

## **Working Group on the Legal Development of the Madrid System for the International Registration of Marks**

**Twelfth Session  
Geneva, October 20 to 24, 2014**

### **PROPOSAL TO FREEZE THE OPERATION OF ARTICLES 6(2), (3) AND (4) OF THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND OF THE PROTOCOL RELATING THERETO**

*Document prepared by the International Bureau*

1. As requested by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), at its eleventh session, this document analyzes all aspects of freezing of dependency, addresses the various questions that had been raised during its discussion at previous sessions of the Working Group and proposes a temporary freeze of the operation of dependency.

#### **BACKGROUND ON THE PRINCIPLE OF DEPENDENCY**

2. Before the Nice Act<sup>1</sup> of the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Agreement”), an international registration was considered to be an extension of the registration of the mark registered in the country of origin. A change (such as a change in ownership) of the basic registration, or any cancellation thereof, had an automatic corresponding effect on the international registration.

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<sup>1</sup> The Nice Act was adopted in 1957 and entered into force in 1966. Under the original (1891) version of the Agreement, the first paragraph of Article 9 read: “The Administration of the country of origin shall notify the International Bureau of annulments, cancellations, renunciations, transfers and other changes that may occur regarding the ownership of the mark.”

3. This dependency on the basic registration continued for as long as the international registration existed. Following the Washington Act (1911), an international registration could be transferred to a new owner in another contracting country, if the new owner had a national registration of the mark in that country, on which the international registration became dependent. This country was then regarded as the country of origin for the application of the provisions of the Agreement and its Regulations.

4. The London Act (1934) of the Madrid Agreement loosened dependency by making it possible to effect a partial change in ownership of the international registration. Article 9(1)<sup>2</sup> was modified to state that the Office of the country of origin should notify the International Bureau of any annulments, cancellations, renunciations, changes in ownership and other changes made in the national register, no longer in every case but only to the extent that those changes affected the international registration.

5. Dependency, was further weakened with the Nice Act (1957) of the Madrid Agreement, when the duration of dependency was limited to five years from the date of the international registration, and by restricting the effect of dependency to the case where the national mark registered in the country of origin ceased to enjoy legal protection in that country. Except where these conditions applied, changes in the national register no longer had an impact on the international registration.

6. Before the said Nice Act, “country of origin” meant the country of the recorded owner, and therefore changed when a transfer to a person established in another country was recorded. Since the Nice Act, “country of origin” means simply the country through whose Office the international application was originally filed. The country of origin no longer changes where there is a change in the ownership of the international registration. In particular, even where the international registration is transferred to a person in a country other than the country of origin, the registration continues to depend on the original basic registration for the remainder of the five-year dependency period.

7. The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks<sup>3</sup> (hereinafter referred to as “the Protocol”) introduced in Article 9*quinquies* the possibility of transformation, which softened the effect of dependency. Where an international registration is cancelled because of the ceasing of effect of the basic mark, the holder may keep his rights intact by “transforming” these rights into national or regional applications in the respective Contracting Parties where the international registration had effect. If such transformation is requested within three months from the date of cancellation in the International Register, his national or regional applications will benefit from the date of the international registration and its priority date, if any.

8. With the recent repeal of the safeguard clause most designations are now governed by the Protocol and, as a result, most users of the Madrid System may take advantage of transformation, should the international registration be cancelled due to the ceasing of effect of the basic mark.

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<sup>2</sup> Article 9(1) read as follows: “The Office of the country of origin shall likewise notify the International Bureau of all annulments, cancellations, renunciations, transfers and other changes made in the entry of the mark in the national register, if such changes affect the international registration.”

<sup>3</sup> Adopted in 1989, entered into effect 1995 and became operational on April 1, 1996.

## EFFECTS OF DEPENDENCY ON THE MADRID SYSTEM

### A. DEPENDENCY AND BAD FAITH

9. Dependency was preserved as a mechanism to balance the interest of right holders and third parties and it was never meant to serve as a supranational mechanism to fight against the spread of bad faith. Moreover, there is no information on the incidence of bad faith applications in the Madrid System or evidence to suggest that the Madrid System facilitates the spread of bad faith applications throughout its Contracting Parties. The Contracting Parties of the Madrid System, in accordance with the Paris Convention for the Protection of Industrial Property (Paris Convention), should have enacted mechanisms, in their corresponding national laws, to fight against the spread of bad faith.

