequent designation will not be considered as such. Any fees already paid will be reimbursed to the party having paid them.

## Language of the Subsequent Designation

- Rule 6(2)* 36.01 The subsequent designation may be communicated to the International Bureau in English, French or Spanish, independently of the language in which the international application from which the international registration resulted was filed, at the option of the party sending the communication. That is, where the subsequent designation is presented directly by the holder, he may choose which of these languages to use; where however the subsequent designation is presented through an Office, that Office may allow the holder to choose the language, or it may restrict him to one or two of these languages.
- Rule 6(4)(a)* 36.02 The holder may annex to his request a translation into any of the other languages of any text matter contained in the request. This applies whether the subsequent designation is presented to the International Bureau directly by the holder or by an Office. If the International Bureau considers the proposed translation not to be correct it will correct it, after inviting the holder to make, within one month, observations on the proposed correction. If no observation is sent with the prescribed time limit, the proposed translation is corrected by the International Bureau.

### **Official Form**

*Rule 24(2)(b)* 37.01 The subsequent designation must be presented on the official form (MM4) established by the International Bureau, or on a form having the same contents and format (see paragraphs B.I.04.02 and 04.03). One form may be used to designate several Contracting Parties.  
*A.I. Section 3*

#### ***Item 1: International Registration Number***

*Rule 24(3)(a)(i)* 37.02 The holder must indicate the number of the international registration for which he makes a subsequent designation. The subsequent designation may relate to one international registration only.

#### ***Item 2: The Holder***

##### *Name and Address*

*Rule 24(3)(a)(ii)* 37.03 The holder must indicate his name and address, which must be the same as recorded in the International Register. If the holder has changed his name or address without the change having been recorded in the International Register, he should request the recording of the change before making the subsequent designation. The International Bureau will treat the subsequent designation as irregular if the name or address indicated in the request differs from that recorded in the International Register.

#### ***Item 3: Appointment of a Representative***

37.04 If the holder wishes to continue to be represented by a representative who has already been appointed, for example, when the international application was filed, he should not name a representative in the space provided for appointing a representative. Item 3 should therefore be left blank.

*Rule 3(2)(a)* 37.05 Where the holder wishes to appoint a representative for the first time, or to change his representative, the appointment may be made by indicating his name and address in this item of the official form. No separate communication relating to the appointment is needed.

#### ***Item 4: Contracting Parties Subsequently Designated***

*Rule 24(3)(a)(iii)* 37.06 The official form provides a box to be checked for each Contracting Party for which an extension of the protection subsequent to the international registration is sought. If the holder produces his own form, he may instead list the Contracting Parties he wants to designate.



37.07 The official form is regularly updated and the latest version made available under the heading *Trademarks/Madrid System/Forms* of WIPO's website. If however the holder wishes to designate a Contracting Party that is not listed (because it has become party to the Agreement or Protocol since the form was printed), he should write the name of that Contracting Party in the space available for that purpose in item 4. The holder should check that the accession of that Contracting Party has become effective. If it has not, the designation will be disregarded by the International Bureau, which will reimburse any complementary or individual fee paid in respect of that Contracting Party.

*Declaration of Intention to Use the Mark*

*Rule 24(3)(b)* 37.08 The remarks in paragraphs B.II.07.73 and 07.74 apply *mutatis mutandis* to a subsequent designation.

*Indication of a Second Language and Seniority Claim (for the Purpose of the Designation of the European Union)*

*Rule 24(3)(c)(iii)* 37.09 The remarks in paragraphs B.II.07.67 to 07.69 (concerning the indication of a second language before OHIM) and in paragraphs B.II.07.70 to 07.72 (concerning seniority claims) apply *mutatis mutandis* to a subsequent designation. However, it should be noted that in the case of a subsequent designation of the European Union, the second language may not be the language of the international application from which the international registration resulted, regardless of the language of the subsequent designation. Thus, for example, if the international application had been filed in French and the subsequent designation in question is filed in English, French may not be selected as the second language for the purpose of the subsequent designation of the European Union.

***Item 5: Goods and Services for Which the Subsequent Designation Is Made***

*Rule 24(3)(a)(iv)* 37.10 Where the subsequent designation is for all goods or services covered by the international registration concerned in respect of all Contracting Parties designated, this fact should be indicated by checking box (a). Where the subsequent designation is for only some of the goods or services covered by the international registration in respect of all Contracting Parties concerned, this fact should be indicated by checking box (b) and the goods or services covered by the subsequent designation should be listed in a continuation sheet. Where the subsequent designation is for only some of the goods or services covered by the international registration in respect of some of the Contracting Parties designated, and for all the goods or services listed in the international registration in respect of the other Contracting Parties designated, this fact should be indicated by checking box (c) and details of the goods and services concerned and of the designated Contracting Parties concerned should be indicated in a continuation sheet.

***Item 6: Miscellaneous Indications***

*Rule 24(3)(c)* 37.11 This item relates to a number of indications which may be required by certain Contracting Parties designated under the Protocol, and which the holder may wish to indicate in order to forestall a refusal by that Contracting Party. Where these indications have already been given in the international application, they need not be repeated here, since they will automatically be included in the notification of the subsequent designation to the Offices concerned.

***(a) Additional Indications Relating to the Holder***

37.12 The holder may, if he is a natural person, indicate the State of which he is a national. Legal entities may indicate their legal nature, together with the name of the State in which they are incorporated or organized and, where applicable, the territorial unit of that State.

***(b) Indication of Part(s) of the Mark in Color***

37.13 If color was claimed in the international application as a distinctive feature of the mark, the holder may indicate, in item 6(b), in respect of each color, the principal parts of the mark which are in that color.

***(c) and (d) Translation***

37.14 Where the mark consists of a word or words that may be translated, the holder may indicate, in the appropriate space, a translation of these words into English and/or French and/or Spanish.

***Item 7: Request Relating to the Date of Effect***

37.15 The holder may request that the subsequent designation take effect after the recording of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration.

***Item 8: Signature of the Holder or His Representative***

*Rule 24(2)(b)* 37.16 Where the holder communicates his subsequent designation directly to the International Bureau, he (or his representative) must sign it.

37.17 If the subsequent designation is presented to the International Bureau by an Office, the International Bureau does not require the signature of the holder or his representative; item 8 may therefore be left blank. The Office may however require or allow the holder (or representative) to sign.

***Items 9 and 10: Date of Receipt of the Request by the Office and  
Signature by the Office***

*Rule 24(2)(b)* 37.18 A subsequent designation which is presented to the International Bureau  
*Rule 24(3)(a)(vi)* by an Office must be signed by the Office, which must also indicate the date on  
which it received the request to present the subsequent designation. If the holder  
presents the subsequent designation directly to the International Bureau, items 9  
and 10 should be left blank.

*Rule 24(3)(d)* 37.19 Where the international registration was based on a basic application and  
any of the Contracting Parties mentioned is being designated under the *Agreement*,  
the Office of origin should complete the declaration in item 9(b), certifying that the  
said application has resulted in a registration and indicating the date and number of  
that registration, unless such a declaration has already been received by the  
International Bureau. Where the subsequent designation is presented through an  
Office other than the Office of origin, the holder should obtain an equivalent  
declaration from the Office of origin and send it to the International Bureau.

***Fee Calculation Sheet***

*See the remarks concerning completion of the fee calculation sheet in the  
international application form (paragraphs B.II.20.01 to 20.14), and the general  
remarks concerning payment of fees to the International Bureau  
(paragraphs B.I.07.83 to 07.96).*

*Rule 24(4)* 37.20 The fees payable in connection with a subsequent designation consist of:

- the basic fee;
- an individual fee for the designation of each designated Contracting Party that has made the relevant declaration (see paragraph B.II.07.86) and is designated under the Protocol, except where that designated Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a designation, a complementary fee is payable);
- a complementary fee for each designated Contracting Party for which no individual fee is payable.

The fee calculator on the *Trademarks/Madrid System* page of WIPO's website may be used to calculate the fees payable in respect of a subsequent designation.

37.21 These fees are in respect of the remainder of the 10 years for which the fees have already been paid for the international registration concerned. In other words, the amount of the fees is the same irrespective of the number of years during which the subsequent designation will have effect until the renewal of the international registration.

37.22 The payment may be made by any of the different means listed in part (b) of the fee calculation sheet. As in the case for an international application, probably the most convenient method of payment is to use a current account with the International Bureau and merely instruct the International Bureau (by completing part (a) in the fee calculation sheet) to debit the required amount; where payment is made by this method, the amount to be debited should not be specified. Where the fees are paid other than by debit from an account with the International Bureau, or where the party making the payment wishes to specify the amount to be debited from an account with the International Bureau, the method of payment, the amount paid or to be debited and the party making the payment or giving the instructions should be indicated in part (b) of the fee calculation sheet.

## **Effect of Subsequent Designation**

### **Date of Subsequent Designation**

*Rule 24(6)(a)* 38.01 A subsequent designation which is presented by the holder directly to the International Bureau will bear the date on which it was received by the International Bureau.

*Rule 24(6)(b)* 38.02 A subsequent designation which is presented to the International Bureau by an Office bears, if it complies with the applicable requirements, the date on which it was received by the Office, provided that it has been received by the International Bureau within two months from that date. If the International Bureau receives the subsequent designation after the expiry of that time limit, it will bear the date of its receipt by the International Bureau.

38.03 The date of a subsequent designation may be affected if it contains irregularities (see paragraph B.II.39.02).

38.04 In general, the possibility of being accorded an earlier date will be of advantage to the holder. In certain circumstances however, this new possibility can cause complications, and may have even disadvantages. For example, a subsequent designation which is presented through an Office shortly before renewal of the international registration is due but reaches the International Bureau after that date will nonetheless bear a date earlier than the renewal date. It will therefore expire on that date and, in order to maintain it in force, it will be necessary to pay again the complementary fee or (where appropriate) the individual fee required in respect of the newly designated Contracting Party.

38.05 In contrast to a subsequent designation, the recording of a change under Rule 25 is deemed to take effect when it is actually recorded in the International Register, whether the request to record the change was presented through an Office or directly to the International Bureau. Thus, where subsequent designation and a request to record a change are presented at the same time through an Office, the subsequent designation will generally bear a date which is earlier than the effective date of the change. For example, it sometimes happens that a holder wishes to renounce protection in respect of a particular Contracting Party (because of a threatened refusal by that Contracting Party) and then immediately re-extend the protection to that Contracting Party by means of a subsequent designation. If the

renunciation and the subsequent designation are presented simultaneously through an Office then, as a consequence of Rule 24(6)(b), the renunciation with respect to the Contracting Party concerned will take effect *after* the new territorial extension to that Contracting Party.

*Rule 24(6)(d)* 38.06 In order to avoid problems of the kind just described, where a subsequent designation contains a request that it take effect immediately after some other event (such as renewal or the recording of a change or cancellation), the subsequent designation will bear the date of the recording of that other event.

38.07 Where the date of the subsequent designation, determined as described in the foregoing paragraphs, is not more than six months after any priority date recorded in respect of the international registration, the priority which the latter enjoys will also have effect in the Contracting Parties covered by the subsequent designation (see paragraph B.II.40.02).

### **Irregular Subsequent Designation**

*Rule 24(5)(a)* 39.01 Where the International Bureau considers that there is an irregularity regarding the subsequent designation, it will so notify the holder. Where the subsequent designation was presented by an Office, it will also notify the Office.

*Rule 24(6)(c)(i)* 39.02 Where a subsequent designation contains an irregularity which relates to the number of the international registration concerned, the indication of the Contracting Parties designated, the indication of the list of goods or services or any declaration of intention to use to be annexed to the subsequent designation, the date of the subsequent designation will be the date on which the irregularity is remedied. Where however the subsequent designation was presented to the International Bureau by an Office, the date of the subsequent designation will not be affected by any of these irregularities *if they are remedied within two months of the date on which the request to present the subsequent designation was received by the Office*; in this case, the subsequent designation will continue to bear the date on which the request was received by the Office.

*Rule 24(6)(c)(ii)* 39.03 Any other irregularity does not affect the date of the subsequent designation.

*Rule 24(5)(b)* 39.04 If the irregularity is not remedied within three months from the date of the notification by the International Bureau, the subsequent designation will be considered abandoned. In particular, where the irregularity lies in the fact that a declaration of intention to use the mark is missing or defective and such irregularity is not remedied within the prescribed period of three months, it should be noted that the *entire* subsequent designation will be considered abandoned – that is, with respect to all the Contracting Parties which have been designated subsequently. The International Bureau will refund the fees paid, subject to the retention of one half of the basic fee, to the party (holder, representative or Office) that paid them.

39.05 The rules do not specify who should remedy the irregularity. If the holder presented the subsequent designation directly to the International Bureau, then clearly he has to remedy the irregularity. If the subsequent designation was presented by an Office, that Office may remedy the irregularity. Indeed, depending on the nature of the irregularity, it may be difficult or even impossible for the holder to remedy the irregularity himself (for example, if the Office has not signed the subsequent designation or has not indicated the date when it received the request to present it). Where, therefore, a holder is notified by the International Bureau that there is an irregularity in a subsequent designation which has been presented through an Office, he would be well advised to contact that Office to ensure that the irregularity will be remedied in good time.

*Rule 24(5)(c)* 39.06 An exception to the general rule relating to irregularities is made in the case where the International Bureau considers that the holder is not entitled to make the subsequent designation with respect to some or all of the Contracting Parties mentioned (see paragraphs B.II.33.01 to 33.04). Where the lack of entitlement applies to only some of the Contracting Parties mentioned, the subsequent designation will be deemed not to contain the designation of those Contracting Parties; the respective complementary or individual fees paid in respect of them will be refunded. Where the deficiency applies to all the Contracting Parties mentioned, the subsequent designation is considered to be abandoned. In addition to all the complementary and individual fees, the International Bureau will also reimburse one half of the basic fee.

### **Recording, Notification and Publication**

*Rule 24(8)* 40.01 Where the International Bureau finds that the subsequent designation conforms to the applicable requirements, it will record it in the International Register and notify the Office of the Contracting Party that has been designated. It will at the same time inform the holder and, if the subsequent designation was presented through an Office, that Office.

*Rule 32(1)(a)(v)* 40.02 The subsequent designation will be published in the Gazette. Where the date of the subsequent designation, as determined in accordance with Rule 24(6) (see paragraphs B.II.38.01 to 38.07) is not more than six months after the priority date of the international registration, the information concerning the declaration of priority will be included in the publication of the subsequent designation.

*Rule 6(3)* 40.03 The subsequent designation will be recorded and published in English, French and Spanish. As regards international registrations that, under the previous versions of Rule 6, were published only in French, or were published only in English and French, they will be published in English and Spanish and republished in French, or published in Spanish and republished in English and French, respectively (see paragraphs B.I.07.05 to 07.07). That subsequent designation itself will be recorded in the International Register in English, French and Spanish.

### Period of Protection

*Rule 31(2)* 41.01 The period of protection under the subsequent designation expires on the same date as the international registration. For example, if an international registration has already been registered for eight years (or the last installment of fees was paid eight years ago), the fees to be paid for a subsequent designation will cover a period of only two years. This means that the date of renewal of the international registration (or the date of payment of the renewal fees) is the same for all designations contained in the international registration, irrespective of the date on which the designations were recorded (see also paragraph B.II.38.04).

*Rule 40(3)(a)* 41.02 Where an international registration was effected before the entry into force of the Common Regulations (April 1, 1996) and the required fees had been paid for 20 years and a subsequent designation is made during the first 10 years of this period, fees paid in respect of the subsequent designation will cover only the remainder of that 10-year period. At the end of that period, it will be necessary to pay the appropriate complementary and/or individual fees in respect of the second 10-year period (see also paragraphs B.II.75.01 and 75.02).

### Refusal of Protection

*Rule 24(9)* 42.01 The refusal of protection, by a designated Contracting Party, of a subsequent designation follows the same procedures as for the refusal of protection of a designation contained in the international application. Rules 16 to 18<sup>ter</sup> therefore apply *mutatis mutandis*, it being understood that the time limit for a Contracting Party to notify a refusal of protection starts from the date on which the International Bureau has notified the subsequent designation to the Office of that Contracting Party. The comments made in paragraphs B.II.17.01 to 31.01 are referred to.

### **A Particular Case of Subsequent Designation: Subsequent Designation Resulting from the Conversion of the Designation of a Contracting Organization (the European Union)**

43.01 Under the European Community Trade Mark system, where a Community trademark application is withdrawn or refused, or where a Community trademark registration ceases to have effect, the proprietor of that Community Trade Mark may request its conversion into a national trademark application with the Office of one or more Member States of the European Union.

43.02 The effect of a conversion is that the national trademark application resulting from conversion is allocated the same filing date as that of the Community trademark application or registration (and enjoys, if applicable, the same priority date and/or seniority claimed), provided in particular that the request for conversion is filed within the time limit prescribed by the Community legislation.

*Rule 24(7)(a)* 43.03 Having regard to this feature of the Community Trade Mark system, the Common Regulations provide that, where a Contracting Organization (in practice the European Union) is designated in an international registration and to the extent that such designation has been withdrawn, refused or has ceased to have

effect, conversion may also be requested through a subsequent designation of its Member States *under the Madrid system*. This mechanism, offering the holder of an international registration the option of converting the designation of the European Union into *either* a national application filed directly with the Office of a Member State *or* a subsequent designation of that Member State under the Madrid system, is often referred to as the “opting-back” provision.

43.04 As a general principle, subsequent designations resulting from conversion must comply with the requirements set out for “ordinary” subsequent designations (see paragraphs B.II.32.01 to 42.01), subject however to the following.

### Official Form and Contents

- A.I. Section 3(a)* 44.01 A subsequent designation resulting from conversion must be presented on the official form MM16 established by the International Bureau, distinct from that used for an “ordinary” subsequent designation (MM4).
- Rule 24(7)(b)* 44.02 A request for the recording of a subsequent designation resulting from conversion must contain or indicate the following:
- the number of the international registration concerned;
  - the name and address of the holder;
  - the Contracting Organization whose designation is to be converted;
  - the Member State or States of the Contracting Organization that are the subject of the subsequent designation;
  - where the subsequent designation of a Contracting State resulting from conversion is for all the goods and services listed in respect of the designation of the Contracting Organization, that fact, or, where the designation of that Contracting State is for only part of the goods and services listed in the designation of that Contracting Organization, those goods and services;
  - the amount of fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment.
- Rule 3(2)(a)* 44.03 Where the holder wishes to appoint a representative for the first time, or to change his representative, the appointment may be made by indicating his name and address in the corresponding item of the official form.



### **Presentation of the Subsequent Designation Resulting from Conversion**

- Rule 24(2)(a)(iii)* 45.01 A subsequent designation resulting from conversion must always be presented to the International Bureau through the Office of the Contracting Organization (in practice, OHIM). This implies in particular that the said Office must determine, before transmitting the subsequent designation resulting from conversion to the International Bureau, whether such request complies with the necessary conditions under its own legislation (in particular, whether requirements concerning time limits have been complied with).

### **Date of Subsequent Designation Resulting from Conversion**

- Rule 24(6)(e)* 46.01 A subsequent designation resulting from conversion bears the date on which the designation of the *Contracting Organization* in the international registration concerned was recorded in the International Register.

## **CHANGES IN THE INTERNATIONAL REGISTRATION**

### **Change of Name or Address of the Holder or of His Representative**

#### **Change of Name or Address of the Holder**

- Rule 25(1)(a)(iv)* 47.01 A request to record a change in name or address of the holder must be presented to the International Bureau on the official form (MM9) established by the International Bureau (or on a form having the same contents and format).  
*A.I. Section 4*
- Rule 25(1)(b)* 47.02 The request may be presented to the International Bureau directly by the holder or through the Office of the Contracting Party of the holder.

#### **Official Form (MM9)**

48.01 The form for a request relating to a change of name and address of the holder must *not* be used where the change of name results from a change in ownership. In such a case, form MM5 should be used (see paragraphs B.II.60.01 to 67.02).

#### ***Item 1: International Registration Number***

48.02 A single request may relate to several international registrations recorded in the name of the same holder. It is sufficient, for the purpose of the identification of the international registrations to which the request refers, to indicate the numbers of the respective registrations.

48.03 If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given; the holder should wait until he is notified of the international registration number concerned and make a further request.

***Item 2: Name of the Holder***

48.04 The name of the holder as recorded in the International Register must be indicated.

***Item 3: Change in Name and/or Address of the Holder***

48.05 Spaces are provided at item 3 to indicate the new name, new address, new phone and facsimile numbers and new e-mail address. Only the information which has changed need be indicated. That is, where only the name has changed, it is sufficient to indicate the new name, leaving the other spaces blank; similarly, where only the address has changed, there is no need to repeat the name.

48.06 Where only the telephone and/or facsimile number has changed it is sufficient to indicate the new number(s). It should be noted that, where this is the only change to be recorded, no fee is payable for the request.

*Rule 36(ii)*

***Item 4: Address for Correspondence***

48.07 Space is provided to indicate an address for correspondence, if any, and if different from the address of the holder indicated in item 3. If this item is *not* completed, an address for correspondence which may already have been recorded in the International Register is automatically disregarded by the International Bureau.

***Item 5: Appointment of a Representative***

48.08 The opportunity may be taken, in a request to record a change in the name or address of the holder, to appoint a representative.

48.09 Where there is no change in the representative already recorded, this item of the form should be left blank.

***Item 6: Signature by the Holder or His Representative***

*Rule 25(1)(d)* 48.10 Where the request is presented directly to the International Bureau, it must be signed by the holder (or his representative as recorded).

48.11 Where the request is presented to the International Bureau through an Office, that Office may require or permit the holder or his representative to sign the form. The International Bureau will not question the absence of a signature from this item.

### ***Item 7: Signature of the Office***

*Rule 25(1)(d)* 48.12 A request which is presented to the International Bureau by an Office must be signed by that Office. (If the holder submits a request directly to the International Bureau and produces his own form, he may omit item 6).

### ***Fee Calculation Sheet***

*See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.08.01 to 08.14).*

48.13 A request to record a change in the name or address of the holder (including a change concerning the address of correspondence) is subject to the payment of the fee specified in the Schedule of Fees, which covers any number of international registrations mentioned in the request. The payment may be made by any of the different means listed in part (b) of the fee calculation sheet. Probably the most convenient method of payment is to use a current account with the International Bureau and merely instruct the International Bureau (by completing part (a) of the fee calculation sheet) to debit the required amount; where payment is made by this method, the amount to be debited should not be specified. Where the fees are paid other than by debit from an account with the International Bureau, or where the party making the payment wishes to specify the amount to be debited from an account with the International Bureau, the method of payment, the amount paid or to be debited and the party making the payment or giving the instructions should be indicated in part (b).

### **Change of Name or Address of the Representative**

*A.I. Section 5(a)* 49.01 A request to record a change in the name or address of the representative need not be made on an official form – a simple letter will suffice. An optional form (MM10) is however available for this purpose. This form is similar to the form (MM9) to be used for the request to record a change in the name or address of a holder. The main differences are that the name of the holder need not be indicated and that the change to be indicated, of course, relates to the name or address of the representative. The recording of a change in name or address of a representative is free of charge.

*Rule 36(i)*

49.02 Form MM10 is to be used only to request the recording of the change in the name or address of a representative whose appointment has already been recorded. *It may not be used to request the recording of the appointment of a new representative.*

49.03 A single request may relate to several specified international registrations. The International Bureau cannot accept a request to record a change in the name or address of a representative which simply refers to all international registrations in the name of the same representative.

### **Irregular Requests**

*Rule 26* 50.01 If a request to record a change in name or address of the holder or representative does not comply with the applicable requirements, the International Bureau notifies that fact to the holder and, if the request was presented through an Office, to that Office. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned; any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the fee.

50.02 Where the request was presented through an Office, the holder should establish whether that Office intends to remedy the irregularity, or whether he must do this himself.

### **Recording, Notification and Publication**

*Rule 27(1)(a)* 51.01 The International Bureau records the change of name or address in the  
*Rule 27(1)(b)* International Register and notifies accordingly the Offices of the designated Contracting Parties. At the same time, it informs the holder and, where the request was presented by an Office, that Office. The change is recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements; however, where so requested, the change may be recorded after the recording of another change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration. In addition, as regards a change in the name or address of the holder, the International Bureau publishes the relevant data in the Gazette.

*Rule 32(1)(a)(vii)*

### **Limitation, Renunciation and Cancellation**

52.01 The holder may wish to have recorded one of the following restrictions in the protection of his international registration:

- a limitation of the list of goods and services, which may affect *some or all* of the designated Contracting Parties (“limitation”);
- a renunciation of the protection in respect of some of, but not all, the designated Contracting Parties, for *all* the goods and services (“renunciation”);
- the cancellation of the international registration in respect of *all* the designated Contracting Parties, for *some or all* of the goods and services (“cancellation”).

### Effects and Consequences of Limitation, Renunciation or Cancellation

53.01 The recording of a limitation does not entail the removal of the goods and services concerned from the international registration as recorded in the International Register. The sole effect is that the international registration is no longer protected for the goods and services concerned in the Contracting Parties covered by the limitation. Even if a limitation of the list of goods and services has been recorded with effect for all designated Contracting Parties, the goods and services which have been the subject of a limitation may be made the subject of a subsequent designation. They are therefore taken into account when calculating any supplementary fees due on renewal. Similarly Contracting Parties in respect of which protection has been renounced can always be designated again.

53.02 In contrast, where an international registration is cancelled, the goods and services are permanently removed from the International Register. If the cancellation is recorded for all goods and services, nothing remains on the Register. In case of a partial cancellation, the goods and services for which a cancellation has been recorded are eliminated from the Register. The consequence of this is that, in the case of a total cancellation, no subsequent designation may be made for the international registration, since it does not exist any more. If the former holder wishes to protect his mark again he must file a new international application. Similarly, in the case of a partial cancellation, the holder of the international registration cannot ask for any subsequent designation with respect to goods and services for which the international registration has been cancelled. If he wishes to protect his mark again for such goods and services he must file a new international application.

53.03 If the holder voluntarily limits or renounces the protection of his international registration, or asks for its cancellation, he cannot then make use of the possibility provided for in Article 9*quinquies* of the Protocol to ask for transformation of the international registration into national or regional applications while keeping the date of the international registration. Transformation can only follow a cancellation of the international registration requested by the Office of origin in accordance with Article 6(4) of the Protocol (see paragraphs B.II.88.01 to 88.07).

### Request for Recording

*Rule 25(1)(a)*  
*A.I. Section 4* 54.01 A request to record a limitation, renunciation or cancellation must be presented to the International Bureau on the appropriate official form (MM6, MM7 or MM8) established by the International Bureau or on a form having the same contents and format.

*Rule 25(1)(c)* 54.02 Where a renunciation affects any Contracting Parties whose designation is, on the date of receipt of the request by the International Bureau, governed by the Agreement, the request must be presented to the International Bureau through the Office of the Contracting Party of the holder.

*Rule 25(1)(c)* 54.03 Where a cancellation affects any Contracting Parties whose designation is, on the date of receipt of the request by the International Bureau, governed by the Agreement, a request to record a cancellation must be presented to the International Bureau through the Office of the Contracting Party of the holder.

*Rule 25(1)(b)* 54.04 In all other cases, the request may be presented to the International Bureau directly by the holder or through the Office of the Contracting Party of the holder.

*Rule 26(3)* 54.05 Where the request should have been presented through an Office (see paragraphs B.II.54.02 and 54.03) but is presented directly to the International Bureau, the request will not be considered as such and the International Bureau will inform the sender accordingly.

*Rule 6(2)* 54.06 In general, the request may be in English, French or Spanish.  
*Rule 40(4)* However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of a subsequent designation:

– if governed exclusively by the Agreement, French will continue as the sole language of communication, recording and publication.

– if governed wholly or partly by the Protocol, French and English will continue as the language of communication, recording and publication.

For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of a subsequent designation:

– if governed exclusively by the Agreement, then, as above, French will continue as the sole language of communication, recording and publication. (Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004).

### **Presentation of Request to Record Renunciation or Cancellation Following Change in Applicable Treaty**

*Rule Ibis* 55.01 A change may occur in the treaty applicable to the recorded designation of a Contracting Party bound by both the Agreement and the Protocol (see paragraphs A.02.26 to 02.31).

*Rule 25(1)(c)* 55.02 Where a renunciation or a cancellation affects any of the Contracting Parties whose designation is governed by the Agreement, the request to record same must be presented to the International Bureau through the Office of the Contracting Party of the holder.

55.03 The issue as to whether a given designation is governed by the Agreement is, however, settled on the date of receipt of the request by the International Bureau, in accordance with the wording of Rule 25(1)(c). Thus, a change in the applicable treaty will not have any impact on requests for the recording of a renunciation or cancellation that have already been presented to the International Bureau.

### **Official Form**

56.01 Separate official forms (MM6, MM7 and MM8 respectively) are available for requesting the recording of a limitation, renunciation or cancellation. They are broadly similar and are described together, with the differences being commented on.

### ***International Registration Number***

56.02 The number(s) of the international registration(s) concerned should be indicated. A single request may relate to several international registrations, provided the scope of the limitation, renunciation or cancellation is the same for each; that is, the Contracting Parties affected are the same for each international registration (as is necessarily the case for cancellation) and either the change relates to the same goods and services for each registration or else (as is necessarily the case for renunciation) it relates to all the goods and services covered by each registration.

56.03 If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given; the holder should wait until he is notified of the number of the international registration concerned and make a further request.

### ***Holder***

56.04 The name of the holder must be the same as the name recorded in the International Register.

### ***Appointment of a Representative***

56.05 The opportunity may be taken, in a request to record a limitation, renunciation or cancellation, to appoint a representative.

56.06 Where there is no change in the representative already recorded, this item of the form should be left blank.

### ***Contracting Parties***

56.07 If a limitation of the list of goods and services is to apply to all the designated Contracting Parties, it is sufficient to check the relevant box under item 4 of form MM6. Otherwise those Contracting Parties in respect of which the limitation is to be recorded should be listed; where the request relates to several international registrations, this list will apply to all of them.

56.08 In the case of a *renunciation*, the Contracting Parties affected should be listed under item 4 of form MM7; where the request relates to several international registrations, the same list must apply to all of them.

### ***Goods and Services***

56.09 In the case of a *limitation*, the scope of the limitation of the list of goods and services should be set out under item 5 of form MM6. Where any of the terms used to describe a particular good or service are to be replaced by another (narrower) term, it must be clearly indicated which terms are to be replaced by which. Whatever method is used to indicate the limitation, the goods and services must be grouped by classes, indicating the number of the respective class, and in the sequence of the numbers of the International Classification of Goods and Services.

56.10 In the case of a *cancellation* in respect of all the goods and services covered by the international registration, the relevant box under item 4 of form MM8 should be ticked. In the case of a partial cancellation, the scope of the cancellation should be indicated, under item 4, in the manner described in the previous paragraph.

### ***Signature by the Holder or Representative***

*Rule 25(1)(d)* 56.11 Where the request is presented directly to the International Bureau, it must be signed by the holder (or his representative).

56.12 Where the request is presented to the International Bureau through an Office, that Office may require or permit the holder or his representative to sign the form. The International Bureau will not question the absence of a signature from this item.

