

# ACCESSION KIT: THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

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# THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

## ADVANTAGES OF THE MADRID SYSTEM

1. The Madrid system for international registration of marks has advantages for the trademark owner, for national economies and governments, as well as for professionals, like agents and attorney in the field of trademarks.

### Benefits for the Trademark Owner

2. The Madrid system allows companies and individuals to obtain and maintain protection for their marks in an ever-increasing number of countries by means of a simple and economical procedure.

3. International registration has several advantages for the owner of the mark. After registering the basic mark, or filing an application for registration, with the Office of origin, he has only to file one international application, in one language, and pay one fee, in one currency. This simple procedure takes place instead of filing separately in the trademark Offices of the various Contracting Parties, in different languages and paying fees to each Office, in different currencies. Different national/regional procedures, involving different languages and fees payable in different currencies, give rise to translation and exchange-related expenses. Where trademark protection is sought by filing direct to national/regional Offices, most of these Offices require the applicant to appoint a local representative to act on his behalf before the Office, at the time of filing of the application. With the Madrid system, the designated Contracting Parties may only require that the holder appoints a local representative in case the holder has received a notification of a provisional refusal and the holder intends to contest this decision before the Office concerned.

4. The main advantages for trademark owners consist of the simplicity of the international registration system and the financial savings made (expenses related to translation, exchange-related fees and fees for local representatives) when obtaining and maintaining the protection of their marks abroad.

5. The companies most affected by the considerable cost involved in registering and maintaining marks abroad are Small and Medium Enterprises (SMEs). While a large company may afford to devote considerable funds to protect its marks abroad, an SME can ill-afford the registration of marks abroad, due to the high procedural costs. The Madrid system is used by one-third of worldwide applicants seeking protection of their marks through the Madrid system. Of these, about 80 per cent may be categorized as an SME, having a small portfolio of one or two marks.

6. In the current economic context, the possibility of providing easy, low-cost protection for marks provides a welcome advantage for companies and individuals as a factor that will favor exports.

7. Moreover, the holder does not have to wait for the Office of each Contracting Party in which protection is sought to take a positive decision to protect the mark. If no refusal is notified by an Office within the applicable time limit, the mark is automatically protected in the Contracting Party concerned. In some cases, the holder does not even have to wait until the expiry of this time limit in order to know that the mark is protected in a Contracting Party, since he may, before the expiry of the time limit, receive a statement of grant of protection from the Office of that Contracting Party.

8. A further important advantage is that changes subsequent to registration, such as a change in the name or address of the holder, or a change (total or partial) in ownership or a limitation of the list of goods and services may be recorded with effect for several designated Contracting Parties through a single, simple and centralized procedure with the International Bureau of the World Intellectual Property Organization (WIPO) (the International Bureau) and with the payment of a single fee. Moreover, there is only one expiry date and only one registration to renew, which makes for easy portfolio management.

#### Benefits for the National Economy, the Government and Trademark Offices

9. The Madrid system may also be seen as benefiting the national/regional economy in general, and the government's finances, in particular.

10. The Madrid system supports the country's exports to the extent that it simplifies protecting trademarks abroad. Furthermore, it allows individuals and companies established in other Contracting Parties of the Madrid system to have easier access to the protection of their marks in the country/regional territory, since they can seek protection of the mark in any of the applicable Contracting Parties by merely designating these in the international application, or in a subsequent designation. This facility helps to strengthen the climate for foreign investment.

11. International registration is also to the advantage of trademark Offices. The Offices do not need to examine for compliance with formal requirements, or to classify the goods or services, or publish the marks, as such formalities will have already been undertaken by the International Bureau, and they can focus on their substantive examination. Moreover, they are compensated for the work that they perform; the individual fees collected by the International Bureau are transferred to the Contracting Parties in respect of which they have been paid, while the complementary and supplementary fees are distributed annually among the Contracting Parties not receiving individual fees, in proportion to the number of designations made of each of them.

#### Benefits for Professionals Active in the Field of Marks

12. The Madrid system provides an optional, alternative procedure that does not dismantle the traditional route of direct filing. Experience shows that companies and individuals may have a variety of reasons to seek protection for a mark alternatively through a direct national/regional application or through an international application. It is also relevant that applications of foreign origin proceed both from Contracting Parties to the Madrid system and countries that are not members of the Madrid system and that applications originating in Contracting Parties to the Madrid system may continue to be filed directly through a local agent or representative.

13. The overall volume of work for local trademark agents should not be expected to decrease by accession to the Madrid system. The effects of the international registration of a mark, as well as all the procedures to exercise and enforce the rights deriving from that registration, are governed by national or regional law. Trademark agents can expect to engage, in addition to tasks ensuing from the filing of applications, in tasks like searches, responses to objections, raising of objections, requests for annulment or cancellation, dispute settlements, license and assignment contracts, among others. Bearing in mind that the number of marks protected locally would gradually increase as a result of accession to the Madrid system, the overall volume of work for agents should also increase commensurately.

14. Accession to the Madrid system will normally offer local agents novel lines of activity, including advisory and representation work for their clients, in conjunction with the filing of international applications originating locally, as well as representing them thereafter in dealings with the International Bureau for the purposes of the international registration.

## **GENERAL OVERVIEW OF THE MADRID SYSTEM; ITS OBJECTIVES AND MAIN FEATURES**

15. The Madrid system for the international registration of marks is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks (“Agreement”), which dates from 1891, and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“Protocol”), which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. The implementation of the Protocol and the Agreement is governed by Common Regulations and Administrative Instructions, which are updated periodically.

16. The Protocol is a treaty independent of the Agreement. In order to be a party to the Protocol, it is not necessary to be party also to the Agreement.

17. The Protocol and the Agreement govern the system of international registration of marks known as “the Madrid system”. Both treaties have a similar structure and a common aim: to facilitate the protection of marks for goods and services, at the international level, through a simple and economical system of registration.

18. The Madrid system is administered by the International Bureau, whose headquarters are in Geneva. The International Bureau maintains the International Register and publishes the *WIPO Gazette of International Marks* (Gazette).

19. Any State which is a party to the Paris Convention for the Protection of Industrial Property (“Paris Convention”) may become a party to the Agreement or the Protocol, or both. In addition, an intergovernmental organization may become a party to the Protocol (but not the Agreement); see more on “Accession” below (paragraphs 63 to 68).

20. States party to the Agreement and/or the Protocol and intergovernmental organizations party to the Protocol are referred to collectively as Contracting Parties. As of January 2013, the Madrid system has 89 Contracting Parties, of which 88 (87 countries and one intergovernmental organization (the European Union)) are members of the Protocol, and only one country is party to the Agreement alone. For a complete list of Contracting Parties, see: [http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid\\_marks.pdf](http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf).

21. Together, these Contracting Parties constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention. Every member of the Madrid Union is a member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including the fixing of fees connected with the use of the Madrid system.



### Objectives of the Madrid System

22. The objectives of the Madrid system are two-fold. Firstly, it facilitates the obtaining of international protection for marks (trademarks and service marks). The registration of a mark in the International Register produces, in the Contracting Parties designated by the applicant, the effects described below (see paragraphs 47 to 49). Further Contracting Parties may be designated subsequently. Secondly, since an international registration is equivalent to a bundle of national registrations, the subsequent management of that protection is made much easier. There is only one registration to renew, and changes, such as a change in ownership or in the name or address of the holder, or a limitation of the list of goods and services, can be recorded in the International Register through a single simple procedural step. On the other hand, if it is desired to transfer the registration for some only of the designated Contracting Parties, or for some only of the goods or services, or to limit the list of goods and services with respect to some only of the designated Contracting Parties, the system is flexible enough to accommodate this.

### Who May Use the Madrid System?

23. An application for international registration (an “international application”) may be filed only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Agreement or 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.

24. The Madrid system cannot be used by a person or legal entity which does not have the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union. Nor can it be used to protect a mark in the territory of a country outside the Madrid Union.

### The International Application

25. A mark may be the subject of an international application only if it has already been registered (“basic registration”), or if registration has been applied for (“basic application”) in the Trademark Office of the Contracting Party with which the applicant has the necessary connection, through establishment, domicile or nationality. This Office is referred to as the Office of origin. The basic registration or basic application is often referred to as the basic mark.

26. An international application must be presented to the International Bureau through the Office of origin. An international application which is presented direct to the International Bureau by the applicant will not be considered as such and will be returned to the sender.

27. The international application must contain, *inter alia*, a reproduction of the mark (which must be identical with that in the basic registration or basic application) and a list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification).

28. An international application may claim priority under Article 4 of the Paris Convention, whether from the basic application with the Office of origin, or from a prior application filed with the Office of another country party to the Paris Convention, or with the Office of a Member of the World Trade Organization (WTO).
29. An international application must designate the Contracting Parties in which the mark is sought to be protected. The Contracting Party whose Office is the Office of origin cannot be designated in an international application.
30. The designation of a given Contracting Party is made under that treaty (Agreement or Protocol) which is common to the designated Contracting Party and the Contracting Party whose Office is the Office of origin. Where both Contracting Parties are party to both the Agreement and the Protocol, it is the Protocol which governs the designation.
31. An international application can be filed in any one of the three languages of the Madrid system, namely, English, French or Spanish. The Office of origin may, however, restrict the applicant's choice to one only, or to two of those languages, or may permit the applicant to choose between any of the three languages.
32. The international application is subject to the payment of the following fees:
- a basic fee;
  - a complementary fee in respect of each designated Contracting Party for which no individual fee is payable;
  - a supplementary fee in respect of each class of goods and services beyond the third; no supplementary fee is payable however where all the designations are ones in respect of which an individual fee has to be paid.
33. Article 8(7) of the Protocol provides that a Contracting Party may declare that, instead of a share in the revenue produced by the supplementary and complementary fees, it wishes to receive an individual fee. The amount of the individual fee is determined by each Contracting Party; it may not be higher than the amount that would be payable for the registration of a mark at the national level in the Office of that Contracting Party. The amounts of the respective individual fees are published in the Gazette and are also available on the WIPO website.
34. Nevertheless, Article 9*sexies*(1)(b) renders inoperative a declaration under Article 8(7) in the mutual relations between Contracting Parties which are both party to both the Agreement and the Protocol. In other words, where the designated Contracting Party having made the declaration is a party to both the Agreement and the Protocol and the Contracting Party whose Office is the Office of origin is also a party to both treaties, despite the fact that the designated Contracting Party in question has made the declaration requiring payment of individual fee, the supplementary and complementary fees are payable.
35. For international applications filed by applicants whose country of origin is a Least Developed Country (LDC), in accordance with the list established by the United Nations, the basic fee is reduced to 10%.
36. These fees may be paid direct to the International Bureau or, where the Office of origin accepts to collect and forward such fees, through that Office.

37. The Office of origin must certify that the mark being applied for is the same as that in the basic registration or basic application, that any indications, such as a description of the mark or a claim to color as a distinctive feature of the mark, are the same as those contained in the basic registration or basic application, and that the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application.

38. The Office of origin must also certify the date on which it received the international application. This date is important since it will become also the date of the international registration, if the International Bureau receives the international application within two months (and provided that certain crucial elements are not missing).

39. The International Bureau checks that the international application complies with the requirements of the Agreement or the Protocol and the Common Regulations, including requirements relating to the indication of goods and services and their classification, and that the required fees have been paid. The International Bureau will inform the Office of origin and the applicant of any irregularities, which must be remedied within three months; otherwise the international application will be considered abandoned.

40. Where the international application complies with the applicable requirements, the mark is registered and recorded in the International Register and published in the Gazette. The International Bureau then notifies each Contracting Party in which protection has been requested.

#### Examination by the Office of a Designated Contracting Party; Refusal of Protection

41. The Office of a designated Contracting Party examines the international registration in exactly the same way as an application filed directly. If grounds for objection are found during the *ex officio* examination, or if an opposition is filed, the Office has the right to declare that protection cannot be granted to the mark in that Contracting Party. This is referred to as the notification of provisional refusal.

42. Any provisional refusal must be notified to the International Bureau by the Office of the Contracting Party concerned within the time limit specified in the Agreement or Protocol. The standard time limit is 12 months. A Contracting Party may however declare that, when it is designated under the Protocol, this time limit shall be replaced by 18 months. A Contracting Party that has made this declaration may further declare that a provisional refusal based on an opposition may be notified even after the expiry of this 18-month period.

43. Notwithstanding the general principle that the Protocol applies between States both bound by both the Agreement and the Protocol, paragraph (1)(b) of Article 9*sexies* of the Protocol renders inoperative a declaration extending the refusal period in the mutual relations between States both bound by both treaties. What this means, in effect, is that in the case of an international application where the Office of origin is the Office of a Contracting Party bound by both treaties, a designation of a Contracting Party also bound by both treaties will, while being governed by the Protocol, and not the Agreement, nevertheless be subject to the standard refusal regime – that is, the time limit of 12 months for the notification of a provisional refusal, notwithstanding that the designated Contracting Party in question may have declared an extended period for notifying a provisional refusal.

44. The provisional refusal is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

45. Any procedure subsequent to the refusal, such as review, appeal or response to an opposition, is carried out directly between the holder of the international registration and the Office concerned, without any involvement on the part of the International Bureau. However, once all the procedures before that Office have been completed, the Office must send to the International Bureau a final statement. Depending upon the outcome of the case, such statement will confirm either that protection for the mark has been totally refused (Confirmation of Total Provisional Refusal), or that protection has been partially or totally granted to the mark, as the case may be (Statement of Grant of Protection Following a Provisional Refusal). This statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

46. Where, before the expiry of the refusal period, all the procedures before an Office have been completed and the Office has found no grounds to refuse protection, the Office shall, as soon as possible, and before the expiry of the refusal period, send to the International Bureau a statement to the effect that protection is granted to the mark (Statement of Grant of Protection where no Notification of Provisional Refusal has been Communicated). Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration. However, in the absence of communication of a notification of a provisional refusal, and of a statement of grant of protection, the principle remains that a mark is automatically protected in the Contracting Party concerned, for all the goods and services in question, once the refusal period has expired without a notification of provisional refusal having been issued by the Office in question.

#### Effects of the International Registration

47. From the date of the international registration, or in the case of a Contracting Party designated subsequently, from the date of that subsequent designation, the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been the subject of an application for registration filed direct with the Office of that Contracting Party. If no provisional refusal is notified to the International Bureau within the relevant time limit, or if a refusal has been notified and has been subsequently withdrawn, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

48. An international registration is equivalent to a bundle of national registrations. Although it is a single registration recorded in the International Register, protection may be refused by some of the designated Contracting Parties, or protection may be limited or renounced with respect to some only of the designated Contracting Parties. Likewise an international registration may be transferred to a new owner with respect to some only of the designated Contracting Parties. An international registration may also be invalidated (for example, for non-use of the mark) with respect to one or more of the designated Contracting Parties. Moreover, any action for infringement of an international registration must be brought separately in each of the Contracting Parties concerned.

