

Guide to the International Registration of Marks under the Madrid Protocol

GUIDE TO THE INTERNATIONAL REGISTRATION OF MARKS UNDER THE MADRID PROTOCOL

(updated 2021)

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Preface

This Guide is primarily intended for applicants for, and holders of, international registrations of marks, as well as officials of the competent administrations of the members of the Madrid Union. It covers the various steps of the international registration procedure and explains the essential provisions of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks and the Regulations under the Protocol.

The full text of the Madrid Protocol, the Regulations and the Administrative Instructions is available at: https://www.wipo.int/madrid/en/legal_texts/.

The Guide is updated from time to time. Readers are encouraged to contact the International Bureau if they have any comments or suggestions for improvement.

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PART A: INTRODUCTION

THE GUIDE

1. This is a Guide to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, (“the Protocol”) which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. This treaty was adopted at a Diplomatic Conference held in Madrid, Spain. The system for the international registration of marks is referred to as “the Madrid System”.
2. The application of this treaty is governed by two texts, namely the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Regulations”) and the Administrative Instructions for the Application of the Madrid Protocol (“the Administrative Instructions”).
3. The Guide is in two Parts. Part A gives a brief general introduction to the Madrid System. It explains how a State or an intergovernmental organization with its own system for registering marks can become a member of the Madrid Union along with the texts of the different declarations and notifications which may be made under the Protocol or the Regulations. Part B deals with procedures, and is in two Chapters. Chapter I deals with general questions of procedure, such as the methods of communication with the International Bureau, the calculation of time limits or the language regime. Finally, Chapter II describes the international registration procedure, as well as other procedures which may concern an international registration (for example, a subsequent designation or the recording in the International Register of a change in ownership).
4. Wherever possible, the provisions of the Protocol, the Regulations and the Administrative Instructions that are relevant to a particular paragraph of the Guide, are cited between brackets, at the end of such paragraph.
5. Provisions cited in the Guide are noted as follows:
 - [Article xx] refers to an Article of the Protocol;
 - [Rule xx] refers to a Rule of the Regulations;
 - [A.I. Section xx] refers to a Section of the Administrative Instructions.
6. The use of the word “mark” in this Guide refers to both trademarks (for goods) and service marks.

THE MADRID SYSTEM: BASIC FEATURES

The Protocol

7. The Madrid System of international registration of marks is administered by the International Bureau of the World Intellectual Property Organization (WIPO) (“the International Bureau”) in Geneva, Switzerland.

8. Originally, the Madrid System was governed by the Madrid Agreement Concerning the International Registration of Marks (“the Agreement”), which was adopted in 1891. The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Protocol”) was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996.

9. Following a decision in the Madrid Union Assembly (the “Assembly”) in October 2016, the Agreement is now inoperative and the Protocol is the sole governing treaty under the Madrid System. It is no longer possible for countries to accede only to the Agreement. However, it is possible to accede to both the Agreement and to the Protocol at the same time, in which case the Protocol will prevail.

10. The legal framework of the Madrid System consists of the Protocol, the Regulations under the Protocol and the Administrative Instructions.

11. The Contracting Parties – or members – to the Protocol constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention for the Protection of Industrial Property. (For further details on the members of the Union, and the meaning of “Contracting Party”, see paragraphs 40 to 50).

12. Every member of the Madrid Union is a member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including fixing of fees connected with the use of the Madrid System.

Who May Use the System?

13. The Madrid System may be used only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Protocol, or which has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a member State of such an organization.

14. The Office of the Contracting Party with respect to which a person or entity fulfills one or more of the above conditions is referred to as the “Office of origin”. A mark may be the subject of an international registration, if it has been registered, or if its registration has been applied for in the Office of origin.

15. An application for international registration must designate one or more Contracting Parties in which the mark is to be protected. It cannot designate the Contracting Party of the Office of origin. Contracting Parties may also be designated subsequently. The Madrid System cannot be used by a person or entity which does not have the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union. Furthermore, it cannot be used to protect a trademark outside the Madrid Union.

Brief Description of the System

16. An application for international registration must be presented to the International Bureau through the Office of origin. Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the WIPO Gazette of International Marks.

17. The International Bureau notifies each Contracting Party in which protection has been requested, whether in the international application or subsequently. From the date of the international registration or subsequent designation, the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been filed directly with the Office of that Contracting Party. Each designated Contracting Party has the right to refuse protection, within the time limits specified in the Protocol. Unless such a refusal is notified to the International Bureau within the applicable time limit, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party. The time limit for a Contracting Party to notify a refusal is generally one year. However, a Contracting Party may declare that this period is to be 18 months (or longer, in the case of a refusal based on an opposition).

18. For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the Office of origin. If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected. Similarly, where the international registration was based on an application in the Office of origin, it will no longer be protected if, and to the extent that, that application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period. In these cases, the International Bureau, upon request from the Office of origin, cancels the international registration. After the expiry of this period of five years, the international registration becomes independent of the basic registration or basic application.

19. An international registration may be maintained in force indefinitely by the payment, every 10 years, of the prescribed fees.

Advantages of the System

20. International registration has several advantages for the owner of the mark. After registering the mark, or filing an application for registration, with the Office of origin, the applicant has to file only one application in one language (English, French or Spanish), and pay fees to one Office instead of filing separately in the trademark Offices of the various Contracting Parties in different languages, and paying a separate fee in each Office.

21. Another important advantage for owners of marks lies in the fact that all changes subsequent to the international registration, such as a change in name and/or address of the holder, a (total or partial) change in ownership of the holder or a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties, may be recorded and have effect by means of a single procedure with the International Bureau and the payment of one fee.

22. In summary, the main advantages for trademark owners consist of the simplicity of the international registration system and the financial savings made when obtaining and maintaining the protection of their marks abroad.

23. International registration is also to the advantage of trademark Offices. For example, when designated, Offices do not need to examine for compliance with formal requirements, or classify the goods or services, or publish the marks. Moreover, part of the fees collected by the International Bureau is transferred to the Contracting Parties in which protection is sought. Furthermore, if the International Registration Service closes its biennial accounts with a profit, the proceeds may be divided among the Contracting Parties.

THE MADRID AGREEMENT AND THE MADRID PROTOCOL

Historical Comparison Between the Protocol and the Agreement

24. The Madrid Agreement and the Protocol are separate (though intrinsically linked) treaties that share the same objectives namely, to offer a convenient cost-effective solution for registering and managing trademarks worldwide. The Protocol was created to bring more flexibility to the Madrid System and introduced certain new features with the aim of removing the difficulties that prevented certain countries and intergovernmental organizations from adhering to the Agreement. Some of the key comparisons are as follows:

- the applicant may base their application for international registration on a registration or an application filed with the Office of origin; under the Agreement, an international application had to be based on a registration in the Office of origin;
- each Contracting Party in which the applicant seeks protection may elect for a period of 18 months (instead of one year), and an even longer period in the case of opposition, within which to declare that protection cannot be granted to the mark in its territory;
- the Office of each Contracting Party may receive higher fees than under the Agreement;
- an international registration which is cancelled, at the request of the Office of origin, for example because the basic application has been refused or the basic registration has been invalidated within five years from the date of the international registration, may be transformed into national (or regional) applications in the respective Contracting Parties in which the international registration had effect, each benefiting from the date of the international registration (or the subsequent designation) and, where applicable, its priority date. This possibility did not exist under the Madrid Agreement.
- an intergovernmental organization may become a party to the Protocol (but not the Agreement) where the following conditions are fulfilled: at least one of the member States of the organization is a party to the Paris Convention and the organization maintains a regional Office for the purposes of registering marks with effect in the territory of the organization.

The Freezing of the Agreement

25. On October 11, 2016, the Assembly decided to freeze the application of Article 14(1) and (2)(a) of the Agreement.

26. This decision, together with the fact that since October 31, 2015¹, all members of the Madrid Union are party to the Protocol, consolidated the Protocol as the sole treaty governing international applications and registrations under the Madrid System. As a result, provisions regulating international applications and registrations under the Agreement are no longer operational.

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The entering into force of the Protocol in Algeria.

27. The legal framework of the Madrid System consists of the Protocol, the Regulations and the Administrative Instructions. On February 1, 2020, the Common Regulations changed name to the Regulations, reflecting that the Agreement is no longer in operation.

28. The freeze of the application of Article 14(1) and (2)(a) of the Agreement has the following effects:

- new Contracting Parties cannot ratify or accede to the Agreement alone but can ratify or accede simultaneously to the Agreement and to the Protocol;
- countries that are Contracting Parties to the Protocol can accede to the Agreement;
- international applications can no longer be filed under the Agreement;
- no operations under the Agreement will be conducted, including the presentation of subsequent designations;
- Article 9*sexies*(1)(b) of the Protocol will still apply in the mutual relations between Contracting Parties bound by both the Agreement and the Protocol; and,
- the Assembly can still deal with all matters concerning the implementation of the Agreement and can revert, at any time thereafter, to its decision to freeze the application of Article 14(1) and (2)(a) of the Agreement.

29. For further information on the decision to freeze the application of Article 14(1) and (2)(a) of the Agreement, please see documents MM/A/50/3 and MM/A/50/5².

The Safeguard Clause

30. The Protocol and the Agreement were independent, parallel treaties, with separate, but overlapping, memberships: States party only to the Agreement, States and organizations party only to the Protocol, and States party to both the Agreement and the Protocol.

(a) Prior to September 1, 2008: Prevalence of the Agreement by Virtue of the Safeguard Clause

31. Prior to September 1, 2008, paragraph (1) of Article 9*sexies* of the Protocol, which was known as the “safeguard clause”, provided that where, with regard to a given international application or registration, the Office of origin or the Office of the Contracting Party of the holder, was the Office of a State party to both the Agreement and the Protocol, then the designation of a Contracting Party also bound by both treaties would be governed not by the Protocol, but by the Agreement. [Article 9*sexies*(1)]

32. Therefore, in the case of an international application where the Office of origin, or in the case of an international registration the Office of the Contracting Party of the holder, was the Office of a Contracting Party bound by both treaties, a designation (whether in the application, or subsequently) of a Contracting Party bound only by the Protocol would have been governed by the Protocol, a designation of a Contracting Party bound only by the

² https://www.wipo.int/meetings/en/details.jsp?meeting_id=39948.

Agreement would have been governed by the Agreement, and, as a consequence of the safeguard clause, a designation of a Contracting Party bound by both treaties would have been governed by the Agreement. As a whole, such an international registration would then have been an international registration governed by both the Agreement and the Protocol.

33. Prior to September 1, 2008, paragraph (2) of Article 9*sexies* contained a provision that the Assembly of the Madrid Union might, by a three-fourths majority, repeal or restrict the scope of the safeguard clause after the expiry of a period of 10 years from the entry into force of the Protocol, but not before the expiry of a period of five years from the date on which the majority of States party to the Agreement had become party to the Protocol. These conditions having been fulfilled, the Assembly of the Madrid Union adopted, in November 2007, an amendment of Article 9*sexies* consisting in a repeal of the safeguard clause accompanied, however, by an additional provision setting aside the application of certain declarations in the mutual relations between Contracting Parties bound by both the Agreement and the Protocol (see paragraphs 31 to 35).

34. The amendment of Article 9*sexies* came into effect on September 1, 2008.

(b) As of September 1, 2008: Prevalence of the Protocol

35. As of September 1, 2008, the situation regarding the mutual relations of Contracting Parties bound by both treaties is regulated by a new provision, paragraph (1)(a) of Article 9*sexies* of the Protocol. Under this provision, where, with regard to a given international application or registration, the Office of origin, or the Office of the Contracting Party of the holder, is the Office of a State party to both the Agreement and the Protocol, then the designation of a Contracting Party also bound by both treaties will be governed not by the Agreement, but by the Protocol, which is the reverse of the situation described in paragraph 31.

36. Therefore, in the case of an international application where the Office of origin, or in the case of an international registration the Office of the Contracting Party of the holder, is the Office of a Contracting Party bound by both treaties, a designation (whether in the application, or subsequently) of a Contracting Party bound only by the Protocol will, of course, continue to be governed by the Protocol, a designation of a Contracting Party bound only by the Agreement will, likewise continue to be governed by the Agreement, and now, by virtue of new Article 9*sexies*(1)(a), a designation of a Contracting Party bound by both treaties will, instead of being governed by the Agreement, be governed by the Protocol.

37. Article 9*sexies*(1)(b) renders inoperative a declaration under Article 5(2)(b), Article 5(2)(c) – providing for an extended refusal period – or Article 8(7) – allowing for the application of individual designation fees – of the Protocol, in the mutual relations between States bound by both treaties.

38. This means that in the case of an international application where the Office of origin, or in the case of an international registration the Office of the Contracting Party of the holder, is the Office of a Contracting Party bound by both treaties, a designation (whether in the international application, or subsequently) of a Contracting Party bound by both treaties will now be governed by the Protocol, and not the Agreement. However, it will be subject to the standard regime of Articles 5(2)(a), 7(1) and 8(2) of the Protocol – that is, the time limit of one year for the notification of a provisional refusal, and the payment of supplementary and complementary fees, notwithstanding that the designated Contracting Party in question may have declared an extended period for notifying a provisional refusal or that it wishes to receive individual fees.

39. Paragraph (2) of Article 9*sexies* provides that the Assembly of the Madrid Union shall review the application of paragraph (1)(b) of Article 9*sexies* after a period of three years from September 1, 2008. Following this review, the Assembly may either repeal it or restrict its scope, by a three-fourths majority. Such review took place in 2011³, when the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (“the Working Group”) decided not to recommend to the Madrid Union Assembly any further review of the application of paragraph (1)(b) of Article 9*sexies*. [Article 9*sexies*(2)]

BECOMING PARTY TO THE PROTOCOL

40. Any State which is a party to the Paris Convention for the Protection of Industrial Property may become a party to the Protocol. [Article 14(1)(a)]

41. A State which has signed the Protocol (which was open for signature until the end of 1989) may become a party by depositing an instrument of ratification, acceptance or approval (“instrument of ratification”). Otherwise, a State may become a party to the Protocol by depositing an instrument of accession. [Article 14(2)]

42. An intergovernmental organization may, by depositing an instrument of accession, become a party to the Protocol, provided the following conditions are fulfilled: [Article 14(1)(b)]

- at least one of the member States of the organization is a party to the Paris Convention; and
- the organization has a regional Office for the purpose of registering marks with effect in its territory (provided that such Office is not the subject of a notification under Article 9*quater* of the Protocol (see paragraphs 47 to 49).

43. The expression “Contracting Party” includes any State or intergovernmental organization which is a Party to the Protocol. [Rule 1(iii)]

44. Instruments of ratification or accession must be deposited with the Director General of WIPO (“the Director General”). The Director General will notify all Contracting Parties of any deposits of instruments of ratification of, or accession to, the Protocol, and of any declarations which are included in such instruments. With respect to a given Contracting Party, the Protocol will enter into force three months after the instrument of ratification or accession has been so notified by the Director General. [Article 14(3)] [Article 14(4)(b)]

DECLARATIONS AND NOTIFICATIONS BY CONTRACTING PARTIES

45. The Protocol and the Regulations provide for the possibility for Contracting Parties to make certain declarations and notifications concerning the operation of the international registration system.

46. Details on which Contracting Parties have made which declaration are available on WIPO’s website (<https://www.wipo.int/madrid/en/members/declarations.html>).

³ See document MM/LD/WG/9/5 (https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_9/mm_ld_wg_9_5.pdf).

Common Office of Several States

47. Several States which are all party to the Protocol, and have agreed to adopt uniform legislation on marks, may notify the Director General that a common Office for the registration of marks is to be substituted for the national offices of each of them, and that the whole of their respective territories is to be considered as a single State for the purposes of the Protocol. Such a notification takes effect three months after it has been communicated by the Director General to the other Contracting Parties. [Article 9*quater*]

48. Where such a notification has been made, the Office concerned is not regarded as the Office of an intergovernmental organization (see paragraph 42); it is the respective States who are parties to the Protocol, not the common Office or any organization under which it is constituted.

49. Only one such notification has been made – the Benelux Office for Intellectual Property, which registers marks having effect in Belgium, Netherlands and Luxembourg, has been constituted as a common Office under the Agreement and the Protocol⁴.

Territorial Effect

50. Protection of an international registration under the Protocol extends only to a Contracting Party, which has been expressly designated. [Article 3*bis*]

Limitation Concerning Existing Marks

51. Any State or intergovernmental organization may, when ratifying or acceding to the Protocol, declare that no international registration effected under the Protocol before the date of entry into force of the Protocol with respect to that State or organization can be extended to it. Such a declaration cannot be made subsequent to ratification or accession. In this case, protection can only be obtained by submitting a new application for international registration designating that Contracting Party. [Article 14(5)]

Extension of Time for Notifying Refusal

52. Any Contracting Party may declare that the time limit for its Office to notify a refusal of protection shall be 18 months instead of one year. Such a declaration may also specify that a refusal of protection which results from an opposition may, under certain conditions, be notified after the expiry of this 18-month period. [Article 5(2)(b) and (c)]

53. It is recalled, however, that paragraph (1)(b) of Article 9*sexies* renders inoperative a declaration under Article 5(2)(b) and (c) between States that are both bound by both the Agreement and the Protocol (see paragraphs 32 to 37). [Article 9*sexies*(1)]

54. A declaration under Article 5(2)(b) and (c) may be made in the instrument of ratification or accession. It may also be made later, in which case it will come into effect three months after its receipt by the Director General. [Article 5(2)(d)]

⁴ Until September 1, 2006, the Benelux Office for Intellectual Property (BOIP) was known as the Benelux Trademarks Office and the Benelux Designs Office. The BOIP is an institution of the Benelux Organisation for Intellectual Property.

Notification of Decisions Following a Provisional Refusal of Protection

55. The Office of a Contracting Party may declare that, in accordance with its legislation, 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 any decision taken on the said review may be the subject of a further review or appeal before the Office. [Rule 17(5)(d)]

56. Where this declaration applies, and the Office is not in a position to communicate the said decision directly to the holder, the Office sends the statement referred to in Rule 18*ter*(2) or (3) immediately to the International Bureau, notwithstanding the fact that all procedures before the Office have not yet been completed (the statement referred to in Rule 18*ter*(2) or (3) either indicates that the provisional refusal is withdrawn and that protection of the mark is granted for all goods and services or for some of them, or indicates that the total provisional refusal is confirmed in the Contracting Party concerned). Any new decision affecting the protection of the mark shall be addressed to the International Bureau, in accordance with Rule 18*ter*(4).

57. This declaration is intended for Offices, which (for practical or legal reasons) are not in a position to communicate directly to the holder (or their representative) a decision following an *ex officio* review of the provisional refusal. Sending the decision to the International Bureau, which in turn transmits it to the holder (or representative), means that holders are not deprived of the possibility of requesting further review by the Office.

58. The Office of a Contracting Party may declare that, in accordance with its legislation, an *ex officio* provisional refusal that is notified to the International Bureau is not open to review before the Office. Where this declaration applies, any *ex officio* provisional refusal issued by the Office shall be deemed to include the statement provided for in Rule 18*ter*(2)(ii) or (3) (which is normally notified only after all procedures before the Office have been completed) indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned, or confirming the total provisional refusal of the protection of the mark in the Contracting Party concerned. [Rule 17(5)(e)]

Individual Fees

59. Any Contracting Party may declare that, in connection with each international registration in which it is designated (whether in the international application or subsequently), and in connection with the renewal of such registration, it wants to receive a so-called "individual fee". The amount of any such fee must be determined by that Contracting Party and indicated in the declaration; it may be changed by subsequent declarations. It must not be higher than the fee which the Office of the Contracting Party would receive for registering that mark for a period of ten years, or for the renewal of such registration for a period of ten years, after deduction of the savings resulting from the international procedure. Such savings are expected to accrue, because, for example, the international procedure spares the Offices of Contracting Parties formality examination, the classification of goods and services, or publication of the internationally registered mark. [Article 8(7)(a)]

60. The declaration concerning individual fees may be made in the instrument of ratification or accession. It may also be made after, in which case it will come into effect three months after its receipt by the Director General, or at a later date indicated in the declaration. In such a case, an individual fee will be payable only in respect of an international registration or subsequent designation whose date is the same as, or later than, the effective date of the declaration. [Article 8(7)(b)]

61. A Contracting Party that makes or has made a declaration concerning individual fees may also notify the Director General that the individual fee comprises two parts. The first part must be paid at the time of filing the international application or the subsequent designation of that Contracting Party. The second part is to be paid at a later date, determined in accordance with the law of that Contracting Party (in practice, when the Office considers, following substantive examination, that the mark fulfills the conditions for protection). This payment in two parts is intended to reflect the procedure for payment applicable in that Contracting Party, namely the fact that, at the national level, an applicant may be required to pay an application fee at the time of filing and, only if the application is accepted, a registration fee. [Rule 34(3)(a)]

62. There is no provision specifying the date of entry into force of such a notification. That being so, if it is made at the same time as the declaration requiring the payment of an individual fee, it will enter into force at the same time as that declaration. If the notification is made after the declaration concerning an individual fee, it will enter into force on a date agreed between the International Bureau and the Office concerned (taking into account, in particular, the time needed to publish the declaration).