### ***Signature of the Office***

*Rule 25(1)(d)* 56.13 A request which is presented to the International Bureau by an Office must be signed by that Office. (If the holder submits a request directly to the International Bureau and produces his own form, he may omit this item).

### ***Fee Calculation Sheet (Limitation Only)***

*See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.08.01 to 08.14).*

56.14 A request to record a *limitation* is subject to the payment of the fee specified in the Schedule of Fees. Where the request relates to several international registrations, a fee must be paid with regard to each one of them. The payment may be made by any of the different means listed in part (b) of the fee calculation sheet. Probably the most convenient method of payment is to use a current account with the International Bureau and merely instruct the International Bureau (by completing part (a) in the fee calculation sheet) to debit the required amount; where payment is made by this method, the amount to be debited should not be specified. Where the fees are paid other than by debit from an account with the International Bureau, or where the party making the payment wishes to specify the amount to be debited from



an account with the International Bureau, the method of payment, the amount to be paid or to be debited and the person (holder, representative or Office) making the payment or giving the instructions should be indicated in part (b).

*Rule 36(iii) and (iv)* 56.15 A request to record a *renunciation* or a *cancellation* is exempt from the payment of a fee. Accordingly the forms for these requests do not contain a fee calculation sheet.

### **Irregular Requests**

*Rule 26* 57.01 If a request to record a limitation, renunciation or cancellation does not comply with the applicable requirements, the International Bureau notifies that fact to the holder and, if the request was presented through an Office, to that Office. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned; any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the fee.

57.02 Where the request was presented through an Office, the holder should establish whether that Office intends to remedy the irregularity, or whether he must do this himself.

### **Recording, Notification and Publication**

*Rule 27(1)(a)* 58.01 The International Bureau records the limitation, renunciation or cancellation in the International Register and notifies accordingly the Offices of those designated Contracting Parties concerned (necessarily all of them in the case of a cancellation). At the same time it informs the holder and, where the request was presented by an Office, that Office. The recording is made as of the date of receipt by the International Bureau of a request complying with the applicable requirements; where, however, the holder has so requested, it may be made after the recording of another change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration. In addition, the International Bureau publishes the relevant data in the Gazette.

*Rule 27(1)(a)*

*Rule 32(1)(a)(vii) and (viii)*

*Rule 27(1)(b)*

58.02 Where the request to record a cancellation pursuant to Rule 25 is presented before the end of the five-year period referred to in Article 6(3) of the Agreement and Article 6(3) of the Protocol (see paragraph B.II.83.01), the International Bureau will inform the Office of origin of the cancellation, even if the request was presented through an Office other than the Office of origin or directly by the holder. With regard to the language of recording, notification and publication, see paragraph B.II.54.06.

### **Declaration that a Limitation Has No Effect**

*Rule 27(5)(a) to (c)* 59.01 The Office of a designated Contracting Party which is notified by the International Bureau of a limitation in the list of goods and services affecting it may declare that the limitation has no effect in its territory (in particular, because it considers that the change requested is not in fact a limitation but an extension of the list). Any such declaration must be sent to the International Bureau before the expiry of 18 months from the date on which that notification was sent to the Office concerned. In its declaration, the Office must indicate the reasons for which the limitation has no effect and where the declaration does not affect all the goods and services to which the limitation relates, those which are affected by the declaration or those which are not affected by the declaration, as well as the corresponding essential provisions of the law and whether the declaration is subject to review or appeal. The International Bureau will notify accordingly the party (holder or Office) that presented the request for the recording of the limitation.

*Rule 27(5)(e)* 59.02 Where the declaration indicates that it may be subject to review or appeal, it is for the holder to ascertain from the Office concerned the time limit for requesting such review or appeal and the authority to which the request must be made. The Office must notify any final decision relating to the declaration to the International Bureau, which will notify accordingly the party (holder or Office) that presented the request to record the limitation.

*Rule 27(5)(d) and (e)* 59.03 Any declaration that a limitation has no effect, or any final decision in respect of that declaration, will be recorded in the International Register. The relevant information will be published in the Gazette.

### **Change in Ownership**

60.01 The ownership of a trademark may change for various reasons and in different ways. A change in ownership may result from a contract, such as an assignment. Other reasons might be a court decision, or operation of law, such as an inheritance or bankruptcy. An automatic change in ownership can result from the merger of two companies.

60.02 The change in ownership of an international registration may relate to all the goods and services covered by the international registration, or to only some of those goods and services. Similarly, the change in ownership may be in respect of all the Contracting Parties designated or only some of them.

*Rule 1(xxi)* 60.03 The Regulations do not distinguish between such different causes for, or different types of, change in ownership. Like Article 9 of the Protocol, they use the uniform terminology “change in ownership” for all cases. Until the change has been recorded in the International Register, the former owner of the international registration is referred to as the “holder”, since this term is defined as the person or legal entity in whose name the international registration is recorded. The new owner is referred to as the “transferee”. Once the change in ownership has been recorded, he of course becomes the holder of the international registration.

60.04 *This terminology is different from that used in the Agreement.* Article 9*bis* of the Agreement uses the term “transfer” for a change in ownership in respect of all goods and services and for all countries covered by the international registration, whilst Article 9*ter* of the Agreement uses the term “partial assignment” for a change in ownership for part of the goods and services or for some of the contracting countries.

### **Entitlement of the Transferee to Be the New Holder**

61.01 The change in ownership may be recorded only if the transferee is a person who is entitled to file international applications. Moreover, his entitlement needs to be considered in respect of each of the Contracting Parties in respect of which he seeks to be recorded as the new holder of the international registration concerned.

*Rule 25(2)(a)(iv)* 61.02 In the request to record the change in ownership, the transferee must indicate the Contracting Party or Parties with respect to which he fulfills the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2(1) of the Protocol, to be the holder of an international registration. In other words, the transferee must indicate the Contracting Party or Parties to the Agreement and/or the Protocol in which he has a real and effective industrial or commercial establishment or is domiciled, or the country which is party to the Agreement and/or Protocol (or which is a member State of an organization party to the Protocol) and of which he is a national. A transferee may claim the necessary connection with several Contracting Parties, some of which may be party to the Agreement and some to the Protocol.

*Rule 25(3)* 61.03 The principles which determine whether a person may be recorded as the holder of an international registration in respect of a given designated Contracting Party are as follows:

– where the designated Contracting Party is bound by the Agreement but not the Protocol, he may be recorded as the holder in respect of that Contracting Party provided that the Contracting Party (or one of the Contracting Parties) indicated as mentioned in the preceding paragraph is also a party to the Agreement;

– where the designated Contracting Party is bound by the Protocol but not the Agreement, he may be recorded as the holder in respect of that Contracting Party provided that the Contracting Party (or one of the Contracting Parties) indicated as mentioned in paragraph B.II.61.02 is also a party to the Protocol;

– where the transferee is able to indicate a Contracting Party which is a party to both the Agreement and the Protocol, or to indicate a country party to the Agreement and a Contracting Party to the Protocol, he will be able to be recorded as the holder of any international registration, in respect of whatever Contracting Parties have been designated.

61.04 The following examples will illustrate what is indicated in paragraphs B.II.61.02 and 61.03:

The transferee is a national of a State, bound only by the Protocol and has no domicile or establishment in any other country;

– if the international registration extends only to Contracting States bound exclusively by the Agreement, the change in ownership cannot be recorded in the International Register;

– if the international registration extends to Contracting States bound exclusively by the Agreement but also to Contracting Parties bound by the Protocol (whether or not bound also by the Agreement), the change in ownership can be recorded with respect to all Contracting Parties bound by the Protocol;

– if the international registration extends only to Contracting Parties bound by the Protocol (whether or not bound also by the Agreement), the change in ownership may be recorded with respect to all designated Contracting Parties.

If, on the other hand, that same transferee also has a real and effective establishment in a Contracting Party bound by the Agreement, the change in ownership can be recorded with respect to all designated Contracting Parties.

*Rule 25(4)* 61.05 If there are several transferees, each of them must qualify as described in paragraph B.II.61.03. As a consequence, the change in ownership may not be recorded in respect of a given designated Contracting Party if any of the transferees does not fulfill the conditions to be the holder of the international registration in respect of that Contracting Party. It is however not necessary that the Contracting Party or Parties through which the conditions are fulfilled be the same for each transferee.

61.06 Where, for the reasons explained in the foregoing paragraphs, a change in ownership which cannot be recorded in the International Register in respect of one or more designated Contracting Parties, the transfer is recorded as a partial change in ownership, as described in paragraph B.II.65.01. A separate international registration is therefore created in respect of the designated Contracting Parties for which the new owner is entitled to be recorded as the holder. For the remaining Contracting Parties, the international registration remains in the name of the current holder. If the new owner subsequently becomes entitled to be recorded as the holder in respect of these latter Contracting Parties, the merger of the international registrations may be requested, as described in paragraphs B.II.68.01 to 68.04. The consequences between the parties of a change in ownership which cannot be recorded in the International Register are a matter for the law of the Contracting Parties concerned.

*A Article 9bis(1)* 61.07 According to the last sentence of Article 9bis(1) of the Madrid Agreement, where a transfer to a person established in a contracting country other than the country of origin is effected during the five-year dependency period, the International Bureau should seek the consent of the Office of the country of the new proprietor, and publish, if possible, the date and registration number of the mark in the country of the new proprietor. This procedure was justified by the fact that, at one time in the history of the Madrid Agreement, such a transfer entailed a

change of the country of origin. In order to ensure that the mark was the subject of a national registration in the new country of origin, on which central attack could be based, the consent of the Office of the new country of origin was requested before the transfer would be recorded. As from the Nice Act of 1957, however, the country of origin remains unchanged following a change in ownership; the procedure prescribed in the last sentence of Article 9*bis*(1) of the Madrid Agreement has therefore lost its justification. Accordingly, the Assembly of the Madrid Union decided in 1995 that the International Bureau should cease to apply this provision.

### **Change of Applicable Treaty Following the Recording of a Change in Ownership**

*Rule 1bis* 62.01 It is possible for a designation which was governed by the Agreement to become governed by the Protocol, or *vice versa*, following a change in ownership of the international registration. (In this regard, see also paragraphs A.02.26 to 02.31). For example, where a country which is party to both the Agreement and the Protocol was designated in an international application filed through the Office of a country party to the Agreement only, the designation will have been governed by the Agreement; if, subsequently, following a change in ownership of the international registration, the new owner's claim to be entitled to be the holder of an international registration is through a Contracting Party to both the Agreement and the Protocol, the designation will henceforth be governed by the Protocol (see paragraphs A.02.21 to 02.25). Such a change does not affect matters which are already completed, or procedures which have already started. Thus, matters such as the presentation of a request for renunciation or cancellation are governed by whichever was the applicable treaty at the time when the request in question was received by the International Bureau. Subsequent renewal of the international registration with respect to that Contracting Party will however, in the example given, be governed by the Protocol (however, as regards the liability to pay individual fees, see paragraph B.II.77.02).

### **Request to Record a Change in Ownership**

*Rule 25(1)(a)(i)* 63.01 A request to record a change in ownership must be presented to the  
*A.I. Section 4* International Bureau on the official form (MM5) established by the International Bureau or on a form having the same contents and format.

*Rule 25(1)(b)* 63.02 The request may be presented to the International Bureau by the holder (or his recorded representative), by the Office of the Contracting Party of the (recorded) holder or by the Office of the Contracting Party of the transferee, that is, the Contracting Party (or one of the Contracting Parties) indicated as described in paragraph B.II.61.02. It should be noted that, with effect from April 1, 2002, there is no longer any restriction concerning the presentation of a request to record a change in ownership, even where the change affects Contracting Parties whose designation is governed by the Agreement. It is however no longer possible to present the request through the Office of origin (that is, the Office through which

the international application was filed) where neither the present holder nor the new owner (transferee) has any connection with the Contracting Party whose Office is the Office of origin.

63.03 Where the request is to be presented to the International Bureau through an Office, that Office may require the furnishing of evidence concerning the change of ownership. The International Bureau does not however require evidence of the change in ownership and no supporting documents (such as copies of the deed of assignment or other contract) should be sent to the International Bureau.

*Rule 6(2)* 63.04 In general, the request may be in English, French or Spanish.  
*Rule 40(4)* However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of the first subsequent designation:

– if governed exclusively by the Agreement, French will continue as the sole language of communication, recording and publication.

– if governed wholly or partly by the Protocol, French and English will continue as the language of communication, recording and publication.

For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of the first subsequent designation:

– if governed exclusively by the Agreement, then, as above, French will continue as the sole language of communication, recording and publication. (Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004 (see also paragraphs B.I.07.01 to 07.07).

63.05 In practice, the question of language affects only the list of goods and services, since the other contents of the request are independent of language.

## **Official Form**

### ***Item 1: International Registration Number***

64.01 The number(s) of the international registration(s) concerned should be indicated. A single request may relate to several international registrations being transferred from the same holder to the same transferee provided that, for each of the international registrations concerned, the change applies to all the designated Contracting Parties, or to the same Contracting Parties, and that it concerns all the goods and services, or the same goods and services.

64.02 If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given; the holder should wait until he is notified of the number of the international registration concerned in order to make the request.

**Item 2: Holder**

64.03 The name of the holder must be the same as the name recorded in the International Register.

**Item 3: Transferee**

*Rule 25(2)(a)(iii)* 64.04 The name and address of the transferee should be given, following the guidelines concerning the name and address of the applicant in an international application (see paragraphs B.II.07.08 to 07.13).

**Item 4: Entitlement of the Transferee to Be the Holder**

*Rule 25(2)(a)(iv)* 64.05 There should be indicated, in the appropriate spaces, the Contracting Party or Parties of which the transferee is a national (or the name of the member State of a Contracting Organization of which he is a national), in which he is domiciled or in which he has a real and effective industrial or commercial establishment. Any or all of these spaces may be used, and more than one Contracting Party may be given in any one space. Where the transferee is domiciled or has an establishment in, a Contracting State which is also a member State of a Contracting Organization, both of these Contracting Parties may be indicated in any or all of the spaces, as appropriate.

64.06 Where the transferee may cite more than one Contracting Party, it is a matter for him which ones should be mentioned. The indications must however be sufficient to show that the transferee (or, where there are several transferees, each of them) is entitled to be the holder of the international registration in respect of the designated Contracting Parties affected by the change in ownership (see paragraphs B.II.61.03 to 61.06).

*Rule 25(2)(a)(v)* 64.07 If it has been indicated, under (a)(iii) or (iv), that the transferee is domiciled in or has an establishment in a particular Contracting Party but his address as given in item 3 is not in the territory of that Contracting Party, it is necessary to give under (b) the address of such domicile or establishment unless it has been indicated that the transferee is a national of a Contracting State or of a State member of a Contracting Organization.

**Item 5: Appointment of a Representative**

64.08 The opportunity may be taken, in a request to record a change in ownership, to appoint a representative.

*Rule 3(6)(a)* 64.09 Item 5 should be used for the appointment of a representative of the new holder (the transferee). In the case of a total change in ownership, the recording of the representative of the transferor will be cancelled *ex officio* by the International Bureau. Where the person recorded as the representative of the transferor is to be recorded as the representative of the transferee, he should be reappointed by completing item 5.

***Item 6: Scope of the Change in Ownership***

64.10 If the change in ownership relates to all the designated Contracting Parties covered by the international registration and to all the goods and services covered by the said registration, box (a) should be checked.

64.11 In the case of a partial change in ownership (6(b)), the Contracting Parties in respect of which the change in ownership is to be recorded should be named, and the goods and services affected should be listed and grouped in the classes and sequence of the International Classification.

***Item 7: Miscellaneous Indications***

*Rule 25(2)(b)* 64.12 Where the transferee is a natural person, his nationality may be given under (a) (whether or not this information has already been given under item 4(a)). Where the transferee is a legal entity, the nature of the entity may be indicated, together with the State (and, where appropriate, the territorial unit within that State) in which it is incorporated. These indications are optional and their absence will not be questioned by the International Bureau (see paragraph B.II.07.15).

***Item 8: Signature by the Holder or His Representative***

*Rule 25(1)(d)* 64.13 Where the request is presented directly to the International Bureau, it must be signed by the holder (or his recorded representative).

64.14 Where the request is presented to the International Bureau through an Office, that Office may require or permit the holder to sign the form. The International Bureau will not however question the absence of a signature from this item.

***Item 9: Signature of the Office***

*Rule 25(1)(d)* 64.15 A request which is presented to the International Bureau by an Office must be signed by that Office. (If the holder submits a request directly to the International Bureau and produces his own form, he may omit item 9.)

***Fee Calculation Sheet***

*See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.08.01 to 08.14).*

64.16 A request to record a change in ownership is subject to the payment of the fee specified in the Schedule of Fees. Where the request relates to several international registrations, a fee must be paid with regard to each one of them. The payment may be made by any of the different means listed in the third part of the fee calculation sheet. Probably the most convenient method of payment is to use a current account with the International Bureau and merely instruct the International



Bureau (by completing part (a) in the fee calculation sheet) to debit the required amount; where payment is made by this method, the amount to be debited should not be specified. Where the fees are paid other than by debit from an account with the International Bureau or where the party making the payment wishes to specify the amount to be debited from an account with the International Bureau, the method of payment, the amount paid or to be debited and the party making the payment or giving the instructions should be indicated in part (b).

### **Irregular Requests**

*Rule 26* 65.01 If a request to record a change in ownership does not comply with the applicable requirements, the International Bureau notifies that fact to the holder and, if the request was presented through an Office, to that Office. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned; any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the fee.

65.02 Where the request was presented through an Office, the holder or the transferee should establish whether that Office intends to remedy the irregularity, or whether he must do this himself.

### **Recording, Notification and Publication**

*Rule 27(1)(a)* 66.01 The International Bureau records the change in ownership in the International Register and notifies accordingly the Offices of the designated Contracting Parties in respect of which the international registration has been transferred. At the same time it informs the holder and, where the request was presented through an Office, that Office. The International Bureau will also inform the former holder (in the case of a total change in ownership) or the holder of the part of the international registration which has been assigned or otherwise transferred (in the case of a partial change in ownership).

*Rule 27(1)(b)* 66.02 The change is recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements. It may however be recorded as of a later date where the holder has requested that it be recorded after the recording of another change or cancellation or a subsequent designation in respect of the same international registration or after the renewal of the international registration. The International Bureau publishes the relevant data in the Gazette. With regard to the language of recording, see paragraph B.II.63.04.

*Rule 32(1)(a)(vii)*  
*Rule 6(3)*

### **Partial Change in Ownership**

*A.I. Section 16* 67.01 Where a request is made to record a change in ownership of an international registration in respect of some only of the goods and services or some only of the designated Contracting Parties, the change will be recorded in the International Register under the number of the international registration concerned. Where the change relates to all the designated Contracting Parties, the goods and services that are the subject of the change in ownership will be canceled from the

international registration. The part which has been transferred will be recorded as a separate international registration, which will bear the same number as the registration of which a part has been transferred, together with a capital letter. The publication in the Gazette consists of the part of the international registration which has been transferred (with, *inter alia*, the reproduction of the mark, the list of goods and services and the designated Contracting Parties concerned).

67.02 Either of the resulting separate international registrations may be the subject of a subsequent total or partial change in ownership.

### **Merger of International Registrations Following Change in Ownership**

*Rule 27(3)* 68.01 Where the same party has been recorded as the holder of two or more international registrations of the same mark resulting from a partial change in ownership, that party may request the International Bureau to record the merger of the international registrations.

68.02 Two or more international registrations may be merged in this way only when they result from the splitting of a single international registration because of a partial change in ownership, as described above in paragraph B.II.67.01; there is no provision for the merging of international registrations which have come into the same ownership where they resulted from separate international applications.

68.03 There is no form (official or optional) for requesting the recording of a merger of international registrations. The request may be submitted to the International Bureau directly or through the Office of the Contracting Party of the holder.

*A.I. Section 17* 68.04 The international registration resulting from the merger will bear the number of the international registration of which a part had been assigned, together, where applicable, with a capital letter. The following examples may explain this:

– if all or some of the assigned parts of the international registration (recorded under the original number plus a letter) are merged with the original international registration (still recorded under its original number without a letter), the resulting international registration will bear the number of the original international registration (i.e. without a letter);

– if all or some of the assigned parts of the international registration (each recorded under the original number plus a letter) are merged amongst themselves and each of the assigned parts covers the same goods and/or services, the resulting international registration will bear the number of the original international registration together with the capital letter used earlier in respect of the first assigned part;

– if all or some of the assigned parts of the international registration (each recorded under the original number plus a letter) are merged amongst themselves, but the assigned parts do not cover the same goods and/or services, the resulting international registration will bear the number of the original international

registration together with the next capital letter (in the alphabetical order) not previously used in conjunction with the number of the international registration concerned.

### **Declaration that a Change in Ownership Has No Effect**

69.01 The validity of a change in ownership of an international registration in respect of a particular Contracting Party is governed by the law of that Contracting Party. In particular, where the change in ownership is for only some of the goods and services, a designated Contracting Party has the right to refuse to recognize the validity of the change if the goods and services included in the part transferred are similar to those remaining in the name of the holder. This possibility is expressly mentioned in Article 9*ter*(1) of the Agreement. This might be done where the transferee is a person or legal entity which, under the law of that Contracting Party, is not entitled to own marks. Or it may be done because the law of the Contracting Party concerned does not allow a transfer which, in its view, would be of such a nature as to mislead the public.

*Rule 27(4)(a) to (c)* 69.02 The Office of a designated Contracting Party which is notified by the International Bureau of a change in ownership affecting it may therefore declare that the change in ownership has no effect in its territory. Any such declaration must be sent before the expiry of 18 months from the date on which the notification of the change of ownership was sent to the Office concerned. In its declaration, the Office must indicate the reasons for which the change in ownership has no effect, the corresponding essential provisions of the law and whether the declaration is subject to review or appeal (it being noted that, where the designation of the Contracting Party concerned is governed by the Agreement, the grounds on which a partial change in ownership may be declared as having no effect are limited to the grounds specified in Article 9*ter*(1) of the Agreement). The Office notifies such declaration to the International Bureau which will notify accordingly the party (holder or Office) that presented the request for the recording of the change and the new holder.

*Rule 27(4)(e)* 69.03 Where the declaration indicates that it may be subject to review or appeal, it is for the transferee to ascertain from the Office concerned the time limit for requesting such review or appeal and the authority to which the request must be made. The Office must notify any final decision relating to the declaration to the International Bureau, which will notify accordingly the party (holder or Office) that presented the request to record the change in ownership and the new holder.

*Rule 27(4)(d) and (e)*  
*A.I. Section 18*  
*Rule 32(1)(a)(xi)* 69.04 Any declaration that the change in ownership has no effect, or any final decision in respect of that declaration, will be recorded in the International Register. The part of the international registration which has been the subject of the declaration or of the final decision will be recorded as a separate international registration in the same manner as for the recording of a partial change in ownership (see paragraph B.II.67.01). The relevant information will be published in the Gazette.

*Rule 27(4)(a)* 69.05 The effect, as far as the International Register is concerned, of a declaration by a designated Contracting Party that a change of ownership has no effect is that, with respect to that Contracting Party, the international registration concerned remains in the name of the transferor. The effect of such a declaration as far as the parties to the transfer are concerned is however a matter for the applicable national law.

### **Corrections in the International Register**

*Rule 28(1)* 70.01 Where the International Bureau considers that there is an error concerning an international registration in the International Register, it corrects that error *ex officio*. It will also correct such an error on request of the holder or of an Office.

70.02 Before giving effect to a request for the correction of an error, the International Bureau must be satisfied that the International Register is in fact incorrect. Its practice is as follows:

(a) where there is a discrepancy between what is recorded in the International Register and the documents filed with the International Bureau, that is to say there has been a mistake on the part of the International Bureau, the error will be corrected without further question;

(b) where there is an obvious error in the International Register and the correction sought is likewise obvious, in the sense that a reader would recognize that there was an error and that nothing else could have been intended other than what is offered as the correction, the error will be corrected as soon as it comes to the attention of the International Bureau;

(c) where there is an objective error in a fact recorded in the International Register, for example, where the name or address of the holder, or the date or number of the basic registration as recorded are incorrect, or where the mark that is the subject of the international registration is not in fact identical with the basic mark, this may in general be corrected; where the error results from a discrepancy between a document filed with the International Bureau and what is recorded in the register of a Contracting Party, the request for correction should be submitted by the Office of that Contracting Party;

(d) in any other case, in particular where the request is for a change in the list of designated Contracting Parties or the list of goods and services, this cannot be treated as the correction of an error in the International Register unless there has been a mistake by the Office by which the document containing the error was presented to the International Bureau; a request for a correction of this kind must therefore be submitted to the International Bureau by the Office concerned. Where the list of designated Contracting Parties or the list of goods and services as recorded in the International Register corresponds to what was submitted to the Office concerned by the applicant or holder or his representative, there is not an error in the

International Register. It follows that mistakes made by an applicant, holder or representative in indicating the designated Contracting Parties or in the list of goods and services cannot be corrected under Rule 28.

*Rule 28(4)* 70.03 With effect from April 1, 2002, an error which is attributable to an Office and the correction of which would affect the rights deriving from the international registration may be corrected only if a request for correction is received by the International Bureau within nine months from the date of publication of the erroneous entry in the International Register. This time limit does not apply to errors made by the International Bureau, since the document on which the entry containing the error was based has always been in the custody of the International Bureau. Nor does it apply to non-substantive errors such as those concerning the name or address of the holder or obvious mistakes in the list of goods and services.

*Rule 28(2)* 70.04 Where an error in the International Register has been corrected, the International Bureau notifies the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect. In addition, where the Office that has requested the correction is not the Office of a designated Contracting Party in which the correction has effect, the International Bureau will also inform that Office. The correction is also published in the Gazette.

*Rule 32(1)(a)(ix)*

### **Refusal Following a Correction**

*Rule 28(3)* 71.01 Any Office so notified may declare in a notification to the International Bureau that protection cannot, or can no longer, be granted to the international registration as corrected. This may be done where there are grounds for refusal of the international registration as corrected which did not apply to the international registration as originally notified to the Office concerned.

71.02 Article 5 of the Agreement and of the Protocol, Article 9*sexies* of the Protocol and Rules 16 to 18*ter* apply *mutatis mutandis* to the notification of refusal of the effects of a correction, and in particular to the time limits for notifying such a refusal (see paragraphs B.II.18.01 to 18.12). Such time limits are to be counted from the date of sending the notification of the correction.

### **No Other Change in the International Register**

72.01 No other changes affecting the mark that is the subject of an international registration may be recorded in the International Register (see however, below, the section entitled “Facts in Contracting Parties Affecting International Registrations” as regards the recording of such facts in the International Register).

72.02 In particular, there is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration, as the case may be (where such change is possible according to the law of the Contracting Party

whose Office is the Office of origin). This does not mean that, where the holder is now using the mark in a form which differs from that recorded in the International Register, it is indispensable for him to file a new international application. He may rely on Article 5C(2) of the Paris Convention, according to which use of the mark in a form which differs from the mark as registered in respect of elements which do not affect the distinctive character of that mark does not entail invalidation and does not diminish the protection of the international registration in the designated Contracting Parties.

72.03 It is not possible to extend the list of goods and services of international registration. If the holder wishes to protect his mark for additional goods and services, he must file a new international application. This is true even if those goods and services were included in the basic application or the basic registration; that is, they could have been included in the original international application but were omitted from it.

## RENEWAL OF INTERNATIONAL REGISTRATION

*P Article 6(1)* 73.01 Under the Protocol, registration of a mark at the International Bureau is effected for a period of 10 years. It is then renewable for a further 10 years upon payment of the required fees.  
*P Article 7(1)*

*A Article 6(1)* 73.02 Under the Agreement, registration of a mark is effected for a period of 20 years, and is then renewable for a further 20 years upon payment of the required fees. *Under the Regulations however, the fees must be paid in two installments of 10 years.* The requirements and provisions concerning payment of the second installment are the same as for renewal. For all practical purposes therefore, it is simplest to regard the second installment as a renewal fee.  
*A Article 7(1)*  
*Rule 10*  
*Rule 30(4)*

### Renewal Following Refusal or Invalidation

*Rule 30(2)(b)* 74.01 If a refusal is recorded in the International Register with respect to a particular Contracting Party for all the goods and services covered by the international registration, the holder may nevertheless request the renewal of his international registration with respect to that Contracting Party. The payment of the renewal fees must however be accompanied by an express statement that the renewal is to be recorded in respect of that Contracting Party. The reason for allowing a renewal with respect to a Contracting Party that has pronounced a refusal is that, at the time of renewal, there may still be pending a judicial or administrative procedure in respect of such refusal. The rights of the holder need to be preserved where the refusal was the subject of an appeal and no final decision had been taken by the date on which the renewal was due. A designated Contracting Party which has pronounced a refusal is of course free to determine the effects in its territory of such a renewal.

*Rule 19(1)* 74.02 The situation is different with respect to an invalidation, since the recording of an invalidation in the International Register must mean that the invalidation is no longer subject to appeal. The international registration therefore  
*Rule 30(2)(c)*

may not be renewed with respect to a Contracting Party for which a total invalidation has been recorded. Nor may it be renewed with respect to a Contracting Party for which a renunciation of protection has been recorded. Nor, in the case of a partial invalidation, a limitation of the list of goods and services with respect to a particular Contracting Party, or a partial cancellation with respect to all designated Contracting Parties, may renewal be effected with respect to those goods and services to which the invalidation, limitation or cancellation relate.

### **International Registrations Effected Before the Entry into Force of the Common Regulations**

75.01 In the case of an international registration effected before the entry into force of the Common Regulations (i.e., April 1, 1996):

*Rule 40(2)(c)* – where the fees were paid for 20 years, no further fees were due until the expiry of that period (except in the case where there had been a subsequent designation, see below); renewal fees would then have been due (for 10 years) under the Common Regulations;

– where the fees were paid for a first installment of 10 years and the balance for the remainder of the 20-year period had not been paid before the entry into force of the Common Regulations, renewal fees would have been due, under the Common Regulations, at the expiry of the first 10-year period.

*Rule 40(3)* 75.02 Where, after the entry into force of the Common Regulations, a subsequent designation was made in respect of an international registration for which the requisite fees had been paid for a period of 20 years, and the effective date of the subsequent designation fell within the first 10 years (i.e., between April 1, 1996, and March 31, 2006) of this period, the complementary or individual fees paid at the time of the subsequent designation covered only the period up to the end of the first 10 years. At the end of that period, a further complementary or individual fee would have had to be paid in respect of the Contracting Party concerned by this subsequent designation. The procedure concerning the payment of that fee was the same as for a normal renewal (see paragraphs B.II.76.01 to 76.04).

### **Procedure for Renewal**

*A Article 7(4)* 76.01 Six months before expiry of each 10-year term of protection, the  
*P Article 7(3)* International Bureau, by sending an unofficial notice, reminds the holder of the international registration and his representative (if any) of the exact date of expiry. If  
*Rule 29* however the holder (or representative) does not receive such unofficial notice, this does not constitute an excuse for failure to comply with any time limit for payment of the fees due. The unofficial notice will list all the designated Contracting Parties in respect of which no total refusal or invalidation is recorded in the International Register, or which have not been renounced.