49. This is in contrast to a unitary regional right, such as the Community Trade Mark in the European Union (CTM), which cannot be refused, limited or transferred with effect for a part only of the territory covered by the right, and which may be enforced by a single legal action covering infringement occurring anywhere in that territory.

### Dependence on the Basic Mark and Transformation

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

51. The Office of origin is required to notify the International Bureau of facts and decisions concerning such ceasing of effect or refusal and, where appropriate, to request the cancellation (to the extent applicable) of the international registration. The cancellation is published in the Gazette and notified to the designated Contracting Parties.

52. It is possible, under the Protocol, to avoid further loss of rights by such ceasing of effect as mentioned above, by transforming the rights of an international registration into national/regional applications. If, within three months of such cancellation, the holder files an application for registration with the Office of a Contracting Party that had been designated under the Protocol, that application will be treated as if it had been filed on the date of the international registration, or as the case may be the date of the subsequent designation of the Contracting Party concerned. This option is not available in the case of a Contracting Party designated under the Agreement. This is referred to as transformation.

53. After the expiry of the period of five years from the date of the international registration, the international registration becomes independent of the basic registration or basic application.

### Replacement of a National or Regional Registration by an International Registration

54. An international registration is deemed to replace a national or regional registration for the same mark and the same goods and services recorded in the name of the same person in a designated Contracting Party. The effect of replacement is that, if the national or regional registration is not renewed, the holder of the international registration may continue to benefit from the earlier rights acquired by reason of that national or regional registration. Although replacement takes place automatically, the holder of the international registration may request the Office of the Contracting Party in which the national or regional registration is recorded to take note in its register of the international registration.

### Subsequent Designation

55. The effects of an international registration can be extended to a Contracting Party not covered by the international application by filing a subsequent designation. Thus, the holder of an international registration can expand the geographical scope of the protection of his mark in line with his business needs. This feature of the Madrid system is, perhaps in particular, beneficial to small and medium-sized enterprises (SMEs). Moreover, a subsequent designation may be made in order to extend the protection of the mark to a Contracting Party which was not a party to the Agreement or Protocol at the time of the international application. The principles that determine whether such a designation can be made are as described above (see paragraphs 25 and 26).

### Changes in the International Register; Cancellation; Licenses

56. A change in the name or address of the holder or his representative may be recorded in the International Register upon request.

57. Likewise, a change in the ownership of an international registration may be recorded, in respect of all or some of the goods and services and all or some of the designated Contracting Parties. A person may not, however, be recorded as the new owner of an international registration in respect of a given Contracting Party if he would not be entitled (in accordance with the principles set out, above in paragraphs 25 and 26), to designate that Contracting Party in an international application. Thus, for example, a person who does not have a connection with a country which is a party to the Agreement may not be recorded as the new owner of an international registration in respect of a designated Contracting Party which is a party only to the Agreement.

58. The following may also be recorded in the International Register:

- a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties;
- a renunciation in respect of some of the designated Contracting Parties for all the goods and services;
- a cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;
- a license granted in respect of all or some of the designated Contracting Parties, and for all or some of the goods and services.

59. Information concerning such changes, cancellations and licenses is recorded in the International Register, published in the Gazette and notified to the designated Contracting Parties concerned.

60. No change may be made in the mark that is the subject of an international registration, either on renewal or at any other time. Nor may the list of goods and services be changed in a way that would extend the scope of protection.

### Duration of Registration; Renewal

61. An international registration is effective for 10 years. It may be renewed for further periods of 10 years on payment of the prescribed fees. The International Bureau sends a reminder to the holder and to his representative, if any, six months before renewal is due.

62. The international registration may be renewed in respect of all the designated Contracting Parties or in respect of some only of them. It may not, however, be renewed in respect of some only of the goods and services recorded in the International Register. If the holder wishes, at the time of renewal, to remove some of the goods and services from the international registration, he must separately request cancellation in respect of those goods and services, or request the recording of a limitation, prior to the renewal of the registration.

## **ACCESSION TO THE MADRID SYSTEM**

### Accession Procedures

63. Any State which is a party to the Paris Convention may become a party to the Agreement or the Protocol, or both. In addition, 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.
64. A State or intergovernmental organization may become a party to the Madrid Protocol by depositing an instrument of accession.
65. The instrument of accession must be signed by the Head of State or Government, or by the Minister of Foreign Affairs, in accordance with the country's legal system, and deposited with the Director General of WIPO. Annex I contains a model instrument of accession.
66. The treaty will enter into force three months after the date of deposit of the instrument of accession.
67. The instrument of accession may contain certain declarations. Some declarations can be made only at the time of accession while others may be submitted after the accession. It would therefore be very useful for the potential member of the Madrid system to discuss possible declarations with the International Bureau prior to acceding to the system. For a complete list of possible declarations a Contracting Party may make in connection with accession, please see:  
<http://www.wipo.int/madrid/en/madridgazette/remarks/declarations.html>.
68. The most frequently made declarations are, in particular, the following:
- a declaration that, with respect to each international registration in which the Contracting Party is designated and with respect to the renewal of an international registration, it wishes to receive an individual fee. The amount of that fee, in local currency, must be stated in the declaration, but may be amended by a subsequent declaration.
  - a declaration that, for international registrations in which the Contracting Party has been designated, the period of one year during which its Office must give notification of a provisional refusal of protection will be replaced by a period of 18 months.

### Domestic Legislative or Regulatory Implications

69. The main substantive obligation deriving from accession to the Madrid system will be to give effect to Article 4(1) of the Agreement and the Protocol. Under this provision, a mark registered in the International Register, in which the Contracting Party has been designated, must be protected from the date of international registration (or, in the case of a Contracting Party designated subsequently, from the date of that subsequent designation), in the same way as if that mark had been applied for directly with the national or regional trademark Office. That Office is, however, fully entitled to carry out a substantive examination of the

mark and may, within the period stipulated, refuse to grant protection to the mark (either totally or partially). If the Office does not issue a provisional refusal within the applicable period, the mark is deemed to be protected in the same way as if it had been registered directly with that Office.

70. When acceding to the Madrid system, the country must also be in a position to give full effect to the provisions of the relevant treaty. The International Bureau will provide any necessary advice and technical assistance required for that purpose. One service that is offered to potential members of the Madrid system is to analyze the domestic legislation and provide comments on its compatibility with the Madrid system. Model Provisions have been established to provide information and assistance to these potential members. See Annex II for such Model Provisions.

### Effects of Accession

71. Statistics show that the accession of a country to the Madrid system will gradually produce an increase in the total number of marks for which protection is requested in the country (resulting from combining the number of applications received at the national level and the designations received internationally). This can be explained by the fact that it is relatively easy and economical for the owner of a mark to designate a country/regional territory in an international application.

72. As regards the workload of the national trademark Office, accession to the Madrid system has been seen not to bring an overwhelming number of new applications, but rather a gradual increase in registration activity. Moreover, although the Office should carry out, in respect of the marks filed through the Madrid system, the usual substantive examination, it will not need to carry out the formalities examination, or to publish the mark, since those procedures will already have been conducted by the International Bureau.

## **MAIN ACTIONS TO BE UNDERTAKEN BY AN OFFICE AS PART OF THE INTERNATIONAL PROCEDURE UNDER THE MADRID SYSTEM<sup>1</sup>**

### Introduction

73. With regard to an international application or international registration, an Office may serve, on the one hand, as the Office of origin, the definition of which includes the Office of the Contracting Party of the holder<sup>2</sup>, or, on the other hand, as the Office of a designated Contracting Party.

74. The information below is set out in three parts; Part I concerns an Office as Office of origin, Part II deals with an Office as the Office of a designated Contracting Party, while Part III relates to an Office as the Office of the Contracting Party of the holder.

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<sup>1</sup> The procedures explained in this note are described in detail in Chapter III of Part B “The International Procedure” in the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* (WIPO Publication N° 455). The Guide is also available on the WIPO web site at: <http://www.wipo.int/madrid/en/guide/index.html>.

<sup>2</sup> The “Contracting Party of the holder” is defined as the Contracting Party whose Office is the Office of origin, or where a change in ownership has been recorded, the Contracting Party in respect of which the new holder has the required connection (by means of a real and effective industrial or commercial establishment, domicile or nationality).



## **PART I: MAIN ACTIONS TO BE UNDERTAKEN BY THE OFFICE OF ORIGIN**

### Overview

75. An international application must be based on a basic application or basic registration (“the basic mark”) filed with or registered by the Office of origin, and must be presented to the International Bureau through the Office of origin, of which there can be only one. Moreover, since the international registration is dependent on the basic mark for the first five years of its existence, the Office of origin is required to notify the International Bureau of any relevant changes affecting the basic mark during that period. In addition, various requests may (or, in some cases, must) be presented through the Office of origin.

### Status of “Office of Origin”

76. The Office with which the applicant files an international application must check that it is the correct “Office of origin” within the meaning of Article 1(3) of the Agreement or Article 2(2) of the Protocol. This means ensuring that the necessary connection (by means of a real and effective industrial or commercial establishment, domicile or nationality) has been established, at least on its face, by the applicant, with respect to the Contracting Party concerned. The Office of origin may require the applicant to submit evidence.

### “Basic Mark” in the Country/Regional Territory of Origin

77. The Office of origin must check for the existence of a basic mark, i.e., that the national or regional mark which is the subject of international application has already been filed with it or registered in its national or regional register. If so, the Office of origin must verify that the number of the basic application or basic registration, as the case may be, has been indicated correctly by the applicant in item 5 of the international application form.

### Certification

78. Through comparison between the basic mark and the international application, the Office of origin must certify (in item 13 of the international application form) that the particulars appearing in an international application correspond to the particulars of the basic mark (in particular, that the applicant named in the international application is the same as the applicant or the holder named in the basic mark, that the mark which is the subject of the international application is the same as the basic mark and that the goods and/or services listed in the international application are covered by the goods and/or services appearing in the basic mark).

79. Should there be a discrepancy between the international application and the basic mark in relation to one of the above-mentioned matters, the Office of origin must require the applicant to amend the international application accordingly.

80. The Office of origin must sign this certification in item 13(b) of the international application form.

#### Indication of Date; Forwarding the International Application to the International Bureau

81. The Office of origin must indicate the date on which it received the international application and, in principle, transmit it to the International Bureau within two months from that date. The presentation of the international application to the International Bureau may be made:

- either by postal mail, or
- by fax<sup>3</sup>, or
- by electronic means (provided that such a mode of communication has previously been agreed upon between the Office of origin and the International Bureau).

#### Irregularities in the International Application Other Than Those Concerning the List of Goods and/or Services

82. These irregularities are of three types: those which the Office of origin must remedy, those which the applicant must remedy and those which either the Office of origin or the applicant must remedy. Any and all communications concerning the remedying of irregularities must be forwarded to the International Bureau by the Office of origin or the applicant, as the case may be, within three months of the date of notification of the irregularity by the International Bureau.

#### Irregularities Concerning the Goods and/or Services

83. If the International Bureau finds that the classification of the goods and/or services listed in an international application is incorrect or that a term used in the list of goods and/or services is too vague, is incomprehensible, or is linguistically incorrect, it notifies an irregularity to the Office of origin and, at the same time, informs the applicant. The Office of origin may attempt to resolve any disagreement with the International Bureau with a view to remedying that irregularity. In the course of this process, the Office of origin may seek the views of the applicant.

#### Ceasing of Effect of the Basic Mark

84. If, within a period of five years following the date of the international registration (the so-called “dependency period”), the basic mark ceases, for any reason, to have effect, the Office of origin must inform the International Bureau and request the cancellation of the international registration in respect of the goods and services affected.

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<sup>3</sup> Where the international application has been sent by fax, the *original* of the page of the form bearing the reproduction of the mark, signed by the Office of origin, must be sent to the International Bureau by postal mail.

## **PART II: MAIN ACTIONS TO BE UNDERTAKEN BY THE OFFICE OF A DESIGNATED CONTRACTING PARTY**

### Overview

85. An international registration is notified to the Office of each Contracting Party that has been designated by the applicant. Each such Office may notify the International Bureau, within the time limits set in the Agreement and Protocol (i.e., 12 months, 18 months or more than 18 months, in the case of a provisional refusal based upon an opposition, as the case may be), if it considers that protection cannot be granted in the Contracting Party concerned. It may also notify to the International Bureau a number of matters pertaining to international registrations.

### Examination of the International Registration; Provisional Refusal of Protection

86. The Office of a designated Contracting Party which is notified of an international registration, or a subsequent designation, should examine it in the same way as it would examine an application for registration on its own register. Following such an examination, it may notify to the International Bureau a provisional refusal of protection if it considers that the international registration does not comply with the provisions of its legislation.

87. Such a refusal (*ex officio* provisional refusal) must be sent within a prescribed time limit (i.e., 12 or 18 months, as the case may be). It may relate to all or only some of the goods and/or services for which protection is sought. A refusal may also be based on an opposition filed by a third party who objects to the mark being protected in the Contracting Party concerned (provisional refusal based on an opposition) within the prescribed time limits (i.e., 12 months, 18 months or more than 18 months, as the case may be).

88. If the Office takes no action within the relevant time limit, the mark stands protected, i.e., a mark that is the subject of an international registration is protected automatically in a designated Contracting Party unless protection is actually refused by the Office of that Contracting Party.

### Confirmation or Withdrawal of Provisional Refusal

89. An Office which has sent to the International Bureau a notification of provisional refusal must, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau a statement indicating whether the provisional refusal has been confirmed, or totally or partially reversed by that Office. Where an Office has totally or partially reversed the provisional refusal, that Office shall then send a "Statement of Grant of Protection Following a Provisional Refusal", specifying whether the protection is total or partial. Where the Office confirms a total refusal, it shall send a "Statement of Confirmation of Total Provisional Refusal".

### Further Decision Concerning the Protection of the Mark

90. Where, following the sending of the above statement, a further decision (stemming, for example, from an appeal to a body outside the Office) affects the protection of the mark, the Office must, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and/or services for which the mark is protected in the Contracting Party concerned.

Statement of Grant of Protection Where no Notification of Provisional Refusal Has Been Communicated

91. Where, before the expiry of the refusal period, all the procedures before an Office have been completed and the Office has found no grounds to refuse protection, the Office shall, as soon as possible, and before the expiry of the refusal period, send to the International Bureau a statement to the effect that protection is granted to the mark. Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

Declaration That a Limitation Has no Effect

92. Following the international registration, the holder may request the recording of a limitation of the list of goods and/or services. Where such a limitation replaces one term by a different term which (in the opinion of the holder) is narrower than the first term, the Office of a designated Contracting Party may consider that the new term is in fact broader than the original term, so that the change is not a limitation but rather a broadening of the list of goods and/or services. In such a case, the Office may declare that the limitation 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 limitation was notified to the Office concerned.