63. Where a Contracting Party has not made a declaration that it wishes to receive an individual fee, it receives a share in the revenue produced by the supplementary and complementary fees (“the standard fee regime”) (see paragraphs 292 to 299). By making a declaration that it wishes to receive individual fees, a Contracting Party agrees to forego such a share. [Article 8(7)(a)]

64. An individual fee may be charged only to the extent that its application is not set aside by Article 9*sexies*(1)(b) (see paragraphs 37 and 38).

Presentation of Subsequent Designations

65. It is possible to expand the geographical scope of the international registration by subsequently designating Contracting Parties. The holder of the international registration may present the subsequent designation directly to the International Bureau or through the Office of the Contracting Party of the holder. There are advantages for the holder to present such subsequent designation directly to the International Bureau using the online subsequent designation tool.

Declaration of Intention to Use the Mark

66. Where a Contracting Party requires a declaration of intention to use the mark whenever it is designated under the Protocol, it must notify that fact to the Director General. Where the Contracting Party requires the declaration to be signed by the applicant (that is, a signature by a representative is not sufficient), or to be made on a separate official form annexed to the international application, the notification should contain statements to that effect and should specify the exact wording of the required declaration. Where the Contracting Party requires that the declaration be in a specified one of the three official languages (even where the international application is not in such language), the notification should specify the required language. [Rule 7(2)]

67. Such a notification may be made in the instrument of ratification or accession. It may also be made subsequently, in which case it will come into effect three months after its receipt by the Director General, or at a later date indicated in the notification. The notification may be withdrawn at any time; the withdrawal will have effect upon receipt of the notice of withdrawal, or at a later date indicated in the notice. [Rule 7(3)(a)] [Rule 7(3)(b)]

Declaration that the Recording of Licenses in the International Register Has No Effect

68. Where the legislation of the Office of a Contracting Party does not provide for the recording of trademark licenses, it may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party. Such declaration may be made at any time. There is, however, no provision for it to be withdrawn. [Rule 20*bis*(6)(a)]

69. Where the legislation of the Office of a Contracting Party does provide for the recording of trademark licenses, it may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party. Such declaration may only be made before the date of entry into force of Rule 20*bis* (namely April 1, 2002) or before the date on which the Contracting Party becomes bound by the Protocol. It may be withdrawn at any time. [Rule 20*bis*(6)(b)]

Declaration that a Contracting Party Will Not Present Requests for the Division of an International Registration Under Rule 27*bis*(1)

70. Where the legislation of the Office of a Contracting Party does not provide for the division of an application for the registration of a mark or of a registration of a mark, it had the opportunity to notify the Director General, before Rule 27*bis* entered into force (February 1, 2019) or before that Contracting Party became bound by the Protocol, that it would not present to the International Bureau requests for division of international registrations. [Rule 27*bis*(6)]

71. Holders of international registrations will not be able to request the division of an international registration in respect of a Contracting Party that has notified a declaration under paragraph (6) of Rule 27*bis*.

Declaration that a Contracting Party Will Not Present Requests for the Merger of International Registrations Resulting from Division Rule 27*ter*(2)(a)

72. Where the legislation of the Office of a Contracting Party does not provide for merger of registrations of marks, it had the opportunity to notify the Director General, before Rule 27*ter* entered into force (February 1, 2019) or before that Contracting Party became bound by the Protocol, that it would not present to the International Bureau requests for the merger of an international registration resulting from the recording of division. [Rule 27*ter*(2)(b)]

73. Holders of international registrations will not be able to request the merger of an international registration resulting from division in respect of a Contracting Party that has notified a declaration under paragraph (2)(b) of Rule 27*ter*.

74. Declarations notified under Rules 27*bis*(6) and 27*ter*(2)(b) may be withdrawn at any time. In such case, holders of international registrations will be able to present requests under Rule 27*bis*(1) or 27*ter*(2)(a), as the case may be, in respect of the Contracting Party that has notified the Director General the withdrawal of the corresponding declaration.

Notification of Incompatibility of Rules 27bis(1) and 27ter(2)(a) with the Applicable National or Regional Laws of a Contracting Party

75. Any Office of Contracting Party, before Rules 27bis(1) and 27ter(2)(a) entered into force (namely February 1, 2019) or before that Contracting Party became bound by the Madrid Protocol, had the opportunity to notify the Director General that Rules 27bis(1) and 27ter(2)(a) are not compatible with the applicable national or regional laws, as the case may be. [Rule 40(6)]

76. The Rule or Rules that are the subject of a notification under new paragraph (6) of Rule 40 will not apply to the Contracting Party that has sent such notification. As a result, holders of international registrations will not be able to present requests under Rule 27bis(1) or Rule 27ter(2)(a) in respect of that Contracting Party unless the notification is withdrawn.

Collecting and Forwarding Fees

77. Fees, which are payable in connection with international registrations, may be paid by the applicant or holder directly to the International Bureau. An Office of a Contracting Party may, however, allow an applicant or holder to pay the fees through that Office. An Office, which agrees to collect fees and forward them to the International Bureau, should notify the Director General of that fact. Any fees paid to the International Bureau should be in Swiss currency, irrespective of the fact that an Office may have collected such fees in another currency. [Rule 34(2)] [Rule 35(1)]

Continuation of Effects in Successor State

78. 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”), may deposit with the Director General a declaration of continuation, the effect of which is that the Protocol is applied by the successor State. Where such a declaration has been deposited, the holder of an international registration, which had effect in the predecessor Contracting Party before a date notified by the successor State, may request that the protection of the international registration continue in the successor State (see also paragraphs 771 to 774). [Rule 39]

Publication of Notifications and Declarations

79. Any notifications or declarations referred to above will be published in the periodical gazette issued by the International Bureau. [Rule 32(2)]

FEE REDUCTION FOR APPLICANTS FROM LEAST DEVELOPED COUNTRIES (LDCS)

80. Applicants having a real and effective industrial or commercial establishment, or a domicile in a least developed country, or being a national of a least developed country (in accordance with the list established by the United Nations), and who file their international applications through the trademark office of such country, as the Office of origin, will be required to pay only 10% of the amount of the basic fee. This is reflected in the Schedule of Fees and has been incorporated in the fee calculator on the Madrid System website (<https://www.wipo.int/madrid/feescalculator/>).

81. The list of least developed countries is maintained and updated on a regular basis by the United Nations and may be consulted on the United Nations website at <https://www.un.org/en/>. The list may also be consulted at <https://www.un.org/development/desa/dpad/least-developed-country-category/lDCs-at-a-glance.html>.

FURTHER INFORMATION ABOUT THE MADRID SYSTEM

82. Much information about the system of international registration of marks is available on WIPO's website (<https://www.wipo.int/portal/en/index.html>) under the heading Madrid – The International Trademark System. As well as general information, this site includes:

- the full text of the Protocol, the Regulations and the Administrative Instructions;
- the full text of the present Guide;
- a list of the Contracting Parties to the Protocol and the Agreement, together with an indication of the date on which they became bound by the respective treaties and any declarations they have made under the Protocol;
- information concerning the laws (“WIPO Lex”) and practices of individual Contracting Parties;
- the official and optional forms issued by the International Bureau;
- the current fees, including individual fees;
- an online fee calculator calculating the fees (including individual fees) payable in connection with an international application, a subsequent designation or the renewal of an international registration;
- information notices issued by the International Bureau (for example, concerning new accessions or changes to the Regulations);
- annual, monthly and “in progress” statistics relating to international registrations;
- information concerning meetings and seminars;
- the WIPO Gazette of International Marks;
- the Madrid Monitor, which is an online tool that provides access to information on international registrations that are currently in force in the International Register or which were recorded since April 1, 1996, and have since expired. It also provides access to the real-time status of international applications, subsequent designations and limitations that are under examination by the International Bureau (see paragraphs 87 to 90). E-mail alerts can be set up for updates on international registrations or applications of interest, and the WIPO Gazette of International Marks can also be accessed;

- the Member Profiles Database, which is an online tool that contains information on the laws and examination procedures of individual Contracting Parties;
- the Madrid Goods and Services Manager (MGS), which is an online tool that assists applicants and their representatives in compiling lists of goods and services;
- the Examination Guidelines Concerning the Classification of Goods and Services in International Applications (https://www.wipo.int/export/sites/www/madrid/en/pdf/madrid_examination_guidelines.pdf).
 - the Madrid Portfolio Manager, which is an online service that allows holders of international registrations and their representatives to access their international trademark portfolios;
 - the Madrid Electronic Alert, which is a free “watch service” designed to inform anyone interested in monitoring the status of certain international registrations. Subscribers receive e-mail alerts when changes are recorded in the International Register.

PUBLIC INFORMATION ABOUT INTERNATIONAL APPLICATIONS AND INTERNATIONAL REGISTRATIONS

83. Anyone wishing to obtain information about the contents of the International Register, or about a particular international application or registration, or general information about the operation of the system of international registration of marks, has access to the following sources of information:

The Gazette

84. The WIPO Gazette of International Marks (“the Gazette”) is published every week on the Madrid System website. The Gazette contains all relevant data on new international registrations, renewals, subsequent designations and changes as well as other entries affecting international registrations. The bibliographic data is identified by the WIPO INID (“Internationally agreed Numbers for the Identification of Data”) codes, that is, the codes of Standard ST.60 (“Recommendation concerning bibliographic data relating to marks”) and Standard ST.3 (“Recommended standard two-letter code for the representation of States, other entities and international organizations issuing or registering industrial property titles”). The various codes used in the Gazette and the bibliographic data to which they relate are given in each issue of the Gazette. [Rule 32(1)] [Rule 32(3)]

85. The Gazette also contains information of general interest such as declarations and notifications made by Contracting Parties under the Protocol or the Regulations regarding particular requirements, the amounts of individual fees under Article 8(7) of the Protocol or information on the days on which the International Bureau is not scheduled to be open to the public. [Rule 32(2)]

86. The Gazette can be accessed by Madrid Monitor (<https://www3.wipo.int/madrid/monitor/en/>).

Madrid Monitor

87. The status of all international registrations in force, including data relating to international applications and subsequent designations under examination by the International Bureau, is published by the International Bureau online on Madrid Monitor. This database contains the bibliographic data of all international registrations in force and the images of marks registered, which consist of or contain special characters or figurative elements. Data is made available through daily Madrid Monitor update files downloadable from the Internet. Madrid Monitor is updated daily and is available to the public, free of charge on the Internet at <https://www3.wipo.int/madrid/monitor/en/>. Madrid Monitor provides access to the Gazette. [Rule 33]

88. Madrid Monitor provides a powerful search tool for trademark attorneys and agents. While every effort is made to ensure that the information in Madrid Monitor accurately reflects the data recorded in the International Register, the only official publication remains the Gazette and the only official statements by the International Bureau regarding the contents of the International Register for a given international registration remain the certified extracts from the Register established on request by the International Bureau (see paragraphs 102 to 105).

89. The International Bureau continues to improve the scope of the information available to users of Madrid Monitor. To that end, where relevant, the database contains a statement in respect of the designation of each Contracting Party in an international registration to the effect that, although the time limit for the notification of a provisional refusal has expired, the International Bureau has not recorded any such notification of provisional refusal. The said statement is made available on Madrid Monitor three months after the expiry of the applicable refusal period.

90. In addition, digitized copies of notifications received by the International Bureau in accordance with Rules 17, 18*bis*, 18*ter* and 19 of the Regulations since January 1, 2005 and having a corresponding registration in the International Register, are accessible directly by users of Madrid Monitor database in PDF format under the corresponding heading and INID code. This concerns, for example, statements of grant of protection, notifications of provisional refusal, final decisions (statements of confirmation of total refusal or statements of grant of protection following a provisional refusal), further decisions or invalidations.

Online Services Assisting in the Filing of Applications and Management of International Registrations

There are a number of useful customized tools designed by WIPO to assist the trademark applicants during each stage of their trademark's lifecycle.

The Madrid Application Assistant

91. The Madrid Application Assistant is an electronic version of the official MM2 form that applicants may use to file an international application under the Madrid System. This new tool is available to applicants where the Office of origin does not offer the services of Madrid e-Filing or its own online filing solutions. The Madrid Application Assistant records all the information required to complete an international application in an intuitive and linear manner. Once completed, the international application will be made available in a PDF format ready for the applicant to submit to the Office of origin for certification. Information required to fill out the international application may be imported directly from the Office of origin's national/regional trademarks database. This not only saves time and effort, but also reduces the risk of irregularities, thus making the process of filing an international application more efficient and

accurate. When using the Madrid Application Assistant, the applicant can check the list of goods and services, and have this translated automatically, by using the integrated Madrid Good and Services Manager. The fees may be paid by using a current account opened with WIPO (https://www.wipo.int/finance/en/current_account/index.html), by bank transfer or by credit card.

92. The Madrid Application Assistant is available to the public, free of charge, at <https://www.wipo.int/madrid/application-assistant/>. Applicants can check whether they can use this tool to file through their Office of origin.

Madrid Goods and Services Manager

93. The Madrid Goods and Services (MGS) is an online tool that provides access to a database of goods and services. It assists trademark applicants in compiling the list of goods and services that must be submitted when filing an international application. The MGS provides terms from the alphabetical list of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) as well as a much wider choice of terms that are pre-accepted by the International Bureau and many Intellectual Property Offices in the Madrid System. Using such pre-accepted terms enables applicants to avoid irregularity letters from the International Bureau. The pre-accepted terms of goods and services are provided in the three languages of the Madrid System as well as in many other languages. The MGS enables users to obtain an instant translation of a list of goods and services from any of those languages into any other one available on the MGS. It also features a function enabling users to check whether the terms of a list of goods and services that are pre-accepted by the International Bureau will be accepted or not by some Contracting Parties of the Madrid System that they wish to designate in an international application, or subsequently, thereby enabling them to avoid provisional refusals and to prepare adequate simultaneous limitations in the international application, or in the subsequent designation. The MGS is available to the public, free of charge, at <https://webaccess.wipo.int/mgs/>.

Member Profiles Database

94. The Madrid Member Profiles Database is an online tool that provides access to information concerning the laws and practices of the trademark Offices of Contracting Parties. It helps applicants to understand the rules and procedures in effect in each of the target markets of interest, including time limits to respond to a refusal or opposition, to request a review, or to file an appeal. It also assists applicants to comply with the trademark requirements in the markets of interest and understand the procedures for filing an international application through the Office of origin. The Members Profiles Database is available to the public, free of charge, at <https://www.wipo.int/madrid/memberprofiles/#/>.

Madrid Portfolio Manager

95. The Madrid Portfolio Manager is an online service that allows holders of international registrations and their representatives to access their international trademark portfolios. Trademark holders have a user account which allows them to access the International Register online and view all transactions occurring on their international registrations, in real time. The service also offers the possibility for the trademark holder to manage actions pertaining to the protection of their own international registration(s), such as changes in name and/or address of the holder, presentations of subsequent designation, renewals and payments of fees. Madrid Portfolio Manager is available to trademark holders and their representatives, free of charge, at <https://www3.wipo.int/authpage/signin.xhtml?goto=https%3A%2F%2Fwww3.wipo.int%3A443%2Fmpm%2F>.

Madrid Monitor

96. Madrid Monitor is a tool for tracking the status of international applications or registrations and following the latest developments on all registered international trademarks. Madrid Monitor has several features and functions. It allows applicants to track the real-time status of registrations and related requests including changes in ownership and renewals. Once a mark has been registered, Madrid Monitor may be used to monitor its progress and find out where protection has been granted or refused. It is possible to use Madrid Monitor to set up e-mail alerts for updates on marks of interest, and it also provides access to the Gazette. Madrid Monitor is available to the public, free of charge on the Internet at <https://www3.wipo.int/madrid/monitor/en/>.

Online Renewal

97. It is possible to renew an international registration online in the WIPO IP Portal. The payment of renewal fees may be made by credit card or through a WIPO current account.

Online Subsequent Designation

98. It is possible to expand the geographical scope of an international registration online.

Online Payment

99. It is possible to pay fees owed with respect to international applications or registrations, as notified in WIPO irregularity letters or any other WIPO communication indicating the amount of the fees due in the relevant time limit. These payments may be made by credit card or through a WIPO current account.

Online Forms

100. The Madrid Registry is currently developing more online forms for various transactions such as, restricting the holder's rights (limitation, cancellation and renunciation), change in ownership and appointment or change of a representative.

Extracts from the International Register

101. On payment of the fee prescribed in the Schedule of Fees, anyone may obtain from the International Bureau the following certified documents concerning the contents of international registrations (either in force or expired): [Article 5ter(1)]

- The detailed extract is an analysis of the situation of an international registration. It consists of a certified copy of the international registration as originally published in the Gazette, with, as the case may be, details of any subsequent change, refusal, invalidation, statement of grant of protection, correction or renewal recorded in the International Register at the time the extract is prepared. The detailed extract is only available in the original language of the application for international registration. However, the cover page of the detailed extract can be requested in English, French, Spanish, Arabic, Chinese or Russian;
- a simple certified extract consists of certified copies of all entries that have been published in the Gazette with regard to a given international registration, together with, as the case may be, any notification of refusal of protection, invalidation or statement of grant of protection received at the time the extract is prepared. The simple certified extract is available only in the original language of the international registration. However, the cover page of the simple extract can be requested in English, French, Spanish, Arabic, Chinese or Russian;
- an attestation certifies specific information on the current status of an international registration and/or application;
- a copy of a certificate (registration or renewal) consists of a certified copy of a certificate of registration or renewal. It can only be requested by the holder or recorded representative.

A request for an extract should indicate the number and date of the international registration with respect to which an extract is requested and the type of extract requested. The establishment of an extract may be expedited, upon request and on payment of a fee.

Legalization of Extracts from the International Register

102. Such extracts from the International Register may be produced in legal proceedings in a Contracting Party. A Contracting Party may not require that the extract be subject to legalization. An extract from the International Register may be legalized with a view to its production in non-Contracting Parties of the Madrid System. Upon request, WIPO will arrange the legalization of extracts from the International Register for production in non-Contracting Parties of the Madrid System. [Article 5ter(3)]

103. Extracts of the International Register required for use in Contracting Parties of the Madrid System are exempt from legalization requirements. [Article 5ter(3)]

104. The legalization consists of an official stamp and signature certifying the validity of the information requested by the non-Contracting Party. Any person can request a legalized extract from the International Register. The extract requested (simple or detailed) will be certified with an official WIPO stamp and signed by an authorized person in the Madrid Registry, Brands and Design Sector. Once signed and stamped the original extract will be sent to the Civil Status and Legalization Service of the Republic and Canton of Geneva where the signature will be authenticated. The document will then be delivered to the relevant Consulate/Embassy of the non-Contracting Party/country for legalization.

105. It is currently not possible to legalize extracts for some countries. For further advice and/or an estimate, please use “Contact Madrid” (<https://www3.wipo.int/contact/en/madrid/>).

Annual, Monthly and “In Progress” Statistics

106. The International Bureau publishes on its website, for each calendar year, a statistical report summarizing activity under the Protocol during that year. Furthermore, it also publishes statistics featuring international applications, international registrations, subsequent designations, refusals and renewals, among others, in a dynamic form on an annual, monthly and “in progress” basis. The statistical information may be selected by Office of origin, Office of the Contracting Party of the holder or by designated Contracting Party. Statistics are available at <https://www.wipo.int/madrid/statistics/?lang=en>.

PART B: PROCEDURE

CHAPTER I: GENERAL

INTRODUCTION

This Chapter is concerned with procedural matters, which are of interest to applicants, holders and to Offices. It deals with communications with the International Bureau (including the methods of communication, the calculation of time limits and the language of communication), the payment of fees and representation before the International Bureau.

COMMUNICATIONS WITH THE INTERNATIONAL BUREAU

107. Three kinds of communications are, in principle, possible:

- between the International Bureau and the Office of a Contracting Party;
- between the International Bureau and the applicant or holder (or representative);
- between the applicant or holder (or representative) and an Office.

108. Communications which do not involve the International Bureau (that is, communications between an Office and an applicant or holder or a representative), are outside the scope of the Protocol and of the Regulations. They are a matter for the law and practice of the Contracting Party concerned.

109. Communications between the International Bureau and an Office or applicant or holder are governed, as regards the form and the manner of communicating and such matters as language and the effective date of the communication, by the Regulations and the Administrative Instructions. In particular, the Regulations sometimes allow the applicant or holder to choose whether to communicate directly with the International Bureau or through an Office. However, such choice is not always given, for example, an international application must always be filed through the Office of origin.

110. Unless otherwise specified, where this Guide refers to a communication being sent to or by an applicant or holder, this is to be understood as meaning that, where a representative is recorded in the International Register for that applicant or holder, the communication will be sent to, or may validly be sent by, that representative (see paragraphs 182 to 184).

