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

**Twelfth Session**

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

rEPLACEMENT

*Document prepared by the International Bureau*

1. This document recalls the basic elements of the operation of replacement and examines how the applicable provisions of the treaties of the Madrid System have been implemented by its Contracting Parties, based on information provided by them. It summarizes the divergent interpretations of the underlying principles governing replacement made by the Contracting Parties and it proposes, for the consideration of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), issues for discussion and consideration aimed at simplifying and harmonizing the practices on replacement of the Offices of the Contracting Parties.

# I. Introduction

1. Replacement is set out in Articles 4*bis* of the Madrid Agreement Concerning the International Registration of Marks and of the Protocol Relating to that Agreement (hereinafter referred to, respectively, as “the Agreement” and “the Protocol”) and in Rule 21 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”).
2. The issue of replacement was last discussed in the *ad hoc* Working Group, at its fifth session (May 5 to 9, 2008). Document MM/LD/WG/5/7 presented the findings of a survey where 48 Offices of Contracting Parties[[1]](#footnote-2) had replied to a questionnaire on the practices concerning the replacement procedures. Reference is made also to document MM/LD/WG/3/3, presented in the third session of the Working Group.
3. The International Bureau frequently receives questions from users of the Madrid System on how replacement works and how the various Offices of the Contracting Parties to the Madrid System have implemented the procedure for replacement. Due to the sustained interest of users on replacement and the recent significant growth in the number of Contracting Parties to the Madrid System, the International Bureau wanted to revisit the issue of replacement, to gather more information on how this is implemented in the various Offices. The International Bureau invited Offices and other relevant authorities of the members of the Madrid Union to provide information in a questionnaire concerning replacement[[2]](#footnote-3). This questionnaire was identical to the one sent to the Contracting Parties in November 2007; so, Offices had the options to submit information for the first time, to update the information provided in 2008, or to refrain from replying, if the information provided in 2008, was still valid.
4. By March 10, 2014, the International Bureau had received replies to the questionnaire from 57 out of the 92 Contracting Parties to the Madrid System. In addition, information from 14 Contracting Parties that was provided in 2008, has been taken into account, as it is assumed that this information is still valid since no new information has been submitted. The statistical compilation of all the replies to the questionnaire, from 71 Contracting Parties, is set out in Annex I, while Annex II provides a matrix showing the answers received.

# II. REPLACEMENT: BASIC PRINCIPLES

1. The basic principles that govern the replacement procedure were set out in document MM/LD/WG/2/8. These are reproduced below for the convenience of this session of the Working Group.
2. Articles 4*bis*(1) of the treaties provide that a mark that is the subject of a national or regional registration in the Office of a Contracting Party is deemed to be replaced by an international registration of the same mark under the following conditions[[3]](#footnote-4):

(i) both the national or regional registration and the international registration are in the name of the same holder,

(ii) protection resulting from the international registration extends to the Contracting Party in question,

(iii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the Contracting Party in question, and

(iv) the extension of the international registration to that Contracting Party takes effect after the date of the national or regional registration.

1. Furthermore, Articles 4*bis*(1) of the treaties state that the international registration is deemed to replace the national or regional registration without prejudice to any rights acquired by virtue of the latter.
2. Articles 4*bis*(2) of the treaties provide that the Office, in whose national or regional register the mark is recorded, is required, upon request, to take note in its register of the international registration. Rule 21(1) of the Common Regulations further provides that where, following a request by the holder, an Office has taken note in its register, that Office is required to notify the International Bureau accordingly[[4]](#footnote-5). Such notification should indicate the following:

(i) the number of the international registration concerned,

(ii) where the replacement concerns only some of the goods and services in the international registration, those goods and services, and

(iii) the filing date and number, the registration date and number, and the priority date, if any, of the national or regional registration which has been replaced by the international registration.

1. Pursuant to Rules 21(2) and 32(1)(xi) of the Common Regulations, the International Bureau records and publishes the above indications. The purpose of this procedure is to ensure that the relevant information concerning replacement is made available to third parties in the national or regional registers, as well as in the International Register[[5]](#footnote-6).
2. It should be underlined that the fact that an Office takes note in its register of an international registration, pursuant to Articles 4*bis*(2) of the treaties, is not a precondition for replacement, only a formality. Articles 4*bis*(2) of the treaties merely provide that an Office take note “upon request”. In other words, provided the conditions under Articles 4*bis*(1) of the treaties have been met, replacement has effect and the possibility of requesting an Office to take note of that fact is an option which the holder may elect, or not, to exercise. However, apart from the qualification relating to earlier acquired rights, neither the Agreement nor the Protocol elaborates further on the effects of replacement.

# III. IMPLEMENTATION AND APPLICATION OF ARTICLES 4*BIS* OF THE MADRID AGREEMENT AND of the PROTOCOL, AND OF RULE 21 OF THE COMMON REGULATIONS

1. The information provided by the Offices shows that divergent procedures and practices prevail regarding the implementation of Articles 4*bis* of the treaties and of Rule 21 of the Common Regulations.

### Implementation of Articles 4*bis*

1. There are Contracting Parties that have not yet adopted any specific provisions concerning the implementation of Articles 4*bis* of the treaties. The information provided shows that Articles 4*bis*(1) are directly applicable in a large group of Offices (38), while a noteworthy number of Offices (27) have provisions in their national or regional trademark legislation specifically implementing these Articles. A small number of Offices (six) neither have implementing provisions nor is the Agreement or the Protocol directly applicable.

### Request to take note (Article 4*bis*(2) – procedure)

1. While replacement as such is effective automatically, provided that the conditions are met, Articles 4*bis*(2) of the treaties state that an Office, upon request, shall be required to take note in its register of the international registration. Regarding the formality of an Office taking note in its register of an international registration, the replies to the questionnaire show that the following practices have been adopted:

(a) A noteworthy group of Offices (29) have provisions in their national trademark legislation to implement Articles 4*bis*(2) of the treaties, while a large group of Offices (44) have not implemented such provisions. Of the latter group, the Agreement or the Protocol is of direct application in 28 Offices, 13 Offices have a specific procedure for its application (such as Office practice or Administrative guidelines of Office), and three Offices have neither implementing provisions nor is the Agreement or the Protocol of direct application.

(b) Regarding the procedure of taking note, a noteworthy number of Offices (14) require that a request under Articles 4*bis*(2) of the treaties be presented on a specific form.

(c) Not all Offices have established fees concerning replacement, although a noteworthy number of Offices (24) require the payment of a specific fee.

(d) A number of Offices (28) have informed of other specific requirements. One Office (New Zealand) requires the request to be submitted electronically, another Office (Republic of Korea) requires the holder to submit an extract of the national registration, and in yet another Office (Turkey), the holder is required to submit a letter of application together with a power of attorney.

(e) Most of the Offices (54) have received requests to take note in their register of a replacement of a national or regional registration. Twenty-three Offices have received between one to five requests to take note, 15 Offices have received between five and 20 requests, and 16 Offices have received between 21 and 100 requests. No Office has received more than 100 requests. However, a noteworthy number of Offices (17) have not yet taken note of any replacement.

(f) Most of the Offices (60) that have taken note of replacement have done so upon request from the holder. However, a small number of Offices (10) have in place an *ex officio* procedure for taking note of the international registration, irrespective of a request from the holder: three Offices have indicated that they have not yet taken such note, three Offices have taken note less than five times, two Offices have taken note between five to 20 times, one Office has taken note between 21 to 100 times, and one Office reported having taken note *ex officio* more than 100 times.

(g) All of the Offices verify criteria for replacement before taking note. Almost all of the Offices verify that all the goods and services listed in the national registration are also listed in the international registration (69); that the same holder owns the national and the international mark (68); that the protection resulting from the international registration extends to the territory (66); and that the extension of the international registration takes effect after the date of the national registration (59). In addition, a noteworthy number of Offices (14) have other specific requirements, for example, identity of marks or payment of fees.

# IV. INTERPRETATION OF ARTICLES 4*BIS* – DIVERGENT VIEWS AND PRACTICES AT THE NATIONAL OR REGIONAL LEVEL

1. Apart from the matter of the direct implementation and application of Articles 4*bis* of the treaties and Rule 21 of the Common Regulations, it seems clear that among those Offices where procedures for replacement are in place or where there is some experience with replacement, there are divergent interpretations on how to apply the provisions. The following differences, that were also addressed in the Working Group at its third session (see document MM/LD/WG/3/3), continue to exist according to the information given upon the latest questionnaire.

### Date on which replacement takes place

1. There are different views among the Offices on the date of effect of replacement. A large group of Offices (30) take the view that the relevant date for the purpose of replacement is the date of the international registration in question. A smaller number of Offices (10) take the view that replacement takes place upon the date of expiry of the refusal period. A noteworthy number of Offices (19) consider that replacement would take place on the date of the grant of protection, where applicable. Ten Offices have provided specific information, such as that replacement would take place on the date of expiry of an opposition period, if no opposition has been filed (Estonia), or that replacement would take place within one month from the request for taking note of replacement (Lithuania).

### Time at which a request under Articles 4*bis*(2) may be filed with the Office

1. Regarding the request to take note under Articles 4*bis*(2) of the treaties, there are various practices in the Offices regarding as from when they will accept such requests. A large group of Offices (47) accept such request after the date of notification of the international registration or the subsequent designation by the International Bureau. A noteworthy number of Offices (11) accepts the request only after the date of issuing a statement of grant of protection. A small number of Offices (7) accept the request only from the date of expiry of the refusal period, and another small number of Offices (6) indicate they have different practices, which have been specifically detailed; for example, that the holder would need to submit the request on a specific form (“Request for recordal on concurrent registration” – TM28 in the United Kingdom).

### Goods and services listed in the national or regional registration

1. A noteworthy number of Offices (27) have informed that they do not take note of the international registration where the list of goods and services in the national or regional registration is not entirely covered by that of the international registration. A slightly larger group of Offices (28) accept “partial replacement”, meaning that the goods and services not fully covered by the international registration will remain unaffected in the national register. One Office (Japan) does not accept “partial replacement”, but the goods and services covered by the international registration are taken note in its register (so called “overlapping”). In a smaller group of Offices (12) such “partial replacement” takes place, but the holder will be required to request cancellation of the remainder of the registration in the national register. Only two Offices cancel the remaining goods and services *ex officio*.

### Effects of replacement on the national or regional registration

1. Following a request made under Articles 4*bis*(2) of the treaties, the information provided by the Offices indicate different practices on whether the national registration that is deemed replaced by the international registration may continue to co‑exist with the international registration. A large group of Offices (41) permits such co‑existence of the national registration and the international registration, while a smaller number of Offices (10) only allow the co‑existence for the goods and services in the national registration that are not considered replaced by the international registration (“partial replacement”) and then only for the remainder of the current term of protection. Few Offices (4) cancel the national registration *ex officio* and three Offices require the holder to renounce the national registration.
2. Where the holder has not requested the Office to take note under Articles 4*bis*(2) of the treaties, but where the Office is aware that replacement is deemed to have taken place and the conditions for taking note in the national register are met, a large number of Offices (46) have indicated that they allow the co‑existence of the national registration and the international registration that has replaced it. A small number of Offices (7) only allow co‑existence for the goods and services in the national registration that are not covered by the goods and services of the international registration and only for the remainder of the current term of protection. Few Offices (4) have indicated that they request the holder to renounce the national registration, and one Office would cancel the national registration *ex officio*.
3. Among the number of Offices that do not allow co‑existence, a noteworthy number (14) do not allow for reinstatement of the national registration in the event that the international registration ceases to have effect within the five-year dependency period (Article 6 of the Agreement and the Protocol). However, a small number of Offices (8) have indicated that they allow for reinstatement of the national registration where the international registration ceases to have effect under Rule 22 of the Common Regulations.
4. Where an international registration, deemed to have replaced a national registration, ceases to have effect in accordance with Rule 22 of the Common Regulations, most of the Offices (55) have indicated that a transformation carries the benefit of the earlier national rights. However, 12 Offices have indicated that the transformation does not carry that kind of benefits.

### Miscellaneous

1. A noteworthy number of Offices (21) replied that reliance on a replaced and non‑renewed national mark is permitted in their legal and administrative proceedings, but only if the international registration has been noted in the national register. In a smaller group of Offices (11), reliance is possible even if the international registration has not been noted in the national register. A larger group of Offices have replied that reliance would either not be possible (17) or they are not certain (20).
2. The International Bureau has made available to the Offices of Contracting Parties to the Madrid System model provisions on replacement. Most of the Offices (52) have found these useful, a noteworthy number of Offices (14) were indifferent to their usefulness and two Offices did not consider them useful at all.

# V. KEY ELEMENTS FOR DISCUSSION AND CONSIDERATION

1. The findings of the questionnaire, as summarized above, have revealed that divergent interpretations, procedures and practices continue to exist in respect of the implementation of replacement under Articles 4*bis* of the treaties and of Rule 21 of the Common Regulations. The findings show that there are different interpretations of key elements of replacement, such as the effective date of replacement, the time at which a request under Articles 4*bis*(2) may be filed with the Office, the goods and services listed in the national or regional registration, and the effects of replacement on the national or regional registration. It is therefore proposed that the Working Group discuss these key elements, with a view to make the Madrid System more user‑friendly and to achieve a smoother process for the users and the Offices concerned.

### The effective date of replacement

1. Replacement of the national registration by an international registration is deemed to be automatic when the conditions under Articles 4*bis*(1) of the treaties are met; replacement is not depending on any action by the holder or an Office concerned. There are two relevant dates, namely the effective date of replacement and the date of the recording in the national or regional register taking note that replacement has occurred. The effective date of replacement is the date of the international registration or the subsequent designation.

### The time at which a request under Articles 4*bis*(2) may be filed with the Office

1. Offices of Contracting Parties shall, upon request, take note in their national or regional register of replacement, as established in Articles 4*bis*(2) of the treaties. The Offices should accept requests to take note of replacement as from the date of notification of the international registration or the subsequent designation by the International Bureau.

### The goods and services listed in the national or regional registration

1. Before taking note, the Offices should verify that the requirements under Articles 4*bis*(1) of the treaties are met, specifically, that the date of any extension of protection under Articles 3*ter* of the treaties is subsequent to the date of the national or regional registration, and that the goods and services listed in the national or regional registration are all listed in the international registration. The international registration does not need to have an identical list of goods and services: the list can be broader in scope, but not narrower. The names of the goods and services used in the international registration do not need to be the same, but they must be equivalent.

### The effects of replacement on the national or regional registration

1. A national or regional registration and the international registration that is replacing it (totally or partially) should be able to co‑exist. Replacement itself does not necessarily imply or require a cancellation of the national or regional registration. It should be a decision by the holder whether to renew the national or regional registration or not. With such co‑existence, the holder may avoid losing protection for his trademark, where the international registration ceases to have effect in the five-year dependency period (Article 6(2) of the Agreement and Article 6(2) of the Protocol).
2. *The Working Group is invited to:*

*(i) comment on the above, in particular on the key elements listed in part V; and*

*(ii) indicate any other action it deems appropriate in view of the current status of practices regarding replacement in Offices of Contracting Parties.*

[Annexes follow]

# STATISTICal compilation of replies received to the questionnaire on replacement (december 2013)

## CONTRACTING PARTIES HAVING REPLIED TO THE QUESTIONNAIRE ON REPLACEMENT

|  |  |  |  |
| --- | --- | --- | --- |
| 1. | Albania | 37. | Madagascar |
| 2. | Algeria | 38. | Mexico |
| 3. | Antigua and Barbuda | 39. | Monaco (2008) |
| 4. | Armenia | 40. | Mongolia |
| 5. | Australia | 41. | Montenegro |
| 6. | Austria (2008) | 42. | Morocco (2008) |
| 7. | Azerbaijan (2008) | 43. | Netherlands Antilles (2008) / Curacao[[6]](#footnote-7) and Sint Maarten (Dutch part)1 (2014) |
| 8. | Bahrain (2008) | 44. | New Zealand |
| 9. | Belarus | 45. | Norway |
| 10. | Benelux | 46. | Philippines |
| 11. | Bosnia and Herzegovina (2008) | 47. | Poland |
| 12. | Bulgaria | 48. | Portugal (2008) |
| 13. | China | 49. | Republic of Korea |
| 14. | Colombia | 50. | Republic of Moldova |
| 15. | Croatia | 51. | Romania |
| 16. | Cuba (2008) | 52. | Russian Federation |
| 17. | Cyprus | 53. | Serbia (2008) |
| 18. | Czech Republic | 54. | Singapore (2008) |
| 19. | Denmark | 55. | Slovakia |
| 20. | Estonia | 56. | Slovenia |
| 21. | European Union | 57. | Spain |
| 22. | Finland | 58. | Sudan |
| 23. | France (2008) | 59. | Sweden |
| 24. | Georgia | 60. | Switzerland |
| 25. | Germany | 61. | The former Yugoslav Republic of Macedonia (2008) |
| 26. | Greece | 62. | Tajikistan |
| 27. | Hungary | 63. | Tunisia |
| 28. | Iceland | 64. | Turkey |
| 29. | Ireland | 65. | Turkmenistan |
| 30. | Israel | 66. | Ukraine |
| 31. | Italy | 67. | United Kingdom |
| 32. | Japan | 68. | United States of America |
| 33. | Kenya (2008) | 69. | Uzbekistan |
| 34. | Kyrgyzstan | 70. | Viet Nam |
| 35. | Latvia (2008) | 71. | Zambia |
| 36. | Lithuania |  |  |

# Questionnaire on replacement (december 2013)

## I. APPLICABLE LEGISLATION

1. Are there provisions in your national[[7]](#footnote-8)2 trademark legislation to implement Article 4*bis*(1) of the Madrid Agreement and/or the Protocol?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 27 | 38% | 19 | 40% |
| 2 | No, because the Agreement/Protocol is of direct application | 38 | 54% | 26 | 54% |
| 3 | No, there are no such provisions, although the Agreement/Protocol is not of direct application | 6 | 8% | 3 | 6% |
|  | Total number of responses | 71 |  | 48 |  |
|  | Number of Offices having responded to the question | 71 |  | 48 |  |

2. Are there provisions in your national trademark legislation to implement Article 4*bis*(2) of the Madrid Agreement and/or the Protocol?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 29 | 38% | 21 | 43% |
| 2 | No, because the Agreement/Protocol is of direct application | 28 | 37% | 20 | 41% |
| 3 | No, there are no such provisions, although the Agreement/Protocol is not of direct application | 3 | 4% | 1 | 2% |
| 4 | No, but there is a procedure | 13 | 21% | 7 | 14% |
|  | Total number of responses | 73 |  | 49 |  |
|  | Number of Offices having responded to the question | 71 |  | 47 |  |

If No, but there is a procedure, this procedure:

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Consists of Office practice | 10 | 63% | 7 | 78% |
| 2 | Is prescribed by Administrative guidelines of Office | 3 | 19% | 2 | 22% |
| 3 | Other | 3 | 19% |  |  |
|  | Total number of responses | 16 |  | 9 |  |
|  | Number of Offices having responded to the question | 15 |  | 9 |  |

3. If your Office does have in place a procedure for “taking note” of an international registration in accordance with Article 4*bis(2)* of the Madrid Agreement and/or of the Protocol, do you require:

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Use a specific form | 14 | 20% | 9 | 23% |
| 2 | Payment of fee | 24 | 34% | 15 | 38% |
| 3 | Extract of the International Register | 6 | 8% | 4 | 10% |
| 4 | Other | 28 | 39% | 19 | 48% |
|  | Total number of responses | 72 |  | 47 |  |
|  | Number of Offices having responded to the question | 71 |  | 40 |  |

4. Are there provisions in your national trademark legislation to implement Rule 21 of the Common Regulations?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 19 | 26% | 11 | 22% |
| 2 | No, because the Regulations are of direct application | 33 | 45% | 24 | 47% |
| 3 | No, there are no such provisions, although the Regulations are not of direct application | 4 | 5% | 1 | 2% |
| 4 | No, but there is a procedure | 17 | 23% | 14 | 27% |
|  | Total number of responses | 73 |  | 51 |  |
|  | Number of Offices having responded to the question | 71 |  | 48 |  |

If No, but there is a procedure, this procedure:

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Consists of Office practice | 12 | 71% | 11 | 73% |
| 2 | Is prescribed by the Administrative Guidelines of Office | 6 | 35% | 4 | 27% |
| 3 | Other | 2 | 12% |  |  |
|  | Total number of responses | 17 |  | 15 |  |
|  | Number of Offices having responded to the question | 17 |  | 15 |  |

## II. EXPERIENCE OF THE OFFICE

1. Has your Office, in fact, had occasion, on request, to take note of an international registration in accordance with Article 4*bis*(2) of the Madrid Agreement and/or of the Protocol?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | No | 17 | 24% | 9 | 19% |
| 2 | Yes, but no more than 5 such requests | 23 | 32% | 13 | 27% |
| 3 | Yes, between 5 and 20 such requests | 15 | 21% | 13 | 27% |
| 4 | Yes, between 21 and 100 such requests | 16 | 23% | 13 | 27% |
| 5 | Yes, more than 100 such requests | 0 | 0% | 0 | 0% |
|  | Total number of responses | 71 |  | 48 |  |
|  | Number of Offices having responded to the question | 71 |  | 48 |  |

2. Does your Office operate an *ex officio* procedure for “taking note” of an international registration – i.e., irrespective of the filing of a request to take note?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | No | 60 | 86% | 39 | 81% |
| 2 | Yes | 10 | 14% | 9 | 19% |
|  | Total number of responses | 70 |  | 48 |  |
|  | Number of Offices having responded to the question | 70 |  | 48 |  |

If Yes, how many cases have there been?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | None, so far | 3 | 30% | 2 | 25% |
| 2 | No more than 5 | 3 | 30% | 2 | 25% |
| 3 | Between 5 and 20 | 2 | 20% | 3 | 38% |
| 4 | Between 21 and 100 | 1 | 10% | 1 | 13% |
| 5 | More than 100 | 1 | 10% | 0 | 0% |
|  | Total number of responses | 10 |  | 8 |  |
|  | Number of Offices having responded to the question | 10 |  | 8 |  |

## III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE

1. Assuming that your Office is presented with a request to take note of an international registration, on which criteria does it, or would it, carry out an examination to assess whether replacement should take place?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | The protection resulting from the international registration extends to the territory of your country/region | 66 | 94% | 48 | 100% |
| 2 | The national and international marks are in the name of the same holder | 68 | 97% | 47 | 98% |
| 3 | All the goods and services listed in the national registration are also listed in the international registration, in respect of the territory of your country/region | 69 | 99% | 47 | 98% |
| 4 | The extension of the international registration to the territory of your country/region takes effect after the date of the national registration | 59 | 84% | 42 | 88% |
| 5 | Other | 14 | 20% | 10 | 21% |
| 6 | There would be no examination | 0 | 0% | 0 | 0% |
|  | Total number of responses | 277 |  | 194 |  |
|  | Number of Offices having responded to the question | 70 |  | 48 |  |

2. If it occurs that the goods and services listed in the national registration are *not* all listed in the international registration, i.e., the list of goods and services in the international registration is narrower than the list recorded nationally, does, or would, your Office nevertheless consider that a partial replacement takes place in respect of the specification that is common to both the national and international registrations?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | No, replacement would not take place | 27 | 39% | 19 | 40% |
| 2 | Yes, with the remainder of the specification remaining unaffected in the national register | 28 | 41% | 20 | 43% |
| 3 | Yes, but the Office would *ex officio* cancel the remainder of the specification in the national register | 2 | 3% | 1 | 2% |
| 4 | Yes, but the holder would be required to request cancellation of the remainder of the specification in the national register | 12 | 17% | 7 | 15% |
|  | Total number of responses | 69 |  | 47 |  |
|  | Number of Offices having responded to the question | 69 |  | 47 |  |

