

# Guide to the Madrid System

International Registration  
of Marks under the  
Madrid Protocol





# **GUIDE TO THE MADRID SYSTEM**

## **INTERNATIONAL REGISTRATION OF MARKS UNDER THE MADRID PROTOCOL**

(updated 2022)

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World Intellectual Property Organization (WIPO)  
Geneva  
WIPO Publication No. 455E/22  
WIPO 2022

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# CHAPTER I: INTRODUCTION

## THE GUIDE

1. This Guide concerns the international registration of marks under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Protocol), referred to as “the Madrid System”, which is administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland.
2. The purpose of this Guide is to provide information and practical advice to brand owners wishing to protect their trademarks outside of their home market, as well as to inform Intellectual Property Offices (IP Offices) that are members of the Madrid System, about their roles, responsibilities and tasks under the Madrid System.
3. The Guide has four Chapters:
  - [Chapter I](#) is an introduction to the Madrid System, which contains useful information for all its users, namely, applicants and holders of international registrations and their representatives, as well as Officials of the IP Offices of its members. This Chapter provides a brief general introduction to the Madrid System and its history; the benefits of the Madrid System and information about procedural matters, such as the methods of communication, the calculation of time limits and the language regime.
  - [Chapter II](#) contains useful and practical information for applicants and holders, including information on all aspects of the Madrid System and the life cycle of the international registration. This Chapter covers the application procedure, subsequent designation, decisions on the scope of protection issued by the Offices of the designated members, the centralized management and various procedures that may concern an international registration during its lifetime (for example, recording of changes, renewal, replacement and transformation).
  - [Chapter III](#) contains useful and practical information for officials in the IP Offices. It provides information on the two roles of an Office as a member; as the Office of origin and the application process, and as the Office of the designated member, including issuing decisions on the scope of protection. This Chapter also explains how a State or an intergovernmental organization with its own system for registering marks can become a member of the Madrid System along with the texts of the different declarations and notifications which may be made under the Protocol or the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Regulations).
  - [Chapter IV](#) contains useful and practical information to any country or intergovernmental organization that is interested in becoming a member of the Madrid System.

4. Wherever possible, [the provisions](#) of the Protocol, the Regulations and the Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Administrative Instructions) that are relevant to a particular paragraph of the Guide, are cited between brackets, at the end of such paragraph. Provisions cited in the Guide are noted as follows:

- [Article xx] refers to an Article of the [Protocol](#);
- [Rule xx] refers to a Rule of the [Regulations](#);
- [A.I. Section xx] refers to a Section of the [Administrative Instructions](#).

5. The use of the word “mark” in this Guide refers to both trademarks (for goods) and service marks.

## THE MADRID SYSTEM

### The Protocol

6. [The Protocol](#) was adopted in 1989, in a Diplomatic Conference held in Madrid, Spain. It entered into force on December 1, 1995 and came into operation on April 1, 1996.

7. In addition to the Protocol, the legal framework of the Madrid System consists of [the Regulations](#) and [the Administrative Instructions](#).

8. Following a decision in the Madrid Union Assembly (the Assembly) in October 2016, the Madrid Agreement Concerning the International Registration of Marks (the Agreement) is now inoperative and the Protocol is the sole governing treaty under the Madrid System<sup>1</sup>. It is no longer possible for countries to accede only to the Agreement. However, it is possible to accede to both the Agreement and to the Protocol at the same time, in which case the Protocol will prevail.

9. The Agreement and the Protocol are separate (though intrinsically linked) treaties that share the same objectives, namely to offer a convenient cost-effective solution for registering and managing trademarks in multiple territories. The Protocol was created to bring more flexibility to the Madrid System and introduced certain new features with the aim of removing the difficulties that prevented certain countries and intergovernmental organizations from adhering to the Agreement.

10. For further information on the freezing of the Agreement and historical comparison between the Protocol and the Agreement, see paragraphs 91 to 101 and 102 to 106.

11. The Contracting Parties, also referred to as members, to the Protocol constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention for the Protection of Industrial Property ([the Paris Convention](#)). For further details on the members of the Union, and the meaning of “members”, see paragraphs 13 to 15.

12. 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 of amendments to the Regulations, including [the Schedule of Fees](#).

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<sup>1</sup> See document [MM/A/50/5](#), paragraph 17.

## Becoming a Member of the Madrid System

13. Any State which is a party (member) to the Paris Convention may become a party (member) to the Protocol. [[Article 14\(1\)\(a\)](#)]
14. The Protocol and the Regulations provide for the possibility for members to make certain declarations and notifications concerning the operation of the international registration system. Details on which members have made which [declaration\(s\)](#) are available on WIPO's website.
15. For further information on becoming a member of the Madrid System and the possible declarations a member may make, see paragraphs 1297 to 1313.

## Who May Use the System?

16. An application for an international registration (international application) may only be filed by a natural person or a legal entity that has a connection to a member of the Madrid System (known as entitlement). This means any natural person or legal entity with a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of a country party to the 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.
17. The IP Office of the member where a person or legal entity fulfills the entitlement condition above, is referred to as the "Office of origin". Before filing an international application, the person or entity must have already filed or registered the same mark in the Office of origin (the basic mark). The Office of origin and the principle of entitlement are explained further, in paragraphs 157 to 165.
18. The Madrid System is a closed system; a connection with a member is needed and protection can only be sought among the members.

## Brief Description of the System

19. An international application must be presented to the International Bureau through the Office of origin. Before the Office of origin transmits the international application to the International Bureau, it must certify that the particulars of the international application correspond to the particulars appearing in the basic mark. Where the International Bureau finds that 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](#) (the Gazette).
20. The International Bureau then notifies the Offices of each of the members designated in the international application (or subsequently in the international registration). From the date of the international registration (or the subsequent designation), the protection of the mark in each of the designated members is the same as if the mark had been filed directly with the Office concerned. Each of those Offices have the right to refuse protection, within the time limit specified in the Protocol. Unless such a refusal is notified to the International Bureau within the applicable time limit, the protection of the mark in each designated member is the same as if it had been registered by the Office of that member. The time limit for an Office to notify a provisional refusal is generally one year (12 months). However, a member may extend this period to 18 months (or longer, in the case of a refusal based on an opposition) by making the relevant declarations (see paragraphs 1299 and 1301).

21. An international registration remains dependent on the basic mark for a period of five years from the date of the international registration. If the basic mark ceases to have effect for any reason, either partially or totally, for example, it is refused, withdrawn, cancelled or not renewed, within this five-year period, the international registration will be cancelled to the same extent. In these cases, upon request from the Office of origin, the International Bureau cancels the international registration either partially or totally, as applicable. After the expiry of this five-year period, the international registration becomes independent of the basic mark.

22. An international registration is valid for 10 years counted from the date of the international registration and may be renewed every 10 years, by payment of the prescribed fees.

### **Advantages of the System**

23. The overall advantage of the Madrid System for trademark owners is that it simplifies the administrative aspect of seeking protection of a trademark in multiple territories, leading to financial savings when obtaining and maintaining the protection of their marks abroad.

24. The Madrid System offers a convenient and cost-effective way for trademark owners to obtain and maintain protection in multiple markets, by filing one application in one language (English, French or Spanish) and paying one set of fees in one currency (Swiss francs). Renewal takes place every 10 years with one simple procedure. This can be compared to filing multiple national or regional applications with different IP Offices, where the trademark owner would need to file separate applications in several languages and pay fees in different currencies, as well as manage different registration numbers, renewal dates and procedures. Additional fees for translations and the use of local representatives would also be incurred when filing national or regional applications.

25. The centralized management feature of the Madrid System also offers a simple and efficient way to manage a global trademark portfolio. Any changes to be made to the international registration, such as a change in name and/or address of the holder, a change in ownership of the holder (total or partial), or a limitation of the list of goods and services in respect of all or some of the designated members, may be recorded and have effect in all the members concerned by means of a single procedure with the International Bureau and the payment of one fee.

26. Another advantage of the Madrid System is that it allows the holder to add further territories to their existing international registration by way of subsequent designation. This gives the holder the flexibility to expand the scope of protection in line with their evolving business strategy and financial situation.

27. A lesser known benefit of the Madrid System is the principle of replacement. Replacement is a procedure that allows holders designating territories where they already have an older national or regional right, to benefit from that earlier date of protection. An international registration will automatically replace a national or regional registration for the same mark, covering the same or overlapping goods and services, recorded in the name of the same holder, without the holder having to do anything. Where replacement has taken place, the replacement has no impact on the national or regional registration; it means that the holder now has two rights – one at the national or regional level and one at the international level. Before deciding whether to let the national or regional mark lapse while still benefiting from the earlier date of protection, the holder is advised to request the Office to take note of the replacement in their national or regional Register. By taking note, the Office concerned acknowledges in its Register that while the date of the international registration may be recent, the holder has had protection in its territory as from the date of the earlier national or regional right.

28. There is no WIPO official form for replacement, so the holder should contact the relevant Office(s) directly. Upon taking note, the Office will notify the International Bureau of this fact, and this fact will be recorded in the International Register. For more information on replacement see paragraphs 823 to 842.

29. Being a member of the Madrid System is also to the advantage of the Offices concerned. For example, Offices of designated members do not need to examine for compliance with formal requirements or classify the goods or services. Also, the International Bureau collects the fees for each member designated and transfers those fees to the Offices of the members concerned.

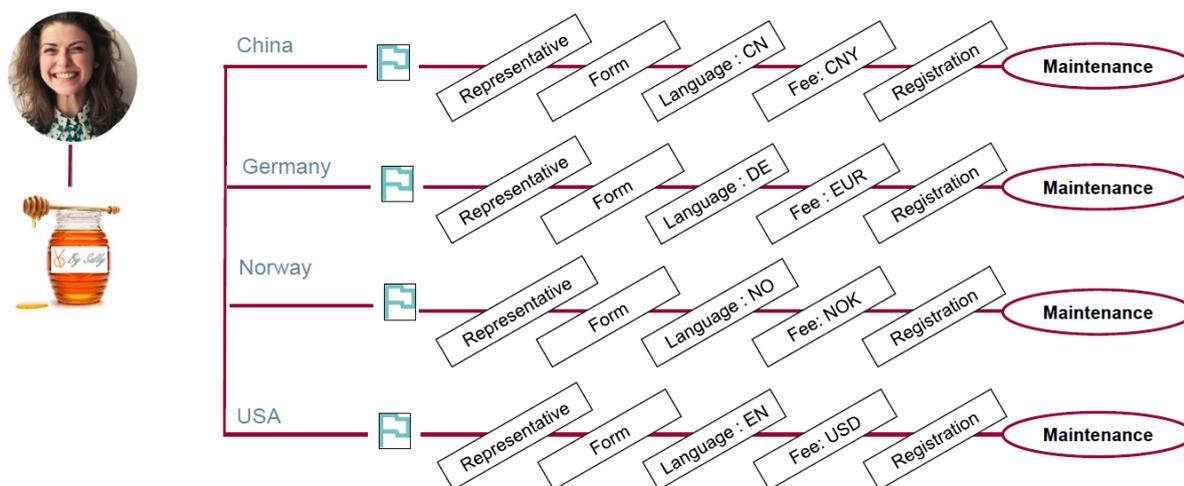
### **Benefits of the Madrid System: Case Study**

30. The following fictitious case helps to illustrate the benefits of using the Madrid System:

*Sally lives in Wonderland Valley, in the French-speaking part of Canada. Sally has developed a unique brand for her honey products and is interested in selling her products in China, Germany, Norway and the United States of America (USA).*

*There are two routes that Sally could take to protect her mark. She could file separate applications in each of the Offices in the territories of interest, namely China, Germany, Norway and the USA, this is referred to as the “direct route” (illustration A), or she could file one international application with the International Bureau of WIPO using the Madrid System, this is referred to as the “international route” (illustration B).*

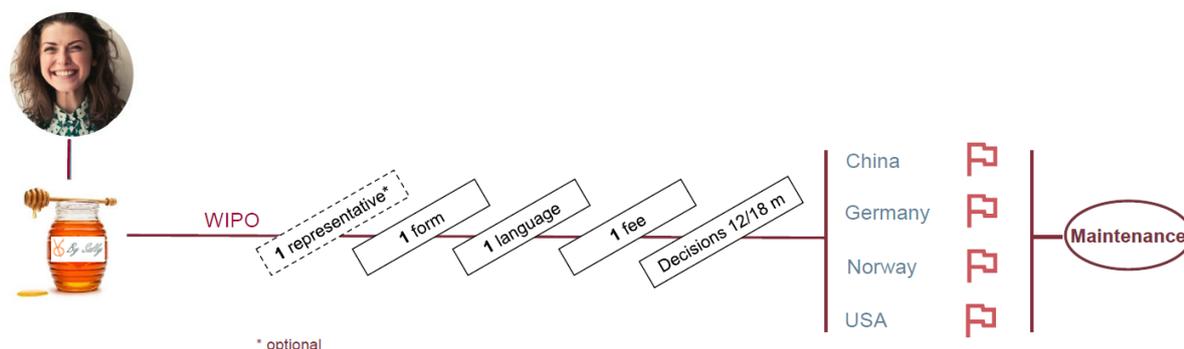
### Illustration A (the Direct Route)



**Illustration A**, provides an overview of the direct route option should Sally decide to file separate applications directly before the IP Offices concerned. Going this route means that she would need to follow the requirements set out in the legislation of each of those countries.

Sally would need to find and instruct a local representative (an attorney or agent) in each of the countries to file the applications on her behalf. This would result in the use of different local application forms and carrying out the application process in four local languages (Chinese, German, Norwegian, English). Sally would also need to pay the required fees in four local currencies.

Protection may ultimately be granted in the various countries, but this would result in independent trademark registrations, with different renewal dates that Sally would need to manage and keep track of. Furthermore, any changes in Sally's position, such as a change in name or address at a later stage, would need to be recorded separately. Such actions, and maintenance of the rights would need to be carried out before each of the Offices concerned, through a local representative, following the domestic processes and requirements. This would mean completing specific forms and paying fees in local currencies. These are parallel processes that are possible, but Sally would need to carefully manage each of the registrations and there could be significant cost implications.

**Illustration B (the Madrid Route)**

**Illustration B** provides an overview of the Madrid System, an alternative option for protecting marks abroad.

To use the Madrid System, Sally would need to have a connection with a Madrid member, that is, be a national of, domiciled in, or have a place of business in a member. As a national of Canada, Sally meets this requirement as Canada is a member. She is also domiciled in and has her place of business there. Sally has already registered her mark with the Canadian IP Office (CIPO), so she also meets the requirement to have a basic mark with the Office of her member, i.e., her Office of origin. It is possible to base the international application on a national application, but that could be risky because if the application does not proceed to a national registration, it would lead to cancellation of the international registration.

The Madrid System is a good option for Sally, because all her countries of interest are members of the Madrid System, allowing her to make the most of the simplified international registration process. This means she would only need to file an international application through her Office of origin, namely CIPO.

As a French speaker, Sally may choose to file the international application in French because CIPO gives applicants the choice to use either English or French. Sally would need to specify the countries where she is seeking protection, i.e., China, Germany, Norway and the USA. Sally would then need to pay the relevant fees in one currency (Swiss francs). This is referred to as centralized filing with the International Bureau.

There is no requirement for Sally to use a local representative at the time of filing and there is no requirement to translate the application into different languages. However, though it is not necessary to use a representative to file an international application, it may be a good investment to seek advice from an attorney or trademark agent with knowledge of the Madrid System that can provide pre-filing assistance. Such assistance may ensure that the application is prepared properly to meet the requirements of the Madrid System, and to avoid possible future problems with the designated members. While this could add costs initially, it could also lead to substantial savings later.

*CIPO will examine the international application and compare the particulars of the international application with the particulars of the basic mark. If the particulars correspond, i.e., the holders are the same, the marks are the same, and the goods and services covered by the international application fall within the scope of those covered by the basic mark, CIPO will certify the application and send it to the International Bureau.*

*It is important to note that the International Bureau will examine the application for formalities only, it will not decide whether a mark may be protected in the designated members (i.e., in Sally's case, China, Germany, Norway and the USA). Once the International Bureau has received the completed international application and payment of the fees, the application will be translated into the working languages of the Madrid System (English, French and Spanish) and the mark will be recorded. The international registration will be published in the official [Gazette](#), and WIPO will send a registration certificate to Sally.*

*Sally now has an international registration, which may ultimately be granted protection in multiple countries (China, Germany, Norway and the USA) that she can manage centrally with one date for renewal.*

*WIPO will notify the Offices of the members she has designated, namely China, Germany, the Norway and the USA. At this stage, Sally does not know whether her mark will be granted full protection, as these Offices will now examine the international registration in line with their own national trademark legislation and practice, just as they would have done if Sally had chosen the direct route.*

*The Offices of the designated members will examine the mark and notify Sally of their decision within a given time limit. Members of the Madrid System have a time limit of one year to refuse protection of the mark, but they may declare that the time limit is extended to 18 months. A list of [declarations](#) made by members of the Madrid System and [useful information](#) concerning various members and their time limits (one year or 18 months) are available on WIPO's website, so Sally would know within which time limit to expect a decision.*

*If an Office finds grounds to refuse protection of the mark, that Office must notify Sally through the International Bureau of its provisional refusal (first Office action). A refusal by one Office would not affect the possible decisions by the other Offices. Sally may contest that provisional refusal within the applicable means set out in the relevant national legislation – just as if the mark had been filed directly. It is only at this stage that Sally would need a local representative (attorney or agent), to contest a refusal before that Office concerned.*

*Where the Offices grant protection, Sally's rights in those countries under the Madrid System would be the same as if she had filed applications directly with those Offices.*

*Should Sally need to record a change, for example, to her name or address, or wish to renew the registration in 10 years' time, she can manage this directly with the International Bureau by submitting the relevant request and paying the required fees. WIPO will record the change or the renewal for all the members covered. This is part of the centralized management of her rights.*

*If Sally later decides to export to further countries, she can add more Madrid members to her existing international registration, known as subsequent designation, while continuing to manage and maintain one registration with one renewal date to keep track of. Subsequent designation is particularly*

*beneficial for small and medium sized enterprises (SMEs) like Sally, who may wish to initially protect their mark in two or three members, as it allows them to add new export markets to their existing international registration as their business expands. Sally could file a request for subsequent designation directly with WIPO using the online form. It would not be necessary to file the subsequent designation through the Canadian Office. The date of protection in those additional markets will be from the date of the subsequent designation. However, Sally would still benefit from centralized management.*

*The comparison of costs and ease of management of the two routes are illustrated in the following tables.*

**Costs Comparison (Applications)**

<b>Madrid System</b>	<b>Direct Route</b>
Basic fee (mark in color): CHF 930	N/A
Fees for each of the designations (China, Germany, Norway and the USA in 2 classes of goods/services)	Official fees for each territory: China, Germany, Norway and the USA in 2 classes of goods/services  Additional costs:  4 x translations  4 x local representatives fees
<b>Total CHF 2,513</b>	<b>Total CNY/EUR/NOK/USD</b>

*Using the Madrid System, Sally would need pay a basic fee to the International Bureau (903 Swiss francs for a mark in color), and then the fees for each of the designated members where she is seeking protection. In this particular case, Sally would pay a total of 2,513 Swiss francs.*

*In comparison, using the national route, Sally would not need to pay the basic fee to the International Bureau, but she would need to pay the official fees, which should be the same or more compared to what she would pay for the designations in the Madrid System. In addition, there are costs for using the direct route that would not apply to the Madrid System, for example, Sally would incur costs for translations of her details into Chinese, Norwegian, German and English. She would also need to pay for four local representatives (attorneys or agents), to file the applications on her behalf in the four IP Offices. These additional costs would result in far higher fees than the basic fee payable to the International Bureau.*

### **Costs Comparison (Management of Rights)**

<b>Madrid System</b>	<b>Direct Route</b>
Change in name/address: CHF 150	Official fees for 4 countries and 4 x translations + local attorney fees
Change in ownership: CHF 177	Official fees for 4 countries and 4 x translations + local attorney fees
Renewal: CHF 653 basic mark + fees for each territory	Official fees for 4 countries and 4 x translations + local attorney fees

*Once the international registration has obtained protection in each of the members concerned, Sally would incur costs for the maintenance of her rights. The centralized management feature of the Madrid System means maintenance is straightforward, with fixed fees. Costs could quickly escalate, however, when maintaining the mark via the direct route before each of the Offices. For example, should she need to record a change in her name or address, or renew the marks, she would need to manage this through her local representatives before each of the four Offices concerned.*

## **IMPORTANT PROCEDURAL MATTERS FOR ALL USERS**

### **Communications with the International Bureau**

31. The following paragraphs contain important information concerning communications with the International Bureau (including the methods of communication, the calculation of time limits and the language of communication), the payment of fees and representation before the International Bureau.

32. Three kinds of communications are, in principle, possible:

- between the International Bureau and the Office of a member;
- between the International Bureau and the applicant or holder (or representative);
- between the applicant or holder (or representative) and an Office.

33. Communications that 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 Protocol and of the Regulations. They are a matter for the law and practice of the member concerned.

34. Communications between the International Bureau and an Office or applicant or holder are governed by the Regulations and the Administrative Instructions. The Regulations sometimes allow the applicant or holder to choose whether to communicate directly with the International Bureau or through an Office, for example, where the holder may submit a request for a subsequent designation directly to the International Bureau or through an Office. However, such choice is not always given, for example, an international application must always be filed through the Office of origin.

35. 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 their representative, where such is recorded in the International Register for that applicant or holder (see paragraphs 187 to 216).

### Methods of Communications

36. Any communication between an Office and the International Bureau, including the presentation of an international application, should be made by electronic transmission. The methods 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. [\[A.I. Section 11\(a\)\(i\)\]](#)

37. The preference of the International Bureau is to communicate electronically with the Offices and its users. The International Bureau notifies Offices electronically and these Offices also transmit their communications to the International Bureau electronically. It is no longer possible to communicate with the International Bureau by facsimile.

### Mandatory E-mail Address for Applicants, Holders and Representatives

38. Communications between the International Bureau and applicants and holders should be by electronic means. As of February 1, 2021, it is mandatory for new applicants, new holders following change in ownership and new representatives to provide their individual e-mail address to the International Bureau, following amendments to Rules 3(2)(a), 9(4)(a)(ii) and (iii) and 25(2)(a)(iii) of the Regulations. It is mandatory to provide the e-mail addresses in the international application, in a request for the recording of a change in ownership, and in a separate communication ([MM12 form](#) or the [online version](#); see also the [Note for filing MM12](#)) for appointing a representative. [\[Rule 3\(2\)\(a\)\]](#) [\[Rule 9\(4\)\(a\)\(ii\) and \(iii\)\]](#) [\[Rule 25\(2\)\(a\)\(iii\)\]](#)

39. This means that where the International Bureau has the e-mail address of the applicant, holder or their representative, all communications from the International Bureau will be sent to that e-mail address. [\[A.I. Section 11\(a\)\(ii\)\]](#)

40. It is voluntary for the holder or representative to provide their e-mail addresses in transactions other than those mentioned above. Please keep in mind that where the International Bureau does not have an e-mail address, the International Bureau may not be able to send the holder time-sensitive communications, such as provisional refusals, when there is a suspension of postal services, as experienced in many countries due to COVID-19 pandemic.

41. Holders and applicants cannot indicate the e-mail address of their representative as their own. Therefore, the e-mail address of the representative must be different from the e-mail address provided for the applicant or the holder. Failure to provide such e-mail address will result in an irregularity, which means that the International Bureau will not record the international registration, the change in ownership or the appointment of the representative.

Where such irregularity is not remedied within the given time limit, the international application or the request for recording a change in ownership or the appointment of a representative will be considered abandoned.

42. Where a representative is appointed, the International Bureau will send all communications only to the e-mail address of the representative. However, there are a few exceptions to this rule, where the Regulations require that the International Bureau inform both the applicant or holder and the representative:

- six months before the expiry of the term of protection, the International Bureau will send an unofficial notice to both the holder and the representative alerting them of the upcoming renewal;
- where insufficient fees are paid for the purpose of renewal, the International Bureau will notify both the holder and the representative;
- where an international registration is not renewed, or is not renewed in respect of a designated member, the International Bureau will notify both the holder and the 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.

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

44. The e-mail address of applicants, holders or representatives will not be published on the Madrid System online information services (e.g., Madrid Monitor, Madrid Real-time Status) nor published in the [Gazette](#) or given to the Offices of the designated members.

45. Electronic communication is traceable and allows the International Bureau to determine whether a communication has reached its intended recipient. The International Bureau transmits time-sensitive communications using a registered e-mail service, which delivers a receipt for every e-mail sent and indicates when such e-mail has failed to reach the intended recipient. Where a communication sent by electronic means fails to reach its intended recipient, the International Bureau will send communications by postal services until a new e-mail address has been provided.

46. To inform the International Bureau of the e-mail address that they wish to use for communication, holders and representatives can use the [online forms](#) “[Online change in holder details](#)” and “[Online management of representative](#)” or [Contact Madrid](#) available on WIPO’s website. The International Bureau will send all communications in PDF format to that e-mail address within one month of being informed.

47. Provided the sender can be identified and 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\(b\)\]](#)

48. Where, because of a time difference between Geneva and the place from where an electronic communication has been sent, the date of the transmission is different from the date on which it was received by the International Bureau, the earlier of the two dates will be considered to be the date of receipt by the International Bureau. [\[A.I. Section 11\(c\)\]](#)

## Official Forms

49. Where the Protocol or Regulations require the use of an official form, this refers to a form established by the International Bureau and includes [online forms](#) (see also the [Notes for filing MM forms](#)), available on WIPO's website. [\[Rule 1\(xxvii\)\]](#) [\[A.I. Section 2\]](#)

50. WIPO has introduced a number of user-friendly online forms and [tools](#), for example, the international trademark renewal tool, which has been significantly enhanced over the years, making it the preferred way to request renewal of an international mark. For further details on WIPO's online forms and tools see paragraphs 107 to 147. [\[Rule 30\]](#) [\[Rule 39\]](#).

## Signatures

51. Signatures may be handwritten, printed, typed or stamped. The International Bureau does not check the authenticity of signatures; it only checks that signatures are actually made. Provided the signature box in the form is not empty, the signature requirement will be considered met; a blank box would result in an irregularity. Where an international application is transmitted to the International Bureau by the Office by electronic means, the signature is replaced by a mode of identification agreed with the International Bureau. [\[A.I. Section 7\]](#) [\[Rule 9\(2\)\(b\)\]](#)

## Model Forms (for Offices of Members)

52. The International Bureau has made available a number of [Model Forms](#) that may be used by Offices of members when communicating with the International Bureau. These are available on WIPO's website. The Model Forms are templates for the various decisions an Office may make in the Madrid System, that are intended to reflect the essential applicable requirements under the Regulations. However, these can be adapted to fit the particular needs of each Office.

## Time Limits and Relief Measures

53. The Protocol and the Regulations set 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 member 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.

54. 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\(5\)\]](#)

- 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, 2021, will expire on February 20, 2031; a period of 10 years from February 29, 2020, will expire on February 28, 2030. [\[Rule 4\(1\)\]](#)

- 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\(2\)\]](#)
- 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 calculated from an event which occurred on the twelfth day of a month will expire on the twenty second day of that month. [\[Rule 4\(3\)\]](#)

55. If a period, within which a communication must be received by the International Bureau, expires 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 International Bureau is open. For example, if a period expires on a Saturday or Sunday, the time limit 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 the International Bureau is not scheduled to be open to the public during the current and the following calendar year is published on the WIPO website under “[WIPO Official Holidays](#)” and in the [Gazette](#). [\[Rule 4\(4\)\]](#) [\[Rule 32\(2\)\(v\)\]](#)

56. Likewise if the period, within which a communication (such as a notification of provisional refusal) must be sent by an Office to the International Bureau, expires 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.

### ***Excuse in Delay in Meeting Time Limits***

57. It is not possible to extend time limits set by the International Bureau. However, an applicant, holder or Office that has failed to meet a time limit specified in the Regulations to perform an action before the International Bureau because of a *force majeure* situation may be excused, provided that they submit evidence showing, to the satisfaction of the International Bureau that such failure was due to war, revolution, civil disorder, strike, natural calamity, irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of the interested party or other *force majeure* reason. [\[Rule 5\(1\)\]](#)

58. This means that relief measures are provided for applicants, holders, representatives and Offices that have failed to perform any action before the International Bureau where the Regulations prescribe a time limit, for example, sending a communication, remedying an irregularity or paying a prescribed fee. This is helpful for users of the Madrid System that were faced with any *force majeure* situation that prevented them from taking the required action within the specified time limit.

59. Following the outbreak of the COVID-19 pandemic in early 2020, the application of [Rule 5](#) of the Regulations was first clarified in [Information Notice 27/2020](#) titled “Excuse from Failure to Meet a Time Limit Due to the COVID-19 Disease Outbreak as a Natural Calamity: Waiver of the Submission of Evidence Required under Rule 5 of the Regulations”. Amendments to Rule 5 entered into force on February 1, 2021, and this Rule provides an excuse where applicants, holders and Offices have failed to meet time limits in actions before the International Bureau due to *force majeure* events. Should this be the case, Rule 5 may be invoked and this would give applicants, holders and Offices a maximum time limit of six months, from the expiry of the time limit they have failed, to perform the necessary action before the International Bureau and provide evidence.

60. [Rule 5](#) of the Regulations applies to any communication addressed to the International Bureau for which there is a time limit under the Regulations or the treaty. For example, a communication:

- in which an Office transmits an international application or a subsequent designation;
- in which an Office notifies a provisional refusal; or
- in which an applicant, a holder or an Office remedies an irregularity in an international application or in a request for recording.

61. [Rule 5](#) of the Regulations also covers the time limit to pay any fee to the International Bureau, including the period of grace to pay the fees for the renewal of an international registration. Accordingly, this will apply to communications addressed to the International Bureau for acceptable [modes of payment under the Madrid System](#) (e.g., instructions to debit from a current account at WIPO or a payment by transfer to a WIPO bank or postal account).

62. Users can present requests and send communications to the International Bureau via the [online services](#) or [Contact Madrid](#).

### ***Time Limits Set by Offices***

63. Time limits set by Offices (for example, to respond to a provisional refusal), are outside the scope of [Rule 5](#). In such cases, where the holder has failed to meet a time limit to perform an action before the Office, the holder would need to contact the Office concerned to check whether there are any options to extend such time limits.

### ***Date of International Application and Subsequent Designation***

64. 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 International Bureau. However, where the Office concerned indicates that the late receipt resulted from circumstances referred to in [Rule 5\(1\)](#), 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 57 to 62, 378 to 383, 498 to 504). [\[Article 3\(4\)\]](#) [\[Rule 24\(6\)\(b\)\]](#) [\[Rule 5\(5\)\]](#)

## ***Continued Processing***

65. The Regulations allow an applicant or holder to request continued processing before the International Bureau, where the applicant or holder has failed to meet a time limit for an action in a procedure before the International Bureau. This is an objective relief measure where, provided the conditions are met, the application, registration or the request will be revived and the International Bureau can continue the processing of the application, registration or request. Continued processing is only available in the following circumstances: [\[Rule 5bis\]](#)

- irregularities relating to an international application that can be remedied by the applicant under [Rule 11\(2\) or \(3\), or Rule 12\(7\)](#) (see paragraphs 364 to 372);
- irregularities relating to a request for the recording of licenses under [Rule 20bis\(2\)](#) (see paragraphs 716 to 718);
- irregularities relating to a request for subsequent designation under [Rule 24\(5\)\(b\)](#) (see paragraphs 506 to 511);
- irregularities relating to a request for the recording of a change of ownership, a limitation, a renunciation, a change in the name or address of the holder, or where the holder is a legal entity, an introduction of, or a change in the indications concerning legal nature and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized, a cancellation of the international registration, or change in name of address of the representative under [Rule 26\(2\)](#) (see paragraphs 546 to 548, 587 to 589, and 628 to 630);
- irregularities relating to a request for the recording of the division of an international registration under [Rule 27bis\(3\)\(c\)](#) (see paragraphs 667 to 669);
- the payment of the second part of the individual fee under [Rule 34\(3\)\(c\)\(iii\)](#) (see paragraphs 325 and 326); and
- a request that an international registration continues its effects in a successor State and the payment of the fees related to this request under [Rule 39\(1\)](#) (see paragraph 843 to 848).

66. The request for continued processing can be made within two months from the expiry of the time limit concerned. However, the request is only possible after the expiration of the respective time limit. Continued processing cannot be requested as a precaution before the end of the time limit for any of the actions listed above. The request for continued processing needs to be presented to the International Bureau on the official [form MM20](#) (see also the [Note for filing MM20](#)). The form must be signed by the applicant or holder. A fee of 200 Swiss francs is due for this request. Together with the request and the payment of the fee for continued processing, the requirements in respect of which the respective time limit was missed need to be complied with. All this has to be done within the time limit for continued processing of two months.

67. A request for continued processing that does not meet the previously mentioned requirements will not be considered, and the International Bureau will notify the applicant or holder accordingly.

68. Where the request has been received in order, the International Bureau continues to process the international application, subsequent designation, request or other action for which a payment had to be made. The International Bureau will record any continued processing in the International Register and notify the applicant or holder accordingly.

69. In the case of continued processing relating to the recording of licenses under [Rule 20bis\(3\)](#) and to the recording of changes and cancellations under [Rule 27\(1\)](#), the date of recording will be the date on which the time limit to comply with the corresponding requirement expired.

## Languages

### *Trilingual Regime*

70. 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\(1\)\]](#)

71. 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, must be in English, French or Spanish, as chosen by 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 6\(2\)\(i\)\]](#)

- where a notification of provisional refusal refers to a conflicting mark as a ground for refusal, 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 conflicting mark. The same applies to a notification of provisional refusal based on an opposition, which refers, as a ground for refusal, to a conflicting mark. [\[Rule 17\(2\)\(v\)\]](#) [\[Rule 17\(3\)\]](#)
- where a member 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 paragraphs 310 to 314). [\[Rule 6\(2\)\(ii\)\]](#) [\[Rule 7\(2\)\]](#)

72. 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. Accordingly, an Office could refuse to accept notifications in a prescribed language (or in two such languages) and 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\(2\)\(iii\)\]](#)

73. 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 inform the International Bureau, by checking the relevant box in the international application form, that they wish to receive all such notifications in English, in French or in Spanish, irrespective of the language in which the international application was filed. [\[Rule 6\(2\)\(iv\)\]](#)

## Payment of Fees to the International Bureau

74. 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 member concerned. Information concerning [individual fees](#) is published on WIPO's website and in the [Gazette](#).

75. 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 member 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 Office must not, however, require the applicant or holder to pay the fees through an Office. [\[Rule 34\(2\)\(a\)\]](#)

76. 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 34\(2\)\(b\)\]](#) [\[Rule 32\(2\)\(iv\)\]](#)

## Currency of Payment

77. 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. [\[Rule 35\(1\)\]](#)

## Mode of Payment

78. [Fees may be paid](#) to the International Bureau: [\[A.I. Section 19\]](#)
- by debit to a current account with the International Bureau;
  - by payment into the Swiss postal account (within Europe) or the bank account of the International Bureau;
  - by credit card where applicable [\[AI Section 11\]](#)

79. An electronic interface for the payment of fees ("[Online Payment](#)") for 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's website under "[Madrid Online Services](#)". Online Payment can be made by credit card or through a WIPO current account. An acknowledgement of receipt of payment will be sent automatically. More precisely, Online Payment may be used in the following situations:

- 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;
- 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 member that has declared such payment;
- where an invitation to request the continuation of effects of international registrations in a successor State has been issued by the International Bureau.

80. An applicant, holder or representative (or 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 (PCT) or applications under the Hague Agreement Concerning the International Registration of Industrial Designs) 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 dependent on there being a sufficient balance in the account.

81. 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: [[Rule 34\(5\)](#)]

- 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 the recording of the international registration, the name of the holder and the international registration number.

82. 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 in the relevant 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 and will debit the correct amount, which will appear in the detailed monthly statement of the transactions recorded for the current account. Further information on [how to open an account](#), is available on the WIPO website under "[Paying for IP Services](#)".

## Date of Payment

83. Where the International Bureau receives instructions to debit fees from such current account, and provided the required amount is available in the account, the fees are considered to have been paid: [\[Rule 34\(6\)\]](#)

- 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.

84. 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

85. 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, 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\(7\)\(a\)\]](#)

86. 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, the fee that was valid on the earlier date applies. [\[Rule 34\(7\)\(b\)\]](#)

87. 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, provided the payment is made not more than three months before the date on which renewal is due, the fee that was valid on the date of payment applies. 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\(7\)\(d\)\]](#)

88. In any other case, the applicable amount is that which was valid on the date the International Bureau received the payment. [\[Rule 34\(7\)\(e\)\]](#)

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

89. Applicants who file their international applications through the IP Office in a least developed country (LDC) 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 WIPO's website.

90. The [list of LDCs](#) is maintained and updated on a regular basis by the United Nations and may be consulted on the [United Nations website](#).

## MILESTONES IN THE EVOLUTION OF THE MADRID SYSTEM

### Comparison Between the Protocol and the Agreement

91. The Agreement and the Protocol are separate (though intrinsically linked) treaties that share the same objectives, namely to offer a convenient cost-effective solution for registering and managing trademarks worldwide. The Protocol was created to bring more flexibility to the Madrid System and introduced certain new features with the aim of removing the difficulties that prevented certain countries and intergovernmental organizations from adhering to the Agreement. The key comparisons are as follows:

- The applicant is free to choose the entitlement and Office of origin, based on a real and effective industrial or commercial establishment, domicile or nationality. The “cascade” entitlement principle of the Agreement no longer applies; where the applicant had to first choose the country where they had a real and effective industrial or commercial establishment, if no such establishment, then the country of their domicile, and if no such domicile, then the applicant could rely on the country of which they were a national.
- The applicant may base their international application on a registration or an application filed with the Office of origin. Under the Agreement, an international application had to be based on a registration in the Office of origin.
- Each designated member may declare that the time limit to issue a provisional refusal be extended from one year to 18 months, and even beyond that in the case of opposition;
- Each member may declare individual fees, instead of receiving its share of the revenue (+100 Swiss francs);
- The Protocol introduced transformation to mitigate the consequence of the dependency period. An international registration, which is cancelled at the request of the Office of origin, may be transformed into national or regional applications in the respective members in which the international registration had effect, each benefiting from the date of the international registration (or the subsequent designation) and, where applicable, its priority date.
- An intergovernmental organization may become a party to the Protocol (but not the Agreement) where 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 maintains a regional Office for the purposes of registering marks with effect in the territory of the organization.
- The renewal period under the Protocol is 10 years, rather than 20 years as under the Agreement.

### The Safeguard Clause

92. Historically, the Protocol and the Agreement were independent, parallel treaties, with separate, but overlapping, memberships: States party only to the Agreement, States and organizations party only to the Protocol, and States party to both.

### **Prior to September 1, 2008: Prevalence of the Agreement by Virtue of the Safeguard Clause**

93. Prior to September 1, 2008, paragraph (1) of Article 9*sexies* of the Protocol, which was known as the “safeguard clause”, provided that, where the Office of origin for a given international application or registration (or the Office of the member of the holder) was a member of both the Agreement and the Protocol, then the designation of a member also bound by both treaties would be governed by the Agreement. [[Article 9\*sexies\*\(1\)](#)]

94. Where the Office of origin for a given international application or registration (or the Office of the member of the holder) was a member bound by both treaties, then a designation (whether in the application or subsequently) of a member bound only by the Protocol would have been governed by the Protocol; a designation of a member bound only by the Agreement would have been governed by the Agreement; and, as a consequence of the safeguard clause, a designation of a member 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.

95. Prior to September 1, 2008, [paragraph \(2\) of Article 9\*sexies\*](#) contained a provision stating that the Assembly 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 Agreement had become party to the Protocol.

96. Following these conditions, in November 2007, the Assembly adopted an amendment to [Article 9\*sexies\*](#), which repealed the safeguard clause with effect from September 1, 2008. This amendment consisted in a new paragraph (1)(a), replacing existing paragraph (1) of Article 9*sexies* and establishing the principle that the Protocol, and the Protocol alone, will (as from September 1, 2008), in all aspects, apply between States bound by both the Agreement and the Protocol.

### **As of September 1, 2008: Prevalence of the Protocol**

97. As of September 1, 2008, the situation regarding the mutual relations of members bound by both treaties is regulated by a new provision, [paragraph \(1\)\(a\) of Article 9\*sexies\*](#) of the Protocol. Under this provision, where the Office of origin (or the Office of the member of the holder) for a given international application or registration is a member of both the Agreement and the Protocol, then the designation of a member also bound by both treaties, will now be governed by the Protocol.

98. Where the Office of origin for a given international application or registration (or the Office of the member of the holder, is a member bound by both treaties, then a designation (whether in the application or subsequently) of a member bound only by the Protocol will continue to be governed by the Protocol; a designation of a member 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 member bound by both treaties will be governed by the Protocol.

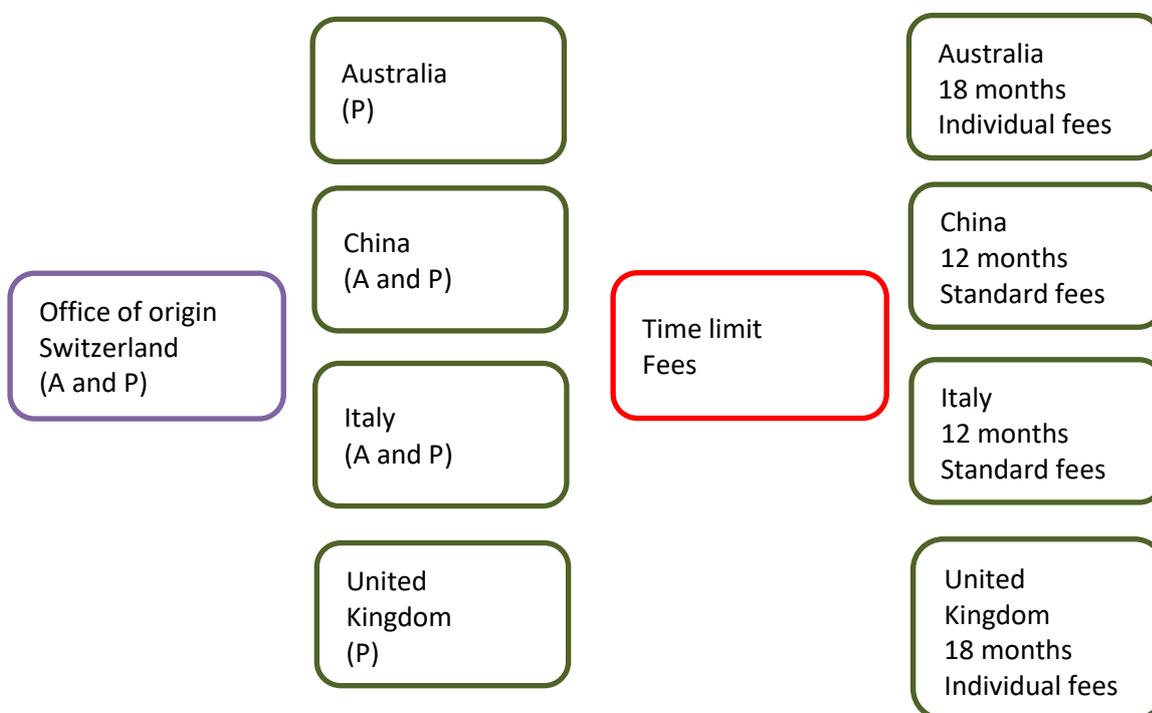
99. Paragraph (1)(a) was accompanied by a new paragraph (1)(b) that renders inoperative a declaration under [Articles 5\(2\)\(b\), \(c\) or 8\(7\)](#) of the Protocol, in the mutual relations between members bound by both treaties.

## The Effects of Article 9sexies

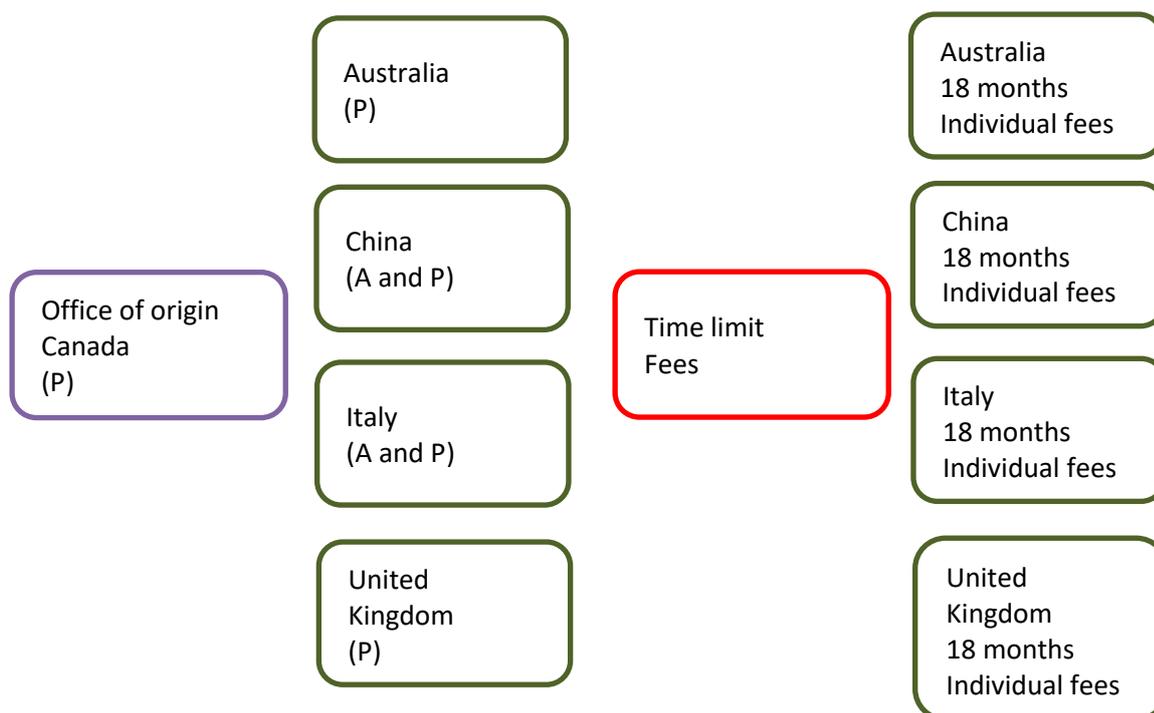
100. For a given international application or registration, where the Office of origin (or the Office of the member of the holder), is a member bound by both treaties, a designation (whether in the application or subsequently) of a member also bound by both treaties will be governed by the Protocol. However, the designation will be subject to the standard regime of [Articles 5\(2\)\(a\), 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 member in question may have declared an extended period for notifying a provisional refusal or that it wishes to receive individual fees. The following illustrations help explain how the safeguard clause works:

- Both illustrations concern an international registration with designations of Australia, China, Italy and the United Kingdom. However, how and when [Article 9sexies](#) comes into play, depends on whether the member of the Office of origin, is a member of both the Agreement and the Protocol.
- Australia, China, Italy and the United Kingdom have all declared individual fees, and an extension of the time limit for refusal from one year to 18 months. In **illustration A**, the Office of origin (Switzerland) is member of both the Agreement (A) and the Protocol (P). Therefore, the declarations concerning time limits and individual fees do not apply to China and Italy, because they are members of both treaties. Conversely, in **illustration B**, the Office of origin (Canada) is a member of the Protocol (P) only, so the declarations of extended time limit and individual fees of all the designated members would apply.

### Illustration A (Application of Article 9sexies(1)(b) Applies)



**Illustration B (Article 9sexies(1)(b) Does Not Apply)**



101. Paragraph (2) of Article 9sexies provides that the Assembly shall review the application of paragraph (1)(b) of Article 9sexies 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. Such review took place in 2011<sup>2</sup>, when the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (the Working Group) decided not to recommend to the Assembly any further review of the application of paragraph (1)(b) of Article 9sexies. [\[Article 9sexies\(2\)\]](#)

## The Freezing of the Agreement

102. At its fiftieth (29<sup>th</sup> extraordinary) session (October 3 to 11, 2016), the Assembly took the decision to freeze, with effect from October 11, 2016, the application of [Article 14\(1\) and \(2\)\(a\) of the Agreement](#).

103. This decision, together with the fact that since October 31, 2015<sup>3</sup>, all members of the Madrid Union are party to the Protocol, consolidated the Protocol as the sole treaty governing international applications and registrations under the Madrid System. As a result, provisions regulating international applications and registrations under the Agreement are no longer operational.

104. The [legal framework of the Madrid System](#) consists of the Protocol, the Regulations and the Administrative Instructions. On February 1, 2020, the Common Regulations changed name to the Regulations, reflecting that the Agreement is no longer in operation.

<sup>2</sup> See document [MM/LD/WG/9/5](#).

<sup>3</sup> The entering into force of the Protocol in Algeria.

105. The freeze of the application of [Article 14\(1\) and \(2\)\(a\) of the Agreement](#) has the following effects:

- new members cannot ratify or accede to the Agreement alone, but can ratify or accede simultaneously to the Agreement and to the Protocol;
- countries that are members to the Protocol can accede to the Agreement;
- international applications can no longer be filed under the Agreement;
- no operations under the Agreement will be conducted, including the presentation of subsequent designations;
- [Article 9sexies\(1\)\(b\)](#) of the Protocol will still apply in the mutual relations between members bound by both the Agreement and the Protocol; and,
- the Assembly can still deal with all matters concerning the implementation of the Agreement and can revert, at any time thereafter, to its decision to freeze the application of Article 14(1) and (2)(a) of the Agreement.

106. For further information on the decision to freeze the application of Article 14(1) and (2)(a) of the Agreement, please see documents [MM/A/50/3](#) and [MM/A/50/5](#).

## ONLINE SERVICES: MADRID SYSTEM RESOURCES AND TOOLS

107. There is a wide range of online tools and resources made available to the public free of charge on WIPO's website, to help simplify the international registration process and provide valuable support to all users of the Madrid System.

### Madrid System Online Resources

108. The Information about the Madrid System is available on WIPO's website under the heading [Madrid – The International Trademark System](#). As well as general information, this site includes:

- the [full text](#) of the Protocol, the Regulations and the Administrative Instructions;
- the present [Guide](#);
- a [list of the members](#) to the Protocol and the Agreement, together with an indication of the date on which they became bound by the respective treaties and any declarations they have made under the Protocol;
- information concerning the laws ([WIPO Lex](#)) and practices of individual members;
- the [WIPO Gazette of International Marks](#) (see paragraphs 110 to 112).
- the [Examination Guidelines Concerning the Classification of Goods and Services in International Applications](#).

- the [official forms](#) available for various transactions (see paragraphs 49, 50, and 141 to 147);
- the [current fees](#), including [individual fees](#);
- [information notices](#) issued by the International Bureau, for example, concerning new members, changes in fees or to the Regulations;
- information concerning [extracts](#) from the International Register (see paragraphs 116 to 121);
- annual, monthly and “in progress” [statistics](#) relating to international registrations (see paragraphs 115 and 853); and
- information concerning [meetings and seminars](#).

### Contents of the International Register

109. Anyone wishing to obtain information about the contents of the International Register, about a particular international application or registration or general information about the operation of the Madrid System, has access to the following sources of information:

#### ***WIPO Gazette of International Marks***

110. The [Gazette](#) is published every week on WIPO’s website. The Gazette contains all relevant data on new international registrations, renewals, subsequent designations and changes as well as other entries affecting international registrations. The bibliographic data is identified by the WIPO INID (“Internationally agreed Numbers for the Identification of Data”) codes, that is, the codes of Standard ST.60 (“Recommendation concerning bibliographic data relating to marks”) and Standard ST.3 (“Recommended 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\(1\)\]](#) [\[Rule 32\(3\)\]](#)

111. The Gazette also contains information of general interest, such as declarations and notifications made by members under the Protocol or the Regulations regarding particular requirements, the amounts of individual fees under [Article 8\(7\)](#) or information on the days on which the International Bureau is not scheduled to be open to the public. [\[Rule 32\(2\)\]](#)

112. The Gazette is accessible via [Madrid Monitor](#).

#### ***Alerts***

113. The Madrid Electronic Alert is a free “watch service” designed to inform anyone interested in monitoring the status of certain international registrations. Subscribers receive e-mail alerts when changes are recorded in the International Register

#### ***Madrid Monitor***

114. The status of all international registrations in force, including data relating to international applications and subsequent designations under examination by the International Bureau, is published by the International Bureau online on [Madrid Monitor](#) (see paragraphs 131 to 134).

### **Annual, Monthly and “In Progress” Statistics**

115. The International Bureau publishes on its website, for each calendar year, a [statistical report](#) summarizing activity under the Madrid System during that year (*Madrid Yearly Review*). Furthermore, it also publishes [statistics](#) featuring international applications, international registrations, subsequent designations, refusals and renewals, among others, in a dynamic form on an annual, monthly and “in progress” basis. The statistical information may be selected by Office of origin, Office of the member of the holder or by designated member.

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

116. On payment of the fee prescribed in the Schedule of Fees, anyone may obtain from the International Bureau the following [certified documents](#) concerning the contents of international registrations (either in force or expired): [\[Article 5ter\(1\)\]](#)

- [The detailed extract](#) is an analysis of the situation of an international registration. It consists of a certified copy of the international registration as originally published in the [Gazette](#), with details of any subsequent change, refusal, invalidation, statement of grant of protection, correction or renewal recorded in the International Register at the time the extract is prepared. The detailed extract is only available in the original language of the application for international registration. However, the cover page of the detailed extract can be requested in English, French, Spanish, Arabic, Chinese or Russian;
- [a simple certified extract](#) consists of certified copies of all entries that have been published in the [Gazette](#) for a given international registration, together with any notification of refusal of protection, invalidation or statement of grant of protection received at the time the extract is prepared. The simple certified extract is available only in the original language of the international registration. However, the cover page of the simple extract can be requested in English, French, Spanish, Arabic, Chinese or Russian;
- [an attestation](#) certifies specific information on the current status of an international registration and/or application;
- [a copy of a certificate](#) (registration or renewal) consists of a certified copy of a certificate of registration or renewal. It can only be requested by the holder or recorded representative.

117. A request for an extract should indicate the number and date of the international registration for which an extract is requested and the type of extract requested. The establishment of an extract may be expedited, upon request and on payment of a fee.

### **Legalization of Extracts from the International Register**

118. Such extracts from the International Register may be produced in legal proceedings in a member. An extract from the International Register may be legalized with a view to its production in non-members of the Madrid System. Upon request, WIPO will arrange the legalization of extracts from the International Register for production in non-members of the Madrid System. [\[Article 5ter\(3\)\]](#)

119. Extracts of the International Register required for use in members of the Madrid System are exempt from legalization requirements. [\[Article 5ter\(3\)\]](#)

120. The legalization consists of an official stamp and signature certifying the validity of the information requested by the non-member. Any person can request a legalized extract from the International Register. The extract requested (simple or detailed) will be certified with an official WIPO stamp and signed by an authorized person in the Madrid Registry, Brands and Designs Sector. Once signed and stamped, the original extract will be sent to the Civil Status and Legalization Service of the Republic and Canton of Geneva where the signature will be authenticated. The document will then be delivered to the relevant Consulate/Embassy of the non-member/country for legalization.

121. It is currently not possible to legalize extracts for some countries. For further advice and/or an estimate, please use "[Contact Madrid](#)".

### **Madrid System Online Services: Search; File; Monitor; Manage**

122. A number of specialized online tools are available to help simplify the international registration process and provide support to all users of the Madrid System during each stage of the international registration lifecycle. These tools, listed below, are available to the public free of charge.

#### ***Global Brand Database***

123. Search the [Global Brand Database](#) before filing a trademark application, to uncover marks that may be considered similar or identical to the mark of interest and which may prevent protection in specific territories, or to simply browse brands in markets of interest. The search provides the opportunity to browse trademarks from multiple national and international databases and features over 50 million trademarks from more than 70 national and international databases (including those registered with the Madrid System and more). With 14 data-field search options, including image search and searching suggestions, the tool is comprehensive and user-friendly. It is also easy to search U.S or Vienna image classes by description, and browse by [Nice Classification](#) indication numbers. Although this search may help uncover marks that are similar or identical, it does not mean the mark is available for use and protection, and a full clearance search and advice from a trademark agent is highly recommended.