Methods of Communications

111. Communications between an applicant or holder and the International Bureau must be in writing, and may take place by electronic means, at a time and in a manner and format to be determined by the International Bureau. Communications between an Office and the International Bureau may be in writing or, where an Office so desires, by electronic means in a way agreed upon between the International Bureau and the Office concerned. [A.I. Sections 6 and 11]

Communications in Writing

112. Communications addressed to the International Bureau may be sent by mail (through a postal or other delivery service) or by electronic means. [A.I. Section 11]

113. Any communication in writing addressed to the International Bureau must be typed or otherwise printed. Handwritten communications are not acceptable. The communication must be signed. The signature may be handwritten, printed, typed or stamped. [A.I. Section 6] [A.I. Section 7]

114. If several documents are mailed to the International Bureau in one envelope, they should be accompanied by a list identifying each one of them. The International Bureau will inform the sender of any discrepancy between the list and what is actually received. [A.I. Section 6(b)]

Electronic Communications

115. Any communication between an Office and the International Bureau, including the presentation of an international application, may be made by electronic transmission. The methods for such communication, including the presentation of the content of official forms and the means for self-identification of the sender, are a matter for agreement between each Office and the International Bureau. [A.I. Section 11(a)(i)]

116. The preference of the International Bureau is to communicate electronically with the Offices and its users. The International Bureau notifies Offices electronically, and most Offices are also transmitting their communications to the International Bureau electronically. It is no longer possible to communicate with the International Bureau by telefacsimile.

117. Ideally, communications between the International Bureau and applicants and holders should also be by electronic means. On February 1, 2021, amendments to Rules 3(2)(a), 9(4)(a)(ii) and (iii) and 25(2)(a)(iii) of the Regulations entered into force. As such, applicants, holders and their representatives must indicate an e-mail address in the international application, in a separate communication appointing a representative, or in a request for the recording of a change in ownership. A consequential amendment to Rule 36(ii) of the Regulations clarifies that changes to the e-mail address of the representatives are exempt from the payment of fees. The e-mail address of the applicant or holder are already exempt from fees. This means that where the International Bureau has the e-mail address of the applicant, holder or their representatives, all communications from the International Bureau will be sent to that e-mail address. [A.I. Section 11(a)(ii)]

118. Electronic communication is traceable and allows the International Bureau to determine whether a communication has reached its intended recipient. The International Bureau transmits time sensitive communications using a registered e-mail service that delivers a receipt for every e-mail sent and indicates when such e-mail has failed to reach the intended recipient. The International Bureau will continue to send communications by postal services where a communication sent by electronic means fails to reach its intended recipient.

119. Users can use “Contact Madrid” (<https://www3.wipo.int/contact/en/madrid/>) to inform the International Bureau of the e-mail address that they wish to use for this purpose, as well as the list of all international registrations concerned. The International Bureau will send all communications to that e-mail address in PDF format within one month of being informed.

120. Provided the sender can be identified and can be reached, the International Bureau will promptly, by electronic transmission, confirm receipt of the electronic communication, and of any deficiencies in the transmission (for example, if it is incomplete or illegible). [A.I. Section 11(b)]

121. Where, because of a time difference between the place from where an electronic communication has been sent and Geneva, the date on which the transmittal of a communication by electronic means was started is different from the date on which it was received by the International Bureau, the earlier of the two dates shall be considered to be the date of receipt by the International Bureau. [A.I. Section 11(c)]

122. In 2006, WIPO introduced an online international trademark renewal tool enabling users to maintain their trademark rights simply and economically. This tool has been significantly enhanced over the years, making it the preferred way to request renewal of an international mark than the renewal form MM11 in PDF format. [Rule 30] [Rule 39]

123. As regards the electronic communications referred to in Section 11(a)(i) of the Administrative Instructions, a signature may be replaced by a mode of identification agreed upon between the International Bureau and the Office concerned. With respect to the electronic communications referred to in Section 11(a)(ii), a signature may be replaced by a mode of identification to be determined by the International Bureau. [A.I. Section 7]

Official Forms

124. Where the Protocol or Regulations require the use of an official form, this refers to a form established by the International Bureau. The forms are available on WIPO’s website. [Rule 1(xxvii)] [A.I. Section 2]

125. As an alternative to using a form produced by the International Bureau, Offices, applicants or holders may generate their own forms. Such self-generated forms will be acceptable to the International Bureau provided that they have the same contents and format as the official forms. Where, however, such a form is presented through an Office (for example, for an international application), it is for the Office to decide whether it is acceptable (see paragraph 128).

126. The items in such self-generated forms need not have the same spacing and layout as in the forms established by the International Bureau. Indeed, one advantage of producing such forms is that as much space can be allocated to a given item as is needed; for example, where an international application is in the names of several applicants, or there is a particularly long list of goods and services, use of such self-produced forms can avoid the need for continuation sheets. The following prescriptions must, however, be observed:

- the form must be on A4 paper, written on one side only;
- the form must contain the same items, with their numbering and titles, in the same order, as the official form established by the International Bureau;
- where use of the official form requires a box to be checked, the wording which accompanies the box should be reproduced;
- where an item is not used or is not applicable, the item should not be omitted, but should be included with an appropriate indication, such as “not applicable” or “nil” or “not used”; for example, if an international application submitted on a self-generated form does not include a claim to priority, the form should still include the relevant entry, between items 5 and 7, with an appropriate indication, such as: “6. Priority: Not applicable”;
- in the case of an international application, the reproduction of the mark must be of a size that would fit within the box in the official form (8 cm x 8 cm); where there are two such reproductions (one in black and white and one in color (see paragraph 251)), they should both be on the same page.

127. The form must be completed legibly, by means of a typewriter or other machine. Handwritten forms are not acceptable. [A.I. Section 6(a)]

128. It will be the responsibility of the Office to ensure that the forms are updated, following changes in the Regulations or for new Contracting Parties.

Continuation Sheets

129. Where the space available in any part of a form is insufficient (for example, in the case of an international application, because there is more than one applicant, or more than one basic registration or application, or more than one priority application) one or more continuation sheets should be used (unless the use of a self-generated form avoids the need to use such continuation sheets). On the continuation sheet, it is necessary to indicate “Continuation of item number ...”, the information then being presented in the same manner as required in the form itself. The number of continuation sheets used should be indicated in the box provided at the beginning of the form.

Indication of Dates

130. Any indication of a date in an official form must consist of the day in two digits, followed by the number of the month in two digits, followed by the number of the year in four digits, all in Arabic numerals and day, month and year being separated by slashes (/). For example, the date March 9, 2020, is to be written as “09/03/2020”.

Optional Forms

131. In addition to the official forms, several optional forms are available, for example, for renewing an international registration. The use of these forms is not compulsory; they are provided by the International Bureau for the convenience of users. [A.I. Section 3]

Signatures

132. Signatures may be handwritten, printed, typed or stamped. The International Bureau does not check the authenticity of signatures; it only controls that signatures are actually made. Provided the signature box in the form is not empty the signature requirement will be considered met; only a blank box should elicit an irregularity. Where the application is transmitted to the International Bureau by electronic means, the signature is replaced by a mode of identification agreed with the International Bureau. [A.I. Section 7] [Rule 9(2)(b)]

Calculation of Time Limits

133. The Protocol and the Regulations lay down time limits within which certain communications must be made. Normally, the date on which the time limit expires is the date on which the communication must be received by the International Bureau. An exception to this is the time limit within which the Office of a designated Contracting Party may notify refusal of protection; in this case, it is the date on which the Office sends the notification to the International Bureau which is decisive.

134. Any communication from the International Bureau which refers to a time limit will indicate the date of expiry of that time limit, calculated in accordance with the following rules: [Rule 4(5)]

- any period expressed in years expires, in the relevant subsequent year, on the same day and month as the event from which the period started to run, except that a period which started on February 29, and ends in a year in which there is no such date, will expire on February 28. For example, a period of 10 years from February 20, 2021, will expire on February 20, 2031; a period of 10 years from February 29, 2020, will expire on February 28, 2030. [Rule 4(1)]
- any period expressed in months expires, in the relevant subsequent month, on the day having the same number as the day of the event from which the period started to run, except that if there is no day with that number, the period expires on the last day of the month. For example, a period of two months which begins on January 31 ends on March 31, while a period of three months which begins on the same date ends on April 30. [Rule 4(2)]

- any period expressed in days starts on the day following the day on which the relevant event occurred. For example, a period of 10 days which is to be reckoned from an event which occurred on the twelfth day of a month will expire on the twenty second day of that month. [Rule 4(3)]

135. If, in accordance with paragraph 134, a period within which a communication must be received by the International Bureau would expire on a day on which the International Bureau is not open to the public, it will expire on the next subsequent day on which the Bureau is open. For example, if a period within which a communication must be received by the International Bureau ends on a Saturday or Sunday, the deadline will be met if the communication is received on the following Monday (assuming that the Monday is not a holiday); and, for example, a period of three months starting from October 1 will not expire on January 1 (which is a holiday at the International Bureau), but on the next working day. 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 is published on WIPO's website and in the WIPO Gazette of International Marks. [Rule 4(4)] [Rule 32(2)(v)]

136. Likewise if, in accordance with paragraph 134, the period within which a communication (such as a notification of provisional refusal) must be sent by an Office to the International Bureau would expire on a day on which the Office concerned is not open to the public, it will expire on the next subsequent day on which the Office is open. It should be noted that this applies only where the period in question is specified in terms of the communication being sent by an Office within that period. Where the period is specified in terms of the communication being received by the International Bureau within that period, paragraph 135, shall apply; in such a case, late receipt of the communication by the International Bureau cannot be excused on the ground that its dispatch was delayed because the Office which sent it was closed.

Irregularities in Postal and Delivery Services and in Communications Sent Electronically

137. Where a time limit is not met because a communication addressed to the International Bureau by an applicant or holder or by an Office is unduly delayed or is lost because of an irregularity in a postal or delivery service or in communications sent electronically, this may be excused, provided due care has been exercised by the sender and the communication was dispatched in good time. The rule is that failure to meet a time limit shall be excused if the party which sent the communication submits evidence showing, to the satisfaction of the International Bureau: [Rule 5(1), (2) and (3)]

- (i) that the communication was mailed or sent to the International Bureau at least five days prior to the expiry of the time limit, or, where the postal or 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 mailed or sent not later than five days after postal or delivery service was resumed;
- (ii) that the mailing of the communication was registered, or details of the communication were recorded by the postal or delivery service at the time of mailing or sending; and
- (iii) in the case of a communication sent by a postal service from a location from which not all classes of mail normally reach the International Bureau within two days of mailing, that the communication was either mailed by a class of mail which normally reaches the International Bureau within two days of mailing, or was sent by airmail.

- (iv) in the case of a communication sent electronically, failure of an interested party to meet a time limit would be excused where the interested party submits satisfactory evidence showing that the time limit was not met because of a failure in the electronic communication with the International Bureau or a failure that affects the locality of the interested party due to extraordinary circumstances beyond the control of the interested party.

138. Failure to meet a time limit shall be excused only if the evidence referred to in paragraph 137 and the communication or a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit, or, in the case of a communication sent electronically, a new communication is effected no later than five days after the electronic communication services are resumed. [Rule 5(3) and (4)]

139. Where an international application or a subsequent designation is received from an Office by the International Bureau more than two months after it was filed with that Office, the international registration or the designation will normally bear the date on which it was actually received by the International Bureau. Where however the Office concerned indicates that the late receipt resulted from an irregularity in the postal or delivery service, the application or designation will be considered to have been received within the time limit (and will therefore be able to keep the date on which it was filed with that Office (see paragraphs 340, 341 and 453), provided that the circumstances referred to in paragraphs 137 and 138 apply. [Article 3(4)] [Rule 24(6)(b)] [Rule 5(5)]

Failure to Meet Time Limits Due to COVID-19 Pandemic

140. Following the outbreak of the COVID-19 pandemic early 2020, the application of Rule 5 of the Regulations has been clarified in Information Notice 27/2020⁵ titled “Excuse from Failure to Meet a Time Limit Due to the COVID 19 Disease Outbreak as a Natural Calamity: Waiver of the Submission of Evidence Required under Rule 5 of the Regulations”.

141. In certain parts of the world, access to mail and delivery services, as well as to electronic communication might be impracticable due to measures taken in connection with the COVID-19 outbreak, such as, for example, lockdown, quarantine or self-isolation. In such a situation, under Rule 5(1), (2) and (3) of the Regulations, applicants, holders and Offices who have failed to meet a time limit for a communication addressed to the International Bureau may be excused if they send that communication within five days after regaining access to mail or delivery services or to electronic communication. In any event, the International Bureau must receive the communication no later than six months from the date on which the time limit concerned expired. The International Bureau will treat favorably any request made under Rule 5 of the Regulations citing COVID-19 related issues and not require that applicants, holders or Offices submit evidence in support of such request.

142. Rule 5 of the Regulations applies to any communication addressed to the International Bureau for which there is a time limit under the Regulations or the treaty. For example, a communication:

- in which an Office transmits an international application or a subsequent designation;
- in which an Office notifies a provisional refusal; or

⁵ https://www.wipo.int/edocs/madrdocs/en/2020/madrid_2020_27.pdf.

- in which an applicant, a holder or an Office remedies an irregularity in an international application or in a request for recording.

143. Rule 5 of the Regulations also covers the time limit to pay any fee to the International Bureau, including the period of grace to pay the fees for the renewal of an international registration. Accordingly, this will apply to communications addressed to the International Bureau for acceptable modes of payment under the Madrid System (e.g. instructions to debit from a current account at WIPO or a payment by transfer to a WIPO bank or postal account).

144. For more detailed information see Information Notices No. 7/2020⁶ and No. 27/2020⁷. Users can present requests and send communications to the International Bureau via the online services or Contact Madrid.

Continued Processing

145. Since January 1, 2015, Rule 5*bis* of the Regulations allows an applicant or holder to request continued processing before the International Bureau where the applicant or holder failed to meet a time limit for an action in a procedure before the International Bureau. Continued processing is available only in those cases which are listed in an exhaustive manner in Rule 5*bis*, namely with respect to time limits concerning: [Rule 5*bis*]

- irregularities relating to an international application, under Rule 11(2) or (3) of the Regulations;
- irregularities relating to a request for the recording of licenses, under Rule 20*bis*(2) of the Regulations;
- irregularities relating to a subsequent designation, under Rule 24(5)(b) of the Regulations;
- irregularities relating to a request for the recording of a change or cancellation, under Rule 26(2) of the Regulations;
- the payment of the second part of the individual fee, under Rule 34(3)(c)(iii) of the Regulations; and
- a request that an international registration continue its effects in a successor State and the payment of the fees related to this request, under Rule 39(1) of the Regulations.

146. The request for continued processing can be made within two months from the expiry of the time limit concerned. However, the request is only possible after the expiration of the respective time limit. Continued processing cannot be requested as a precaution before the end of the time limit for any of the actions listed above. The request for continued processing needs to be presented to the International Bureau on the official form MM20. The form must be signed by the applicant or holder. A fee of 200 Swiss francs is due for this request. Together with the request and the payment of the fee for continued processing, the requirements in respect of which the respective time limit was missed needs to be complied with. All this has to be done within the time limit for continued processing of two months.

⁶ https://www.wipo.int/edocs/madrdocs/en/2020/madrid_2020_7.pdf.

⁷ https://www.wipo.int/edocs/madrdocs/en/2020/madrid_2020_27.pdf.

147. A request for continued processing that does not meet the previously mentioned requirements shall not be considered as such and the International Bureau will notify the applicant or holder accordingly.

148. Where the request has been received in order, the International Bureau continues to process the international application, subsequent designation, request or other action for which a payment had to be made. The International Bureau will record any continued processing in the International Register and notify the applicant or holder accordingly.

149. In the case of continued processing relating to the recording of licenses under Rule 20*bis*(3) of the Regulations and to the recording of changes and cancellations under Rule 27(1) of the Regulations, the date of recording will be the date on which the time limit to comply with the corresponding requirement expired.

Languages

General Principles

Trilingual Regime

150. An international application may be filed in English, French or Spanish, according to what is prescribed by the Office of origin. That is, the Office of origin is entitled to restrict the choice of the applicant to only one language, or to two languages, or may permit the applicant to choose between any of the three languages. [Rule 6(1)]

151. Any communication concerning an international application or an international registration, which is addressed to the International Bureau by an Office or by an applicant or holder shall be in English, French or Spanish, at the option of the party sending the communication, irrespective of the language in which the international application was filed. However, there are two exceptions to this rule: [Rule 6(2)(i)]

- where a notification of provisional refusal refers, as a ground for refusal, to an application for a registration or a registration of a conflicting mark, the list of all goods and services or of relevant goods and services covered by that mark, may be in the language of the said application or registration. The same applies as regards a notification of provisional refusal based on an opposition, which refers, as a ground for refusal, to a mark which has been the subject of an application or registration: [Rule 17(2)(v)] [Rule 17(3)]
- where a Contracting Party has notified the International Bureau that it requires a declaration of intention to use the mark, it may require that the declaration be in a specific one of the three official languages, English, French or Spanish, irrespective of the language in which the international application was received by the International Bureau (see paragraph 66). [Rule 6(2)(ii)] [Rule 7(2)]

152. Any notification concerning an application or registration, which is addressed by the International Bureau to an Office, will normally be in the language in which the international application was filed. An Office may, however, notify the International Bureau that it wishes to receive all notifications concerning international applications or registrations in English, in French or in Spanish, irrespective of the language in which the international application was filed. That would enable an Office not to accept notifications in a prescribed language (or in two such languages) and to indicate to the International Bureau which other language should

be used instead. Where the notification by the International Bureau concerns the recording in the International Register of an international registration, the notification will indicate the language in which the relevant international application was received by the International Bureau. [Rule 6(2)(iii)]

153. Any notification concerning an application or registration, which is addressed by the International Bureau to an applicant or holder, will normally be in the language in which the international application was filed. An applicant or holder may inform the International Bureau, by checking the relevant box in the international application form that they wish to receive all such notifications in English, in French or in Spanish, irrespective of the language in which the international application was filed. [Rule 6(2)(iv)]

PAYMENT OF FEES TO THE INTERNATIONAL BUREAU

154. The amounts of the fees payable in connection with an international application or registration are either prescribed in the Schedule of Fees appended to the Regulations or (in the case of individual fees) fixed by the Contracting Party concerned. Information concerning individual fees is published on WIPO's website and in the Gazette.

155. Fees may be paid by the applicant or holder directly to the International Bureau. Alternatively, where the Office of origin or the Office of the Contracting Party of the holder agrees to collect and forward such fees, an applicant or holder may pay fees to the International Bureau through that Office. An applicant or holder may not however be required to pay the fees through an Office. [Rule 34(2)(a)]

156. An Office which accepts to collect and forward fees to the International Bureau should so notify the Director General of WIPO. Any such notification will be published in the Gazette. [Rule 34(2)(b)] [Rule 32(2)(iv)]

Currency of Payment

157. All payments to the International Bureau must be made in Swiss currency. An Office which accepts to collect and forward fees may collect payments from the applicant or holder in another currency, but the payment forwarded to the International Bureau by the Office must be in Swiss currency. [Rule 35(1)]

Mode of Payment

158. Fees may be paid to the International Bureau: [A.I. Section 19]
- (i) by debit to a current account with the International Bureau;
 - (ii) by payment into the Swiss postal account or to any of the specified bank accounts of the International Bureau;
 - (iii) by credit card, where, in the context of an electronic communication under Section 11 of the Administrative Instructions, an electronic interface for online payment has been made available by the International Bureau.

159. An electronic interface for the payment of fees (“Online Payment”) due with regard to international applications or registrations, as notified in irregularities letters or other WIPO communications indicating the amount of the fees payable within an applicable time limit, is available on the WIPO Madrid system website under “Online Services”. More precisely, Online Payment may be used in the following situations:

- (a) where an irregularity notice has been issued by the International Bureau, and any amount of fee is due with respect to an international application, a subsequent designation, a request for the recording of a change or of a license, a request for amendment of the recording of a license or the renewal of an international registration;
- (b) where a notification concerning the payment of the second part of the individual fee has been issued by the International Bureau in respect of the designation of any Contracting Party;
- (c) where an invitation to request the continuation of effects of international registrations in a successor State has been issued by the International Bureau.

Online Payment can be made by credit card or through a WIPO current account. An acknowledgement of receipt of payment will be sent automatically.

160. An applicant, holder or representative (or indeed an Office) having frequent dealings with the International Bureau (possibly also in connection with matters other than international registration of marks, such as applications under the Patent Cooperation Treaty or applications under the Hague Agreement) will find it useful to maintain a current account with the International Bureau. This greatly simplifies the payment of fees and, as explained below, reduces the risk of irregularities due to late or incorrect payment. This method of payment is of course dependent on there being a sufficient balance in the account; the International Bureau will therefore inform the holder of the account whenever the balance has diminished to an extent that there is a danger that it might be insufficient to cover the next fee.

