



WORLD INTELLECTUAL PROPERTY ORGANIZATION

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MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND PROTOCOL RELATING TO THAT AGREEMENT

Date of Subsequent Designation

Introduction

1. Under Rule 24(6)(b) of the Common Regulations, a subsequent designation which is presented to the International Bureau through an Office bears the date on which it was received by that Office (provided that it is received by the International Bureau within two months of that date and that it does not contain irregularities which affect the date). This provision is new. Before the Common Regulations came into force on April 1, 1996, it was not possible for a subsequent designation to bear a date earlier than that on which it was received by the International Bureau.

2. In general, the possibility of being accorded an earlier date will be of advantage to the holders of international registrations. In certain circumstances however, this new possibility can cause complications, of which holders and their representatives should be aware.

Subsequent Designation Presented Before Renewal

3. A subsequent designation which is presented through an Office shortly before renewal of the international registration is due but reaches the International Bureau after that date will nonetheless bear a date earlier than the renewal date. It will therefore expire on that date. For example, an international registration was due for renewal on August 1; on July 10, a subsequent designation was filed with the Office of origin and was forwarded to the International Bureau, which received it on August 12. As a consequence of Rule 24(6)(b), the subsequent designation bears the date of July 10. However, before the subsequent designation was received by the International Bureau, the international registration became due for renewal (on August 1). At that time, it was not yet possible for the International Bureau to charge the additional complementary fee or (where appropriate) the individual fees required in respect of the newly-designated Contracting Party, and a complementary renewal will have to be requested, involving the payment of a surcharge.

Subsequent Designation Presented at Same Time as Request to Record Other Change

4. In contrast to a subsequent designation, the recordal of a change under Rule 25 is deemed to take effect when it is actually recorded in the International Register, whether the request to record the change was presented through an Office or direct to the International Bureau. Thus, where a request for the recordal of a change is presented at the same time as, or even before, a subsequent designation which is presented through an Office, the subsequent designation may bear a date which is earlier than the effective date of the change.

5. The legal consequences of this are, to say the least, uncertain and may not be what the holder intended. For example, it sometimes happens that a holder wishes to renounce the protection in respect of a particular Contracting Party (because of a threatened refusal by that Contracting Party) and then immediately re-extend the protection to that Contracting Party by means of a subsequent designation. If the renunciation and the subsequent designation are presented simultaneously through an Office then, as a consequence of Rule 24(6)(b), the renunciation with respect to the Contracting Party concerned will take effect *after* the new territorial extension to that Contracting Party.

Avoiding these problems

6. In order to avoid problems of the kind described above, where a subsequent designation is presented through an Office but the holder wishes it to bear a date which is *later* than the date on which it was filed with the Office, and in particular when he wishes the subsequent designation to take effect immediately after some other event (such as renewal or recordal of a change) which is the subject of a request filed at the same time, the International Bureau will accept a declaration to that effect signed by the holder, his representative or the Office presenting the subsequent designation.

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