10. In fact, it has been argued that the Madrid System, as a mechanism which provides a uniform and earlier date of effect in the designated Contracting Parties, could be effectively used to prevent trademark squatting.

### B. THE EFFECT ON THE WORKLOAD OF OFFICES

11. In accordance with the treaties of the Madrid System, the Offices of origin have an obligation to monitor the fate of basic applications and registrations, and of registrations resulting from basic applications, to determine whether these have ceased to have effect and, in that case, notify the International Bureau and request that the international registration be cancelled accordingly. This obligation extends beyond the dependency period, as the final outcome of actions initiated during the dependency period and resulting in a ceasing of effect of the basic mark might be communicated to the Office of origin several years later.

12. Dependency has increased the burden on the Offices of the Contracting Parties of the Madrid System as evidenced by the number of notifications sent under Rule 22 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”), compared to the number of international registrations in which these Offices acted as Office of origin. In 2013, the International Bureau recorded cancellations in respect of 4,440 international registrations, due to the ceasing of effect of the basic mark, at the request of 42 Offices. In the same year, these Offices acted as Office of origin in respect of 43,495 international registrations<sup>4</sup>. In general terms, in 2013, a cancellation due to the ceasing of effect of the basic mark was recorded for every 10 international registrations effected that year; in 2001, it was one for every 133 international registrations (see Annex II, Tables I and II).

### C. THE EFFECT ON THE FLEXIBILITY TO FILE AN INTERNATIONAL APPLICATION WITH A BASIC APPLICATION

13. The growth rate of recorded cancellations due to ceasing of effect is significantly higher than that of international registrations. As evidenced in Annex II of this document, between 2001 and 2013, the number of recorded cancellations due to ceasing of effect increased by 4,353%, while the number of international registrations increased by 85% (see Annex II, Table II and Graph I). The accelerated increase in the number of recorded cancellations due to ceasing of effect might be attributed to the filing behavior of users, who are increasingly filing international applications based on a basic application.

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<sup>4</sup> 44,414 international registrations were effected in 2013.

14. In any case, the flexibility to file an international application with a basic application, introduced by the Protocol, might be undermined by dependency since, as it was reported to the Working Group<sup>5</sup>, most of the notifications under Rule 22 of the Common Regulations are not sent by Offices as a result of a third party action. Where a notification under Rule 22 is sent *ex officio*, it most likely concerns a basic application and not a basic registration. Dependency might be disproportionately affecting international registrations attained with a basic application, making the Madrid System more rigid.

#### D. THE EFFECT ON LEGAL CERTAINTY

15. Dependency is perceived as an unjustified weakening factor for international registrations, which would put them at an inferior level in respect of national marks, as judicial or administrative decisions taken in the jurisdiction of the Office of origin might negatively affect the international registration and the protection acquired in all the designated Contracting Parties.

16. Moreover, final judiciary or other decisions resulting in ceasing of effect of the basic mark may be made and communicated to Offices of origin much later than upon the expiry of the five-year dependency period, as it is sufficient that the action leading to the ceasing of effect be initiated within this period. Dependency thus negatively affects legal certainty in an additional way.

#### E. THE EFFECT ON INCREASED USE

17. Dependency is perceived as a disincentive to use the Madrid System, as potential applicants may refrain from filing international applications due to the vulnerability of international registrations.

18. During the preceding discussions, delegations of certain Contracting Parties with rapidly growing export-oriented economies have stated that companies in their countries may be reluctant to use the Madrid System and may, instead, resort to the Paris route because of concerns generated by dependency. These concerns result in an underutilization of the System, with all the associated consequences, such as loss of efficiency and of economies of scale.

19. This could be particularly relevant in Contracting Parties using non-Latin scripts, where holders file a new basic mark in Latin characters for improved brand recognition in export markets. This “new” basic mark may not be used in the home market, in particular if holders already have protection there for a mark in non-Latin characters. Depending on the law applicable in the jurisdiction of the Office of origin, such marks may be vulnerable to non-use cancellation actions, resulting in a further disincentive to the use of the Madrid System.