124. The Global Brand Database is available on WIPO's website. The search results and records are downloadable.

#### ***Madrid Goods and Services Manager***

125. The [Madrid Goods and Services](#) (MGS) provides access to a database of goods and services. It assists trademark applicants in compiling the list of goods and services that must be submitted when filing an international application. The MGS provides terms from the alphabetical list of the *International Classification of Goods and Services for the Purposes of the Registration of Marks* ([Nice Classification](#)) as well as a much wider choice of terms that are pre-accepted by the International Bureau and many Offices that are members of the Madrid System. Using such pre-accepted terms helps applicants to avoid irregularity letters from the International Bureau. The pre-accepted terms of goods and services are provided in the three languages of the Madrid System as well as in many other languages. The MGS enables users to obtain an instant translation of a list of goods and services from any of those languages into any other one available on the MGS. It also features a check-acceptance function, enabling users to check whether the pre-accepted terms will be accepted or not by some members of the Madrid System that they wish to designate in an international application, or subsequently. It is important to note that while the Offices of members

designated in an international registration are not able to challenge the classification of goods and services as accepted by the International Bureau (as indicated in the MGS), they may issue provisional refusals on the basis that certain terms accepted by the International Bureau are considered too broad following their examination practice. The MGS tool can help identify some of these potential examination pitfalls, but cannot guarantee that provisional refusals will not be raised in this regard.

126. The MGS is available to the public on WIPO's website.

### ***Madrid Member Profiles Database***

127. The [Madrid Member Profiles](#) database provides access to information concerning the laws and practices of the IP Offices of members. It helps trademark owners to understand the rules and procedures in effect in each of the markets of interest, including time limits to respond to a refusal or opposition, to request a review, or to file an appeal. It also assists trademark owners understand the procedures for filing an international application through the Office of origin.

128. The Madrid Member Profiles database is available to the public on WIPO's website.

### ***The Madrid Application Assistant***

129. The [Madrid Application Assistant](#) (MAA) is an electronic version of the official [MM2 form](#) (see also the [Note for filing MM2](#)) that applicants may use to file an international application under the Madrid System. This new tool is available to applicants where the Office of origin does not offer the services of [Madrid e-Filing](#) or its own online filing solutions. The MAA records all the information required to complete an international application in an intuitive and linear manner. Once completed, the international application will be made available in a PDF format ready for the applicant to submit to the Office of origin for certification. Information required to fill out the international application may be imported directly from the Office of origin's national or regional trademarks database. This saves time and effort, and reduces the risk of irregularities, thus making the process of filing an international application more efficient and accurate. When using the MAA, the applicant can check the list of goods and services and have this translated automatically by using the integrated MGS tool. The [fees may be paid](#) by using a [current account opened with WIPO](#), by bank transfer or by credit card.

130. The MAA is available on WIPO's website. Applicants should check with their Office of origin whether they can use this tool to file the international application through that Office.

### ***Madrid Monitor***

131. The status of all international registrations in force, including data relating to international applications and subsequent designations under examination by the International Bureau, is published by the International Bureau online on [Madrid Monitor](#). This database contains 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. Data in the Madrid Monitor is updated daily.

132. Since January 1, 2005, copies of notifications concerning statements of grant of protection, refusals, interim status, final decisions and invalidations, received by the International Bureau (in accordance with [Rules 17, 18bis, 18ter and 19](#)) are accessible in PDF format under the corresponding heading and INID code. This concerns, for example, statements of grant of protection, notifications of provisional refusal, final decisions (statements

of confirmation of total refusal or statements of grant of protection following a provisional refusal), further decisions or invalidations. Where the time limit for the notification of a provisional refusal has expired and the International Bureau has not received or recorded any notification from a designated member in a given international registration, the International Bureau will publish the following statement to that effect in Madrid Monitor: “The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)”.

133. Madrid Monitor provides a powerful search tool for trademark attorneys and agents. While every effort is made to ensure that the information in Madrid Monitor accurately reflects 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, which is established by the International Bureau upon request (see paragraphs 116 to 121).

134. Madrid Monitor is updated daily and is available to the public on WIPO’s website. Madrid Monitor provides access to the [Gazette](#). [\[Rule 33\]](#)

### ***Madrid Portfolio Manager***

135. The [Madrid Portfolio Manager](#) (MPM) allows holders and their representatives to access their international trademark portfolios. Having a user account, allows holders to access the International Register online and view all transactions occurring on their international registrations, in real time. The service also offers the possibility for the holder to manage actions pertaining to the protection of their own international registration(s), such as changes in name and/or address of the holder, presentations of subsequent designation, renewals and payments of fees.

136. MPM is available to holders and their representatives on WIPO’s website.

### ***Online Fee Calculator***

137. The [Fee Calculator](#) helps to estimate the cost of registering a mark through the Madrid System, as well as other costs related to managing an international trademark, such as the renewal, the subsequent designation, the second part fee for certain members and all Madrid transactions with fees.

138. The online Fee Calculator is available to the public on WIPO’s website.

### ***Online Payment***

139. It is possible to use the [Madrid Online Payment Service](#) to pay 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.

140. The Madrid Online Payment Service may be accessed by applicants, holders and their representatives on WIPO’s website.

## **Online Forms**

141. A number of [online forms](#) for various transactions are made available to the public on WIPO's website.

### **Online Renewal**

142. An international registration may be renewed using an online form. Once the international registration number has been entered into the [Online renewal](#) form, the members and the status of protection in those members will be displayed. The holder may then easily select the members to be renewed. The renewal fees will be automatically calculated and may be paid by credit card or through a WIPO current account.

### **Online Subsequent Designation**

143. It is possible to request an expansion of the geographical scope of an international registration using an online form. Once the international registration number has been entered into the [Online subsequent designation](#) form, a list of members available for subsequent designation will be displayed. The holder may easily select members to subsequently designate, as well as the goods and services that are to be covered by the designation. The fees will be automatically calculated and may be paid by credit card or through a WIPO current account.

### **Online Limitation**

144. It is possible to request a reduction of the list of goods and services in respect of one or some of the designated members in an international registration using an online form. Once the international registration has been selected in the [Online limitation](#) form, the list of goods and services as currently recorded for each of the designated members will be displayed. The holder may then easily modify those goods and services or delete entire classes to reflect the limitation. The fees will be automatically calculated and may be paid by credit card, or through a WIPO Account.

### **Online Renunciation**

145. It is possible to request the abandonment of the effects of an international registration for all the goods and services with respect to some (but not all) of the designated members using an online form. Once the international registration has been selected in the [Online renunciation](#) form, the details of the designated members as currently recorded in the international registration will be display, and the holder may simply then select those that they wish to renounce.

### **Online Change in Holder Details**

146. It is possible to request the recording of a change of name and/or address of the holder; and/or where the holder is a legal entity, to introduce or change its legal nature using an online form. Once the international registration has been selected in the [Online change in holder details](#) form, the details of the holder as currently recorded will be displayed and the holder may indicate the necessary changes.

### **Online Management of Representative**

147. It is possible for the holder to request the appointment or cancellation of a recording of a representative using the [Online management of representative](#) form. The same form may be used by a recorded representative to change their details (such as name or address) or to cancel their appointment.

### Online Change in Ownership

148. It is possible to record a total or partial change in ownership of an international registration using the [Online change in ownership](#) form. If applicable, an appointment of a representative for the new holder (transferee) may also be requested at the same time, in the same form. If the e-mail address used to request the change in ownership is not the same as that on record for the holder or their representative, the holder will receive a message inviting them to confirm the request. If an appointment of a representative for the new holder is included in the request, a message will be sent to the e-mail address provided for the new holder (transferee) inviting the representative to confirm their appointment.

## CHAPTER II: THE MADRID SYSTEM FROM THE USERS' PERSPECTIVE

### INTRODUCTION

149. This part of the Guide provides practical information to applicants and holders that wish to protect their brands using the Madrid System. It follows the recording of the international registration and the various procedures that the holder may take advantage of during the lifespan of the international registration (renewal, subsequent designation, changes to the holder's details), and various applicable restrictions of the international registration (limitation, renunciation, cancellation).

150. This Guide also offers practical information for trademark owners, to assist them in the preparation of the international application.

### SUBSTANTIVE REQUIREMENTS FOR TRADEMARK OWNERS

151. The Madrid System may only be used by a natural person or a legal entity, which has an entitlement (connection) with a member of the Madrid System. This means that the trademark owner must have a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country party to the Protocol. Alternatively, the trademark owner may have 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. The Intellectual Property Office (IP Office) of the member to which the applicant claims entitlement is referred to as the Office of origin.

152. In addition to having the necessary entitlement, the applicant must also have a basic mark, more specifically, have an application or registration for the mark with that Office of origin. The Office of origin and the requirements of the basic mark and entitlement are explained further in the following paragraphs.

#### Basic Application or Registration (the Basic Mark)

153. An international application must be based on either a registration recorded with the Office of origin (basic registration) or on an application for registration filed with that Office (basic application). This is referred to as the "basic mark" requirement. The international application may relate only to goods and services covered by the basic mark.

154. In most cases, the international application will be based on a single basic mark (registration or application), which covers the goods and services listed in the basic mark. It is, however, possible to base an international application on several basic marks (applications and/or registrations), which together cover the goods and services of the international application. This is particularly relevant where the Office of origin has previously followed a single-class system. The basic marks must all be in the name of the applicant in the international application and must have been filed with the same Office. For the sake of simplicity, the following text refers only to a basic mark, it being understood that this includes the possibility of several basic marks.

155. An international registration remains dependent on the basic mark for a period of five years from the date of its registration. If the basic mark ceases to have effect, either partially or totally, for any reason (for example, it is refused or withdrawn, cancelled or not renewed) within this five-year period, the international registration will no longer be protected to the same extent. This is called ceasing of effect of the basic mark. In these cases, the International Bureau, upon request from the Office of origin, will cancel the international registration either partially or totally as applicable. After the expiry of this five-year period, the international registration becomes independent of the basic mark. However, where an authority, for example, a national court, makes its final decision that results in the cancellation of an application or registration, which is a basic mark, after the expiry of the dependency period, the Office of origin will be obliged to notify WIPO of the ceasing of effect of the basic mark if the action, which led to that final decision, was initiated in the five-year dependency period.

156. The trademark owner can take steps to mitigate the risk of a cancellation of the international registration following the ceasing of effect of the basic mark, such as selecting a basic registration (rather than an application) that is unlikely to become vulnerable to cancellation on the grounds of non-use or invalidation, and ensuring that the basic mark is renewed, if necessary, during the five-year dependency period. For more information on dependency and the ceasing of effect of the basic mark, see paragraphs 796 to 805.

## Entitlement and the Office of Origin

157. Before filing an international application, the trademark owner must establish their entitlement (connection) with the Madrid System, and which Office will be the Office of origin for the international application in question.

158. “Office of origin” is defined in a way that allows the trademark owner to freely choose their Office of origin on the basis of establishment, domicile or nationality, it being understood that there can be only one Office of origin. Where the trademark owner has a relevant connection with more than one member, they may decide which one to choose. [\[Article 2\(2\)\]](#)

159. 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 (for example, the European Union), 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. [\[Article 2\(1\)\(i\) and \(ii\)\]](#) [\[Article 2\(2\)\]](#) [\[Rule 1\(xxv\) and \(xxvi\)\]](#)

160. The interpretation of “national”, “domicile” and “real and effective commercial or industrial establishment” is a matter for the laws of the members to determine. This Guide can therefore, only give some general guidance below.

161. “National”, under the Protocol, is intended to have the same meaning as in Article 2 of the [Paris Convention](#), and it is understood to include 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. In practice, the nationality or domicile of a legal entity is not often questioned or relied upon, since its entitlement to file an international application will usually be based on the existence of a real and effective commercial or industrial establishment in the territory of the Office of origin.

162. The concept of “domicile” can have different meanings; the criteria for either a natural person or a legal entity to be regarded as domiciled in a member will depend on the relevant domestic legislation of the member. For example, some laws allow a natural person to obtain domicile only by virtue of an official authorization. Other laws interpret “domicile” as more or less equivalent to “residence”. It is generally believed that the Paris Convention did not seek, by using the expression “domicile”, to indicate a legal situation, but rather a more or less permanent situation of fact, so that a foreign national residing in a member would, in most cases, be eligible to claim entitlement through domicile. The domicile of a legal entity may be considered to be the place of their actual headquarters. However, as mentioned above, legal entities, in practice, generally rely on the existence of a real and effective commercial establishment in the territory of the Office of origin.

163. 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, in Brussels in 1897 to 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.

164. An enterprise may have several real and effective industrial or commercial establishments in different States that are members of the Protocol. In such a case, any of the Offices of the respective States may qualify as the Office of origin. This means that the enterprise may choose an Office of origin based on its business, language or other strategic reasons. For example, an enterprise domiciled in Switzerland that has real and effective industrial or commercial establishments in the United States of America (US), the United Kingdom (GB) and New Zealand (NZ), may choose the Swiss Federal Institute of Intellectual Property (IPI), the United States Patent Office (the USPTO), the United Kingdom Intellectual Property Office (the UKIPO) or the Intellectual Property Office of New Zealand (IPONZ), to be the Office of origin.

165. Where the member of which an applicant is a national, or in which the applicant is domiciled or has an establishment, is also a member State of a Contracting Organization, there is the possibility of choosing either the national Office or the regional Office as the Office of origin. For example, a national of Germany may choose the German Patent and Trade Mark Office (DPMA) or the European Union Intellectual Property Office (the EUIPO) as the Office of origin. Where the entitlement, and the Office of origin, is chosen, the applicant must have a basic mark (application or registration) with that Office concerned.

## Several Applicants

166. Two or more applicants (whether natural persons or legal entities) may jointly file an international application, provided that the basic mark is also jointly owned by them, and that each of the applicants have the necessary connection through establishment, domicile or nationality with the member of the Office of origin.

167. 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 member. [\[Rule 8\(2\)\]](#)

## Presentation of the International Application

168. The international application must be filed through the Office of origin. [\[Article 2\(2\)\]](#)  
[\[Article 8\(1\)\]](#)

169. An international application presented by the applicant directly to the International Bureau will not be considered and will be returned to the sender without being considered. Any fees paid will be reimbursed to the party having paid them. [\[Rule 11\(7\)\]](#)

## Language of the International Application

170. 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 6\(1\)\]](#)

171. The International Bureau will return an international application that does not comply with the language requirements to the Office which forwarded it, without examining the application in any way. All fees paid will be reimbursed to the party having paid them. [\[Rule 11\(7\)\]](#)

## PRE-FILING CONSIDERATIONS

172. Before filing an international application, the trademark owner preferably should seek advice from an expert in the field of trademark protection. However, generally speaking the following issues should be considered:

### Options for Protecting a Trademark Abroad

173. There are three options for protecting a trademark abroad:

- (i) the direct national route, where separate applications for trademark registration are filed directly with the Office of each territory where protection is sought;
- (ii) the direct regional route, where a single application is filed with an intergovernmental organization in the region where protection is sought (for example, the European Union Intellectual Property Office); and,
- (iii) the international route (via the Madrid System), where a single application is filed for multiple countries and regions where protection is sought.

174. The Madrid System may be the preferred option where trademark protection is sought in many territories that are members of the Madrid System. Its streamlined and centrally managed administration means that marks can be protected and maintained conveniently and cost-effectively. There is no need to appoint a representative in each territory of interest at the time of filing, nor is there a need to provide multiple translations. Further, the geographical scope of protection can be extended at any time (subsequent designation) and there are fixed time limits (one year or 18 months) for Offices to examine and make their decision on the scope of protection. If no provisional refusal is issued by the Office in the territory concerned by the expiry of the applicable time limit, the mark is deemed automatically protected in that territory. If however, trademark protection is sought in just one or two territories, with no plans to expand protection to other territories in the future, the national or regional route may be more appropriate.

175. Please refer to the illustrations in paragraph 30 of this Guide for a comparison of the Madrid System and the national route.

### Choosing Entitlement and Office of Origin

176. It is possible for a natural person or legal entity to have more than one basis for entitlement and therefore, more than one Office of origin to choose from. The choice of Office of origin could depend on number of factors, such as the language used by that Office, whether there is an existing relationship with that Office (for example, some Offices have more resources to assist trademark owners than others), any differences in the fees charged by that Office, and whether there is an appropriate basic mark already registered or applied for in the territory of that Office.

### Selecting the Basic Mark

177. Before filing an application for an international registration, it is important to have an appropriate basic mark registered or applied for in the territory of the Office of origin. When determining whether the basic mark is appropriate, the following issues may be considered:

#### Reproduction of the Mark

178. The basic mark should be the version of the mark that is to be protected in all territories to be covered by the international registration.

179. Some members accept what may be referred to as “series marks” (several versions of a trademark that differ only in respect of minor, non-distinctive matter not substantially affecting the identity of the trademark). However, the Madrid System does not recognize series marks. Therefore, it is not possible to file an international application for a series of trademarks, even where the basic trade mark covers a series of marks. It is however, possible to base an international application on a series mark. In this case, the applicant will need to select and indicate only one of the marks in the series in the international application form. If the applicant provides a reproduction of the series mark in the application form (i.e., it includes all marks in the series in one representation), it will be treated as the representation of the mark *per se*, i.e., it will not be considered as separate versions of mark (in a series). Therefore, the applicant will need to file separate international registrations (budget permitting) for each version of the mark in the series, if it is considered strategically necessary to protect all versions.

## Goods and Services

180. The basic mark should cover the scope of goods and services for which the mark to be protected in all territories at the time of filing the application and in the future. Therefore, some trademark owners may choose a basic mark which has a broad scope of protection, particularly given that it is possible to limit the scope of protection for some of the designations, if necessary. For example, if the mark is to be protected in classes 3, 9 and 25 in Australia and New Zealand, in classes 3 and 9 in France and the United Kingdom, and only class 25 in other territories, the basic mark would need to cover classes 3, 9 and 25. The trademark owner needs to be mindful of not going too broad as it may leave the basic mark vulnerable for non-use cancellation actions by third parties, which could have an impact on the international registration (see paragraphs 181, 796 to 805, and 814 to 816).

## Dependency Period

181. The international registration is dependent on the basic mark for five years. If the basic mark ceases to have effect, either partially or totally, for any reason, for example, it is refused or withdrawn, cancelled or not renewed within this five-year period, it will affect the international registration. Therefore, it is important to lower the risk of possible ceasing of effect by choosing a “strong” basic mark. This could be a basic registration, rather than a pending application which may be open to opposition by a third party; it could be a mark already in use and therefore not vulnerable to a non-use cancellation action. The basic mark must remain in force and be renewed, if necessary, during the five-year dependency period. Furthermore, within this period, the holder of the international registration should proceed with any change in ownership of the basic mark to a third party with caution.

## List of Goods and Services

182. Before filing an international trademark application, it is also necessary to determine the list of goods and services to be covered by the mark. The [Madrid Goods and Services](#) (MGS), available on WIPO’s website, helps applicants compile and classify their goods and services by providing access to an extensive collection of terms and descriptions, including an alphabetical list of the [Nice Classification](#) plus terms approved by the International Bureau and a large number of participating IP Offices. The terms in the MGS are pre-approved by the International Bureau, which means that there will not be any issues with irregularities, and the service also has information on specific terms that are not acceptable by specific Offices, which is helpful to avoid possible provisional refusals later on. With more terms being added regularly, the MGS gives users an ever-expanding range of terms, which offers them greater flexibility and reduces the risk of refusals being raised.

## Pre-filing Searches

183. Before filing an international application, it is important to search for existing trademarks in the territories to be designated. Such searches will help uncover trademarks that may be similar or identical to the international mark of interest. A full clearance search conducted by a trademark agent or attorney is highly recommended. However, there are a number of online services that are also available. The [Global Brand Database](#), available on WIPO’s website, includes brand data provided from a number of sources, including data from national and regional trademark Offices and marks registered through the Madrid System. If the country or region of interest is not included in the Global Brand Database, the [Madrid Member Profiles](#) database, also available on WIPO’s website, may be used to locate details of the trademark Register of that particular country or region. If the mark is similar or identical

to an earlier mark protected by a third party, it may not be possible to protect it. In such case, it would be advisable to seek advice from a trademark agent or attorney with knowledge of that particular country or region.

## Examination Practices

184. It is also a good idea to check the examination practices of the Offices in the territories of interest, to see if any action can be taken to minimize the risk of future possible provisional refusals, for example, some members of the Madrid System require holders that are legal entities to provide details of the legal nature of that legal entity. A wide range of information of the practices and procedures of Madrid System members is available in the [Madrid Member Profiles](#) database, available on WIPO's website.

## Representative

185. It is not necessary for an applicant or holder to appoint a representative to file or manage an international registration before the International Bureau. However, there are some advantages for doing so. An expert in the field of trademarks and of the Madrid System can provide invaluable advice on the best protection strategies, help applicants navigate the international application process and coordinate overseas representation, if required later to overcome a provisional refusal. Although, appointing a representative may incur costs, particularly at the start of the protection process, significant costs may be saved later down the track. For example, a trademark representative will be able to advise on pre-filing searches and review the requirements of certain territories to help avoid provisional refusals and infringement. If provisional refusals are issued, a trademark representative will likely have a network of overseas representatives ready to instruct quickly, to provide advice and meet time limits, that are also trustworthy and cost-effective.

186. The following paragraphs provide further information concerning the appointment of a representative before the International Bureau.

## REPRESENTATION BEFORE THE INTERNATIONAL BUREAU

187. The applicant or holder may appoint a representative to act on their behalf before the International Bureau. This may or may not be the same representative that they used before the Office of origin. [\[Rule 3\(1\)\(a\)\]](#)

188. References in the Regulations, the Administrative Instructions or in this Guide to representation relate only to representation before the International Bureau. Whether a representative is needed before the Office of origin, or the Office of a designated member (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 Protocol and Regulations and are governed by the law and practice of the member concerned.

## Appointment of a Representative

189. With regard to who may be appointed as a representative before the International Bureau, the Madrid System does not provide requirements as to professional qualification, nationality, residence or domicile. Anyone can act as a representative before the International Bureau, even someone residing or domiciled in a country not yet member of the Protocol.

190. The applicant or holder may appoint a representative to act on their behalf before the International Bureau in an international application (see paragraphs 240 to 244) or in a request to record a change in ownership of an international registration (see paragraphs 617 and 618). A representative can also be appointed in a separate official form (see paragraphs 192 and 193).

### **In an International Application or Request to Record a Change in Ownership of an International Registration**

191. A representative may be appointed in an international application simply by indicating their name, address and e-mail address in the appropriate part of the official form. Similarly, a representative may be appointed by the new holder (transferee) in a request for a change in ownership of an international registration, by giving their name, address and e-mail address, provided that the appointment is signed by the new holder (transferee). Where a representative is appointed, no further formality is necessary; in particular, no power of attorney should be sent to the International Bureau. [\[Rule 3\(2\)\(a\)\]](#)

### **In a Separate Official Form**

192. The simplest way to appoint a representative is to use the [Online Management of Representative form](#) available on WIPO's website. Alternatively, official [form MM12](#) may be used to appoint a representative, which is available on WIPO's website (see also the [Note for filing MM12](#)). [\[Rule 3\(2\)\(b\)\]](#)

193. Such an appointment may include multiple international applications or registrations, provided they are all clearly and individually identified. However, 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**

194. Only one representative may be appointed in 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 first one listed 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. [\[Rule 3\(1\)\(b\) and \(c\)\]](#)

### **E-mail Address of the Representative**

195. The representative must indicate their e-mail address in the form. Holders cannot indicate the e-mail address of their representative as their own. Therefore, the e-mail address of the holder and of the representative must be different. Please note, WIPO will not include the e-mail address of applicants, holders or representatives on the Madrid System online information services (e.g., Madrid Monitor, Madrid Real-time Status) nor publish such information in the [Gazette](#), or make these available to the Offices of the designated members.

## Irregular Appointment

196. 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. The applicant or holder and the purported representative and, if the request was presented by an Office, that Office, will be notified accordingly. [\[Rule 3\(3\)\(a\)\]](#)

197. Where the appointment is considered irregular or as not having been made, the International Bureau will send all relevant communications to the applicant or the holder. Where such irregularity is not remedied within the given time limit, the request will be considered abandoned. [\[Rule 3\(3\)\(b\)\]](#)

## Recording and Notification of Appointment

198. If the appointment complies with the applicable requirements, the International Bureau will record the representative's 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, request to record a change in ownership or separate communication) in which the appointment was made. The appointment of the holder's representative, as recorded in the International Register, will also be published in the [Gazette](#). [\[Rule 3\(4\)\(a\)\]](#) [\[Rule 32\(1\)\(a\)\(xiii\)\]](#)

199. The International Bureau will notify the Offices of the designated members as well as both the applicant or holder and the representative, that the appointment has been recorded in the International Register. This means that Offices of designated members may contact the holder or the recorded representative directly, if necessary, for example, to provide information on maintenance requirements to be complied with before the Office or on cancellation actions initiated by third parties. Where the appointment was made in a separate communication presented through an Office, that Office will also be notified. [\[Rule 3\(4\)\(b\)\]](#)

## Effect of the Appointment

200. Unless the Regulations expressly require otherwise, a 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 this representative 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. [\[Rule 3\(5\)\]](#)

201. 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 set out in the Regulations:

- 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; [\[Rule 3\(3\)\]](#)
- six months before the expiry of the term of protection, the International Bureau will send an unofficial notice to both the holder and the representative; [\[Article 7\(3\)\]](#)

- where insufficient fees are paid for the purpose of renewal, the International Bureau will notify both the holder and the representative; [[Rule 30\(3\)](#)]
- where an international registration is not renewed or is not renewed in respect of a designated member, the International Bureau will send a notification to the holder and the representative; [[Rule 31\(4\)](#)]
- 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 213 to 216).

202. 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 recorded representative.

### **Change in Details of a Recorded Representative**

203. It is possible to request the recording of a change in the name and/or address of the recorded representative. The easiest way to record such change is to use WIPO's [Online management of representative form](#) available on WIPO's website. Alternatively, the official [form MM10](#) to request for the recording of a change in the name and/or address of the representative may be used, which is also available on WIPO's website (see also the [Note for filing MM10](#)).

204. The change in the name and/or address of the recorded representative implies that the same person or legal entity continues to be the holder's representative.

### **Notification of the Change(s)**

205. Once the change concerning the representative has been recorded, it will be reflected in the International Register and the Offices of the designated members will be notified of the change(s).

206. The new name or new address of the representative will be used in all communications from the International Bureau (including provisional refusals, decisions and irregularity notices).

207. It is important to note that the recording of a new name or address (or failure to record) does not constitute an excuse for failure to comply with any time limit to be met with regard to the international registration(s) concerned.

### **Cancellation at the Request of the Applicant or Holder**

208. The recording of a representative will be cancelled upon receipt of a request signed by the applicant, the holder or the representative. To request the cancellation of the recording of an appointment of representative, use the [Online management of representative form](#) available on WIPO's website.

209. The cancellation of the recording may concern all the international applications or registrations of the same applicant or holder in respect of which the representative had been appointed, or any specified international applications or registrations of that applicant or holder. Cancellations at the request of the holder or the holder's representative will be published in the [Gazette](#). [[Rule 6\(a\)](#)] [[Rule 32\(1\)\(a\)\(xiii\)](#)]

210. The recording will also be cancelled *ex officio* by the International Bureau where a new representative has been appointed. Since 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. [\[Rule 3\(6\)\(a\)\]](#)

211. 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.

212. 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. [\[Rule 3\(6\)\(b\)\]](#)

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

213. Where the International Bureau receives a request from the representative for cancellation of the recording of the appointment, it will immediately notify the applicant or holder of this fact. [\[Rule 3\(6\)\(d\)\]](#)

214. The effective date of the cancellation will be the earlier of the following:

- 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 the appointment. [\[Rule 3\(6\)\(c\)\]](#)

215. 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 the appointment without informing, or contrary to the wishes of, the client.

### **Notification of Cancellation**

216. 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. The cancellation at the request of the holder or the holder's representative will also be notified to the Offices of the designated members. The International Bureau will send all future communications either to the new representative or, where no new representative has been recorded, to the applicant or holder. [\[Rule 3\(6\)\(e\)\]](#)  
[\[Rule 3\(6\)\(f\)\]](#)

### **No Fee for Recording**

217. There is no fee payable to the International Bureau for the recording of the appointment of a representative, of any change in the details of the representative, or of the cancellation of the recording of an appointment of representative. [\[Rule 36\(i\)\]](#)

## THE APPLICATION FORM

218. Before completing the international application form, applicants are strongly advised to read the detailed [notes for filing](#) available on WIPO's website.

219. An international application must be presented to the International Bureau on the official [form MM2](#) (see also the [Note for filing MM2](#)) or online equivalent versions. [\[Rule 9\(2\)\(a\)\]](#) [\[A.I. Section 2\]](#)

220. The Offices of some members provide forms for requesting an international application that may differ from the official international application form, which applicants may be permitted or required to use, as prescribed by the law of the member. 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.

221. Some Offices offer the services of [Madrid e-Filing](#) or their own online filing solutions. If the applicant's Office of origin has neither, the applicant is advised to use the [Madrid Application Assistant](#), which is an electronic version of the official [MM2 form](#) available on WIPO's website (see also the [Note for filing MM2](#)).

222. The official form must be typed; handwritten forms are not acceptable. The following paragraphs offer the applicant some guidance in completing the application.

### Contracting Party (Member) of the Office of Origin

223. The name of the State or intergovernmental organization of the Office of origin should be given, e.g., "Japan", "European Union", etc. In the case of a common Office under [Article 9quater](#) of the Protocol, the name of the single State that the members concerned are deemed to constitute should be given, for example, "Benelux".

224. There can be only one Office of origin. Therefore, where there is more than one applicant (joint applicants), each of the applicants must have the necessary connection through establishment, domicile or nationality with the member of the Office of origin. 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 member. [\[Rule 8\(2\)\]](#)

### Applicant's Details

#### Name

225. 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, for example, "proprietary limited company (Pty Ltd)" or "a limited liability company (LLC)". 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. [\[A.I. Section 12\(a\), \(b\) and \(c\)\]](#)

## Address

226. The postal address of the applicant must be given in such a way as to satisfy the customary requirements for prompt delivery. In addition, telephone numbers may be given.

## E-mail Address

227. The applicant must indicate an e-mail address in the international application. The International Bureau will send all communications concerning the international application and resulting international registration electronically only, to the e-mail address recorded for the applicant/holder unless an alternative e-mail address for correspondence is indicated, or a representative is appointed. The applicant must ensure that the e-mail address provided is kept up to date. [[Rule 9\(4\)\(a\)\(ii\)](#)] [[A.I. Section 12\(d\)](#)]

## Alternative Postal Address and E-mail Address for Correspondence

228. An alternative postal address and e-mail address for correspondence should only be provided if the applicant would like the International Bureau to send all communications concerning the international application and the resulting international registration to an address and e-mail address different to that indicated for the applicant. Since it is mandatory for the applicant to indicate an e-mail address, this means that where an alternative address for correspondence is indicated, this should also include an e-mail address. The International Bureau will then use this e-mail address for all communications, unless a representative is appointed. Any later inclusion or update of address for correspondence (including e-mail address) can be given to the International Bureau using [Contact Madrid](#). Where a representative is appointed in the application, all communications, which are required to be sent by the International Bureau to the applicant or holder, will be sent to the e-mail address of that representative.

## Phone Numbers

229. The applicant may also provide a phone number, so that the International Bureau may contact the applicant in case no e-mail address is indicated or where the one indicated is incorrect.

## Application in the Names of More than One Applicant

230. If there is more than one applicant, the total number of applicants and the name and address of the first applicant only should be indicated. The name(s) and the address(es) of the other applicant(s) should be provided in the "Continuation Sheet for Several Applicants". Do not indicate the details of more than one applicant in the form.

231. 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 e-mail address of the applicant first named in the international application. [[A.I. Section 13](#)]

## Preferred Language for Correspondence

232. In the case of an international application, the applicant may (by checking the appropriate box) indicate whether they wish 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 provisional refusal, are sent in the language in which they are received from the Office. [[Rule 6\(2\)\(iv\)](#)]

## Other Indications

233. Where the applicant is a natural person, they may indicate the State of which they are 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. [[Rule 9\(4\)\(b\)\(i\) and \(ii\)](#)]

234. Such indications are not required by the Protocol or the Regulations, but may be included in the international application, to avoid possible future objections that may be raised by Offices of designated members which require them.

## Entitlement to File

235. The applicant will need to provide details of the entitlement with the member, the Office of origin, by indicating one of the following:

- where the member is a State, that the applicant is a national of that State;
- where the member 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 member;
- that the applicant has a real and effective industrial or commercial establishment in that member.

236. Only one of these indications needs be given, though more may be given if the applicant so wishes. [[Rule 9\(5\)\(b\)](#)]

237. The Office of origin may ask for evidence of the entitlement where it has reasonable grounds to doubt the veracity of the indications given.

238. Where the applicant indicates that they have an establishment or domicile in the territory of the member of the Office of origin, but the applicant's address is not in that territory, the applicant must, in addition, indicate the address of their establishment or domicile in that territory as illustrated in the following example. [[Rule 9\(5\)\(c\)](#)]

*The Contracting Party (member) of the Office of origin is the United States of America.*

– *The applicant has provided an address in Switzerland as indicated below:*

### 1. CONTRACTING PARTY WHOSE OFFICE IS THE OFFICE OF ORIGIN

United States of America

### 2. APPLICANT

If there is more than one applicant, indicate the number of applicants and complete the “Continuation Sheet for Several Applicants”.

**Number of applicants:**

**(a) Name:**

World Intellectual Property Organization (WIPO)

**(b) Address:**

34, chemin des Colombettes  
CH-1211 Geneva 20  
Switzerland

– *The applicant has entitlement based on a real and effective industrial or commercial establishment in the United States of America as indicated below:*

### 3. ENTITLEMENT TO FILE

**(a) Check the appropriate box:**

(i)  where the Contracting Party mentioned in item 1 is a State, the applicant is a national of that State; or

(ii)  where the Contracting Party mentioned in item 1 is an organization, the name of the State of which the applicant is a national:

; or

(iii)  the applicant is domiciled in the territory of the Contracting Party mentioned in item 1; or

(iv)  the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party mentioned in item 1.

- *The applicant is required to provide an address in the United States of America (i.e., in the territory of the member from which they are claiming entitlement).*

**(b) Where the address of the applicant, given in item 2(b), is not in the territory of the Contracting Party mentioned in item 1, indicate in the space provided below:**

- (i) if the box in paragraph (a)(iii) of the present item has been checked, the domicile of the applicant in the territory of that Contracting Party, or,
- (ii) if the box in paragraph (a)(iv) of the present item has been checked, the address of the applicant's industrial or commercial establishment in the territory of that Contracting Party.

WIPO New York Office  
 2 UN Plaza, Suite 2525  
 New York, NY 10017  
 United States of America

239. 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. This information should be given in the specific continuation sheet for several applicants. See also paragraphs 166, 167, 230, and 231. [\[Rule 8\(2\)\]](#)

### **Appointment of a Representative**

240. If the applicant wishes to be represented before the International Bureau, the name and address of the representative should be given where indicated in the form. The appointment of a representative will not be recorded unless an e-mail address of the representative has been indicated (see also paragraphs 195). [\[Rule 9\(4\)\(a\)\(iii\)\]](#)  
[\[A.I. Section 12\(d\)\]](#)

241. Where the name of the representative is not given in Latin characters a transliteration of the name into Latin characters must be provided, 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.

242. Giving the name and address (including the e-mail address) of the representative in the international application is all that is necessary to effect the appointment; no power of attorney or other separate document should be sent to the International Bureau.

243. 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. Where the appointment cannot be recorded because the requirements concerning the appointment of the representative are not complied with, the International Bureau sends all communications to the e-mail address of the applicant (or the alternative e-mail address for correspondence for the applicant, if provided).

244. The appointment of a representative in the international application only concerns the empowerment 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 members, for example, in the event of a provisional 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 member concerned.

## Basic Application or Basic Registration

245. An international application 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 2\(1\)\]](#)

246. A basic registration recorded with 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 that governs the Office concerned, is regarded as the date of registration. This is not necessarily the date the mark was actually recorded by the Office in its Register; for instance, if the law applicable to that Office states that a mark is registered as of the date of filing, that is the date that should be given here. To avoid any confusion, where the basic mark is a registration, only provide the registration number (do not provide its application number). [\[Article 3\(1\)\]](#) [\[Rule 9\(5\)\(b\)\]](#)

247. A basic application filed with the Office of origin must be indicated by its application number and date of filing. [\[Rule 9\(5\)\(b\)\]](#)

248. 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 those with the earliest date(s) should be given, and those remaining should be indicated in a continuation sheet.

249. For further information on the basic mark requirement, please see paragraphs 153 to 156.

## Priority Claimed

250. 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: [\[Article 4\(2\)\]](#)

- 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>4</sup>; or

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<sup>4</sup> This results from the fact that members of the World Trade Organization (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.

- an application which, under a bilateral or multilateral treaty concluded between countries of the Paris Union, is equivalent to a regular national filing<sup>5</sup>.

251. Where priority is claimed, the applicant must indicate 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. A copy of the earlier filing is not required by the International Bureau. [\[Rule 9\(4\)\(a\)\(iv\)\]](#)

252. Where priority is claimed from more than one earlier filing and all relevant indications do not fit in the space provided, then those with the earliest date should be indicated in the form, with those remaining indicated in a continuation sheet.

253. Where the earlier filing does not relate to all of the goods and services listed later in the international application form, the applicant should indicate 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.

254. The International Bureau will disregard any claimed priority date that is more than six months earlier than the date of the international registration, and will so inform the applicant and the Office of origin. Such 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 378 to 383). [\[Rule 14\(2\)\(i\)\]](#)

255. 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 of priority will be disregarded and no data in respect of priority will be recorded by the International Bureau. [\[Rule 14\(2\)\(i\)\]](#)

## The Mark

256. A reproduction of the mark must be provided in accordance with the requirements of the form. Such a reproduction must consist of a two-dimensional graphic (including photographic) representation of the mark. This reproduction must correspond to the reproduction of the mark in the basic application or basic registration (basic mark). In particular, where the basic mark is in black and white, the reproduction of the international mark must also be in black and white; where the basic mark is in color, the reproduction must also be in color. [\[Article 3\]](#) [\[Rule 9\(4\)\(a\)\(v\)\]](#)

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<sup>5</sup> This results from Article 4A(2) of the Paris Convention. On this basis, the International Bureau records claims to priority from applications for European Union Trade Marks filed with the European Union Intellectual Property Office.

257. The reproduction 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.

258. The reproduction 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.

259. Where the Office of origin transmits, to the International Bureau, the reproduction of the mark in electronic format, for example, JPEG, this image will appear in the [Gazette](#). Where the Office of origin transmits the international application in paper format or PDF, the image used for publication is produced by scanning the application form, and the mark will be published in the Gazette exactly as it appears on the form. For example, if the mark is simply typed on the form, that is what will appear in the Gazette.

### **Special Kinds of Mark (Three-dimensional Marks, Sound Marks or Collective, Certification or Guarantee Marks)**

260. 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, as illustrated below. Such an indication may be given only if it appears in the basic mark. [\[Rule 9\(4\)\(a\)\(viii\) to \(x\)\]](#)

**(d) Where applicable, check the relevant box(es) below:**

- Three-dimensional mark
- Sound mark
- Collective mark, certification mark, or guarantee mark

261. 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 member may, however, ask for such regulations to be filed. To avoid a provisional refusal by such a member, an applicant may wish to send the required documents directly to the Office of that member as soon as they receive the certificate of international registration. Before doing so, the applicant should check whether there are any specific requirements for submitting such regulations, for example, whether a local representative is required and whether the regulations should be in the local language (rather than the language of the international application).

262. The reproduction of the mark in the application should correspond exactly with the representation of the mark, which appears in the basic mark. If the representation in the basic mark 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 the form. Any description, which is supplementary to this representation of the mark, should be given where indicated later in the form (see paragraphs 275 to 278). Non-graphical representations of such marks (such as samples of three-dimensional marks or recordings of sound marks) must not be included.

### Mark to Be in Color (Basic Mark in Black and White)

263. Where the applicant claims color as a distinctive feature of the mark but the reproduction of the mark in the basic mark is 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 addition to the black and white reproduction. [\[Article 3\(3\)\]](#)  
[\[Rule 9\(4\)\(a\)\(vii\)\]](#)

### Mark Consists Exclusively of a Color or Combination of Colors

264. Where the basic mark consists exclusively of a color or a combination of colors as such, without any figurative element, that fact should be indicated, as illustrated below. This is without prejudice to the fact that a designated member may refuse protection on the ground that such marks (color marks *per se*) are not recognized under its law. [\[Rule 9\(4\)\(a\)\(vii\*\*bis\*\*\)\]](#)



- (d)  The mark consists exclusively of a color or a combination of colors as such, without any figurative element.

### Standard Characters

265. The applicant may, if they wish, indicate that the mark is to be considered as a mark in standard characters, as illustrated below.

ROMARIN

- (c)  The applicant declares that the mark is to be considered as a mark in standard characters.

266. A mark in standard characters is known in some countries as a “word mark”, as opposed to a “figurative” mark. This declaration does not legally bind the Office or courts of a designated member, 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 that are not standard in the language(s) used in that member. [\[Rule 9\(4\)\(a\)\(vi\)\]](#)

267. A standard character declaration should not be made when the mark contains special characters or figurative elements. The International Bureau will not question a declaration concerning standard characters. However, the applicant should be aware that if the Office of a designated member considers that the mark is not in standard characters, it may issue a provisional 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.

## Color(s) Claimed

268. Where color has been claimed as a distinctive feature of the mark in the basic mark, 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, as illustrated below:

### 8. COLOR(S) CLAIMED

- (a)  **The applicant claims color as a distinctive feature of the mark.**  
Color or combination of colors claimed:

Blue pantone 2728 C

- (b) **Indication, for each color, of the principal parts of the mark that are in that color** (as may be required by certain designated Contracting Parties):

All letters in blue

269. Color may also be claimed in an international application despite the fact that there is not a corresponding claim in the basic mark. Where there is no such claim in the basic mark, the basic mark must be in the color or combination of colors claimed in the international application. Finally, where color is claimed, the 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 for example, “a red bird sitting on a green leaf”. [\[Article 3\(3\)\]](#) [\[Rule 9\(4\)\(a\)\(vii\)\]](#) [\[Rule 9\(4\)\(b\)\(iv\)\]](#)

## Miscellaneous Indications

270. It is important to be aware that it is not possible to change or remove miscellaneous indications from the International Register once they are recorded. In other words, such indications will remain on the International Register for the lifetime of the international registration. There are mandatory indications and optional indications.

### Transliteration of the Mark (Mandatory)

271. 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, as illustrated below.

Mark: ロマリン

#### 9. MISCELLANEOUS INDICATIONS

- (a)  **Transliteration of the mark** (this information is compulsory where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals):

Romarin

272. The transliteration into Latin characters must follow the phonetics of the language of the international application. [\[Rule 9\(4\)\(a\)\(xii\)\]](#)

### Translation of the Mark (Optional)

273. Where the mark consists of or contains words that may be translated, such a translation may be provided, as illustrated below. The translation may be into English and/or French and/or Spanish, irrespective of the language of the international application. Providing a translation is optional. However by doing so, the applicant may avoid provisional refusals being issued by Offices of designated members that require such translations. The International Bureau will not check the accuracy of any translation of the mark, nor will it question the absence of a translation or provide a translation of its own. [\[Rule 9\(4\)\(b\)\(iii\)\]](#)  
[\[Rule 6\(4\)\(b\)\]](#)

Mark: ROMARIN

- (b) **Translation of the mark** (as may be required by certain designated Contracting Parties; **do not** check the box in item (c) if you provide a translation in this item):

(i) into English: Rosemary

(ii) into French:

(iii) into Spanish: Romero

### The Mark Has no Meaning (Optional)

274. Where the applicant believes that the word or words appearing in the mark cannot be translated (for example, it is an invented word), this may be indicated by checking the appropriate box as illustrated below. This is intended to avoid provisional refusals from designated members requesting translation or for confirmation that no translation is possible.

- (c)  **The words contained in the mark have no meaning** (and therefore cannot be translated; **do not** check this box if you have provided a translation in item (b)).

### Description of the Mark

275. Where the basic mark contains a description of the mark, the same description may, if required by the Office of origin, be included in the appropriate space, as illustrated below:

- (e) **Description of the mark** (as may be required by certain designated Contracting Parties, such as, for example, the United States of America)
- (i) Description of the mark contained in the basic application or basic registration, where applicable (**only use this item** if the Office of origin requires to include this description in the international application for the purposes of item 13(a)(ii) of this form):

The mark comprises a brown coffee bean, in the center of an orange square.

276. 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 260), for example, a hologram mark, provided that such an indication is present in the basic mark. Where the description in the basic mark 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. [\[Rule 9\(4\)\(a\)\(xi\)\]](#) [\[Rule 9\(4\)\(b\)\(vi\)\]](#)

277. The applicant may also include a description of the mark in the international application that is not included, or differs from the one in the basic mark (“voluntary description” of the mark). This allows the applicant to include a description that is necessary to satisfy the requirements of some members, for example, those that require a description of the mark in non-standard characters, and to avoid unnecessary provisional refusals. It is important to note that this description will apply to the international registration as a whole, i.e., it will apply to all the designated members including those to be added in the future (subsequently designated). Offices of the designated members can either choose to recognize it, ignore it or seek clarification of it by way of a provisional refusal.

278. Offices cannot request that the holder remove or amend a description on the international registration as recorded in the International Register. However, this does not prevent an Office from issuing a provisional refusal to seek clarification of a description or request that a description be added. The Office may then add a description or include a description that is different to that in the international registration in their domestic Register. Therefore, if the applicant wishes to include a description for a particular member only, and costs are not a concern, they may leave this part of the international application form blank, and address this issue directly with the Office of the designated member concerned should a provisional refusal be issued.

## Verbal Elements of the Mark (Optional)

279. The International Bureau captures from the reproduction what appears to be the essential verbal elements of the mark. This is included in the [Madrid Monitor](#) database and is used in notifications and correspondence to confirm the identity of the resulting international registration. Where, however, the mark is in special characters or highly stylized, there is a risk that the words or letters may be misinterpreted by the International Bureau. Further, 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 they consider to be the essential verbal elements of the mark as illustrated in the example below:

### *Example of Verbal Elements of the Mark*

*The representation of the mark is as follows:*

**R***arin*

*The indication of the verbal element is as follows:*

(f) **Verbal elements of the mark (where applicable):**

Romarin

280. Some Offices may raise issues if the verbal element does not accurately reflect the mark in “their eyes”. Any such indication is, however, entirely for information purposes only and is not intended to have any legal effect. This indication should not be given where the applicant has declared that the mark is to be considered as a mark in standard characters.

## Disclaimer (Optional)

281. Where the applicant wishes to disclaim protection for any element of the mark, that element or elements should be indicated as illustrated in the example below:

(g) **The applicant wishes to disclaim protection for the following element(s) of the mark:**

The applicant disclaims the exclusive right to the use of the word “CAFÉ”.

282. The purpose of this is to avoid provisional refusals from designated members that may require such disclaimer to be included in the International Register. However, if a disclaimer is included in the international application, it will be in respect of the international registration as a whole, i.e., it will apply to all the designated members including those to be added in the future (subsequently designated). Alternatively, the applicant may leave this part of the form blank and address this issue directly with the Office of the designated member concerned should a provisional refusal be issued. [[Rule 9\(4\)\(b\)\(v\)](#)]

283. Offices cannot request that the holder remove or amend a disclaimer in the international registration, which is recorded in the International Register. However, this does not prevent an Office from issuing a provisional refusal to seek clarification of a disclaimer, or to request that a disclaimer be added. The Office may then add a disclaimer (or include one that is different to that in the international registration) in their domestic Register. The applicant may find useful information concerning disclaimer practice in the various members in the [Madrid Member Profiles](#) database.

284. It does not matter whether there is a corresponding disclaimer in the basic mark or not. If there is a disclaimer in the basic mark, this does not make it obligatory to include it in the international application. It is not possible to include a disclaimer in the International Register once the mark has been registered by the International Bureau.

## Goods and Services

285. The applicant must indicate the names of the goods and services for which they wish to protect the mark in the international registration. These must be grouped in the appropriate classes of the [Nice Classification](#). Each group of goods and services must be preceded by the number of the class, listed in the order of the classes to be covered. The goods and services must be indicated in precise terms, preferably using words appearing in the Alphabetical List of the Nice Classification. If necessary, a continuation sheet should be used and the appropriate box should be checked. [[Rule 9\(4\)\(a\)\(xiii\)](#)]

286. The list of goods and services set out in the international application (the main list) must fall within the scope of the goods and services set out in the basic mark. This means that the list in the international application may be narrower, but it cannot be broader or contain different goods and services. The terms used in the international application do not have to be exactly the same, but they must however, be equivalent to those used in the basic registration or application (see paragraphs 943 to 948).

287. The applicant may benefit from including all the goods and services covered by the basic mark in the international application, as a full list would provide more flexibility in the future in terms of the possible protection for subsequent designations and possibly save the applicant from having to file a new application in the future. For example, the basic mark covers classes 25 and 32; the international application covers class 25 and designates Australia, Canada and New Zealand. A future plan to extend the business in Australia to goods in class 32 was under consideration at the time of filing the international application, but class 32 was not indicated in the international registration. In such case, a new separate international application would need to be filed (based on the basic mark as the earlier international application) because class 32 was not included in the main list of the earlier international application. In hindsight, the applicant could have included classes 25 and 32 in their main list and requested a limitation of class 25 to Australia, Canada and New Zealand when filing the international application, then subsequently designated Australia to add class 32 resulting in only having one international registration to maintain in the future instead of having two.

288. The list of goods and services does not need to be the same for all the designations. It is possible to indicate different classes or different goods and services for the different designations, provided they are within the scope of the main list. Such tailoring of the list of goods and services can be done by limiting the list of goods and services for specific members (see paragraphs 294 to 298).

289. The Office of origin must check that all the goods and services listed are covered by those appearing in the basic mark, so that it can make the required declaration (referred to in [Rule 9\(5\)\(d\)](#)) (see paragraphs 943 to 950, for more information concerning the certification process). The Office should also help the applicant to check that the classification and grouping of the goods and services is correct to avoid any irregularities being raised by the International Bureau (see paragraphs 343 to 358). [\[Rule 9\(5\)\(d\)\]](#)

290. The International Bureau will apply the version of the corresponding edition of the Nice Classification in force at the time of the filing of the international application, regardless of the version and edition of the Nice Classification applied to the goods and services in the basic mark. Where the International Bureau receives the international application more than two months after the date of receipt of the Office of origin, and there is a new version or edition in place, the International Bureau will apply the new version or edition.

291. The International Bureau accepts class headings, but some members may not. To avoid a possible provisional refusal by the Office of such a member, it is advisable to list specific goods and services instead of using the indication of the class headings.

292. The use of expressions, such as “all goods in class X” and “all other services in this class”, will not be accepted by the International Bureau. Therefore, the relevant goods and services must be indicated. For further guidance and information on classification, please refer to the [Examination Guidelines Concerning the Classification of Goods and Services in International Applications Under the Madrid System](#) and the [Madrid Goods and Services Manager](#) made available on WIPO’s website.

293. 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 paragraphs 389 and 390), it may assist the International Bureau in ensuring that the translation reflects the applicant’s intentions, particularly where the list in the basic mark is in a language other than English, French or Spanish. [\[Rule 6\(4\)\(a\)\]](#)

### **Limitation of Goods and Services**

294. The international application may contain limitations of the list of goods and services in respect of one or more designated members.

295. There are many reasons why the applicant may wish to limit the goods and services for certain members. In general, a limitation may be used for reducing the amount of the fees to be paid, preventing a possible provisional refusal and/or avoiding possible litigation. Limitation may also be useful to enable the applicant to comply with an agreement made with a third party or to avoid a conflict with a third party.

296. The limitation may be different in respect of different designated members. If the basic mark covers class 32 “Beers; mineral and aerated waters and other non-alcoholic beverages”, the international application may, for example, indicate class 32 “Beers; mineral and aerated waters and other non-alcoholic beverages” for some designations, and for other designations (for example, where alcoholic beverages are not permitted) “mineral and aerated waters and other non-alcoholic beverages” may be indicated, as illustrated below:

**10. GOODS AND SERVICES**

(a) Indicate below the goods and services for which the international registration is sought

Class: Goods and Services:

32	Beers; mineral and aerated waters and other non-alcoholic beverages.
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(b)  The applicant wishes to limit the list of goods and services in respect of one or more designated Contracting Parties, as follows:

Contracting Party: Class(es) or list of goods and services for which protection is sought in this Contracting Party:

United States of America	Mineral and aerated waters.
European Union	Mineral and aerated waters and other non-alcoholic beverages.
Switzerland	Beers.

297. A limitation with respect to a designated member 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 members, the goods and services listed in the application are nonetheless included in the international registration and may be the subject of a subsequent designation. [\[Rule 9\(4\)\(a\)\(xiii\)\]](#)

298. When requesting a limitation, the applicant must expressly indicate all the goods and services for which protection of the mark is sought in the designated members concerned. If the applicant only indicates goods and services in a particular class, the International Bureau will consider that protection is only sought in the members for which the limitation is requested, and not for the other classes set out in the main list.

## Designations

299. The applicant must indicate the territories it wishes to designate and seek protection of the mark, by checking the appropriate boxes. [\[Rule 9\(4\)\(a\)\(xv\)\]](#)

300. It is not possible to designate the member of the Office of origin (prohibition of “self-designation”). [\[Article 3bis\]](#)

301. The applicant can only designate countries or intergovernmental organizations that are members of the Protocol. If the applicant has indicated a country for which the Protocol has not yet entered into force, the Office of origin may delete the designation and inform the applicant accordingly.

302. It is possible to designate, in the international application or subsequently, certain territories that are not members *per se*, but where the member concerned has extended the application of the Protocol to specific territories. This is the case for Bonaire, Saint Eustatius and Saba (BES-island), Curacao and Sint Maarten (Dutch part). These territories are not members; the member concerned here is the Netherlands. Similarly, the Bailiwick of Guernsey is not a member, but may be designated because the United Kingdom has extended the application of the Protocol to the Bailiwick of Guernsey (as of January 1, 2021). While these territories are not members, these will, however, perform the roles of an Office, as if they were.

## Specific Requirements Applicable to Certain Members

303. A number of specific requirements apply for certain members. These are indicated in the various footnotes in the form available on WIPO’s website ([MM2 form](#) and [Notes for filing MM2](#)), which is updated regularly. However, it should be noted, that if the international application includes a designation of the European Union or the United States of America, the following information should be provided at the time of filing the application.

### ***Indication of a Second Language (European Union)***

304. Where the European Union is designated in an international application, the applicant must select one of the five official languages of the European Union Intellectual Property Office (EUIPO), namely, English, French, German, Italian and Spanish. The second language must be different from the language of the international application. With regard to the designation of the European Union in a subsequent designation, refer to paragraph 477 to 480. [\[Rule 9\(5\)\(g\)\(ii\)\]](#)

305. This second language serves exclusively as a language in which third parties may lodge opposition and cancellation proceedings before the EUIPO.

306. Where the indication of the second language is missing or is incorrect, the International Bureau will still record the international registration or the subsequent designation and notify the EUIPO. However, a provisional refusal based on this ground will be notified by the EUIPO and will have to be overcome by the holder directly before the EUIPO.

### ***Seniority Claim (Earlier Rights in an European Union Member State)***

307. Seniority is a feature of the European Union (EU) trademarks system, governed by EU legislation. It may apply to owners of EU trademarks, and holders of international trademarks designating the EU.

308. An applicant (or holder) designating the EU in an international application (or subsequently in an international registration), may claim the seniority (prior rights) of an existing national trademark registration, or international registration protected in an EU member State provided that several requirements are met (for example, the owner, the mark and the goods and services must be the same). A valid seniority claim means that the prior rights in the member State concerned, may be allowed to lapse, without detriment to the holder's trademark rights in that particular country. In principle, the concept of seniority is based on the concept of "replacement" in the Madrid System. The details of the seniority claim will be published in the [Gazette](#), for the international registration concerned. [\[Rule 9\(5\)\(g\)\(i\)\]](#)

309. Applicants wishing to claim seniority in respect of a designation of the EU under the Protocol are required to indicate the following elements in a separate official form ([MM17](#)), to be annexed to the international application form [MM2](#) (see also the [Note for filing MM2](#) and the [Note for filing MM17](#)):

- 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.

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

310. Where a designated member 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 ([MM18](#); see also the [Note for filing MM18](#)), that declaration should be annexed to the international application ([MM2](#); see also the [Note for filing MM2](#)). Any additional requirements of that member concerning the language or the signing of the declaration must also be complied with. In particular, a member may require that the declaration be signed by the applicant. [\[Rule 7\(2\)\]](#) [\[Rule 9\(5\)\(f\)\]](#) [\[A.I. Section 2\]](#)

311. Accordingly, where the United States of America (US) is designated in an international application, a form MM18 must be completed and attached.

312. If the form MM18 is missing or defective, and where this irregularity is not remedied within the two-month period counted from the date of receipt of the international application by the Office of origin, the designation of the USA will be disregarded. The International Bureau will, however, proceed and record the international registration where other members are indicated (see paragraphs 371 and 372).