*Article 7(2)* 76.02 Since renewal is considered to be a simple prolongation of the period of protection of the international registration against payment of the necessary fees, it may not include any change in relation to the international registration in its latest

form, that is at the expiry of the current period of protection. Therefore, no change in the name or address of the holder or in the list of goods and services may be made as part of the renewal procedure. Any such changes which the holder wishes to have recorded in the International Register when the registration is renewed must be communicated separately to the International Bureau according to the applicable procedures. They will be included in the data recorded at renewal only if they are recorded in the International Register not later than the date of expiry of the international registration.

- Rule 30(2)(a)* 76.03 The international registration may however be renewed for some only of the Contracting Parties covered. This is not regarded as a change which, according to *Rule 30(2)(d)* Article 7(2) of the Agreement and Article 7(2) of the Protocol, may not be included in the renewal. In that case the payment of fees must be accompanied by a statement listing the Contracting Parties for which no renewal is to be recorded.

76.04 A system for electronic renewal of international registrations is available on the WIPO website and can be accessed under *Forms* (<http://www.wipo.int/madrid/en/forms/>) and also under *Online Services* (<http://www.wipo.int/madrid/en/services/>) on the *Madrid System* webpage. No official form is prescribed for the renewal of an international registration. Renewal may be effected by any communication giving the necessary information (number(s) of the international registration(s) concerned and purpose of the payment). Holders may however find it convenient to use the optional form (MM11) which is sent by the International Bureau to the holder and the representative with the unofficial notice of expiry. This form provides for indications of:

- the number of the international registration to be renewed;
- the name of the holder, which must be the same as the one recorded in the International Register;
- the Contracting Parties for which the renewal is requested, including the Contracting Parties in respect of which a total refusal is recorded in the International Register;
- the signature of the holder or representative or of the Office through which the request for renewal is presented;
- the fees being paid and the method of payment, or instructions to debit the required fees from an account with the International Bureau.

### **Fees for Renewal**

- Rule 30(1)* 77.01 The fees due for the renewal of an international registration consist of:
- P Article 9sexies*
- the basic fee;
  - an individual fee for the designation of each designated Contracting Party that has made the relevant declaration (see paragraph B.II.07.86) and is designated under the Protocol, except where that designated Contracting



Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a designation, a complementary fee is payable);

– for each designated Contracting Party for which no individual fee is payable, a complementary fee;

– for each class of goods and services in excess of three, a supplementary fee; where however *all* the designated Contracting Parties are ones in respect of which an individual fee is payable, no supplementary fees are payable.

*P Article  
9sexies(1)(b)*

77.02 Subject to Article 9*sexies*(1)(b) of the Protocol, an individual fee is payable on renewal where the designated Contracting Party concerned has opted to receive individual fees and the designation of the Contracting Party is governed by the Protocol. It may happen that there has been a change of the applicable treaty governing a designation, following the recording of a change in ownership, and this may have implications on the fees paid on renewal (see paragraph B.II.62.01). If, for example, the treaty governing a designation has changed from being the Protocol to being the Agreement, then of course it is the complementary fee, rather than the possible individual fee, that would be payable in respect of the designated Contracting Party concerned, on the renewal of that international registration. The converse might occur if the change of applicable treaty were from the Agreement to the Protocol. It should be noted that there may also occur a change in the liability to pay individual fees following the recording of a change in ownership, even when there has *not* been a change in the applicable treaty.

*Rule 30(1)*

*Rule Ibis  
A Article 7(5)  
P Article 7(4)*

77.03 It is recalled that Article 9*sexies*(1)(b) of the Protocol provides for a derogation from the liability to pay individual fees in the mutual relations between States that are both party to the Agreement and to the Protocol. Thus, if the State whose Office is the Office of origin is party to both treaties and the international application contains the designation of a Contracting Party that is also bound by both treaties, then, notwithstanding the fact that the latter may have opted for individual fees *and* that the designation in question is a designation governed by the Protocol, by virtue of Article 9*sexies*(1)(b), the standard fees only will be payable to that Contracting Party. If, in due course, a change in ownership is recorded in respect of that international registration and the new owner claims entitlement to be recorded as owner through a connection with a Contracting Party that is bound only by the Protocol, then, while there has not been a change of the treaty governing the designation in question – i.e., the designation is still governed by the Protocol – there will be a change in the fee regime on the renewal of that international registration. Whereas, previously, the derogation provided for in Article 9*sexies*(1)(b) would have applied, it will no longer do so, and individual fees will be payable on renewal.

77.04 The fee calculator on the *Trademarks/Madrid System* page of WIPO's website may be used to calculate the fees payable for the renewal of an international the registration (<http://www.wipo.int/madrid/en/fees/calculator.jsp>).

77.05 The fees should be paid to the International Bureau by, at the latest, the date of expiry. Any payment received by the International Bureau earlier than three months before the due date is considered as having been received three months before

that date. The payment can still be made up to six months after the date on which the renewal was due, provided that a surcharge (which amounts to 50% of the basic fee for renewal) is paid at the same time.

*Rule 34(7)(d)* 77.06 Where the amount of a renewal fee changes between the date on which the fee was paid to the International Bureau and the date on which renewal is due,

– where payment is made not more than three months before the date on which renewal is due, it is the fee that was valid on the date of payment that is applicable;

– where the fee is paid more than three months before the date on which renewal is due, the payment is considered to have been received three months before the due date, and it is the fee that was valid three months before the due date that is applicable;

– where the renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable.

77.07 The fees may be paid directly to the International Bureau by the holder. Where however the Office of the Contracting Party of the holder agrees to collect and forward such fees, the fees may instead be paid through that Office. The holder cannot however be required to pay through an Office.

77.08 It is noted that an electronic interface (“E-Renewal”) for renewing international registrations is available on the WIPO Madrid System website at the following address: [https://webaccess.wipo.int/trademarks\\_ren/erenewal\\_en.jsp](https://webaccess.wipo.int/trademarks_ren/erenewal_en.jsp). Payment of renewal fees may be made by credit card or through a WIPO current account (see paragraph A.05.01).

*Article 8(1)* 77.09 Where the Office of origin accepts to collect the renewal fees and forward them to the International Bureau, that Office may fix, at its own discretion, and collect, for its own benefit, a handling fee for this service.

### **Renewal Fees Following Change in Applicable Treaty**

*Rule 1bis* 78.01 A change may occur in the treaty applicable to the *recorded* designation of a Contracting Party bound by both the Agreement and the Protocol (see paragraphs A.02.26 to 02.31). Depending on whether or not a given Contracting Party has made the declaration for individual fees under Article 8(7) of the Protocol, there may be a change in the amount of fees payable on renewal,

*P Article 8(7)* following a change in the treaty applicable (see also paragraph A.04.21).

### **Insufficient Fees Paid**

*Rule 30(3)(a)* 79.01 If the amount of the fees received is less than the amount of the fees required, the International Bureau will notify both the holder and the representative, if any, and specify the missing amount. If the fees have been paid by a party other than the holder, his representative or an Office, the International Bureau will inform accordingly that other party.

*Rule 30(3)(b)* 79.02 If the amount received, after the expiry of the period of six months following the date on which renewal was due, is less than the amount required (including the surcharge for late payment), the renewal will not be recorded. The International Bureau will reimburse the amount received to the party that paid it and will notify the holder and his representative accordingly.

*Rule 30(3)(c)* 79.03 There is an exception, however, to the rule just explained. Where the notification referred to in paragraph B.II.79.01 was sent less than three months before the expiry of the six-month period, and the amount paid by the end of that period is at least 70% of the amount due, the International Bureau will proceed to renew the international registration. If however the full amount is not paid within three months of the notification, the International Bureau will cancel the renewal and reimburse the amount paid.

79.04 Where the amount paid is insufficient, the holder may, instead of paying the missing amount, ask for some of the designated Contracting Parties to be omitted, thereby reducing the amount due. This request must however be made within the time within which the missing payment would have had to be made.

### **Recording of the Renewal; Notification, Certificate and Publication**

*Rule 31(1)* 80.01 The International Bureau records the renewal in the International Register, with the date on which it was due, even if the fees required were paid within the grace period of six months after the due date.

*Rule 31(2)* 80.02 The effective date of the renewal is the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register.

*Rule 31(3)* 80.03 Where the international registration has been renewed, the International Bureau so notifies the Offices of the designated Contracting Parties concerned and sends a certificate to the holder.

*Rule 31(4)(b)* 80.04 Where an international registration is not renewed in respect of a given designated Contracting Party, the International Bureau notifies accordingly the Office concerned.

*Rule 32(1)(a)(iv)* 80.05 Where an international registration has been renewed, the relevant data concerning the renewal are published in the Gazette. The publication is in effect a re-publication of the international registration, in the form at which it stands after renewal.

*Rule 6(3)* 80.06 In general, the recording and publication will be in English, French and  
*Rule 40(4)* Spanish. However, for all international registrations resulting from applications  
filed before April 1, 2004, and pending the recording of the first subsequent  
designation:

– if governed exclusively by the Agreement, French will continue  
as the sole language for the recording of a renewal.

– if governed wholly or partly by the Protocol, French and English  
will continue as the languages of renewal.

For international registrations resulting from applications filed between  
April 1, 2004, and August 31, 2008, and pending the recording of the first  
subsequent designation:

– if governed exclusively by the Agreement, then, as above, French  
will continue as the sole language for the recording of renewals. (Registrations  
resulting from applications filed during this period and governed wholly or partly  
by the Protocol will enjoy the full trilingual regime, following the introduction of  
Spanish as from April 1, 2004, and will therefore be renewed in all three languages  
(see also paragraphs B.I.07.01 to 07.07).

80.07 An Office which is notified of the renewal (or non-renewal) of an  
international registration need take no action, beyond amending any records which it  
keeps for its own use.

### **Complementary Renewal**

81.01 Where an international registration has been renewed in respect of only  
some of the designated Contracting Parties and the holder decides, after the due  
date, to renew said registration in respect of a designated Contracting Party not  
covered by the renewal already effected, this may be done through a so-called  
“complementary renewal”, provided that the period of grace of six months (see  
paragraph B.II.77.05) has not yet expired. The fees payable are the basic fee, a  
complementary or individual fee in respect of the Contracting Party concerned, and  
the surcharge referred to in paragraph B.II.77.05.

### **Non-Renewal**

82.01 If an international registration is not renewed (because the holder did not  
pay the renewal fees or because the fees paid were not sufficient), it lapses with effect  
from the date of expiry of the previous period of protection. (This is true also in the  
case of subsequent designations in respect of which fees due for the second  
installment of 10 years – see paragraph B.II.75.02 – have not been paid).

*Rule 31(4)(a)* 82.02 Where the international registration has not been renewed, that fact is  
*Rule 32(1)(a)(xii)* notified to the Offices of the designated Contracting Parties and is published in the  
Gazette. The publication consists simply of the number of the international  
registration and the date on which renewal was due. The notification and publication

are not made until there is no longer any possibility that the international registration might be renewed, that is, it is after the expiry of the period of six months after the due date (within which period renewal was possible upon payment of a surcharge). Where the renewal has been canceled for lack of payment of the balance of renewal fees (see paragraph B.II.79.02 to 79.04), that fact is also published in the Gazette.

82.03 Where the required renewal fees have not been paid by the due date, no subsequent designation and no changes may be recorded in the International Register during the period of six months after the due date within which renewal remains possible upon payment of a surcharge. It is only after renewal has been recorded in the International Register that the subsequent designation or the change may be recorded in the Register.

## DEPENDENCE AND INDEPENDENCE

### Ceasing of Effect During the Dependency Period

83.01 For a period of five years from the date of the international registration, the protection resulting from the international registration remains dependent on the mark registered or whose registration has been applied for with the Office of origin (basic application, registration resulting therefrom, or basic registration). The protection resulting from the international registration may no longer be invoked if, or to the extent that, the basic registration, or the registration resulting from the basic application is canceled, renounced, revoked, invalidated or has lapsed, or if the basic application is the subject of a final decision of rejection or is withdrawn, either within that five-year period or as a result of an action commenced within that period.

83.02 This dependence is absolute, and is effective regardless of the reasons why the basic application is rejected or is withdrawn or the basic registration ceases to enjoy, in whole or in part, legal protection. The process by which an international registration may be defeated for all countries in which it is protected, by means of a single invalidation or revocation action against the basic registration has become generally known by the term “central attack”.

83.03 Under the Protocol, there is an increased risk of the holder who chooses to base his international registration on an application with the Office of origin losing his protection as a result of the basic application ceasing to have effect. This need not be the result of a “central attack”, in the sense of an action brought by a third party. The basic application may be refused protection, totally or partially, on absolute grounds or because of the existence of a prior right cited *ex officio* in the examination procedure, or as a result of an opposition by the holder of such earlier right in that territory. In all these cases, and provided the decision in respect of the basic application is final (that is, no longer subject to review or appeal), the Office of origin is required to request the International Bureau to cancel the international registration, either totally or partially.

83.04 In order to soften the consequences of the five-year dependency feature of the Madrid system, the Protocol provides for the holder of an international registration which is canceled as a result of the ceasing of effect of the basic application, the

registration resulting therefrom, or the basic registration to apply, within three months of the date of the cancellation of the international registration in the International Register, for registration of the same mark with the Offices of all Contracting Parties whose designation are governed by the Protocol where the international registration had effect. The national or regional applications resulting from this so-called “transformation” are treated as if they had been filed on the date of the original international registration. (For details, see paragraphs B.II.88.01 to 88.07).

83.05 Although an international application must be filed by the person who is the holder of the national or regional registration or application on which it is based, the validity of an international registration is not affected if it and the national or regional registration or application subsequently become owned by different persons. It does not even matter if the national or regional application or registration is transferred to a person who would not qualify to be the holder of an international registration. Since however the international registration continues to be dependent on the fate of the basic mark, the holder of an international registration runs a risk if, during the five-year dependency period, he does not control the basic mark (see paragraph B.II.86.01).

*Article 6(2)* 83.06 At the end of the five-year dependency period, the international registration becomes independent of the basic mark (subject to paragraphs B.II.84.01 to 84.03). It should be noted that there is no separate dependency for subsequent designations; the only dependency period is the one which runs from the date of the international registration.

### **Ceasing of Effect of the Basic Application or Registration**

*Article 6(3)* 84.01 The protection resulting from the international registration may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom or the basic registration no longer enjoys legal protection because it:

- has been withdrawn;
- has lapsed;
- has been renounced; or
- has been the subject of a final decision of rejection, revocation, cancellation or invalidation.

Where the ceasing effect of the basic application, of the registration resulting therefrom or of the basic registration is in respect of only some of the goods or services listed in the international registration, the protection of the international registration is restricted accordingly.

84.02 Under the Agreement, this provision applies also when legal protection has later ceased as the result of an action begun before the expiry of the period of five years. The Protocol contains a more detailed provision, which takes into account the possibility of a basic application; the same rules apply if:

- an appeal lodged within the five-year period against a decision refusing the effects of the basic application,
- an action started within the five-year period requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
- an opposition to the basic application which is filed within the five-year period, results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, the registration resulting therefrom or the basic registration, as the case may be.

84.03 Furthermore the same rules apply under the Protocol if the basic application is withdrawn, or the registration resulting therefrom or the basic registration is renounced, after the expiry of the five-year period, in a case where, at the time of the withdrawal or renunciation, the application or registration was the subject of one of the proceedings referred to in the preceding paragraph, such proceeding having begun before the expiry of the five-year period. This provision prevents the holder of an international registration from frustrating the effects of central attack, when his basic application, the registration resulting therefrom or the basic registration has come under attack within the five-year period of dependency, by abandoning that application or registration after the end of that period but before an Office or a court has given a final decision on the matter.

### **Procedure for Notification of Ceasing of Effect**

- Rule 22(1)(a)* 85.01 Where the basic application, the registration resulting therefrom or the basic registration has ceased to have effect within the five-year period of dependency, the Office of origin notifies the International Bureau the following facts and decisions:
- the basic application is refused *ex officio* before the end of the period of five years from the date of the international registration, or such a refusal becomes final (for example, following an appeal) after the expiry of that period;
  - the basic application is refused as a result of an opposition which was begun before the expiry of that five-year period, whether or not such refusal becomes final before the end of that period;
  - the basic application has been withdrawn following a request made before the expiry of the five-year period;
  - the basic application has lapsed because of some event (for example, failure to comply with a procedural requirement of the Office of origin) before the expiry of the five year period, even if a decision concerning the lapsing of the application becomes final only after the end of that period;

– the basic registration (or the registration resulting from the basic application) is renounced, canceled, revoked or declared to be invalid following a request made (whether by the holder or by another party) before the end of the five-year period, even if the renunciation, cancellation, revocation or invalidation becomes effective or final only after the expiry of that period;

– the basic registration (or the registration resulting from the basic application) has lapsed (for example because of failure to pay renewal fees) before the end of the five-year period, even if a decision concerning the lapsing becomes final only after the end of that period.

*Rule 22(1)(a)* 85.02 Such notification must indicate the number of the international registration concerned and the name of the holder. The notification must also indicate the facts and decisions affecting the basic application (or the registration resulting therefrom) or the basic registration, and the effective date of those facts and decisions. By an indication of the facts and decisions is meant some statement such as:

– application number [####] has been refused by a decision of the [name of Office] dated [date]; the period allowed for filing an appeal against this decision expired on [date];

– application number [####] has been withdrawn following a request dated [date];

– registration number [####] ceased on [date]; the period within which the registration could be restored expired on [date];

– by a decision of the [name of court] dated [date], registration number [####] was revoked with effect from [date]; the period allowed for filing an appeal against this decision expired on [date].

There is no need for the Office of origin to give the International Bureau any indication of the grounds for the refusal or other decision.

*Rule 22(1)(a)(iv)* 85.03 Where these facts and decisions affect only some of the goods and services covered by the international registration, the notification must indicate which goods and services are affected or which goods and services are not affected. The obligation of the Office of origin to notify relates to *relevant* facts and decisions; where therefore a refusal, withdrawal, cancellation etc., affects the basic application, the registration resulting therefrom or the basic registration only in respect of goods and services which are not covered by the international registration, no notification should be sent to the International Bureau.

*Rule 6(2)* 85.04 In general, the notification may be in English, French or Spanish, at the option of the Office making the communication. However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of the first subsequent designation:

– if governed exclusively by the Agreement, French will continue as the sole language of notification.



*Rule 6(2)(i)* – if governed wholly or partly by the Protocol, French or English will continue as the languages of notification.

*Rule 40(4)* For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of the first subsequent designation:

– if governed exclusively by the Agreement, then, as above, French will continue as the sole language of notification. (Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004 (see also paragraphs B.I. 07.01 to 07.07).

85.05 The notification should not be sent until it is clear that there is no possibility of the ceasing of effect being reversed (but see also the following paragraph). For example, in the case of an administrative or judicial decision, the notification should not be sent until any appeal has been decided or until the period allowed for filing an appeal has expired. In particular, in the case of ceasing of effect of the registration resulting from the basic application or of ceasing of effect of the basic registration for failure to pay renewal fees, the notification should not be sent until any period of grace allowed for late payment, or for applying for restoration of the registration has expired.

*Rule 22(1)(b)* 85.06 Where however the Office of origin is aware that any of the following is pending at the end of the period of five years from the date of the international registration:

- a judicial action concerning the basic registration;
- an appeal against a decision refusing the basic application;
- an action requesting withdrawal of the basic application;
- an opposition to the basic application;

– an action requesting the revocation, cancellation or invalidation of the basic registration, or of the registration resulting from the basic application, it should notify accordingly the International Bureau as soon as possible. Such notification should make clear that the action in question has not yet resulted in a final decision.

*Rule 22(1)(c)* 85.07 Where the Office of origin has sent a preliminary notification as referred to in the preceding paragraph, the Office should, once the decision has become final, promptly notify the International Bureau accordingly. Where the Office is not directly notified of the decision (where for example the decision is given by a court or similar authority), the Office should notify the International Bureau as soon as it becomes aware of the decision. For example, the Office may be informed about the decision by the holder or by another party to the proceedings.

*Article 6(4)* 85.08 Where applicable, the Office of origin will request the International Bureau to cancel the international registration to the extent applicable (that is, for those goods and services with respect to which the basic application, the registration resulting therefrom, or the basic registration has ceased to have effect).

85.09 It is of course possible for an Office to notify the International Bureau only if it is aware of the action in question. This will be the case if the action is before that Office or is an appeal against a decision of the Office. The Office will however not necessarily be aware of an action brought by a third party before a court. It may be expected however that, where the decision is one which adversely affects the basic application, the registration resulting therefrom or the basic registration, and which thus requires cancellation of the international registration, the party who brought the action will bring it to the attention of the Office.

*Rule 22(2)* 85.10 The International Bureau records any notification in the International Register, and transmits copies of the notification to the holder and to the Offices of the designated Contracting Parties. Where the notification requests cancellation of the international registration, it will be so canceled, to the extent applicable; the International Bureau will notify accordingly the holder and the Offices of the designated Contracting Parties.

*Rule 32(1)(a)(viii)* 85.11 Any cancellation of the international registration will be published and recorded, with an indication of the date of the cancellation. Similarly, any notification that an action begun before the end of the five-year period of dependence is still pending at the end of that period will be published in the Gazette.

*Rule 32(1)(a)(xi)*

85.12 There is no official form for use by an Office of origin for requesting cancellation of an international registration. The form (MM8) for use by a holder for requesting cancellation should *not* be used by an Office.

85.13 Where the notification does not comply with the requirements mentioned in paragraphs B.II.85.02 to 85.05, the International Bureau will inform the Office which sent it that it cannot record the ceasing of effect until the notification is put in order.

### **Change in Ownership of the International Registration During the Dependency Period**

*Article 6(3)* 86.01 A change in ownership of the international registration or the basic mark (or both) during the five-year period of dependence has no influence on the effects of that dependence. The international registration remains dependent on the protection the basic mark in the Contracting Party whose Office is the Office of origin. Thus, for example, the international registration will cease to be protected if the basic registration or the registration resulting from the basic application is not renewed, or if the basic application is withdrawn or is refused by the Office of origin, even if it stands in the name of a person who is not the holder of the international registration.

### **Division or Merger of the Basic Application, the Registration Resulting Therefrom, or the Basic Registration**

*Rule 23* 87.01 It may be possible for a national or regional application or registration on which an international registration is based to be divided into several applications or registrations by distributing among them the goods and services listed in the initial application or registration, or for several basic applications or basic registrations to be merged into a single application or registration. Where this is done during the five-year period of dependence of the international registration, the Office of origin must notify the International Bureau accordingly.

*Rule 23(1)* 87.02 This notification must indicate:

- the number of the international registration concerned; where this is not yet available, the number of the basic application should be given instead (this will enable the International Bureau to identify the international registration concerned);
- the name of the holder or applicant;
- the number of each application resulting from the division of the basic application or the number of the application resulting from the merger.

*Rule 23(3)* 87.03 Similarly, the Office of origin must notify the International Bureau of a division of the basic registration or merger of the basic registrations, or of the registration(s) which resulted from the basic application(s), during this five-year period.

*Rule 32(1)(a)(xi)* 87.04 The International Bureau records the notification in the International Register and notifies the division or merger to the Offices of the designated Contracting Parties and to the holder of the international registration. The relevant data are published in the Gazette.

87.05 The entry in the International Register will only record the fact that the basic application or the basic registration has been divided or that the basic applications or basic registrations have been merged. It will not mention the goods and services covered by each application or registration resulting from the division. The full particulars of those applications and/or registrations may be obtained from the Office of origin.

87.06 Such division or merger has no legal effect on the international registration. The purpose of the notification by the Office of origin and its recording, notification and publication by the International Bureau is simply to provide the Offices of designated Contracting Parties and third parties with information concerning the situation of the basic mark during the period when the international registration is dependent on it.

## Transformation

*P Article  
9quinquies*

88.01 The effect of transformation of an international registration into one or more national or regional applications is that an application to the Office of a Contracting Party for the registration of a mark which was the subject of an international registration designating that Contracting Party will be treated by that Office as if it had been filed on the date of the international registration or, where that Contracting Party had been designated subsequently, the date of the subsequent designation. Where the international registration claimed priority, the national or regional application will benefit from that claim.

88.02 Transformation may take place only where the international registration has been cancelled, in respect of all or some of the goods and services, at the request of the Office of origin, as described in paragraphs B.II.85.01 to 85.06. It is not available where the international registration has been canceled at the request of the holder.

88.03 Transformation may take place with respect to any of the Contracting Parties in the territory of which the international registration had effect, that is any of the designated Contracting Parties in respect of which the international registration had not been the subject of a total refusal, invalidation or renunciation.

88.04 In order to benefit from this provision, the national or regional application must be filed within three months of the date of cancellation of the international registration. The goods and services listed in the application must have been covered by the list in the canceled international registration (or in the canceled part of the international registration) in respect of the Contracting Party concerned.

88.05 Apart from the special provisions regarding date, an application resulting from transformation is in effect an ordinary national or regional application. The application must be filed with the Office concerned. This filing is not governed by the Protocol or the Regulations, nor is the International Bureau involved in any way.

88.06 It is up to each Contracting Party to determine the modalities for giving effect to such transformation into a national or regional application. It may require that such an application comply with all requirements that apply to national or regional applications filed with its Office, including requirements concerning fees. That is, it may require that the full amount of application and other fees be paid; alternatively, and particularly where the Office concerned has already received individual fees in respect of the international registration concerned, it may decide to provide for reduced fees in the case of such an application.

88.07 Since transformation is provided for only in the Protocol (and not in the Agreement), its benefits can be claimed only in a Contracting Party whose designation is governed by the Protocol.

## **Transformation Following Change in the Applicable Treaty**

*Rule Ibis* 89.01 A change may occur in the treaty applicable to the *recorded* designation of a Contracting Party in the International Register (see paragraphs A.02.26 to 02.31). Since the possibility of transformation is provided for under the Protocol only, a holder will become entitled to request transformation, in the appropriate circumstances, following a change in the applicable treaty from the Agreement to the Protocol, provided that this change took place, at the latest, on the date of recording of the cancellation of the international registration.

## **FACTS IN CONTRACTING PARTIES AFFECTING INTERNATIONAL REGISTRATIONS**

90.01 The following paragraphs deal with facts in designated Contracting Parties other than the refusal of protection, which is covered in paragraphs B.II.17.01 to 31.01.

### **Invalidation in a Designated Contracting Party**

*Article 5(6)* 91.01 Invalidation, by the competent authorities of a Contracting Party, of the effects, in the territory of that Contracting Party, of an international registration may not be pronounced without the holder having, in good time, been afforded the opportunity of defending his rights. Proceedings concerning such invalidation take place directly between the holder of the international registration, the party who has brought the action for invalidation and the competent authority concerned (Office or court). It may be necessary for the holder to appoint a local representative. The proceedings are governed entirely by the law and practice of the Contracting Party concerned.

91.02 The procedures and substantive law governing such invalidation should be the same as for marks registered by the Office of that Contracting Party. For example, the protection of the mark may be revoked because the holder has not complied with provisions of the law of the Contracting Party concerning the use of the mark, or because the mark has been allowed to become generic or misleading, or because it has been established (for example, in proceedings brought by a third party, or in a counterclaim in infringement proceedings) that protection ought to have been refused when the designation was originally examined.

*Rule 19* 91.03 Where the effects of an international registration are invalidated (in whole or in part) in a Contracting Party, and the invalidation is no longer subject to any appeal, the Office of that Contracting Party must notify the International Bureau of the relevant facts, namely:

– the authority (for example, the Office or a particular court) which pronounced the invalidation, the date on which it was pronounced and the fact that it is no longer subject to appeal;

- the number of the international registration and the name of the holder;
- if the invalidation does not concern all the goods and services, those which are concerned (either by indicating those goods and services which are no longer covered or those which are still covered);
- the date on which the invalidation was pronounced and its effective date.

*Rule 32(1)(a)(x)* The International Bureau records the invalidation in the International Register, as of the date of receipt of a notification complying with the applicable requirements, together with the data contained in the notification, and informs accordingly the Office of origin, if that Office has informed the International Bureau that it wishes to receive such information, and the holder. It also publishes the invalidation in the Gazette.

*Rule 1(xixbis)* 91.04 In the Regulations, the term “invalidation” means any decision by a competent authority (whether administrative or judicial) of a designated Contracting Party revoking or canceling the effects, in the territory of that Contracting Party, of an international registration with regard to all or some of the goods or services covered by the designation of that Contracting Party. For this reason, an Office should notify not only the date on which the invalidation was pronounced but also, wherever possible, the effective date of the invalidation.

*Rule 19(1)(vi)*

### **Restriction of the Holder’s Right of Disposal**

*Rule 20(1)* 92.01 With effect from April 1, 2002, the scope of this provision has been greatly expanded. The holder, or the Office of the Contracting Party of the holder, may inform the International Bureau that the holder’s right to dispose of the international registration has been restricted. Such restriction may apply to the international registration as a whole or in respect of only some of the designated Contracting Parties; in the latter case, this should be specified in the information given to the International Bureau. Similarly, the Office of a designated Contracting Party may inform the International Bureau that the holder’s right of disposal has been restricted but, in this case, the information may only relate to a restriction in the territory of that Contracting Party. Such information should consist of a summary statement of the main facts concerning the restriction – for example, that it results from a court order concerning the disposal of the assets of the holder. This statement should be brief, and in a form suitable for recording in the International Register. Copies of court decisions or deeds should not be sent to the International Bureau. The International Bureau cannot however act on the basis of such information coming from a source other than the holder or an Office, for example, from a third party.

92.02 An example of a reason for such a restriction would be that the extension of the international registration in that Contracting Party has been given as security or is the subject of a right *in rem*, or that there is a court order concerning the disposal of the assets of the holder. However, this provision does not apply to licenses, which are the subject of a separate provision (see paragraphs B.II.93.01 to 99.04).

- Rule 20(2)* 92.03 Where the International Bureau has been informed of a restriction in accordance with this provision, the party that communicated the information should similarly inform the International Bureau of any partial or total removal of the restriction.
- Rule 20(3)* 92.04 The International Bureau records any information communicated about restrictions and their removal in the International Register, as of the date of its receipt, provided that the communication complies with the applicable requirements and informs, accordingly, the holder, the Office of the Contracting Party of the Holder and the Offices of the designated Contracting Parties concerned. The information
- Rule 32(1)(a)(xi)* is also published in the Gazette.

## Licenses

93.01 Some Contracting Parties provide for the recording at the national level of licenses in respect of international marks, such recording then having the same legal effect as does the recording of a license in respect of a national mark. With effect from April 1, 2002, however, it is possible for such licenses to be recorded in the International Register, thereby relieving holders of international registrations from the need to take such action with the Office of each Contracting Party in respect of which a license has been granted.