161. Whenever a fee is paid to the International Bureau, the purpose of the payment must be indicated, together with information identifying the application or registration concerned. This information should include: [Rule 34(5)]

- before the mark has been registered as an international registration, the mark to which the payment relates, together with the name of the applicant and, as far as possible, the number of the basic application or registration;
- after international registration, the name of the holder and the international registration number.

162. Where payment is made other than by debit from a current account with the International Bureau, the amount being paid should be stated. It is not necessary to do this when payment is made from such an account; instead, it is sufficient to give instructions to the International Bureau (by checking the appropriate box on the fee calculation sheet in the relevant official form) to debit whatever is the correct amount for the transaction in question. Indeed one of the advantages of paying by this method is that it avoids the risk of an irregularity if the fees as calculated by the applicant or the holder are incorrect. Where instruction is given to the International Bureau to debit the appropriate amount and an amount is nevertheless indicated, the International Bureau will treat the latter amount as indicative only and will debit the correct amount, which will appear in the detailed monthly statement of the transactions recorded for the current account. For further information, on how to open an account, please see WIPO’s website (https://www.wipo.int/finance/en/current_account/open.html).

Date of Payment

163. Where the International Bureau receives instructions to debit fees from such current account, and provided the required amount is available in the account, the fees are considered to have been paid: [Rule 34(6)]

- in the case of an international application or subsequent designation, on the day on which the application or designation was received by the International Bureau;
- in the case of a request to record a change, on the day on which the request was received by the International Bureau;
- in the case of renewal of the international registration, on the day on which instructions to renew were received by the International Bureau.

Where payment is made by any other method, or where the amount in the current account is insufficient, the fees are considered to have been paid on the date on which the International Bureau received the required amount.

Change in the Amount of Fee

164. Where the amount of a fee payable in respect of the filing of an international application (see paragraphs 291 to 305) changes between the date on which the request to present the international application was received or is deemed to have been received by the Office of origin and the date on which the application was received by the International Bureau, it is the fee that was valid on the earlier date that is applicable. [Rule 34(7)(a)]

165. Where a subsequent designation is presented through an Office and the amount of a fee payable in respect of that designation changes between the date on which the request to present the subsequent designation was received by that Office and the date on which the designation was received by the International Bureau, the fee that was valid on the earlier date applies. [Rule 34(7)(b)]

166. Where the amount of a renewal fee changes between the date on which the fee was paid to the International Bureau and the date on which renewal is due, provided the payment is made not more than three months before the date on which renewal is due, the fee that was valid on the date of payment applies. Where the renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable. [Rule 34(7)(d)]

167. In any other case, the applicable amount is that which was valid on the date on which the payment was received by the International Bureau. [Rule 34(7)(e)]

Fee Reduction for Applicants from Least Developed Countries (LDCs)

168. Applicants who file their international applications through the trademark office in a least developed country, as the Office of origin, will be required to pay only 10% of the amount of the basic fee. This is reflected in the Schedule of Fees and has been incorporated in the Fee Calculator on WIPO's website (<https://www.wipo.int/madrid/feescalculator/>).

169. The list of least developed countries is maintained and updated on a regular basis by the United Nations and may be consulted on the United Nations website at <https://www.un.org/> (<https://www.un.org/development/desa/dpad/least-developed-country-category/ldcs-at-a-glance.html>).

REPRESENTATION BEFORE THE INTERNATIONAL BUREAU

170. The applicant or holder may appoint a representative to act on their behalf before the International Bureau. This may or may not be the same representative that they use before the Office of origin. [Rule 3(1)(a)]

171. References in the Regulations, the Administrative Instructions or in this Guide to representation relate only to representation before the International Bureau. The questions of the need for a representative before the Office of origin or the Office of a designated Contracting Party (for example, in the event of a refusal of protection issued by such an Office), who may act as a representative in such cases and the method of appointment, are outside the scope of the Protocol and Regulations and are governed by the law and practice of the Contracting Party concerned.

Appointment of Representative

172. With regard to who may be appointed as a representative before the International Bureau, the Madrid System does not provide for any requirement as to professional qualification, nationality, residence or domicile.

Method of Appointment

In International Application, Subsequent Designation or Request to Record a Change

173. A representative may be appointed in an international application, simply by indicating their name and address in the appropriate part of the official form. Similarly a representative may be appointed by giving their name and address, including the e-mail address, in the official form for presenting a subsequent designation or for requesting the recording of a change, provided that the form is signed by the holder or is presented through an Office. Where a representative is appointed in this way, no further formality is necessary; in particular, no power of attorney should be sent to the International Bureau. [Rule 3(2)(a)]

In a Separate Communication

174. The appointment of a representative may also be made at any time in a separate communication. Such separate communication may be presented to the International Bureau: [Rule 3(2)(b)]

- by the applicant, holder or representative, in which case it must be signed by the applicant or holder;
- by the Office of the Contracting Party of the holder, in which case it must be signed either by the applicant or holder or by the Office through which it is presented.

175. The communication may be a simple letter providing that it clearly identifies the person making the appointment, the appointed representative and the international application or registration concerned. An optional (MM12) form for appointing a representative is, nevertheless, available from the International Bureau for the convenience of applicants and holders.

176. Such an appointment may relate to any number of specified international applications or registrations, provided they are all clearly and individually identified. The International Bureau cannot accept, as an appointment of a representative, a communication which simply refers to “all” international applications and registrations in the name of the same applicant or holder.

Only One Representative

177. The International Bureau will recognize only one representative in respect of a given international application or registration. Where a document in which a representative is appointed indicates the names of more than one representative, only the one indicated first will be considered to have been appointed. Where, however, a partnership or firm of attorneys or patent or trademark agents has been indicated, this will be regarded as a single representative. [Rule 3(1)(b) and (c)]

Irregular Appointment

178. Where the appointment of a representative was not made in accordance with the requirements referred to above, the International Bureau will consider the appointment to be irregular. It will notify accordingly the applicant or holder and the purported representative and, if the sender or transmitter is an Office, that Office. [Rule 3(3)(a)]

179. Where the appointment is regarded as irregular or as not having been made, the International Bureau will send all relevant communications to the applicant or the holder. [Rule 3(3)(b)]

Recording and Notification of Appointment

180. If the appointment complies with the applicable requirements, the International Bureau will record the fact that the applicant or holder has a representative, and their name and address, in the International Register. The effective date of the appointment is the date on which the International Bureau has received the communication (international application, subsequent designation, request to record a change or separate communication) in which the appointment was made. The appointment of the holder’s representative, as recorded in the International Register, will also be published in the Gazette. [Rule 3(4)(a)] [Rule 32(1)(a)(xiii)]

181. The International Bureau will notify the Offices of the designated Contracting Parties as well as both the applicant or holder and the representative, that the appointment has been recorded in the International Register. This means that Offices of designated Contracting Parties may contact the holder or the recorded representative directly if necessary, for example, to provide information on maintenance requirements to be complied with before the Office, or on cancellation actions initiated by third parties. Where the appointment was made in a separate communication presented through an Office, that Office will also be notified. [Rule 3(4)(b)]

Effect of the Appointment

182. Unless the Regulations expressly require otherwise, a recorded representative may always sign a communication, or carry out any other procedural step, in place of the applicant or holder. Any communication addressed by the representative to the International Bureau has the same effect as if it had been addressed to the International Bureau by the applicant or holder. Similarly, where a representative has been recorded, the International Bureau will send to this representative any invitation, notification or other communication which, in the absence of a representative, would have been sent to the applicant or holder. Any such communication has the same effect as if it had been addressed to the applicant or holder. [Rule 3(5)]

183. Where a representative has been appointed, the International Bureau will not normally send communications directly to the applicant or holder. There are a few exceptions to this rule:

- where the International Bureau finds that the appointment of a representative is irregular, it will so inform both the applicant or holder and the purported representative; [Rule 3(3)]
- six months before the expiry of the term of protection, the International Bureau will send an unofficial notice to both the holder and the representative; [Article 7(3)]
- where insufficient fees are paid for the purpose of renewal, the International Bureau will notify both the holder and the representative; [Rule 30(3)]
- where an international registration is not renewed or is not renewed in respect of a designated Contracting Party, the International Bureau will send a notification to the holder and the representative; [Rule 31(4)]
- where cancellation of the appointment is requested by the representative, the International Bureau will, until such time as the cancellation becomes effective, send communications to both the applicant or holder and the representative (see paragraphs 189 and 190).

184. Apart from these exceptions, whenever this Guide refers to anything being sent to, or done by, an applicant or holder, this should be understood as a reference to it being sent to, or allowed to be done by, a recorded representative.

Cancellation of Appointment

185. The recording of a representative will be cancelled upon receipt of a request signed by the applicant, holder or representative. Cancellation may be requested by means of a simple letter. The cancellation of the recording may be effected for all the international applications or registrations of the same applicant or holder in respect of which the representative had been appointed, or any specified international applications or registrations of that applicant or holder. Cancellations at the request of the holder or the holder's representative shall be published in the Gazette. [Rule 3(6)(a)] [Rule 32(1)(a)(xiii)]

186. The recording will also be cancelled *ex officio* by the International Bureau where a new representative has been appointed. As already noted (see paragraph 177), only one representative may be recognized at any one time; the appointment of a new representative is therefore assumed to replace any representative previously appointed. [Rule 3(6)(a)]

187. The recording of a representative will also be cancelled *ex officio* by the International Bureau where a change in ownership has been recorded, unless the representative is expressly re-appointed by the new holder of the international registration.

188. As a general rule, the cancellation becomes effective from the date on which the International Bureau receives the communication leading to the cancellation. Where, however, the cancellation is requested by the representative, the following paragraphs apply. [Rule 3(6)(b)]

Cancellation at the Request of the Representative

189. Where the International Bureau receives a request from the representative for cancellation of the recording of the appointment, it will immediately notify the applicant or holder of this fact, and will include copies of all communications sent to the representative, or received from this representative, during the six months preceding the date of the notification. The effective date of the cancellation will be the earlier of the following: [Rule 3(6)(d)] [Rule 3(6)(c)]

- the date on which the International Bureau receives a communication appointing a new representative, or
- the date of the expiry of a period of two months counted from the date on which the International Bureau received the communication from the representative requesting cancellation of the recording of the appointment.

190. Until the cancellation has become effective, all communications which normally would be addressed to the representative only will be addressed to the representative and to the applicant or holder. The interests of an applicant or holder are therefore safeguarded when a representative has requested the cancellation of the recording of the appointment without informing, or contrary to the wishes of, the client.

Notification of Cancellation

191. Once the cancellation has become effective, the International Bureau will 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, that Office. The cancellation at the request of the holder or the holder's representative shall also be notified to the Offices of the designated Contracting Parties. The International Bureau will send all future communications either to the new representative or, where no new representative has been recorded, to the applicant or holder. [Rule 3(6)(e)] [Rule 3(6)(f)]

No Fee for Recording

192. The recording of the appointment of a representative, of any change concerning the representative or of the cancellation of the recording of the appointment of a representative are exempt from the payment of a fee. [Rule 36(i)]

CHAPTER II: THE INTERNATIONAL PROCEDURE

INTRODUCTION

This Chapter describes the procedures under the Protocol, the Regulations and the Administrative Instructions.

It also provides explanations concerning the forms which may be required to be used, or which the International Bureau may provide for the convenience of the users of the System, and on how these forms should be completed.

The Chapter follows, as far as possible, the life of an international registration, starting with the international application and proceeding through to the recording of the international registration. It then deals with the various events, which can occur following international registration, such as refusal of protection, subsequent designation, requests for limitation of the list of goods and services, etc.

THE INTERNATIONAL APPLICATION

Substantive Requirements

Basic Registration or Application

193. The Madrid System is founded on the requirement of a basic national or regional registration or application for registration. An international application may be based on either a registration with the Office of origin (basic registration) or on an application for registration filed with that Office (basic application). This is referred to as the basic mark requirement. The international application may relate only to goods and services covered by the basic mark.

194. In most cases, the international application will be based on a single registration or application, which covers the goods and services listed in the international application. It is, however, possible to base an international application on several applications and/or registrations under the Protocol, which together cover the goods and services to which the international application relates. This would be especially relevant where the Contracting Party of the Office of origin previously has followed a single-class system. The basic marks must all be in the name of the person filing the international application and must have been made with the same Office. For the sake of simplicity, the following text refers only to a basic mark, it being understood that this includes the possibility of several basic marks.

The Office of Origin

195. Before filing an international application, the potential applicant must establish their entitlement with the Madrid System, and which Office or Offices may be the Office of origin for the international application in question.

196. “Office of origin” is defined (Article 2(2) of the Protocol) in a way which means that the applicant may freely choose their Office of origin on the basis of establishment, domicile or nationality, it being understood that there can be only one Office of origin. In the case of the Office of a country, an international application may be filed by anyone who is a national of that country or is domiciled or has a real and effective industrial or commercial establishment in that country. In the case of the Office of a Contracting Organization, an international application may be filed by anyone who is a national of a member State of that organization or who is domiciled or has a real and effective industrial or commercial establishment in the territory of that organization. [Article 2(2)] [Rule 1(xxv) and (xxvi)] [Article 2(1)(i)(ii)]

197. The interpretation of “national”, “domicile” and “real and effective commercial or industrial establishment” is a matter for the laws of the Contracting Parties to determine, each as far as it is concerned. This Guide can therefore only give some guidance.

198. “National”, under the Protocol, is intended to have the same meaning as in Article 2 of the Paris Convention, and it is understood to include both natural and legal persons. The question as to whether a natural person is a national of a particular country, and the criteria (for example, place of incorporation or headquarters) for deciding whether a legal entity is regarded as a national of that country, are matters for the law of that country. Likewise, it is for the law of a Contracting Party to determine what are the criteria for either a natural person or a legal entity to be regarded as domiciled in that Contracting Party. In practice, the question of the nationality or domicile of a legal entity will arise infrequently, since its entitlement to file an international application will usually be based on the existence of an establishment in the country of origin.

199. The expression “real and effective industrial or commercial establishment” is taken from Article 3 of the Paris Convention, to which it was added at the first conference for the revision of the Convention, which took place in Brussels in 1897 to 1900. It was felt that the original provision, which simply referred to “an establishment”, was too broad and should be restricted. The intention was that, by using the French term “sérieux” (“real” in English), fraudulent or fictitious establishments would be excluded. The term “effective” makes it clear that, while the establishment must be one at which some industrial or commercial activity takes place (as distinct from a mere warehouse), it need not be the principal place of business (in the Brussels Conference, the proposal by one of the States party to the Madrid Agreement to narrow down the requirement for establishment to the principal place of business was not adopted).

200. It is therefore to be understood that an enterprise may have several real and effective industrial or commercial establishments in different States that are party to the Protocol. In such a case, any of the Offices of the respective States may qualify as the Office of origin.

201. Where the Contracting State of which an applicant is a national, or in which they are domiciled or have an establishment, is also a member State of a Contracting Organization, there is the possibility of basing an international application on either a national or a regional application or registration.

Several Applicants

202. Two or more parties (whether natural persons or legal entities) may jointly file an international application, provided that the basic application or registration is also jointly owned by them, and that each of the applicants has the necessary connection through establishment, domicile or nationality with the Contracting Party whose Office is the Office of origin.

203. It is not necessary for the nature of the connection (nationality, domicile or establishment) to be the same for each applicant, but all must be entitled to file an international application with the Office of the same Contracting Party. [Rule 8(2)]

Presentation of the International Application

204. The international application must be filed through the Office of origin. The first contact that an Office will have with an international application, therefore, is when a request is made to it to present an international application to the International Bureau. [Article 2(2)] [Article 8(1)]

205. An international application which, instead of being presented through an Office, is presented by the applicant directly to the International Bureau will not be considered to be an international application. It will be returned to the sender without being examined in any way and any fees paid will be reimbursed to the party having paid them. [Rule 11(7)]

206. In such case, the International Bureau is not obliged to acknowledge receipt of an international application. Where transmitted by electronic communication, the International Bureau will acknowledge the receipt of an electronic communication (see paragraph 120) and will return the sending as described above.

Language of the International Application

207. An international application may be filed in English, French or Spanish, subject to what is prescribed by the Office of origin. That is, the Office of origin is entitled to restrict the choice of the applicant to only one language, or to two languages, or could permit the applicant or holder to choose between any of the three languages. [Rule 6(1)]

208. An international application which does not comply with these requirements concerning language will not be considered as such by the International Bureau, which will return it to the Office which forwarded it, without examining the application in any way and all fees paid will be reimbursed to the party which effected such payment. [Rule 11(7)]

The Application Form

209. An international application must be presented to the International Bureau on the official form (MM2). [Rule 9(2)(a)] [A.I. Section 2]

210. The Offices of some Contracting Parties provide forms for requesting an international application, that may differ from the official international application form, which applicants may be permitted or required to use, as prescribed by the law of the Contracting Party. Where the language(s) allowed before the Office of origin is not English, French or Spanish, the Office may require the applicant to provide the necessary information (in particular, the list of goods and services) in the language of the international application (English, French or Spanish), or it may itself translate the information into that language.

211. Some Offices offer the services of Madrid e-Filing or their own online filing solutions. If the applicant's Office of origin has neither, the applicant is advised to use the Madrid Application Assistant⁸, which is an electronic version of the official MM2 form.

⁸ <https://www.wipo.int/madrid/application-assistant/>.

212. The official forms are available on WIPO's website (<https://www.wipo.int/madrid/en/forms/>).

213. The official form must be completed legibly, with the use of a typewriter or other machine; handwritten forms are not acceptable by the International Bureau. Where, instead of using forms produced by the International Bureau, applicants produce their own form, the guidance set out in paragraph 126 must be followed.

Item 1: Contracting Party Whose Office Is the Office of Origin

214. The name of the State or intergovernmental organization whose Office is the Office of origin should be given, e.g. "Japan", "European Union", etc. In the case of a common Office under Article 9^{quater} of the Protocol, the name of the single State that the Contracting Parties concerned are deemed to constitute should be given, for example, "Benelux".

215. Where there is more than one applicant, the name of only one Contracting Party whose Office is the Office of origin should be indicated.

Item 2: Applicant

Name

216. Where the applicant is a natural person, the name to be indicated is the family (or principal) name and the given (or secondary) name(s) of the natural person as customarily used by that person and in the order in which they are customarily used. Where the applicant is a legal entity, its full official designation must be given. Where the name of the applicant is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application; where the applicant is a legal entity, the transliteration may be replaced by a translation into the language of the international application. [A.I. Section 12(a), (b) and (c)]

Address

217. The postal address of the applicant must be given in such a way as to satisfy the customary requirements for prompt delivery. In addition, telephone numbers may be given.

E-mail Address

218. The applicant must indicate an e-mail address in the international application. The International Bureau will send all communications concerning the international application and resulting international registration electronically only to the e-mail address recorded for the applicant/holder unless an alternative e-mail address for correspondence is indicated, or a representative is appointed. The applicant must ensure that the e-mail address provided is kept up to date. [Rule 9(4)(a)(ii)] [A.I. Section 12(d)]

Address for Correspondence

219. Where the name and address of a representative has been given in item 4, all communications, which are required to be sent by the International Bureau to the applicant or holder, will be sent to the e-mail address of that representative. Where no e-mail address of a representative is given in item 4, such communications will be sent to the address of the applicant given in item 2. Where communications are to be sent to an address different to that indicated in item 2, an address for correspondence may, at the option of the applicant, be indicated in this space; otherwise the field "address for correspondence" should be left blank. Since it is mandatory for the applicant to indicate an e-mail address, this means that where an

address for correspondence is indicated, this should also include an e-mail address. If information is only provided for a postal address for correspondence, the International Bureau will communicate with the applicant, using the e-mail address for the applicant. Any later inclusion or update of address for correspondence (including e-mail address) can be given to WIPO using Contact Madrid.

Phone Numbers

220. The applicant may also provide a phone number, so that the International Bureau may contact the applicant if needed, in case no e-mail address is indicated or where the one indicated is incorrect.

Application in the Names of More than One Applicant

221. If there is more than one applicant, the total number of applicants and the name and address of the first applicant only should be indicated. The name(s) and the address(es) of the other applicant(s) should be provided in the "Continuation Sheet for Several Applicants". Do not indicate the details of more than one applicant in item 2.

222. Where the international application is jointly filed by two or more applicants with different addresses, and neither the name and address of a representative nor an address for correspondence has been indicated, communications will be sent to the e-mail address of the applicant first named in the international application. [A.I. Section 13]

Preferred Language for Correspondence

223. In the case of an international application, the applicant may (by checking the appropriate box in item 2) indicate whether he or she wishes to receive communications from the International Bureau in English, in French or in Spanish. It is not necessary to check this box if the applicant wishes to receive communications in the language in which the international application was filed. It should be noted that this applies only to communications originating from the International Bureau; communications from Offices that are simply transmitted by the International Bureau, such as notifications of refusal, are sent in the language in which they are received from the Office. [Rule 6(2)(iv)]

Other Indications

224. Where the applicant is a natural person, he or she may indicate the State of which he or she is a national. Where the applicant is a legal entity, the nature of the legal entity may be indicated, together with the name of the State (and, where appropriate, the territorial unit within that State) in which it is incorporated. [Rule 9(4)(b)(i) and (ii)]

225. Such indications are not required by the Protocol or the Regulations, but may be included in the international application, to forestall objections in designated Contracting Parties which require them.