313. In the case of a member 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; the statement on the international application form indicates that by designating such a member, the applicant declares that they have the intention that the mark will be used by the applicant or with their consent in that member for the goods and services covered by the international application.

314. By designating Brazil, the applicant declares that the applicant, or a company controlled by the applicant, effectively and lawfully conducts business in connection with the goods and services for which Brazil is being designated; and, agrees to receive notifications, including summons, not covered by the Protocol concerning the international registration of the mark that is the subject of this international application, issued in judicial proceedings held in Brazil, by post.

### **Signature of the Applicant and/or Their Representative**

315. The Office of origin may require or permit the applicant or the applicant's representative to sign the international application. The International Bureau will not question the absence of such a signature. [\[Rule 9\(2\)\(b\)\]](#)

316. Any signature by the applicant or the representative may be handwritten, printed, typed or stamped. [\[A.I. Section 7\]](#) [\[A.I. Section 11\(a\)\(ii\)\]](#)

### **Certification and Signature of the International Application by the Office of Origin**

317. The Office of origin must sign the international application and must certify the date on which it received the international application (or is deemed to have received the application). This date is important because, in principle, it will become the date of the international registration (see paragraphs 378 and 379).

318. The Office of origin must certify that the particulars of the international application correspond to those of the basic mark, i.e., that the applicant is the same, that the mark is the same, and that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic mark. For more information on the certification process, see paragraphs 923 to 926. [\[Rule 9\(2\)\(b\)\]](#) [\[Rule 9\(5\)\(d\)\(i\)\]](#)

### **Fee Calculation Sheet**

319. The following paragraphs should be read in conjunction with the general remarks in paragraphs 74 to 90 concerning the payment of fees to the International Bureau.

320. The applicant must indicate, in the Fee Calculation Sheet contained in the official form: [\[Rule 9\(4\)\(a\)\(xiv\)\]](#)

- the authorization to debit the required amount from an account opened with the International Bureau (Current Account) 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.

## Applicable Fees

321. The fees payable for an international application consist of the basic fee (653 Swiss francs for a mark in black and white or 903 Swiss francs where the mark is in color) and, either a complementary fee (100 Swiss francs) for each member designated, and a supplementary fee (100 Swiss francs) for each class of goods and services in excess of three (referred to as the “standard fees”) or individual fees (as declared by the member concerned).

### ***Complementary Fees and Supplementary Fees (“Standard Fees”)***

322. Complementary fees (100 Swiss francs per designated member) and supplementary fees (100 Swiss francs for each class of goods and services in the excess of three) are fixed amounts and often referred to as “standard fees”, which apply where the members designated have not declared individual fees.

### ***Individual Fees***

323. Some members have declared that they would rather receive an individual fee instead of the supplementary and complementary fees. In this case, the applicant will pay the individual fee rather than the standard fees. [\[Article 8\(7\)\]](#)

324. However, where the designated member is a party to both the Agreement and the Protocol, and the member of the Office of origin is also a party to both treaties, the standard fees, and not the individual fee, are payable (see paragraphs 100, 101 and 322). [\[Article 9sexies\(1\)\(b\)\]](#)

### ***Fee Payable in Two Parts***

325. A member that requires an individual fee may also require that the fee is payable in 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 member 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. If the holder does not pay the second part of the individual fee within the time limit indicated in the notification by the International Bureau, the International Bureau will cancel the international registration in the International Register with respect to the member concerned and notify the holder and the member accordingly. [\[Rule 34\(3\)\]](#)

326. If the holder has failed to meet the time limit to pay the second part of the individual fee, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the failed time limit has ended (see also the [Notes for filing MM20](#)). Together with the request, the missing fee and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#) [\[A.I. Section 2\]](#)

## Amount of Fees

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

- the basic fee (653 Swiss francs for a mark in black and white or 903 Swiss francs where the mark is in color)
- an individual fee for the designation of each member that has made the relevant declaration (see paragraphs 323 and 324), except where that designated member 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 member in respect of which no individual fee is payable (100 Swiss Francs);
- a supplementary fee for each class of goods and services in excess of three (100 Swiss francs); where, however, all the members designated are those in respect of which an individual fee is payable, no supplementary fee is required.

328. The amounts of the basic, complementary and supplementary fees are set out in the [Schedule of Fees](#). The amounts of the current [Individual Fees](#) are available on WIPO's website. The [Fee Calculator](#), also available on WIPO's website, will estimate the fees, taking into account the Office of origin, the designation of members and number of classes of goods and services.

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

329. 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 IP Office of such country, as the Office of origin, will benefit from a 90% reduction of the basic fee (would only need to pay 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 WIPO's website. However, the applicants would need to pay the fees for each member designated.

330. The [list of least developed countries \(LDCs\)](#) is maintained and updated on a regular basis by the United Nations and may be consulted on the [United Nations website](#).

## How to Pay the Application Fees

331. The [fees may be paid](#) by the following methods:

- by debiting the required amount from a [Current Account at WIPO](#), or
- from funds already transferred to WIPO, or
- by transferring the require fees into WIPO's postal account (within Europe only) or bank account,
- by credit card (only where the Office of origin has [Madrid E-filing](#) (or its own online solution, or the applicant has used the [Madrid Application Assistant](#)) or following an irregularity concerning payment of fees after filing).

### ***Debit from a Current Account with the International Bureau***

332. Where payment is to be made by debit of the required amount from an [account opened with the International Bureau](#), the relevant box in 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. 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.

### ***Other Methods of Payment***

333. Where the applicant has not provided instructions to debit the required fee from a Current Account, the total amount being paid must be indicated in the appropriate box of the Fee Calculation Sheet. In addition, the breakdown of the amount of the fees, and preferably, the number of designations, classes and details of the individual fees, should be indicated in the spaces provided, to assist the International Bureau in identifying the error if the total is incorrect. Use the online [Fee Calculator](#) available on WIPO's website to help estimate the required fees.

334. Where funds were previously received and acknowledged by the International Bureau, the receipt number (issued when the international Bureau acknowledged the transfer) should be clearly indicated as well as the identity of the party who made the payment.

335. Where the fee is transferred to a [WIPO bank or postal account](#), check the respective box and indicate the following:

- name of party making the payment and complete address;
- [transaction code](#): enter the code (EN) for international application;
- the mark or verbal elements of mark (if available); and
- name of the applicant (if different than the name of the party making the payment).

336. 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, and to whom reimbursement will be made if the application is considered as abandoned, is not considered as such, or is withdrawn.

337. Where the fees are not being paid through the Office of origin, the Office may draw the applicant's attention to the fact that international registration cannot be recorded until the necessary fees have been received by the International Bureau. Paying the fees to the International Bureau is the responsibility of the applicant, the Office is not required to check that payment has been made.

### ***Payment by Credit Card***

338. If the Office of origin offers the [Madrid E-filing](#) service, or its own online solution, the fees may be paid [by credit card](#). Where the Office does not have the Madrid E-filing (or its own online solution), the applicant should use the [Madrid Application Assistant](#), upon receipt of which, the International Bureau will invite the applicant to pay the fees up front using available methods of payment including by credit card (before examination in the International Bureau). If the fees are not paid at the time of filing, or the fees are insufficient the International Bureau will issue an irregularity.

## **EXAMINATION OF THE INTERNATIONAL APPLICATION BY THE INTERNATIONAL BUREAU**

339. Once the International Bureau receives the international application, it will examine it to ensure it meets the formality requirements set out in the Regulations.

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

340. If there is an irregularity in an international application, the International Bureau will notify the Office of origin and the applicant. Whether the responsibility for remedying it lies with the Office or with the applicant depends on its nature.

341. 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 [\[Rule 12\]](#);
- irregularities with respect to the indication of goods and services [\[Rule 13\]](#);
- other irregularities [\[Rule 11\]](#).

342. Where the International Bureau finds that there are irregularities with the international application, it will:

- notify both the Office of origin and the applicant;
- inform of the specific irregularity;
- explain how to remedy this;
- provide a time limit of three months to remedy the irregularity;
- specify who needs to remedy the irregularity, the Office of origin or the applicant; and
- state what the consequence would be in case the irregularity is not remedied.

## Irregularities Concerning the Classification of Goods and Services

343. The classification and grouping of goods and services as listed in the international application is strictly the responsibility of the International Bureau. If there are any issues with the classification of the goods and services indicated in the international application, the International Bureau will try to resolve the issues with the Office of origin. The applicant will also be informed, so as to give them the opportunity of liaising with that Office to find a suitable solution.

344. The list of goods and services set out in the international application needs to follow the latest edition and version of the [Nice Classification](#). 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 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. However, such an interpretation does not bind a designated member with regard to the determination of the scope of the protection of the mark. [\[Rule 12\(1\)\(a\)\]](#) [\[Article 4\(1\)\(b\)\]](#)

345. The 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 [Nice Classification](#) than indicated in the international application, additional supplementary and/or individual fees may be payable to cover the additional classes.

346. 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 the applicant to intervene with the Office of origin. The International Bureau cannot, however, accept proposals or suggestions directly from the applicant.

347. 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 of the goods and services to the International Bureau. This opinion may originate from or be influenced by the applicant who, following the received information may have intervened with the Office of origin or may have been invited to give their opinion. The Office of origin is, however, not obliged to give their opinion on the proposal. The proposal made by the International Bureau prevails. [\[Rule 12\(2\)\]](#)

348. 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 indicated in the irregularity notice. [\[Rule 12\(3\)\]](#)

349. If the Office of origin responds to the irregularity notification, the International Bureau will review the response and will 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\(4\) to \(6\)\]](#) [\[Rule 12\(7\)\(c\)\]](#)

350. Any additional fees that may have to be paid as a consequence of the proposed reclassification must be paid: [\[Rule 12\(7\)\(a\) and \(b\)\]](#)

- 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.

351. 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, the Office of origin must notify the International Bureau accordingly.

352. This shows that the applicant must pay attention to irregularities issued to the Office of origin. When an additional amount of fees is due and, two months after the first notification (of which they were informed), the applicant receives the reminder of the International Bureau, they should intervene with the Office of origin to check whether the Office intends to communicate an opinion on the proposal. The applicant 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. See paragraph 980, for an example of an irregularity concerning the classification of goods and services.

353. 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. This currently amounts to 451.50 Swiss francs. [\[Rule 12\(8\)\]](#)

354. If the international application contains a limitation of the list of goods or services in respect of one or more of the designated members, the International Bureau will examine the limitations to ensure that the goods and services indicated are correctly classified and grouped under the [Nice Classification](#), applying the same examination procedure as described above (paragraphs 343 to 353). However, it will not examine whether the goods and services fall within the scope of the main list or not, as this should be determined by the Offices of the designated members. If the International Bureau is unable to group the goods and services listed in the limitation in the international application, it will issue an irregularity. If the irregularity is not remedied within three months from the date of the notification, the limitation will be deemed not to contain the goods and services concerned. [\[Rule 12\(8bis\)\]](#)

355. 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. [\[Rule 12\(9\)\]](#)

## Irregularities Concerning the Indication of Goods and Services

356. 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 (see paragraph 984, for an example of an irregularity concerning the indications of goods and services. It may suggest either a substitute term or the deletion of the term. [[Rule 13\(1\)](#)]

357. The Office of origin may, within three months of the notification, make a proposal for remedying the irregularity. The applicant should communicate their 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 made by the International Bureau, the International Bureau will change the term accordingly. [[Rule 13\(2\)\(a\)](#)]

358. 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 with an indication stating 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. [[Rule 13\(2\)\(b\)](#)]

## Other Irregularities

359. 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 remedy the irregularity.

### Irregularities to Be Remedied by the Office of Origin

360. There are a number of irregularities (in addition to those relating to the classification of goods and services) that must be remedied by the Office of origin. Such irregularities must be remedied by the Office of origin within three months after the notification, otherwise the international application will be considered abandoned and the Office of origin and the applicant will be notified accordingly. [[Rule 11\(4\)](#)]

361. The following irregularities must be remedied by the Office of origin, since an international application containing such defects should not have been forwarded to the International Bureau by that Office: [[Rule 11\(4\)\(a\)](#)]

- the international application was not presented on the correct official form, or not typed or otherwise printed, or not signed by the Office of origin;
- irregularities concerning the entitlement of the applicant to file the international application; for example, the application does not indicate the applicant's entitlement (see paragraph 157 to 165, and 235 to 239). This would be the case if, for example:
  - the applicant has indicated that they have an establishment or domicile in the territory of the member whose Office is the Office of origin, while their address is not in that territory, and no additional address has been given in the [MM2 form](#) (see paragraph 238), or

- the address given is also not in that territory; or
- the applicant’s address is in the territory of that member but it has not been indicated whether the applicant’s entitlement is based on an establishment or a domicile;
- irregularities concerning the date and the number of the basic mark;
- irregularities concerning the declaration by the Office of origin (certification) (see paragraphs 317 and 318, 923 to 926, and 956 to 957);
- Any of the following indications are missing:
  - indications allowing the identity of the applicant to be established and sufficient to contact the applicant or the representative;
  - an indication of at least one member to be designated;
  - a reproduction of the mark;
  - the list of goods and services for which registration of the mark is sought.

362. If 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.

363. Some of these irregularities are a straightforward matter for the Office of origin to remedy. Others might necessitate consultation with the applicant – for example, if the International Bureau considers that there are irregularities relating to the designations or the entitlement of the applicant to file an international application. Many Offices have a process in place to allow the applicant a short time limit to comment on the irregularity and provide any necessary information.

### **Irregularities to Be Remedied by the Office of Origin or by the Applicant**

364. Where the fees for the international application have been paid through the Office of origin and 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). 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. [[Rule 11\(3\)](#)]

365. If the applicant has failed to meet the time limit of three months to pay the missing amount, the applicant has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the failed time limit has ended (see also the [Note for filing MM20](#)). Together with the request, the missing fee and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [[Rule 5bis](#)]

## Irregularities to Be Remedied by the Applicant

366. The applicant must remedy any irregularity that is not listed for remedying by the Office of origin, or by the Office of origin or 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: [\[Rule 11\(2\)\(a\)\]](#)

- 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, the e-mail address is missing or any necessary transliteration is missing;
- the details given concerning the priority claim are not sufficient; for example, no filing date of the earlier application is given;
- the reproduction of the mark is not sufficiently clear;
- the international application contains a color claim, but the reproduction of the mark is not in color;
- 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 amount of fees paid directly to the International Bureau by the applicant or their representative is insufficient or missing;
- instructions have been given to pay the fees by debit to an account opened with the International Bureau (Current Account), but the necessary amount is not available in the account.

367. 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 priority claim 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\(2\)\(b\)\]](#)

368. If the applicant fails to meet the time limit of three months to remedy an irregularity, they have the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the failed time limit has ended (see also the [Note for filing MM20](#)). Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#)

369. 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. This currently amounts to 326.50 Swiss francs. [\[Rule 11\(5\)\]](#)

370. Where the international application includes a designation for a member that may not be designated (for example, where the applicant has attempted to designate the Office of origin), the International Bureau will disregard the designation and will inform the Office of origin accordingly.

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

371. When designating the United States of America (US), the applicant must complete and attach a declaration of intention to use the mark to the international application form, using [form MM18](#) (see also the [Note for filing MM18](#)), which must be attached to the international application. If 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\(6\)\(a\) and \(b\)](#)]

372. If, however, the missing or corrected declaration is not received within that period, the designation of the US 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 that designation. The International Bureau will also point out that the designation of the US may be added as a subsequent designation, provided that such designation is accompanied by the required declaration of intent to use. [[Rule 11\(6\)\(c\)](#)]

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

373. Where the International Bureau finds that the international application meets the applicable requirements, it registers the mark in the International Register. It also notifies the Offices of the designated members 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 will always be issued in the language of the international application. Certified copies of a certificate of international registration may be requested upon the payment of a fee. [[Rule 14\(1\)](#)]

374. The certificate of international registration is to be treated as a record that the international application has been registered with the International Bureau, this does not mean that the mark is protected in the designated members. An international registration certificate should not be confused with a certificate of registration issued by a national or regional intellectual property Office (which are generally issued once the mark has been granted protection in that territory). A certificate of international registration is more akin to a filing receipt at the national or regional level. At this time, it is not known whether the mark will be ultimately protected in the designated members as the Offices concerned have one year or 18 months to complete their substantive examination and issue their decision on the scope of protection. A decision by the designated members stating the grant of protection in their territories is the equivalent of a certificate of registration issued by a national or regional intellectual property Office (see more on such decision in paragraphs 441 to 447).

375. The international registration is published in the [Gazette](#). The Gazette can be accessed by [Madrid Monitor](#) available on WIPO's website. [[Rule 32\(1\)\(a\)\(i\)](#)]

## THE INTERNATIONAL REGISTRATION

### Effects of the International Registration

376. The effects of the international registration extend to the members expressly designated in the international application. [[Articles 3bis and 3ter](#)]

377. From the date of the international registration, the protection of the mark in each of the designated members is the same as if the mark had been filed or deposited directly with the Office of that member. If no provisional refusal is notified to the International Bureau within the prescribed time limit, or such refusal so notified is not regarded as such or is subsequently withdrawn, the protection of the mark in the member concerned shall, as from the date of the international registration, be the same as if the mark had been registered by the Office of that member. [[Article 4\(1\)](#)]

### Date of the International Registration

378. 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. [[Article 3\(4\)](#)]

379. 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, the Office is excused for the failure to submit the international application to the International Bureau within this two-month period due to *force majeure* reasons, 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. [[Rule 5](#)]

### Irregularities: Date in Special Cases

380. The date of the international registration may be affected if any of the following important substantive elements is missing from the international application:

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

381. If the date on which the last missing element reached the International Bureau is still within the two-month period referred to in paragraph 379, 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 do 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. This applies also in the cases of continued processing under [Rule 5bis](#) of the Regulations because the procedure of continued processing has no impact on the determination of the date of the international registration. [\[Rule 15\(1\)\]](#)

382. 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 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 (see paragraph 1009, for an example of how the date of an international registration may be affected in these special cases). [\[Rule 11\(4\)\(a\)\(ii\)\]](#)

383. The date of an international registration is not affected by any deficiencies other than those referred to in paragraph 380 (such as the late payment of fees or irregularities concerning the classification of goods and services). [\[Rule 15\(2\)\]](#)

## Recording of the International Registration

### Content of the International Registration

384. The international registration contains: [\[Rule 14\(2\)\]](#)
- all the data contained in the international application (except information relating to an invalid priority claim – 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 of Marks \(Vienna Classification\)](#), the relevant classification symbols as determined by the International Bureau. However, when the international application contains a declaration that the mark is to be considered as a mark in standard characters, symbols from the Vienna Classification will not be applied;
  - indications relating to a seniority claim (see paragraphs 307 to 309), concerning the member State or member States for which the earlier mark subject of the seniority claim 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

385. The international registration is published in the [Gazette](#). The Gazette can be accessed by [Madrid Monitor](#), available on WIPO's website. [\[Rule 32\(1\)\(a\)\(i\)\]](#)

386. The mark is published exactly as it appears in the international application or received in digital format from the Office of origin. Where the applicant has made a declaration that the mark is to be considered as a mark in standard characters, the publication will include an indication of that fact. [[Rule 32\(1\)\(b\)](#)]

387. 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 in [Madrid Monitor](#). This data will contain any irregularities that exist in the international application (for more information concerning Madrid Monitor, see paragraphs 114 and 131 to 134). [[Rule 33\(1\) and \(2\)](#)]

### Language of the Registration and the Publication

388. An international registration will be recorded and published in English, French and Spanish. [[Rule 6\(3\)](#)]

389. 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 to be incorrect, 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\(4\)\(a\)](#)]

390. The International Bureau will not translate the mark, nor will it check any translation of the mark given by the applicant. [[Rule 6\(4\)\(b\)](#)]

### Period of Validity

391. The registration of the mark is for 10 years from the date of the international registration, with the possibility of renewal for further periods of 10 years. [[Article 6\(1\)](#)] [[Article 7\(1\)](#)]

## EXAMINATION OF THE INTERNATIONAL MARK BY OFFICES OF THE DESIGNATED MEMBERS

### Grounds for Refusal

392. Each designated member 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 that Convention, and any such refusal will generally be subject to review or appeal, depending upon the laws and practice of the member concerned. [[Article 5\(1\)](#)]

393. The holder may consult the [Madrid Member Profiles](#) database to access information concerning the laws and practices of the trademark Offices of the members. Such information helps applicants and holders to understand the rules and procedures in effect in each of the target markets of interest, including time limits to respond to a provisional refusal, to request a review, or to file an appeal. The Members Profiles database is available to the public, free of charge on WIPO's website.

394. The Office of a member may not refuse protection of an international registration on the following grounds:

- on the basis that it covers more than one class or too many items of goods or services. The Office of a designated member must accept that an international registration may be protected in that member for several (or even all 45) classes of goods and services, even when that Office only permits single-class applications under its local practice.
- on formal grounds, as the formal requirements have already been checked by the International Bureau.
- the classification of the goods and services in the international registration, even if an Office disagrees with the classification (as approved by the International Bureau).

395. Where the designation includes a declaration that the mark is to be considered as a mark in standard characters, it is entirely up to each designated member to decide the effect of such a declaration.

396. An Office may object to a term in the specification if it is considered too broad or too vague. Such objection needs to be in the form of a provisional refusal. The Office may propose that the broad or vague term be replaced by a more narrow or precise term in the list of the goods and services in the International Register. Where the holder accepts a proposed term the result would in effect, be a limitation of protection for that member.

397. The Office must not advise the holder to contact the International Bureau to overcome any grounds for refusal. For example, it is possible for an Office to issue a provisional refusal on the grounds that a description of the mark is not clear, but it should not advise the holder to request an amendment of the description in the International Register. Any amendment to a description agreed between the holder and the Office concerned may, however, be reflected in the final decision by that Office and indicated in the domestic Register.

## Time Limits for Refusal

398. Once the applicable time limit (one year or 18 months) has expired, the holder of an international registration will know whether the mark is protected in a given member, or whether there is a possibility that protection will be refused and, if so, on what grounds.

399. Where the Office of a designated member finds grounds to refuse protection of the mark, it must notify the International Bureau of such provisional refusal within the applicable time limit. The default time limit is one year, from the date on which the International Bureau has notified the Office of the international registration or the subsequent designation. [\[Article 5\(2\)\(a\)\]](#)

400. However, any member may declare that the time limit of one year be replaced by 18 months (see paragraph 393 and paragraphs 1299 and 1300). [\[Article 5\(2\)\(b\)\]](#)

401. In that declaration, the member 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. In this case, the Office concerned would need to notify the International Bureau, before the expiry of the 18-month time limit for given international registration, that oppositions with respect to this international registration may be filed after the expiry of the 18-month period. The relevant dates concerning the possible opposition will be indicated in the notification. [\[Rule 16\]](#).

402. [Article 9sexies](#) states that a declaration made under [Article 5\(2\)\(b\) or \(c\)](#) would not have any effect in the mutual relations between members that are members of both the Agreement and the Protocol. This means that where both the member of the Office of origin and the member of the designation in the international registration are bound by both treaties, the time limit for the notification of a provisional refusal is one year, notwithstanding that the designated member in question may have declared an extended period for notifying a provisional refusal. [[Article 9sexies](#)]

403. Any provisional refusal sent after the applicable time limit will not be considered as such by the International Bureau (see paragraphs 424 to 427). The Office must raise all the relevant grounds for refusal in the provisional refusal as it is not possible for the Office to add new grounds or send a further provisional refusal after the expiry of the applicable time limit. The only exception is the situation mentioned in paragraph 401, for provisional refusals based on opposition where the member concerned has made the declaration under [Article 5\(2\)\(b\) and \(c\)](#). Please note that the applicable time limit (one year or 18 months) is only for the provisional refusal, there is no time limit for the Office to notify the International Bureau of its final decision following such refusal under [Rule 18ter\(2\) or \(3\)](#).

404. Provided that a warning concerning the possibility of later oppositions has been given, as described in paragraph 401, an Office may notify a provisional refusal based on an opposition after the expiry of the 18-month period. The following example helps to explain the operation of these provisions:

*An international registration (IR) designates a particular member in respect of classes 3, 5 and 10*

- *Upon examination, the Office considers that the mark should be refused protection in respect of classes 5 and 10. The Office issues a total refusal and indicates that protection may be considered for class 3 if the holder limits the list of goods set out in the IR to class 3 before the Office or, alternatively, by submitting a request for recording a limitation to class 3 to the International Bureau. If the holder does not respond within the given time limit of three months, the designation is considered abandoned in its entirety i.e., the designation will be totally refused.*
- *Upon examination, the Office considers that the mark should be refused protection in respect of classes 5 and 10, but may be protected for goods in class 3. The provisional refusal states that the holder must inform the Office within six months if they wish to request a review of this refusal; and in the event that the holder does not respond, the Office will proceed with publication of the mark for opposition for goods in class 3 only. The Office also informs that there is a possibility of an opposition being filed by a third party, even if this is after the end of the 18-month time limit for refusal;*
- *The holder requests a review of the provisional refusal in respect of goods in classes 5 and 10 within the six months' time-limit. Following such a review, the Office decides to refuse protection for the mark for goods in class 5 but allows protection for goods in class 10. The Office publishes the mark for opposition for goods in classes 3 and 10, and also notifies the holder that there is a possibility of an opposition being filed by a third party, even if this is after the expiry of the period of 18 months from the notification of the designation.*

405. This example is merely indicative. Many variants are possible and the details will vary, depending on the legislation of each designated member.

406. Where a designated member finds grounds for refusal, the Office must notify the International Bureau of such provisional refusal within the applicable time limit. Where the designated member does not issue any decision before the expiry of the applicable time limit, the Protocol considers the mark to be protected in that member from the date of the international registration, or the date of the subsequent designation, if that is the case. This is the principle of *tacit acceptance*. The International Bureau will publish a statement to that effect on the [Madrid Monitor](#) database available on WIPO's website, stating the following: "The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)". [\[Article 4\]](#)

407. For further details on the time limits for provisional refusal by an Office in a designated member, see paragraphs 1066 to 1079.

## Procedure for Refusal of Protection

### Notification of Provisional Refusal of Protection

408. The notification of provisional refusal is sent by the Office concerned to the International Bureau. It will contain the details of the international registration concerned and state the grounds on which the Office considers that protection cannot be granted ("*ex officio* provisional refusal"), or state that protection cannot be granted because an opposition has been filed ("provisional refusal based on an opposition"), or both, and will include a reference to the corresponding provisions of the relevant law. Also, it should be clear whether the provisional refusal concerns all goods and services covered by the international registration or, an indication of the goods and services that are affected, or not affected, by the provisional refusal.

409. If the grounds for refusal concern an earlier conflicting mark, all details of 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 local language of the Office concerned, for example, if the Office in Norway issues a notification of provisional refusal based on an earlier right, the details of that earlier right may be in Norwegian.

410. A notification of provisional refusal must relate to only one international registration. [\[Rule 17\(1\)\]](#)

411. The holder will be given a time limit to respond to the provisional refusal and details of the authority to file that response. If a local representative is required to file the response, this will also be indicated.

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

### ***Total or Partial Refusal***

413. The Office may issue either a total or partial refusal. Whether the refusal is total or partial depends on whether the holder is required to respond to the provisional refusal or not.

414. A total refusal is where the holder is required to respond to the refusal, and if they do not respond, the designation will be considered abandoned – even where the grounds of the refusal only apply to some of the goods and services, i.e., if the holder does not respond to the provisional refusal, the mark will be refused in its entirety – totally (see further in paragraphs 1089 to 1092).

415. A partial refusal is where the Office finds grounds for refusal but does not require the holder to respond in order for the Office to (partially) proceed with the designation in respect of some of the goods and services or with some other condition. This could be where the Office finds grounds to refuse protection, for example, for one out of the three classes covered by the international registration, and the holder wishes to proceed with the mark with the two classes that have not been refused rather than invest in contesting the decision. In this case, the Office would proceed with the publication of the mark for opposition once the time limit to respond has expired (see paragraphs 1093 to 1095). The Office may also wish to issue a partial refusal following a proposal for a clarification of a condition, for example, where the Office has proposed a disclaimer and the holder is happy to proceed with the proposed disclaimer. See paragraph 418, below concerning conditional acceptance.

### ***Notification of Provisional Refusal Based on Opposition***

416. 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 other information mentioned above, the notification 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 also provide the complete list of goods and services of that earlier application or registration. These lists may be in the local language of the Office (even if that language is neither English nor French nor Spanish). [[Rule 17\(3\)](#)]

417. Where an Office has made the declaration under [Article 5\(2\)\(c\)](#) – extending the time limit to issue a provisional refusal based on opposition after the expiry of the 18-month time limit, and where the Office finds that there may be a possibility of such opposition for a given international registration, the Office must notify the International Bureau of such fact before the expiry of the 18-month time limit.

### ***Conditional Acceptance***

418. At the national or regional level, the Office may decide on conditional acceptance, meaning that if the applicant accepts certain conditions, for example, a specific disclaimer, the mark will be accepted for publication for opposition or for protection. Where the Office finds that a given condition is required, it must notify the holder in a provisional refusal. Unless the mark may be fully accepted as it has been designated, the Office would need to issue a provisional refusal, for example, where the holder is required to accept a specific disclaimer to overcome the provisional refusal, the Office should indicate the disclaimer in the section “Other requirements, if any”.

### **Recording and Publication of the Provisional Refusal: Transmission to the Holder**

419. The International Bureau will examine the notification of provisional refusal to ensure it complies with the formal requirements. If it is in order, the International Bureau will record the provisional refusal in the International Register, together with an indication of the date on which the notification was sent (or is regarded as having been sent).

420. The provisional refusal is 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 member 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 and the Office has issued its final decision. The International Bureau makes the notification of provisional refusal available on [Madrid Monitor](#) database available on WIPO's website<sup>6</sup>. [\[Rule 17\(4\)\]](#) [\[Rule 32\(1\)\(a\)\(iii\)\]](#)

421. The International Bureau transmits a copy of the notification to the holder. It also transmits to the holder any information sent by the Office of a designated member 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. [\[Rule 16\(2\)\]](#) [\[Rule 17\(4\)\]](#)

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

422. The provisional refusal may be in English, French or Spanish (at the option of the Office making the notification). The fact that the international registration is refused 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 the provisional refusal, in the language in which it was sent by the Office of the designated member – the provisional refusal itself is not translated into the preferred language of the holder. The communication by the International Bureau forwarding the copy of the notification of provisional 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 paragraphs 170 and 232). [\[Rule 6\(2\)\(3\) and \(4\)\]](#)

### **Irregular Notification of Provisional Refusal**

423. If a notification does not meet the formality requirements, the International Bureau will consider the notification irregular. There are three types of irregular provisional refusals, each with varying degrees of consequences; there are those that are irregular, but will be recorded; there are those that are irregular that cannot be recorded; and there are those that are irregular and cannot be considered as such by the International Bureau.

#### ***The Provisional Refusal Is Not Considered as Such***

424. A notification of provisional refusal will be disregarded by the International Bureau if it is missing the international registration number, the grounds of refusal, or it was sent too late (i.e., after the expiry of the applicable time limit).

425. This is the most severe irregularity. In these cases, the Office must send a new provisional refusal if it still within the applicable time limit (one year or 18 months). If the time limit has expired, the international registration is deemed protected in the designated member concerned under the principle of *tacit acceptance*. [\[Article 4\]](#) [\[Rule 18\(1\)\(a\) and \(2\)\]](#)

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<sup>6</sup> Since January 1, 2009, the International Bureau has made available to users digitized copies of notifications of provisional refusal on the Madrid Monitor database.

426. The International Bureau will transmit a copy of the notification to the holder and inform them (and at the same time the Office that sent it) that it does not regard the notification of provisional refusal as such, and indicate the reasons why. [\[Rule 18\(1\)\(b\) and \(2\)\(c\)\]](#)

427. Where 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 still be made aware that this does not necessarily mean that there are no problems concerning the protection of the mark in the member concerned. For example, it may be possible for a third party to initiate an invalidation action against the designation, based on the grounds that were cited by the Office in the defective notification of provisional refusal. Depending on the irregularity contained in the notification of provisional refusal, the holder may wish to contact the Office for further information in respect of the grounds for refusal of protection and any risks that such grounds may pose.

### ***The Provisional Refusal Is Irregular and it Is Not Recorded***

428. Where, the notification does not contain 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. This type of irregularity causes a delay in the recording of the notification of the provisional refusal, as the Office will be given a time limit to remedy the irregularity. In these cases, the time limit for issuing a provisional refusal will be considered as being met, if the Office sends a rectified notification within the two-month period referred to in the irregularity notice. If the Office does not remedy its notification within this given time limit, it will not be regarded as a notification of provisional refusal and it will not be recorded in the International Register. The International Bureau will inform the holder and the Office that it does not regard the notification as such, indicating the reasons why. [\[Rule 18\(1\)\(d\)\]](#)

429. 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\(1\)\(e\) and \(f\)\]](#)

430. The International Bureau will send a copy of any rectified notification to the holder. Copies of any irregular notification of provisional refusal and, in the case of irregularities that can be remedied, of the irregularity notice sent to the Office to remedy it, can be very useful for the holder. In most 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, cited *ex officio* or who may have opposed the international registration.

### ***The Provisional Refusal Is Irregular but Recorded***

431. This is the least severe type of irregularity. 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 nonetheless record the provisional refusal in the International Register. It will then invite the Office to rectify its notification within two months, however, the Office is not required to remedy the irregularity. 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\(1\)\(c\)\]](#)

## Procedure Following Notification of Provisional Refusal

432. Where the holder of an international registration receives, through the International Bureau, a notification of provisional refusal, including an irregular notification of provisional refusal under [Rule 18\(1\)\(c\)](#), they have the same rights and remedies (such as, review of or appeal against the refusal set out in the domestic legislation) 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 member concerned, subject to the same procedures as would apply to an application for registration filed with the Office of that member. [[Article 5\(3\)](#)]

433. When responding to a provisional refusal (whether *ex officio* or based on an opposition) by requesting a review or filing an appeal against a decision of provisional refusal, the holder may in most cases be required to do so through a local representative. However, even if this is not required by the law of the member concerned, find it useful to consult 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 Protocol and the Regulations, and is governed by the law and practice of the member concerned.

434. The decision whether to grant or refuse protection of an international mark, or the reasons for doing so, is to be taken exclusively by the Office of the designated member concerned, in line with its domestic legislation and practices. The International Bureau has no authority to intervene in any way. Such matters are outside the role of the International Bureau.

## STATUS OF A MARK IN A DESIGNATED MEMBER

435. [Rules 18bis and 18ter](#) are concerned with the status, in a designated member, 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

436. An Office, which has not communicated a notification of provisional refusal, may within the applicable time limit, notify the International Bureau 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\(1\)\(a\)](#)]

437. An Office, which has communicated a provisional refusal, may send a statement to the effect that the *ex officio* examination has been completed and indicate that the protection of the mark is still subject to oppositions or observations by third parties. Equally, in this statement, the Office should indicate the date by which such oppositions and observations may be filed. [[Rule 18bis\(1\)\(b\)](#)]

438. The notification of such interim status of a mark is optional. It is provided for information purposes only and has no binding legal effect on domestic law. It is important to note, that there may exist provisions in the domestic law under which the Office may *ex officio* reassess the case and reach a different conclusion. Hence, in rare cases, an Office may send a notification of provisional refusal after having sent a positive statement under [Rule 18bis](#).

439. The International Bureau records any statement received under [Rule 18bis](#) in the International Register, informs the holder of the international registration concerned and, where the statement was communicated, or can be reproduced in the form of a specific document, transmits a copy of that document to the holder.

440. An Office of a designated member which has sent an interim status under [Rule 18bis](#), must, in due course, either send a notification of provisional refusal of protection in accordance with [Rule 17\(1\)](#) if an opposition (or observation) is filed during the applicable refusal period; or in the absence of opposition or observation having been filed, send to the International Bureau a statement in accordance with [Rule 18ter](#). If no follow-up is made by the Office in the form of a provisional refusal or statement of grant of protection, the principle of *tacit acceptance* prevails and the international registration is deemed protected in the member concerned.

## Final Status of a Mark

441. The Office of a member designated in an international registration is required to send a statement to the International Bureau confirming the final status of a mark in the member concerned, as soon as all the procedures concerning the protection of the mark before this Office have been completed. [\[Rule 18ter\]](#)

442. 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

443. Where an Office of a designated member has completed all its procedures and finds no ground to refuse protection of the mark, that Office must, as soon as possible and before the expiry of the applicable refusal period, send to the International Bureau a statement to the effect that protection is granted to the mark. Such statement of grant of protection is the equivalent of a domestic certificate of registration issued by the Office concerned. The International Bureau will, upon its receipt, record a statement of grant of protection in the International Register and inform the holder, as well as upload this decision to the [Madrid Monitor](#) database available on WIPO's website. [\[Rule 18ter\(1\)\]](#)

444. While such statement is obligatory where the conditions are met, should the International Bureau not receive such statement – or a provisional refusal – from the designated member concerned by the expiry of the applicable time limit of one year or 18 months, the principle of *tacit acceptance* applies and protection is deemed granted in that member concerned. [\[Article 4\]](#) [\[Rule 18ter\(1\)\]](#)

445. Where a holder has designated a member that has required that the fee for the designation is payable in two parts, the sending of a statement of grant of protection will be subject to payment of the second part of the fee. The holder will be notified by that Office concerned when and how much to pay for the second part of the fee. [\[Rule 34\(3\)\]](#)

## Statement of Grant of Protection Following a Provisional Refusal

446. Where an Office has notified the International Bureau of a provisional refusal, it must follow-up with its final decision once all procedures before the said Office have been completed. The type of decision will depend on whether the holder has successfully overcome the reasons for the refusal or not. Therefore, unless it confirms a total provisional refusal (see paragraph 448), the Office of a designated member that has issued a notification of provisional refusal must, once all procedures before the said Office have been completed, send to the International Bureau either: [\[Rule 18ter\(2\)\]](#)

- a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the member concerned, for all goods and services for which protection has been requested; or [\[Rule 18ter\(2\)\(i\)\]](#)
- a statement indicating the goods and services for which protection of the mark is granted in the member concerned. [\[Rule 18ter\(2\)\(ii\)\]](#)

447. Again, where a holder has designated a member that has required that the fee for the designation is payable in two parts, the sending of a statement of grant of protection shall be subject to payment of the second part of the fee. The holder will be notified by that Office concerned when and how much to pay for the second part of the fee. [\[Rule 34\(3\)\]](#)

## Confirmation of Total Provisional Refusal

448. Finally, the Office of a designated member that 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 member concerned for all goods and services, send to the International Bureau a statement to that effect. [\[Rule 18ter\(3\)\]](#)

## Other Decisions Affecting the Scope of Protection

### Further Decisions Taken by a Designated Member

449. There may be occasions where a decision is taken after a grant of protection, final decision or *tacit acceptance* that affects the scope of protection. For example, the holder may have successfully challenged the Office's final decision at a higher level that has resulted in the scope of protection being increased. Or a third party could have taken action after the final decision at an higher level, that has resulted in a decrease in scope of protection. If the Office of a designated member becomes aware of a further decision (for example, a decision resulting from an appeal to an authority outside of that Office) that affects the scope of that protection, it will send to the International Bureau a further statement indicating the goods and services for which the mark is now protected. Such statement could also be that the mark is no longer protected for any goods and services. [\[Rule 18ter\(4\)\]](#)

## **Recording of Statements Received Under Rule 18ter (Decisions Concerning the Scope, or Refusal of Protection)**

450. The International Bureau will record any statement received under [Rule 18ter](#) (i.e., statements received from Offices concerning the scope of protection) in the International Register and will 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 will also be published in the [Gazette](#). In addition, digitized copies of those statements, are also made available on [Madrid Monitor](#). [\[Rule 18ter\(5\)\]](#) [\[Rule 32\(1\)\(a\)\(iii\)\]](#)

## **Invalidation in a Designated Member**

451. The scope of protection in the territory of a designated member may be invalidated in whole or in part. The term “invalidation” in the context of the international registration, means any decision made by a competent authority (whether administrative or judicial) of a designated member revoking or canceling the effects, in the territory of that member, of an international registration with regard to all or some of the goods and services covered by the designation of that member.

452. The effects of an international registration may be invalidated for a number of reasons, for example, the holder has not complied with provisions of the law concerning the use of the mark, the mark has become generic or misleading or because it has been established that the mark should have been refused when the designation was originally examined. The invalidation may not be pronounced without the holder having an opportunity to defend their 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 member concerned. [\[Article 5\(6\)\]](#)

453. The procedures and substantive law governing such invalidation should be the same as for marks registered directly before the Office of that member. For example, the protection of the mark may be revoked because the holder has not complied with provisions of the law of the member 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.

454. Where the effects of an international registration are invalidated (in whole or in part) in a designated member, and the invalidation is no longer subject to any appeal, the Office of that designated member must notify the International Bureau of the relevant facts, namely: [\[Rule 19\]](#)

- 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 in the international registration or those which are still covered);
- the date on which the invalidation was pronounced and its effective date.

### Recording of Invalidations

455. 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 32\(1\)\(a\)\(x\)](#)]

### Communications from the Offices of the Designated Members Under Rule 23bis Sent Through the International Bureau

456. The holder may receive a communication from an Office of a designated member (through the International Bureau) that fall outside of its obligations in the Regulations. This concerns situations where the law of a member does not allow the Office to transmit the communication directly to a holder who has no address for service or local representative in that member concerned. Such communications could, for example, inform the holder that a cancellation action has been initiated in that member concerned and give the holder a time limit to defend their right.

457. The International Bureau transmits the communication to the holder or the recorded representative without examining its contents or recording it in the International Register. Such communication may be in the official language of the Office, and not in English or French or Spanish. [[Rule 23bis](#)]

458. Where any action taken against an international mark results in a decision affecting the rights in that member concerned, the Office would be obliged to notify the holder, under [Rule 18ter\(4\)](#) (further decision) or [Rule 19](#) (invalidation).

## SUBSEQUENT DESIGNATION

459. The holder may extend the geographical scope of an existing international registration by filing a subsequent designation (adding a member). The holder may wish to do this for a number of reasons, for example, to expand into new territories or to add a member that was not party to the Protocol at the time of filing the international application. The holder may also wish to extend the coverage of an existing designation that did not cover all the goods and services in the international registration; or to re-designate a member because the holder did not obtain protection (following a final refusal, an invalidation or a renunciation) and the grounds preventing such protection no longer exist. [[Article 3ter\(2\)](#)]

460. A subsequent designation means that the international registration will extend to additional member(s) and may be made for the full list of goods and services, or for only some of the goods and services recorded in the International Register. Providing all the formalities are met, the International Bureau will record a subsequent designation, even for a member already designated in the existing international registration.

461. 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 member, 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.

462. Where a given member is the subject of several subsequent designations, each referring to a different part of the list of goods and services recorded in the International Register, or even the same or similar goods and services, it is up to the designated member to determine the scope of protection, and whether it would allow for such double designation for same or similar goods and services.

463. Note that if a renunciation is requested in respect of a designated member, which has been designated more than once, all designations for that same member will be renounced. This means that as a practical measure, if a holder wishes to renounce a member, and then re-designate it (by way of a subsequent designation), they will need to ensure that the renunciation is recorded before the subsequent designation is requested.

## Subsequent Designations Not Possible in Certain Cases

464. In principle, a subsequent designation may be made with respect to any member, at any time. However, there is an exception for members that have made the declaration under [Article 14\(5\)](#). This means that those members, cannot be subject to subsequent designation where the date of the international registration is earlier than the date of entry into force of the Protocol in the member concerned. A few members have made such declaration, such as Brazil, Estonia, India and the Philippines. By way of example, a holder of an international registration can only subsequently designate India if the date of the international registration is July 8, 2013 or later, as this is the date the Protocol entered into force in India. Similarly, for Brazil, the date of the international registration must be October 2, 2019 or later, as this is the date the Protocol entered into force in Brazil. [[Article 14\(5\)](#)]

## Presentation of the Subsequent Designation

465. The holder must present the request for subsequent designation on the official [Online subsequent designation](#). Alternatively, the holder may submit [form MM4](#) (see also the [Note for filing MM4](#)) either directly to the International Bureau or through the Office of the member of the holder. [[Rule 24\(2\)\(a\)](#)]

466. It is recommended that the subsequent designation be transmitted directly to the International Bureau by using the [Online subsequent designation](#) service available on WIPO's website. This is the simplest way to add members to an international registration. Once the international registration number has been entered in the online form, a list of the members available for subsequent designation will be displayed, allowing the holder to easily select those that they wish to designate and for which goods and services (including a limitation of the list of goods and services). Further, the fees will be automatically calculated and can be paid by using a credit card or by debiting them from a current account at WIPO. [[Rule 24\(2\)\(a\) and \(3\)](#)]

467. If the formal requirements are not complied with, the International Bureau will not consider the subsequent designation and will inform the sender accordingly. [[Rule 24\(10\)](#)]

## Language of the Subsequent Designation

468. The subsequent designation may be sent to the International Bureau in English, French or Spanish at the option of the party sending the communication, independently of the language in which the international application from which the international registration resulted was filed. That is, where the subsequent designation is presented directly by the holder, they 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 the holder to one or two of these languages. [\[Rule 6\(2\)\]](#)

469. The holder may annex to their 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 within the prescribed time limit, the proposed translation will be corrected by the International Bureau. [\[Rule 6\(4\)\(a\)\]](#)

## Official Form

470. The following information must be provided in the official form ([Online subsequent designation](#) or form [MM4](#)). One form may be used to designate several members. [\[Rule 24\(2\)\(b\)\]](#) [\[A.I. Section 2\]](#)

## *International Registration Number*

471. The holder must indicate the number of the international registration for which they wish to make a subsequent designation. The subsequent designation may relate to one international registration only. One clear advantage of using the [Online subsequent designation](#) is that the information of the international registration (as recorded in the International Register) will be displayed when indicating the international registration number. [\[Rule 24\(3\)\(a\)\(i\)\]](#)

## *Holder of the International Registration*

### **Name**

472. The holder must indicate their name, which must be the same as recorded in the International Register. If the holder has changed their name without the change having been recorded in the International Register, the holder should request the recording of the change before making the subsequent designation if the intention is for the new name to be reflected in the subsequent designation. The International Bureau will treat the subsequent designation as irregular if the name indicated in the request differs from that recorded in the International Register. [\[Rule 24\(3\)\(a\)\(ii\)\]](#)

473. If there is more than one holder, the name(s) of the joint holders should be indicated exactly as recorded in the International Register.

## ***Designations***

474. The official form provides a box to be checked for each member for which an extension of the protection subsequent to the international registration is sought. [\[Rule 24\(3\)\(a\)\(iii\)\]](#)

475. It is possible to subsequently designate certain territories that are not members *per se*, but where the member concerned has extended the application of the Protocol to specific territories. This is the case for Bonaire, Saint Eustatius and Saba (BES-island), Curacao and Sint Maarten (Dutch part). These territories are not members; the member concerned here is the Netherlands. Similarly, the Bailiwick of Guernsey is not a member, but may be designated because the United Kingdom has extended the application of the Protocol to the Bailiwick of Guernsey (as of January 1, 2021). While these territories are not members, these will, however, perform the roles of an Office, as if they were members.

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

476. Where a member has made a declaration of intent to use the mark under [Rule 7\(2\)](#), this requirement would also apply where such member is subject to subsequent designation. See comments made for intention to use the mark under the international application, in paragraphs 310 to 314 and 371 and 372. [\[Rule 24\(3\)\(b\)\]](#)

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

477. Where the EU is subsequently designated, the holder should indicate the second language. This second language serves exclusively as a language in which third parties may lodge opposition and cancellation proceedings before the EUIPO.

478. Where the indication of the second language is missing or is incorrect, the International Bureau will still record the subsequent designation and notify the EUIPO. However, a provisional refusal based on this ground will be notified by the EUIPO and will have to be overcome by the holder directly before the EUIPO.

479. It should be noted that in the case of a subsequent designation of the EU, the second language must not be the language of the international application from which the international registration resulted, regardless of the language of the subsequent designation. For example, if the international application had been filed in French and the subsequent designation is filed in English, French may not be selected as the second language for the purpose of the subsequent designation of the EU. [\[Rule 24\(3\)\(c\)\(iii\)\]](#)

480. When subsequently designating the EU, the holder may also claim the seniority (prior rights) of an existing national trademark registration, or international registration protected in an EU member State, provided that several requirements are met (for example, the owner, the mark and the goods and services must be the same). A valid seniority claim means that the prior rights in the member State concerned may be allowed to lapse without detriment to the holder's trademark rights in that particular country. In principle, the concept of seniority is based on the concept of replacement in the Madrid System. The details of the seniority claim will be published in the [Gazette](#), for the international registration concerned. See more in paragraphs 307 to 309. [\[Rule 9\(5\)\(g\)\(i\)\]](#) [\[Rule 24\(3\)\(c\)\(iii\)\]](#)

### ***Goods and Services Concerned by the Subsequent Designation***

481. Where the subsequent designation is for all goods or services covered by the international registration concerned in respect of all members designated, this fact should be indicated by checking the relevant box. Where the subsequent designation is for only some of the goods or services covered by the international registration in respect of all members concerned, this fact should be indicated by checking the relevant box, 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 members designated, and for all the goods or services listed in the international registration in respect of the other members designated, this fact should be indicated by checking the relevant box, and the details (which goods and services for which designated members) should be indicated in a continuation sheet. [\[Rule 24\(3\)\(a\)\(iv\)\]](#)

482. The list of goods and services in the subsequent designation will follow the [Nice Classification](#) version and edition in place at the time of filing the international application. Therefore, where a subsequent designation is filed sometime after the recording of the international registration, there is a risk that goods and services may be classified under a different version of the Nice Classification. For example, the goods “nutcrackers” covered in an international registration recorded in 2015 will be classified in class 8. These goods have since been reclassified to class 21. However, the International Bureau will not reclassify goods and services at the time of subsequent designation or renewal. Therefore, if the holder filed a subsequent designation covering “nutcrackers” in 2017, these are classified in class 8, not class 21. The Office of the designated member will decide on the scope of protection following the classification in the international registration.

### ***Miscellaneous Indications***

483. There are a number of indications, which may be required by certain designated members, and which the holder may wish to indicate to avoid a refusal by that member. Where these indications have already been given in the international application, they need not be repeated since they will automatically be included in the notification of the subsequent designation to the Offices concerned. [\[Rule 24\(3\)\(c\)\]](#)

#### **Indications Concerning the Holder**

484. The holder may, if they are a natural person, indicate the State of which they are 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. The holder does not have to provide this information, but certain members require such indications and will issue a provisional refusal if these are not provided.

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

485. If color was claimed in the international application as a distinctive feature of the mark, the holder may indicate, in respect of each color, the principal parts of the mark which are in that color.

#### **Translation**

486. 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. If the words contained in the mark have no meaning and therefore cannot be translated, this should be indicated.

### **Voluntary Description**

487. The holder may include a voluntary description of the mark where such has not already been included in the international registration. This allows the holder to meet the requirements of designated members regardless of whether such description was contained in the basic mark or differs in wording.

### ***Date of the Subsequent Designation***

488. The holder may request that the subsequent designation take effect after the recording of a change or a partial cancellation in respect of the international registration concerned, or after the renewal of the international registration. [[Rule 24\(3\)\(c\)\(ii\)](#)]

### ***Signature of the Holder and/or Their Representative***

489. Where the holder communicates the subsequent designation directly to the International Bureau, the holder (or the representative) must sign it. [[Rule 24\(2\)\(b\)](#)]

490. 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 the representative. The Office may, however, require or allow the holder (or representative) to sign.

### ***Date of Receipt and Declaration by the Office of the Member of the Holder Presenting the Subsequent Designation***

491. A subsequent designation presented to the International Bureau 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, this part of the form should be left blank. [[Rule 24\(2\)\(b\)](#)] [[Rule 24\(3\)\(a\)\(vi\)](#)]

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

492. The holder should include all the relevant information concerning fees and the method of payment in the Fee Calculation Sheet. See the remarks concerning completion of the Fee Calculation Sheet in the international application form (paragraphs 319 to 338), and the general remarks concerning payment of fees to the International Bureau (paragraphs 74 to 90).

493. The fees payable in connection with a subsequent designation consist of: [[Rule 24\(4\)](#)]

- the basic fee (300 Swiss francs);
- an individual fee for each designated member that has made the relevant declaration (see paragraphs 323 and 324), except where that designated member 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 member for which no individual fee is payable.

494. The [Fee Calculator](#) available on WIPO's website may be used to calculate the fees payable in respect of a subsequent designation.

495. The subsequent designation follows the same lifecycle as the international registration. This means that the fees payable for a subsequent designation 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. The holder may wish to bear this in mind when making a subsequent designation very close to the renewal date. If costs are an issue, then the holder may wish to request the International Bureau to record the subsequent designation after the renewal of the international registration.

496. The payment may be made by any of the different means listed in 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 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 the Fee Calculation Sheet. When using the [Online subsequent designation](#), fees may be paid by using a credit card.

## Effects of Subsequent Designation

497. From the date of the subsequent designation, the protection of the mark in the subsequently designated member is the same as if the mark had been filed or deposited directly with the Office of that member. If no provisional refusal is notified to the International Bureau within the prescribed time limit, or such refusal is not regarded as such or is subsequently withdrawn, the protection of the mark in the member concerned shall, as from the date of the subsequent registration, be the same as if the mark had been registered by the Office of that member. [\[Article 4\(1\)\]](#)

## Date of Subsequent Designation

498. A subsequent designation presented by the holder directly to the International Bureau will bear the date on which it was received by the International Bureau. [\[Rule 24\(6\)\(a\)\]](#)

499. A subsequent designation 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. This applies also in the cases of continued processing under [Rule 5bis](#) because the procedure of continued processing has no impact on the determination of the date of the subsequent designation. [\[Rule 24\(6\)\(b\)\]](#)

500. The date of a subsequent designation may be affected if it contains irregularities (see paragraph 499).

501. In general, the possibility of being accorded an earlier date will be to the advantage of the holder. In certain circumstances however, this can cause complications, and may even have 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, 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 member. The following illustrates the issues that may arise, for example, where the international registration has a renewal date of July 5, 2022, and subsequent designation is requested just one month before.

***Example of a Subsequent Designation Requested Close to Renewal***



502. In contrast to a subsequent designation, the recording of a change under [Rule 25](#) (for example, change in holder's details, change in ownership or a change in the scope of protection, see paragraphs 525, 549, 590, 632 and 647) is deemed to take effect as of the date of receipt by the International Bureau of a request complying with the applicable requirements, regardless of whether the request to record the change was presented through an Office or directly to the International Bureau. This means that where a subsequent designation and a request to record a change are presented at the same time through an Office, the subsequent designation will generally bear an earlier date than the date of the change. For example, occasionally a holder may wish to renounce protection in respect of a particular member (because of a refusal by that member) and then immediately re-extend the protection to that member 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 member concerned will take effect after the new territorial extension to that member. In such case, there would then no longer be any designation in force for that particular member.

503. To avoid problems of this kind, the holder can indicate that the subsequent designation must take effect after the recording of a change or a partial cancellation in respect of the international registration concerned, or after the renewal of the international registration, by checking the appropriate box in the subsequent designation form. Such a change or partial cancellation must be specified and the relevant form submitted. [\[Rule 24\(6\)\(d\)\]](#)

504. It is not possible to include a priority claim in the subsequent designation. Where the date of the subsequent designation, determined as described in the above 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 members covered by the subsequent designation.

## Period of Protection

505. 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, 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 770). [\[Rule 31\(2\)\]](#)

## Irregular Subsequent Designation

506. 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\(5\)\(a\)\]](#)

507. Where a subsequent designation contains an irregularity, which relates to the number of the international registration concerned, the indication of the members 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 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\(6\)\(c\)\(i\)\]](#)

508. Any other irregularity will not affect the date of the subsequent designation. [\[Rule 24\(6\)\(c\)\(ii\)\]](#)

509. 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. Nevertheless, where official [form MM18](#) (“declaration of intention to use the mark”; see also the [Note for filing MM18](#)) has not been submitted together with a subsequent designation covering the United States of America (US), or where the submitted form is defective, and where this irregularity is not remedied within the given time limit, only the designation of the US will be considered as not contained in the subsequent designation. The International Bureau will proceed with its examination of the subsequent designation where other members are included therein. 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. Currently, this amounts to 150 Swiss francs. [\[Rule 24\(5\)\(b\)\]](#) [\[Rule 24\(5\)\(c\)\]](#)

510. If the holder presented the subsequent designation directly to the International Bureau, then they have 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 alone (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, they should contact that Office to ensure that the irregularity will be remedied in good time. In light of the above and to avoid unnecessary irregularities, it is recommended that the holder presents the subsequent designation directly to the International Bureau using the available online form.

511. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the failed time limit has ended (see also the [Note for filing MM20](#)). Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#)

## Recording, Notification and Publication

512. Where the subsequent designation is found to be in order, the International Bureau will record it in the International Register and notify the Office of the designated member. It will at the same time inform the holder and, if the subsequent designation was presented through an Office, that Office. [\[Rule 24\(8\)\]](#)

513. Where a priority claim still applies (see paragraph 504), the information concerning the declaration of priority will be included in the publication of the subsequent designation. [\[Rule 32\(1\)\(a\)\(v\)\]](#)

514. The subsequent designation will be published in the [Gazette](#). The Gazette can be accessed by [Madrid Monitor](#), available on WIPO's website. The subsequent designation will be recorded and published in English, French and Spanish. As regards older international registrations that, under the previous language regime, 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. That subsequent designation itself will be recorded in the International Register in English, French and Spanish. [\[Rule 6\(3\)\]](#)

## Decisions on the Scope of Protection by Designated Members

515. The Office of the designated member will perform the same substantive examination, regardless of whether it is designated in the international application or in the request for subsequent designation, to issue a decision on the scope of protection in line with their domestic legislation and [Rules 16 to 18ter](#). This means that where the Office finds no grounds for refusal, it will issue a statement of grant of protection. Where the Office finds grounds for refusal, it will issue a notification of provisional refusal. The time limit for a member to notify a provisional refusal of protection is one year or 18 months if a declaration under [Article 5\(2\)\(b\)](#) has been made, counted from the date on which the International Bureau has notified the subsequent designation to the Office of that member. [\[Article 5\(2\)\]](#) [\[Rule 24\(9\)\]](#)

## Subsequent Designation Resulting from the Conversion of the Designation of a Contracting Organization (the European Union)

516. Under the European Union Trade Mark System, where a European Union (EU) trademark application is withdrawn or refused, or where a EU trademark registration ceases to have effect, the holder of that EU Trade Mark may request its conversion into a national trademark application with the Office of one or more member States of the European Union. This possibility or feature is often also referred to as “opting-back”

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

518. Where a designation of the EU in an international registration 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 provides the holder of an international registration with the option of converting the designation of the EU 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. The following information only relates to subsequent designation resulting from conversion. [\[Rule 24\(7\)\(a\)\]](#)

519. As a general principle, subsequent designation resulting from conversion must comply with the requirements set out for “ordinary” subsequent designations (see paragraphs 459 to 496), subject to the following.

### Official Form and Contents

520. A subsequent designation resulting from conversion must be presented on a specific official form ([form MM16](#); see also the [Note for filing MM16](#)) and not the form used for an “ordinary” subsequent designation (MM4). Since the request must be submitted to the International Bureau by the EUIPO, it is recommended to use [the form established by them](#) (see more on this below).

521. A request for the recording of a subsequent designation resulting from conversion must contain or indicate the following: [\[Rule 24\(7\)\(b\)\]](#)

- the number of the international registration concerned;
- the name and address of the holder;
- the member Organization (the EU) whose designation is to be converted;
- the member State or States of the member Organization that are the subject of the subsequent designation;
- where the subsequent designation of a member resulting from conversion is for all the goods and services listed in respect of the designation of the member Organization, that fact, or, where the designation of that member is for only part of the goods and services listed in the designation of that member 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.

## Presentation of the Subsequent Designation Resulting from Conversion

522. A subsequent designation resulting from conversion must always be presented to the International Bureau through the Office of the member Organization, i.e., the EUIPO. The EUIPO must determine whether such request complies with the necessary conditions under its own legislation (in particular, whether requirements concerning time limits have been complied with) before transmitting the subsequent designation resulting from conversion to the International Bureau. Users are recommended to [use the form established by the EUIPO](#) given that requests must be presented directly to that Office. [\[Rule 24\(2\)\(a\)\(iii\)\]](#)

## Date of Subsequent Designation Resulting from Conversion

523. A subsequent designation resulting from conversion bears the date on which the designation of the member Organization in the international registration concerned was recorded in the International Register. This could either be the date of the international registration or the date of a subsequent designation. [\[Rule 24\(6\)\(e\)\]](#)

## RECORDING OF VARIOUS CHANGES IN THE INTERNATIONAL REGISTRATION

524. One of the benefits of the Madrid System is the ability for the holder to centrally manage their rights directly before the International Bureau. This means that the holder can request a number of changes directly with the International Bureau and providing the formality requirements are complied with, the International Bureau will record the requested changes and notify each of the designated members concerned.

525. The holder may request the recording of the various changes in the international registration as listed below: [\[Rule 25\]](#)

- change of name, address or legal nature of the holder;
- restrictions in the scope of protection of the international registration, such as limitation, renunciation and cancellation;
- change in ownership; and
- change in the name and/or address of the recorded representative.

## Language of Communication, Recording and Publication

526. In general, all communications, recordings in the international Register and publications in the official [Gazette](#) may be in English, French or Spanish. However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of a subsequent designation: [\[Rule 6\(2\)\]](#) [\[Rule 40\(4\)\]](#)

- 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).

## Change in Name, Address or Legal Nature of the Holder

527. It is possible for a holder of an international registration to request the recording of a change in their name and/or address. Where the holder is a legal entity, they may also file a request to add or change indications concerning the legal nature of that entity. The possibility to provide information on the legal nature and State of organization of the holder, where the holder is a legal entity, was introduced into the Madrid System to enable holders to satisfy the requirements in the laws of certain members. In certain members, a legal entity may change its legal nature without this change resulting in a new legal entity. This could pose significant challenges for holders of international registrations in, for instance, prosecution, enforcement and litigation proceedings because the holder's information contained in the International Register and notified to the members is no longer current. If such indications are provided to the International Bureau, such information will become part of the international registration.

### Presentation of the Request

528. The holder of an international registration may add or update its legal nature as recorded by the International Bureau (for example, limited liability company or corporation) to comply with the applicable domestic legislation using the same form required for a change of name and/or address. A request to add the legal nature of the holder, or record a change in name, address or legal nature of the holder, must be presented to the International Bureau using the [Online change in holder details](#) form or the official [form MM9](#), available on WIPO's website (see also the [Note for filing MM9](#)). The simplest way to request the recording of a change of name, address or legal nature of the holder is to use the [Online change in holder details](#) form. [\[Rule 25\(1\)\(a\)\(iv\)\]](#)

529. The form may be presented to the International Bureau directly by the holder or through the Office of the member of the holder. It is recommended to present the form directly to the International Bureau as this may result in an earlier date of recording. [\[Rule 25\(1\)\(b\)\]](#)

530. A single form may include one or more changes for one or more international registrations. The same change(s) can be recorded for multiple international registrations provided that the name of the holder recorded for each registration concerned is identical. For example, the holder may submit a single form for the recording of a change of name and address for several international registrations, provided the name of the holder (as recorded in the International Register) for all the registrations listed in the form is identical. The holder may also submit one form requesting to record a number of changes, such as a change of name, address and an indication of legal nature in respect of one international registration.

531. The [Online change in holder details](#) form or the official [form MM9](#) must not be used where the indicated change has resulted in a change in ownership of the international registration. A change in the name of the holder implies that the same person or legal entity continues to be the holder of the international registration. A holder would need to determine, in line with the applicable national/regional laws, whether it would be legally appropriate to request the mere recording of a change in name or legal nature rather than record a change in actual ownership of the international registration. In such a case, the [Online change in ownership](#) form or the official [form MM5](#) should be used (see the [Note for filing MM5](#) and paragraphs 603 to 627).

532. With regard to the language of recording, notification and publication of a change in name, address or legal nature of the holder, see paragraph 526.

### **Official Form**

533. The following information must be provided in the Official form ([Online change in holder details](#) or [form MM9](#)).

#### **International Registration Number**

534. The holder must indicate the number(s) of the registrations concerned. If, the number is not known (because the international registration has not yet been recorded or notified to the holder), no other number should be given; the holder should wait until they are notified of the international registration number concerned before submitting the form.

#### **Name of the Holder**

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

#### **Change in Name and/or Address of the Holder**

536. Only the information which has changed (new name and/or new address) needs be indicated in the form. That is, where only the name has changed, it is sufficient to indicate the new name; similarly, where only the address has changed, there is no need to repeat the name.

537. Where there are joint holders and the change only applies to one of them, it must be clear to which holder the change applies. If there are several joint holders but only one of them has a new name and/or address, provide the new name and/or address of the holder concerned, as well as the unchanged name and/or address of the other holders in the continuation sheet. For example, A and B are joint holders of an international registration. If just B wishes to change their name or address, the following details should be provided in the continuation sheet:

*“A’s name and/or address are unchanged; B’s new name and/or address have been changed as follows: [..].”*

538. In the example above, if only the new name and/or address of B is indicated without any information concerning A, the International Bureau will issue an irregularity notice, asking the holder to clarify the issue.

### **Recording of or Change in the Indications Concerning the Legal Nature of the Holder**

539. Where the holder is a legal entity, it may record or change the details of the legal entity by indicating the legal nature (e.g., “Limited Liability Company”) and the State (country) and the territorial unit within that State (canton, province, state, etc.) under which the laws of the legal entity has been organized (e.g., “USA, Florida”).

#### **Holder’s Contact Details**

540. To request a change in the holder’s contact details (for example, e-mail address or address for correspondence) use the [Online change in holder details](#) form. Such change is free of charge.

#### **Signature of the Holder and/or Their Representative**

541. Where the form is presented directly to the International Bureau, it must be signed by the holder or the representative as recorded in the International Register. [[Rule 25\(1\)\(d\)](#)]

542. Where the form is presented to the International Bureau through an Office, that Office may require or permit the holder or the representative to sign the form. The International Bureau will not question the absence of a signature when presented through an Office.

#### **Office of the Member of the Holder Presenting the Request**

543. Where the form is presented to the International Bureau, no documentation supporting the change should be included. However, where the form is presented through an Office, that Office may require to see such documentation before signing and transmitting the form to the International Bureau. A form presented to the International Bureau by an Office must be signed by that Office. [[Rule 25\(1\)\(d\)](#)]

#### **Fee Calculation Sheet**

544. The holder should include all the relevant information concerning fees and the method of payment in the Fee Calculation Sheet. See the remarks concerning completion of the Fee Calculation Sheet in the international application form (paragraphs 319 to 338), and the general remarks concerning payment of fees to the International Bureau (paragraphs 74 to 90).

545. A request to record the legal nature of the holder or a change in the name, address or legal nature of the holder is subject to the payment of the fee specified in the [Schedule of Fees](#). There is one flat fee of 150 Swiss francs, which covers any number of international registrations and/or recordings or changes mentioned in the request. The payment may be made by any of the different means listed in the Fee Calculation Sheet (and by credit card if using the online form). The most convenient method of payment is to use a current account with the International Bureau and simply give instructions to debit the required amount. Where payment is made by this method, the amount to be debited should not be specified. Where the [Online change in holder details](#) form is used, payment may be made by using a credit card.

## Irregular Requests

546. If a request to record a change concerning the name, address or legal nature of the holder does not comply with the applicable requirements, the International Bureau will notify the holder and the applicable Office, if the request was presented through an 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 referred to in item 7 of the [Schedule of Fees](#). Currently, this amounts to 75 Swiss francs. [\[Rule 26\]](#)

547. Where the request was presented through an Office, the holder will need to clarify whether that Office intends to remedy the irregularity or whether the holder must do this.

548. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the expiry of the failed time limit (see also the [Note for filing MM20](#)). Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. In the case of continued processing, the date of recording of the change will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#) [\[Rule 27\(1\)\(c\)\]](#)

## Recording, Notification and Publication

549. The International Bureau records the requested changes of the holder's details and notifies accordingly the Offices of the designated members. At the same time, it informs the holder and, where the request was presented by an Office, that Office. Information concerning the introduction of the legal nature of the holder or any changes concerning the holder's name, address or legal nature are recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements. It is possible to request that the recording of the change in the holder's details be recorded before, or after, the recording of another change, partial cancellation or subsequent designation, or after the renewal of the international registration. In addition, the International Bureau publishes the relevant information in the [Gazette](#). [\[Rule 25\(2\)\(c\)\]](#) [\[Rule 27\(1\)\(a\) and \(b\)\]](#) [\[Rule 32\(1\)\(a\)\(vii\)\]](#)

## The Effect of the Recording of a Change in Name, Address or Legal Nature of the Holder

550. When notified by the International Bureau, the designated members concerned by the change will take note of the recorded changes, and where necessary, update their domestic Registers.

## Recording of a Limitation, Renunciation and Cancellation

551. The holder may wish to record one of the following changes (restrictions) in the scope of protection of the international registration:

- a limitation of the list of goods and services, which may affect some or all of the designated members (“limitation”);
- a renunciation of the protection in respect of some of the designated members, for all the goods and services (“renunciation”);

- the cancellation of the international registration in respect of all the designated members, for some or all of the goods and services (“cancellation”).

552. Before requesting the recording of a limitation, renunciation or cancellation, the holder is recommended to consult the [notes for filing](#) available on WIPO’s website, which contain up to date information and guidance on these transactions.

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

### ***Limitation***

553. The holder may request the recording of a limitation to reduce the list of goods and services in respect of some or all of the designated members. This may be useful, for example, to overcome a provisional refusal (including one based on an opposition), or to comply with a settlement agreement. The recording of a limitation does not result in the removal of the goods and services concerned from the main list of 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 specific members covered by the limitation. Even if a limitation of the list of goods and services has been recorded with effect for all designated members, the goods and services, which have been the subject of a limitation, may later be included in a subsequent designation. Furthermore, since the goods and services subject of a limitation remain in the main list of the international registration, they are still taken into account when calculating any supplementary fees (i.e., where the designated member has not opted for individual fees) due on renewal.

### ***Renunciation***

554. The holder may request a renunciation of a designated member to abandon the effects of an international registration for all goods and services in the designated member concerned (i.e., remove a member from the international registration). This may be useful, for example, where the international registration is nearing the date of renewal and the holder no longer has any interest in the territory of the member concerned, or where the holder has received a refusal and has no intention to contest this. The effect of renunciation is that the protection of the international registration would no longer apply to the member that is the subject of a renunciation. However, where the holder has renounced some designated members, they may later subsequently designate these members.

### ***Cancellation***

555. In contrast, where an international registration is cancelled on request of the holder, the goods and services are permanently removed from the main list of the international registration in the International Register – and such removal will impact all of the designated members. A cancellation may be partial (for some goods and services only) or total (for all goods and services).

556. In case of a partial cancellation, the goods and services for which a cancellation has been recorded are removed from the International Register for all the designated members. The holder cannot request subsequent designation for the goods and services for which the international registration has been cancelled; if they wish to protect the mark again for such goods and services, it would be necessary to file a new international application.

557. In the case of a total cancellation, nothing remains on the International Register, the international registration no longer exists and subsequent designations are not possible. If the former holder wishes to protect the mark again, they must file a new international application.

558. If the holder voluntarily cancels the protection of the international registration, it is not possible to request transformation 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 817 to 822). [[Article 6\(4\)](#)] [[Rule 25\(1\)\(a\)\(ii\) and \(iii\)](#)]

### Summary of Restrictions

559. The table below illustrates the key differences between limitation, renunciation and cancellation.

	<b>Limitation</b> ( <a href="#">MM6</a> or <a href="#">Online limitation</a> )	<b>Renunciation</b> ( <a href="#">MM7</a> or <a href="#">Online renunciation</a> )	<b>Cancellation</b> ( <a href="#">MM8</a> )
Goods and Services	Some	All	Some or All
Designated Members	Some or All	Some	All
Subsequent Designations	✓	✓	✗
Fees	177 CHF	Free of charge	Free of charge

### Presentation of a Request for the Recording of a Limitation, Renunciation or Cancellation

560. A request for a limitation, renunciation or cancellation must be presented on the appropriate official forms ([MM6](#), [MM7](#) or [MM8](#)) (including online forms, where available) established by the International Bureau. [[Rule 25\(1\)\(a\)](#)]

561. The simplest way to request the recording of a limitation is to use the [Online limitation](#) form, which is available on WIPO's website. Once the international registration number is entered into the online form, the list goods and services as currently recorded for each of the designated members will be clearly displayed. These goods and services can then be easily modified, and entire class(es) can be deleted to reflect the limitation. Furthermore, the holder is given various options to pay the required fees, including by credit card or debiting the required amount from the holder's WIPO Account. Alternatively, a request to record a limitation may be presented on form [MM6](#) (see also the [Note for filing MM6](#)). A limitation only reduces the list of goods and services for the designated members concerned, without removing the goods and services from the main list of the international registration.

562. The simplest way to request the recording of a renunciation, i.e., to remove one or more (but not all) of the designated members from the international registration, is to use the [Online renunciation](#) form available on WIPO's website. Once the international registration number is entered into the online form, the designated members will be displayed and the holder can simply select the member(s) they wish to renounce. Furthermore, the holder is given various options to pay the required fees, including by credit card or debiting the required amount from the holder's WIPO Account. Alternatively, the holder may use form [MM7](#) (see also the [Note for filing MM7](#)). Where a renunciation is recorded, the international registration will no longer apply or be extended to the member(s) subject of that renunciation.

563. The holder should use form [MM8](#)<sup>7</sup> also available on WIPO's website to request the cancellation the international registration for some goods and services (partial) or all goods and services (total) for all the designated members covered in the international registration (see also the [Note for filing MM8](#)). The Online cancellation form should be used when it becomes available.

564. A request for a limitation, renunciation or cancellation may be transmitted to the International Bureau directly by the holder or through the Office of the member of the holder. It is recommended to present the form directly to the International Bureau, and to use online forms, where available ([Online limitation](#) and [Online renunciation](#)). [[Rule 25\(1\)\(b\)](#)]

565. It is possible to request that the recording of the specific restriction be recorded before, or after, the recording of another change, partial cancellation or subsequent designation, or after the renewal of the international registration.

### **Official Forms**

566. The information to be provided in the separate official forms, is broadly similar and is described together below, with the differences being commented on.

#### **International Registrations Concerned**

567. The number(s) of the international registration(s) concerned should be indicated. If, in respect of a given international registration, the number is not known (because the international registration has not yet been recorded or notified to the holder), no other number should be given; the holder should wait until they are notified of the number of the international registration concerned before submitting the relevant form.

568. A form is required for each type of transaction, but each form may relate to several international registrations, provided the scope of the restriction (limitation, renunciation or cancellation) is the same for each international registration. For example:

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<sup>7</sup> The *Online cancellation form* will be available in 2022.

Limitation

569. For a limitation of the list of goods and services for one or more specific members, the listed international registrations must be in the name of the same recorded holder and, the same limitation must apply to all designated members or to the same designated member for each of the international registrations.

*In the following scenario, all three of the international registrations may be listed in the same form, provided that the holder wishes to limit the goods to soaps only, in respect of China and Germany. However, separate forms would be required for limitations concerning shampoo, cosmetics or perfume, or where the limitation concerns Brazil, Japan, Switzerland, or the United States of America.*

- *International Registration No. 1234567 designating Brazil, China, Germany, United States of America covering class 3; soaps, shampoo, perfume.*
- *International Registration No. 2345678 designating China, Germany, Japan, Switzerland covering class 3; soaps, cosmetics.*
- *International Registration No. 3456789 designating China, France, Germany. covering class 3; soaps, perfume.*

570. Given the seriousness of the consequences of limiting the wrong international registration, or the wrong list of goods and services, the holder is advised to file separate forms for each international registration they are seeking to limit (as required when using the [Online limitation](#) form).

571. If all the goods and services in an international registration for a member are covered by the limitation, leaving that member “empty” of protection in their territory, it would be more appropriate to request a renunciation.

Renunciation

572. For a renunciation of one or more designated members, all the listed international registrations must be in the name of the same recorded holder and contain, at least, the specified members to be renounced.

*In the following scenario, all three of the international registrations may be listed in the same form, providing that the holder wishes to renounce China and/or Germany. However, separate forms must be used if the holder wishes to renounce Japan, Switzerland, United States of America or Brazil.*

- *International Registration No. 1234567 designating Brazil, China, Germany, United States of America.*
- *International Registration No. 2345678 designating China, Germany, Japan, Switzerland.*
- *International Registration No. 3456789 designating China, France, Germany.*

573. If an international registration only contains the member to be renounced, the renunciation would leave an “empty shell” and such renunciation should not be requested nor recorded.

### Cancellation

574. For a total cancellation, all listed international registrations must be recorded in the name of the same recorded holder.

*In the following scenario, only one form would be required regardless of whether the goods and services, and the designated members are the same or different.*

- *International Registration No. 1234567 covering class 3; soaps, shampoo*
- *International Registration No. 2345678 covering class 3; soaps, cosmetics*
- *International Registration No. 3456789 covering class 3; soaps, perfume*

575. However, if the request concerns a partial cancellation, given the seriousness of the consequences of cancelling the wrong mark or the wrong goods and services, and the potential errors that may incur when partially cancelling a number on international registrations, the holder must file separate forms for each international registration.

### **Holder**

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

### **Designated Members**

577. If a limitation of the list of goods and services is to apply to all the designated members, it is sufficient to check the relevant box in the [online form](#) or [MM6](#) form (see also the [Note for filing MM6](#)). Otherwise, those members in respect of which the limitation is to be recorded should be listed. Where the form relates to several international registrations, this list will apply to all of them.

578. In the case of a renunciation, the members affected should be listed in the appropriate space in the [online form](#) or [MM7](#) form (see also the [Note for filing MM7](#)). Where the form relates to several international registrations, the same list must apply to all of them.

### **Goods and Services**

579. In the case of a limitation, the scope of the limitation of the list of goods and services should be clearly indicated in the form. The limitation cannot be broader in scope than the goods and services recorded for the members concerned. The limited goods and services must be grouped under the corresponding number of the classes, indicating the number of the respective class, and in the sequence of the numbers of the [Nice Classification](#). Where the limitation concerns changes in a given class, the holder needs to clearly list those goods and services in that class (i.e., the “new limited list”). Where the limitation affects all the goods and services in one or more of the classes, the form must indicate the classes to be deleted. It will be understood that the designation of the members indicated in the form will no longer be protected for the class(es) concerned. Any class covered by the international registration(s) concerned that is not mentioned in the form, will remain as recorded in the International Register. Please see examples below:

*The international registration (IR) covers “clothing; footwear; headwear” in class 25 and “sunglasses” in class 9.*

- *Where the holder wishes to limit the IR for certain members to “clothing and headwear”, the holder should list “clothing; headwear” as the “new list” in class 25 and indicate that class 9 should be deleted.*

- *Where the holder wishes to limit the IR for certain members to “sunglasses” in class 9 and “t-shirts, footwear and headwear” in class 25 (i.e., limit the term “clothing”), the holder should indicate “t-shirts; footwear; headwear” in class 25 as the new limited list and not make any reference to class 9.*
- *Where the holder wishes to exclude “t-shirts” from “clothing” in class 25, the holder would need to indicate “clothing, except t shirts; footwear; headwear” in class 25 as the new limited list.*

580. In the case of a cancellation in respect of all the goods and services covered by the international registration (total cancellation), the relevant box in [MM8 form](#) should be ticked (see also the [Note for filing MM8](#)). In the case of a partial cancellation, the scope of the cancellation should be indicated, in the manner described in paragraphs 574 and 575.

### **Signature of the Holder and/or Their Representative**

581. Where the request is presented directly to the International Bureau, it must be signed by the holder (or their representative). [[Rule 25\(1\)\(d\)](#)]

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

### **Office of the Member of the Holder Presenting the Request**

583. A request 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, this field should be left blank. [[Rule 25\(1\)\(d\)](#)]

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

584. The holder should include all the relevant information concerning fees and the method of payment in the Fee Calculation Sheet. See the general remarks concerning payment of fees to the International Bureau (paragraphs 74 to 90).

585. A request to record a limitation is subject to the payment of the fee specified in the [Schedule of Fees](#). Where the form relates to several international registrations, a fee of 177 Swiss francs must be paid with regard to each one of them. The payment may be made by any of the different means listed in the Fee Calculation Sheet. The most convenient method of payment is to use a current account with the International Bureau and give instruction 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 by other methods than by debit 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 the Fee Calculation Sheet. Where the [Online limitation](#) form is used, payment may be made by credit card.

586. There is no fee payable to the International Bureau to request the recording of a renunciation or a cancellation. [[Rule 36\(iii\) and \(iv\)](#)]

## Irregular Requests

587. If a form requesting the recording of a limitation, renunciation or cancellation does not comply with the applicable requirements, the International Bureau notifies the holder and the applicable Office, if it was presented through an 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 set out in item 7 of the [Schedule of Fees](#). This applies to limitations only, and currently amounts to 88.50 Swiss francs. [[Rule 26](#)]

588. Where the form was presented through an Office, the holder should clarify whether that Office intends to remedy the irregularity, or whether the holder must do this.

589. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the expiry of the failed time limit (see also the [Note for filing MM20](#)). Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. In the case of continued processing, the date of recording of the change will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [[Rule 5bis](#)] [[Rule 27\(1\)\(c\)](#)]

## Recording, Notification and Publication

590. The International Bureau records the limitation, renunciation or cancellation in the International Register and notifies accordingly the Offices of those designated members concerned (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 relevant restriction is recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements. It is possible to request that the recording of a limitation or renunciation be recorded before, or after, the recording of another change, partial cancellation or subsequent designation, or after the renewal of the international registration. [[Rule 25\(2\)\(c\)](#)]

591. In addition, the International Bureau publishes the relevant information in the [Gazette](#). [[Rule 27\(1\)\(a\) and \(b\)](#)] [[Rule 32\(1\)\(a\)\(vii\) and \(viii\)](#)]

592. Where the request to record a cancellation is presented by the holder (or by an Office other than the Office of origin) before the end of the five-year dependency period referred to in [Article 6\(3\)](#) (see paragraph 802), the International Bureau will also inform the Office of origin of the cancellation.

## The Effect of the Recording of a Restriction

593. The effect of recording of a restriction of the international registration, is that the designated members concerned take note of the reduced scope in protection, and where necessary, update their domestic Registers accordingly. However, it is possible for a designated member to declare that a limitation has no effect in its territory. [[Rule 27\(4\) and \(5\)](#)]

## Declaration that a Limitation Has No Effect

594. The Office of a designated member, 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. 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. An Office of designated member may, for example, make such declaration when it considers that the limitation extends the scope of protection, either as set out in the designation or because the Office has already made a decision that has resulted in more narrow scope than the recorded limitation. The declaration must indicate the reasons for which the limitation has no effect, and the goods and services affected or those which are not affected by the declaration, 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. See paragraphs 1165 to 1178, for further information. [\[Rule 27\(5\)\(a\) to \(c\)\]](#)

595. Where the declaration is subject to review or appeal, the holder must check with 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\(5\)\(e\)\]](#)

596. Any declaration that a limitation has no effect, or any final decision in respect of such declaration, will be recorded in the International Register. This means that where such declaration is recorded, the limitation will not take effect in the designation concerned, and the scope of protection will be that as set out in the designation subject to any decisions the Office in the member of that designation has made under [Rule 18ter](#) (i.e., following its substantive examination) or [Rule 19](#) (invalidation). The relevant information will be published in the [Gazette](#). [\[Rule 27\(5\)\(d\) and \(e\)\]](#)

## Change in Ownership

597. 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, from 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. There is no distinction between such different causes for, or different types of, change in ownership. The term “change in ownership” is used for all cases.

598. The change in ownership of an international registration may be total, i.e., it relates to all the members designated and all the goods and services covered by the international registration, or partial, for example, where the change may concern:

- some designated members for all goods and services;
- all designated members for some goods and services; or
- some designated members for some goods and services.

599. 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, and the new owner is referred to as the “transferee”. Once the change in ownership has been recorded, the transferee becomes the holder of the international registration. [\[Rule 1\(xxi\)\]](#)

## Entitlement of the Transferee to Be the New Holder

600. The change in ownership may be recorded only if the transferee is a person who is entitled to file international applications.

601. The transferee must indicate their entitlement in the form, more specifically, the member or members with respect to which they fulfill the conditions (under [Article 2\(1\)](#)) to be the holder of an international registration. In other words, the transferee must indicate the member(s) where they have a real and effective industrial or commercial establishment, or is domiciled, or the country which is party to the Protocol (or a member State of an organization party to the Protocol) and of where they are a national. A transferee may claim the necessary connection with several members (see more on entitlement in paragraphs 614 to 616). [\[Article 2\(1\)\]](#) [\[Rule 25\(2\)\(a\)\(iv\)\]](#)

602. If there are several transferees, each of them must fulfill the conditions under [Article 2\(1\)](#), but it is not necessary that the member(s) through which the conditions are fulfilled be the same for each transferee. [\[Rule 25\(4\)\]](#)

## Presentation of a Request to Record a Change in Ownership

603. A request to record a change in ownership must be presented to the International Bureau on the official [form MM5](#) (see also the [Note for filing MM5](#)) or the [Online change in ownership](#) form. [\[Rule 25\(1\)\(a\)\(i\)\]](#)

604. The request may be presented to the International Bureau directly by the holder (or the recorded representative), or through an Office. In one situation, the form must be presented through an Office of the member, and this is where the recorded holder has not signed the form MM5, for example, because the holder does not exist anymore (due to a death or bankruptcy). In such case, the form must be presented through the Office of the member of either the recorded holder (the transferor) or the transferee. [\[Rule 25\(1\)\(b\)\]](#)

605. The International Bureau does not 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. Where the request is to be presented to the International Bureau through an Office, that Office may require evidence concerning the change of ownership.

606. It is possible to request that the recording of the change in ownership be recorded before, or after, the recording of another change, partial cancellation or subsequent designation, or after the renewal of the international registration.

### **Official Form**

607. The following information must be provided in the official [form MM5](#) or the [Online change in ownership](#) form.

### **International Registration Number**

608. 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 recorded holder to the same new holder (transferee), provided that, for each of the international registrations concerned, the change applies to all the designated members, or to the same members, and that it concerns all the goods and services, or the same goods and services.

609. If the international registration number is not known (because the international registration has not yet been recorded or notified to the holder), no other number should be given. It is not possible to record a change in ownership for an international application that is pending registration. Therefore, the holder would need to wait until they are notified of the number of the international registration concerned before submitting the form requesting the recording of the change in ownership.

#### **Name of the Holder (Transferor)**

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

#### **New Holder (Transferee)**

611. The name and address of the new holder (transferee) should be given following the guidelines concerning the name and address of the applicant in an international application (see paragraphs 225 to 231). [\[Rule 25\(2\)\(a\)\(iii\)\]](#)

612. As from February 1, 2021, a request for the recording of a change in ownership must also indicate the e-mail address of the transferee. Where the transferee has not indicated an email address, the International Bureau will issue a notification of irregularity under [Rule 26](#).

613. Where the transferee is a natural person, the nationality may be given where indicated in the form. 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 paragraphs 233 and 234). However, it would be useful to include this information as the Offices of some members may declare that the change in ownership has no effect where such indications are not provided. The transferee may indicate the preferred language for further communication with the International Bureau, English French or Spanish. [\[Rule 25\(2\)\(b\)\]](#)

#### **Entitlement of the New Holder (Transferee) to Be the Recorded Holder of the International Registration(s)**

614. The new holder (transferee) should indicate the member(s) of which they are a national, is domiciled or in which they have a real and effective industrial or commercial establishment. Where the transferee is domiciled or has an establishment in a member, which is also a member State of a member Organization, both of these members may be indicated, as appropriate. For example, where a transferee is domiciled in Sweden, they may indicate entitlement to both Sweden and the European Union. [\[Rule 25\(2\)\(a\)\(iv\)\]](#)

615. Where more than one member may apply, it is a matter for the transferee to decide 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.

616. Where the transferee's address is not in the territory of the member of its entitlement based on domicile or an establishment, it is necessary to provide the address of the transferee's domicile or establishment unless the transferee is stating that its entitlement is based on their nationality of a member, which is a member State of a member Organization. For example, where the transferee has an address in Germany, but is basing their entitlement on an establishment or domicile in the United Kingdom, they would need to provide an address in the United Kingdom. However, if the transferee has an address in Germany but is basing their entitlement on their United Kingdom nationality, they would not need to provide a further address. Similarly, if the same transferee based their entitlement on domicile, nationality or establishment in Germany or the European Union, it would not be necessary to provide a further address. [\[Rule 25\(2\)\(a\)\(v\)\]](#)

### **Appointment of a Representative by the New Holder (Transferee)**

617. The new holder (transferee) may request the appointment of a representative in the [form MM5](#) (see also the [Note for filing MM5](#)) or in the [Online change in ownership](#) form. Where such representative is appointed, the new holder (transferee) must sign this section of the form. When using the online form, the new holder will receive a message from the International Bureau asking them to confirm the appointment of the new representative. An e-mail address must also be indicated for the representative appointed by the new holder (transferee). If there is no signature, the International Bureau will still process the request for the change in ownership, but the appointment of the representative will not be recorded and all communications from the International Bureau will be sent directly to the e-mail address of the transferee. The new holder may then later appoint a representative using the relevant form ([Online management of representative](#) or [form MM12](#)).

618. 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, they should be re-appointed by completing the appropriate section of the form. [\[Rule 3\(6\)\(a\)\]](#)

### **Scope of the Change in Ownership**

619. If the change in ownership is total, meaning it relates to all the designated members covered by the international registration and to all the goods and services covered by the said registration, this should be indicated by checking the relevant box.

620. In the case of a partial change in ownership, the relevant box should be checked, and the members in respect of which the change in ownership is to be recorded should be named, and a list of the goods and services affected, grouped in the classes and sequence of the [Nice Classification](#) should be provided. The list of specific goods and services cannot be broader than the main list in the international registration, and semicolons (;) should be used to separate items in the list. For example, if the international registration is for "shoes" in class 25 only, then "shoes" or "sandals" may be specified as the subject of the change in ownership, but "pants" or "hats" cannot be indicated since those goods are not included in the main list of the international registration.

621. If more space is needed to indicate the members (Contracting Parties) or the goods and/or services, check the box at the bottom of the page, to indicate the use of a continuation sheet.

### **Signature of the Holder (Transferor) and/or Their Representative**

622. Where the form is presented directly to the International Bureau, it must be signed by the holder (or the recorded representative). [\[Rule 25\(1\)\(d\)\]](#)

623. Where the online form is used, and the e-mail address used to request the change in ownership is not the same as that on record for the holder or their representative, the International Bureau will send a message to the holder or their representative on record, inviting them to confirm the request. If not confirmed within seven days, the request will be cancelled and any fees paid will be reimbursed.

624. Where the form 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 question the absence of a signature from this item.

### **Office of the Member of the Recorded Holder (Transferor) or that of the New Holder (Transferee) Presenting the Request**

625. A form presented to the International Bureau by an Office must be signed by that Office. [\[Rule 25\(1\)\(d\)\]](#)

### **Fee Calculation Sheet**

626. The holder should include all the relevant information concerning fees and the method of payment in the Fee Calculation Sheet. See the general remarks concerning payment of fees to the International Bureau (paragraphs 74 to 90).

627. 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 of 177 Swiss francs must be paid for each one of them. The payment may be made by any of the different means listed in Fee Calculation Sheet. The most convenient method of payment is to use a current account with the International Bureau and give instructions 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 by other methods than by debit from an account with the International Bureau, the method of payment, the amount paid and the party making the payment or giving the instructions should be indicated in the Fee Calculation Sheet.

### **Irregular Requests**

628. The International Bureau will notify the holder if the form does not comply with the applicable requirements. If the form was presented through an Office, that Office will also be notified. The irregularity must be remedied within three months from the date of the notification, otherwise, the request will be considered abandoned and paid fees will be reimbursed to the party that paid them, after deduction of an amount corresponding to one-half of the fee set out in item 7 of the [Schedule of Fees](#). Currently, this amounts to 88.50 Swiss francs. [\[Rule 26\]](#)

629. Where the form was presented through an Office, the holder or the transferee should establish whether that Office intends to remedy the irregularity, or whether the holder or the transferee should do so.

630. If the holder has failed to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the expiry of the failed time limit (see also the [Note for filing MM20](#)). Together with the request, the holder or the transferee must remedy the irregularity concerned and pay the fee for continued processing. In the case of continued processing, the date of recording of the change will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [[Rule 5bis](#)] [[Rule 27\(1\)\(c\)](#)]

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

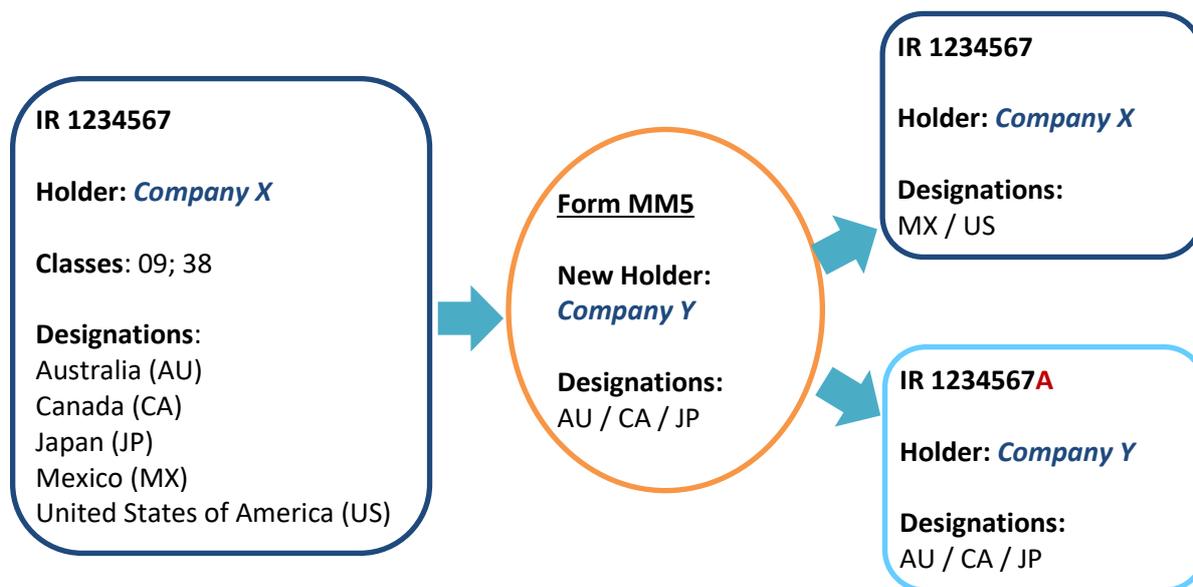
631. The International Bureau records the change in ownership in the International Register and notifies accordingly the Offices of the designated members concerned with the change. At the same time, it informs the new holder and, where the request was presented through an Office, that Office. The International Bureau will also inform the former holder in the case of a total change in ownership; and the holder of the part of the international registration that has not been subject of the change in the case of a partial change in ownership. [[Rule 27\(1\)\(a\)](#)]

632. The change in ownership is recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements. It is possible to request that the recording of the change in ownership be recorded before, or after, the recording of another change, partial cancellation or subsequent designation, or after the renewal of the international registration. The International Bureau publishes the relevant information in the [Gazette](#). [[Rule 27\(1\)\(b\)](#)] [[Rule 32\(1\)\(a\)\(vii\)](#)] [[Rule 6\(3\)](#)]

### **Partial Change in Ownership**

633. Where a request to record a change in ownership of an international registration only concerns some of the goods and services or some of the designated members, the change will be recorded in the International Register under the number of the international registration concerned. The part that has been transferred will be recorded as a separate international registration. This new international registration shares the same number as the original registration, together with a capital letter, and will be published in the [Gazette](#). [[Rule 27\(2\)](#)] [[A.I. Section 16](#)]

### Example of Partial Change in Ownership



634. The above example illustrates the following:

- *Company X is the recorded holder of international registration (IR) 1234567 for classes 9 and 38 designating Australia (AU), Canada (CA), Japan (JP), Mexico (MX), United States of America (US).*
- *Company X wishes to record a partial change of ownership for three of the five designations. The new holder of the three designations being transferred (AU, CA, JP) is Company Y.*
- *The recording of this partial change of ownership results in two IRs. The original IR for the two designations not transferred (that remain in the name of Company X) and the creation of a new IR 1234567A for the three designations being transferred recorded in the name of the new holder Company Y.*

*Either of the resulting separate IRs may be the subject of a further total or partial change in ownership, as well as recordings of subsequent designations.*

### Several Consecutive Changes in Ownership

635. Where an international registration has been the subject of several consecutive changes in ownership that have not yet been recorded in the International Register, the recording of the changes in ownership may be requested by submitting separate [MM5 forms](#), one for each change in ownership together with the payment of fees (see also the [Note for filing MM5](#)). With this approach, the full history of ownership would be recorded in the International Register. Alternatively, the holder could request the recording of a change in ownership from the recorded holder to the latest owner. However, in this case, the International Register would only reflect one change in ownership and not show the full history of the international registration.

## Declaration that a Change in Ownership Has No Effect

636. It is up to the members concerned to determine the effects of the change in ownership. The validity of a change in ownership of an international registration in respect of a particular member is governed by the law of that member. In particular, where the change in ownership is for only some of the goods and services, a designated member has the right to refuse to recognize the validity of the change if the goods and services included in the change are similar to those remaining in the name of the holder. A designated member may make such declaration following its domestic legislation, for example, where the transferee concerned is a person or legal entity which is not entitled to own marks or where the Office finds that the change would be likely to mislead the public.

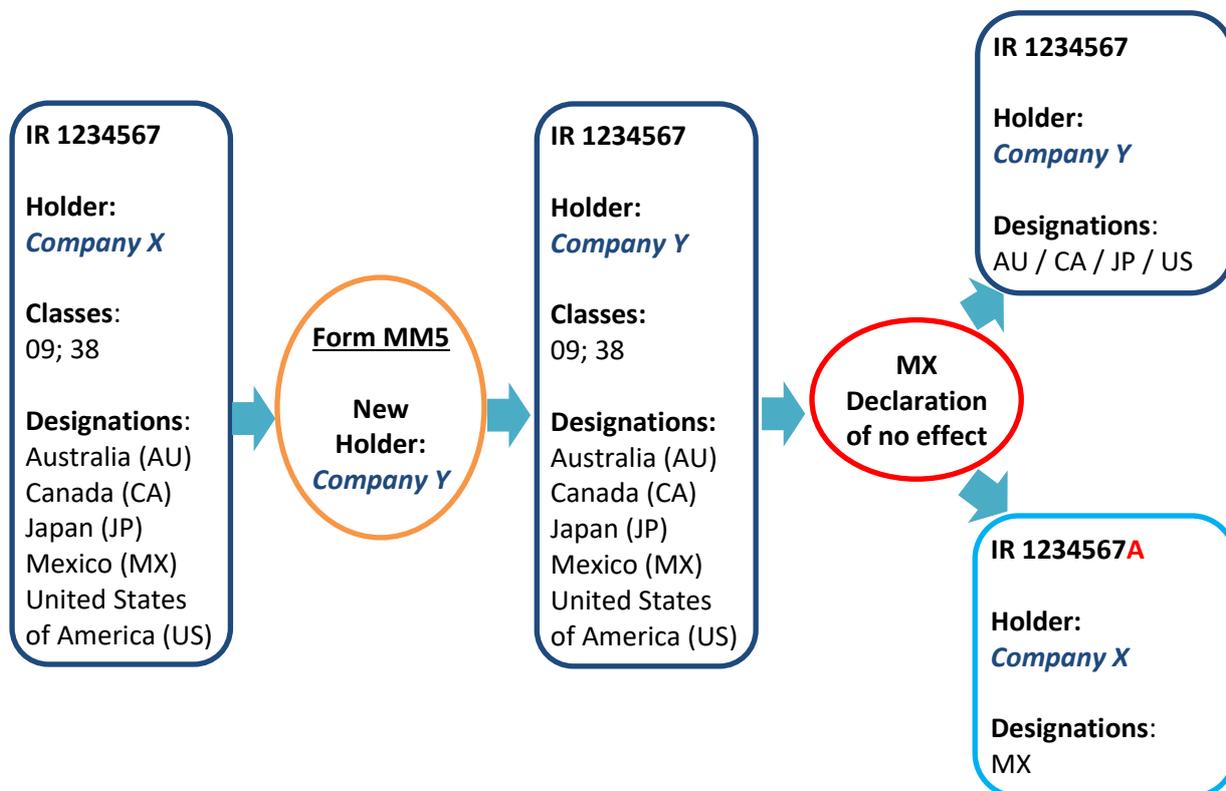
637. The Office of a designated member, which is notified by the International Bureau of a change in ownership affecting it, may therefore declare that the change in ownership has no effect in its territory. Any such declaration must be sent to the International Bureau before the expiry of 18 months from the date on which the notification of the change in 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. 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\(4\)\(a\) to \(c\)\]](#)

638. Where the declaration is subject to review or appeal, the transferee must check with 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\(4\)\(e\)\]](#)

639. 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 paragraphs 633 and 634). The relevant information will be published in the [Gazette](#). [\[Rule 27\(4\)\(d\) and \(e\)\]](#) [\[A.I. Section 18\]](#) [\[Rule 32\(1\)\(a\)\(xi\)\]](#)

640. The effect is that the designated member concerned does not recognize the transferee as the holder of the international registration. In the International Register, the effect of such declaration is that, with respect to that member, the international registration concerned remains in the name of the transferor (former holder). The effect of such a declaration as far as the transferor and transferee are concerned is, however, a matter for the applicable national law. [\[Rule 27\(4\)\(a\)\]](#)

**Example of Partial Change in Ownership Following the Recording of a Declaration that the Change of Ownership Has No Effect**



641. The above example illustrates the following:

- Company X is the recorded holder of international registration (IR) 1234567 for classes 9 and 38 designating Australia (AU), Canada (CA), Japan (JP), Mexico (MX), United States of America (US).
- Company X wishes to record a total change of ownership to the new holder, Company Y.
- Company Y is recorded as the new holder and the Offices of all designated members are notified.
- The Office in Mexico (MX) issues a declaration that the change in ownership has no effect in Mexico. This results in two IRs. The original IR (the parent) transferred to Company Y covering all designations except Mexico, and the creation of a new IR (the child) 1234567A for Mexico recorded in the name of the previous holder Company X.

## Change in Name or Address of the Representative

642. It is possible for the recorded representative to submit a request to record a change in their name or address, including their e-mail address. The easiest way to record such change is to use the [Online management of representative](#) form available on WIPO's website. Alternatively, official [form MM10](#) may also be used for this purpose (see also the [Note for filing MM10](#)). The recording of a change of name or address of a representative is free of charge. The form MM10 is not to be used to request the recording of the appointment of a new representative; the [MM12](#) concerns the recording of a new representative. [\[Rule 25\(1\)\(a\)\(vi\)\]](#) [\[Rule 36\(i\)\]](#)

643. 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

644. If a request to record a change concerning the name or address of the representative does not comply with the applicable requirements, the International Bureau will notify the holder and the applicable Office, if the request was presented through an 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. [\[Rule 26\]](#)

645. Where the request was presented through an Office, the holder will need to clarify whether that Office intends to remedy the irregularity, or whether the holder must do this.

646. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the expiry of the failed time limit (see also the [Note for filing MM20](#)). Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. In the case of continued processing, the date of recording of the change will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#) [\[Rule 27\(1\)\(c\)\]](#)

### Recording, Notification and Publication

647. The International Bureau records the changes as requested, in respect of the representative's details, and notifies accordingly the Offices of the designated members. At the same time, it informs the holder and, where the request was presented by an Office, that Office. Information concerning a change in name or address of the representative is recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements. It is possible to request that the recording of the change in the representative's details be recorded before, or after, the recording of another change, partial cancellation or subsequent designation, or after the renewal of the international registration. In addition, the International Bureau publishes the relevant information in the [Gazette](#). [\[Rule 25\(2\)\(c\)\]](#) [\[Rule 27\(1\)\(a\) and \(b\)\]](#) [\[Rule 32\(1\)\(a\)\(vii\)\]](#)

## Division of an International Registration

648. It is possible to divide an international registration before one or more specific members. Such division may be an option for the holder to overcome a provisional refusal, which only concerns some of the classes or some of the goods and services covered by the international registration, without yet letting go of the goods and services for which the Office has refused protection of the mark. It may be possible to request an Office to divide the international registration provided that member has not made the relevant declaration under [Rule 27bis](#).

649. A number of members have notified the International Bureau that they will not present requests for division to the International Bureau, either because their domestic legislation does not provide for division or their domestic laws are not compatible with Rule 27bis. Please refer to the [Madrid Member Profiles](#) database or the [declarations](#) made by members on WIPO's website. [[Rule 27bis\(6\)](#)] [[Rules 27bis\(1\) and 40\(6\)](#)].

650. The holder may request the Office concerned to divide the international registration (the parent) by setting apart, for example, the refused goods and services to create a new international registration (the divisional registration or the child). Some Offices may require payment of fees, and in such case, these fees are payable directly to the Office concerned, in local currency. Where the Office accepts such request for division, it will notify the International Bureau. Where the International Bureau records the division, this divisional registration will have the same number as the original registration (the parent), together with a capital letter. Where the holder has received provisional refusals from several Offices, and where possible to request division, the holder may end up with several divisional registrations.

651. The Office may then grant protection to the international registration containing the acceptable classes (or goods and services), the parent. The holder may then continue contesting the refusal of the divisional registration before the Office concerned, without delaying the possible protection for the parent registration.

652. It may be preferable for the holder to set apart the refused classes (or goods and services); this is especially relevant where the international registration contains more than one designation. Otherwise, if the accepted classes are set apart and the Office later grants protection to the divisional registration, the holder would have to maintain two international registrations. In case the Office is unable to accept a request for the merger of the divisional registration (child) back with the International registration (parent) covering all the other designations.

653. Before requesting division of the international registration, it is important for the holder to check with the relevant Office of the designated member whether a request for such division is an option, and if so, whether a merger of international registrations resulting from division can be requested later. See more on merger in paragraphs 675 to 697. [[Rule 27bis](#)]

### Presentation of a Request for Division of an International Registration

654. A request for the division of an international registration must be presented to the Office of the designated member in respect of which the international registration is to be divided, using the official [form MM22](#) (see also the [Note for filing MM22](#)). The request cannot be presented directly with the International Bureau. [[Rule 27bis\(1\)\(a\)](#)]

655. The Office concerned may examine the request for division of an international registration to ensure that it meets the requirements of its applicable law, before presenting it to the International Bureau. The Office concerned may also request a fee for processing the divisional request. This fee is separate to the fee to be paid to the International Bureau, and would be payable directly with the Office concerned.

### **Official Form**

656. The following information must be provided in the Official [form MM22](#).

#### **Member Presenting the Request**

657. The name of the designated member in respect of which the international registration is to be divided should be given, specifying also the name of the Office of the member. [[Rule 27bis\(1\)\(b\)\(i\) and \(ii\)](#)]

#### **International Registration Number**

658. The number of the international registration concerned should be indicated. [[Rule 27bis\(1\)\(b\)\(iii\)](#)]

#### **Name of the Holder**

659. The name of the holder must be the same as the name recorded in the International Register. [[Rule 27bis\(1\)\(b\)\(iv\)](#)]

#### **Goods and Services for Which Division is to be Recorded**

660. The goods and services to be set apart in the divisional international registration must be indicated and grouped in the appropriate classes of the [Nice Classification](#). If necessary, a continuation sheet should be used and the appropriate box should be checked. [[Rule 27bis\(1\)\(b\)\(v\)](#)]

661. Where the Office concerned has refused an international registration for only some of the goods or services covered by the international registration, the holder may list either the refused goods and services or the acceptable goods and services. The division will create a separate divisional registration for the listed goods and services and for one designation only. The advantage of setting aside the refused goods and services is that the goods and services the Office may accept, will then be covered in the main registration along with all the other designations.

#### **Signature of the Holder and/or Their Representative**

662. The Office may require or permit the holder or their recorded representative to sign the form. The International Bureau will not question the absence of a signature from this item. [[Rule 27bis\(1\)\(c\)](#)]

#### **Statement of Interim Status (for the Divisional Registration)**

663. The Office presenting a request may also include a statement of interim status of the mark under [Rule 18bis](#) (see paragraphs 436 to 440) or a statement of grant of protection under [Rule 18ter\(1\) or \(2\)](#) (see paragraphs 443 to 447) in respect of the goods and services listed in the request. This should be indicated by checking the appropriate box. However, most Offices will only send such statements after they have received information from the International Bureau of the division of the international registration. [[Rule 27bis\(1\)\(d\)](#)]

### Signature of the Office Presenting the Request

664. The request must be signed by the Office presenting the request to record a division. [\[Rule 27bis\(1\)\(c\)\]](#)

### Fee Calculation Sheet

665. See the general remarks concerning payment of fees to the International Bureau (paragraphs 74 to 90).

666. A request to record a division is subject to the payment of the fee specified in the [Schedule of Fees](#). The payment of 177 Swiss francs may be made by any of the means listed in the payment information in the form. The most convenient method of payment is to instruct the International Bureau to debit the required amount from a current account. Where the fees are paid by other methods than by debit from an account with the International Bureau, the method of payment and the person (holder, representative or Office) making the payment, or giving the instructions for payment, should be indicated in the form. [\[Rule 27bis\(1\)\(b\)\(vi\) and \(2\)\]](#)

### Irregular Request

667. The International Bureau will examine the request to determine whether it meets the requirements prescribed in [Rule 27bis](#). If the request is irregular, the International Bureau will notify the Office that presented the request, as well as the holder. If the irregularity concerns insufficient payment of the fee due to the International Bureau, the holder would have three months to pay the outstanding balance directly to the International Bureau.

668. If the holder has failed to remedy the irregularity concerning insufficient fees mentioned above, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the expiry of the failed time limit (see also the [Note for filing MM20](#)). Together with the request, the holder must remedy the irregularity concerned (i.e., pay the outstanding fees) and pay the fee for continued processing. In the case of continued processing, the date of recording of the division will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#) [\[Rule 27\(1\)\(c\)\]](#)

669. Regarding any other irregularity, the Office will need to remedy the request within three months. If the irregularity is not remedied, the request will be considered abandoned and the International Bureau will refund any fee paid, after the deduction of an amount corresponding to one-half of the fee specified in item 7.7 of the [Schedule of Fees](#). Currently, this amounts to 88.50 Swiss francs. [\[Rule 27bis\(3\)\]](#)

### Recording, Notification and Publication

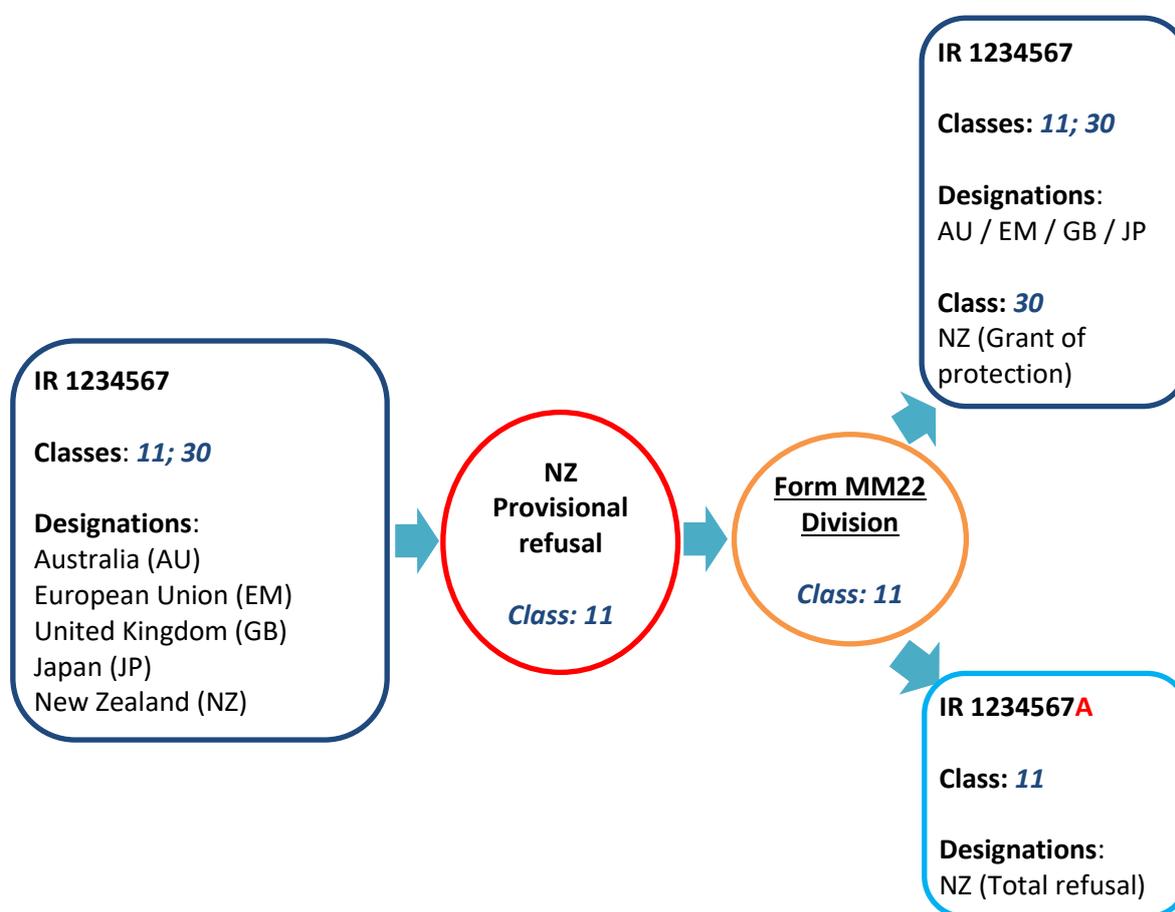
670. Where the request complies with the applicable requirements, the division of the international registration will be recorded with the date on which the International Bureau received the request or, where the request was irregular, the date on which the irregularity was remedied. However, the effective date of the divisional registration will be the same as the original international registration. Therefore, it follows that the renewal date of the divisional international registration will also be the same as the original international registration (the parent), and not the recorded date of the request for division. [\[Rule 27bis\(4\)\(a\)\]](#)

671. Following the recording of division, the International Bureau will create a divisional international registration (the child) for the goods and services specified in the request and with the member concerned as the sole designated member, notify the Office that presented the request and inform the holder. The part which has been divided will be recorded as a separate international registration (the child), which will bear the same number as the parent from which it has been divided, together with a capital letter. The publication in the [Gazette](#) consists of the part of the international registration which has been divided. [[Rule 27bis\(4\)\(b\)](#)] [[A.I. Section 16](#)] [[Rule 32\(1\)\(a\)\(viii bis\)](#)]

672. A request for the division of an international registration in respect of a designated member that is not or is no longer designated for the classes of the [Nice Classification](#) mentioned in the request will not be considered as such. [[Rule 27bis\(5\)](#)]

673. For more information on division of international registrations, see [Information Notice No. 21/2018](#), available on WIPO's website.