Restriction on the Holder's Right of Disposal

93. The Office of a designated Contracting Party may inform the International Bureau that the right of the holder of an international registration to dispose of that international registration has been restricted with respect to the territory of that Contracting Party. Such information should consist of a summary statement of the main facts concerning the restriction, for example, that it results from a court order concerning the disposal of the assets of the holder. Copies of court decisions or deeds should not be sent to the International Bureau.

Replacement of National or Regional Registration by an International Registration

94. In accordance with Article 4*bis* of the Agreement and the Protocol, the holder may request the Office of a designated Contracting Party to take note in its register that a national/regional registration has been replaced by the corresponding international registration by virtue of the holder's designation of that Contracting Party. The international registration and the national/regional registration must be for the same mark and must be in the same name; the goods and/or services listed in the national/regional registration must also be listed in the international registration with regard to the designated Contracting Party in question; and the designation must take effect after the date of the national/regional registration. The Office must notify the International Bureau accordingly.

### Invalidation of Effects of International Registration

95. A mark which is protected in a Contracting Party may subsequently be invalidated by the competent authorities (for example, in proceedings brought by a third party, or in a counterclaim in infringement proceedings). The Office of the Contracting Party concerned must notify the International Bureau where it is aware of a final decision invalidating the effects of an international registration in its territory.

### Transformation of an International Registration Into a National/Regional Application

96. Following a cancellation of an international registration at the request of the Office of origin under Article 6(4) of the Protocol (i.e., following a ceasing of effect during the five years dependency period), the holder may file a national/regional application for the same mark with the Office of a designated Contracting Party.

97. If the required formalities are complied with, the application shall be treated by the Office concerned as though it had been filed on the date of the international registration, or where the Contracting Party was designated subsequently to the international registration, the date of the subsequent designation.

98. It is up to each Contracting Party to determine the modalities for giving effect to such transformation into a national or regional application. It may require that such an application comply with all requirements that apply to national or regional applications filed with its Office, including requirements concerning fees. That is, it may require that the full amount of application and other fees be paid; alternatively, and in particular 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.

## **PART III: MAIN ACTIONS TO BE UNDERTAKEN BY AN OFFICE AS OFFICE OF THE CONTRACTING PARTY OF THE HOLDER**

### Overview

99. A Contracting Party may also undertake actions in the capacity of being the Office of the Contracting Party of the holder.

100. According to Rule 1(xxvibis) “Contracting Party of the Holder” means the Contracting Party whose Office is the Office of origin, or where a change in ownership has been recorded, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfils the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration.

### Presentation of Subsequent Designations to the International Bureau

101. The Office of the Contracting Party of the holder may be requested by the holder to present to the International Bureau a subsequent designation. That Office must indicate the date on which it received the subsequent designation, sign the request and send it to the International Bureau before the expiry of two months.

### Presentation of Other Requests to the International Bureau

102. The Office of the Contracting Party of the holder may be requested by the holder to present to the International Bureau a request for the recording of a change in ownership, a limitation of the list of goods and/or services, a renunciation, a change in the name and/or address of the holder or a cancellation of the international registration.

103. In each case, the Office should make sure that it may in fact serve as the Office of the Contracting Party of the holder. It should also check that the correct official form is used. The Office must sign the request and send it promptly to the International Bureau (without, however, any time-limit being provided for).

### Restriction on the Holder's Right of Disposal

104. The Office of the Contracting Party of the holder may inform the International Bureau that the right of the holder of an international registration to dispose of that international registration has been restricted with respect to the international registration as a whole or in respect of one or more designated Contracting Parties. 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). In addition, the optional form MM19 may be used to request the recording in the International Register of a restriction of the holder's right of disposal. Copies of court decisions or deeds should not be sent to the International Bureau.

[Annexes follow]

ANNEX I

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**ANNEX I**

**MODEL INSTRUMENT OF ACCESSION TO THE PROTOCOL RELATING TO  
THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION  
OF MARKS**

(To be deposited with the Director General of WIPO in Geneva)

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The Government of [name of State] hereby declares that [name of State] accedes to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989.

Done at ....., [date] .....

(Signature)\*  
(Capacity)

[Annex II follows]

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\* This instrument must bear the signature of the Head of State, Head of Government or Minister of Foreign Affairs.

ANNEX II

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ANNEX II

**THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING  
THE INTERNATIONAL REGISTRATION OF MARKS (THE MADRID PROTOCOL)**

**MODEL PROVISIONS AND INFORMATION FOR THE IMPLEMENTATION  
OF THE MADRID PROTOCOL**

[NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION]

NOVEMBER 2017

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**INTRODUCTION**

[Name of the country or intergovernmental organization] is not yet party to the Madrid System for the International Registration of Marks (“the Madrid System”). If and when [name of the country or intergovernmental organization] becomes party to the Madrid System, it will accede to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Madrid Protocol”) only.

This document provides information on the Model Provisions. The Model Provisions are the minimum requirements that should be included in the legislation of a member of the Madrid System. It is very important that [a country] [an intergovernmental organization], at the time of accession to the Madrid Protocol, has legislation that is fully compatible with the Madrid Protocol. Each member will need to decide how this may be done.

One possibility is to have a bill of accession acknowledging the Madrid Protocol, placing all relevant provisions of the Madrid Protocol in a Chapter to the Regulations. This chapter could be entitled, for example, “International Registration of Marks under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks”.



Another option may be to have all relevant provisions of the Madrid Protocol in the Trademarks [Law] itself. The more detailed provisions of the Madrid System may be placed in the Regulations, as it is often easier to amend provisions in the Regulations than the [Law] itself.

This document has six parts:

- Part I contains the Model Provisions;
- Part II contains comments to these provisions;
- Part III addresses specific issues which [name of the country or intergovernmental organization] would need to consider or address prior to implementing the Madrid System;
- Part IV contains information on declarations that [name of the country or intergovernmental organization] may consider for its future accession to the Madrid Protocol;
- Part V provides the links to the legal framework of the Madrid Protocol, meaning the provisions of the Madrid Protocol, the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (the “Common Regulations”) and the Administrative Instructions, and to other reference material; and
- Part VI lists the current model forms available for the use by Offices for the various communications an Office of a Contracting Party may make in the Madrid System.

These Model Provisions and the following commentary have been prepared in the context of the Trademark [Law No. XXX] [and the Trademark [Regulation] No. XXX].

The Government of [name of the country or intergovernmental organization] would need to make choices with respect to the use of forms and payment of fees. Where such choices are required, text in square brackets suggests alternatives for example, in Model Provisions 6, 21(1)(b), 22(2)(a) and (b).

The references to Article 5(2) of the Madrid Protocol that appear between brackets in Model Provisions 10(1), 13(1) and 17, would depend on whether [name of the country or intergovernmental organization] makes a declaration under paragraphs (2)(b) and (c) of that Article.

Model Provision 12 would be required if [name of the country or intergovernmental organization] makes a declaration under Article 5(2)(c) of the Madrid Protocol.

The text in Model Provision 21(2)(vi) would be optional as it relates to the optional content of the notification made under Rule 21(1)(iii), second sentence, of the Common Regulations.

Further details may, from time to time, be dealt with in the corresponding [national] [regional] regulations or in administrative instructions issued by the [national] [regional] industrial property authority (“the [Registrar]”).

## **PART I – MODEL PROVISIONS**

### 1. DEFINITIONS

For the purpose of this [Law][Chapter]:

(i) “the [Law]” shall be intended to mean references to the [Law] No. [XXXXXX], [Law on the Protection of Intellectual Property] and any amendments thereof or any governing regulatory instruments;

(ii) “Madrid Agreement” means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as amended;

(iii) “Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid on June 27, 1989, as amended;

(iv) “Common Regulations” means the Common Regulations under the Madrid Agreement and the Madrid Protocol;

(v) “Contracting Party” means any country or intergovernmental organization party to the Madrid Protocol;

(vi) “International Bureau” means the International Bureau of the World Intellectual Property Organization;

(vii) “International Register” means the official collection of data concerning international registrations of marks maintained by the International Bureau;

(viii) “international application” means an application to obtain registration of a mark under the Madrid Protocol;

(ix) “Office of origin” means the Office of the Contracting Party where, in accordance with Article 2(2) of the Madrid Protocol, the international application was filed;

(x) [“Registrar”] means the [XXX] of the [name of the country or intergovernmental organization];

(xi) “applicant” refers to the natural person or legal entity in whose name an international application is filed with the Office of origin;

(xii) “basic application” means an application for registration of a mark, filed with the [Registrar] under the [Law], and which is used as a basis to file an international application under the Madrid Protocol;

(xiii) “basic registration” means a mark registered by the [Registrar] under the [Law], and which is used as the basis to file an international application under the Madrid Protocol;

(xiv) “international registration” means the registration of a mark effected under the Madrid Protocol;

(xv) “holder” refers to the natural person or legal entity in whose name an international registration is recorded in the International Register;

(xvi) “designation” means the request for extension of protection (“territorial extension”) under Article 3*ter*(1) or (2) of the Madrid Protocol, as the case may be; it also means such extension as recorded in the International Register;

(xvii) “subsequent designation” means the request for extension of protection (“territorial extension”) under Article 3*ter*(2) of the Madrid Protocol; it also means such extension as recorded in the International Register;

(xviii) “designated Contracting Party” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3*ter*(1) or (2) of the Madrid Protocol, as the case may be, or in respect of which such extension has been recorded in the International Register;

(xvix) “invalidation” means a final decision by the competent authority (whether administrative or judicial) of [name of the country or intergovernmental organization] revoking or cancelling the effects, in the territory of [name of the country or intergovernmental organization], of an international registration with regard to all or some of the goods or services covered by the designation of [name of the country or intergovernmental organization].

## 2. LANGUAGE

(1) Any international application for transmittal to the International Bureau through the intermediary of the [Registrar] shall be in [English] [French] [Spanish].

(2) Any communication concerning an international application or an international registration addressed to the International Bureau by the [Registrar] shall [, subject to Rule 17(2)(v) and (3), and Rule 6(2)(ii) of the Common Regulations,] be in [English] [French] [Spanish].

### **(A) INTERNATIONAL APPLICATIONS ORIGINATING FROM [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION]**

## 3. ENTITLEMENT TO FILE AN INTERNATIONAL APPLICATION

Any natural person or legal entity, that is a national of [name of the country] [a member State of the intergovernmental organization], is domiciled in [name of the country or intergovernmental organization] or has a real and effective industrial or commercial establishment in [name of the country or intergovernmental organization], is entitled to file an international application with the [Registrar], provided the basic application or basic registration, as the case may be, used as a basis to file the international application is in the name of that natural person or legal entity.

4. EXAMINATION OF INTERNATIONAL APPLICATIONS WHERE [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION] IS THE OFFICE OF ORIGIN

Where an international application is filed with the [Registrar] for transmittal to the International Bureau, the [Registrar] shall verify that the Office of [name of the country or intergovernmental organization] may be considered as the Office of origin for that application, and that the relevant particulars appearing in the international application correspond to those appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

5. CERTIFICATION BY THE [REGISTRAR]

(1) Where the international application complies with the prescribed requirements, the [Registrar] shall certify the international application, also indicating the date of its receipt and shall forward the international application to the International Bureau.

(2) Where the international application does not comply with the prescribed requirements, the [Registrar] shall not forward the international application to the International Bureau, and shall inform the applicant accordingly.

6. HANDLING FEE

[The prescribed fee shall be due and payable to the [Registrar] in connection with the filing of an international application originating in [name of the country or intergovernmental organization].]

7. CEASING OF EFFECT OF THE BASIC APPLICATION OR BASIC REGISTRATION

Where, in accordance with Article 6 of the Madrid Protocol, the basic application, the registration resulting from such application, or the basic registration, ceases to have effect, the [Registrar] shall inform the International Bureau accordingly and shall request the cancellation of the international registration for the goods and services affected.

**(B) INTERNATIONAL REGISTRATIONS WHERE [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION] IS A DESIGNATED CONTRACTING PARTY**

8. EFFECTS OF AN INTERNATIONAL REGISTRATION

(1) An international registration designating [name of the country or intergovernmental organization] shall have the same effects, as from the date of the international registration or of the subsequent designation of [name of the country or intergovernmental organization], as the case may be, as an application for the registration of the mark filed directly with the [Registrar] under the [Law].

(2) If no refusal is notified by the [Registrar] to the International Bureau in accordance with the Madrid Protocol and the Common Regulations, or if a refusal has been so notified but has been subsequently withdrawn, or if a statement of grant of protection is sent by the [Registrar], the protection of the mark in [name of the country or intergovernmental organization] shall be the same as if the mark had been registered directly by the [Registrar] on the date of the international registration or of the subsequent designation of [name of the country or intergovernmental organization], as the case may be.

## 9. EXAMINATION OF INTERNATIONAL REGISTRATIONS

The [Registrar] shall examine the marks that are the subject of international registrations designating [name of the country or intergovernmental organization] in relation to provisions in [Articles XXX and XXX] of the [Law].

## 10. EX OFFICIO PROVISIONAL REFUSAL OF PROTECTION

(1) Where the [Registrar] finds that, in accordance with the [Law] of [name of the country or intergovernmental organization], the mark that is the subject of an international registration designating [name of the country or intergovernmental organization] cannot be accepted, the [Registrar] shall, before the expiry of the refusal period specified in Article 5(2)(a)(b) of the Madrid Protocol, notify to the International Bureau of a provisional refusal of protection, complying with the requirements of the Madrid Protocol and the Common Regulations.

(2) The holder of that international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the [Registrar].

## 11. PUBLICATION OF INTERNATIONAL REGISTRATION; OPPOSITION

(1) Where [name of the country or intergovernmental organization] has been designated in an international registration and [the mark has been accepted], the [Registrar] shall publish the international registration as provided for in the [Law].

(2) Opposition to the international registration shall be governed by the provisions of the [Law] regarding opposition, *mutatis mutandis*.

## 12. POSSIBLE NOTIFICATION OF PROVISIONAL REFUSAL BASED ON OPPOSITION IN ACCORDANCE WITH ARTICLE 5(2)(C) OF THE MADRID PROTOCOL

[Where the period to file an opposition against an international registration ends after the expiry of the refusal period specified in Article 5(2)(b) of the Madrid Protocol or the [Registrar] considers that it will end too late for the [Registrar] to send a notification under [Model Provision 13] within that refusal period, the [Registrar] shall send a communication informing that fact to the International Bureau, complying with the requirements of the Madrid Protocol and the Common Regulations.]

### 13. PROVISIONAL REFUSAL BASED ON AN OPPOSITION

(1) Where an opposition is filed with the [Registrar] against an international registration designating [name of the country or intergovernmental organization], the [Registrar] shall, before the expiry of the refusal period specified in Article 5(2)[(a)][(b) or in accordance with Article 5(2)(c)] of the Madrid Protocol, notify that fact to the International Bureau as a provisional refusal based on an opposition, complying with the requirements of the Madrid Protocol and the Common Regulations.