20. The Working Group would need to weigh the advantages of maintaining the operation of dependency against its restraining effect on the growth of the Madrid System resulting from the disincentive for companies of Contracting Parties to use the System.

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<sup>5</sup> See document MM/LD/WG/11/4, page 3.

## F. THE EFFECT ON THE COST OF PRESERVING PROTECTION; TRANSFORMATION

21. Transformation was introduced in the Protocol as a means to balance the vulnerability of international registrations based on applications. Yet transformation, as attested by the data gathering exercises on dependency previously reported to the Working Group<sup>6</sup>, does not appear to be working as intended.

22. Offices participating in the abovementioned exercises indicated that, in the 18 months covered by those exercises, they had only received 223 requests for transformation. To provide some perspective, 37,826 designations were affected by the recording of a cancellation due to ceasing of effect in 2013 alone (see Annex II, Table I).

23. The Madrid System provides cost-efficiency gains that reduce barriers to accede to global trademark protection for small and medium-sized enterprises (SMEs). Dependency, when it results in the cancellation of the international registration, all but deletes those gains. One possible reason for the relatively low use of transformation may be the additional costs incurred when filing new applications in the concerned designated Contracting Parties.

## CONSTITUTIONAL CONSIDERATIONS REGARDING THE POSSIBILITY TO FREEZE THE OPERATION OF A TREATY OR OF A PROVISION CONTAINED THEREIN

### A. SUSPENSION OF THE OPERATION OF TREATIES OR OF PROVISIONS THEREOF

24. The application of treaties or provisions contained therein can be suspended for a certain period or until a decision is taken to resume the application.

25. The Vienna Convention on the Law of Treaties (hereinafter referred to as “the Vienna Convention”) sets out the law and procedure for the termination and suspension of the operation of treaties. To be effective, the denunciation, termination or suspension of operations of a treaty may take place only as a result of the application of the provisions of the treaty or of the Vienna Convention (Article 42(2) of the Vienna Convention). Article 57 of the Vienna Convention provides that “the operation of a treaty in regard to all the parties or to a particular party may be suspended: (a) in conformity with the provisions of the treaty; or (b) at any time by consent of all the parties after consultation with the other Contracting States”.

### B. EXPRESS PROVISIONS IN WIPO TREATIES

26. Most WIPO treaties are of unlimited duration. They remain in force without limitation as to time (see for example, Article 15 of the Madrid Agreement and Protocol).

27. The only provisions regarding their termination relate to the possibility for Contracting Parties to denounce them. Most of the WIPO treaties, including the Madrid Agreement and Protocol, contain provisions on denunciation, which is a unilateral act by a party whereby it terminates its participation in a treaty.

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<sup>6</sup> *Ibid.* and document MM/LD/WG/9/3, page 4.

### C. TERMINATION OR SUSPENSION OF THE OPERATION BY CONSENT

28. A treaty may be terminated or its operation suspended at any time by consent of all the parties, and the parties are free to choose the form their consent will take. The consent does not have to be expressed in any particular form. Although the provisions of the Vienna Convention would appear to envisage the power to terminate or suspend the whole treaty, the parties are free to terminate or suspend only some provisions of the treaty.

29. In the case of the Madrid Agreement and Protocol, since the Contracting Parties are members of the Madrid Union Assembly, the consent to suspend the application of the provision under consideration can be obtained in the Assembly through the consensus principle. Moreover, Article 10(3)(c) provides for a procedure to get the consent of any members who were not present when the decision was taken by the Assembly.

30. The application of certain WIPO treaties has been discontinued by consent of all the Contracting Parties in the following cases.

