



## WORLD INTELLECTUAL PROPERTY ORGANIZATION

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

#### **Implications of the Repeal of the Safeguard Clause and Other Changes Taking Effect on September 1, 2008**

#### I. INTRODUCTION

1. The amendment of Article 9*sexies* of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, commonly known as “the safeguard clause”, accompanied by certain consequential amendments to the Common Regulations under the Madrid Agreement and Protocol, will come into effect on September 1, 2008.

2. In addition to the above, the following changes will also come into effect on September 1, 2008:

– as of that date, any international application may be in English, French or Spanish (however, the Office of origin may restrict the choice to one or two of these languages)<sup>1</sup>;

– as of that date, the amounts of supplementary and complementary fees (“standard fees”) will increase from 73 Swiss francs to 100 Swiss francs<sup>2</sup>. These new amounts will apply in all situations where the standard fees are to be paid, under the Agreement or under the Protocol.

3. Reference is made to Information Notice No. 18/2007 which describes all the aforementioned amendments. The purpose of the present information notice is to highlight the practical implications of the amendment of Article 9*sexies* of the Protocol.

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<sup>1</sup> Concerning the language regime, in respect of communications other than the international application, see Rule 6(2) and Rule 40(4) of the Common Regulations, as amended and as in force as from September 1, 2008.

<sup>2</sup> Sub-items 2.4, 3.3, 3.4, 5.2, 5.3 and 6.2 to 6.4 of the Schedule of Fees annexed to the Common Regulations, as amended and as in force as from September 1, 2008.

## II. AMENDMENT OF ARTICLE 9SEXIES

### Article *sexies*(1)(a) – Repeal of the Safeguard Clause

4. Article 9*sexies* of the Protocol, as amended, and as in force from September 1, 2008, repeals the safeguard clause. New paragraph (1)(a) of Article 9*sexies* provides that the Protocol, and the Protocol alone, will, in all aspects, apply between Contracting Parties bound by both the Agreement and the Protocol. As a result, as from September 1, 2008, designations of a Contracting Party bound by both the Agreement and the Protocol made in an international application or subsequent to an international registration, by an applicant or holder of a Contracting Party also bound by both the Agreement and the Protocol will be governed by the Protocol. For convenience, such designations are hereinafter referred to as “designations governed by the Protocol by virtue of new Article 9*sexies*”.

### Article 9*sexies*(1)(b) – Time Limit for Refusal and Individual Fees

5. New paragraph (1)(a) of Article 9*sexies* is completed by a new paragraph (1)(b) which renders inoperative a declaration under Article 5(2)(b) or Article 5(2)(c) of the Protocol (extension of the time limit for notifying a provisional refusal) or Article 8(7) of the Protocol (individual fees) between Contracting Parties bound by both the Agreement and the Protocol. As a result, as from September 1, 2008, for any designation governed by the Protocol by virtue of new Article 9*sexies*, the standard time limit of one year for the notification of a provisional refusal and the payment of standard fees (increased to 100 Swiss Francs)<sup>3</sup> will continue to apply.

## III. IMPLICATIONS OF THE AMENDMENT OF ARTICLE 9SEXIES

### Existing International Registrations on September 1, 2008

6. Any designations governed by the Agreement by virtue of the safeguard clause (*i.e.*, prior to its repeal) that are already recorded in the International Register and still in force on September 1, 2008, will *automatically* change into designations governed by the Protocol by virtue of new Article 9*sexies*. This change of applicable treaty will entail no implications on the time limit for refusal or on the fees payable upon renewal.

### Designations Pending on September 1, 2008

7. International applications or subsequent designations to an international registration governed by the Agreement by virtue of the safeguard clause (*i.e.*, prior to its repeal) that are still pending on September 1, 2008 (*i.e.*, not yet recorded), will be processed, up to recording, according to the regime applicable on the date of their filing. Consequently, the designations contained therein will be entered into the International Register as designations governed by the Agreement.

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<sup>3</sup> See paragraph 2, above.

8. However, as from September 1, 2008, once recorded, these designations governed by the Agreement by virtue of the safeguard clause will *automatically* change into designations governed by the Protocol by virtue of new Article 9*sexies*. This change of applicable treaty will entail no implications on the time limit for refusal or on the fees payable.

International Applications and Subsequent Designations Filed as of September 1, 2008

9. In the mutual relations between Contracting Parties bound by both the Agreement and the Protocol, the Protocol will apply as from September 1, 2008. Therefore, unless it originates from, or contains a designation of, a Contracting Party bound *only* by the Agreement<sup>4</sup>, an international application could be based on a mere application for registration filed with the Office of origin (“basic application”). Such international application will have to be presented on form MM2 (*Application for International Registration Governed Exclusively by the Madrid Protocol*), instead of form MM1, as formerly.

10. Similarly, unless it originates from, or contains a designation of, a Contracting Party bound *only* by the Agreement, a designation subsequent to an international registration could be based on a mere basic application and could be presented directly to the International Bureau.

11. With respect to designations governed by the Protocol by virtue of new Article 9*sexies* (whether made in an international application or in a subsequent designation filed as from September 1, 2008), it is recalled that the standard time limit of one year for refusal and the payment of standard fees apply, notwithstanding any declaration made by the designated Contracting Party<sup>5</sup>.

IV. OTHER IMPLICATIONS AS FROM SEPTEMBER 1, 2008

Transformation

12. All designations governed by the Protocol by virtue of new Article 9*sexies* would enjoy the possibility of transformation as provided for by Article 9*quinquies* of the Protocol in the event of a cancellation of the basic application or registration.

Presentation of a Request for the Recording of a Renunciation or a Cancellation

13. A request for the recording of a renunciation or a cancellation that concerns any designation governed by the Protocol by virtue of new Article 9*sexies* could be presented directly to the International Bureau.

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<sup>4</sup> Algeria, Bosnia and Herzegovina, Egypt, Kazakhstan, Liberia, Sudan and Tajikistan.

<sup>5</sup> See paragraph 5, above.

V. NEW INID<sup>6</sup> CODE 834

14. International registration certificates and notifications relating to recordings made as from September 1, 2008, as well as the publication thereof in the *WIPO Gazette of International Marks*, will all be presented in a way that will allow users and Offices to identify designations governed by the Protocol by virtue of new Article 9*sexies*. To this end, the heading “Designation(s) under the Madrid Protocol by virtue of Article 9*sexies*” and its corresponding INID code 834 will be used. This code will also be used in both the ROMARIN and Madrid Express databases to identify all designations governed by the Protocol by virtue of new Article 9*sexies*, regardless of their date of recording.

July 23, 2008

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<sup>6</sup> INID is the abbreviation of “Internationally agreed Numbers for the Identification of (bibliographic) Data”.