(2) The holder of the international registration concerned shall enjoy the same remedies as if the mark had been filed for registration directly with the [Registrar].

### 14. NO GROUNDS FOR REFUSAL – STATEMENT OF GRANT OF PROTECTION

Where all procedures before the [Registrar] have been completed, the [Registrar] has not found grounds to refuse protection[, has not received a notice of opposition] and, as a result, has not notified a provisional refusal in accordance with [Model Provision 10] or [Model Provision 13], the [Registrar] shall, as soon as possible and before the expiry of the refusal period applicable under Article 5(2) of the Madrid Protocol, send a statement to the International Bureau to the effect that protection is granted to the mark in [name of the country or intergovernmental organization].

### 15. DECISIONS BY THE [REGISTRAR] FOLLOWING THE NOTIFICATION OF A PROVISIONAL REFUSAL

#### (1) Statement of Grant of Protection Following the Notification of a Provisional Refusal

Where the [Registrar] has notified the International Bureau of a provisional refusal of protection in accordance with [Model Provision 10] or [Model Provision 13] and, all the procedures before the [Registrar] having been completed, the mark is either totally or partially protected, the [Registrar] shall send to the International Bureau

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted in [name of the country or intergovernmental organization] for all the goods and services for which protection has been requested, or

(ii) a statement indicating the goods and services for which protection of the mark is granted in [name of the country or intergovernmental organization].

#### (2) Confirmation of Total Provisional Refusal

Where the [Registrar] has sent to the International Bureau a notification of total provisional refusal in accordance with [Model Provision 10] or [Model Provision 13] and, all the procedures before the [Registrar] having been completed, the [Registrar] has decided to confirm such refusal of protection of the mark in [name of the country or intergovernmental organization] for all the goods and services for which protection has been requested, the [Registrar] shall send to the International Bureau a statement to that effect.

## 16. APPEALS

[Any person aggrieved with any decision made by the [Registrar] concerning international registrations designating [name of the country or intergovernmental organization] may appeal therefrom to the [Court]. Appeals against those decisions shall be governed by the provisions of the [Law] regarding appeals, *mutatis mutandis*.]

## 17. FURTHER DECISION AFFECTING THE PROTECTION OF A MARK

Where a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2)(a)(b) or in accordance with Article 5(2)(c) of the Madrid Protocol, or, where following the sending of a statement in accordance with [Model Provision 14] or [Model Provision 15], a further decision, taken by the Office or other authority, affects the protection of a mark in [name of the country or intergovernmental organization], the [Registrar] shall, to the extent that it is aware of that decision, without prejudice to [Rule 19 of the Common Regulations [or Model Provision 18]], send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in [name of the country or intergovernmental organization].

## 18. INVALIDATION

Where the effects of an international registration are invalidated in [name of the country or intergovernmental organization] and the invalidation is no longer subject to appeal, the [Registrar] shall, provided that the [Registrar] is made aware of that decision, notify the International Bureau in accordance with Rule 19 of the Common Regulations.

## 19. RENEWAL OF INTERNATIONAL REGISTRATIONS DESIGNATING [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION] AND RECORDINGS IN THE INTERNATIONAL REGISTER

(1) International registrations which, in accordance with Article 7 of the Madrid Protocol, have been renewed in respect of [name of the country or intergovernmental organization] as a designated Contracting Party shall continue to have effect in [name of the country or intergovernmental organization].

(2) Any recording made in the International Register concerning an international registration, shall, to the extent that it applies to [name of the country or intergovernmental organization] as a designated Contracting Party, have the same effect as if it had been recorded by the [Registrar] in the Register of marks.

(3) Where, under the laws of [name of the country or intergovernmental organization], the [Registrar] considers that the recording referred to in paragraph (2) has no effect in [name of the country or intergovernmental organization], the [Registrar] shall, where so provided for in the Common Regulations, send a communication to the International Bureau to this effect, in accordance with the relevant provisions of the Common Regulations.

20. [COLLECTIVE], [CERTIFICATION] [AND/OR GUARANTEE MARKS]

(1) [Collective], [certification] [and/or guarantee marks] in international registrations designating [name of the country or intergovernmental organization] shall be governed by the provisions of the [Law] regarding such marks, *mutatis mutandis*.

(2) Where an international registration designating [name of the country or intergovernmental organization] is a [collective mark][, a certification mark] [or a guarantee mark], a copy of the regulations governing the use of such marks shall be submitted directly, by the holder of that international registration, to the [Registrar], within the prescribed time limit.

21. REPLACEMENT

(1) (a) Where:

(i) a mark registered in [name of the country or intergovernmental organization] is also the subject of an international registration, and the protection resulting therefrom extends to [name of the country or intergovernmental organization], and

(ii) the same person is recorded as holder of the registration in [name of the country or intergovernmental organization] and of the international registration, and

(iii) all the goods and services listed in the registration in [name of the country or intergovernmental organization] are also listed in the international registration in respect of [name of the country or intergovernmental organization], and

(iv) the extension of that international registration to [name of the country or intergovernmental organization] took effect after the date of registration of the mark in [name of the country or intergovernmental organization],

the holder of the international registration may request the [Registrar] to take note of that international registration in the Register of marks.

(b) A request filed with the [Registrar] in accordance with paragraph (a), shall be made on Form [...] and [shall be subject to the payment of the prescribed fee] [shall not be subject to the payment of a fee].

(2) Where the [Registrar] has taken note of an international registration in accordance with paragraph (1)(a), the [Registrar] shall notify the International Bureau accordingly. Such notification shall indicate the following:

(i) the number of the international registration in question,

(ii) where some only of the goods and services listed in the international registration are concerned, those goods and services,

(iii) the filing date and number of the application for registration of the mark in [name of the country or intergovernmental organization],



(iv) the registration date and number of the registration in [name of the country or intergovernmental organization],

(v) the priority date, if any, of the registration in [name of the country or intergovernmental organization], and

[(vi) information relating to other rights acquired by virtue of the registration in [name of the country or intergovernmental organization].]

## 22. TRANSFORMATION

(1) (a) Where an international registration designating [name of the country or intergovernmental organization] is cancelled at the request of the Office of origin, in accordance with Article 6(4) of the Madrid Protocol, for all or some of the goods and services listed in the international registration, an application may be made to the [Registrar], within three months from the date on which the international registration was cancelled, by the person who was the holder of the international registration at the date of its cancellation, for registration of the same trademark (“an application resulting from transformation”), for goods and services covered by the list of goods and services contained in the international registration.

(b) Subject to paragraphs (2) and (3), the provisions applicable to a trademark application filed directly with the [Registrar] shall apply *mutatis mutandis* to an application resulting from transformation.

(2) (a) An application resulting from transformation shall be made on Form [...] and shall, in addition, include the following:

(i) a statement that the application is made by way of transformation,

(ii) the international registration number of the international registration which has been cancelled,

(iii) the date of the said international registration or the date of the subsequent designation, as appropriate,

(iv) the date on which the cancellation of the international registration was recorded,

(v) where applicable, the date of any priority claimed in the international application and recorded in the International Register.

(b) An application resulting from transformation [shall be subject to the payment of the prescribed [transformation] fee[s]] [shall not be subject to the payment of [a] [the standard application] fee].

(3) (a) Where a mark that is the subject of an international registration has become protected in [name of the country or intergovernmental organization] on or before the date on which the international registration was cancelled and, provided that all the requirements relating to an application resulting from transformation have been met, that trademark shall be registered by the [Registrar]. The date of registration shall be the date of the cancelled international registration or the date of the subsequent designation, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.

(b) Where a mark that is the subject of an international registration has not yet become protected in [name of the country or intergovernmental organization] on or before the date on which the international registration was cancelled, any procedures or measures already undertaken on or before the date on which an application resulting from transformation is filed for the purpose of the international registration shall be considered as having been undertaken for the purposes of the application resulting from transformation. The filing date of the application resulting from transformation shall be the date of the international registration or the date of the subsequent designation, as appropriate.

### 23. FURTHER DETAILS CONCERNING INTERNATIONAL REGISTRATIONS

Further details concerning international registrations may be included in the implementing regulations or instructions issued by the [Registrar].

### 24. CONFLICT BETWEEN THE [LAW] AND THE MADRID PROTOCOL

In the event of conflict between the provisions of the [Law] and those of the Madrid Protocol, the provisions of the Madrid Protocol and the Common Regulations shall prevail.

## **PART II – NOTES ON THE MODEL PROVISIONS**

### MODEL PROVISION 1: DEFINITIONS

For the sake of legal certainty, a number of expressions used in the context of the international procedure should be defined in the [Law][Chapter], those expressions being defined as having the same meaning as in the Madrid Protocol and the Common Regulations. In addition, reference is made in the definitions to the [national] [regional] legislation on trademarks (i.e. the [Law]).

### MODEL PROVISION 2: LANGUAGE

Under Rule 6(1) of the Common Regulations, an international application may be filed in English, French or Spanish, according to what is prescribed by the Office of origin.

The implementing legislation of [name of the country or intergovernmental organization] should therefore state that international applications are required to be filed through the [Registrar] in the language, or languages, indicated in this provision.

[Name of the country or intergovernmental organization] would also need to decide on which language it will communicate with the International Bureau concerning international applications or international registrations designating [name of the country or intergovernmental organization]. There can be only one language of communication.

For further information, reference is made to Rule 6 of the Common Regulations and to the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol ("the Guide").

**(A) INTERNATIONAL APPLICATIONS ORIGINATING FROM [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION] - THE OFFICE OF [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION] AS OFFICE OF ORIGIN**

**MODEL PROVISION 3: ENTITLEMENT TO FILE AN INTERNATIONAL APPLICATION**

This provision governs the entitlement to use the Madrid System; the applicant needs to be a national of [name of the country] [a member State of the intergovernmental organization], be domiciled or have a place of business (a real and effective industrial or commercial establishment) in [name of the country or intergovernmental organization]. In addition, the applicant needs to have a basic mark, meaning an application filed with or a registration effected by the [Registrar].

**MODEL PROVISION 4: EXAMINATION OF INTERNATIONAL APPLICATIONS WHERE THE OFFICE OF [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION] IS THE OFFICE OF ORIGIN**

This provision defines the principal role of the Office of [name of the country or intergovernmental organization] as Office of origin, namely, the fact that the [Registrar] is required, before transmitting an international application to the International Bureau, to check that the Office of [name of the country or intergovernmental organization] may be considered as the Office of origin and that the relevant particulars appearing in the international application correspond to those appearing in the basic application or basic registration, as the case may be.

The [Registrar] is required also to indicate the actual date on which the [Registrar] received the international application (which will become, in principle, the date of the international registration – see Article 3(4) of the Madrid Protocol and Rule 15 of the Common Regulations).

The [Registrar] cannot require the applicant to meet any further conditions to assign a date to the international application; for example, the [Registrar] cannot require that the applicant pay a fee to the Office before assigning a date to the international application.

If the international application does not meet the applicable requirements (either because the Office of [name of the country or intergovernmental organization] cannot be considered as Office of origin, or because the particulars appearing in the international application, and requiring certification, do not correspond to those appearing in the basic application or basic registration), the [Registrar] should not transmit the international application to the International Bureau.

The [Registrar] may require that the applicant pay a fee to the [Registrar] before transmitting the international application to the International Bureau (see Model Provision 6).

For further information, see Rule 9 of the Common Regulations and the Guide.

#### MODEL PROVISION 5: CERTIFICATION BY THE [REGISTRAR]

If the [Registrar] is satisfied that the Office of [name of the country or intergovernmental organization] may be considered as the Office of origin and that the relevant particulars appearing in the international application correspond to those appearing in the basic application or basic registration, as the case may be, then the [Registrar] is required to certify accordingly in item 13 of the international application form, and transmit the application to the International Bureau.

#### MODEL PROVISION 6: HANDLING FEE

Under Article 8(1) of the Madrid Protocol, the [Registrar] may establish and collect a fee in connection with the filing of the international application. The aim of this fee is to cover the cost of the work involved in the reception, certification and transmittal of the international application to the International Bureau. However, charging such fee is optional.

#### MODEL PROVISION 7: CEASING OF EFFECT OF THE BASIC APPLICATION OR BASIC REGISTRATION

Model Provision 7 deals with the so-called “ceasing of effect” of the basic application or basic registration during the five-year dependency period referred to in Article 6 of the Madrid Protocol.

Under paragraph (4) of Article 6, where the basic application or basic registration ceases, either totally or partially, to have effect within that period, the Office of origin is required to inform the International Bureau accordingly and request the cancellation of the international registration for the goods and services affected.

For example, if the basic application is withdrawn, abandoned or not accepted, in whole or in part, within the dependency period (or as a result of actions initiated within the dependency period), the [Registrar] must notify the International Bureau of this fact and request that the international registration concerned be cancelled to the same extent.

Moreover, if the basic registration (or the registration resulting from a basic application) is cancelled, renounced, revoked, invalidated or is not renewed, within the dependency period (or as a result of actions initiated within the dependency period), the [Registrar] must notify this fact to the International Bureau and request that the international registration concerned be cancelled accordingly.

**(B) INTERNATIONAL REGISTRATIONS WHERE [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION] IS A DESIGNATED CONTRACTING PARTY**

INTRODUCTION

International registrations designating [name of the country or intergovernmental organization] should be subject to examination as to substantive grounds for refusal in the same way as applications filed directly with the [Registrar] and should be subject to the same possibility of opposition as [nationally] [regionally] filed applications.

Accordingly, holders of international registrations designating [name of the country or intergovernmental organization] should have the same means of recourse and remedies as provided for regular applications filed directly with the [Registrar].

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

In this part, the proposed Model Provisions dealing with examination of an international registration designating [name of the country or intergovernmental organization] follow a logical progression, [similar to the one in the [Law]].

- Model Provision 8 deals with the effects of international registrations in which [name of the country or intergovernmental organization] is a designated Contracting Party;
- Model Provision 9, with the grounds for refusal;
- Model Provision 10, with marks that are refused by the [Registrar] *ex officio*;
- Model Provision 11, with the publication, for opposition purposes, of marks that are accepted by the [Registrar];
- Model Provision 12, with possible notification of a provisional refusal based on opposition beyond the expiry of the refusal period;
- Model Provision 13, with a notification of provisional refusal based on opposition;
- Model Provision 14, with marks that are accepted by the [Registrar] without reservation, published for opposition and not opposed;
- Model Provision 15, with the communication on the final decision by the [Registrar], following a provisional refusal *ex officio* or based on opposition;
- Model Provision 16, with appeals against the final decision by the [Registrar];

- Model Provision 17, with further decisions affecting the protection of a mark;
- Model Provision 18, with invalidation;
- Model Provision 19, with the renewal of international registrations and other recordings in the International Register;
- Model Provision 20, with collective, certification and guarantee marks;
- Model Provisions 21 and 22 deal with, respectively, replacement and transformation; and
- Model Provisions 23 and 24, deal with, correspondingly, possible further provisions, in the form of regulations or directives, and hierarchy of laws.