### D. RELEVANT PRECEDENTS IN WIPO ON THE SUSPENSION OF THE OPERATION OF A TREATY

31. The first precedent concerns the Trademark Registration Treaty (TRT), which was concluded in Vienna in 1973. The TRT came into effect in 1980 among five countries, but no further countries adhered to it. Only two trademarks were ever registered under it. Although the TRT is formally still in force, its application was “frozen” by virtue of a decision by the TRT Assembly in October 1991. This means that the system ceased to function: no new accessions can be accepted, no new registrations may be made and the Assembly of the TRT Union may no longer meet in ordinary sessions. The TRT could, however, be “unfrozen” by decision of the Assembly of the TRT Union in an extraordinary session (see documents TRT/A/VII/1 and 2). This has never happened and all registrations made under the Treaty have ceased through failure to renew.

32. The Treaty on the International Registration of Audiovisual Works (FRT) had the same fate. The Treaty was concluded in 1989, and it established an international register of audiovisual works. It entered into force in February 1991. Approximately 400 audiovisual works were registered. Since the decision of the FRT Assembly, in May 1993, to relocate the International Register from Austria to Geneva, there has been no further activity recorded in respect of the International Register, which for all practical purposes is defunct. At the 1993 Assembly meeting of the FRT Union, it was decided that until any further decision by the Assembly of the FRT Union, the application of the Treaty be suspended. At the 2000 meetings of the Assemblies, the Assembly of the FRT Union decided that it would not be reconvened unless there was a specific request to convene the Assembly. Such request has never been made.

33. More recently, in order to reduce the complexity of the Hague System for the International Registration of Industrial Designs, the Contracting States to the London (1934) Act of the Hague Agreement Concerning the International Deposit of Industrial Designs (London (1934) Act) decided in an Extraordinary Meeting, which took place in Geneva on September 24, 2009, to freeze the application of the London (1934) Act, with effect from January 1, 2010. In addition, the Extraordinary Meeting agreed that the next course of action would be to move towards the termination of the London (1934) Act, through receipt of the consent to the termination (signed by a competent authority) from all the 15 Contracting States.

34. In all the cases described above, the decision concerned the suspension of the application of the entire treaty. In all cases the competent Assembly of Member States took the decision. Although the terminology used was different – in one case, it was a decision to “suspend” the application of the treaty; in the other, to “freeze” its application – the legal consequences were the same. Finally, in all cases, the suspension or freeze could be reversed by a subsequent decision by the Assembly or by the Member States.

#### E. RELEVANT PRECEDENT IN THE MADRID SYSTEM

35. A last precedent is worth mentioning, as it concerns the Madrid Agreement and the suspension of the operation of a part of one provision of the Treaty. The Madrid Assembly decided, in 1995, that the International Bureau should cease to apply the last sentence of Article 9*bis*(1)<sup>7</sup> of the Agreement.

36. The last sentence of Article 9*bis*(1) of the Agreement required the consent of the Office of the Contracting Party of the transferee before the recording in the International Register of a change in ownership within five years from the date of the international registration. The International Bureau reported that, in most cases, the Office of the Contracting Party of the transferee gave its consent. Indicating that the procedures described by the last sentence of Article 9*bis*(1) had lost their original legal justification, the International Bureau proposed that this sentence cease to apply<sup>8</sup>. The Madrid Union Assembly decided that the last sentence of Article 9*bis*(1) of the Madrid Agreement ceased to be applied by the International Bureau with immediate effect<sup>9</sup>.

#### F. DECISION TO SUSPEND THE OPERATION OF DEPENDENCY

37. Accordingly, the decision to freeze the operation of dependency should be adopted by the Madrid Union Assembly, as it would be a situation very similar to the one described above.

38. Since it would be a mere suspension of the operation of the concerned provisions, the freezing would be reversible, i.e., the Assembly could decide that the freezing would be for a given period or that it could be repealed by the Assembly at any time. The Assembly would decide on the consequences of the suspension; the freeze would be in effect as from the date it is agreed upon, and without retroactive effect. As a result, a suspension of the operations of the concerned provisions of the Madrid treaties would not affect the rights and obligations of the parties before the date on which such suspension comes into effect.

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<sup>7</sup> The last sentence of Article 9*bis*(1) reads: “If the transfer has been effected before the expiration of a period of five years from the international registration, the International Bureau shall seek the consent of the Office of the country of the new proprietor, and shall publish, if possible, the date and registration number of the mark in the country of the new proprietor.”

<sup>8</sup> See document MM/A/XXVI/1.