Item 3: Entitlement to File

226. The application should give one of the following indications concerning the applicant's connection with the Contracting Party through whose Office the international application is being presented, using the appropriate box or space in item 3(a):

- (where the Contracting Party is a State) that the applicant is a national of that State;

- (where the Contracting Party is an organization) the name of the member State of that organization of which the applicant is a national;
- that the applicant is domiciled in that Contracting Party;
- that the applicant has a real and effective industrial or commercial establishment in that Contracting Party.

Only one of these indications need be given, though more may be given if the applicant so wishes. [Rule 9(5)(b)]

227. The Office through which the international application is presented may ask for evidence where it has reasonable grounds to doubt the veracity of the indications given. In general, it may be presumed that the address given in item 2(b) is the address of the applicant's establishment or domicile. Even if this address is in the territory of the Contracting Party through whose Office the international application is presented, it is still necessary to check at least one box under item 3(a); if this is not done, it is not possible to determine the nature of the applicant's entitlement to file.

228. Where the applicant indicates, by checking the appropriate box(es) in item 3(a), that they have an establishment or domicile in the territory of the Contracting Party through whose Office the international application is presented, but the address (as given in item 2(b)) is not in that territory, the applicant must in addition indicate, in item 3(b), the address of their establishment or domicile in that territory. [Rule 9(5)(c)]

229. As indicated in paragraph 202, where the international application is jointly filed by two or more applicants, the requirements as to entitlement to file the international application must be satisfied in respect of each applicant. This information should be given in the specific continuation sheet for several applicants.

Item 4: Appointment of a Representative

230. If the applicant wishes to be represented before the International Bureau, the name and address of the representative should be given in this part of the form. The appointment of a representative will not be recorded unless an e-mail address of the representative has been indicated (see also paragraphs 170 to 181). [Rule 9(4)(a)(iii)] [A.I. Section 12(d)]

231. Where the name of the representative is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application. Where the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international application.

232. Giving the name and address (including the e-mail address) of the representative in the international application is all that is necessary to effect the appointment; no power of attorney or other separate document should be sent to the International Bureau.

233. With respect to who may be appointed as representative, the Madrid System does not provide for any requirement as to professional qualification, nationality, residence or domicile. As long as the more general requirements concerning the appointment of the representative are not complied with, the International Bureau sends all communications to the applicant.

234. The appointment of a representative in the international application only empowers him or her to act before the International Bureau. It may subsequently become necessary to appoint one or more further representatives to act before the Offices of designated Contracting Parties, for example, in the event of a refusal of protection issued by such an Office. The appointment of a representative in such a case will be governed by the requirements of the Contracting Party concerned.

Item 5: Basic Application or Basic Registration

235. An international application may be based either on a registration by the Office of origin or on an application for registration filed with that Office; equally, it may be based on several applications or registrations (or a combination thereof). [Article 2(1)]

236. A basic registration effected by the Office of origin must be indicated by its registration number and its date of registration. This date should be the date which, under the law which governs the Office concerned, is regarded as the date of registration, which will not necessarily be the date on which the mark was actually recorded by the Office in its register; for instance if, under the law applicable to that Office, a mark is registered as of the date of filing, that is the date that should be given here. Where an international application is based on a registration with the Office of origin, the number of the application from which the said registration resulted should not be given, because it is liable to be confused with a basic application. [Article 3(1)] [Rule 9(5)(b)]

237. A basic application filed with the Office of origin must be indicated by its application number and date of filing. [Rule 9(5)(b)]

238. Where there is more than one basic registration or more than one basic application, and all numbers and dates do not fit in the space provided, then (unless a self-generated form is used) the one(s) with the earliest date(s) should be given in item 5, and the remaining ones should be indicated in a continuation sheet.

Item 6: Priority Claimed

239. Priority of an earlier filing may be claimed under Article 4 of the Paris Convention. That earlier filing will normally be the basic application or the application which resulted in the basic registration. However it may also be: [Article 4(2)]

- another application made either in a country party to the Paris Convention or in a member of the World Trade Organization (WTO) even if the latter is not a party to the Paris Convention⁹; or

⁹ This results from the fact that members of the WTO are obliged by Article 2(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) to comply with Article 4 of the Paris Convention. However, the members of the Madrid Union that are not members of the WTO are not obliged to recognize the effects of a priority claim based on an application filed in a member of the WTO that is not party to the Paris Convention. However, the Office of origin should not decline to transmit such a claim. Otherwise, a designated State which is a member of the WTO would be hindered from fulfilling its obligation to recognize the priority claim.

- an application which, under a bilateral or multilateral treaty concluded between countries of the Paris Union, is equivalent to a regular national filing¹⁰.

240. Where priority is claimed, the applicant must indicate the name of the national or regional Office with which the earlier filing was made, together with the date of filing and (where available) the number of the application. No copy of the earlier filing is needed. [Rule 9(4)(a)(iv)]

241. Where priority is claimed from more than one earlier filing, and all relevant indications do not fit in the space provided, then (unless a self-generated form is used) the one(s) with the earliest date are to be given in item 6, with the remaining ones indicated in a continuation sheet.

242. Where the earlier filing does not relate to all of the goods and services listed in item 10 of the international application form, the applicant should indicate, in item 6, the goods and services to which the earlier filing relates. Where several earlier filings with different dates are indicated, the goods and services to which each relates should be indicated.

243. The International Bureau will disregard any claimed priority date which is more than six months earlier than the date of the international registration and will so inform the applicant and Office of origin. Such a date will therefore not be recorded in the International Register. However, in accordance with Article 4(C)(3) of the Paris Convention, where the last day of the six-month period from the claimed priority date is a day when the Office of origin is not open for the receipt of requests to present international applications, the six-month period will, where the international registration bears the date of the receipt by the Office of origin of the said request, be extended until the first following working day at the Office of origin; similarly, where the international registration bears the date of the receipt of the international application by the International Bureau, or a subsequent date, and the last day of the six-month period is a day when the International Bureau is not open to the public, the six-month period will be extended until the first following working day at the International Bureau. (For the date of the international registration, see paragraphs 340 to 345). [Rule 14(2)(i)]

244. As described in paragraphs 342 to 345, deficiencies or delays may cause the international registration to have a date, which is later than the date on which the international application was received by the Office of origin. If the result is that the date of international registration is more than six months after any priority date claimed, the claim to priority will be lost, and no data in respect of priority will be recorded by the International Bureau. [Rule 14(2)(i)]

Item 7: The Mark

245. A reproduction of the mark must be provided in box (a) in item 7 of the form. Such a reproduction must consist of a two-dimensional graphic (including photographic) representation of the mark. This reproduction must be identical with the mark as it appears in the basic application or registration. In particular, where the mark in the basic registration or application (the basic mark) is in black and white, so must the reproduction in this box; likewise where the basic mark is in color, the reproduction in this box must also be in color. [Rule 9(4)(a)(v)]

¹⁰ This results from Article 4A(2) of the Paris Convention. On this basis, the International Bureau records claims to priority from applications for European Union Trade Marks filed with the European Union Intellectual Property Office.

246. The boxes in this item of the application form measure 8 cm x 8 cm, which is the standard size for publication of a mark in the WIPO Gazette of International Marks.

247. The reproduction(s) of the mark must be sufficiently clear for the purposes of recording, publication and notification. If this is not the case, the International Bureau will treat the international application as irregular.

248. The reproduction(s) of the mark may be typed, printed, pasted or reproduced by any other means, at the option of the applicant and subject to what may be prescribed by the Office of origin.

249. Where the Office of origin transmits, to the International Bureau, the reproduction of the mark in electronic format, for example, JPEG, this image will appear in the Gazette. Where the Office of origin transmits the international application in paper format or PDF, the image used for publication is produced by scanning the application form, and the mark will be published in the Gazette exactly as it appears on the form. For example, if it is simply typed on the form, that is what will appear in the Gazette.

Special Kinds of Mark

250. Where the mark is of an unusual kind (for example, a three-dimensional mark or a sound mark), then the reproduction in box (a) should correspond exactly with the graphical representation of the mark which appears in the basic mark. If the representation in the basic mark consists of, for example, a perspective view of a three-dimensional mark, or a representation in conventional musical notation or a description in words of a sound mark, then this is what should appear in box (a) under item 7. Any description, which is supplementary to this graphic representation of the mark, should be given under item 9 (see paragraph 261). Non-graphical representations of such marks (such as samples of three-dimensional marks, or recordings of sound marks) must not be included.

Mark to Be in Color

251. Where the applicant claims color as a distinctive feature of the mark but the reproduction of the mark in the basic mark was in black and white (for example, because the Office of origin did not provide for registration or publication in color), a reproduction of the mark in color must be provided in box 7(b), in addition to the black and white reproduction to be provided in box (a). Otherwise, box (b) should be left empty. [Article 3(3)] [Rule 9(4)(a)(vii)]

Standard Characters

252. Where the applicant wishes that the mark be considered as a mark in standard characters, box (c) should be checked. A mark in standard characters is equivalent in some countries to what is known as a “word mark”, as opposed to a “figurative” mark. This declaration does not legally bind the Office or courts of a designated Contracting Party, which are free to determine what effect (if any) such a declaration has in their territory. In particular, they may consider that the mark is not in standard characters if it contains elements such as accents that are not standard in the language(s) used in that Contracting Party. [Rule 9(4)(a)(vi)]

253. This box should not be checked where the mark contains special characters or figurative elements. The International Bureau will not question a declaration concerning standard characters. However, the applicant should be aware that if the Office of a designated Contracting Party considers that the mark is not in standard characters, it may issue a refusal, for example, on the ground that the international registration covers two marks (one in standard characters and one in special characters) or that it is simply not clear for what protection is sought.

254. Where the mark that is the subject of the basic mark consists of a color or a combination of colors as such, that fact should be indicated by checking the appropriate box. This is without prejudice to the fact that a designated Contracting Party may refuse protection on the ground that such marks are not recognized under its law. [Rule 9(4)(a)(vii^{bis})]

Item 8: Color(s) Claimed

255. Where color has been claimed as a distinctive feature of the mark in the basic mark, such a claim should be reflected in the international application by checking the appropriate box, and the color or combination of colors must be indicated in words. Color may also be claimed in an international application despite the fact that there is not a corresponding claim in the basic mark. Where there is no such claim in the basic mark, the basic mark must be in the color or combination of colors claimed in the international application. Finally, where color is claimed, the applicant may, in addition, give an indication in words of the principal parts of the mark that are in that color, in respect of each of the colors claimed (see also paragraph 286). [Article 3(3)] [Rule 9(4)(a)(vii)] [Rule 9(4)(b)(iv)]

Item 9: Miscellaneous Indications

(a) Transliteration

256. Where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals, a transliteration into Latin characters or Arabic numerals must be provided. The transliteration into Latin characters must follow the phonetics of the language of the international application. [Rule 9(4)(a)(xii)]

(b) Translation

257. Where the mark consists of or contains words that may be translated, such a translation may be provided. The translation may be into English and/or French and/or Spanish, irrespective of the language of the international application. Providing a translation is optional. However by doing so, the applicant may avoid provisional refusals being issued by Offices of designated Contracting Parties that require such translations. The International Bureau will not check the accuracy of any translation of the mark, nor will it question the absence of a translation or provide a translation of its own. [Rule 9(4)(b)(iii)] [Rule 6(4)(b)]

(c) Indication that the Mark Cannot Be Translated

258. Where the applicant believes that the word or words appearing in the mark cannot be translated (that is, they are made-up words), this may be indicated by checking the appropriate box. This is intended to forestall provisional refusals from designated Contracting Parties requesting translation or for confirmation that no translation is possible.

(d) Special Type or Category of Mark

259. Where the mark is a three-dimensional mark, a sound mark or a collective, certification or guarantee mark, this should be indicated by checking the appropriate box. Such an indication may be given only if it appears in the basic mark. [Rule 9(4)(a)(viii) to (x)]

260. In the case of a collective, certification or guarantee mark, regulations governing the use of the mark are not required as part of the international application, and should not be sent to the International Bureau with the international application. A designated Contracting Party may, however, ask for such regulations to be filed. To forestall a provisional refusal by such a Contracting Party, an applicant may wish to send the required documents directly to the Office of that Contracting Party as soon as he or she receives the certificate of international registration.

(e) Descriptions of the Mark

261. Where the basic mark contains a description of the mark, the same description may, if the Office of origin so requires, be included in the appropriate space. Such a description may also indicate that the mark is of a kind not covered by the types or categories mentioned on the form (see paragraph 259), such as a hologram mark, provided that such an indication is present in the basic mark. Where the description in the basic mark is in a language other than the language of the international application, the description in this item must be given in the language of the international application. [Rule 9(4)(a)(xi)] [Rule 9(4)(b)(vi)]

262. The applicant may also include a description of the mark in the international application that is not included, or differs from the one in the basic mark. This will allow the applicant to include a description that is necessary to satisfy the requirements of some Contracting Parties for example, those that require a description of the mark in non-standard characters, and avoid unnecessary provisional refusals.

(f) Verbal Elements of the Mark

263. The International Bureau captures (from the reproduction in item 7) what appears to it to be the essential verbal elements of the mark. This is included in the Madrid Monitor database and is used in notifications and correspondence to confirm the identity of the resulting international registration. Where, however, the mark is in special characters or in handwriting, there is a risk that the words or letters may be misinterpreted by the International Bureau. Moreover, where the mark contains a great deal of verbal matter (for example, where the mark consists of a label), it may not be apparent what should be captured. The applicant may therefore wish to indicate what he or she considers to be the essential verbal elements of the mark. Any such indication is, however, entirely for information and is not intended to have any legal effect. This indication should not be given where the box in item 7 for standard characters has been checked.

(g) Disclaimer

264. Where the applicant wishes to disclaim protection for any verbal element of the mark, the element or elements for which protection is disclaimed should be indicated under this item. The purpose of this is to forestall requests from designated Contracting Parties for such a disclaimer to be included in the International Register. If, however, a disclaimer is included in the international application, it must be in respect of the international registration as a whole; it cannot be made for only some of the designated Contracting Parties. [Rule 9(4)(b)(v)]

265. It does not matter if there was no corresponding disclaimer in the basic mark. Conversely, if there was a disclaimer in the basic mark, this does not make it obligatory to include it in the international application. It is not possible to include a disclaimer in the International Register once the mark has been registered by the International Bureau.

Item 10: Goods and Services

266. The applicant must indicate the names of the goods and services for which the international registration of the mark is sought. These must be grouped in the appropriate classes of the International Classification of Goods and Services, each group being preceded by the number of the class, and presented in the order of the classes of that Classification. The goods and services must be indicated in precise terms, preferably using words appearing in the Alphabetical List of the International Classification. If necessary, a continuation sheet should be used and the appropriate box should be checked. [Rule 9(4)(a)(xiii)]

267. This list of goods and services must fall within the scope of the goods and services set out in the basic mark. This means that the list in the international application may be narrower, but it cannot be broader or contain different goods and services. The terms used in the international application do not have to be exactly the same, but they must, however, be equivalent to those used in the basic registration or application.

268. The Office of origin must check that all the goods and services listed are covered by those appearing in the basic mark, so that it can make the declaration referred to in paragraph 286 (item 13 of the official form MM2). The Office should also check that the classification and grouping of the goods and services is correct, to avoid the need for the International Bureau to notify it of any irregularity in this regard (see paragraphs 308 to 318).

269. The international application may contain limitations of the list of goods and services in respect of one or more designated Contracting Parties. Such limitations should be indicated in item 10(b). The limitation may be different in respect of different Contracting Parties. A limitation with respect to a designated Contracting Party for which an individual fee is payable will be taken into account in calculating the amount of that fee. In contrast, a limitation will not affect the number of supplementary fees to be paid. Even if a limitation is made for all the designated Contracting Parties, the goods and services named in item 10(a) are nonetheless included in the international registration and may be the subject of a subsequent designation. [Rule 9(4)(a)(xiii)]

270. A translation of the list of goods and services into English, French or Spanish, as the case may be, may be annexed to the international application. Although the International Bureau is not bound to accept such a translation as correct (see paragraph 353), it may assist the International Bureau in ensuring that the translation reflects the applicant's intentions, particularly where the list in the basic mark is in a language other than English, French or Spanish. [Rule 6(4)(a)]

Item 11: Designations

271. Those States or organizations in which the applicant wishes the mark to be protected should be indicated by checking the appropriate boxes in item 11. Where a self-generated form is used, the names of the Contracting Parties to be designated should be written in. [Rule 9(4)(a)(xv)]

272. The name of a Contracting Party for which there is no box on the official form, because it has ratified or acceded to the Protocol since the form was printed, may be written in, provided that the ratification or accession has entered into force. The latest form is available on WIPO's website (<https://www.wipo.int/madrid/en/forms/>).

273. Where a State or organization which has been designated has ratified the relevant treaty, or acceded to it, but the ratification or accession has not yet come into force, the Office of origin may cancel the designation and so inform the applicant; alternatively, it may ask the applicant whether he or she wishes the designation to be cancelled or whether he or she would prefer the request to be put on one side and be deemed to have been received on the date on which the ratification or accession in question comes into force.

274. It is possible to designate, in the international application or subsequently, certain territories that are not Contracting Parties *per se*, but where the Contracting Party concerned has extended the application of the Protocol to specific territories. This is the case for Bonaire, Saint Eustatius and Saba (BES-island), Curacao and Sint Maarten (Dutch part). These territories are not Contracting Parties; the Contracting Party concerned here is the Netherlands. Similarly, the Bailiwick of Guernsey is not a Contracting Party, but may be designated because the United Kingdom has extended the application of the Protocol to the Bailiwick of Guernsey (as of January 1, 2021). While these territories are not Contracting Parties, these will, however, perform the roles of an Office, as if they were Contracting Parties.

Indication of a Second Language

275. Where the European Union (EU) is designated in an international application, the applicant must, in addition to the language of the application itself, indicate a second working language before the Office of that Contracting Organization. The indication of this second language must be chosen among one of the (five) official languages of the European Union Intellectual Property Office (EUIPO), namely, English, French, German, Italian or Spanish. With regard to the designation of the EU in a subsequent designation, refer to paragraph 438. [Rule 9(5)(g)(ii)]

276. This second language serves exclusively as a language in which third parties may lodge opposition and cancellation proceedings before EUIPO.

277. Where the EU has been designated and the indication of the second language is missing or is incorrect, this does not prevent the International Bureau from proceeding to the international registration and notifying it to EUIPO. In such a case, however, a provisional refusal based on this ground will be notified by EUIPO and will have to be overcome by the holder directly before EUIPO.

Seniority Claim

278. Under the European Union Trade Mark system, the proprietor of a mark already registered in or for a member State of the EU who applies for registration of an identical mark with EUIPO for goods or services that are covered by the earlier mark, may claim the seniority of that earlier mark in respect of the member State concerned. The effect of such seniority claim is that where the proprietor of the EU trademark surrenders the earlier mark or allows it to lapse, he or she shall be deemed to continue to have the same rights as he or she would have had if the earlier mark had continued to be registered. [Rule 9(5)(g)(i)]

279. Applicants wishing to claim seniority in respect of a designation of the EU under the Protocol are required to indicate the following elements in a separate official form (MM17), to be annexed to the international application form: [A.I. Section 2]

- each member State 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.

280. With respect to the treatment of seniority claims by the International Bureau and to various operations which may arise in relation to such claims (such as the withdrawal, refusal or cancellation), see paragraphs 767 to 770.

Declaration of Intention to Use the Mark

281. Where a Contracting Party designated under the Protocol is one which has notified the Director General of WIPO, under Rule 7(2), that it requires a declaration of intention to use the mark on a separate form (MM18), that declaration should be annexed to the international application. Any additional requirements of that Contracting Party concerning the language or the signing of the declaration must also be complied with. In particular, a Contracting Party may require that the declaration be signed by the applicant. [Rule 9(5)(f)] [A.I. Section 2]

282. In the case of a Contracting Party which requires a declaration of intention to use the mark under Rule 7(2), but without requiring that it be on a separate form, no special action is needed, as the statement on the international application form indicates that by designating such a Contracting Party, the applicant declares that he or she has the intention that the mark will be used by the applicant or with his or her consent in that Contracting Party for the goods and services covered by the international application.

