



## WORLD INTELLECTUAL PROPERTY ORGANIZATION

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### MADRID AGREEMENT AND PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

#### **Amendment to the Common Regulations and the Administrative Instructions**

1. In the prospect of the accession of the European Community to the Madrid Protocol (which is expected in the course of 2004), the Assembly of the Madrid Union, at its Thirty-fifth session, which took place in September 2003, amended the Common Regulations under the Madrid Agreement and Protocol with a view to taking into account a number of features which are particular to the Community Trade Mark system.
2. Under Rules 9(5)(g), 14(2)(vi), 21*bis* and 24, as amended and reproduced in Annex I to the present information notice, three additional features have been incorporated in the Common Regulations, namely: (i) indication of a second language before the Office of the European Community; (ii) claim of seniority and (iii) conversion of a designation of the European Community into the designation of its Members States under the Madrid system (the so-called “opting-back provision”).
3. The Assembly of the Madrid Union decided that these amendments to the Common Regulations will enter into force on April 1, 2004. (It being however understood that the amended provisions will not be applicable until the European Community has acceded to the Madrid Protocol).
4. Moreover, as further explained below, the amendments to the Common Regulations have also entailed the modification by the Director General of WIPO, after consultation with the Offices of the Contracting Parties, of Sections 3 and 4 of the Administrative Instructions. These amended Administrative Instructions will also enter into force on April 1, 2004, and are reproduced in Annex II to the present information notice.

#### Indication of a Second Language Before the Office of the European Community (Rules 9(5)(g)(i) and 24(3)(c)(iii))

5. Applicants designating the European Community in an international application or in a subsequent designation will be required to indicate in the corresponding official form a second language—in addition to the language of the international application—before the Office of that Contracting Organization (the Office for Harmonization in the Internal Market (Trade Marks and Designs), hereinafter referred to as “OHIM”).

6. This second language must be one of the five official languages of OHIM (namely, English, French, German, Italian and Spanish) and will serve exclusively as a language in which third parties may lodge opposition and cancellation proceedings before OHIM. These languages will be listed in the official form and the applicant or holder will be required to tick the appropriate box.

Seniority Claim (Rules 9(5)(g)(ii), 21*bis* and 24(3)(c)(iii))

7. Under the Community Trade Mark system, the proprietor of a mark already registered in or for a Member State of the European Community may, if applying for registration of the same mark with OHIM for goods or services which are covered by the earlier mark, claim the seniority of that earlier mark in respect of the Member State concerned. The effect of such a seniority claim is that where the proprietor of the Community trademark surrenders the earlier mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier mark had continued to be registered.

8. Applicants wishing to claim seniority in respect of a designation of the European Community under the Madrid Protocol will be required to indicate four elements, which correspond to those needed by OHIM, namely, each Member State in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration and the goods and services for which the earlier mark is registered.

9. Given that such indications could only be relevant where the European Community is designated, and in order not to unnecessarily encumber the international application form or the subsequent designation form, these indications are required to be made on a *separate* official form (MM17), to be annexed to the international application form or the subsequent designation form, as the case may be. Section 4(j) of the Administrative Instructions has been amended accordingly (see Annex II).

10. Furthermore, a number of operations which may arise in relation to a seniority claim under the Community Trade Mark system (such as the withdrawal, refusal or cancellation of such claim) have been reflected in a new Rule 21*bis*.

Subsequent Designation of a Member State of a Contracting Organization Resulting from Conversion (“Opting-Back” Provision) (Rule 24)

11. Under the Community Trade Mark system, where a Community trademark application is withdrawn or refused, or where a Community trademark registration ceases to have effect, the proprietor of that Community trademark may request its conversion into a *national* trademark application directly with the Office of one or more Member States of the European Community.

12. The effect of a conversion is that the national trademark application resulting from conversion is allocated the same filing date as that of the Community trademark application or registration (and enjoys, if applicable, the same priority date and/or seniority claimed), provided in particular that the request for conversion is filed within a three-month time limit following the withdrawal, refusal or ceasing of effect of the Community trademark.