<sup>9</sup> See document MM/A/XXVI/3.

## IMPLICATIONS OF A POSSIBLE FREEZE OF DEPENDENCY

### A. EFFECTS ON THE LEGAL FRAMEWORK

39. The freeze of the operation of dependency would essentially mean that Articles 6(2), (3) and (4) of both the Agreement and the Protocol would cease to apply; these provisions stipulate that the protection resulting from the international registration may no longer be invoked if the effect of the basic mark has ceased during the five-year dependency period.

40. It would not be necessary to freeze the operation of Article 9*quinquies* of the Protocol, because the application of this provision is dependent on the cancellation of an international registration due to the ceasing of effect of the basic mark. If Article 6 were to be frozen, there would be no possibility of a cancellation of an international registration due to ceasing of effect of the basic mark, and therefore, no longer any need to request transformation. However, transformation would still be available for those international registrations that remain subject to dependency.

41. A few specific provisions of the Common Regulations would also be affected by the proposed freeze of the relevant provisions of Article 6. Offices of origin would no longer be obliged to notify the International Bureau of ceasing of effects of basic marks under Rule 22 of the Common Regulations in respect of those international registrations for which the operation of dependency is suspended. Where the basic mark is subject to division or merger, the Office of origin would no longer be obliged to notify the International Bureau of these events under Rule 23. Finally, Rule 32 (1)(a)(viii) and (xi) would also cease to be applied where publications in the *WIPO Gazette of International Marks* of relevant data under Rules 22 and 23 would be concerned.

### B. OTHER IMPLICATIONS

#### Preserved basic mark requirement

42. There would still be a requirement for a basic mark; the need for correspondence of the mark that is the subject of the international application with the basic mark would not be affected. The first would still have to mirror the basic mark in a relevant series of elements, such as the applicants or holders, the nature of the mark and its diverse claims and the list of goods and services. This correspondence would still have to be certified by the Office of origin, when presenting an international application.

#### Modernized Madrid System

43. It is recalled that the basic mark requirement is a feature of the Madrid System that is not mirrored by national or regional trademark systems. Even if this requirement is maintained, freezing the operation of dependency could modernize the Madrid System, making it more flexible and in tune with the prevailing trademark frameworks of both Contracting Parties and the rest of the world.



#### Increased legal certainty

44. In the current scenario, the loss of protection resulting from an international registration is a mechanical outcome of the ceasing of effect of the basic mark. International registrations would be strengthened, as their fate would no longer depend on the basic mark, and legal certainty would be enhanced. In a context of expanding global trade, reinforcing the legal protection of the international registration is of paramount importance for companies with international reach.

#### Preserved balance of interests between holders and third parties

45. The legal balance between holders and third parties would not be substantially affected as mechanisms to attack the international registration in designated Contracting Parties would remain available. Admittedly, these “local attacks” would imply higher costs but it is submitted that these costs would be outweighed by the strategic benefits for the Madrid System as whole. In addition, the experience gained with the use of legal remedies triggering provisional refusals and the existence of built-in attack mechanisms such as invalidation, suggests that the freeze of the operation of dependency should not result in detriment of third-party interests. Third parties would still have remedies available to preserve their rights, where appropriate and in accordance with the legal framework of the designated Contracting Parties.

46. Document MM/LD/WG/11/4 revealed little evidence of central attack as being a mechanism widely used as such by third parties. Where the statistics showed that a ceasing of effect was triggered by a third party action, it was more likely due to the goal of preserving or defending a right in the country of origin, not necessarily with the clear intent of eliminating the basic mark and thereby the international registration as such.

#### Preserved balance of interest between holders and Offices

47. The position of Offices of origin in the Madrid System would not be negatively affected either. The basic mark requirement would remain the same, but the fate of that basic mark would no longer have an impact on the international registration. The certification function of the Office of origin would remain unaffected; the quality of the international application would be maintained by the certification performed by the staff of the Office and the fee revenue for the Office would not be affected either.

48. Freezing the operation of dependency would also have a positive impact on the workload of the Offices of Contracting Parties, because it would reduce the number of transactions to be performed by them.

#### Increased alignment with the principle of territoriality

49. The invalidation of the protection resulting from an international registration in the designated Contracting Parties would no longer depend on a decision made on the basic mark in the jurisdiction of the Office of origin on the basis of grounds that may not be applicable in the concerned designated Contracting Parties.

## Increased use of the Madrid System

50. Freezing the operation of dependency could lead to an increased use of the system. For instance, this could be the case in Contracting Parties where, as indicated earlier, a basic mark registered in the country of origin in a script other than the one normally used, is perceived as more vulnerable to actions resulting in cancellation for non-use.

## **PROPOSAL TO FREEZE THE OPERATION OF DEPENDENCY**

51. For the reasons set out above, it is proposed that the operation of dependency be suspended for all international registrations effected between January 1, 2016 and December 31, 2021. This proposal would provide a flexible approach allowing the Madrid Union Assembly to assess the positive and negative effects of a new development in the System.

52. Accordingly, it is further proposed that, in 2021, the Madrid Union Assembly undertake a review of the effects of the proposed suspension and take a decision on its further continuation. Unless otherwise decided by the Assembly, dependency would be fully restored for international registrations with a date later than December 31, 2021.

53. Legal security would not be compromised for the international registrations suggested to be the subject of this proposal. A late final judiciary or other decision resulting in the ceasing of effect of the basic mark, following an action initiated within the dependency period, would not result in the recording of a cancellation, as the operation of dependency would remain suspended for those international registrations.

54. It is therefore proposed that the Working Group recommend that the Madrid Union Assembly freeze or suspend the operation of Articles 6(2), (3) and (4) of the Agreement and of the Protocol, through the adoption of the following Statement: "Articles 6(2), (3) and (4) of the Madrid Agreement Concerning the International Registration of Marks and of the Protocol Relating Thereto will cease to apply in respect of international registrations bearing dates of international registration between January 1, 2016, and December 31, 2021."

55. *The Working Group is invited to:*

*(i) consider this document and provide comments thereon; and*

*(ii) provide guidance to the International Bureau on possible further actions, including a recommendation to the Madrid Union Assembly to suspend the operation of Articles 6(2), (3) and (4) of the Madrid Agreement and the Protocol, as proposed in this document or in modified form.*

[Annexes follow]

**PROPOSAL TO FREEZE THE OPERATION OF ARTICLES 6(2), (3) AND (4) OF THE  
MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS  
AND OF THE PROTOCOL RELATING THERETO**

MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

**Madrid Agreement Concerning  
the International Registration of Marks**

of April 14, 1891,  
as revised  
at Brussels on December 14, 1900, at Washington on June 2, 1911,  
at The Hague on November 6, 1925, at London on June 2, 1934,  
at Nice on June 15, 1957,  
and at Stockholm on July 14, 1967,  
and as amended on September 28, 1979

[...]

**Article 6**

[Period of Validity of International Registration. Independence of  
International Registration. Termination of Protection in Country of Origin]<sup>\*</sup>

(1) Registration of a mark at the International Bureau is effected for twenty years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiration of a period of five years from the date of the international registration, such registration shall become independent of the national mark registered earlier in the country of origin, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked, in whole or in part, if, within five years from the date of the international registration, the national mark, registered earlier in the country of origin in accordance with Article 1, no longer enjoys, in whole or in part, legal protection in that country. This provision shall also apply when legal protection has later ceased as the result of an action begun before the expiration of the period of five years.

(4) In the case of voluntary or ex officio cancellation, the Office of the country of origin shall request the cancellation of the mark at the International Bureau, and the latter shall effect the cancellation. In the case of judicial action, the said Office shall send to the International Bureau, ex officio or at the request of the plaintiff, a copy of the complaint or any other documentary evidence that an action has begun, and also of the final decision of the court; the Bureau shall enter notice thereof in the International Register.

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<sup>\*</sup> [The Assembly of the Madrid Union has decided that paragraphs \(2\), \(3\) and \(4\) of Article 6 cease to apply in respect of international registrations bearing dates of international registration between January 1, 2016, and December 31, 2021.](#)

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

**Protocol  
Relating to the  
Madrid Agreement  
Concerning  
the International Registration  
of Marks**

Adopted at Madrid on June 27, 1989,  
as amended on October 3, 2006,  
and on November 12, 2007

[...]

