



## WORLD INTELLECTUAL PROPERTY ORGANIZATION

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

#### **Subsequent Designations**

**Holders of international registrations are reminded of the following:**

##### Duration of subsequent designations

1. The period of protection of a subsequent designation expires on the same date as the international registration to which it refers. This means that, although the full complementary and individual fees must be paid in full, the duration of protection may be much shorter. This is illustrated by the following example: an international registration was effected on February 1, 1982, and its renewal date is therefore February 1, 2002. The holder of this registration makes a subsequent designation on July 1, 2001, and pays the required fees. In 2002 therefore, the holder will have to pay renewal fees for the entire international registration, including therefore the subsequent designation. In other words, the duration of that subsequent designation will be of six months only. This is particularly relevant in the case of subsequent designations of countries charging individual fees. A warning has been added to the front page of form MM4.

##### Date of subsequent designations

2. The date of a subsequent designation is the date of receipt by the International Bureau or (if the request is filed through an Office and the International Bureau has received the request within two months) the date of receipt by that Office. On the other hand, the effective date of the renewal of an international registration is the expiry date. Therefore, if the holder of an international registration requests, just before its expiry, the renewal of its registration and files at the same time a subsequent designation, the latter will take effect before the renewal is recorded. As a consequence, the subsequent designation will be effective only until the renewal is recorded; at this moment, further complementary and/or individual fees will be due for the subsequent designation.

3. Attention is drawn to the fact that Rule 24(3)(c)(ii) provides for the possibility of requesting that a subsequent designation take effect **after** the recordal of the renewal of the international registration to which it refers. Such a request may be made in a letter accompanying the subsequent designation and the request for renewal.

Duration of subsequent designations in respect of international registrations for which the required fees have been paid for 20 years (Rule 40(3))

4. Before the coming into force of the Common Regulations on April 1, 1996, fees for international registrations could be paid either for the entire 20-year period or in two instalments each for 10 years. Rule 40(2)(c) and (d) provide that, where the fees have been paid for 20 years, no further fees are required of the holder in respect of the international registration *or in respect of any subsequent designation which was effected before April 1, 1996*, until the expiry of such 20-year period. Where however an international registration for which the required fees have been paid for 20 years is the subject of a subsequent designation bearing a date which is later than March 31, 1996, but before the expiry of the first 10-year period of protection of the international registration, Rule 40(3) provides that it is necessary to pay the complementary fee or the individual fee in respect of the Contracting Party which was the subject of the subsequent designation in order to secure protection in that Contracting Party for the second period of 10 years from the date of the international registration. This is illustrated by the following example: an international registration effected on January 1, 1992, and for which the fees have been paid for a period of 20 years, expires on January 1, 2012. This registration is the subject of a subsequent designation on January 1, 2001. On January 1, 2002, the complementary or individual fee must be paid in respect of the country which was the subject of the subsequent designation. A warning has been added to the first page of form MM4.

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