#### WHAT IS “REFUSAL” UNDER THE MADRID SYSTEM?

In the context of the Madrid System, a “refusal” by the [Registrar] does not mean that a final determination must have been reached concerning the protection of a mark that is the subject of an international registration. What is required is that, within the applicable refusal period, the [Registrar] notify to the International Bureau a “provisional” objection (a “provisional refusal”), indicating the grounds which may eventually lead to a definitive refusal. There are strict time limits for the notification of a provisional refusal, but no limits on the notification of the eventual final decision.

Accordingly, under the Madrid System, where the [Registrar] finds grounds for refusal of an international registration where [name of the country or intergovernmental organization] is designated, the [Registrar] must, within a time limit of 12 months from the date of notification by the International Bureau of the designation, send its provisional refusal to the International Bureau.

However, it is possible, by making a declaration to that effect, to extend this period to 18 months, and to further extend this period in the case of refusals following third party opposition (this is often referred to as “18 months plus”). Please, see Part IV below for possible declarations under the Madrid Protocol.

#### MODEL PROVISION 8: EFFECTS OF AN INTERNATIONAL REGISTRATION

The effects in [name of the country or intergovernmental organization] of an international registration designating [name of the country or intergovernmental organization] should be stated by transposing the substance of Article 4(1)(a) of the Madrid Protocol.

Model Provision 8 provides that a mark that has been registered in the International Register shall be protected in [name of the country or intergovernmental organization] as if the mark had been the subject of an application for registration filed directly with the [Registrar] (paragraph (1)); and that, if no refusal of protection has been issued – or if a refusal has been notified to the International Bureau but has been subsequently withdrawn – or if a statement of grant of protection has been sent, the protection of the mark will be the same as if it had been directly registered by the [Registrar] (paragraph (2)).

#### MODEL PROVISION 9: EXAMINATION OF INTERNATIONAL REGISTRATIONS

According to Article 4(1)(a) of the Madrid Protocol, an international registration has the effects of an application for the registration of a mark filed directly with the [Registrar]. Therefore, the [Registrar] shall examine the mark that is the subject of that international registration for its acceptance, in accordance with the [Law].

#### MODEL PROVISION 10: *EX OFFICIO* PROVISIONAL REFUSAL OF PROTECTION

International registrations designating [name of the country or intergovernmental organization] will be subject to examination as to substantive grounds for refusal in the same way as applications filed directly with the [Registrar].

Where the [Registrar] finds that the mark is not acceptable for protection, based on absolute grounds or because of third party rights, or considers that the international registration can be accepted subject to certain conditions, the [Registrar] must notify the International Bureau of an *ex officio* provisional refusal of protection.

The [Registrar] must ensure that *ex officio* examination can be completed well within the confines of the time limit to notify a provisional refusal. It is important to stress that if a provisional refusal is not notified to the International Bureau before the expiry of the applicable refusal period, the mark is deemed to be protected in [name of the country or intergovernmental organization].

Holders of international registrations for which the [Registrar] has sent an *ex officio* provisional refusal shall have the same means of recourse and remedies as provided in respect of regular applications filed directly with the [Registrar].

The [Registrar] may use Model Form 3A to notify an *ex officio* total provisional refusal, (i.e. one that affects all goods and services) and Model Form 3B to notify an *ex officio* partial provisional refusal (i.e. one that affects some goods and services) (see Part VI).

#### MODEL PROVISION 11: PUBLICATION OF INTERNATIONAL REGISTRATION; OPPOSITION

The publication of the international registration in [name of the country or intergovernmental organization] – additional to the publication undertaken by the International Bureau in accordance with the Madrid Protocol shall be effected *ex officio* to initiate the opposition period. The [Registrar] cannot charge any fee for such publication.

Accordingly, once the international registration has passed the *ex officio* examination and there are no grounds for refusal, the [Registrar] shall publish the international registration for opposition.

Opposition procedures shall be governed by the provisions of the [Law], *mutatis mutandis*.

**MODEL PROVISION 12: POSSIBLE NOTIFICATION OF PROVISIONAL REFUSAL BASED ON OPPOSITION IN ACCORDANCE WITH ARTICLE 5(2)(C) OF THE MADRID PROTOCOL**

This provision would only apply if [name of the country or intergovernmental organization] makes a declaration under Article 5(2)(c) of the Madrid Protocol (along with a declaration under Article 5(2)(b)). Under that declaration, the [Registrar] may send a provisional refusal based on opposition after the expiry of the 18-month refusal period specified in Article 5(2)(b), provided such refusal is sent no later than seven months from the start date and no later than one month from the end date of the opposition period.

However, to send a provisional refusal based on opposition under Article 5(2)(c), the [Registrar] must first inform the International Bureau of this possibility before the expiry of the 18-month refusal period specified in Article 5(2)(b) and also inform the start and end dates of the opposition period to the International Bureau, as soon as those dates are known.

The opposition period does not have to end after the expiry of the 18-month refusal period specified in Article 5(2)(b). The [Registrar] can send information in accordance with Article 5(2)(c) when the opposition period is deemed to end too late for the [Registrar] to send a notification of provisional refusal within the 18-month refusal period.

Finally, should the opposition period be extendable, the [Registrar] may send a communication under Article 5(2)(c) indicating the start date of the opposition period only. This date is sufficient because, according to Article 5(2)(c), a provisional refusal based on opposition must be sent no later than seven months from the start date of the opposition period.

The [Registrar] may use Model Form 1 to inform the International Bureau about possible oppositions, in accordance with Article 5(2)(c), and Model Form 2 to inform the International Bureau of the start and end dates of the opposition period, if those dates were not included in the initial communication (see Part VI).

**MODEL PROVISION 13: PROVISIONAL REFUSAL BASED ON OPPOSITION**

Where, following publication in accordance with Model Provision 11, an opposition is filed, the [Registrar] is required to notify this fact to the International Bureau, and Model Provision 13 provides accordingly. Such notification must be communicated to the International Bureau within the applicable refusal period, in the same way as the notification under Model Provision 10.

The [Registrar] may use Model Form 3A to notify a total provisional refusal based on opposition and Model Form 3B to notify a partial provisional refusal based on opposition (see Part VI).



MODEL PROVISION 14: NO GROUNDS FOR REFUSAL – STATEMENT OF GRANT OF PROTECTION

Model Provision 14 deals with paragraph (1) of Rule 18~~ter~~ of the Common Regulations.

That paragraph requires that Office of a designated Contracting Party to send a statement of grant of protection where:

- (a) all the procedures before the Office have been completed;
- (b) the Office has not found any grounds to notify an *ex officio* refusal of protection of the mark;
- (c) an opposition has not been filed against the international registration within the applicable time limit; and
- (d) the applicable refusal period, according to Article 5(2) of the Madrid Protocol, has not yet expired.

That is to say, the mark has been examined and accepted by the [Registrar], the mark has then been published for opposition purposes, no opposition has been filed, and the period for filing such opposition has expired – all of this before the applicable Madrid Protocol refusal period has expired. The benefit of sending such a statement of protection, as far as the holder is concerned, is that, where the mark has been fully cleared for protection in advance of the expiry of the refusal period, the holder does not have to wait for the expiry of that period to know that his/her mark is protected in [name of the country or intergovernmental organization].

This latter situation is often referred to as “tacit acceptance”, according to which, under Article 5, paragraphs (1) and (2) and Article 5(5) of the Madrid Protocol, a mark that is not refused within the applicable refusal period in a designated Contracting Party is deemed automatically to be protected.

Please note that the holder may find it useful to receive a statement of grant of protection from the [Registrar], where the conditions indicated in subparagraphs (a) to (c), above, have been met, even after the refusal period has expired. In such situation, the mark will automatically be deemed to be protected in [name of the country or intergovernmental organization] and the statement is not strictly necessary. However, the holder would receive some comfort from having received a statement from the [Registrar] indicating that the mark is protected.

The [Registrar] may use Model Form 4 to send a statement of grant of protection (see Part VI).

## MODEL PROVISION 15: DECISIONS FOLLOWING THE NOTIFICATION OF A PROVISIONAL REFUSAL

While the Madrid System requires that a provisional refusal be notified to the International Bureau within the applicable refusal period, there is no time limit for the eventual communication to the International Bureau of the outcome, once the Office has completed all its procedures. However, the [Registrar] is required to communicate to the International Bureau the particulars of any such “final decision”, once all the procedures have been completed.

### (1) Statement of Grant of Protection Following the Notification of a Provisional Refusal

When the [Registrar] has notified the International Bureau of a provisional refusal within the applicable refusal period, whether such provisional refusal was *ex officio* or followed the filing of an opposition, then, in due course, the [Registrar] is required to communicate to the International Bureau the outcome, as far as the protection of the mark is concerned. This is often referred to as the “final decision”, to the extent that the [Registrar] is required to send it to the International Bureau only after all the procedures before the [Registrar] have been completed. Such final decision may take a number of forms.

#### *Model Provision 15(1)(i): Protection Granted to All of the Goods and Services*

Following the notification of a provisional refusal, all the procedures before the [Registrar] have been completed and the mark is finally protected in [name of the country or intergovernmental organization] for all the goods and services for which protection has been requested, then the [Registrar] is required to send a statement of grant of protection to that effect to the International Bureau. This is in accordance with Rule 18~~ter~~(2)(i) of the Common Regulations.

Please note that this statement provided for by Model Provision 15(1)(i) follows the earlier notification of a provisional refusal, so it is not the same statement as provided for in Model Provision 14 above.

#### *Model Provision 15(1)(ii): Protection Granted to Some of the Goods and Services*

Following the notification of a provisional refusal, all the procedures before the [Registrar] have been completed and the mark is protected for some of the goods and services in [name of the country or intergovernmental organization], then the [Registrar] is required to send a statement of grant of protection to that effect to the International Bureau. This is in accordance with Rule 18~~ter~~(2)(ii) of the Common Regulations.

The Office may use Model Form 5 to send a statement of total or partial grant of protection following a provisional refusal (see Part VI).

(2) Confirmation of Total Refusal

Following the notification of a total provisional refusal, all the procedures before the [Registrar] have been completed and the [Registrar] has decided to confirm such total provisional refusal of protection of the mark in [name of the country or intergovernmental organization], then the [Registrar] is required to send a statement of confirmation of total refusal to the International Bureau. This is in accordance with Rule 18*ter*(3) of the Common Regulations.

The Office may use Model Form 6 to send a statement confirming a total refusal (see Part VI).

MODEL PROVISION 16: APPEALS

It is advisable to include a provision that reasserts the right of the holder and third parties to appeal to the [Court] a decision made by the [Registrar] with respect to an international registration designating [name of the country or intergovernmental organization].

MODEL PROVISION 17: FURTHER DECISION AFFECTING THE PROTECTION OF A MARK

This provision implements the requirement under Rule 18*ter*(4) of the Common Regulations for the [Registrar] to communicate to the International Bureau the particulars of any further decision affecting the protection of the mark in [name of the country or intergovernmental organization].

This is to be distinguished from the “final” decision covered by Model Provisions 15(1) and (2). Those communications follow the earlier sending by the [Registrar] of a notification of provisional refusal and are required to be sent to the International Bureau once all the regular procedures before the [Registrar] have been completed.

The communication under Model Provision 17 would be any later decision taken concerning the scope of protection of an international registration designating [name of the country or intergovernmental organization]. It could be a decision by another administrative or judicial authority concerning an appeal of a decision made by the [Registrar]. It could also be a decision unrelated to the examination procedures of the [Registrar], for example, concerning a request for cancellation due to non-use, whether this decision would be by the [Registrar] or the Court, or another administrative or judicial body. The [Registrar] should communicate any such further statement to the International Bureau where the [Registrar] is aware of any such decision, and, only to the extent that any such decision actually affects the status of protection of the mark.

Rule 18*ter*(4) will be amended from November 1, 2017. The text of Model Provision 17 follows the new wording. The current wording of Rule 18*ter*(4) is available on the Madrid System website, at the following address:

[www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=397995](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=397995).

The [Registrar] may use Model Form 7 to communicate a further decision affecting the protection of a mark (see Part VI).

#### MODEL PROVISION 18: INVALIDATION

In the Common Regulations, the term “invalidation” is intended to mean any final decision by a competent authority in [name of the country or intergovernmental organization] revoking or cancelling the effects in [name of the country or intergovernmental organization] of an international registration for all or some of the goods and services.

This provision requires the [Registrar], where the [Registrar] is aware of a decision to terminate in [name of the country or intergovernmental organization] the protection of the international registration, to notify the International Bureau accordingly.

The [Registrar] may use Model Form 10 to notify the invalidation in [name of the country or intergovernmental organization] of an international registration (see Part VI).

#### MODEL PROVISION 19: RENEWAL OF AN INTERNATIONAL REGISTRATION AND RECORDINGS IN THE INTERNATIONAL REGISTER

This Model Provision implements the principle of centralized management of international registrations, whereby the renewal of an international registration and any recording made in the International Register in respect of an international registration for which [name of the country or intergovernmental organization] is a designated Contracting Party shall have the same effect as if it had been made directly in its Register of marks.

The Common Regulations envisage the recording in the International Register of licenses, restriction of the holder’s right of disposal, changes in the name, address and legal nature of the holder, changes in ownership, cancellations, renunciations and limitations.

Those recordings, to the extent that they concern [name of the country or intergovernmental organization] as a designated Contracting Party, have full effect in [name of the country or intergovernmental organization], without further requirements or formalities, and the [Registrar] must update its [national] [regional] database or Registry, as the case may be, accordingly.

The Common Regulations also envisage that an Office may declare that certain recordings have no effect. Under Rule 20*bis*(5) and 27(4) and (5), an Office may declare that the recording of a given license, a change in ownership or a limitation has no effect.

Where, in accordance with the laws of [name of the country or intergovernmental organization], the [Registrar] considers that a given license, a change in ownership or a limitation has no effect in [name of the country or intergovernmental organization], the [Registrar] must send a statement to this effect to the International Bureau within the time limits specified in the abovementioned Rules.

For example, the [Registrar] may consider that a recorded limitation is, in fact, an expansion of the original scope of protection. In that case, the [Registrar] may send the corresponding declaration.

The Common Regulations also envisage recordings concerning representation before the International Bureau. The Offices of the designated Contracting Parties are notified of such recordings for their information only.

Holders of international registrations are not required to have representation before the Offices of the designated Contracting Parties, unless they wish or need to address those Offices directly. In that case, holders must comply with the requirements for local representation, if any.