**Article 6**

**Period of Validity of International Registration;  
Dependence and Independence of International Registration\***

(1) *Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.*

(2) *Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.*

(3) *The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if*

(i) *an appeal against a decision refusing the effects of the basic application,*

(ii) *an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or*

(iii) *an opposition to the basic application*

*results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such*

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\* [The Assembly of the Madrid Union has decided that paragraphs \(2\), \(3\) and \(4\) of Article 6 cease to apply in respect of international registrations bearing dates of international registration between January 1, 2016, and December 31, 2021.](#)

*appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.*

*(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.*

[Annex II follows]

**STATISTICAL INFORMATION CONCERNING RECORDED CANCELLATIONS DUE TO CEASING OF EFFECT OF THE BASIC MARK**

TABLE I: NOTIFICATIONS OF CEASING OF EFFECT RECORDED IN 2013\*

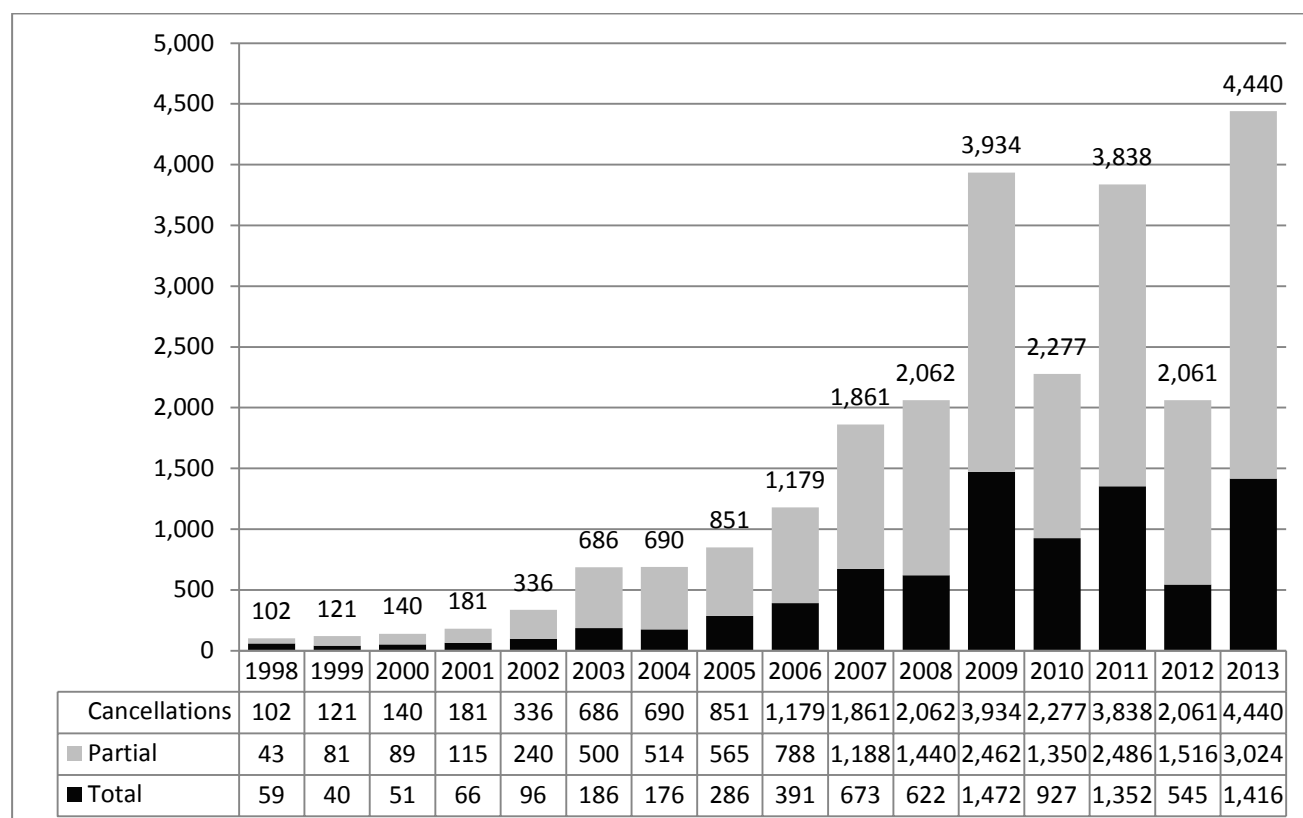
Contracting Party	International Registrations	Notifications of Ceasing of Effect	Total Ceasing of Effect	Partial Ceasing of Effect	Protocol Only	Agreement and Protocol	Designations Affected
Australia (AU)	1,195	198	63	135	198		1,092
Austria (AT)	808	113	39	74	94	19	1,410
Belarus (BY)	329	13	4	9	12	1	123
Benelux (BX)	1,784	53	26	27	44	9	567
Bosnia and Herzegovina (BA)	12	1	1			1	8
Bulgaria (BG)	200	11	8	3	7	4	199
China (CN)	2,455	2	1	1	1	1	142
Croatia (HR)	119	3	1	2	3		12
Czech Republic (CZ)	375	17	7	10	15	2	270
Denmark (DK)	372	36	10	26	36		330
Estonia (EE)	35	13	3	10	13		88
