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

Effects and Consequences of a Limitation, a Cancellation and a Partial Change in Ownership

(Rules 25(1)(a) and 27(2) of the Common Regulations under the Madrid Agreement
and Madrid Protocol)

Limitation and Cancellation

1. Rule 25(1)(a) of the Common Regulations under the Madrid Agreement and Madrid Protocol (which entered into force on April 1, 1996) allows the holder of an international registration to request the recordal of a limitation or cancellation. The difference between these terms is the following. The recordal of a *limitation* of the list of goods and services, although such a limitation may be made for all the designated Contracting Parties, does not entail the deletion of the goods and services concerned from the international registration as recorded in the International Register. In other words, the only effect of a limitation is that the international registration is no longer protected for the goods and services concerned in the Contracting Parties covered by the limitation; those goods and services can therefore be the subject of a subsequent designation, not only for new Contracting Parties but also for those Contracting Parties covered by the limitation (where, for example, the reasons for the limitation—an opposition or a citation based on a prior mark in the course of a refusal procedure—have ceased to exist). Furthermore, those goods and services continue to be taken into account for the purposes of the calculation of the supplementary fees at the time of renewal. In contrast, the recordal of a *cancellation* for some of the goods and services (partial cancellation) entails the permanent deletion of the goods and services concerned. Its effect is that the goods and services concerned are removed from the international registration; they can no longer be the subject of a subsequent designation and are not taken into account at the time of renewal.

2. The situation was different at the time of the Regulations under the Madrid Agreement (in force until March 31, 1996). In fact, the holder could only request the recordal of a limitation, or of a total cancellation of the international registration. However, a limitation (recorded, notified and published as such) was treated as a partial cancellation of the goods and services (see paragraph 149 of the former Guide to the International Registration of Marks). Where the limitation concerned all the designated countries, it entailed the deletion of the goods and services concerned from the international registration as recorded in the International Register.

3. Since the entry into force, on April 1, 1996, of the Common Regulations under the Agreement and the Protocol, the limitations relating to all the designated countries recorded up to March 31, 1996, remain qualified as such in the International Register but their effects remain those which they had before April 1, 1996, that is those of a partial cancellation.

Partial Change in Ownership

4. It follows from Rule 25(1)(a)(i) of the Common Regulations that three types of partial change in ownership can be recorded in the International Register, namely:

(a) for some of the goods and services in respect of all the designated Contracting Parties;

(b) for all the goods and services in respect of some of the designated Contracting Parties;

(c) for some of the goods and services in respect of some of the designated Contracting Parties.

5. It follows from Rule 27(2) of the Common Regulations that the part of an international registration which has been assigned (or otherwise transferred) entails the creation (in the name of the holder of that assigned or otherwise transferred part) of a new international registration bearing the same number as the international registration which was the subject of the change in ownership and accompanied by a capital letter (for example, international registration No. 500 000 in the name of X and international registration No. 500 000 A in the name of Y). Furthermore, Rule 27(2) provides that the part which has been assigned or otherwise transferred is canceled from the International Register under the number of the international registration a part of which has been assigned or otherwise transferred.

6. In respect of an international registration of which a part has been assigned or otherwise transferred, the International Register does not contain the indication "cancellation" but the indication "change in ownership" with the indication of the goods and services and the designated Contracting Parties concerned. In the case referred to in paragraph 4(a), above, that recordal must be understood as a partial cancellation; in other words, an international registration which has been the subject of a change in ownership for some of the goods and services in respect of all the designated Contracting Parties will no longer be able to cover, in a subsequent designation or at renewal, the goods and services which were the subject of the change in ownership. In the case referred to in paragraph 4(b), above, that recordal must be understood as a renunciation in respect of the designated Contracting Parties concerned; in other words, the renewal of the initial international registration will not be able to cover those Contracting Parties.

7. It should be noted that the effects described in the previous paragraph correspond to a constant practice and that the entry into force, on April 1, 1996, of the Common Regulations did not change anything to that practice.

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