The [Registrar] may use Model Forms 11 and 12 to send, correspondingly, a declaration that a change in ownership has no effect and the final decision therefrom; and, Model Forms 13 and 14 to send, correspondingly, a declaration that a limitation has no effect and the final decision therefrom (see Part VI).

#### MODEL PROVISION 20: COLLECTIVE, CERTIFICATION AND/OR GUARANTEE MARKS

[A country] [An intergovernmental organization] may have provisions in its domestic legislation, which would allow for protection of collective, certification and/or guarantee marks. The domestic legislation may also specify that it would only one or two of these marks.

This Model Provision relates to the requirement under the [law] of [name of the country or intergovernmental organization] that applications to register collective, certification and guarantee marks must be accompanied by a copy of the regulations governing the use of such marks. Since copies of those regulations may not be filed with the International Bureau with an international application, it should be specified that the holders of those marks are required to submit those copies directly to the [Registrar]. Moreover, the regulations that govern the use of such marks must be submitted according to the relevant [articles] in the [Law].

#### MODEL PROVISION 21: REPLACEMENT

Article 4*bis* of the Madrid Protocol provides that where an international registration relates to a mark that is already registered in a designated Contracting Party for the same goods or services and in the name of the same person or entity, the international registration is deemed to replace the [national] [regional] registration, and that the Office of the designated Contracting Party should, upon request, take note of the international registration.

To implement Article 4*bis*, it should be provided that, where the holder of the international registration so requests, the [Registrar] will take note of the international registration in the Register of marks in connection with the record of the [national] [regional] registration.

However, the fact that the holder requests the [Registrar] to take note of the international registration should not entail a cancellation of the corresponding [national] [regional] registration of the mark. There is no physical replacement of the marks, despite the term used; both registrations should be allowed to co-exist, and cancellation or limitation of the [national] [regional] registration should only be effected upon express request from the holder of that registration.

#### MODEL PROVISION 22: TRANSFORMATION

Paragraph (1)(a) of this Model Provision is based on Article 9*quinquies* of the Madrid Protocol. Paragraph (1)(b) establishes the principle that an application resulting from transformation is, to all intents and purposes, the same as a standard [national] [regional] trademark application, subject to the special provisions of this Model Provision.

Paragraph (2) provides for the furnishing of additional information to enable the [Registrar] to confirm compliance with the conditions for transformation under Article 9*quinquies*. Applications resulting from transformation may be filed using the same official form as for the filing of ordinary applications, or a special form for transformation, although such form might not be necessary.

Paragraph (3)(a) provides that where, by virtue of an international registration, a mark had already become protected in [name of the country or intergovernmental organization], an application resulting from transformation should automatically lead to the registration of the mark in question (if all formal requirements have been met).

Paragraph (3)(b) provides that, where the mark that is the subject of an international registration had not yet become protected in [name of the country or intergovernmental organization] on the date of cancellation of the international registration, but certain steps have already been taken by the [Registrar] with regard to the substantive examination of a mark that is the subject of an international registration, the benefit of those steps should accrue to the application resulting from transformation and the remaining procedure should continue thereafter as for a standard application. This approach avoids unnecessary duplication of work and expense, both for the holder and the [Registrar].

[Name of the country or intergovernmental organization] would need to decide, in the provision itself, whether a special form is to be used and a fee is payable for this.

#### MODEL PROVISION 23: FURTHER PROVISIONS CONCERNING INTERNATIONAL REGISTRATIONS

For purposes of flexibility, it may be useful to introduce a general provision in accordance with which further provisions to facilitate procedures concerning international registrations may be included in the trademark regulations or in Office administrative instructions.

#### MODEL PROVISION 24: CONFLICT BETWEEN THE [LAW] AND THE MADRID PROTOCOL

It is useful to have a provision along the lines of that proposed in Model Provision 24 to address situations of conflict between the [Law] and the Madrid Protocol.

### **PART III – ISSUES FOR FURTHER CONSIDERATION**

#### **EXAMINATION OF INTERNATIONAL AND [NATIONAL] [REGIONAL] APPLICATIONS AND ADMINISTRATION OF REGISTRATIONS**

In the context of the accession to, and the operation of the Madrid System, there are a number of issues for consideration beyond the mere implementation of provisions in the [national] [regional] law. They relate, more specifically, to certain differences between the processing of [national] [regional] and international applications and registrations, to which attention should be drawn in the following paragraphs.

#### **INTERNATIONAL APPLICATIONS AND INTERNATIONAL REGISTRATIONS**

At the outset, it is recalled that, within the Madrid System, the [national] [regional] trademark Office will deal with two categories of cases: (i) international applications which are filed with it as Office of origin; and (ii) international registrations where [name of the country or intergovernmental organization] is the designated Contracting Party.

International applications are examined for formalities in accordance with the relevant provisions of the Madrid Protocol and the Common Regulations. Provisions in [national] [regional] trademark law regarding [national] [regional] applications are not applicable. As a consequence, relevant provisions of the Madrid Protocol and the Common Regulations apply to international applications instead of requirements which apply to [national] [regional] applications. This particularly concerns provisions relating to filing requirements, payment of fees and evidence to be provided.

[Certain kinds of trademarks (for example [associated trademarks ([Article] XX of the [Law])] or [series of trademarks ([Article] XX of the [Law])]) are not recognised by the Madrid System and cannot be applied for as such in international applications.] With respect to collective, certification and/or guarantee marks, the international application cannot be accompanied by the regulations governing the use of such marks. These regulations have to be submitted by the holder of the international registration separately and directly to the Office of the designated Contracting Party.

International registrations, in which [name of the country or intergovernmental organization] has been designated, have already undergone a formality examination in the Office of origin and in the International Bureau before being registered in the International Register. While the Trademark Office of the designated Contracting Party, in principle, examines those international registrations received in the same way as [national] [regional] applications for trademark protection, those formality requirements which have been subject to formality examination on the international level cannot be questioned during the [national] [regional] examination and diverging [national] [regional] requirements will not apply.

Moreover, the Madrid System provides for a centralized management of international registrations with effect for the designated Contracting Parties. This means that a number of requests for recording will be made in the International Register, which will have effect for [name of the country or intergovernmental organization] on the date when they are recorded in the International Register. Therefore, on the [national] [regional] level, no further formality requirements, beyond what is foreseen in the Madrid Protocol and the Common Regulations, will apply. For details on the central management of international registrations, please refer to the specific paragraphs below.

#### DATE OF THE INTERNATIONAL REGISTRATION

The date of the international registration, which is the equivalent to the filing date, follows from Article 3(1) and (4) of the Madrid Protocol. This means that the international registration shall bear the date on which the international application was received in the Office of origin. The date of receipt as indicated under Model Provision 5(1) has to be the date of the real receipt of the documents and cannot depend on the payment of a fee (not even the handling fee). Should the [Registrar] decide to require the payment of a handling fee for international applications, the only sanction available for the [Registrar] would be to transmit the international application to the International Bureau only once the payment has been received.

Where [name of the country or intergovernmental organization], in the future, will be a designated Contracting Party, the notification to the [Registrar], informing of the designation, will contain this date of the international registration. Where the territorial extension to [name of the country or intergovernmental organization] is made subsequently to the international registration (subsequent designation), the applicable date would be the date of the subsequent designation. See also Rule 24 of the Common Regulations.

#### CLAIMS TO PRIORITY

Checking priority claims is part of the formality examination undertaken by the International Bureau. A priority claim accepted by the International Bureau, will be binding on a designated Contracting Party. As a consequence, the [Registrar], when [name of the country or intergovernmental organization] is designated, cannot ask for any further evidence as to priority claims. Specifically, the formalities prescribed by Article 4, Section D of the Paris Convention do not need to be complied with.

#### CLASSIFICATION

The classification of goods and services will be controlled for international applications by the International Bureau in association with the Office of origin in accordance with Article 3(2) of the Madrid Protocol. In the event of disagreement with the [Registrar], the opinion of the International Bureau will prevail.

However, where [name of the country or intergovernmental organization] is designated in an international registration, the [Registrar] would not be bound by the indication of classes of goods and services with regard to the determination of the scope of protection of the mark (Article 4(2) of the Madrid Protocol).



## PUBLISHING FOR OPPOSITIONS

Under the Madrid System, it is not necessary, in principle, for an Office to re-publish marks that have been registered under the Madrid System and published in the *WIPO Gazette of International Marks*. See also above on Model Provision 11. However, where the [national] [regional] law provides an opposition system, it is advisable that the Office re-publish the mark to provide clear information on the start and end of the opposition period, which enhances legal security on trademark rights for right holders and third parties, having prior rights in [name of the country or intergovernmental organization].

If a [national] [regional] re-publication were to take place, the [Registrar] should ensure the mark to be advertised, without the holder needing to do anything; meaning the [Registrar] cannot charge fee for publication or require that the holder request such advertisement.

## CERTIFICATE

Under the Madrid System, the [Registrar] is required to issue, as the case may be, either notifications of provisional refusal (Article 5 of the Madrid Protocol, Rules 16 and 17 of the Common Regulations) or statements of grant of protection (Rule 18<sup>ter</sup> of the Common Regulations), which will provide precise information about the scope of protection of the mark in [name of the country or intergovernmental organization]. The statement of grant of protection would be equivalent to the [national] [regional] certificate that the [Registrar] will issue for [national] [regional] registrations.

## ADDRESS FOR SERVICE / LOCAL REPRESENTATIVE IN [NAME OF THE COUNTRY OR INTERGOVERNMENTAL ORGANIZATION]

It is important to note that, under the Madrid System, the applicant – and later the holder – of an international application is not required to engage a local representative or provide a local address for service in the designated Contracting Parties. The [national] [regional] law can require a holder to engage a local representative or provide a local address for service only where the Office of the designated Contracting Party concerned is refusing protection of the mark and where the holder would like to contest that decision by the [Registrar].

## CENTRAL MANAGEMENT OF AN INTERNATIONAL REGISTRATION

The international registration is protected for ten years from the date of international registration, with the possibility of renewal for further periods of 10 years, upon payment of the required fees.

Renewal of an international registration is covered by a central procedure, which would prevail over the [national] [regional] procedure. The international registration will be renewed directly before the International Bureau, which will inform all the concerned designated Contracting Parties of the renewal.

The International Bureau will collect the renewal fees and distribute these accordingly; the distribution time will depend on whether the Contracting Party concerned is under the standard fee regime (annually) or has declared individual fees (the following month). Where an international registration is not renewed, the International Bureau will also inform the concerned Contracting Parties of this non-renewal. The grace period with respect to the renewal of an international registration is six months in accordance with Article 7(4) of the Madrid Protocol.

The Madrid System provides a central management of an international registration, which allows that specified events concerning an international registration, such as amendments or changes, be recorded by the International Bureau in the International Register with effect in all the designated Contracting Parties concerned. Such central management covers particularly the recording of a limitation of the list of goods or services, the recording of a license or amendment to such license, the recording of a change in the name or address of the holder or the representative or the recording of a change in ownership. Where such changes have been recorded in the International Register, the Contracting Parties concerned will be notified of the changes and these changes will have effect in the Contracting Parties from the date of recording in the International Register. This means that [name of the country or intergovernmental organization] as a designated Contracting Party should not require any specific documentation or evidence or payment of fees provided for in [national] [regional] provisions with respect to the recording of these changes.

However, the Madrid System does not bind as to the substantive effect of certain changes and, on a case by case basis, the [Registrar] could declare that the recording of a change in ownership has no effect (Rule 27(4) of the Common Regulations), that the recording of a limitation has no effect (Rule 27(5) of the Common Regulations) or that the recording of a license has no effect (Rule 20*bis*(5) of the Common Regulations).

#### **PART IV – PRINCIPAL DECLARATIONS THAT MAY BE MADE IN CONNECTION WITH ACCESSION TO THE MADRID PROTOCOL**

A detailed explanation of all declarations provided for in the Madrid System may be found in the Guide.

There are possibly [five] declarations that may be of interest for [name of the country or intergovernmental organization].

The declarations mentioned below that are set out in the Articles in the Protocol must be signed by the same authority which may sign the instrument of accession, namely the Head of State, Head of Government or the Minister of Foreign Affairs. For other declarations, for example, under Rule 20*bis*(6) of the Common Regulations, it will be up to the Contracting Party to decide who should sign, the entities mentioned above or the IP Office.

1. EXTENSION OF THE REFUSAL PERIOD (ARTICLE 5(2)(B) OF THE MADRID PROTOCOL)

[A country] [An intergovernmental organization] acceding to the Madrid Protocol may declare that, in connection with an international registration in which it is designated, the time limit for the Office to notify the International Bureau of a provisional refusal of protection shall be 18 months, instead of 12 months. Such declaration may also be made after the [country] [intergovernmental organization] has acceded to the Madrid Protocol, in which case the declaration will enter into effect three months after its receipt by the Director General of WIPO, or at any later date indicated in the declaration.

2. FURTHER EXTENSION OF THE REFUSAL PERIOD WHERE THE REFUSAL IS BASED ON AN OPPOSITION (ARTICLE 5(2)(C) OF THE MADRID PROTOCOL)

[A country] [An intergovernmental organization] may further declare that, in the case of refusals based on an opposition, such refusals may be notified after the expiry of the 18-month time limit. Such declaration may be made at the time of its accession or at any later time, in which case that declaration will enter into force three months after its receipt by the Director General of WIPO, or at any later date indicated in the declaration.

3. INDIVIDUAL FEE (ARTICLE 8(7) OF THE MADRID PROTOCOL)

[A country] [An intergovernmental organization] acceding to the Madrid Protocol may declare that, in connection with each international registration in respect of which it is designated, and in connection with the renewal of such international registration, it wishes to receive an individual fee.

The amounts of the individual fee must not be higher than the fees that would be payable for registering the mark by means of an application made directly to the [Registrar], and should be lower than those fees by an amount reflecting the savings resulting from the international procedure.

The amounts of the individual fee should be expressed in the [national] [regional] currency. The Director General of WIPO will, in consultation with the Contracting Party concerned, establish the amounts of the fee in Swiss currency based on the official exchange rate of the United Nations. The first declaration under Article 8(7) must be signed by the Head of State, Head of Government or the Minister of Foreign Affairs, but any later declarations of changes in the amount can be made by the Office.

4. LICENSES (RULE 20B/S OF THE COMMON REGULATIONS)

The Office of a Contracting Party may make certain declarations concerning licensing, depending upon the legislation in that regard at the [national] [regional] level. This should be discussed with the International Bureau in advance of accession by a Contracting Party.

(a) Rule 20bis(6)(a)

Under Rule 20bis(6)(a) of the Common Regulations, the Office of a Contracting Party whose legislation does not provide 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 Contracting Party.

Such declaration may be made at any time.

(b) Rule 20bis(6)(b)

Under Rule 20bis(6)(b) of the Common Regulations, the Office of a Contracting Party whose legislation does provide 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 Contracting Party.