3. At what time does, or would, your Office consider that replacement takes place?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | On the date of international registration or subsequent designation | 30 | 43% | 20 | 42% |
| 2 | On the date of expiry of the refusal period | 10 | 14% | 12 | 25% |
| 3 | In the event that your Office issues statements of grant of protection, on the date of issuing of statement of grant of protection | 19 | 28% | 9 | 19% |
| 4 | Other | 10 | 14% | 7 | 15% |
|  | Total number of responses | 69 |  | 48 |  |
|  | Number of Offices having responded to the question | 69 |  | 48 |  |

4. If your Office considers, or would, consider that replacement takes place either on the date of expiry of the refusal period, or of issuing of a statement of grant of protection, is the effect of replacement considered to be retroactive to the date of the international registration or subsequent designation in question?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 31 | 69% | 12 | 57% |
| 2 | No | 14 | 31% | 9 | 43% |
|  | Total number of responses | 45 |  | 21 |  |
|  | Number of Offices having responded to the question | 45 |  | 21 |  |

5. When does, or would, your Office accept the filing of a request to take note under Article 4*bis*(2)?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | After the date of notification by the International Bureau of the international registration or subsequent designation in question | 47 | 66% | 34 | 67% |
| 2 | Only from the date of expiry of the refusal period | 7 | 10% | 7 | 14% |
| 3 | In the event that your Office issues statements of grant of protection, only after the date of issuing of statement of grant of protection | 11 | 15% | 5 | 10% |
| 4 | Other | 6 | 8% | 5 | 10% |
|  | Total number of responses | 71 |  | 51 |  |
|  | Number of Offices having responded to the question | 71 |  | 48 |  |

6. (redrafted on June 23, 2008)

(a) In case it has been requested to take note, under Article 4*bis*(2), of the international registration, does your Office permit the coexistence of the national registration and the international registration that has replaced it?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 41 | 71% | 36 | 75% |
| 2 | Yes, but only for the remainder of the current term of protection (i.e., the national registration may not be renewed) | 10 | 17% | 5 | 10% |
| 3 | No, the Office *ex officio* cancels the national registration | 4 | 7% | 6 | 13% |
| 4 | No, the holder needs to renounce the national registration | 3 | 5% | 1 | 2% |
|  | Total number of responses | 58 |  | 48 |  |
|  | Number of Offices having responded to the question | 58 |  | 48 |  |

(b) In case your Office has not been requested to take note, under Article 4*bis*(2), of the international registration, but is nevertheless aware that the conditions under Article 4*bis*(1) are met, does it permit the coexistence of the national registration and the international registration that has replaced it?[[8]](#footnote-9)3

|  |  |  |  |
| --- | --- | --- | --- |
|  |  | **2014** | |
|  | **Option** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 46 | 79% |
| 2 | Yes, but only for the remainder of the current term of protection (i.e., the national registration may not be renewed) | 7 | 12% |
| 3 | No, the Office *ex officio* cancels the national registration | 1 | 2% |
| 4 | No, the holder needs to renounce the national registration | 4 | 7% |
|  | Total number of responses | 58 |  |
|  | Number of Offices having responded to the question | 58 |  |

7. If your Office does not, or would not, permit coexistence of a national registration and the international registration that has replaced it, does, or would, your Office nevertheless permit reinstatement of the national registration should the international registration cease to have effect within the five-year dependency period (Article 6 of the Agreement and/or the Protocol)?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 8 | 38% | 4 | 57% |
| 2 | No | 14 | 67% | 3 | 43% |
|  | Total number of responses | 22 |  | 7 |  |
|  | Number of Offices having responded to the question | 22 |  | 7 |  |

8. **(For Offices of Members of the Protocol)** Article 4*bis* of the Agreement and of the Protocol provides that an international registration is deemed to replace a national registration without prejudice to any rights acquired by virtue of the latter. Thus, for example, replacement may include the benefit of a priority claim attached to the national registration.

Assume that replacement, under Article 4*bis*(1) of the Protocol, has taken place and has included certain such rights acquired by virtue of the national registration, but subsequently there has been recorded a ceasing of effect due to failure of the basic mark within the five-year dependency period in accordance with Article 6 of the Protocol. Assume also that in such case, the holder wishes to exercise his rights, under Article *9quinquies* of the Protocol, to transform the international registration into national application.

In your Office, does, or would, such transformation carry the benefit of those earlier national rights, such as, for example, a priority date?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 55 | 82% | 32 | 80% |
| 2 | No | 12 | 18% | 8 | 20% |
|  | Total number of responses | 67 |  | 40 |  |
|  | Number of Offices having responded to the question | 67 |  | 40 |  |

## IV. MISCELLANEOUS

1. (redrafted on June 23, 2008)

Where the conditions under Article 4*bis*(1) are met and, in addition, the national mark has lapsed, is reliance on any rights acquired by virtue of the national registration permitted in legal and administrative proceedings?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes, even if the international registration has not been noted in the national register | 11 | 16% | 5 | 10% |
| 2 | Yes, but only if the international registration has been noted in the national register | 21 | 30% | 10 | 21% |
| 3 | No | 17 | 25% | 15 | 31% |
| 4 | Do not know | 20 | 29% | 18 | 38% |
|  | Total number of responses | 69 |  | 48 |  |
|  | Number of Offices having responded to the question | 69 |  | 48 |  |

2. The International Bureau has made available model provisions with regard to the replacement procedure (see [www.wipo.int/madrid/en/contracting\_parties](http://www.wipo.int/madrid/en/contracting_parties)). Have you found the model provisions to be of assistance?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  |  | **2014** | | **2008** | |
|  | **Option** | **Contracting Parties** | **Percentage** | **Contracting Parties** | **Percentage** |
| 1 | Yes | 52 | 76% | 32 | 70% |
| 2 | No | 2 | 3% | 3 | 7% |
| 3 | Do not know | 14 | 21% | 11 | 24% |
|  | Total number of responses | 68 |  | 46 |  |
|  | Number of Offices having responded to the question | 68 |  | 46 |  |

[Annex II follows]

# Matrix of Replies received to the questionnaire on replacement (december 2013)

| **Contracting Party** | **QUESTION I.1.**  **I. APPLICABLE LEGISLATION**  **1. Are there provisions in your national trademark legislation to implement Article 4*bis*(1) of the Madrid Agreement and/or the Protocol?** | | |
| --- | --- | --- | --- |
| **YES** | **NO, because the Agreement/Protocol is of direct application** | **NO, there are no such provisions, although the Agreement/Protocol is not of direct application** |
| Albania |  | • |  |
| Algeria |  | • |  |
| Antigua and Barbuda |  | • |  |
| Armenia | • |  |  |
| Australia | • |  |  |
| Austria (2008) |  | • |  |
| Azerbaijan (2008) |  |  | • |
| Bahrain (2008) | • |  |  |
| Belarus | • |  |  |
| Benelux |  | • |  |
| Bosnia and Herzegovina (2008) |  | • |  |
| Bulgaria | • |  |  |
| China |  | • |  |
| Colombia | • |  |  |
| Croatia |  | • |  |
| Cuba (2008) |  |  | • |
| Cyprus |  | • |  |
| Czech Republic |  | • |  |
| Denmark | • |  |  |
| Estonia |  | • |  |
| European Union |  | • |  |
| Finland | • |  |  |
| France (2008) |  | • |  |
| Georgia |  | • |  |
| Germany |  | • |  |
| Greece | • |  |  |
| Hungary |  | • |  |
| Iceland | • |  |  |
| Ireland | • |  |  |
| Israel | • |  |  |
| Italy |  | • |  |
| Japan | • |  |  |
| Kenya (2008) |  | • |  |
| Kyrgyzstan |  | • |  |
| Latvia (2008) | • |  |  |
| Lithuania | • |  |  |
| Madagascar |  | • |  |
| Mexico | • |  |  |
| Monaco (2008) |  | • |  |
| Mongolia |  |  | • |
| Montenegro |  | • |  |
| Morocco (2008) |  | • |  |
| Netherlands Antilles (2008) / Curacao[[9]](#footnote-10) and Sint Maarten (Dutch part)\* (2014) |  |  | • |
| New Zealand | • |  |  |
| Norway | • |  |  |
| Philippines | • |  |  |
| Poland |  | • |  |
| Portugal (2008) |  | • |  |
| Republic of Korea | • |  |  |
| Republic of Moldova | • |  |  |
| Romania |  | • |  |
| Russian Federation |  | • |  |
| Serbia (2008) |  | • |  |
| Singapore (2008) | • |  |  |
| Slovakia |  | • |  |
| Slovenia |  | • |  |
| Spain |  | • |  |
| Sudan | • |  |  |
| Sweden | • |  |  |
| Switzerland |  | • |  |
| The former Yugoslav Republic of Macedonia (2008) |  | • |  |
| Tajikistan |  | • |  |
| Tunisia |  | • |  |
| Turkey |  | • |  |
| Turkmenistan | • |  |  |
| Ukraine |  | • |  |
| United Kingdom | • |  |  |
| United States of America | • |  |  |
| Uzbekistan |  | • |  |
| Viet Nam |  |  | • |
| Zambia |  |  | • |

| **Contracting Party** | **QUESTION I.2.**  **I. APPLICABLE LEGISLATION**  **2. Are there provisions in your national trademark legislation to implement Article 4*bis*(2) of the Madrid Agreement and/or the Protocol?** | | | | | | |
| --- | --- | --- | --- | --- | --- | --- | --- |
| **YES** | **NO, because the Agreement/Protocol is of direct application** | **NO, there are no such provisions, although the Agreement/**  **Protocol is not of direct application** | **NO, but there is a procedure** | **Consists of Office practice** | **Is prescribed by Administrative Guidelines of Office** | **Other** |
| Albania |  | • |  |  |  |  |  |
| Algeria |  | • |  |  |  |  |  |
| Antigua and Barbuda |  | • |  |  |  |  |  |
| Armenia | • |  |  |  |  |  |  |
| Australia | • |  |  |  |  |  |  |
| Austria (2008) |  | • |  |  |  |  |  |
| Azerbaijan (2008) |  |  | • |  | • |  |  |
| Bahrain (2008) | • |  |  |  |  |  |  |
| Belarus | • |  |  |  |  |  |  |
| Benelux |  | • |  |  |  |  |  |
| Bosnia and Herzegovina (2008) |  | • |  |  |  |  |  |
| Bulgaria | • |  |  |  |  |  |  |
| China |  |  |  | • | • |  |  |
| Colombia | • |  |  |  |  |  |  |
| Croatia |  | • |  |  | • |  |  |
| Cuba (2008) |  |  |  | • | • |  |  |
| Cyprus | • |  |  |  |  |  |  |
| Czech Republic |  | • |  |  |  |  |  |
| Denmark | • |  |  |  |  |  |  |
| Estonia | • |  |  |  |  |  |  |
| European Union | • |  |  |  |  |  |  |
| Finland | • |  |  |  |  |  |  |
| France (2008) |  | • |  |  |  |  |  |
| Georgia |  | • |  |  |  |  |  |
| Germany |  | • |  |  |  |  |  |
| Greece |  |  |  | • | • |  | The tax for this procedure is specified in L.4072/2012 art.179 1) ιδ. |
| Hungary | • |  |  |  |  |  |  |
| Iceland | • |  |  |  |  |  |  |
| Ireland | • |  |  |  |  |  |  |
| Israel | • |  |  |  |  |  |  |
| Italy |  | • |  |  |  |  |  |
| Japan |  | • |  |  |  |  |  |
| Kenya (2008) |  | • |  |  |  |  |  |
| Kyrgyzstan |  |  |  | • | • |  |  |
| Latvia (2008) | • |  |  |  |  |  |  |
| Lithuania | • |  |  |  |  |  |  |
| Madagascar |  |  |  | • |  | • |  |
| Mexico | • |  |  |  |  |  |  |
| Monaco (2008) |  | • |  |  |  |  |  |
| Mongolia |  |  | • |  |  |  |  |
| Montenegro |  | • |  |  |  |  |  |
| Morocco (2008) |  | • |  |  |  |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) |  |  |  | • | • |  |  |
| New Zealand | • |  |  |  |  |  |  |
| Norway | • |  |  |  |  |  |  |
| Philippines | • |  |  |  |  |  |  |
| Poland |  |  |  | • |  |  | The request to take note on the replacement is processed as any other request for new entry in the national register. |
| Portugal (2008) |  |  |  | • |  | • |  |
| Republic of Korea | • |  |  |  |  |  |  |
| Republic of Moldova | • |  |  |  |  |  |  |
| Romania |  | • |  |  |  |  |  |
| Russian Federation |  |  |  | • |  | • |  |
| Serbia (2008) |  | • |  |  |  |  |  |
| Singapore (2008) | • |  |  |  |  |  |  |
| Slovakia |  | • |  |  |  |  |  |
| Slovenia |  | • |  | • | • |  |  |
| Spain |  | • |  |  |  |  |  |
| Sudan | • |  |  |  |  |  |  |
| Sweden | • |  |  |  |  |  |  |
| Switzerland |  | • |  | • | • |  |  |
| The former Yugoslav Republic of Macedonia (2008) |  | • |  |  |  |  |  |
| Tajikistan |  | • |  |  |  |  |  |
| Tunisia |  | • |  |  |  |  |  |
| Turkey |  |  |  | • | • |  |  |
| Turkmenistan | • |  |  |  |  |  |  |
| Ukraine |  | • |  |  |  |  |  |
| United Kingdom | • |  |  |  |  |  |  |
| United States of America | • |  |  |  |  |  |  |
| Uzbekistan |  | • |  |  |  |  |  |
| Viet Nam |  |  | • |  |  |  |  |
| Zambia |  |  |  | • |  |  | Section 6(1) of our Trademarks Act require that all trademarks are placed on the register. |