### Example of Division



674. The above example illustrates the following:

- *The international registration (IR) is for two classes (11 and 30) and covers designations of Australia (AU), the European Union (EM), United Kingdom (GB) and New Zealand (NZ).*

- *The IP Office of New Zealand (IPONZ) issues a provisional refusal concerning class 11 only.*
- *Not being ready to give up class 11, the holder presents official form MM22, requesting a division of the IR, to IPONZ.*
- *IPONZ accepts this and presents the form to the International Bureau, which records the division and creates a new divisional IR. This new divisional IR (the child) bears the same number as the original registration (the parent), but with the added letter A, and it has only one designation (NZ) and one class (11).*
- *The provisional refusal is duplicated in the divisional registration. Therefore, the holder will need to respond to both, so the Office may issue its final decision for both international registrations.*
- *The holder can now contest the refusal for the mark for class 11 refusal, for the child. In the meantime, IPONZ grants protection to the mark in class 30 for the parent, by issuing a statement of grant of protection following a provisional refusal ([Rule 18ter\(2\)](#)). The parent contains classes 11 and 30 and five designations (but the designation of NZ is now only for class 30); the child contains the designation of NZ for class 11 only.*
- *In the event that the holder ultimately overcomes the outstanding refusal in class 11 for the divisional IR, and IPONZ issues a statement of grant of protection following a provisional refusal ([Rule 18ter\(2\)](#)) the holder may request that this be merged back with the parent, as New Zealand accepts requests for merger. See more on merger in paragraphs 675 to 697.*

*If IPONZ ultimately confirms the refusal for class 11 for the child and the holder is not interested in contesting this decision further, the holder may then let the child lapse (cancel or not renew this). The child being an independent international registration will remain in the International Register until the holder cancels or does not renew it.*

## **Merger of International Registrations**

675. The holder may request the merger of international registrations resulting from:
- the recording of a partial change in ownership [[Rule 27ter\(1\)](#)]; and
  - the recording of division [[Rule 27ter\(2\)](#)]
676. Merging international registrations may be a benefit to the holder, as it would mean that they would have less international registrations to maintain and manage, and would save renewal fees.
677. It is only possible to merge two or more international registrations that were separated from the same international registration due to a partial change in ownership or a division. It is not possible to merge international registrations that originated as separate international applications.

## **Merger of International Registrations Resulting from the Recording of a Partial Change in Ownership**

678. A separate international registration may have been created as a result of a partial change in ownership for some goods and services or some designated members, or it may have been created due to a declaration that a change in ownership has no effect being issued by a designated member.

679. Where two or more international registrations resulting from a partial change in ownership are recorded in the name of the same holder, that holder may request the International Bureau to record the merger of the international registrations. [[Rule 27\(3\)](#)]

### ***Presentation of a Request for the Recording of a Merger Resulting from the Recording of a Partial Change in Ownership***

680. The request for the merger of international registrations resulting from the recording of a partial change in ownership must be presented to the International Bureau on the official [form MM23](#) (see also the [Note for filing MM23](#)) or online form, when available. This form may be presented directly to the International Bureau by the holder or through the Office of the member of the holder. It is free of charge to record such merger. [[Rule 27ter\(1\)](#)]

#### **Official Form**

681. The following information must be provided in the official [form MM23](#).

##### *Name of the Holder*

682. The name of the holder must be the same as the name recorded in the International Register for all the international registrations requested to be merged.

##### *International Registration Numbers*

683. The number of all the international registrations to be merged should be indicated, for example, 123456, 123456A, 123456B.

##### *Signature of the Holder and/or Their Representative*

684. Where the request is presented directly to the International Bureau, it must be signed by the holder or the recorded representative.

##### *Office of the Member of the Holder Presenting the Request*

685. Where the request to record the merger is presented through the Office, the request must be signed by that Office.

## **Merger of International Registrations Resulting from the Recording of Division of an International Registration**

686. The holder may request the merger of international registrations resulting from the recording of division of an international registration before the Office which presented the initial request for division of the international registration, resulting in the divisional registration. A divisional international registration may only be merged with the international registration from which it was divided. [[Rule 27ter\(2\)](#)]

687. It is important for the holder to check with the relevant Office of the designated member whether requests for merger are possible. A number of members have notified the International Bureau that they will not present requests for merger to the International Bureau ([Rule 27ter\(2\)\(b\) or Rules 40\(6\) and 27ter\(2\)\(a\)](#)). Any such notification received by the International Bureau is published in the [Gazette](#) and on WIPO's website ([declarations](#) made by members).

### ***Presentation of a Request for Merger of International Registrations Resulting from the Recording of Division of an International Registration***

688. The request for the merger of international registrations resulting from the recording of division must be presented to the International Bureau on the official [form MM24](#), through the Office that presented the request for division (see also the [Note for filing MM24](#)). Where the holder has several divisional registrations, the holder must present, where possible, separate requests for merger (one form per Office having presented the request for division). [\[Rule 27ter\(2\)\(a\)\]](#)

#### **Official Form**

689. The following information must be provided in the official [form MM24](#).

##### ***Name of the Holder***

690. The international registration of the divisional international registration (the child) and the international registration from which it was divided (the parent) must both be in the name of the same holder.

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

691. The number of the international registration resulting from the recording of division to be merged with the international registration from which it was divided (the parent and the child) should be indicated, for example, 1234567 and 1234567A.

##### ***Signature of the Holder and/or Their Representative***

692. The Office may require or permit the holder or their recorded representative to sign the form. The International Bureau will not question the absence of a signature from this item.

##### ***Office Presenting the Request***

693. The request to record a merger of international registrations resulting from the recording of division must be presented through the Office that requested the recording of the division of the international registrations in the first place. The request must be signed by that Office. While it is free of charge to record such merger in the International Register, the Office presenting the request may charge a fee for presenting such request.

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

694. When a request for merger meets the applicable requirements, the International Bureau will record the merger of the international registrations concerned, notify the Office that presented the request, and inform the holder. The relevant data are published in the [Gazette](#). [\[Rule 27ter\(1\) and \(2\)\(a\)\]](#) [\[Rule 32\(1\)\(a\)\(viii bis\)\]](#)

695. For the merger of international registrations resulting from the recording of division of an international registration, the child (IR 1234567A) will be merged with the parent (IR 1234567), which will result in only one international registration (IR 1234567).

696. For more information on merger of international registrations resulting from division, see [Information Notice No. 21/2018](#), available on WIPO's website.

697. The recording following a request to merge several international registrations, resulting from multiple recordings of partial changes of ownership, can be a little complex as the resulting (merged) international registration number will depend on whether the child (or children) are merged back with the parent, amongst themselves or, where the children that are to be merged amongst themselves cover different goods and services. The following examples explain this: [\[A.I. Section 17\]](#)

- if all or some of the children of the international registration (recorded under the original number plus a letter) are merged back with the parent (still recorded under its original number without a letter), the resulting international registration will bear the number of the parent without a letter. The following example is illustrated below:

*The recording of a partial change in ownership for international registration number (IR) 1234567 resulted in two registrations, IR 1234567 and IR 1234567A. Following the recording of the merger, the IR 1234567A will no longer exist and the resulting merged IR will be 1234567.*

- if all or some of the children of the international registration (each recorded under the original number plus a letter) are merged amongst themselves (and not with the parent) and each child covers the same goods and services, the resulting international registration will bear the number of the international registration together with the capital letter used earlier in respect of the first child. For example:

*The recording of two partial changes in ownership for International registration number (IR) 1234567 designating Australia, China, Germany and Switzerland resulted in three registrations namely, the parent IR 1234567 for Germany and Switzerland, and the newly created IR 1234567A for Australia and 1234567B for China (the children).*

*The new holder requested the merger of IRs 1234567A and 1234567B. Following the recording of the merger, IR 1234567B will no longer exist and the resulting merged IR will be 1234567A, which now covers Australia and China.*

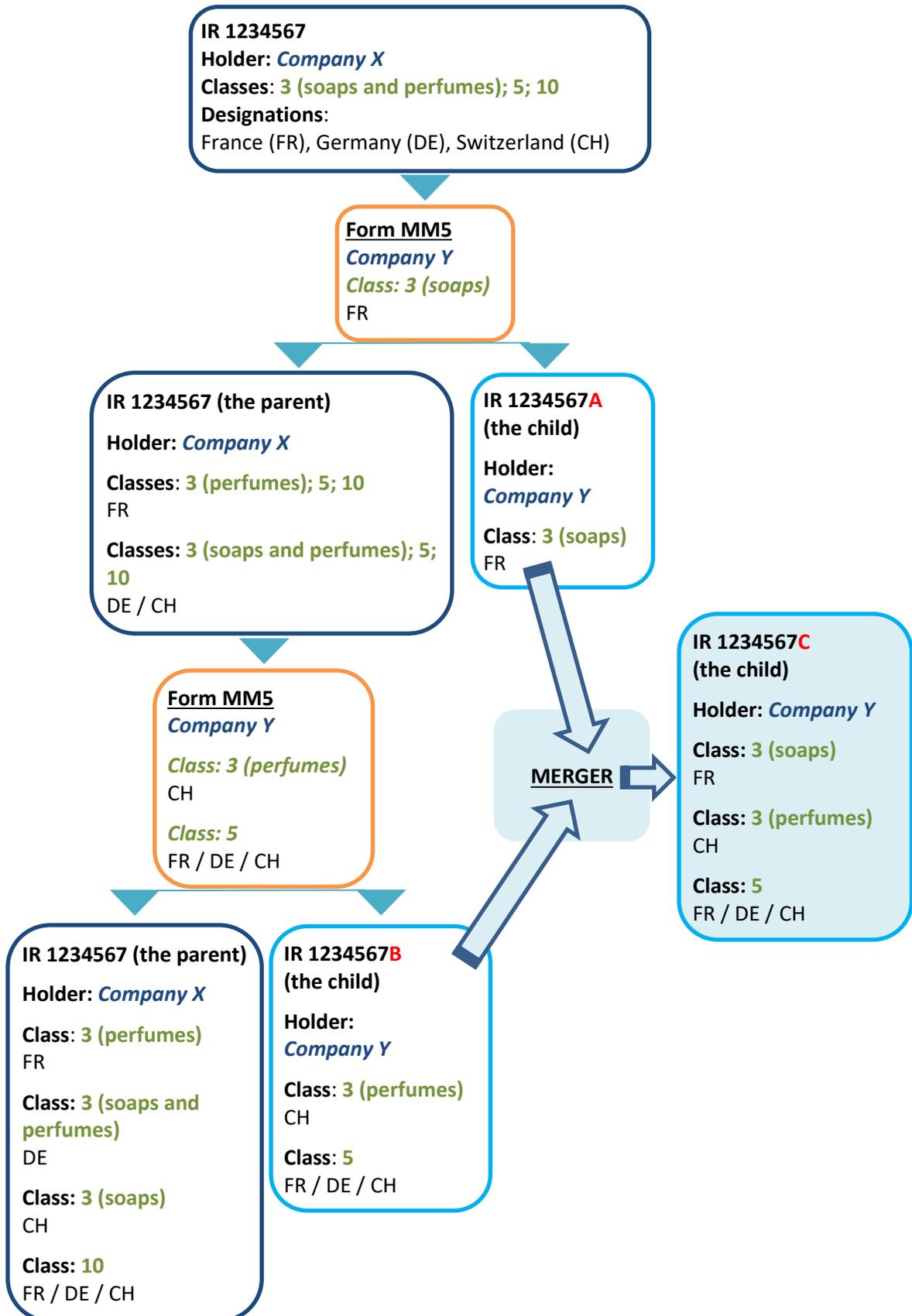
- if all or some of the children (each recorded under the original number plus a letter) are merged amongst themselves, but the children do not cover the same goods and/or services, the resulting international registration will bear the number of the original international registration together with the next capital letter in the alphabetical order, not previously used in conjunction with the number of the international registration concerned. For example:

*The holder of international registration (IR) 1234567 designating France, Germany and Switzerland for classes 3 for “soaps and perfumes”, 5 and 10, records a partial change in ownership for the mark in class 3 for “soaps” in France. This results in two IRs, namely,*

*IR 1234567 (the parent) designating France (class 3 for “perfumes” and goods in classes 5 and 10), Germany and Switzerland (class 3 for “soaps and perfumes” and goods in classes 5 and 10) in the name of the existing holder (the parent); and IR 1234567A designating France in class 3 for “soaps” in the name of the new holder.*

*The same holder (of IR 1234567) records another partial change in ownership to the same new holder for the mark for goods in class 5 in respect of France, Germany and Switzerland, and for class 3 “perfumes” for Switzerland. This results in a total of three IRs, namely, IR 1234567 (the parent) designating France (class 3 for “perfumes” and goods in class 10), Germany (class 3 for “soaps and perfume” and goods in class 10) and Switzerland (class 3 for “soaps” and goods in class 10); IR 1234567A designating France (class 3 for “soaps”); and IR 1234567B designating France (goods in class 5), Germany (goods in class 5) and Switzerland (class 3 for “perfumes” and goods in class 5).*

*The holder of international registrations (IRs) 1234567A and 1234567B requests a merger (i.e., of the children covering different goods). Following the recording of the merger, IRs 1234567A and 1234567B will no longer exist and the resulting merged registration will be IR 123456C designating France (class 3 for soaps and goods in class 5), Germany (goods in class 5) and Switzerland (for class 3 “perfumes” and goods in class 5).*



## MISCELLANEOUS RECORDINGS

### Restriction of the Holder's Right of Disposal

698. The holder, or the Office of the member 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 members; in the latter case, this should be specified in the information given to the International Bureau. Similarly, the Office of a designated member 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 member. 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. [\[Rule 20\(1\)\]](#)

699. An example of a reason for such a restriction would be that the extension of the international registration in that member 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 703 to 726).

700. 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. The restriction, where recorded, will stay on the International Register until it is requested removed. [\[Rule 20\(2\)\]](#)

701. 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 member of the holder and the Offices of the designated member concerned. The information is also published in the [Gazette](#). [\[Rule 20\(3\)\]](#) [\[Rule 32\(1\)\(a\)\(xi\)\]](#)

702. Any recording of such restriction is for information purposes only, and will not prevent the International Bureau from recording changes to the international registration, where this is later requested. Any action on the side of the holder, which would go against the contents of the restriction, could be seen as a breach of that, and any consequential fall-out would be a matter to be settled between the parties concerned, the holder and the party that requested the recording of the restriction.

### Recording of Licenses in International Registrations

703. Some members provide for the recording, at the national or regional level, of licenses in respect of international registrations, such recording then having the same legal effect as the recording of a license in respect of a national or regional mark. 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 member in respect of which a license has been granted. [Rule 20bis](#) does not cover the recording of a sub-license.

704. Where a license is to be recorded with effect for an international registration, depending on the member where the license is to have effect, the request may need to be presented directly to the International Bureau, or to the IP Office of that member where a declaration under [Rule 20bis\(6\)\(b\)](#) has been made.

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

705. The Office of a member, whose law does not provide at all for the recording of trademark licenses, may notify the Director General of WIPO that the recording of licenses in the International Register has no effect in that member. [\[Rule 20bis\(6\)\(a\)\]](#)

706. The Office of a member, 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 member. Such declaration must be notified to the Director General of WIPO before the date of entry of the Protocol in that member concerned. [\[Rule 20bis\(6\)\(b\)\]](#)

707. For the recording of a license in an international registration with effect for a member having made such declaration under [Rule 20bis\(6\)\(b\)](#), the request for recording must be presented directly to the IP Office concerned, in accordance with the domestic requirements.

708. Any notification made as described in the above paragraphs is published in the [Gazette](#) and on WIPO's website ([declarations](#) made by members).

### **Presentation of a Request for the Recording of a License**

709. A request to record a license may be presented to the International Bureau either directly by the holder or through an Office (the Office of the member of the holder or a member 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. [\[Rule 20bis\(1\)\]](#)

710. A licensee who wishes to have the license recorded in the International Register may ask the Office of the member of the holder, or the Office of a member with respect to which the license is granted, to present the request. That Office may take whatever measures it considers appropriate to verify that the person concerned is entitled to be recorded as a licensee. The International Bureau cannot, however, accept such a request directly from the licensee (who is a person unknown to the International Bureau), where the form is not signed by either the holder or an Office.

711. The request must be presented on the official [form MM13](#) (see also the [Note for filing MM13](#)).

### **Official Form**

712. The following information must be provided in the official [form MM13](#): [\[Rule 20bis\(1\)\(b\)\]](#)

- 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 (see paragraphs 225 and 231);
- the designated members with respect to which the license is granted; and
- 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 [Nice Classification](#).

713. 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>8</sup>, and in Rule 10 of the [Regulations under the Singapore Treaty on the Law of Trademarks](#)<sup>9</sup>. Indications or elements that do not appear pertinent in the framework of the recording of licenses at the international level have not been included.

714. Some designated members may request additional information, so the request may also indicate: [\[Rule 20bis\(1\)\(c\)\]](#)

- 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 member;
- 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>10</sup>; and
- where applicable, the duration of the license.

715. The recording of a license is subject to the payment of the fee specified in item 7.5 of the [Schedule of Fees](#), of 177 Swiss francs for each international registration concerned. If the holder wishes to record a license for more than one licensee, or for more than one international registration, a separate form for each licensee or for each international registration will need to be completed.

### Irregular Request

716. 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\(2\)\(a\)\]](#)

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<sup>8</sup> WIPO publication No. 835.

<sup>9</sup> WIPO publication No. 259.

<sup>10</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).

717. 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. Currently, this amounts to 88.50 Swiss francs. [\[Rule 20bis\(2\)\(b\)\]](#)

718. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the failed time limit has ended (see also the [Note for filing MM20](#)). Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. In the case of continued processing, the date of recording of the license will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#) [\[Rule 20bis\(3\)\]](#)

### **Recording and Notification**

719. 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 members 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. [\[Rule 20bis\(3\)\]](#)

### **Declaration that the Recording of a Given License Has No Effect**

720. The Office of a designated member, which is notified by the International Bureau of the recording of a license in respect of that member, may declare that the recording of that license has no effect in the said member. Such a declaration may be made on a case-by-case basis, where the law of the member concerned recognizes the effects of licenses recorded in the International Register, but there are objections with respect to a particular given license, for example, on the ground that the public could be misled. [\[Rule 20bis\(5\)\]](#)

721. 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.

722. 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, publish the information in the [Gazette](#) 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.

### **Amendment or Cancellation of the Recording of a License**

723. After the recording of a license, the holder may wish to amend some details concerning the license, for example, its duration. The request must be made on the official [form MM14](#) (see also the [Note for filing MM14](#)). The recording of an amendment to a recorded license is subject to the payment of the fee specified in item 7.5 of the [Schedule of Fees](#), of 177 Swiss francs for each international registration concerned. [[Rule 20bis\(4\)](#)]

724. 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](#), followed by the payment of the respective fee (see also the [Note for filing MM13](#)).

725. A request for cancellation of the recording of a license must be made on the official [form MM15](#) (see also the [Note for filing 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.

726. Where several licenses are recorded in respect of a given international registration, any request to amend or cancel the recording of a license should specify clearly and unambiguously to which license the request relates.

## **RENEWAL OF INTERNATIONAL REGISTRATION**

727. An international registration, recorded by the International Bureau in the International Register, is valid for a period of 10 years from the date of the international registration. An international registration can be renewed every 10 years directly with the International Bureau, upon payment of the required renewal fees. There is no limit to the number of times that an international registration can be renewed.

728. Renewal takes place before the International Bureau with effect for the members covered by the international registration.

729. The renewal fees can be paid at the earliest, three months before the date of expiry of the international registration (the due date), and the latest during the six months following the date of expiry. The six months following the date of expiry is called the grace period and payment during this period requires the payment of an additional fee of 50% of the basic fee (surcharge) set out in item 6.1 of the [Schedule of Fees](#). Currently, this surcharge fee amounts to 326.50 Swiss francs. Other surcharges may apply with respect to certain designated members. Please see further information concerning [individual fees](#) available on WIPO's website.

730. Holders are responsible for renewing their international registrations by paying the renewal fees to the International Bureau. The international registration cannot be renewed until the required fees are paid in full. When the fees are paid, the renewal is recorded on the exact date on which the renewal of the international registration is due. [\[Article 6\(1\)\]](#) [\[Article 7\(1\)\]](#)

## Important Considerations: Managing the Renewal

### Unofficial Notice of Renewal

731. Six months before expiry of each 10-year term of protection, the International Bureau sends an unofficial notice, to remind the holder of the international registration and the holder's representative (if any) of the exact date of expiry (due date). If 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. [\[Article 7\(3\)\]](#) [\[Rule 29\]](#)

732. This notice will alert the holder of the upcoming renewal and remind the holder to request the recording of any necessary changes in the international registration before the renewal.

### No Changes to the International Registration

733. It is not possible to include changes to the international registration at the time of renewal. The international registration will be renewed 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. One exception is that the holder may renew for only some of the members covered by the international registration; this is not considered to be a change.

734. Any changes to the international registration that the holder wishes to record in the International Register and be reflected in the renewal certificate must be communicated separately to the International Bureau according to the applicable procedures. The changes will be included in the information recorded at renewal only if they are recorded in the International Register before or by the due date at the latest. Therefore, it is important to make the relevant changes in good time before the renewal due date, to make sure those changes would be recorded in the International Register and reflected at renewal time. If possible, the holder should hold off renewing the international registration until the necessary changes have been recorded. However, if this is not possible due to an imminent renewal due date, the holder should bear in mind that the changes will not be reflected in the renewal certificate, and the final cost of the renewal may be higher than what would have been the case if the changes had been recorded before the due date. The Madrid [Fee Calculator](#) or [Online renewal service](#) are available on WIPO's website. [\[Article 7\(2\)\]](#)

### **Non-Renewal of a Particular Designated Member**

735. The fact that the international registration may be renewed for only some of the members covered is not regarded as a change to the international registration. Therefore, the holder may decide not to renew the international registration for one or more of the designated members. If the holder later decides to include a member that was not included in the renewal but covered by the international registration, they may do so, provided it is within the six months grace period after the renewal period. Beyond the grace period, if the holder would still like protection in the member not covered by the renewal, the holder would need to subsequently designate that member. See paragraph 777 on complementary renewal. [[Article 7\(2\)](#)] [[Rule 30\(2\)\(a\) and \(e\)](#)]

### **Renewal and Subsequent Designation**

736. It is possible to expand the geographical scope of protection of an international registration by subsequently designating additional territories (members). It is important to note that a subsequent designation is simply an expansion of an existing international registration – it does not have an independent lifetime of 10 years, but expires on the same date as the international registration. Therefore, where an international registration is nearing its expiry, the holder may wish to wait until after the renewal is recorded before subsequently designating additional members. A subsequent designation that has not yet been recorded in the International Register by the due date of the international registration, will not be taken into account during the renewal process.

737. For further information concerning subsequent designations refer to paragraphs 459 to 523.

### **Other Changes that Affect the Scope of the International Registration**

738. In general, Offices of members should promptly notify the International Bureau of matters that may affect the scope of protection of a given international registration. The following matters are particularly important with regard to renewals:

- ceasing of effect of the basic mark;
- statements of grant of protection under [Rule 18ter\(1\) and \(2\)](#);
- confirmation of a total provisional refusal;
- further decision;
- invalidations of some or all of the goods and services in a designated member;
- any other decisions by the Office of a designated member that affect the scope of the international registration (usually resulting from a subsequent designation or invalidation). [[Article 6\(4\)](#)] [[Rule 18ter\(1\) to \(4\)](#)] [[Rule 19](#)] [[Rule 22](#)]

739. If the above changes have not been recorded by the International Bureau at the time of the renewal, the final cost of the renewal may be affected. For example, the recording of a statement of grant of protection following a provisional refusal under Rule 18*ter*(2), granting protection to two out of the four classes, will impact the total amount of fees to be paid (two classes instead of a possible four). Therefore, if the holder has been notified of any of the above decisions directly by the Office and is aware that such notification has not yet been recorded by the International Bureau, it is important for the holder to follow up directly with the Office concerned to ensure that it has notified the International Bureau.

## Status of Protection at the Time of Renewal

740. An international registration will be renewed in respect of a designated member for all the goods and services not affected by limitation, partial invalidation or partial cancellation. It is not possible to renew the international registration for goods and services that have been cancelled or for designated members for which total invalidation or renunciation has been recorded. It is not possible to renew an “empty shell”. Therefore, a request for renewal must indicate at least one designated member in the international registration.

### Total Grant of Protection

741. The international registration may be renewed for designated members that have granted protection to all the goods and services concerned (i.e., those that have issued total grant of protection). A total grant of protection is a final decision, which is recorded in the International Register, where the Office granted protection without issuing any provisional refusal or following a provisional refusal or in a further decision. [[Rule 18\*ter\*\(1\), \(2\)\(i\) and \(4\)](#)].

### Partial Grant of Protection

742. The international registration may be renewed for designated members that have granted protection to only some of the goods and services (partial grant of protection). A partial grant of protection is a final decision, which is recorded in the International Register, where the Office concerned has granted partial protection following a provisional refusal or in a further decision. [[Rule 18\*ter\*\(2\)\(ii\) and \(4\)](#)].

743. For members that have [declared](#) for an [individual fee](#) per class, the calculation of the renewal fee will take into account only the number of classes for which protection has been granted in a statement recorded under Rule 18*ter* (final or further decision). [[Rule 18\*ter\*\(1\), \(2\) and \(4\)](#)].

744. The holder of an international registration appealing a decision made under [Rule 18\*ter\*](#) by an Office of a designated member granting partial protection, would now be required to pay individual fees only for the classes for which protection has been granted, and not for all the classes covered by the designation.

745. In view of the above, holders do not need to pay individual fees for goods and services that are not protected upon renewal. However, where an Office later notifies the International Bureau, in a further statement under Rule 18*ter*(4), of a change in the scope of protection, the next renewal fee will take into account the number of classes for which the international registration is protected. Such change in the scope of protection will have no impact on the renewal fees that have already been paid, i.e., there is no retroactive effect on the renewal fees. [[Rule 18\*ter\*\(4\)](#)] [[Rule 34\(6\)\(a\)](#)].

746. The following example helps to further explain renewal where a designated member has granted partial protection to the international registration.

- *An international registration (IR) covering goods in classes 3, 5 and 10 is due for renewal on March 1, 2022.*
- *At the time of the renewal, the IR has been granted partial protection for the goods in classes 5 and 10 by the United Kingdom Intellectual Property Office (UKIPO), in accordance with [Rule 18ter\(2\)\(ii\)](#).*
- *The holder appealed the final decision granting only partial protection in the United Kingdom (UK), but the appeal was still pending at the time of renewal.*
- *The UK declared an individual fee per class. Therefore, the renewal fee for the UK designation on March 1, 2022 will take into account only the number of classes for which protection has been granted, i.e., classes 5 and 10.*
- *In June 2025, the holder's appeal is successful and the UKIPO notifies the International Bureau, in a further statement under [Rule 18ter\(4\)](#), that protection has also been granted to class 3. In the upcoming renewal, on March 1, 2032, the holder will need to pay fees for the designation of the UK for classes 3, 5 and 10 (subject to a notification of a further decision).*

### Total Refusal of Protection

747. It is possible to renew the international registration for designated members that have refused protection for all the goods and services concerned in a final decision under [Rule 18ter\(3\)](#) or a further decision under [Rule 18ter\(4\)](#). However, in this case, the international registration must be renewed in respect of that designated member for all the goods and services concerned. The designated members concerned must be indicated in the [Online renewal](#), or in the relevant part of the [form MM11](#), and the corresponding fees for all the goods and services for which that member remains designated (i.e., those goods and services not affected by a limitation, a partial invalidation or a partial cancellation) must be paid (see also the [Note for filing MM11](#)). [[Rule 30\(2\)\(b\)](#)]

748. Following the above, the renewal fees for the designated members that have declared for an individual fee per class and have refused protection for all the goods and services, must be calculated taking into account the number of classes corresponding to all the goods and services not affected by limitation, partial invalidation or partial cancellation.

749. The renewal in those cases does not mean that the international registration is protected in such a designated member concerned. It means that the International Bureau will record the renewal and give holders the option to preserve their rights. Holders may have legitimate reasons to do so, for example, where they are contesting the refusal by appealing a final or further decision.

750. The following example helps to further explain renewal where a designated member has totally refused protection of the international registration.

- *An international registration (IR) covering goods in classes 3, 5 and 10 is due for renewal on March 1, 2022.*
- *At the time of the renewal, the IR has been refused protection for all the goods by the Canadian Intellectual Property Office (CIPO), in accordance with [Rule 18ter\(3\)](#).*

- *The holder appealed the final decision of total refusal in Canada, but at the time of the renewal of the IR, the appeal was still pending.*
- *Canada has declared for an individual fee per class. Therefore, the renewal fees for the designation of Canada on March 1, 2022 will take into account all three classes covered by the designation of Canada, even if protection has been totally refused.*
- *The holder includes Canada in the renewal of the IR, which enables the holder to preserve their rights in Canada.*
- *In June 2025, the holder's appeal is partially successful and CIPO notifies the International Bureau, in a further statement under [Rule 18ter\(4\)](#), that partial protection has been granted to the goods in classes 3 and 10. In the upcoming renewal, on March 1, 2032, the holder will need to pay for the designation of Canada in respect of classes 3 and 10 (subject to a notification of a further decision).*
- *In the event that the holder did not renew the IR in respect of Canada, it would no longer cover Canada. In this case, the holder would need to re-designate Canada in a subsequent designation if they want to seek protection there, with the result that possible protection in Canada would then be from the later date of the subsequent designation.*

### **Provisional Refusal of Protection**

751. It is possible to renew an international registration for designated members that have provisionally refused protection under [Rule 17](#), which have not yet been confirmed under [Rule 18ter](#). A provisional refusal may concern all the goods and services (total provisional refusal) or only some of the goods and services (partial provisional refusal). Where the holder wishes to renew the international registration for that member, it will be necessary to pay the renewal fees for all the goods and services covered by the designation; with the exception of those goods and services that are affected by a limitation, partial invalidation or partial cancellation. This, however, concerns only the renewal fees for members that have declared for individual fees (see paragraph 743 to 746).

752. Changes to the goods and services for which protection has been granted in a designated member will not have retroactive effect on renewal fees that have already been paid in accordance with [Rule 34\(6\)\(a\)](#).

### **Invalidations, Renunciations, Cancellations and Limitations**

753. 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 may not be renewed with respect to a member for which a total invalidation has been recorded or with respect to a member for which a renunciation of protection has been recorded.

754. Furthermore, in the case of a partial invalidation, a limitation of the list of goods and services with respect to a particular member, or a partial cancellation with respect to all designated members, the international registration cannot be renewed for those goods and services to which the invalidation, limitation or cancellation relate. [\[Rule 19\(1\)\]](#) [\[Rule 30\(2\)\(c\)\]](#)

## Renewal Process – Presenting the Request for Renewal

755. The simplest way to renew an international registration is to use the [Online renewal](#) service when paying the renewal fees with a credit card or debiting them from a WIPO current account. This service provides the up to date information on the designated members included in the international registration and the scope of protection as recorded in the International Register. Online renewal is available on WIPO's website.

756. Alternatively, holders may use the optional [form MM11](#), which is available on WIPO's website (see also the [Note for filing MM11](#)). The following information must be provided:

- 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;
- all the members for which the renewal is requested, including, if the holder so wishes, the members in respect of which a partial or total refusal is recorded in the International Register (at least one designated member must be indicated in the request for renewal);
- the signature of the holder or their recorded 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 (Fee Calculation Sheet).

### Fees for Renewal

757. The fees due for the renewal of an international registration consist of: [\[Rule 30\(1\)\]](#) [\[Article 7\(1\)\]](#) [\[Article 9sexies\]](#)

- the basic fee of 653 Swiss francs;
- an individual fee for each designated member that has made the relevant declaration (see paragraphs 323 and 324).
- a complementary fee of 100 Swiss francs for each designated member for which no individual fee is payable;
- a supplementary fee of 100 Swiss francs for each class of goods and services in excess of three; where, however, all the designated members are ones in respect of which an individual fee is payable, no supplementary fees are payable.

758. If the member of the Office of origin (or the member of the holder) is party to both the Agreement and the Protocol, and the international registration contains the designation of a member that is also bound by both treaties, then, notwithstanding the fact that the latter may have opted for individual fees, the standard fees only will be payable to that member.

759. The [Fee Calculator](#) available on WIPO's website may be used to calculate the fees payable for the renewal of an international the registration.

760. The fees should be paid to the International Bureau by, at the latest, the date of expiry. The earliest the holder may pay the renewal fees is three months before the due 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. Currently, this surcharge fee amounts to 326.50 Swiss francs. [[Article 7\(4\)](#)]

761. 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, the following applies:

- 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 renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable. [[Rule 34\(7\)\(d\)](#)]

762. The fees may be paid directly to the International Bureau by the holder. Where the Office of the member 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. Payment of renewal fees may be made by bank transfer, postal account within Europe, credit card or through a WIPO current account. When using the [Online renewal](#), the fees may be paid by credit card (see paragraphs 74, 75 and 78 to 82).

763. 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. [[Article 8\(1\)](#)]

764. It is recommended that WIPO's [Online renewal](#) service is used when paying the renewal fees with a credit card or debiting them from a WIPO current account.

### **Insufficient Fees Paid**

765. 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, the representative or an Office, the International Bureau will also inform that other party. [[Rule 30\(3\)\(a\)](#)]

766. 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 the representative accordingly. [[Rule 30\(3\)\(b\)](#)]

767. There is an exception, however, to the rule just explained. Where the notification of insufficient fees paid referred to in paragraph 766 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. [[Rule 30\(3\)\(c\)](#)]

768. Where the amount paid is insufficient, the holder may, instead of paying the missing amount, ask for one or more of the designated members to be omitted, thereby reducing the amount due. This request must be made within the time within which the missing payment would have had to be made.

## Recording of the Renewal, Notification, Certificate and Publication

769. The International Bureau records the renewal of the international registration 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\(1\)\]](#)

770. 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\(2\)\]](#)

771. Where the international registration has been renewed, the International Bureau notifies the Offices of the designated members concerned and sends a certificate to the holder. [\[Rule 31\(3\)\]](#)

772. Where an international registration is not renewed in respect of a given designated member, the International Bureau notifies accordingly the holder, the representative, if any, and the Office concerned. [\[Rule 31\(4\)\(b\)\]](#)

773. Where an international registration has been renewed, the relevant information concerning the renewal is 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 32\(1\)\(a\)\(iv\)\]](#)

774. An Office, which is notified of the renewal (or non-renewal) of an international registration, does not need to take any action, beyond amending any records which it keeps for its own use.

775. In general, the recording and publication will be in English, French and Spanish. However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of the first subsequent designation: [\[Rule 6\(3\)\]](#) [\[Rule 40\(4\)\]](#)

- 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.

776. 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.

## Complementary Renewal

777. Where an international registration has been renewed in respect of only some of the designated members and the holder decides, after the due date, to renew said registration in respect of a designated member 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 paragraphs 729, 735, 760, and 769) has not yet expired. The fees payable are the basic fee, a complementary or individual fee in respect of the member concerned, and the surcharge fee.

## Non-Renewal

778. 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.

779. Where the international registration has not been renewed, that fact is notified to the holder, the representative, if any, and the Offices of the designated members, 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 paragraphs 765 to 767), that fact is also published in the Gazette. [[Rule 31\(4\)\(a\)](#)] [[Rule 32\(1\)\(a\)\(xii\)](#)]

780. 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 International Register.

## CORRECTIONS OF ERRORS IN THE INTERNATIONAL REGISTRATION

781. The holder or Office of a member may request the correction of an error made by the International Bureau or by an Office concerning an international registration. 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, the recorded representative, or of an Office. [[Rule 28\(1\)](#)]

### Errors Made by the Holder or the Holder’s Representative

782. The International Bureau will not correct errors made by the holder or the holder’s representative, such as mistakes when indicating the designated members or mistakes in the list of goods and services. For example, if an applicant or their representative, indicated AT (Austria) instead of AU (Australia) in the international application in the list of designations by mistake, the designation of AU could only be included in the international registration by way of a subsequent designation. Where the representative has made an error in the holder’s name, it would be necessary to request a recording of a change in the holder’s details.

## Errors Made by the International Bureau or an Office

783. If the International Bureau has made an error, the holder, the recorded representative or an Office may make a request for a correction of that error at any time.

784. If an Office has made an error, the holder or the Office may request a correction of that error, providing the request is received within nine months from the date the error was published in the International Register. If the holder or the recorded representative requests a correction of an error made by the Office, the error must be confirmed by the Office concerned.

785. Before proceeding with the correction of an error, the International Bureau must be satisfied that the International Register is in fact incorrect. Its practice is as follows:

- (i) 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;
- (ii) where there is an error made by an Office, such as an error in the list of designated members or the list of goods and services filed with the International Bureau, and the correction of which would affect the rights deriving from the international registration, such error 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. Where the holder or the recorded representative presents the request for correction in this case, the Office will need to verify the error. Given the nine-month time limit, if the holder or the recorded representative believes that an Office has made an error, they should raise the error directly with the Office concerned and the International Bureau as soon as possible. [[Rule 28\(4\)](#)]

786. The International Bureau may generally amend minor typographical or spelling errors made by an Office, such as, a date or number of the basic mark, provided that such amendments do not impact the rights deriving from the international registration. These types of amendments will be carefully reviewed on a case by case basis, and may be considered to fall outside the scope of [Rule 28](#).

## Official Form for Requesting a Correction

787. The request for the correction of a recording may be presented to the International Bureau on the [MM21 form](#) (see also the [Note for filing MM21](#)). [[Rule 28](#)]

### International Registration Number

788. The number of the international registration should be indicated.

### Reference Number

789. If the holder or their representative requests the correction, the WIPO reference number should be indicated. If the Office requests the correction, the WIPO notification number should be indicated.

## Description of the Requested Correction

790. The details of the error to be corrected should be described.

## Presentation and Signature

791. The form must indicate who is presenting the form (the holder, the representative of the holder or the Office), and include their signature and e-mail address.

## Recording, Publication and Notification of Correction

792. The International Bureau will carefully examine a request for correction. 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 members in which the correction has effect. In addition, where the Office that has requested the correction is not the Office of a designated member in which the correction has effect, the International Bureau will also inform that Office. The correction is published in the [Gazette](#). [\[Rule 28\(2\)\]](#) [\[Rule 32\(1\)\(a\)\(ix\)\]](#)

## Refusal Following a Correction

793. Any Office that is notified of a correction may reopen its examination of the international registration and 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. [Articles 5](#) and [9sexies](#) of the Protocol and [Rules 16 to 18ter](#) apply *mutatis mutandis* to the notification of refusal concerning a correction, and, in particular, to the time limits (one year or 18 months) for notifying such a refusal in respect of the corrected part. Such time limits are to be counted from the date of sending the notification of the correction to the Office concerned. This effectively means that a correction “restarts” the time limit for the Office to examine the international registration as far as the correction is concerned and to issue a provisional refusal, where it finds it necessary. [\[Rule 28\(3\)\]](#)

## NO OTHER CHANGES IN THE INTERNATIONAL REGISTER

794. No other changes affecting the international registration may be recorded in the International Register. In particular, there is no provision in the legal framework of the Madrid System allowing for an amendment (or alteration) of a mark that is recorded in the International Register. If the holder wishes to protect the mark in a form that differs, even slightly, from the mark as recorded in the International Register, they must file a new international application. This is true even if the mark has been allowed to be changed in the basic mark, where such change is possible according to the law of the member of the Office of origin. This does not necessarily mean that, where the holder is now using the mark in a form slightly different from that recorded in the International Register, it is strictly necessary to file a new international application. The holder may wish to rely on Article 5C(2) of the [Paris Convention](#), according to which use of the mark in a form that 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 members.

795. It is not possible to extend the list of goods and services of the international registration. If the holder wishes to protect the mark for additional goods and services not covered by the main list of the international registration, the holder must file a new international application. This is true even if those goods and services were included in the basic mark; that is, they could have been included when filing the international application, but were not.

## THE DEPENDENCY PERIOD

### Ceasing of Effect During the Dependency Period

796. The international registration is dependent on the basic mark (i.e., the national or regional registration or application on which the international registration is based) for five years from the date of the international registration. The protection resulting from the international registration may no longer be invoked if, or to the extent that, the basic mark is canceled, renounced, revoked, invalidated or has lapsed, or where the basic mark is an application for registration, 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.

797. This dependence is absolute and effective regardless of the reasons why the basic mark is rejected, withdrawn or ceases to enjoy, in whole or in part, legal protection. The process by which an international registration may be defeated for all members 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”. However, often the basic mark ceases to have effect due to the inaction of the holder, for example, by not responding to a refusal of a basic mark that is subject of an application or not renewing a registered basic mark.

798. There is an increased risk of the holder, who chooses to base an international registration on an application with the Office of origin, of losing their protection as a result of the basic application ceasing to have effect. This loss does not need to 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.

799. To soften the consequences of the five-year dependency feature of the Madrid System, the Protocol provides for an opportunity for the holder of an international registration, which is canceled as a result of the ceasing of effect of the basic mark, to continue securing protection in the designated members by transforming the international registration to national or regional applications. See more on transformation in paragraphs 817 to 822.

800. Although an international application must be filed by the holder of the basic mark on which it is based, the validity of an international registration is not affected if the basic mark later is subject to a change in ownership. The new owner of the basic mark does not need to qualify to be the holder of an international registration (unless the international registration is also being transferred to them). However, since 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, due to a change in ownership of the basic mark, they are no longer in a position to control its validity (see paragraphs 796 to 798 and 814 to 816).

801. At the end of the five-year dependency period, the international registration becomes independent of the basic mark (subject to paragraphs 796 to 798). It should be noted that there is no separate dependency for subsequent designations; the only dependency period is the one that runs from the date of the international registration. [[Article 6\(2\)](#)]

### **Ceasing of Effect of the Basic Application or Registration**

802. 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 mark no longer enjoys legal protection because it: [[Article 6\(3\)](#)]

- has been withdrawn;
- has lapsed;
- has been renounced; or
- has been the subject of a final decision of rejection, revocation, cancellation or invalidation.

803. Where the ceasing of effect of the basic mark 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.

804. This provision applies also when legal protection (resulting from international registration) has later ceased as the result of an action that begun before the expiry of the period of five years. 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.

805. Furthermore, the same rules apply 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 paragraph 804, such proceeding having begun before the expiry of the five-year period. This provision prevents the holder of an international registration from avoiding the effects of central attack, when their basic mark 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. By way of example:

- *On January 2, 2000, an international registration was recorded based on a national registration covering “sunglasses” in class 9 and “clothing” in class 25.*

- On November 4, 2004, a third party filed a non-use cancellation action against the basic mark, for goods in class 25.
- On April 2, 2006, the Court issued a decision, which resulted in the partial cancellation of the national registration for goods in class 25.
- On April 15, 2006, the Office of origin notified the International Bureau that the basic mark had partially ceased to have effect, for specific goods in class 25, and that the list of goods in class 25 had been limited to “t-shirts”.
- Given that the action that resulted in the ceasing of effect of the basic mark was commenced before January 2, 2005, the international registration was cancelled to the same effect, and protection in all the designated members was limited to class 9 “sunglasses” and class 25 “t-shirts”.

## Procedure for Notification of Ceasing of Effect

806. Where the basic mark has ceased to have effect within the five-year period of dependency, the Office of origin must notify the International Bureau. Where the ceasing of effect concerns 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.

807. The notification should not be sent until it is clear that there is no possibility of the ceasing of effect being reversed. 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.

808. Where, however, the Office of origin is aware of a pending action that may result in the ceasing of effect of the basic mark at the end of the period of five years from the date of the international registration, it should notify 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. Once the decision has become final, the Office must notify the International Bureau of the outcome. 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.

809. 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 mark has ceased to have effect). [[Article 6\(4\)](#)]

810. An Office can only notify the International Bureau if it is aware of the action in question, for example, 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. In that case, it is likely that the party who brought the action will bring it to the attention of the Office, particularly where the decision is one that adversely affects the basic mark and requires cancellation of the international registration.

811. For further information concerning the procedure followed by Offices in relation to a notification of ceasing of effect, see paragraphs 1022 to 1033.

## Recording in the International Register of the Ceasing of Effect

812. 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 members. 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 members. The International Bureau must also cancel international registrations resulting from partial change in ownership or from division recorded under the cancelled international registration, as well as those resulting from their merger. [\[Rule 22\(2\)\]](#) [\[Rule 22\(2\)\(b\)\]](#)

813. 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 that begun before the end of the five-year dependency period is still pending at the end of that period will be published in the [Gazette](#). [\[Rule 32\(1\)\(a\)\(viii\) and \(xi\)\]](#)

## Change in Ownership of the International Registration During the Dependency Period

814. A change in ownership of the international registration or the basic mark (or both) during the five-year dependency period has no influence on the effects of that dependence. The international registration remains dependent on the protection of the basic mark in the member of the Office of origin. Thus, for example, where the basic mark is not renewed, or if the basic application is withdrawn or is refused by the Office of origin, this will result in the cancellation of the international registration, even if the basic mark is recorded in a name that is different to the name of the holder of the international registration. [\[Article 6\(3\)\]](#)

815. In view of the above, it is noted that the holder may transfer the basic mark at any time, including during the dependency period, without transferring the international registration. However, the holder of an international registration needs to be aware of the risks involved with doing so during the dependency period. This is because the international registration will remain dependent on the basic mark regardless of its ownership. By transferring the basic mark to a different person or entity, the holder would no longer be in control of its status and its possible ceasing of effect. Consequently, the holder would be subject to the risk of a cancellation of their international registration due to the action taken (or not taken) by the new owner.

816. Similarly, a potential transferee of an international registration should proceed with the transfer with caution where the basic mark is not also being transferred to them, and the international registration is still within the dependency period.

## TRANSFORMATION

817. Where the international registration is cancelled (total or in part) by the International Bureau due to the ceasing of effect of the basic mark, the Protocol offers that holder the possibility of securing continued protection in the designated members by way of transformation. Transformation is not available where the holder has voluntarily canceled the international registration.

818. Transformation means that the holder is now leaving the Madrid System and moving on to the direct route, by filing a national or regional application directly before the Offices concerned, following the relevant applicable domestic requirements. Apart from the special provisions regarding date, an application resulting from transformation is in effect an ordinary national or regional application. This filing is not governed by the Protocol or the Regulations, nor is the International Bureau involved in any way.

819. If the holder wishes to take advantage of such transformation, they need to file a national or regional application within three months counted from the date the International Bureau recorded the cancellation of the international registration in the International Register.

820. The holder may request transformation with respect to any of the members in which the international registration had effect, that is any of the designated members in respect of which the international registration had not been the subject of a total refusal, invalidation or renunciation. The goods and services listed in the application must have been covered by the list in the canceled international registration (or in the cancelled part of the international registration) in respect of the member concerned.

821. 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 member for the registration of a mark, which was the subject of an international registration designating that member, will be treated by that Office as if it had been filed on the date of the international registration or, where that member 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. [[Article 9quinquies](#)]

822. It is up to each member 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, for example, using a specific form through a local representative and payment of fees in local currency. The Office 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. For more information on the applicable requirements before the various Offices, holders may contact the Offices directly or consult the [Madrid Member Profiles](#) database on WIPO's website.

## **REPLACEMENT OF NATIONAL OR REGIONAL REGISTRATION BY INTERNATIONAL REGISTRATION**

### **What is Replacement?**

823. Replacement is a feature introduced into the Madrid System to alleviate the holder from the burden of having to renew previous national registrations in one or several territories of the Madrid System, later designated in an international registration. This feature was intended to make the centralized management of trademark portfolios under the Madrid System more efficient, as international registrations, under certain conditions, are deemed to automatically replace national or regional registrations in designated members.

824. The terminology is somewhat misleading as there is no physical replacement in the national or regional Registers, but this feature allows the holder of an international registration to benefit from an earlier date of protection in a jurisdiction covered by an earlier national or regional right. The reference to the international registration being “deemed to replace the national or regional registration” does not mean that the national or regional registration is suspended or otherwise affected. The national or regional registration will remain on the Register of the member concerned, with all the rights attaching to such a registration, unless it is not renewed by the holder.

825. One international registration may replace more than one national or regional registration. This would typically be the case where the member concerned used to have a single class system, meaning one national registration could only cover one class of goods and services, whereas the international registration can cover up to 45 classes of goods and services.

### Conditions for Replacement

826. For replacement to take place, the following conditions need to be met:

- both the national or regional registration and the international registration are in the name of the same holder;
- protection resulting from the international registration extends to the member in question;
- goods and services listed in the national or regional registration are also listed in the international registration in respect of that member concerned;
- the extension of the international registration to that member (which may be a subsequent designation) takes effect after the date of the national or regional registration. [\[Article 4bis\(1\)\]](#)

827. The international registration is deemed to replace the national or regional registration without prejudice to any rights acquired by virtue of the latter (for example, rights resulting from a priority claim or from prior use of the mark).

### The Goods and Services Listed in the National or Regional Registration

828. The international registration does not need to have an identical list of goods and services as the national or regional registration. The list in the international registration can be broader in scope or it can be narrower, but there needs to be, at least, some goods and services overlapping, i.e., covered by the national or regional registration and the international registration. The names of the overlapping goods and services do not need to be the same, but they must be equivalent.

829. Replacement may be total or partial. See paragraphs 836 to 842 for further information and practical examples of replacement. It is up to the holder to ensure whether, in a given case, the conditions under [Article 4bis](#) are actually fulfilled. In other words, provided the conditions have been met, replacement has effect and the possibility of requesting an Office to take note (see paragraph 830 to 835) of that fact is an option which the holder may elect, or not, to exercise. The holder may benefit from asking the Office to take note, particularly in cases of partial replacement, to help ensure that all conditions have been met and to gain a better understanding of the consequences of allowing an earlier national or regional right to lapse where only partial replacement has taken place.

## Taking Note of Replacement

830. Replacement is automatic, without the Office or the holder needing to do anything. However, the holder may request the Office concerned to take note of the replacement in its Register. This will be especially important where the national or regional right later lapses and eventually may disappear from the national or regional Register. Without the Office taking note of the earlier date, it would not be possible for the holder to alert third parties of this fact. [\[Article 4bis\(2\)\]](#)

831. The holder must present the request directly before the Office concerned, possibly through a local representative, using a local form and pay a fee for such request. For more information on the procedures before the various Offices, holders may contact the Offices directly or consult the [Madrid Member Profiles](#) database on WIPO's website.

832. Where the Office has taken note in its Register following such request by the holder, that Office must notify the International Bureau accordingly. [\[Rule 21\(1\)\]](#).

833. Once notified, the International Bureau will record the replacement details in the International Register and inform the holder accordingly. The details of the replacement will also be published in the [Gazette](#), making such information concerning the replacement available to third parties in the national or regional Registers as well as in the International Register. [\[Rule 21\]](#) [\[Rule 32\(1\)\(a\)\(xi\)\]](#)

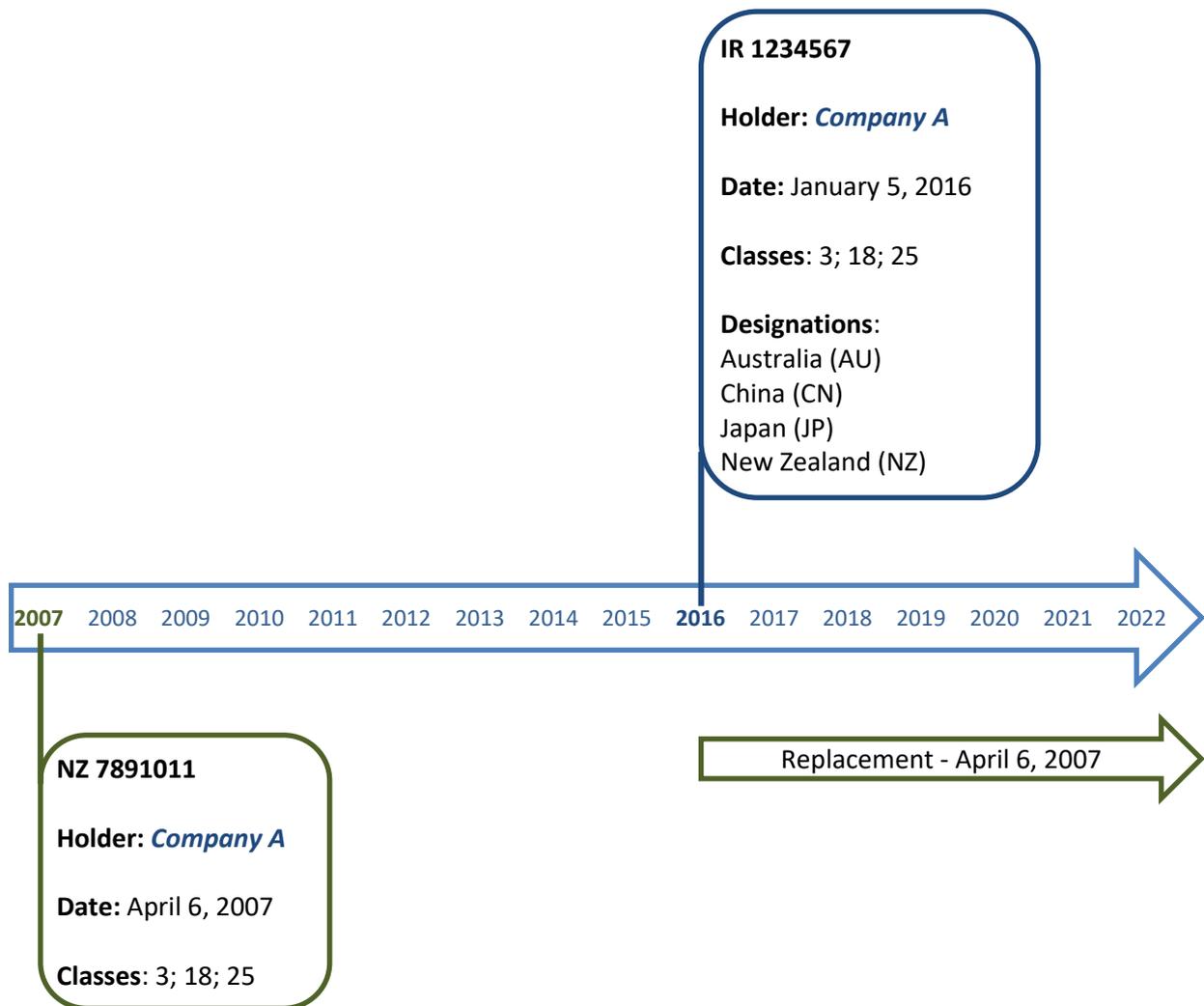
834. While replacement is a fundamental feature of the Madrid System and potentially one of the most attractive features, the use remains low. Replacement supports the simplified and centralized management of a holder's trademark portfolio, by allowing the holder to benefit, in the international registration, from the dates of protection previously acquired in the earlier national and regional rights. With only one renewal date, the need to only monitor and maintain one registration (the international registration) and no requirement of local representatives, replacement would lead to lower maintenance costs.