## Presentation of Request

- Rule 20bis(1)* 94.01 A request to record a license may be presented to the International Bureau either directly by the holder or through the Office of the Contracting Party of the holder or a Contracting Party in respect of which the license is granted. The request must be signed by the holder or by the Office through which it is presented. No supporting documents, such as copies of the license agreement, should be sent to the International Bureau.
- 94.02 A licensee who wishes to have his license recorded in the International Register may ask the Office of his Contracting Party to present the request. That Office may take whatever measures it considers appropriate in order to verify that the person concerned is entitled to be recorded as a licensee. The International Bureau cannot however accept such a request from the licensee (who is a person unknown to the International Bureau) which is not signed by either the holder or an Office.
- Rule 20(bis)(1)(b)* 94.03 The request must be presented on the official form (MM13) and must  
*A.I. Section 4(f)* indicate
- the number of the international registration concerned,
  - the name of the holder,
  - the name and address of the licensee, given in accordance with the guidelines concerning the name and address of the applicant (paragraphs B.II.07.08 and 07.09),

– the designated Contracting Parties with respect to which the license is granted,

– that the license is granted for all the goods and covered by the international registration, or the goods and services for which the license is granted, grouped in the appropriate classes of the International Classification of Goods and Services.

94.04 The above list is based on the indications or elements listed in Article 2 of the Joint Recommendation Concerning Trademark Licenses adopted by the General Assembly of WIPO and the Assembly of the Paris Union in September 2000<sup>3</sup>, and in Rule 10 of the Regulations under the Singapore Treaty on the Law of Trademarks<sup>4</sup>. Those indications or elements which do not appear pertinent in the framework of the recording of licenses at the international level have not been included.

*Rule 20 bis(1)(c)* 94.05 The request may also indicate

– where the licensee is a natural person, the State of which the licensee is a national,

– where the licensee is a legal entity, the legal nature of that entity and the State (and, where applicable, the territorial unit within that State) under the law of which the said legal entity has been organized,

– that the license concerns only a part of the territory of a specified designated Contracting Party,

– where the licensee has a representative, the name and address of the representative, given in accordance with the Administrative Instructions,

– where the license is an exclusive license or a sole license, that fact<sup>5</sup>,

– where applicable, the duration of the license.

94.06 The list in the preceding paragraph comprises additional elements which may be required by some designated Contracting Parties with respect to which the license is granted.

94.07 The recording of a license is subject to the payment of the fee specified in the Schedule of Fees. It is possible for a single request to cover several international registrations in the name of the same holder where the facts to be recorded (licensee, Contracting Parties and goods and services concerned) are the same, though the fee will need to be paid for each international registration mentioned in the request.

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<sup>3</sup> WIPO publication No. 835.

<sup>4</sup> WIPO publication No. 259.

<sup>5</sup> Where there is no indication that a license is exclusive or sole, it may be considered that the license is non-exclusive (*interpretative statement endorsed by the Assembly of the Madrid Union when adopting Rule 20bis*).



### **Irregular Request**

*Rule 20bis(2)(a)* 95.01 If the request for the recording of a license does not comply with the applicable requirements, the International Bureau will notify that fact to the holder and, if the request was presented by an Office, to that Office.

*Rule 20bis(2)(b)* 95.02 If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request will be considered abandoned, and the International Bureau will notify accordingly and at the same time the holder and, if the request was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees to the party having paid those fees.

### **Recording and Notification**

*Rule 20bis(3)* 96.01 Where the request complies with the applicable requirements, the International Bureau will record the license in the International Register, as of the date of receipt of a request complying with the applicable requirements, together with the information contained in the request, notify accordingly the Offices of the designated Contracting Parties in respect of which the license is granted and inform at the same time the holder and, if the request was presented by an Office, that Office.

### **Declaration that the Recording of a Given License Has No Effect**

*Rule 20bis(5)* 97.01 The Office of a designated Contracting Party which is notified by the International Bureau of the recording of a license in respect of that Contracting Party may declare that the recording of that license has no effect in the said Contracting Party. Such a declaration may be made, on a case-by-case basis, where the law of the Contracting Party concerned recognizes the effects of licenses recorded in the International Register but there are objections with respect to a particular license, for example, on the ground that the public could be misled.

97.02 The declaration must indicate:

- (i) the reasons for which the recording of the license has no effect,
- (ii) where the declaration does not affect all the goods and services to which the license relates, those which are affected by the declaration or those which are not affected by the declaration,
- (iii) the corresponding essential provisions of the law, and
- (iv) whether such declaration may be subject to review or appeal.

97.03 The declaration must be sent to the International Bureau before the expiry of 18 months from the date on which the notification of the recording of a license was sent to the Office concerned. The International Bureau will record the declaration in the International Register, as of the date of receipt of a

communication complying with the applicable requirements, and notify accordingly the party (holder or Office) that presented the request to record the license. Any final decision relating to a declaration should also be notified by the Office to the International Bureau, which will record it in the International Register and notify accordingly the party (holder or Office) that presented the request to record the license.

### **Declaration that the Recording of Licenses in the International Register Has No Effect in a Contracting Party**

*Rule 20bis(6)(a)* 98.01 The Office of a Contracting Party whose law does not provide at all for the recording of trademark licenses may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party.

*Rule 20bis(6)(b)* 98.02 The Office of a Contracting Party whose law does provide for the recording of trademark licenses but does not recognize the effects of licenses recorded in the International Register may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party.

*Rule 32(2)(i)* 98.03 Any notification made as described in the above paragraphs are published in the Gazette. A holder or licensee will therefore be aware that a request to record a license in respect of a Contracting Party that has made such a notification will have no legal effect. The International Bureau will nonetheless proceed with the recording and will notify the Office of the Contracting Party concerned. There is no need for that Office to issue a declaration as described in paragraphs B.II.97.01 to 97.03 since, by virtue of the general notification under Rule 20bis(6)(a) or (b), it is to be understood that the recording has no legal effect in that Contracting Party.

### **Amendment or Cancellation of the Recording of a License**

*Rule 20bis(4)* 99.01 After the recording of a license, the holder or the licensee may wish to amend some details concerning the license (for example its duration). The request must be made on the official form (MM14). Paragraphs B.II.94.01 to 94.05 apply.

99.02 Where a new licensee is to be recorded in respect of an international registration, this request is not considered as an amendment of a license but as a request for the recording of a new license and should be filed on form MM13.

99.03 Paragraphs B.II.94.01 and 94.02 also apply to the request for cancellation of the recording of a license. The request must be made on the official form (MM15). Once the cancellation has been requested, the license will be removed from the International Register. There is no fee for the cancellation of the recording of a license.

99.04 Where several licenses are recorded in respect of a given international registration, any request to amend or cancel the recording of license should specify clearly and unambiguously to which license the request relates.

### **Replacement of National or Regional Registration by International Registration**

*Article 4bis(1)* 100.01 Article 4bis of the Agreement and of the Protocol provides that a mark that is the subject of a national or regional registration in the Office of a Contracting Party is, under certain conditions, deemed to be replaced by an international registration of the same mark. These conditions are:

- both the national or regional registration and the international registration must be in the name of the same holder;
- the protection of the international registration extends to the Contracting Party in question;
- all the goods and services listed in the national or regional registration are also listed in the international registration in respect of that Contracting Party;
- the extension of the international registration to that Contracting Party (which may be a subsequent designation) takes effect after the date of the national or regional registration.

100.02 Furthermore, it is expressly stated that such effect is without prejudice to any rights acquired by virtue of the earlier national or regional registration (for example, rights resulting from a priority claim or from prior use of the mark).

100.03 It is up to the holder to satisfy himself whether, in a given case, these conditions are actually fulfilled, in particular, the requirement that all the goods and services listed in the national or regional registration must also be listed in the international registration. Clearly, the international registration need not have an identical list of goods and services; the list can be broader in scope. However, it cannot be narrower. Furthermore, the names used in the international registration must, at least in their meaning, be equivalent.

100.04 The reference to the international registration being deemed to replace the national or regional registration is not to be taken as meaning that that registration is suspended or otherwise affected. It remains on the register of the Contracting Party concerned, with all the rights attaching to such a registration, as long as it is renewed by its holder.

*Article 4bis(2)* 100.05 The Office in whose national or regional register the mark is recorded is required, upon request by the holder (made direct to that Office), to take note in its register of the international registration. This should not be interpreted as a mandatory requirement in order to benefit from replacement. The wording of Article 4bis(1) clearly provides that the replacement is deemed to take place automatically, without any action by the holder being necessary and without any

record having to be made of the replacement. It is however advisable, for the information of third parties, to request that the Office take note of the international registration in its register.

100.06 Notwithstanding replacement of a national or regional registration, it will be in the interest of the holder of the international registration to renew the national or regional registration during the five-year period during which the international registration is dependent on the fate of the basic application, the registration resulting therefrom or the basic registration.

*Rule 21* 100.07 Where the Office of a designated Contracting Party has taken note in its Register, following a request made by the holder with that Office, that a national or regional registration has been replaced by an international registration, that Office must notify the International Bureau accordingly. Such notification must indicate the number of the international registration, the filing date and number, the registration date and number and the priority date (if any) of the national or regional registration which has been replaced and, where the replacement concerns only some of the goods and services listed in the international registration, those goods and services. In addition, the notification should include information relating to any other rights acquired by virtue of the national or regional registration, in a form agreed between the International Bureau and the Office concerned. The International Bureau records the indications so notified in the International Register, as of the date of receipt of a notification complying with the applicable requirements, and informs the holder accordingly. It also publishes them in the Gazette.

*Rule 32(1)(a)(xi)*

### **Facts Concerning Seniority Claims**

*Rule 21bis(1)* 101.01 Where a claim of seniority has been recorded in the International Register in respect of a designation of the European Union (see paragraphs B.II.07.70 to 07.72), such claim is examined by OHIM, which may either accept or refuse it, in accordance with its applicable legislation. Where OHIM *refuses* the validity of such claim, and to the extent that the corresponding decision is final, that fact must be notified to the International Bureau. On the other hand, where the seniority claim is *accepted* by OHIM, there is not any necessity for the International Bureau to be notified, since the recording of the seniority claim in the International Register and its publication in the Gazette would not require any modification.

*Rule 21bis(2)* 101.02 The Community Trade Mark Regulation allows for a seniority claim to be made *subsequently* to a Community trademark registration. Where the European Union is designated in an international registration, any such “late” seniority claim must be presented *directly* with OHIM. Moreover, if such seniority claim is refused by OHIM following its examination, there is no corresponding notification by OHIM to the International Bureau (since there is nothing to be recorded in the International Register). It is therefore only where a late seniority claim has been *accepted* by OHIM that the relevant information must be notified to the International Bureau. The matters which must be notified are as follows:

(i) the number of the international registration concerned,

(ii) the Member State or Member States in or for which the earlier mark is registered, together with the date from which the registration of that earlier mark was effective, and the number of the relevant registration.

*Rule 21bis(3)* 101.03 Under the Community Trade Mark system, a seniority claim which has been accepted by OHIM may subsequently cease to have effect (following, in particular, a withdrawal or a cancellation). Therefore, where the corresponding seniority claim has already been recorded in the International Register, any further *final* decision affecting such claim, including withdrawal and cancellation, must be notified by OHIM to the International Bureau.

*Rules 21bis(4) and 32(1)(a)(xi)* 101.04 All information notified to the International Bureau under the above paragraphs is recorded in the International Register and published in the Gazette.

## CONTINUATION OF EFFECTS OF INTERNATIONAL REGISTRATIONS IN CERTAIN SUCCESSOR STATES

*Rule 39* 102.01 These paragraphs deal with the protection of an international registration when a State which had been designated is affected by changes resulting in a part of the territory of that State (“the predecessor Contracting Party”) becoming an independent State (“the successor State”). In such a case, the successor State may deposit with the Director General a declaration of continuation, the effect of which is that the Agreement, the Protocol, or both the Agreement and the Protocol are applied by the successor State.

*Rule 39(1)* 102.02 Any holder of an international registration with a territorial extension to the predecessor Contracting Party which is effective from a date prior to a date notified by the successor State will receive from the International Bureau a notice. The holder can ensure continued protection of his international registration in the successor State by filing with the International Bureau, within six months from the date of the notice, a request that the international registration continue its effects in the successor State and by the payment, within the same period of six months, to the International Bureau of a fee, the amount of which is specified in the Regulations. Part of that fee is transferred by the International Bureau to the successor State.

102.03 After the time limit for requesting continued protection has expired, protection of the international registration in the Contracting Party concerned can only be achieved by way of a subsequent designation.

*Rule 39(3)* 102.04 Upon receipt of the request and the fee, the International Bureau notifies the Office of the successor State and makes the corresponding recording in the International Register. It also publishes the relevant data in the Gazette.

*Rule 39(4)* 102.05 The successor State may refuse protection to the international registration only if the time limit referred to in Article 5(2) of the Agreement or of the Protocol has not expired with respect to the territorial extension to the predecessor Contracting Party. Rule 39(4) of the Regulations, however, does not

preclude the Office of a successor State from notifying, beyond the time limit fixed in Article 5(2) of the Agreement and of the Protocol, a final decision on a refusal of protection regularly notified to the International Bureau by the predecessor Contracting Party (before the succession took place) in respect of an international registration which has been the subject of a request for continuation of effect in the successor State.

## **PART C**

### **LIST OF ANNEXES**

- Madrid Agreement Concerning the International Registration of Marks (Stockholm Act)
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks
- Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement
- Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement
- Conditions for Opening, Using and Closing a Current Account at WIPO





# MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

of April 14, 1891,  
as revised  
at Brussels on December 14, 1900, at Washington on June 2, 1911,  
at The Hague on November 6, 1925, at London on June 2, 1934,  
at Nice on June 15, 1957,  
and at Stockholm on July 14, 1967,  
and as amended on September 28, 1979

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## Article 1

[Establishment of a Special Union. Filing of Marks at International Bureau.  
Definition of Country of Origin]

(1) The countries to which this Agreement applies constitute a Special Union for the International registration of marks.

(2) Nationals of any of the contracting countries may, in all the other countries party 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 of Intellectual Property (hereinafter designated as “the International Bureau”) referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as “the Organization”), through the intermediary of the Office of the said country of origin.

(3) Shall be considered 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 has his domicile; if he has no domicile within the Special Union but is a national of a country of the Special Union, the country of which he is a national.

## Article 2

[Reference to Article 3 of Paris Convention (Same Treatment for Certain  
Categories of Persons as for Nationals of Countries of the Union)]

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

## Article 3

[Contents of Application for International Registration]

(1) Every application for international registration must be presented on the form prescribed by the Regulations; the Office of the country of origin of the mark shall certify that the particulars appearing in such application correspond to the particulars in the national register, and shall mention the dates and numbers of the filing and registration of the mark in the country of origin and also the date of the application for international registration.

(2) The applicant must indicate the goods or services in respect of which 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 for the Purposes of the Registration of Marks. If the applicant does

not give such indication, the International Bureau shall classify the goods or services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the national Office. In the event of disagreement between the national Office 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 required:

1. to state the fact, and to file with his application a notice specifying 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 notification given 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 record it as at the date on which it received the said application. The International Bureau shall notify such registration without delay to the Offices concerned. Registered marks shall be published in a periodical journal issued by the International Bureau, on the basis of the particulars contained in the application for registration. In the case of 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) With a view to the publicity to be given in the contracting countries to registered marks, each Office shall receive from the International Bureau a number of copies of the said publication free of charge and a number of copies at a reduced price, in proportion to the number of units mentioned in Article 16(4)(a) of the Paris Convention for the Protection of Industrial Property, under the conditions fixed by the Regulations. Such publicity shall be deemed in all the contracting countries to be sufficient, and no other publicity may be required of the applicant.

### **Article 3bis**

[“Territorial Limitation”]

(1) Any contracting country may, at any time, notify the Director General of the Organization (hereinafter designated as “the Director General”) in writing that the protection resulting from the international registration shall extend to that country only at the express request of the proprietor of the mark.

(2) Such notification shall not take effect until six months after the date of the communication thereof by the Director General to the other contracting countries.

**Article 3ter**

[Request for “Territorial Extension”]

(1) Any request for extension of the protection resulting from the international registration to a country which has availed itself of the right 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 Office 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 Office or Offices concerned. It shall be published in the periodical journal issued by the International Bureau. Such territorial extension shall be effective from the date on which it has been 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**

[Effects of International Registration]

(1) From the date of the registration so 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 filed therein direct. The indication of classes of 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 for by Article 4 of the Paris Convention for the Protection of Industrial Property, without requiring compliance with the formalities prescribed in Section D of that Article.

**Article 4*bis***

[Substitution of International Registration for Earlier National Registrations]

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

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

## Article 5

### [Refusal by National Offices]

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

(2) Offices wishing to exercise such right must give notice of their refusal to the International Bureau, together with a statement of all grounds, within the period prescribed by their domestic law and, at the latest, before the expiration of one year from the date of the international registration of the mark or of the request for extension of protection made in accordance with Article 3<sup>ter</sup>.

(3) The International Bureau shall, without delay, transmit to the Office of the country of origin and to the proprietor of the mark, or to his agent if an agent has been mentioned to the Bureau by the said Office, one of the copies of the declaration of refusal so notified. The interested party shall have the same remedies as if the mark had been filed by him direct 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 who may so request.

(5) Offices which, within the aforesaid 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 right provided for in paragraph (1) of this Article with respect to the mark in question.

(6) 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 defending his rights. Invalidation shall be notified to the International Bureau.

## Article 5bis

### [Documentary Evidence of Legitimacy of Use of Certain Elements of Mark]

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the Offices of the contracting countries shall be exempt from any legalization or certification other than that of the Office of the country of origin.

**Article 5ter**

[Copies of Entries in International Register. Searches for Anticipation.  
Extracts from International Register]

- (1) The International Bureau shall issue to any person applying therefor, subject to a fee fixed by the Regulations, a copy of the entries in the Register relating to 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 legalization.

**Article 6**

[Period of Validity of International Registration. Independence of  
International Registration. Termination of Protection in Country of Origin]

- (1) Registration of a mark at the International Bureau is effected for twenty years, with the possibility of renewal under the conditions specified in Article 7.
- (2) Upon expiration of a period of five years from the date of the international registration, such registration shall become independent of the national mark registered earlier in the country of origin, subject to the following provisions.
- (3) The protection resulting from the international registration, whether or not it has been 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, registered earlier in the country of origin in accordance with Article 1, no longer enjoys, in whole or in part, legal protection in that country. This provision shall also apply when legal protection has later 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 Office of the country of origin shall request the cancellation of the mark at the International Bureau, and the latter shall effect the cancellation. In the case of judicial action, the said Office shall send to the International Bureau, ex officio or at the request of the plaintiff, a copy of the complaint or any other documentary evidence that an action has begun, and also of the final decision of the court; the Bureau shall enter notice thereof in the International Register.

**Article 7**

[Renewal of International Registration]

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

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

(3) The first renewal effected under the provisions of the Nice Act of June 15, 1957, or 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 renewal of the international registration.

### Article 8

[National Fee. International Fee. Division of Excess Receipts,  
Supplementary Fees, and Complementary Fees]

(1) The Office 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 shall include:

(a) a basic fee;

(b) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall;

(c) a complementary fee for any request for extension of protection under Article 3*ter*.

(3) However, the supplementary fee specified 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 deemed to have been 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 party to this Act by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of the said Act. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the excess receipts calculated on the basis of that earlier Act which is applicable to it.



(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 party to this Act or to the Nice Act of June 15, 1957, in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being multiplied, in the case of countries which make a preliminary examination, by a coefficient which shall be determined by the Regulations. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the amounts calculated on the basis of the Nice Act.

(6) The amounts derived from the complementary fees provided for in paragraph (2)(c) shall be divided according to the requirements of paragraph (5) among the countries availing themselves of the right provided for in Article 3*bis*. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the amounts calculated on the basis of the Nice Act.

### **Article 8*bis***

[Renunciation in Respect of One or More Countries]

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

### **Article 9**

[Changes in National Registers also Affecting International Registration.  
Reduction of List of Goods and Services Mentioned in International  
Registration. Additions to that List. Substitutions in that List]

(1) The Office of the country of the person in whose name the international registration stands shall likewise notify the International Bureau of 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 record those changes in the International Register, shall notify them in turn to the Offices 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 a reduction of the list of goods or services to which the registration applies.

(4) Such transactions 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 as prescribed in Article 3.

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

### **Article 9bis**

[Transfer of International Mark Entailing Change in Country  
of Proprietor]

(1) When a mark registered 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 Office of the latter country. The International Bureau shall record the transfer, shall notify the other Offices thereof, 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 Office 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 registered 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 the said transfer has been made for the benefit of a person who is not entitled to apply for international registration, the Office of the country of the former proprietor shall have the right to demand that the International Bureau cancel the mark in its Register.

### **Article 9ter**

[Assignment of International Mark for Part Only of Registered Goods or  
Services or for Certain Contracting Countries. Reference to Article 6<sup>quater</sup>  
of Paris Convention (Assignment of Mark)]

(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 such assignment if the goods or services included in the part so assigned are similar to those in respect of which the mark remains registered for the benefit of the assignor.

(2) The International Bureau shall likewise record the assignment of an international mark in respect of one or several of the contracting countries only.

(3) If, in the above cases, a change occurs in the country of the proprietor, the Office 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 its consent as required by Article 9*bis*.

(4) The provisions of the foregoing paragraphs shall apply subject to Article 6*quater* of the Paris Convention for the Protection of Industrial Property.

### **Article 9*quater***

[Common Office for Several Contracting Countries. Request by Several Contracting Countries to be Treated as a Single Country]

(1) If several countries of the Special Union agree to effect the unification of their domestic legislations on marks, they may notify the Director General:

(a) that a common Office shall be substituted for the national Office of each of them, and

(b) that the whole of their respective territories shall be deemed to be a single country for the purposes of the application of all or part of the provisions preceding this Article.

(2) Such notification shall not take effect until six months after the date of the communication thereof by the Director General to the other contracting countries.

### **Article 10**

[Assembly of the Special Union]

(1) (a) The Special Union shall have an Assembly consisting of those countries which have ratified or acceded to this Act.

(b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each member country, which shall be paid from the funds of the Special Union.

(2) (a) The Assembly shall:

(i) deal with all matters concerning the maintenance and development of the Special Union and the implementation of this Agreement;

(ii) give directions to the International Bureau concerning the preparation for conferences of revision, due account being taken of any comments made by those countries of the Special Union which have not ratified or acceded to this Act;

(iii) modify the Regulations, including the fixation of the amounts of the fees referred to in Article 8(2) and other fees relating to international registration;

(iv) review and approve the reports and activities of the Director General concerning the Special Union, and give him all necessary instructions concerning matters within the competence of the Special Union;

(v) determine the program and adopt the biennial budget of the Special Union, and approve its final accounts;

(vi) adopt the financial regulations of the Special Union;

(vii) establish such committees of experts and working groups as it may deem necessary to achieve the objectives of the Special Union;

(viii) determine which countries not members of the Special Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;

(ix) adopt amendments to Articles 10 to 13;

(x) take any other appropriate action designed to further the objectives of the Special Union;

(xi) perform such other functions as are appropriate under this Agreement.

(2) (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) (a) Each country member of the Assembly shall have one vote.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Article 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one country only.

(g) Countries of the Special Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(4) (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the countries members of the Assembly.

(c) The agenda of each session shall be prepared by the Director General.

(5) The Assembly shall adopt its own rules of procedure.

## Article 11

### [International Bureau]

(1) (a) International registration and related duties, as well as all other administrative tasks concerning the Special Union, shall be performed by the International Bureau.

(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may have been established by the Assembly.

(c) The Director General shall be the chief executive of the Special Union and shall represent the Special Union.

(2) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly and of such committees of experts or working groups as may have been established by the Assembly. The Director General, or a staff member designated by him, shall be ex officio secretary of those bodies.

(3) (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of the provisions of the Agreement other than Articles 10 to 13.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at those conferences.

(4) The International Bureau shall carry out any other tasks assigned to it.

## **Article 12**

### **[Finances]**

(1) (a) The Special Union shall have a budget.

(b) The budget of the Special Union shall include the income and expenses proper to the Special Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.

(c) Expenses not attributable exclusively to the Special Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Special Union in such common expenses shall be in proportion to the interest the Special Union has in them.

(2) The budget of the Special Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Special Union shall be financed from the following sources:

(i) international registration fees and other fees and charges due for other services rendered by the International Bureau in relation to the Special Union;

(ii) sale of, or royalties on, the publications of the International Bureau concerning the Special Union;

(iii) gifts, bequests, and subventions;

(iv) rents, interests, and other miscellaneous income.

(4) (a) The amounts of the fees referred to in Article 8(2) and other fees relating to international registration shall be fixed by the Assembly on the proposal of the Director General.

(b) The amounts of such fees shall be so fixed that the revenues of the Special Union from fees, other than the supplementary and complementary fees referred to in Article 8(2)(b) and (c), and other sources shall be at least sufficient to cover the expenses of the International Bureau concerning the Special Union.

(c) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) Subject to the provisions of paragraph (4)(a), the amount of fees and charges due for other services rendered by the International Bureau in relation to the Special Union shall be established, and shall be reported to the Assembly, by the Director General.

(6) (a) The Special Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Special Union. If the fund becomes insufficient, the Assembly shall decide to increase it.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country as a member of the Paris Union for the Protection of Industrial Property to the budget of the said Union for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(d) As long as the Assembly authorizes the use of the reserve fund of the Special Union as a working capital fund, the Assembly may suspend the application of the provisions of subparagraphs (a), (b), and (c).

(7) (a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of those advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Special Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

### **Article 13**

[Amendment of Articles 10 to 13]

(1) Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any country member of the Assembly, or by the Director General. Such proposals shall be communicated by the Director General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date.

#### Article 14

[Ratification and Accession. Entry into Force. Accession to Earlier Acts. Reference to Article 24 of Paris Convention (Territories)]

(1) Any country of the Special Union which has signed this Act may ratify it, and, if it has not signed it, may accede to it.

(2) (a) Any country outside the Special Union which is party to the Paris Convention for the Protection of Industrial Property may accede to this Act and thereby become a member of the Special Union.

(b) As soon as the International Bureau is informed that such a country has acceded to this Act, it shall address to the Office of that country, in accordance with Article 3, a collective notification of the marks which, at that time, enjoy international protection.

(c) Such notification shall, of itself, ensure to the said marks the benefits of the foregoing provisions in the territory of the said country, and shall mark the commencement of the period of one year during which the Office concerned may make the declaration provided for in Article 5.

(d) However, any such country may, in acceding to this Act, 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, application of this Act shall be limited to marks registered from the date on which its accession enters into force.

(e) Such declaration shall dispense the International Bureau from making the collective notification referred to above. The International Bureau shall notify only those 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, to take advantage of the exception provided for in subparagraph (d).

(f) The International Bureau shall not make the collective notification to such countries as declare, in acceding to this Act, that they are availing themselves of the right provided for in Article 3*bis*. The said 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, such limitation shall not affect international marks which have already been the subject of an earlier identical national registration in those countries, and which could give rise to requests for extension of protection made and notified in accordance with Articles 3*ter* and 8(2)(c).



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

(3) Instruments of ratification and accession shall be deposited with the Director General.

(4) (a) With respect to the first five countries which have deposited their instruments of ratification or accession, this Act shall enter into force three months after the deposit of the fifth such instrument.

(b) With respect to any other country, this Act shall enter into force three months after the date on which its ratification or accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of ratification or accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(5) Ratification or accession shall automatically entail acceptance of all the clauses and admission to all the advantages of this Act.

(6) After the entry into force of this Act, a country may accede to the Nice Act of June 15, 1957, only in conjunction with ratification of, or accession to, this Act. Accession to Acts earlier than the Nice Act shall not be permitted, not even in conjunction with ratification of, or accession to, this Act.

(7) The provisions of Article 24 of the Paris Convention for the Protection of Industrial Property shall apply to this Agreement.

## **Article 15**

### **[Denunciation]**

(1) This Agreement shall remain in force without limitation as to time.

(2) Any country may denounce this Act by notification addressed to the Director General. Such denunciation shall constitute also denunciation of all earlier Acts and shall affect only the country making it, the Agreement remaining in full force and effect as regards the other countries of the Special Union.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Special Union.

(5) International marks registered up to the date on which denunciation becomes effective, and not refused within the period of one year provided for in Article 5, shall continue, throughout the period of international protection, to enjoy the same protection as if they had been filed direct in the denouncing country.

### **Article 16**

[Application of Earlier Acts]

(1) (a) This Act shall, as regards the relations between the countries of the Special Union 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.

(b) However, any country of the Special Union which has ratified or acceded to this Act shall remain bound by the earlier texts which it has not previously denounced by virtue of Article 12(4) of the Nice Act of June 15, 1957, as regards its relations with countries which have not ratified or acceded to this Act.

(2) Countries outside the Special Union which become party to this Act shall apply it to international registrations effected at the International Bureau through the intermediary of the national Office of any country of the Special Union not party to this Act, provided that such registrations satisfy, with respect to the said countries, the requirements of this Act. With regard to international registrations effected at the International Bureau through the intermediary of the national Offices of the said countries outside the Special Union which become party to this Act, such countries recognize that the aforesaid country of the Special Union may demand compliance with the requirements of the most recent Act to which it is party.

### **Article 17**

[Signature, Languages, Depositary Functions]

(1) (a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) This Act shall remain open for signature at Stockholm until January 13, 1968.

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Act to the Governments of all countries of the Special Union and, on request, to the Government of any other country.

(4) The Director General shall register this Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries of the Special Union of signatures, deposits of instruments of ratification or accession and any declarations included in such instruments, entry into force of any provisions of this Act, notifications of denunciation, and notifications pursuant to Articles *3bis*, *9quater*, 13, 14(7), and 15(2).

### **Article 18**

#### [Transitional Provisions]

(1) Until the first Director General assumes office, references in this Act to the International Bureau of the Organization or to the Director General shall be construed as references to the Bureau of the Union established by the Paris Convention for the Protection of Industrial Property or its Director, respectively.

(2) Countries of the Special Union not having ratified or acceded to this Act may, until five years after the entry into force of the Convention establishing the Organization, exercise, if they so desire, the rights provided for under Articles 10 to 13 of this Act as if they were bound by those Articles. Any country desiring to exercise such rights shall give written notification to that effect to the Director General; such notification shall be effective from the date of its receipt. Such countries shall be deemed to be members of the Assembly until the expiration of the said period.



**PROTOCOL  
RELATING TO THE MADRID AGREEMENT  
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

Adopted at Madrid on June 27, 1989,  
as amended on October 3, 2006,  
and on November 12, 2007

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## Article 1

### Membership in the Madrid Union

The States party to this Protocol (hereinafter referred to as “the Contracting States”), even where they are not party to the Madrid Agreement Concerning the International Registration of Marks as revised at Stockholm in 1967 and as amended in 1979 (hereinafter referred to as “the Madrid (Stockholm) Agreement”), and the organizations referred to in Article 14(1)(b) which are party to this Protocol (hereinafter referred to as “the Contracting Organizations”) shall be members of the same Union of which countries party to the Madrid (Stockholm) Agreement are members. Any reference in this Protocol to “Contracting Parties” shall be construed as a reference to both Contracting States and Contracting Organizations.

## Article 2

### Securing Protection through International Registration

(1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as “the basic application”) or that registration (hereinafter referred to as “the basic registration”) stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organization (hereinafter referred to as “the international registration,” “the International Register,” “the International Bureau” and “the Organization,” respectively), provided that,

(i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,

(ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.

(2) The application for international registration (hereinafter referred to as “the international application”) shall be filed with the International Bureau through the intermediary of the Office with which the basic application was filed or by which the basic registration was made (hereinafter referred to as “the Office of origin”), as the case may be.

(3) Any reference in this Protocol to an “Office” or an “Office of a Contracting Party” shall be construed as a reference to the office that is in charge, on behalf of a Contracting Party, of the registration of marks, and any reference in this Protocol to “marks” shall be construed as a reference to trademarks and service marks.

(4) For the purposes of this Protocol, “territory of a Contracting Party” means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituting treaty of that intergovernmental organization applies.

### **Article 3**

#### **International Application**

(1) Every international application under this Protocol shall be presented on the form prescribed by the Regulations. The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be. Furthermore, the said Office shall indicate,

(i) in the case of a basic application, the date and number of that application,

(ii) in the case of a basic registration, the date and number of that registration as well as the date and number of the application from which the basic registration resulted.

The Office of origin shall also indicate the date of the international application.

(2) The applicant must indicate the goods and services in respect of which 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 for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office 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 required

(i) to state the fact, and to file with his international application a notice specifying the color or the combination of colors claimed;

(ii) to append to his international application copies in color of the said mark, which shall be attached to the notifications given 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 2. The international registration shall bear the date on which the international application was received in the Office of origin, provided that the international application has been received by the International Bureau within a period of two months from that date. If the international application has not been received within that period, the international registration shall bear the date on which the said international application was received by the International Bureau. The International Bureau shall notify the international registration without delay to the Offices concerned. Marks registered in the International Register shall be published in a periodical gazette issued by the International Bureau, on the basis of the particulars contained in the international application.

(5) With a view to the publicity to be given to marks registered in the International Register, each Office shall receive from the International Bureau a number of copies of the said gazette free of charge and a number of copies at a reduced price, under the conditions fixed by the Assembly referred to in Article 10 (hereinafter referred to as “the Assembly”). Such publicity shall be deemed to be sufficient for the purposes of all the Contracting Parties, and no other publicity may be required of the holder of the international registration.

### **Article 3bis**

#### **Territorial Effect**

The protection resulting from the international registration shall extend to any Contracting Party only at the request of the person who files the international application or who is the holder of the international registration. However, no such request can be made with respect to the Contracting Party whose Office is the Office of origin.

### **Article 3ter**

#### **Request for “Territorial Extension”**

(1) Any request for extension of the protection resulting from the international registration to any Contracting Party shall be specially mentioned in the international application.

(2) A request for territorial extension may also be made subsequently to the international registration. Any such request shall be presented on the form prescribed by the Regulations. It shall be immediately recorded by the International Bureau, which shall notify such recordal without delay to the Office or Offices concerned. Such recordal shall be published in the periodical gazette of the International Bureau. Such territorial extension shall be effective from the date on which it has been recorded in the International Register; it shall cease to be valid on the expiry of the international registration to which it relates.

## Article 4

### Effects of International Registration

(1) (a) From the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3*ter*, the protection of the mark in each of the Contracting Parties concerned shall be the same as if the mark had been deposited direct with the Office of that Contracting Party. If no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been withdrawn subsequently, the protection of the mark in the Contracting Party concerned shall, as from the said date, be the same as if the mark had been registered by the Office of that Contracting Party.

(b) The indication of classes of goods and services provided for in Article 3 shall not bind the Contracting Parties with regard to the determination of the scope of the protection of the mark.

(2) Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without it being necessary to comply with the formalities prescribed in Section D of that Article.

## Article 4*bis*

### Replacement of a National or Regional Registration by an International Registration

(1) 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, without prejudice to any rights acquired by virtue of the latter, provided that

(i) the protection resulting from the international registration extends to the said Contracting Party under Article 3*ter*(1) or (2),

(ii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said Contracting Party,

(iii) such extension takes effect after the date of the national or regional registration.

(2) The Office referred to in paragraph (1) shall, upon request, be required to take note in its register of the international registration.

## Article 5

### **Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties**

(1) Where the applicable legislation so authorizes, any Office of a Contracting Party which has been notified by the International Bureau of an extension to that Contracting Party, under Article 3<sup>ter</sup>(1) or (2), of the protection resulting from the international registration shall have the right to declare in a notification of refusal that protection cannot be granted in the said Contracting Party to the mark which is the subject of such extension. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark deposited direct with the Office which notifies the refusal. However, protection may not be refused, even partially, by reason only that the applicable legislation would permit registration only in a limited number of classes or for a limited number of goods or services.

(2) (a) Any Office wishing to exercise such right shall notify its refusal to the International Bureau, together with a statement of all grounds, within the period prescribed by the law applicable to that Office and at the latest, subject to subparagraphs (b) and (c), before the expiry of one year from the date on which the notification of the extension referred to in paragraph (1) has been sent to that Office by the International Bureau.

(b) Notwithstanding subparagraph (a), any Contracting Party may declare that, for international registrations made under this Protocol, the time limit of one year referred to in subparagraph (a) is replaced by 18 months.

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if

(i) it has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit, and

(ii) the notification of the refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.

(d) Any declaration under subparagraphs (b) or (c) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General of the Organization (hereinafter referred to as “the Director General”), or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

(e) Upon the expiry of a period of ten years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly\*.

(3) The International Bureau shall, without delay, transmit one of the copies of the notification of refusal to the holder of the international registration. The said holder shall have the same remedies as if the mark had been deposited by him direct with the Office which has notified its refusal. Where the International Bureau has received information under paragraph (2)(c)(i), it shall, without delay, transmit the said information to the holder of the international registration.

(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

(5) Any Office which has not notified, with respect to a given international registration, any provisional or final refusal to the International Bureau in accordance with paragraphs (1) and (2) shall, with respect to that international registration, lose the benefit of the right provided for in paragraph (1).

(6) Invalidation, by the competent authorities of a Contracting Party, of the effects, in the territory of that Contracting Party, of an international registration may not be pronounced without the holder of such international registration having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

### **Article 5bis**

#### **Documentary Evidence of Legitimacy of Use of Certain Elements of the Mark**

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the Offices of the Contracting Parties shall be exempt from any legalization as well as from any certification other than that of the Office of origin.

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\* Interpretative statement adopted by the Assembly of the Madrid Union:

“Article 5(2)(e) of the Protocol is understood as allowing the Assembly to keep under review the operation of the system established by subparagraphs (a) to (d), it being also understood that any modification of those provisions shall require a unanimous decision of the Assembly.”

### **Article 5ter**

#### **Copies of Entries in International Register; Searches for Anticipations; Extracts from International Register**

(1) The International Bureau shall issue to any person applying therefor, upon the payment of a fee fixed by the Regulations, a copy of the entries in the International Register concerning a specific mark.

(2) The International Bureau may also, upon payment, undertake searches for anticipations among marks that are the subject of international registrations.

(3) Extracts from the International Register requested with a view to their production in one of the Contracting Parties shall be exempt from any legalization.

### **Article 6**

#### **Period of Validity of International Registration; Dependence and Independence of International Registration**

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if

(i) an appeal against a decision refusing the effects of the basic application,

(ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or

(iii) an opposition to the basic application

results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same

also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.

## **Article 7**

### **Renewal of International Registration**

(1) Any international registration may be renewed for a period of ten years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not bring about any change in the international registration in its latest form.

(3) Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.

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

## **Article 8**

### **Fees for International Application and Registration**

(1) The Office of origin may fix, at its own discretion, and collect, for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.

(2) Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which shall, subject to the provisions of paragraph (7)(a), include,

- (i) a basic fee;

(ii) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall;

(iii) a complementary fee for any request for extension of protection under Article 3*ter*.

(3) However, the supplementary fee specified in paragraph (2)(ii) may, without prejudice to the date of the international registration, be paid within the 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 expiry 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 international application shall be deemed to have been abandoned.

(4) The annual product of the various receipts from international registration, with the exception of the receipts derived from the fees mentioned in paragraph (2)(ii) and (iii), shall be divided equally among the Contracting Parties by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of this Protocol.

(5) The amounts derived from the supplementary fees provided for in paragraph (2)(ii) shall be divided, at the expiry of each year, among the interested Contracting Parties in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being multiplied, in the case of Contracting Parties which make an examination, by a coefficient which shall be determined by the Regulations.

(6) The amounts derived from the complementary fees provided for in paragraph (2)(iii) shall be divided according to the same rules as those provided for in paragraph (5).

(7) (a) Any Contracting Party may declare that, in connection with each international registration in which it is mentioned under Article 3*ter*, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, a fee (hereinafter referred to as “the individual fee”) whose amount shall be indicated in the declaration, and can be changed in further declarations, but may not be higher than the equivalent of the amount which the said Contracting Party’s Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure. Where such an individual fee is payable,

(i) no supplementary fees referred to in paragraph (2)(ii) shall be payable if only Contracting Parties which have made a declaration under this subparagraph are mentioned under Article 3*ter*, and

(ii) no complementary fee referred to in paragraph (2)(iii) shall be payable in respect of any Contracting Party which has made a declaration under this subparagraph.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental

organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General, or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

### **Article 9**

#### **Recordal of Change in the Ownership of an International Registration**

At the request of the person in whose name the international registration stands, or at the request of an interested Office made *ex officio* or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.

### **Article 9bis**

#### **Recordal of Certain Matters Concerning an International Registration**

The International Bureau shall record in the International Register

- (i) any change in the name or address of the holder of the international registration,
- (ii) the appointment of a representative of the holder of the international registration and any other relevant fact concerning such representative,
- (iii) any limitation, in respect of all or some of the Contracting Parties, of the goods and services listed in the international registration,
- (iv) any renunciation, cancellation or invalidation of the international registration in respect of all or some of the Contracting Parties,
- (v) any other relevant fact, identified in the Regulations, concerning the rights in a mark that is the subject of an international registration.



**Article 9ter****Fees for Certain Recordals**

Any recordal under Article 9 or under Article 9bis may be subject to the payment of a fee.

**Article 9quater****Common Office of Several Contracting States**

(1) If several Contracting States agree to effect the unification of their domestic legislations on marks, they may notify the Director General

(i) that a common Office shall be substituted for the national Office of each of them, and

(ii) that the whole of their respective territories shall be deemed to be a single State for the purposes of the application of all or part of the provisions preceding this Article as well as the provisions of Articles 9quinquies and 9sexies.

(2) Such notification shall not take effect until three months after the date of the communication thereof by the Director General to the other Contracting Parties.

**Article 9quinquies****Transformation of an International Registration  
into National or Regional Applications**

Where, in the event that the international registration is cancelled at the request of the Office of origin under Article 6(4), in respect of all or some of the goods and services listed in the said registration, the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, shall enjoy the same priority, provided that

(i) such application is filed within three months from the date on which the international registration was cancelled,

(ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the Contracting Party concerned, and

(iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

### **Article 9sexies**

#### **Relations Between States Party to both this Protocol and the Madrid (Stockholm) Agreement**

(1) (a) This Protocol alone shall be applicable as regards the mutual relations of States party to both this Protocol and the Madrid (Stockholm) Agreement.

(b) Notwithstanding subparagraph (a), a declaration made under Article 5(2)(b), Article 5(2)(c) or Article 8(7) of this Protocol, by a State party to both this Protocol and the Madrid (Stockholm) Agreement, shall have no effect in the relations with another State party to both this Protocol and the Madrid (Stockholm) Agreement.

(2) The Assembly shall, after the expiry of a period of three years from September 1, 2008, review the application of paragraph (1)(b) and may, at any time thereafter, either repeal it or restrict its scope, by a three-fourths majority. In the vote of the Assembly, only those States which are party to both the Madrid (Stockholm) Agreement and this Protocol shall have the right to participate.

### **Article 10**

#### **Assembly**

(1) (a) The Contracting Parties shall be members of the same Assembly as the countries party to the Madrid (Stockholm) Agreement.

(b) Each Contracting Party shall be represented in that Assembly by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Contracting Party which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each Contracting Party, which shall be paid from the funds of the Union.

(2) The Assembly shall, in addition to the functions which it has under the Madrid (Stockholm) Agreement, also

(i) deal with all matters concerning the implementation of this Protocol;

(ii) give directions to the International Bureau concerning the preparation for conferences of revision of this Protocol, due account being taken of any comments made by those countries of the Union which are not party to this Protocol;

(iii) adopt and modify the provisions of the Regulations concerning the implementation of this Protocol;

(iv) perform such other functions as are appropriate under this Protocol.

(3) (a) Each Contracting Party shall have one vote in the Assembly. On matters concerning only countries that are party to the Madrid (Stockholm) Agreement, Contracting Parties that are not party to the said Agreement shall not have the right to vote, whereas, on matters concerning only Contracting Parties, only the latter shall have the right to vote.

(b) One-half of the members of the Assembly which have the right to vote on a given matter shall constitute the quorum for the purposes of the vote on that matter.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of the members of the Assembly having the right to vote on a given matter which are represented is less than one-half but equal to or more than one-third of the members of the Assembly having the right to vote on that matter, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly having the right to vote on the said matter which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiry of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Articles 5(2)(e), 9*sexies*(2), 12 and 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one member of the Assembly only.

(4) In addition to meeting in ordinary sessions and extraordinary sessions as provided for by the Madrid (Stockholm) Agreement, the Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the members of the Assembly having the right to vote on the matters proposed to be included in the agenda of the session. The agenda of such an extraordinary session shall be prepared by the Director General.

## **Article 11**

### **International Bureau**

(1) International registration and related duties, as well as all other administrative tasks, under or concerning this Protocol, shall be performed by the International Bureau.

(2) (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of this Protocol.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for such conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at such conferences of revision.

(3) The International Bureau shall carry out any other tasks assigned to it in relation to this Protocol.

## **Article 12**

### **Finances**

As far as Contracting Parties are concerned, the finances of the Union shall be governed by the same provisions as those contained in Article 12 of the Madrid (Stockholm) Agreement, provided that any reference to Article 8 of the said Agreement shall be deemed to be a reference to Article 8 of this Protocol. Furthermore, for the purposes of Article 12(6)(b) of the said Agreement, Contracting Organizations shall, subject to a unanimous decision to the contrary by the Assembly, be considered to belong to contribution class I (one) under the Paris Convention for the Protection of Industrial Property.

## **Article 13**

### **Amendment of Certain Articles of the Protocol**

(1) Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any Contracting Party, or by the Director General. Such proposals shall be communicated by the Director General to the Contracting Parties at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of those States and intergovernmental organizations which, at the time the amendment was adopted, were members of the Assembly and had the right to vote on the amendment. Any amendment to the said Articles thus accepted shall bind all the States and intergovernmental organizations which are Contracting Parties at the time the amendment enters into force, or which become Contracting Parties at a subsequent date.

## Article 14

### **Becoming Party to the Protocol; Entry into Force**

(1) (a) Any State that is a party to the Paris Convention for the Protection of Industrial Property may become party to this Protocol.

(b) Furthermore, any intergovernmental organization may also become party to this Protocol where the following conditions are fulfilled:

(i) at least one of the member States of that organization is a party to the Paris Convention for the Protection of Industrial Property;

(ii) that organization has a regional Office for the purposes of registering marks with effect in the territory of the organization, provided that such Office is not the subject of a notification under Article 9*quater*.

(2) Any State or organization referred to in paragraph (1) may sign this Protocol. Any such State or organization may, if it has signed this Protocol, deposit an instrument of ratification, acceptance or approval of this Protocol or, if it has not signed this Protocol, deposit an instrument of accession to this Protocol.

(3) The instruments referred to in paragraph (2) shall be deposited with the Director General.

(4) (a) This Protocol shall enter into force three months after four instruments of ratification, acceptance, approval or accession have been deposited, provided that at least one of those instruments has been deposited by a country party to the Madrid (Stockholm) Agreement and at least one other of those instruments has been deposited by a State not party to the Madrid (Stockholm) Agreement or by any of the organizations referred to in paragraph (1)(b).

(b) With respect to any other State or organization referred to in paragraph (1), this Protocol shall enter into force three months after the date on which its ratification, acceptance, approval or accession has been notified by the Director General.

(5) Any State or organization referred to in paragraph (1) may, when depositing its instrument of ratification, acceptance or approval of, or accession to, this Protocol, declare that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

## **Article 15**

### **Denunciation**

(1) This Protocol shall remain in force without limitation as to time.

(2) Any Contracting Party may denounce this Protocol by notification addressed to the Director General.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any Contracting Party before the expiry of five years from the date upon which this Protocol entered into force with respect to that Contracting Party.

(5) (a) Where a mark is the subject of an international registration having effect in the denouncing State or intergovernmental organization at the date on which the denunciation becomes effective, the holder of such registration may file an application for the registration of the same mark with the Office of the denouncing State or intergovernmental organization, which shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3<sup>ter</sup>(2) and, if the international registration enjoyed priority, enjoy the same priority, provided that

(i) such application is filed within two years from the date on which the denunciation became effective,

(ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the denouncing State or intergovernmental organization, and

(iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

(b) The provisions of subparagraph (a) shall also apply in respect of any mark that is the subject of an international registration having effect in Contracting Parties other than the denouncing State or intergovernmental organization at the date on which denunciation becomes effective and whose holder, because of the denunciation, is no longer entitled to file international applications under Article 2(1).

## Article 16

### **Signature; Languages; Depositary Functions**

(1) (a) This Protocol shall be signed in a single copy in the English, French and Spanish languages, and shall be deposited with the Director General when it ceases to be open for signature at Madrid. The texts in the three languages shall be equally authentic.

(b) Official texts of this Protocol shall be established by the Director General, after consultation with the interested governments and organizations, in the Arabic, Chinese, German, Italian, Japanese, Portuguese and Russian languages, and in such other languages as the Assembly may designate.

(2) This Protocol shall remain open for signature at Madrid until December 31, 1989.

(3) The Director General shall transmit two copies, certified by the Government of Spain, of the signed texts of this Protocol to all States and intergovernmental organizations that may become party to this Protocol.

(4) The Director General shall register this Protocol with the Secretariat of the United Nations.

(5) The Director General shall notify all States and international organizations that may become or are party to this Protocol of signatures, deposits of instruments of ratification, acceptance, approval or accession, the entry into force of this Protocol and any amendment thereto, any notification of denunciation and any declaration provided for in this Protocol.





**COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING  
THE INTERNATIONAL REGISTRATION OF MARKS AND  
THE PROTOCOL RELATING TO THAT AGREEMENT**

(as in force on September 1, 2009)

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## Chapter 1 General Provisions

### *Rule 1 Abbreviated Expressions*

For the purposes of these Regulations,

(i) “Agreement” means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967, and amended on September 28, 1979;

(ii) “Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;

(iii) “Contracting Party” means any country party to the Agreement or any State or intergovernmental organization party to the Protocol;

(iv) “Contracting State” means a Contracting Party that is a State;

(v) “Contracting Organization” means a Contracting Party that is an intergovernmental organization;

(vi) “international registration” means the registration of a mark effected under the Agreement or the Protocol or both, as the case may be;

(vii) “international application” means an application for international registration filed under the Agreement or the Protocol or both, as the case may be;

(viii) “international application governed exclusively by the Agreement” means an international application whose Office of origin is the Office

– of a State bound by the Agreement but not by the Protocol, or

– of a State bound by both the Agreement and the Protocol, where only States are designated in the international application and all the designated States are bound by the Agreement but not by the Protocol;

(ix) “international application governed exclusively by the Protocol” means an international application whose Office of origin is the Office

– of a State bound by the Protocol but not by the Agreement, or

– of a Contracting Organization, or

– of a State bound by both the Agreement and the Protocol, where the international application does not contain the designation of any State bound by the Agreement but not by the Protocol;

(x) “international application governed by both the Agreement and the Protocol” means an international application whose Office of origin is the Office of a State bound by both the Agreement and the Protocol and which is based on a registration and contains the designations

– of at least one State bound by the Agreement but not by the Protocol, and

– of at least one State bound by the Protocol, whether or not that State is also bound by the Agreement or of at least one Contracting Organization;

(xi) “applicant” means the natural person or legal entity in whose name the international application is filed;

(xii) “legal entity” means a corporation, association or other group or organization which, under the law applicable to it, is capable of acquiring rights, assuming obligations and suing or being sued in a court of law;

(xiii) “basic application” means the application for the registration of a mark that has been filed with the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

(xiv) “basic registration” means the registration of a mark that has been effected by the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

(xv) “designation” means the request for extension of protection (“territorial extension”) under Article 3*ter*(1) or (2) of the Agreement or under Article 3*ter*(1) or (2) of the Protocol, as the case may be; it also means such extension as recorded in the International Register;

(xvi) “designated Contracting Party” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3*ter*(1) or (2) of the Agreement or under Article 3*ter*(1) or (2) of the Protocol, as the case may be, or in respect of which such extension has been recorded in the International Register;

(xvii) “Contracting Party designated under the Agreement” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3*ter*(1) or (2) of the Agreement;

(xviii) “Contracting Party designated under the Protocol” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3*ter*(1) or (2) of the Protocol;

(xix) “notification of provisional refusal” means a declaration by the Office of a designated Contracting Party, in accordance with Article 5(1) of the Agreement or Article 5(1) of the Protocol;

(xix*bis*) “invalidation” means a decision by the competent authority (whether administrative or judicial) of a designated Contracting Party revoking or cancelling the effects, in the territory of that Contracting Party, of an international registration with regard to all or some of the goods or services covered by the designation of the said Contracting Party;

(xx) “Gazette” means the periodical gazette referred to in Rule 32;

(xxi) “holder” means the natural person or legal entity in whose name the international registration is recorded in the International Register;

(xxii) “International Classification of Figurative Elements” means the Classification established by the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks of June 12, 1973;

(xxiii) “International Classification of Goods and Services” means the Classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977;

(xxiv) “International Register” means the official collection of data concerning international registrations maintained by the International Bureau, which data the Agreement, the Protocol or the Regulations require or permit to be recorded, irrespective of the medium in which such data are stored;

(xxv) “Office” means the Office of a Contracting Party in charge of the registration of marks, or the common Office referred to in Article 9*quater* of the Agreement or Article 9*quater* of the Protocol, or both, as the case may be;

(xxvi) “Office of origin” means the Office of the country of origin defined in Article 1(3) of the Agreement or the Office of origin defined in Article 2(2) of the Protocol, or both, as the case may be;

(xxvi*bis*) “Contracting Party of the holder” means

- the Contracting Party whose Office is the Office of origin, or
- where a change of ownership has been recorded or in the case of State succession, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfills the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration;

(xxvii) “official form” means a form established by the International Bureau or any form having the same contents and format;

(xxviii) “prescribed fee” means the applicable fee set out in the Schedule of Fees;

(xxix) “Director General” means the Director General of the World Intellectual Property Organization;

(xxx) “International Bureau” means the International Bureau of the World Intellectual Property Organization.

(xxxi) “Administrative Instructions” means the Administrative Instructions referred to in Rule 41.

### *Rule 1bis*

#### *Designations Governed by the Agreement and Designations Governed by the Protocol*

(1) *[General Principle and Exceptions]* The designation of a Contracting Party shall be governed by the Agreement or by the Protocol depending on whether the Contracting Party has been designated under the Agreement or under the Protocol. However,

(i) where, with regard to a given international registration, the Agreement ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Agreement, the designation of the latter shall become governed by the Protocol as of the date on which the Agreement so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Protocol, and

(ii) where, with regard to a given international registration, the Protocol ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Protocol, the designation of the latter shall become governed by the Agreement as of the date on which the Protocol so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Agreement.

(2) *[Recording]* The international Bureau shall record in the International Register an indication of the treaty governing each designation.

### *Rule 2*

#### *Communication with the International Bureau*

Communications addressed to the International Bureau shall be effected as specified in the Administrative Instructions.

### *Rule 3*

#### *Representation Before the International Bureau*

(1) *[Representative; Number of Representatives]* (a) The applicant or the holder may have a representative before the International Bureau.

(b) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.

(c) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.

(2) *[Appointment of the Representative]* (a) The appointment of a representative may be made in the international application, or in a subsequent designation or a request under Rule 25.

(b) The appointment of a representative may also be made in a separate communication which may relate to one or more specified international applications or international registrations of the same applicant or holder. The said communication shall be presented to the International Bureau

(i) by the applicant, the holder or the appointed representative, or

(ii) by the Office of the Contracting Party of the holder.

The communication shall be signed by the applicant or the holder, or by the Office through which it was presented.

(3) *[Irregular Appointment]* (a) Where the International Bureau considers that the appointment of a representative under paragraph (2) is irregular, it shall notify accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.

(b) As long as the relevant requirements under paragraph (2) are not complied with, the International Bureau shall send all relevant communications to the applicant or holder himself.

(4) *[Recording and Notification of Appointment of a Representative; Effective Date of Appointment]* (a) Where the International Bureau finds that the appointment of a representative complies with the applicable requirements, it shall record the fact that the applicant or holder has a representative, as well as the name and address of the representative, in the International Register. In such a case, the effective date of the appointment shall be the date on which the International Bureau received the international application, subsequent designation, request or separate communication in which the representative is appointed.

(b) The International Bureau shall notify the recording referred to in subparagraph (a) to both the applicant or holder and the representative. Where the appointment was made in a separate communication presented through an Office, the International Bureau shall also notify the recording to that Office.

(5) *[Effect of Appointment of a Representative]* (a) Except where these Regulations expressly provide otherwise, the signature of a representative recorded under paragraph (4)(a) shall replace the signature of the applicant or holder.

(b) Except where these Regulations expressly require that an invitation, notification or other communication be addressed to both the applicant or holder and the representative, the International Bureau shall address to the representative recorded under paragraph (4)(a) any invitation, notification or other communication which, in the absence of a representative, would have to be sent to the applicant or holder; any invitation, notification or other communication so addressed to the said representative shall have the same effect as if it had been addressed to the applicant or holder.

(c) Any communication addressed to the International Bureau by the representative recorded under paragraph (4)(a) shall have the same effect as if it had been addressed to the said Bureau by the applicant or holder.

(6) *[Cancellation of Recording; Effective Date of Cancellation]* (a) Any recording under paragraph (4)(a) shall be cancelled where cancellation is requested in a communication signed by the applicant, holder or representative. The recording shall be cancelled *ex officio* by the International Bureau where a new representative is appointed or, in case a change in ownership has been recorded, where no representative is appointed by the new holder of the international registration.

(b) Subject to subparagraph (c), the cancellation shall be effective from the date on which the International Bureau receives the corresponding communication.

(c) Where the cancellation is requested by the representative, it shall be effective from the earlier of the following:

(i) the date on which the International Bureau receives a communication appointing a new representative;

(ii) the date of the expiry of a period of two months counted from the receipt of the request of the representative that the recording be cancelled.

Until the effective date of the cancellation, all communications referred to in paragraph (5)(b) shall be addressed by the International Bureau to both the applicant or holder and the representative.

(d) The International Bureau shall, upon receipt of a request for cancellation made by the representative, notify accordingly the applicant or holder, and add to the notification copies of all communications sent to the representative, or received by the International Bureau from the representative, during the six months preceding the date of the notification.

(e) The International Bureau shall, once the effective date of the cancellation is known, notify the cancellation and its effective date to the representative whose recording has been cancelled, to the applicant or holder and, where the appointment of the representative had been presented through an Office, to that Office.

#### *Rule 4*

##### *Calculation of Time Limits*

(1) *[Periods Expressed in Years]* Any period expressed in years shall expire, in the relevant subsequent year, in the month having the same name and on the day having the same number as the month and the day of the event from which the period starts to run, except that, where the event occurred on February 29 and in the relevant subsequent year February ends on the 28th, the period shall expire on February 28.

(2) *[Periods Expressed in Months]* Any period expressed in months shall expire, in the relevant subsequent month, on the day which has the same number as the day of the event from which the period starts to run, except that, where the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month.

(3) *[Periods Expressed in Days]* The calculation of any period expressed in days shall start with the day following the day on which the relevant event occurred and shall expire accordingly.

(4) *[Expiry on a Day on Which the International Bureau or an Office Is Not Open to the Public]* If a period expires on a day on which the International Bureau or the Office concerned is not open to the public, the period shall, notwithstanding paragraphs (1) to (3), expire on the first subsequent day on which the International Bureau or the Office concerned is open to the public.

(5) *[Indication of the Date of Expiry]* The International Bureau shall, in all cases in which it communicates a time limit, indicate the date of the expiry, according to paragraphs (1) to (3), of the said time limit.

#### *Rule 5*

##### *Irregularities in Postal and Delivery Services*

(1) *[Communications Sent Through a Postal Service]* Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and mailed through a postal service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,

(i) that the communication was mailed at least five days prior to the expiry of the time limit, or, where the postal service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed not later than five days after postal service was resumed,

(ii) that the mailing of the communication was registered, or details of the mailing were recorded, by the postal service at the time of mailing, and

(iii) in cases where all classes of mail do not normally reach the International Bureau within two days of mailing, that the communication was mailed by a class of mail which normally reaches the International Bureau within two days of mailing or by airmail.

(2) *[Communications Sent Through a Delivery Service]* Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and sent through a delivery service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,

(i) that the communication was sent at least five days prior to the expiry of the time limit, or, where the delivery service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was sent not later than five days after the delivery service was resumed, and

(ii) that details of the sending of the communication were recorded by the delivery service at the time of sending.

(3) *[Limitation on Excuse]* Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1) or (2) and the communication or a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.

(4) *[International Application and Subsequent Designation]* Where the International Bureau receives an international application or a subsequent designation beyond the two-month period referred to in Article 3(4) of the Agreement, in Article 3(4) of the Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1) or (2), paragraph (1) or (2) and paragraph (3) shall apply.



*Rule 6*  
*Languages*

(1) *[International Application]* The international application shall be in English, French or Spanish according to what is prescribed by the Office of origin, it being understood that the Office of origin may allow applicants to choose between English, French and Spanish.

(2) *[Communications Other Than the International Application]* Any communication concerning an international application or an international registration shall, subject to Rule 17(2)(v) and (3), be

(i) in English, French or Spanish where such communication is addressed to the International Bureau by the applicant or holder, or by an Office;

(ii) in the language applicable under Rule 7(2) where the communication consists of the declaration of intention to use the mark annexed to the international application under Rule 9(5)(f) or to the subsequent designation under Rule 24(3)(b)(i);

(iii) in the language of the international application where the communication is a notification addressed by the International Bureau to an Office, unless that Office has notified the International Bureau that all such notifications are to be in English, or are to be in French or are to be in Spanish; where the notification addressed by the International Bureau concerns the recording in the International Register of an international registration, the notification shall indicate the language in which the relevant international application was received by the International Bureau;

(iv) in the language of the international application where the communication is a notification addressed by the International Bureau to the applicant or holder, unless that applicant or holder has expressed the wish that all such notifications be in English, or be in French or be in Spanish.

(3) *[Recording and Publication]* (a) The recording in the International Register and the publication in the Gazette of the international registration and of any data to be both recorded and published under these Regulations in respect of the international registration shall be in English, French and Spanish. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

(b) Where a first subsequent designation is made in respect of an international registration that, under previous versions of this Rule, has been published only in French, or only in English and French, the International Bureau shall, together with the publication in the Gazette of that subsequent designation, either publish the international registration in English and Spanish and republish the international registration in French, or publish the international registration in Spanish and republish it in English and French, as the case may be. That subsequent designation shall be recorded in the International Register in English, French and Spanish.