Item 12: Signature of the Applicant and/or Their Representative

283. The Office of origin may require or permit the applicant or his or her representative to sign the international application. The International Bureau will not question the absence of a signature from item 12. [Rule 9(2)(b)]

284. Any signature by the applicant or the representative may be handwritten, printed, typed or stamped. As regards electronic communications, the signature may be replaced by a mode of identification to be determined by the International Bureau. [A.I. Section 7] [A.I. Section 11(a)(ii)]

Item 13: Certification and Signature of the International Application by the Office of Origin

285. The Office of origin must sign the international application and must certify the date on which it received the request to present the international application (or is deemed to have received the application). This date is important because, in principle, it will become the date of the international registration (see paragraph 340). The Office of origin must also certify certain facts concerning the relationship between the international application and the basic registration or basic application. [Rule 9(2)(b)] [Rule 9(5)(d)(i)]

286. The declaration of the Office of origin in item 13 of the application form must certify:

- (a) that the applicant for the international registration is the same as the applicant or holder of the basic mark mentioned in item 5; where the international application is filed jointly by several applicants, they must all also be joint applicants or holders of the basic mark; [Rule 9(5)(d)(ii)] [Rule 8(2)]
- (b) that the mark indicated in item 7 is the same as the mark in the basic mark mentioned in item 5; [Rule 9(5)(d)(iv)]

- (c) that, where any of the following indications appears in the international application, the same indications appear also in the basic mark: [Rule 9(4)(a)(vii*bis*)-(xi), (5)(d)(iii)] [Rule 9(5)(d)(v)]
- an indication that the mark consists of a color or a combination of colors as such
 - an indication that the mark is a three-dimensional mark, a sound mark or a collective, certification or guarantee mark;
 - a description of the mark by words (it being understood that any description in the international application must however be in the language of the international application);
- (d) that, if color is claimed as a distinctive feature of the mark in the basic mark, 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 mark, the mark in the basic mark is in fact in the color or combination of colors claimed;
- (e) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic mark at the time when the Office certifies the international application; that is, each of the goods and services mentioned in the international application must either appear in the list in the basic mark, or must fall within a broader term included in that list; the list of goods and services in the international application may of course be narrower than that in the basic mark. [Rule 9(5)(d)(vi)]

287. Where the international application is based on two or more basic marks, this declaration may be made only if the statements under (a), (b), (c) and (d) in paragraph 286 are true for each of them. As far as the statement under (e) is concerned, the Office of origin may make this declaration provided that the goods and services mentioned in the basic mark(s), taken together, cover those listed in the international application. [Rule 9(5)(e)]

288. The international application must be signed by the Office of origin. This signature may be handwritten, printed, typed or stamped. The International Bureau does not check the authenticity of signatures; it only controls that signatures are actually made. Provided the signature box in the form is not empty the signature requirement will be considered met; only a blank box should elicit an irregularity. Where the application is transmitted to the International Bureau by electronic means, the signature is replaced by a mode of identification agreed with the International Bureau. [Rule 9(2)(b)] [A.I. Section 7]

289. The declaration to be signed by the Office of origin and referred to in paragraph 286 is printed on the official form. The Office of origin, by signing the form, is deemed to affirm the truth of the declaration. Where, for example, an international application contains a description or an indication which is covered by the declaration but is not present in the basic mark, or the international application includes goods and services not covered by the basic mark, the Office is unable to do this. It must ask the applicant to correct any discrepancy (for example, by deleting the description or indication or by restricting the list of goods and services so that it falls within the list contained in the basic mark). Until this has been done, the application must not be forwarded to the International Bureau.

290. The Office of origin should check the content of the form to the extent that this is necessary to avoid any irregularities for which it would be responsible (see paragraphs 324 and 325). Any such examination should, however, not unduly delay the forwarding of the application to the International Bureau, as this could affect the date of the international registration (see paragraph 341).

Fee Calculation Sheet

The following paragraphs should be read in conjunction with the general remarks in paragraphs 154 to 167 concerning the payment of fees to the International Bureau.

291. There must be indicated, in the fee calculation sheet contained in the official form: [Rule 9(4)(a)(xiv)]

- the authorization to debit the required amount from an account opened with the International Bureau and the identification of the party giving the instructions; or
- the amount of the fees being paid, the method by which payment is being made and the identification of the party making the payment.

Fees Due

292. The fees payable in connection with the filing of an international application consist of the basic fee, one or more complementary or individual fees, depending on the Contracting Parties designated and possibly one or more supplementary fees, depending on the number of classes of goods and services covered.

293. Article 8(2) of the Protocol provide that the fees payable in connection with an international application consist of: [Article 8(2)]

- the basic fee;
- a complementary fee for each Contracting Party designated;
- a supplementary fee for each class of goods and services in excess of three.

294. Article 8(7) of the Protocol provides that a Contracting Party may declare that it wishes to receive an individual fee instead of a share in the revenue produced by the supplementary and complementary fees. Nevertheless, Article 9*sexies*(1)(b) renders inoperative a declaration under Article 8(7) in the mutual relations between Contracting Parties to both the Agreement and Protocol. In other words, where the designated Contracting Party having made the declaration is a party to both the Agreement and the Protocol and the Contracting Party whose Office is the Office of origin is also a party to both treaties, it follows from Article 9*sexies*(1)(b) (see paragraph 63) that the supplementary and complementary fees, and not the individual fee, are payable. [Article 8(7)]

295. A Contracting Party that requires an individual fee may also require that the fee comprises two parts, one part to be paid at the time of filing the international application and the second part to be paid at a later date determined in accordance with the law of the Contracting Party concerned. In practice, the second part will be payable when the Office concerned is satisfied that the mark qualifies for protection. In other words, payment of the second part of the individual fee is analogous to payment of a registration fee in the case of a national application. At the stage of filing the international application, the only practical effect of this requirement is that the amount to be paid corresponds to the first part of the individual fee. The holder will be notified by the International Bureau when the second part of the fee

becomes due. If the holder does not pay the second part of the individual fee within the time limit indicated in the notification of the International Bureau, the International Bureau cancels the international registration in the International Register with respect to the Contracting Party concerned and notifies the holder and the Contracting Party accordingly. [Rule 34(3)]

296. If the applicant has failed to meet the time limit to pay the second part of the individual fee, the applicant has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the failed time limit has ended. Together with the request, the missing fee and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5*bis*] [A.I. Section 2]

297. In summary, the fees payable for an international application are:

- the basic fee;
- an individual fee for the designation of each designated Contracting Party that has made the relevant declaration (see paragraph 294) under the Protocol, except where that 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 designation, a complementary fee is payable);
- a complementary fee for each designated Contracting Party in respect of which no individual fee is payable;
- a supplementary fee for each class of goods and services in excess of three; where however all the Contracting Parties designated are ones in respect of which an individual fee is payable, no supplementary fee is required.

298. The amounts of the basic, complementary and supplementary fees are set out in the Schedule of Fees. It should be noted that the amount of the basic fee depends on whether the mark is in color; where the reproduction of the mark, or one of the reproductions (see paragraph 251), is in color, a higher fee is payable. The amounts of the current individual fees are available under the heading dedicated to the Madrid System on WIPO's website (https://www.wipo.int/madrid/en/fees/ind_taxes.html). A fee calculator that takes account of all possible permutations of designations of Contracting Parties and number of classes of goods and services (including limitations in respect of particular Contracting Parties) is also available on this website (<https://www.wipo.int/madrid/feescalculator/>).

Fee Reduction for Applicants from Least Developed Countries (LDC)

299. Applicants having a real and effective industrial or commercial establishment, or a domicile in a least developed country, or being a national of a least developed country (in accordance with the list established by the United Nations), and who file their international applications through the trademark office of such country, as the Office of origin, will be required to pay only 10% of the amount of the basic fee. This is reflected in the Schedule of Fees and has been incorporated in the Fee Calculator on the Madrid System website (<https://www.wipo.int/madrid/feescalculator/>).

300. The list of least developed countries is maintained and updated on a regular basis by the United Nations and may be consulted on the United Nations website at <https://www.un.org/> (<https://www.un.org/development/desa/dpad/least-developed-country-category/ldcs-at-a-glance.html>).

Payment by Debit from an Account with the International Bureau

301. Where payment is to be made by debit of the required amount from an account opened with the International Bureau, the box in part (a) of the fee calculation sheet should be checked; furthermore, the holder of the account, the account number and the party giving the instructions to debit should be indicated. Where this method of payment is being used, the amount to be debited need not be indicated; indeed one of the advantages of paying by this method is that it avoids the risk of an irregularity if the fees, as calculated by the applicant or the representative, are incorrect. It is nevertheless possible to give instructions to the International Bureau to debit a specified amount from an account opened with it. In that case, the details conducting to the total amount being paid should be indicated in part (b) of the fee calculation sheet, and the instruction to debit that amount from an account with WIPO should be indicated in that same part (b) of the said sheet.

Payment Otherwise than by Debit from an Account with the International Bureau

302. The total amount being paid must be indicated in the appropriate box in part (b) of the fee calculation sheet. In addition, amounts and, preferably, the numbers of fees being paid should be indicated in the spaces provided in that part of the fee calculation sheet, to assist the International Bureau in identifying the error if the total is incorrect.

303. The identity of the party (applicant, representative or Office of origin) making the payment should be indicated in the appropriate space in part (c) of the fee calculation sheet. It is important to indicate who is making the payment, since it is that party that will be notified if the International Bureau finds that the payment is insufficient or that will be totally or partially reimbursed if the application is considered as abandoned, is not considered as such, or is withdrawn.

304. Where the fees are not being paid through the Office of origin, the Office should draw the attention of the applicant to the fact that international registration cannot take place until the necessary fees have been received by the International Bureau. The Office is not required to check that payment has been made.

305. The method by which the fees are being paid (see paragraph 158) should be indicated by checking the appropriate box in part (c) of the fee calculation sheet.

Irregularities in the International Application

306. Whenever the International Bureau considers that there is an irregularity in an international application, it will communicate this fact both to the Office of origin and to the applicant. Whether the responsibility for remedying it lies with the Office or with the applicant will depend on its nature.

307. There are three distinct kinds of irregularity, the remedying of which follow different Rules. These are:

- irregularities with respect to the classification of goods and services;
- irregularities with respect to the indication of goods and services;
- other irregularities.

Irregularities with Respect to the Classification of Goods and Services

308. Final responsibility for the classification and grouping of goods and services as listed in the international application lies with the International Bureau, although the International Bureau must try to resolve any disagreement with the Office of origin. In so doing, it will, by supplying appropriate information to the applicant, give him or her the possibility of intervening with that Office.

309. If the International Bureau considers that the goods and services are not grouped in the appropriate class or classes, or if they are not preceded by the number of the class or classes, or if that number is not correct, it will make its own proposal, which it notifies to the Office of origin and copies the applicant. Where a particular product or service could be classified in more than one class but only one of the applicable classes has been indicated, the International Bureau will not regard this as an irregularity. It will be assumed that the reference is only to the product or service falling in that class. However, such an interpretation does not bind a designated Contracting Party with regard to the determination of the scope of the protection of the mark. [Rule 12(1)(a)] [Article 4(1)(b)]

310. That notification will also state the amount, if any, of the fees due as a consequence of the proposed amended classification and grouping. If the International Bureau considers that the goods and services indicated in the international application belong to more classes of the International Classification than indicated in the international application, additional supplementary and/or individual fees may be payable to cover the additional classes. Furthermore, an amount (specified in item 4 of the Schedule of Fees) must be paid in order to cover the work of the International Bureau in grouping the goods and services in classes and in reclassifying terms appearing in wrong classes. However, where the total amount due under this item is less than a threshold specified in the Schedule of Fees (currently 150 Swiss francs), that amount will not have to be paid. [Rule 12(1)(b)]

311. The procedure following this notification is entirely the responsibility of the International Bureau and of the Office of origin. The information given to the applicant enables him or her to intervene with the Office of origin. The International Bureau cannot, however, accept proposals or suggestions directly from the applicant.

312. The Office of origin may, within three months of the date of notification of this proposal, communicate its opinion on the proposed classification and grouping to the International Bureau. This opinion may originate from or be influenced by the applicant who, following the information which he or she received from the International Bureau, may have intervened with the Office of origin or may have been invited to give his or her opinion. The Office of origin is, however, not obliged to give an opinion on the proposal. [Rule 12(2)]

313. If, within two months of the date of notification of the proposal, the Office of origin has not communicated an opinion on the proposal, the International Bureau will send to both the Office and the applicant a reminder, reiterating the proposal. The sending of this reminder does not affect the three-month period referred to in paragraph 312. [Rule 12(3)]

314. If the Office of origin gives an opinion on the proposal of the International Bureau, the latter may, having considered this opinion, either withdraw, modify or confirm its proposal. It will notify the Office of origin accordingly and, at the same time, inform the applicant. Where the International Bureau decides to modify its proposal, the communication to that effect will also indicate any change in the amount of any fees due. Where the International Bureau withdraws its proposal, any additional amount previously claimed will not be due and, if already paid, will be reimbursed to the party having paid it. [Rule 12(4) to (6)] [Rule 12(7)(c)]

315. Any additional fees that may have to be paid as a consequence of the proposed reclassification must be paid: [Rule 12(7)(a) and (b)]

- where the Office of origin has communicated no opinion on the proposal of the International Bureau, within a period of four months from the date of the notification of that proposal; or
- where the Office of origin has communicated an opinion, within a period of three months from the date on which the International Bureau notified its decision to modify or confirm its proposal.

If these fees are not paid within the period prescribed, the international application will be considered abandoned. In that case, the International Bureau will notify the Office of origin and inform the applicant accordingly. If the applicant decides to withdraw one or more classes from the international application instead of paying additional individual or supplementary fees, such decision should be communicated to the International Bureau by the Office of origin.

316. This shows that the applicant cannot always remain inactive. When an additional amount of fees is due and, two months after the first notification (of which he or she was informed), the applicant receives the reminder of the International Bureau, he or she should intervene with the Office of origin in order to check whether the Office intends to communicate an opinion on the proposal. The applicant should also ensure that the payment of the additional amount or the instructions to withdraw one or more classes (or a combination thereof) is received by the International Bureau before the expiry of the period prescribed. Even if the Office of origin agrees to collect fees and to transmit them to the International Bureau it may, under certain circumstances, be preferable to pay the amount directly to the International Bureau.

317. If, as a consequence of non-payment of any additional amount of fees, the international application is considered abandoned, the International Bureau refunds the fees already paid for the international application to the party which had paid the fees, after deducting an amount corresponding to one half of the basic fee due for a registration in black and white. [Rule 12(8)]

318. If the international application contains a limitation of the list of goods or services in respect of one or more of the designated Contracting Parties (see paragraphs 267 to 269) the International Bureau will examine the limitations to ensure that the goods and services indicated are correctly classified and grouped under the International Classification of Goods and Services applying the same examination procedure as described above (paragraphs 309 to 314). However, it will not examine whether the goods and services fall within the scope of the main list or not, as this should be determined by the Offices of the designated Contracting Parties. If the International Bureau is unable to group the goods and services listed in the limitation in the international application (or as amended following any communications with the Office of origin in accordance with paragraphs 309 to 314) it will issue an irregularity. If the irregularity is not remedied within three months from the date of the notification, the limitation will be deemed not to contain the goods and services concerned. [Rule 12(8*bis*)]

319. Where the International Bureau has made a proposal for the classification and grouping of the goods and services, it will, whether or not an opinion on the proposal has been communicated by the Office of origin, register the mark with the classification and grouping that it considers to be correct. [Rule 12(9)]

Irregularities with Respect to the Indication of Goods and Services

320. If the International Bureau considers that a term used in the list of goods and services is too vague for the purposes of classification, is incomprehensible, or is linguistically incorrect, it will notify the Office of origin and inform the applicant at the same time. It may suggest either a substitute term or the deletion of the term. [Rule 13(1)]

321. The Office of origin may, within three months of the notification, make a proposal for remedying the irregularity. The applicant may communicate his or her views to the Office, or the Office may seek the views of the applicant. If this proposal by the Office is acceptable, or if the Office agrees to accept any suggestion which the International Bureau may have made, the International Bureau will change the term accordingly. If the proposal made by the Office is acceptable but irregular with respect to the classification of goods and services, the procedure described above applies (see paragraphs 308 to 319). [Rule 13(2)(a)]

322. Where no proposal acceptable to the International Bureau is made within the time limit, there are two possibilities. If the Office of origin has specified the class in which it considers that the term should be classified, the International Bureau will include the term in the international registration just as it appears in the international application, but the international registration will contain an indication to the effect that, in the opinion of the International Bureau, the term is too vague for the purposes of classification, or is incomprehensible, or is linguistically incorrect, as the case may be. If, however, no class has been indicated, the International Bureau will delete the term and will notify the Office of origin and inform the applicant accordingly. [Rule 13(2)(b)]

Other Irregularities

323. Certain irregularities can only be remedied by the Office of origin and not by the applicant, while for others, the Regulations provide for either the Office or the applicant to rectify the irregularity.

Irregularities to be Remedied by the Office of Origin

324. There are a number of irregularities which have to be remedied by the Office of origin within three months after notification. Where such irregularity is not remedied the international application will be considered abandoned and the Office of origin and the applicant will be notified accordingly. [Rule 11(4)]

325. Remedying of the following irregularities is the responsibility of the Office of origin, since an international application containing such defects should not have been forwarded to the International Bureau by that Office: [Rule 11(4)(a)]

- (a) application not presented on the correct official form, or not typed or otherwise printed, or not signed by the Office of origin;
- (b) irregularities concerning the entitlement of the applicant to file the international application; for example, on the face of the information contained in the application, the applicant does not appear to fulfill the conditions in Article 2(1) of the Protocol with regard to the Office of origin through which the application was filed (see paragraph 196). This would be the case if, for example, the applicant has indicated (in item 3(a)) that he or she has an establishment or domicile in the territory of the Contracting Party whose Office is the Office of origin, while his or her address (given in item 2(b)) is not in that territory, but no address has been given under item 3(b) (see paragraph 228), or the address given is also not in that

territory; or the applicant's address is in the territory of that Contracting Party but it has not been indicated whether the applicant's entitlement is based on an establishment or a domicile;

- (c) one or more of the following elements is missing from the application as received by the International Bureau:
- indications allowing the identity of the applicant to be established and sufficient to contact him or her or the representative;
 - indications concerning the applicant's connection with the Office of origin (see paragraphs 226 to 229);
 - the date and the number of the basic mark;
 - a reproduction of the mark;
 - the list of goods and services for which registration of the mark is sought;
 - an indication of the Contracting Parties designated;
 - the declaration by the Office of origin (see paragraph 286).

If, therefore, the International Bureau considers that the international application is irregular in any of the above respects, it will so notify the Office of origin, and at the same time inform the applicant.

326. Some of these irregularities are a straightforward matter for the Office of origin. Others might necessitate consultation with the applicant – for example, if the International Bureau considers that there are irregularities relating to the entitlement of the applicant to file an international application (see paragraphs 227 and 228).

Irregularities to Be Remedied by the Office of Origin or by the Applicant

327. This rule relates only to fees and covers only the case where the fees for the international application have been paid through the Office of origin. Where, in such a case, the International Bureau considers that the amount of fees received is less than the amount required, it will notify both the Office of origin and the applicant, specifying the missing amount. Normally, the Office of origin will leave it to the applicant to arrange for the necessary payment (either directly to the International Bureau or again through the Office). Alternatively the Office may itself pay the missing amount and make its own arrangements to recover the amount from the applicant. If the missing amount is not paid within three months from the date of the notification, the international application is considered abandoned and the International Bureau will notify both the Office and the applicant accordingly. [Rule 11(3)]

328. If the applicant has failed to meet the time limit of three months to pay the missing amount, the applicant has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the failed time limit has ended. Together with the request, the missing fee and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5bis]

Irregularities to Be Remedied by the Applicant

329. If the International Bureau considers that there is any irregularity other than those listed for remedying by the Office of origin, or by the Office of origin or the applicant, such irregularity must be remedied by the applicant. In such a case, the International Bureau will notify the applicant and at the same time inform the Office of origin. Such irregularities may, for example, relate to the following: [Rule 11(2)(a)]

- the information given concerning the applicant or representative does not comply with all the requirements, but is sufficient for the International Bureau to identify the applicant and to contact the representative; for example, the address is incomplete, or any necessary transliteration is missing;
- the indications given concerning the claiming of priority are not sufficient; for example, no filing date of the earlier application is given;
- the reproduction of the mark is not sufficiently clear;
- the international application contains a color claim, but no color reproduction of the mark appears in item 7 of the form;
- the mark consists of, or contains, matter in characters other than Latin characters, or numerals other than Arabic numerals, and the international application contains no transliteration;
- the amount of fees paid directly to the International Bureau by the applicant or his or her representative is insufficient;
- instructions have been given to pay the fees by debit to an account opened with the International Bureau, but the necessary amount is not available in the account;
- no fees at all have been paid.