835. Notwithstanding the replacement of a national or regional registration, it is in the holder's interest to renew the national or regional registration during the five-year period, where the international registration is dependent on the fate of the basic mark. Otherwise, in a worst case scenario, the holder may be left without any protection, losing both the international registration due to the ceasing of effect of the basic mark, and the earlier national or regional registration due to non-renewal.

## Examples of Total Replacement of a National Right

836. The following examples illustrate how total replacement works.

### The International Registration and the National Registration Cover the Same Scope of Protection

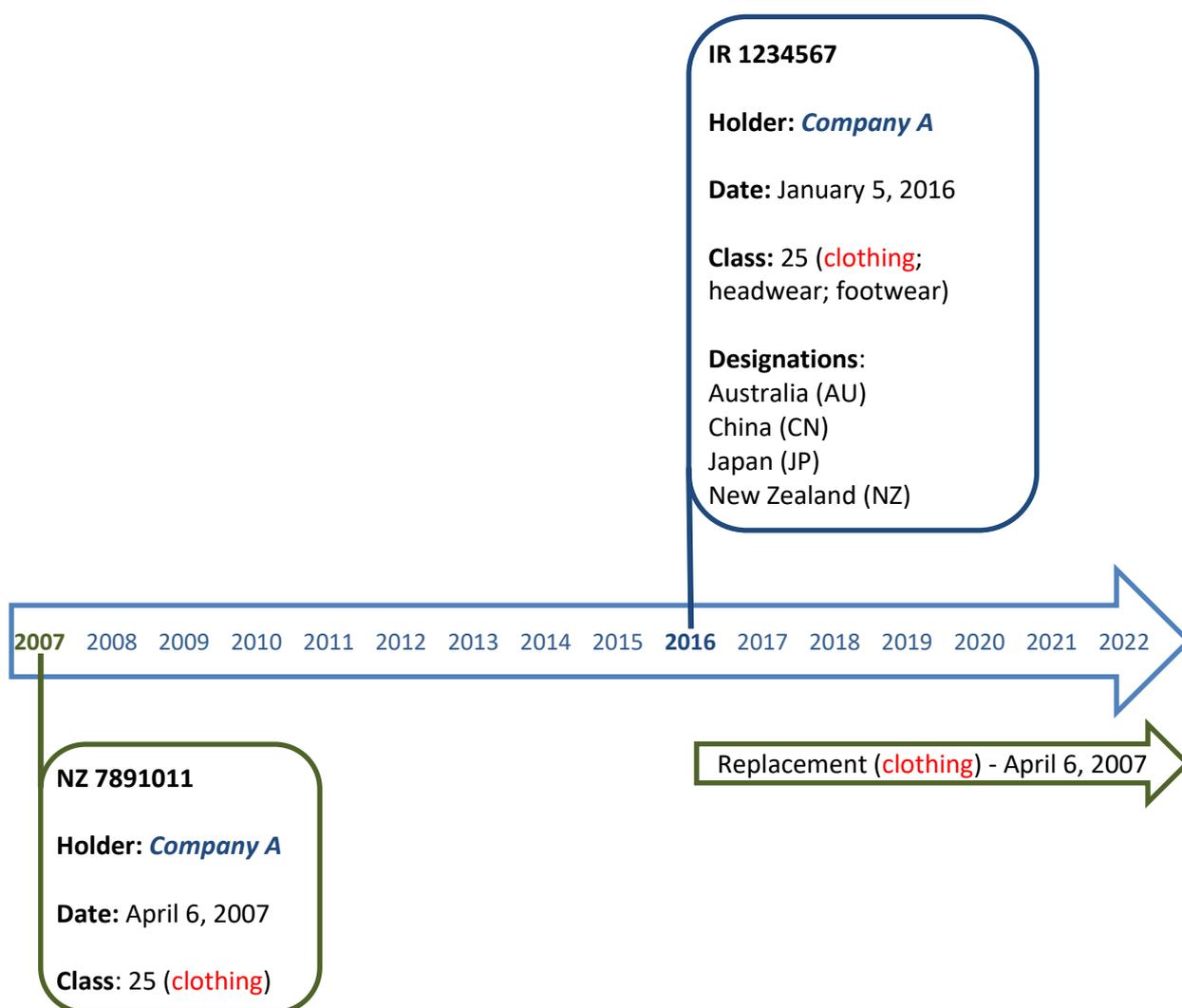


837. The above illustrates how an international registration simply and automatically will replace an earlier national registration.

- *Company A owns the earlier national registration 7891011 (the national right) dated April 6, 2007, in New Zealand, covering goods in classes 3, 18, 25.*
- *Company A is the holder of international registration (IR) dated January 5, 2016, covering goods in classes 3, 18, 25.*

*With its designation of New Zealand, the IR automatically replaces the earlier national right. In this case, the holder can request the Intellectual Property Office of New Zealand (IPONZ) to take note of the replacement. The IPONZ Register would then reflect that the prior national right for goods in classes 3, 18 and 25 is totally replaced by the later filed IR. Should the holder later decide to let the earlier national right lapse, the IPONZ Register would show, under the IR number, that the holder has protection for the mark concerned for goods in classes 3, 18 and 25, from the date of protection of the lapsed earlier national right (April 6, 2007).*

### The International Registration Has a Broader Scope of Protection than the National Registration



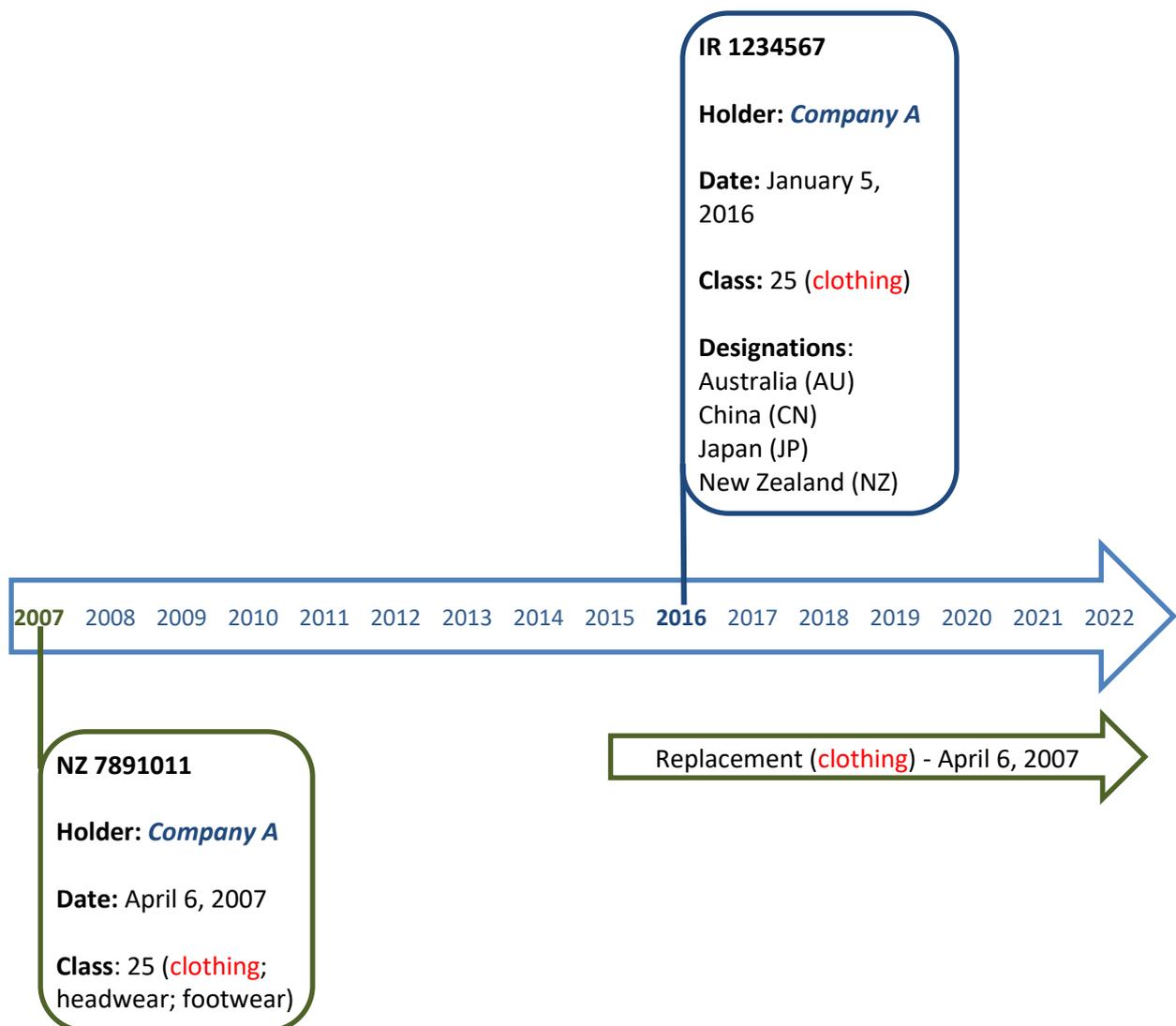
838. The above illustrates how a national registration can be replaced by an international registration that is broader in scope.

- *Company A owns the earlier national registration 7891011 (the national right) dated April 6, 2007, in New Zealand, covering only “clothing” in class 25.*
- *Company A is the holder of international registration (IR) dated January 5, 2016, covering “clothing; headwear; footwear” in class 25.*

*With its designation of New Zealand, the IR automatically replaces the earlier national right in respect of clothing. However, in this case, the holder can request the Intellectual Property Office of New Zealand (IPONZ) to take note of the replacement. The IPONZ Register would then reflect that the earlier national right “clothing” in class 25 is totally replaced by the later IR. Should the holder later decide to let the earlier national right lapse, the IPONZ Register would show, under the IR number, that the holder has protection for the mark concerned for “clothing” in class 25, as from the date of protection of the lapsed earlier national registration (April 6, 2007).*

### Example of Partial Replacement of National Right

839. The following example illustrates how partial replacement works.



840. The above illustrates how a national registration can be replaced by an international registration that is narrower in scope.

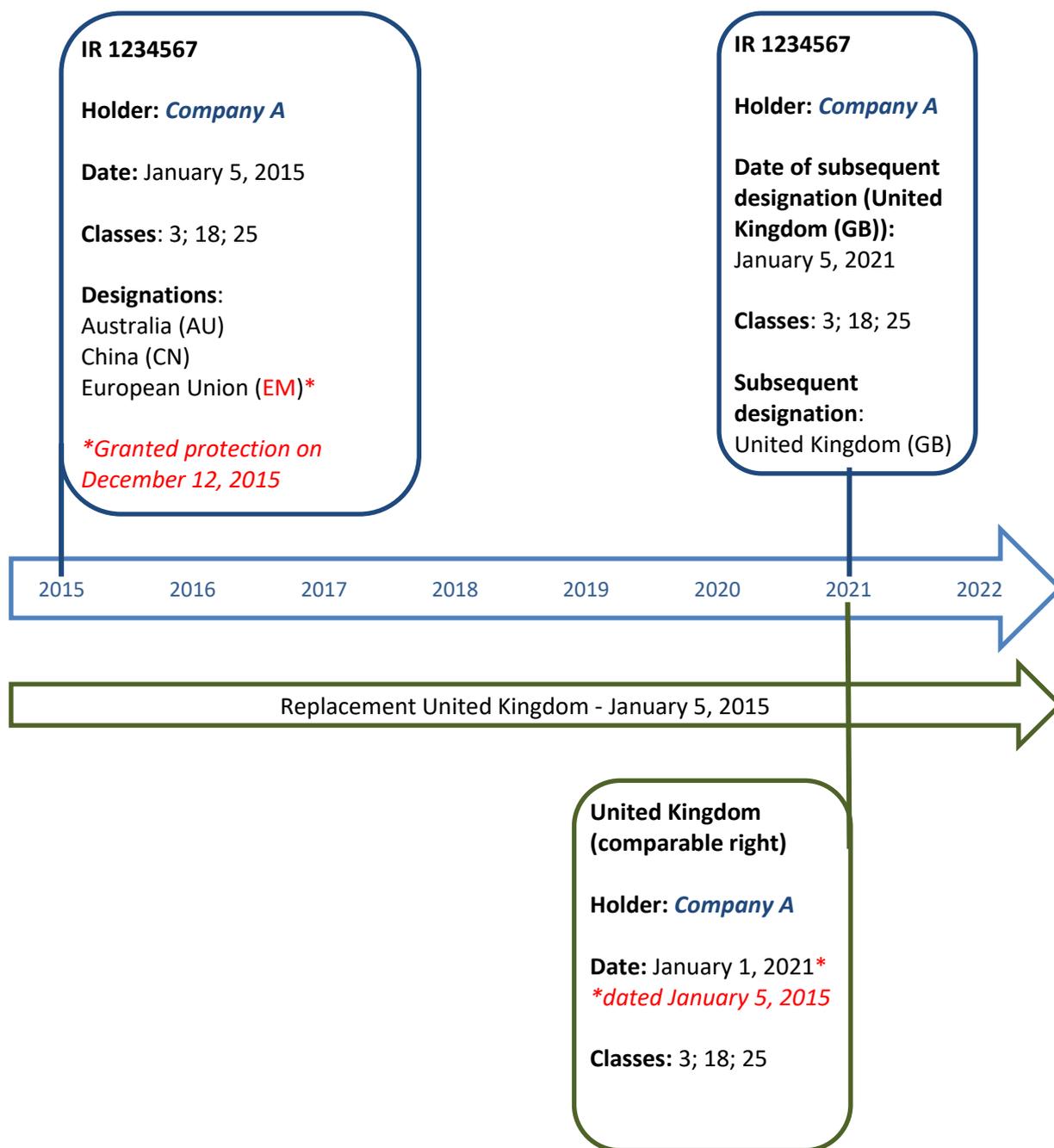
- *Company A owns the earlier national registration 7891011 (the national right), dated April 6, 2007, in New Zealand, covering “clothing, headwear and footwear” in class 25.*
- *Company A is the holder of international registration (IR), dated January 5, 2016, covering only “clothing” in class 25.*

*With its designation of New Zealand, the IR automatically replaces the earlier national right in respect of clothing only. In this case, the holder can request the Intellectual Property Office of New Zealand (IPONZ) to take note of the replacement. Should the holder later decide to let the earlier national right lapse, there would no longer be any protection for those goods in class 25 beyond “clothing”, namely “headwear and footwear”. The IPONZ Register would show, under the IR number, that the holder has protection for the mark concerned for “clothing” in class 25, as from the date of protection of the earlier national right (April 6, 2007).*

## Replacement and BREXIT

841. As of January 1, 2021, a designation of the European Union (EU) in an international registration no longer covers the United Kingdom (UK). Where the EUIPO had granted protection to the designation of the EU before December 31, 2020, a national UK right based on the scope of the EU designation concerned, (“comparable right”) would have been automatically created by the Office of UK (UKIPO). The protection of the UK is no longer part of the international registration and its designation of the EU, but the holder would now have a national right in the UK reflecting the scope of the designation of the EU. Where the EU designation was still pending before the EUIPO by December 31, 2020, the holder had the opportunity to file a national application before the UKIPO within nine months (end of September 2021). Where a national application was filed, that application date would reflect the date of the designation of the EU (either the date of the international registration or the date of the subsequent designation, where applicable).

842. Following the scenario above, where the holder would like to have protection of the UK covered yet again in the international registration, they would need to subsequently designate the UK under the Madrid System. In such case, the holder may later, provided the conditions in [Article 4bis](#) are met, request the UKIPO to take note of the replacement of the national registration. In this way, the UK national Register would reflect the fact that the holder had protection through a national right in the UK, which would refer to the date of their designation of the EU in the international registration. This is illustrated below.



## CONTINUATION OF EFFECTS OF INTERNATIONAL REGISTRATIONS IN CERTAIN SUCCESSOR STATES

843. 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 member”) becoming an independent State (“the successor State”). In such a case, the successor State may deposit with the Director General of WIPO a declaration of continuation, the effect of which is that the Protocol is applied by the successor State. [[Rule 39](#)]

844. Any holder of an international registration with a territorial extension to the predecessor member, 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 their 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. [[Rule 39\(1\)](#)]

845. If the holder has failed to comply with the time limit of six months to request that the international registration continue its effects in the successor State and to pay to the International Bureau the corresponding fee, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official [form MM20](#) within two months after the failed time limit has ended (see also the [Note for filing MM20](#)). Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [[Rule 5bis](#)]

846. After the time limit for requesting that the international registration continue its effect in the successor State has expired, protection of the international registration in the member concerned can only be achieved by way of a subsequent designation, then with a later date of protection.

847. Upon receipt of the request and the fees, the International Bureau notifies the Office of the successor State and makes the corresponding recording in the International Register. It also publishes the relevant information in the [Gazette](#). [[Rule 39\(3\)](#)]

848. The successor State may only refuse protection of the international registration if the time limit referred to in [Article 5\(2\)](#) of the Protocol has not expired with respect to the territorial extension to the predecessor member. [Rule 39\(4\)](#), however, does not preclude the Office of a successor State from notifying, beyond the time limit fixed in [Article 5\(2\)](#) of the Protocol, a final decision on a refusal of protection regularly notified to the International Bureau by the predecessor member (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. [[Rule 39\(4\)](#)]

## CHAPTER III: GUIDE FOR OFFICES OF MEMBERS OF THE MADRID SYSTEM

### INTRODUCTION

849. This chapter of the Guide provides useful information for Offices of members, and includes information and guidance on the role of the Office, acting as the Office of origin and as the Office of the designated member. It also covers Madrid-specific procedures (replacement, transformation and correction) and how the Office should manage these. Finally, it explains in detail how to become a member and the technical assistance that the International Bureau may provide to assist the Offices in their preparations for an accession.

850. The information contained in Chapter I of this Guide provides guidance on some of the more general and practical aspects of the Madrid System, that may be useful to Offices. Chapter II of the Guide is geared for applicants and holders but may also be of interest to Offices.

### ONLINE RESOURCES FOR OFFICES

851. The International Bureau has made available many online resources and tools for its users and these are detailed in paragraphs 107 to 147. General resources and tools that are of particular interest for Offices include [Madrid Monitor](#) and [Contact Madrid](#). Tools specifically designed for Offices include [Model Forms](#) and [Madrid System Statistics](#).

#### Model Forms

852. Model Forms have been introduced to help Offices of members communicate effectively with the International Bureau. By using these forms to communicate with the International Bureau, Offices are likely to include all the information needed to meet the requirements under the Madrid System, and reduce the risk of receiving irregularity notifications. The [Model Forms](#) are available on WIPO's website. The forms are regularly updated, so Offices should periodically check WIPO's website, to ensure that they use the most updated version of the forms. These forms should be tailored to suit the particular needs and requirements of each member, including adding the name of the Office and its logo. Further information concerning the most commonly used Model Forms is provided below in relation to the relevant subject matter.

#### Madrid System Statistics

853. A [Madrid System Statistics tool](#) is available on WIPO's website. The Offices can create reports, monitor the status and volume of pending applications and subsequent designations being processed by the International Bureau. The statistics are updated daily, but as notifications generally come in weekly batches, it would be useful for the Offices of members to check these statistics weekly (for example, every Monday) to see how many designations are in the pipeline. Such figures may help Offices monitor and plan their examination workload.

## COMMUNICATIONS WITH THE INTERNATIONAL BUREAU

854. Chapter I of the Guide contains important information concerning communications with the International Bureau (including the methods of communication, the calculation of time limits and the language of communication), the payment of fees and representation before the International Bureau (see paragraphs 31 to 90).

855. Three kinds of communications are, in principle, possible:

- between the International Bureau and the Office of a member;
- between the International Bureau and the applicant or holder (or representative);
- between the applicant or holder (or representative) and an Office.

856. Communications that 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 Protocol and of the Regulations. They are a matter for the law and practice of the member concerned.

857. Communications between the International Bureau and the applicant or holder (or representative) should be by electronic means. Depending on the specific transaction, it may be for the holder to decide whether to communicate directly with the International Bureau or through an Office. However, some communications must be submitted through an Office, for example, the international application form and a request for a change in ownership of an international registration, where the holder has not signed the form. Communications between the International Bureau and the applicant or holder (or representative) are covered in Chapter II of this Guide, in relation to each type of transactions that may take place.

### Methods of Communications (Offices)

858. The preference of the International Bureau is to communicate electronically with the Offices and its users. Any communication between an Office and the International Bureau, including the presentation of an international application, should be made by electronic transmission. It is not possible to communicate with the International Bureau by facsimile.

859. The methods 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. [\[A.I. Section 11\(a\)\(i\)\]](#)

### XML Data to the FTP Server or SFTP Server

860. The preferred method for the International Bureau to receive communications from an Office is for the Office to transmit files directly to its dedicated folder on the FTP or SFTP server. These communications could be in XML format, PDF and image files. This method is particularly useful for Offices that send a high volume of transactions to the International Bureau (international applications as well as decisions on the scope of protection where designated) as it allows for a high level of automation on the part of the Office. Contact the International Bureau if more information is required on how to submit communications to the FTP or SFTP server.

## The Madrid Office Portal

861. If the Office is not yet in a position to transmit communications to the FTP or SFTP server as mentioned above, the Office can use the [Madrid Office Portal](#) (MOP), which is a secure and effective way to exchange documents and notifications. Participating Offices can access their customized portal using a unique username and password, where they will be able to:

- view and download WIPO notifications (current and past);
- upload official documents;
- transmit applications, forms, Office actions and other requests;
- respond to irregularity letters;
- track the status of any international registration in real-time;
- browse the International Register and the [Gazette](#).

862. To get started with MOP, Offices will need to create a [WIPO Account](#) using the link available on WIPO's website and then contact WIPO using [Contact Madrid](#) also available on WIPO's website to request private access.

863. It is important to note that while documents and notifications exchanged using MOP remain available for a limited time, Offices should not rely on MOP as a repository. For further details on MOP, please refer to the [Quick Start Guide](#) available on WIPO's website.

## Industrial Property Administration System (IPAS)

864. IPAS supports the processing of trademarks from filing through to the grant of rights and post-grant processes. IPAS is a workflow-based system that can be customized to fit the requirements and legal framework of each Office. Notifications of designations in international registrations are transmitted to the Office concerned having IPAS installed. Version 3.6.1 or later of IPAS allows for bi-directional communications, to be submitted directly from IPAS to the International Bureau.

## Madrid E-filing

865. International applications should be transmitted to the International Bureau by [Madrid E-filing](#), the Office's own online service, or a customized version of the [MM2 form](#). WIPO can provide a Madrid E-filing solution to Offices, which allows integration with their national Registers and facilitates the filing of international applications, certification by Offices and the subsequent handling of any irregularities which may arise during the examination process. If an Office does not have Madrid E-filing installed, or have its own online service or customized version of the MM2 form, the [Madrid Application Assistant](#), available on WIPO's website, should be used. Applications must be sent to the International Bureau via the Office of origin. The clear advantage of having Madrid E-filing is that all communications to and from the Office of origin and the International Bureau are captured in the system. Madrid E-filing also keeps communication between the Office and the applicant during the pre-certification phase. Madrid E-filing may be provided free of charge. Offices may contact the International Bureau using [Contact Madrid](#) for more information.

## Communications – An Office of a Designated Member

866. An Office of a designated member should send its decisions on the scope of protection in each of the international registrations where it is designated, by xml data to the FTP or SFTP server, or using the [Model Forms](#) (mentioned above) uploaded to the FTP or SFTP server or by the [Madrid Office Portal](#) (MOP). For those Offices that have version 3.6.1 or later of IPAS, it would also be possible to send such decisions using the two way communication feature of IPAS.

867. Offices may contact the International Bureau using [Contact Madrid](#) for more information on the methods of communication available.

## ROLES OF THE OFFICE OF A MEMBER

868. The Office of a member has essentially two main roles, namely its role as the Office of origin and its role as the Office of the designated member. The Office of a member must, in addition, be available to assist and support users of the Madrid System and transmit requests received from holders concerning changes to, or maintenance of, their international registrations to the International Bureau, if necessary.

## ASSISTING AND SUPPORTING USERS OF THE MADRID SYSTEM

869. Offices of members must be available to assist and support users of the Madrid System. As an Office of origin, the Office may need to help their local applicants to file their international application, and provide advice on the suitability of the basic mark. Offices may also seek assistance from applicants when remedying irregularities in the application, where necessary.

## RECEIVING AND FORWARDING REQUESTS TO THE INTERNATIONAL BUREAU ON BEHALF OF HOLDERS

870. A holder may present any request to the International Bureau directly, or through an Office with the exception of the following, which must be submitted through an Office:

- The international application must be transmitted through the Office of origin;
- A request to record a change in ownership of the international registration not signed by the recorded holder must be submitted through the Office of the member of the recorded holder (or the new owner). Under these circumstances, the Office may request documentation to support the request, for example, to ensure that the change in ownership is legitimate;
- A request to divide an international registration in respect of a designated member (that allows for division) must be submitted through that Office of the designated member;
- A request to merge international registrations following a division of an international registration must be submitted through the Office that submitted the request for division.

871. Where possible (i.e., with the exception of the situations mentioned above), the Office should encourage the holder to submit requests concerning the international registration directly to the International Bureau, using [the forms](#) available on WIPO's website. Where an online form is available for the given transaction or change, the preference should be to use that form. This is more convenient for the holder and also offers secure payment methods where fees are applicable. Also, an Office should not charge a fee for forwarding requests to the International Bureau, even if such involvement would increase their workload. Furthermore, submitting forms through an Office may not be in the best interest of the holder, as this may result in a later date of recording for the specific transaction or change.

872. In addition to those requests that must be submitted through an Office, such as requests for the recording of a change of ownership where the holder has not signed the form, an Office should be mindful when receiving a request for the recording of a subsequent designation, for example, as any delay in forwarding such request to the International Bureau could have an impact on the date of protection, as detailed in the paragraphs below.

### **Requests for the Recording of a Subsequent Designation Submitted Through an Office**

873. The Office is not obliged to receive requests for subsequent designations and cannot charge a handling fee for its involvement with such requests. The simplest and most convenient way for a holder to add members to an international registration is to submit a request directly to the International Bureau, using the [Online subsequent designation](#) service available on WIPO's website (see paragraphs 143, 465 and 466).

874. Accordingly, the Office should advise the holder to use the online service. However, if the Office decides to receive the request, then the following paragraphs should be considered.

#### **Date of Subsequent Designation**

875. A subsequent designation presented to the International Bureau 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.

876. If the subsequent designation complies with the applicable requirements, it will bear 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. This also applies in the cases of continued processing under [Rule 5bis](#), given that the procedure of continued processing has no impact on the determination of the date of the subsequent designation under [Rule 24\(6\)](#).

877. Therefore, it is very important for Offices to forward requests for subsequent designations promptly to the International Bureau. [[Rule 24\(6\)\(b\)](#)]

878. The date of the subsequent designation may be affected if it contains irregularities. The holder may also indicate that the subsequent designation takes effect after the recording of a change or partial cancellation in respect of the international registration concerned, or after the renewal of the international registration.

879. It is not possible to include a priority claim in the subsequent designation. Where a priority claim is included in the international application and this is still applicable at the time of the subsequent designation, the claim will also apply for subsequently designated members. For further information concerning requests for subsequent designation, refer to paragraphs 459 to 523.

### **Irregular Subsequent Designation**

880. Where the International Bureau considers that there is an irregularity regarding the subsequent designation that was presented by an Office, it will notify the Office. [[Rule 24\(5\)\(a\)](#)]

881. Where a subsequent designation contains an irregularity, which relates to the international registration concerned, such as the mark, the indication of the designated members, 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, provided they are remedied within two months from 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\(6\)\(c\)\(i\)](#)]

882. The rules do not specify who should remedy the irregularity. If the holder presented the subsequent designation directly to the International Bureau, then they have 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 alone (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 a holder is notified by the International Bureau that there is an irregularity in a subsequent designation which has been presented through an Office, they should contact that Office to ensure that the irregularity will be remedied in good time.

883. For further information on the formalities and the content of requests for subsequent designation, please refer to paragraphs 459 to 523, for further information on the examination of subsequent designations for Offices of the designated members, please refer to paragraphs 1053 to 1055.

### **Request to Record a Change in Ownership of an International Registration**

884. A request to record a change in ownership must be presented to the International Bureau on the official [form MM5](#). [[Rule 25\(1\)\(a\)\(i\)](#)]

885. The request may be presented to the International Bureau directly by the holder (or the recorded representative) or through the Office of the member of either the (recorded) holder or the new owner (transferee).

886. In most cases, the Office may wish to encourage the holder to present a request for a change in ownership directly to the International Bureau, using the [form MM5](#) or preferably the [Online change in ownership](#) form. However, there is one situation, when such request must be presented through an Office. This is where the recorded holder has not signed the form MM5, for example, because the holder does not exist anymore (for example, due to a death or bankruptcy). [[Rule 25\(1\)\(b\)](#)]

887. Where the request is to be presented to the International Bureau through an Office, that Office may require evidence concerning the change of ownership. The International Bureau does not 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.

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

- 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.

889. 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.

890. 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.

891. Please see paragraphs 597 to 641, for further details concerning requests for recording of a change of ownership.

## ROLE OF THE OFFICE OF ORIGIN

892. In its role as the Office of origin, the Office of a member must:

- be prepared to receive, examine and certify international applications and transmit those applications to the International Bureau;
- remedy certain irregularities in the international application; and
- monitor the basic mark and notify the International Bureau of any ceasing of effect.

## THE INTERNATIONAL APPLICATION

893. The international application must be filed through the Office of origin on the official form (see paragraphs 218 to 338). [\[Article 2\(2\)\]](#)

894. 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 6\(1\)\]](#)

895. An international application that does not comply with these requirements concerning language will not be considered and the International Bureau, will return it to the Office that forwarded it, without examining the application in any way. All fees paid will be reimbursed to the party that made the payment. [\[Rule 11\(7\)\]](#)

## Requirements for Trademark Owners to Use the Madrid System

896. The Madrid System may only be used by a natural person or a legal entity, which has an entitlement (connection) with a member of the Madrid System.

897. In addition to having the necessary entitlement, the applicant must also have a basic mark, more specifically, have an application or registration for the mark with that Office of origin.

### Entitlement and the Office of Origin

898. Before filing an international application, the trademark owner must establish their entitlement (connection) with the Madrid System, and which Office or Offices may be the Office of origin for the international application in question.

899. 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 (for example, the European Union), 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. [\[Article 2\(1\)\(i\)\(ii\) and 2\(2\)\]](#) [\[Rule 1\(xxv\) and \(xxvi\)\]](#)

900. The interpretation of “national”, “domicile” and “real and effective commercial or industrial establishment” is a matter for the laws of the Office of origin. Please see however, paragraphs 157 to 165 and 235 to 239, for guidance.

901. The Office of origin may request documentation to support the applicant’s claim of entitlement. However, this is not required by the International Bureau and should not be submitted with the international application.

### Basic Application or Registration (the Basic Mark)

902. An international application must be based on either a registration recorded with the Office of origin (basic registration) or on an application for registration filed with that Office (basic application). This is referred to as the “basic mark” requirement. The international application may relate only to goods and services covered by the basic mark.

903. In most cases, the international application will be based on a single basic mark (registration or application), which covers the goods and services listed in the basic mark. It is, however, possible to base an international application on several basic marks (applications and/or registrations), which together cover the goods and services of the international application. This is particularly relevant where the Office of origin has previously followed a single-class system. The basic marks must all be in the name of the applicant indicated in the international application and must have been filed with the same Office. For the sake of simplicity, the following paragraphs refer only to a basic mark, it being understood that this includes the possibility of several basic marks.

## Selecting the Basic Mark – Advising the Applicant

904. The Office can assist the applicant by helping them understand the importance of selecting an appropriate basic mark. When determining whether the basic mark is appropriate, the Office may guide the applicant to select a mark that covers a broad enough scope of goods and services, bearing in mind that it is also possible to limit the scope of protection in some of the designations, if necessary. The applicant should also be reminded that basing the international application on a mark too broad in scope may result in the basic mark becoming vulnerable for non-use cancellation actions by third parties, which could have an impact on the international registration, as explained below in the following paragraphs (see also, paragraphs 796 to 801).

905. An international registration remains dependent on the basic mark for a period of five years from the date of its registration. If the basic mark ceases to have effect, either partially or totally, for any reason (for example, it is refused or withdrawn, cancelled or not renewed) within this five-year period, the international registration will no longer be protected to the same extent. This is referred to as a ceasing of effect of the basic mark. Refer to paragraphs 1013 to 1036.

906. Therefore, it is important to lower the risk of possible ceasing of effect by advising the applicant to choose a “strong” basic mark. This could be a basic registration, rather than a pending application, which may be open to opposition by a third party; it could also be a mark already in use and therefore not vulnerable to a non-use cancellation action. It is important to be aware that the basic mark must remain in force and be renewed, if necessary, during the five-year dependency period. Furthermore, within this period, the holder of the international registration should be aware that proceeding with any change in the ownership of the basic mark to a third party should be done with caution, since the responsibility of maintaining the basic mark would then be out of their control.

907. If the applicant’s most feasible option is to base the international registration on a basic application rather than a registration, the Office may consider offering the applicant a speedy examination and classification of the domestic application, if possible, to reduce issues that could affect the scope of the international registration at a later stage.

## Several Applicants

908. Two or more applicants (whether natural persons or legal entities) may jointly file an international application, provided that the basic mark is also jointly owned by them, and that each of the applicants have the necessary connection through establishment, domicile or nationality with the member of the Office of origin.

909. 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 member. [\[Rule 8\(2\)\]](#)

## THE APPLICATION FORM

910. Applicants are strongly advised to read the detailed [notes for filing](#) available on WIPO’s website before completing the application for an international application form. However, they may still contact the Office for advice.

911. An international application must be presented to the International Bureau on the [official form MM2](#). [\[Rule 9\(2\)\(a\)\]](#)

912. Some Offices offer [Madrid E-filing](#) (provided by WIPO) or their own online filing service. If the applicant's Office of origin has neither, the applicant is advised to use the [Madrid Application Assistant](#), which is an electronic version of the official MM2 form.

913. The Offices of some members provide forms for requesting an international application, that may differ from the official international application form, which applicants may be permitted or required to use, as prescribed by the law of the member. Where the language(s) allowed before the Office of origin are 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). Alternatively, the Office may translate the information into that language.

914. The official form must be typed; handwritten forms are not acceptable.

915. Chapter II of this Guide provides applicants with full guidance on completing the application form (see paragraphs 218 to 338).

916. However, Offices should pay particular attention to the following paragraphs, to understand their role in terms of certifying the application and assisting the applicant, where possible, to help avoid delays in the processing of the application, and irregularities being raised by the International Bureau.

917. It is up to the Office concerned to decide how much assistance to provide to the applicants, in addition to certifying that the particulars of the international application correspond to those of the basic mark. Ideally, the Office of origin should check the contents of the application form to avoid any irregularities, for example, it should ensure that the entitlement of the applicant to hold an international registration is clearly indicated. The Office may ask the applicant to support any information contained in the application form. Any such examination should, however, not delay the forwarding of the application to the International Bureau, as this could affect the date of the international registration, nor should any documentation submitted to the Office to verify, for example, an entitlement claim be sent to the International Bureau. As a minimum, the Office should check that the international application contains all the substantive information required, which, if not provided, could negatively affect the calculation of the date of the international registration, namely the name of the applicant, the representation of the mark, the list of goods and services, and, at least, one designation. Where the Office finds that any of this information is missing, it would be advisable to have a procedure in place, to allow the applicant a short time limit to provide the missing information, while still be able to transmit the international application to the International Bureau within the two-month time limit.

## Basic Mark and Priority Claim

918. The Office must ensure that the correct details have been entered for the basic mark. If the basic mark is registered, only the details of the registration should be indicated. The application details of the basic mark are only to be indicated if the basic mark has not yet proceeded to registration. Where the Office has [Madrid E-filing](#), this tool will automatically gather/display all relevant information concerning the basic mark from the domestic Register.

919. The Office may consider advising the applicant to claim priority from the basic mark (or other first filing) if the international application is received within the six-month priority period. The Office should not send any documentation supporting the priority claim to the International Bureau.

## Entitlement

920. The Office should ensure that the applicant has correctly indicated their entitlement by checking that the relevant box has been ticked (see paragraphs 157 to 165, and 235 to 239).

921. The Office may request documentation to support the claim of entitlement, but such documentation should not be sent to the International Bureau.

922. Where the applicant has indicated that their address is not in the territory of the member for which they are claiming entitlement (i.e., not in the territory of the Office of origin), they must provide an address in the territory of the member from which they are claiming entitlement (i.e., in the territory of the Office of origin). See example in paragraph 238.

## Certification of the International Application by the Office of Origin

923. When the Office of origin receives an application, it is important to indicate the date of receipt. When signing the international application, the Office must certify the date on which it was received. This date will become the date of the international registration providing the certified application is forwarded to the International Bureau within two months of the date it was received by the Office of origin (see paragraphs 378 and 383).

924. The main task of the Office of origin is to certify the international application and forward it to the International Bureau within the two-month time limit. The certification by the Office of origin confirms that the particulars of the international application correspond to the particulars of the basic mark.

925. The Office of origin must certify the following particulars of the international application:

- (i) the date on which the Office of origin received the international application (see paragraph 923, and paragraphs 317, 378, 379, 383 and 891);
- (ii) that the applicant in the international application is the same as the applicant or holder of the basic mark mentioned in the form; where the international application is filed jointly by several applicants, they must all also be joint applicants or holders of the basic mark; [\[Rule 9\(5\)\(d\)\(ii\)\]](#) [\[Rule 8\(2\)\]](#)
- (iii) that, where any of the following indications appears in the international application, the same indications appear also in the basic mark: [\[Rule 9\(4\)\(a\)\(vii\) to \(xi\) and \(5\)\(d\)\(iii\)\]](#) [\[Rule 9\(5\)\(d\)\(v\)\]](#)
  - an indication that the mark consists of a color or a combination of colors as such;
  - an indication that the mark is a three-dimensional mark, a sound mark or a collective, certification or guarantee mark;
  - a description of the mark by words (it being understood that any description in the international application must, however, be in the language of the international application);

- (iv) that the mark indicated in the form is the same as the basic mark; [\[Rule 9\(5\)\(d\)\(iv\)\]](#)
- (v) that, if color is claimed as a distinctive feature of the mark in the basic mark, 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 mark, the mark in the basic mark is in fact in the color or combination of colors claimed;
- (vi) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic mark 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 mark, 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 mark. [\[Rule 9\(5\)\(d\)\(vi\)\]](#)

926. Where the international application is based on two or more basic marks, this declaration may be made only if the statements under paragraph 925(i) to 925(vi) are true for each of them. As far as the statement under paragraph 925(vi) is concerned, the Office of origin may make this declaration provided that the goods and services mentioned in the basic mark(s), taken together, cover those listed in the international application. [\[Rule 9\(5\)\(e\)\]](#)

### **Correspondence of Particulars**

927. Before the Office can sign the form and certify the particulars of the international application (see paragraphs 923 to 926), it must determine, as mentioned above, that the particulars of the international application correspond with those of the basic mark.

928. The interpretation of “correspondence” is a matter for the Office of origin to determine. This Guide can, therefore, only give some general guidance on the elements of the international application that must “correspond”.

### ***The Mark***

929. When considering whether the basic mark and the international mark correspond, the Office may be more flexible where the reproduction of the mark is, for example, clearer in the international application than on the local register, or where there are minor differences providing the overall impression is the same. The Office is not required to use a magnifying glass when comparing the marks in question, for example, some Offices may take a flexible approach in particular situations, such as those illustrated below.

Basic Mark	International Mark	Correspondence
Apple Pies	Apple Pies <b>Apple Pies</b> A p p l e P i e s APPLE PIES Apple Pies Apple Pies ®	Commonly used fonts Bold lettering Spacing Upper case Size of letters Use of ®
		Clearer image

***Special Kinds of Marks (Three-dimensional Marks, Sound Marks or Collective, Certification or Guarantee Marks)***

930. If the basic mark is a three-dimensional mark, sound mark or a collective, certification or guarantee mark, this must be indicated in the international application, for example, if the basic mark is a three-dimensional mark, the relevant box should be checked (see paragraphs 260 to 262).

***Mark to Be in Color (Basic Mark in Black and White)***

931. Where the applicant claims color as a distinctive feature of the mark but the reproduction of the mark in the basic mark is in black and white (for example, because the Office of origin did not provide for publications of registrations in color), a reproduction of the mark in color must be provided, in addition to the black and white reproduction. [\[Article 3\(3\)\]](#) [\[Rule 9\(4\)\(a\)\(vii\)\]](#)

***Mark Consists Exclusively of a Color or Combination of Colors***

932. If the basic mark consists exclusively of a color or combination of colors as such, without any figurative element, the international mark should also include this indication (see paragraph 264).

***Standard Characters***

933. Where the mark is a word mark with no figurative elements, the applicant can declare that the mark is to be considered as a mark in standard characters. By doing so, the applicant may avoid provisional refusals being issued by members that require such declaration (for example, the United States of America) (see paragraphs 265 to 267).

### ***Color(s) Claimed***

934. If color is claimed as a distinctive feature of the mark in the basic mark, the same claim must be included in the international application. If color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic mark, the basic mark must be in the color or combination of colors claimed (see further, in paragraphs 268 and 269).

### **Miscellaneous Indications**

935. There are a number of other indications that may be included in an international application. Although such indications do not need to be certified, it would be very helpful if the Office could assist the applicant in correctly including any applicable indications, to help them avoid irregularities or future provisional refusals. It would also be helpful to remind applicants that it is not possible to change or remove miscellaneous indications from the International Register once they are recorded. Also, it is worth noting that some of these indications are mandatory.

### ***Transliteration of the Mark (Mandatory)***

936. The applicant must provide a transliteration of the mark, where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals (see paragraphs 271 and 272).

### ***Translation of the Mark (Optional)***

937. The applicant may include a translation of the mark. By doing so, the applicant may avoid provisional refusals being issued by members that require such translation (see paragraph 273).

### ***The Mark Has No Meaning (Optional)***

938. If the mark is an invented word, the applicant may wish to indicate that the mark has no meaning. By doing so, the applicant may avoid provisional refusals being issued by members that require such clarification (see paragraph 274).

### ***Description of the Mark***

939. The applicant must include a description of the mark, only if

- (i) there is a description contained in the basic mark and,
- (ii) if the Office of origin requires the same description be included in the international mark. The description must be in the language of the international application.

940. The applicant may also include a voluntary description. This does not need to be certified by the Office (see paragraphs 275 to 278).

### ***Verbal Elements of the Mark (Optional)***

941. The International Bureau captures from the reproduction what appears to be the essential verbal elements of the mark. This is included in the [Madrid Monitor](#) database and is used in notifications and correspondence to confirm the identity of the resulting international registration. Where, however, the mark is in special characters or highly stylized, there is a risk that the words or letters may be misinterpreted by the International Bureau. Further, 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 they consider to be the essential verbal elements of the mark, to help reduce any misinterpretation (see paragraphs 279 and 280).

### ***Disclaimer (Optional)***

942. Where the applicant wishes to disclaim protection for any element of the mark, that element or elements should be indicated. The purpose of this is to avoid provisional refusals from designated members that may require such disclaimer to be included in the International Register. However, if a disclaimer is included in the international application, it will be in respect of the international registration as a whole, i.e., it will apply to all the designated members, including those to be added in the future (subsequently designated). Alternatively, the applicant may leave this part of the form blank and address this issue directly with the Office of the designated member concerned should a provisional refusal be issued (see paragraphs 281 to 284).

### **Goods and Services**

943. The Office of origin must check that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic mark 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 mark, or must fall within a broader term included in that list; the list of goods and services in the international application may, however, be narrower than that in the basic mark. The Office should look at the specific terms to see if they correspond, and not necessarily be bound by the indicated class number of the [Nice Classification](#). This may especially be relevant where the basic mark is an older registration, as certain terms, set out in the international application, may now fall under a different class of the Nice Classification, than what was the case for the classification of the goods and services in the basic mark. [\[Rule 9\(5\)\(d\)\(vi\)\]](#)

944. The list the applicant indicates in the international application is referred to as the main list; this list will be, once recorded, the list subject to subsequent designations. However, the applicant is free to determine that for one or more members, they want a reduced list and not the main list. In such case, they will indicate a limitation. That means, where a limitation is requested for a specific Office, that Office must consider the limited list and not the main list.

945. When determining whether the goods and services covered by the international application correspond to those covered by the basic mark, it is important to remember that the terms do not need to match exactly (for many Offices the lists will be in different languages), nor do they need to be as broad in nature as the basic mark (i.e., the international application can cover a narrower scope of protection), for example:

- *Basic mark covers classes 3, 5 and 10, and the international application covers classes 5 and 10 only. This would amount to “correspondence”, as the list of the international application is within the scope of the basic mark.*

- *Basic mark covers class 7 “cutting machines; metalworking machines” and the international application covers class 7 “machines”. This would not amount to “correspondence” as the list in the international application is broader than the list in the basic mark.*

946. The International Bureau will apply the version of the corresponding edition of the [Nice Classification](#) in force at the time of the filing of the international application, regardless of the version and edition of the Nice Classification applied to the goods and services in the basic mark. Where the International Bureau receives the international application more than two months after the date of receipt of the Office of origin, and there is a new version or edition in place, the International Bureau will apply the new version or edition.

947. The International Bureau accepts class headings, but some members may not. Therefore, the applicant may choose to list the specific goods and services to help avoid a provisional refusal by the Office of such a member, and it may be advisable to list specific goods and services instead of using the indication of the class headings.

948. The use of expressions, such as “all goods in class X” and “all other services in this class”, will not be accepted by the International Bureau. Therefore, the relevant goods and services must be indicated. For further guidance and information on classification, please refer to the [Examination Guidelines Concerning the Classification of Goods and Services in International Applications Under the Madrid System](#) and the [Madrid Goods and Services Manager](#) made available on WIPO’s website.

### ***Limitation of Goods and Services***

949. The international application may contain limitations of the list of goods and services in respect of one or more designated members.

950. The limitation may be different in respect of different designated members. If the basic mark covers class 32 “Beers; mineral and aerated waters and other non-alcoholic beverages”; the international application may, for example, indicate class 32 “Beers; mineral and aerated waters and other non-alcoholic beverages” for some designations, for some designations (for example, where alcoholic beverages are not permitted) “mineral and aerated waters” may be indicated, and yet for others, just “beers” could be indicated (see paragraphs 294 to 298).

### **Designations**

951. The Office must ensure that the applicant has designated at least one member (see paragraphs 299 to 302).

### ***Designations of the United States of America and the European Union***

952. If the applicant designates the United States of America or the European Union, it is important for the Office to remind the applicant or that they will need to provide additional information and attach additional forms, in particular a [form MM18](#) must be attached to the application. If this is missing the applicant will receive an irregularity notification, and in the worst case scenario, the designation of the United States of America will be disregarded. The Office may provide similar advice where a request for subsequent designation is presented through the Office.

953. If the European Union is designated, the applicant will need to select one of the five official languages of the European Union Intellectual Property Office (EUIPO) namely, English, French, German, Italian and Spanish. The Office should check that the applicant has included an indication for the second language as required, and where they have not, give them a short time limit to do so. This would help the applicant avoid a future provisional refusal. If the applicant wishes to claim seniority for more than one member State of the EU, a separate [form MM17](#) should be completed for each member State. See paragraphs 303 to 314 for more information. The Office may provide similar advice where a request for subsequent designation is presented through the Office.

### **Signature of the Applicant and/or Their Representative**

954. The Office of origin may require or permit the applicant or the applicant's representative to sign the international application. The International Bureau will not question the absence of such a signature. [\[Rule 9\(2\)\(b\)\]](#)

955. Any signature by the applicant or the representative may be handwritten, printed, typed or stamped. [\[A.I. Section 7\]](#) [\[A.I. Section 11\(a\)\(ii\)\]](#)

### **Signature of the International Application by the Office of Origin**

956. The international application must be signed by the Office of origin. This signature may be handwritten, printed, typed or stamped. The International Bureau does not check the authenticity of signatures; it only checks that there is a signature in the form. Provided the signature box in the form is not empty the signature requirement will be considered met; only a blank box would result in an irregularity. 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. [\[Rule 9\(2\)\(b\)\]](#) [\[A.I. Section 7\]](#)

957. The Office of origin, by signing the form, affirms the truth of the declaration contained in the form (i.e., it has certified the application as set out in paragraphs 923 to 926). For example, the Office would not be able to sign the international application if this includes goods and services that are not covered by the basic mark. In such case, the Office must ask the applicant to correct any discrepancy (for example, by restricting the list of goods and services so that it falls within the list contained in the basic mark). Until this has been done, the application must not be forwarded to the International Bureau.

**Example of Certification and Signature of the International Application  
by the Office of Origin**

**13. CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY  
THE OFFICE OF ORIGIN**

**(a) Certification. The Office of origin certifies:**

- (i) That the request to present this application was received on (dd/mm/yyyy):

23/01/2022

- (ii) that the applicant named in item 2 is the same as the applicant named in the basic application or the holder named in the basic registration mentioned in item 5, as the case may be,

that any indication given in item 7(d), 9(d) or 9(e)(i) appears also in the basic application or the basic registration, as the case may be,

that the mark in item 7(a) is the same as in the basic application or the basic registration, as the case may be,

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 item 8 or that, if color is claimed in item 8 without having being 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

that the goods and services listed in item 10 are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deemed to apply to all those basic applications or basic registrations.

**(b) Name of the Office:**

The IP Office of a member

**(c) Name and signature of the official signing on behalf of the Office:**

*By signing this form, I declare that I am entitled to sign it under the applicable law.*

Jane Doe

Jane Doe

**(d) E-mail address of the contact person in the Office:**

jdoe@IPOffice.com

## Transmission of the International Application to the International Bureau

958. Any communication between an Office and the International Bureau, including the presentation of an international application, should be made by electronic transmission, for example, through [Madrid E-Filing](#), as xml data, PDF or image files, to the FTP or SFTP server using the [Madrid Office Portal](#) (see paragraphs 860 to 867).

## Payment of Application Fees

959. Payment of the international application fees is the responsibility of the applicant. However, some Offices may opt to collect and forward the application fees to the International Bureau on behalf of the applicant.

960. The Office should warn the applicant that the international registration cannot be recorded until the necessary fees have been received by the International Bureau. Since it is the applicant's responsibility to pay the required fees, the Office is not required to check that payment has been made, or hold off on the transmission of the international application until it has seen evidence of the payment of the fees concerned.

961. See paragraphs 319 to 338, for further information concerning the payment of fees.

## EXAMINATION OF THE INTERNATIONAL APPLICATION BY THE INTERNATIONAL BUREAU

962. Once the International Bureau receives the international application, it will examine it to ensure it meets the formality requirements set out in the Regulations.

## Irregularities in the International Application

963. If there is an irregularity in an international application, the International Bureau will notify the Office of origin and the applicant. Whether the responsibility for remedying it lies with the Office or with the applicant depends on its nature.

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

- irregularities with respect to the classification of goods and services; [\[Rule 12\]](#)
- irregularities with respect to the indication of goods and services; [\[Rule 13\]](#)
- other irregularities. [\[Rule 11\]](#)

965. Where the International Bureau finds that there are irregularities with the international application, it will:

- notify both the Office of origin and the applicant (or the applicant's representative);
- inform of the specific irregularity;
- explain how to remedy this;

- provide a time limit of three months to remedy the irregularity;
- specify who needs to remedy the irregularity, the Office of origin or the applicant; and
- state what the consequence would be in case the irregularity is not remedied.

### **Irregularities Concerning the Classification of Goods and Services**

966. The Office must pay attention to the classification of goods and services listed in the international application.

967. The classification and grouping of goods and services as listed in the international application is strictly the responsibility of the International Bureau. If there are any issues with the classification of the goods and services indicated in the international application, the International Bureau will try to resolve the issues with the Office of origin. The applicant will also be informed, so they can liaise with the Office to find a suitable solution.

968. The list of goods and services set out in the international application must follow the latest edition and version of the [Nice Classification](#). 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 incorrect, it will notify the Office of origin with a proposal and copy 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. However, such an interpretation does not bind a designated member with regard to the determination of the scope of the protection of the mark. [\[Article 4\(1\)\(b\)\]](#) [\[Rule 12\(1\)\(a\)\]](#)

969. The 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 than indicated in the international application, additional supplementary and/or individual fees may be payable to cover the additional classes.

970. 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 them to intervene with the Office of origin. However, the International Bureau cannot accept proposals or suggestions directly from the applicant. It is recommended that the Office of origin establishes an internal procedure to allow the applicant a short time limit to clarify the goods and services concerned with the irregularity.

971. The Office of origin may, within three months of the date of notification of this proposal, respond to the irregularity and provide 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 received from the International Bureau, may have intervened with the Office of origin or may have been invited to give their opinion. The Office of origin is, however, not obliged to give an opinion on the proposal. The proposal made by the International Bureau prevails. [\[Rule 12\(2\)\]](#)

972. 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 a reminder to both the Office and the applicant, reiterating the proposal. The sending of this reminder does not affect the three-month period referred to in the irregularity notification. [\[Rule 12\(3\)\]](#)

973. If the Office of origin responds to the irregularity, the International Bureau will review such response, and may 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, any change in the amount of any fees due will be also indicated. 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\(4\) to \(6\) and 12\(7\)\(c\)\]](#)

974. Any additional fees to be paid as a consequence of the proposed reclassification must be paid: [\[Rule 12\(7\)\(a\) and \(b\)\]](#)

- 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.

975. 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, the Office of origin must notify the International Bureau.

976. This demonstrates that the applicant must pay attention to the irregularities issued to the Office of origin. When additional fees are due and, if two months after the first notification (of which the applicant was informed), the applicant receives the reminder of the International Bureau, they should intervene with the Office of origin to check whether the Office intends to communicate an opinion on the proposal. The applicant should also ensure that the payment of the additional fees 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.

977. If, as a consequence of non-payment of any additional fees, the international application is considered abandoned, the International Bureau will refund the fees already paid 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\(8\)\]](#)

978. If the international application contains a limitation of the list of goods or services in respect of one or more of the designated members (see paragraphs 294 to 298, 553, 949 and 950), the International Bureau will examine the limitation to ensure that the goods and services indicated are correctly classified and grouped under the [Nice Classification](#), by applying the same examination procedure as described in paragraphs 943 to 948). However, it will not examine whether the goods and services fall within the scope of the main list or not, as this should be determined by the Offices of the designated members. If the International Bureau is unable to group the goods and services listed in the limitation in the international application, it will issue an irregularity. If the irregularity is not remedied within three months from the date of the notification, the limitation will be deemed not to contain the goods and services concerned. [\[Rule 12\(8bis\)\]](#)

979. 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. [[Rule 12\(9\)](#)]

***Example of Irregularities Concerning the Classification of Goods and Services (Rule 12)***

980. The example below illustrates the application of [Rule 12](#) (classification of goods and services):

*The goods “Medicated and non-medicated soaps; dispensers for liquid soaps for household use; wholesale services for toiletries and soaps” were listed in class 3 in the international application, as illustrated below:*

**10. GOODS AND SERVICES**

(a) **Indicate below the goods and services for which the international registration is sought:**

Class: Goods and Services:

3	Medicated and non-medical soaps; dispensers for liquid soaps for household use; wholesale services for toiletries and soaps.
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*Following its examination, the International Bureau notified the Office of origin that some the goods listed in the international application were incorrectly classified. Please see extract below:*

IRREGULARITY(IES) CONCERNING THE CLASSIFICATION OF GOODS AND SERVICES: TO BE REMIEDIED BY THE OFFICE (RULE 12)

The International Bureau considers that the goods/and/or services listed in the international application are not grouped in the appropriate classes of the International Classification of Goods and Services (Rule 9(4)(a) (xiii)). The International Bureau proposes therefore to transfer the following terms:

- “medicated soaps” from class 3 to class 5;
- “dispensers for liquid soaps for household use” from class 3 to class 21;
- “wholesale services for toiletries and soaps” from class 3 to class 35”.

The proposed grouping may entail the payment of further fees (see attached accounting statement).

An opinion on this proposal may be communicated to the International Bureau. Any such opinion must be communicated **THROUGH THE OFFICE OF ORIGIN within three months from the date of the present notification, that is 5 September 2022**. Failing this, the mark will be registered with the classification and grouping proposed by the international Bureau. However, if this proposal entails the payment of further fees and such fees are not paid within four months from the date of the present notification, the international application will be considered abandoned.