13. Having regard to this feature of the Community Trade Mark system, Rule 24 of the Common Regulations has been amended in order to provide that, where the European Community is designated in an international registration and to the extent that such designation has been withdrawn, refused or has ceased to have effect under its applicable law, conversion may also be requested through designation of its Member States *under the Madrid system*. This mechanism, offering the holder of an international registration the option of converting the designation of the European Community into *either* a national application filed directly with the Office of a Member State *or* a subsequent designation of that Member State under the Madrid system, is often referred to as the “opting-back” provision.

14. The principle of such subsequent designation resulting from conversion has been introduced in a new paragraph (7) of Rule 24 and is subject to three main requirements.

– firstly, a subsequent designation resulting from conversion will always have to be presented to the International Bureau through the intermediary of OHIM (Rule 24(2)(a)(iii)). If it is presented directly to the International Bureau by the holder, such subsequent designation will not be considered as such and any fees already paid will be reimbursed to the party having paid them;

– secondly, a subsequent designation resulting from conversion will bear the date on which the designation of the *European Community* was recorded in the International Register (which is the very purpose of the opting-back provision) (Rule 24(6)(e));

– thirdly, in order to avoid any misunderstanding as to the type of subsequent designation concerned, a subsequent designation resulting from conversion will be required to be presented on a new official form (MM16), *distinct* from that used for an “ordinary” subsequent designation (MM4). Section 3 of the Administrative Instructions has been amended accordingly (see Annex II).

### Guide

15. Further information concerning each of the above mentioned issues will be described in an updated version of the *Guide to the International Registration of Marks*, which will be issued in March 2004 and will be accessible on WIPO’s website, at the following address: [www.wipo.int](http://www.wipo.int)

### Forms

16. The new forms (MM16 and MM17) referred to in paragraphs 9 and 14 above, and the updated version of the international application and subsequent designation forms aiming at taking into account the indication of a second language before OHIM (see paragraph 6), will be available on the International Marks page on WIPO’s website, following the deposit of the instrument of accession by the European Community to the Madrid Protocol .

January 12, 2004

## ANNEX I

### RULES 9(5)(g), 14(2)(vi), 21*bis* and 24 OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT AND PROTOCOL, AS AMENDED WITH EFFECT FROM APRIL 1, 2004

#### *Rule 9*

##### *Requirements Concerning the International Application*

(5) *[Additional Contents of an International Application]*

[...]

(g) Where an international application contains the designation of a Contracting Organization, it may also contain the following indications:

(i) where the applicant wishes to claim, under the law of that Contracting Organization, the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, a declaration to that effect, stating the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration and the goods and services for which the earlier mark is registered. Such indications shall be on an official form to be annexed to the international application;

(ii) where, under the law of that Contracting Organization, the applicant is required to indicate a second working language before the Office of that Contracting Organization, in addition to the language of the international application, an indication of that second language.

#### *Rule 14*

##### *Registration of the Mark in the International Register*

(2) *[Contents of the Registration]* The international registration shall contain

[...]

(vi) indications annexed to the international application in accordance with Rule 9(5)(g)(i) concerning the Member State or Member States in or for which an earlier mark, for which seniority is claimed, is registered, the date from which the registration of that earlier mark was effective and the number of the relevant registration.

#### *Rule 21bis*

##### *Other Facts Concerning Seniority Claim*

(1) *[Final Refusal of Seniority Claim]* Where a claim of seniority has been recorded in the International Register in respect of the designation of a Contracting Organization, the Office of that Organization shall notify the International Bureau of any final decision refusing, in whole or in part, the validity of such claim.

(2) [*Seniority Claimed Subsequent to the International Registration*] Where the holder of an international registration designating a Contracting Organization has, under the law of such Contracting Organization, claimed directly with the Office of that Organization the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, and where such claim has been accepted by the Office concerned, that Office shall notify that fact to the International Bureau. Such notification shall indicate:

- (i) the number of the international registration concerned, and
- (ii) the Member State or Member States in or for which the earlier mark is registered, together with the date from which the registration of that earlier mark was effective and the number of the relevant registration.

