

PART B

PROCEDURE

CHAPTER I: GENERAL

INTRODUCTION

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

COMMUNICATIONS WITH THE INTERNATIONAL BUREAU

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

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

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

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

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

Modalities of Communications

*A.I. Sections 6, 8
and 11*

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

Communications in Writing

*A.I. Sections 8
and 11*

02.02 Communications addressed to the International Bureau may be delivered by hand, sent by mail (through a postal or other delivery service) or by facsimile, or by electronic means.

A.I. Section 6

A.I. Section 7

02.03 Any communication in writing which is addressed to the International Bureau must be typed or otherwise printed. Handwritten communications are not acceptable. The communication must be signed. The signature may be handwritten, printed or stamped, or may be replaced by a seal. There is no need to indicate in letters the name of the person whose seal is used.

A.I. Section 6(b)

02.04 If several documents are mailed to the International Bureau in one envelope, they should be accompanied by a list identifying each one of them. The International Bureau will inform the sender of any discrepancy between the list and what is actually received.

Facsimile

A.I. Section 8

02.05 Any communication may be sent to the International Bureau by facsimile. Where a communication is required to be presented on an official form, that form must be used for the purposes of any facsimile communication.

A.I. Section 9(a)

02.06 Where a communication has been sent to the International Bureau by facsimile, the original document must not be sent, since there is a risk that it will be mistaken for a new communication. There is one exception to this rule: where the international application is sent by the Office of origin to the International Bureau by facsimile, that Office must also send the original of the page of the international application bearing the reproduction(s) of the mark.

- A.I. Section 10(a)* 02.07 Provided the sender can be identified and can be reached by facsimile, the International Bureau will promptly inform him, by facsimile, of the receipt of the facsimile communication, and of any deficiencies in the transmission (for example, if it is incomplete or illegible).
- A.I. Section 10(b)* 02.08 Where, because of a time difference between Geneva and the place from which it was sent, the date on which the transmittal of a communication by facsimile was started is different from the date on which it was received by the International Bureau, the earlier of the two dates shall be considered to be the date of receipt by the International Bureau.

Electronic Communications

- A.I. Section 11(a)(i)* 03.01 Any communication between an Office and the International Bureau, including the presentation of an international application, may be made by electronic transmission. The modalities for such communication, including the presentation of the content of official forms and the means for self-identification of the sender, are a matter for agreement between each Office and the International Bureau.
- 03.02 The International Bureau has already established electronic communications with a number of Offices and a substantial proportion of international applications are now transmitted electronically to the International Bureau. Electronic communication is also used by a number of Offices for the transmission of refusals, statements of grant of protection and modifications. In addition, the number of Offices to which the International Bureau sends notifications electronically continues to increase.
- A.I. Section 11(a)(ii)* 03.03 Communications between the International Bureau and applicants and holders may also take place by electronic means, at a time and in a manner and format to be determined by the International Bureau. The particulars of the modality of such communications will be published in the Gazette.
- A.I. Section 11(b)* 03.04 Provided the sender can be identified and can be reached, the International Bureau will promptly, by electronic transmission, confirm receipt of the electronic communication, and of any deficiencies in the transmission (for example, if it is incomplete or illegible).
- A.I. Section 11(c)* 03.05 Where, because of a time difference between the place from where an electronic communication has been sent and Geneva, the date on which the transmittal of a communication by electronic means was started is different from the date on which it was received by the International Bureau, the earlier of the two dates shall be considered to be the date of receipt by the International Bureau.
- Rule 30* 03.06 In 2006, WIPO introduced an online international trademark renewal service enabling users to maintain their trademark rights simply and economically and, more recently, online facilities were made available to users wishing to file a request for the continuation of protection of their trademarks in accordance with Rule 39 of the Common Regulations.
- Rule 39*

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

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

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

Official Forms

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

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

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

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

“6. Priority: *Not applicable*”;

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

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

Continuation Sheets

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

Indication of Dates

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

Optional Forms

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

Calculation of Time Limits

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

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

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

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

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

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

Rule 32(2)(v)

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

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

Irregularities in Postal and Delivery Services

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

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

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

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

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

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

Languages

General Principles

Trilingual Regime

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

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

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

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

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

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

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

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

PAYMENT OF FEES TO THE INTERNATIONAL BUREAU

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

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

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

Rule 32(2)(iv)

Currency of Payment

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

Mode of Payment

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

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

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

(a) where an *irregularity notice* has been issued by the International Bureau, and any amount of fee is due with respect to an international application, a subsequent designation, a request for the recording of a change or of a license, a request for amendment of the recording of a license or the renewal of an international registration;

(b) where a notification concerning the payment of the second part of the individual fee has been issued by the International Bureau in respect of the designation of any Contracting Party;

(c) where an invitation to request the continuation of effects of international registrations in a successor State has been issued by the International Bureau.

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

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

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

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

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

Date of Payment

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

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

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

Change in the Amount of Fee

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

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

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

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

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

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

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

Fee Reduction for Applicants from Least Developed Countries (LDCs)

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

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

REPRESENTATION BEFORE THE INTERNATIONAL BUREAU

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

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

Appointment of Representative

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

Method of Appointment

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

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

In a Separate Communication

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

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

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

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

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

Only One Representative

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

Irregular Appointment

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

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

Recording and Notification of Appointment

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

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

Effect of the Appointment

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

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

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

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

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

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

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

Cancellation of Appointment

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

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

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

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

Cancellation at the Request of the Representative

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

Rule 3(6)(c)

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

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

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

Notification of Cancellation

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

No Fee for Recording

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