330. Any such irregularity may be remedied by the applicant within three months from the date on which the notification of the irregularity was sent by the International Bureau. Where the irregularity relates to a deficiency in the indications concerning a claim to priority and this is not corrected within this period, the priority claim will not be recorded in the International Register. In any other case, where the international application does not comply with the requirements of the Regulations, the international application is considered abandoned if the irregularity is not remedied within the period allowed; the International Bureau will inform accordingly the applicant and the Office of origin. [Rule 11(2)(b)]

331. If the applicant has failed to meet the time limit of three months to remedy an irregularity, the applicant has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the failed time limit has ended. Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5bis]

332. Where failure to remedy an irregularity leads to the abandonment of the international application, the International Bureau will refund the fees paid, after deducting an amount corresponding to one half of the basic fee for a registration in black and white. [Rule 11(5)]

333. Where the international application purports to designate a Contracting Party that may not be designated (for example, where the applicant has attempted to designate the Contracting Party whose Office is the Office of origin), the International Bureau will disregard the designation and will inform accordingly the Office of origin.

Irregularities Concerning a Declaration of Intention to Use the Mark

334. Where a Contracting Party that has been designated under the Protocol is one which requires a declaration of intention to use the mark which is on a separate form annexed to the international application and the International Bureau finds that the declaration is missing or does not comply with the applicable requirements, the International Bureau will promptly notify the applicant and the Office of origin. Provided that the missing or corrected declaration is received by the International Bureau within a period of two months from the date on which the request to present the international application was received by the Office of origin, the declaration will be deemed to have been duly filed, and the date of the international registration will be unaffected by the irregularity. [Rule 11(6)(a)] [Rule 11(6)(b)]

335. If, however, the missing or corrected declaration is not received within that period, the designation of the Contracting Party in question will be deemed not to have been made. The International Bureau will so notify both the applicant and the Office of origin and will reimburse any fee paid in connection with the designation of that Contracting Party. The International Bureau will also point out that the designation in question may be effected as a subsequent designation, provided that such designation is accompanied by the required declaration of intent to use. [Rule 11(6)(c)]

Registration, Notification and Publication

336. Where the International Bureau finds that the international application conforms to the applicable requirements, it registers the mark in the International Register. It also notifies the Offices of the designated Contracting Parties of the international registration, informs the Office of origin and sends a certificate to the holder. Where, however, the Office of origin so wishes and has informed the International Bureau accordingly, the certificate will be sent to the holder through the Office of origin. The certificate of international registration is not considered to be a notification and will always be in the language of the international application even if the applicant has expressed the wish to refer this in a different language referred to in paragraph 223. Certified copies of a certificate of international registration may be requested upon the payment of a fee. [Rule 14(1)]

337. The international registration is published in the Gazette. The Gazette can be accessed by Madrid Monitor (<https://www3.wipo.int/madrid/monitor/en/>). [Rule 32(1)(a)(i)]

THE INTERNATIONAL REGISTRATION

Effects of the International Registration

338. The effects of the international registration extend to the Contracting Parties expressly designated by the applicant in the international application. [Articles 3*bis* and 3*ter*]

339. From the date of the international registration, the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been filed or deposited directly with the Office of that Contracting Party. If no refusal is notified to the International Bureau within the prescribed time limit, or a refusal so notified is not regarded as such or is subsequently withdrawn, the protection of the mark in the Contracting Party concerned is the same, as from the date of the international registration, as if the mark had been registered by the Office of that Contracting Party. [Article 4(1)]

Date of the International Registration

340. The international registration resulting from an international application will, as a rule, bear the date on which the international application was received by the Office of origin. [Article 3(4)]

341. Where, however, the international application is not received by the International Bureau within a period of two months from the date on which it was received (or deemed to have been received) by the Office of origin, the international registration will instead bear the date on which the application was actually received by the International Bureau. Where, however, it is established that the late receipt resulted from an irregularity in a postal or delivery service (see paragraphs 137 to 139), the international registration may still bear the date on which the international application was received or deemed to have been received by the Office of origin.

Irregularities: Date in Special Cases

342. The date of the international registration may be affected if any of the following important elements is missing from the international application:

- indications allowing the identity of the applicant to be established and sufficient to contact him or her or the representative;
- designation of the Contracting Parties where protection is sought;
- a reproduction of the mark;
- the indication of the goods and services for which registration of the mark is sought.

If the date on which the last missing element reached the International Bureau is still within the two-month period referred to in Article 3(4), the international registration will bear the date on which the defective international application was originally received (or is deemed to have been received) by the Office of origin. Where any of these elements does not reach the International Bureau until after the expiry of this two-month period, the international registration will bear the date on which that element has reached the International Bureau. This applies also in the cases of continued processing under Rule 5*bis* of the Regulations, because the procedure of continued processing has no impact on the determination of the date of the international registration under Rule 15(1) of the Regulations. [Rule 15(1)]

343. The remedying of any of the above deficiencies is the responsibility of the Office of origin. The applicant will, however, have been informed of the irregularity, and may wish to contact the Office to ensure that the deficiency is rectified as speedily as possible. If it is not rectified within three months of the date on which the Office of origin was notified of the irregularity, the application will be considered abandoned. [Rule 11(4)(a)(ii)]

344. The combined application of these rules may be illustrated with the following example:

An international application is filed with the Office of origin on April 1, and is received by the International Bureau on May 1. The International Bureau notices that no Contracting Party is designated in the international application; on May 5, the International Bureau notifies the Office of origin of the irregularity and invites it to remedy the irregularity before August 5;

- if the Office remedies the deficiency on or before June 1, the date of the international registration will be April 1;
- if the Office remedies the deficiency after June 1 but on or before August 5, the date of the international registration will be the date on which the missing information was received by the International Bureau;
- if the Office does not remedy the irregularity on or before August 5, the international application will be considered abandoned.

345. The date of an international registration is not affected by any deficiencies other than those referred to in paragraph 342 (such as the late payment of fees or irregularities concerning the classification of goods and services). [Rule 15(2)]

Period of Validity

346. The registration of the mark is effected for 10 years from the date of the international registration, with the possibility of renewal for further periods of 10 years. [Article 6(1)] [Article 7(1)]

Registration in the International Register

Content of the International Registration

347. The international registration contains: [Rule 14(2)]

- all the data contained in the international application (except data relating to an invalid claim to priority – that is, where the date of the earlier filing is more than six months before the date of the international registration);
- the date and the number of the international registration;
- where the mark can be classified according to the International Classification of Figurative Elements (Vienna Classification), the relevant classification symbols as determined by the International Bureau; when, however, the international application contains a declaration to the effect that the applicant wishes that the mark be considered as a mark in standard characters, symbols from the Vienna Classification will not be applied;
- indications relating to a seniority claim (see paragraphs 278 to 280), concerning the member State or member States in or for which the 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.

Publication of the International Registration

348. The international registration is published in the Gazette. The Gazette can be accessed by Madrid Monitor (<https://www3.wipo.int/madrid/monitor/en/>). [Rule 32(1)(a)(i)]

349. The reproduction of the mark is scanned from the international application form and is therefore published exactly as it appears in the international application. Thus, for example, where the mark has been typed on the form, this is what will be published in the Gazette. Where the applicant has made a declaration that the mark is to be considered as a mark in standard characters, the publication will include an indication of that fact. [Rule 32(1)(b)]

350. Where the international application contained both a reproduction in black and white and a reproduction in color, the Gazette shall contain both reproductions. [Rule 32(1)(c)]

351. If an international application is not recorded in the International Register within three working days following the receipt by the International Bureau, the data will nonetheless be entered forthwith in the database. This data will contain any irregularities that exist in the international application. (For more information concerning this database, see paragraphs 87 to 90). [Rule 33(1) and (2)]

Language of Registration and Publication

352. An international registration will be recorded and published in English, French and Spanish. [Rule 6(3)]

353. The translations needed for recording and publication are prepared by the International Bureau. The applicant may annex to the international application a translation of any text contained in the international application. The International Bureau is, however, not bound to accept this translation; if it considers the proposed translation not to be correct, it will correct it, after inviting the applicant to make, within one month, observations on the proposed corrections. If no observation is sent with the prescribed time limit, the proposed translation is corrected by the International Bureau. This procedure will not affect the date of the international registration. [Rule 6(4)(a)]

354. The mark will not be translated by the International Bureau, nor will any translation of the mark which the applicant has given be checked by the International Bureau. [Rule 6(4)(b)]

REFUSAL OF PROTECTION

Grounds for Refusal

355. Each designated Contracting Party has the right to refuse the protection of the international registration in its territory. Such refusal may be based on any grounds that are supported by a provision of the Paris Convention, or that are not prohibited by a provision of that Convention, and any such refusal will generally be subject to review or appeal, depending upon the laws and practice of the Contracting Party concerned. [Article 5(1)]

356. A Contracting Party may not refuse protection of an international registration, even partially, on the ground that the applicable legislation permits registration only in a limited number of classes or for a limited number of goods or services. Even if that legislation requires that an application made directly to that Office must be in one class only, the Office must accept that an international registration may be protected in that Contracting Party where it relates to several (or even all 45) classes of goods and services.

357. The notification of the designation may include a declaration that the holder wishes the mark to be considered as a mark in standard characters. The question of standard characters is a difficult one, because of the additional indications (such as accents) which may be standard in one language but not in another. It is therefore entirely up to each designated Contracting Party to decide what is the effect of such a declaration. An Office (and the courts) may, for example, decide to ignore such a declaration when determining such matters as the extent of protection or conflict with another mark. In that case, the Office of the Contracting Party concerned would be free, for its own purposes, to assign a classification symbol of the Vienna Classification to the mark in respect of which an international registration is effected (where the standard character declaration has been made, the International Bureau will not have applied the Vienna Classification).

358. The International Bureau will already have established, before notifying the designation to the Contracting Party, that all applicable formal requirements of the Protocol and the Regulations have been complied with. An Office should therefore never have occasion to raise objections on formal or presentational grounds. Where the Contracting Party is one which requires a declaration of intention to use the mark, which is on a separate form signed by the applicant, the International Bureau will have established that this has been supplied before it notified the international registration or the subsequent designation to the Contracting Party. Where the Contracting Party requires a declaration of intention to use, but does not require that this be on a separate form then, as the rubric on the international application form or subsequent designation form indicates, the applicant or holder is deemed, in designating that Contracting Party, to have made the required declaration. Moreover, provision is made for an international application or subsequent designation to contain various other indications, which may be required by particular Contracting Parties.

359. Nor is it appropriate for an Office to object to the classification of the goods and services in the international registration. Even if an Office disagrees with the classification (which will of course have been approved by the International Bureau), an objection on such grounds would have no effect, since the classification in the International Register remains unchanged. An Office may use its own interpretation of the classification, for example, to carry out a search for earlier conflicting marks; indeed it is explicitly provided that the indication of the classes does not bind Contracting Parties with regard to the determination of the scope of the protection of the mark. [Article 4(1)(b)]

360. An Office may object if it considers that a term is too broad or too vague. Such objection might take the form of a partial refusal, resulting in the broad or vague term being replaced by a more narrow or precise term in the list of the goods and services in the International Register for the applicable Contracting Party – in effect, a limitation of protection for that Contracting Party.

Time Limits for Refusal

361. Refusal must be notified to the International Bureau within a prescribed time limit. Any refusal sent after that time limit will not be considered as such by the International Bureau (see paragraph 383). It is not necessary that a final decision on the refusal be taken within the applicable time limit; it is sufficient that all grounds for refusal are notified within the time limit. In other words, what must be sent within the applicable time limit is a provisional refusal.

An Office may notify additional grounds with respect to that particular international registration in further notifications of refusal, provided that it sends such further notifications to the International Bureau within the applicable time limit.

362. The Office may not base a confirmation of total provisional refusal on a partial provisional refusal, or on a ground not mentioned in the notification of provisional refusal made within the applicable time limit. Nor may it base a statement of grant of protection under Rule 18*ter*(2) indicating the goods and services for which the protection of a mark is granted on a ground that was not mentioned in the notification of provisional refusal.

363. The normal time limit for the notification of a provisional refusal is one year from the date on which the International Bureau has notified the international registration or the subsequent designation to the Office of the designated Contracting Party, unless the legislation of that Contracting Party provides for a shorter period. [Article 5(2)(a)]

364. However, any Contracting Party may declare that, for international registrations in which it is designated, the time limit of one year is replaced by 18 months (see paragraph 366). [Article 5(2)(b)]

365. In that declaration, the Contracting Party may also specify that a refusal of protection resulting from an opposition may be notified to the International Bureau after the expiry of the period of 18 months. The Office of a Contracting Party that has made this declaration may notify, after the expiry of the 18-month time limit, a refusal of protection resulting from an opposition, but only if [Article 5(2)(c)]

- before the expiry of the 18-month time limit, it has informed the International Bureau of the possibility that oppositions with respect to this international registration may be filed after the expiry of the 18-month period, and
- the notification of refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.

366. Paragraph (1)(b) of Article 9*sexies* renders inoperative a declaration under Article 5(2)(b) and (c) in the mutual relations between States bound by both treaties. This means that in the case of an international registration where the Office of origin is the Office of a Contracting Party bound by both treaties, a designation of a Contracting Party bound by both treaties will be subject to the standard regime of Article 5(2)(a) – that is, the time limit of one year for the notification of a provisional refusal, notwithstanding that the designated Contracting Party in question may have declared an extended period for notifying a provisional refusal. [Article 9*sexies*]

367. To determine whether a notification of provisional refusal was sent within the appropriate time limit, the date of sending of a notification sent by post will be determined by the postmark. If the postmark is illegible or missing, the International Bureau treats the notification as having been sent 20 days before the date on which it was actually received by the International Bureau. If, however, this date would be earlier than the date of any refusal or date of sending mentioned in the notification, the notification is treated as having been sent on the latter date. In the case of a notification sent through a delivery service, the date of sending is determined by the information recorded by the delivery service. [A.I. Section 14]

368. When an Office informs the International Bureau, in connection with a given international registration, of the possibility that oppositions may be filed after the expiry of the 18-months period, it must, where the dates on which the opposition period begins and ends are known, indicate those in the communication. If such dates are, at that time, not yet known, they must be communicated to the International Bureau once they become known. If the

opposition period is renewable, the Office may only communicate the date from which this period begins. The International Bureau will record this information in the International Register, transmit it to the holder of the international registration and publish it in the Gazette. The Gazette can be accessed by Madrid Monitor (<https://www3.wipo.int/madrid/monitor/en/>). [Rule 16(1)(b)] [Rule 16(2)] [Rule 32(1)(a)(ii)]

369. Provided that the warning concerning the possibility of later oppositions has been given, as described in paragraph 368, an Office may notify a refusal based on an opposition after the end of the 18-month period. An example may help in understanding the operation of these provisions:

- An international registration designates a particular Contracting Party in respect of goods (X + Y + Z).
- Upon examination, the Office considers that a mark should be refused protection for some of the goods concerned (X + Y), but may be protected for the remaining goods (Z) and, nine months after the date on which the notification of the designation was sent to it, issues a notification provisionally refusing protection for goods (X + Y). This notification states that the holder should inform the Office within six months if he or she wishes to request review of this refusal; it also informs that, once the position has been resolved vis-à-vis the objections raised by the Office, there is a possibility of an opposition being filed by a third party, even if this is after the end of the period of 18-months from the notification of the designation; it also states that, if the holder does not respond within this period of six months, the mark will be regarded as protected in the Contracting Party concerned for goods (Z) but refused for goods (X + Y), that the Office will publish a notice to this effect and that an opposition to the protection in respect of goods (Z) may be filed within the four months following the publication of that notice.
- The holder responds within the six-month period, requesting a review of the provisional refusal in respect of goods (X + Y); following such a review, a decision is issued, refusing protection for goods (X) but allowing protection for goods (Y); the Office publishes a notice to the effect that the mark is to be protected for goods (Y + Z), and that any opposition to this may be filed within four months of the date of publication of the notice; the communication informing the holder of the decision also indicates that this notice is being published, together with its date and the duration of the opposition period.
- Alternatively, the holder does not respond within the period prescribed by the Office to the notification refusing protection for goods (X + Y); at the end of this period, the Office publishes a notice to the effect that the mark is to be protected for goods (Z) and that any opposition to this may be filed within four months of the date of publication of the notice; at the same time, the holder is informed that this notice is being published, together with its date and the duration of the opposition period.

This example is merely indicative. Many variants are possible, and the details will of course vary, depending on the legislation of each Contracting Party.

370. In summary, upon the expiry of one year the holder will know whether the mark is protected in a given Contracting Party, or whether there is a possibility that protection will be refused and, if so, for what reasons, in the following situations:

- for all designations where the designated Contracting Party has not made a declaration extending the refusal period to 18 months; and

- for all designations where the designated Contracting Party has made a declaration extending the refusal period to 18 months, but the Contracting Party through which the holder was entitled to make that designation and the designated Contracting Party are both party to the Agreement (by virtue of Article 9*sexies*(1)(b) of the Protocol) (see also paragraphs 30 to 38).

371. In respect of any designation where the Contracting Party has made the declaration extending the time limit to 18 months and in respect of which the derogation provided for in paragraph (1)(b) of Article 9*sexies* does not apply, the holder will know, upon the expiry of 18 months, whether their mark is protected in that designated Contracting Party, or whether there is a possibility that protection will be refused and, if so, for what reasons. Where that designated Contracting Party has also made the declaration allowing for the possibility of notifying, after the period of 18 months, provisional refusals resulting from an opposition, the holder will know, after the expiry of 18 months, whether there is a possibility that oppositions may be filed at a later stage.

372. Where the time limit for the notification of a provisional refusal has expired without the International Bureau having recorded a notification of provisional refusal in respect of the designation of any given Contracting Party, then a statement to that effect will appear on the Madrid Monitor database.

Procedure for Refusal of Protection

Notification of Refusal of Protection

373. The notification of refusal is sent by the Office concerned to the International Bureau. It may comprise a declaration stating the grounds on which the Office considers that protection cannot be granted (“*ex officio* provisional refusal”), or stating that protection cannot be granted because an opposition has been filed (“provisional refusal based on an opposition”) or both. A notification of refusal must relate to only one international registration. [Rule 17(1)]

Contents of the Notification

374. A notification of provisional refusal must contain the following information and indications: [Rule 17(2)]

- the Office making the notification;
- 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 mark number;
- all the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law;

- if the grounds on which the refusal is based refer to an application for registration, or a registration, of a mark with which the mark that is the subject of the international registration appears to be in conflict, all relevant data concerning that mark, including the filing or registration date and number, the priority date (if any), a reproduction of the mark (which may, if the mark contains no figurative elements, be simply typed), the name and address of the owner of the mark and a list of all the goods or services covered by that mark or of the relevant goods or services; this list may be in the language of the said application or registration;
- 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;
- the time limit, reasonable under the circumstances, for filing a request for review of or appeal against the provisional refusal or for filing a response to the opposition, and the authority to which such request for review or appeal shall lie; if such request for review or appeal must be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal, this will also be indicated.

375. The requirement according to which all grounds on which the provisional refusal is based must be indicated, together with a reference to the corresponding essential provisions of the law, is of particular importance for the holder. In practice, refusals are generally communicated by the Office concerned on a special form. The grounds applicable in a particular case are mentioned in the notification, with a reference to the corresponding provision or provisions of the law.

376. If the notification of provisional refusal specifies that a local representative must be appointed, the requirements for appointment will be governed by the law and practice of the Contracting Party concerned. These are likely to be different from the requirements for the appointment of a representative before the International Bureau.

Additional Contents of the Notification when Provisional Refusal Based on Opposition

377. Where the provisional refusal of protection is based on an opposition or on an opposition and on other grounds, the notification will indicate that fact. The notification will, in addition to the indications referred to in paragraph 374, contain the name and address of the opponent and, where the opposition is based on a mark which has been the subject of an application or registration, a list of the goods and services on which the opposition is based. The Office may, in addition, communicate the complete list of goods and services of that earlier application or registration. These lists may be in the language of the earlier application or registration (even if that language is neither English nor French nor Spanish). [Rule 17(3)]

Recording and Publication of the Provisional Refusal: Transmittal to the Holder

378. The provisional refusal is recorded in the International Register, together with an indication of the date on which the notification was sent (or is regarded as having been sent – see paragraph 386). The provisional refusal is published in the Gazette, with an indication as to whether the refusal is total (i.e., relates to all the goods and services covered by the designation of the Contracting Party concerned) or partial (i.e., relates to only some of those goods and services). In the latter case, the classes affected (or not affected) by the provisional refusal are published but not the goods and services themselves. These are not published until the proceedings before the Office have been completed. The grounds for refusal are not published. [Rule 17(4)] [Rule 32(1)(a)(iii)]

379. The International Bureau then transmits a copy of the notification to the holder. It also transmits to the holder any information sent by the Office of a designated Contracting Party concerning the possible filing of an opposition after the expiry of the 18-month time limit, as well as any information concerning the dates on which the opposition period begins and ends. In addition, since January 1, 2009, the International Bureau has made available to users digitized copies of notifications of provisional refusal on the Madrid Monitor database. [Rule 17(4)] [Rule 16(2)]

Language of the Notification of Provisional Refusal

380. The provisional refusal may be notified to the International Bureau in English, French or Spanish (at the option of the Office making the notification). The refusal will be recorded and published in all three languages. The required translation of the data to be recorded and published is prepared by the International Bureau. The holder will receive from the International Bureau a copy of the notification of refusal, in the language in which it was sent by the Office of the designated Contracting Party. The communication by the International Bureau forwarding the copy of the notification of refusal will however be in the language in which the international application was filed (or the language in which the holder has asked to receive communications from the International Bureau – see paragraph 153). [Rule 6(2)] [Rule 6(3)] [Rule 6(4)]

381. It should be noted, in the context of refusals, that for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of the first subsequent designation: [Rule 40(4)]

- if governed exclusively by the Agreement, French will continue as the sole language of communication, recording and publication.
- if governed wholly or partly by the Protocol, English and French will continue as the language of communication, recording and publication.

