

# PART A

## INTRODUCTION

### THE GUIDE

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

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

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

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

01.05 Provisions cited in the margin are noted as follows:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

### **Advantages of the System**

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

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

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

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

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

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

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

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

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

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

### Applicable Treaty

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

*Rule 1(xvii) and (xviii)*

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

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

### BECOMING PARTY TO THE AGREEMENT OR PROTOCOL

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

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

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

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

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

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

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

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

## **DECLARATIONS AND NOTIFICATIONS BY CONTRACTING PARTIES**

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

### **Common Office of Several States**

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

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

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

### **Territorial Effect**

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

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

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

### **Limitation Concerning Existing Marks**

#### **Under the Agreement**

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

#### **Under the Protocol**

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

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

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

## Notification of Decisions Following a Provisional Refusal of Protection

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

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

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

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

## Individual Fees

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

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

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

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

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

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

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

## **Presentation of Subsequent Designations**

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

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

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

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

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

*Rule 7(3)(b)*

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

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

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

### **Collecting and Forwarding Fees**

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

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

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

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

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

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

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

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

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

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

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

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

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

## **PUBLIC INFORMATION ABOUT INTERNATIONAL REGISTRATIONS**

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

### **The Gazette**

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

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

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

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

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

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

## ROMARIN

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

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

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

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

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

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

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

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

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

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

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

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

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

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

### **Annual Statistics**

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