| **Contracting Party** | **QUESTION I.3.**  **I. APPLICABLE LEGISLATION**  **3. If your Office does have in place a procedure for “taking note” of an international registration in accordance with Article 4*bis(2)* of the Madrid Agreement and/or of the Protocol, do you require:** | | | |
| --- | --- | --- | --- | --- |
| **Use a specific form** | **Payment of fee** | **Extract of the International Register** | **Other** |
| Albania |  |  |  |  |
| Algeria |  |  |  |  |
| Antigua and Barbuda |  | • | • |  |
| Armenia |  | • |  |  |
| Australia |  |  |  | Written request. |
| Austria (2008) |  |  |  |  |
| Azerbaijan (2008) |  |  |  |  |
| Bahrain | • |  |  |  |
| Belarus | • | • |  |  |
| Benelux |  |  |  | No specific requirements. |
| Bosnia and Herzegovina (2008) |  |  |  |  |
| Bulgaria |  | • |  |  |
| China | • |  |  |  |
| Colombia | • | • |  |  |
| Croatia |  |  |  |  |
| Cuba (2008) |  |  |  | Written request in form of a letter, including the reference numbers of both the national and international registry for the replacement (more than one national registry might be involved, depending on the classes, as a consequence of the former mono-class registration system). |
| Cyprus |  |  |  | Until present our office communicates the Act of Replacement to the International Bureau in Geneva. |
| Czech Republic |  |  |  | Without specific form, requirement in accordance with Article 4*bis* (1), (2), numbers of TMs. |
| Denmark |  |  |  | The Danish Patent and Trademark Office have no formal requirements. |
| Estonia |  |  |  |  |
| European Union |  |  |  | We consult databases. |
| Finland |  | • |  |  |
| France (2008) |  |  |  |  |
| Georgia |  |  |  | SAKPATENTI only requires a written request for replacement by the holder or a legal representative of the holder of the mark. |
| Germany |  |  |  | The German Patent and Trade Mark Office only requires a request for replacement by the holder of the mark. |
| Greece |  | • |  | An extract from the national register in which the national mark is registered and an extract from the national register in which the international registration is recorded. |
| Hungary |  |  |  | None of the above is required. |
| Iceland |  |  |  | A written request for replacement. |
| Ireland | • |  |  |  |
| Israel |  | • |  |  |
| Italy |  |  |  | The Italian Office requires only that the application by the holders, or his representative, includes a revenue stamp. No other fee has to be paid. |
| Japan | • |  |  |  |
| Kenya (2008) |  |  |  |  |
| Kyrgyzstan |  | • |  |  |
| Latvia (2008) |  | • | • |  |
| Lithuania |  | • |  |  |
| Madagascar | • | • |  |  |
| Mexico |  | • |  | The written requirement doesn’t need a specific form. |
| Monaco (2008) |  |  |  |  |
| Mongolia | • |  |  |  |
| Montenegro |  |  |  | Payment of a fee for entry of alteration into the register. |
| Morocco (2008) |  |  |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part) \* (2014) |  |  |  | We do not require any formalities yet. |
| New Zealand |  |  |  | Written request submitted electronically. |
| Norway |  |  |  |  |
| Philippines | • | • |  |  |
| Poland |  | • |  |  |
| Portugal (2008) | • | • |  |  |
| Republic of Korea | • |  | • | Extract of the National Registration. |
| Republic of Moldova |  | • |  | 1. The international registration which extends its effects for Republic of Moldova and national registration must be owned by the same person.  2. The international registration which extends its effects for Republic of Moldova and national registration must identify the same mark.  3. All of the goods/services listed in national registration are covered by international registration which extends its effects for Republic of Moldova.  4. The national trademark must be registered prior to the designation of the Republic of Moldova by international registration. |
| Romania |  |  |  |  |
| Russian Federation |  | • |  |  |
| Serbia (2008) | • |  |  |  |
| Singapore (2008) | • | • |  |  |
| Slovakia |  |  |  |  |
| Slovenia |  |  |  | We require a written request. |
| Spain |  |  |  | A note is taken on the National registry. |
| Sudan |  |  | • |  |
| Sweden |  | • |  |  |
| Switzerland |  |  |  | A mail from the holder or representative, asking for the inscription of the replacement and mentioning the concerned registrations (both national and international). |
| The former Yugoslav Republic of Macedonia (2008) |  |  |  |  |
| Tajikistan |  |  |  | Because the Agreement/Protocol is of direct application we have not in place a procedure of replacement for an international registration. |
| Tunisia |  |  |  |  |
| Turkey |  | • |  | Letter of application and power of attorney. |
| Turkmenistan |  | • | • |  |
| Ukraine |  |  |  | Request of the certificate owner in a free form. |
| United Kingdom |  |  |  |  |
| United States of America |  | • |  | 1. Both the registered extension of protection of the international registration and national registration must be owned by the same person and identify the same mark;  2. all of the goods/services listed in national registration are also listed in registered extension of protection;  3. must identify serial number or U.S. registration number of registered extension of protection;  4. must identify U.S. registration number of replaced national registration. |
| Uzbekistan |  |  | • |  |
| Viet Nam | • | • |  | Information of holder, international registration number, list of goods and services, national registration number. |
| Zambia |  |  |  | Madrid notification form. |

| **Contracting Party** | **QUESTION I.4.**  **I. APPLICABLE LEGISLATION**  **4. Are there provisions in your national trademark legislation to implement Rule 21 of the Common Regulations?** | | | | | | |
| --- | --- | --- | --- | --- | --- | --- | --- |
| **YES** | **No, because the Regulations are of direct application** | **No, there are no such provisions, although the Regulations are not of direct application** | **No, but there is a procedure** | **Consists of Office practice** | **Is prescribed by the Administrative Guidelines of Office** | **Other** |
| Albania |  | • |  |  |  |  |  |
| Algeria |  | • |  |  |  |  |  |
| Antigua and Barbuda |  | • |  |  |  |  |  |
| Armenia |  | • |  |  |  |  |  |
| Australia | • |  |  |  |  |  |  |
| Austria (2008) |  | • |  |  |  |  |  |
| Azerbaijan (2008) |  | • |  |  | • |  |  |
| Bahrain (2008) | • |  |  |  |  |  |  |
| Belarus | • |  |  |  |  |  |  |
| Benelux |  |  | • |  |  |  |  |
| Bosnia and Herzegovina (2008) |  | • |  |  |  |  |  |
| Bulgaria | • |  |  |  |  |  |  |
| China |  |  |  | • | • |  |  |
| Colombia | • |  |  |  |  |  |  |
| Croatia |  | • |  |  | • |  |  |
| Cuba (2008) |  |  |  | • | • |  |  |
| Cyprus | • |  |  |  |  |  |  |
| Czech Republic |  | • |  |  |  |  |  |
| Denmark |  |  |  | • | • |  | We follow Rule 21 of the Common Regulations. |
| Estonia |  |  |  | • | • |  |  |
| European Union |  |  |  | • |  | • |  |
| Finland |  |  |  | • |  | • |  |
| France (2008) |  | • |  |  |  |  |  |
| Georgia |  | • |  |  |  |  |  |
| Germany |  | • |  |  |  |  |  |
| Greece |  | • |  |  |  |  |  |
| Hungary |  | • |  |  |  |  |  |
| Iceland |  |  |  | • | • |  |  |
| Ireland | • |  |  |  |  |  |  |
| Israel | • |  |  |  |  |  |  |
| Italy |  | • |  |  |  |  |  |
| Japan |  | • |  |  |  |  |  |
| Kenya (2008) |  | • |  |  |  |  |  |
| Kyrgyzstan |  | • |  |  |  |  |  |
| Latvia (2008) | • |  |  |  |  |  |  |
| Lithuania |  | • |  |  |  |  |  |
| Madagascar |  |  |  | • |  | • |  |
| Mexico | • |  |  |  |  |  |  |
| Monaco (2008) |  |  | • |  |  |  |  |
| Mongolia |  |  | • |  |  |  |  |
| Montenegro |  | • |  |  |  |  |  |
| Morocco (2008) |  | • |  |  |  |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) |  |  |  | • | • |  |  |
| New Zealand | • |  |  |  |  |  |  |
| Norway |  |  |  | • |  | • |  |
| Philippines | • |  |  |  |  |  |  |
| Poland |  | • |  |  |  |  |  |
| Portugal (2008) |  |  |  | • |  | • |  |
| Republic of Korea | • |  |  |  |  |  |  |
| Republic of Moldova | • |  |  |  |  |  |  |
| Romania |  | • |  |  |  |  |  |
| Russian Federation |  |  |  | • |  | • |  |
| Serbia (2008) |  | • |  |  |  |  |  |
| Singapore (2008) | • |  |  |  |  |  |  |
| Slovakia |  | • |  |  |  |  |  |
| Slovenia |  | • |  | • | • |  |  |
| Spain |  | • |  |  |  |  |  |
| Sudan | • |  |  |  |  |  |  |
| Sweden |  |  |  | • | • |  |  |
| Switzerland |  | • |  | • | • |  |  |
| The former Yugoslav Republic of Macedonia (2008) |  | • |  |  |  |  |  |
| Tajikistan |  | • |  |  |  |  |  |
| Tunisia |  | • |  |  |  |  |  |
| Turkey |  |  |  | • | • |  |  |
| Turkmenistan | • |  |  |  |  |  |  |
| Ukraine |  | • |  |  |  |  |  |
| United Kingdom | • |  |  |  |  |  |  |
| United States of America | • |  |  |  |  |  |  |
| Uzbekistan |  | • |  |  |  |  |  |
| Viet Nam |  |  | • |  |  |  |  |
| Zambia |  |  |  | • |  |  | Section 39 (1) of our Trademarks Act allows for registered proprietor of trademark to request for cancellation or removal of trademark from register. |

| **Contracting Party** | **QUESTION II.1.**  **II. EXPERIENCE OF THE OFFICE**  **1. Has your Office, in fact, had occasion, on request, to take note of an international registration in accordance with Article 4*bis*(2) of the Madrid Agreement and/or of the Protocol?** | | | | |
| --- | --- | --- | --- | --- | --- |
| **NO** | **YES, but no more than 5 such requests** | **YES, between 5 and 20 such requests** | **YES, between 21 and 100 such requests** | **YES, more than 100 such requests** |
| Albania |  | • |  |  |  |
| Algeria | • |  |  |  |  |
| Antigua and Barbuda | • |  |  |  |  |
| Armenia |  | • |  |  |  |
| Australia |  |  |  | • |  |
| Austria (2008) |  |  |  | • |  |
| Azerbaijan (2008) | • |  |  |  |  |
| Bahrain (2008) | • |  |  |  |  |
| Belarus |  |  | • |  |  |
| Benelux | • |  |  |  |  |
| Bosnia and Herzegovina (2008) | • |  |  |  |  |
| Bulgaria |  |  |  | • |  |
| China |  | • |  |  |  |
| Colombia | • |  |  |  |  |
| Croatia |  |  | • |  |  |
| Cuba (2008) |  |  | • |  |  |
| Cyprus |  | • |  |  |  |
| Czech Republic |  | • |  |  |  |
| Denmark |  |  |  | • |  |
| Estonia |  |  |  | • |  |
| European Union |  |  | • |  |  |
| Finland |  |  | • |  |  |
| France (2008) |  | • |  |  |  |
| Georgia |  |  |  | • |  |
| Germany |  |  |  | • |  |
| Greece |  |  |  | • |  |
| Hungary |  | • |  |  |  |
| Iceland |  |  | • |  |  |
| Ireland |  |  | • |  |  |
| Israel |  |  | • |  |  |
| Italy |  | • |  |  |  |
| Japan |  |  | • |  |  |
| Kenya (2008) | • |  |  |  |  |
| Kyrgyzstan |  | • |  |  |  |
| Latvia (2008) |  |  |  | • |  |
| Lithuania |  |  |  | • |  |
| Madagascar | • |  |  |  |  |
| Mexico |  | • |  |  |  |
| Monaco (2008) |  | • |  |  |  |
| Mongolia |  | • |  |  |  |
| Montenegro | • |  |  |  |  |
| Morocco (2008) | • |  |  |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) |  | • |  |  |  |
| New Zealand |  | • |  |  |  |
| Norway |  |  | • |  |  |
| Philippines | • |  |  |  |  |
| Poland |  |  |  | • |  |
| Portugal (2008) |  | • |  |  |  |
| Republic of Korea |  |  |  | • |  |
| Republic of Moldova |  | • |  |  |  |
| Romania |  | • |  |  |  |
| Russian Federation |  |  |  | • |  |
| Serbia (2008) |  | • |  |  |  |
| Singapore (2008) |  |  |  | • |  |
| Slovakia |  |  | • |  |  |
| Slovenia |  | • |  |  |  |
| Spain |  | • |  |  |  |
| Sudan |  | • |  |  |  |
| Sweden |  |  |  | • |  |
| Switzerland |  |  | • |  |  |
| The former Yugoslav Republic of Macedonia (2008) | • |  |  |  |  |
| Tajikistan | • |  |  |  |  |
| Tunisia | • |  |  |  |  |
| Turkey |  |  | • |  |  |
| Turkmenistan |  |  | • |  |  |
| Ukraine |  | • |  |  |  |
| United Kingdom |  |  |  | • |  |
| United States of America |  |  | • |  |  |
| Uzbekistan | • |  |  |  |  |
| Viet Nam | • |  |  |  |  |
| Zambia |  | • |  |  |  |

| **Contracting Party** | **QUESTION II.2.**  **II. EXPERIENCE OF THE OFFICE**  **2. Does your Office operate an *ex officio* procedure for “taking note” of an international registration – i.e., irrespective of the filing of a request to take note?** | | | | | | |
| --- | --- | --- | --- | --- | --- | --- | --- |
| **NO** | **YES** | **None, so far** | **No more than 5** | **Between 5 and 20** | **Between 21 and 100** | **More than 100** |
| Albania | • |  |  |  |  |  |  |
| Algeria | • |  |  |  |  |  |  |
| Antigua and Barbuda |  | • | • |  |  |  |  |
| Armenia | • |  |  |  |  |  |  |
| Australia | • |  |  |  |  |  |  |
| Austria (2008) | • |  |  |  |  |  |  |
| Azerbaijan (2008) |  | • |  |  |  |  | • |
| Bahrain (2008) |  | • | • |  |  |  |  |
| Belarus | • |  |  |  |  |  |  |
| Benelux | • |  |  |  |  |  |  |
| Bosnia and Herzegovina (2008) | • |  |  |  |  |  |  |
| Bulgaria | • |  |  |  |  |  |  |
| China | • |  |  |  |  |  |  |
| Colombia | • |  |  |  |  |  |  |
| Croatia | • |  |  |  |  |  |  |
| Cuba (2008) | • |  |  |  |  |  |  |
| Cyprus |  | • |  | • |  |  |  |
| Czech Republic | • |  |  |  |  |  |  |
| Denmark | • |  |  |  |  |  |  |
| Estonia | • |  |  |  |  |  |  |
| European Union | • |  |  |  |  |  |  |
| Finland | • |  |  |  |  |  |  |
| France (2008) | • |  |  |  |  |  |  |
| Georgia |  | • |  |  |  | • |  |
| Germany | • |  |  |  |  |  |  |
| Greece | • |  |  |  |  |  |  |
| Hungary | • |  |  |  |  |  |  |
| Iceland | • |  |  |  |  |  |  |
| Ireland | • |  |  |  |  |  |  |
| Israel | • |  |  |  |  |  |  |
| Italy | • |  |  |  |  |  |  |
| Japan |  | •  However, the JPO has handled a number of overlaps (as defined previously). The number of “taking note” of international registrations in the national register based on national registrations, including the above-mentioned number of replacements is 306. We do not have the number only about replacements. |  |  |  |  |  |
| Kenya (2008) | • |  |  |  |  |  |  |
| Kyrgyzstan | • |  |  |  |  |  |  |
| Latvia (2008) | • |  |  |  |  |  |  |
| Lithuania | • |  |  |  |  |  |  |
| Madagascar | • |  |  |  |  |  |  |
| Mexico | • |  |  |  |  |  |  |
| Monaco (2008) | • |  |  |  |  |  |  |
| Mongolia | • |  |  |  |  |  |  |
| Montenegro | • |  |  |  |  |  |  |
| Morocco (2008) | • |  |  |  |  |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |  |  |  |  |  |
| New Zealand | • |  |  |  |  |  |  |
| Norway | • |  |  |  |  |  |  |
| Philippines | • |  |  |  |  |  |  |
| Poland | • |  |  |  |  |  |  |
| Portugal (2008) |  | • |  |  | • |  |  |
| Republic of Korea |  | • |  |  | • |  |  |
| Republic of Moldova | • |  |  |  |  |  |  |
| Romania | • |  |  |  |  |  |  |
| Russian Federation | • |  |  |  |  |  |  |
| Serbia (2008) |  | • |  | • |  |  |  |
| Singapore (2008) | • |  |  |  |  |  |  |
| Slovakia | • |  |  |  |  |  |  |
| Slovenia | • |  |  |  |  |  |  |
| Spain | • |  |  |  |  |  |  |
| Sudan |  | • |  | • |  |  |  |
| Sweden | • |  |  |  |  |  |  |
| Switzerland | • |  |  |  |  |  |  |
| The former Yugoslav Republic of Macedonia (2008) | • |  |  |  |  |  |  |
| Tajikistan | • |  |  |  |  |  |  |
| Tunisia | • |  |  |  |  |  |  |
| Turkey | • |  |  |  |  |  |  |
| Turkmenistan | • |  |  |  |  |  |  |
| Ukraine | • |  |  |  |  |  |  |
| United Kingdom | • |  |  |  |  |  |  |
| United States of America | • |  |  |  |  |  |  |
| Uzbekistan | • |  |  |  |  |  |  |
| Viet Nam | • |  |  |  |  |  |  |
| Zambia |  | • | • |  |  |  |  |

| **Contracting Party** | **QUESTION III.1.**  **III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE**  **1. Assuming that your Office is presented with a request to take note of an international registration, on which criteria does it, or would it, carry out an examination to assess whether replacement should take place?** | | | | | |
| --- | --- | --- | --- | --- | --- | --- |
| **The protection resulting from the international registration extends to the territory of your country/ region** | **The national and international marks are in the name of the same holder** | **All the goods and services listed in the national registration are also listed in the international registration, in respect of the territory of your country/ region** | **The extension of the international registration to the territory of your country/ region takes effect after the date of the national registration** | **Other** | **There would be no examination** |
| Albania | • | • | • | • |  |  |
| Algeria | • | • | • |  |  |  |
| Antigua and Barbuda |  | • | • |  |  |  |
| Armenia | • | • | • | • |  |  |
| Australia | • | • | • | • | The trademarks are identical. |  |
| Austria (2008) | • | • | • | • |  |  |
| Azerbaijan (2008) |  |  |  |  |  |  |
| Bahrain (2008) | • | • | • | • |  |  |
| Belarus | • | • | • | • |  |  |
| Benelux | • | • | • | • |  |  |
| Bosnia and Herzegovina (2008) | • | • | • | • |  |  |
| Bulgaria | • | • | • |  |  |  |
| China | • | • | • | • | The marks should be identic. |  |
| Colombia | • | • | • | • |  |  |
| Croatia | • | • | • | • |  |  |
| Cuba (2008) | • | • | • | • |  |  |
| Cyprus | • | • | • | • |  |  |
| Czech Republic | • | • | • | • | Identity of TMs. |  |
| Denmark | • | • | • | • | The Danish and International Trademark must be identical. |  |
| Estonia | • | • | • | • |  |  |
| European Union | • | • | • | • |  |  |
| Finland | • | • | • | • |  |  |
| France (2008) | • | • | • |  |  |  |
| Georgia | • | • | • | • |  |  |
| Germany | • | • | • | • |  |  |
| Greece | • | • | • | • |  |  |
| Hungary | • | • | • | • |  |  |
| Iceland | • | • | • | • |  |  |
| Ireland | • | • | • | • |  |  |
| Israel | • | • | • | • |  |  |
| Italy | • | • | • | • |  |  |
| Japan | • | • | • | • | The national and international trademarks are the same. |  |
| Kenya (2008) | • | • | • | • | The marks are identical. |  |
| Kyrgyzstan | • | • | • | • |  |  |
| Latvia (2008) | • | • | • | • |  |  |
| Lithuania | • | • | • | • | Fee for the replacement of a national registration by an international registration. |  |
| Madagascar | • | • | • | • |  |  |
| Mexico | • | • | • | • |  |  |
| Monaco (2008) | • | • | • | • |  |  |
| Mongolia |  | • | • |  |  |  |
| Montenegro | • | • | • | • |  |  |
| Morocco (2008) | • | • | • | • |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • | • | • | • |  |  |
| New Zealand | • | • | • | • | The marks are identical. |  |
| Norway | • | • | • | • |  |  |
| Philippines | • | • | • | • |  |  |
| Poland | • | • | • | • |  |  |
| Portugal (2008) | • | • | • | • |  |  |
| Republic of Korea | • | • | • | • | The national and international marks are same. |  |
| Republic of Moldova | • | • | • | • | 1. The international registration which extends its effects for Republic of Moldova and national registration must identify the same mark.  2. The fee for replacement must be paid. |  |
| Romania | • | • | • |  |  |  |
| Russian Federation | • | • | • |  |  |  |
| Serbia (2008) | • | • | • | • | Identity of signs. |  |
| Singapore (2008) | • | • | • | • |  |  |
| Slovakia | • | • | • | • |  |  |
| Slovenia | • | • | • | • |  |  |
| Spain | • | • |  | • |  |  |
| Sudan |  | • | • |  |  |  |
| Sweden | • | • | • | • |  |  |
| Switzerland | • | • | • | • |  |  |
| The former Yugoslav Republic of Macedonia (2008) | • | • | • | • |  |  |
| Tajikistan | • |  |  |  |  |  |
| Tunisia | • | • | • | • |  |  |
| Turkey | • | • | • | • | Payment of the replacement fee. |  |
| Turkmenistan | • | • | • | • |  |  |
| Ukraine | • | • | • | • | Mark that is the subject of a national registration in Ukraine is also the subject of an international registration. |  |
| United Kingdom | • | • | • | • |  |  |
| United States of America | • | • | • | • | The same marks are identified in both the national and international registrations; request must provide registration numbers for both the national and extended registrations; proper fee is included. |  |
| Uzbekistan | • | • | • |  |  |  |
| Viet Nam | • | • | • | • | The same marks are identified in both the national and international registrations; request must provide registration numbers for both the national and extended registrations; proper fees are included. |  |
| Zambia | • | • | • | • |  |  |

| **Contracting Party** | **QUESTION III.2.**  **III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE**  **2. If it occurs that the goods and services listed in the national registration are not all listed in the international registration, i.e., the list of goods and services in the international registration is narrower than the list recorded nationally, does, or would, your Office nevertheless consider that a partial replacement takes place in respect of the specification that is common to both the national and international registrations?** | | | |
| --- | --- | --- | --- | --- |
| **NO, replacement would not take place** | **YES, with the remainder of the specification remaining unaffected in the national register** | **YES, but the Office would *ex officio* cancel the remainder of the specification in the national register** | **YES, but the holder would be required to request cancellation of the remainder of the specification in the national register** |
| Albania |  | • |  |  |
| Algeria |  |  |  | • |
| Antigua and Barbuda |  |  | • |  |
| Armenia |  |  |  | • |
| Australia | • |  |  |  |
| Austria (2008) |  | • |  |  |
| Azerbaijan (2008) |  |  |  |  |
| Bahrain (2008) | • |  |  |  |
| Belarus | • |  |  |  |
| Benelux |  |  |  | • |
| Bosnia and Herzegovina (2008) |  | • |  |  |
| Bulgaria |  | • |  |  |
| China | • |  |  |  |
| Colombia |  | • |  |  |
| Croatia |  | • |  |  |
| Cuba (2008) |  | • |  |  |
| Cyprus | • |  |  |  |
| Czech Republic |  | • |  |  |
| Denmark | • |  |  |  |
| Estonia |  |  |  | • |
| European Union |  |  |  | • |
| Finland | • |  |  |  |
| France (2008) |  | • |  |  |
| Georgia | • |  |  |  |
| Germany | • |  |  |  |
| Greece |  | • |  |  |
| Hungary |  | • |  |  |
| Iceland |  | • |  |  |
| Ireland | • |  |  |  |
| Israel | • |  |  |  |
| Italy | • |  |  |  |
| Japan |  |  |  |  |
| Kenya (2008) |  |  |  | • |
| Kyrgyzstan |  |  | • |  |
| Latvia (2008) |  | • |  |  |
| Lithuania |  |  |  | • |
| Madagascar | • |  |  |  |
| Mexico | • |  |  |  |
| Monaco (2008) |  | • |  |  |
| Mongolia |  | • |  |  |
| Montenegro |  | • |  |  |
| Morocco (2008) |  |  |  | • |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |  |  |
| New Zealand | • |  |  |  |
| Norway |  |  |  | • |
| Philippines |  | • |  |  |
| Poland |  |  |  | • |
| Portugal (2008) |  | • |  |  |
| Republic of Korea | • |  |  |  |
| Republic of Moldova | • |  |  |  |
| Romania |  | • |  |  |
| Russian Federation |  | • |  |  |
| Serbia (2008) | • |  |  |  |
| Singapore (2008) |  |  |  | • |
| Slovakia |  | • |  |  |
| Slovenia |  | • |  |  |
| Spain |  | • |  |  |
| Sudan |  | • |  |  |
| Sweden | • |  |  |  |
| Switzerland |  | • |  |  |
| The former Yugoslav Republic of Macedonia (2008) |  | • |  |  |
| Tajikistan | • |  |  |  |
| Tunisia |  |  |  | • |
| Turkey | • |  |  |  |
| Turkmenistan | • |  |  |  |
| Ukraine | • |  |  |  |
| United Kingdom |  | • |  |  |
| United States of America | • |  |  |  |
| Uzbekistan |  |  |  | • |
| Viet Nam | • |  |  |  |
| Zambia |  | • |  |  |

| **Contracting Party** | **QUESTION III.3.**  **III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE**  **3. At what time does, or would, your Office consider that replacement takes place?** | | | |
| --- | --- | --- | --- | --- |
| **On the date of international registration or subsequent designation** | **On the date of expiry of the refusal period** | **In the event that your Office issues statements of grant of protection, on the date of issuing of statement of grant of protection** | **Other** |
| Albania | • |  |  |  |
| Algeria |  |  | • |  |
| Antigua and Barbuda | • |  |  |  |
| Armenia |  |  | • |  |
| Australia |  |  |  | When the trademark becomes protected. |
| Austria (2008) | • |  |  |  |
| Azerbaijan (2008) |  |  |  |  |
| Bahrain (2008) | • |  |  |  |
| Belarus | • |  |  |  |
| Benelux |  |  |  | The BOIP does not have an opinion on this issue. |
| Bosnia and Herzegovina (2008) | • |  |  |  |
| Bulgaria |  |  | • |  |
| China |  | • |  |  |
| Colombia |  |  | • |  |
| Croatia |  |  | • |  |
| Cuba (2008) |  | • |  |  |
| Cyprus |  | • |  |  |
| Czech Republic | • |  |  |  |
| Denmark | • |  |  |  |
| Estonia |  |  |  | On the date of expiry of an opposition period if there has not been any opposition. |
| European Union | • |  |  |  |
| Finland | • |  |  |  |
| France (2008) |  | • |  |  |
| Georgia | • |  |  |  |
| Germany | • |  |  |  |
| Greece |  |  |  | When filing the request for replacement. |
| Hungary |  |  |  | On the date of issuing of a decision on the recordal of the replacement  in the national register. |
| Iceland | • |  |  |  |
| Ireland |  |  | • |  |
| Israel |  |  | • |  |
| Italy |  | • |  |  |
| Japan | • |  |  |  |
| Kenya (2008) | • |  |  |  |
| Kyrgyzstan |  |  | • |  |
| Latvia (2008) |  | • |  |  |
| Lithuania |  |  |  | Within one month from the request for replacement of a national registration by an international registration. |
| Madagascar |  |  | • |  |
| Mexico |  |  | • |  |
| Monaco (2008) | • |  |  |  |
| Mongolia | • |  |  |  |
| Montenegro |  | • |  |  |
| Morocco (2008) |  | • |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |  |  |
| New Zealand | • |  |  |  |
| Norway | • |  |  |  |
| Philippines | • |  |  |  |
| Poland |  |  | • |  |
| Portugal (2008) |  |  | • |  |
| Republic of Korea |  |  | • |  |
| Republic of Moldova |  |  |  | From the date of record in the national Register. |
| Romania | • |  |  |  |
| Russian Federation |  |  |  | From date of entry in the State Register of Trademarks. |
| Serbia (2008) | • |  |  |  |
| Singapore (2008) |  |  |  | On the date the international registration is updated as registered in our national register. |
| Slovakia |  |  | • |  |
| Slovenia | • |  |  |  |
| Spain |  |  |  |  |
| Sudan | • |  |  |  |
| Sweden | • |  |  |  |
| Switzerland | • |  |  |  |
| The former Yugoslav Republic of Macedonia (2008) | • |  |  |  |
| Tajikistan |  |  |  | We have no practice of replacement of a national registration by an international registration and both registrations can coexist without replacement. |
| Tunisia |  | • |  |  |
| Turkey |  |  | • |  |
| Turkmenistan |  |  | • |  |
| Ukraine | • |  |  |  |
| United Kingdom | • |  |  |  |
| United States of America |  |  | • |  |
| Uzbekistan |  |  | • |  |
| Viet Nam |  |  | • |  |
| Zambia | • |  |  |  |

| **Contracting Party** | **QUESTION III.4.**  **III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE**  **4. If your Office considers, or would, consider that replacement takes place either on the date of expiry of the refusal period, or of issuing of a statement of grant of protection, is the effect of replacement considered to be retroactive to the date of the international registration or subsequent designation in question?** | |
| --- | --- | --- |
| **YES** | **NO** |
| Albania | • |  |
| Algeria | • |  |
| Antigua and Barbuda |  | • |
| Armenia | • |  |
| Australia |  |  |
| Austria (2008) |  |  |
| Azerbaijan (2008) | • |  |
| Bahrain (2008) |  |  |
| Belarus | • |  |
| Benelux |  | • |
| Bosnia and Herzegovina (2008) | • |  |
| Bulgaria | • |  |
| China | • |  |
| Colombia | • |  |
| Croatia | • |  |
| Cuba (2008) | • |  |
| Cyprus | • |  |
| Czech Republic | • |  |
| Denmark |  |  |
| Estonia | • |  |
| European Union |  |  |
| Finland |  |  |
| France (2008) |  |  |
| Georgia |  | • |
| Germany |  |  |
| Greece |  | • |
| Hungary | • |  |
| Iceland |  |  |
| Ireland | No policy decision taken by the Office in this regard. | |
| Israel |  | • |
| Italy |  | • |
| Japan |  |  |
| Kenya (2008) |  |  |
| Kyrgyzstan | • |  |
| Latvia (2008) |  | • |
| Lithuania |  |  |
| Madagascar | • |  |
| Mexico | • |  |
| Monaco (2008) |  |  |
| Mongolia | • |  |
| Montenegro | • |  |
| Morocco (2008) | • |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |
| New Zealand |  |  |
| Norway |  |  |
| Philippines | • |  |
| Poland |  | • |
| Portugal (2008) | • |  |
| Republic of Korea | • |  |
| Republic of Moldova |  |  |
| Romania |  |  |
| Russian Federation |  | • |
| Serbia (2008) |  |  |
| Singapore (2008) |  |  |
| Slovakia | • |  |
| Slovenia | • |  |
| Spain |  |  |
| Sudan |  | • |
| Sweden |  |  |
| Switzerland |  |  |
| The former Yugoslav Republic of Macedonia (2008) |  |  |
| Tajikistan |  | • |
| Tunisia | • |  |
| Turkey | • |  |
| Turkmenistan |  | • |
| Ukraine |  |  |
| United Kingdom |  |  |
| United States of America |  | • |
| Uzbekistan |  | • |
| Viet Nam | • |  |
| Zambia |  |  |