European Union (EM)	6,814	824	146	678	821	3	5,864
Finland (FI)	173	46	8	38	46		383
France (FR)	3,514	58	5	53	48	10	646
Germany (DE)	4,357	560	94	466	512	48	5,197
Hungary (HU)	259	2	2		1	1	53
Iceland (IS)	125	1	1		1		19
Ireland (IE)	55	4	1	3	4		72
Israel (IL)	142	1		1	1		2
Italy (IT)	2,118	8	8		8		32
Japan (JP)	1,855	189	44	145	189		1,636
Latvia (LV)	110	6	6		2	4	16
Lithuania (LT)	104	8	2	6	8		69
Morocco (MA)	49	1	1		1		6
New Zealand (NZ)	225	1		1	1		6
Norway (NO)	340	30	9	21	30		158
Portugal (PT)	208	7	4	3	5	2	66
Republic of Korea (KR)	430	84	39	45	84		965
Republic of Moldova (MD)	55	5	3	2	4	1	27
Romania (RO)	92	4	2	2	2	2	21
Russian Federation (RU)	1,211	24	18	6	15	9	292
Serbia (RS)	146	16	8	8	16		88
Singapore (SG)	210	5	1	4	5		50
Slovakia (SK)	100	2	1	1	1	1	29
Slovenia (SI)	163	2	1	1	2		12
Spain (ES)	655	5	2	3	4	1	27
Sweden (SE)	210	13	6	7	13		78
Switzerland (CH)	2,885	144	47	97	134	10	1,356
Turkey (TR)	1,254	159	78	81	157	2	2,667
Ukraine (UA)	479	1		1	1		7
United Kingdom (GB)	1,580	42	14	28	42		426
United States of America (US)	5,893	1,728	702	1,026	1,728		13,315
TOTAL	43,495	4,440	1,416	3,024	4,309	131	37,826

\* In 2013, no notification sent under Rule 22 of the Common Regulations was recorded in respect of an international registration governed by the Agreement only.

TABLE II: RATE OF INCREASE OF INTERNATIONAL REGISTRATIONS (IR) AND RECORDED CANCELLATIONS DUE TO CEASING OF EFFECT (CE) (2001 TO 2013)

	2001	2002	2003	2004	2005	2006	2007	2008	2009	2010	2011	2012	2013
IR	23,985	22,236	21,847	23,379	33,169	37,224	38,471	40,985	35,295	37,533	40,711	41,954	44,414
	4%	-7%	-2%	7%	42%	12%	3%	7%	-14%	6%	8%	3%	6%
CE	181	336	686	690	851	1,179	1,861	2,062	3,934	2,277	3,838	2,061	4,440
	29%	86%	104%	1%	23%	39%	58%	11%	91%	-42%	69%	-46%	115%

GRAPH I: RECORDED CANCELLATIONS DUE TO CEASING OF EFFECT (2009 TO 2013)



[End of Annex II and of document]