*In the given example, there are various possible outcomes depending on whether the International Bureau receives a response from the Office of origin and whether the fees for the additional classes (if applicable) are paid.*

- (i) *If, within the time limit, the Office responds to the notification and agrees to the amendments proposed by the International Bureau; and the applicant pays the additional individual fees due for the three additional classes, the mark will be registered for the following goods and services:*

- class 3: non-medicated soaps;*
- class 5: medicated soaps;*
- class 21: dispensers for liquid soaps for household use;*
- class 35: wholesale services for toiletries and soaps.*

- (ii) *If, within the time limit, the Office responds to the notification and informs the International Bureau that the applicant wishes to proceed only with the goods in class 3 (the proposed classes 5, 21 and 35 are withdrawn); and the fees for the application in one class have already been paid (there are no additional fees payable), the mark will be registered for the following goods:*

*class 3: non-medicated soaps*

- (iii) *If the Office does not respond to the proposal within the three-month time limit, but the applicant pays the fees for the additional classes within the four-month time limit, the mark will be registered for the goods and services list in (i).*
- (iv) *If, within the time limit, the Office responds to the notification and agrees to the amendments proposed by the International Bureau, but the applicant does not pay the additional individual fees due for the three additional classes; or the Office does not respond within the time limit, the application will be considered abandoned and 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.*

### **Irregularities Concerning the Indication of Goods and Services**

981. 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\(1\)\]](#)

982. The Office of origin may, within three months of the notification, respond to the irregularity with a proposal. The applicant may communicate their 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 a suggestion made by the International Bureau, 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 966 to 980). [\[Rule 13\(2\)\(a\)\]](#)

983. Where no acceptable proposal has been made to the International Bureau within the time limit, there are two possibilities:

- (i) 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;
- (ii) 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. [\[Rule 13\(2\)\(b\)\]](#)

**Example of Irregularities Concerning the Indication of Goods and Services (Rule 13)**

984. The example below illustrates the application of [Rule 13](#) (indication of goods and services):

*The item “strudel” was listed in class 30 in the international application, as illustrated below:*

**10. GOODS AND SERVICES**

(a) Indicate below the goods and services for which the international registration is sought:

Class: Goods and Services:

30	Strudel
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*Following its examination, the International Bureau notified the Office of origin that some the goods listed in the international application were incomprehensible. Please see extract below:*

IRREGULARTY(IES) CONCERNING THE INDICATION OF GOODS AND SERVICES:  
TO BE REMEDIED BY THE OFFICE

The International Bureau considers that the following term(s) of the list of goods/and/or services is/are incomprehensible (Rule 13)

- “strudel” (class 30)

The International Bureau suggests therefore, the following:

- strudel (cake) (class 30).

An opinion of this proposal may be communicated to the International Bureau. Such proposal must be communicated **THROUGH THE OFFICE OF ORIGIN within three months from the date of the present notification, that is 5 September 2022**. If no proposal acceptable to the International Bureau is made within this period, the International Bureau will include in the international registration the term(s) as appearing in the international application, with an indication to the effect that, in the opinion of the International Bureau, the specified term(s) is/are too vague for the purposes of classification.

*In the given example, there are various possible outcomes depending on whether the International Bureau receives a response from the Office of origin; whether the response results in an acceptable proposal; and whether the application fees have been paid.*

- (i) *If, within the time limit, the Office responds to the notification and agrees to the proposed amendment by the International Bureau, and the applicant pays the application fees, the mark will be registered for the following goods:*

*class 30: Strudel (cake)*

*In this case, the goods will be displayed in Madrid Monitor as follows:*

### **511. The International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) and the list of goods and services classified according thereto**

30

Strudel (cake).

**NCL (10-2015)**

- (ii) *If, within the time limit, the Office responds to the notification with an alternative proposal to that provided by the International Bureau that is acceptable (for example, “strudel (baked pastry”); and the applicant pays the application fees, the mark will be registered for the following goods:*

*class 30: strudel (baked pastry)*

*In this case, the goods will be displayed in Madrid Monitor as follows:*

#### **511. The International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) and the list of goods and services classified according thereto**

30

Strudel (baked pastry)

#### **NCL (10-2015)**

- (iii) *If, within the time limit, the Office responds to the notification with an unacceptable alternative proposal; or does not respond at all; and the applicant has paid the fees due; the mark will be registered for the following goods:*

*class 30: Strudel (term too vague in the opinion of the International Bureau – [Rule 13\(2\)\(b\)](#) of the Regulations).*

*In this case, the goods will be displayed in Madrid Monitor as follows:*

#### **511. The International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) and the list of goods and services classified according thereto**

30

Strudel (terms too vague in the opinion of the International Bureau – Rule 13(2)(b) of the Regulations).

#### **NCL (10-2015)**

- (iv) *If, within the time limit, the Office responds to the notification and agrees to proposed amendment by the International Bureau but the applicant does not pay the fees due, the international application will be considered abandoned and 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.*

#### **Other Irregularities**

985. 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 remedy the irregularity.

### ***Irregularities to Be Remedied by the Office of Origin***

986. There are a number of irregularities (in addition to those relating to the classification of goods and services) that must be remedied by the Office of origin. Such irregularities must be remedied by the Office of origin within three months of the notification. If the irregularity is not remedied, the international application will be abandoned, and the Office of origin and the applicant will be notified accordingly. [\[Rule 11\(4\)\]](#)

987. The following irregularities are the responsibility of the Office of origin, since an international application containing such errors should not have been forwarded to the International Bureau by that Office: [\[Rule 11\(4\)\(a\)\]](#)

- (i) application not presented on the correct official form, or not typed or otherwise printed, or not signed by the Office of origin;
- (ii) irregularities concerning the entitlement of the applicant to file the international application; for example, irregularities concerning the entitlement of the applicant to file the international application; or the application does not indicate the applicant's entitlement (see paragraph 157 to 165, 235 to 239, 898 to 901, and 920 to 922). This would be the case if, for example:
  - the applicant has indicated that they have an establishment or domicile in the territory of the member whose Office is the Office of origin, while their address is not in that territory, and no additional address has been given in the [MM2 form](#) (see paragraph 238), or
  - the address given is also not in that territory; or
  - the applicant's address is in the territory of that member but it has not been indicated whether the applicant's entitlement is based on an establishment or a domicile;
- (iii) irregularities concerning the date and the number of the basic mark;
- (iv) irregularities concerning the declaration by the Office of origin (certification) (see paragraphs 317 and 318 and paragraphs 923 to 926);
- (v) any of the following indications are missing:
  - indications allowing the identity of the applicant to be established and sufficient to contact them or the representative;
  - an indication of the members designated;
  - a reproduction of the mark;
  - a list of goods and services for which registration of the mark is sought;

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

989. While some of these irregularities are easy for the Office to remedy, others could 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. It is therefore recommended that the Office has an established procedure to allow the applicant a short time limit to comment on the irregularity and provide any necessary information.

### ***Irregularities to Be Remedied by the Office of Origin or by the Applicant***

990. Where the fees for the international application have been paid through the Office of origin and 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. [\[Rule 11\(3\)\]](#)

991. If the applicant has failed to meet the time limit of three months to pay the missing amount, the applicant has the option to request continued processing. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#)

### ***Irregularities to Be Remedied by the Applicant***

992. The applicant must remedy any irregularity that is not listed for remedying by the Office of origin, or by the Office of origin or 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: [\[Rule 11\(2\)\(a\)\]](#)

- 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, the e-mail address is missing, or any necessary transliteration is missing;
- details concerning the priority claim are not sufficient; for example, no filing date of the earlier application is given;
- the reproduction of the mark is not sufficiently clear;
- the international application contains a color claim, but the reproduction of the mark is not in color;
- the mark consists of, or contains, elements in characters other than Latin characters, or numerals other than Arabic numerals, and the international application contains no transliteration;
- the amount of fees paid directly to the International Bureau by the applicant or their representative is insufficient or missing;
- 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.

993. 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 priority claim 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\(2\)\(b\)\]](#)

994. If the applicant fails to meet the time limit of three months to remedy an irregularity, they may request continued processing. For further details on the relief measure of continued processing, see paragraphs 65 to 69. [\[Rule 5bis\]](#)

995. 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. [\[Rule 11\(5\)\]](#)

996. Where the international application includes a designation of a member that may not be designated (for example, where the applicant has attempted to designate the member of 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**

997. When designating the United States of America (US), the applicant must attach a declaration of intention to use the mark to the international application ([form MM18](#)). If the declaration is missing or does not comply with the applicable requirements, the International Bureau will notify the applicant and the Office of origin. If the missing or corrected declaration is received by the International Bureau within a period of two months from the date on which 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\(6\)\(a\) and \(b\)\]](#)

998. If, however, the missing or corrected declaration is not received within that period, the designation of the US will be deemed not to have been made. This further highlights the importance of the Office of origin forwarding the international application to the International Bureau as quickly as possible. In this case, the International Bureau will notify both the applicant and the Office of origin, and will reimburse any fee paid in connection with the designation of the US. The International Bureau will also point out that the US can later be subsequently designated in the international registration, provided that such designation is accompanied by the required declaration of intent to use. [\[Rule 11\(6\)\(c\)\]](#)

## Registration, Notification and Publication

999. Where the international application meets the applicable requirements, the International Bureau registers the mark in the International Register. It also notifies the Offices of the designated members 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 to be treated as a record that the international application has been registered with the International Bureau, this does not mean that the mark is protected in the designated members, and it is not to be confused with a certificate of registration issued by a national or regional Office (which are generally issued once the mark has been examined and granted protection). The international registration certificate will be issued in the language of the international application regardless of whether the applicant has indicated that communications from the International Bureau are to be in a different language.

1000. Certified copies of a certificate of international registration may be requested upon the payment of a fee. [[Rule 14\(1\)](#)]

1001. The international registration is published in the [Gazette](#). The Gazette can be accessed by [Madrid Monitor](#) available on WIPO's website. [[Rule 32\(1\)\(a\)\(i\)](#)]

## THE INTERNATIONAL REGISTRATION

### Effects of the International Registration

1002. The effects of the international registration extend to the members expressly designated by the applicant in the international application. [[Articles 3bis and 3ter](#)]

1003. As of the date of the international registration, the protection of the mark in each of the designated members is the same as if the mark had been filed or deposited directly with the Office of that member. If a refusal is not 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 member concerned is the same, as from the date of the international registration, as if the mark had been registered by the Office of that member. [[Article 4\(1\)](#)]

### Date of the International Registration

1004. 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. [[Article 3\(4\)](#)]

1005. 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. The exception to this rule would be where it can be established that the late receipt was a result of a *force majeure* reason, and evidence has been submitted to the satisfaction of the International Bureau that such failure was due to war, revolution, civil disorder, strike, natural calamity, irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of the interested party, or other *force majeure* reason, in accordance with [Rule 5\(1\)](#). In this case, 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**

1006. The date of the international registration may be affected if any of the following important elements are missing from the international application:

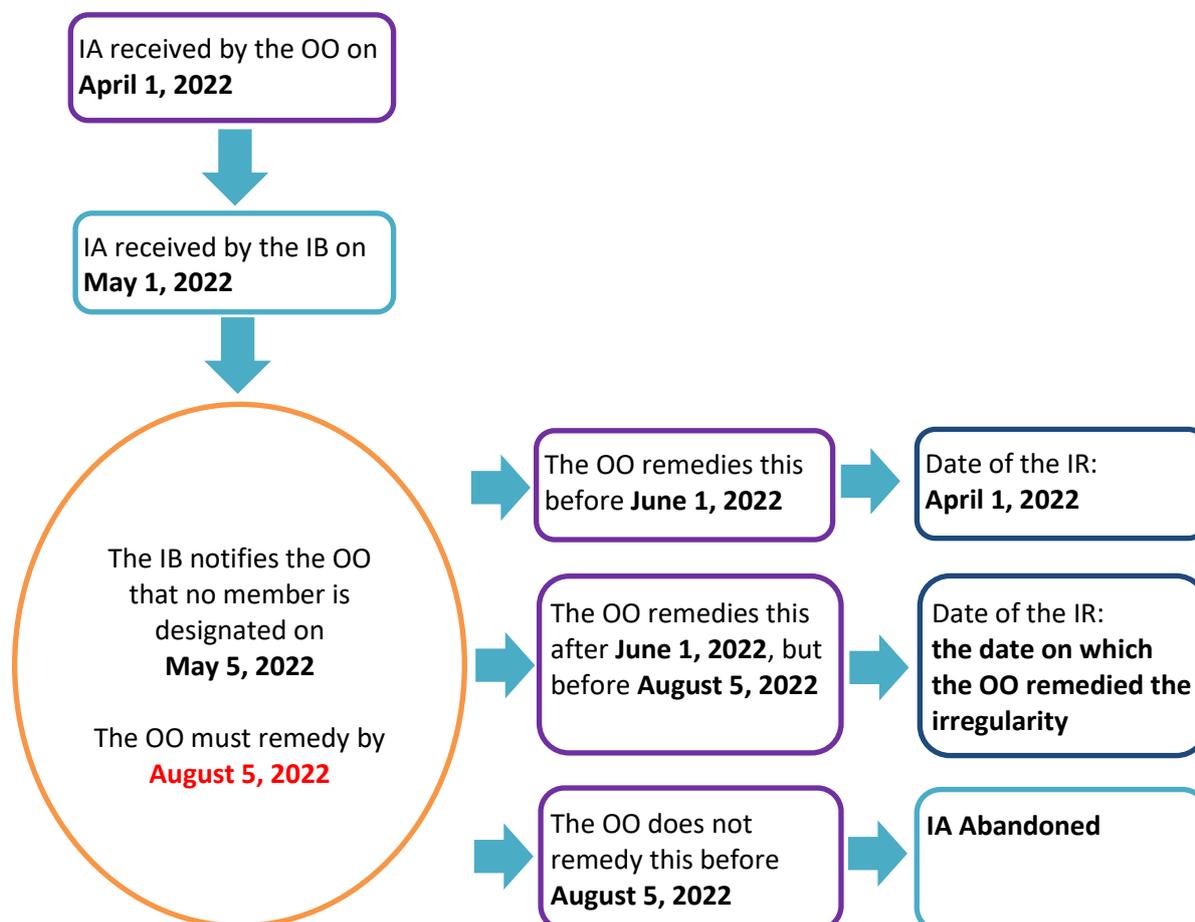
- indications allowing the identity of the applicant to be established and sufficient to contact them or the representative;
- designation of the members where protection is sought;
- a reproduction of the mark;
- the indication of the goods and services for which registration of the mark is sought.

1007. If the last missing element reaches the International Bureau within the two-month time limit for the Office of origin to forward the international application, as mentioned in paragraph 1005, 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 do 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. This applies also in the cases of continued processing under [Rule 5bis](#), because the procedure of continued processing has no impact on the determination of the date of the international registration. [[Rule 15\(1\)](#)]

1008. The remedying of any of the above-mentioned 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 to ensure that the deficiency is remedied as speedily as possible. If it is not remedied within three months of the date on which the Office of origin was notified of the irregularity, the application will be considered abandoned. [[Rule 11\(4\)\(a\)\(ii\)](#)]

### Example of Date of International Registration in Special Cases

1009. The following example illustrates the combined application of these rules for determining the date of the international registration:



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

- *if the OO remedies the irregularity on or before June 1, the date of the international registration (IR) will be April 1;*
- *if the OO remedies the irregularity after June 1, but on or before August 5, the date of the IR will be the date on which the missing information was received by the IB;*
- *if the OO does not remedy the irregularity on or before August 5, the IA will be considered abandoned.*

1010. The date of an international registration is not affected by any irregularities other than those referred to in paragraph 1006, for example, the late payment of fees or irregularities concerning the classification of goods and services will not affect the date of the international registration, provided that such irregularities are remedied within the applicable time limit. [\[Rule 15\(2\)\]](#)

1011. While it is the applicant's responsibility to ensure that the international application contains all the relevant information, it would be helpful if the Office of origin checks, at least, that it contains the substantive elements that would impact the possible date of the international registration.

1012. For information on the content, recording, publication and language of the international registration, see paragraphs 384 to 390.

## **Ceasing of Effect of the Basic Mark During the Dependency Period**

1013. The international registration is dependent on the basic mark (i.e., the national or regional registration or application on which the international registration is based) for five years from the date of the international registration. The protection resulting from the international registration may no longer be invoked if, or to the extent that, the basic mark is canceled, renounced, revoked, invalidated or has lapsed, or where the basic mark is an application for registration, 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.

1014. This dependence is absolute, and is effective regardless of the reasons why the basic mark is rejected, withdrawn or 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". However, often the basic mark ceases to have effect due to the inaction of the holder, for example, where the holder is not responding to a refusal of a basic mark that is subject of an application, or not renewing a registered basic mark.

1015. To soften the consequences of the five-year dependency period of the Madrid System, the Protocol provides for an opportunity for the holder of an international registration, where this is canceled as a result of the ceasing of effect of the basic mark, to continue securing protection in the designated members by way of transformation (see paragraphs 817 to 822, and 1245 to 1251).

1016. At the end of the five-year dependency period, the international registration becomes independent of the basic mark (subject to paragraph 1027). It should be noted that there is no separate dependency period for subsequent designations; the only dependency period is the one which runs from the date of the international registration. [[Article 6\(2\)](#)]

## **Ceasing of Effect of the Basic Application or Registration**

### ***Monitoring the Status of the Basic Mark***

1017. It is important for the Office of origin to monitor the status of the basic mark during the five-year dependency period. Therefore, when the Office of origin receives an international application, it should make a note in the domestic trademark register, next to the domestic application or registration that it is a basic mark for an international registration. Should this domestic right later be subject to an action that results in a change in the scope of protection, the Office would immediately see that it is a basic mark, and, after checking the timing (five years or initiated within the five-year period counted from the date of the international registration), the Office would then know whether it needs to notify the International Bureau of a ceasing of effect under [Rule 22](#).

1018. 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 mark no longer enjoys legal protection because it: [\[Article 6\(3\)\]](#)

- has been withdrawn;
- has lapsed;
- has been renounced; or
- has been the subject of a final decision of rejection, revocation, cancellation or invalidation.

1019. Where the ceasing of effect of the basic mark 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.

1020. This provision applies also when legal protection (resulting from international registration) has later ceased as the result of an action begun before the expiry of the period of five years. 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.

1021. Furthermore, the same rules apply 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 paragraph 1018, such proceeding having begun before the expiry of the five-year period. This provision prevents the holder of an international registration from avoiding the effects of ceasing of effect, when their basic mark 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**

1022. Where the basic mark has ceased to have effect within the five-year period of dependency, the Office of origin must notify the International Bureau of the following facts and decisions: [\[Rule 22\(1\)\(a\)\]](#)

- 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.

1023. 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 statements, such as: [\[Rule 22\(1\)\(a\)\]](#)

- 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].

1024. 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.

1025. 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 also covered in the international registration; where, therefore, a refusal, withdrawal, cancellation etc., affects the basic mark 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 22\(1\)\(a\)\(iv\)\]](#)

1026. 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 paragraph 806 to 811). 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.

1027. Where, however, the Office of origin is aware that any of the following is pending at the end of the five-year period that may result in the ceasing of effect of the basic mark, it should notify 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\(1\)\(b\)\]](#)

- 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.

1028. Where the Office of origin has sent a preliminary notification as referred to in paragraph 1027, 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. Rule 22(1)(c) provides that the Office of origin must follow up on all completed decisions on ceasing of effect and notify the International Bureau of any decision it is aware of, or at the request of the holder. Recordings in the International Register will thus be confirmed, modified or withdrawn accordingly, and greater clarity and more complete information on the history of the mark will be available. [\[Rule 22\(1\)\(c\)\]](#)

1029. 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 mark has ceased to have effect). [\[Article 6\(4\)\]](#)

1030. An Office can only notify the International Bureau 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 made by 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 that adversely affects the basic mark, and one that requires cancellation of the international registration, the party who brought the action will bring it to the attention of the Office.

### **Model Form 9**

1031. 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. However, the following Model Forms are available for such notification on WIPO's website:

- (i) [Model Form 9A](#) (MF9A) should be used where the basic mark ceases to have effect (in whole or in part) and the decision is final. In this case, the Office must request the cancellation of the international registration [[Article 6\(4\)](#)]. The Office of origin should also use this form when it has sent a preliminary notification (using Model Form 9B – see below), and it now wishes to notify the International Bureau that the decision has become final and has resulted in the rejection, withdrawal, cancellation, renunciation, revocation, invalidation or lapse of the basic mark (see also [Note for filing MF9A](#)).
- (ii) [Model Form 9B](#) (MF9B) should be used to notify the International Bureau where the Office of origin is aware that any of the following actions are pending at the end of the five-year period:
  - 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; or,
  - an action requesting the revocation, cancellation or invalidation of the basic registration, or of the registration resulting from the basic application.See also [Note for filing MF9B](#).
- (iii) [Model Form 9C](#) should be used when the Office of origin has sent a preliminary notification (using MF9B), and it now wishes to notify the International Bureau that the decision has become final and has not resulted in any of the final decisions, withdrawal or renunciation referred to in [Article 6\(3\)](#) of the Madrid Protocol (see also [Note for filing MF9C](#)).

1032. Where the notification does not comply with the requirements mentioned in paragraphs 1022 and 1023, 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. Using Model Form 9A, 9B or 9C, as applicable, will assist the Office of origin in providing all the required information and reduce the risk of irregularities.

1033. The Office of origin should submit this notification following the usual means of transmitting communications to the International Bureau, using xml data to the FTP or SFTP server or through the [Madrid Office Portal](#) (see paragraphs 860 to 867).

## Recording in the International Register of the Ceasing of Effect

1034. 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 members. Where the notification requests cancellation of the international registration, it will be canceled, to the same extent; the International Bureau will notify accordingly the holder and the Offices of the designated members.

1035. Rule 22(2)(b) provides that the International Bureau must also cancel any international registrations resulting from partial change in ownership or division recorded under the cancelled international registration, as well as those resulting from their merger. [\[Rule 22\(2\)\]](#)

1036. 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 that 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\(1\)\(a\)\(viii\) and \(xi\)\]](#)

## Division or Merger of the Basic Application, the Registration Resulting Therefrom, or the Basic Registration

1037. Following the domestic legislation, it may be possible for the basic mark 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. [\[Rule 23\]](#)

1038. This notification must indicate: [\[Rule 23\(1\)\]](#)

- 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.

1039. 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 23\(3\)\]](#)

1040. There is no model form for the Office of origin to notify the International Bureau of such communication; a simple letter from the Office of origin stating the relevant information is sufficient.

1041. The International Bureau records the notification in the International Register and notifies the division or merger to the Offices of the designated members and to the holder of the international registration. The relevant information is published in the [Gazette](#). [\[Rule 32\(1\)\(a\)\(xi\)\]](#)

1042. 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 Office of origin may be contacted directly by the holder or third parties, seeking the full particulars of those applications and/or registrations.

1043. 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 members and third parties with information concerning the situation of the basic mark during the period when the international registration is dependent on it.

## ROLE OF THE OFFICE AS THE OFFICE OF A DESIGNATED MEMBER

1044. Where designated, the Office of a designated member must conduct its substantive examination of the international registration (as well as the subsequent designation, where applicable) in accordance with its local laws and practices, and send the relevant decisions on the scope of protection under Rules 17, 18*ter* and 19; such as:

- Provisional refusal ([Rule 17](#));
- Statement of grant of protection ([Rule 18\*ter\*\(1\)](#)) or following a provisional refusal ([Rule 18\*ter\*\(2\)](#));
- Confirming a total refusal ([Rule 18\*ter\*\(3\)](#));
- Statement of further decision ([Rule 18\*ter\*\(4\)](#)); or
- Invalidation ([Rule 19](#)).

1045. The Office of a designated member will also receive, and will need to take note of, many other notifications that affect the recording of an international registration, such as changes in the holder's details and change in ownership, restrictions of the right (limitation, cancellation and renunciation) and renewals.

1046. Of those notifications, the Office needs to pay particular attention to notifications of recording of:

- a given license;
- a limitation; and
- change in ownership;

1047. Following the examination of such notifications, the Office needs to notify the International Bureau if such recordings have no effect unless for licenses, the member had made a declaration under Rule 20*bis*(6). [[Rule 20\*bis\*](#)] [[Rule 27\(4\) and \(5\)](#)]

1048. Other tasks for the Office of a designated member to perform, include:
- Submitting requests for division of international registrations, and requests for merger of international registrations resulting from division ([Rules 27bis and 27ter](#)) on behalf of the holder (where applicable) (see paragraphs 1206 to 1214 and 1215 to 1226);
  - Taking note of replacement ([Article 4bis](#) and [Rule 21](#)) (see paragraphs 1227 to 1244);
  - Receiving requests for transformation of an international registration into national or regional application or registration ([Article 9quinquies](#)) (see paragraphs 1245 to 1251).

## EXAMINATION OF THE INTERNATIONAL REGISTRATION BY OFFICES OF THE DESIGNATED MEMBERS

1049. The Office of a member may be designated in an international application or subsequently in an international registration. However, the role of the Office in terms of its examination of the international registration is the same. The Office is required to make decisions on the scope of protection, as set out in [Rules 16 to 18ter](#), and as explained in the following paragraphs.

### Designated in an International Application

1050. Where the Office of a member is notified of a designation in an international application, as illustrated below, the important dates are the date of the international registration and the date of the notification.

Registrations



**NOTIFICATION**

ENN/2006/14

<i>Reproduction of the mark</i>	
<i>Registration number</i>	<b>879 539</b>
<i>Registration date</i>	<b>December 27, 2005</b>
<i>Date next payment due</i>	<b>December 27, 2025</b>
<i>Name and address of holder</i>	Organisation Mondiale de la Propriété Intellectuelle chemin des Colombettes 34, CH-1211 Genève 20 (Switzerland)
<i>Legal nature of the holder (legal entity) and place of organization</i>	organisation intergouvernementale, (sans objet)
<i>Classification of figurative elements</i>	16.3; 27.5
<i>List of goods and services NCL(8)</i>	<p>9 Media (other than paper) for viewing by means of electronic machines, including magnetic tapes, optical discs, DVDs and CD-ROMs, holding bibliographical and graphical data, documentation and information on patents of invention, instructional or teaching apparatus and instruments; computer programs and software stored on optical or magnetic media and containing information for the field of patents of invention; electronic publications (downloadable).</p> <p>16 Manuals, printed matter and pamphlets; instructional and teaching material (except apparatus).</p> <p>35 Clerical services for data banks (including statistical data), in connection with the provision of information in the field of patents of invention, including collection, updating, editing, formatting, development and analysis of such data.</p> <p>38 Telecommunications services for data banks, in connection with data in the field of patents of invention, including online distribution and transmission of such data; providing user access to servers and databases; telecommunications by means of computer terminals.</p> <p>41 Teaching and training services; arranging and conducting of seminars, presentations for teaching purposes, lectures and taught classes; publishing of information and documentation; all the above services in the field of patents of invention.</p> <p>42 Legal and technical advice in the field of patents of invention, including services for submitting applications for patents of invention, analysis (scientific, technical and technological) of data (including statistical data) in the field of patents of invention.</p>
<i>Basic registration</i>	Switzerland, 19.07.2005, 538720
<i>Data relating to priority under the Paris Convention</i>	Switzerland, 19.07.2005, 538720
<i>Designations under the Madrid Protocol</i>	Australia, European Union, Japan, Republic of Korea, Singapore, United States of America
<i>Declaration of intention to use the mark</i>	Singapore, United States of America
<i>Date of notification</i>	<b>20.04.2006</b>
<i>Language of the international application</i>	English

1051. From the date of the international registration, the protection of the mark in each of the members designated in the international application, is the same as if the mark had been filed or deposited directly with the Office of that member. 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 member concerned is the same, as from the date of the international registration, as if the mark had been registered by the Office of that member. [\[Article 4\(1\)\]](#).

1052. Therefore, when examining the international registration the Office needs to determine whether rights can be granted from the date of the international registration, in the above example, that date is December 27, 2005. The prescribed time limit (one year or 18 months) to notify the International Bureau of a provisional refusal starts from the date of the notification, in this case, April 20, 2006.

### **Designated in a Subsequent Designation**

1053. Where the Office of a member receives a notification that it has been designated in a subsequent designation, as illustrated below, the important dates are the date the member of the Office was subsequently designated, and the date of the notification.

Designations subsequent to international registration



**NOTIFICATION**

EXN/2013/49

<i>Reproduction of the mark</i>	<b>ROMARIN</b>
<i>Registration number</i>	<b>605 000</b>
<i>Subsequent designations under the Madrid Protocol</i>	Bonaire, Sint Eustatius and Saba, Botswana, Colombia, Curaçao, Ghana, Israel, Madagascar, Mexico, New Zealand, Oman, Rwanda, Sao Tome and Principe, Sint Maarten (Dutch part), Tunisia
<i>Date of subsequent designation</i>	October 16, 2013
<i>Date of notification</i>	19.12.2013
<i>International registration concerned</i>	<b>605 000</b>
<i>Registration date</i>	<b>June 16, 1993</b>
<i>Date of the renewal</i>	<b>June 16, 2013</b>
<i>Date next payment due</i>	<b>June 16, 2023</b>
<i>Declaration of intention to use the mark</i>	Ireland, New Zealand, Singapore, United Kingdom, United States of America
<i>Name and address of holder</i>	ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE chemin des Colombettes 34, CH-1211 GENÈVE 20 (Switzerland)
<i>List of goods and services</i>	9 Machine-readable bibliographic and graphic data media, including magnetic tapes, optical disks, CD-ROM disks for mark documentation; software on magnetic or optical media. 35 Services relating to data banks in connection with data relating to marks, namely collection, storage, update, formatting, analysis, archiving, sorting and documentation of data, including information, communications, images, films and documents. 38 Services relating to data banks in connection with data relating to marks, namely distribution and delivery of data, including information, communications, images, films and documents.
<i>Basic registration</i>	Switzerland, 01.04.1993, 402 418
<i>Data relating to priority under the Paris Convention</i>	Switzerland, 01.04.1993, 402 418
<i>Language of the international application</i>	French

1054. From the date of the subsequent designation, the protection of the mark in the subsequently designated member in the international registration, is the same as if the mark had been filed or deposited directly with the Office of that member. 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 member concerned is the same, as from the date of the subsequent designation, as if the mark had been registered by the Office of that member.

1055. Therefore, when examining the international registration, the Office needs to determine whether rights can be granted from the date of the subsequent designation, in the above example, that date is October 16, 2013. The prescribed time limit to notify the International Bureau of a provisional refusal starts from the date of the notification, in this case from December 19, 2013.

## **Substantive Examination (Considerations)**

1056. The Office of a designated member must perform its substantive examination of the designation following the domestic legislation and practice. It cannot examine on formalities (for example, classification) as these have already been cleared by the International Bureau (see paragraphs 339 to 375 and 962 to 1001).

## **Limitations**

1057. The international application may contain limitations of the list of goods and services in respect of one or more designated members. Likewise, a member subsequently designated in an international registration may also be subject to a limitation.

1058. Regardless of whether the member is designated in the international application or subsequently to the international registration), the Office needs to examine the limitation, to ensure that the limited list of the goods and services falls within the scope of the main list. If this is not the case, the Office may raise this as a ground to refuse protection of the international registration, by issuing a provisional refusal. Offices should pay particular attention to limitations in subsequent designations as illustrated below. The limitation (framed in red) should be compared with the main list of the international registration (framed in green).

Designations subsequent to international registration



**NOTIFICATION**

EXN/0/0

*Reproduction of the mark* **ROMARIN**  
*Registration number* **605 000**  
*Subsequent designations under the Madrid Protocol* **Canada**  
*Limitation of the list of goods and services* **Canada**

*List limited to:*  
 9 Machine-readable bibliographic and graphic data media, including magnetic tapes, optical disks, CD-ROM disks for mark documentation; software on magnetic or optical media.

*Date of subsequent designation* **April 26, 2022**  
*Date of notification* **12.05.2022**

*International registration concerned* **605 000**  
*Registration date* **June 16, 1993**  
*Date of the renewal* **June 16, 2013**  
*Date next payment due* **June 16, 2023**  
*Declaration of intention to use the mark* **Ireland, New Zealand, Singapore, United Kingdom, United States of America**  
*Name and address of holder* **Organisation Mondiale de la Propriété Intellectuelle  
 Ch. des Colombettes, 34, CH-1202 Genève (Switzerland)**  
*State of which the holder is a national* **Switzerland**  
*Legal nature of the holder (legal entity) and place of organization* **UN Specialised Agency, Geneva, CH**  
*Address for correspondence* **ORGANISATION MONDIALE DE LA PROPRIÉTÉ  
 INTELLECTUELLE, chemin des Colombettes 34, CH-1211  
 GENÈVE 20 (Switzerland)**  
*Name and address of the representative* **OMPI S.R.L., Via Salvo d'Acquisto, 4/A, I-42020 ALBINEA  
 (REGGIO EMILIA) (Italy)**  
*List of goods and services* **9 Machine-readable bibliographic and graphic data media, including magnetic tapes, optical disks, CD-ROM disks for mark documentation; software on magnetic or optical media.  
 35 Services relating to data banks in connection with data relating to marks, namely collection, storage, update, formatting, analysis, archiving, sorting and documentation of data, including information, communications, images, films and documents.  
 38 Services relating to data banks in connection with data relating to marks, namely distribution and delivery of data, including information, communications, images, films and documents.**  
*Basic registration* **Switzerland, 01.04.1993, 402 418**

## Decisions on the Scope of Protection

1059. Where a member is designated, the Office would need to make its decision on the scope of protection. The International Bureau has established templates for all the possible communications the Office may make, where designated. These [Model Forms](#) together with explanations are available on WIPO's website.

### Grounds for Refusal

1060. Each designated member 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 that Convention, and any such refusal will generally be subject to review or appeal, depending upon the laws and practice of the member concerned. [\[Article 5\(1\)\]](#)

1061. The Office of a member may not refuse protection of an international registration on the following grounds:

- on the basis that it covers more than one class, or too many items of goods or services. The Office of a designated member must accept that an international registration may be protected in that member for several classes of goods and services, even when that Office only permits single-class applications under its local practice.
- on formal grounds, as the formal requirements have already been checked by the International Bureau.
- the classification of the goods and services in the international registration, even if the Office disagrees with the classification as approved by the International Bureau.

1062. Where the notification of the designation includes a declaration that the holder wishes the mark to be considered as a mark in standard characters, it is entirely up to each designated member to decide what is the effect of such a declaration.

1063. An Office may object to a term set out in the list of goods and services, considering this to be too broad or too vague. Such objections must be in the form of a provisional refusal. The Office may propose that broad or vague terms be replaced by a narrow or more precise term in the list of the goods and services in the International Register. Where the holder responds to the provisional refusal and accepts the term proposed by the Office, the result would, in effect, be a limitation of protection for that member. For example, if an Office considers the term "computer software" is too broad, it may issue a provisional refusal on that basis. In such a case, it would be helpful if the Office concerned could provide some guidance or suggestions to the holder on how to overcome the refusal, for example, by suggesting the amendment "computer software for logistics, namely, software for tracking documents, packages and freight".

1064. It is important to understand that the list of goods and services is classified in line with the [Nice Classification](#), the edition and version in place at the time of the recording of the international registration. This means that where a member is designated, it must also examine the list following that version and edition. The International Bureau does not reclassify international registrations after their recording. For example, the Office of a member that is subsequently designated in an international registration containing terms classified in class 42, cannot raise a refusal simply on the ground that the indicated services in class 42 fall into different classes following the current Nice Classification version and edition (for example, in classes 43 and 44).

1065. The Office must not advise the holder to contact the International Bureau directly to overcome any grounds for refusal. While it is possible for an Office to raise a provisional refusal on the grounds that a description of the mark is not clear, it is not possible for the holder to request an amendment of the description in the International Register. Any amendment to a description agreed between the holder and the Office concerned may, however, be reflected in the final decision issued by the Office, following its provisional refusal and introduced in the national or regional Register. This principle applies also to other indications, such as color claims and disclaimers.

### **Time Limits for Refusal**

1066. Where the Office finds grounds for refusal, it must notify the International Bureau of a provisional refusal within the prescribed time limit.

1067. The default time limit for an Office to notify the International Bureau of a provisional refusal is one year from the date on which the International Bureau has notified the international registration, or the subsequent designation, to the Office of the designated member. [\[Article 5\(2\)\(a\)\]](#)

1068. However, any member may declare that for international registrations in which it is designated, the time limit of one year is replaced by 18 months (see paragraphs 1299 and 1300). [\[Article 5\(2\)\(b\)\]](#)

### **Notification of Possible Opposition (Model Forms 1 and 2)**

1069. A member may also make the declaration under [Article 5\(2\)\(c\)](#), specifying 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. This would be possible provided that the Office has informed the International Bureau, before the expiry of the 18-month time limit, that oppositions with respect to the international registration may be filed after the expiry of the 18-month period. Furthermore, the notification of provisional refusal based on an opposition must be notified 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. If the time limits are not met, the provisional refusal based on an opposition will be disregarded. [\[Article 5\(2\)\(c\)\]](#) [\[Rule 16\(1\)\]](#)

1070. Many Offices have selected an option in their IT system, which automatically generates an alert for each international registration that has reached, for example, month 15 after the date of notification of the designation by the International Bureau, without the Office having issued a statement under [Rule 18ter](#).

1071. Offices need to bear in mind that a declaration made under [Article 5\(2\)\(b\) and \(c\)](#) would not have any effect in the mutual relations between members that are members of both the Agreement and the Protocol. This means that where both the member of the Office of origin and the designated member are bound by both treaties, the time limit for the notification of a provisional refusal is one year, notwithstanding that the designated member in question may have declared an extended period for notifying a provisional refusal. [[Article 9sexies](#)]

1072. The applicable time limit (one year or 18 months) means that an Office that wishes to refuse an international registration in which it is designated, must do so within that time limit; otherwise, the international registration will be deemed protected in its territory. [[Article 4](#)]

1073. This time limit of one year or 18 months only applies to the notification of provisional refusal. There is no time limit for the Office to notify the International Bureau of its final decision.

1074. 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-month period, it must, where the dates on which the opposition period begins and ends are known, indicate those in the communication. Depending on whether the dates of a future opposition are known or not, the Office may use [Model Form 1 or 2](#). Where the dates are not yet known, for example, it is not clear whether the international registration will be published for opposition, [Model Form 1](#) (information relating to possible oppositions) should be used. Later, when the dates are known (when the Office is preparing to publish the international registration for opposition), the Office should submit [Model Form 2](#) (dates on which opposition period begins and ends), informing of the start and end date of the opposition period. Where it is possible to extend the opposition period, it is sufficient to indicate the start date only of the opposition period. The Office must keep in mind the absolute time limit to notify of a provisional refusal based on opposition set out in [Article 5\(2\)\(c\)\(iii\)](#). 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](#). The Gazette can be accessed by [Madrid Monitor](#). [[Rule 16\(1\)\(b\) and \(2\)](#)] [[Rule 32\(1\)\(a\)\(ii\)](#)]

1075. Provided the Office has notified the International Bureau of a possible later notification of provisional refusal based on opposition under [Rule 16](#), the Office may notify such provisional refusal after the end of the 18-month period. The following example illustrates the operation of these provisions:

- *An international registration (IR) designates a particular member in respect of goods (X + Y + Z).*
- *Upon examination, the Office considers that the IR should be refused protection for some of the goods concerned (X + Y), but may be protected for the remaining goods (Z). Nine months after the date on which the notification of the designation was sent to it, the Office issues a notification of provisional refusal concerning goods (X + Y). This notification states that the holder should inform the Office within six months if they wish to request a review of this refusal; it also informs that, once this issue has been resolved, there is a possibility of an opposition being filed later by a third party, even if this is after the end of the period of 18 months from the notification of the designation. The notification also states that if the holder does not respond within this period of six months, the IR will be regarded as protected in the member concerned for goods (Z), but refused for goods (X + Y), and if so, 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.*

1076. This example is merely indicative. Many variants are possible, and the details will of course vary depending on the legislation of each member.

1077. In summary, upon the expiry of one year, the holder will know whether the international registration is protected in a given member, or whether there is a possibility that protection will be refused and, if so, for what reasons, in the following situations:

- for all designations where the designated member has not made a declaration extending the refusal period to 18 months; and
- for all designations where the designated member has made a declaration extending the refusal period to 18 months, but the member through which the holder was entitled to make that designation and the designated member are both party to the Agreement and the Protocol (see also paragraphs 93 to 101). [[Article 9sexies\(1\)\(b\)](#)]

1078. In respect of any designation where the member has made the declaration extending the time limit to 18 months, and where [Article 9sexies](#) is not applicable, the holder will know, upon the expiry of 18 months, whether the international registration is protected in that designated member, or whether there is a possibility that protection will be refused and, if so, for what reasons. Where that designated member has also made the declaration allowing for the possibility of notifying a provisional refusal based on opposition after the period of 18 months, the holder will know, after the expiry of 18 months, whether there is a possibility that oppositions may be filed at a later stage.

1079. 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 member, then the following statement to that effect will appear on the [Madrid Monitor](#) database: “The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)”.

## Procedure for Refusal of Protection

### *Notification of Provisional Refusal of Protection*

1080. The Office concerned must notify the International Bureau of the provisional refusal. The notification must contain details of the international registration concerned and be in the language of communication opted for by that Office; English, French or Spanish. [\[Rule 6\]](#)

1081. The International Bureau has made available [Model Forms](#) for notification of provisional refusal – [MF3A](#) or [MF3B](#).

1082. The notification must state the grounds on which the Office considers that protection cannot be granted (“*ex officio* provisional refusal”), or that protection cannot be granted because an opposition has been filed (“provisional refusal based on an opposition”), or both. It must also include a reference to the corresponding provisions of the relevant law. Finally, it must be clear whether the provisional refusal concerns all goods and services covered by the international registration or, an indication of the goods that are affected, or not affected, by the provisional refusal.

1083. If the grounds for refusal concern an earlier conflicting mark, the Office must also provide all details of 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). For example, if the Office in Norway issues a notification of provisional refusal based on an earlier right, the details of that earlier right may be in Norwegian.

1084. A notification of provisional refusal must relate to only one international registration. [\[Rule 17\(1\)\]](#)

1085. The Office must transmit the notification of the provisional refusal to the International Bureau, which will forward this to the holder. The holder should be given a time limit to respond to the provisional refusal, and the details of to which authority to file that response. If a local representative is required to file the response, this should also be indicated. Offices should set a reasonable time limit to allow the holder sufficient time to make a decision, whether to contest the refusal, and if so, to also appoint a local representative to act on their behalf before the Office. The time limit should be minimum two months, preferably calculated from the date the International Bureau sends the provisional refusal to the holder. The Office should bear in mind that the International Bureau would need to examine the provisional refusal received from that Office, before forwarding this to the holder. Where the provisional refusal is in order, the International Bureau will record this in the International Register and notify the holder by transmitting a copy to the holder. Where the Office provides a short time limit, calculated from the date of its decision, the holder would have very little time to consider the provisional refusal. In a worst case scenario, this could even result in the time limit to respond being missed and rights being lost.

1086. The Office should state all the relevant grounds for refusal in the notification of provisional refusal. The Office cannot add more grounds later; this should only be done in exceptional circumstances, and only where it is possible to submit a new notification of provisional refusal covering all the relevant grounds still within the applicable time limit for refusal.

1087. 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 member concerned. These are likely to be different from the requirements for the appointment of a representative before the International Bureau. The Office should therefore provide as much information as possible, to make it simple for the holder to find an appropriate representative. For example, where the Office has a list of approved agents or attorneys on its website, then the Office should add a link to this site or provide information on where to find that list.

### ***Total or Partial Refusal***

1088. If the Office wishes to notify the International Bureau of a provisional refusal, it must make it clear whether this is a total or partial refusal. Whether the refusal is total or partial depends on whether the holder is required to respond to the provisional refusal or not. In most cases, a provisional refusal will be total.

### **Total Provisional Refusal**

1089. A total provisional refusal is where the holder is required to respond to the refusal, and if they do not respond, the designation will be considered abandoned – even where the grounds of the refusal only apply to some of the goods and services, i.e., if the holder does not respond to the provisional refusal, the international registration is refused in its entirety (i.e., totally).

1090. The Office should use [Model Form 3A](#) (MF3A) to notify the International Bureau of a decision to refuse protection of the international registration for all goods and services in its territory, following *ex officio* examination (*ex officio* provisional refusal), opposition (provisional refusal based on opposition), or both. Where the provisional refusal is based on an opposition, alone or also on grounds raised *ex officio* by the Office, the Office must provide the name and address of the opponent. Where the *ex officio* provisional refusal is based on an earlier mark or where the opposition is based on an earlier mark, the information required may be given by attaching a printout from the register or database. See paragraphs 1069 to 1079 for further information on a provisional refusal based on opposition.

1091. When completing the MF3A, the Office should provide as much guidance to the holder as possible.

### **Example of Total Provisional Refusal**

1092. The below extract from MF3A illustrates an example of total provisional refusal.

*The international registration (IR) covers classes 1, 5 and 30. The Office has refused protection, stating that the IR is considered descriptive for goods in class 30. The holder must respond to the provisional refusal within a set time limit. If the holder does not respond to the provisional refusal, the IR will be refused in its entirety and the designation in that member would be abandoned. This would be a total provisional refusal.*

**IV. Information concerning the type of provisional refusal:**

Please indicate the type of refusal by checking **only one** of the following options:

- Total provisional refusal based on an *ex officio* examination.
- Total provisional refusal based on an opposition.
- Total provisional refusal based on both an *ex officio* examination and an opposition.

Where the refusal is based on an opposition or on both an *ex officio* examination and an opposition, please indicate:

- (i) Name of the opponent:
- (ii) Address of the opponent:

**V. Information concerning the scope of the provisional refusal:**

**The provisional refusal affects all the goods and services.**

**VI. Grounds for refusal (where applicable, see item VII):**

**The mark is considered descriptive in respect of the goods covered in class 30.**

**Partial Provisional Refusal**

1093. A partial provisional refusal is where the Office finds grounds for refusal, but does not require the holder to respond in order for the Office to (partially) proceed with the designation in respect of some of the goods and services, or with some other condition. This could be where the Office finds grounds to refuse protection, for example, for one out of the three classes covered by the international registration, and it informs the holder that in case no request for review is submitted within the given time limit, the Office will publish the international registration for opposition with the two acceptable classes. The holder wishes to proceed with the international registration for the two classes that have not been refused, rather than invest in contesting the decision. In this case, the Office would proceed with publication of the mark for opposition once the time limit to respond has expired. The Office may also wish to issue a partial refusal following a proposal for a clarification of a condition, for example, where the Office has proposed a disclaimer and the holder is happy to proceed with the proposed disclaimer (see paragraphs 418 and 1101, concerning conditional acceptance).

1094. The Office should use [Model Form 3B](#) (MF3B) to notify the International Bureau of a decision to refuse protection of the international registration for only some of the goods and services in its territory, following *ex officio* examination (*ex officio* provisional refusal), opposition (provisional refusal based on opposition), or both. Where the provisional refusal is based on an opposition, alone or together on grounds raised *ex officio* by the Office, the Office must provide the name and address of the opponent. The Office must provide a clear indication of the goods and services that are affected or those that are not affected. Where the *ex officio* provisional refusal is based on an earlier mark or where the opposition is based on an earlier mark, the information required may be given by annexing a printout from the register or database.

1095. When completing the MF3B, the Office should provide as much guidance to the holder as possible. Please see below extracts of MF3B for guidance.

*Example of Partial Provisional Refusal*

*The international registration (IR) covers classes 3, 18 and 25. The Office has refused protection for the IR for goods in class 3 due to an earlier mark. The holder is not required to respond to the provisional refusal unless they wish to contest the provisional refusal of the mark in class 3. The holder chooses not to respond, and the Office allows the mark to proceed to publication for opposition for goods in classes 18 and 25. This would be a partial provisional refusal.*

**IV. Information concerning the type of provisional refusal:**

Please indicate the type of refusal by checking **only one** of the following options:

- Partial provisional refusal based on an *ex officio* examination.
- Partial provisional refusal based on an opposition.
- Partial provisional refusal based on both an *ex officio* examination and an opposition.

*Where the refusal is based on an opposition or on both an *ex officio* examination and an opposition, please indicate:*

- (i) Name of the opponent:
- (ii) Address of the opponent:

**V. Information concerning the scope of the provisional refusal:**

*Please indicate the scope of the refusal, by choosing one of the two listed options below and, where applicable, list the relevant goods and services:*

- The provisional refusal affects only the following goods and services (*list the goods and services that have been refused*):

All goods in class 3.

- The provisional refusal does NOT affect the following goods and services (*list the goods and services that have not been refused*):

**VI. Grounds for refusal (where applicable, see item VII):**

The mark is refused in respect of class 3 on the basis that it is similar to an earlier registered trademark (detailed below).

**IX. Information relating to the possibility to request a review, file an appeal or otherwise respond to the opposition:**

- (i) Time limit to request a review, file an appeal or otherwise respond to the opposition:

3 months.

- (ii) Calculation of time limit (*the time limit runs from*):

From the date of the notification of the refusal sent to the holder by the International Bureau.

- (iii) Authority to which such request for review, appeal or response should be made:

The IP Office.

- (iv) Whether the request for review, appeal or response has to be filed in a specific language or through a local representative:

A local representative is required to represent the holder before the Office.

- (v) Other requirements, if any:

If no response is filed by the deadline referred to above in (ii), the Office will proceed with the publication of the international registration for opposition purposes in respect of classes 18 and 25 only.

### ***Provisional Refusal Based on Opposition***

1096. Third parties must be given the opportunity to oppose a designation in an international registration in the same way that they may oppose a national application or registration.

1097. It is not mandatory for an Office to republish the international registration. However, where the Office provides for an opposition system, it is recommended that the Office publishes the international registration for opposition; otherwise, it may be difficult for third parties to be aware of these designations.

1098. Where an Office has made the declaration under [Article 5\(2\)\(b\) and \(c\)](#) – extending the time limit to issue provisional refusal based on opposition after the expiry of the 18-month time limit, and it understands that for a given international registration that may be an option (for all international registrations where no decision under [Rule 18ter](#) has been made), the Office must notify the International Bureau of such fact. Such notification under [Rule 16](#) must be made before the expiry of the 18-month time limit. Many Offices have opted to ensure that their IT system automatically generates a notification for each international registrations where it is designated and it has reached, for example, month 15 after the date of notification of the designation by the International Bureau, without the Office having issued a statement under [Rule 18ter](#). The Office may use [Model Form 1](#) or [Model Form 2](#) depending on whether the dates of a future opposition is known or not (see paragraph 1069).

1099. If an opposition is filed before the Office, the Office must notify the International Bureau of a provisional refusal based on an opposition. At this stage, the Office may not yet have examined the opposition to see whether it has merits, but simply puts all the relevant information from the opposition in a notification of provisional refusal based on opposition. It is important to note that some Offices will only notify of a provisional refusal based on opposition where it finds that the stated grounds have merits. Depending on whether the provisional refusal is total or partial (see above), the Office should use [Model Form 3A](#) or [3B](#).

1100. Where the provisional refusal of protection is based on an opposition, or on an opposition and on other grounds, the notification must indicate that fact. The notification, in addition to the other information mentioned above, must 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 provide 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). [\[Rule 17\(3\)\]](#)

### ***Conditional Acceptance***

1101. At the national or regional level, the Office may decide on conditional acceptance, meaning that if the applicant accepts certain conditions, for example, a specific disclaimer, the mark will be accepted for publication for opposition or for registration. Where the Office finds that a given condition is required, it must notify the holder of such condition in a provisional refusal. Unless the international registration can be fully accepted as it is, the Office must issue a provisional refusal. Where, for example, the holder is required to accept a specific disclaimer to overcome the provisional refusal, the Office should indicate the disclaimer in the section “Other requirements, if any”. Depending on whether the holder is required to respond to the proposed disclaimer or not within the given time limit (i.e., whether it is a total or partial provisional refusal), the Office would need to issue a final decision on the scope of protection (see paragraphs 1127 to 1155).

### ***Transmittal of the Notification of Provisional refusal***

1102. The Office must transmit the notification of provisional refusal to the International Bureau following its usual means of communication (xml data to the FTP or SFTP server or through the [MOP](#)) (see paragraphs 860 to 867).

### ***Recording and Publication of the Provisional Refusal***

1103. The International Bureau will examine the notification of provisional refusal to ensure it complies with the formal requirements. If it is in order, the International Bureau will record the provisional refusal in the International Register, together with an indication of the date on which the notification was sent (or is regarded as having been sent).

1104. The provisional refusal is 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 member 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. [\[Rule 17\(4\)\]](#) [\[Rule 32\(1\)\(a\)\(iii\)\]](#)

### ***Notifying the Holder of the Provisional Refusal***

1105. The International Bureau transmits a copy of the notification to the holder, on behalf of the Office concerned. It also transmits to the holder any information sent by the Office of a designated member 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. [\[Rule 16\(2\)\]](#) [\[Rule 17\(4\)\]](#)

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

1106. 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 International Bureau will not translate the provisional refusal, 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 member. 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). [\[Rule 6\(2\), \(3\) and \(4\)\]](#)

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

1107. When the International Bureau receives a notification of provisional refusal, it will examine it for formalities.

1108. There are three categories of irregularities for refusals; those that are irregular, but will be recorded; those that are irregular, but cannot be recorded; and those that are irregular and cannot be considered as such by the International Bureau.

### **The Provisional Refusal Is Not Considered as Such**

1109. A notification of provisional refusal will be disregarded by the International Bureau if it is missing the international registration number, the grounds for opposition, or it was sent in too late (i.e., after the relevant time limit). [[Rule 18\(1\)\(a\) and \(2\)](#)]

1110. This is the most severe irregularity. In this case, the Office would need to send a new notification (without irregularities) provided that it still has time to do so (i.e., it is still within the one year or 18-month time limit set out in [Article 5\(2\)](#). If the time limit has expired, then the principle of *tacit acceptance* applies, meaning that in the absence of a refusal, protection is deemed granted.

1111. The International Bureau will transmit a copy of the notification to the holder and inform them (and at the same time the Office that sent it) that the notification of refusal has been disregarded and the reasons why it has been disregarded. [[Rule 18\(1\)\(b\) and \(2\)\(c\)](#)]

### **The Provisional Refusal Is Irregular and it Is Not Recorded**

1112. Where the notification does not contain 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. This type of irregularity causes a delay in the recording of the notification of the provisional refusal, as the Office will be given a time-limit to remedy the irregularity. In these cases, if the Office sends a rectified notification within the two-month period referred to in the irregularity notice, the International Bureau will, for the purposes of [Article 5\(2\)](#) 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 Protocol, a rectified notification, which is sent within the two-month time limit mentioned in the notice, will be regarded as having met the requirements of that provision. If, however, the Office does not rectify its notification within this two-month time limit, 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\(1\)\(d\)](#)]

1113. 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\(1\)\(e\) and \(f\)](#)]

1114. The International Bureau will send a copy of any rectified notification to the holder.

### **The Provisional Refusal Is Irregular but it Is Recorded**

1115. Except in the circumstances referred to in paragraph 1112, the International Bureau will record a provisional refusal if it is irregular, but will invite the Office to rectify the 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\(1\)\(c\)](#)]

1116. This is the least severe irregularity; although the Office is invited to rectify its notification it is not obliged to do so as the provisional refusal has been recorded in the International Register. However, rectifying this would be helpful for the holder. Where rectified, the International Bureau will record the rectified provisional refusal and transmit a copy to the holder. Examples of the irregularities falling into this category include:

- the indication of the goods and services that are affected, or not affected, by the provisional refusal is missing;
- the notification does not contain a reproduction of a conflicting earlier mark;
- details relating to the earlier mark, including the name and address of its owner are missing.

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

1117. 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 paragraph 1111), they have 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 member concerned, subject to the same procedures as would apply to an application for registration filed with the Office of that member. [\[Article 5\(3\)\]](#)

1118. If the holder receives a notification provisional refusal they would need to consider whether they wish to proceed with the designation in the member concerned and whether they need to file a response with that Office. Therefore, the Office needs to be very clear in this regard. In most cases, the holder would need to instruct a local representative. All communications following the notification of provisional refusal will be conducted between the local representative and the Office. When the matter has been concluded and the Office is ready to mark a decision, it must inform the International Bureau of that decision and provide details of the scope of protection of the mark in the member concerned under [Rule 18ter\(2\) or \(3\)](#). See more on this below, in paragraphs 1127 to 1146.

### ***Status of an International Registration in a Designated Member***

1119. [Rules 18bis and 18ter](#) concern the status of an international registration in a designated member, and the types of communications to the International Bureau by an Office in such regard.