(4) *[Translation]* (a) The translations needed for the notifications under paragraph (2)(iii) and (iv), and recordings and publications under paragraph (3), shall be made by the International Bureau. The applicant or the holder, as the case may be, may annex to the international application, or to a request for the recording of a subsequent designation or of a change, a proposed translation of any text matter contained in the international application or the request. If the proposed translation is not considered by the International Bureau to be correct, it shall be corrected by the International Bureau after having invited the applicant or the holder to make, within one month from the invitation, observations on the proposed corrections.

(b) Notwithstanding subparagraph (a), the International Bureau shall not translate the mark. Where, in accordance with Rule 9(4)(b)(iii) or Rule 24(3)(c), the applicant or the holder gives a translation or translations of the mark, the International Bureau shall not check the correctness of any such translations.

*Rule 7*

*Notification of Certain Special Requirements*

(1) [Deleted]

(2) *[Intention to Use the Mark]* Where a Contracting Party requires, as a Contracting Party designated under the Protocol, a declaration of intention to use the mark, it shall notify that requirement to the Director General. Where that Contracting Party requires the declaration to be signed by the applicant himself and to be made on a separate official form annexed to the international application, the notification shall contain a statement to that effect and shall specify the exact wording of the required declaration. Where the Contracting Party further requires the declaration to be in English, French or Spanish, the notification shall specify the required language.

(3) *[Notification]* (a) Any notification referred to in paragraph (2) may be made at the time of the deposit by the Contracting Party of its instrument of ratification, acceptance or approval of, or accession to, the Protocol, and the effective date of the notification shall be the same as the date of entry into force of the Protocol with respect to the Contracting Party having made the notification. The notification may also be made later, in which case the notification shall have effect three months after its receipt by the Director General, or at any later date indicated in the notification, in respect of any international registration whose date is the same as or is later than the effective date of the notification.

(b) Any notification made under paragraph (1), as in force before October 4, 2001<sup>1</sup>, or paragraph (2) may be withdrawn at any time. The notice of withdrawal shall be addressed to the Director General. The withdrawal shall have effect upon receipt of the notice of withdrawal by the Director General or at any later date indicated in the notice.

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<sup>1</sup> Paragraph (1) of Rule 7 read:

“Where a Contracting Party requires that, where its Office is the Office of origin and the holder’s address is in the territory of that Contracting Party, designations made subsequently to the international registration be presented to the International Bureau by the said Office, it shall notify that requirement to the Director General.”

## Chapter 2 International Applications

### *Rule 8 Several Applicants*

(1) *[Two or More Applicants Applying Exclusively Under the Agreement or Applying Under Both the Agreement and the Protocol]* Two or more applicants may jointly file an international application governed exclusively by the Agreement or governed by both the Agreement and the Protocol if the basic registration is jointly owned by them and if the country of origin, as defined in Article 1(3) of the Agreement, is the same for each of them.

(2) *[Two or More Applicants Applying Exclusively Under the Protocol]* Two or more applicants may jointly file an international application governed exclusively by the Protocol if the basic application was jointly filed by them or the basic registration is jointly owned by them, and if each of them qualifies, in relation to the Contracting Party whose Office is the Office of origin, for filing an international application under Article 2(1) of the Protocol.

### *Rule 9 Requirements Concerning the International Application*

(1) *[Presentation]* The international application shall be presented to the International Bureau by the Office of origin.

(2) *[Form and Signature]* (a) The international application shall be presented on the official form in one copy.

(b) The international application shall be signed by the Office of origin and, where the Office of origin so requires, also by the applicant. Where the Office of origin does not require the applicant to sign the international application but allows that the applicant also sign it, the applicant may do so.

(3) *[Fees]* The prescribed fees applicable to the international application shall be paid as provided for in Rules 10, 34 and 35.

(4) *[Contents of the International Application]* (a) The international application shall contain or indicate

(i) the name of the applicant, given in accordance with the Administrative Instructions,

(ii) the address of the applicant, given in accordance with the Administrative Instructions,

(iii) the name and address of the representative, if any, given in accordance with the Administrative Instructions,

(iv) where the applicant wishes, under the Paris Convention for the Protection of Industrial Property, to take advantage of the priority of an earlier filing, a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and, where the earlier filing relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the earlier filing relates,

(v) a reproduction of the mark that shall fit in the box provided on the official form; that reproduction shall be clear and shall, depending on whether the reproduction in the basic application or the basic registration is in black and white or in color, be in black and white or in color,

(vi) where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect,

(vii) where color is claimed as a distinctive feature of the mark in the basic application or basic registration, or where the applicant wishes to claim color as a distinctive feature of the mark and the mark contained in the basic application or basic registration is in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,

(vii*bis*) where the mark that is the subject of the basic application or the basic registration consists of a color or a combination of colors as such, an indication to that effect,

(viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication “three-dimensional mark,”

(ix) where the basic application or the basic registration relates to a sound mark, the indication “sound mark,”

(x) where the basic application or the basic registration relates to a collective mark or a certification mark or a guarantee mark, an indication to that effect,

(xi) where the basic application or the basic registration contains a description of the mark by words and the applicant wishes to include the description or the Office of origin requires the inclusion of the description, that same description; where the said description is in a language other than the language of the international application, it shall be given in the language of the international application,

(xii) where the mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals; the transliteration into Latin characters shall follow the phonetics of the language of the international application,

(xiii) the names of the goods and services for which the international registration of the mark is sought, grouped in the appropriate classes of the International Classification of Goods and Services, each group preceded by the number of the class and presented in the order of the classes of that Classification; the goods and services shall be indicated in precise terms, preferably using the words appearing in the Alphabetical List of the said Classification; the international application may contain limitations of the list of goods and services in respect of one or more designated Contracting Parties; the limitation in respect of each Contracting Party may be different,

(xiv) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and

(xv) the designated Contracting Parties.

(b) The international application may also contain,

(i) where the applicant is a natural person, an indication of the State of which the applicant is a national;

(ii) where the applicant is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into English, French and Spanish, or in any one or two of those languages;

(iv) where the applicant claims color as a distinctive feature of the mark, an indication by words, in respect of each color, of the principal parts of the mark which are in that color;

(v) where the applicant wishes to disclaim protection for any element of the mark, an indication of that fact and of the element or elements for which protection is disclaimed.

(5) [*Additional Contents of an International Application*] (a) An international application governed exclusively by the Agreement or by both the Agreement and the Protocol shall contain the number and date of the basic registration and shall indicate one of the following:

(i) that the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting State whose Office is the Office of origin, or

(ii) where the applicant has no such establishment in any Contracting State of the Agreement, that he has a domicile in the territory of the State whose Office is the Office of origin, or

(iii) where the applicant has no such establishment or domicile in the territory of any Contracting State of the Agreement, that he is a national of the State whose Office is the Office of origin.

(b) An international application governed exclusively by the Protocol shall contain the number and date of the basic application or basic registration and shall indicate one or more of the following:

(i) where the Contracting Party whose Office is the Office of origin is a State, that the applicant is a national of that State;

(ii) where the Contracting Party whose Office is the Office of origin is an organization, the name of the Member State of that organization of which the applicant is a national;

(iii) that the applicant has a domicile in the territory of the Contracting Party whose Office is the Office of origin;

(iv) that the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party whose Office is the Office of origin.

(c) Where the address of the applicant given in accordance with paragraph (4)(a)(ii) is not in the territory of the Contracting Party whose Office is the Office of origin and it has been indicated under subparagraph (a)(i) or (ii) or subparagraph (b)(iii) or (iv) that the applicant has a domicile or an establishment in the territory of that Contracting Party, that domicile or the address of that establishment shall be given in the international application.

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

(i) the date on which the Office of origin received or, as provided for in Rule 11(1), is deemed to have received the request by the applicant to present the international application to the International Bureau,

(ii) that the applicant named in the international application is the same as the applicant named in the basic application or the holder named in the basic registration, as the case may be,

(iii) that any indication referred to in paragraph (4)(a)(vii*bis*) to (xi) and appearing in the international application appears also in the basic application or the basic registration, as the case may be,

(iv) that the mark that is the subject matter of the international application is the same as in the basic application or the basic registration, as the case may be,

(v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and

(vi) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

(e) Where the international application is based on two or more basic applications or basic registrations, the declaration referred to in subparagraph (d) shall be deemed to apply to all those basic applications or basic registrations.

(f) Where the international application contains the designation of a Contracting Party that has made a notification under Rule 7(2), the international application shall also contain a declaration of intention to use the mark in the territory of that Contracting Party; the declaration shall be considered part of the designation of the Contracting Party requiring it and shall, as required by that Contracting Party,

(i) be signed by the applicant himself and be made on a separate official form annexed to the international application, or

(ii) be included in the international application.

(g) Where an international application contains the designation of a Contracting Organization, it may also contain the following indications:

(i) where the applicant wishes to claim, under the law of that Contracting Organization, the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, a declaration to that effect, stating 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. Such indications shall be on an official form to be annexed to the international application;

(ii) where, under the law of that Contracting Organization, the applicant is required to indicate a second working language before the Office of that Contracting Organization, in addition to the language of the international application, an indication of that second language.

#### *Rule 10*

##### *Fees Concerning the International Application*

(1) *[International Applications Governed Exclusively by the Agreement]* An international application governed exclusively by the Agreement shall be subject to the payment of the basic fee, the complementary fee and, where applicable, the supplementary fee, specified in item 1 of the Schedule of Fees. Those fees shall be paid in two instalments of ten years each. For the payment of the second instalment, Rule 30 shall apply.

(2) *[International Applications Governed Exclusively by the Protocol]* An international application governed exclusively by the Protocol shall be subject to the payment of the basic fee, the complementary fee and/or the individual fee and, where applicable, the supplementary fee, specified or referred to in item 2 of the Schedule of Fees. Those fees shall be paid for ten years.

(3) *[International Applications Governed by Both the Agreement and the Protocol]* An international application governed by both the Agreement and the Protocol shall be subject to the payment of the basic fee, the complementary fee and, where applicable, the individual fee and the supplementary fee, specified or referred to in item 3 of the Schedule of Fees. As far as the Contracting Parties designated under the Agreement are concerned, paragraph (1) shall apply. As far as the Contracting Parties designated under the Protocol are concerned, paragraph (2) shall apply.

*Rule 11*  
*Irregularities Other Than Those Concerning*  
*the Classification of Goods and Services*  
*or Their Indication*

(1) *[Premature Request to the Office of Origin]* (a) Where the Office of origin received a request to present to the International Bureau an international application governed exclusively by the Agreement before the mark which is referred to in that request is registered in the register of the said Office, the said request shall be deemed to have been received by the Office of origin, for the purposes of Article 3(4) of the Agreement, on the date of the registration of the mark in the register of the said Office.

(b) Subject to subparagraph (c), where the Office of origin receives a request to present to the International Bureau an international application governed by both the Agreement and the Protocol before the mark which is referred to in that request is registered in the register of the said Office, the international application shall be treated as an international application governed exclusively by the Protocol, and the Office of origin shall delete the designation of any Contracting Party bound by the Agreement but not by the Protocol.

(c) Where the request referred to in subparagraph (b) is accompanied by an express request that the international application be treated as an international application governed by both the Agreement and the Protocol once the mark is registered in the register of the Office of origin, the said Office shall not delete the designation of any Contracting Party bound by the Agreement but not by the Protocol and the request to present the international application shall be deemed to have been received by the said Office, for the purposes of Article 3(4) of the Agreement and Article 3(4) of the Protocol, on the date of the registration of the mark in the register of the said Office.

(2) *[Irregularities to Be Remedied by the Applicant]* (a) If the International Bureau considers that the international application contains irregularities other than those referred to in paragraphs (3), (4) and (6) and in Rules 12 and 13, it shall notify the applicant of the irregularity and at the same time inform the Office of origin.

(b) Such irregularities may be remedied by the applicant within three months from the date of the notification of the irregularity by the International Bureau. If an irregularity is not remedied within three months from the date of the notification of that irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the applicant and the Office of origin.

(3) *[Irregularity to Be Remedied by the Applicant or by the Office of Origin]* (a) Notwithstanding paragraph (2), where the fees payable under Rule 10 have been paid to the International Bureau by the Office of origin and the International Bureau considers that the amount of the fees received is less than the amount required, it shall notify at the same time the Office of origin and the applicant. The notification shall specify the missing amount.

(b) The missing amount may be paid by the Office of origin or by the applicant within three months from the date of the notification by the International Bureau. If the missing amount is not paid within three months from the date of the notification of the irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the Office of origin and the applicant.

(4) *[Irregularities to Be Remedied by the Office of Origin]* (a) If the International Bureau

(i) finds that the international application does not fulfill the requirements of Rule 2 or was not presented on the official form prescribed under Rule 9(2)(a),

(ii) finds that the international application contains any of the irregularities referred to in Rule 15(1),

(iii) considers that the international application contains irregularities relating to the entitlement of the applicant to file an international application,

(iv) considers that the international application contains irregularities relating to the declaration by the Office of origin referred to in Rule 9(5)(d),

(v) *[Deleted]*

(vi) finds that the international application is not signed by the Office of origin,  
or

(vii) finds that the international application does not contain the date and number of the basic application or basic registration, as the case may be, it shall notify the Office of origin and at the same time inform the applicant.

(b) Such irregularities may be remedied by the Office of origin within three months from the date of notification of the irregularity by the International Bureau. If an irregularity is not remedied within three months from the date of the notification of that irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the Office of origin and the applicant.

(5) *[Reimbursement of Fees]* Where, in accordance with paragraphs (2)(b), (3) or (4)(b), the international application is considered abandoned, the International Bureau shall refund any fees paid in respect of that application, after deduction of an amount corresponding to one-half of the basic fee referred to in items 1.1.1, 2.1.1 or 3.1.1 of the Schedule of Fees, to the party having paid those fees.

(6) *[Other Irregularity With Respect to the Designation of a Contracting Party Under the Protocol]* (a) Where, in accordance with Article 3(4) of the Protocol, an international application is received by the International Bureau within a period of two months from the date of receipt of that international application by the Office of origin and the International Bureau considers that a declaration of intention to use the mark is required according to Rule 9(5)(f) but is missing or does not comply with the applicable requirements, the International Bureau shall promptly notify accordingly and at the same time the applicant and the Office of origin.

(b) The declaration of intention to use the mark shall be deemed to have been received by the International Bureau together with the international application if the missing or corrected declaration is received by the International Bureau within the period of two months referred to in subparagraph (a).

(c) The international application shall be deemed not to contain the designation of the Contracting Party for which a declaration of intention to use the mark is required if the missing or corrected declaration is received after the period of two months referred to in subparagraph (b). The International Bureau shall notify accordingly and at the same time the applicant and the Office of origin, reimburse any designation fee already paid in respect of that



Contracting Party and indicate that the designation of the said Contracting Party may be effected as a subsequent designation under Rule 24, provided that such designation is accompanied by the required declaration.

(7) *[International Application Not Considered as Such]* If the international application is presented direct to the International Bureau by the applicant or does not comply with the requirement applicable under Rule 6(1), the international application shall not be considered as such and shall be returned to the sender.

*Rule 12*  
*Irregularities With Respect to the*  
*Classification of Goods and Services*

(1) *[Proposal for Classification]* (a) If the International Bureau considers that the requirements of Rule 9(4)(a)(xiii) are not complied with, it shall make a proposal of its own for the classification and grouping and shall send a notification of its proposal to the Office of origin and at the same time inform the applicant.

(b) The notification of the proposal shall also state the amount, if any, of the fees due as a consequence of the proposed classification and grouping.

(2) *[Opinion Differing From the Proposal]* The Office of origin may communicate to the International Bureau an opinion on the proposed classification and grouping within three months from the date of the notification of the proposal.

(3) *[Reminder of the Proposal]* If, within two months from the date of the notification referred to in paragraph (1)(a), the Office of origin has not communicated an opinion on the proposed classification and grouping, the International Bureau shall send to the Office of origin and to the applicant a communication reiterating the proposal. The sending of such a communication shall not affect the three-month period referred to in paragraph (2).

(4) *[Withdrawal of Proposal]* If, in the light of the opinion communicated under paragraph (2), the International Bureau withdraws its proposal, it shall notify the Office of origin accordingly and at the same time inform the applicant.

(5) *[Modification of Proposal]* If, in the light of the opinion communicated under paragraph (2), the International Bureau modifies its proposal, it shall notify the Office of origin and at the same time inform the applicant of such modification and of any consequent changes in the amount indicated under paragraph (1)(b).

(6) *[Confirmation of Proposal]* If, notwithstanding the opinion referred to in paragraph (2), the International Bureau confirms its proposal, it shall notify the Office of origin accordingly and at the same time inform the applicant.

(7) *[Fees]* (a) If no opinion has been communicated to the International Bureau under paragraph (2), the amount referred to in paragraph (1)(b) shall be payable within four months from the date of the notification referred to in paragraph (1)(a), failing which the international application shall be considered abandoned and the International Bureau shall notify the Office of origin accordingly and at the same time inform the applicant.

(b) If an opinion has been communicated to the International Bureau under paragraph (2), the amount referred to in paragraph (1)(b) or, where applicable, paragraph (5) shall be payable within three months from the date of the communication by the International Bureau of the modification or confirmation of its proposal under paragraph (5) or (6), as the case may be, failing which the international application shall be considered abandoned and the International Bureau shall notify the Office of origin accordingly and at the same time inform the applicant.

(c) If an opinion has been communicated to the International Bureau under paragraph (2) and if, in the light of that opinion, the International Bureau withdraws its proposal in accordance with paragraph (4), the amount referred to in paragraph (1)(b) shall not be due.

(8) [*Reimbursement of Fees*] Where, in accordance with paragraph (7), the international application is considered abandoned, the International Bureau shall refund any fees paid in respect of that application, after deduction of an amount corresponding to one-half of the basic fee referred to in items 1.1.1, 2.1.1 or 3.1.1 of the Schedule of Fees, to the party having paid those fees.

(9) [*Classification in the Registration*] Subject to the conformity of the international application with the other applicable requirements, the mark shall be registered with the classification and grouping that the International Bureau considers to be correct.

### *Rule 13*

#### *Irregularities With Respect to the Indication of Goods and Services*

(1) [*Communication of Irregularity by the International Bureau to the Office of Origin*] If the International Bureau considers that any of the goods and services is indicated in the international application by a term that is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect, it shall notify the Office of origin accordingly and at the same time inform the applicant. In the same notification, the International Bureau may suggest a substitute term, or the deletion of the term.

(2) [*Time Allowed to Remedy Irregularity*] (a) The Office of origin may make a proposal for remedying the irregularity within three months from the date of the notification referred to in paragraph (1).

(b) If no proposal acceptable to the International Bureau for remedying the irregularity is made within the period indicated in subparagraph (a), the International Bureau shall include in the international registration the term as appearing in the international application, provided that the Office of origin has specified the class in which such term should be classified; the international registration shall contain an indication to the effect that, in the opinion of the International Bureau, the specified term is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect, as the case may be. Where no class has been specified by the Office of origin, the International Bureau shall delete the said term *ex officio* and shall notify the Office of origin accordingly and at the same time inform the applicant.

### Chapter 3 International Registrations

#### *Rule 14*

#### *Registration of the Mark in the International Register*

(1) [*Registration of the Mark in the International Register*] Where the International Bureau finds that the international application conforms to the applicable requirements, it shall register the mark in the International Register, notify the Offices of the designated Contracting Parties of the international registration and inform the Office of origin accordingly, and send a certificate to the holder. Where the Office of origin so wishes and has informed the International Bureau accordingly, the certificate shall be sent to the holder through the Office of origin.

- (2) [*Contents of the Registration*] The international registration shall contain
- (i) all the data contained in the international application, except any priority claim under Rule 9(4)(a)(iv) where the date of the earlier filing is more than six months before the date of the international registration,
  - (ii) the date of the international registration,
  - (iii) the number of the international registration,
  - (iv) where the mark can be classified according to the International Classification of Figurative Elements, and unless the international application contains a declaration to the effect that the applicant wishes that the mark be considered as a mark in standard characters, the relevant classification symbols of the said Classification as determined by the International Bureau,
  - (v) an indication, with respect to each designated Contracting Party, as to whether it is a Contracting Party designated under the Agreement or a Contracting Party designated under the Protocol.
  - (vi) indications annexed to the international application in accordance with Rule 9(5)(g)(i) concerning the Member State or Member States in or for which an earlier mark, for which seniority is claimed, is registered, the date from which the registration of that earlier mark was effective and the number of the relevant registration.

#### *Rule 15*

#### *Date of the International Registration*

(1) [*Irregularities Affecting the Date of the International Registration*] Where the international application received by the International Bureau does not contain all of the following elements:

- (i) indications allowing the identity of the applicant to be established and sufficient to contact the applicant or his representative, if any,
- (ii) the Contracting Parties which are designated,
- (iii) a reproduction of the mark,
- (iv) the indication of the goods and services for which registration of the mark is sought, the international registration shall bear the date on which the last of the missing elements reached the International Bureau, provided that, where the last of the missing elements reaches the International Bureau within the two-month time limit referred to in Article 3(4) of the Agreement and Article 3(4) of the Protocol, the international registration shall bear the date on which the defective international application was received or, as provided in Rule 11(1), is deemed to have been received by the Office of origin.

(2) *[Date of the International Registration in Other Cases]* In any other case, the international registration shall bear the date determined in accordance with Article 3(4) of the Agreement and Article 3(4) of the Protocol.

**Chapter 4**  
**Facts in Contracting Parties**  
**Affecting International Registrations**

*Rule 16*

*Possibility of Notification of a Provisional Refusal Based on an Opposition  
Under Article 5(2)(c) of the Protocol*

(1) *[Information Relating to Possible Oppositions and Time Limit for Notifying Provisional Refusal Based on an Opposition]* (a) Subject to Article 9*sexies*(1)(b) of the Protocol, where a declaration has been made by a Contracting Party pursuant to Article 5(2)(b) and (c), first sentence, of the Protocol, the Office of that Contracting Party shall, where it has become apparent with regard to a given international registration designating that Contracting Party that the opposition period will expire too late for any provisional refusal based on an opposition to be notified to the International Bureau within the 18-month time limit referred to in Article 5(2)(b), inform the International Bureau of the number, and the name of the holder, of that international registration.

(b) Where, at the time of the communication of the information referred to in subparagraph (a), the dates on which the opposition period begins and ends are known, those dates shall be indicated in the communication. If such dates are not yet known at that time, they shall be communicated to the International Bureau as soon as they are known<sup>2</sup>.

(c) Where subparagraph (a) applies and the Office referred to in the said subparagraph has, before the expiry of the 18-month time limit referred to in the same subparagraph, informed the International Bureau of the fact that the time limit for filing oppositions will expire within the 30 days preceding the expiry of the 18-month time limit and of the possibility that oppositions may be filed during those 30 days, a provisional refusal based on an opposition filed during the said 30 days may be notified to the International Bureau within one month from the date of filing of the opposition.

(2) *[Recording and Transmittal of the Information]* The International Bureau shall record in the International Register the information received under paragraph (1) and shall transmit that information to the holder.

*Rule 17*

*Provisional Refusal*

(1) *[Notification of Provisional Refusal]* (a) A notification of provisional refusal may comprise a declaration stating the grounds on which the Office making the notification considers that protection cannot be granted in the Contracting Party concerned (“*ex officio* provisional refusal”) or a declaration that protection cannot be granted in the Contracting Party concerned because an opposition has been filed (“provisional refusal based on an opposition”) or both.

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<sup>2</sup> In adopting this provision, the Assembly of the Madrid Union understood that if the opposition period is extendable, the Office may communicate only the date the opposition period begins.

(b) A notification of provisional refusal shall relate to one international registration, shall be dated and shall be signed by the Office making it.

(2) [*Content of the Notification*] A notification of provisional refusal shall contain or indicate

- (i) the Office making the notification,
- (ii) the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number,
- (iii) [Deleted]
- (iv) all the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law,
- (v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a reproduction, of the former mark, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,
- (vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are affected, or are not affected, by the provisional refusal,
- (vii) the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires, and the authority with which such request for review, appeal or response should be filed, with the indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

(3) [*Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition*] Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name and address of the opponent; however, notwithstanding paragraph (2)(v), the Office making the notification must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.

(4) *[Recording; Transmittal of Copies of Notifications]* The International Bureau shall record the provisional refusal in the International Register together with the data contained in the notification, with an indication of the date on which the notification was sent or is regarded under Rule 18(1)(d) as having been sent to the International Bureau and shall transmit a copy thereof to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies, and, at the same time, to the holder.

(5) *[Declarations Relating to the Possibility of Review]* (a) [Deleted]

(b) [Deleted]

(c) [Deleted]

(d) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party,

(i) any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such review has been requested by the holder, and

(ii) the decision taken on the said review may be the subject of a further review or appeal before the Office.

Where this declaration applies and the Office is not in a position to communicate the said decision directly to the holder of the international registration concerned, the Office shall, notwithstanding the fact that all procedures before the said Office relating to the protection of the mark may not have been completed, send the statement referred to in Rule 18ter(2) or (3) to the International Bureau immediately following the said decision. Any further decision affecting the protection of the mark shall be sent to the International Bureau in accordance with Rule 18ter(4).

(e) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party, any *ex officio* provisional refusal that has been notified to the International Bureau is not open to review before the said Office. Where this declaration applies, any *ex officio* notification of a provisional refusal by the said Office shall be deemed to include a statement in accordance with Rule 18ter(2)(ii) or (3).

## Rule 18

### *Irregular Notifications of Provisional Refusal*

(1) *[Contracting Party Designated Under the Agreement]* (a) A notification of provisional refusal communicated by the Office of a Contracting Party designated under the Agreement shall not be regarded as such by the International Bureau

(i) if it does not contain any international registration number, unless other indications contained in the notification permit the international registration to which the provisional refusal relates to be identified,

(ii) if it does not indicate any grounds for refusal, or

(iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of one year from the date on which the recording of the international registration or the recording of the designation made subsequently to the international registration has been effected, it being understood that the said date is the same as the date of sending the notification of the international registration or of the designation made subsequently.

(b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

(c) If the notification

(i) is not signed on behalf of the Office which communicated it, or does not otherwise comply with the requirements of Rule 2 or with the requirement applicable under Rule 6(2),

(ii) does not contain, where applicable, the details of the mark with which the mark that is the subject of the international registration appears to be in conflict (Rule 17(2)(v) and (3)),

(iii) does not comply with the requirements of Rule 17(2)(vi),

(iv) does not comply with the requirements of Rule 17(2)(vii), or

(v) [Deleted]

(vi) does not contain, where applicable, the name and address of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)), the International Bureau shall, except where subparagraph (d) applies, nonetheless record the provisional refusal in the International Register. The International Bureau shall invite the Office that communicated the provisional refusal to send a rectified notification within two months from the invitation and shall transmit to the holder copies of the irregular notification and of the invitation sent to the Office concerned.

(d) Where the notification does not comply with the requirements of Rule 17(2)(vii), the provisional refusal shall not be recorded in the International Register. If however a rectified notification is sent within the time limit referred to in subparagraph (c), it shall be regarded, for the purposes of Article 5 of the Agreement, as having been sent to the International Bureau on the date on which the defective notification had been sent to it. If the notification is not so rectified, it shall not be regarded as a notification of provisional refusal. In the latter case, the International Bureau shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

(e) Any rectified notification shall, where the applicable law so permits, indicate a new time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires.

(f) The International Bureau shall transmit a copy of any rectified notification to the holder.

(2) [Contracting Party Designated Under the Protocol] (a) Paragraph (1) shall also apply in the case of a notification of provisional refusal communicated by the Office of a Contracting Party designated under the Protocol, it being understood that the time limit referred to in paragraph (1)(a)(iii) shall be the time limit applicable under Article 5(2)(a) or, subject to Article 9*sexies*(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol.

(b) Paragraph (1)(a) shall apply to determine whether the time limit before the expiry of which the Office of the Contracting Party concerned must give the International Bureau the information referred to in Article 5(2)(c)(i) of the Protocol has been complied with. If such information is given after the expiry of that time limit, it shall be regarded as not having been given and the International Bureau shall inform the Office concerned accordingly.

(c) Where the notification of provisional refusal based on an opposition is made under Article 5(2)(c)(ii) of the Protocol without the requirements of Article 5(2)(c)(i) of the Protocol having been complied with, it shall not be regarded as a notification of provisional refusal. In such a case, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

*Rule 18bis**Interim Status of a Mark in a Designated Contracting Party*

(1) *[Ex Officio Examination Completed but Opposition or Observations by Third Parties Still Possible]* (a) An Office which has not communicated a notification of provisional refusal may, within the period applicable under Article 5(2) of the Agreement or Article 5(2)(a) or (b) of the Protocol, send to the International Bureau a statement to the effect that the *ex officio* examination has been completed and that the Office has found no grounds for refusal but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed<sup>3</sup>.

(b) An Office which has communicated a notification of provisional refusal may send to the International Bureau a statement to the effect that the *ex officio* examination has been completed but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed.

(2) *[Recording, Information to the Holder and Transmittal of Copies]* The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

*Rule 18ter**Final Disposition on Status of a Mark in a Designated Contracting Party*

(1) *[Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated]*<sup>4</sup> When, before the expiry of the period applicable under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned<sup>5</sup>.

(2) *[Statement of Grant of Protection Following a Provisional Refusal]* Except where it sends a statement under paragraph (3), an Office which has communicated a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau either

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or

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<sup>3</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“The references in Rule 18bis to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations.”

<sup>4</sup> In adopting this provision, the Assembly of the Madrid Union understood that a statement of grant of protection could concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of these international registrations.

<sup>5</sup> In adopting paragraphs (1) and (2) of this rule, the Assembly of the Madrid Union understood that where Rule 34(3) applies, the grant of protection will be subject to the payment of the second part of the fee.



(ii) a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned.

(3) [*Confirmation of Total Provisional Refusal*] An Office which has sent to the International Bureau a notification of a total provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed and the Office has decided to confirm refusal of the protection of the mark in the Contracting Party concerned for all goods and services, send to the International Bureau a statement to that effect.

(4) [*Further Decision*] Where, following the sending of a statement in accordance with either paragraph (2) or (3), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned<sup>6</sup>.

(5) [*Recording, Information to the Holder and Transmittal of Copies*] The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

#### Rule 19

##### *Invalidations in Designated Contracting Parties*

(1) [*Contents of the Notification of Invalidation*] Where the effects of an international registration are invalidated in a designated Contracting Party under Article 5(6) of the Agreement or Article 5(6) of the Protocol and the invalidation is no longer subject to appeal, the Office of the Contracting Party whose competent authority has pronounced the invalidation shall notify the International Bureau accordingly. The notification shall contain or indicate

- (i) the authority which pronounced the invalidation,
- (ii) the fact that the invalidation is no longer subject to appeal,
- (iii) the number of the international registration,
- (iv) the name of the holder,
- (v) if the invalidation does not concern all the goods and services, those in respect of which the invalidation has been pronounced or those in respect of which the invalidation has not been pronounced, and
- (vi) the date on which the invalidation was pronounced and, where possible, its effective date.