(3) [*Other Decisions Affecting Seniority Claim*] The Office of a Contracting Organization shall notify the International Bureau of any further final decision, including withdrawal and cancellation, affecting a claim to seniority which has been recorded in the International Register.

(4) [*Recording in the International Register*] The International Bureau shall record in the International Register the information notified under paragraphs (1) to (3).

#### *Rule 24*

##### *Designation Subsequent to the International registration*

(1) [*Entitlement*] (a) A Contracting Party may be the subject of a designation made subsequent to the international registration (hereinafter referred to as “subsequent designation” where, at the time of that designation, the holder fulfills the conditions, under Article 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration.

(b) Where the Contracting Party of the holder is bound by the Agreement, the holder may designate, under the Agreement, any Contracting Party that is bound by the Agreement.

(c) Where the Contracting Party of the holder is bound by the Protocol, the holder may designate, under the Protocol, any Contracting Party that is bound by the Protocol, provided that the said Contracting Parties are not both bound by the Agreement.

(2) [*Presentation; Form and Signature*] (a) A subsequent designation shall be presented to the International Bureau by the holder or by the Office of the Contracting Party of the holder; however,

(i) where Rule 7(1), as in force before October 4, 2001, applies, it must be presented by the Office of origin;

(ii) where any of the Contracting Parties are designated under the Agreement, the subsequent designation must be presented by the Office of the Contracting Party of the holder;

(iii) where paragraph (7) applies, the subsequent designation resulting from conversion must be presented by the Office of the Contracting Organization.

(b) The subsequent designation shall be presented on the official form in one copy. Where it is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

(3) *[Contents]* (a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate

(i) the number of the international registration concerned,  
(ii) the name and address of the holder,  
(iii) the Contracting Party that is designated,  
(iv) where the subsequent designation is for all the goods and services listed in the international registration concerned, that fact, or, where the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services,

(v) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and,

(vi) where the subsequent designation is presented by an Office, the date on which it was received by that Office.

(b) Where the subsequent designation concerns a Contracting Party that has made a notification under Rule 7(2), that subsequent designation shall also contain a declaration of intention to use the mark in the territory of that Contracting Party; the declaration shall, as required by the said Contracting Party,

(i) be signed by the holder himself and be made on a separate official form annexed to the subsequent designation, or

(ii) be included in the subsequent designation.

(c) The subsequent designation may also contain

(i) the indications and translation or translations, as the case may be, referred to in Rule 9(4)(b),

(ii) a request that the subsequent designation take effect after the recording of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration,

(iii) where the subsequent designation concerns a Contracting Organization, the indications referred to in Rule 9(5)(g)(i), which shall be on a separate official form to be annexed to the subsequent designation, and in Rule 9(5)(g)(ii).

(d) Where the international registration is based on a basic application, a subsequent designation under the Agreement shall be accompanied by a declaration, signed by the Office of origin, certifying that the said application has resulted in a registration and indicating the date and number of that registration, unless such a declaration has already been received by the International Bureau.

(4) *[Fees]* The subsequent designation shall be subject to the payment of the fees specified or referred to in item 5 of the Schedule of Fees.

(5) *[Irregularities]* (a) If the subsequent designation does not comply with the applicable requirements, and subject to paragraph (10), the International Bureau shall notify that fact to the holder and, if the subsequent designation was presented by an Office, that Office.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the subsequent designation shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the subsequent designation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the basic fee referred to in item 5.1 of the Schedule of Fees, to the party having paid those fees.

(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraph (1)(b) or (c) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designation shall be deemed not to contain the designation of those Contracting Parties, and any complementary or individual fees already paid in respect of those Contracting Parties shall be reimbursed. Where the requirements of paragraph (1)(b) or (c) are complied with in respect of none of the designated Contracting Parties, subparagraph (b) shall apply.