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

1120. An Office which has not communicated a notification of provisional refusal may, within the applicable time limit, notify the International Bureau 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 also indicate the date by which such oppositions or observations may be filed. [\[Rule 18bis\(1\)\(a\)\]](#)

1121. An Office, which has notified a provisional refusal, may send a statement to the effect that the *ex officio* examination has been completed but indicating that the protection of the mark is still subject to oppositions or observations by third parties. Equally, in this statement, the Office should indicate the date by which such oppositions and observations may be filed. [[Rule 18bis\(1\)\(b\)](#)]

1122. The notification of interim status of a mark is optional. It is provided only for informational purposes and has no binding effect on national procedural law. It is up to the Office concerned to decide whether it wishes to provide holders with such interim status. The International Bureau records any statement received under [Rule 18bis](#) in the International Register, informs the holder of the international registration concerned, and, where the statement was communicated or can be reproduced in the form of a specific document, transmits a copy of that document to the holder.

1123. An Office of a designated member, which has sent a statement under [Rule 18bis](#) to the International Bureau must, in due course, either send 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, send to the International Bureau a statement in accordance with [Rule 18ter](#).

1124. If the Office does not follow-up, by notifying a provisional refusal or a statement of grant of protection under [Rule 18ter\(1\)](#), the principle of *tacit acceptance* prevails, and the international registration is deemed protected in the member concerned.

### **Model Form 8**

1125. The Office should use [Model Form 8](#) to notify the International Bureau of such interim status; that an *ex officio* examination has been completed without finding any grounds for refusal, but where protection of the international registration is still subject to opposition or observations by third parties. This form can also be used when a notification of provisional refusal has been previously communicated.

1126. The Office must further notify the International Bureau under [Rules 17 or 18ter](#), preferably using Model Forms 3, 4 or 5, depending on the situation:

- Where an opposition is filed, the Office should notify of a provisional refusal based on opposition under [Rule 17](#) (using [Model Form 3A](#) or [3B](#)), depending on whether the provisional refusal is total or only partial.
- Where no opposition is filed, the Office should notify of a statement of grant of protection under [Rule 18ter\(1\)](#) (using [Model Form 4](#)), or notify of a statement of partial or total grant of protection following a provisional refusal under [Rule 18ter\(2\)](#) (using [Model Form 5](#)).

### ***Final Status of the International Registration***

1127. The Office of a member designated in an international registration is required to send a statement to the International Bureau informing it of the final status of a mark in the member concerned, as soon as all the procedures concerning the protection of the mark before this Office have been completed. [[Rule 18ter](#)]

1128. 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

1129. Where an Office of a designated member has completed all its procedures and finds no ground to refuse protection of the mark, that Office must, as soon as possible, and before the expiry of the applicable refusal period, send to the International Bureau a statement to the effect that protection is granted to the mark.

1130. This means that the Office must have performed, where applicable, its *ex officio* examination without finding any grounds for refusal and published the mark for opposition without any opposition from third parties being filed, i.e., the Office is ready to grant full protection to the international registration. Ideally, such statement should be notified to the International Bureau before the expiry of the applicable time limit of one year or 18 months.

1131. While such statement is obligatory where the conditions are met, 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 Protocol, the mark is automatically protected in the member concerned, for all the goods and services in question. This principle of *tacit acceptance* applies. [[Rule 18ter\(1\)](#)]

1132. Where the Office is a member that requires the holder to pay the individual fee for its designation in two parts, the sending of a statement of grant of protection will be subject to payment of the second part of the fee. [[Rule 34\(3\)](#)]

#### Model Form 4

1133. It is recommended that the Office use [Model Form 4](#) to notify the International Bureau of such statement of grant of protection; that it has completed all its procedures and has found no ground to refuse protection before the expiry of the refusal period applicable under [Article 5\(2\)](#). Since protection is granted to the mark for all the goods and services listed in the international registration, the Office should not list the goods and services in this form.

1134. Model Form 4 should only be used where the Office has not already sent a notification of a provisional refusal. Where the Office has previously sent a provisional refusal, it must send a statement regarding the final decision on the status of protection of the mark, using either [Model Form 5](#) (Statement of Total or Partial Grant of Protection Following a Provisional Refusal) or [Model Form 6](#) (Confirmation of Total Provisional Refusal). See more on these Model Forms below, paragraphs 1139 and 1140.

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

1135. Where the Office has already notified the International Bureau of a provisional refusal, it must then later follow-up with its final decision. Such final decision could be following responses from the holder or their local representatives in line with the procedures set out in the domestic legislation. Where the Office has issued a provisional total refusal, it may confirm such total refusal or grant total or partial protection. However, where the Office has issued a provisional partial refusal, the final decision cannot confirm a total refusal.

1136. Once it has completed all its procedures, the Office may make its final decision. It is important to distinguish the procedures open to the Office and the procedures that may concern another judicial body, such as the Board of Appeals or the courts. Once the Office has completed the procedures it has full control over, it should make its final decision.

1137. Unless it confirms a total provisional refusal (see paragraph 1140), the Office of a member, that has issued a notification of provisional refusal must, once all procedures before the said Office have been completed, send to the International Bureau either: [\[Rule 18ter\(2\)\]](#)

- statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the member concerned, for all goods and services for which protection has been requested or [\[Rule 18ter\(2\)\(i\)\]](#)
- a statement indicating the goods and services for which protection of the mark is granted in the member concerned [\[Rule 18ter\(2\)\(ii\)\]](#)

1138. Again, where a holder has designated a [member that has required that the fee for the international application is payable in two parts](#), the sending of a statement of grant of protection will be subject to payment of the second part of the fee. [\[Rule 34\(3\)\]](#)

#### Model Form 5

1139. It is recommended that the Office uses [Model Form 5](#) when it has previously notified the International Bureau of a total or partial provisional refusal (using [Model Form 3A](#) or [3B](#)), and, after having completed all its procedures, it has now decided to grant protection to some or all of the goods and services listed in the international registration. If the Office has granted partial protection, it must provide a clear indication of the goods and services that have been granted protection. Where all the goods or services included in a given class are concerned, the indication should read “all goods (or all services) in class X”.

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

#### Model Form 6

1140. Finally, the Office of a designated member, 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 member concerned for all goods and services, send to the International Bureau a statement to that effect. The Office is recommended to use [Model Form 6](#) for this purpose. [\[Rule 18ter\(3\)\]](#)

### **Other Decisions Affecting the Scope of Protection Taken by a Designated Member**

#### ***Further Decisions***

1141. Where the Office has notified the International Bureau of its final decision, the holder may, in line with the domestic legislation, appeal this final decision by the Office, for example, to the Boards of Appeal or the courts.

1142. Where the Office of a designated member, after the mark has been granted or refused protection, becomes aware of a further decision (for example, a decision resulting from an appeal to an authority outside that Office) that affects the scope of that protection, it must send to the International Bureau a further statement indicating the goods and services for which the mark is now protected. Where the decision by the Boards of Appeal or the courts simply confirms the scope as indicated by the Office in its final decision, the Office does not need to notify the International Bureau. It is only necessary to notify the International Bureau where the decision affects the scope as recorded in the International Register, meaning that the scope is either further reduced (more narrow in scope) or extended (the scope is broader).

1143. An authority outside the Office may issue such a decision, for example, following an appeal or other proceedings. The Office may also issue a further decision following the completion of its regular procedures, for example, where there has been a request for reinstatement of rights or *restitutio in integrum*.

1144. While there can be only one final decision, in theory, there can be several further decisions, for example, a further decision by the Boards of Appeal, and where this decision is appealed to the courts, that later decision by the courts may be another further decision. It may also be the case that later on a third party may initiate cancellation actions against a designation in an international registration due to non-use. Following this, where there is a later decision partially cancelling the international registration for some goods and services, that decision should also be notified to the International Bureau as a further decision. [\[Rule 18ter\(4\)\]](#)

### **Model Form 7**

1145. The Office is recommended to use [Model Form 7](#) where there is a further decision, which affects the scope of the protection of the mark, and either one of the following facts has happened:

- the applicable refusal period under [Article 5\(2\)](#) has expired without the Office sending a notification of provisional refusal (*tacit acceptance*); or,
- the Office has sent a statement of total grant of protection ([Rule 18ter\(1\)](#)) (using [Model Form 4](#)); or,
- the Office has sent a statement of total or partial grant of protection following a provisional refusal ([Rule 18ter\(2\)](#)) (using [Model Form 5](#)); or,
- the Office has sent a confirmation of total provisional refusal ([Rule 18ter\(3\)](#)) (using [Model Form 6](#)).

1146. Where the further decision affects some of the goods and services, the Office must provide a clear indication of the goods and services for which the mark is protected. Where all the goods or services included in a given class are concerned, the indication should read “all goods (or all services) in class X”.

### **Recording of Statements Received Under Rule 18ter**

1147. The International Bureau will record any statement received under [Rule 18ter](#) in the International Register and 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 will also be published in the [Gazette](#).

1148. In addition, the International Bureau has made available digitized copies of those statements on [Madrid Monitor](#). [\[Rule 18ter\(5\)\]](#) [\[Rule 32\(1\)\(a\)\(iii\)\]](#)

### ***Invalidation in a Designated Member***

1149. In the Regulations, the term “invalidation” means any decision made by a competent authority (whether administrative or judicial) of a designated member revoking or canceling the effects, in the territory of that member, of an international registration with regard to all or some of the goods or services covered by the designation of that member.

1150. The effects of an international registration may be invalidated for a number of reasons, for example, the holder has not complied with provisions of the law concerning the use of the mark, the mark has become generic or misleading or because it has been established that the mark should have been refused when the designation was originally examined.

1151. Invalidation, by the competent authorities of a member, of the effects of an international registration in the territory of that member may not be pronounced without the holder having, in good time, been afforded the opportunity of defending their 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 member concerned. [[Article 5\(6\)](#)]

1152. The procedures and substantive law governing such invalidation should be the same as for marks registered by the Office of that member. For example, the protection of the mark may be revoked because the holder has not complied with provisions of the law of the member 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.

1153. Where the effects of an international registration are invalidated (in whole or in part) in a member, and the invalidation is no longer subject to any appeal, the Office of that member must notify the International Bureau of the relevant facts, namely: [[Rule 19](#)]

- 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 that are no longer covered or those that are still covered);
- the date on which the invalidation was pronounced and its effective date.  
[[Rule 1\(xixbis\)](#)] [[Rule 19\(1\)\(vi\)](#)]

#### **Model Form 10**

1154. The Office is recommended to use [Model Form 10](#), where the effects of an international registration have been invalidated (including, for example, revoked, annulled or canceled) in its territory in accordance with [Article 5\(6\)](#) and [Rule 19](#), and the invalidation is no longer subject to appeal. However, the holder must have had the opportunity to defend their rights. Where all the goods or services included in a given class are affected, the indication should read “all goods (or all services) in class X”. In all cases, a clear indication of those goods and services that are concerned or those that are not concerned should be provided. The Office should notify not only the date on which the invalidation was pronounced, but also, wherever possible, the effective date of the invalidation.

## Recording of Invalidations

1155. 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 32\(1\)\(a\)\(x\)](#)]

## ***Communications from the Offices of the Designated Members Under Rule 23bis Sent Through the International Bureau***

1156. The Office of a designated member may send to the holder or their representative (through the International Bureau) communications that fall outside of its obligations in the Regulations. This concerns situations where the law of a member does not allow the Office to transmit the communication directly to a holder who has no address for service or local representative in that member concerned. Such communications could, for example, inform the holder that a cancellation action has been initiated in that member concerned and give the holder a time limit to defend their right.

1157. Where any action taken against an international registration results in a decision affecting the rights in that member concerned, the Office would be obliged to notify the holder, under [Rule 18ter\(4\)](#) (further decision) or [Rule 19](#) (invalidation).

1158. The International Bureau transmits the communication to the holder or the recorded representative, without examining its contents or recording it in the International Register. [[Rule 23bis](#)]

## **Notification of Changes and Other Recordings in the International Registration**

1159. One of the benefits of the Madrid System is the ability for the holder to centrally manage their rights directly before the International Bureau and that the various recordings concerning the international registration will have effect in the designated members.

1160. An Office of a designated member may receive the following notifications from the International Bureau concerning updates in the International Register:

- changes in name or address of the holder (see paragraphs 527 to 550);
- changes to the legal nature of the holder ,where the holder is a legal entity (see paragraphs 527 to 550);
- appointment of a representative, or changes of name or address of such (see paragraphs 187 to 217, and 642 to 647);
- restrictions in the holder's right of disposal (see paragraphs 698 to 702);
- restriction of the international registration requested by the holder, such as limitation, renunciation or cancellations (see paragraphs 551 to 596);
- cancellation of the international registration due to ceasing of effect of the basic mark (paragraphs 1034 to 1036);

- renewal of an international registration; the Office of each member designated in an international registration will be notified if the international registration has been renewed or not, in respect of their member; or whether the international registration has not been renewed (see paragraphs 727 to 780).

1161. When notified of the above, the Office needs to take note of the new information. This means updating its Register to reflect the new information. For further information please see Chapter II of this Guide in respect of each update as indicated above.

1162. Where the international registration is cancelled due to ceasing of effect of the basic mark, the holder has a time limit within which they may request transformation of the international right into national or regional right, see more on transformation in paragraphs 817 to 822 and 1245 to 1251.

### **Examination of Notifications of Changes and Other Recordings in the International Registration**

1163. The Office needs to pay particular attention to notifications concerning cancellation (whether voluntary by the holder or due to ceasing of effect of the basic mark) and renunciation, meaning that the mark is no longer protected in that territory. Generally, the Office should not examine or comment on the recordings – which have been made centrally at the International Bureau and concerns the international registration.

1164. However, the following notifications require special attention because in these situations the Office may examine the recordings and notify the International Bureau that such recording is to have no effect in its territory.

- limitations recorded under [Rule 25](#) using the [official form MM6](#) or the [online version](#);
- change of ownership; and
- recording of a license.

### ***Declaration that a Limitation Has No Effect***

1165. The holder may request the recording of a limitation to reduce the list of goods and services in respect of some or all of the designated members. The Office of a designated member, which is notified by the International Bureau of a limitation in the list of goods and services affecting it, may examine the limitation and declare that the limitation has no effect in its territory. [\[Rule 27\(5\)\]](#)

1166. This possibility only applies where the holder has requested the recording of a limitation under [Rule 25](#), that is after the recording of the international registration and not included in the international application or in a subsequent designation. For more information on how to examine limitations presented in the international application or in the subsequent designation, see paragraphs 1057 and 1058.

### Examination of the Limitation

1167. When notified of a limitation, the Office should compare the limited list of goods and services with the main list of goods and services in the international registration, or the list of goods and services that apply to the member of the Office (for example, where the main list has already been restricted due to a previous transaction). See illustration below:

Goods in the main list of the international registration	Compare	Goods in the notification of the limitation
<i>Clothing</i>		<i>T-shirts, shirts and dresses</i>
<i>Wines and spirits</i>		<i>Wines</i>

1168. If the Office is satisfied that the limitation requested by the holder is acceptable, it simply has to take note of the new limited scope of protection.

1169. However, if the Office finds that the limitation is not acceptable, it may declare that the limitation has no effect in its territory. This may be an option for the Office where, for example, it considers that the change requested is not in fact a limitation, but rather an extension of the list, or because the Office has already granted protection to the mark but with a more narrow scope than the limitation as illustrated below:

Goods in the main list of the international registration	Compare	Goods in the notification of the limitation
<i>Clothing</i>		<i>T-shirts, shirts and sandals</i>
<i>Wines and spirits</i>		<i>Alcoholic beverages</i>

### The Effect of the Declaration

1170. The effect of making such declaration is that with respect to the member concerned, the limitation will not apply to the goods and services affected by the declaration. The applicable list of goods and services for that member concerned would be that which follows from the designation (including any previously recorded limitations) or the list following a decision on the scope of protection under [Rules 18ter or 19](#).

### Time Limit to Make Declaration

1171. Where the Office wishes to make such declaration under [Rule 27\(5\)](#), it must send this to the International Bureau before the expiry of 18-months from the date on which that notification of the limitation 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.

1172. The Office can indicate, in the declaration, that the declaration is final and not subject to a review or appeal. However, if an Office states in the declaration that it may be subject to review or appeal, the Office should clearly indicate the time limit for requesting such review or appeal and the authority to which the request must be made, as well as whether it would be necessary to do so through a local representative.

### **Model Form 13**

1173. The Office should use [Model Form 13](#) to notify the International Bureau of a declaration that a limitation (requested under [Rule 25](#)) has no effect in its territory. The Office must state whether the declaration affects all the goods and services that were the subject of the limitation or only some of them. In that latter case, the Office must provide a clear indication of those goods and services that are affected or those that are not affected. Where all the goods or services included in a given class are concerned, the indication should read “all goods (or all services) in class X”.

### **Example of a Declaration That a Limitation Has No Effect**

1174. An international registration covers:

*Class 14: “bracelets; earrings; rings; tie clips; lapel pins; cuff links; watch bands; wrist watches”.*

*On February 1, 2022, the Office was notified of the following limited list:*

*Class 14: “jewelry; pocket watches”.*

*After conducting an examination of the limitation, the Office considers that the limited list is in fact broader in scope than the main list of the international registration (for which they have been designated).*

*The Office has 18 months to declare that the limitation has no effect in its territory. There is no provision in the local law to allow the holder to request a review of the declaration.*

*The Office completes Model Form 13 and forwards this to the International Bureau before August 1, 2023.*

### *Final Decision Following Declaration*

1175. Where the Office provides for a review or appeal of the declaration, and then makes a final decision, it must notify this to the International Bureau, which will record this in the International Register and notify accordingly the holder, the recorded representative or the Office that presented the request to record the limitation. [\[Rule 27\(5\)\(e\)\]](#)

### *Model Form 14*

1176. Where the Office previously has notified the International Bureau of a declaration under [Rule 27\(5\)](#) (using [Model Form 13](#)) and it now wishes to notify the International Bureau of the final decision relating to that declaration, this should be done using [Model Form 14](#). If the final decision changes the scope of the declaration, the Office must provide a clear indication of the goods and services to which the limitation relates. Where all the goods or services included in a given class are concerned, the indication should read “all goods (or all services) in class X”.

### **Recording, Notification and Publication of the Declaration**

1177. Upon receipt of such declaration containing all the relevant information, the International Bureau will record this in the International Register and notify accordingly the party (holder or Office) that presented the request for the recording of the limitation. [\[Rule 27\(5\)\(a\) to \(c\)\]](#)

1178. The relevant information concerning the declaration, or any final decision in respect of such, will be published in the [Gazette](#). [\[Rule 27\(5\)\(d\) and \(e\)\]](#)

### ***Declaration That a Change in Ownership Has No Effect***

1179. Where the International Bureau has received a request for the recording of a change in ownership for an international registration, it will record this in the International Register where it has received all the relevant information.

1180. Where the Office of a designated member concerned has received a notification from the International Bureau informing of the change in ownership affecting it, the Office can accept the change and take note of the information of the transferee as the new holder, or it may need to examine the information contained in the notification provided their legislation has provisions allowing for such examination. [\[Rule 27\(4\)\]](#)

1181. In line with its legislation, the Office of a designated member, 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.

### **Examination of the Change in Ownership**

1182. It is up to the members concerned to determine the effects of the change in ownership, in line with their domestic legislation. The validity of a change in ownership of an international registration in respect of a particular member is governed by the law of that member. In particular, where the change in ownership is for only some of the goods and services, a designated member 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 may be the case where the transferee is a person or a legal entity which, under the law of that member, is not entitled to own marks, or where the law of the member concerned does not allow a transfer which, in its view, would be likely to mislead the public.

### **Time Limit to Make Declaration**

1183. Where the Office wishes to make such declaration, it must send this to the International Bureau before the expiry of 18-months from the date on which that notification of the change in 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, as well as the corresponding essential provisions of the law and whether the declaration is subject to review or appeal.

1184. The Office can indicate, in the declaration, that the declaration is final and not subject to a review or appeal. However, if an Office states in the declaration that it may be subject to review or appeal, the Office should clearly indicate the time limit for requesting such review or appeal and the authority to which the request must be made, as well as whether it would be necessary to do so through a local representative.

### **The Effect of the Declaration**

1185. The effect of making such declaration is that with respect to the designated member concerned, the international registration will remain in the name of the transferor. As far as the parties to the transfer are concerned, the effect of such a declaration is, however, a matter for the applicable national or regional law. [[Rule 27\(4\)\(a\)](#)]

### **Model Form 11**

1186. The Office should use [Model Form 11](#) to notify the International Bureau of a declaration that a change in ownership has no effect.

### **Final Decision Following Declaration**

1187. Where the Office makes a final decision relating to the declaration, it must notify this to the International Bureau, which will record this in the International Register and notify accordingly the party (holder or Office) that presented the request to record the change in ownership and the new holder. [[Rule 27\(4\)\(e\)](#)]

### **Model Form 12**

1188. Where the Office previously has notified the International Bureau of a declaration under [Rule 27\(4\)](#) (using [Model Form 11](#)), and it now wishes to notify the International Bureau of the final decision relating to that declaration, this should be done using [Model Form 12](#).

### **Recording, Notification and Publication of the Declaration**

1189. Upon receipt of such declaration containing all the relevant information, the International Bureau will record this in the International Register and will notify accordingly the party (holder or Office) that presented the request for the recording of the change and the new holder. [[Rule 27\(4\)\(a\) to \(c\)](#)]

1190. 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 paragraphs 633 to 634). This means that for the member making such declaration, the international registration will change – to the same number but with the addition of a capital letter (for example, international registration 1234567 becomes 1234567A).

1191. The declaration, or any final decision in respect of such, will be published in the [Gazette](#). [[Rule 27\(4\)\(d\) and \(e\)](#)] [[A.I. Section 18](#)] [[Rule 32\(1\)\(a\)\(xi\)](#)]

### ***Declaration That the Recording of a Given License Has No Effect***

1192. Where the International Bureau has received a request for the recording of a license for an international registration, it will record this in the International Register together with all the relevant information. It will record the given license to have effect for the indicated members, unless that member has already made a declaration under [Rule 20bis\(6\)\(a\) or \(b\)](#) (see paragraphs 1307 and 1308 for more information).

### Examination of the License Recording

1193. Where the Office of a designated member concerned has received a notification from the International Bureau informing of the recording of a license in respect of that member, the Office can accept the change and take note of the information of the license, or it may need to examine the information contained in the notification provided their legislation has provisions allowing for such examination.

1194. In line with its legislation, the Office of a designated member, which is notified by the International Bureau of the recording of a license, may therefore declare that the recording of a given license has no effect in its territory. [[Rule 20bis\(5\)](#)]

1195. Such a declaration may be made, on a case-by-case basis, where the law of the member concerned recognizes the effects of licenses recorded in the International Register, but there are objections with respect to a particular given license, for example, on the ground that the public could be misled. [[Rule 20bis\(5\)](#)]

### The Effect of Declaration

1196. The effect of making such declaration is that with respect to the designated member concerned, the license will not be considered recorded.

### Time Limit

1197. Where the Office wishes to make such declaration, it must send this 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.

### Model Form 15

1198. The Office should use [Model Form 15](#) to notify the International Bureau of a declaration that a recording of a given license under [Rule 20bis\(5\)](#) has no effect in its territory.

1199. 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. [[Rule 20bis\(5\)\(a\) to \(c\)](#)]

1200. Where the Office indicates, in the declaration, that it may be subject to review or appeal, the Office should clearly indicate the time limit for requesting such review or appeal and the authority to which the request must be made, as well as whether it would be necessary to do so through a local representative.

### Final Decision Following Declaration

1201. 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. [[Rule 20bis\(5\)\(e\)](#)]

1202. Upon receipt of such declaration, the International Bureau will record this in the International Register, as of the date of receipt of a communication complying with the applicable requirements, publish the information in the [Gazette](#) and notify accordingly the party (holder or Office) that presented the request to record the license.

#### **Model Form 16**

1203. Where the Office has previously notified the International Bureau of a declaration under [Rule 20bis\(5\)](#) (using [Model Form 15](#)), and it now wishes to notify the International Bureau of the final decision relating to that declaration, this should be done using [Model Form 16](#).

#### **Recording, Notification and Publication of the Declaration**

1204. Upon receipt of such declaration containing all the relevant information, the International Bureau will record this in the International Register and notify accordingly the party (holder or Office) that presented the request for the recording of the license.

1205. The relevant information concerning the declaration, or any final decision in respect of such, will be published in the [Gazette](#).

#### **Division of an International Registration**

1206. It is possible for the holder to request the division of an international registration before the Office of a designated member, using the [official form MM22](#). This feature in the Madrid System may be useful for a holder, for example, to overcome a provisional refusal, which only concerns some of the classes or some of the goods and services covered by the international registration.

1207. A number of [members have notified](#) the International Bureau that they will not present requests for division to the International Bureau, either because their domestic legislation does not provide for division or their domestic laws are not compatible with [Rule 27bis](#). [[Rule 27bis\(6\)](#)] [[Rules 27bis\(1\) and 40\(6\)](#)].

1208. An Office that has issued a provisional refusal, which only concerns some of the goods and services may, unless it has made the relevant declaration under [Rule 27bis](#), receive a request from the holder to divide the international registration (the parent), to set apart, for example, the refused goods and services to create a new international registration (the divisional registration or the child).

1209. A request for the division of an international registration must be presented to the Office of the designated member (see [form MM22](#)) in respect of which the international registration is to be divided. The request cannot be presented directly with the International Bureau. [[Rule 27bis\(1\)\(a\)](#)]

1210. The Office concerned may examine the request for division of an international registration to ensure that it meets the requirements of its applicable law, before presenting it to the International Bureau. The Office concerned may also request a fee for processing the divisional request. This fee is separate to the fee to be paid to the International Bureau, and would be payable directly with the Office concerned.

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

1211. Where the request complies with the applicable requirements, the division of the international registration will be recorded with the date on which the International Bureau received the request or, where the request was irregular, the date on which the irregularity was remedied. However, the effective date of the divisional registration will be the same as the original international registration. Therefore, it follows that the renewal date of the divisional international registration will also be the same as the original international registration (the parent), and not the recorded date of the request for division. [\[Rule 27bis\(4\)\(a\)\]](#)

1212. Following the recording of division, the International Bureau will create a divisional international registration (the child) for the goods and services specified in the request and with the member concerned as the sole designated member, notify the Office that presented the request and inform the holder. The part which has been divided will be recorded as a separate international registration (the child), which will bear the same number as the parent from which it has been divided, together with a capital letter. The publication in the [Gazette](#) consists of the part of the international registration which has been divided. [\[Rule 27bis\(4\)\(b\)\]](#) [\[A.I. Section 16\]](#) [\[Rule 32\(1\)\(a\)\(viii bis\)\]](#)

1213. Once notified of the recording of the divisional registration, the Office may then issue a grant of protection to the uncontested classes (or goods and services) usually covered by the parent under [Rule 18ter\(2\)](#) leaving the holder free to contest the refused goods usually covered by the child before the Office concerned, without delaying the possible protection for the parent registration. When the Office is ready, it will also need to notify the International Bureau of the final decision for the contested goods and services, most likely covered by the child, under [Rule 18ter\(2\)](#) or [18ter\(3\)](#). A decision taken under [Rule 18ter\(2\)](#) would result in the holder having two international registrations for the same member (i.e., the parent and the child). Whether these registrations can be merged or not at a later stage, would depend on whether the member concerned can accept requests for mergers (see paragraph 1221). If the Office issues a decision under [Rule 18ter\(3\)](#), the holder must be given the rights to contest such decision to a higher authority in line with domestic laws. [\[Rule 18ter\(2\) and \(3\)\]](#)

1214. See paragraphs 648 to 674 for further information on requests for division of an international registration.

### **Merger of International Registrations**

1215. It is possible for the holder to request the merger of international registrations resulting from:

- the recording of a partial change in ownership [\[Rule 27ter\(1\)\]](#); and
- the recording of division [\[Rule 27ter\(2\)\]](#).

1216. It is only possible to merge two or more international registrations that were separated from the same international registration due to a partial change in ownership or a division. It is not possible to merge international registrations that originated as separate international applications.

### ***Merger of International Registrations Resulting from the Recording of a Partial Change in Ownership***

1217. A separate international registration may have been created as a result of a partial change in ownership for some goods and services or some designated members, or it may have been created due to a declaration that a change in ownership has no effect being issued by a designated member.

1218. Where two or more international registrations resulting from a partial change in ownership are recorded in the name of the same holder, that holder may request the International Bureau to record the merger of the international registrations. [[Rule 27\(3\)](#)]

1219. A request for the merger of an international registration resulting from the recording of a change in ownership may be submitted to the International Bureau directly or through the Office of the member of the holder.

1220. When a request for merger meets the applicable requirements, the International Bureau will record the merger of the international registrations concerned, notify the Office that presented the request, and inform the holder. The relevant data are published in the [Gazette](#). [[Rule 27ter\(1\) and \(2\)\(a\)](#)] [[Rule 32\(1\)\(a\)\(viii bis\)](#)].

1221. See paragraphs 675 to 685 for more information on merger of an international registration following a partial change in ownership.

### ***Merger of International Registrations Resulting from the Recording of Division of an International Registration***

1222. A number of members have notified the International Bureau that they will not present requests for merger to the International Bureau ([Rule 27ter\(2\)\(b\)](#) or [Rules 40\(6\) and 27ter\(2\)\(a\)](#)). Any such notification received by the International Bureau is published in the [Gazette](#) and on WIPO's website (declarations made by members). However, where the Office concerned has granted protection to a divisional registration, and such Office allows for merger, the holder may request the merger of international registrations resulting from the recording of division of an international registration. A divisional international registration may only be merged with the international registration from which it was divided. [[Rule 27ter\(2\)](#)]

1223. The request for the merger of international registrations resulting from the recording of division must be presented to the International Bureau on the official [form MM24](#) through the Office that presented the request for division (see also the [Note for filing MM24](#)). [[Rule 27ter\(2\)\(a\)](#)]

1224. When a request for merger meets the applicable requirements, the International Bureau will record the merger of the international registrations concerned, notify the Office that presented the request, and inform the holder. The relevant data are published in the [Gazette](#). [[Rule 27ter\(1\) and \(2\)\(a\)](#)] [[Rule 32\(1\)\(a\)\(viii bis\)](#)]

1225. For the merger of international registrations resulting from the recording of division of an international registration, the child (IR 1234567A) will be merged with the parent (IR 1234567), which will result in only one international registration (IR 1234567).

1226. For more information on merger of international registrations resulting from division, see [Information Notice No. 21/2018](#), available on WIPO's website.

## Replacement of National or Regional Registration by International Registration

### *What is Replacement?*

1227. Replacement is a feature introduced into the Madrid System to alleviate the holder from the burden of having to renew previous national registrations in one or several territories of the Madrid System, later designated in an international registration. This feature was intended to make the centralized management of trademark portfolios under the Madrid System more efficient, as international registrations, under certain conditions, are deemed to automatically replace national or regional registrations in designated members.

1228. The terminology is somewhat misleading as there is no physical replacement in the national or regional Registers, but this feature allows the holder of an international registration to benefit from an earlier date of protection in a jurisdiction covered by an earlier national or regional right. The reference to the international registration being “deemed to replace the national or regional registration” does not mean that the national or regional registration is suspended or otherwise affected. The national or regional registration will remain on the Register of the member concerned, with all the rights attaching to such a registration, unless it is not renewed by the holder.

1229. One international registration may replace more than one national or regional registration. This could be the case where the member concerned used to have a single class system, meaning one national registration could only cover one class of goods and services, whereas the international registration can cover up to 45 classes of goods and services.

### *Conditions of Replacement*

1230. For replacement to take place, the following conditions need to be met:

- both the national or regional registration and the international registration are in the name of the same holder;
- protection resulting from the international registration extends to the member in question;
- goods and services listed in the national or regional registration are also listed in the international registration in respect of that member concerned;
- the extension of the international registration to that member (which may be a subsequent designation) takes effect after the date of the national or regional registration. [\[Article 4bis\(1\)\]](#)

1231. The international registration is deemed to replace the national or regional registration without prejudice to any rights acquired by virtue of the latter (for example, rights resulting from a priority claim or from prior use of the mark).

### ***Coexistence and Goods and Services Listed in the National or Regional Registration***

1232. Offices of designated members cannot refuse protection to the international registration just because there is a prior identical national or regional registration in the name of the same holder. The Office has to acknowledge that both the national or regional registration and the international registration can coexist – until the holder decides to no longer keep the national or regional right in force.

1233. Upon receipt of a request for the Office to take note, the Office should determine whether the required conditions have been met (as listed in paragraph 1230).

1234. The international registration does not need to have an identical list of goods and services as the national or regional registration. The list in the international registration can be broader in scope or it can be narrower but most importantly, there needs to be at least some goods and services that overlap, meaning that the goods and services are covered by the national or regional registration and the international registration. The name of the overlapping goods and services do not need to be the same, but they must be equivalent.

1235. The replacement is deemed to take place when the international registration takes effect in the designated Contracting Party concerned.

1236. Replacement may be total or partial. See paragraphs 836 to 842 for further information and practical examples of replacement. It is up to the holder to ensure whether, in any given case, the conditions under [Article 4bis](#) are actually fulfilled. In other words, provided the conditions have been met, replacement has effect and the possibility of requesting an Office to take note (see paragraphs 830 to 835) of that fact is an option which the holder may elect, or not, to exercise. The holder may benefit from asking the Office to take note particularly in cases of partial replacement, to help ensure that all conditions have been met and to gain a better understanding of the consequences of allowing an earlier national or regional right to lapse where only partial replacement has taken place.

### ***Taking Note of Replacement***

1237. Replacement is automatic and without the Office or the holder needing to do anything. However, the holder may request the Office concerned to take note of the replacement in its Register. This will be especially important where the national or regional right later lapses and eventually may disappear from the national or regional Register. Without the Office taking note of the earlier date, it may not be possible for the holder to alert third parties of this fact. [[Article 4bis\(2\)](#)]

1238. The holder must present the request directly before the Office concerned. The Office may determine whether the holder needs to instruct a local representative, use a local form and whether the Office would need to charge a fee for such request. It would be useful if Offices could include as much information concerning its practice on taking note of replacement in the [Madrid Member Profiles](#) database available on WIPO's website.

1239. The effective date of replacement is the date of the international registration or the subsequent designation.

1240. The Offices should accept requests to take note of replacement as from the date of notification of the international registration or the subsequent designation by the International Bureau. However, some Offices may only accept to receive requests to take note of the replacement once they have granted protection to the international registration concerned.

1241. Before taking note of the replacement, the Office must examine the request to determine whether the conditions under [Article 4bis\(1\)](#) have been met. [\[Rule 21\]](#)

1242. Where the Office has taken note in its Register following such request by the holder, that Office must notify the International Bureau accordingly. [\[Rule 21\(1\)\]](#).

**Model Form 17**

1243. The Office may use [Model Form 17](#), as illustrated below, to notify the International Bureau of the replacement.

<b>I.</b>	<b>Name of the Office:</b>  A Madrid member Office
<b>II.</b>	<b>International registration number:</b>  1234567
<b>III.</b>	<b>Name of the holder:</b>  ABC Company Limited
<b>IV.</b>	<p><b>Information concerning the national or regional registration(s) replaced by the international registration:</b></p> <p>(i) Filing date and number:</p> <p>(ii) Registration date and number: January 27, 2013, 891011</p> <p>(iii) Priority date (if any):</p> <p>(iv) Any other rights acquired by virtue of the national or regional registration (where applicable):</p> <p><input type="checkbox"/> If the replacement concerns several national or regional registrations, check the box and use a continuation sheet giving the above-required information for each registration.</p>
<b>V.</b>	<p><b>Information concerning the scope of the replacement:</b></p> <p><i>Please choose <b>only one</b> of the two options listed below and list, where applicable, the goods and services concerned:</i></p> <p><input checked="" type="checkbox"/> The replacement concerns <u>all</u> the goods and services of the international registration.</p> <p><input type="checkbox"/> The replacement concerns <u>only</u> the following goods and services of the international registration:</p>

**VI. Date and Signature of the Office:**

April 20, 2022

*Office Signature*

1244. Once notified, the International Bureau will record the replacement details in the International Register and inform the holder accordingly. The details of the replacement will also be published in the [Gazette](#), making such information concerning the replacement available to third parties in the national or regional Registers as well as in the International Register. [[Rule 21](#)] [[Rule 32\(1\)\(a\)\(xi\)](#)]

### **Transformation**

1245. Where the International Bureau has cancelled an international registration due to the ceasing of effect of the basic mark, the holder has an option of securing continued protection in the members included in that international registration by transforming this to national or regional rights.

1246. 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 817 to 822. It is not available where the international registration has been canceled at the request of the holder in accordance with [Rule 25](#).

1247. 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 member for the registration of a mark, which was the subject of an international registration designating that member, will be treated by that Office as if it had been filed on the date of the international registration or, where that member 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. [[Article 9quinquies](#)]

1248. The Office should check the following:

- that it was in fact designated in the international registration and that this had effect in the territory – transformation may take place with respect to any of the members in the territory of which the international registration had effect, that is, any of the designated members in respect of which the international registration had not been the subject of a total refusal, invalidation or renunciation; and
- that the holder requests transformation within the time limit – the national or regional application must be filed within three months of the date of the recording of the cancellation of the international registration in the International Register;
- 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 member concerned; and
- the application must comply with the requirements of the applicable law of the member.

1249. Provided the conditions are met, the new national or regional application may be given a new application number by the Office, but the filing date would be the applicable date of the international registration for that member – which would either be the date of the international registration or the date of the subsequent designation.

1250. Apart from the special provisions regarding the 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.

1251. It is up to each member 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, for example, using a specific form through a local representative and payment of fees in local currency. The Office 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.

### **Corrections of Errors in the International Registration**

1252. The holder or Office of a member may request the correction of an error made by the International Bureau or by an Office concerning an international registration. 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, the recorded representative, or of an Office. [\[Rule 28\(1\)\]](#)

#### ***Errors Made by the Holder or the Holder's Representative***

1253. The International Bureau will not correct errors made by the holder or the holder's representative, such as mistakes when indicating the designated members or in the list of goods and services. For example, if an applicant or their representative, indicated AT (Austria) instead of AU (Australia) in the international application in the list of designations by mistake, the designation of AU could only be included in the international registration by way of a subsequent designation. Where the representative has made an error in the holder's name, it would be necessary to request a recording of a change in the holder's details.

#### ***Errors Made by the International Bureau or an Office***

1254. If the International Bureau has made an error, the holder, the recorded representative or an Office may make a request for a correction of that error at any time.

1255. If an Office has made an error, the holder or the Office may request a correction of that error, providing the request is received within nine months from the date the error was published in the International Register. If the holder or the recorded representative requests a correction of an error made by the Office, the error must be confirmed by the Office concerned.

1256. Before proceeding with the correction of an error, the International Bureau must be satisfied that the International Register is in fact incorrect. Its practice is as follows:

- (i) 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;
- (ii) where there is an error made by an Office, such as an error in the list of designated members or the list of goods and services filed with the International Bureau, and the correction of which would affect the rights deriving from the international registration, such error 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. Where the holder or the recorded representative presents the request for correction in this case, the Office will need to verify the error. Given the nine-month time limit, if the holder or the recorded representative believes that an Office has made an error, they should raise the error directly with the Office concerned and the International Bureau as soon as possible. [[Rule 28\(4\)](#)]

1257. The International Bureau may generally amend minor typographical or spelling errors made by an Office, such as, a date or number of the basic mark, provided that such amendments do not impact the rights deriving from the international registration. These types of amendments will be carefully reviewed on a case by case basis, and maybe considered to fall outside the scope of [Rule 28](#).

### ***Form for Requesting a Correction***

1258. The request for the correction of a recording may be presented to the International Bureau on the [MM21 form](#) (see also the [Note for filing MM21](#)). [[Rule 28](#)]

#### **International Registration Number**

1259. The number of the international registration should be indicated.

#### **Reference Number**

1260. If the holder or their representative requests the correction, the WIPO reference number should be indicated. If the Office requests the correction, the WIPO notification number should be indicated.

#### **Description of the Requested Correction**

1261. The details of the error to be corrected should be described.

#### **Presentation and Signature**

1262. The form must indicate who is presenting the form (the holder, the representative of the holder or the Office), and include their signature and e-mail address.

### **Recording, Publication and Notification of Correction**

1263. The International Bureau will carefully examine a request for correction. 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 members in which the correction has effect. In addition, where the Office that has requested the correction is not the Office of a designated member in which the correction has effect, the International Bureau will also inform that Office. The correction is published in the [Gazette](#). [\[Rule 28\(2\)\]](#) [\[Rule 32\(1\)\(a\)\(ix\)\]](#)

### **Refusal Following a Correction**

1264. Any Office that is notified of a correction may reopen its examination of the international registration and 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. [Articles 5 and 9sexies](#) and [Rules 16 to 18ter](#) apply *mutatis mutandis* to the notification of refusal concerning a correction, and, in particular, to the time limit (one year or 18 months) for notifying such a refusal in respect of the corrected part. Such time limit is to be counted from the date of sending the notification of the correction to the Office concerned. This effectively means that a correction “restarts” the time limit for the Office to examine the international registration as far as the correction is concerned and to issue a refusal, where it finds it necessary. [\[Rule 28\(3\)\]](#)

### **No Other Change in the International Register**

1265. No other changes affecting the international registration may be recorded in the International Register. In particular, there is no provision in the legal framework of the Madrid System allowing for an amendment (or alteration) of a mark that is recorded in the International Register. If the holder wishes to protect the mark in a form that differs, even slightly, from the mark as recorded in the International Register, they must file a new international application. This is true even if the mark has been allowed to be changed in the basic mark, where such change is possible according to the law of the member of the Office of origin. This does not necessarily mean that, where the holder is now using the mark in a form slightly different from that recorded in the International Register, it is strictly necessary to file a new international application. The holder may wish to rely on Article 5C(2) of the [Paris Convention](#), according to which the use of the mark in a form that 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 members.

1266. It is not possible to extend the list of goods and services of the international registration. If the holder wishes to protect the mark for additional goods and services, not covered in the main list of the international registration the holder must file a new international application. This is true even if those goods and services were included in the basic mark; that is, they could have been included when filing the international application, but were not.

## CHAPTER IV: BECOMING A MEMBER TO THE PROTOCOL

1267. Any country or intergovernmental organization that is interested in becoming a member of the Protocol, should contact the Madrid Legal Division for more information on the necessary steps to make as well as on what kind of assistance that WIPO may offer.

1268. There is only one formal requirement to become a member and that is that the country concerned is a party to the Paris Convention for the Protection of Industrial Property. [\[Article 14\(1\)\(a\)\]](#)

1269. An intergovernmental organization may, by depositing an instrument of accession, become a party to the Protocol, provided the following conditions are fulfilled: [\[Article 14\(1\)\(b\)\]](#)

- 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 9quater](#) of the Protocol (see paragraphs 151 and 223).

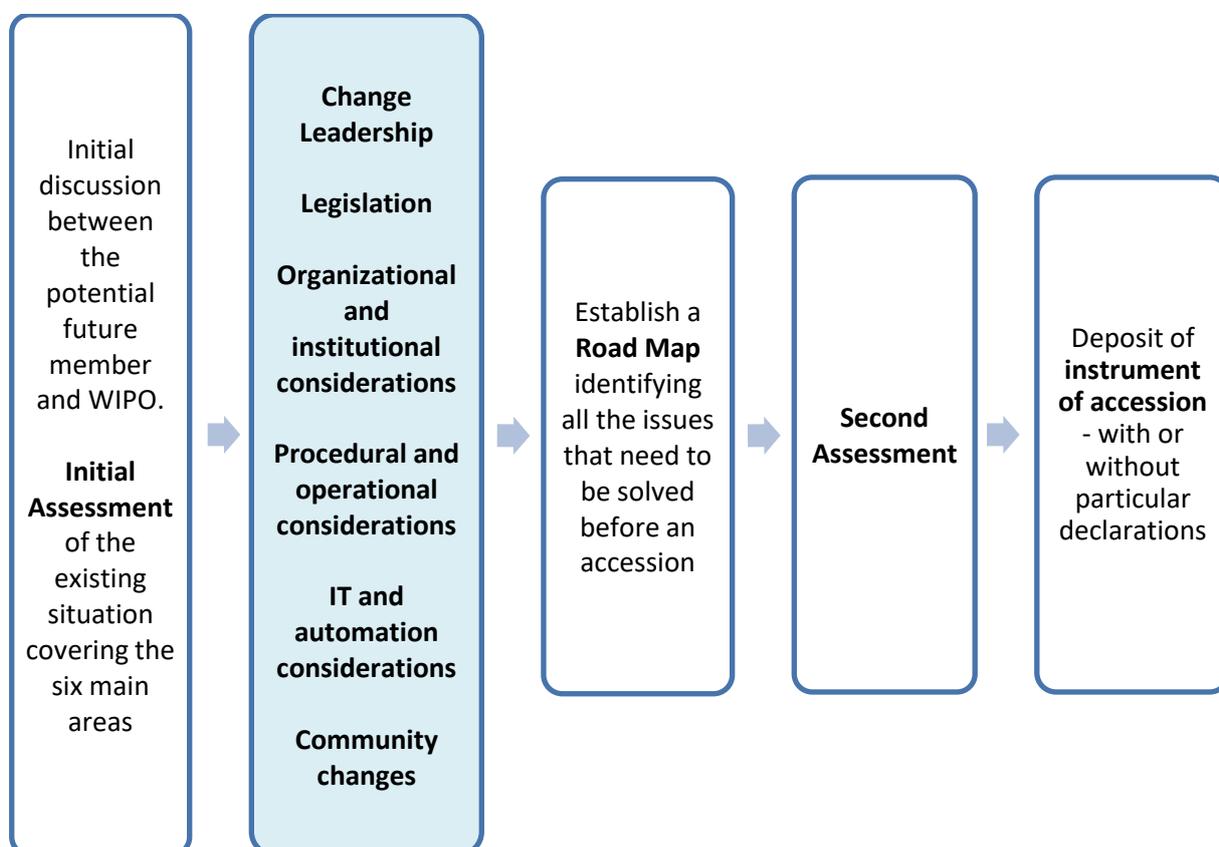
1270. While there is only one formal requirement, there are a number of practical aspects that need to be in place prior to the accession to ensure that the new member will be a fully functioning Office in the Madrid System. The future member must have :

- Madrid-compatible legislation;
- necessary institutional organization;
- operational procedures in place for handling international applications and designations;
- necessary IT set up to handle Madrid matters;
- agreement with the International Bureau on electronic communication of information; and
- received training of staff.

For further details of these practical aspects, see the following paragraphs.

## PREPARATIONS FOR ACCESSION

1271. When a country or intergovernmental organization expresses its intent to join the Protocol, WIPO will begin discussions with government officials on how to best prepare for accession and what kind of assistance would be necessary. The following illustration provides an overview of the preparations for accession.



1272. The first step will consist of an assessment of the existing situation during which WIPO will identify areas of activity that will need to be considered – and possible gaps that would need to be addressed – prior to the deposit of an instrument of accession to the Madrid Protocol.

1273. Preparatory work the potential member will need to undertake, will involve the following six main areas:

- Change leadership;
- Legislation;
- Organizational and institutional considerations;
- Procedural and operational considerations;
- IT and automation considerations;
- Community changes.

## Initial Assessment

1274. An initial assessment can be carried out through WIPO visiting the IP Office concerned for detailed discussions with government officials and technical staff in the Office or Ministry. In this assessment, it will be important for the future member to inform WIPO of a number of important elements, including:

- the political importance of an accession, that is, a determination as to the political will to vigorously support a future accession,
- the situation of local export industry,
- the likely position of local agents,
- political time frame (i.e. upcoming elections), and
- initial thoughts on the timetable for when an accession may take place.

1275. The main purpose of the initial assessment is to determine whether it is in the best interests of the national or regional IP Office to initiate a project to oversee all necessary pre-accession activities, to nominate an "Accession Team" and to establish an accession "Road Map".

## Change Leadership

1276. The IP Office would need to establish a team, comprising key personnel (an Accession Team) to lead the accession initiative, to drive the internal process and to ensure the close follow-up of the Road Map.

1277. The Accession Team should be composed of representatives from various parts of the Office that would be affected by an accession to the Madrid System, such as international cooperation, legal, finance, IT, trademarks operations and administrative support.

## Legislation

1278. It is of great importance that the potential new member has in place functioning trademark legislation, complying with the [Paris Convention](#), and has the capacity to establish legislation which complies with the [Madrid Protocol](#), to provide for the effective operation of the Protocol as well as the enforcement of rights resulting from an international registration.

1279. Madrid-compatible legislation needs to be implemented before the accession takes place. Without such legislation in place, the holders of international registrations will not be able to enforce their rights in the territory concerned. Discussion on legislation will cover the various provisions that are necessary in the national or regional Trademarks Act or their Regulations, and cover a compliance check towards the Paris Convention and the Madrid System.

1280. WIPO can provide the required legal assistance.

## Organizational and Institutional Considerations

1281. A discussion on organizational and institutional considerations will cover the following topics:

- the organization of the national or regional IP Office – current and future under the Madrid System,
- working language(s) of the IP Office,
- overall institutional strength of the IP Office (means of securing its knowledge, documentation of practices, financial autonomy, etc.),
- the staff, their education or background and training needs,
- general information on the examination system in place, its main features and time limits, and the fee structure,
- statistical data, such as the number of trademark applications received per year and information on the origin of these applications, and
- overall industrial property institutional framework (main practitioner and professional associations, educational institutions, user-associations, industry-associations, etc.).

## Procedural and Operational Considerations

1282. The discussion on procedural and operational considerations will focus on the IP Office's domestic trademark registration processes (to ensure they are reliable and consistent), and specifically on how the national or regional procedures and operational transactions can be integrated with the procedures of the Madrid System.

1283. By going through all the relevant tasks that an Office as a member of the Madrid System would be obliged to perform, a common understanding will emerge on how national or regional processes will fit with these Madrid processes.

## IT and Automation Considerations

1284. In the assessment of the actual situation of the IP Office, IT – and automation – is an important aspect.

1285. The status of the current IT system needs to be clear, for both WIPO and the Office, to help to determine whether the system will require modifications to handle international applications and designations through the Madrid System, and how the Office will communicate with WIPO.

## Community Changes

1286. It is important to involve the community, meaning local industry, trademark agents and lawyers and other external stakeholders in the preparations for the accession.

1287. The community would need to possess the appropriate knowledge of what the Madrid System is and how it may affect them, and more specifically, be able to advocate for, use and benefit from the accession to the Madrid System.

### Road Map

1288. The discussions between WIPO and government officials would lead to the establishment of a Road Map, which functions as a plan for the future member on issues and activities that need to be addressed and solved before an accession can take place.

1289. The Road Map should be detailed, and it should identify all relevant issues, activities and persons responsible for carrying out various activities or projects, as well as having a realistic timetable. A detailed [Road Map example](#) is available on WIPO's website.

### Second Assessment

1290. At a time agreed between WIPO and the IP Office, WIPO would undertake a second assessment, also called a desk audit, checking off all the activities, improvements, and identified issues indicated in the Road Map, to ensure that the Office will be an effective and fully functioning member of the Madrid System.

1291. The contents of this second assessment would depend on the elements detailed in the Road Map established by the Office together with WIPO.

1292. As part of the preparations for a future accession, the Madrid Legal Division will assist with assessing the domestic legislation and identify necessary changes as well as provide relevant draft provisions.

### Accession

1293. The instrument of accession would need to be deposited with the Director General of WIPO. The Madrid Protocol will enter into effect three months after the Director General has received the instrument of accession. The Head of State or the Minister of Foreign Affairs of the future member usually signs such instrument of accession.

1294. When depositing the instrument of accession to the Madrid Protocol, the future member has the opportunity to submit [declarations](#), such as extending the time limit for issuing provisional refusals to 18 months (and beyond, for oppositions) and a declaration concerning individual fees.

1295. WIPO will provide relevant information on declarations that can be made together with the instrument of accession or later.

### Further Resources

1296. To further assist prospective members to the Madrid Union, the [Accession Kit: The Madrid System for the International Registration of Marks](#) provides a detailed account of Madrid System features and steps required to prepare for accession:

- advantages of the Madrid System,
- general overview of the Madrid System, its objectives and main features,

- procedures, domestic implications and effects of accession to the Madrid System,
- main actions to be undertaken by an IP Office as party to the Madrid System,
- model instrument of accession to the Madrid Protocol,
- model provisions for implementation of the Madrid Protocol and information concerning declarations made further to the Protocol,
- model implementing provisions,
- principal declarations that may be made in connection with accession to the Madrid Protocol, and
- model forms.

## COMMONLY MADE DECLARATIONS

1297. The Protocol and the Regulations provide for the possibility for members to make certain declarations and notifications concerning the operation of the international registration system.

1298. Details on which Members have made which [declaration](#) are available on WIPO's website.

### Extension of Time Limit for Notifying Provisional Refusal

1299. Any member may declare that the time limit for its Office to notify a provisional 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. [[Article 5\(2\)\(b\) and \(c\)](#)]

1300. A declaration under [Article 5\(2\)\(b\) and \(c\)](#) may be made in the instrument of accession. It may also be made later, in which case it will come into effect three months after its receipt by the Director General of WIPO. [[Article 5\(2\)\(d\)](#)]

### Individual Fees

1301. Any member may declare that, in connection with each international registration in which it is designated (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". Such declaration may be made where the local fees for a 10-year protection period in the country concerned is higher than the equivalent of 100 Swiss francs. It should be discussed with the Madrid Legal Division, to see whether it would be beneficial for the future member to make such declaration. The amount of any such fee must be determined by that member and indicated in the declaration set out in local currency; it may be changed by subsequent declarations. It must not be higher than the fee which the Office of the member would receive for registering that mark for a period of 10 years, or for the renewal of such registration for a period of 10 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 members formality examination, the classification of goods and services, or publication of the internationally registered mark. [[Article 8\(7\)\(a\)](#)]

1302. The declaration concerning individual fees may be made in the instrument of ratification or accession. It may also be made after, in which case it will come into effect three months after its receipt by the Director General of WIPO, 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. [\[Article 8\(7\)\(b\)\]](#)

1303. Where a member has not made a declaration that it wishes to receive an individual fee, it will receive a share in the revenue produced by the supplementary and complementary fees (“the standard fee regime”) (see paragraph 322). By making a declaration that it wishes to receive individual fees, a member agrees to forego such a share. [\[Article 8\(7\)\(a\)\]](#)

1304. An individual fee may be charged only to the extent that its application is not set aside by [Article 9sexies\(1\)\(b\)](#), which would apply where the new member would accede to not only the Protocol but also the Agreement. (see paragraphs 100 and 101).

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

1305. Where a member 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 of WIPO. [\[Rule 7\(2\)\]](#)

1306. Such a notification may be made in the instrument of 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\(3\)\(a\) and \(b\)\]](#)

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

1307. Where the legislation of the Office of a member does not provide for the recording of trademark licenses, it may notify the Director General that the recording of licenses in the International Register has no effect in that member. Such declaration may be made at any time. [\[Rule 20bis\(6\)\(a\)\]](#)

1308. Where the legislation of the Office of a member does provide for the recording of trademark licenses, it may notify the Director General that the recording of licenses in the International Register has no effect in that member. Such declaration may only be made before the date on which the member becomes bound by the Protocol. It may be withdrawn at any time. [\[Rule 20bis\(6\)\(b\)\]](#)

### **Declarations Concerning Division and Merger of an International Registration**

1309. Where the legislation of the Office of a member does not provide for the division of an application for the registration of a mark or of a registration of a mark, it may notify the Director General that it would not present to the International Bureau requests for division of international registrations. Such declaration must be received by the Director General of WIPO before the date on which that member becomes bound by the Protocol. [\[Rule 27bis\(6\)\]](#)

1310. Where the legislation of the Office of a member does not provide for merger of registrations of marks, it may notify the Director General that it would not present to the International Bureau requests for merger of international registrations resulting from division. Such declaration must be received by the Director General before the date on which that member becomes bound by the Protocol. [[Rule 27ter\(2\)\(b\)](#)]

1311. Declarations notified under [Rules 27bis\(6\) and 27ter\(2\)\(b\)](#) may be withdrawn at any time. In such case, holders of international registrations will be able to present requests under [Rule 27bis\(1\) or 27ter\(2\)\(a\)](#), as the case may be, in respect of the member that has notified the Director General the withdrawal of the corresponding declaration.

1312. Any Office of member may, before that member becomes bound by the Protocol, notify the Director General that [Rules 27bis\(1\) and 27ter\(2\)\(a\)](#) are not compatible with the applicable national or regional laws, as the case may be. [[Rule 40\(6\)](#)]

1313. The Rule or Rules that are the subject of a notification under [paragraph \(6\) of Rule 40](#) will not apply to the member that has sent such notification. As a result, holders of international registrations will not be able to present requests under [Rule 27bis\(1\) or Rule 27ter\(2\)\(a\)](#) in respect of that member unless the notification is withdrawn.

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WIPO Publication No. 455E/22  
DOI: 10.34667/tind.45832