

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

**Sixteenth Session  
Geneva, July 2 to 6, 2018**

### REPORT

*adopted by the Working Group*

1. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) met in Geneva from July 2 to 6, 2018.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Algeria, Antigua and Barbuda, Armenia, Australia, Austria, Belarus, China, Colombia, Croatia, Cuba, Czech Republic, Denmark, Estonia, European Union (EU), Finland, France, Georgia, Germany, Ghana, Greece, Hungary, India, Indonesia, Iran (Islamic Republic of), Israel, Italy, Japan, Kenya, Lithuania, Mexico, Morocco, Mozambique, New Zealand, Norway, Oman, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, Slovenia, Spain, Sudan, Sweden, Switzerland, Syrian Arab Republic, Thailand, The former Yugoslav Republic of Macedonia, Turkey, United Kingdom, United States of America, Uzbekistan, Zimbabwe (56).
3. The following States were represented as observers: Argentina, Bangladesh, Canada, Jordan, Kuwait, Malawi, Malta, Nigeria, Pakistan, Saudi Arabia, Seychelles, Sri Lanka, Trinidad and Tobago, United Arab Emirates (14).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Benelux Organization for Intellectual Property (BOIP), World Trade Organization (WTO) (2).

5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: American Intellectual Property Law Association (AIPLA), Association of Trade Mark and Design Law Practitioners (APRAM), *Association romande de propriété intellectuelle* (AROPI), Centre for International Intellectual Property Studies (CEIPI), Chartered Institute of Trade Mark Attorneys (CITMA), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), MARQUES – Association of European Trade Mark Owners (11).
6. The list of participants is contained in Annex III to this document.

#### **AGENDA ITEM 1: OPENING OF THE SESSION**

7. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO) opened the session and welcomed the participants.
8. The Director General informed that, since the previous session of the Working Group, Thailand, Indonesia and Afghanistan had joined the Madrid System, bringing the number of Contracting Parties to 101 members covering 117 countries noting that there had been increasing interest from prospective members, and said that further expansion of the Madrid System and enlargement of its geographical coverage was expected over the next two to three years.
9. In terms of the use of the Madrid System by its existing members, the Director General said that 2017 had seen substantial growth, with the number of applications rising by five per cent, with 56,200 international applications filed in 2017, and added that a growth rate of around four per cent was expected for 2018. For the fourth consecutive year, the United States of America filed the highest number of applications, followed closely by Germany, China, France and the United Kingdom. In terms of the overall geographical distribution of applications, the Director General noted that European countries remained the most prominent filers, filing around 60 per cent of the applications, and that filings in Asia had increased to around 17.5 per cent, with the highest growth rate in terms of use of the system taking place in China, where applications had risen by 36 per cent, and in the Russian Federation, where applications had risen by 24 per cent. The Director General also indicated that the European Union was the most designated Contracting Party, followed by China and the United States of America.
10. In terms of developments in the Madrid System and in the International Bureau, the Director General acknowledged a significant improvement in the backlog level and pendency rates, which were then down to an acceptable level. In terms of the information technology (IT) platform, the Director General noted that WIPO's original monitoring tools ROMARIN, Madrid e-Alert and Madrid Real-time Status had been replaced by the successful newly designed and more streamlined Madrid Monitor, an integrated monitoring tool that provided access to the *WIPO Gazette of International Marks* (the "WIPO Gazette") and allowed international registrations to be tracked. The Director General further noted that a new major undertaking for the organization for the coming three years would be a new IT platform for the Madrid System.
11. The Director General stated that the Madrid Working Group Roundtable would provide the International Bureau with an opportunity to seek the advice of its participants on a number of relevant issues concerning the evolution of the Madrid System, in the interest of both Offices and users. On the upcoming discussion on the expansion of the working languages of the Madrid System, the Director General made reference to the language regime of the Patent Cooperation Treaty (PCT) System and encouraged discussions around balancing the needs of users and the aim of making the Madrid System a truly global system, with the financial and practical impact that an expansion of the working languages could have on its members.

**AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE-CHAIRS**

12. Mr. Steffen Gazley (New Zealand) was unanimously elected as Chair of the Working Group, Mr. Geoffrey Muchai Ramba (Kenya) and Mr. Pedro Damián Alarcón Romero (Mexico) were unanimously elected as Vice-Chairs.

13. Ms. Debbie Roenning acted as Secretary to the Working Group.

**AGENDA ITEM 3: ADOPTION OF THE AGENDA**

14. The Chair thanked the participants for his election and the Director General for his opening remarks.

15. The Working Group adopted the draft agenda excluding item 10 (document MM/LD/WG/16/1).

16. The Working Group took note of the electronic adoption of the report of the fifteenth session of the Working Group.

**AGENDA ITEM 4: REPLACEMENT**

17. Discussions were based on document MM/LD/WG/16/2.

18. The Secretariat introduced document MM/LD/WG/16/2, and noted that replacement had been discussed, either in the Working Group or in the Roundtable, since 2010 and acknowledged that, in the previous session, the Working Group had tentatively agreed on proposed amendments to 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”, “the Agreement” and “the Protocol”) and on a new item 7.8 of the Schedule of Fees. The Secretariat indicated that the tentatively agreed upon amendments specified the principles governing replacement and provided for an optional centralized filing procedure for requesting that Offices take note in accordance with Article 4*bis*(2) of the Protocol. The Secretariat recalled that the Working Group requested the International Bureau to prepare, for its sixteenth session, a document suggesting a date for the entry into force of amended Rule 21 of the Common Regulations and proposing an amount of the fee to be specified in new item 7.8 of the Schedule of Fees. The Secretariat further recalled that, during the previous session of the Working Group, some delegations informed that their corresponding domestic legislation would have to be amended to allow for such centralized procedure. The Secretariat also noted that there had been no agreement on the time needed for the possible implementation of the proposed amendments, but that there had been estimates ranging from two years to 10 years. The Secretariat referred to the decision taken by the Madrid Union Assembly to approve the allocation of funds for the development of a new customer centered IT platform and indicated that, given that work on the IT platform would soon be underway, it would be advisable to postpone the introduction of new automated processes until after the deployment of the said platform and until the Working Group had agreed on the time required for implementing the amendments. However, the Secretariat invited the Working Group to consider clarifying the key principles of replacement in Rule 21, so as to give guidance to trademark holders and Offices on replacement, without changing the current procedure.

19. The Chair stated that the three issues for discussion were (i) the time needed for Contracting Parties to implement the amendments to Rule 21, covered by paragraphs 1 to 5 of document MM/LD/WG/16/2; (ii) the suggested date of entry into force, covered by paragraphs 6 to 12 of the same document; and, (iii) a proposal to modify Rule 21 to include only the clarification of the principles of replacement, without changing the current procedure. The Chair opened the floor for comments on the first issue, the time needed for Contracting Parties to implement the amendments to Rule 21.

20. The Delegation of New Zealand estimated that, given the implementation of division in February 2019, the implementation of a centralized system should be within the following two years.

21. The Delegation of the European Union, speaking on behalf of its member states, supported continued discussions towards a harmonized practice, as far as the scope of replacement was concerned, but noted with regret that the Secretariat had not taken any position on the two outstanding issues following the fifteenth session of the Working Group. The Delegation acknowledged that the International Bureau would undertake an extensive assessment of all its Madrid System services with a view to developing a comprehensive customer-centered platform but indicated that it did not agree with the view that it would be premature to recommend a possible date of entry into force of the proposed amendments to Rule 21 or an amount for new item 7.8 of the Schedule of Fees. The Delegation said it hoped the International Bureau would be in a position to have some tentative suggestions on both issues at the following session of the Working Group, together with proposed changes to Rule 21 of the Common Regulations.

22. The Delegation of Italy said it was important that the International Bureau was ready with the new IT platform before any comments could be made on the time that would be required for the entry into force of the amendments to Rule 21.

23. The Chair, noting that there were no further comments on paragraphs 1 to 5 of the document, opened the floor for comments on the rest of the document.

24. The Delegation of Japan stated that, from the users' perspective, discussions on a number of principles governing replacement of national or regional registrations that could be followed by all members should not be postponed until an optional centralized filing mechanism was implemented.

25. The Delegation of the Republic of Moldova expressed its support for the possibility of requesting a fee for replacement and for introducing the principles governing the replacement procedure. The Delegation indicated its preference for a flexible interpretation of the goods and services, in terms of the scope of replacement, as referred to in paragraph 13(iii) of the document.

26. The Delegation of New Zealand stated that, given the low number of replacement requests received and in light of the IT upgrades to be undertaken by WIPO, the implementation of a centralized filing mechanism was not urgent. The Delegation added however, that discussions should not be indefinitely delayed and agreed that amendments to Rule 21 should be discussed at the following session of the Working Group.

27. The Delegation of Sweden, referring to paragraph 13(iii) of the document, asked the Secretariat to further comment on the scope of replacement, and, in particular, clarify the meaning of partial replacement. The Delegation said that, under a flexible interpretation of Article 4*bis*(2) of the Protocol, it was clear that it would be possible to replace a national registration for, for example, "wines", in class 33, with an international registration for "alcoholic beverages"; and, in such case, the scope of replacement would be "wines" because all the goods in the national registration would be covered by the international registration. The Delegation questioned whether a national registration covering, for example, goods in classes 18 and 25 could be replaced by an international registration covering goods and services in classes 18, 25, and 42. The Delegation asked whether, in such case, there would be partial replacement for classes 18 and 25 and whether that would mean that the goods in those classes would enjoy the same priority date as the national registration while services in class 42 would have, as priority date, the date of the international registration. The Delegation questioned whether a national registration containing goods and services in classes 18, 25, and 42, could be replaced by an international registration that contained goods in classes 18 and 25 only, and asked whether, in such case, it would be possible to delete class 42 from the national registration to make replacement possible.

28. The Delegation of Israel indicated that, since joining the Madrid System in 2010, Israel had received 20 requests to take note of replacement. The Delegation noted that, when taking note of replacement, the Office of Israel considered the three principles stated in paragraph 13 of the document, namely, the effective date of replacement, the timing of the request and the co-existence of the national and international registrations. Regarding the scope of replacement, as set out in Article 4*bis*(2) of the Protocol, the Delegation said the Office required all the goods and services listed in the national registration to be covered by the international registration; or, in other words, while the scope of the international registration could be broader than the scope of the national registration, the opposite was not possible. The Delegation expressed the view that partial replacement would benefit users and indicated that Israel would consider changes to its legislation should partial replacement be explicitly provided for in the Common Regulations.

29. The Delegation of Spain, referring to paragraph 13(iii) of the document and to the interpretation of the wording “the goods and services in the registration shall be the same or equivalent to those covered by the international registration”, questioned the meaning of the word “equivalent” and stated that it favored a strict interpretation of Article 4*bis*(2) of the Protocol and, therefore, it needed to know the exact scope of the term “equivalent”.

30. The Delegation of Germany referred to an example on partial replacement appearing in a document discussed at the previous session of the Working Group and recalled that, in that example, a national registration covering “clothing, footwear and headgear”, in class 25, could have been replaced by an international registration covering only “clothing” and, in that case, the national registration would be broader than the international registration but partial replacement would take place because “clothing” was covered by both registrations. However, the Delegation said that it understood, from paragraph 100.03 of the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* published by WIPO, that the international registration did not need to have an identical list of goods and services and, while such list could be broader in scope, it could not be narrower. In that regard, the Delegation expressed its support for the views shared by the Delegation of Sweden and requested further clarification of partial replacement. In terms of implementation, the Delegation indicated that, while Germany did not need to change its national law, it would wait until a centralized filing system was developed by the International Bureau to further comment on changes to the IT system of the German Office and on the timing for their implementation.

31. The Delegation of Colombia stated that amending Rule 21 to reflect the principles in paragraph 13(iii) of the document would allow progress harmonizing the replacement practices without the need to make significant changes the IT systems of the International Bureau and of the Contracting Parties. Nonetheless, the Delegation said it was important to clarify the points raised by the Delegations of Spain and Germany, so all could share the same interpretation.

32. The Delegation of China stated that the scope of the goods and services in the national registration should be equivalent or, at least, very similar to that of the international registration.

33. The Delegation of Cuba expressed its agreement with the principles in paragraph 13(ii) of the document and proposed that the International Bureau present a document proposing possible amendments to Rule 21 of the Common Regulations to reflect those principles, for discussion at the next session of the Working Group.

34. The Representative of INTA stated that, for the reasons given by the International Bureau in the document, it could take some time to establish a date for the implementation of a centralized filing mechanism and noted that the Director General of WIPO referred to an IT platform that would be developed in the following years. The Representative said that, nevertheless, such project should not delay the entry into force of the amendments to Rule 21 which incorporated the principles set out in paragraph 13 of the document; or, at least, those principle in items (i), (ii) and (iv) of the said paragraph, on which a broad consensus had been reached at the previous session of the Working Group and for which an appropriate wording had been agreed upon in principle. The Representative of INTA wondered whether that agreed wording could be recommended for the adoption of the Madrid Union Assembly, at its next session, rather than waiting another year for their adoption.

35. The Delegation of Italy noted that Italy had received only five requests to take note of replacement in the previous 20 years but added that it followed with interest the discussion on the proposed amendments to Rule 21 of the Common Regulations and on the possible change in the Schedule of Fees with a new item 7.8. The Delegation recalled that, in 2013, the Italian Office responded to a questionnaire on replacement which had been sent to the Contracting Parties and noted that, since then, the Working Group had been discussing the opportunity to provide users with an optional centralized filing mechanism and that such discussions had led to progress and to the identification of the four principles specified in paragraph 13 of the document. The Delegation expressed its agreement with the principles in items (i) and (ii) of the said paragraph but, with regard to the principle in item (iii), the Italian Office applied a literal interpretation of Article 4*bis*(2) of the Protocol meaning that the Office required that the goods and services concerned by replacement be equivalent to those covered by the international registration. The Delegation informed that Italy had never received a request for partial replacement. With regard to the fees, the Delegation said that the Italian Office did not require specific additional fees for replacement, but just a revenue stamp of 16 Euros for the request to take note.

36. The Delegation of the United States of America acknowledged the need and useful purpose of replacement and expressed its desire to find a solution. The Delegation added that it also recognized the problems faced by other members with regard to refusals being issued on the basis of double protection. However, the Delegation said that the United States Patent and Trademark Office (USPTO) regarded designations in international registrations as separate from national filings and did not face a double protection problem when taking note of replacement. The Delegation informed that the United States of America would be required to make significant changes if the proposed amendments were adopted. The Delegation explained that its system was based on the understanding that the international registration did not have effect in the United States of America until such registration had been granted legal protection and, accordingly, the USPTO waited until the international registration was registered in the United States of America before taking note of replacement. The Delegation further indicated that, if a replacement request was received before the international registration had been granted protection, such request would not be processed until the extension of protection was registered in the United States of America. The Delegation indicated that the United States of America received around 15 to 20 requests for replacement per year, and that implementing a centralized system would require several changes to the Office's IT system. The Delegation noted that the effective date of replacement was a real concern because it would need to amend its laws and, instead, proposed that the Working Group consider other proposals to address the double protection problem, such as, for example, a provision in the Common Regulations stating that international registrations were separate from national filings for purposes of replacement. Finally, with regard to the goods and services, the Delegation said that, while the United States of America had a literal interpretation of Article 4*bis*(2) of the Protocol, it would not be opposed to partial replacement.

37. The Delegation of the Republic of Korea expressed its support for the proposed amendments as it would benefit users, and hoped that such amendments would take effect in a timely manner. However, given the time required to develop WIPO's new IT platform, the Delegation said it would be appropriate to wait until members, including the Republic of Korea, were ready for the change. The Delegation stressed that, if fees were inevitable, the amounts should be kept as low as possible.
38. The Delegation of Switzerland stated that the proposals, as set out in paragraphs 4 to 6 of the document, posed no problem for Switzerland, adding that while partial replacement was accepted in Switzerland, the Swiss Office received few request for replacement, as few as four or five a year. The Delegation expressed its preference for the prompt adoption of the amendments, as the matter had been discussed for some time.
39. The Chair noted that there was some agreement on deferring the implementation of a centralized filing mechanism and suggested that the outstanding questions on the key principles and on the scope of replacement be discussed at the following session.
40. The Delegation of Sweden expressed its agreement with the Chair's proposal.
41. The Delegation of Germany wondered whether the proposed wording of Rule 21 had already been agreed upon at the previous session and, in such case, whether the only two issues open for discussion were the amount of the fee and the date of entry into force. The Delegation also wondered whether the discussion was limited to the fee due to WIPO or included the fees for the Offices.
42. The Chair clarified that the wording of Rule 21 had only been tentatively agreed at the previous session and that some delegations still had questions regarding the scope of replacement. The Chair confirmed that discussions would be limited to the fee due to WIPO for filing a centralized request for the Offices to take note of replacement.
43. The Delegation of Switzerland expressed its support for the comments made by the Delegation of Germany and said it understood that the only question which remained partially open concerned whether replacement could be total or partial.
44. The Chair, reiterated that an agreement had been reached to postpone the implementation of a centralized filing mechanism, noted that questions had been raised on the scope and on the effective date of replacement and recalled that the need to revise the domestic legislation of certain Contracting Parties had also been mentioned. Accordingly, the Chair suggested, as the best way forward, to undertake further discussions at the next session of the Working Group based on a new document discussing the issues at hand.
45. The Representative of MARQUES welcomed the option of a centralized filing and a common understanding of the rule concerning replacement. However, the Representative requested that progress on that matter be made as soon as possible given that it had been discussed for a long time.
46. The Working Group requested the Secretariat to prepare a new document, to be discussed at its next session:
- (i) clarifying the principles governing replacement, such as scope and date of effect of replacement; and,
  - (ii) proposing amendments to Rule 21 of the Common Regulations based on those principles.

## AGENDA ITEM 5: TRANSFORMATION

47. Discussions were based on document MM/LD/WG/16/3.

48. The Secretariat stated that the purpose of transformation, a new topic for discussion, was to mitigate the consequences of the cancellation of an international registration requested by the Office of origin due to the ceasing of effect of the basic mark, allowing the holder to secure continued protection of the mark by filing domestic applications before the Offices of the previously designated Contracting Parties within a specific time limit. The Secretariat added that the filing date of the new transformation application would be the date of the international registration or the date of the subsequent designation where applicable. The Secretariat recalled that there were no provisions on transformation in the Common Regulations, adding that, apart from the minimum requirements for a transformation application set out in Article 9*quinquies* of the Protocol, transformation was to be dealt with by the concerned Contracting Party only. The Secretariat indicated that, while the transformation procedure should be valuable for users, information received from Offices revealed that the procedure was not often used because users considered it to be expensive, complex and cumbersome, with a few of them also indicating that some Offices had not yet implemented provisions which allowed for transformation and that they often found it easier to file a new application instead of attempting to take advantage of transformation. The Secretariat recalled that, against that background, users had requested the Working Group to discuss how the procedure could be made more user-friendly and stated that document MM/LD/WG/16/3 provided a brief overview of the legal framework around transformation and included comments made by users which might explain why transformation was underutilized. The Secretariat invited the Working Group to look into how the transformation procedure could be improved to better meet the needs and expectations of the users.

49. The Chair opened the floor for comments on paragraphs 1 to 8 of the document and encouraged delegations to inform on the transformation procedures in their corresponding Contracting Parties, suggesting that delegations also share concerns expressed by users.

50. The Delegation of Norway noted that the Norwegian Office received a low number of transformation applications and informed that the Trademark Law of Norway specified the main criteria for transformation, in accordance with the Madrid Protocol. The Delegation stated that Norway also had supplementing regulations which provided further details on transformation and that examiners processed requests for transformation according to guidelines and followed a checklist. The Delegation explained that, if a holder wanted to transform an international registration into a national application, the holder had to submit the request as a standard trademark application filed directly with the Office, and that request would be treated as a national application, adding that the Norwegian Office charged a standard application fee and that the national application form allowed the holder to indicate that the application was being filed under transformation and to provide the international registration number and date. The Delegation said that the Norwegian Office would also request the holder to provide verification that the international registration had been canceled at the request of the Office of origin and, if all the criteria was met, the transformation request would be approved resulting in the previous designation of Norway in an international registration then being a national application which would bear the same application date and priority details as the international registration. The Delegation further explained that if the canceled international registration had been granted protection in Norway before the transformation request, the Norwegian Office would register the mark in the national Register, without examination, and that the registration and priority dates would correspond to those of the international registration, the registration would be published with an indication explaining that the registration stemmed from transformation and the holder would receive a new registration certificate. The Delegation indicated that, if the international registration was pending protection in Norway at the time of the transformation request, the transformation request would still be approved but the national application would have the same pending status as the international registration had had before it was canceled, adding that, for example, if the international registration had been provisionally refused or had been the subject of an opposition or invalidity claim, the same would be the case



for the transformed national application or registration, which simply took the place of the canceled international registration. The Delegation said that it welcomed initiatives that may reduce the disadvantages deriving from the dependency principle and that it believed an accessible and efficient transformation procedure in the different members would be beneficial.

51. The Delegation of New Zealand explained that information on transformation was published on the website of the Office of New Zealand and that holders could request to transform their international registration by sending an email to the New Zealand Office, no fee would be charged for that type of request, from a procedural perspective, a national application which mirrored the international registration would be created, and that the priority and filing dates of the application and the status of the trademark would be the same. The Delegation said that, if the international registration was protected at the time of its cancellation, the new national mark would be registered but, if the international registration was still under examination or there were procedural steps filed, such as opposition, those steps would be transferred over to the national mark, adding, as an example, that if an opposition proceeding had begun on the international registration, it would continue on to the national trademark.

52. The Chair, noting that there were no further comments on paragraphs 1 to 8 of the document, opened the floor for discussions on the remainder of the document.

53. The Delegation of Austria, speaking on behalf of the European Union and its member states, said it was crucial that all Contracting Parties of the Madrid System provided for the possibility of transformation. The Delegation underscored the importance of building on feedback from users to identify some possible improvements that could be made and expressed both its support for the recommendations set out in paragraph 9 of the document and its concerns with the recommendation set out in item (iii) of the said paragraph relating to added costs. The Delegation stated that Contracting Parties should remain free to establish a fee for transformation applications, while expressing its agreement with the recommendation in item (iv) of the document, concerning the avoidance of unnecessary duplication of work, adding that in the European Union such could already be observed and offered, as an example, Article 24 of the European Trademark Regulation which contained provisions that were aligned with that principle.

54. The Delegation of Israel stated that over the previous three years there had been 30 cases of transformation. The Delegation noted that Israel had specific legislation for transformation under which the Office did not reopen for request for examination and the Israeli application received the same status as the international registration. The Delegation underscored the importance of making the transformation process accessible, detailed and clear to users, adding that, in response to the Working Group document, it had requested the International Bureau to update the page of the Office of Israel on the Madrid Member Profiles Database. As for payment of transformation fees in Israel, the Delegation indicated that applicants were required to pay new application fees but added that, to relieve the users and make transformation more usable, Israel was prepared to lower the fees which, however, would take time. The Delegation stated that notifications of ceasing of effect of the basic mark should be processed quickly, both by the Office of origin and the International Bureau, so holders could submit transformation requests as soon as possible before the designated Offices.

55. The Delegation of France noted that France's transformation procedure was based on the provisions of the Madrid Protocol, without any problems, adding that it was in favor of the proposals made in the document, in particular, those set out in items (iv) and (v) of paragraph 9 of the document. However, the Delegation pointed out that, as the Delegation of Austria, it had some reservations on item (iii) of the said paragraph and felt Offices ought to remain neutral with regard to fees.

56. The Delegation of Italy informed that Italy provided for transformation and that, while the trademark to be transformed had to cover the goods and services claimed in the international registration, they need not to be exactly the same but, rather, covered by the international registration. The Delegation underscored that, following from the document, there appeared to be few requests for transformation, with only 96 requests filed in 2010, and 127 in 2012. The Delegation added that Italy already followed the transformation procedure described in paragraph 7 of the document and in accordance with Article 9*quinquies* of the Protocol. With regard to paragraph 9 of the document, the Delegation said that it remained open to discuss possible improvements of the transformation procedure but pointed out that it was also acceptable as it was. The Delegation expressed its agreement with the position, expressed by the Delegation of the European Union, that each Contracting Party should remain free to establish its own transformation fee in accordance with its national legislation, provided costs be contained agreeing with the interest of the users.

57. The Delegation of the Republic of Moldova informed that Moldova had not had many cases of transformation, with an average of four or five cases per year. However, the Delegation stated transformation was really important and special provisions concerning transformation had been introduced into its national law. The Delegation explained that the transformation procedure described by the Delegation of Norway, more or less, described the procedure in the Republic of Moldova, international registrations were not re-examined; there was no examination fee for the transformation application; the only fee that the applicant had to pay was the fee for a domestic application; the applicant had to inform the Office that the application was by virtue of transformation; and, although the application was not re-examined, it was published again. The Delegation said that users were satisfied with the procedure because, in most cases, it was less costly than filing a new application and the transformed application benefited from the date of the international registration. The Delegation expressed its support for the views shared by the Delegations of the European Union and of Italy concerning the fact that each Contracting Party should examine its costs to ensure that the system was affordable, adding that it believed discussions on the transformation procedure should continue in order to have a consistent approach, but that each Contracting Party should follow its own transformation procedures according to its legislation.

58. The Delegation of Colombia stated that it had the necessary regulations in place for transformation, which followed the same principles described by other delegations. The Delegation explained that it did not re-examine transformation applications, on the basis that they had already been examined, and expressed its agreement with the views shared by the Delegation of Israel, in that the transformation procedure was to be established by each Office. The Delegation said it would review the information provided in the document and, if it made any modifications to its practice, it would update the information of the Office of Colombia in the Madrid Member Profiles Database.

59. The Delegation of the Republic of Korea stated that transformation protected the holder of a cancelled registration and mitigated the downside of central attack and said it would be better to discuss the fundamental cause for transformation. In the meantime, the Delegation suggested a reduction in the fees for transformation to lessen the burden of the holder and informed that the Republic of Korea did not charge any fees for transformation.

60. The Delegation of Japan said that, from a user's perspective, improving the transformation procedure would enhance the user friendliness of the Madrid System. The Delegation added that the recommendations suggested in paragraph 9 of the document appeared useful. The Delegation confirmed that the Office of Japan had already provided information on its transformation procedure and fees to be displayed on the Madrid Member Profiles Database.

61. The Representative of INTA expressed agreement with the recommendations listed in paragraph 9 of the document and said he was glad to hear that the delegations which had spoken on the issue had either supported or described procedures which followed those recommendations. The Representative of INTA said he was encouraged by the number of Contracting Parties that did not charge for transformation and by those that were open to either establish a special fee or to reduce such fee, taking into account that some or all of the work had already been performed. The Representative added that he wished to encourage all Contracting Parties to consider that, in effect, an application fee had already been paid in the international procedure.

62. The Representative of JIPA expressed agreement with the proposed improvements regarding the transformation procedure which would be of benefit to the users, in particular, if Contracting Parties provided more detailed information on how they handled requests for transformation through the Madrid Member Profiles Database.

63. The Representative of MARQUES said she was pleased to hear that the numbers for transformation were low and noted that, because transformation followed cancellation of the basic mark, either by central attack, opposition or due to inadvertent non-renewal, the more that could be done to alleviate the misfortune behind transformation, the better. The Representative indicated that, as the Representative of INTA, she was also encouraged by the discussions and noted that, while members needed to be free to decide on their own procedure and it was beneficial to obtain details of the transformation procedure on the Madrid Member Profiles Database, it would be even better if there were model provisions implemented in more members. The Representative of MARQUES explained that it was confusing to go through procedures that could be different from country to country, reiterated her request, made in the previous session of the Working Group, that Offices of the Contracting Parties use a form provided by WIPO for the purposes of transformation and further requested that fees be reasonable, particularly, where a statement of grant of protection had already been issued.

64. The Delegation of Norway acknowledged that the agenda item under discussion concerned transformation and not dependency, but, supporting the views expressed by the Delegation of the Republic of Korea, underscored the importance of continuing discussions in the Working Group on the costs and negative consequences of dependency.

65. The Representative of ECTA asked whether Offices of the designated Contracting Parties, after having been informed by the International Bureau that an international registration had ceased to have effect, notified the holder that it had three months to transform the international registration into a national or regional application and wondered whether more awareness might be the key to saving the marks by increasing the use of the transformation system. The Representative said she did not believe it was just a question of fees or forms but, rather, a question of awareness and also of defining transformation as a switch to the national track, because the word transformation itself could be a block for many holders as it was such an arduous word.

66. The Representative of JPAA welcomed and expressed her support for continued discussions on possible improvements of the transformation procedures, as set out in paragraph 9(i) to (v) of the document, and hoped that the cost for applying for transformation in each designated country would be reasonable and that information concerning transformation procedures would be published on the Madrid Member Profiles Database.

67. The Delegation of the United States of America said the United States of America had incorporated transformation into its national laws, had rules addressing its process and requirements, and it was also covered in the Office's Examiner Manual, which were made available to the public and practitioners, and had also made that information available on the Madrid Member Profiles Database. With regard to fees, the Delegation informed that, while the Office charged a small fee for processing the transformation request, there was no fee for the new application created as a result of transformation. The Delegation explained that such fee covered the cost incurred by the Office and that very few transformation requests had been

received, only 30 to 35 transformation requests in total. The Delegation explained that, while there was an electronic form for filing transformation applications, the work itself was manually done and, therefore, the fee was considered reasonable and sufficiently covered the costs of processing the requests. On that basis, the Delegation favored having a fee in place and supported, as indicated by other delegations, that each member should determine whether to charge a fee. With regard to examination of the transformation application, the Delegation informed that the USPTO's practice was to generally re-examine that application and explained that, when an application was transformed into a national filing, there was a need to select a basis for filing, as the applicant would need to do when filing a national application, which required that all cases of transformation be subject to a minimal re-examination to determine whether new requirements came into play as a result of the applicant selecting a new filing basis. The Delegation further explained that actual use of a mark was required in the United States of America, and that, accordingly, the USPTO would look into the applicant's use and check whether the applicant met the requirements to obtain a national registration; thus, whether the designation of the United States of America was pending protection or whether it had been granted protection when it was transformed, the application would sometimes be re-examined, which was usually the case when a significant time had lapsed between the examination of the initial request for extension of protection and the request for transformation. The Delegation said that, where a significant time had lapsed, market conditions could have changed and the USPTO would re-examine the mark to determine whether a refusal would be necessary where, for example, the mark was no longer distinctive. The Delegation indicated that such had been the practice of the USPTO from the beginning, continued to be its practice then and would likely continue to be its practice in the future; that, generally, such cursory examination did not raise any new issues and the new transformed application proceeded to protection or remained protected but that, sometimes, there might be issues which would require a substantive refusal and, perhaps, bar registration.

68. The Delegation of China explained that requests for transformation were processed in accordance with the Protocol and that, while a transformation fee was not required, the applicant had to pay the fee for a national application, in accordance with China's national laws. The Delegation stated transformation had a role to play in exercising the advantages of the Madrid System but that, given the different procedures followed in different countries, changes to the transformation procedure involved changing domestic laws as well as the IT systems of the Offices, which merited further consideration and a longer period of preparation. The Delegation added that the cost of trademark registration was different from country to country and that, accordingly, national Offices should decide on the amount of the transformation fees.

69. The Representative of AROPI, referred to the comments made by the Delegation of the United States of America concerning the possibility of the re-examination of a request for transformation, and believed that it would be rather difficult for users to understand that the application should be re-examined on the basis of criteria different than those applied on the day the international application was filed because one of the main advantages of transformation was to benefit from the initial date of the international registration. The Representative of AROPI said that it seemed rather odd that updated examination criteria could prevail on a request for transformation, which would apply to rights already granted at a given earlier time. The Representative, referring to comments made by the Delegation of Italy, stated that, while taking a fee would not necessarily be justified, because the fee had already been paid at the time of the filing, he was not opposed to a fee, provided, as noted by the Representative of ECTA, the amount was reasonable and such fee corresponded, in fact, to the benefit of the holder having a right which was retroactive to the day of the initial filing of the international application.

70. The Delegation of Switzerland informed that the Swiss Office partially re-examined transformation applications, would refuse them if there were new grounds for refusal and noted that, while the Office had not yet refused a transformed application, it wanted to be in the position to do so where its practice had changed, for example, where the list of goods and services that had been accepted in the international registration no longer conformed to Swiss practice. The Delegation recalled that the Office had once experienced a case where there had been a partial cancellation in which, should the Office had accepted a transformation application, it would have granted additional rights. The Delegation said that, to avoid that very rare case, Switzerland left open the possibility to re-examine the transformation application and confirmed that Switzerland required the payment of fees for the transformation application.

71. The Delegation of Norway informed that, where the international registration had been granted protection, the Office of Norway did not re-examine transformation applications because Norway considered that a transformation application should be treated in the same way as the international registration, adding that, however, the transformed national registration could be subject to revocation or invalidation actions and that a possible change in practice could then be raised as grounds in revocation or invalidation proceedings.

72. The Working Group noted the recommendations for the transformation procedure by designated Contracting Parties, as set out in paragraph 9 of document MM/LD/WG/16/3, understanding that, those Contracting Parties were free to establish a fee for filing an application resulting from transformation.

#### **AGENDA ITEM 6: NEW TYPES OF MARKS AND NEW MEANS OF REPRESENTATION**

73. Discussions were based on document MM/LD/WG/16/4.

74. The Secretariat presented the document, which introduced a new topic for discussion, as set out in the Road Map agreed upon by the Working Group in 2016, by providing an overview of the legal framework of the Madrid System and listing a number of matters for the Working Group to consider as basis for future discussions. The Secretariat stated that the Madrid System legal framework did not restrict the types of signs that could be registered as marks under the Madrid System and that the types of signs which may constitute and be protected as a mark in its Contracting Parties remained a matter for their corresponding domestic legislations. The Secretariat recalled that Rule 9 of the Common Regulations required only that the applicant indicate that the mark was of a given type and that the Office of origin certified that the same indication appeared in the basic mark. The Secretariat noted that the designated Contracting Parties could refuse protection of the international registration, where, for example, the sign concerned was not considered to constitute a trademark under their domestic legislation. The Secretariat explained that the Madrid System required that a mark be graphically represented and that such was still also the case in several Contracting Parties. The Secretariat invited the Working Group to consider whether the graphical reproduction of the mark requirement should be replaced with a more flexible requirement, such as, for example, that the application contained a representation of the mark, and whether to introduce new means of representing that mark.

75. The Chair suggested that the document be discussed in five parts and invited delegations to first deliver general comments on the entire document.

76. The Representative of INTA said that he understood the topic concerned the capacity of applicants to use the Madrid System to secure protection in jurisdictions which required or would require non-graphical representation of non-traditional marks, such as, for example, in the European Union and in its member states. The Representative of INTA stated that, if the objective of the Madrid System was to remain an alternative route for protection, it would need to adapt to changing requirements prompted by new technologies. The Representative of INTA, questioning whether a mark filed in a jurisdiction that required non-graphical representation could be used as the basic mark for an international application, expressed his agreement with the suggestions made in paragraphs 21 and 24 of the document, that new

means of representation could and should be gradually introduced and that electronic data exchange in the Madrid System should be developed with a view to providing for the transmission of digital files with non-graphical representation of non-traditional marks.

The Representative of INTA drew attention to the connection of the latter with the standards for the electronic management of sound marks, developed by the Committee on WIPO Standards two years before.

77. The Delegation of the Russian Federation said that its national legislation did not exclude any marks from being registered and that, from year to year, there had been a growth in the number of applicants submitting trademarks for national registration in electronic form, which accounted for about 50 per cent of the applications received by the Russian Office in the previous year, further indicating that, during that year, there had been a significant seven per cent growth in the number of the applications filed in electronic form, with applicants being allowed to submit representations of the mark in digital form, which was not limited to graphical representation. The Delegation underscored the importance of developing an electronic exchange of data in the Madrid System to provide for the possibility of exchanging files, including non-graphical representation of marks. The Delegation said its Office was prepared to accept such applications.

78. The Chair opened the floor for comments on paragraphs 1 to 9 of the document concerning the overview of the legal framework.

79. The Delegation of the European Union said that in the previous year it had informed WIPO's General Assembly of the new European Union Trademark Regulation 2017/1101, which had entered into force on October 1, 2017, and on the new Trademark Directive 2015/2436, which the European Union member states were implementing. The Delegation confirmed that the new European Union legislation repealed the graphical representation requirement, replacing it with a general condition that a trademark be capable of being represented on the Register in a manner that enabled the competent authorities and the public to determine the clear and precise subject matter of protection. The Delegation said that, following the change, the European Union and its member states considered it of utmost importance that European Union trademark applicants and holders had the opportunity to seek extended protection for non-traditional marks using the Madrid route under the same modernized conditions that were available to them under the new European Union legislation. The Delegation underscored that embracing the use of the latest technologies in actual application practices would also facilitate the modernization, digitalization and enhanced user-friendliness of the Madrid System, adding that, against that background, document MM/LD/WG/16/4 was being given due consideration. The Delegation stated that it found the assessment of the legal framework of the Madrid System required further elaboration and referred, as an example, to paragraphs 9 and 15 of the document, which clearly stated that there existed a requirement for a graphical reproduction of marks, as set out by Rule 9(4)(a)(v) of the Common Regulations, and that the respective official form was not available in a format that would allow users to avoid graphical reproduction. The Delegation added that, however, paragraph 5 of the document stated that the Common Regulations did not restrict the types of marks for which an international application could be filed and that paragraph 12 of the same document expressed doubts as to whether it would be desirable, or even necessary, to amend the Common Regulations. The Delegation noted that paragraph 17 of the document suggested that acceptable formats be dealt with in the Administrative Instructions, which, in its view, would not be possible without amending the underlying rule in the Common Regulations. The Delegation requested, in light of those considerations, further clarification from the Secretariat, adding that it fully understood and appreciated the concerns expressed by the International Bureau in paragraphs 18 to 25 of the document concerning the difficulties that some Contracting Parties may face if new means of representation were to be introduced in the Madrid System. However, the Delegation said that it found the document did not delve deeply into the matter and did not include any suggestions on how to overcome those concerns, adding that the European Union had engaged in possible ways forward to align the Madrid System with technical developments and that, as a result of that ongoing work, it would like to present a proposal at the next session of the Working Group while remaining open to the opinions of other participants to the Working Group.

The Delegation stated that the European Union and its member states looked forward to further discussions on what it considered to be an important issue and was ready to work with the International Bureau, the members of the Madrid Union and interested user associations to find technical and legal solutions for the adequate protection of non-traditional trademarks via the Madrid System.

80. The Delegation of Italy highlighted the importance of discussing new types of marks and means of representation because it was both a European country and a member of the Madrid Union, and added that it firmly believed users should have the same criteria and opportunities when applying for European and international trademarks through the Madrid System. The Delegation informed that, according to Article 3 of the new European Union Directive of December 16, 2015, graphical representation was no longer required for European Union trademark applications and that such directive would be in force in Italy as from January 2019. The Delegation expressed its agreement with the views shared by the Delegation of the European Union in that the use of latest technologies in application practices would promote the modernization and digitalization of the Madrid System. The Delegation stated that, for such important improvement, the use of e-filing was essential, adding that, since Contracting Parties had different national solutions, situations, legislation and requirements, harmonization would not be an easy goal to reach; thus, a constructive discussion during the Working Group on the subject was important to find a way forward. The Delegation stated that the potential impact of the introduction of new means of representation had to be considered and that efforts in that regard were evolving at both national Offices and the International Bureau. The Delegation referred to the work done in 2008 where, during a meeting of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, the representation of non-traditional marks, such as three-dimensional marks, color marks, hologram marks, motion or multimedia marks, position marks, gesture marks and sound marks were addressed and said that such work should be continued. The Delegation expressed support for the proposal to amend Rule 9(4)(a) of the Common Regulations but did not agree with the suggestion that requirements for the representation of the mark and the acceptable formats be dealt with in the Administrative Instructions because of the importance of the matter.

81. The Delegation of Israel informed that, aside from three-dimensional marks, not many other types of non-traditional marks had been registered in Israel; there were no olfactory marks, approximately 20 sound and motion marks and a few color marks. The Delegation said it believed that, as more types of non-traditional marks were appearing, the Common Regulations should reflect those changes and stated that the nature of the mark for which protection was sought should be as clear and defined as possible, for all designated Contracting Parties, from the moment the new international registration is notified and that the proposal to include detailed voluntary descriptions of the mark was a good way to address that challenge. The Delegation said that the Common Regulations should be amended to accommodate for non-graphical representation in exceptional cases, such as, for example, attaching a sound file where the visual representation of the mark consisted of musical notes or of the description of a sound, such as the sound of a lion's roar, and that such possibility should be reflected in the official form MM2. The Delegation said that Israel would need to amend its legislation to allow for non-graphical representation of such marks and that, regarding the transmission of digital files, the Office of Israel would have to receive the sound file when receiving the notification of the international registration of a sound mark and that its technological infrastructure would have to allow for such digital files. The Delegation stated that the Office of Israel recognized the importance of the issue and was willing to work with its IT professionals to develop such solutions. The Delegation added that digital files would have to be both searchable and accessible on both Madrid Monitor and in the WIPO Global Brand Database.

82. The Delegation of Japan stated that it felt no particular urgency for the introduction of new means of representation and that, with a view to improving user-friendliness for both applicants and Offices and advancing the digitalization of the Madrid System operation, it would be more meaningful to better understand the current status of the Madrid System operations, identify specific issues and discuss ways to solve them. The Delegation said that, accordingly, Japan would like to play an active role in advancing the discussion on achieving that goal, suggesting

that, for instance, examples of marks should be added to the form MM2 if they helped to clarify how users should complete international applications. The Delegation further stated that, while sending and receiving data electronically might be beneficial to both applicants and Offices, it might take considerable time for some Contracting Parties to revise their domestic laws and develop their system, with Japan being one of them; thus, it advised careful discussion on the matter.

83. The Delegation of Australia expressed its support for increasing the consistency in the treatment of new types of marks and said it wished to build on comments made by the Delegation of Japan, proposing that the International Bureau conduct a survey of how members currently handled those kinds of marks to gather information on which discussions could be based. The Delegation said it believed that information concerning the kinds of marks that were protected in the members and details on the minimum requirements to enable applications to be further processed and examined would be helpful, adding that it felt information on new types of marks that were already being handled by Madrid System members could be useful for determining the approach to be used in the Madrid System and could result the widest possible acceptance among members for those kinds of marks.

84. The Delegation of France expressed its support for the statement made by the Delegation of the European Union and its belief on the need to change the Common Regulations because the current version could be interpreted as limiting the types of mark that could be filed under the Madrid System. The Delegation said it was in favor of developing an electronic data exchange.

85. The Representative of JPAA noted that applicants could not expressly state in form MM2 the type of mark for which they wished to obtain protection and added that, where an applicant wished to obtain a registration, for example, for a position mark, the Offices of designated Contracting Parties could misunderstand that the applicant wished to obtain protection for another type of mark. The Representative stated that JPAA believed that applicants might avoid such misunderstandings by listing the types of trademarks in the MM2 form.

86. The Representative of JTA expressed its agreement with the views shared by the Representative of JPAA, in that it would be beneficial to have boxes in form MM2 to indicate new types of trademarks, such as, for example, multimedia marks and motion marks, to make sure that the intended marks were protected in the designated Contracting Parties.

87. The Representative of JIPA expressed its support for the views shared by the Representatives of JPAA and JTA and added that Japanese users could make good use of the Madrid System for protecting both traditional and non-traditional marks, if possible, through an electronic filing system in the future.

88. The Chair opened the floor for comments on the remainder of the document, paragraphs 10 to 25.

89. The Delegation of the European Union requested that the Secretariat further elaborate on paragraph 17 of the document, and, in particular, on the reference to the role of the Administrative Instructions in respect of the graphical representation requirement. The Delegation reiterated that the request for clarification had been made in its initial statement on the subject, delivered on behalf of the European Union and its member states, and insisted on having a completely clear understanding of the International Bureau's interpretation of the Common Regulations. The Delegation wondered whether the Secretariat was considering, in paragraph 17, as one of the possible scenarios to be further discussed, the wording of the Common Regulations that stipulated that the mark had to be reproduced in a manner to fit in the box provided in the official form. The Delegation said it believed, at least from a strictly theoretical point of view, that the Common Regulations did not explicitly require a graphical representation of the mark and that an applicant had to provide the graphical representation simply because the form was designed in a way that required such graphical representation. The Delegation wondered, along that line of reasoning, whether, after simply amending the official form and the Administrative Instructions to, for instance, making the form apt to accept



electronic formats of trademarks, there would no longer be a need to amend the Common Regulations and users could avoid having to provide a graphical reproduction of the mark. The Delegation acknowledged that a reply to that question had already been somewhat given in the introduction of the document made by the Secretariat, but it insisted further clarification was needed, so it could have a completely sure understanding of the Common Regulations.

90. The Chair invited the Secretariat to respond to the question raised by the Delegation of the European Union.

91. The Secretariat explained that, as the proposal itself stated, to meet the needs of users and follow the development in Contracting Parties that were removing the graphical representation requirement, Rule 9(4)(a)(v) had to be changed. The Secretariat stated that the rule said the international application had to contain or indicate a reproduction of the mark fitting in the box provided on the official form and that, accordingly, it was never intended to just change the form and amend the Administrative Instructions but Rule 9(4) had to be amended to require a representation of the mark rather than a reproduction fitting the box provide to that effect. The Secretariat further explained that what was meant by acceptable formats, as indicated in paragraph 17 of the document, was formats for electronically representing the mark, such as, for example, a JPEG, MP3 or MP4 file, which could be dealt with in the Administrative Instructions. The Secretariat added that, given the fast pace of technological development, it would be better to have those formats listed in the Administrative Instructions which would be easier to amend, rather than listing all those formats in the Common Regulations.

92. The Delegation of Germany recalled that a delegation had suggested a questionnaire, but considered that such a questionnaire and study would take a long time. The Delegation said that it would be premature to conduct a survey given that, at least with regard to all the European Union members, the graphical representation requirement would cease to apply as from February 2019, and there would be no experience on the acceptance of such non-graphically represented marks. The Delegation noted that, however, there were several countries, including the Russian Federation, which had already accepted new forms of marks and no longer required a graphical representation. The Delegation suggested, as a good way of going forward, to have a draft of the proposed changes to Rule 9(4)(a)(v), to be discussed at the next session of the Working Group, which would not require that all Contracting Parties change their laws but, at least, would make it possible to have an international registration for those types of marks in countries which did accept them. The Delegation said that, for example, a German trademark owner who wanted to designate the Russian Federation in an international registration in respect of such a mark could do so. The Delegation reiterated that there would be no need for all Contracting Parties to change their law, which could be done whenever possible, and that, in the meantime, those Contracting Parties which were already able to accept such marks could do so.

93. The Chair invited the Secretariat to take the floor for comments.

94. The Secretariat highlighted the importance of making the very basic distinction between new types of marks and how those marks were represented, and noted that, while discussion had centered on new types of marks, those new types of marks could be represented graphically, such as, for example, a sound mark, which could be described by using words and which was still the practice in some of the members of the Madrid Union. The Secretariat explained that the topic for discussion concerned the representation of non-visible signs by non-graphical means, such as, for example, a sound mark represented by a digital recording instead of being represented graphically by words, such as, for example, "the roar of a lion". The Secretariat stated that, while the International Bureau was concerned with the format in which the mark were to be represented, whether certain types of marks could be protected or not was a substantive matter which remained within the realm of the trademark laws of the Contracting Parties. The Secretariat underscored that the means in which marks could be represented was an important matter for the International Bureau in order to carry out procedures under the Madrid Protocol and the Common Regulations. The Secretariat explained that the International Bureau received international applications, examined them,

but not as to substance, registered and published the marks and then notified the Contracting Parties concerned, which was the procedure even when the graphical representation of the mark was received in digital format. The Secretariat informed that, while the International Bureau received 80 per cent of the international applications in digital format, the core question was whether all the Offices of the members of the Madrid System were ready to receive notifications without a graphical representation of the mark, which meant that those notifications would have to be transmitted electronically. The Secretariat added that, in such case, there would be no fallback in the way of a PDF or JPEG image of the notification, including the graphical representation of the mark, which could be easily printed and said that it was aware not all Offices were ready to receive electronic communications. The Secretariat underscored that it wanted to bring that matter to the attention of the Working Group because it was very important for its future work and reiterated that the Madrid System did not contain any limitation as to the type of mark that could be protected. The Secretariat stated that what was limited was the type of representation, not the type of mark, and that such was an important difference. The Secretariat recalled that Rule 9(4) had been in existence for some time and highlighted that, while certain types of marks were specifically mentioned, such as three-dimensional marks and sound marks, other types of marks were not specifically mentioned, such as, for example, word marks, and recalled that the rule referred instead to marks in standard characters, which could be considered outdated. The Secretariat stated that there was room to amend and modernize the rule, and highlighted that such modernization would not necessarily be an issue for the International Bureau because, whether the application was received with a graphical reproduction of the mark in a digital format, as a JPEG or PDF file, or with a non-graphical representation of the mark, as a multimedia file, made no difference for the International Bureau as to how the application would be dealt with. The Secretariat acknowledged there would be practical issues further down the line, such as, for example, registration certificates in which a link providing online access to the non-graphical representation of the mark could be included, and stated that it was important to first understand all the implications. The Secretariat invited the Working Group to further comment on the matter.

95. The Delegation of New Zealand referred to the comments made by the Secretariat and confirmed that New Zealand also required graphical representation of trademarks and added that New Zealand took a very flexible approach as to which signs could constitute a trademark, as long as the sign met the graphical representation requirement. The Delegation said, while sounds were required to be represented graphically, as a musical notation or as a description of the sound, electronic submission of a sound file was also allowed as a supplementary representation of the trademark, so those three prongs, in combination, defined the scope of the trademark. The Delegation stated that it considered that the graphical representation requirement had some practical benefits, as mentioned by the Secretariat, when publishing trademark information, printing registration certificates and communicating information where electronic transmission was not an option. The Delegation said that, while it welcomed the introduction of electronic media or of other means of representing the mark under the Madrid System, it did not agree with removing the graphical representation requirement in its entirety.

96. The Delegation of the Republic of Moldova informed that its national law no longer required graphical representation and applicants were able to apply for non-traditional trademarks, such as sounds, hallmarks and position marks. The Delegation added that the Office of the Republic of Moldova had a flexible interpretation of the representation requirement and, for example, descriptions of movement were accepted instead of a graphical representation. The Delegation expressed its support for the initiative to introduce some changes in Rule 9(4) of the Common Regulations to allow applications for new types of trademarks and recalled that digital formats were already being accepted which was not a problem because digital communication with the International Bureau was already in use. The Delegation said that it believed the Madrid Office Portal, which was already developed, offered the possibility for all Contracting Parties to have access to trademark reproduction in digital format.

97. The Delegation of Mexico informed that implementation of amendments to its law which incorporates new types of marks would start in August 2018. Therefore, the Delegation was interested in what had been done in other members in that regard. The Delegation supported the proposal to include non-traditional marks in the Common Regulations because, as the European Union, it had abolished the graphical representation requirement. The Delegation said that, while holders who applied for sound marks directly in Mexico would have the possibility of submitting a sound file, those seeking protection in Mexico under the Madrid System would receive a notification of provisional refusal requiring them to submit a sound file. For that reason, the Delegation expressed support for the idea of including new types of marks in the Common Regulations or other options, such as, for example, giving applicants the possibility to upload a sound file.

98. The Delegation of Germany said it understood the problem the International Bureau had put forward regarding Offices that were not able to receive electronic communication but added that waiting until every Office was capable of receiving electronic communication would not be a good reason to postpone the introduction of non-graphical representation of marks. The Delegation, while acknowledging that it did not have a solution, said that it did not consider such introduction would be a big practical problem because an applicant would not likely designate and spend money on a country knowing that the mark would be refused from the very beginning. The Delegation suggested that the Madrid Member Profiles Database provide information on whether a country required graphical representation and added that there should be no reason to postpone the decision for the next 10 or 15 years.

99. The Chair acknowledged that a number of members were in different positions and noted that there were two aspects to the discussion; new types of marks, many of which could be represented graphically, and non-graphical representation of trademarks, such as, for example, a sound file instead of a musical notation, which was still required in many Offices. The Chair recalled proposals for at least two ways forward; the first proposal, put forward by the Delegation of Australia, was to conduct a survey. The Chair stated that a survey could be useful to provide a better understanding of the types of marks members received and the corresponding requirements and suggested the findings be presented at the following session of the Working Group. The Chair said that the second proposal concerned possible amendments to Rule 9 which could also be presented in a document to be discussed at the following Working Group session. The Chair opened the floor for comments on both proposals.

100. The Delegation of the Republic of Korea expressed its support for the collection of information from members concerning their current handling of non-traditional marks, including application requirements and procedures, by the circulation of questionnaires and stated that data from each of the members could be the basis for a productive discussion on that issue at the following session of the Working Group.

101. The Delegation of Cuba expressed its agreement with the proposed questionnaire to examine the experience in members and added that the issue raised by the Delegation of Germany should be borne in mind. The Delegation noted that, while there were members in which the representation of the mark created some issues and members who were much more advanced in resolving those issues, several delegations had not expressed views on the matter. The Delegation said that there were a number of other legal and material issues to consider which would be obstacles to reaching the level of development that members expected the Madrid System to achieve. The Delegation stated that, while it had never been against progress in the Madrid System, at that moment, it held reservations against the introduction of new types of marks until the Office of Cuba had the necessary legal and material conditions to cope with them.

102. The Delegation of Colombia said it joined the Delegations of the Republic of Korea and Cuba in supporting the proposal, made by the Delegation of Australia, to send out a questionnaire to collect the information necessary to determine the *status quo* in the members of the Madrid System.

103. The Delegation of Italy reiterated its support for any study that could be used to better understand non-traditional trademarks for which protection was available, including the proposal for a questionnaire. The Delegation recalled that such questionnaire had been proposed not only by the Delegation of Australia but also by the Delegation of Japan. The Delegation added that it favored the proposal to amend Rule 9 but that would only be possible after the new types of marks had been identified. The Delegation, while thanking the Delegation of Germany for its practical observations on the matter, stressed that, until all members used the e-filing system, it was not possible to achieve a practical result. The Delegation said that Italy was one of the members still using paper but that it believed all countries, including Italy, had to do their best to promote e-filing.

104. The Delegation of Switzerland expressed its support for a questionnaire and said that, as with the questionnaire on limitations, it would help to provide an understanding on the practical and legal implications of the matter. The Delegation said that it might be useful to request that Offices and users comment on the questionnaire as it might help direct discussions in the future because some Offices could raise matters that had already come up internally. The Delegation said would be premature to amend Rule 9 without the findings of the proposed questionnaire.

105. The Delegation of Poland added its support for a questionnaire and stated that it would be helpful and interesting to know more about the experience of other countries in dealing with non-traditional trademarks.

106. The Representative of ECTA noted that a non-traditional mark could be registered as a European Trade Mark (EUTM) and wondered what would happen if an international application was filed on the basis of such EUTM designating, for example, Afghanistan and the United Kingdom. The Representative of ECTA asked whether the International Bureau could process such international application at all because Afghanistan had no way of receiving it, or whether it would process such application in respect of the designation of the United Kingdom only, which could receive it. The Representative also asked whether it would be possible, from the results of the proposed questionnaire, to publish on the WIPO website a list of countries that did not have the means to process non-traditional registrations. The Representative of ECTA stated that waiting until all members had the means to receive non-traditional would prevent those countries which had those means from receiving those registrations.

107. The Chair informed that the Madrid Member Profiles Database contained information concerning the types of marks that would and would not be accepted by many members, and recalled that, at that moment, the reproduction of the mark still needed to fit in the box in the MM2 form. The Chair said it was too early to answer other questions raised by the Representative of ECTA.

108. The Representative of ECTA, seeking further clarification, wondered whether the problem was the box in the MM2 form and, therefore, even where a Contracting Party had implemented changes to its law, holders would not be able to obtain protection by way of the Madrid System.

109. The Chair confirmed that, at the moment, the representation of the mark still had to either fit in the box in the MM2 form or, where Offices transmit that form electronically, be sent as a graphical representation of the mark in electronic form to the International Bureau.

110. The Delegation of the Czech Republic explained that it had had no experience with non-traditional marks but that the Czech Republic would harmonize its practice along with several members shortly thereafter. The Delegation indicated that, as of January 2019, the Czech Republic would accept non-traditional marks and stated that it would be a good idea to look at and compare the situation in other members. The Delegation expressed its agreement with the solution, proposed by the Representative of ECTA, to have declarations made by members in that regard, in a single list, which would be clearer than having to look at each of the individual declarations made by the members.

111. The Representative of CEIPI stated that the two options which were being discussed were not necessarily mutually exclusive and that everything depended on how the draft new Rule 9(4) was viewed. The Representative said that, in any event, it was timely to draft changes in a sufficiently flexible way to include future and unknown types of marks, which could grow very quickly, adding that it would be pity if changing the rules was required every time. The Representative noted that the initial draft could be changed if the results of the questionnaire proved such change was necessary and expressed support for the proposal made by the Delegation of Germany because it opened up very interesting prospects.

112. The Chair proposed to proceed with a survey. The Chair, while acknowledging the request made by the Delegation of Switzerland to review the draft survey, said that, given the complexity of the subject matter, such review would be difficult and could delay the distribution of the survey. The Chair indicated that the Secretariat would welcome any suggestions on the questionnaire and that a document, presenting the findings of the survey, could be presented at the next session of the Working Group. The Chair, noting that there was little enthusiasm for discussing a draft new Rule 9 at the following session, proposed, as an alternative, to have a document discussing the principles guiding possible changes to Rule 9. The Chair opened the floor for comments on the proposed way forward.

113. The Delegation of the European Union expressed support for the Chair's proposal and agreed that the results of the survey and the principles guiding possible changes to Rule 9 should be discussed at the next session of the Working Group. The Representative said that it agreed with the Representative of CEIPI, believed both options were not mutually exclusive and, therefore, a simultaneous discussion on both the results of the survey and on the principles guiding possible changes to Rule 9 could take place.

114. The Working Group requested the Secretariat to:

- (i) conduct a survey among Offices of the Contracting Parties of the Madrid Protocol on acceptable types of marks and means of representation and present its findings in a document to be discussed at the next session of the Working Group; and
- (ii) prepare a document describing possible changes to Rule 9 of the Common Regulations with a view to accommodating new means of representation.

## **AGENDA ITEM 7: FINDINGS OF THE QUESTIONNAIRE ON LIMITATIONS OF INTERNATIONAL REGISTRATIONS UNDER THE MADRID SYSTEM**

115. The Working Group considered in detail document MM/LD/WG/16/5.

116. The Secretariat recalled that limitations in international registrations had been discussed in the Working Group and in its Roundtable since 2010 and that discussions had focused on the roles of the Office of origin, of the International Bureau and of the Offices of the Contracting Parties concerning limitations presented in an international application, in a subsequent designation and as a request for the recording of a change to the international registration. The Secretariat further recalled that, in its previous session held in 2017, the Working Group requested the International Bureau to conduct a survey among Contracting Parties and observer organizations on the role of the Offices and of the International Bureau on limitations; that, in November of the previous year, the International Bureau presented a draft questionnaire to the Offices of the Contracting Parties as well as to observer organizations; and, that the International Bureau received feedback and contributions from 21 Offices and four observer organizations. The International Bureau informed that the final version of the questionnaire had been sent out in February 2018, and that, by the given deadline, it had received replies from 55 Offices and seven observer organizations, with a few replies received after the deadline, which, while not reflected in the document, were posted on the website of that session of the Working Group under "Other Related Documents". The Secretariat explained that the document under discussion contained information concerning 21 questions presented

in two main parts and that Part I concerned Offices only and covered information on the role of the Office of origin, for limitations made in international applications, and on the role of the Office of the Contracting Party of the holder, for limitations made in subsequent designations or requested as recording of a change to the international registration; further presented information on the role of the Office of the designated Contracting Party for limitations in international registrations, subsequent designations or recorded as a change; and, had information on the role of the Office as well as on the legislation and practices concerning limitations made in national or regional applications or registrations. The Secretariat further explained that Part II of the results presented information provided by observer organizations only. The Secretariat stated that the document presented the main findings of the survey without drawing conclusions.

117. The Chair opened the floor for comments.

118. The Delegation of Switzerland said that it had expected a summary of the positions of, at least, those which held the same view and stated that, from the document, most Offices expected the International Bureau to examine limitations before registration, and, if such was the case, the findings of the survey supported the position held by Switzerland over recent years, namely, that limitations had to be examined by the International Bureau before registration. The Delegation asked whether the International Bureau or the Chair shared the same understanding regarding the results of the survey.

119. The Delegation of the Russian Federation expressed its support for the views shared by the Delegation of Switzerland and requested the Secretariat to answer the question asked by this Delegation.

120. The Delegation of New Zealand said that, from the survey answers, it appeared there was no clear consensus on who should assess limitations and that, while many of the respondents expected the International Bureau to assess limitations, the Delegation stated the International Bureau had no legal mandate to do so because the Common Regulations and the Protocol stated that the International Bureau assisted with the classification of goods and services only, and not with the scope of limitations.

121. The Delegation of Italy noted that the Italian Office was in line with most of the positions expressed by the majority of the participants. The Delegation stressed the importance of the central role national Offices had in examining limitations in international applications because only national Offices were able to ensure that the scope of the limitation did not exceed the scope of the basic mark. The Delegation said that the Italian Office took a different approach in respect of limitations in subsequent designations, because those could be filed directly with WIPO. Accordingly, the Delegation stated that the International Bureau could perform the examination work and aligned itself with the position expressed by the Delegations of Switzerland and of the Russian Federation. The Delegation stated that, while it did not have any specific suggestions on the further work concerning the examination of limitations, believed that the findings of the questionnaire could be a good starting point for further work to be performed by the International Bureau, with the collaboration of the members.

122. The Delegation of France expressed its support for the comments made by the Delegations of Switzerland and Italy.

123. The Delegation of New Zealand reiterated its belief that the International Bureau had no legal mandate to assess limitations. The Delegation referred to earlier comments made on the role of the Office of origin assessing limitations and said that, while it was beneficial for identifying obvious issues with limitations filed through those Offices, the fact that those Offices did not see all types of limitations remained a concern. The Delegation added that, for example, the Office of New Zealand had never received a request for subsequent designation because those requests were filed with the International Bureau. The Delegation added that, while seeing the benefits of the Office of origin doing that initial assessments, it fell on the designated Contracting Party to assess whether the limitation would be acceptable under its own legislation and practices because it was there where the limitation would have effect.

The Delegation suggested that a possible way forward could be amending Rules 17 and 27 to give those designated Contracting Parties who wished to refuse a limitation a clear ability to do so.

124. The Delegation of the Czech Republic expressed its agreement with the comments made by the Delegations of Switzerland, Italy and France. The Delegation did not have a specific proposal but believed limitations had to be assessed by WIPO.

125. The Delegation of Sweden expressed its support for the statement made by the Delegation of New Zealand and reiterated its view that the possibility for designated Contracting Parties to examine limitations in international registrations should be set out in the Common Regulations. The Delegation informed that Sweden conducted an *ex-officio* examination on relative grounds and, therefore, considered that the designated Contracting Party should finally decide on the scope of protection. The Delegation stated that, from the results of the questionnaire, such a regime would be supported by some of the users' organizations and, possibly, some delegations.

126. The Delegation of Japan stated that the results of the questionnaire showed how various Offices examined limitations and what their concepts were in regards to those limitations, such as, for example, the roles of Offices and of International Bureau in handling limitations. The Delegation said that it was clear that Contracting Parties had a wide range of differences in terms of their operating procedures when it came to examining limitations as Office of origin and as Office of a designated Contracting Party and that, in order to improve examination practices, it was essential for the International Bureau, the Office of origin and Offices of designated Contracting parties to promote the harmonization of the classification of goods and services. The Delegation added that, going forward, it considered it would be important to enhance the Madrid Goods and Services database and proposed that the International Bureau study whether it might be possible to use artificial intelligence to examine indications of goods and services, including in limitations.

127. The Delegation of Switzerland wondered whether the Working Group should go through the document, heading by heading, after a general discussion, to have a better understanding of the subjects under discussion and better direct such discussion.

128. The Chair recalled that the floor was open for general comments and then the Working Group could go through some of the questions and answers of the questionnaire, if there was value in doing so.

129. The Delegation of Cuba stated that, while some countries had different views on the role of the Offices of the designated Contracting Parties, the examination of limitations was important because it involved conferring or granting of rights. The Delegation recalled that the document had requested the Working Group discuss the findings of the questionnaire and draw conclusions and added that, accordingly, it had a suggestion regarding form MM6, which was the official form to request the recording of a limitation as a change, which would make it easier for Offices of designated Contracting Parties to examine those limitations. The Delegation recalled that the goods and services listed in form MM6 had to be worded positively and said that this posed a challenge for the Office of Cuba. The Delegation wondered whether it would be clearer if holders were to simply indicate the goods or services to be eliminated from the main list of the international registration. The Delegation noted that a number of Offices, when responding to the questionnaire, had indicated that, as the Office of a designated Contracting Party, they examined the scope of limitations in international registrations. The Delegation stated that, in such case, protection could be refused in accordance with Rule 17 of the Common Regulations. The Delegation stated that, while Offices, as the Office of a designated Contracting Party, were responsible for examining limitations and were doing so, examination in those Offices could be expedited if the Working Group were to review the official forms in respect of limitations and discuss possible changes to those forms so applicants and holders could present information concerning limitations in a clearer manner.

130. The Representative of INTA noted that the question concerning the various roles of the International Bureau, the Office of origin and the Offices of designated Contracting Parties in respect of the examination of limitations had been discussed for a long time within the Working Group and added that he believed a solution to that question was needed and that such solution should not only be consistent with the underlying principles of the Madrid System but also practical in operational terms. The Representative stated that the solution needed not necessarily to be the same for all types of limitations; that was, limitations in the international application, in subsequent designations or under Rule 25 of the Common Regulations. The Representative reiterated INTA's previously expressed view that the examination as to the scope of any limitation in the international application should be part of the process of certification by the Office of origin, provided for in Article 3 of the Protocol and in Rule 9(5)(d) of the Common Regulations. The Representative said that he was struck by the replies to the very first question of the questionnaire because those replies showed that 52 out of 56 Offices had indicated that they did some kind of examination of limitations in international applications, with only four Offices indicating they did not conduct any kind of examination. The Representative of INTA expressed its belief on the consistency of examination by the Office of origin with the basic concept of the Madrid System, which was that the international registration was a territorial extension of the protection obtained in the Contracting Party of origin by virtue of the basic mark. The Representative stated that, accordingly, the Office of origin was the only authority in position to assess, with certainty, whether the scope of the limitation was covered by the basic mark, in accordance with its law and practice and to certify that all the goods and services listed in the international application, including any limitation contained therein, fell within the scope of the basic mark. The Representative said that, under Rule 9(5)(d) of the Common Regulations, the Office of origin had to certify that the goods and services listed in the international application were covered by the goods and services appearing in the basic application or in the basic registration, as the case may be, and added that it seemed logical and practical to understand that such requirement applied not only to the main list of goods and services, but also to any limited list or lists of goods and services that appeared in the international application. The Representative noted that, from the replies to question 1 of the questionnaire, a large majority of the Offices appeared to share that interpretation, and suggested that, if such was not sufficient, it could certainly be specified in Rule 9(5)(d) of the Common Regulations that Contracting Parties relied on the Office of origin to ensure that the goods and services which appeared in the main list of the international application were covered by the basic mark and that, likewise, also relied on the Office of origin to ensure that goods and services resulting from any limitation of that main list were also covered by the basic mark.

131. The Representative of JIPA expressed its support for the views shared by the Representative of INTA and hoped that the Office of origin would examine limitations and ensure they fell within the main list of the international application, so Offices of the designated Contracting Parties would not need to undertake such examination. The Delegation explained that JIPA would be very concerned about an increase in the costs, by the need to reply to any Office action and by any delay in examination if examination was to be undertaken by the Offices of the designated Contracting Parties.

132. The Representative of JPAA said that she shared the views expressed by the Representative of INTA concerning limitations and that, according to its understanding of the results of the questionnaire, especially, the first question, the Office of origin examined limitations in the international application and, therefore, hoped there would be a consensus on that, at least, those limitations should be examined by the Office of origin.

133. The Chair suggested going through the document, question by question, to find a possible way forward then opened the floor for comments on the findings of question 1, concerning the role of the Office of origin. The Chair asked delegations whether the Offices of their corresponding Contracting Parties, acting as the Office of origin, examined limitations in form MM2 or for Offices with an electronic filing, the electronic form, and noted that quite a high number of Offices considered that they had a role at that point.



134. The Delegation of Switzerland noted that a large number of Offices considered limitations should be examined before they were registered or recorded in the International Register, which conformed to the expectations of users, Offices and to the interest of having clarity in the International Register because a limitation, by its own definition, should not be an extension of the main list. The Delegation referred to the first question, concerning the role of the Office of origin in international applications, and noted that an overwhelming majority of Offices considered such limitations should be looked at by the Office of origin before being conveyed any further. The Delegation said it favored clarification of the rules, along the lines suggested by the Representative of INTA.

135. The Chair opened the floor for comments on the findings of question 2, concerning the role of the Office of the Contracting Party of the holder; he further explained that discussions should focus on limitations made in either a subsequent designation or requested as the recording of a change to the international registration; and, noted that, while, from the findings of the questionnaire, a good proportion of Offices considered they had a role in examining limitations, the Office of the Contracting Party of the holder would only see a small number of those limitations because holders could submit their requests directly to the International Bureau. The Chair said he had been informed by the Secretariat that, approximately, 78 per cent of subsequent designations were filed directly with the International Bureau, which meant that only one in five subsequent designations was filed with the Office of the Contracting Party of the holder.

136. The Delegation of Switzerland reiterated its belief in changing the rules to spell out that the Office of origin should examine limitations in international applications and, also, sought clarification on the way the discussions were going to be conducted.

137. The Chair clarified that all questions would be discussed and that any conclusions that could be drawn from those discussions would be considered.

138. The Representative of INTA said the question suggested that no international registration remained governed by the Madrid Agreement and that, accordingly, the intervention of the Office of the Contracting Party of the holder had become entirely optional. The Representative added that it would be useful, before coming to any conclusion on the examination of limitations in subsequent designations, to know what proportion of the subsequent designations remained channeled through an Office, and, if that was a substantial proportion, to investigate the reasons why holders would choose to present their subsequent designations through the Office of their Contracting Party rather than directly to the International Bureau.

139. The Chair recalled that 78 per cent of all subsequent designations were received directly by the International Bureau, which meant that only one in five subsequent designations was filed through the Office of the Contracting Party of the holder, or, approximately 20 per cent of the total. The Chair stated that it was fairly clear that the majority of holders preferred presenting their subsequent designations directly to the International Bureau.

140. The Delegation of Switzerland said that, with regard to limitations made in subsequent designations, the findings indicated that most Offices expected the examination of those limitations to be done by the Office of the designated Contracting Party. The Delegation stated that, nevertheless, the Office at which a subsequent designation was presented should examine those limitations and, accordingly, said it believed either the Office of the holder or the International Bureau that should undertake such examination.

141. The Chair opened the floor for discussions on the findings of question 3, concerning the role of the Contracting Party of the holder in requests for the recording of a limitation as a change. The Chair noted that, while a reasonable number of Offices considered they had a role in that regard, he had been informed by the Secretariat that 96.5 per cent of requests for the recording of a limitation as a change were filed directly with the International Bureau and, accordingly, the Office of the Contracting Party of the holder received an extremely low number of those requests because virtually all requests were presented directly to the International Bureau. The Chair further recalled that, in those cases, the designated Contracting Parties could refuse the effects of the limitation under Rule 27(5).

142. The Delegation of Switzerland stated that the great majority of users or Offices that considered that a limitation ought to be examined prior to its inscription in the International Register and that, despite the fact that there were different ways of correcting that recording, including through a declaration under Rule 27, the principle was that limitations ought to be examined prior to their inscription in the International Register.

143. The Chair observed that, from a review of the answers to the question under discussion, there seemed to be fewer Offices that thought it was the role of the International Bureau to examine these limitations, with only six Offices stating this should be the case. The Chair further recalled that over 96 per cent of requests for the recording of a limitation as change were presented directly to the International Bureau.

144. The Delegation of Germany said that it did not share the conclusion drawn by the Chair, because, for example, the Office of Germany examined limitations recorded as change only because it was aware the International Bureau did not do so. The Delegation stated that, however, such practice did not mean that the Office believed the International Bureau should not examine requests for the recording of a limitation as a change.

145. The Delegation of Switzerland said it shared the views expressed by the Delegation of Germany. The Delegation believed that, when a subsequent designation was filed through the Office of the holder, that Office should examine the limitation; however, the International Bureau should examine the request when it was presented directly to the International Bureau.

146. The Chair reminded delegations that the purpose of the survey was to look at the practices of the Offices at that time, rather than discussing what delegations believed Offices ought to do, and that the survey should be assessed in light of that.

147. The Chair opened the floor for discussions on the findings of question 4, concerning the role of the Office of the designated Contracting Party for limitations in international applications; explained that the issue to be discussed was whether those Offices that examined such limitations to determine whether they were covered by the main list of the international registration; and, noted that, from the findings of the survey, some Offices examined the limitation but a reasonable number Offices did not because they considered the International Bureau had previously done so. The Chair remarked that the answers to the question under discussion were not consistent with the answers given to question 1, where most Offices thought it was the role of the Office of origin to examine the limitation.

148. The Delegation of Australia stated that limitations would best be examined by the Office of the designated Contracting Party, where the limitation was intended to have effect, because the reasons for requesting the limitation may be based on circumstances that existed only in that Contracting Party and because some Offices had particular requirements. The Delegation stated that leaving the examination of limitations to the designated Contracting Parties would also respect the intellectual property legislation and systems which were observed in each of them; and, would avoid unnecessarily burdening the International Bureau with examination functions, particularly in the case of the subsequent designations, where the majority of which were not being filed through the Office of the Contracting Party of the holder. The Delegation said that, as the Common Regulations did not provide for a mechanism under which Contracting Parties could declare that limitations in international registrations or subsequent designations had no effect, Australia supported the comments made by the Delegations of New Zealand and

Sweden regarding amendments to Rule 17 to provide for a declaration that such limitations had no effect. The Delegation stated that a uniform mechanism for all limitations would provide greater clarity to both users and Offices, adding that Australia supported the continued ability of Offices of origin to assist applicants in drafting limitations as part of an advisory role.

149. The Delegation of France informed that the Office of France examined limitations, both as Office of origin and as Office of the Contracting Party of the holder, in international applications, subsequent designations and throughout the lifecycle of the mark. The Delegation said that the Office could not examine limitations as the Office of a designated Contracting Party because examination was limited, by its legislation, to the grounds for provisional refusal; namely, examination of the signs to determine whether they could constitute a mark. The Delegation said that determining whether or not a limitation was actually an extension of the original scope would, in its opinion, amount to a formal examination of the French designations, for which the Office had no legal basis. The Delegation added that, from a practical point of view, it would be difficult for the Office to examine limitations, even if it had the legal capacity to do so, because the Office did not have access to the list of the goods and services in the basic mark.

150. The Delegation of Switzerland noted that, in response to question 4, the majority of Offices considered that examination of limitations should be carried out prior to their recording in the International Register. The Delegation wondered whether Offices of designated Contracting Parties looked at the scope of the limitation only because they were aware that this was not always being previously checked and did so just to, essentially, fill in a gap in practice.

151. The Chair recalled that, when the International Bureau notified the Offices of the designated Contracting Parties, the notification contained both the main and limited lists, and that, accordingly, Offices of designated Contracting Parties could always compare them.

152. The Delegation of Norway said that Norway had a practice along the same lines as the practice in Switzerland and said that, while the Office of Norway did not examine limitations, because it considered that such an examination had already been previously done, the Office would refuse protection, in accordance with the national legislation, when it noticed that a limitation had not been made in accordance with the main list.

153. The Delegation of Germany said the practice in Germany differed from that in Australia because, as Office of origin, the Office of Germany certified that the list of goods and services of the international application was covered by the basic mark. The Delegation stated that a limitation should not go beyond the scope of the list of goods and services in the basic mark. The Delegation added that, as a designated Office, the Office of Germany examined limitations because it knew that neither the other Offices nor the International Bureau were examining them.

154. The Chair opened the floor for discussions on the findings of question 5, concerning limitations made in a subsequent designations, clarified that discussions should be on whether the Office of the designated Contracting Parties examined limitations made in a subsequent designation to determine whether such limitation was covered by the main list of the international registration and noted that, from the findings of the survey, a reasonable number of Offices did not examine those limitations because they considered that either the Office of origin or the International Bureau had previously done. The Chair indicated that, from previous discussions, there was a high likelihood of that not being the case because the Office of origin may not have received the limitation and, when presented directly, the International Bureau did not examine them.

155. The Chair noting that there were no comments on the findings of question 5, opened the floor for comments on the findings of question 6 and clarified that the question concerned the action an Office took when it determined that a limitation made in an international application or subsequent designation was not covered by the main list of the international registration. The Chair remarked that, according to the findings, the vast majority of Offices would issue a refusal under Rule 17.

156. The Delegation of Switzerland expressed its surprise at the fact that 13 Offices issued a provisional refusal and asked whether those Offices had special legal basis for doing so. The Delegation said that Switzerland had always interpreted that the grounds for a provisional refusal were limited to substantive grounds to refuse protection to the mark in accordance with the Paris Convention and, therefore, wondered whether such interpretation was too strict.

157. The Delegation of Cuba referred to question 6 and stated that the number of Offices that issued a provisional could have been 14 because the Office of Cuba also issued such refusal and recalled that the Office had indicated, in questions 4 and 5, that it examined limitations as the Office of a designated Contracting Party. The Delegation explained that the Office undertook such examination in accordance with the national law, which provided for the possibility of requesting a limitation in respect of a domestic application or registration at any time and required the Office to examine the request. The Delegation stated that it treated limitations in international registrations no different than limitations in domestic applications or registrations; and that, accordingly, the Office examined limitations to determine whether they were covered by either the main list of the international registration or the list for which Cuba had been designated and would refuse when such was not the case. The Delegation further explained that the Office also examined limitations in international applications, when acting as the Office of origin, and, should those limitations not be covered by the main or basic list, would not certify and present the application until the issue had been resolved. The Delegation further underscored that the fact that the International Bureau was not examining limitations filed directly compelled the Office to examine such limitations to ensure compliance with the national law.

158. The Delegation of Germany referring to the comments made by the Delegation of Switzerland, said that, the Office of Germany, as one of the Offices that issued provisional refusals, did not have an interpretation as strict as Switzerland. The Delegation said that the Office also issued provisional refusals when, for example, the list of goods and services was not clear enough or there were indications that were obviously unacceptable. The Delegation recalled that the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* indicated that designated Offices could raise a provisional refusal where indications of goods or services were too vague and the Office followed the same approach when examining limitations.

159. The Chair noted that, it was not possible to extend the scope of an application in New Zealand and the Office could refuse limitations, made not only to a national trademark but also to an international registration, on that basis, which meant that the situation in Germany seemed similar to that in New Zealand.

160. The Chair opened the floor for discussions on the findings of question 8, concerning limitations recorded as a change, and clarified that discussions should be on whether the Office of a designated Contracting Party examined such limitation. The Chair noted that, from the findings of the questionnaire, half of the Offices examined limitations and some Offices did not because they believed either the Office of origin or the International Bureau had already done so, while a small number of Offices did not examine due to lack of legal basis to do so. The Chair recalled that Rule 27(5) enabled a designated Contracting Party to refuse the effects of a limitation and wondered why, in spite of this, some Offices still believed they lacked legal basis to do so.

161. The Delegation of the Czech Republic explained that the Office of the Czech Republic, acting as the Office of origin, examined limitations but, as a designated Office, did not do so limitations because, like Switzerland and other members believed that the International Bureau should examine everything that was recorded so users could trust what was found in the International Registry. The Delegation said that such had to be done properly because, otherwise, users would have to review all refusals, such as those issued by Germany, to see whether a limitation was correct or not. The Delegation informed that, as far as the Czech Republic was concerned, examination of limitations was not provided for in its legislation, the Office did not have the means to carry out those examinations and, accordingly, did not do so.

The Delegation stated that, if a limitation concerned several members, the International Bureau should examine it so the limitation had effect in all those members in a harmonized way. The Delegation said it was aware that some members had certain specificity requirements concerning the designation of goods and services and that, while it should be possible for those members to take action, it would defy the logic of having one international registration for several members, from the perspective of the users, if each member had different specificity requirements because, in such case, users would need to proceed in each member and appoint a local representative. For that reason, the Delegation stated that the International Bureau should examine the list of goods and services, including limitations.

162. The Delegation of Switzerland stated that it fully agreed with the remarks made by the Delegation of the Czech Republic and explained that Switzerland examined limitations, as a designated Office, because it had become aware that this work was not being done upstream. The Delegation added that, like Germany, Switzerland examined limitations to see whether they involved an expansion and to check whether there were no further reasons for refusal, because it had received limitations that had resulted in the mark being misleading. The Delegation said that, while it was of the opinion that inaccurate recordings of limitations should be avoided, it also understood that sometimes considered users that the limitation concerned only the designated Contracting Party and that, ultimately, it was up to that designated Contracting Party to make a decision. The Delegation said it envisioned a system whereby the International Bureau, as the Office where the limitation had been filed, gave an opinion on the expansive nature of a limitation, by analogy to Rule 13, notifying any irregularity and making suggestions, to the holder or to the Office, indicating the problem and, if the holder or the Office did not reply, a remark would be inscribed indicating that, in the opinion of the International Bureau, the limitation was an extension. The Delegation said that such indication would put the designated Contracting Party and third parties on notice that the International Bureau considered the limitation to be invalid. The Delegation stated that such system would simplify the work of the Offices of the designated Parties clearer because Offices that did not examine limitations could immediately see that there was a problem with the limitation. The Delegation offered to further discuss the matter, separately, if necessary.

163. The Chair opened the floor for comments on the findings of question 9 of the survey and noted that this question was only for the Offices that had replied “yes” to question 8. The Chair clarified that the question concerned the examination of a limitation recorded as a change and the scope Offices took into account, noting that, from the findings of the questionnaire, most Offices took into account the list of goods or services for which the mark was protected.

164. The Chair acknowledged there were no comments to question 9 and opened the floor for comments on the findings of question 10, noting that the question only applied to those Offices that had replied “yes” to question 8. The Chair explained that the question sought information on the actions Offices took when determining that a limitation recorded as a change was not covered by the main list of an international registration, or as the case may be, the list of goods or services for which the mark had effect or was protected. The Chair noted that, from the findings of the questionnaire, almost all Offices issued a declaration that such limitation had no effect in the Contracting Party, in accordance with Rule 27(5) of the Common Regulations.

165. The Chair noted there were no comments to question 10 and opened the floor for comments on the findings of questions 11 through to 14. The Chair clarified that question 11 concerned the legislation and practice in the designated Contracting Parties regarding national or regional applications or registrations. The Chair noted, from the findings, that Offices examined requests for limitations made in respect of national or regional applications and remarked that there was a contradiction in the treatment of limitations because, while most Offices examined limitations for national or regional applications or registrations, a number of Offices did not examine limitations in international applications or registrations.

166. The Delegation of Switzerland said it found the question interesting to determine whether Offices examined limitation requests at the national level and whether a parallel could be drawn and noted that Offices examined whenever they received those requests. The Delegation, however, stated that it had interpreted the figures different than the Chair and considered Offices examined when they received the request and had to inscribe in the national register. The Delegation said that it understood that 47 Offices had indicated that they examined the requests that were filed with them, and that, in a similar manner, the Office of the holder, the Office of a designated Contracting Party or the International Bureau must examine a request filed with them before a change could be inscribed. The Delegation said that the Office of Switzerland, as the Office of a designated Contracting Party, in most cases, simply received the information that had been recorded in the International Register; whereas, as the active Office concerning the recording of a change in its register, examined the request.

167. The Chair opened the floor for comments on the last part of the questionnaire which concerned observer organizations.

168. The Representative of MARQUES said she believed that, as long as there was no harmonization regarding acceptable indications of goods and services, a limitation would need to be examined by the Offices that were concerned by such limitation. The Representative concluded that, until there was complete harmonization and a much bigger common footstep on how lists of goods and services were put together and accepted, examination would have to be done by each member affected by the limitation.

169. The Representative of INTA, referring to questions 15 to 17, stated that all the reasons which were listed in the questionnaire were valid reasons, adding that he had tried, in its contribution, to rank the three main reasons in each question.

170. The Representative of AROPI stated that legal certainty was most important for users and, consequently, it was extremely important to ensure a limitation was accepted in each designated Contracting Party affected by such limitation. The Representative said that AROPI supported the practice in New Zealand described by the Chair because it felt that it was the most favorable approach for legal certainty.

171. The Chair invited the Secretariat to take the floor for comments.

172. The Secretariat addressed the question raised by the Delegation of Cuba concerning limitations set out in official for MM6 and the difficulties faced by the Office to understand the scope of that limitation. The Secretariat explained that, historically, it was easier when Offices received the information contained in the MM6 forms because the holder had to simply delete from the main list the indications that were no longer applicable; with the evolution of limitations seen in previous years, the main list could be just a few lines short while the limitation could be hundreds or even thousands of words; thus, it had become more difficult to convey the actual scope of the limitation. Therefore, with the existing layout of form MM6, the holder could indicate the classes that were to be deleted completely or specify the new complete limited list that was requested to have effect in a designated Contracting Party. The Secretariat said that, since the International Bureau could not interpret the meaning of a limitation, it needed clear information on the intended scope to inscribe it in the International Register; for that reason, the holder was required to indicate the complete limited list. The Secretariat stated that such practice provided more transparency for third parties and Offices, even though it could be sometimes difficult to understand what had actually changed. The Secretariat said it was a good time to take stock of where the Working Group was in terms of its discussions on limitations. The Secretariat noted that, after many years of discussions, the Working Group was still divided on who should be responsible for determining the scope of limitations and whether those limitations were covered by the main list of goods and services in the international registration. A number of delegations were in favor of the Office of origin determining that scope; some delegations felt the International Bureau should decide; other delegations were of the opinion that the scope should be decided by the Office of the designated Contracting Parties where the limitation had effect. The Secretariat added that a recap of the legal situation

concerning limitations would be helpful. The Secretariat recalled that, while a number of Offices, acting as Offices of origin, examined limitations in international applications, Rule 8 of the Regulations under the Madrid Agreement Concerning the International Registration of Marks the did not envision the inclusion of limitations in international applications and, consequently, the international application form did not reflect that possibility. The option, to include limitations in international applications was only provided for in Rule 9(4)(a)(xiii) of the Common Regulations, which resulted in the modification of the international application forms in 2001. Prior to that year, any limitation had to be requested separately, although it could be published along with the international registration. On that basis, the certification function could not be considered to have originally included the examination of limitations. The Secretariat noted that there were different practices in many Offices, when acting as Office of origin, regarding the examination of limitations in international applications; accordingly, delegations would have to agree on whether Offices, acting as Office origin, should examine the main list of goods and services of the international application as well as any limitation therein to determine whether that limitation was within the scope of the main list. The Secretariat said that, in doing so, Offices, acting as Office of origin, could provide a valuable service but the opinion of the Office of origin should not, as some delegations have expressed, bind the Offices of designated Contracting Parties because the latter should be able to determine the scope of protection for which the international registration would have effect in their corresponding territories. The Secretariat, recalling that some delegations had expressed the view that the International Bureau should determine whether a limitation was within the scope of the main list, stated that there was no legal basis in the Common Regulations supporting such view and, moreover, there was no consensus as to whether this should be the case. The Secretariat recalled that, without consensus, the Common Regulations could not be changed. The Secretariat further recalled that the Common Regulations entrusted the International Bureau with the control of the international application and that such function was developed in Rules 11 to 13 of the Common Regulations; of those provisions, Rules 12 and 13 dealt, respectively, with irregularities concerning the classification and the indications of goods and services. The Secretariat said that Rule 12(1)(a) stated the International Bureau should verify the compliance with the requirements under Rule 9(4)(a)(xiii); yet, the provision referred only to classification. As a result of previous discussions, the Working Group, at its thirteenth session, recommended changes to Rules 12 and 25 to 27 of the Common Regulations, which were adopted by the Madrid Union Assembly and entered into force on July 1, 2017. Those changes, which were also explained further in Information Notice No. 11/2017, clarified the examination to be undertaken by the International Bureau concerning limitations presented in international applications and those requested as the recording of a change to the international registration. For international applications containing limitations, new paragraph (8bis) in Rule 12, clarified that the International Bureau should also control the classification of limitations in international applications. Thus, while that rule concerned the classification, it was still up to the Offices of the designated Contracting Parties to determine whether the limitation was within the scope of the main list. The Secretariat informed that the amendments to Rules 25 to 27 of the Common Regulations, which concerned limitations recorded as a change, required the holder to group the limited list of goods and services in the corresponding classes that appeared in the main list of the international registration. The International Bureau would examine the request to determine whether the class numbers indicated in the request corresponded those in the international registration and the Office of the designated Contracting Party where the limitation was to have effect would then be free to determine whether the limitation was within the scope of the main list. The Secretariat noted that, while Article 3ter(2) of the Protocol allowed for designations subsequently to the international registration, it did not mandate the International Bureau to exercise control over the classification of goods and services and it simply required the International Bureau to record the territorial extensions, notify the Offices concerned and publish it whenever a subsequent designation complied with the applicable requirements. The Secretariat recalled that, in October 2016, the Madrid Union Assembly, at its fiftieth (29<sup>th</sup> extraordinary) session<sup>1</sup>, suspended the entry into force of a previously adopted

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<sup>1</sup> See document MM/A/50/4 "Proposed Amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement".

amendment to Rule (24)(5)(a) and (d), which would have required the International Bureau to control, on its own initiative, the classification of indications listed in limited subsequent designations. The reason for the suspension was that such control would have gone beyond both what was then provided for in the legal framework and the mandate of the International Bureau, and that such implementation, if possible, would have entailed significant practical implications for the International Bureau, Offices and users of the Madrid System. The Secretariat further recalled that, in the previous session of the Working Group, the International Bureau had proposed an amendment to Rule 24, that was not approved, which would have dealt with designations containing limitations using newly revised Rule 25 as a model, meaning that the International Bureau would only check the classes listed in the limitation to make sure they corresponded to the classes listed in the main list and that it would still be left for the Offices of the designated Contracting Parties to determine whether such limitation would have effect or not. The Secretariat added that, from the views expressed by delegations during the session, it seemed clear that Contracting Parties considered that, when designated, their Offices should determine whether a limitation would have effect in their territory and, accordingly, those Offices should also determine whether a limited list could be considered to be within the main list of that international registration.

173. The Chair said it was clear the Working Group remained divided on who should be responsible for determining the scope of limitations and whether a given limitation was covered by the main list of the international registration and concluded that discussions on the role of the International Bureau had been exhausted without reaching consensus. The Chair noted that there were some suggestions concerning an amendment to Rule 17, made by the Delegations of New Zealand, Australia and Sweden, giving designated Contracting Parties the legal basis to refuse the effects of a limitation. The Chair also noted the comments made by the Delegation of Switzerland concerning a possible amendment to Rule 9, regarding the role of the Office of origin when certifying an international application. Accordingly, the Chair suggested that the Working Group considered whether to continue discussions on possible amendments to Rules 9 and 17, in a future session, which could help Offices, when examining limitations, and, possibly, clarify the role of the Office of origin, when certifying the international application. The Chair opened the floor for comments on that suggestion.

174. The Delegation of Switzerland expressed surprise at the Chair's summary because it considered that discussions on the role of the International Bureau had not been exhausted and noted that the International Bureau was the only common contact point for all limitations. The Delegation recalled that, in all cases, limitations went through the International Bureau, and wondered whether its role in examining limitations had been excluded. The Delegation further recalled that it had made a proposal on a possible role of the International Bureau in the examination of limitations, which would be similar to Rule 13, and underscored the importance of having an alternative which spared efforts on both sides. The Delegation stated that, as far as it was concerned, the question of the role of the International Bureau remained open, adding that it would like the matter to be discussed in the future.

175. The Chair reiterated that there was no consensus on the role of the International Bureau and noted no other delegations had wished to continue that discussion. The Chair said it was clear the issue had gained no traction in with the Working Group, recalled there were still a number of other issues in the Road Map which were to be discussed in the mid-term and suggested there would be some benefit in parking the issue of limitations to revisit it sometime in the future. The Chair noted that there was also no support for amending Rules 9 or 17.

176. The Delegation of Germany said it also believed that there was no consensus on the roles of the Office of the origin, the designated Office or the International Bureau in the examination of limitations and that such had been the position at the start of the discussions. The Delegation said it understood the International Bureau did not want, or was not able, to examine limitations, which had to be accepted because it seemed to be the strict opinion of the International Bureau. In terms of the suggestion to discuss amendments to Rule 17, the Delegation said that, while Germany already had a legal basis, the Delegation agreed to move forward with that proposal if other countries required such legal basis. The Delegation



highlighted the fact that no consensus had been reached on the view that the International Bureau should not examine limitations, but that it was rather clear that the International Bureau did not want or was not able to do it.

177. The Chair stated that the main issue was the lack of legal basis for the International Bureau to examine a limitation; thus, unless there was a consensus on changing the Common Regulations to allow the International Bureau to perform such examination, the International Bureau could not do so. The Chair added that the Working Group had not reached a consensus for such change and underscored that, while some delegations wanted to see an expanded role for the International Bureau, a number of delegations did not see a role for the International Bureau in the examination of limitations. The Chair concluded that the only way forward was to consider the proposals to amend Rules 9 and 17, because those proposals did not involve the International Bureau. The Chair further recalled that nothing prevented Contracting Parties from changing their legislation because the Madrid System legal framework did not prevent Offices of designated Contracting Parties from examining limitations. The Chair opened the floor for comments.

178. The Delegation of Switzerland acknowledged that the question of limitations was complex and recalled that there were three types of limitations, in the international application, in a subsequent designation and under Rule 25. The Delegation explained that the role of the International Bureau in those three cases was different and, as such, the Delegation said it did not consider there was consensus on the role of the International Bureau because that role depended on the type of limitation. The Delegation stated that the role of the International Bureau was less active than the role of the Office of origin when the limitation was made in an international application; however, there could be a role for the International Bureau in limitations filed with the International Bureau. The Delegation concluded that clarification on the role of the International Bureau in respect of the three types of limitations was needed before consensus could be reached.

179. The Representative of INTA expressed his support for the intervention of the Delegation of Switzerland and stated that he did not believe the Madrid System could be dealt with without discussions on the role of the International Bureau. The Representative noted that things had been taken for granted during the 130 years of existence of the Madrid System, and that it was understood that, when a limitation was recorded in the International Register, the International Bureau, as the central authority of the Madrid System, had checked such limitation and that such had indeed been the case for 100 or more years. The Representative of INTA acknowledged that the adoption of the Protocol and the expansion of the Madrid System had led to changes and believed that those changes should be accommodated. The evolution of the provisions behind the role of the International Bureau and, possibly, that of the Offices of origin and of the designated Contracting Parties should be consistent with the philosophy and basic principles of the Madrid System which were that, in practical terms and where possible, duplication of work should be avoided and users should not be left in confusion not knowing who was doing what and what the implications were. The Representative added that discussions had essentially concerned the examination of limitations, as to the scope of the list of goods and services, but the Secretariat, when summarizing the position of the International Bureau before the Working Group, had raised the issue of the role of the International Bureau in the control of the classification. He recalled that INTA's position had always been very firm in that the International Bureau, as the guardian of the *International Classification of Goods and Services for the Purposes of the Registration of Marks* (Nice Classification), should effectively control the classification of goods and services in limitations. The Representative stated that, for users, the lack of harmonization in classification practices among trademark Offices around the world was a constant source of difficulty; that the Madrid System offered the essential authority with the final word on the classification of goods and services in international registrations; and, that such responsibility of the International Bureau had to be maintained in the interest of a smooth operation of the international registration system. The Representative said that there should be future discussions on the role the International Bureau should but, at that time, did not play in the examination of the classification goods and services in limitations.

180. The Delegation of Poland expressed its support for the statement made by the Delegation of Switzerland and stated that, while the questionnaire was about the current practice of the Offices, it was not clear what the expected practice of the International Bureau should be. The Delegation suggested an additional questionnaire concerning the expected role of the International Bureau regarding the examination of limitations in all three situations.

181. The Delegation of France, agreeing with the Delegations of Switzerland and Poland, stated that the lack of a consensus reflected doubts and uncertainties concerning the role of the International Bureau and, as such uncertainty was not in the interest of users, it would be desirable to clarify the role of the International Bureau in the examination of limitations. Accordingly, the Delegation concluded that sending out a questionnaire on the expected role of the International Bureau, as proposed by the Delegation of Poland, seemed to be a good solution. The Delegation said that, while it had taken note of the views of the International Bureau on the various roles regarding limitations, did not entirely share those views, in particular, regarding the role of the designated Offices. The Delegation reiterated that the lack of consensus was due to lack of clarity.

182. The Delegation of Turkey proposed that the examination of limitations in international applications be made by the Office of origin, but examination of requests for the recording of limitations as a change made by the International Bureau. The Delegation noted that consensus remained a problem, but considered it would be important for users that the roles of the Offices and of the International Bureau be clarified.

183. The Delegation of New Zealand stated that there had been plenty of discussions about the role of the International Bureau and that, from its interpretation of the Protocol, the International Bureau was in charge of the classification of goods and services but not, as the Secretariat had indicated, of determining the scope of what would be acceptable in those classes. While the International Bureau provided indications on what could be considered too vague for classification purposes, at no point stated that a term was either too broad or not within scope. The Delegation considered that such a role should be conducted by the designated Contracting Parties and noted with interest, from the questionnaire, that user groups filed limitations purely to either avoid or overcome provisional refusals raised in the designated Contracting Parties. Therefore, the Delegation said, it seemed incongruous to state that such a decision should be made by the International Bureau when the purpose of filing the limitation was to get around an issue raised at the domestic level. The Delegation reiterated its view that examination of limitations should fall within the role of the designated Contracting Parties, as they were the ones receiving all kinds of limitations in all instances and had the best knowledge of their own internal legislation, case law and practices to determine whether the scope of the limitation was correct at the domestic level.

184. The Delegation of the Czech Republic, while supporting the position expressed by Switzerland and France, referred to question 11 of the questionnaire and explained that, in terms of its national register, the Office examined all limitations but, in terms of the international registration, its users expected limitations to be examined and verified by WIPO. The Delegation stated it would be confusing for users to first receive an irregularity notification from WIPO concerning the classification, which was then addressed and corrected, to then receive a further notification from a designated Contracting Party concerning an irregularity in the scope of the limitation. The Delegation said that users would believe that, because WIPO had examined and corrected the classification, the limitation had been determined to be correct and, therefore, a refusal from one or more of the designated Contracting Parties would come as a shock and create confusion.

185. The Delegation of Mexico expressed its support for the views shared by the Delegation of New Zealand. The Delegation recalled that limitations could affect whether a mark would be registered and, moreover, could be requested to overcome a refusal based on grounds or on the existence of a prior trademark. The Delegation stated that a substantive examination of a limitation could actually have a profound impact on the determination of whether to register the mark.

186. The Representative of MARQUES, referring to the Road Map, recalled that there would be a discussion on classification principles and reducing inconsistencies in classification practices at the Roundtable and wondered whether those discussions could help the Working Group come to a better answer on limitations. The Representative expressed her agreement with the comments made by the Delegation of Mexico and stated that, where the limitation was made to overcome a problem at the national level, it was obvious and made sense that the Office concerned should examine that limitation, because it was the only relevant Office to do so. However, the Representative of MARQUES said it would be helpful to hear more about what delegations were looking for to understand what the goal of further discussion should be.

187. The Representative of AROPI expressed his support for the statement made by the Representative of INTA.

188. The Delegation of Australia expressed its support for the comments made by the Delegations of New Zealand and Mexico, in particular, regarding the fact that, as the survey indicated, the large majority of limitations sought to avoid problems in designated Contracting Parties; therefore, the Delegation stated examination should occur in the designated Contracting Parties.

189. The Chair noted that there was still no consensus regarding the role of the International Bureau on limitations made in the international application, in a subsequent designation or as a request for the recording of a change. The Chair, while acknowledging that there had been some proposals for a questionnaire on what the role of the International Bureau should be, said he was not convinced such questionnaire would necessarily shed any more light on the issue because the views of delegations on the role of the International Bureau was clear. The Chair, suggested that, in addition to the proposals concerning amendments to Rule 9 and Rule 17, delegations that wanted to make any proposals on the role of the International Bureau should put those proposals forward for discussion at the next session of the Working Group. The Chair, however, concluded that it was clear there was no consensus on the role of the International Bureau and opened the floor for comments on the way forward.

190. The Delegation of Switzerland questioned the conclusions drawn by the Chair.

191. The Chair reiterated that an invitation was open to all delegations to submit proposals for the following session of the Working Group on possible amendments to Rules 9 and 17, as well as on the expected role of the International Bureau. The Chair said there were other issues on the Road Map which may be of more interest or on which achieving consensus could be more likely.

192. The Chair noted that no further action was to be taken on this topic at the present session and recalled that, in accordance with WIPO's General Rules of Procedure, proposals for future work on this item could be submitted by delegations not later than one month before the date fixed for the opening of the next session, requesting their inclusion as a supplementary item on the draft agenda.

## **AGENDA ITEM 8: PROPOSED REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

193. Discussions were based on document MM/LD/WG/16/6 Rev. 2.

194. The Secretariat informed that the Madrid Protocol had been the sole treaty governing international applications and registrations under the Madrid System since October 2015, making the Madrid Agreement a treaty no longer in operation and recalled that such situation had been consolidated, in October 2016, with a decision by the Madrid Union Assembly to freeze the application of Article 14(1) and (2)(a) of the Madrid Agreement. The Secretariat said that, to reflect that fact, the International Bureau was proposing specific editorial changes to the Common Regulations and explained that work started with the deletion of references to

the Madrid Agreement but that it then became clear other specific provisions needed to be clarified by either deleting unnecessary references to the Madrid Protocol or, in some cases, inserting references to the Madrid Protocol. The Secretariat also proposed to delete provisions that no longer applied, as well as references to submitting forms in one copy. The Secretariat highlighted that the International Bureau wanted to take that opportunity to introduce inclusive language, where possible, and that, while the proposed amendments would result in a fully language inclusive English version of the Common Regulations, further work would be required to achieve the same objective in the French and Spanish versions. The Secretariat said the document also suggested amending the title to Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registrations or Marks (hereinafter referred to as “the Regulations”); that the proposed changes were set out in Annexes I and II to document MM/LD/WG/16/6 Rev. 2; and, underscored that, while there were a number of changes proposed, those were of editorial character and not substantial. The Secretariat clarified that the version of the Common Regulations in which the proposed changes had been indicated in track change mode, corresponded to the version that would enter in force on February 1, 2019, and included recently adopted provisions on division and merger of international registrations. The Secretariat stated that, should the proposed changes be first recommended by the Working Group and then adopted by the Madrid Union Assembly, the Director General of WIPO would consult the Offices or Contracting Parties, in line with the procedures set out in Rule 41 of the Common Regulations, for consequential amendments to the Administrative Instructions.

195. By way of background, the Secretariat referred inclusive language initiatives at the United Nations and WIPO and described the steps WIPO was taking to adopt inclusive language in all its communications. In order to provide the Working Group with some further insights on the possible use of inclusive language, the Secretariat provided some examples of ways in which the Common Regulations could be made language inclusive and informed that the inclusive language initiative covered, at that moment, the English, French and Spanish languages but that it would cover other languages in the future.

196. The Chair clarified that the English version of the proposed Regulations was already language inclusive and that the Working Group was to consider possible future amendments to make the French and Spanish versions also language inclusive. The Chair opened the floor for comments.

197. The Representative of CEIPI asked whether the French and Spanish versions of the proposed Regulations which had been annexed to document MM/LD/WG/16/6 Rev. 2 would be first submitted to the Madrid Union Assembly for their adoption and then revised, depending upon the proposals for adopting inclusive language principles.

198. The Chair said that the annexes to the document reflected the changes proposed in terms of, for example, deleting references to the Madrid Agreement and that all three linguistic versions of the proposed Regulations contained in those annexes would be submitted to the Madrid Union Assembly. The Chair further clarified that only the English version included some amendments to adopt inclusive language, but that the French and Spanish versions did not yet include any amendments to adopt inclusive language.

199. The Chair opened the floor for discussions on document MM/LD/WG/16/6 Rev 2.

200. The Delegation of Germany asked when the French version of the proposed Regulations using inclusive language would be available because the French version would be easier to translate into German than the English version, due to similarities in the French and German languages.

201. The Delegation of Australia said that, in principle, it supported all the proposals, which it believed would aid the ongoing process of making the Madrid System more streamlined and user-friendly. The Delegation commented that Australian legislation included references to the Common Regulations and it would need to make amendments to its national legislation to accommodate the proposed change in title. The Delegation questioned whether other Contracting Parties might be in a similar situation of having to change their legislation.
202. The Delegation of New Zealand said that New Zealand was in a very similar position as Australia because its national regulations referred to the Common Regulations. On inclusive language, the Delegation expressed its agreement with amending the Regulations, as such would be aligned with the way in which laws in New Zealand were being drafted at that time.
203. The Delegation of Germany stated that Germany would also need to change its law.
204. The Delegation of Cuba requested clarification as to whether the English version only of the proposed Regulations was being discussed at that time.
205. The Chair explained that the annexes to the document contained proposals in all three languages, English, French, and Spanish and that the only difference between the English version and the French and Spanish versions was that the English version included proposals to adopt inclusive language. The Chair added that the French and Spanish versions did not yet include such proposal because it would be a bit more complicated to achieve a language inclusive version in those languages and as such that would take time.
206. The Delegation of Cuba sought further clarification on what was being discussed.
207. The Chair invited the Secretariat to take the floor.
208. The Secretariat explained that the annexes to the document proposed English, French, and Spanish versions of the proposed Regulations which corresponded to each other and were absolutely identical. The Secretariat explained that, due to the very nature of the English language, the only difference was that the English version of the proposed regulations already adopted inclusive language. The Secretariat added that what the Working Group was then being asked to analyze were the proposed changes to eliminate references to the Agreement and to simplify the Common Regulations in English, French, and Spanish. The Secretariat stated that, discussions on whether there could also be a French and Spanish version of the Regulations adopting inclusive language would need to take place in the Working Group, among all the delegations concerned, sometime in the future.
209. The Delegation of Cuba further noted its concerns with the adoption of inclusive language.
210. The Secretariat reassured the Delegation of Cuba that any changes to the Spanish or French versions adopting inclusive language would be the subject of consultations with the Offices of the Contracting Parties concerned and duly discussed, in advance, before any proposals were submitted to the Working Group.
211. The Representative of CEIPI said he had submitted some suggestions to the Secretariat concerning editorial issues, formatting or layout matters and suggestions concerning slight changes to the text. The Representative said he did not believe the suggestions concerning editorial issues and formatting matters needed to be discussed but believed the proposed slight changes to the text should be brought to the attention of the Working Group for its approval.
212. The Chair invited the Representative of CEIPI to take the floor and present his suggestions.

213. The Representative of CEIPI referred to:

- (i) page 3, Annex I, Rule 1(iii) and to the definition of Contracting Party which read “Contracting Party, means any country party to the Protocol or to the Agreement and the Protocol or any State or Intergovernmental Organization party to the Protocol” and suggested simplifying that definition to take into consideration that the Agreement was obsolete, adding that the suggestion applied to all languages;
- (ii) Rule 9(5)(b) and its title and suggested that the word “an” in the phrase “an international application” be replaced with the word “the” to read “the international application” and suggested a similar amendment to the same wording in Rule 10(2);
- (iii) Rule 15(1)(i) of the French version and suggested that the reference to “his” be replaced with a reference to the applicant or the representative, to adopt more inclusive language;
- (iv) the title of Rule 18(1) and noted that it was strange to see “Designated Contracting Party” standing alone and suggested using the word “General” instead, adding that the suggestion applied to all languages;
- (v) the title of Rule 18(2) and suggested it should refer to Article 5(2)(c), without a reference to item (ii), adding that the suggestion applied to all languages;
- (vi) Rule 20*bis*(6)(b) of the French version only and noted that, in the second line, there was the expression “*avant la date à laquelle cette règle entre en vigueur*” and explain that in the Common Regulations, in general, as well as in the treaties, the French version would state “*la présente règle*” and not “*cette règle*” which would be ambiguous;
- (vii) the title of Rule 23*bis*(1), in all versions, and noted that it was the communications that were not covered by the Regulations, not the Offices of the Contracting Parties and suggested slightly modifying the wording to avoid that ambiguity;
- (viii) Rule 25(2)(v) of the French version and suggested some grammatical changes;
- (ix) Rule 32(3) and, noting that the title of that paragraph was missing, suggested adding the title “Publications on the Website”;
- (x) Rule 40(6) of the French version only, and suggested that, in the first line, “this Rule” be replaced with “the present Rule”;
- (xi) Page 1 of Annex II, the Schedule of Fees, and indicated that item 2, “International applications”, was in the plural and should be in the singular;
- (xii) Annex II, the Schedule of Fees, and noted that there were a number of references to several Articles without mentioning they referred to Articles of the Protocol.

214. The Chair opened the floor for comments on the suggestions made by the Representative of CEIPI.

215. The Representative of INTA said that he also had a couple of remarks or questions for the Secretariat on some of the changes that had been introduced.

216. The Chair invited the Representative of INTA to take the floor and introduce his remarks and questions.

217. The Representative of INTA:

(i) Referred to Rule 3(3)(b), in the English version, and expressed concern over replacing the word “himself” with the word “only” because this word may be somewhat confusing when read out of context, as it meant that all communications sent by the International Bureau would be sent only to the applicant but not to any other party, in particular, not to an Office. The Representative suggested deleting the word “himself” and replacing it by the phrase “send all relevant communications to the applicant or holder only but not to the purported representative” and added that using “the purported representative” would be consistent with the language found in the preceding subparagraph.

(ii) Said he shared the concerns expressed by the Representative of CEIPI concerning the title of Rule 18(1) and suggested replacing the words “Designated Contracting Party” with “All Notifications of Provisional Refusal”, as it would balance the title of paragraph 2, which was “Notification of Provisional Refusal made under Article 5(2)(c)” but added that any title, other than “Designated Contracting Party”, would be suitable.

(iii) Questioned the proposal to delete the words “the request for presentation to the International Bureau of which was received [...]” from Rule 40(2)(a)(i) because keeping that phrase was important as, at the time the request was received by the Office of origin, that request was not yet an international application. The Representative explained that the request became an international application when it was certified by the Office of origin and the signature of the Office of origin was affixed to the request and that such was the reason why similar language was also found in Rule 40(4)(b). The Representative added that, should there be no imperative reason for deleting those words, they should remain.

(iv) Noted that the words “or was deemed to have been received under Rule 11(1)(a) or (c)” have been maintained in Rule 40(2)(a)(1)(i) and questioned whether that was to be on the safe side or because the International Bureau was aware that there may still be premature requests under Rule 11(1) of the Common Regulations, which would be a request that had been presented to the Office of a Contracting Party bound by the Agreement only and which transmission was deferred to the International Bureau until that Contracting Party became also bound by the Madrid Protocol. The Secretariat added that, should there be no evidence that this could still be the case, the phrase could be deleted.

(v) Suggested not deleting the words “to be in order for the purposes of” from Rule 40(2)(a)(ii) because, if there was no imperative reason to do so, that was the language used in Rule 27(1) of the Common Regulations, and such language was correct.

218. The Chair thanked both the Representatives of CEIPI and INTA and noted that the suggestions made, while relatively minor, were large in number. The Chair opened the floor for comments on those suggestions.

219. The Representative of CEIPI noted that it had given some further thought to the gender inclusive language initiative and wanted to draw the attention of the Secretariat to the potential pitfalls of that exercise. The Representative referred to some examples in which changing certain provisions in one language would require changing certain definitions provided for in the Regulations, which would affect all linguistic versions. The Representative said that there could be other similar cases and stated that great care was needed in that respect. The Representative of CEIPI said that it was also important to consider the treaties themselves, which were the most important texts, and recalled that WIPO administered some 25 or 26 treaties and that all of them would have to be revised to adopt inclusive language in accordance with the United Nations initiative, which was probably unthinkable in the short or medium term. The Representative provided several examples in the French version of the Common Regulations in which either masculine or feminine nouns had been properly been used and wondered whether other solutions, not necessarily aligned with the United Nations

inclusive language initiative, could be explored, such as, for example, using only feminine nouns, as it had been done in some countries. The Representative of CEIPI concluded that introducing inclusive language in all linguistic versions of the Regulations would be a very delicate exercise and that it would certainly take a long time to do correctly.

220. The Representative of INTA said that he shared the concerns expressed by the Representative of CEIPI and suggested not approving the amendments in the English version of proposed regulations that had to do with inclusive language until inclusive language had also been adopted in the other two linguistic versions. The Representative of INTA acknowledged that such could take some time but said the matter should be considered when the International Bureau had completed the exercise in respect of the three linguistic versions.

221. The Delegation of Cuba said it had some concerns with the adoption of inclusive language, along with those previously expressed. The Delegation, while agreeing with the adoption of inclusive language, stated that the Cuban regulations were based on the Common Regulations and any change in the language used in the Common Regulations may have repercussions on those regulations. The Delegation added that, even if there was consensus on introducing inclusive language in the proposed Regulations, the Delegation did not have the mandate to approve such changes. The Delegation reiterated that it agreed with the adoption of inclusive language but it shared the concerns expressed by the Representative of CEIPI regarding time constraints and the possible impact.

222. The Chair invited the Secretariat to respond to the concerns raised by the Representatives of the observer organizations and by the Delegation of Cuba.

223. The Secretariat clarified that the French and Spanish version of proposed Regulations that had been submitted for the consideration of the Working Group corresponded exactly to the text of the Common Regulations that was in force at the time and that no language inclusive amendments had been made to those versions. The Secretariat said that it understood the concerns raised and reiterated that any future attempt to adopt inclusive language in the French and Spanish versions of the Regulations would be consulted, ahead of time, with the delegations and Offices that had any interest in those linguistic versions, before presenting them for the consideration of the Working Group. The Secretariat reiterated that the proposed Regulations presented in that session of the Working Group corresponded entirely to the version of the Common Regulations in force at that time and that the only modifications that had been introduced sought to simplify the Regulations by, among others, removing references to the Agreement.

224. The Delegation of Cuba stated that it was clear the French and Spanish versions of the proposed Regulations under discussion had not yet adopted inclusive language but, along the same views expressed by the Representative of CEIPI, the possible future adoption of inclusive language in those linguistic versions remained a concern.

225. The Chair recalled that comments had been made on the need to amend domestic legislation to reflect the proposed new title of the Regulations and opened the floor for comments on how much time members would need to make those changes.

226. The Delegation of Australia said that it was not in a position to give an exact timeframe at that point but stated that, while Australia would not be able to start its domestic process until after the following session of the Madrid Union Assembly, the Delegation did not expect such would be a problem.

227. The Chair suggested February 1, 2020, as the date of entry into force and opened the floor for comments on that suggestion.

228. The Delegation of the Republic of Moldova said that, as the Delegation of Australia, it did not have an exact timeframe but that February 1, 2020, was acceptable.



229. The Chair noted that there were no objections to the proposed changes entering into force on February 1, 2020, and invited delegations and observers to consider the suggested revisions to the documents and provide comments.

230. The Chair informed that the Secretariat had taken into account the comments received and had revised the documents.

231. The Working Group recommended to the Madrid Union Assembly the adoption of the proposed Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as amended by the Working Group and as set out in Annex I and Annex II to the present document, with February 1, 2020, as the date for entry into force.

#### **AGENDA ITEMS 9 AND 10: PROPOSAL BY THE DELEGATION OF CHINA AND PROPOSAL BY THE DELEGATION OF THE RUSSIAN FEDERATION**

232. Discussions were based on documents MM/LD/WG/16/7 and MM/LD/WG/16/9 Rev.

233. The Chair invited the Delegation of China to introduce document MM/LD/WG/16/7.

234. The Delegation of China informed that Chinese was one of the six official languages of the United Nations and one of the working languages at WIPO. The Chinese Government had always maintained that the Chinese language should be used in all WIPO mechanisms, including the Madrid System. China believed that the implementation of that language policy would enable China to play a greater role in the development of WIPO. Introducing Chinese as a working language of Madrid System could help further develop the Madrid System in China. As the world's second largest economy, China had aggregated numerous markets to its own market and, with the implementation of the Belt and Road Initiative, China's economic links with other countries had become even closer. The Delegation stated that China was the world's largest trader of goods, the second largest trader in services, the second largest foreign direct investment recipient and third largest foreign direct investor. When reviewing that process, it was evident that marks came to China and Chinese marks went abroad. Therefore, China was also one of the countries that had had the fastest development and still had the biggest potential in the Madrid System. The Delegation noted that, in recent years, the number of applications from China in the Madrid System had kept rising and reached 4,810 in 2017, which represented an increase of 59.6 per cent compared to the previous year. From January to May 2018, 2,228 applications had been filed. However, China's applications for international registrations of marks filed through the Madrid System only accounted for 10 per cent of the total of applications filed by Chinese residents abroad, far behind the average 63 per cent of the Madrid System members. That fact demonstrated that the Madrid System had prospects in China. The introduction of Chinese as a working language in the Madrid System was a general aspiration of the Chinese users. The Delegation believed it would make the Madrid System more attractive for Chinese users and thus, lead to more applications. In its efforts to expand the Madrid System in China, the Delegation had learned that the language barrier had prevented, to a large extent, many trademark holders from choosing the Madrid System. The Madrid System would be more convenient if Chinese were used in filing applications and in the other related steps. The Delegation noted that China was also promoting the digitization of applications filed through the Madrid System. On June 21, 2018, China's online Madrid System filing solution started operation and effected electronic communication with the International Bureau. By June 28, 2018, one week after entering into operation, that solution had already received 144 electronic filings, thus facilitating use of the Madrid System. That demonstrated the attractiveness of the Madrid System in China. For Madrid System applicants designating China, Chinese as a working language of the Madrid System would reduce linguistic misunderstandings and complexity and could shorten the time for international registration. In view of that, the Delegation appealed to all members to give positive consideration to the proposal made by the Delegation of China and support for the introduction of Chinese as a working language of the Madrid System and request the Working Group to submit its proposal to the Assembly of the Madrid Union.

235. The Chair invited the Delegation of the Russian Federation to introduce document MM/LD/WG/16/9 Rev.

236. The Delegation of the Russian Federation stated that it would like to count upon Russian as an official language of the Madrid System. Russian was one of the official languages of the United Nations and its specialized institutions. There were more than 250 million Russian speakers making Russian one of the 10 most spoken languages in the world. Russian was a national language in a number of countries. The Russian diaspora had made a major contribution to the development of science and culture throughout the world. Thus, on the Internet, Russian was increasingly used, particularly, for distance learning. That made it possible for Russian to contribute to innovation and creativity throughout the world. The Delegation highlighted that the Russian Federation was one of the five WIPO members that was most often designated in international applications within the Madrid System. Within the previous three years, the Delegation had observed there had been an ongoing increase in the number of requests for registration. In the previous year, that increase had been 30 per cent. Automatic translation was increasingly being used at WIPO and the Russian version of the Madrid Goods and Services Manager was often used when drafting the list of goods and services; those two elements would make it possible to reduce the cost of translation. Implementing the initiative would make it possible to increase and improve the number of applications for registration in Russian. Linguistic representativeness in the Madrid System meant that it would be possible to have a larger number of applications for registration, not just from the Russian Federation but from other members in the region. Consequently, the Delegation said it would be advisable to include that item on the agenda of the Madrid Union Assembly.

237. The Chair opened the floor for comments.

238. The Delegation from Uzbekistan, speaking on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC), informed that the CACEEC Group had nine countries, all of which were members of the Madrid System. Russian language was a State language in the Russian Federation and Belarus and an official language in Kazakhstan and the Kyrgyz Republic. The Russian language was widespread and used as a means of communication in all of the Eurasian space, including in the areas of technology and industry, and, moreover, Russian was the language of international relations in Tajikistan. Statistical data existed with regard to the growth in use of the Madrid System in the countries of the region. In a number of those countries, the number of international applications had increased. The Delegation said it believed that the potential for growth of the Madrid System was not yet fully achieved and that the use of the Russian language, as one of the official languages, would certainly help to maintain the positive growth in international registrations in members of its Group. The Delegation stated that achieving that goal would increase the effectiveness of the work of Russian language examiners and also save time necessary for working on applications coming in from those countries. The CACEEC Group hoped that the Working Group would recommend to the Assembly of the Madrid Union the proposal made by the Delegation of the Russian Federation in document MM/LD/WG/16/9 Rev. The Delegation added, in its national capacity, that Uzbekistan also supported the proposal made by the Delegation of the Russian Federation to include Russian as an official language of the Madrid System.

239. The Delegation of the European Union said that it remained open to exploring possible measures to make the Madrid System even more attractive by taking into consideration the introduction of additional languages. The Delegation stated that such significant step should be performed after an in-depth examination and evaluation of all its possible implications. The Delegation, therefore, requested the International Bureau to build upon the information already provided in the documents under consideration and to perform an in-depth study on the practical and financial implications of introducing additional languages to the Madrid System.

240. The Delegation of Belarus expressed its support for the proposal made by the Delegation of the Russian Federation and its hope that the work undertaken in this regard would improve and make the Madrid System more attractive for users. The Delegation stated that Russian, along with Belarusian, was one of the two official languages of the Republic of Belarus and was the official working language for the registration of trademarks at the Office of Belarus. The Delegation noted that some 80 per cent of all of the trademarks filed with the Office of Belarus originated in the Russian Federation, Kazakhstan and Ukraine, and that in two of those countries, Russian was the official language while in the third it was very widely used. The Delegation stated that such fact demonstrated there was great interest among Belarusian users of trademarks in other Russian-speaking countries and noted that the Madrid System was not used very intensively by Belarusian users, with only around 4 per cent of national trademarks becoming the basis for international applications. The Delegation said that it believed the lack of Russian as a working language within the Madrid System was one of the limiting factors for broader use of the Madrid System by Belarusian users and that the situation could not remain as it was. The Delegation added that the Belarus Office felt that using Russian language would help to save time in the examination of international applications within Belarus and requested that the Working Group supported the proposal put forward by the Russian Federation. The Delegation also expressed its support for the proposal made by Delegation of China given the significant use of the system and its potential for growth in the Chinese market.

241. The Delegation of Iran (Islamic Republic of) stated that Russian was one of the official languages of the United Nations, and believed its inclusion as a working language of the Madrid System would assist in the geographical expansion as well as in a more appropriate functioning of the Madrid System. The Delegation also underlined the importance of the Madrid System as one of the main WIPO-administered Unions. The Delegation believed that the proposal would lead to further growth in international applications and subsequently improve the financial sustainability of the Madrid System.

242. The Delegation of Armenia noted that, while Armenian was the only State language in Armenia, more than 90 per cent of its population spoke and could read and write in Russian. The Delegation added that bringing Russian into the Madrid System would make it easier for the Armenian Office to send applications and receive responses in Russian. The Delegation explained that Armenia received very few international applications and, for that reason, it supported the proposal made by Delegation of the Russian Federation.

243. The Delegation of the Syrian Arab Republic expressed its support for the proposal made by the Delegation of the Russian Federation. The Delegation said that the Madrid System was underused and believed that the addition of that language would help to increase the rate of international registrations filed in the Russian Federation as well as those filed in Asia, Caucasus and Eastern Europe. The Delegation considered that such proposal would guarantee the rights of applicants and facilitate their access to the Madrid System, as well as enhance the efficiency of examiners in Russian, reducing the time span required to examine requests regarding that region.

244. The Delegation of Italy expressed its strong agreement with the position expressed by the Delegation of the European Union. The Delegation considered the proposals from the Delegations of China and the Russian Federation interesting and noted that the additional languages could have some positive impact. However, the Delegation said it had some concerns regarding the financial impact on the Madrid System and the extra workload for the International Bureau resulting from working in more languages. Further, the Delegation questioned whether that would open a bridge for many other countries, including Italy, to ask whether their own language could be added as working language. On that basis, the Delegation requested more details before it could consider the matter any further.

245. The Delegation of Hungary expressed its support for the statements made by the Delegations of the European Union and Italy and added that it had concerns regarding the proposals of the Delegations of China and of the Russian Federation from a different perspective because, although there would be undoubted benefits from introducing new working languages to the Madrid System, the Delegation feared that such introduction could also increase the basic application fee of an international application. An increased basic application fee would negatively affect the number of the Hungarian applications, which was not aligned with the Hungarian interest. Therefore, the Delegation could not support the proposals.

246. The Delegation of Denmark expressed its support for the statement made by the Delegation of the European Union and also expressed some concerns in respect of the effect of the proposals. In particular, the Delegation said it was concerned that the addition of new working languages could have a negative effect on the Madrid System in terms of higher costs of, amongst others, translation, and make the system less simple. For that reason, the Delegation advised caution and requested more information on the impact of those proposals, but stressed that it remained open to further discussions regarding the possible effects of adding further working languages.

247. The Delegation of Japan expressed its support for the statements made by the Delegations of the European Union, Italy, Hungary, Denmark and other delegations and considered that the working languages of the Madrid System was a very important issue that formed the fundamental basis of the system. Therefore, any change to the working languages might have a significant impact, not only on the International Bureau but also on all those involved in the Madrid System, including users and Offices. The Delegation recognized that translation was unavoidable and, though the International Bureau did its best, mistranslation could cause problems in Offices of designated Contracting Parties which may need to re-examine, delaying the protection of the mark in that Contracting Party. Also, due to additional working languages, the cost of the Madrid System itself could rise and users might not feel the cost-benefits of the system. The Delegation expressed concerns that such negative impact might damage the user-friendliness of the Madrid System and that, eventually, users might not choose the Madrid System. The working languages of the Madrid System were an issue for users and Contracting Parties where the official language was not one of the working languages and, as such, Japanese users also faced that issue. For that reason, the Delegation felt that the best possible solution to widen the use of the Madrid System would not to add working languages, which might have a significant impact on the system, but, instead, it might be more beneficial to consider possible measures to enhance the user-friendliness for users in countries not using working languages. One idea might be to, for example, display the headings of WIPO's online services, such as Madrid Monitor and Madrid Portfolio Manager, in more languages. The Delegation believed that providing such user-friendly services would reduce some of the language difficulties that users faced. The Delegation advised on the need for further careful discussions on the advantages and disadvantages of the proposals before considering any additional working languages.

248. The Delegation of Georgia fully aligned itself with the comments made by the Delegations of Italy, Hungary and Denmark. The Delegation considered that, if adopted, the proposals would unreasonably increase the administration costs of the Madrid System and prolong the examination time at the International Bureau. In addition, expansion of official languages would require amendments to the Common Regulations which could only be adopted by the Madrid Union Assembly.

249. The Delegation of China recalled that, as early as 2011, the Program and Budget Committee had decided that in WIPO, as one of the major agencies of the United Nations system, all Committees should be conducted in its six official languages. China had always been of the view that the coverage of the six official languages should also apply to all mechanisms administered by WIPO. The Delegation stated that a gradual approach could be taken for the introduction of Chinese as a working language. The Delegation confirmed that it understood that Chinese, if introduced as a working language, would increase the cost of the Madrid Union but that, with an intelligent translation system, translation cost could be limited and the introduction of Chinese as a working language would increase the attractiveness of the Madrid System. The Delegation considered that the introduction of Chinese would attract an increasing number of Chinese applicants to file international applications under the Madrid System and that the profit brought about by the introduction of Chinese as a working language would exceed the cost, which would also play a significant role in support of the Madrid System. Accordingly, the Delegation hoped that the Madrid Union Assembly would consider introducing Chinese as a working language.

250. The Delegation of the Republic of Korea generally supported the idea of introducing the official languages of the countries that filed the higher number of applications. However, the Delegation said it shared the opinions expressed by the Delegations of the European Union, Italy and Japan and that it believed the Secretariat needed to fully explain the need for additional official languages after conducting an analysis on the issue. The Delegation noted that the concerned parties and members may need more time to review the issue in more depth and hold full discussion at the following session before making a decision.

251. The Delegation of the Russian Federation said it was firmly convinced that the potential growth of the Madrid System was directly linked to broadening the availability of languages, and that such step would actually lead to the development of the Madrid System, growth of international applications and, also, more stable financial basis. The Delegation said it believed that taking any other decision would have the opposite effect and, therefore, it proposed that the issue of the inclusion of Russian and Chinese as official working languages of the Madrid System be brought forward for the consideration of the Madrid Union Assembly.

252. The Delegation of Armenia expressed its support for the proposal put forward by the Delegation of China.

253. The Delegation of Germany supported the statement made by the Delegation of the European Union and by other delegations which also supported that statement. The Delegation, referring to the views that all six official United Nations languages should become working languages, expressed by the Delegation of China, stated that it believed Arabic could, for example, also become the next working language to be introduced in the Madrid System. Such introduction could then lead to a breakthrough for other languages, such as, for example, German which was the language used by, still, the second largest group of applicants. The Delegation referred to the comments made by the Delegation of the Russian Federation which had said that the introduction of languages could give the Madrid System a more a stable financial basis, and noted the conflict between comments made concerning higher cost and statements made that the proposals would result in a better financial basis. As such, the Delegation stated that an in-depth study of all the consequences, as the Delegation of the European Union had proposed, was needed.

254. The Delegation of the Czech Republic said it shared the opinions expressed by the Delegations of the European Union, Italy, Germany and similar opinions expressed by other delegations.

255. The Representative of MARQUES said that, while she was in favor of anything that would make the system more accessible to users, she also shared the concerns expressed by some delegations and agreed with the statement made by the Delegation of the European Union. The Representative stated that the issue needed to be thoroughly examined before any decision could be made. The Representative acknowledged that it would be nice if other

languages could be introduced and was not opposed to their introduction but, rather, that a good analysis would help assess the advantages and any potential obstacles. The Representative referred to a paper and a proposal made by MARQUES concerning non-Latin script marks and said that MARQUES believed increasing the access of the system was a higher priority, when it came to the protection of marks, than dealing with the introduction of more languages. The Representative noted that trademarks in non-Latin scripts were often regarded as device marks and not even read properly and wanted to put that matter on the table again, given that the topic of languages was being discussed. The Representative said it believed that dealing with marks in non-Latin script was a more important matter for businesses than adding languages.

256. The Delegation of China clarified that it agreed with recommending that the Madrid Union Assembly consider including Russian and Chinese as working languages of the Madrid System.

257. The Chair informed that there were a number of steps that needed to take place before a new working language could be introduced into the Madrid System. The Chair further clarified that an amendment to Rule 6 of the Common Regulations would be needed in order to introduce any further working languages into the Madrid System and that, accordingly, the Working Group would first need to agree on possible amendments to Rule 6 and recommend their adoption to the Madrid Assembly Union.

258. The Delegation of Cuba reiterated its support for the proposals made by the Delegations of China and of the Russian Federation.

259. The Representative of JPAA expressed support for the comments made by the Delegations of the European Union, Italy, Japan and several other delegations. The Representative stated that, while an increase in the number of working languages may be attractive and beneficial for users whose mother tongue was one of the new languages, such increase would be unfavorable for users of Madrid System. The Representative said that an increase in translation work may delay registration, increase translation costs and manpower needs which could result in an increase in fees and in corrections due to mistranslation. The Representative of JPAA added that differences in translation may affect the scope of rights. On that basis, the Representative suggested discussions should be undertaken with care.

260. The Representative of JTA expressed concern with the addition of new working languages as it could mean increasing delays and higher costs which would have adverse effect on users. Therefore, the Representative of JTA also hoped that discussion would be undertaken with care.

261. The Representative of JIPA expressed support for the comments made by the Representatives of JPAA and JTA, as well as for the comments made by the Delegations of the European Union, Japan and the Republic of Korea. The Representative expressed his concern with increasing delays and higher costs as a result of introducing new working languages into the Madrid System and requested that all aspects be thoroughly considered.

262. The Chair considered that there were two clear positions on the proposals to introduce Chinese and Russian as new working languages of the Madrid System adding that there was either support for the proposals or requests for further information in the form of a study. The Chair, therefore, proposed an in-depth study to enable continued discussions at the following session of the Working Group. The Chair opened the floor for comments.

263. The Delegation of the Republic of Moldova supported the Chair's proposal.

264. The Delegation of the Russian Federation, referring to the comments made by the Chair on the need to amend the text of Rule 6, asked whether there would be a discussion on specific amendments to that rule, alongside other proposals in the document concerning the introduction of Russian and Chinese as working languages, so that the Working Group could actually have something concrete on the table for discussion.

265. The Chair referred to the comments made by the Director General of WIPO earlier in that session and, specifically, on the different ways that could be looked at when introducing languages into the Madrid System, such as, for example, ways which could be the most efficient, most cost-effective. The Chair said the study would look at a number of scenarios for introducing further languages into the Madrid System and added that, once such scenarios had been considered and an agreement had been reached on the best way to move forward, it would then be the best time to look at what changes to the rule would be required. The Chair concluded that, accordingly, the document to be presented at the following session would not necessarily have any concrete proposals concerning changes to the Regulations but it would provide ideas for the best and most cost-effective way in which to proceed.

266. The Delegation of Italy expressed its support for the proposal made by the Chair and requested that the document to be discussed at the following session also provide information on the economic impact as well as the advantages and the disadvantages of introducing new languages.

267. The Working Group requested the Secretariat to prepare an in-depth study on the implications of the possible introduction of the Chinese and the Russian languages into the Madrid System, building on the information already provided in document MM/LD/WG/16/INF/2, to be discussed at the next session of the Working Group.

#### **AGENDA ITEM 11: OTHER MATTERS**

268. The Chair invited the Delegation of the United States of America to introduce document MM/LD/WG/16/10.

269. The Delegation of the United States of America urged that the issue of Madrid fees and payment options be considered as a priority by the Working Group. The Delegation recalled that the International Bureau had noted, in a document discussed at the previous session of the Working Group, that it had been more than 20 years since the last comprehensive review of the Schedule of Fees under the Madrid System took place. The Delegation also recalled that the Working Group had decided to include the issue of fee revision and payment options on its Road Map, a list of subjects to be discussed by the Working Group in the short, medium, and long term, and the issue of fee revision and payment options had been listed among the items to be discussed in the medium term. The Delegation urged the Working Group to consider that issue in the short-term, given its importance and need for a Madrid Union decision on fees to be reflected in the organization's program and budget in a timely manner. The Delegation said it believed that all delegations could agree on changes to the fee schedule to create incentives and disincentives for applicant behavior such as, for example, the fact that the fee for an assignment was higher than the fee for a change in name and address or entity type likely encouraged use of the wrong form to save money. The Delegation added that technological advances in the previous 20 years suggested that different fees between international applications with a drawing in black and white *versus* a drawing in color should be re-evaluated. The Delegation highlighted that those were just examples, but that there would certainly be more ideas. The Delegation indicated that the United States of America believed that, in addition to creating incentives for applicant behavior, a review of the fees under the Madrid System would also provide the opportunity to consider adjustments that would allow the Madrid System to generate increased income and contribute more robustly to the overall financial health of WIPO. The Delegation said it believed WIPO enjoyed a strong financial position primarily due to the success of the PCT, which generated over 75 per cent of WIPO's overall income, but that the long-term strength of the PCT masked weakness in WIPO's other fee funded systems, namely, the Madrid, The Hague, and Lisbon Systems. The Delegation stated that those systems did not proportionally contribute to the overall expenses of the organization and referred to document WO/PBC/27/13, submitted by the Delegation of the United States of America to the WIPO Program and Budget Committee at its previous session, held in September 2017, which discussed the imbalance in WIPO funding in greater detail and was available in all languages on the WIPO website. The Delegation said that, without going into

excruciating detail, the United States of America felt that the Madrid System would be broke if it had to pay all of its own indirect costs in proportion to its own direct expenses, further adding that, if it had to pay its indirect costs proportionately, the Madrid System would be unable to fully contribute to any other WIPO activities of common interest, including development agenda activities. The Delegation stated that, under the Madrid Agreement and Madrid Protocol, the Madrid Union should be paying its own real costs, direct and indirect, as well as a share of the common expenses but, because the Madrid System did not pay its own costs fully, it was not making a strong contribution to the overall health of the organization. The Delegation said that the United States of America believed that WIPO's financial well-being should be strengthened by giving consideration to a more balanced funding of the organization's activities and capital expenditures by all of its fee funded unions and that it hoped the International Bureau would present several fee options for consideration by the Working Group, including modest fee increases that would generate net additional resources, under each scenario, for the Madrid System, which would allow the Madrid System to make a stronger contribution in support of the overall health of the organization and its activities.

270. The Chair opened the floor for comments.

271. The Delegation of Austria said that it had carefully studied the document submitted by the Delegation of the United States of America and that, in the short time it had had to examine it, its first impression was, especially given the title and the arguments in the proposal, that the matter affected not only the Madrid Union but had cross cutting implications on other unions and on the organization as a whole. Therefore, the Delegation said it was of the view that the matter should not be discussed in isolation, in a technical gathering of one union, but in the competent committee for the overall financial situation of WIPO and of the WIPO-administered unions.

272. The Delegation of Italy expressed its agreement with the statement made by the Delegation of Austria. The Delegation said that it was not in favor of discussing possible changes and increases to the fees under the Madrid System, recalling that, in a previous session of the Working Group, when discussing the Road Map, delegations had agreed that the issue would be discussed in the medium-term. The Delegation stated that it was not the time to discuss fees and added that document MM/LD/WG/16/10 also referred to Lisbon, The Hague, and the PCT Systems, while, in its view, all discussions in the Working Group must exclusively focus on Madrid matters. The Delegation said that there would be an opportunity to discuss the financial matters of the different WIPO-administered unions during the following session of the Program and Budget Committee.

273. The Delegation of Hungary expressed its support for the statements made by the Delegations of Austria and Italy. The Delegation said it shared the view that the proposal dealt with matters which were in the competence of a different platform and, therefore, discussions on the matter should not be held at the Working Group.

274. The Delegation of France stated that, given the late submission of the proposal, it would not be possible to take a definitive position on the matter, but expressed an interest in the positions taken by the Delegations of Austria, Italy and Hungary. The Delegation stated that the Working Group was not the appropriate forum to discuss such matters and that the discussion should be taken to the competent working groups or to the Program and Budget Committee, in the presence of the appropriate delegations.

275. The Delegation of Denmark expressed its support for the statement made by the Delegation of Austria and its belief that the discussion was a matter for the Program and Budget Committee to decide upon.

276. The Delegation of the United Kingdom said it agreed with the intervention made by the Delegation of Austria and stated that the proposals put forward by the Delegation of the United States of America covered wider issues. The Delegation said that the Madrid Working Group may not be the best place to discuss all the points put forward in the document and that the Working Group should be considering issues within the Madrid System and not looking at the financial positions of other unions. The Delegation added that, however, it agreed that, after



more than 20 years, the Working Group should be looking at the fee structure and payment options within the Madrid System and recalled that the International Bureau had also acknowledged this in a document discussed at the Fourteenth Session of the Working Group and that the issue was listed in the mid-term priorities of the Working Group Road Map. The Delegation added that, as part of the discussions of the fee structure, the International Bureau should be looking at payment options within the system to improve the experience of users. The Delegation also referred to a document presented by United Kingdom at the Fifteenth Session of the Working Group concerning changes to be made to the Madrid System and that the issues considered in that document had also been added to the mid-term priorities. The Delegation asked the Secretariat to provide a timetable of when proposals listed as mid-term priorities in the Road Map would be discussed.

277. The Delegation of Iran (Islamic Republic of) recognized that the Madrid System was in a stable and good financial situation and noted that, according to the document, the Madrid System was not in deficit but, rather, had a surplus, which proved the current level of fees was sufficient to cover the current expenses of the system and, more broadly, to contribute to the expenses of WIPO. The Delegation recalled that, according to a decision of the WIPO General Assembly in 2017, fee-financed unions were expected to review their budgets to ensure they were not in deficit and added that it was obvious that the Madrid System was not in deficit. The Delegation stated that the financial sustainability of other WIPO-administered unions and their activities with regard to their own sustainability felt outside the mandate of the Working Group and that, accordingly, it was not convinced of the value of moving the discussion on the fee revision and payment options from the mid to the near-term. Finally, the Delegation said that, as the proposal had been submitted recently, it had faced a time constraint for consideration and it had not had the opportunity to consult with its capital.

278. The Delegation of Portugal expressed support for the statements made by the Delegations of Austria, Italy, Hungary and Iran (Islamic Republic of).

279. The Delegations of China, Switzerland and Germany expressed their support for the statement made by the Delegation of Austria.

280. The Delegation of the United States of America recognized that its proposal was submitted late and thanked the Delegation of the United Kingdom for recalling that the Secretariat had also noted it had been over 20 years since the last discussions regarding fee revisions of the Madrid System had taken place. The Delegation said it wished to clarify that it was not asking for a divergence from the Road Map, which all delegations had already agreed upon at the fourteenth session of the Working Group, but that it was rather requesting that that International Bureau prepare various fee option scenarios for the following session of the Working Group, which, it believed, would keep the Working Group Road Map on track. The Delegation asked the Secretariat when the issue of fee revisions was likely to come up in the context of the Road Map and, in that context, the Delegation asked whether the Secretariat would be able to comment on what steps it would be taking in order to help members prepare for that discussion.

281. The Chair invited the Secretariat to respond to the questions raised by delegations.

282. The Secretariat explained that there were a number of questions on the table for the mid-term and that, when the Road Map was agreed upon, the short-term covered sessions until 2018, which meant that the mid-term was anticipated as from 2019. The Secretariat stated that there was no fixed period of how long the mid-term period would last and, as such, the start of the long-term period was unknown. The Secretariat recalled that there were a number of topics listed in the mid-term, stated that it would not be possible to start discussions on all of those topics at the first session of the mid-term and noted that there were also a number of topics from the current session that would be brought forward to the next, such as, new types of marks and continued discussions on languages. The Secretariat said that it would be feasible to begin discussions on two of the topics listed in the mid-term and, in that regard, consideration was being given to harmonized time limits to reply to provisional refusals,

as requested by Offices and user organizations, as well as discussions on the possible reduction of the dependency period, which had been requested and pending for some time, following previous discussions on the possible abolition of the basic mark and the dependency period. The Secretariat stated that, although it was listed in the mid-term, it would not be possible to begin discussions on fee revisions at the next session of the Working Group and that any work on fees would need to wait until the new IT platform had been deployed. The Secretariat explained that the new IT platform would have a significant impact on the services provided by WIPO and that it would not be possible to cost those services until the new IT platform had been deployed. Accordingly, the Secretariat proposed that, at its next session, the Working Group continued discussions on new types of marks and languages and start discussions on harmonized time limits to reply to provisional refusals and on a possible reduction of the dependency period.

283. The Delegation of Cuba recalled that paragraph (2) of Article 9*sexies* remained in force, according to which, as from 2008 and at the request of any Contracting Party, the Madrid Union Assembly must examine the application of paragraph (1)(b) of the same Article and may either repeal or restrict it with the three-fourths majority of the States party to both the Madrid Agreement and the Madrid Protocol.

284. The Delegation of the United States of America thanked the Secretariat for the additional information and clarification with respect to the timeline for the Road Map and said it was very helpful to understand it in order to be prepared for the following session. The Delegation stated that it would certainly be interested in further discussing the issue and may very well prepare another document for the following session of the Working Group. The Delegation said that it had also taken note of the comments made by other delegations regarding their interest in discussing the overall fee system in the context of the Program and Budget Committee.

285. The Representative of MARQUES welcomed the addition of the topics concerning the harmonized time limits and the dependency period on the draft agenda for the following session of the Working Group.

286. The Representative of INTA asked whether the topic of replacement and, in particular, the principles of Rule 21, was also on the draft agenda for following session.

287. The Chair confirmed that the topic of replacement would also be discussed at the following session.

288. The Delegation of Switzerland asked whether limitations would be discussed at the following session.

289. The Chair recalled that proposals concerning limitations would have to be submitted in writing for the following session of the Working Group.

290. The Chair closed the discussions and concluded that the topic of fee revisions and payment options would be discussed after the International Bureau had deployed its new IT platform.

291. The Chair opened the floor for discussions on any other matters.

292. The Delegation of Portugal sought further clarification on the position of the International Bureau on new types of marks, in particular, on olfactory marks, noted that olfactory marks were registered in the United Kingdom and the United States of America and asked whether the International Bureau would accept such marks or whether that had been put aside as it had been the case in the Office of the European Union.

293. The Chair clarified that there was no limitation as to the types of marks that could be filed through the Madrid System, provided they complied with the graphical representation requirement and added that the mark would be accepted if it met such requirement.

294. The Representative of ECTA said that ECTA had made available three position papers which were entitled “ECTA Position Paper on the Introduction of a Non-Use Central Attack for International Trade Mark Registrations (Madrid System)”<sup>2</sup>; “ECTA Position Paper on the Dependency of International Trade Marks on a National Basic Application or Registration (Madrid System)”<sup>3</sup>; and “ECTA Position Paper on the Introduction of a Common Electronic Filing Portal (CEFP) for International Trademark Registration (Madrid System)”<sup>4</sup>. The Representative of ECTA said she wished to make five points: (i) each paper contained references to the other papers, but that did not mean ECTA was suggesting a package deal; (ii) ECTA submitted the three papers on May 16, 2018; the papers had been developed for the previous session of the Working Group and predated the document on replacement<sup>5</sup>, prepared by the International Bureau, which was dated May 2, 2018; ECTA wished to draw attention to paragraphs 6 to 8 of that document which concerned the development of an optional centralized filing mechanism under proposed amendments to Rule 21 of the Common Regulations; (iii) dependency was listed in the five-year Road Map, which was approved in 2016, as a mid-term item for discussion and, given that 2018 was the mid-point in that five-year plan, the Representative of ECTA reminded that the reduction of the pendency period from five to three years was to be discussed; (iv) a common electronic filing platform should be considered at the Roundtable on the basis that it was an operational matter and not a legal matter, which would free up time for the Madrid Working Group to consider dependency and central track; (v) the international system retained a central attack mechanism but lacked provisions for a central non-use attack mechanism. The Representative explained that third parties wishing to contest a mark for non-use had to present multiple cancellation actions in multiple jurisdictions and said that the inequity of the cost burden could be mitigated if, at an early stage, the burden to respond was placed on the holder who would lose the international registration should the holder fail to respond. The Representative of ECTA further explained that such proposal would not subvert the distinction between the International Bureau, as the formality authority, and the Contracting Parties, as the substantive authorities, but that it would simply establish a single track, at the beginning of the proceedings, to determine whether the holder wished to respond or not. The Representative asked the Working Group to consider the issues ECTA had raised and said ECTA stood ready to assist in any way.

295. The Delegation of Norway commended the Representative of ECTA for raising the topic of the reduction of the dependency period in ECTA’s position paper and for sharing the views of its members. The Delegation also thanked the Secretariat for the clarification regarding the mid-term priorities and stated that Norway was still of the opinion that the abolishment or freezing of the dependency principle would be beneficial, and, hence, it was in favor of the group considering a reduction of the dependency period because a shorter period would strike a fairer balance and increase legal certainty for users of the system. The Representative stated that a shorter period of uncertainty could make the Madrid System more attractive and user-friendly worldwide and that a shorter dependency period could, for instance, benefit applicants from countries using non-Latin script. The Delegation stated that, as reflected in document MM/LD/WG/14/4 and in the revised Road Map as well as in light of ECTA’s position paper and on previous observations made by other users’ organizations, it looked forward to continuing discussions on that important topic in the coming sessions.

296. The Representative of MARQUES made reference to MARQUES’ paper<sup>6</sup> and its proposal concerning trademarks in different scripts, and noted that such topic was not on the Road Map. The Representative questioned whether the Working Group decided that it did not want to discuss it and suggested putting it forward for discussion at some point.

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<sup>2</sup> See document MM/LD/WG/16/ECTA/1.

<sup>3</sup> See document MM/LD/WG/16/ECTA/2.

<sup>4</sup> See document MM/LD/WG/16/ECTA/3.

<sup>5</sup> See document MM/LD/WG/16/2 “Replacement”.

<sup>6</sup> See document MM/LD/WG/16/MARQUES/1 “MARQUES’ Comments on Official Languages and Non-Latin Script Marks”.

297. The Chair clarified that the issue of marks in non-Latin script had been discussed at the Roundtable, during previous sessions, but that it appeared it had not gained much traction which was the reason why it was not on the Road Map.

298. The Delegation of Israel said that as a country where non-Latin script was used, it saw great advantage in allowing holders to file international applications for marks that, in the opinion of the Office of origin, intrinsically corresponded to the basic mark. Therefore, the Delegation recommended the preparation of a document, according to MARQUES' proposal, for the following session of the Working Group.

299. The Chair said that it might be difficult to have a document on marks in non-Latin script for the following session of the Working Group, but that it could be possible to consider a minor amendment to the Road Map and introduce the issue as an item to be discussed at the Roundtable, in the mid-term.

300. The Chair concluded the discussions on Other Matters.

#### **AGENDA ITEM 12: SUMMARY BY THE CHAIR**

301. The Working Group approved the Summary by the Chair, as amended to take into account the interventions of a number of delegations.

#### **AGENDA ITEM 13: CLOSING OF THE SESSION**

302. The Chair closed the session on July 6, 2018.

[Annex I follows]

**PROPOSED REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID  
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

**Common Regulations under  
the ~~Madrid Agreement Concerning  
the International Registration of Marks~~  
and the Protocol Relating to ~~that~~ the Madrid Agreement  
Concerning the International Registration of Marks**

(as in force on February 1, ~~2019~~ 2020)

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Rule 40: Entry into Force; Transitional Provisions

Rule 41: Administrative Instructions

## Chapter 1 General Provisions

### Rule 1 Abbreviated Expressions

For the purposes of these Regulations,

(i) "Agreement" means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967, and amended on September 28, 1979;

(ii) "Protocol" means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;

(iii) "Contracting Party" means ~~any country party to the Agreement or~~ any State or intergovernmental organization party to the Protocol;

(iv) "Contracting State" means a Contracting Party that is a State;

(v) "Contracting Organization" means a Contracting Party that is an intergovernmental organization;

(vi) "international registration" means the registration of a mark effected under the Agreement or the Protocol or both, as the case may be;

(vii) "international application" means an application for international registration filed under ~~the Agreement or the Protocol or both, as the case may be;~~

(viii) ~~[Deleted]"international application governed exclusively by the Agreement" means an international application whose Office of origin is the Office~~  
~~— of a State bound by the Agreement but not by the Protocol, or~~  
~~— of a State bound by both the Agreement and the Protocol, where only States are designated in the international application and all the designated States are bound by the Agreement but not by the Protocol;~~

(ix) ~~[Deleted]"international application governed exclusively by the Protocol" means an international application whose Office of origin is the Office~~  
~~— of a State bound by the Protocol but not by the Agreement, or~~  
~~— of a Contracting Organization, or~~  
~~— of a State bound by both the Agreement and the Protocol, where the international application does not contain the designation of any State bound by the Agreement but not by the Protocol;~~

(x) ~~[Deleted]"international application governed by both the Agreement and the Protocol" means an international application whose Office of origin is the Office of a State bound by both the Agreement and the Protocol and which is based on a registration and contains the designations~~

~~— of at least one State bound by the Agreement but not by the Protocol,~~  
~~and~~

~~— of at least one State bound by the Protocol, whether or not that State is also bound by the Agreement or of at least one Contracting Organization;~~

(xi) "applicant" means the natural person or legal entity in whose name the international application is filed;

(xii) "legal entity" means a corporation, association or other group or organization which, under the law applicable to it, is capable of acquiring rights, assuming obligations and suing or being sued in a court of law;

(xiii) "basic application" means the application for the registration of a mark that has been filed with the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

(xiv) "basic registration" means the registration of a mark that has been effected by the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

(xv) “designation” means the request for extension of protection (“territorial extension”) ~~under Article 3ter(1) or (2) of the Agreement or~~ under Article 3ter(1) or (2) of the Protocol, ~~as the case may be;~~ it also means such extension as recorded in the International Register;

(xvi) “designated Contracting Party” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested ~~under Article 3ter(1) or (2) of the Agreement or~~ under Article 3ter(1) or (2) of the Protocol, ~~as the case may be;~~ or in respect of which such extension has been recorded in the International Register;

(xvii) ~~[Deleted] “Contracting Party designated under the Agreement” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3ter(1) or (2) of the Agreement;~~

(xviii) ~~[Deleted] “Contracting Party designated under the Protocol” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3ter(1) or (2) of the Protocol;~~

(xix) “notification of provisional refusal” means a declaration by the Office of a designated Contracting Party, in accordance with ~~Article 5(1) of the Agreement or~~ Article 5(1) of the Protocol;

(xixbis) “invalidation” means a decision by the competent authority (whether administrative or judicial) of a designated Contracting Party revoking or cancelling the effects, in the territory of that Contracting Party, of an international registration with regard to all or some of the goods or services covered by the designation of the said Contracting Party;

(xx) “Gazette” means the periodical gazette referred to in Rule 32;

(xxi) “holder” means the natural person or legal entity in whose name the international registration is recorded in the International Register;

(xxii) “International Classification of Figurative Elements” means the Classification established by the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks of June 12, 1973;

(xxiii) “International Classification of Goods and Services” means the Classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977;

(xxiv) “International Register” means the official collection of data concerning international registrations maintained by the International Bureau, which data ~~the Agreement,~~ the Protocol or the Regulations require or permit to be recorded, irrespective of the medium in which such data are stored;

(xxv) “Office” means the Office of a Contracting Party in charge of the registration of marks, or the common Office referred to in ~~Article 9quater of the Agreement or~~ Article 9quater of the Protocol, ~~or both, as the case may be;~~

(xxvi) “Office of origin” means ~~the Office of the country of origin defined in Article 1(3) of the Agreement or~~ the Office of origin defined in Article 2(2) of the Protocol, ~~or both, as the case may be;~~

(xxvibis) “Contracting Party of the holder” means

- the Contracting Party whose Office is the Office of origin, or
- where a change of ownership has been recorded or in the case of State succession, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfills the conditions, ~~under Articles 1(2) and 2 of the Agreement or~~ under Article 2 of the Protocol, to be the holder of an international registration;

(xxvii) “official form” means a form established by the International Bureau or any form having the same contents and format;

(xxviii) “prescribed fee” means the applicable fee set out in the Schedule of Fees;

(xxix) “Director General” means the Director General of the World Intellectual Property Organization;

(xxx) “International Bureau” means the International Bureau of the World Intellectual Property Organization.

(xxxi) “Administrative Instructions” means the Administrative Instructions referred to in Rule 41.



*Rule 1bis*

~~*[Deleted] Designations Governed by the Agreement and  
Designations Governed by the Protocol*~~

~~(1) *[General Principle and Exceptions]* The designation of a Contracting Party shall be governed by the Agreement or by the Protocol depending on whether the Contracting Party has been designated under the Agreement or under the Protocol. However,~~

~~(i) where, with regard to a given international registration, the Agreement ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Agreement, the designation of the latter shall become governed by the Protocol as of the date on which the Agreement so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Protocol, and~~

~~(ii) where, with regard to a given international registration, the Protocol ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Protocol, the designation of the latter shall become governed by the Agreement as of the date on which the Protocol so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Agreement.~~

~~(2) *[Recording]* The International Bureau shall record in the International Register an indication of the treaty governing each designation.~~

*Rule 2*

*Communication with the International Bureau*

Communications addressed to the International Bureau shall be effected as specified in the Administrative Instructions.

*Rule 3*

*Representation Before the International Bureau*

(1) *[Representative; Number of Representatives]* (a) The applicant or the holder may have a representative before the International Bureau.

(b) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.

(c) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.

(2) *[Appointment of the Representative]* (a) The appointment of a representative may be made in the international application, or in a subsequent designation or [in](#) a request under Rule 25.

(b) The appointment of a representative may also be made in a separate communication which may relate to one or more specified international applications or international registrations of the same applicant or holder. The said communication shall be presented to the International Bureau

(i) by the applicant, the holder or the appointed representative, or

(ii) by the Office of the Contracting Party of the holder.

The communication shall be signed by the applicant or the holder, or by the Office through which it was presented.

(3) *[Irregular Appointment]* (a) Where the International Bureau considers that the appointment of a representative under paragraph (2) is irregular, it shall notify accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.

(b) As long as the relevant requirements under paragraph (2) are not complied with, the International Bureau shall send all relevant communications to the applicant or holder ~~himself~~ but not to the purported representative.

(4) *[Recording and Notification of Appointment of a Representative; Effective Date of Appointment]* (a) Where the International Bureau finds that the appointment of a representative complies with the applicable requirements, it shall record the fact that the applicant or holder has a representative, as well as the name and address of the representative, in the International Register. In such a case, the effective date of the appointment shall be the date on which the International Bureau received the international application, subsequent designation, request or separate communication in which the representative is appointed.

(b) The International Bureau shall notify the recording referred to in subparagraph (a) to both the applicant or holder and, in the latter case, the Offices of the designated Contracting Parties, as well as the representative. Where the appointment was made in a separate communication presented through an Office, the International Bureau shall also notify the recording to that Office.

(5) *[Effect of Appointment of a Representative]* (a) Except where these Regulations expressly provide otherwise, the signature of a representative recorded under paragraph (4)(a) shall replace the signature of the applicant or holder.

(b) Except where these Regulations expressly require that an invitation, notification or other communication be addressed to both the applicant or holder and the representative, the International Bureau shall address to the representative recorded under paragraph (4)(a) any invitation, notification or other communication which, in the absence of a representative, would have to be sent to the applicant or holder; any invitation, notification or other communication so addressed to the said representative shall have the same effect as if it had been addressed to the applicant or holder.

(c) Any communication addressed to the International Bureau by the representative recorded under paragraph (4)(a) shall have the same effect as if it had been addressed to the said Bureau by the applicant or holder.

(6) *[Cancellation of Recording; Effective Date of Cancellation]* (a) Any recording under paragraph (4)(a) shall be cancelled where cancellation is requested in a communication signed by the applicant, holder or representative. The recording shall be cancelled *ex officio* by the International Bureau where a new representative is appointed or, in case a change in ownership has been recorded, where no representative is appointed by the new holder of the international registration.

(b) Subject to subparagraph (c), the cancellation shall be effective from the date on which the International Bureau receives the corresponding communication.

(c) Where the cancellation is requested by the representative, it shall be effective from the earlier of the following:

(i) the date on which the International Bureau receives a communication appointing a new representative;

(ii) the date of the expiry of a period of two months counted from the receipt of the request of the representative that the recording be cancelled.

Until the effective date of the cancellation, all communications referred to in paragraph (5)(b) shall be addressed by the International Bureau to both the applicant or holder and the representative.

(d) The International Bureau shall, upon receipt of a request for cancellation made by the representative, notify accordingly the applicant or holder, and add to the notification copies of all communications sent to the representative, or received by the International Bureau from the representative, during the six months preceding the date of the notification.

(e) The International Bureau shall, once the effective date of the cancellation is known, notify the cancellation and its effective date to the representative whose recording has been cancelled, to the applicant or holder and, where the appointment of the representative had been presented through an Office, to that Office.

(f) Cancellations at the request of the holder or the holder's representative shall also be notified to the Offices of the designated Contracting Parties.

*Rule 4*  
*Calculation of Time Limits*

(1) *[Periods Expressed in Years]* Any period expressed in years shall expire, in the relevant subsequent year, in the month having the same name and on the day having the same number as the month and the day of the event from which the period starts to run, except that, where the event occurred on February 29 and in the relevant subsequent year February ends on the 28th, the period shall expire on February 28.

(2) *[Periods Expressed in Months]* Any period expressed in months shall expire, in the relevant subsequent month, on the day which has the same number as the day of the event from which the period starts to run, except that, where the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month.

(3) *[Periods Expressed in Days]* The calculation of any period expressed in days shall start with the day following the day on which the relevant event occurred and shall expire accordingly.

(4) *[Expiry on a Day on Which the International Bureau or an Office Is Not Open to the Public]* If a period expires on a day on which the International Bureau or the Office concerned is not open to the public, the period shall, notwithstanding paragraphs (1) to (3), expire on the first subsequent day on which the International Bureau or the Office concerned is open to the public.

(5) *[Indication of the Date of Expiry]* The International Bureau shall, in all cases in which it communicates a time limit, indicate the date of the expiry, according to paragraphs (1) to (3), of the said time limit.

*Rule 5*  
*Irregularities in Postal and Delivery Services*  
*and in Communications Sent Electronically*

(1) *[Communications Sent Through a Postal Service]* Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and mailed through a postal service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,

(i) that the communication was mailed at least five days prior to the expiry of the time limit, or, where the postal service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed not later than five days after postal service was resumed,

(ii) that the mailing of the communication was registered, or details of the mailing were recorded, by the postal service at the time of mailing, and

(iii) in cases where all classes of mail do not normally reach the International Bureau within two days of mailing, that the communication was mailed by a class of mail which normally reaches the International Bureau within two days of mailing or by airmail.

(2) *[Communications Sent Through a Delivery Service]* Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and sent through a delivery service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,

(i) that the communication was sent at least five days prior to the expiry of the time limit, or, where the delivery service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was sent not later than five days after the delivery service was resumed, and

(ii) that details of the sending of the communication were recorded by the delivery service at the time of sending.

(3) *[Communication Sent Electronically]* Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.

(4) *[Limitation on Excuse]* Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1), (2) or (3) and the communication or, where applicable, a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.

(5) *[International Application and Subsequent Designation]* Where the International Bureau receives an international application or a subsequent designation beyond the two-month period referred to ~~in Article 3(4) of the Agreement,~~ in Article 3(4) of the Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1), (2) or (3), paragraph (1), (2) or (3) and paragraph (4) shall apply.

*Rule 5bis*  
*Continued Processing*

(1) *[Request]* (a) Where an applicant or holder has failed to comply with any of the time limits specified or referred to in Rules 11(2) and (3), 20*bis*(2), 24(5)(b), 26(2), 34(3)(c)(iii) and 39(1), the International Bureau shall, nevertheless, continue the processing of the international application, subsequent designation, payment or request concerned, if:

(i) a request to that effect, signed by the applicant or holder, is presented to the International Bureau on the official form; and

(ii) the request is received, the fee specified in the Schedule of Fees is paid and, together with the request, all of the requirements in respect of which the time limit concerned applied are complied with, within two months from the date of expiry of that time limit.

(b) A request not complying with items (i) and (ii) of subparagraph (a) shall not be considered as such and the applicant or holder shall be notified to that effect.

(2) *[Recording and Notification]* The International Bureau shall record in the International Register any continued processing and notify the applicant or holder accordingly.

*Rule 6*  
*Languages*

(1) [*International Application*] The international application shall be in English, French or Spanish according to what is prescribed by the Office of origin, it being understood that the Office of origin may allow applicants to choose between English, French and Spanish.

(2) [*Communications Other than the International Application*] Any communication concerning an international application or an international registration shall, subject to Rule 17(2)(v) and (3), be

(i) in English, French or Spanish where such communication is addressed to the International Bureau by the applicant or holder, or by an Office;

(ii) in the language applicable under Rule 7(2) where the communication consists of the declaration of intention to use the mark annexed to the international application under Rule 9(5)(f) or to the subsequent designation under Rule 24(3)(b)(i);

(iii) in the language of the international application where the communication is a notification addressed by the International Bureau to an Office, unless that Office has notified the International Bureau that all such notifications are to be in English, or are to be in French or are to be in Spanish; where the notification addressed by the International Bureau concerns the recording in the International Register of an international registration, the notification shall indicate the language in which the relevant international application was received by the International Bureau;

(iv) in the language of the international application where the communication is a notification addressed by the International Bureau to the applicant or holder, unless that applicant or holder has expressed the wish that all such notifications be in English, or be in French or be in Spanish.

(3) [*Recording and Publication*] (a) The recording in the International Register and the publication in the Gazette of the international registration and of any data to be both recorded and published under these Regulations in respect of the international registration shall be in English, French and Spanish. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

(b) Where a first subsequent designation is made in respect of an international registration that, under previous versions of this Rule, has been published only in French, or only in English and French, the International Bureau shall, together with the publication in the Gazette of that subsequent designation, either publish the international registration in English and Spanish and republish the international registration in French, or publish the international registration in Spanish and republish it in English and French, as the case may be. That subsequent designation shall be recorded in the International Register in English, French and Spanish.

(4) [*Translation*] (a) The translations needed for the notifications under paragraph (2)(iii) and (iv), and recordings and publications under paragraph (3), shall be made by the International Bureau. The applicant or the holder, as the case may be, may annex to the international application, or to a request for the recording of a subsequent designation or of a change, a proposed translation of any text matter contained in the international application or the request. If the proposed translation is not considered by the International Bureau to be correct, it shall be corrected by the International Bureau after having invited the applicant or the holder to make, within one month from the invitation, observations on the proposed corrections.

(b) Notwithstanding subparagraph (a), the International Bureau shall not translate the mark. Where, in accordance with Rule 9(4)(b)(iii) or Rule 24(3)(c), the applicant or the holder gives a translation or translations of the mark, the International Bureau shall not check the correctness of any such translations.

*Rule 7*  
*Notification of Certain Special Requirements*

(1) [Deleted]

(2) *[Intention to Use the Mark]* Where a Contracting Party requires, ~~as a Contracting Party designated under the Protocol~~ as a designated Contracting Party, a declaration of intention to use the mark, it shall notify that requirement to the Director General. Where that Contracting Party requires the declaration to be signed personally by the applicant ~~himself~~ and to be made on a separate official form annexed to the international application, the notification shall contain a statement to that effect and shall specify the exact wording of the required declaration. Where the Contracting Party further requires the declaration to be in English, French or Spanish, the notification shall specify the required language.

(3) *[Notification]* (a) Any notification referred to in paragraph (2) may be made at the time of the deposit by the Contracting Party of its instrument of ratification, acceptance or approval of, or accession to, the Protocol, and the effective date of the notification shall be the same as the date of entry into force of the Protocol with respect to the Contracting Party having made the notification. The notification may also be made later, in which case the notification shall have effect three months after its receipt by the Director General, or at any later date indicated in the notification, in respect of any international registration whose date is the same as or is later than the effective date of the notification.

(b) Any notification made under paragraph (2) may be withdrawn at any time. The notice of withdrawal shall be addressed to the Director General. The withdrawal shall have effect upon receipt of the notice of withdrawal by the Director General or at any later date indicated in the notice.

**Chapter 2**  
**International Applications**

*Rule 8*  
*Several Applicants*

(1) ~~[Deleted]~~ ~~*[Two or More Applicants Applying Exclusively Under the Agreement or Applying Under Both the Agreement and the Protocol]*~~ Two or more applicants may jointly file an international application governed exclusively by the Agreement or governed by both the Agreement and the Protocol if the basic registration is jointly owned by them and if the country of origin, as defined in Article 1(3) of the Agreement, is the same for each of them.

(2) ~~*[Two or More Applicants Applying Exclusively Under the Protocol]*~~ Two or more applicants may jointly file an international application ~~governed exclusively by the Protocol~~ if the basic application was jointly filed by them or the basic registration is jointly owned by them, and if each of them qualifies, in relation to the Contracting Party whose Office is the Office of origin, for filing an international application under Article 2(1) of the Protocol.

*Rule 9*  
*Requirements Concerning the International Application*

(1) *[Presentation]* The international application shall be presented to the International Bureau by the Office of origin.

(2) *[Form and Signature]* (a) The international application shall be presented on the official form ~~in one copy~~.

(b) The international application shall be signed by the Office of origin and, where the Office of origin so requires, also by the applicant. Where the Office of origin does not require the applicant to sign the international application but allows that the applicant also sign it, the applicant may do so.

(3) *[Fees]* The prescribed fees applicable to the international application shall be paid as provided for in Rules 10, 34 and 35.

(4) *[Contents of the International Application]* (a) The international application shall contain or indicate

(i) the name of the applicant, given in accordance with the Administrative Instructions,

(ii) the address of the applicant, given in accordance with the Administrative Instructions,

(iii) the name and address of the representative, if any, given in accordance with the Administrative Instructions,

(iv) where the applicant wishes, under the Paris Convention for the Protection of Industrial Property, to take advantage of the priority of an earlier filing, a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and, where the earlier filing relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the earlier filing relates,

(v) a reproduction of the mark that shall fit in the box provided on the official form; that reproduction shall be clear and shall, depending on whether the reproduction in the basic application or the basic registration is in black and white or in color, be in black and white or in color,

(vi) where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect,

(vii) where color is claimed as a distinctive feature of the mark in the basic application or basic registration, or where the applicant wishes to claim color as a distinctive feature of the mark and the mark contained in the basic application or basic registration is in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,

(vii*bis*) where the mark that is the subject of the basic application or the basic registration consists of a color or a combination of colors as such, an indication to that effect,

(viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication "three-dimensional mark,"

(ix) where the basic application or the basic registration relates to a sound mark, the indication "sound mark,"

(x) where the basic application or the basic registration relates to a collective mark or a certification mark or a guarantee mark, an indication to that effect,

(xi) where the basic application or the basic registration contains a description of the mark by words and the Office of origin requires the inclusion of the description, that same description; where the said description is in a language other than the language of the international application, it shall be given in the language of the international application,

(xii) where the mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals; the transliteration into Latin characters shall follow the phonetics of the language of the international application,



(xiii) the names of the goods and services for which the international registration of the mark is sought, grouped in the appropriate classes of the International Classification of Goods and Services, each group preceded by the number of the class and presented in the order of the classes of that Classification; the goods and services shall be indicated in precise terms, preferably using the words appearing in the Alphabetical List of the said Classification; the international application may contain limitations of the list of goods and services in respect of one or more designated Contracting Parties; the limitation in respect of each Contracting Party may be different,

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

(xv) the designated Contracting Parties.

(b) The international application may also contain,

(i) where the applicant is a natural person, an indication of the State of which the applicant is a national;

(ii) where the applicant is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into English, French and Spanish, or in any one or two of those languages;

(iv) where the applicant claims color as a distinctive feature of the mark, an indication by words, in respect of each color, of the principal parts of the mark which are in that color;

(v) where the applicant wishes to disclaim protection for any element of the mark, an indication of that fact and of the element or elements for which protection is disclaimed;

(vi) any description of the mark by words or, if the applicant so wishes, the description of the mark by words contained in the basic application or the basic registration, where it has not been provided under paragraph (4)(a)(xi).

(5) *[Additional Contents of ~~an~~the International Application]* (a) ~~[Deleted]An international application governed exclusively by the Agreement or by both the Agreement and the Protocol shall contain the number and date of the basic registration and shall indicate one of the following:~~

~~(i) that the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting State whose Office is the Office of origin, or~~

~~(ii) where the applicant has no such establishment in any Contracting State of the Agreement, that he has a domicile in the territory of the State whose Office is the Office of origin, or~~

~~(iii) where the applicant has no such establishment or domicile in the territory of any Contracting State of the Agreement, that he is a national of the State whose Office is the Office of origin.~~

(b) ~~An~~The international application ~~governed exclusively by the Protocol~~ shall contain the number and date of the basic application or basic registration and shall indicate one or more of the following:

(i) where the Contracting Party whose Office is the Office of origin is a State, that the applicant is a national of that State;

(ii) where the Contracting Party whose Office is the Office of origin is an organization, the name of the Member State of that organization of which the applicant is a national;

(iii) that the applicant has a domicile in the territory of the Contracting Party whose Office is the Office of origin;

(iv) that the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party whose Office is the Office of origin.



(c) Where the address of the applicant given in accordance with paragraph (4)(a)(ii) is not in the territory of the Contracting Party whose Office is the Office of origin and it has been indicated under subparagraph (a)(i) or (ii) or subparagraph (b)(iii) or (iv) that the applicant has a domicile or an establishment in the territory of that Contracting Party, that domicile or the address of that establishment shall be given in the international application.

(d) The international application shall contain a declaration by the Office of origin certifying

(i) the date on which the Office of origin received ~~or, as provided for in Rule 11(1), is deemed to have received~~ the request by the applicant to present the international application to the International Bureau,

(ii) that the applicant named in the international application is the same as the applicant named in the basic application or the holder named in the basic registration, as the case may be,

(iii) that any indication referred to in paragraph (4)(a)(vii*bis*) to (xi) and appearing in the international application appears also in the basic application or the basic registration, as the case may be,

(iv) that the mark that is the subject matter of the international application is the same as in the basic application or the basic registration, as the case may be,

(v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and

(vi) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

(e) Where the international application is based on two or more basic applications or basic registrations, the declaration referred to in subparagraph (d) shall be deemed to apply to all those basic applications or basic registrations.

(f) Where the international application contains the designation of a Contracting Party that has made a notification under Rule 7(2), the international application shall also contain a declaration of intention to use the mark in the territory of that Contracting Party; the declaration shall be considered part of the designation of the Contracting Party requiring it and shall, as required by that Contracting Party,

(i) be personally signed by the applicant ~~himself~~ and be made on a separate official form annexed to the international application, or

(ii) be included in the international application.

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

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

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

*Rule 10  
Fees Concerning the International Application*

(1) ~~[Deleted]/International Applications Governed Exclusively by the Agreement/~~ An international application governed exclusively by the Agreement shall be subject to the payment of the basic fee, the complementary fee and, where applicable, the supplementary fee, specified in item 1 of the Schedule of Fees. Those fees shall be paid in two instalments of ten years each. For the payment of the second instalment, Rule 30 shall apply.

(2) ~~[Payable Fees]~~~~International Applications Governed Exclusively by the Protocol/~~ An ~~The~~ international application governed exclusively by the Protocol shall be subject to the payment of the basic fee, the complementary fee and/or the individual fee and, where applicable, the supplementary fee, specified or referred to in item 2 of the Schedule of Fees. Those fees shall be paid for ten years.

(3) ~~[Deleted]/International Applications Governed by Both the Agreement and the Protocol/~~ An international application governed by both the Agreement and the Protocol shall be subject to the payment of the basic fee, the complementary fee and, where applicable, the individual fee and the supplementary fee, specified or referred to in item 3 of the Schedule of Fees. As far as the Contracting Parties designated under the Agreement are concerned, paragraph (1) shall apply. As far as the Contracting Parties designated under the Protocol are concerned, paragraph (2) shall apply.

*Rule 11  
Irregularities Other than Those Concerning  
the Classification of Goods and Services  
or Their Indication*

(1) ~~[Deleted]/Premature Request to the Office of Origin/~~ (a) Where the Office of origin received a request to present to the International Bureau an international application governed exclusively by the Agreement before the mark which is referred to in that request is registered in the register of the said Office, the said request shall be deemed to have been received by the Office of origin, for the purposes of Article 3(4) of the Agreement, on the date of the registration of the mark in the register of the said Office.

(b) Subject to subparagraph (c), where the Office of origin receives a request to present to the International Bureau an international application governed by both the Agreement and the Protocol before the mark which is referred to in that request is registered in the register of the said Office, the international application shall be treated as an international application governed exclusively by the Protocol, and the Office of origin shall delete the designation of any Contracting Party bound by the Agreement but not by the Protocol.

(c) Where the request referred to in subparagraph (b) is accompanied by an express request that the international application be treated as an international application governed by both the Agreement and the Protocol once the mark is registered in the register of the Office of origin, the said Office shall not delete the designation of any Contracting Party bound by the Agreement but not by the Protocol and the request to present the international application shall be deemed to have been received by the said Office, for the purposes of Article 3(4) of the Agreement and Article 3(4) of the Protocol, on the date of the registration of the mark in the register of the said Office.

(2) *[Irregularities to Be Remedied by the Applicant]* (a) If the International Bureau considers that the international application contains irregularities other than those referred to in paragraphs (3), (4) and (6) and in Rules 12 and 13, it shall notify the applicant of the irregularity and at the same time inform the Office of origin.

(b) Such irregularities may be remedied by the applicant within three months from the date of the notification of the irregularity by the International Bureau. If an irregularity is not remedied within three months from the date of the notification of that irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the applicant and the Office of origin.

(3) *[Irregularity to Be Remedied by the Applicant or by the Office of Origin]* (a) Notwithstanding paragraph (2), where the fees payable under Rule 10 have been paid to the International Bureau by the Office of origin and the International Bureau considers that the amount of the fees received is less than the amount required, it shall notify at the same time the Office of origin and the applicant. The notification shall specify the missing amount.

(b) The missing amount may be paid by the Office of origin or by the applicant within three months from the date of the notification by the International Bureau. If the missing amount is not paid within three months from the date of the notification of the irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the Office of origin and the applicant.

(4) *[Irregularities to Be Remedied by the Office of Origin]* (a) If the International Bureau (i) finds that the international application does not fulfill the requirements of Rule 2 or was not presented on the official form prescribed under Rule 9(2)(a),

(ii) finds that the international application contains any of the irregularities referred to in Rule 15(1),

(iii) considers that the international application contains irregularities relating to the entitlement of the applicant to file an international application,

(iv) considers that the international application contains irregularities relating to the declaration by the Office of origin referred to in Rule 9(5)(d),

(v) ~~[Deleted]~~

(vi) finds that the international application is not signed by the Office of origin, or

(vii) finds that the international application does not contain the date and number of the basic application or basic registration, as the case may be, it shall notify the Office of origin and at the same time inform the applicant.

(b) Such irregularities may be remedied by the Office of origin within three months from the date of notification of the irregularity by the International Bureau. If an irregularity is not remedied within three months from the date of the notification of that irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the Office of origin and the applicant.

(5) *[Reimbursement of Fees]* Where, in accordance with paragraphs (2)(b), (3) or (4)(b), the international application is considered abandoned, the International Bureau shall refund any fees paid in respect of that application, after deduction of an amount corresponding to one-half of the basic fee referred to in items ~~s-1.1.1, 2.1.1 or 3.1.1~~ of the Schedule of Fees, to the party having paid those fees.

(6) *[Other Irregularity With Respect to the Designation of a Contracting Party-Under the Protocol]* (a) Where, in accordance with Article 3(4) of the Protocol, an international application is received by the International Bureau within a period of two months from the date of receipt of that international application by the Office of origin and the International Bureau considers that a declaration of intention to use the mark is required according to Rule 9(5)(f) but is missing or does not comply with the applicable requirements, the International Bureau shall promptly notify accordingly and at the same time the applicant and the Office of origin.

(b) The declaration of intention to use the mark shall be deemed to have been received by the International Bureau together with the international application if the missing or corrected declaration is received by the International Bureau within the period of two months referred to in subparagraph (a).

(c) The international application shall be deemed not to contain the designation of the Contracting Party for which a declaration of intention to use the mark is required if the missing or corrected declaration is received after the period of two months referred to in subparagraph (b). The International Bureau shall notify accordingly and at the same time the applicant and the Office of origin, reimburse any designation fee already paid in respect of that Contracting Party and indicate that the designation of the said Contracting Party may be effected as a subsequent designation under Rule 24, provided that such designation is accompanied by the required declaration.

(7) *[International Application Not Considered as Such]* If the international application is presented direct to the International Bureau by the applicant or does not comply with the requirement applicable under Rule 6(1), the international application shall not be considered as such and shall be returned to the sender.

*Rule 12*  
*Irregularities with Respect to the*  
*Classification of Goods and Services*

(1) *[Proposal for Classification]* (a) If the International Bureau considers that the requirements of Rule 9(4)(a)(xiii) are not complied with, it shall make a proposal of its own for the classification and grouping and shall send a notification of its proposal to the Office of origin and at the same time inform the applicant.

(b) The notification of the proposal shall also state the amount, if any, of the fees due as a consequence of the proposed classification and grouping.

(2) *[Opinion Differing from the Proposal]* The Office of origin may communicate to the International Bureau an opinion on the proposed classification and grouping within three months from the date of the notification of the proposal.

(3) *[Reminder of the Proposal]* If, within two months from the date of the notification referred to in paragraph (1)(a), the Office of origin has not communicated an opinion on the proposed classification and grouping, the International Bureau shall send to the Office of origin and to the applicant a communication reiterating the proposal. The sending of such a communication shall not affect the three-month period referred to in paragraph (2).

(4) *[Withdrawal of Proposal]* If, in the light of the opinion communicated under paragraph (2), the International Bureau withdraws its proposal, it shall notify the Office of origin accordingly and at the same time inform the applicant.

(5) *[Modification of Proposal]* If, in the light of the opinion communicated under paragraph (2), the International Bureau modifies its proposal, it shall notify the Office of origin and at the same time inform the applicant of such modification and of any consequent changes in the amount indicated under paragraph (1)(b).

(6) [*Confirmation of Proposal*] If, notwithstanding the opinion referred to in paragraph (2), the International Bureau confirms its proposal, it shall notify the Office of origin accordingly and at the same time inform the applicant.

(7) [*Fees*] (a) If no opinion has been communicated to the International Bureau under paragraph (2), the amount referred to in paragraph (1)(b) shall be payable within four months from the date of the notification referred to in paragraph (1)(a), failing which the international application shall be considered abandoned and the International Bureau shall notify the Office of origin accordingly and at the same time inform the applicant.

(b) If an opinion has been communicated to the International Bureau under paragraph (2), the amount referred to in paragraph (1)(b) or, where applicable, paragraph (5) shall be payable within three months from the date of the communication by the International Bureau of the modification or confirmation of its proposal under paragraph (5) or (6), as the case may be, failing which the international application shall be considered abandoned and the International Bureau shall notify the Office of origin accordingly and at the same time inform the applicant.

(c) If an opinion has been communicated to the International Bureau under paragraph (2) and if, in the light of that opinion, the International Bureau withdraws its proposal in accordance with paragraph (4), the amount referred to in paragraph (1)(b) shall not be due.

(8) [*Reimbursement of Fees*] Where, in accordance with paragraph (7), the international application is considered abandoned, the International Bureau shall refund any fees paid in respect of that application, after deduction of an amount corresponding to one-half of the basic fee referred to in items ~~s 1.1.1, 2.1.1 or 3.1.1~~ of the Schedule of Fees, to the party having paid those fees.

(8bis) [*Examination of Limitations*] The International Bureau shall examine limitations contained in an international application, applying paragraphs (1)(a) and (2) to (6) *mutatis mutandis*. Where the International Bureau cannot group the goods and services listed in the limitation under the classes of the International Classification of Goods and Services listed in the international application concerned, as amended pursuant to paragraphs (1) to (6), as the case may be, it shall issue an irregularity. Where the irregularity is not remedied within three months from the date of the notification of the irregularity, the limitation shall be deemed not to contain the goods and services concerned.

(9) [*Classification in the Registration*] Subject to the conformity of the international application with the other applicable requirements, the mark shall be registered with the classification and grouping that the International Bureau considers to be correct.

*Rule 13*  
*Irregularities with Respect to the*  
*Indication of Goods and Services*

(1) [*Communication of Irregularity by the International Bureau to the Office of Origin*] If the International Bureau considers that any of the goods and services is indicated in the international application by a term that is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect, it shall notify the Office of origin accordingly and at the same time inform the applicant. In the same notification, the International Bureau may suggest a substitute term, or the deletion of the term.



(2) *[Time Allowed to Remedy Irregularity]* (a) The Office of origin may make a proposal for remedying the irregularity within three months from the date of the notification referred to in paragraph (1).

(b) If no proposal acceptable to the International Bureau for remedying the irregularity is made within the period indicated in subparagraph (a), the International Bureau shall include in the international registration the term as appearing in the international application, provided that the Office of origin has specified the class in which such term should be classified; the international registration shall contain an indication to the effect that, in the opinion of the International Bureau, the specified term is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect, as the case may be. Where no class has been specified by the Office of origin, the International Bureau shall delete the said term *ex officio* and shall notify the Office of origin accordingly and at the same time inform the applicant.

### Chapter 3 International Registrations

#### Rule 14 *Registration of the Mark in the International Register*

(1) *[Registration of the Mark in the International Register]* Where the International Bureau finds that the international application conforms to the applicable requirements, it shall register the mark in the International Register, notify the Offices of the designated Contracting Parties of the international registration and inform the Office of origin accordingly, and send a certificate to the holder. Where the Office of origin so wishes and has informed the International Bureau accordingly, the certificate shall be sent to the holder through the Office of origin.

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

- (i) all the data contained in the international application, except any priority claim under Rule 9(4)(a)(iv) where the date of the earlier filing is more than six months before the date of the international registration,
- (ii) the date of the international registration,
- (iii) the number of the international registration,
- (iv) where the mark can be classified according to the International Classification of Figurative Elements, and unless the international application contains a declaration to the effect that the applicant wishes that the mark be considered as a mark in standard characters, the relevant classification symbols of the said Classification as determined by the International Bureau,
- (v) ~~[Deleted]an indication, with respect to each designated Contracting Party, as to whether it is a Contracting Party designated under the Agreement or a Contracting Party designated under the Protocol.~~
- (vi) indications annexed to the international application in accordance with Rule 9(5)(g)(i) concerning the Member State or Member States in or for which an earlier mark, for which seniority is claimed, is registered, the date from which the registration of that earlier mark was effective and the number of the relevant registration.

*Rule 15*  
*Date of the International Registration*

(1) *[Irregularities Affecting the Date of the International Registration]* Where the international application received by the International Bureau does not contain all of the following elements:

- (i) indications allowing the identity of the applicant to be established and sufficient to contact the applicant or ~~his~~<sup>the</sup> representative, if any,
- (ii) the Contracting Parties which are designated,
- (iii) a reproduction of the mark,
- (iv) the indication of the goods and services for which registration of the mark is sought,

the international registration shall bear the date on which the last of the missing elements reached the International Bureau, provided that, where the last of the missing elements reaches the International Bureau within the two-month time limit referred to in ~~Article 3(4) of the Agreement and~~ Article 3(4) of the Protocol, the international registration shall bear the date on which the defective international application was received ~~or, as provided in Rule 11(1), is deemed to have been received~~ by the Office of origin.

(2) *[Date of the International Registration in Other Cases]* In any other case, the international registration shall bear the date determined in accordance with ~~Article 3(4) of the Agreement and~~ Article 3(4) of the Protocol.

**Chapter 4**  
**Facts in Contracting Parties**  
**Affecting International Registrations**

*Rule 16*  
*Possibility of Notification of a Provisional Refusal*  
*Based on an Opposition Under Article 5(2)(c) of the Protocol*

(1) *[Information Relating to Possible Oppositions and Time Limit for Notifying Provisional Refusal Based on an Opposition]* (a) Subject to Article 9sexies(1)(b) of the Protocol, where a declaration has been made by a Contracting Party pursuant to Article 5(2)(b) and (c), first sentence, of the Protocol, the Office of that Contracting Party shall, where it has become apparent with regard to a given international registration designating that Contracting Party that the opposition period will expire too late for any provisional refusal based on an opposition to be notified to the International Bureau within the 18-month time limit referred to in Article 5(2)(b), inform the International Bureau of the number, and the name of the holder, of that international registration.

(b) Where, at the time of the communication of the information referred to in subparagraph (a), the dates on which the opposition period begins and ends are known, those dates shall be indicated in the communication. If such dates are not yet known at that time, they shall be communicated to the International Bureau as soon as they are known<sup>1</sup>.

(c) Where subparagraph (a) applies and the Office referred to in the said subparagraph has, before the expiry of the 18-month time limit referred to in the same subparagraph, informed the International Bureau of the fact that the time limit for filing oppositions will expire within the 30 days preceding the expiry of the 18-month time limit and of the possibility that oppositions may be filed during those 30 days, a provisional refusal based on an opposition filed during the said 30 days may be notified to the International Bureau within one month from the date of filing of the opposition.

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<sup>1</sup> In adopting this provision, the Assembly of the Madrid Union understood that if the opposition period is extendable, the Office may communicate only the date the opposition period begins.

(2) *[Recording and Transmittal of the Information]* The International Bureau shall record in the International Register the information received under paragraph (1) and shall transmit that information to the holder.

*Rule 17*  
*Provisional Refusal*

(1) *[Notification of Provisional Refusal]* (a) A notification of provisional refusal may comprise a declaration stating the grounds on which the Office making the notification considers that protection cannot be granted in the Contracting Party concerned (“*ex officio* provisional refusal”) or a declaration that protection cannot be granted in the Contracting Party concerned because an opposition has been filed (“provisional refusal based on an opposition”) or both.

(b) A notification of provisional refusal shall relate to one international registration, shall be dated and shall be signed by the Office making it.

(2) *[Content of the Notification]* A notification of provisional refusal shall contain or indicate

(i) the Office making the notification,  
(ii) the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number,

(iii) [Deleted]

(iv) all the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law,

(v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a reproduction, of the former mark, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,

(vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are affected, or are not affected, by the provisional refusal,

(vii) the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires, and the authority with which such request for review, appeal or response should be filed, with the indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

(3) *[Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition]* Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name and address of the opponent; however, notwithstanding paragraph (2)(v), the Office making the notification must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.



(4) *[Recording; Transmittal of Copies of Notifications]* The International Bureau shall record the provisional refusal in the International Register together with the data contained in the notification, with an indication of the date on which the notification was sent or is regarded under Rule 18(1)(d) as having been sent to the International Bureau and shall transmit a copy thereof to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies, and, at the same time, to the holder.

(5) *[Declarations Relating to the Possibility of Review]* (a) [Deleted]

(b) [Deleted]

(c) [Deleted]

(d) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party,

(i) any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such review has been requested by the holder, and

(ii) the decision taken on the said review may be the subject of a further review or appeal before the Office.

Where this declaration applies and the Office is not in a position to communicate the said decision directly to the holder of the international registration concerned, the Office shall, notwithstanding the fact that all procedures before the said Office relating to the protection of the mark may not have been completed, send the statement referred to in Rule 18*ter*(2) or (3) to the International Bureau immediately following the said decision. Any further decision affecting the protection of the mark shall be sent to the International Bureau in accordance with Rule 18*ter*(4).

(e) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party, any *ex officio* provisional refusal that has been notified to the International Bureau is not open to review before the said Office. Where this declaration applies, any *ex officio* notification of a provisional refusal by the said Office shall be deemed to include a statement in accordance with Rule 18*ter*(2)(ii) or (3).

(6) [Deleted]

#### *Rule 18* *Irregular Notifications of Provisional Refusal*

(1) ~~*[Contracting Party Designated Under the Agreement General]*~~ (a) A notification of provisional refusal communicated by the Office of a designated Contracting Party ~~designated under the Agreement~~ shall not be regarded as such by the International Bureau

(i) if it does not contain any international registration number, unless other indications contained in the notification permit the international registration to which the provisional refusal relates to be identified,

(ii) if it does not indicate any grounds for refusal, or

(iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of ~~one year~~ the time limit applicable under Article 5(2)(a) or, subject to Article 9*sexies*(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol, from the date on which the recording of the international registration or the recording of the designation made subsequently to the international registration has been effected, it being understood that the said date is the same as the date of sending the notification of the international registration or of the designation made subsequently.

(b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

(c) If the notification

(i) is not signed on behalf of the Office which communicated it, or does not otherwise comply with the requirements of Rule 2 or with the requirement applicable under Rule 6(2),

(ii) does not contain, where applicable, the details of the mark with which the mark that is the subject of the international registration appears to be in conflict (Rule 17(2)(v) and (3)),

(iii) does not comply with the requirements of Rule 17(2)(vi),

(iv) does not comply with the requirements of Rule 17(2)(vii), or

(v) [Deleted]

(vi) does not contain, where applicable, the name and address of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)), the International Bureau shall, except where subparagraph (d) applies, nonetheless record the provisional refusal in the International Register.

The International Bureau shall invite the Office that communicated the provisional refusal to send a rectified notification within two months from the invitation and shall transmit to the holder copies of the irregular notification and of the invitation sent to the Office concerned.

(d) Where the notification does not comply with the requirements of Rule 17(2)(vii), the provisional refusal shall not be recorded in the International Register. If however a rectified notification is sent within the time limit referred to in subparagraph (c), it shall be regarded, for the purposes of Article 5 of the [Agreement Protocol](#), as having been sent to the International Bureau on the date on which the defective notification had been sent to it. If the notification is not so rectified, it shall not be regarded as a notification of provisional refusal. In the latter case, the International Bureau shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

(e) Any rectified notification shall, where the applicable law so permits, indicate a new time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires.

(f) The International Bureau shall transmit a copy of any rectified notification to the holder.

(2) [~~Contracting Party Designated Under the Protocol~~ [Notification of Provisional Refusal Made Under Article 5\(2\)\(c\) of the Protocol](#)] (a) [~~Deleted~~ Paragraph (1) shall also apply in the case of a notification of provisional refusal communicated by the Office of a Contracting Party designated under the Protocol, it being understood that the time limit referred to in paragraph (1)(a)(iii) shall be the time limit applicable under Article 5(2)(a) or, subject to Article 9sexies(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol.

(b) Paragraph (1)(a) shall apply to determine whether the time limit before the expiry of which the Office of the Contracting Party concerned must give the International Bureau the information referred to in Article 5(2)(c)(i) of the Protocol has been complied with. If such information is given after the expiry of that time limit, it shall be regarded as not having been given and the International Bureau shall inform the Office concerned accordingly.

(c) Where the notification of provisional refusal based on an opposition is made under Article 5(2)(c)(ii) of the Protocol without the requirements of Article 5(2)(c)(i) of the Protocol having been complied with, it shall not be regarded as a notification of provisional refusal. In such a case, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

*Rule 18bis*  
*Interim Status of a Mark in a Designated Contracting Party*

(1) *[Ex Officio Examination Completed but Opposition or Observations by Third Parties Still Possible]* (a) An Office which has not communicated a notification of provisional refusal may, within the period applicable under ~~Article 5(2) of the Agreement or~~ Article 5(2)(a) or (b) of the Protocol, send to the International Bureau a statement to the effect that the *ex officio* examination has been completed and that the Office has found no grounds for refusal but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed<sup>2</sup>.

(b) An Office which has communicated a notification of provisional refusal may send to the International Bureau a statement to the effect that the *ex officio* examination has been completed but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed.

(2) *[Recording, Information to the Holder and Transmittal of Copies]* The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

*Rule 18ter*  
*Final Disposition on Status of a Mark in a Designated Contracting Party*

(1) *[Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated]*<sup>3</sup> When, before the expiry of the period applicable under ~~Article 5(2) of the Agreement or~~ Article 5(2)(a), (b) or (c) of the Protocol, all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned<sup>4</sup>.

(2) *[Statement of Grant of Protection Following a Provisional Refusal]* Except where it sends a statement under paragraph (3), an Office which has communicated a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau either

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or

(ii) a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned.

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<sup>2</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“The references in Rule 18bis to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations.”

<sup>3</sup> In adopting this provision, the Assembly of the Madrid Union understood that a statement of grant of protection could concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of these international registrations.

<sup>4</sup> In adopting paragraphs (1) and (2) of this rule, the Assembly of the Madrid Union understood that where Rule 34(3) applies, the grant of protection will be subject to the payment of the second part of the fee.

(3) *[Confirmation of Total Provisional Refusal]* An Office which has sent to the International Bureau a notification of a total provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed and the Office has decided to confirm refusal of the protection of the mark in the Contracting Party concerned for all goods and services, send to the International Bureau a statement to that effect.

(4) *[Further Decision]* Where a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2) ~~of the Agreement or~~ of the Protocol, or, where following the sending of a statement under paragraph (1), (2) or (3), a further decision, taken by the Office or other authority, affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, without prejudice to Rule 19, send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in the Contracting Party concerned<sup>5</sup>.

(5) *[Recording, Information to the Holder and Transmittal of Copies]* The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

#### *Rule 19* *Invalidations in Designated Contracting Parties*

(1) *[Contents of the Notification of Invalidation]* Where the effects of an international registration are invalidated in a designated Contracting Party under ~~Article 5(6) of the Agreement or~~ Article 5(6) of the Protocol and the invalidation is no longer subject to appeal, the Office of the Contracting Party whose competent authority has pronounced the invalidation shall notify the International Bureau accordingly. The notification shall contain or indicate

- (i) the authority which pronounced the invalidation,
- (ii) the fact that the invalidation is no longer subject to appeal,
- (iii) the number of the international registration,
- (iv) the name of the holder,
- (v) if the invalidation does not concern all the goods and services, those in respect of which the invalidation has been pronounced or those in respect of which the invalidation has not been pronounced, and
- (vi) the date on which the invalidation was pronounced and, where possible, its effective date.

(2) *[Recording of the Invalidation and Information to the Holder and the Office Concerned]* (a) The International Bureau shall record the invalidation in the International Register, together with the data contained in the notification of invalidation, and shall inform accordingly the holder. The International Bureau shall also inform the Office that communicated the notification of invalidation of the date on which the invalidation was recorded in the International Register if that Office has requested to receive such information.

(b) The invalidation shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

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<sup>5</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“The reference in Rule 18ter(4) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed.”

*Rule 20*  
*Restriction of the Holder's Right of Disposal*

(1) *[Communication of Information]* (a) The holder of an international registration or the Office of the Contracting Party of the holder may inform the International Bureau that the holder's right to dispose of the international registration has been restricted and, if appropriate, indicate the Contracting Parties concerned.

(b) The Office of any designated Contracting Party may inform the International Bureau that the holder's right of disposal has been restricted in respect of the international registration in the territory of that Contracting Party.

(c) Information given in accordance with subparagraph (a) or (b) shall consist of a summary statement of the main facts concerning the restriction.

(2) *[Partial or Total Removal of Restriction]* Where the International Bureau has been informed of a restriction of the holder's right of disposal in accordance with paragraph (1), the party that communicated the information shall also inform the International Bureau of any partial or total removal of that restriction.

(3) *[Recording]* (a) The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform accordingly the holder, the Office of the Contracting Party of the holder and the Offices of the designated Contracting Parties concerned.

(b) The information communicated under paragraphs (1) and (2) shall be recorded as of the date of its receipt by the International Bureau, provided that the communication complies with the applicable requirements.

*Rule 20bis*  
*Licenses*

(1) *[Request for the Recording of a License]* (a) A request for the recording of a license shall be presented to the International Bureau on the relevant official form by the holder or, if the Office admits such presentation, by the Office of the Contracting Party of the holder or the Office of a Contracting Party with respect to which the license is granted.

(b) The request shall indicate

- (i) the number of the international registration concerned,
- (ii) the name of the holder,
- (iii) the name and address of the licensee, given in accordance with the Administrative Instructions,
- (iv) the designated Contracting Parties with respect to which the license is granted,
- (v) that the license is granted for all the goods and services covered by the international registration, or the goods and services for which the license is granted, grouped in the appropriate classes of the International Classification of Goods and Services.

(c) The request may also indicate

- (i) where the licensee is a natural person, the State of which the licensee is a national,
- (ii) where the licensee is a legal entity, the legal nature of that entity and the State and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized,
- (iii) that the license concerns only a part of the territory of a specified designated Contracting Party,
- (iv) where the licensee has a representative, the name and address of the representative, given in accordance with the Administrative Instructions,

- (v) where the license is an exclusive license or a sole license, that fact,<sup>6</sup>
  - (vi) where applicable, the duration of the license.
- (d) The request shall be signed by the holder or by the Office through which it is presented.

(2) *[Irregular Request]* (a) If the request for the recording of a license does not comply with the requirements of paragraph (1)(a), (b) and (d), the International Bureau shall notify that fact to the holder and, if the request was presented by an Office, to that Office.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

(3) *[Recording and Notification]* (a) Where the request complies with the requirements of paragraph (1)(a), (b) and (d), the International Bureau shall record the license in the International Register, together with the information contained in the request, shall notify accordingly the Offices of the designated Contracting Parties in respect of which the license is granted and shall inform at the same time the holder and, if the request was presented by an Office, that Office.

(b) The license shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements.

(c) Notwithstanding subparagraph (b), where continued processing has been recorded under Rule 5*bis*, the license shall be recorded in the International Register as of the date of expiry of the time limit specified in paragraph (2)(b).

(4) *[Amendment or Cancellation of the Recording of a License]* Paragraphs (1) to (3) shall apply *mutatis mutandis* to a request for the amendment or cancellation of the recording of a license.

(5) *[Declaration that the Recording of a Given License Has No Effect]* (a) The Office of a designated Contracting Party which is notified by the International Bureau of the recording of a license in respect of that Contracting Party may declare that such recording has no effect in the said Contracting Party.

(b) The declaration referred to in subparagraph (a) shall indicate

- (i) the reasons for which the recording of the license has no effect,
- (ii) where the declaration does not affect all the goods and services to which the license relates, those which are affected by the declaration or those which are not affected by the declaration,

(iii) the corresponding essential provisions of the law, and

(iv) whether such declaration may be subject to review or appeal.

(c) The declaration referred to in subparagraph (a) shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in paragraph (3) was sent to the Office concerned.

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the license. The declaration shall be recorded as of the date of receipt by the International Bureau of a communication complying with the applicable requirements.

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<sup>6</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“Where a request to record a license does not include the indication, provided for in Rule 20*bis*(1)(c)(v), that the license is exclusive or sole, it may be considered that the license is non-exclusive.”



(e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and notify accordingly the party (holder or Office) that presented the request to record the license.

(6) *[Declaration that the Recording of Licenses in the International Register Has No Effect in a Contracting Party]* (a) The Office of a Contracting Party the law of which does not provide for the recording of trademark licenses may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party.

(b) The Office of a Contracting Party the law of which provides for the recording of trademark licenses may, before the date on which this Rule comes into force or the date on which the said Contracting Party becomes bound by ~~the Agreement or~~ the Protocol, notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party. Such notification may be withdrawn at any time<sup>7</sup>.

*Rule 21*  
*Replacement of a National or Regional Registration*  
*by an International Registration*

(1) *[Notification]* Where, in accordance with ~~Article 4bis(2) of the Agreement or~~ Article 4bis(2) of the Protocol, the Office of a designated Contracting Party has taken note in its Register, following a request made direct by the holder with that Office, that a national or a regional registration has been replaced by an international registration, that Office shall notify the International Bureau accordingly. Such notification shall indicate

- (i) the number of the international registration concerned,
- (ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and
- (iii) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration which has been replaced by the international registration.

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.

(2) *[Recording]* (a) The International Bureau shall record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.

(b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

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<sup>7</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“Subparagraph (a) of Rule 20bis(6) deals with the case of a notification by a Contracting Party whose law does not provide for the recording of trademark licenses; such a notification may be made at any time; subparagraph (b) on the other hand deals with the case of a notification by a Contracting Party whose law does provide for the recording of trademark licenses but which is unable at present to give effect to the recording of a license in the International Register; this latter notification, which may be withdrawn at any time, may only be made before this Rule has come into force or before the Contracting Party has become bound by the Agreement or the Protocol.”

*Rule 21bis*  
*Other Facts Concerning Seniority Claim*

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

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

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

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

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

*Rule 22*  
*Ceasing of Effect of the Basic Application,  
of the Registration Resulting Therefrom,  
or of the Basic Registration*

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]* (a) Where ~~Article 6(3) and (4) of the Agreement or~~ Article 6(3) and (4) of the Protocol, ~~or both,~~ apply, the Office of origin shall notify the International Bureau accordingly and shall indicate

(i) the number of the international registration,  
(ii) the name of the holder,  
(iii) the facts and decisions affecting the basic registration, or, where the international registration concerned is based on a basic application which has not resulted in a registration, the facts and decisions affecting the basic application, or, where the international registration is based on a basic application which has resulted in a registration, the facts and decisions affecting that registration, and the effective date of those facts and decisions, and  
(iv) where the said facts and decisions affect the international registration only with respect to some of the goods and services, those goods and services which are affected by the facts and decisions or those which are not affected by the facts and decisions.

(b) Where ~~a judicial action referred to in Article 6(4) of the Agreement, or a proceeding referred to in item (i), (ii) or (iii) of Article 6(3) of the Protocol,~~ began before the expiry of the five-year period but has not, before the expiry of that period, resulted in the final decision referred to in ~~Article 6(4) of the Agreement, or in the final decision referred to in~~ the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof and as soon as possible after the expiry of the said period, notify the International Bureau accordingly.



(c) Once the ~~judicial action or~~ proceeding referred to in subparagraph (b) has resulted ~~in the final decision referred to in Article 6(4) of the Agreement,~~ in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv). Where the judicial action or proceedings referred to in subparagraph (b) has been completed and has not resulted in any of the aforesaid final decisions, withdrawal or renunciation, the Office of origin shall, where it is aware thereof or at the request of the holder, promptly notify the International Bureau accordingly.

(2) *[Recording and Transmittal of the Notification; Cancellation of the International Registration]* (a) The International Bureau shall record any notification referred to in paragraph (1) in the International Register and shall transmit a copy of the notification to the Offices of the designated Contracting Parties and to the holder.

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register. The International Bureau shall also cancel, to the extent applicable, international registrations resulting from partial change in ownership or division recorded under the international registration that has been cancelled, following the above-mentioned notification, and those resulting from their merger.

(c) Where the international registration has been cancelled in the International Register in accordance with subparagraph (b), the International Bureau shall notify the Offices of the designated Contracting Parties and the holder of the following:

(i) the date on which the international registration was cancelled in the International Register;

(ii) where the cancellation concerns all goods and services, that fact;

(iii) where the cancellation concerns only some of the goods and services, the goods and services indicated under paragraph (1)(a)(iv).

### *Rule 23*

#### *Division or Merger of the Basic Applications, of the Registrations Resulting Therefrom, or of the Basic Registrations*

(1) *[Notification of the Division of the Basic Application or Merger of the Basic Applications]* Where, during the five-year period referred to in Article 6(3) of the Protocol, the basic application is divided into two or more applications, or several basic applications are merged into a single application, the Office of origin shall notify the International Bureau accordingly and shall indicate

(i) the number of the international registration or, if the international registration has not yet been effected, the number of the basic application,

(ii) the name of the holder or applicant,

(iii) the number of each application resulting from the division or the number of the application resulting from the merger.

(2) *[Recording and Notification by the International Bureau]* The International Bureau shall record the notification referred to in paragraph (1) in the International Register and shall notify the Offices of the designated Contracting Parties and, at the same time, the holder.

(3) *[Division or Merger of Registrations Resulting from Basic Applications or of Basic Registrations]* Paragraphs (1) and (2) shall apply, *mutatis mutandis*, to the division of any registration or merger of any registrations which resulted from the basic application or applications during the five-year period referred to in Article 6(3) of the Protocol and to the division of the basic registration or merger of the basic registrations during the five-year period referred to ~~in Article 6(3) of the Agreement and~~ in Article 6(3) of the Protocol.

*Rule 23bis*  
*Communications from the Offices of the*  
*Designated Contracting Parties sSent tThrough*  
*the International Bureau*

(1) *[Communications ~~from the Offices of the designated Contracting Parties n~~Not eCovered by tThese Regulations]* Where the law of a designated Contracting Party does not allow the Office to transmit a communication concerning an international registration directly to the holder, that Office may request the International Bureau to transmit that communication to the holder on its behalf.

(2) *[Format of the Communication]* The International Bureau shall establish the format in which the communication referred to in paragraph (1) shall be sent by the Office concerned.

(3) *[Transmission to the hHolder]* The International Bureau shall transmit the communication referred to in paragraph (1) to the holder, in the format established by the International Bureau, without examining its contents or recording it in the International Register.

**Chapter 5**  
**Subsequent Designations; Changes**

*Rule 24*  
*Designation Subsequent to the International Registration*

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

(b) ~~[Deleted] Where the Contracting Party of the holder is bound by the Agreement, the holder may designate, under the Agreement, any Contracting Party that is bound by the Agreement, provided that the said Contracting Parties are not both bound also by the Protocol.~~

(c) ~~[Deleted] Where the Contracting Party of the holder is bound by the Protocol, the holder may designate, under the Protocol, any Contracting Party that is bound by the Protocol, whether or not the said Contracting Parties are both also bound by the Agreement.~~

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

(i) [Deleted]

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

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

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

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

- (i) the number of the international registration concerned,
- (ii) the name and address of the holder,
- (iii) the Contracting Party that is designated,
- (iv) where the subsequent designation is for all the goods and services listed in the international registration concerned, that fact, or, where the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services,
- (v) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and,
- (vi) where the subsequent designation is presented by an Office, the date on which it was received by that Office.

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

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

(ii) be included in the subsequent designation.

(c) The subsequent designation may also contain

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

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

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

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

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

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

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

(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraphs ~~(1)(b) or (c) or~~ (3)(b)(i) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designation shall be deemed not to contain the designation of those Contracting Parties, and any complementary or individual fees already paid in respect of those Contracting Parties shall be reimbursed. Where the requirements of paragraphs ~~(1)(b) or (c) or~~ (3)(b)(i) are complied with in respect of none of the designated Contracting Parties, subparagraph (b) shall apply.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

*Rule 25*  
*Request for Recording*

(1) *[Presentation of the Request]* (a) A request for recording shall be presented to the International Bureau on the relevant official form, ~~in one copy~~, where the request relates to any of the following:

(i) a change in the ownership of the international registration in respect of all or some of the goods and services and all or some of the designated Contracting Parties;

(ii) a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties;

(iii) a renunciation in respect of some of the designated Contracting Parties for all the goods and services;

(iv) a change in the name or address of the holder or, where the holder is a legal entity, an introduction of or a change in the indications concerning the legal nature of the holder and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized;

(v) cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;

(vi) a change in the name or address of the representative.

(b) ~~Subject to subparagraph (c), t~~The request shall be presented by the holder or by the Office of the Contracting Party of the holder; however, the request for the recording of a change in ownership may be presented through the Office of the Contracting Party, or of one of the Contracting Parties, indicated in the said request in accordance with paragraph (2)(a)(iv).

(c) ~~[Deleted]The request for the recording of a renunciation or a cancellation may not be presented directly by the holder where the renunciation or cancellation affects any Contracting Party whose designation is, on the date of receipt of the request by the International Bureau, governed by the Agreement.~~

(d) Where the request is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

(2) *[Contents of the Request]* (a) A request under paragraph (1)(a) shall, in addition to the requested recording, contain or indicate

(i) the number of the international registration concerned,

(ii) the name of the holder or the name of the representative where the change relates to the name or address of the representative,

(iii) in the case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, of the natural person or legal entity mentioned in the request as the new holder of the international registration (hereinafter referred to as "the transferee"),

(iv) in the case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the transferee fulfills the conditions, ~~under Articles 1(2) and 2 of the Agreement or~~ under Article 2 of the Protocol, to be the holder of an international registration,



(v) in the case of a change in the ownership of the international registration, where the address of the transferee given in accordance with item (iii) is not in the territory of the Contracting Party, or of one of the Contracting Parties, given in accordance with item (iv), and unless the transferee has indicated ~~that he is to be~~ a national of a Contracting State or of a State member of a Contracting Organization, the address of the establishment, or the domicile, of the transferee in the Contracting Party, or in one of the Contracting Parties, in respect of which the transferee fulfills the conditions to be the holder of an international registration,

(vi) in the case of a change in the ownership of the international registration that does not relate to all the goods and services and to all the designated Contracting Parties, the goods and services and the designated Contracting Parties to which the change in ownership relates, and

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

(b) The request for the recording of a change in the ownership of the international registration may also contain,

(i) where the transferee is a natural person, an indication of the State of which the transferee is a national;

(ii) where the transferee is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized.

(c) The request for recording of a change or a cancellation may also contain a request that it be recorded before, or after, the recording of another change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration.

(d) The request for the recording of a limitation shall group the limited goods and services only under the corresponding numbers of the classes of the International Classification of Goods and Services appearing in the international registration or, where the limitation affects all the goods and services in one or more of those classes, indicate the classes to be deleted.

(3) ~~[Deleted]~~~~[Request Not Admissible]~~ A change in the ownership of an international registration may not be recorded in respect of a given designated Contracting Party if that Contracting Party

~~(i) is bound by the Agreement but not by the Protocol, and the Contracting Party indicated under paragraph (2)(a)(iv) is not bound by the Agreement, or none of the Contracting Parties indicated under that paragraph is bound by the Agreement;~~

~~(ii) is bound by the Protocol but not by the Agreement, and the Contracting Party indicated under paragraph (2)(a)(iv) is not bound by the Protocol, or none of the Contracting Parties indicated under that paragraph is bound by the Protocol.~~

(4) *[Several Transferees]* Where the request for the recording of a change in the ownership of the international registration mentions several transferees, that change may not be recorded in respect of a given designated Contracting Party if any of the transferees does not fulfill the conditions to be holder of the international registration in respect of that Contracting Party.

*Rule 26*  
*Irregularities in Requests for Recording ~~u~~nder Rule 25*

(1) *[Irregular Request]* If a request under Rule 25(1)(a) does not comply with the applicable requirements, and subject to paragraph (3), the International Bureau shall notify that fact to the holder and, if the request was made by an Office, to that Office. For the purposes of this Rule, where the request is for the recording of a limitation, the International Bureau shall only examine whether the numbers of the classes indicated in the limitation appear in the international registration concerned.

(2) *[Time Allowed to Remedy Irregularity]* The irregularity may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request under Rule 25(1)(a) was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

(3) *[Requests Not Considered as Such]* If the requirements of Rule 25(1)(b) ~~or (c)~~ are not complied with, the request shall not be considered as such and the International Bureau shall inform the sender accordingly.

*Rule 27*  
*Recording and Notification with ~~r~~espect to Rule 25;  
Declaration that a Change in Ownership or a Limitation Has No Effect*

(1) *[Recording and Notification]* (a) The International Bureau shall, provided that the request referred to in Rule 25(1)(a) is in order, promptly record the indications, the change or the cancellation in the International Register, shall notify accordingly the Offices of the designated Contracting Parties in which the recording has effect or, in the case of a cancellation, the Offices of all the designated Contracting Parties, and shall inform at the same time the holder and, if the request was presented by an Office, that Office. Where the recording relates to a change in ownership, the International Bureau shall also inform the former holder in the case of a total change in ownership and the holder of the part of the international registration which has been assigned or otherwise transferred in the case of a partial change in ownership. Where the request for the recording of a cancellation was presented by the holder or by an Office other than the Office of origin during the five-year period referred to in ~~Article 6(3) of the Agreement~~ and Article 6(3) of the Protocol, the International Bureau shall also inform the Office of origin.

(b) The indications, the change or the cancellation shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements, except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

(c) Notwithstanding subparagraph (b), where continued processing has been recorded under Rule 5*bis*, the change or cancellation shall be recorded in the International Register as of the date of expiry of the time limit specified in Rule 26(2), except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

(2) *[Recording of Partial Change in Ownership]* (a) A change in ownership of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration concerned by the partial change in ownership.

(b) The part of the international registration for which a change in ownership has been recorded shall be deleted from the international registration concerned and recorded as a separate international registration.

(3) [Deleted]

(4) *[Declaration that a Change in Ownership Has No Effect]* (a) The Office of a designated Contracting Party which is notified, by the International Bureau, of a change in ownership affecting that Contracting Party may declare that the change in ownership has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the international registration concerned shall remain in the name of the transferor.

- (b) The declaration referred to in subparagraph (a) shall indicate
- (i) the reasons for which the change in ownership has no effect,
  - (ii) the corresponding essential provisions of the law, and
  - (iii) whether such declaration may be subject to review or appeal.

(c) The declaration referred to in subparagraph (a) shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in subparagraph (a) was sent to the Office concerned.

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and, as the case may be, record as a separate international registration that part of the international registration which has been the subject of the said declaration, and shall notify accordingly the party (holder or Office) that presented the request for the recording of a change in ownership and the new holder.

(e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and, as the case may be, modify the International Register accordingly, and shall notify accordingly the party (holder or Office) that presented the request for the recording of a change in ownership and the new holder.

(5) *[Declaration that a Limitation Has No Effect]* (a) The Office of a designated Contracting Party which is notified by the International Bureau of a limitation of the list of goods and services affecting that Contracting Party may declare that the limitation has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the limitation shall not apply to the goods and services affected by the declaration.

- (b) The declaration referred to in subparagraph (a) shall indicate
- (i) the reasons for which the limitation has no effect,
  - (ii) where the declaration does not affect all the goods and services to which the limitation relates, those which are affected by the declaration or those which are not affected by the declaration,
  - (iii) the corresponding essential provisions of the law, and
  - (iv) whether such declaration may be subject to review or appeal.

(c) The declaration referred to in subparagraph (a) shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in subparagraph (a) was sent to the Office concerned.

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the limitation.



(e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and notify accordingly the party (holder or Office) that presented the request to record the limitation.

*Rule 27bis*  
*Division of an International Registration*

(1) *[Request for the Division of an International Registration]* (a) A request by the holder for the division of an international registration for some only of the goods and services in respect of a designated Contracting Party shall be presented to the International Bureau on the relevant official form by the Office of that designated Contracting Party, once the latter is satisfied that the division whose recording is requested meets the requirements of its applicable law, including the requirements concerning fees.

(b) The request shall indicate

- (i) the Contracting Party of the Office presenting the request,
- (ii) the name of the Office presenting the request,
- (iii) the number of the international registration,
- (iv) the name of the holder,
- (v) the names of the goods and services to be set apart, grouped in the appropriate classes of the International Classification of Goods and Services,
- (vi) the amount of the fee being paid and the method of payment, or instructions to debit the required amount to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

(c) The request shall be signed by the Office presenting the request and, where the Office so requires, also by the holder.

(d) Any request presented under this paragraph may include or be accompanied by a statement sent in accordance with either Rule 18*bis* or 18*ter* for the goods and services listed in the request.

(2) *[Fee]* The division of an international registration shall be subject to the payment of the fee specified in item 7.7 of the Schedule of Fees.

(3) *[Irregular Request]* (a) If the request does not comply with the applicable requirements, the International Bureau shall invite the Office that presented the request to remedy the irregularity and at the same time inform the holder.

(b) If the irregularity is not remedied by the Office within three months from the date of the invitation under subparagraph (a), the request shall be considered abandoned and the International Bureau shall notify accordingly the Office that presented the request, it shall inform at the same time the holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee.

(4) *[Recording and Notification]* (a) Where the request complies with the applicable requirements, the International Bureau shall record the division, create a divisional international registration in the International Register, notify accordingly the Office that presented the request and shall inform at the same time the holder.

(b) The division of an international registration shall be recorded with the date of receipt by the International Bureau of the request or, where applicable, the date where the irregularity referred to in paragraph (3) was remedied.

(5) *[Request Not Considered as Such]* A request for the division of an international registration in respect of a designated Contracting Party that is not or is no longer designated for the classes of the International Classification of Goods and Services mentioned in the request will not be considered as such.

(6) *[Declaration that a Contracting Party Will Not Present Requests for Division]* A Contracting Party, the law of which does not provide for division of applications for the registration of a mark or registrations of a mark, may notify the Director General, before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by ~~the Agreement or~~ the Protocol, that it will not present to the International Bureau the request referred to in paragraph (1). This declaration may be withdrawn at any time.

*Rule 27ter*  
*Merger of International Registrations*

(1) *[Merger of International Registrations Resulting from the Recording of a Partial Change in Ownership]* Where the same natural person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change in ownership, the registrations shall be merged at the request of the said person or entity, made either direct or through the Office of the Contracting Party of the holder. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Offices of the designated Contracting Party or Parties affected by the change and shall inform at the same time the holder and, if the request was presented by an Office, that Office.

(2) *[Merger of International Registrations Resulting from the Recording of the Division of an International Registration]* (a) An international registration resulting from division shall be merged into the international registration it was divided from at the request of the holder, presented through the Office that presented the request referred to in paragraph (1) of Rule 27bis, provided that the same natural person or legal entity is the recorded holder in both aforementioned international registrations and the Office concerned is satisfied that the request meets the requirements of its applicable law, including the requirements concerning fees. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Office that presented the request and shall inform at the same time the holder.

(b) The Office of a Contracting Party, the law of which does not provide for the merger of registrations of a mark, may notify the Director General, before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the ~~Agreement or~~ the Protocol, that it will not present to the International Bureau the request referred to in subparagraph (a). This declaration may be withdrawn at any time.

*Rule 28*  
*Corrections in the International Register*

(1) *[Correction]* Where the International Bureau, acting *ex officio* or at the request of the holder or of an Office, considers that there is an error concerning an international registration in the International Register, it shall modify the Register accordingly.

(2) *[Notification]* The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect. In addition, where the Office that has requested the correction is not the Office of a designated Contracting Party in which the correction has effect, the International Bureau shall also inform that Office.

(3) *[Refusal Following a Correction]* Any Office referred to in paragraph (2) shall have the right to declare in a notification of provisional refusal addressed to the International Bureau that it considers that protection cannot, or can no longer, be granted to the international registration as corrected. ~~Article 5 of the Agreement or~~ Article 5 of the Protocol and Rules 16 to 18~~ter~~ shall apply *mutatis mutandis*, it being understood that the period allowed for sending the said notification shall be counted from the date of sending the notification of the correction to the Office concerned.

(4) *[Time Limit for Correction]* Notwithstanding paragraph (1), an error which is attributable to an Office and the correction of which would affect the rights deriving from the international registration may be corrected only if a request for correction is received by the International Bureau within nine months from the date of publication of the entry in the International Register which is the subject of the correction.

## Chapter 6 Renewals

### Rule 29 *Unofficial Notice of Expiry*

The fact that the unofficial notice referred to in ~~Article 7(4) of the Agreement and~~ Article 7(3) of the Protocol is not received shall not constitute an excuse for failure to comply with any time limit under Rule 30.

### Rule 30 *Details Concerning Renewal*

(1) *[Fees]* (a) The international registration shall be renewed upon payment, at the latest on the date on which the renewal of the international registration is due, of

- (i) the basic fee,
- (ii) where applicable, the supplementary fee, and,
- (iii) the complementary fee or individual fee, as the case may be, for each designated Contracting Party for which no statement of refusal under Rule 18~~ter~~ or invalidation, in respect of all the goods and services concerned, is recorded in the International Register, as specified or referred to in item 6 of the Schedule of Fees.

However, such payment may be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in item 6.5 of the Schedule of Fees is paid at the same time.

(b) If any payment made for the purposes of renewal is received by the International Bureau earlier than three months before the date on which the renewal of the international registration is due, it shall be considered as having been received three months before the date on which renewal is due.

(2) *[Further Details]* (a) Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no statement of refusal under Rule 18~~ter~~, in respect of all the goods and services concerned, is recorded in the International Register, payment of the required fees shall be accompanied by a statement by the holder that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18~~ter~~ is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee

or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party.

(c) The international registration shall not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration shall not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

(d) Where a statement under Rule 18ter(2)(ii) or (4) is recorded in the International Register, the international registration shall not be renewed in respect of the designated Contracting Party concerned for the goods and services that are not included in that statement, unless payment of the required fees is accompanied by a statement by the holder that the international registration is to be renewed also for those goods and services.

(e) The fact that the international registration is not renewed under subparagraph (d) in respect of all the goods and services concerned, shall not be considered to constitute a change for the purposes of ~~Article 7(2) of the Agreement or~~ Article 7(2) of the Protocol. The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of ~~Article 7(2) of the Agreement or~~ Article 7(2) of the Protocol.

(3) *[Insufficient Fees]* (a) If the amount of the fees received is less than the amount of the fees required for renewal, the International Bureau shall promptly notify at the same time both the holder and the representative, if any, accordingly. The notification shall specify the missing amount.

(b) If the amount of the fees received is, on the expiry of the period of six months referred to in paragraph (1)(a), less than the amount required under paragraph (1), the International Bureau shall not, subject to subparagraph (c), record the renewal, and shall reimburse the amount received to the party having paid it and notify accordingly the holder and the representative, if any.

(c) If the notification referred to in subparagraph (a) was sent during the three months preceding the expiry of the period of six months referred to in paragraph (1)(a) and if the amount of the fees received is, on the expiry of that period, less than the amount required under paragraph (1) but is at least 70% of that amount, the International Bureau shall proceed as provided in Rule 31(1) and (3). If the amount required is not fully paid within three months from the said notification, the International Bureau shall cancel the renewal, notify accordingly the holder, the representative, if any, and the Offices which had been notified of the renewal, and reimburse the amount received to the party having paid it.

(4) *[Period for Which Renewal Fees Are Paid]* The fees required for each renewal shall be paid for ten years, ~~irrespective of the fact that the international registration contains, in the list of designated Contracting Parties, only Contracting Parties whose designation is governed by the Agreement, only Contracting Parties whose designation is governed by the Protocol, or both Contracting Parties whose designation is governed by the Agreement and Contracting Parties whose designation is governed by the Protocol. As regards payments under the Agreement, the payment for ten years shall be considered to be a payment for an instalment of ten years.~~

*Rule 31*  
*Recording of the Renewal; Notification and Certificate*

(1) *[Recording and Effective Date of the Renewal]* Renewal shall be recorded in the International Register with the date on which renewal was due, even if the fees required for renewal are paid within the period of grace referred to in ~~Article 7(5) of the Agreement and in Article 7(4) of the Protocol.~~

(2) *[Renewal Date in the Case of Subsequent Designations]* The effective date of the renewal shall be the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register.

(3) *[Notification and Certificate]* The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the renewal and shall send a certificate to the holder.

(4) *[Notification in Case of Non-Renewal]* (a) Where an international registration is not renewed, the International Bureau shall notify accordingly the holder, the representative, if any, and the Offices of all of the Contracting Parties designated in that international registration.

(b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the holder, the representative, if any, and the Office of that Contracting Party accordingly.

**Chapter 7**  
**Gazette and Data Base**

*Rule 32*  
*Gazette*

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

(i) international registrations effected under Rule 14;  
(ii) information communicated under Rule 16(1);  
(iii) provisional refusals recorded under Rule 17(4), with an indication as to whether the refusal relates to all the goods and services or only some of them but without an indication of the goods and services concerned and without the grounds for refusal, and statements and information recorded under Rules 18*bis*(2) and 18*ter*(5);

(iv) renewals recorded under Rule 31(1);  
(v) subsequent designations recorded under Rule 24(8);  
(vi) continuation of effects of international registrations under Rule 39;  
(vii) recordings under Rule 27;  
(viii) cancellations effected under Rule 22(2) or recorded under Rule 27(1) or

Rule 34(3)(d);  
(viii*bis*) division recorded under Rule 27*bis*(4) and merger recorded under Rule 27*ter*.

(ix) corrections effected under Rule 28;  
(x) invalidations recorded under Rule 19(2);  
(xi) information recorded under Rules 20, 20*bis*, 21, 21*bis*, 22(2)(a), 23, ~~and 27(4) and 40(3);~~

(xii) international registrations which have not been renewed;  
(xiii) recordings of the appointment of the holder's representative communicated under Rule 3(2)(b) and cancellations at the request of the holder or the holder's representative under Rule 3(6)(a).

(b) The reproduction of the mark shall be published as it appears in the international application. Where the applicant has made the declaration referred to in Rule 9(4)(a)(vi), the publication shall indicate that fact.

(c) Where a color reproduction of the mark is furnished under Rule 9(4)(a)(v) or (vii), the Gazette shall contain both a reproduction of the mark in black and white and the reproduction in color.

(2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* The International Bureau shall publish in the Gazette

(i) any notification made under Rules 7, 20*bis*(6), 27*bis*(6), 27*ter*(2)(b) or 40(6) and any declaration made under Rule 17(5)(d) or (e);

(ii) any declarations made under Article 5(2)(b) or Article 5(2)(b) and (c), first sentence, of the Protocol;

(iii) any declarations made under Article 8(7) of the Protocol;

(iv) any notification made under Rule 34(2)(b) or (3)(a);

(v) a list of the days on which the International Bureau is not scheduled to be open to the public during the current and the following calendar year.

(3) *[Publications on the Website]* The International Bureau shall effect the publications under paragraphs (1) and (2) on the website of the World Intellectual Property Organization.

### *Rule 33* *Electronic Data Base*

(1) *[Contents of Data Base]* The data which are both recorded in the International Register and published in the Gazette under Rule 32 shall be entered in an electronic data base.

(2) *[Data Concerning Pending International Applications and Subsequent Designations]* If an international application or a designation under Rule 24 is not recorded in the International Register within three working days following the receipt by the International Bureau of the international application or designation, the International Bureau shall enter in the electronic data base, notwithstanding any irregularities that may exist in the international application or designation as received, all the data contained in the international application or designation.

(3) *[Access to Electronic Data Base]* The electronic data base shall be made accessible to the Offices of the Contracting Parties and, against payment of the prescribed fee, if any, to the public, by on-line access and through other appropriate means determined by the International Bureau. The cost of accessing shall be borne by the user. Data entered under paragraph (2) shall be accompanied by a warning to the effect that the International Bureau has not yet made a decision on the international application or on the designation under Rule 24.

## **Chapter 8** **Fees**

### *Rule 34* *Amounts and Payment of Fees*

(1) *[Amounts of Fees]* The amounts of fees due under ~~the Agreement~~, the Protocol or these Regulations, other than individual fees, are specified in the Schedule of Fees that is annexed to these Regulations and forms an integral part thereof.



(2) *[Payments]* (a) The fees indicated in the Schedule of Fees may be paid to the International Bureau by the applicant or the holder, or, where the Office of the Contracting Party of the holder accepts to collect and forward such fees, and the applicant or the holder so wishes, by that Office.

(b) Any Contracting Party whose Office accepts to collect and forward fees shall notify that fact to the Director General.

(3) *[Individual Fee Payable in Two Parts]* (a) A Contracting Party that makes or has made a declaration under Article 8(7) of the Protocol may notify the Director General that the individual fee to be paid in respect of a designation of that Contracting Party comprises two parts, the first part to be paid at the time of filing the international application or the subsequent designation of that Contracting Party and the second part to be paid at a later date which is determined in accordance with the law of that Contracting Party.

(b) Where subparagraph (a) applies, the references in items 2, ~~3~~ and 5 of the Schedule of Fees to an individual fee shall be construed as references to the first part of the individual fee.

(c) Where subparagraph (a) applies, the Office of the designated Contracting Party concerned shall notify the International Bureau when the payment of the second part of the individual fee becomes due. The notification shall indicate

- (i) the number of the international registration concerned,
- (ii) the name of the holder,
- (iii) the date by which the second part of the individual fee must be paid,
- (iv) where the amount of the second part of the individual fee is dependent on

the number of classes of goods and services for which the mark is protected in the designated Contracting Party concerned, the number of such classes.

(d) The International Bureau shall transmit the notification to the holder. Where the second part of the individual fee is paid within the applicable period, the International Bureau shall record the payment in the International Register and notify the Office of the Contracting Party concerned accordingly. Where the second part of the individual fee is not paid within the applicable period, the International Bureau shall notify the Office of the Contracting Party concerned, cancel the international registration in the International Register with respect to the Contracting Party concerned and notify the holder accordingly.

(4) *[Modes of Payment of Fees to the International Bureau]* Fees shall be paid to the International Bureau as specified in the Administrative Instructions.

(5) *[Indications Accompanying the Payment]* At the time of the payment of any fee to the International Bureau, an indication must be given,

- (i) before international registration, of the name of the applicant, the mark concerned and the purpose of the payment;
- (ii) after international registration, of the name of the holder, the number of the international registration concerned and the purpose of the payment.

(6) *[Date of Payment]* (a) Subject to Rule 30(1)(b) and to subparagraph (b), any fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives the required amount.

(b) Where the required amount is available in an account opened with the International Bureau and that Bureau has received instructions from the holder of the account to debit it, the fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives an international application, a subsequent designation, an instruction to debit the second part of an individual fee, a request for the recording of a change or an instruction to renew an international registration.

(7) *[Change in the Amount of the Fees]* (a) Where the amount of the fees payable in respect of the filing of an international application is changed between, on the one hand, the date on which the request to present the international application to the International Bureau is received, ~~or is deemed to have been received under Rule 11(1)(a) or (c)~~, by the Office of origin and, on the other hand, the date of the receipt of the international application by the International Bureau, the fee that was valid on the first date shall be applicable.

(b) Where a designation under Rule 24 is presented by the Office of the Contracting Party of the holder and the amount of the fees payable in respect of that designation is changed between, on the one hand, the date of receipt, by the Office, of the request by the holder to present the said designation and, on the other hand, the date on which the designation is received by the International Bureau, the fee that was valid on the first date shall be applicable.

(c) Where paragraph (3)(a) applies, the amount of the second part of the individual fee which is valid on the later date referred to in that paragraph shall be applicable.

(d) Where the amount of the fees payable in respect of the renewal of an international registration is changed between the date of payment and the due date of the renewal, the fee that was valid on the date of payment, or on the date considered to be the date of payment under Rule 30(1)(b), shall be applicable. Where the payment is made after the due date, the fee that was valid on the due date shall be applicable.

(e) Where the amount of any fee other than the fees referred to in subparagraphs (a), (b), (c) and (d) is changed, the amount valid on the date on which the fee was received by the International Bureau shall be applicable.

#### *Rule 35* *Currency of Payments*

(1) *[Obligation to Use Swiss Currency]* All payments due under these Regulations shall be made to the International Bureau in Swiss currency irrespective of the fact that, where the fees are paid by an Office, that Office may have collected those fees in another currency.

(2) *[Establishment of the Amount of Individual Fees in Swiss Currency]* (a) Where a Contracting Party makes a declaration under Article 8(7)(a) of the Protocol that it wants to receive an individual fee, the amount of the individual fee indicated to the International Bureau shall be expressed in the currency used by its Office.

(b) Where the fee is indicated in the declaration referred to in subparagraph (a) in a currency other than Swiss currency, the Director General shall, after consultation with the Office of the Contracting Party concerned, establish the amount of the individual fee in Swiss currency on the basis of the official exchange rate of the United Nations.

(c) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Office of that Contracting Party may ask the Director General to establish a new amount of the individual fee in Swiss currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.



(d) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is lower by at least 10% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Director General shall establish a new amount of the individual fee in Swiss currency according to the current official exchange rate of the United Nations. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

*Rule 36*  
*Exemption From Fees*

Recording of the following shall be exempt from fees:

- (i) the appointment of a representative, any change concerning a representative and the cancellation of the recording of a representative,
- (ii) any change concerning the telephone and telefacsimile numbers, address for correspondence, electronic mail address and any other means of communication with the applicant or holder, as specified in the Administrative Instructions,
- (iii) the cancellation of the international registration,
- (iv) any renunciation under Rule 25(1)(a)(iii),
- (v) any limitation effected in the international application itself under Rule 9(4)(a)(xiii) or in a subsequent designation under Rule 24(3)(a)(iv),
- (vi) any request by an Office under ~~Article 6(4), first sentence, of the Agreement~~ or Article 6(4), first sentence, of the Protocol,
- (vii) the existence of a judicial proceeding or of a final decision affecting the basic application, or the registration resulting therefrom, or the basic registration,
- (viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rules 18*bis* or 18*ter* or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),
- (ix) the invalidation of the international registration,
- (x) information communicated under Rule 20,
- (xi) any notification under Rule 21 or Rule 23,
- (xii) any correction in the International Register.

*Rule 37*  
*Distribution of Supplementary Fees*  
*and Complementary Fees*

(1) The coefficient referred to in ~~Article 8(5) and (6) of the Agreement and~~ Article 8(5) and (6) of the Protocol shall be as follows:

for Contracting Parties which examine only for absolute grounds of refusal .....	two
for Contracting Parties which also examine for prior rights:	
(a) following opposition by third parties.....	three
(b) <i>ex officio</i> .....	four

(2) Coefficient four shall also be applied to Contracting Parties which carry out *ex officio* searches for prior rights with an indication of the most significant prior rights.

*Rule 38*  
*Crediting of Individual Fees to the Accounts*  
*of the Contracting Parties Concerned*

Any individual fee paid to the International Bureau in respect of a Contracting Party having made a declaration under Article 8(7)(a) of the Protocol shall be credited to the account of that Contracting Party with the International Bureau within the month following the month in the course of which the recording of the international registration, subsequent designation or renewal for which that fee has been paid was effected or the payment of the second part of the individual fee was recorded.

**Chapter 9**  
**Miscellaneous**

*Rule 39*  
*Continuation of Effects of International Registrations*  
*in Certain Successor States*

(1) Where any State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting Party (“the predecessor Contracting Party”) has deposited with the Director General a declaration of continuation the effect of which is that ~~the Agreement, the Protocol, or both the Agreement and the Protocol are~~ is applied by the successor State, the effects in the successor State of any international registration with a territorial extension to the predecessor Contracting Party which is effective from a date prior to the date fixed under paragraph (2) shall be subject to

(i) the filing with the International Bureau, within six months from the date of a notice addressed for that purpose by the International Bureau to the holder of the international registration concerned, of a request that such international registration continue its effects in the successor State, and

(ii) the payment to the International Bureau, within the same time limit, of a fee of 41 Swiss francs, which shall be transferred by the International Bureau to the Office of the successor State, and of a fee of 23 Swiss francs for the benefit of the International Bureau.

(2) The date referred to in paragraph (1) shall be the date notified by the successor State to the International Bureau for the purposes of this Rule, provided that such date may not be earlier than the date of independence of the successor State.

(3) The International Bureau shall, upon receipt of the request and the fees referred to in paragraph (1), notify the Office of the successor State and make the corresponding recording in the International Register.

(4) With respect to any international registration concerning which the Office of the successor State has received a notification under paragraph (3), that Office may only refuse protection if the applicable time limit referred to in ~~Article 5(2) of the Agreement or in~~ Article 5(2)(a), (b) or (c) of the Protocol has not expired with respect to the territorial extension to the predecessor Contracting Party and if the notification of refusal is received by the International Bureau within that time limit.

(5) This Rule shall not apply to the Russian Federation, nor to a State which has deposited with the Director General a declaration according to which it continues the legal personality of a Contracting Party.

Rule 40  
Entry into Force; Transitional Provisions

(1) [*Entry into Force*] These Regulations shall enter into force on ~~April 1, 1996~~ February 1, 2020, and shall, as of that date, replace the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement as in force on ~~March 31, 1996~~ January 31, 2020 (hereinafter referred to as “the Common Regulations ~~under the Agreement~~”).

(2) [*General Transitional Provisions*] (a) Notwithstanding paragraph (1),

(i) an international application the request for presentation to the International Bureau of which was received, ~~or is deemed to have been received under Rule 11(1)(a) or (c),~~ by the Office of origin before ~~April 1, 1996~~ February 1, 2020, shall, to the extent that it conforms to the requirements of the Common Regulations ~~under the Agreement~~, be deemed to conform to the applicable requirements for the purposes of Rule 14;

(ii) a subsequent designation or a request for ~~the recording of a change under Rule 20 of the Regulations under the Agreement sent by the Office of origin or by another interested Office~~ presented to the International Bureau before ~~April 1, 1996~~ February 1, 2020, ~~or, where such date can be identified, whose date of receipt by the Office of origin or by another interested Office for presentation to the International Bureau is earlier than April 1, 1996,~~ shall, to the extent that it conforms to the requirements of the Common Regulations ~~under the Agreement~~, be deemed to conform to the applicable requirements for the purposes of Rules 5bis, 20bis(3), 24(78), ~~or to be in order for the purposes of Rule 27, 27bis or 27ter~~;

(iii) an international application, a subsequent designation or a request for ~~the recording of a change under Rule 20 of the Regulations under the Agreement~~, that, before ~~April 1, 1996~~ February 1, 2020, has been the subject of any action by the International Bureau under Rules 11, 12, 13, 20bis(2), 24(5), or 2624 or 27bis(3)(a) of the Common Regulations ~~under the Agreement~~, shall continue to be processed by the International Bureau under the said Rules; the date of the resulting international registration or recording in the International Register shall be governed by Rules 15, 20bis(3)(b), or 2224(6), 27(1)(b) and (c) or 27bis(4)(b) of the Common Regulations ~~under the Agreement~~;

(iv) a notification under Articles 4bis(2), 5(1) and (2), 5(6) or 6(4) of the Protocol or under Rules 21bis, 23 or 34(3)(c) of the Common Regulations ~~of refusal or a notification of invalidation sent by the Office of a designated Contracting Party~~ to the International Bureau before ~~April 1, 1996~~ February 1, 2020, shall, to the extent that it conforms to the requirements of the Common Regulations ~~under the Agreement~~, be deemed to conform to the applicable requirements for the purposes of Rules 17(4), and (5) or of Rule 19(2), 21(2), 21bis(4), 22(2), 23(2) or 34(3)(d);

(v) a communication, a statement, declaration or final decision under Rules 16, 18bis, 18ter, 20, 20bis(5), 23bis or 27(4) or (5) of the Common Regulations sent to the International Bureau before February 1, 2020, shall, to the extent that it conforms to the requirements of the Common Regulations, be deemed to conform to the applicable requirements for the purposes of Rules 16(2), 18bis(2), 18ter(5), 20(3), 20bis(5)(d), 23bis(3), 27(4)(d) and (e) or (5)(d) and (e).

(b) For the purposes of Rule 34(7), the fees valid at any date before ~~April 1, 1996~~ February 1, 2020, shall be the fees prescribed by Rule ~~32~~ 34(1) of the Common Regulations ~~under the Agreement~~.

(c) A notification under Rules 6(2)(iii), 7(2), 17(5)(d), 20bis(6), 27bis(6), 27ter(2)(b), 34(3)(a) or 40(6) of the Common Regulations sent by the Office of a Contracting Party to the International Bureau before February 1, 2020, shall continue to have effects in accordance with Rules 6(2)(iii), 7(2), 17(5)(d), 20bis(6), 27bis(6), 27ter(2)(b), 34(3)(a) or 40(6). ~~Notwithstanding Rule 10(1), where, in accordance with Rule 34(7)(a), the fees paid in respect of the filing of an international application are the fees prescribed for 20 years by Rule 32 of the Regulations under the Agreement, no second instalment shall be due.~~

(d) ~~[Deleted] Where, in accordance with Rule 34(7)(b), the fees paid in respect of a subsequent designation are the fees prescribed by Rule 32 of the Regulations under the Agreement, paragraph (3) shall not apply.~~

(3) ~~[Deleted] [Transitional Provisions Applicable to International Registrations for Which Fees Have Been Paid for 20 Years] (a) Where an international registration for which the required fees had been paid for 20 years is the subject of a subsequent designation under Rule 24 and where the current term of protection of that international registration expires more than ten years after the effective date of the subsequent designation as determined in accordance with Rule 24(6), the provisions of subparagraphs (b) and (c) shall apply.~~

~~(b) Six months before the expiry of the first period of ten years of the current term of protection of the international registration, the International Bureau shall send to the holder and his representative, if any, a notice indicating the exact date of expiry of the first period of ten years and the Contracting Parties which were the subject of subsequent designations referred to in subparagraph (a). Rule 29 shall apply *mutatis mutandis*.~~

~~(c) Payment of complementary and individual fees corresponding to the fees referred to in Rule 30(1)(iii) shall be required for the second period of ten years in respect of the subsequent designations referred to in subparagraph (a). Rule 30(1) and (3) shall apply *mutatis mutandis*.~~

~~(d) The International Bureau shall record in the International Register the fact that payment has been made to the International Bureau for the second period of ten years. The date of recording shall be the date of expiry of the first period of ten years, even if the fees required are paid within the period of grace referred to in Article 7(5) of the Agreement and in Article 7(4) of the Protocol.~~

~~(e) The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the fact that payment has or has not been made for the second period of ten years and shall at the same time inform the holder.~~

(4) *[Transitional Provisions Concerning Languages]* (a) Rule 6 [of the Common Regulations](#) as in force before April 1, 2004, shall continue to apply to any international application filed before that date and to any international application governed exclusively by the Agreement filed between that date and August 31, 2008, inclusively, [as defined in Rule 1\(viii\) of the Common Regulations](#), to any communication relating thereto and to any communication, recording in the International Register or publication in the Gazette relating to the international registration resulting therefrom, unless

(i) the international registration has been the subject of a subsequent designation under the Protocol [in accordance with Rule 24\(1\)\(c\) of the Common Regulations](#) between April 1, 2004, and August 31, 2008; or

(ii) the international registration is the subject of a subsequent designation on or after September 1, 2008; and

(iii) the subsequent designation is recorded in the International Register.

(b) For the purposes of this paragraph, an international application is deemed to be filed on the date on which the request to present the international application to the International Bureau is received, or deemed to have been received under Rule 11(1)(a) or (c) [of the Common Regulations](#), by the Office of origin, and an international registration is deemed to be the subject of a subsequent designation on the date on which the subsequent designation is presented to the International Bureau, if it is presented directly by the holder, or on the date on which the request for presentation of the subsequent designation is filed with the Office of the Contracting Party of the holder if it is presented through the latter.

(5) [Deleted]

(6) *[Incompatibility with National Laws]* If, on the date this Rule comes into force or the date on which a Contracting Party becomes bound by ~~the Agreement or~~ the Protocol, paragraph (1) of Rule 27*bis* or paragraph (2)(a) of Rule 27*ter* are not compatible with the national law of that Contracting Party, the paragraph or paragraphs concerned, as the case may be, shall not apply in respect of this Contracting Party, for as long as it or they continue not to be compatible with that law, provided that the said Contracting Party notifies the International Bureau accordingly before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by ~~the Agreement or~~ the Protocol. This notification may be withdrawn at any time.

*Rule 41*  
*Administrative Instructions*

(1) *[Establishment of Administrative Instructions; Matters Governed by Them]* (a) The Director General shall establish Administrative Instructions. The Director General may modify them. Before establishing or modifying the Administrative Instructions, the Director General shall consult the Offices which have a direct interest in the proposed Administrative Instructions or their proposed modification.

(b) The Administrative Instructions shall deal with matters in respect of which these Regulations expressly refer to such Instructions and with details in respect of the application of these Regulations.

(2) *[Control by the Assembly]* The Assembly may invite the Director General to modify any provision of the Administrative Instructions, and the Director General shall proceed accordingly.

(3) *[Publication and Effective Date]* (a) The Administrative Instructions and any modification thereof shall be published in the Gazette.

(b) Each publication shall specify the date on which the published provisions become effective. The dates may be different for different provisions, provided that no provision may be declared effective prior to its publication in the Gazette.

(4) *[Conflict with ~~the Agreement,~~ the Protocol or These Regulations]* In the case of conflict between, on the one hand, any provision of the Administrative Instructions and, on the other hand any provision of ~~the Agreement,~~ the Protocol or these Regulations, the latter shall prevail.

[Annex II follows]

## SCHEDULE OF FEES

### SCHEDULE OF FEES

(in force on February 1, ~~2019~~[2020](#))

Swiss francs

1. ~~[Deleted] International applications governed exclusively by the Agreement~~

~~The following fees shall be payable and shall cover 10 years:~~

~~1.1 Basic fee (Article 8(2)(a) of the Agreement)\*~~

~~1.1.1 where no reproduction of the mark is in color 653~~

~~1.1.2 where any reproduction of the mark is in color 903~~

~~1.2 Supplementary fee for each class of goods and services beyond three classes (Article 8(2)(b) of the Agreement) 100~~

~~1.3 Complementary fee for the designation of each designated Contracting State (Article 8(2)(c) of the Agreement) 100~~

2. ~~International applications governed exclusively by the Protocol~~

The following fees shall be payable and shall cover 10 years:

2.1 Basic fee (Article 8(2)(i) of the Protocol)\*

2.1.1 where no reproduction of the mark is in color 653

2.1.2 where any reproduction of the mark is in color 903

2.2 Supplementary fee for each class of goods and services beyond three classes ~~(Article 8(2)(ii) of the Protocol)~~, except if only Contracting Parties in respect of which individual fees (see 2.4, below) are payable are designated (~~see Article 8(2)(ii) and~~ [\(7\)\(a\)\(i\)](#) of the Protocol) 100

\* For international applications filed by applicants whose country of origin is a Least Developed Country, in accordance with the list established by the United Nations, the basic fee is reduced to 10% of the prescribed amount (rounded to the nearest full figure). In such case, the basic fee will amount to 65 Swiss francs (where no reproduction of the mark is in color) or to 90 Swiss francs (where any reproduction of the mark is in color).



Swiss francs

2.3 Complementary fee for ~~the designation of~~ each designated Contracting Party ~~(Article 8(2)(iii) of the Protocol)~~, except if the designated Contracting Party is a Contracting Party in respect of which an individual fee (see 2.4 below) is payable ~~(see 2.4 below)~~ (see Article 8(2)(iii) and 8(7)(a)(ii) of the Protocol) 100

2.4 Individual fee for ~~the designation of~~ each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable ~~(see Article 8(7)(a) of the Protocol)~~ except where the designated Contracting Party and the Contracting Party of the Office of origin are both ~~is a State~~ bound ~~(also)~~ by the Agreement ~~, in which case, and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable in respect of such a designated Contracting Party (Articles 8(7)(a) and 9sexies(1)(b) of the Protocol):~~ the amount of the individual fee is fixed by each Contracting Party concerned

### 3. [Deleted]

~~International applications governed by both the Agreement and the Protocol~~

~~— The following fees shall be payable and shall cover 10 years:~~

~~— 3.1 Basic fee<sup>\*</sup>~~

~~— 3.1.1 where no reproduction of the mark is in color 653~~

~~— 3.1.2 where any reproduction of the mark is in color 903~~

~~— 3.2 Supplementary fee for each class of goods and services beyond three classes 100~~

~~— 3.3 Complementary fee for the designation of each designated Contracting Party in respect of which an individual fee is not payable (see 3.4, below) 100~~

~~— 3.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee is payable (see Article 8(7)(a) of the Protocol), except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned~~

<sup>\*</sup> ~~— For international applications filed by applicants whose country of origin is a Least Developed Country, in accordance with the list established by the United Nations, the basic fee is reduced to 10% of the prescribed amount (rounded to the nearest full figure). In such case, the basic fee will amount to 65 Swiss francs (where no reproduction of the mark is in color) or to 90 Swiss francs (where any reproduction of the mark is in color).~~

Swiss francs

4. *Irregularities with respect to the classification of goods and services*

The following fees shall be payable (Rule 12(1)(b)):

- |   |   |
|---|---|
| 4.1 Where the goods and services are not grouped in classes   | 77 plus 4 per term<br>in excess of 20           |
| 4.2 Where the classification, as appearing in the application,<br>of one or more terms is incorrect | 20 plus 4<br>per incorrectly<br>classified term |

provided that, where the total amount due under this item in respect of an international application is less than 150 Swiss francs, no fees shall be payable

5. *Designation subsequent to international registration*

The following fees shall be payable and shall cover the period between the effective date of the designation and the expiry of the then current term of the international registration ([Article 3ter\(2\) of the Protocol](#)):

- |   |     |
|---|-----|
| 5.1 Basic fee   | 300 |
| 5.2 Complementary fee for each designated Contracting Party indicated in the same request where an individual fee is not payable in respect of such designated Contracting Party (see 5.3, below) | 100 |

5.3 Individual fee for ~~the designation of~~ each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable, ~~(see Article 8(7)(a) of the Protocol)~~ except where the designated Contracting Party and the Contracting Party of the holder are both a States bound ~~(also)~~ by the Agreement, in which case, and the Office of the Contracting Party of the holder is the Office of a State bound (also) by the Agreement (a complementary fee is payable in respect of such a designated Contracting Party, a complementary fee is payable (Articles 8(7)(a) and 9sexies(1)(b) of the Protocol): the amount of the individual fee is fixed by each Contracting Party concerned



Swiss francs

6. *Renewal*

The following fees shall be payable and shall cover 10 years ([Article 7\(1\) of the Protocol](#)):

6.1 Basic fee	653
6.2 Supplementary fee, except if the renewal is made only for designated Contracting Parties in respect of which individual fees are payable (see 6.4, below)	100
6.3 Complementary fee for each designated Contracting Party in respect of which an individual fee is not payable (see 6.4, below)	100
6.4 Individual fee for <del>the designation of</del> each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable <del>(see Article 8(7)(a) of the Protocol)</del> except where the designated Contracting Party <a href="#">and the Contracting Party of the holder</a> <del>is</del> <a href="#">are both</a> a State <a href="#">bound</a> <del>(also)</del> by the Agreement <del>and the Office of the Contracting Party of the holder is the Office of a State bound (also) by the Agreement (in which case, a complementary fee is payable</del> in respect of such a Contracting Party, <del>a complementary fee is payable (Articles 8(7)(a) and 9sexies(1)(b) of the Protocol)</del> : the amount of the individual fee is fixed by each Contracting Party concerned	
6.5 Surcharge for the use of the period of grace ( <a href="#">Article 7(4) of the Protocol</a> )	50% of the amount of the fee payable under item 6.1

Swiss francs

7.	<i>Miscellaneous recordings</i> ( <a href="#">Article 9ter of the Protocol</a> )	
7.1	Total transfer of an international registration	177
7.2	Partial transfer (for some of the goods and services or for some of the Contracting Parties) of an international registration	177
7.3	Limitation requested by the holder subsequent to international registration, provided that, if the limitation affects more than one Contracting Party, it is the same for all	177
7.4	Change in the name and/or address of the holder and/or, where the holder is a legal entity, introduction of or change in the indications concerning the legal nature of the holder and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized for one or more international registrations for which the same recording or change is requested in the same form	150
7.5	Recording of a license in respect of an international registration or amendment of the recording of a license	177
7.6	Request for a continued processing under Rule 5bis(1)	200
7.7	Division of an international registration	177

Swiss francs

8. *Information concerning international registrations* ([Article 5ter of the Protocol](#))

8.1 Establishing a certified extract from the International Register consisting of an analysis of the situation of an international registration (detailed certified extract),

up to three pages 155

for each page after the third 10

8.2 Establishing a certified extract from the International Register consisting of a copy of all publications, and of all notifications of refusal, made with respect to an international registration (simple certified extract),

up to three pages 77

for each page after the third 2

8.3 A single attestation or information in writing

for a single international registration 77

for each additional international registration if the same information is requested in the same request 10

8.4 Reprint or photocopy of the publication of an international registration, per page 5

9. *Special services*

The International Bureau is authorized to collect a fee, whose amount it shall itself fix, for operations to be performed urgently and for services not covered by this Schedule of Fees.

[Annex III follows]



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MM/LD/WG/16/INF/1  
ORIGINAL : FRANCAIS / ENGLISH  
DATE : 6 JUILLET 2018 / JULY 6, 2018

## **Groupe de travail sur le développement juridique du système de Madrid concernant l'enregistrement international des marques**

**Seizième session  
Genève, 2 – 6 juillet 2018**

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

**Sixteenth Session  
Geneva, July 2 to 6, 2018**

**LISTE DES PARTICIPANTS  
LIST OF PARTICIPANTS**

*établie par le Secrétariat  
prepared by the Secretariat*

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(dans l'ordre alphabétique des noms français des membres/in the alphabetical order of the names in French of the members)

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[End of Annex III and of document]