However, such notification may only be made before the date on which the Contracting Party becomes bound by the Madrid Protocol.

[5. DECLARATION OF INTENTION TO USE THE MARK (RULE 7(2) OF THE COMMON REGULATIONS)

As provided for by Rule 7(2) of the Common Regulations, a Contracting Party may notify the Director General of WIPO that it requires, when that Contracting Party is designated under the Madrid Protocol, a declaration of intention to use the mark.

Such 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 of WIPO, or at a later date indicated in the notification.]

**PART V – LINKS TO THE LEGAL FRAMEWORK OF THE MADRID PROTOCOL AND TO OTHER REFERENCE MATERIAL**

The full text of the Madrid Protocol can be found here  
[www.wipo.int/treaties/en/text.jsp?file\\_id=283484](http://www.wipo.int/treaties/en/text.jsp?file_id=283484)

The full text of the Common Regulations can be found here  
[www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=397995](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=397995).

The full text of the Administrative Instructions can be found here  
[www.wipo.int/treaties/en/text.jsp?file\\_id=281226](http://www.wipo.int/treaties/en/text.jsp?file_id=281226).

The Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol can be found here  
[www.wipo.int/madrid/en/guide/](http://www.wipo.int/madrid/en/guide/).

Making the Most of the Madrid System, a handbook with information and practical tips on how to use specific forms, can be found here  
[www.wipo.int/export/sites/www/madrid/en/forms/docs/making\\_the\\_most\\_of\\_the\\_madrid\\_system\\_mm\\_forms.pdf](http://www.wipo.int/export/sites/www/madrid/en/forms/docs/making_the_most_of_the_madrid_system_mm_forms.pdf).

Information regarding replacement can be found here  
[www.wipo.int/madrid/en/services/open\\_forum.html](http://www.wipo.int/madrid/en/services/open_forum.html).

Information on the practice of Offices concerning replacement can be found here  
[www.wipo.int/madrid/en/members/replacement.html](http://www.wipo.int/madrid/en/members/replacement.html) and  
[www.wipo.int/edocs/mdocs/madrid/en/mm\\_id\\_wg\\_12/mm\\_id\\_wg\\_12\\_5.pdf](http://www.wipo.int/edocs/mdocs/madrid/en/mm_id_wg_12/mm_id_wg_12_5.pdf).

## **PART VI – MODEL FORMS**

The International Bureau makes available to Offices a number of model forms for use in connection with Madrid procedures.

Copies of the model forms are reproduced below and the forms are available on the Madrid System website at the following address:

[www.wipo.int/madrid/en/contracting\\_parties/model\\_forms.html](http://www.wipo.int/madrid/en/contracting_parties/model_forms.html).

The model forms are as follows:

- Model Form 1: Information Relating to Possible Oppositions (Rule 16 of the Common Regulations)
- Model Form 2: Dates on which Opposition Period Begins and Ends (Rule 16(1)(b) of the Common Regulations)
- Model Form 3A: Total Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)
- Model Form 3B: Partial Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)
- Model Form 4: Final Disposition on Status of a Mark – Statement of Total Grant of Protection (Rule 18*ter*(1) of the Common Regulations)
- Model Form 5: Final Disposition on Status of a Mark – Statement of Total or Partial Grant of Protection Following a Provisional Refusal (Rule 18*ter*(2) of the Common Regulations)
- Model Form 6: Final Disposition on Status of a Mark –Confirmation of Total Provisional Refusal (Rule 18*ter*(3) of the Common Regulations)
- Model Form 7: Further Decision Affecting the Protection of a Mark (Rule 18*ter*(4) of the Common Regulations)
- Model Form 8: Completion of *Ex Officio* Examination – Interim Status of a Mark (Rule 18*bis* of the Common Regulations)
- Model Form 9: Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration, and Request for Cancellation of the International Registration (Rule 22(1)(a) or (c) and (2)(b) of the Common Regulations)
- Model Form 10: Invalidation (Rule 19 of the Common Regulations)
- Model Form 11: Declaration That a Change in Ownership Has No Effect (Rule 27(4) of the Common Regulations)
- Model Form 12: Final Decision That a Change in Ownership Has No Effect (Rule 27(4)(e) of the Common Regulations)

Model Form 13: Declaration That a Limitation Has No Effect (Rule 27(5) of the Common Regulations)

Model Form 14: Final Decision Stating That a Limitation Has No Effect (Rule 27(5)(e) of the Common Regulations)

## **MADRID PROTOCOL**

### **Model Form 1: Information Relating to Possible Oppositions (Rule 16 of the Common Regulations) [Note for filing]**

This form may only be used by an Office that has made the declaration under Article 5(2)(b) and (c) of the Protocol. The Office should send this form to the International Bureau when the period during which an opposition may be made, for a given international registration, will end too late for this Office to send a notification of a provisional refusal based on an opposition within the 18-month time limit referred to in Article 5(2)(b) of the Protocol.

The Office shall indicate the dates on which the opposition period begins and ends, if these dates are known at the time of this notice to the International Bureau. If those dates are not yet known, they shall be communicated to the International Bureau as soon as they are known (by using Model Form 2). If the opposition period is extendable, the Office may communicate only the date on which the opposition period begins.



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**MADRID PROTOCOL**

**Model Form 1: Information Relating to Possible Oppositions (Rule 16 of the Common Regulations)**

I.	Office communicating the information:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Dates of the opposition period:  <i>Please choose only one of the following options and, where applicable, indicate the dates of the opposition period:</i>  <input type="checkbox"/> Dates on which the opposition period begins and ends are known and indicated below:  <input type="checkbox"/> The opposition period is extendable and only the date on which the opposition period begins is indicated below:  <input type="checkbox"/> Dates on which the opposition period begins and ends are not yet known.  – Date on which the opposition period begins:  – Date on which the opposition period ends:
V.	Signature or official seal of the Office communicating the information:
VI.	Date of notification to the International Bureau:

[End of Model Form 1]

## **MADRID PROTOCOL**

### **Model Form 2: Dates on Which Opposition Period Begins and Ends (Rule 16(1)(b) of the Common Regulations) [Note for filing]**

This form may only be used where an Office has previously notified the International Bureau of possible oppositions using Model Form 1, but the dates of the opposition period were not known at that time. This form may be used by the Office to communicate those dates to the International Bureau.

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**MADRID PROTOCOL**

**Model Form 2: Dates on Which Opposition Period Begins and Ends (Rule 16(1)(b) of the Common Regulations)**

I.	Office communicating the information:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Dates of the opposition period:  <i>Please choose only one of the following options and indicate the date or dates, as the case may be, of the opposition period:</i>  <input type="checkbox"/> Dates on which the opposition period begins and ends are known and indicated below:  <input type="checkbox"/> The opposition period is extendable and only the date on which the opposition period begins is indicated below:  – Date on which the opposition period begins:  – Date on which the opposition period ends:
V.	Signature or official seal of the Office communicating the information:
VI.	Date of notification of the International Bureau:

[End of Model Form 2]

## MADRID PROTOCOL

### **Model Forms 3A and 3B: Total or Partial Provisional Refusal of Protection (Rule 17(1) of the Common Regulations) [Note for filing]**

An Office can use this form to communicate to the International Bureau a decision to refuse protection of the international registration in the Contracting Party, following *ex officio* examination (*ex officio* provisional refusal), opposition (provisional refusal based on opposition), or both.

The Office would need to specify to the International Bureau whether the provisional refusal is total, meaning for all the concerned goods and services, or only partial, for specific goods and services. To do this, the Office can choose between using Model Form 3A or 3B:

- Model Form 3A should be used where the Office is refusing protection for all the concerned goods and services (total refusal).
- Model Form 3B should be used where the Office is refusing protection for only a part of the goods and services (partial refusal).

Once all procedures before the Office have been completed, the Office shall communicate to the International Bureau a statement regarding the final decision on the status of protection of the mark. At that time, the Office should use Model Form 5 (Statement of grant of protection following a refusal) or Model Form 6 (Confirmation of total provisional refusal).

Where the provisional refusal is based on an opposition, alone or together with an *ex officio* refusal, the name and address of the opponent should also be provided.

Where a total refusal affecting all the goods or services is being notified, the indication under item V should read “all goods (or all services) in class X”.

In cases of partial refusal, a clear indication of those goods and/or services that are affected or those that are NOT affected should be provided.

Where the provisional refusal is based on an earlier mark, the indication required under item VII may be given by annexing a printout from the register or database.

If the Office requires that the holder accept a specific disclaimer to overcome the provisional refusal, the Office should indicate the disclaimer under item IX (iv) “Other requirements, if any”.

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**MADRID PROTOCOL**

**Model Form 3A: Total Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)**

I. Office making the notification:
II. Number of the international registration:
III. Name of the holder:
IV. Information concerning the type of provisional refusal:  <i>Please indicate the type of refusal by checking only one of the following options:</i>  <input type="checkbox"/> Total provisional refusal based on an <i>ex officio</i> examination  <input type="checkbox"/> Total provisional refusal based on an opposition  <input type="checkbox"/> Total provisional refusal based on both an <i>ex officio</i> examination and an opposition  <i>Where the refusal is based on an opposition, please indicate the name and address of the opponent:</i>  (i) Name of the opponent:  (ii) Address of the opponent:
V. Information concerning the scope of the provisional refusal:  Total provisional refusal affects all the goods and/or services.
VI. Grounds for refusal [(where applicable, see item VII)]:

VII. Information relating to an earlier mark:

- (i) Filing date and number, and, if any, priority date:
- (ii) Registration date and number (if available):
- (iii) Name and address of the owner:
- (iv) Reproduction of the mark:
- (v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):

VIII. Corresponding essential provisions of the applicable law:

IX. Information relating to the possibility to request a review or file an appeal:

- (i) Time limit for requesting review or appeal:
- (ii) Authority to which such request for review or appeal should be made:
- (iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:
- (iv) Other requirements, if any:

X. Signature or official seal of the Office making the notification:

XI. Date of the notification to the International Bureau:

[End of Model Form 3A]

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**MADRID PROTOCOL**

**Model Form 3B: Partial Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)**

I.	Office making the notification:
II.	Number of the international registration:
III.	Name of the holder:
IV.	<p>Information concerning the type of provisional refusal:</p> <p><i>Please indicate the type of refusal by checking only one of the following options:</i></p> <p><input type="checkbox"/> Partial provisional refusal based on an <i>ex officio</i> examination</p> <p><input type="checkbox"/> Partial provisional refusal based on an opposition</p> <p><input type="checkbox"/> Partial provisional refusal based on both an <i>ex officio</i> examination and an opposition</p> <p><i>Where the refusal is based on an opposition, please indicate the name and address of the opponent:</i></p> <p>(i) Name of the opponent:</p> <p>(ii) Address of the opponent:</p>



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/or services:*

- Partial provisional refusal affects only the following goods and/or services:
- Partial provisional refusal does NOT affect the following goods and/or services:

List of goods and/or services:

VI. Grounds for refusal [(where applicable, see item VII)]:

VII. Information relating to an earlier mark:

(i) Filing date and number, and, if any, priority date:

(ii) Registration date and number (if available):

(iii) Name and address of the owner:

(iv) Reproduction of the mark:

(v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):

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VIII. Corresponding essential provisions of the applicable law:
IX. Information relating to the possibility to request a review or file an appeal:  (i) Time limit for requesting review or appeal:  (ii) Authority to which such request for review or appeal should be made:  (iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:  (iv) Other requirements, if any:
X. Signature or official seal of the Office making the notification:
XI. Date of the notification to the International Bureau:

[End of Model Form 3B]

## **MADRID PROTOCOL**

### **Model Form 4: Final Disposition on Status of a Mark – Statement of Total Grant of Protection (Rule 18ter(1) of the Common Regulations) [Note for filing]**

This form may only be used where the Office 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) of the Protocol.

Protection is granted to the mark for **all** the goods and/or services listed in the international registration. It is **not** appropriate to list the goods and/or services in this form.

Where the Office has previously communicated to the International Bureau a provisional refusal, it needs to follow up with a statement regarding the final decision on the status of protection of the mark, using either Model Form 5 or 6.

**MADRID PROTOCOL**

**Model Form 4: Final Disposition on Status of a Mark – Statement of Total Grant of Protection (Rule 18ter(1) of the Common Regulations)**

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Protection is granted to the mark that is the subject of this international registration for all the goods and/or all the services for which protection has been requested.
V.	Signature or official seal of the Office sending the statement:
VI.	Date of notification to the International Bureau:

[End of Model Form 4]

## **MADRID PROTOCOL**

### **Model Form 5: Final Disposition on Status of a Mark – Statement of Total or Partial Grant of Protection Following a Provisional Refusal (Rule 18ter(2) of the Common Regulations) [Note for filing]**

An Office may use this form where 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, has now decided to grant protection to some or all of the goods and services listed in the international registration. This decision concluded all procedures before the Office.

The Office shall tick only one of the boxes in item (iv) to indicate whether protection is total or partial.

required in item (iv).

Where protection is granted to some of the goods and services, a clear indication of the goods and services that are protected shall be provided. This indication could be, for instance, “all goods (or all services) in class X”.

Where a further review or appeal against this decision before an authority outside the Office is still possible, the Office should provide the information in item (vi), where available.

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**MADRID PROTOCOL**

**Model Form 5: Final Disposition on Status of a Mark – Statement of Total or Partial Grant of Protection Following a Provisional Refusal (Rule 18ter(2) of the Common Regulations)**

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder:
IV.	The Office has completed all its procedures and this is the decision by the Office: <input type="checkbox"/> Total protection is granted for <u>all</u> the goods and/or services (Rule 18ter(2)(i)) <input type="checkbox"/> Partial protection is granted to the following goods and/or services (Rule 18ter(2)(ii)):
V.	Disclaimer or Reservation:  <i>Please specify the element(s) of the mark for which protection cannot be granted:</i>  <i>Please also specify, by checking only one of the options below, whether the disclaimer or reservation applies to:</i>  <input type="checkbox"/> All of the goods and/or services <input type="checkbox"/> Only the following goods and/or services:

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<p>VI. Where a further review or appeal against this decision before an authority outside the Office is still possible, the Office should provide the following information, where available:</p> <p>(i) Time limit for requesting review or appeal:</p> <p>(ii) Authority to which such request for review or appeal should be made:</p> <p>(iii) Whether the request for review or appeal has to be filed in a specific language or through the intermediary of a representative whose address is within the territory of the Contracting Party:</p>
<p>VII. Signature or official seal of the Office sending the statement:</p>
<p>VIII. Date of notification to the International Bureau:</p>

[End of Model Form 5]

## **MADRID PROTOCOL**

### **Model Form 6: Final Disposition on Status of a Mark – Confirmation of Total Provisional Refusal (Rule 18~~ter~~(3) of the Common Regulations) [Note for filing]**

An Office may use this form where it has previously notified the International Bureau of a total provisional refusal (using Model Form 3A) and, after having completed all its procedures, has now decided to confirm the total refusal of the international registration. This decision concluded all procedures before the Office.

