

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

**Seventeenth session
Geneva, July 22-26, 2019**

PROPOSAL BY THE DELEGATION OF SWITZERLAND

1. In a communication dated June 18, 2019, the International Bureau received a proposal from the Delegation of Switzerland concerning the limitations provided for in the Madrid System for the International Registration of Marks, for consideration by the Working Group on the Legal Development of the Madrid System of the Madrid System for the International Registration of Marks at its seventeenth session to be held in Geneva from July 22 to 26, 2019.
2. The above-mentioned proposal is attached to this document as an Annex.

[Annex follows]

Proposal by Switzerland: Limitations in the International Register

The last few sessions of the Working Group on the Legal Development of the Madrid System have been partly devoted to the question of which Office should examine a limitation recorded in the International Register. The discussions have shown that the issue lacked clarity and transparency, and that some limitations recorded in the international register had never been examined by an Office, either before or after registration. As this situation is not satisfactory, **the Federal Intellectual Property Institute (Switzerland) would like the Working Group in July 2019 to recommend that several amendments to the Common Regulations be adopted in order to clarify the role of each of the Offices involved.**

Preamble

Switzerland is convinced that the International Bureau, as the Office through which all requests for limitations to the International Register are submitted, since it is the custodian of the Madrid and Nice Agreements, should play a central role in examining limitations. It is aware, however, that a solution centered on the International Bureau would not be acceptable to all of the Offices that are members of the Madrid System. It therefore proposes that the various interests at stake be taken into account in order to achieve a solution satisfactory to all parties.

Context

There are 3 types of limitation:

- limitations embodied in international applications (Rule 9 of the Common Regulations);
- limitations included in or constituting a subsequent designation (Rule 24 of the Common Regulations); and
- limitations embodying changes to the International Register (Rule 25 of the Common Regulations).

Depending on the type of limitation sought, the Office of origin, the Office of the holder or the designated Office and the International Bureau may examine the scope (and the classification) of the limitation. At present, however, certain limitations have been recorded unexamined and remain recorded in the International Register. An existing limitation to an international registration for a given country may, therefore, not have been examined by the Office of origin through which it was submitted or by the International Bureau by which it was recorded or by the designated country, which considers that it has already been examined.

As each type of limitation differs slightly from the other, Switzerland proposes one or more amendments to the Common Regulations in respect of each type.

1. Limitation embodied in international applications (Rule 9 of the Common Regulations)

In making an international application, a holder may indicate a desire for limitations of protection for a list of goods or services in respect of specific designated Contracting Parties (Rule 9(4)(a)(xiii) of the Common Regulations).

1.1 Examination by the Office of origin

Most Offices, as Offices of origin, consider that it is their certification duty (Rule 9(5)(d)(vi) of the Common Regulations) to ascertain that the limitation list in an international application is covered both by the list for the underlying mark and by the main list in the international registration. It is only through such vetting that international registration in its entirety (main list and limited list) can be assuredly based on the underlying mark.

Although this principle is very widely accepted, *Switzerland proposes that the current Rules be amended in order to state the principle clearly (see the proposed amendment at the end of the document).*

1.2 Examination by the International Bureau

The International Bureau currently examines limitations in international applications in accordance with Rule 12 (classification, see Rule 12(8bis) of the Common Regulations). It also examines such limitations in line with Rule 13 (accuracy), although this is not required in any provision in the Common Regulations. *Switzerland therefore proposes explicit provisions on the subject (see the proposed amendment at the end of the document).*

Switzerland considers, however, that the International Bureau must do more. It should consider in its examination whether the scope of the limitation is acceptable (is the limitation covered by the main list?). The aims here would be to avoid the recording of “gross” errors (which may occur, despite the certification duty of the Office of origin) and to promote the harmonization of (practical) interpretations among Offices. As many Offices believe in the primacy of the certification duty of the Office of origin, irregularity notifications issued by the International Bureau could be based on and included in Rule 13 of the Common Regulations insofar as the final decision on the recording of the limitation would not rest with the International Bureau. Upon notification by the International Bureau, the Office of origin could either amend the list or leave it unchanged. If it remains unchanged, an annotation, such as “extensive term, in the opinion of the International Bureau”, could be made to the limitation list. The purpose of such an annotation is to ensure that the information is transparent, as some Offices, to which such information could be useful, already reject limitations that they believe to be extensive.

Switzerland proposes an amendment to that end (see the proposed amendment at the end of the document).

1.3 Examination by the designated Office

There is no need for a specific provision to enable the designated Office to examine the scope of a limitation, given the primacy of the certification duty of the Office of origin.

2. Limitations in subsequent designations (Rule 24 of the Common Regulations)

2.1 Current situation

Subsequent designation to a specific Contracting Party may comprise the main list of goods and services or only part thereof (Rule 24 of the Common Regulations). Subsequent designation may be presented through the Office of the holder or directly to the International Bureau.

The *International Bureau* does not check whether the limitation list is included in the main list. In our opinion, this situation is not satisfactory.

Some Offices, in their capacity as the *Office of the holder* through which the limitation request is presented, also do not check whether the limitation in a subsequent designation is actually covered by the main list. These limitations are then forwarded, unexamined, to the designated Office. In our opinion, this situation is not satisfactory either.

Some *designated Offices* do not consider that this is a problem, for they may, under domestic legislation, compare the limitation list contained in the subsequent designation with the main international registration list.

Other designated Offices do not have any territorial legal basis for refusing a subsequent designation on the ground that the list for which protection is sought is extensive in relation to the main international registration list. This problem could be resolved by inserting in the Common Regulations a provision requiring the designated Office to examine the scope of limitations, but Switzerland does not consider this to be satisfactory. International registration and subsequent designation are two distinct forms of registration. They do have a common root, but they have different protection dates, the marks are not valid in the same territories, the lists of goods and services may be different, and so on. How can an Office justifiably be required to compare a subsequent designation list, namely list desired for its territory, with the international registration list which is not at all valid in its territory and is, in other words, a registration list of which it knows naught? Switzerland therefore does not consider that a provision requiring the designated Office to examine the scope of the subsequent designation list is desirable.

Furthermore, the limitations in some subsequent designations are designed to meet the requirements of the designated Office from which protection is sought. Some Offices therefore consider that authority to determine the scope of subsequent designation must vest in the designated Office only. A solution that takes into account all of the differing roles of a designated Office should therefore be found.

2.2 Proposal

In view of the situation described above, Switzerland proposes that provisions be drafted to permit the following:

- the *Office of the holder*, through which the request is submitted, must examine the limitation list to determine whether it is covered by the main list and, if it does not wish to do so, it must request the holder to apply directly to the International Bureau;

- the *International Bureau* shall examine the limitation in a subsequent designation to determine whether it is covered by the main list. If it considers that the limitation is extensive, it shall issue an irregularity notification pursuant to the model provided for in Rule 12, in which the opinion of the International Bureau is the determining factor. In the event of disagreement with the holder, the contentious goods or services shall be excluded. Said notification must be the determining factor inasmuch as the Office of the holder has no certification duty in respect of these limitations, unlike limitations embodied in international applications;
- there is no need for a provision requiring the *designated Office* to examine the scope of subsequent designations as such examination is conducted upstream, but if it may perform such examinations under domestic legislation (and thus compares the subsequent designation list with the international registration list), then it may issue a provisional refusal, if necessary;
- some Offices and system users think that the question of whether the limitation is extensive is a matter for the designated Office only, inasmuch as the main reason for requesting the recording of limitations in a subsequent designation is to meet the requirements of the designated Office in the best possible way. A provision under which the designated Office, too, may present subsequent designations could therefore be drafted, in which case the International Bureau would cursorily examine the scope of any subsequent designations if the request for a subsequent designation is processed through the designated Office concerned. As noted with regard to limitations embodied in international applications, the purpose of examination by the International Bureau is to avoid the recording of “gross” errors and to promote the harmonization of (practical) interpretations among Offices. The irregularity notification issued by the International Bureau could be based on Rule 13 of the Common Regulations, insofar as the final decision on the recording of the limitation would not rest with the International Bureau. It is unconventional for a designated Office to be the Office that submits the request for the recording of a limitation, but the idea is not completely new (see Rule 27bis of the Common Regulations on the division of an international registration).

The mechanism could take the form outlined below.

A holder wishing to obtain subsequent protection in a territory for a limited list of goods and services may apply either to the Office of the holder or to the International Bureau or (*breaking news!*) to the designated Office concerned. If a subsequent designation concerns several territories, the holder must apply either to the Office of the holder or the International Bureau – and *not* through the designated Office. If the holder presents to the designated Office a request for the recording of a limitation, that designated Office, in its role as an Office requesting the recording of the subsequent designation, will ascertain whether all “formal” conditions (e.g. holder, registration number, etc.) have been met and, in particular, whether the list of goods and services for which protection is sought is covered by the main international registration list. As the designated Office has no knowledge of the main list, a field could be created in the application form in order to incorporate the main list; moreover, Offices that only process online requests must each have a system to open a new file, as an Office applying to the International Bureau. Initially, the designated Office will only examine the request as to form and, if all is in order, shall forward it to the International Bureau to be recorded in the International Register. As subsequent designation is a matter for that designated Office only, the International Bureau shall only briefly examine the list of goods and services in order to identify gross errors (in the manner desirable for limitations in international applications). Upon recording the subsequent designation, the International

Bureau shall accordingly notify the designated Office which shall conduct the usual examination. As the scope of the limitation has already been examined, it should not be considered again.

The new proposed mechanism therefore has two steps: first, the designated Office formally examines the request, in the same way as it considers requests for changes when acting in its capacity as Office of origin or the Office of the holder; and second, the designated Office examines the substance of the request, which is currently the case. This two-step review has the advantage of clarifying the roles of the Offices, ensuring that the scope of the list in a subsequent designation is examined by the list-relevant Office and precluding any recording in the International Register of subsequent designations for which the scope of the list of goods and services has not been examined.

The proposed amendments to the Common Regulations to this end are reproduced at the end of the document.

3 Limitation embodying change (Rule 25 of the Common Regulations)

3.1 Current situation

Under Rule 25, a limitation amounts to a change in the International Register. A holder may request that a limitation be recorded for many reasons such as countering a provisional refusal, resolving conflict with a third party and adapting the list of goods and services for real-life use in the designated Contracting Parties concerned. Such limitations may be presented by holders through the relevant Office (of the holder) or directly to the International Bureau.

Some *Offices of the holder* do not currently examine the scope of the limitation before forwarding it to the International Bureau, which also does not examine the scope of the limitation, but merely records it in the International Register. *Designated Offices* may, under Rule 27 of the Common Regulations, issue a declaration stating that a limitation has no effect, but do not necessarily use this option, as it is complicated.

With regard to a limitation concerning several designated Contracting Parties, as in the case of a “world” coexistence agreement, the question arises as to whether or not the scope of that limitation should be examined centrally before registration. This would have the advantage of achieving a harmonized solution, if that were the purpose of the coexistence agreement. For this reason, the best solution does not always consist in merely stating that it is the duty of each of the designated Offices to conduct an examination.

The issue here is quite similar to the one encountered in limitations in subsequent designations (see section 2 above) and it underpins the rationale for the following proposed amendments.

3.2 Proposal

In view of the situation described above, Switzerland proposes that provisions be drafted to permit the following:

- the *Office of the holder*, through which the request is submitted, must examine the limitation list to determine whether it is covered by the main list and, if it does not wish to do so, it must request the holder to apply directly to the International Bureau;
- the *International Bureau* shall examine the request to record a limitation under Rule 25 of the Common Regulations to determine whether it is covered by the main list. If it considers that the limitation is extensive, it shall issue an irregularity notification pursuant to the model provided for in Rule 12, in which the opinion of the International Bureau is the determining factor. In the event of disagreement with the holder, the contentious goods or services shall be excluded. Said notification must be the determining factor inasmuch as the Office of the holder has no certification duty in respect of these limitations, unlike limitations embodied in international applications;
- if the *designated Office*, despite the care taken by the International Bureau in examining the limitation, considers that it is extensive in relation to the protected list in its territory, it may issue a declaration pursuant to Rule 27 of the Common Regulations;
- some Offices and system users consider that only the Office for which the limitation is sought must determine whether a limitation is extensive, as the limitation actually concerns that Office only. If this is so, a provision could be drafted to permit the designated Office, too, to present a limitation that is its concern. If the limitation recording request passes through the designated Office, the International Bureau would be relieved of the duty to examine the scope of the limitation. It is unconventional for a designated Office to be the Office submitting the request to record the limitation, but the idea is not completely new (see Rule 27bis of the Common Regulations on the division of an international registration). This option would, moreover, have the advantage of obviating the need for the designated Office to make a Rule 27 declaration, as it would have already examined the limitation recording request. The mechanism could be very similar to the one described for limitations in subsequent designations. It could even be simpler, as the designated Office would be already cognizant of the limitation embodied in the international registration in question.

The proposed amendments to the Common Regulations to this end are reproduced at the end of the document.

4. Proposed amendments

4.1 Limitations in international applications

4.1.1 Role of the Office of origin

*Rule 9
Requirements Concerning the International Application*

[...]

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

[...]

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

[...]

(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, and, where applicable, that the goods and services indicated in any limitation are covered by the list of goods and services indicated in the international application.

[...]

4.1.2 Role of the International Bureau

*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 or, where applicable, if it considers that some of the goods and services indicated in a limitation are not covered by the main list of the international application, 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 or the limitation 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, or extensive in relation to the main list, 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.

4.2 Limitations in subsequent designations (Rule 24 of the Common Regulations)

Rule 24

Designation Subsequent to the International Registration

(1) *[Entitlement]*

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

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

(c) Where the Contracting Party of the holder is bound by the Protocol, the holder may designate, under the Protocol, any Contracting Party that is bound by the Protocol, 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 or by the Office of the Contracting Party in which the subsequent designation shall have effect; however,

(i) *[Deleted]*

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

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

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

(3) [Contents]

(a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate:

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

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

- (i) be signed by the holder himself and be made on a separate official form annexed to the subsequent designation; or
- (ii) be included in the subsequent designation;

(c) The subsequent designation may also contain:

- (i) the indications and translation or translations, as the case may be, referred to in Rule 9(4)(b);
- (ii) a request that the subsequent designation take effect after the recording of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration;
- (iii) where the subsequent designation concerns a Contracting Organization, the indications referred to in Rule 9(5)(g)(i), which shall be on a separate official form to be annexed to the subsequent designation, and in Rule 9(5)(g)(ii).

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

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

(5) [Irregularities]

(a) If the subsequent designation does not comply with the applicable requirements, with the exception of the irregularities mentioned in paragraphs (d) and (e) below, and subject to paragraph (10), the International Bureau shall notify that fact to the holder and, if the subsequent designation was presented by an Office, that Office.

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

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

(d) If the subsequent designation concerns only part of the goods and services listed in the international registration concerned and has been presented by the Office of the holder or directly to the International Bureau, Rules 12 and 13 shall apply *mutatis mutandis* except that all communications concerning an irregularity to be corrected under these Rules shall be effected between the holder and the International Bureau. Where the subsequent designation has been presented by the Office of the holder or directly to the International Bureau, the International Bureau shall also give notification of an irregularity if it considers that the goods and services indicated in the subsequent designation are not covered by the goods and services listed in the international registration.

(e) Where the subsequent designation concerns only part of the goods and services listed in the international registration and has been filed by the designated Office, if the International Bureau considers that some of the goods and services are indicated in the international application by a term that is too vague for classification purposes or is incomprehensible or linguistically incorrect or, where applicable, if it considers that some of the goods and services indicated in the subsequent designation are not covered by the main list in the international application, it shall notify the designated Office 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. The designated Office may make a proposal to remedy the irregularity within three months of notification. If no proposal acceptable to the International Bureau for remedying the irregularity is made within the period stated above, the International

Bureau shall include in the international registration the term as it appears in the subsequent designation, provided that the designated Office has specified the class in which such term should be classified; the subsequent designation shall contain an indication to the effect that, in the opinion of the International Bureau, the specified term is too vague for classification purposes or incomprehensible or linguistically incorrect or extensive in comparison with the main list, as the case may be. Where no class has been specified by the designated Office, the International Bureau shall delete the said term *ex officio* and shall notify the designated Office accordingly and at the same time inform the applicant.

(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 18ter 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.

4.3 Limitation embodying change (Rule 25 of the Common Regulations)

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), 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), and the request for the recording of a limitation of the list of goods and services may be presented through the Office of the designated Contracting Party which that limitation concerns.

(c) 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) The request for the recording of a change or the request for the recording of a cancellation shall, in addition to the requested change or cancellation, contain or indicate:

(i) the number of the international registration concerned;

(ii) the name of the holder, unless 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 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) [*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 under Rule 25

(1) *[Irregular Request]* If the request for the recording of a change, or the request for the recording of a cancellation, referred to in 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. If the request concerns the recording of a limitation and has been presented by the Office of the holder or directly to the International Bureau, Rules 12 and 13 shall apply *mutatis mutandis* except that all communications concerning an irregularity to be remedied under these Rules shall be effected between the holder and the International Bureau. If the request concerns the recording of a limitation presented by the Office of the holder or directly to the International Bureau, the International Bureau shall also give notification of an irregularity when it finds that the goods and services specified in that limitation request are not covered by the goods and services listed in the international registration.~~

(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 for the recording of a change or the request for the recording of a cancellation 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.

(4) *[Details on limitations presented by the Office of the holder or directly to the International Bureau]* If the request concerns the recording of a limitation presented by the Office of the holder or directly to the International Bureau, Rules 12 and 13 shall apply *mutatis mutandis* except that all communications concerning an irregularity to be remedied under these Rules shall be effected between the holder and the International Bureau. The International Bureau shall also give notification of an irregularity if it considers that the goods and services specified in the subsequent designation are not covered by the goods and services listed in the international registration.

(5) *[Details on limitations presented by the designated Office]* If the request concerns the recording of a limitation presented by the designated Office and if the International Bureau considers that some of the goods and services are indicated in the international application by a term that is too vague for the purposes of classification or incomprehensible or linguistically incorrect or, where applicable, if it considers that some of the goods and services indicated in the limitation are not covered by the list in the international registration designating the Contracting Party of the Office indicated above, it shall notify that Office 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. The designated Office may make a proposal to remedy the irregularity within three months of notification. If no proposal acceptable to the International Bureau for remedying the irregularity is made within the period stated above, the International Bureau shall include in the international registration the term as it appears in the subsequent designation, provided

that the designated Office has specified the class in which such term should be classified; the subsequent designation shall contain an indication to the effect that, in the opinion of the International Bureau, the term is too vague for classification purposes or incomprehensible or linguistically incorrect or extensive in comparison with the main list, as the case may be. Where no class has been specified by the designated Office, the International Bureau shall delete the said term *ex officio* and shall notify the designated Office accordingly and at the same time inform the applicant.

[End of Annex and of document]