| **Contracting Party** | **QUESTION III.5.**  **III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE**  **5. When does, or would, your Office accept the filing of a request to take note under Article 4*bis*(2)?** | | | |
| --- | --- | --- | --- | --- |
| **After the date of notification by the International Bureau of the international registration or subsequent designation in question** | **Only from the date of expiry of the refusal period** | **In the event that your Office issues statements of grant of protection, only after the date of issuing of statement of grant of protection** | **Other** |
| Albania | • |  |  |  |
| Algeria |  |  | • |  |
| Antigua and Barbuda | • |  |  |  |
| Armenia | • |  |  |  |
| Australia | • |  |  |  |
| Austria (2008) | • |  |  |  |
| Azerbaijan (2008) |  |  |  | We do not have such kind of experience. |
| Bahrain (2008) | • |  |  |  |
| Belarus | • |  |  |  |
| Benelux |  |  |  | The BOIP does not have an opinion on this issue. |
| Bosnia and Herzegovina (2008) | • |  |  |  |
| Bulgaria | • |  |  |  |
| China |  | • |  |  |
| Colombia | • |  |  |  |
| Croatia |  |  | • |  |
| Cuba (2008) | • |  |  |  |
| Cyprus | • |  |  |  |
| Czech Republic | • |  |  |  |
| Denmark | • |  |  | The Danish Patent and Trademark Office will accept the filling but cannot take note of the international registration in accordance with Article 4*bis* before statement of grant of protection has been issued or the refusal period has expired (tacit acceptance). |
| Estonia | • |  |  |  |
| European Union | • |  |  |  |
| Finland | • |  |  |  |
| France (2008) |  | • |  |  |
| Georgia | • |  |  |  |
| Germany | • |  |  |  |
| Greece | • |  |  |  |
| Hungary | • |  |  |  |
| Iceland | • |  |  |  |
| Ireland | • |  |  |  |
| Israel |  |  | • |  |
| Italy | • |  |  |  |
| Japan | • |  |  |  |
| Kenya (2008) |  |  |  | On submission of a prescribed form and payment of prescribed fees.  NOTE: form and fees not prescribed as yet. |
| Kyrgyzstan |  |  | • |  |
| Latvia (2008) |  | • |  |  |
| Lithuania | • |  |  |  |
| Madagascar | • |  |  |  |
| Mexico | • |  |  |  |
| Monaco (2008) | • |  |  |  |
| Mongolia | • |  |  |  |
| Montenegro | • |  |  |  |
| Morocco (2008) |  | • |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |  |  |
| New Zealand | • |  |  |  |
| Norway | • |  |  |  |
| Philippines | • |  |  |  |
| Poland |  |  | • |  |
| Portugal (2008) |  |  | • |  |
| Republic of Korea | • |  |  |  |
| Republic of Moldova |  | • |  | Only from the date of expiry of the refusal period, if the trademark has been accepted. |
| Romania | • |  |  |  |
| Russian Federation | • |  |  |  |
| Serbia (2008) | • |  |  |  |
| Singapore (2008) | • |  |  |  |
| Slovakia |  |  | • |  |
| Slovenia | • |  |  |  |
| Spain |  |  | • |  |
| Sudan | • |  |  |  |
| Sweden | • |  |  |  |
| Switzerland | • |  |  |  |
| The former Yugoslav Republic of Macedonia (2008) | • |  |  |  |
| Tajikistan |  |  |  | We have no practice of the filing of a request to take note under Article 4*bis*(2). |
| Tunisia |  | • |  |  |
| Turkey |  |  | • |  |
| Turkmenistan | • |  |  |  |
| Ukraine | • |  |  |  |
| United Kingdom |  |  |  | On the filing of a form TM28 “Request for recordal on concurrent registration”, for which there is no fee. |
| United States of America |  |  | • |  |
| Uzbekistan |  |  | • |  |
| Viet Nam |  |  | • |  |
| Zambia | • |  |  |  |

| **Contracting Party** | **QUESTION III.6. (2008) – QUESTION III.6.(A) (2014)** III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE **6. (redrafted on June 23, 2008)**  **(a) In case it has been requested to take note, under Article 4*bis*(2), of the international registration, does your Office permit the coexistence of the national registration and the international registration that has replaced it?** | | | |
| --- | --- | --- | --- | --- |
| **YES** | **YES, but only for the remainder of the current term of protection (i.e., the national registration may not be renewed)** | **NO, the Office *ex officio* cancels the national registration** | **NO, the holder needs to renounce the national registration** |
| Albania | • |  |  |  |
| Algeria |  |  |  | • |
| Antigua and Barbuda |  | • |  |  |
| Armenia | • |  |  |  |
| Australia | • |  |  |  |
| Austria (2008) | • |  |  |  |
| Azerbaijan (2008) |  |  |  | • |
| Bahrain (2008) | • |  |  |  |
| Belarus | • |  |  |  |
| Benelux | • |  |  |  |
| Bosnia and Herzegovina (2008) | • |  |  |  |
| Bulgaria | • |  |  |  |
| China |  | • |  |  |
| Colombia | • |  |  |  |
| Croatia | • |  |  |  |
| Cuba (2008) | • |  |  |  |
| Cyprus | • |  |  |  |
| Czech Republic | • |  |  |  |
| Denmark | • |  |  |  |
| Estonia | • |  |  |  |
| European Union | • |  |  |  |
| Finland | • |  |  |  |
| France (2008) |  |  |  |  |
| Georgia |  |  | • |  |
| Germany |  |  | • |  |
| Greece | • |  |  |  |
| Hungary | • |  |  |  |
| Iceland | • |  |  |  |
| Ireland | • |  |  |  |
| Israel |  | • |  |  |
| Italy | • |  |  |  |
| Japan | • |  |  |  |
| Kenya (2008) |  | • |  |  |
| Kyrgyzstan |  | • |  |  |
| Latvia (2008) | • |  |  |  |
| Lithuania | • |  |  |  |
| Madagascar | • |  |  |  |
| Mexico | • |  |  |  |
| Monaco (2008) | • |  |  |  |
| Mongolia |  | • |  |  |
| Montenegro | • |  |  |  |
| Morocco (2008) | • |  |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |  |  |
| New Zealand | • |  |  |  |
| Norway | • |  |  |  |
| Philippines |  | • |  |  |
| Poland |  | • |  |  |
| Portugal (2008) |  |  | • |  |
| Republic of Korea | • |  |  |  |
| Republic of Moldova | • |  |  |  |
| Romania | • | • |  |  |
| Russian Federation | • |  |  |  |
| Serbia (2008) |  |  | • |  |
| Singapore (2008) | • |  |  |  |
| Slovakia |  | • |  |  |
| Slovenia |  | • |  |  |
| Spain |  |  | • |  |
| Sudan |  |  | • |  |
| Sweden | • |  |  |  |
| Switzerland | • |  |  |  |
| The former Yugoslav Republic of Macedonia (2008) | • |  |  |  |
| Tajikistan | • |  |  |  |
| Tunisia | • |  |  |  |
| Turkey | • |  |  |  |
| Turkmenistan | • |  |  |  |
| Ukraine | • |  |  |  |
| United Kingdom | • |  |  |  |
| United States of America | • |  |  |  |
| Uzbekistan |  |  |  | • |
| Viet Nam |  |  |  | • |
| Zambia | • |  |  |  |

| **Contracting Party** | **QUESTION III.6.(B) (2014)**  **III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE**  **6. (b) In case your Office has not been requested to take note, under Article 4*bis*(2), of the international registration, but is nevertheless aware that the conditions under Article 4*bis*(1) are met, does it permit the coexistence of the national registration and the international registration that has replaced it?** | | | |
| --- | --- | --- | --- | --- |
| **YES** | **YES, but only for the remainder of the current term of protection (i.e., the national registration may not be renewed)** | **NO, the Office *ex officio* cancels the national registration** | **NO, the holder needs to renounce the national registration** |
| Albania | • |  |  |  |
| Algeria |  |  |  | • |
| Antigua and Barbuda |  | • |  |  |
| Armenia | • |  |  |  |
| Australia | • |  |  |  |
| Austria (2008) |  |  |  |  |
| Azerbaijan (2008) |  |  |  |  |
| Bahrain (2008) |  |  |  |  |
| Belarus | • |  |  |  |
| Benelux | • |  |  |  |
| Bosnia and Herzegovina (2008) |  |  |  |  |
| Bulgaria | • |  |  |  |
| China |  | • |  |  |
| Colombia |  |  |  | • |
| Croatia | • |  |  |  |
| Cuba (2008) |  |  |  |  |
| Cyprus | • |  |  |  |
| Czech Republic | • |  |  |  |
| Denmark | • |  |  |  |
| Estonia | • |  |  |  |
| European Union | • |  |  |  |
| Finland | • |  |  |  |
| France (2008) |  |  |  |  |
| Georgia |  |  | • |  |
| Germany | • |  |  |  |
| Greece | • |  |  |  |
| Hungary | • |  |  |  |
| Iceland | • |  |  |  |
| Ireland | • |  |  |  |
| Israel | • |  |  |  |
| Italy | • |  |  |  |
| Japan | • |  |  |  |
| Kenya (2008) |  |  |  |  |
| Kyrgyzstan |  | • |  |  |
| Latvia (2008) |  |  |  |  |
| Lithuania | • |  |  |  |
| Madagascar | • |  |  |  |
| Mexico | • |  |  |  |
| Monaco (2008) |  |  |  |  |
| Mongolia |  | • |  |  |
| Montenegro | • |  |  |  |
| Morocco (2008) |  |  |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |  |  |
| New Zealand | • |  |  |  |
| Norway | • |  |  |  |
| Philippines | • |  |  |  |
| Poland | • |  |  |  |
| Portugal (2008) |  |  |  |  |
| Republic of Korea | • |  |  |  |
| Republic of Moldova | • |  |  |  |
| Romania | • | • |  |  |
| Russian Federation | • |  |  |  |
| Serbia (2008) |  |  |  |  |
| Singapore (2008) |  |  |  |  |
| Slovakia | • |  |  |  |
| Slovenia |  | • |  |  |
| Spain | • |  |  |  |
| Sudan |  | • |  |  |
| Sweden | • |  |  |  |
| Switzerland | • |  |  |  |
| The former Yugoslav Republic of Macedonia (2008) |  |  |  |  |
| Tajikistan | • |  |  |  |
| Tunisia | • |  |  |  |
| Turkey | • |  |  |  |
| Turkmenistan | • |  |  |  |
| Ukraine | • |  |  |  |
| United Kingdom | • |  |  |  |
| United States of America | • |  |  |  |
| Uzbekistan |  |  |  | • |
| Viet Nam |  |  |  | • |
| Zambia | • |  |  |  |

| **Contracting Party** | **QUESTION III.7.**  **III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE**  **7. If your Office does not, or would not, permit coexistence of a national registration and the international registration that has replaced it, does, or would, your Office nevertheless permit reinstatement of the national registration should the international registration cease to have effect within the five-year dependency period (Article 6 of the Agreement and/or the Protocol)?** | |
| --- | --- | --- |
| **YES** | **NO** |
| Albania |  |  |
| Algeria |  | • |
| Antigua and Barbuda |  | • |
| Armenia | • |  |
| Australia |  |  |
| Austria (2008) |  |  |
| Azerbaijan (2008) | • |  |
| Bahrain (2008) |  |  |
| Belarus | • |  |
| Benelux |  |  |
| Bosnia and Herzegovina (2008) |  |  |
| Bulgaria |  |  |
| China |  |  |
| Colombia |  | • |
| Croatia |  |  |
| Cuba (2008) |  |  |
| Cyprus |  |  |
| Czech Republic |  |  |
| Denmark |  |  |
| Estonia |  |  |
| European Union |  |  |
| Finland |  |  |
| France (2008) |  | • |
| Georgia |  | • |
| Germany |  | • |
| Greece |  |  |
| Hungary | • |  |
| Iceland |  |  |
| Ireland |  |  |
| Israel |  |  |
| Italy |  |  |
| Japan |  |  |
| Kenya (2008) |  |  |
| Kyrgyzstan |  | • |
| Latvia (2008) |  |  |
| Lithuania |  |  |
| Madagascar |  |  |
| Mexico |  |  |
| Monaco (2008) |  |  |
| Mongolia |  | • |
| Montenegro |  |  |
| Morocco (2008) |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |
| New Zealand |  |  |
| Norway |  |  |
| Philippines |  | • |
| Poland |  | • |
| Portugal (2008) | • |  |
| Republic of Korea |  |  |
| Republic of Moldova |  |  |
| Romania |  |  |
| Russian Federation |  | • |
| Serbia (2008) | Never had such transformation in practice and we have no provisions in our national legislation. | |
| Singapore (2008) |  |  |
| Slovakia |  |  |
| Slovenia | • |  |
| Spain |  |  |
| Sudan | • |  |
| Sweden |  |  |
| Switzerland |  |  |
| The former Yugoslav Republic of Macedonia (2008) |  |  |
| Tajikistan |  |  |
| Tunisia |  |  |
| Turkey |  |  |
| Turkmenistan |  |  |
| Ukraine |  |  |
| United Kingdom |  |  |
| United States of America |  |  |
| Uzbekistan |  | • |
| Viet Nam |  | • |
| Zambia |  |  |

| **Contracting Party** | **QUESTION III.8.**  **III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE**  **8. (For Offices of Members of the Protocol) Article 4*bis* of the Agreement and of the Protocol provides that an international registration is deemed to replace a national registration without prejudice to any rights acquired by virtue of the latter. Thus, for example, replacement may include the benefit of a priority claim attached to the national registration.**  **Assume that replacement, under Article 4*bis*(1) of the Protocol, has taken place and has included certain such rights acquired by virtue of the national registration, but subsequently there has been recorded a ceasing of effect due to failure of the basic mark within the five-year dependency period in accordance with Article 6 of the Protocol. Assume also that in such case, the holder wishes to exercise his rights, under Article 9*quinquies* of the Protocol, to transform the international registration into national application.**  **In your Office, does, or would, such transformation carry the benefit of those earlier national rights, such as, for example, a priority date?** | |
| --- | --- | --- |
| **YES** | **NO** |
| Albania |  |  |
| Algeria |  |  |
| Antigua and Barbuda | • |  |
| Armenia | • |  |
| Australia |  | • |
| Austria (2008) |  |  |
| Azerbaijan (2008) | • |  |
| Bahrain (2008) | • |  |
| Belarus | • |  |
| Benelux | • |  |
| Bosnia and Herzegovina (2008) |  |  |
| Bulgaria | • |  |
| China |  |  |
| Colombia |  | • |
| Croatia | • |  |
| Cuba (2008) | • |  |
| Cyprus |  | • |
| Czech Republic | • |  |
| Denmark | • |  |
| Estonia | • |  |
| European Union | • |  |
| Finland | • |  |
| France (2008) | • |  |
| Georgia |  | • |
| Germany | • |  |
| Greece | • |  |
| Hungary | • |  |
| Iceland |  | • |
| Ireland |  | • |
| Israel | • |  |
| Italy |  |  |
| Japan | • |  |
| Kenya (2008) | • |  |
| Kyrgyzstan | • |  |
| Latvia (2008) | • |  |
| Lithuania | • |  |
| Madagascar | • |  |
| Mexico |  | • |
| Monaco (2008) | • |  |
| Mongolia | • |  |
| Montenegro | • |  |
| Morocco (2008) | • |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |
| New Zealand | • |  |
| Norway | • |  |
| Philippines | • |  |
| Poland |  | • |
| Portugal (2008) |  | • |
| Republic of Korea | • |  |
| Republic of Moldova | • |  |
| Romania | • |  |
| Russian Federation | • |  |
| Serbia (2008) | Never had such transformation in practice and we have no provisions in our national legislation. | |
| Singapore (2008) | • |  |
| Slovakia | • |  |
| Slovenia | • |  |
| Spain |  | • |
| Sudan | • |  |
| Sweden | • |  |
| Switzerland |  |  |
| The former Yugoslav Republic of Macedonia (2008) |  |  |
| Tajikistan | • |  |
| Tunisia | • |  |
| Turkey | • |  |
| Turkmenistan | • |  |
| Ukraine | • |  |
| United Kingdom | • |  |
| United States of America | • |  |
| Uzbekistan | • |  |
| Viet Nam | • |  |
| Zambia |  | • |

| **Contracting Party** | **QUESTION IV.1.**  **IV. MISCELLANEOUS**  **1. (redrafted on June 23, 2008)**  **Where the conditions under Article 4*bis*(1) are met and, in addition, the national mark has lapsed, is reliance on any rights acquired by virtue of the national registration permitted in legal and administrative proceedings?** | | | |
| --- | --- | --- | --- | --- |
| **YES, even if the international registration has not been noted in the national register** | **YES, but only if the international registration has been noted in the national register** | **NO** | **Do not know** |
| Albania |  | • |  |  |
| Algeria | • |  |  |  |
| Antigua and Barbuda |  | • |  |  |
| Armenia |  | • |  |  |
| Australia |  |  |  | • |
| Austria (2008) |  | • |  |  |
| Azerbaijan (2008) |  |  | • |  |
| Bahrain (2008) |  |  |  | • |
| Belarus |  |  | • |  |
| Benelux |  |  |  | • |
| Bosnia and Herzegovina (2008) |  |  |  | • |
| Bulgaria |  |  | • |  |
| China |  |  | • |  |
| Colombia |  |  | • |  |
| Croatia |  | • |  |  |
| Cuba (2008) |  |  | • |  |
| Cyprus | • |  |  |  |
| Czech Republic |  | • |  |  |
| Denmark | • |  |  |  |
| Estonia |  |  |  | • |
| European Union | • |  |  |  |
| Finland |  |  |  | • |
| France (2008) |  |  |  | • |
| Georgia | • |  |  |  |
| Germany |  | • |  |  |
| Greece |  |  |  | • |
| Hungary |  | • |  |  |
| Iceland |  | • |  |  |
| Ireland |  |  |  | • |
| Israel |  | • |  |  |
| Italy | • |  |  |  |
| Japan |  |  | • |  |
| Kenya (2008) |  | • |  |  |
| Kyrgyzstan |  |  |  | • |
| Latvia (2008) |  | • |  |  |
| Lithuania |  | • |  |  |
| Madagascar |  | • |  |  |
| Mexico |  | • |  |  |
| Monaco (2008) |  |  |  | • |
| Mongolia | • |  |  |  |
| Montenegro |  | • |  |  |
| Morocco (2008) |  |  |  | • |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) |  | • |  |  |
| New Zealand |  |  | • |  |
| Norway | • |  |  |  |
| Philippines | • |  |  |  |
| Poland |  |  |  | • |
| Portugal (2008) |  | • |  |  |
| Republic of Korea |  |  | • |  |
| Republic of Moldova |  |  | • |  |
| Romania | • |  |  |  |
| Russian Federation |  |  | • |  |
| Serbia (2008) |  |  |  | • |
| Singapore (2008) |  |  | • |  |
| Slovakia |  | • |  |  |
| Slovenia |  |  | • |  |
| Spain |  |  | • |  |
| Sudan |  | • |  |  |
| Sweden |  |  |  | • |
| Switzerland |  |  |  | • |
| The former Yugoslav Republic of Macedonia (2008) |  |  |  | • |
| Tajikistan |  |  |  |  |
| Tunisia |  |  |  |  |
| Turkey |  |  |  | • |
| Turkmenistan |  |  |  | • |
| Ukraine |  |  | • |  |
| United Kingdom |  | • |  |  |
| United States of America | • |  |  |  |
| Uzbekistan |  |  | • |  |
| Viet Nam |  |  |  | • |
| Zambia |  |  | • |  |

| **Contracting Party** | **QUESTION IV.2.**  **IV. MISCELLANEOUS**  **2. The International Bureau has made available model provisions with regard to the replacement procedure (see www.wipo.int/madrid/en/contracting\_parties). Have you found the model provisions to be of assistance?** | | |
| --- | --- | --- | --- |
| **YES** | **NO** | **Do not know** |
| Albania |  |  |  |
| Algeria | • |  |  |
| Antigua and Barbuda | • |  |  |
| Armenia | • |  |  |
| Australia | • |  |  |
| Austria (2008) |  |  |  |
| Azerbaijan (2008) | • |  |  |
| Bahrain (2008) | • |  |  |
| Belarus |  |  | • |
| Benelux | • |  |  |
| Bosnia and Herzegovina (2008) |  |  | • |
| Bulgaria | • |  |  |
| China | • |  |  |
| Colombia | • |  |  |
| Croatia | • |  |  |
| Cuba (2008) |  | • |  |
| Cyprus | • |  |  |
| Czech Republic | • |  |  |
| Denmark | • |  |  |
| Estonia | • |  |  |
| European Union | • |  |  |
| Finland |  |  | • |
| France (2008) | • |  |  |
| Georgia | • |  |  |
| Germany |  | • |  |
| Greece | • |  |  |
| Hungary | • |  |  |
| Iceland |  |  | • |
| Ireland |  |  | • |
| Israel | • |  |  |
| Italy | • |  |  |
| Japan |  |  | • |
| Kenya (2008) | • |  |  |
| Kyrgyzstan | • |  |  |
| Latvia (2008) | • |  |  |
| Lithuania | • |  |  |
| Madagascar | • |  |  |
| Mexico | • |  |  |
| Monaco (2008) | • |  |  |
| Mongolia | • |  |  |
| Montenegro | • |  |  |
| Morocco (2008) | • |  |  |
| Netherlands Antilles (2008) / Curacao\* and Sint Maarten (Dutch part)\* (2014) | • |  |  |
| New Zealand | • |  |  |
| Norway |  |  | • |
| Philippines | • |  |  |
| Poland |  |  | • |
| Portugal (2008) | • |  |  |
| Republic of Korea | • |  |  |
| Republic of Moldova | • |  |  |
| Romania | • |  |  |
| Russian Federation | • |  |  |
| Serbia (2008) |  |  | • |
| Singapore (2008) | • |  |  |
| Slovakia | • |  |  |
| Slovenia |  |  | • |
| Spain |  |  | • |
| Sudan | • |  |  |
| Sweden |  |  | • |
| Switzerland | • |  |  |
| The former Yugoslav Republic of Macedonia (2008) |  |  | • |
| Tajikistan | • |  |  |
| Tunisia | • |  |  |
| Turkey | • |  |  |
| Turkmenistan | • |  |  |
| Ukraine | • |  |  |
| United Kingdom | • |  |  |
| United States of America |  |  |  |
| Uzbekistan | • |  |  |
| Viet Nam | • |  |  |
| Zambia |  |  | • |

[End of Annex II and of document]

1. In May 2008, the Madrid Union had 82 members, of which 75 were party to the Protocol. [↑](#footnote-ref-2)
2. Note C. M 1402, dated December 16, 2013. [↑](#footnote-ref-3)
3. In the Basic Proposal for the Madrid Protocol submitted at the Conference of Madrid of 1989, the notes concerning Article 4*bis*(1) stated that “this provision – as well as paragraph (2) – is in essence the same as it is in the Stockholm Act but has been redrafted for greater clarity.” See document MM/DC/3, paragraph 133. Aside from the addition of the words “without prejudice to any rights acquired by virtue of the latter” – similar to the wording found in the Agreement – and from merely editorial changes, Article 4*bis*(1) of the Protocol was adopted as proposed. Against this background, the position of the International Bureau is that the conditions under which replacement takes place are the same under the Agreement and the Protocol. See in particular WIPO publication No. 455 *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol*, paragraph B.II. 100.01. [↑](#footnote-ref-4)
4. Rule 21 was introduced with the adoption of the Common Regulations, which entered into force on April 1, 1996. There was no equivalent procedure in the Regulations under the Agreement. [↑](#footnote-ref-5)
5. In this respect, it is further recalled that, following the recommendation of the Working Group, the Assembly of the Madrid Union adopted, at its thirty-seventh (21st extraordinary) session, an amendment to Rule 21(1) to broaden its scope by allowing the communication by Offices to the International Bureau of information relating to “other rights” acquired by virtue of a replaced national or regional registration. This amendment entered into force on April 1, 2007, and reads as follows: “The notification may also include information relating to any other rights acquired by virtue of that national or regional registration, in a form agreed between the International Bureau and the Office concerned.” [↑](#footnote-ref-6)
6. Territorial entity previously part of the former Netherlands Antilles. [↑](#footnote-ref-7)
7. 2 Please note that the reference to “national” is intended to include also, where relevant, “regional”. [↑](#footnote-ref-8)
8. 3 This question was not present in the questionnaire sent in 2008. [↑](#footnote-ref-9)
9. Territorial entity previously part of the former Netherlands Antilles. [↑](#footnote-ref-10)