Where a further review or appeal against this decision before an authority outside the Office is still possible, the Office should provide the information in item (v), where available.



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**MADRID PROTOCOL**

**Model Form 6: Final Disposition on Status of a Mark – Confirmation of Total Provisional Refusal (Rule 18~~ter~~(3) of the Common Regulations)**

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder:
IV.	The Office has completed all its procedures and this is the decision by the Office:  Protection of the mark is refused for <u>all</u> the goods and/or services.
V.	Where a further review or appeal against this decision before an authority outside the Office is still possible, the Office should provide the following information, where available:  (i) Time limit for requesting review or appeal:  (ii) Authority to which such request for review or appeal should be made:  (iii) Whether the request for review or appeal has to be filed in a specific language or through the intermediary of a representative whose address is within the territory of the Contracting Party:
VI.	Signature or official seal of the Office sending the statement:
VII.	Date of notification to the International Bureau:

## MADRID PROTOCOL

### **Model Form 7: Further Decision Affecting the Protection of a Mark (Rule 18ter(4) of the Common Regulations) [Note for filing]**

This form may be used 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) of the Madrid Protocol has expired without the Office sending a notification of provisional refusal; or,
- the Office has sent a statement of total grant of protection (Rule 18ter(1) of the Common Regulations 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) of the Common Regulations using Model Form 5); or,
- the Office has sent a confirmation of total provisional refusal (Rule 18ter(3) of the Common Regulations using Model Form 6).

The decision can be by an authority outside the Office, where a subsequent decision is resulting from an appeal decision. The decision can also be by the Office, where a further decision, following the completion of its regular procedures, is resulting from a request for reinstatement of rights or *restitutio in integrum*.

**MADRID PROTOCOL**

**Model Form 7: Further Decision Affecting the Protection of a Mark (Rule 18ter(4) of the Common Regulations)**

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder:
IV. Goods and Services affected by the further decision:  <i>Please check the box that applies (only one box) and indicate, where applicable, the goods and services that are now protected:</i>  <input type="checkbox"/> Total protection is granted for <u>all</u> the goods and/or services  <input type="checkbox"/> Partial protection is granted to the following goods and/or services:  <input type="checkbox"/> Total refusal for <u>all</u> the goods and/or services
IVbis. Disclaimer or Reservation:  <i>Please specify the element(s) of the mark for which protection cannot be granted:</i>  <i>Please also specify, by checking only one of the options below, whether the disclaimer or reservation applies to:</i>  <input type="checkbox"/> All of the goods and/or services  <input type="checkbox"/> Only the following goods and/or services:

V. Signature or official seal of the Office sending the statement:

VI. Date of notification to the International Bureau:

[End of Model Form 7]

## MADRID PROTOCOL

### **Model Form 8: Completion of *Ex Officio* Examination – Interim Status of a Mark (Rule 18*bis* of the Common Regulations) [Note for filing]**

This form can be used where an Office wishes to inform that *ex officio* examination has been completed, without finding any grounds for refusal, but where protection of the mark is still subject to opposition or observations by third parties.

This form can be used whether a notification of provisional refusal has been previously communicated or not.

The Office would need to communicate a notification to the International Bureau at a later date under Rules 17 or 18*ter* of the Common Regulations, using Model Form 3, 4 or 5, depending on the situation:

- Where an opposition is later 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 later filed, the Office should notify of a statement of grant of protection under Rule 18*ter*(1), using Model Form 4, or notify of a statement of grant of protection following a provisional refusal under Rule 18*ter*(2), using Model Form 5.

Please note that if an Office has made the declaration under Article 5(2)(c) to allow the notification of provisional refusal based on opposition after the 18-month time limit, it would be necessary for the Office to use Model Form 2 to inform the International Bureau in accordance with Rule 16(1).

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**MADRID PROTOCOL**

**Model Form 8: Completion of *Ex Officio* Examination – Interim Status of a Mark  
(Rule 18*bis* of the Common Regulations)**

I. Office sending the statement:
II. Number of the International Registration:
III. Name of the holder:
IV. Information concerning a possible previous notification of provisional refusal: A notification of provisional refusal: <input type="checkbox"/> has NOT been communicated by the Office (Rule 18 <i>bis</i> (1)(a)) <input type="checkbox"/> has been communicated by the Office (Rule 18 <i>bis</i> (1)(b))
V. Information concerning the opposition period or the period to file observations: (i) Date on which the opposition period or the period to file observations begins:  (ii) Date on which the opposition period or the period to file observations ends:
VI. Signature or official seal of the Office sending the statement:
VII. Date of notification to the international Bureau:

[End of Model Form 8]

## MADRID PROTOCOL

### **Model Form 9: Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration, and request for cancellation of the international registration (Rule 22(1)(a) or (c) and (2)(b) of the Common Regulations) [Note for filing]**

This form should be used where the protection resulting from the international registration may no longer be invoked, in whole or in part, because:

- the basic application is the subject of a final decision of rejection or has been withdrawn; or,
- the basic registration is canceled, renounced, revoked, invalidated or has lapsed,

provided that this happens within a period of five years from the date of the international registration or as a result of an action commenced within that period. Where this is the case, the Office is required to request the cancellation of the international registration, in accordance with Article 6(4) of the Madrid Protocol.

The goods and/or services to be indicated here are as follows:

- those goods and/or services in the international registration concerned which are affected by the facts and decisions, or
- if there has already been a partial cancellation, those, out of the remaining goods and/or services, which are affected by the facts and decisions.

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/or services that are affected or those that are NOT affected should be provided.

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**MADRID PROTOCOL**

**Model Form 9: Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration, and request for cancellation of the international registration (Rule 22(1)(a) or (c) and (2)(b) of the Common Regulations)**

I.	Office making the notification:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Facts and decisions affecting the basic application, the registration resulting therefrom, or the basic registration and their effective date:  <i>Please briefly state these facts and decisions:</i>  Voluntary information:  <input type="checkbox"/> Not resulting from an action brought by a third party  <input type="checkbox"/> Resulting from an action brought by a third party, for example, an opposition or a request for cancellation ("central attack").
V.	Effective date of these facts and decisions:



VI. Goods and services affected by the facts and decisions:

*Please choose only one of the following options and, where applicable, list the goods and/or services:*

Total cancellation:

- The facts and decisions affect all the goods and/or services of the international registration

Partial cancellation:

- The facts and decisions affect only the goods and/or services of the international registration listed below
- The facts and decisions do not affect the goods and/or services of the international registration listed below

List of goods and /or services:

VII. Request for the cancellation of the international registration:

In accordance with Article 6(4) of the Madrid Protocol, the undersigned Office hereby requests the cancellation of the international registration to the extent indicated under item VI.

VIII. Signature or official seal of the Office making the notification:

IX. Date of notification to the International Bureau:

[End of Model Form 9]

## **MADRID PROTOCOL**

### **Model Form 10: Invalidation (Rule 19 of the Common Regulations) [Note for filing]**

This form may only be used where the competent authorities of a designated Contracting Party have invalidated (including, for example, revoked, annulled or canceled) the effects of an international registration in its territory in accordance with Article 5(6) of the Madrid Protocol and Rule 19 of the Common Regulations, and the invalidation is no longer subject to appeal.

Invalidation can be pronounced because the holder has not complied with provisions of the law of the Contracting Party, for example, 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.

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/or services that are affected or those that are NOT affected should be provided.

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**MADRID PROTOCOL**

**Model Form 10: Invalidation (Rule 19 of the Common Regulations)**

I. Office making the notification:
II. Number of the international registration:
III. Date of notification by WIPO:
IV. Name of the holder:
V. Authority which pronounced the invalidation:
VI. Date on which the invalidation was pronounced and its effective date: – Date on which the invalidation was pronounced: – Effective date of the invalidation (if possible):
VII. Scope of the invalidation:  <i>Please indicate the scope of the invalidation by choosing only one of the three options listed below and, where applicable, listing the goods and services concerned:</i>  Total invalidation: <input type="checkbox"/> The invalidation concerns <u>all</u> the goods and/or services of the international registration  Partial invalidation: <input type="checkbox"/> The invalidation concerns <u>only</u> the goods and/or services of the international registration listed below <input type="checkbox"/> The invalidation does NOT concern the goods and/or services of the international registration listed below  List of goods and/or services:

VIII. Signature or official seal of the Office making the notification:  The undersigned Office hereby states the fact that the invalidation is no longer subject to appeal.
IX. Date of notification to the International Bureau:

[End of Model Form 10]

## **MADRID PROTOCOL**

### **Model Form 11: Declaration That a Change in Ownership Has No Effect (Rule 27(4) of the Common Regulations) [Note for filing]**

This form may only be used where the Office of a designated Contracting Party, which has been notified by the International Bureau of a change in ownership, declares that this 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 International Bureau sent the notification of the change in ownership to the Office.

The goods and/or services to be indicated under item VI are those goods and/or services in the international registration concerned that were the subject of the change in ownership and that are affected by the declaration. 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".

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**MADRID PROTOCOL**

**Model Form 11: Declaration That a Change in Ownership Has No Effect (Rule 27(4) of the Common Regulations)**

I.	Office making the declaration:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Reasons for which the change in ownership has no effect:
V.	Corresponding essential provisions of the applicable law:
VI.	<p>Goods and/or services affected by the declaration:</p> <p><i>Please, check only one of the following options and list, where applicable, the goods and/or services concerned:</i></p> <p>This declaration affects:</p> <p><input type="checkbox"/> <u>all</u> the goods and/or services of the international registration that were the subject of the change in ownership</p> <p><input type="checkbox"/> <u>only</u> the goods and/or services of the international registration that were the subject of the change in ownership and that are listed below:</p> <p>List of goods and/or services:</p>

VII. Information concerning a possible review or appeal:

*Please select only one of the following options:*

- This declaration is final and no longer subject to review or appeal
- This declaration is still subject to review or appeal

*Please, provide the following information:*

- (i) Time limit for requesting review or appeal:
- (ii) Authority to which such request for review or appeal should be made:
- (iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:

VIII. Signature or official seal of the Office making the declaration:

IX. Date of communication to the International Bureau:

[End of Model Form 11]

## **MADRID PROTOCOL**

### **Model Form 12: Final Decision That a Change in Ownership Has No Effect (Rule 27(4)(e) of the Common Regulations) [Note for filing]**

This form may only be used where the Office of a designated Contracting Party, which has previously made a declaration under Rule 27(4) using Model Form 11, now wishes to communicate a final decision relating to that declaration.

The goods and/or services to be indicated under item IV are those goods and/or services in the international registration concerned that were the subject of the change in ownership and that are still affected by the declaration. 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”.



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**MADRID PROTOCOL**

**Model Form 12: Final Decision That a Change in Ownership Has No Effect  
(Rule 27(4)(e) of the Common Regulations)**

I. Office making the declaration:
II. Number of the international registration:
III. Name of the holder:
IV. Information concerning the goods and/or services:  <i>Please indicate the scope of the declaration by choosing only one of the following options and, where applicable, listing the goods and/or services:</i>  <input type="checkbox"/> The final decision confirms the previous declaration  <input type="checkbox"/> The final decision reverses the previous declaration, meaning that the change in ownership has effect in the Contracting Party  <input type="checkbox"/> The final decision <u>partially</u> reverses the previous declaration, meaning that the declaration still affects the goods and/or services listed below:  List of goods and/or services:
V. Signature or official seal of the Office making the declaration:
VI. Date of communication to the International Bureau:

[End of Model Form 12]

## **MADRID PROTOCOL**

### **Model Form 13: Declaration That a Limitation Has No Effect (Rule 27(5) of the Common Regulations) [Note for filing]**

This form may only be used where the Office of a designated Contracting Party, which has been notified by the International Bureau of a limitation of the list of goods and services under Rule 25, declares that this limitation 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 International Bureau sent the notification of the limitation to the Office.

The goods and/or services to be indicated under item VI are those goods and/or services for which the international registration concerned continues to have effect in the Contracting Party. Where the international registration is limited to the goods or services included in a given class or classes only, the indication should read "limited to class X only; other classes deleted" or "limited to classes X, Y, Z only; other classes deleted".

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**MADRID PROTOCOL**

**Model Form 13: Declaration That a Limitation Has No Effect (Rule 27(5) of the Common Regulations)**

I.	Office making the declaration:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Reasons for which the limitation has no effect:
V.	Corresponding essential provisions of the applicable law:
VI.	<p>Goods and/or services affected by the declaration:</p> <p><i>Please, check only one of the following options and list, where applicable, the goods and/or services concerned:</i></p> <p>This declaration affects:</p> <p><input type="checkbox"/> <u>all</u> the goods and/or services of the international registration that were the subject of the limitation</p> <p><input type="checkbox"/> <u>only</u> the goods and/or services of the international registration that were the subject of the limitation and that are listed below:</p> <p>List of goods and/or services:</p>

VII. Information concerning a possible review or appeal:

*Please select only one of the following options:*

- This declaration is final and no longer subject to review or appeal
- This declaration is still subject to review or appeal

*Please, provide the following information:*

- (i) Time limit for requesting review or appeal:
- (ii) Authority to which such request for review or appeal should be made:
- (iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:

VIII. Signature or official seal of the Office making the declaration:

IX. Date of communication to the International Bureau:

[End of Model Form 13]

## **MADRID PROTOCOL**

### **Model Form 14: Final Decision Stating That a Limitation Has No Effect (Rule 27(5)(e) of the Common Regulations) [Note for filing]**

This form may only be used where the Office of a designated Contracting Party, which has previously made a declaration under Rule 27(5) using Model Form 13, now wishes to communicate a final decision relating to that declaration.

The goods and/or services to be indicated under item IV are those goods and/or services for which the international registration concerned continues to have effect in the Contracting Party. Where the international registration is limited to the goods or services included in a given class or classes only, the indication should read “limited to class X only; other classes deleted” or “limited to classes X, Y, Z only; other classes deleted”.

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**MADRID PROTOCOL**

**Model Form 14: Final Decision Stating That a Limitation Has No Effect (Rule 27(5)(e) of the Common Regulations)**

I.	Office making the declaration:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Information concerning the goods and/or services:  <i>Please indicate the scope of the declaration by choosing only one of the following options and, where applicable, listing the goods and/or services:</i>  <input type="checkbox"/> The final decision confirms the previous declaration  <input type="checkbox"/> The final decision reverses the previous declaration, meaning that the limitation has effect in the Contracting Party  <input type="checkbox"/> The final decision <u>partially</u> reverses the previous declaration, meaning that the limitation is limited to the goods and/or services listed below:  List of goods and/or services:
V.	Signature or official seal of the Office making the declaration:
VI.	Date of communication to the International Bureau: