

REPLACEMENT: OBJECTIVES

Replacement is a fundamental feature of the Madrid System. Its principle is established by Article 4*bis* of the Madrid Agreement Concerning the International Registration of Marks and by Article 4*bis* of the Madrid Protocol Relating to the Madrid Agreement (hereinafter referred to as “Article 4*bis*”, “the Agreement” and “the Protocol”, respectively). Replacement is also addressed under Rule 21 of the Common Regulations under the Agreement and the Protocol (hereinafter referred to as “the Common Regulations”).

Article 4*bis*(1)

Article 4*bis*(1) provides that a mark that is the subject of a national or regional registration in the Office of a Contracting Party is, under certain conditions, deemed to be replaced by an international registration of the same mark.

Article 4*bis*(1) was adopted and included in the text of the Madrid Agreement at the Conference of Brussels on December 14, 1900. The concern underlying the adoption of the provision was the possibility of an international registration being rejected by the Office of a designated Contracting Party on the ground that the mark in question was already protected at the national level in the territory concerned. This would have considerably undermined the efficacy of the Madrid international trademark registration system¹.

According to the more precise text of the Protocol, the conditions under which replacement takes place are the following²:

- (i) both the national or regional registration and the international registration are in the name of the same holder,
- (ii) protection resulting from the international registration extends to the Contracting Party in question,
- (iii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the Contracting Party in question and

¹ As noted in the records of the Diplomatic Conference in Chapter IV of the “Programme Provisoire”, page 59.

² In the Basic Proposal for the Madrid Protocol submitted at the Conference of Madrid of 1989, the notes concerning Article 4*bis*(1) stated that “this provision – as well as paragraph (2) – is in essence the same as it is in the Stockholm Act but has been redrafted for greater clarity.” Aside from the addition of the words “without prejudice to any rights acquired by virtue of the latter” – similar to the wording found in the Agreement – and from merely editorial changes, Article 4*bis*(1) of the Protocol was adopted as proposed. Against this background, the position of the International Bureau is that the conditions under which replacement takes place are the same under the Agreement and the Protocol. See in particular the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol*, WIPO publication No. 455 paragraph 87.01.

(iv) the extension of the international registration to that Contracting Party takes effect after the date of the national or regional registration.

Furthermore, it is expressly stated in Article 4*bis*(1) that the international registration is deemed to replace the national or regional registration without prejudice to any rights acquired by virtue of the latter.

Article 4*bis*(2)

Article 4*bis*(2) provides that the office in whose national or regional register the mark is recorded, is required, upon request, to take note in its register of the international registration.

Article 4*bis*(2) was adopted for inclusion in the Madrid Agreement at the Conference of London in 1934. The purpose of this supplementary provision was to confer upon the holder of an international registration additional certainty and security and to facilitate the making available of information to interested third parties.

It should be underlined that the formality of an office taking note in its register of an international registration, pursuant to Article 4*bis*(2), is not a precondition of replacement. Article 4*bis*(2) merely provides that an office shall “upon request” be required to take note. In other words, provided the conditions under Article 4*bis*(1) have been met, replacement takes place and the possibility of requesting an office to take note of that fact is an option which the holder may elect, or not, to exercise. However, apart from the qualification relating to earlier acquired rights, neither the Agreement nor the Protocol elaborates further on the effects of replacement.

Rule 21(1)

Rule 21(1) of the Common Regulations, which entered into force on April 1, 1996, further provides that where, following a request by the holder, an office has taken such a note in its register, that office is required to notify the International Bureau accordingly³.

The notification should indicate the following:

- (i) the number of the international registration concerned,
- (ii) where the replacement concerns only some of the goods and services in the international registration, those goods and services, and
- (iii) the filing date and number, the registration date and number, and the priority date, if any, of the national or regional registration which has been replaced by the international registration.

³ Rule 21 was introduced with the adoption of the Common Regulations, which entered into force on April 1, 1996. There was no equivalent procedure in the Regulations under the Agreement.

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration, in a form agreed between the International Bureau and the Office concerned⁴. To date, no such agreement has been entered into between the International Bureau and any Office.

Rule 21(2)

Pursuant to Rule 21(2) of the Common Regulations, the International Bureau then records and publishes the above indications.

The purpose of these procedures is to ensure that the relevant information concerning the replacement is made available to third parties in the national or regional registers, as well as in the International Register⁵.

For more detailed information concerning the replacement, please refer to Madrid Working Group document number MM/LD/WG/3/3, which can be found at the following urls:

- http://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_3/mm_ld_wg_3_3.doc
(English)
- http://www.wipo.int/edocs/mdocs/madrid/fr/mm_ld_wg_3/mm_ld_wg_3_3.doc
(French)
- http://www.wipo.int/edocs/mdocs/madrid/es/mm_ld_wg_3/mm_ld_wg_3_3.doc
(Spanish)

⁴ This followed a recommendation of the Madrid Working Group which was adopted by the Assembly of the Madrid Union at its 37th session, in order to broaden the scope of Rule 21(1) by allowing the communication by Offices to the International Bureau of information relating to “other rights” acquired by virtue of a replaced national or regional registration. The amendment came into force on April 1, 2007.

⁵ See paragraph 28 of document GT/PM/VI/10, *Comment on Some of the Rules of the Draft Common Regulations Under the Madrid Agreement and the Madrid Protocol* (Working Group on the Application of the Madrid Protocol of 1989).