(2) [*Recording of the Invalidation and Information to the Holder and the Office Concerned*] (a) The International Bureau shall record the invalidation in the International Register, together with the data contained in the notification of invalidation, and shall inform accordingly the holder. The International Bureau shall also inform the Office that communicated the notification of invalidation of the date on which the invalidation was recorded in the International Register if that Office has requested to receive such information.

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<sup>6</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“The reference in Rule 18ter(4) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed.”

(b) The invalidation shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

*Rule 20*

*Restriction of the Holder's Right of Disposal*

(1) *[Communication of Information]* (a) The holder of an international registration or the Office of the Contracting Party of the holder may inform the International Bureau that the holder's right to dispose of the international registration has been restricted and, if appropriate, indicate the Contracting Parties concerned.

(b) The Office of any designated Contracting Party may inform the International Bureau that the holder's right of disposal has been restricted in respect of the international registration in the territory of that Contracting Party.

(c) Information given in accordance with subparagraph (a) or (b) shall consist of a summary statement of the main facts concerning the restriction.

(2) *[Partial or Total Removal of Restriction]* Where the International Bureau has been informed of a restriction of the holder's right of disposal in accordance with paragraph (1), the party that communicated the information shall also inform the International Bureau of any partial or total removal of that restriction.

(3) *[Recording]* (a) The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform accordingly the holder, the Office of the Contracting Party of the holder and the Offices of the designated Contracting Parties concerned.

(b) The information communicated under paragraphs (1) and (2) shall be recorded as of the date of its receipt by the International Bureau, provided that the communication complies with the applicable requirements.

*Rule 20bis*

*Licenses*

(1) *[Request for the Recording of a License]* (a) A request for the recording of a license shall be presented to the International Bureau on the relevant official form by the holder or, if the Office admits such presentation, by the Office of the Contracting Party of the holder or the Office of a Contracting Party with respect to which the license is granted.

(b) The request shall indicate

(i) the number of the international registration concerned,

(ii) the name of the holder,

(iii) the name and address of the licensee, given in accordance with the Administrative Instructions,

(iv) the designated Contracting Parties with respect to which the license is granted,

(v) that the license is granted for all the goods and services covered by the international registration, or the goods and services for which the license is granted, grouped in the appropriate classes of the International Classification of Goods and Services.

- (c) The request may also indicate
- (i) where the licensee is a natural person, the State of which the licensee is a national,
  - (ii) where the licensee is a legal entity, the legal nature of that entity and the State and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized,
  - (iii) that the license concerns only a part of the territory of a specified designated Contracting Party,
  - (iv) where the licensee has a representative, the name and address of the representative, given in accordance with the Administrative Instructions,
  - (v) where the license is an exclusive license or a sole license, that fact,<sup>7</sup>
  - (vi) where applicable, the duration of the license.
- (d) The request shall be signed by the holder or by the Office through which it is presented.

(2) *[Irregular Request]* (a) If the request for the recording of a license does not comply with the requirements of paragraph (1)(a), (b) and (d), the International Bureau shall notify that fact to the holder and, if the request was presented by an Office, to that Office.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

(3) *[Recording and Notification]* (a) Where the request complies with the requirements of paragraph (1)(a), (b) and (d), the International Bureau shall record the license in the International Register, together with the information contained in the request, shall notify accordingly the Offices of the designated Contracting Parties in respect of which the license is granted and shall inform at the same time the holder and, if the request was presented by an Office, that Office.

(b) The license shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements.

(4) *[Amendment or Cancellation of the Recording of a License]* Paragraphs (1) to (3) shall apply *mutatis mutandis* to a request for the amendment or cancellation of the recording of a license.

(5) *[Declaration That the Recording of a Given License Has No Effect]* (a) The Office of a designated Contracting Party which is notified by the International Bureau of the recording of a license in respect of that Contracting Party may declare that such recording has no effect in the said Contracting Party.

(b) The declaration referred to in subparagraph (a) shall indicate

- (i) the reasons for which the recording of the license has no effect,

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<sup>7</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“Where a request to record a license does not include the indication, provided for in Rule 20bis(1)(c)(v), that the license is exclusive or sole, it may be considered that the license is non-exclusive.”

(ii) where the declaration does not affect all the goods and services to which the license relates, those which are affected by the declaration or those which are not affected by the declaration,

(iii) the corresponding essential provisions of the law, and

(iv) whether such declaration may be subject to review or appeal.

(c) The declaration referred to in subparagraph (a) shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in paragraph (3) was sent to the Office concerned.

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the license. The declaration shall be recorded as of the date of receipt by the International Bureau of a communication complying with the applicable requirements.

(e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and notify accordingly the party (holder or Office) that presented the request to record the license.

(6) *[Declaration That the Recording of Licenses in the International Register Has No Effect in a Contracting Party]* (a) The Office of a Contracting Party the law of which does not provide for the recording of trademark licenses may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party.

(b) The Office of a Contracting Party the law of which provides for the recording of trademark licenses may, before the date on which this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party. Such notification may be withdrawn at any time.<sup>8</sup>

### *Rule 21*

#### *Replacement of a National or Regional Registration by an International Registration*

(1) *[Notification]* Where, in accordance with Article 4*bis*(2) of the Agreement or Article 4*bis*(2) of the Protocol, the Office of a designated Contracting Party has taken note in its Register, following a request made direct by the holder with that Office, that a national or a regional registration has been replaced by an international registration, that Office shall notify the International Bureau accordingly. Such notification shall indicate

(i) the number of the international registration concerned,

<sup>8</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“Subparagraph (a) of Rule 20*bis*(6) deals with the case of a notification by a Contracting Party whose law does not provide for the recording of trademark licenses; such a notification may be made at any time; subparagraph (b) on the other hand deals with the case of a notification by a Contracting Party whose law does provide for the recording of trademark licenses but which is unable at present to give effect to the recording of a license in the International Register; this latter notification, which may be withdrawn at any time, may only be made before this Rule has come into force or before the Contracting Party has become bound by the Agreement or the Protocol.”

- (ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and
- (iii) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration which has been replaced by the international registration.

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration, in a form agreed between the International Bureau and the Office concerned.

(2) *[Recording]* (a) The International Bureau shall record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.

(b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

#### *Rule 21bis*

##### *Other Facts Concerning Seniority Claim*

(1) *[Final Refusal of Seniority Claim]* Where a claim of seniority has been recorded in the International Register in respect of the designation of a Contracting Organization, the Office of that Organization shall notify the International Bureau of any final decision refusing, in whole or in part, the validity of such claim.

(2) *[Seniority Claimed Subsequent to the International Registration]* Where the holder of an international registration designating a Contracting Organization has, under the law of such Contracting Organization, claimed directly with the Office of that Organization the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, and where such claim has been accepted by the Office concerned, that Office shall notify that fact to the International Bureau. Such notification shall indicate:

- (i) the number of the international registration concerned, and
- (ii) the Member State or Member States in or for which the earlier mark is registered, together with the date from which the registration of that earlier mark was effective and the number of the relevant registration.

(3) *[Other Decisions Affecting Seniority Claim]* The Office of a Contracting Organization shall notify the International Bureau of any further final decision, including withdrawal and cancellation, affecting a claim to seniority which has been recorded in the International Register.

(4) *[Recording in the International Register]* The International Bureau shall record in the International Register the information notified under paragraphs (1) to (3).

*Rule 22**Ceasing of Effect of the Basic Application,  
of the Registration Resulting Therefrom,  
or of the Basic Registration*

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]* (a) Where Article 6(3) and (4) of the Agreement or Article 6(3) and (4) of the Protocol, or both, apply, the Office of origin shall notify the International Bureau accordingly and shall indicate

(i) the number of the international registration,  
(ii) the name of the holder,  
(iii) the facts and decisions affecting the basic registration, or, where the international registration concerned is based on a basic application which has not resulted in a registration, the facts and decisions affecting the basic application, or, where the international registration is based on a basic application which has resulted in a registration, the facts and decisions affecting that registration, and the effective date of those facts and decisions, and

(iv) where the said facts and decisions affect the international registration only with respect to some of the goods and services, those goods and services which are affected by the facts and decisions or those which are not affected by the facts and decisions.

(b) Where a judicial action referred to in Article 6(4) of the Agreement, or a proceeding referred to in item (i), (ii) or (iii) of Article 6(3) of the Protocol, began before the expiry of the five-year period but has not, before the expiry of that period, resulted in the final decision referred to in Article 6(4) of the Agreement, or in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof and as soon as possible after the expiry of the said period, notify the International Bureau accordingly.

(c) Once the judicial action or proceeding referred to in subparagraph (b) has resulted in the final decision referred to in Article 6(4) of the Agreement, in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv).

(2) *[Recording and Transmittal of the Notification; Cancellation of the International Registration]* (a) The International Bureau shall record any notification referred to in paragraph (1) in the International Register and shall transmit a copy of the notification to the Offices of the designated Contracting Parties and to the holder.

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register.

(c) Where the international registration has been cancelled in the International Register in accordance with subparagraph (b), the International Bureau shall notify the Offices of the designated Contracting Parties and the holder of the following:

(i) the date on which the international registration was cancelled in the International Register;

(ii) where the cancellation concerns all goods and services, that fact;

(iii) where the cancellation concerns only some of the goods and services, the goods and services indicated under paragraph (1)(a)(iv).

*Rule 23**Division or Merger of the Basic Applications,  
of the Registrations Resulting Therefrom,  
or of the Basic Registrations*

(1) *[Notification of the Division of the Basic Application or Merger of the Basic Applications]* Where, during the five-year period referred to in Article 6(3) of the Protocol, the basic application is divided into two or more applications, or several basic applications are merged into a single application, the Office of origin shall notify the International Bureau accordingly and shall indicate

- (i) the number of the international registration or, if the international registration has not yet been effected, the number of the basic application,
- (ii) the name of the holder or applicant,
- (iii) the number of each application resulting from the division or the number of the application resulting from the merger.

(2) *[Recording and Notification by the International Bureau]* The International Bureau shall record the notification referred to in paragraph (1) in the International Register and shall notify the Offices of the designated Contracting Parties and, at the same time, the holder.

(3) *[Division or Merger of Registrations Resulting from Basic Applications or of Basic Registrations]* Paragraphs (1) and (2) shall apply, *mutatis mutandis*, to the division of any registration or merger of any registrations which resulted from the basic application or applications during the five-year period referred to in Article 6(3) of the Protocol and to the division of the basic registration or merger of the basic registrations during the five-year period referred to in Article 6(3) of the Agreement and in Article 6(3) of the Protocol.

## **Chapter 5 Subsequent Designations; Changes**

*Rule 24**Designation Subsequent to the International Registration*

(1) *[Entitlement]* (a) A Contracting Party may be the subject of a designation made subsequent to the international registration (hereinafter referred to as “subsequent designation” where, at the time of that designation, the holder fulfills the conditions, under Article 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration.

(b) Where the Contracting Party of the holder is bound by the Agreement, the holder may designate, under the Agreement, any Contracting Party that is bound by the Agreement, provided that the said Contracting Parties are not both bound also by the Protocol.

(c) Where the Contracting Party of the holder is bound by the Protocol, the holder may designate, under the Protocol, any Contracting Party that is bound by the Protocol, whether or not the said Contracting Parties are both also bound by the Agreement.

(2) *[Presentation; Form and Signature]* (a) A subsequent designation shall be presented to the International Bureau by the holder or by the Office of the Contracting Party of the holder; however,

- (i) where Rule 7(1), as in force before October 4, 2001, applies, it must be presented by the Office of origin;

(ii) where any of the Contracting Parties are designated under the Agreement, the subsequent designation must be presented by the Office of the Contracting Party of the holder;

(iii) where paragraph (7) applies, the subsequent designation resulting from conversion must be presented by the Office of the Contracting Organization.

(b) The subsequent designation shall be presented on the official form in one copy. Where it is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

(3) *[Contents]* (a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate

(i) the number of the international registration concerned,

(ii) the name and address of the holder,

(iii) the Contracting Party that is designated,

(iv) where the subsequent designation is for all the goods and services listed in the international registration concerned, that fact, or, where the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services,

(v) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and,

(vi) where the subsequent designation is presented by an Office, the date on which it was received by that Office.

(b) Where the subsequent designation concerns a Contracting Party that has made a notification under Rule 7(2), that subsequent designation shall also contain a declaration of intention to use the mark in the territory of that Contracting Party; the declaration shall, as required by the said Contracting Party,

(i) be signed by the holder himself and be made on a separate official form annexed to the subsequent designation, or

(ii) be included in the subsequent designation.

(c) The subsequent designation may also contain

(i) the indications and translation or translations, as the case may be, referred to in Rule 9(4)(b),

(ii) a request that the subsequent designation take effect after the recording of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration,

(iii) where the subsequent designation concerns a Contracting Organization, the indications referred to in Rule 9(5)(g)(i), which shall be on a separate official form to be annexed to the subsequent designation, and in Rule 9(5)(g)(ii).

(d) Where the international registration is based on a basic application, a subsequent designation under the Agreement shall be accompanied by a declaration, signed by the Office of origin, certifying that the said application has resulted in a registration and indicating the date and number of that registration, unless such a declaration has already been received by the International Bureau.

(4) *[Fees]* The subsequent designation shall be subject to the payment of the fees specified or referred to in item 5 of the Schedule of Fees.



(5) *[Irregularities]* (a) If the subsequent designation does not comply with the applicable requirements, and subject to paragraph (10), the International Bureau shall notify that fact to the holder and, if the subsequent designation was presented by an Office, that Office.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the subsequent designation shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the subsequent designation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the basic fee referred to in item 5.1 of the Schedule of Fees, to the party having paid those fees.

(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraph (1)(b) or (c) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designation shall be deemed not to contain the designation of those Contracting Parties, and any complementary or individual fees already paid in respect of those Contracting Parties shall be reimbursed. Where the requirements of paragraph (1)(b) or (c) are complied with in respect of none of the designated Contracting Parties, subparagraph (b) shall apply.

(6) *[Date of Subsequent Designation]* (a) A subsequent designation presented by the holder direct to the International Bureau shall, subject to subparagraph (c)(i), bear the date of its receipt by the International Bureau.

(b) A subsequent designation presented to the International Bureau by an Office shall, subject to subparagraph (c)(i), (d) and (e), bear the date on which it was received by that Office, provided that the said designation has been received by the International Bureau within a period of two months from that date. If the subsequent designation has not been received by the International Bureau within that period, it shall, subject to subparagraph (c)(i), (d) and (e), bear the date of its receipt by the International Bureau.

(c) Where the subsequent designation does not comply with the applicable requirements and the irregularity is remedied within three months from the date of the notification referred to in paragraph (5)(a),

(i) the subsequent designation shall, where the irregularity concerns any of the requirements referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i), bear the date on which that designation is put in order, unless the said designation was presented to the International Bureau by an Office and the irregularity is remedied within the period of two months referred to in subparagraph (b); in the latter case, the subsequent designation shall bear the date on which it was received by the said Office;

(ii) the date applicable under subparagraph (a) or (b), as the case may be, shall not be affected by an irregularity concerning requirements other than those which are referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i).

(d) Notwithstanding subparagraphs (a), (b) and (c), where the subsequent designation contains a request made in accordance with paragraph (3)(c)(ii), it may bear a date which is later than that resulting from subparagraph (a), (b) or (c).

(e) Where a subsequent designation results from conversion in accordance with paragraph (7), that subsequent designation shall bear the date on which the designation of the Contracting Organization was recorded in the International Register.

(7) *[Subsequent Designation Resulting From Conversion]* (a) Where the designation of a Contracting Organization has been recorded in the International Register and to the extent that such designation has been withdrawn, refused or has ceased to have effect under the law of that Organization, the holder of the international registration concerned may request the conversion of the designation of the said Contracting Organization into the designation of any Member State of that Organization which is party to the Agreement and/or the Protocol.

(b) A request for conversion under subparagraph (a) shall indicate the elements referred to in paragraph (3)(a)(i) to (iii) and (v), together with:

- (i) the Contracting Organization whose designation is to be converted, and
- (ii) where the subsequent designation of a Contracting State resulting from conversion is for all the goods and services listed in respect of the designation of the Contracting Organization, that fact, or, where the designation of that Contracting State is for only part of the goods and services listed in the designation of that Contracting Organization, those goods and services.

(8) *[Recording and Notification]* Where the International Bureau finds that the subsequent designation conforms to the applicable requirements, it shall record it in the International Register and shall notify accordingly the Office of the Contracting Party that has been designated in the subsequent designation and at the same time inform the holder and, if the subsequent designation was presented by an Office, that Office.

(9) *[Refusal]* Rules 16 to 18<sup>ter</sup> shall apply *mutatis mutandis*.

(10) *[Subsequent Designation Not Considered as Such]* If the requirements of paragraph (2)(a) are not complied with, the subsequent designation shall not be considered as such and the International Bureau shall inform the sender accordingly.

#### *Rule 25*

##### *Request for Recording of a Change; Request for Recording of a Cancellation*

(1) *[Presentation of the Request]* (a) A request for recording shall be presented to the International Bureau on the relevant official form, in one copy, where the request relates to any of the following:

- (i) a change in the ownership of the international registration in respect of all or some of the goods and services and all or some of the designated Contracting Parties;
- (ii) a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties;
- (iii) a renunciation in respect of some of the designated Contracting Parties for all the goods and services;
- (iv) a change in the name or address of the holder;
- (v) cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services.

(b) Subject to subparagraph (c), the request shall be presented by the holder or by the Office of the Contracting Party of the holder; however, the request for the recording of a change in ownership may be presented through the Office of the Contracting Party, or of one of the Contracting Parties, indicated in the said request in accordance with paragraph (2)(a)(iv).

(c) The request for the recording of a renunciation or a cancellation may not be presented directly by the holder where the renunciation or cancellation affects any Contracting Party whose designation is, on the date of receipt of the request by the International Bureau, governed by the Agreement.

(d) Where the request is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

(2) *[Contents of the Request]* (a) The request for the recording of a change or the request for the recording of a cancellation shall, in addition to the requested change or cancellation, contain or indicate

(i) the number of the international registration concerned,  
(ii) the name of the holder, unless the change relates to the name or address of the representative,

(iii) in the case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, of the natural person or legal entity mentioned in the request as the new holder of the international registration (hereinafter referred to as “the transferee”),

(iv) in the case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the transferee fulfills the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration,

(v) in the case of a change in the ownership of the international registration, where the address of the transferee given in accordance with item (iii) is not in the territory of the Contracting Party, or of one of the Contracting Parties, given in accordance with item (iv), and unless the transferee has indicated that he is a national of a Contracting State or of a State member of a Contracting Organization, the address of the establishment, or the domicile, of the transferee in the Contracting Party, or in one of the Contracting Parties, in respect of which the transferee fulfills the conditions to be the holder of an international registration,

(vi) in the case of a change in the ownership of the international registration that does not relate to all the goods and services and to all the designated Contracting Parties, the goods and services and the designated Contracting Parties to which the change in ownership relates, and

(vii) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

(b) The request for the recording of a change in the ownership of the international registration may also contain,

(i) where the transferee is a natural person, an indication of the State of which the transferee is a national;

(ii) where the transferee is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized.

(c) The request for recording of a change or a cancellation may also contain a request that it be recorded before, or after, the recording of another change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration.

(3) *[Request Not Admissible]* A change in the ownership of an international registration may not be recorded in respect of a given designated Contracting Party if that Contracting Party

(i) is bound by the Agreement but not by the Protocol, and the Contracting Party indicated under paragraph (2)(a)(iv) is not bound by the Agreement, or none of the Contracting Parties indicated under that paragraph is bound by the Agreement;

(ii) is bound by the Protocol but not by the Agreement, and the Contracting Party indicated under paragraph (2)(a)(iv) is not bound by the Protocol, or none of the Contracting Parties indicated under that paragraph is bound by the Protocol.

(4) [*Several Transferees*] Where the request for the recording of a change in the ownership of the international registration mentions several transferees, that change may not be recorded in respect of a given designated Contracting Party if any of the transferees does not fulfill the conditions to be holder of the international registration in respect of that Contracting Party.

*Rule 26*

*Irregularities in Requests for Recording of a Change  
and for Recording of a Cancellation*

(1) [*Irregular Request*] If the request for the recording of a change, or the request for the recording of a cancellation, referred to in Rule 25(1)(a) does not comply with the applicable requirements, and subject to paragraph (3), the International Bureau shall notify that fact to the holder and, if the request was made by an Office, to that Office.

(2) [*Time Allowed to Remedy Irregularity*] The irregularity may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request for the recording of a change or the request for the recording of a cancellation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

(3) [*Requests Not Considered as Such*] If the requirements of Rule 25(1)(b) or (c) are not complied with, the request shall not be considered as such and the International Bureau shall inform the sender accordingly.

*Rule 27*

*Recording and Notification of a Change or of a Cancellation;  
Merger of International Registrations; Declaration That a Change in Ownership or a Limitation  
Has No Effect*

(1) [*Recording and Notification of a Change or of a Cancellation*] (a) The International Bureau shall, provided that the request referred to in Rule 25(1)(a) is in order, promptly record the change or the cancellation in the International Register, shall notify accordingly the Offices of the designated Contracting Parties in which the change has effect or, in the case of a cancellation, the Offices of all the designated Contracting Parties, and shall inform at the same time the holder and, if the request was presented by an Office, that Office. Where the recording relates to a change in ownership, the International Bureau shall also inform the former holder in the case of a total change in ownership and the holder of the part of the international registration which has been assigned or otherwise transferred in the case of a partial change in ownership. Where the request for the recording of a cancellation was presented by the holder or by an Office other than the Office of origin during the five-year period referred to in Article 6(3) of the Agreement and Article 6(3) of the Protocol, the International Bureau shall also inform the Office of origin.

(b) The change or the cancellation shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements, except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

(2) [Deleted]

(3) *[Recording of Merger of International Registrations]* Where the same natural person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change in ownership, the registrations shall be merged at the request of the said person or entity, made either direct or through the Office of the Contracting Party of the holder. The International Bureau shall notify accordingly the Offices of the designated Contracting Parties affected by the change and shall inform at the same time the holder and, if the request was presented by an Office, that Office.

(4) *[Declaration That a Change in Ownership Has No Effect]* (a) The Office of a designated Contracting Party which is notified, by the International Bureau, of a change in ownership affecting that Contracting Party may declare that the change in ownership has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the international registration concerned shall remain in the name of the transferor.

- (b) The declaration referred to in subparagraph (a) shall indicate
- (i) the reasons for which the change in ownership has no effect,
  - (ii) the corresponding essential provisions of the law, and
  - (iii) whether such declaration may be subject to review or appeal.

(c) The declaration referred to in subparagraph (a) shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in subparagraph (a) was sent to the Office concerned.

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and, as the case may be, record as a separate international registration that part of the international registration which has been the subject of the said declaration, and shall notify accordingly the party (holder or Office) that presented the request for the recording of a change in ownership and the new holder.

(e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and, as the case may be, modify the International Register accordingly, and shall notify accordingly the party (holder or Office) that presented the request for the recording of a change in ownership and the new holder.

(5) *[Declaration That a Limitation Has No Effect]* (a) The Office of a designated Contracting Party which is notified by the International Bureau of a limitation of the list of goods and services affecting that Contracting Party may declare that the limitation has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the limitation shall not apply to the goods and services affected by the declaration.

- (b) The declaration referred to in subparagraph (a) shall indicate
- (i) the reasons for which the limitation has no effect,
  - (ii) where the declaration does not affect all the goods and services to which the limitation relates, those which are affected by the declaration or those which are not affected by the declaration,
  - (iii) the corresponding essential provisions of the law, and
  - (iv) whether such declaration may be subject to review or appeal.

(c) The declaration referred to in subparagraph (a) shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in subparagraph (a) was sent to the Office concerned.

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the limitation.

(e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and notify accordingly the party (holder or Office) that presented the request to record the limitation.

### *Rule 28*

#### *Corrections in the International Register*

(1) *[Correction]* Where the International Bureau, acting *ex officio* or at the request of the holder or of an Office, considers that there is an error concerning an international registration in the International Register, it shall modify the Register accordingly.

(2) *[Notification]* The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect. In addition, where the Office that has requested the correction is not the Office of a designated Contracting Party in which the correction has effect, the International Bureau shall also inform that Office.

(3) *[Refusal Following a Correction]* Any Office referred to in paragraph (2) shall have the right to declare in a notification of provisional refusal addressed to the International Bureau that it considers that protection cannot, or can no longer, be granted to the international registration as corrected. Article 5 of the Agreement or Article 5 of the Protocol and Rules 16 to 18<sup>ter</sup> shall apply *mutatis mutandis*, it being understood that the period allowed for sending the said notification shall be counted from the date of sending the notification of the correction to the Office concerned.

(4) *[Time Limit for Correction]* Notwithstanding paragraph (1), an error which is attributable to an Office and the correction of which would affect the rights deriving from the international registration may be corrected only if a request for correction is received by the International Bureau within nine months from the date of publication of the entry in the International Register which is the subject of the correction.

## **Chapter 6 Renewals**

### *Rule 29*

#### *Unofficial Notice of Expiry*

The fact that the unofficial notice referred to in Article 7(4) of the Agreement and Article 7(3) of the Protocol is not received shall not constitute an excuse for failure to comply with any time limit under Rule 30.

*Rule 30*  
*Details Concerning Renewal*

(1) *[Fees]* (a) The international registration shall be renewed upon payment, at the latest on the date on which the renewal of the international registration is due, of

(i) the basic fee,  
(ii) where applicable, the supplementary fee, and,  
(iii) the complementary fee or individual fee, as the case may be, for each designated Contracting Party for which no refusal or invalidation is recorded in the International Register in respect of all the goods and services concerned, as specified or referred to in item 6 of the Schedule of Fees. However, such payment may be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in item 6.5 of the Schedule of Fees is paid at the same time.

(b) If any payment made for the purposes of renewal is received by the International Bureau earlier than three months before the date on which the renewal of the international registration is due, it shall be considered as having been received three months before the date on which renewal is due.

(2) *[Further Details]* (a) Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no refusal is recorded in the International Register in respect of all the goods and services concerned, payment of the required fees shall be accompanied by a statement that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a refusal is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party.

(c) The international registration may not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration may not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

(d) The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol.

(3) *[Insufficient Fees]* (a) If the amount of the fees received is less than the amount of the fees required for renewal, the International Bureau shall promptly notify at the same time both the holder and the representative, if any, accordingly. The notification shall specify the missing amount.

(b) If the amount of the fees received is, on the expiry of the period of six months referred to in paragraph (1)(a), less than the amount required under paragraph (1), the International Bureau shall not, subject to subparagraph (c), record the renewal, and shall reimburse the amount received to the party having paid it and notify accordingly the holder and the representative, if any.

(c) If the notification referred to in subparagraph (a) was sent during the three months preceding the expiry of the period of six months referred to in paragraph (1)(a) and if the amount of the fees received is, on the expiry of that period, less than the amount required under paragraph (1) but is at least 70% of that amount, the International Bureau shall proceed as provided in Rule 31(1) and (3). If the amount required is not fully paid within three months from the said notification, the International Bureau shall cancel the renewal, notify accordingly the holder, the representative, if any, and the Offices which had been notified of the renewal, and reimburse the amount received to the party having paid it.

(4) *[Period for Which Renewal Fees Are Paid]* The fees required for each renewal shall be paid for ten years, irrespective of the fact that the international registration contains, in the list of designated Contracting Parties, only Contracting Parties whose designation is governed by the Agreement, only Contracting Parties whose designation is governed by the Protocol, or both Contracting Parties whose designation is governed by the Agreement and Contracting Parties whose designation is governed by the Protocol. As regards payments under the Agreement, the payment for ten years shall be considered to be a payment for an instalment of ten years.

### *Rule 31*

#### *Recording of the Renewal; Notification and Certificate*

(1) *[Recording and Effective Date of the Renewal]* Renewal shall be recorded in the International Register with the date on which renewal was due, even if the fees required for renewal are paid within the period of grace referred to in Article 7(5) of the Agreement and in Article 7(4) of the Protocol.

(2) *[Renewal Date in the Case of Subsequent Designations]* The effective date of the renewal shall be the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register.

(3) *[Notification and Certificate]* The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the renewal and shall send a certificate to the holder.

(4) *[Notification in Case of Non-Renewal]* (a) Where an international registration is not renewed, the International Bureau shall notify accordingly the Offices of all of the Contracting Parties designated in that international registration.

(b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the Office of that Contracting Party accordingly.

## **Chapter 7**

### **Gazette and Data Base**

#### *Rule 32*

##### *Gazette*

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

(i) international registrations effected under Rule 14;



- (ii) information communicated under Rule 16(1);
  - (iii) provisional refusals recorded under Rule 17(4), with an indication as to whether the refusal relates to all the goods and services or only some of them but without an indication of the goods and services concerned and without the grounds for refusal, and statements and information recorded under Rules 18*bis*(2) and 18*ter*(5);
  - (iv) renewals recorded under Rule 31(1);
  - (v) subsequent designations recorded under Rule 24(8);
  - (vi) continuation of effects of international registrations under Rule 39;
  - (vii) changes in ownership, limitations, renunciations and changes of name or address of the holder recorded under Rule 27;
  - (viii) cancellations effected under Rule 22(2) or recorded under Rule 27(1) or Rule 34(3)(d);
  - (ix) corrections effected under Rule 28;
  - (x) invalidations recorded under Rule 19(2);
  - (xi) information recorded under Rules 20, 20*bis*, 21, 21*bis*, 22(2)(a), 23, 27(3) and (4) and 40(3);
  - (xii) international registrations which have not been renewed.
- (b) The reproduction of the mark shall be published as it appears in the international application. Where the applicant has made the declaration referred to in Rule 9(4)(a)(vi), the publication shall indicate that fact.
- (c) Where a color reproduction of the mark is furnished under Rule 9(4)(a)(v) or (vii), the Gazette shall contain both a reproduction of the mark in black and white and the reproduction in color.

(2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* The International Bureau shall publish in the Gazette

- (i) any notification made under Rule 7 or Rule 20*bis*(6) and any declaration made under Rule 17(5)(d) or (e);
- (ii) any declarations made under Article 5(2)(b) or Article 5(2)(b) and (c), first sentence, of the Protocol;
- (iii) any declarations made under Article 8(7) of the Protocol;
- (iv) any notification made under Rule 34(2)(b) or (3)(a);
- (v) a list of the days on which the International Bureau is not scheduled to be open to the public during the current and the following calendar year.

(3) *[Number of Copies for Offices of Contracting Parties]* (a) The International Bureau shall send to the Office of each Contracting Party copies of the Gazette. Each Office shall be entitled, free of charge, to two copies and, where during a given calendar year the number of designations recorded with respect to the Contracting Party concerned has exceeded 2,000, in the following year one additional copy and further additional copies for every 1,000 designations in excess of 2,000. Each Contracting Party may purchase every year, at half of the subscription price, the same number of copies as that to which it is entitled free of charge.

(b) If the Gazette is available in more than one form, each Office may choose the form in which it wishes to receive any copy to which it is entitled.

*Rule 33**Electronic Data Base*

(1) *[Contents of Data Base]* The data which are both recorded in the International Register and published in the Gazette under Rule 32 shall be entered in an electronic data base.

(2) *[Data Concerning Pending International Applications and Subsequent Designations]* If an international application or a designation under Rule 24 is not recorded in the International Register within three working days following the receipt by the International Bureau of the international application or designation, the International Bureau shall enter in the electronic data base, notwithstanding any irregularities that may exist in the international application or designation as received, all the data contained in the international application or designation.

(3) *[Access to Electronic Data Base]* The electronic data base shall be made accessible to the Offices of the Contracting Parties and, against payment of the prescribed fee, if any, to the public, by on-line access and through other appropriate means determined by the International Bureau. The cost of accessing shall be borne by the user. Data entered under paragraph (2) shall be accompanied by a warning to the effect that the International Bureau has not yet made a decision on the international application or on the designation under Rule 24.

**Chapter 8****Fees***Rule 34**Amounts and Payment of Fees*

(1) *[Amounts of Fees]* The amounts of fees due under the Agreement, the Protocol or these Regulations, other than individual fees, are specified in the Schedule of Fees that is annexed to these Regulations and forms an integral part thereof.

(2) *[Payments]* (a) The fees indicated in the Schedule of Fees may be paid to the International Bureau by the applicant or the holder, or, where the Office of the Contracting Party of the holder accepts to collect and forward such fees, and the applicant or the holder so wishes, by that Office.

(b) Any Contracting Party whose Office accepts to collect and forward fees shall notify that fact to the Director General.

(3) *[Individual Fee Payable in Two Parts]* (a) A Contracting Party that makes or has made a declaration under Article 8(7) of the Protocol may notify the Director General that the individual fee to be paid in respect of a designation of that Contracting Party comprises two parts, the first part to be paid at the time of filing the international application or the subsequent designation of that Contracting Party and the second part to be paid at a later date which is determined in accordance with the law of that Contracting Party.

(b) Where subparagraph (a) applies, the references in items 2, 3 and 5 of the Schedule of Fees to an individual fee shall be construed as references to the first part of the individual fee.

(c) Where subparagraph (a) applies, the Office of the designated Contracting Party concerned shall notify the International Bureau when the payment of the second part of the individual fee becomes due. The notification shall indicate

(i) the number of the international registration concerned,  
(ii) the name of the holder,  
(iii) the date by which the second part of the individual fee must be paid,  
(iv) where the amount of the second part of the individual fee is dependent on the number of classes of goods and services for which the mark is protected in the designated Contracting Party concerned, the number of such classes.

(d) The International Bureau shall transmit the notification to the holder. Where the second part of the individual fee is paid within the applicable period, the International Bureau shall record the payment in the International Register and notify the Office of the Contracting Party concerned accordingly. Where the second part of the individual fee is not paid within the applicable period, the International Bureau shall notify the Office of the Contracting Party concerned, cancel the international registration in the International Register with respect to the Contracting Party concerned and notify the holder accordingly.

(4) [*Modes of Payment of Fees to the International Bureau*] Fees shall be paid to the International Bureau as specified in the Administrative Instructions.

(5) [*Indications Accompanying the Payment*] At the time of the payment of any fee to the International Bureau, an indication must be given,

(i) before international registration, of the name of the applicant, the mark concerned and the purpose of the payment;  
(ii) after international registration, of the name of the holder, the number of the international registration concerned and the purpose of the payment.

(6) [*Date of Payment*] (a) Subject to Rule 30(1)(b) and to subparagraph (b), any fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives the required amount.

(b) Where the required amount is available in an account opened with the International Bureau and that Bureau has received instructions from the holder of the account to debit it, the fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives an international application, a subsequent designation, an instruction to debit the second part of an individual fee, a request for the recording of a change or an instruction to renew an international registration.

(7) [*Change in the Amount of the Fees*] (a) Where the amount of the fees payable in respect of the filing of an international application is changed between, on the one hand, the date on which the request to present the international application to the International Bureau is received, or is deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin and, on the other hand, the date of the receipt of the international application by the International Bureau, the fee that was valid on the first date shall be applicable.

(b) Where a designation under Rule 24 is presented by the Office of the Contracting Party of the holder and the amount of the fees payable in respect of that designation is changed between, on the one hand, the date of receipt, by the Office, of the request by the holder to present the said designation and, on the other hand, the date on which the designation is received by the International Bureau, the fee that was valid on the first date shall be applicable.

(c) Where paragraph (3)(a) applies, the amount of the second part of the individual fee which is valid on the later date referred to in that paragraph shall be applicable.

(d) Where the amount of the fees payable in respect of the renewal of an international registration is changed between the date of payment and the due date of the renewal, the fee that was valid on the date of payment, or on the date considered to be the date of payment under Rule 30(1)(b), shall be applicable. Where the payment is made after the due date, the fee that was valid on the due date shall be applicable.

(e) Where the amount of any fee other than the fees referred to in subparagraphs (a), (b), (c) and (d) is changed, the amount valid on the date on which the fee was received by the International Bureau shall be applicable.

*Rule 35*  
*Currency of Payments*

(1) [*Obligation to Use Swiss Currency*] All payments due under these Regulations shall be made to the International Bureau in Swiss currency irrespective of the fact that, where the fees are paid by an Office, that Office may have collected those fees in another currency.

(2) [*Establishment of the Amount of Individual Fees in Swiss Currency*] (a) Where a Contracting Party makes a declaration under Article 8(7)(a) of the Protocol that it wants to receive an individual fee, the amount of the individual fee indicated to the International Bureau shall be expressed in the currency used by its Office.

(b) Where the fee is indicated in the declaration referred to in subparagraph (a) in a currency other than Swiss currency, the Director General shall, after consultation with the Office of the Contracting Party concerned, establish the amount of the individual fee in Swiss currency on the basis of the official exchange rate of the United Nations.

(c) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Office of that Contracting Party may ask the Director General to establish a new amount of the individual fee in Swiss currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

(d) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is lower by at least 10% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Director General shall establish a new amount of the individual fee in Swiss currency according to the current official exchange rate of the United Nations. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

*Rule 36*  
*Exemption From Fees*

Recording of the following shall be exempt from fees:

(i) the appointment of a representative, any change concerning a representative and the cancellation of the recording of a representative,

- holder,
- (ii) any change concerning the telephone and telefacsimile numbers of the holder,
  - (iii) the cancellation of the international registration,
  - (iv) any renunciation under Rule 25(1)(a)(iii),
  - (v) any limitation effected in the international application itself under Rule 9(4)(a)(xiii) or in a subsequent designation under Rule 24(3)(a)(iv),
  - (vi) any request by an Office under Article 6(4), first sentence, of the Agreement or Article 6(4), first sentence, of the Protocol,
  - (vii) the existence of a judicial proceeding or of a final decision affecting the basic application, or the registration resulting therefrom, or the basic registration,
  - (viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rules 18*bis* or 18*ter* or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),
  - (ix) the invalidation of the international registration,
  - (x) information communicated under Rule 20,
  - (xi) any notification under Rule 21 or Rule 23,
  - (xii) any correction in the International Register.

#### *Rule 37*

#### *Distribution of Supplementary Fees and Complementary Fees*

(1) The coefficient referred to in Article 8(5) and (6) of the Agreement and Article 8(5) and (6) of the Protocol shall be as follows:

for Contracting Parties which examine only for absolute grounds of refusal	two
for Contracting Parties which also examine for prior rights:	
(a) following opposition by third parties	three
(b) <i>ex officio</i>	four

(2) Coefficient four shall also be applied to Contracting Parties which carry out *ex officio* searches for prior rights with an indication of the most significant prior rights.

#### *Rule 38*

#### *Crediting of Individual Fees to the Accounts of the Contracting Parties Concerned*

Any individual fee paid to the International Bureau in respect of a Contracting Party having made a declaration under Article 8(7)(a) of the Protocol shall be credited to the account of that Contracting Party with the International Bureau within the month following the month in the course of which the recording of the international registration, subsequent designation or renewal for which that fee has been paid was effected or the payment of the second part of the individual fee was recorded.

## Chapter 9 Miscellaneous

### *Rule 39*

#### *Continuation of Effects of International Registrations in Certain Successor States*

(1) Where any State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting Party (“the predecessor Contracting Party”) has deposited with the Director General a declaration of continuation the effect of which is that the Agreement, the Protocol, or both the Agreement and the Protocol are applied by the successor State, the effects in the successor State of any international registration with a territorial extension to the predecessor Contracting Party which is effective from a date prior to the date fixed under paragraph (2) shall be subject to

(i) the filing with the International Bureau, within six months from the date of a notice addressed for that purpose by the International Bureau to the holder of the international registration concerned, of a request that such international registration continue its effects in the successor State, and

(ii) the payment to the International Bureau, within the same time limit, of a fee of 41 Swiss francs, which shall be transferred by the International Bureau to the Office of the successor State, and of a fee of 23 Swiss francs for the benefit of the International Bureau.

(2) The date referred to in paragraph (1) shall be the date notified by the successor State to the International Bureau for the purposes of this Rule, provided that such date may not be earlier than the date of independence of the successor State.

(3) The International Bureau shall, upon receipt of the request and the fees referred to in paragraph (1), notify the Office of the successor State and make the corresponding recording in the International Register.

(4) With respect to any international registration concerning which the Office of the successor State has received a notification under paragraph (3), that Office may only refuse protection if the applicable time limit referred to in Article 5(2) of the Agreement or in Article 5(2)(a), (b) or (c) of the Protocol has not expired with respect to the territorial extension to the predecessor Contracting Party and if the notification of refusal is received by the International Bureau within that time limit.

(5) This Rule shall not apply to the Russian Federation, nor to a State which has deposited with the Director General a declaration according to which it continues the legal personality of a Contracting Party.

### *Rule 40*

#### *Entry into Force; Transitional Provisions*

(1) [*Entry into Force*] These Regulations shall enter into force on April 1, 1996, and shall, as of that date, replace the Regulations under the Agreement as in force on March 31, 1996 (hereinafter referred to as “the Regulations under the Agreement”).

(2) [General Transitional Provisions] (a) Notwithstanding paragraph (1),

(i) an international application the request for presentation to the International Bureau of which was received, or is deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin before April 1, 1996, shall, to the extent that it conforms to the requirements of the Regulations under the Agreement, be deemed to conform to the applicable requirements for the purposes of Rule 14;

(ii) a request for the recording of a change under Rule 20 of the Regulations under the Agreement sent by the Office of origin or by another interested Office to the International Bureau before April 1, 1996, or, where such date can be identified, whose date of receipt by the Office of origin or by another interested Office for presentation to the International Bureau is earlier than April 1, 1996, shall, to the extent that it conforms to the requirements of the Regulations under the Agreement, be deemed to conform to the applicable requirements for the purposes of Rule 24(7) or to be in order for the purposes of Rule 27;

(iii) an international application, or a request for the recording of a change under Rule 20 of the Regulations under the Agreement, that, before April 1, 1996, has been the subject of any action by the International Bureau under Rules 11, 12, 13 or 21 of the Regulations under the Agreement, shall continue to be processed by the International Bureau under the said Rules; the date of the resulting international registration or recording in the International Register shall be governed by Rule 15 or 22 of the Regulations under the Agreement;

(iv) a notification of refusal or a notification of invalidation sent by the Office of a designated Contracting Party before April 1, 1996, shall, to the extent that it conforms to the requirements of the Regulations under the Agreement, be deemed to conform to the applicable requirements for the purposes of Rule 17(4) and (5) or of Rule 19(2).

(b) For the purposes of Rule 34(7), the fees valid at any date before April 1, 1996, shall be the fees prescribed by Rule 32 of the Regulations under the Agreement.

(c) Notwithstanding Rule 10(1), where, in accordance with Rule 34(7)(a), the fees paid in respect of the filing of an international application are the fees prescribed for 20 years by Rule 32 of the Regulations under the Agreement, no second instalment shall be due.

(d) Where, in accordance with Rule 34(7)(b), the fees paid in respect of a subsequent designation are the fees prescribed by Rule 32 of the Regulations under the Agreement, paragraph (3) shall not apply.

(3) [Transitional Provisions Applicable to International Registrations for Which Fees Have Been Paid for 20 Years] (a) Where an international registration for which the required fees had been paid for 20 years is the subject of a subsequent designation under Rule 24 and where the current term of protection of that international registration expires more than ten years after the effective date of the subsequent designation as determined in accordance with Rule 24(6), the provisions of subparagraphs (b) and (c) shall apply.

(b) Six months before the expiry of the first period of ten years of the current term of protection of the international registration, the International Bureau shall send to the holder and his representative, if any, a notice indicating the exact date of expiry of the first period of ten years and the Contracting Parties which were the subject of subsequent designations referred to in subparagraph (a). Rule 29 shall apply *mutatis mutandis*.

(c) Payment of complementary and individual fees corresponding to the fees referred to in Rule 30(1)(iii) shall be required for the second period of ten years in respect of the subsequent designations referred to in subparagraph (a). Rule 30(1) and (3) shall apply *mutatis mutandis*.

(d) The International Bureau shall record in the International Register the fact that payment has been made to the International Bureau for the second period of ten years. The date of recording shall be the date of expiry of the first period of ten years, even if the fees required are paid within the period of grace referred to in Article 7(5) of the Agreement and in Article 7(4) of the Protocol.

(e) The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the fact that payment has or has not been made for the second period of ten years and shall at the same time inform the holder.

(4) *[Transitional Provisions Concerning Languages]* (a) Rule 6 as in force before April 1, 2004, shall continue to apply to any international application filed before that date and to any international application governed exclusively by the Agreement filed between that date and August 31, 2008, inclusively, to any communication relating thereto and to any communication, recording in the International Register or publication in the Gazette relating to the international registration resulting therefrom, unless

(i) the international registration has been the subject of a subsequent designation under the Protocol between April 1, 2004, and August 31, 2008; or

(ii) the international registration is the subject of a subsequent designation on or after September 1, 2008; and

(iii) the subsequent designation is recorded in the International Register.

(b) For the purposes of this paragraph, an international application is deemed to be filed on the date on which the request to present the international application to the International Bureau is received, or deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin, and an international registration is deemed to be the subject of a subsequent designation on the date on which the subsequent designation is presented to the International Bureau, if it is presented directly by the holder, or on the date on which the request for presentation of the subsequent designation is filed with the Office of the Contracting Party of the holder if it is presented through the latter.

(5) *[Transitional Provision Relating to Statements of Grant of Protection]* No Office shall be obliged to send statements of grant of protection under Rule 18<sup>ter</sup>(1) before January 1, 2011.

#### *Rule 41*

##### *Administrative Instructions*

(1) *[Establishment of Administrative Instructions; Matters Governed by Them]* (a) The Director General shall establish Administrative Instructions. The Director General may modify them. Before establishing or modifying the Administrative Instructions, the Director General shall consult the Offices which have a direct interest in the proposed Administrative Instructions or their proposed modification.

(b) The Administrative Instructions shall deal with matters in respect of which these Regulations expressly refer to such Instructions and with details in respect of the application of these Regulations.

(2) *[Control by the Assembly]* The Assembly may invite the Director General to modify any provision of the Administrative Instructions, and the Director General shall proceed accordingly.



(3) *[Publication and Effective Date]* (a) The Administrative Instructions and any modification thereof shall be published in the Gazette.

(b) Each publication shall specify the date on which the published provisions become effective. The dates may be different for different provisions, provided that no provision may be declared effective prior to its publication in the Gazette.

(4) *[Conflict with the Agreement, the Protocol or These Regulations]* In the case of conflict between, on the one hand, any provision of the Administrative Instructions and, on the other hand any provision of the Agreement, the Protocol or these Regulations, the latter shall prevail.



**ADMINISTRATIVE INSTRUCTIONS FOR THE APPLICATION OF THE MADRID  
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION  
OF MARKS AND THE PROTOCOL RELATING THERETO**

(as in force on January 1, 2008)

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- Part Seven: Payment of Fees*  
Section 19: Modes of Payment

## **Part One Definitions**

### *Section 1: Abbreviated Expressions*

- (a) For the purposes of these Administrative Instructions:
- (i) “Regulations” means the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement;
  - (ii) “Rule” means a Rule of the Regulations.
- (b) For the purposes of these Administrative Instructions an expression which is referred to in Rule 1 has the same meaning as in the Regulations.

## **Part Two Forms**

### *Section 2: Prescribed Forms*

For any procedure for which the Common Regulations prescribe the use of a form, the International Bureau shall establish such a form.

### *Section 3: Optional Forms*

In respect of procedures under the Common Regulations other than those referred to in Section 2, the International Bureau may establish optional forms.

### *Section 4: Publication of Forms*

The complete list of all available prescribed and optional forms, as referred to in Sections 2 and 3, shall be published in each issue of the Gazette.

### *Section 5: Availability of Forms*

The International Bureau shall make available all prescribed and optional forms, as referred to in Sections 2 and 3, on its website and, upon request, on paper.

### **Part Three**

#### **Communications with the International Bureau; Signature**

##### *Section 6: Communication in Writing; Several Documents in One Envelope*

(a) Subject to Section 11(a), communications addressed to the International Bureau shall be effected in writing by typewriter or other machine and shall be signed.

(b) If several documents are mailed in one envelope, they should be accompanied by a list identifying each of them.

##### *Section 7: Signature*

A signature shall be handwritten, printed or stamped; it may be replaced by the affixing of a seal or. As regards the electronic communication referred to in Section 11(a), a signature may be replaced by a mode of identification agreed upon between the International Bureau and the Office concerned. With respect to the electronic communications referred to in Section 11(a)(ii), a signature may be replaced by a mode of identification to be determined by the International Bureau.

##### *Section 8: Communications by Telefacsimile*

Any communication may be addressed to the International Bureau by telefacsimile, provided that, where the communication must be presented on an official form, the official form is used for the purposes of the telefacsimile communication.

##### *Section 9: The Original Reproduction or Reproductions of the Mark*

(a) Where the international application is sent by the Office of origin to the International Bureau by telefacsimile, the original of the page of the official form bearing the reproduction or reproductions of the mark, signed by the Office of origin and containing sufficient indications to allow identification of the international application to which it relates, shall be sent to the International Bureau.

(b) Where an international application is addressed to the International Bureau by telefacsimile, examination by the International Bureau as to conformity of the international application with the applicable requirements shall start

(i) upon receipt of the original if such an original is received within a period of one month from the date on which the communication by telefacsimile was received, or

(ii) upon expiry of the period of one month referred to in subparagraph (i) if the said original is not received by the International Bureau within that period.

*Section 10: Acknowledgement and Date of Receipt of Telefacsimile  
by the International Bureau*

(a) The International Bureau shall promptly and by telefacsimile inform the sender of a telefacsimile communication of the receipt of that communication, and, where the telefacsimile communication received is incomplete or illegible, of that fact also, provided that the sender can be identified and can be reached by telefacsimile.

(b) Where a communication is transmitted by telefacsimile and, because of the time difference between the place from where the communication is transmitted and Geneva, the date on which the transmittal started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.

*Section 11: Electronic Communications; Acknowledgement  
and Date of Receipt of Electronic Transmission  
by the International Bureau*

(a) (i) Where an Office so desires, communications between that Office and the International Bureau, including the presentation of the international application, shall be by electronic means in a way agreed upon between the International Bureau and the Office concerned.

(ii) Communications between the International Bureau and applicants and holders may take place by electronic means, at a time and in a manner and format to be determined by the International Bureau, the particulars of which shall be published in the Gazette.

(b) The International Bureau shall promptly and by electronic transmission inform the originator of an electronic transmission of the receipt of that transmission, and, where the electronic transmission received is incomplete or otherwise unusable, also of that fact, provided that the originator can be identified and can be reached.

(c) Where a communication is by electronic means and, because of the time difference between the place from where the communication is sent and Geneva, the date on which the sending started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.

## **Part Four**

### **Requirements Concerning Names and Addresses**

#### *Section 12: Names and Addresses*

(a) In the case of a natural person, the name to be indicated is the family or principal name and the given or secondary name(s) of the natural person.

(b) In the case of a legal entity, the name to be indicated is the full official designation of the legal entity.

(c) In the case of a name in characters other than Latin characters, the indication of that name shall consist of a transliteration into Latin characters which shall follow the phonetics of the language of the international application. In the case of a legal entity whose name is in characters other than Latin characters, the said transliteration may be replaced by a translation into the language of the international application.

(d) An address shall be given in such a way as to satisfy the customary requirements for prompt postal delivery and shall consist, at least, of all the relevant administrative units up to, and including, the house number, if any; in addition, telephone and telefacsimile numbers, an e-mail address as well as a different address for correspondence may be indicated.

#### *Section 13: Address for Correspondence*

Where there are two or more applicants, new owners or licensees with different addresses, one address for correspondence shall be indicated. Where no such address is indicated, the address of the person named first shall be treated as the address for correspondence.

## **Part Five**

### **Notification of Provisional Refusals**

#### *Section 14: Date of Sending of Notification of Provisional Refusal*

In the case of a notification of provisional refusal sent through a postal service, the date of dispatch shall be determined by the postmark. If the postmark is illegible or missing, the International Bureau shall treat such notification as if it was sent 20 days before the date of its receipt by the International Bureau. However, if the date of dispatch thus determined is earlier than any date of refusal or date of sending mentioned in the notification, the International Bureau shall treat such notification as if it had been sent on the latter date. In the case of a notification of refusal sent through a delivery service, the date of dispatch shall be determined by the indication given by such delivery service on the basis of the details of the mailing as recorded by it.

*Section 15: Contents of a Notification of Provisional Refusal Based on an Opposition*

(a) A notification of provisional refusal based on an opposition shall be confined to the elements specified in Rule 17(2) and (3). The indication of the grounds on which the provisional refusal is based, in accordance with Rule 17(2)(iv), shall, in addition to stating that the refusal is based on an opposition, state concisely what are the grounds of the opposition (for example, conflict with an earlier mark or other right, lack of distinctive character). Where the opposition is based on a conflict with an earlier right other than a mark which is registered or is the subject of an application for registration, that right, and preferably the owner of that right, shall be identified as concisely as possible. The notification shall not be accompanied by memoranda or evidence.

(b) Any document accompanying the notification which is not on separate sheets of A4 paper or is otherwise not suitable for scanning, and any non-documentary item such as samples or packaging, will not be recorded and will be disposed of by the International Bureau.

**Part Six**  
**Numbering of International Registrations**

*Section 16: Numbering Following Partial Change in Ownership*

(a) Assignment or other transfer of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration of which a part has been assigned or otherwise transferred.

(b) Any assigned or otherwise transferred part shall be cancelled under the number of the said international registration and recorded as a separate international registration. The separate international registration shall bear the number of the registration of which a part has been assigned or otherwise transferred, together with a capital letter.

*Section 17: Numbering Following Merger of International Registrations*

The international registration resulting from the merger of international registrations in accordance with Rule 27(3) shall bear the number of the international registration of which a part had been assigned or otherwise transferred together, where applicable, with a capital letter.

*Section 18: Numbering Following Declaration that a  
Change in Ownership Has No Effect*

The separate international registration which is recorded in the International Register in accordance with Rule 27(4)(e) shall bear the number of the registration of which a part has been assigned or otherwise transferred, together with a capital letter.



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**Part Seven**  
**Payment of Fees**

*Section 19: Modes of Payment*

Fees may be paid to the International Bureau

- (i) by debit to a current account with the International Bureau,
- (ii) by payment into the Swiss postal account or to any of the specified bank accounts of the International Bureau,
- (iii) by credit card, where, in the context of an electronic communication envisaged in Section 11, an electronic interface for online payment has been made available by the International Bureau.



## CONDITIONS FOR OPENING, USING AND CLOSING A CURRENT ACCOUNT AT WIPO

### 1. General provisions:

Upon the request of regular clients of the Organization, WIPO is offering to open a current account **in Swiss Francs (CHF)** to pay WIPO's services provided (e.g. fees, cost of publications, or expenses for any other WIPO services requested). The opening of a current account is not justified unless a client effects, or envisages effecting, **a significant number** of operations on a regular basis (more than five transactions per month).

### 2. Requirements for the opening of a current account:

- 2.1 In order to open a current account, a **signed written request** must be presented, and the payment of an initial sum of at **least 5,000 Swiss francs**, or more, depending upon the number of transactions envisaged, must be made into WIPO's bank account (see bank references under 5.3 hereunder). **Please state "To open current account" in your bank deposit.**

The request should contain all the necessary contact details of the person or the organization in whose name the account is to be opened (i.e. identity, address, telephone number, fax number, e-mail address, person to contact etc.) A copy of the official registration of the company in its country is also requested.

The current account will not be opened until all the documents and the initial deposit have been received.

- 2.2 The request for the opening of an account should be sent to the following address:

World Intellectual Property Organization (WIPO)  
Finance Department – Income Section  
34, chemin des Colombettes  
1211 Geneva 20  
Switzerland

Telephone: (+41) 22 338 9111

Facsimile: (+41) 22 734 4693

or the signed request may be scanned and sent by e-mail to:

[income.accounts@wipo.int](mailto:income.accounts@wipo.int)

### 3. Administration of the current account:

- 3.1 The current account will be kept only in Swiss francs, at the headquarters of WIPO in Geneva.
- 3.2 No administrative fees will be deducted for the current account's management.

- 3.3 The WIPO current accounts do not produce interests.
- 3.4 Upon request, the holder of a current account can be granted an Internet access to consult his/her account online (see Annex I).
4. Conditions of operation of the current account:
- 4.1 **The current account will be opened only after receipt of the payment of the initial sum and of the official documents.** The account number will then be communicated by e-mail or fax to the holder of the account, who must quote this number when authorizing the charging of fees to the account.
- 4.2 **An amount sufficient** to cover all payments required in respect of fees, services, publications, etc., **should always be available in the account.**
- 4.3 Debits will be entered, by the Finance Section of WIPO, on the current account in chronological order of receipt of requests for transactions to be made.
- 4.4 The holder of the current account who do not have an internet access or an email address, will receive, each month, by normal mail a detailed statement of the transactions recorded for the account for the preceeding month. For holders with an email address, they will receive their monthly statement electronically.
- 4.5 The account holder must immediately, upon receipt of the statement, inform WIPO of any error which may be noted.
- 4.6 The holder of the current account will receive, by email or by post, an acknowledgment of receipt for each deposit received into the current account.
5. Payments into the current account:
- 5.1 The payment of the initial deposit and subsequent payments replenishing the account should be made in Swiss francs. If any such payment is made in a currency other than Swiss francs, it will be accepted provided that the currency in question is freely convertible into Swiss francs, and the amount of the payment will then be converted, for crediting to the current account, into Swiss francs at the exchange rate in effect at the time.
- 5.2 Based upon the activities forecast, the holder of the current account must ensure that the account will be sufficiently funded, by means of single lump sum payments.
- 5.3 The initial deposit should state “to open a current account”.
- 5.4 All other payments must state as purpose of payment “**to replenish current account No. ...**”.

### 5.5 They may be effected:

- (i) by check drawn on a Swiss or foreign bank made payable to WIPO/OMPI and sent to:

World Intellectual Property Organization (WIPO)  
Finance Department – Income Section  
34, chemin des Colombettes  
1211 Geneva 20  
Switzerland

- (ii) by direct bank transfer to:

Bank name:	Credit Suisse – 1211 Geneva 70 – Switzerland
Account name:	WIPO/OMPI
Account number (IBAN):	CH51 0483 5048 7080 8100 0
SWIFT code:	CRESCH ZZ80A

- (iii) by transfer to WIPO postal account:

CCP No. 12-5000-8 or (IBAN): CH03 0900 0000 1200 5000 8  
at SWISS POST/Postfinance  
Engenhaldenstrasse 37 – 3030 Bern  
SWIFT code: POFICHBE

- 5.6 Any payment received in Swiss Francs (CHF) on behalf of a holder of a current account will automatically be credited to his/her current account and considered as replenishment of the account.

## 6. Operations paid from the current account:

- 6.1 The account may only be debited for payment of fees, costs incurred in respect of publications, or charges due to WIPO for other services.
- 6.2 A current account will be debited based on a written authorization or on a transaction requested by the holder of the current account. The holder may authorize other staff members of the company to use the account. A same WIPO account can be used by various locations in the country of the same company. It is the responsibility of the holder of the current account to monitor these authorizations.

For example, the completion of the Fee Calculation sheet attached to the request form being part of a PCT international application, with the authorization to debit the current account, will be considered as a written request. Likewise a registration form for a WIPO or UPOV workshop will be considered as authorization to debit the current account if this mean of payment is selected on the form.

Requests relating to trademarks may be filed with a national office and will be acted upon when transmitted to WIPO.

- 6.3 The debit order must contain the particulars necessary to clearly identify the purpose of the payment and must indicate the number of the account which is to be debited.
- 6.4 No transaction will be carried out if it would cause the current account to be overdrawn.
- 6.5 An authorization to charge a fee to a current account will not be considered payment of the fee unless sufficient funds are present in the account to cover such fee.
7. Closure of the current account:
- 7.1 The current account may be closed, at any time, upon written request by the holder or, if appropriate, by the successor in title of the holder.
- 7.2 The current account holder should make sure that all transactions are paid and completed before requesting the closing of the account.
- 7.3 The credit balance will be refunded by check or by transfer made out to the holder of the account or his successor in title.
- 7.4 A form is sent to the account's holder requesting full bank account information to which the funds will be transferred, and authorized signatures. The funds cannot be refunded on a bank account with a different identity than the WIPO account's holder, except in specific cases (litigation).
- 7.5 Once the instructions have been received, WIPO will start the closing procedure which includes several steps:
- new debit instructions are blocked
  - on-going transactions are reviewed, processed to their final stage and closed
  - balance is then refunded
- 7.6 WIPO reserves the right to close, on its own initiative, any account for which the provisions set out in this document are not fulfilled, or which fails to comply with the above regulations. The same shall apply in respect of accounts in which there has not been any movement for more than one year.

[Annex follows]

## ANNEX

**FOR THE ATTENTION OF WIPO CURRENT ACCOUNT ADMINISTRATORS**

Consultation of balances and movements of a WIPO current account is now available to account owners via the Internet.

The parameters of access are encrypted, and allow the review and printing of a statement as well as of a particular transaction including as far as possible owner's reference.

These parameters also allow the use of our **E-Renewal Trademark System**, available at : [https://webaccess.wipo.int/trademarks\\_ren/](https://webaccess.wipo.int/trademarks_ren/)

The information required for WIPO to set-up access is as follows:

- Current Account No.;
- Last Name of the Administrator, or Name of the department managing the account;
- First Name of the Administrator (or Last Name of the Administrator when a department is designated as mentioned above);
- Email address of the Administrator, or of the department managing the account.

Upon receipt of the aforementioned information, a password and an ID will be sent, which will allow immediate access to the account via the Internet as well as our E-Renewal system.

This facility is free of charge.

All communication relating to the management of a Current Account should be sent by e-mail to: [income.accounts@wipo.int](mailto:income.accounts@wipo.int)

[End of Annex and of document]