(6) *[Date of Subsequent Designation]* (a) A subsequent designation presented by the holder direct to the International Bureau shall, subject to subparagraph (c)(i), bear the date of its receipt by the International Bureau.

(b) A subsequent designation presented to the International Bureau by an Office shall, subject to subparagraph (c)(i), (d) and (e), bear the date on which it was received by that Office, provided that the said designation has been received by the International Bureau within a period of two months from that date. If the subsequent designation has not been received by the International Bureau within that period, it shall, subject to subparagraph (c)(i), (d) and (e), bear the date of its receipt by the International Bureau.

(c) Where the subsequent designation does not comply with the applicable requirements and the irregularity is remedied within three months from the date of the notification referred to in paragraph (5)(a),

(i) the subsequent designation shall, where the irregularity concerns any of the requirements referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i), bear the date on which that designation is put in order, unless the said designation was presented to the International Bureau by an Office and the irregularity is remedied within the period of two months referred to in subparagraph (b); in the latter case, the subsequent designation shall bear the date on which it was received by the said Office;

(ii) the date applicable under subparagraph (a) or (b), as the case may be, shall not be affected by an irregularity concerning requirements other than those which are referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i).

(d) Notwithstanding subparagraphs (a), (b) and (c), where the subsequent designation contains a request made in accordance with paragraph (3)(c)(ii), it may bear a date which is later than that resulting from subparagraph (a), (b) or (c).

(e) Where a subsequent designation results from conversion in accordance with paragraph (7), that subsequent designation shall bear the date on which the designation of the Contracting Organization was recorded in the International Register.

(7) *[Subsequent Designation Resulting From Conversion]* (a) Where the designation of a Contracting Organization has been recorded in the International Register and to the extent that such designation has been withdrawn, refused or has ceased to have effect under the law of that Organization, the holder of the international registration concerned may request the conversion of the designation of the said Contracting Organization into the designation of any Member State of that Organization which is party to the Agreement and/or the Protocol.

(b) A request for conversion under subparagraph (a) shall indicate the elements referred to in paragraph (3)(a)(i) to (iii) and (v), together with:

(i) the Contracting Organization whose designation is to be converted, and

(ii) where the subsequent designation of a Contracting State resulting from conversion is for all the goods and services listed in respect of the designation of the Contracting Organization, that fact, or, where the designation of that Contracting State is for only part of the goods and services listed in the designation of that Contracting Organization, those goods and services.

(8) *[Recording and Notification]* Where the International Bureau finds that the subsequent designation conforms to the applicable requirements, it shall record it in the International Register and shall notify accordingly the Office of the Contracting Party that has been designated in the subsequent designation and at the same time inform the holder and, if the subsequent designation was presented by an Office, that Office.

(9) *[Refusal]* Rules 16 to 18 shall apply *mutatis mutandis*.

(10) *[Subsequent Designation Not Considered as Such]* If the requirements of paragraph (2)(a) are not complied with, the subsequent designation shall not be considered as such and the International Bureau shall inform the sender accordingly.

[Annex II follows]

## ANNEX II

### SECTIONS 3 AND 4(j) OF THE ADMINISTRATIVE INSTRUCTIONS FOR THE APPLICATION OF THE MADRID AGREEMENT AND THE MADRID PROTOCOL AS AMENDED WITH EFFECT FROM APRIL 1, 2004

#### *Section 3: Designation Subsequent to the International Registration*

- (a) A subsequent designation resulting from conversion pursuant to Rule 24(7) shall be made on form MM16.
- (b) Any other subsequent designation shall be made on form MM4.

#### *Section 4: Other Official Forms*

[...]

- (j) Where an international application or a subsequent designation contains the designation of a Contracting Organization, the indications referred to in Rule 9(5)(g)(i) shall be made on form MM17 which shall be annexed to the international application or to the subsequent designation, as the case may be.

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