For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of the first subsequent designation:

- if governed exclusively by the Agreement, then, as above, French will continue as the sole language of communication, recording and publication. Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004.

Irregular Notifications of Provisional Refusal

382. There are two kinds of irregular refusals, those which can be remedied and those which entail that the notification of refusal will not be considered as such by the International Bureau.

383. A notification of provisional refusal will not be regarded as such by the International Bureau if: [Rule 18(1)(a) and (2)]

- it does not contain any international registration number (unless other indications contained in the notification permit the International Bureau to identify the international registration concerned);
- it does not indicate any grounds for refusal; or
- it was sent too late to the International Bureau; that is, it was sent after the expiry of the relevant time limit of one year or 18 months referred in paragraphs 363, 364 and 366) or, in the case of a refusal based on an opposition issued by the Office of a Contracting Party that has made the declaration under Article 5(2)(c) of the Protocol referred to in paragraphs 365 and 366 it was sent after the expiry of 18 months without the Office having, within the time limit of 18 months, informed the International Bureau that there was a possibility of oppositions being filed after the expiry of that period.

384. In all these cases, the International Bureau will nevertheless transmit a copy of the notification to the holder and inform him or her (and at the same time the Office that sent it) that it does not regard the notification of refusal as such, and indicate the reasons therefor. [Rule 18(1)(b) and (2)(c)]

385. If the notification is irregular in other respects (for example, if the indication of the goods and services that are affected, or not affected, by the refusal is missing, or if the notification does not contain a reproduction of a conflicting earlier mark, or if other relevant details relating to the earlier mark, including the name and address of its owner are missing), the International Bureau will (except in the circumstances referred to in paragraph 386) nonetheless record the provisional refusal in the International Register. It will then invite the Office to rectify its notification within two months. At the same time, it will send to the holder copies of the irregular notification of refusal and of the invitation sent to the Office. [Rule 18(1)(c)]

386. Where, however, the notification does not contain the prescribed indications concerning the time limit for filing a request for review or an appeal or a response to an opposition and the authority to which this should be addressed, the provisional refusal will not be recorded in the International Register. If the Office sends a rectified notification within the two-month period referred to in the invitation, the International Bureau will, for the purposes of Article 5(2) of the Protocol, regard this rectified notification as having been sent on the date on which the defective notification had been sent to it. That is, if the defective notification had been sent within the period applicable under Article 5(2) of the Protocol, a rectified notification which is sent within the two-month time limit mentioned in the invitation will be regarded as having met the requirements of that provision. If, however, the Office does not rectify its notification within this two month time limit, it will not be regarded as a notification of provisional refusal. The International Bureau will inform the holder and the Office that it does not regard the notification as such, indicating the reasons therefor. [Rule 18(1)(d)]

387. Where an Office rectifies a notification of refusal that specified a period for requesting review or appeal, it should also, where it is appropriate, specify a new period (for example, starting from the date on which the rectified notification was sent to the International Bureau), preferably with an indication of the date on which the said time limit expires. [Rule 18(1)(e)] [Rule 18(1)(f)]

388. The International Bureau will send a copy of any rectified notification to the holder.

389. It is useful for the holder of the international registration that the International Bureau transmits to him or her copies of any irregular notification of provisional refusal and, in the case of irregularities that can be remedied, of the invitation sent to the Office to remedy it. In most of the latter cases, that Office will remedy the irregularity, but the holder will have had more time to analyze the grounds for refusal and perhaps to start negotiations with holders of prior rights which have been cited *ex officio* or who may have opposed the international registration.

390. Even if a notification of provisional refusal is not regarded as such by the International Bureau, and is consequently not recorded in the International Register, the holder should be aware that this does not necessarily mean that there are no problems concerning the protection of the mark in the Contracting Party concerned. It may be possible for a third party to initiate an invalidation action against the designation, based on the same grounds as were cited by the Office in the defective notification of refusal. Depending on the irregularity contained in the notification of provisional refusal, the holder may find it advisable to request from the Office concerned complete information in respect of the grounds for refusal of protection.

Procedure Following Notification of Provisional Refusal

391. Where the holder of an international registration receives, through the International Bureau, a notification of refusal (including an irregular notification of refusal under Rule 18(1)(c), see paragraphs 385 and 386), he or she has the same rights and remedies (such as review of, or appeal against, the refusal) as if the mark had been deposited directly with the Office that issued the notification of refusal. The international registration is, therefore, with respect to the Contracting Party concerned, subject to the same procedures as would apply to an application for registration filed with the Office of that Contracting Party. [Article 5(3)]

392. When lodging a request for review or an appeal against a decision of refusal of registration or responding to an opposition, the holder may, even if this is not required by the law of the Contracting Party concerned, find it useful to employ a local representative who is familiar with the law and practice (and the language) of the Office that pronounced the refusal. The appointment of such a representative is entirely outside the scope of the Protocol and the Regulations, and is governed by the law and practice of the Contracting Party concerned.

393. It is not within the competence of the International Bureau to express an opinion as to the justification of a refusal of protection or to intervene in any way in the settlement of the substantive issues raised by such a refusal.

STATUS OF A MARK IN A DESIGNATED CONTRACTING PARTY

394. Rules 18*bis* and 18*ter* of the Regulations are concerned with the status, in a designated Contracting Party, of a mark that has been the subject of an international registration, and the communication to the International Bureau, by an Office, of such status.

Interim Status of a Mark

395. By virtue of Rule 18*bis*(1)(a), an Office which has not communicated a notification of provisional refusal, may within the applicable time limit under 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. The Office should indicate also the date by which such oppositions or observations may be filed. [Rule 18*bis*(1)(a)]

396. Otherwise, an Office which has notified a provisional refusal may send a statement to the effect that the *ex-officio* examination has been completed indicating that the protection of the mark is still subject to oppositions or observations by third parties. Equally, in this statement, the Office should indicate the date by which such oppositions and observations may be filed. [Rule 18*bis*(1)(b)]

397. The sending by an Office of a statement under Rule 18*bis*(1)(a) or (b) to the International Bureau is optional. Therefore, there is no obligation for an Office that has completed its examination to send a statement to this effect to the International Bureau.

398. The International Bureau records any statement received under Rule 18*bis* in the International Register, informs the holder of the international registration concerned and, where the statement was communicated, or can be reproduced in the form of a specific document, transmits a copy of that document to the holder. For the purpose of this rule, the International Bureau accepts from Offices lists of international registration numbers, which it will convert into individual communications transmitted to the holders of the international registrations concerned. [Rule 18*bis*(2)]

399. An Office of a designated Contracting Party which has sent a statement under Rule 18*bis* to the International Bureau must, in due course, either:

- communicate to the International Bureau a notification of provisional refusal of protection in accordance with Rule 17(1), if an opposition or observations are filed during the applicable refusal period; or
- in the absence of opposition or observations having been filed, send to the International Bureau a statement in accordance with Rule 18*ter*.

400. Rule 18*bis* of the Regulations serves only informational purposes and has no binding effect on national procedural law. While a statement sent under Rule 18*bis* is sent in the case that the Office, after having completed all its procedures, has reached a favorable conclusion for the holder, so that the mark would be protected under the national law, it has to be noted, that there may exist provisions in the national law under which the Office may *ex-officio* reassess the case and reach a different conclusion. Hence, in rare cases, it may happen that an Office sends a notification of provisional refusal under Rule 17 of the Regulations, after having had sent a positive statement under Rule 18*bis* of the Regulations.

Final Disposition on the Status of a Mark

401. Paragraphs (1), (2) and (3) of Rule 18*ter*, require the Office of a Contracting Party designated in an international registration to send a statement to the International Bureau informing it of the final status of a mark in the Contracting Party concerned, as soon as all the procedures concerning the protection of the mark before this Office have been completed. [Rule 18*ter*]

402. There are three different types of final dispositions on the status of a mark, which are described below.

Statement of Grant of Protection where no Notification of Provisional Refusal has been Communicated

403. Firstly, where, before the expiry of the applicable refusal period under Article 5(2)(a), (b) or (c) of the Protocol, all the procedures before the Office of a Contracting Party designated in an international registration 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. [Rule 18*ter*(1)]

404. Insofar as there is no ground for the Office of a designated Contracting Party to refuse protection and when all the procedures before that Office are completed, the holders of international registrations and third parties are then informed, as soon as possible, and before the expiry of the refusal period, of the outcome of the procedure in that designated Contracting Party. While such statement under Rule 18*ter*(1) is obligatory where the conditions are met, should the International Bureau not receive such statement – or a provisional refusal – from the designated Contracting Party concerned by the expiry of the applicable time limit of one year or 18 months, the principle of “tacit acceptance” applies. [Rule 18*ter*(1)]

405. A statement of grant of protection under Rule 18*ter*(1) may concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of those international registrations. The International Bureau will convert such a list into individual communications that it transmits to the holders of the international registrations concerned. However, from the users’ perspective, it is always preferable to receive an individual statement from the Office concerned.

406. When Rule 34(3) is applicable, the sending of a statement of grant of protection shall be subject to payment of the second part of the fee. [Rule 34(3)]

407. It is to be noted that no legal consequences flow from the fact that a statement of grant of protection has not been sent by an Office. The principle remains that, in the absence of the communication of a notification of provisional refusal within the period applicable under Article 5(2) of the Protocol, the mark is automatically protected in the Contracting Party concerned, for all the goods and services in question. This is the principle of “tacit acceptance”.

Statement of Grant of Protection Following a Provisional Refusal

408. Unless it confirms a total provisional refusal (see paragraph 410), the Office of a Contracting Party, designated in an international registration, 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: [Rule 18ter(2)]

- 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 [Rule 18ter(2)(i)]
- a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned. [Rule 18ter(2)(ii)]

409. Equally in this case, when Rule 34(3) is applicable, the sending of a statement of grant of protection shall be subject to payment of the second part of the fee. [Rule 34(3)]

Confirmation of Total Provisional Refusal

410. Finally, the Office of a Contracting Party designated in an international registration, which has communicated a notification of 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. [Rule 18ter(3)]

Further Decision

411. A statement under Rule 18ter(2) or (3) should be sent as soon as all possibilities of review or appeal before the Office have been exhausted, or the time for requesting review or appeal before the Office has expired. The Office, therefore, should not wait to see whether an appeal is lodged with a tribunal or other body external to the Office. The reason for this is that the Office may not necessarily be aware whether or not such an appeal has been filed; the Office is therefore not able to know with certainty whether or not a decision issued by it has become final. Nor is the Office necessarily aware of the outcome of any such appeal. Although this statement may not reflect the definitive result regarding the protection of the mark in the Contracting Party concerned, the fact that, in many instances, a statement under paragraph (2) or (3) of Rule 18ter will be recorded and published at an early stage (as soon as the procedures before the Office have been completed), will have advantages for both holders and third parties. [Rule 18ter(4)]

412. Where, following the sending of a statement in accordance with Rule 18ter(2) or (3), the Office becomes aware of any further decision that affects the protection of the mark (for example, a decision resulting from an appeal to an authority outside that Office), it will send to the International Bureau a further statement indicating the goods and services for which the mark is now protected, insofar as the Office is informed of this decision.

413. It is also possible for an Office, under Rule 18ter(4), to send further statements when no provisional refusal has been sent within the applicable time limit or when following the sending of a statement under paragraph (1) of the Rule, a further decision taken by the Office or other authority affects the protection of the mark. This further statement must indicate the status of the mark and, where applicable, the protected goods and services. This will allow

Offices to send a statement indicating the goods and services for which the mark is protected following a statement of grant of protection sent under paragraph (1) of the Rule as well as where the mark is considered to be protected under the principle of *tacit acceptance*. The main purpose of the amendment is to allow Offices to notify the International Bureau of any later decision affecting the scope of protection without having to check whether it had already issued a provisional refusal. The amended Rule now envisages both cases of restriction or complete refusal of protection and cases of grant of protection.

Recording, Information to the Holder and Transmittal of Copies

414. The International Bureau shall record any statement received under Rule 18*ter* in the International Register and shall 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. Any statement received under Rule 18*ter* shall also be published in the Gazette. In addition, the International Bureau has made available on Madrid Monitor digitized copies of those statements, which are then accessible directly to users of the database (see paragraph 90). [Rule 18*ter*(5)] [Rule 32(1)(a)(iii)]

COMMUNICATIONS FROM THE OFFICES OF THE DESIGNATED CONTRACTING PARTIES SENT THROUGH THE INTERNATIONAL BUREAU

415. The Office of a designated Contracting Party may request the International Bureau to transmit communications to holders concerning international registrations where the law of such Contracting Party does not allow the Office to transmit the communication. This will help meet the needs of Offices that have no means to send communications to non-resident holders who have indicated neither an address for service in the territory of the concerned Office nor appointed a local representative before the Office. The International Bureau transmits the communication to the holder or the recorded representative without examining its contents or recording it in the International Register. [Rule 23*bis*]

SUBSEQUENT DESIGNATION

416. The holder may add a Contracting Party to an existing international registration at any time by filing a subsequent designation. The holder may wish to do this for a number of reasons, for example, where protection in that Contracting Party was not requested at the time of international registration or, because the mark is no longer protected in that Contracting Party because of a final refusal, an invalidation or a renunciation and the grounds for such refusal, invalidation or renunciation no longer exist. [Article 3*ter*(2)]

417. Another reason for making a subsequent designation may be that, at the time of filing the international application, the Contracting Party in question was not a party to the Protocol. The term "Contracting Party of the holder" means either the Contracting Party whose Office is the Office of origin (i.e., the Office through which the international application was filed) or, where there has been a change in the ownership of the international registration, the Contracting Party with respect to which the new holder fulfills the conditions to be the holder.

418. Providing all the formalities are met the International Bureau will also record a subsequent designation for a Contracting Party already designated in an existing registration. A subsequent designation may be made for all, or only some of the goods and services recorded in the International Register. Therefore, a given Contracting Party may be the subject of several subsequent designations, each referring to the same goods and services, or a different part of the list of goods and services recorded in the International Register as the case may be.

419. When, following a limitation of the list of goods and services, a partial refusal of protection or a partial invalidation, the protection resulting from the international registration covers, in a given Contracting Party, only part of the goods and services recorded in the International Register, a subsequent designation may be made for all or some of the remaining goods and services.

Entitlement to Make the Subsequent Designation

420. A Contracting Party may be the subject of a subsequent designation where, at the time of the designation, the holder fulfills the conditions (of nationality, domicile or establishment) to be the holder of an international registration. [Rule 24(1)(a)]

421. The designation of a particular Contracting Party will be made only under the Protocol since the Protocol governs all international applications and registrations.

No Subsequent Designations Possible in Certain Cases

422. In principle, a subsequent designation may be made with respect to any Contracting Party. However, there is an exception from this principle; when acceding to the Protocol, any State or any intergovernmental organization may declare that the protection resulting from an international registration effected under that treaty before the date on which it entered into force with respect to that State or organization cannot be extended to it. [Article 14(5)]

Presentation of the Subsequent Designation

423. Subject to the exceptions mentioned below, the holder may present the subsequent designation either directly to the International Bureau or through the Office of the Contracting Party of the holder. [Rule 24(2)(a)]

424. A subsequent designation may be transmitted to the International Bureau by mail or by electronic means using official form MM4 or by using the Online Subsequent Designation tool available on WIPO's website (<https://www3.wipo.int/osd/?lang=en>) (see paragraphs 115, 121 and 123). The simplest way to add Contracting Parties to an international registration is to use the Online Subsequent Designation. Once the international registration number has been entered in the online form, a list of the Contracting Parties available for subsequent designation will be displayed, allowing the holder to easily select those that he or she wishes to designate and for which goods and services (including a limitation of the list of goods and services). Further, the fees will be automatically calculated and can be paid by use of a credit card or by debiting them from a current account at WIPO. [A.I. Sections 6, 7 and 11(a)]

425. If the requirements of paragraph (2)(a) of Rule 24 are not complied with, the International Bureau will not consider the subsequent designation as such and shall inform the sender accordingly (see paragraph 423). [Rule 24(10)]

Language of the Subsequent Designation

426. The subsequent designation may be communicated to the International Bureau in English, French or Spanish, independently of the language in which the international application from which the international registration resulted was filed, at the option of the party sending the communication. That is, where the subsequent designation is presented directly by the holder, he or she may choose which of these languages to use; where, however, the subsequent designation is presented through an Office, that Office may allow the holder to choose the language, or it may restrict the holder to one or two of these languages. [Rule 6(2)]

427. The holder may annex to his or her request a translation into any of the other languages of any text matter contained in the request. This applies whether the subsequent designation is presented to the International Bureau directly by the holder or by an Office. If the International Bureau considers the proposed translation not to be correct it will correct it, after inviting the holder to make, within one month, observations on the proposed correction. If no observation is sent with the prescribed time limit, the proposed translation is corrected by the International Bureau. [Rule 6(4)(a)]

Official Form

428. The subsequent designation must be presented on the official form (MM4) established by the International Bureau, or on a form having the same contents and format (see paragraphs 125 and 126). One form may be used to designate several Contracting Parties. [Rule 24(2)(b)] [A.I. Section 2]

Item 1: International Registration Number

429. The holder must indicate the number of the international registration for which he or she makes a subsequent designation. The subsequent designation may relate to one international registration only. [Rule 24(3)(a)(i)]

Item 2: Holder of the International Registration

Name and Address

430. The holder must indicate his or her name and address, which must be the same as recorded in the International Register. If the holder has changed the name or address without the change having been recorded in the International Register, the holder should request the recording of the change before making the subsequent designation. The International Bureau will treat the subsequent designation as irregular if the name or address indicated in the request differs from that recorded in the International Register. [Rule 24(3)(a)(ii)]

431. If there is more than one holder, the total number of holders must be indicated followed by the name and address for the first holder only. The name(s) and address(es) of the additional holder(s) must be provided in the "Continuation Sheet for Several Holders".

Item 3: Appointment of a (New) Representative

432. If the holder wishes to continue to be represented by a representative who has already been appointed, for example, when the international application was filed, the holder should not name a representative in the space provided for appointing a representative. Item 3 should therefore be left blank.

433. Where the holder wishes to appoint a representative for the first time, or to change a representative previously recorded, the appointment may be made by indicating the name and address of the (new) representative in this item of the official form. No separate communication relating to the appointment is needed. [Rule 3(2)(a)]

Item 4: Designations

434. The official form provides a box to be checked for each Contracting Party for which an extension of the protection subsequent to the international registration is sought. If the holder produces his or her own form, he or she may instead list the Contracting Parties he or she wants to designate. [Rule 24(3)(a)(iii)]

435. It is possible to designate, in the international application or subsequently, certain territories that are not Contracting Parties *per se*, but where the Contracting Party concerned has extended the application of the Protocol to specific territories. This is the case for Bonaire, Saint Eustatius and Saba (BES-island), Curacao and Sint Maarten (Dutch part). These territories are not Contracting Parties; the Contracting Party concerned here is the Netherlands. Similarly, the Bailiwick of Guernsey is not a Contracting Party, but may be designated because the United Kingdom has extended the application of the Protocol to the Bailiwick of Guernsey (as of January 1, 2021). While these territories are not Contracting Parties, these will, however, perform the roles of an Office, as if they were Contracting Parties.

436. The official form is regularly updated and the latest version made available on WIPO's website (<https://www.wipo.int/madrid/en/forms/>). If, however, the holder wishes to designate a Contracting Party that is not listed (because it has become party to the Protocol since the form was printed), he or she should write the name of that Contracting Party in the space available for that purpose in item 4. If the holder writes the name of a Contracting Party for which the accession of that Contracting Party has not yet become effective, the designation will be disregarded by the International Bureau, which will reimburse any complementary or individual fee paid in respect of that Contracting Party.

Declaration of Intention to Use the Mark

437. Where a Contracting Party has made a declaration of intent to use the mark under Rule 7(2) of the Regulations, such requirement would also apply where such Contracting Party is subject to subsequent designation. See comments made for intention to use the mark under the international application. [Rule 24(3)(b)]

Indication of a Second Language and Seniority Claim (for the Purpose of the Designation of the European Union)

438. The remarks concerning the indication of a second language before EUIPO and on seniority claim made above under "Presentation of the International Application" in paragraphs 275 to 277 (concerning the indication of a second language before EUIPO) and in paragraphs 278 to 280 (concerning seniority claims) apply *mutatis mutandis* to a subsequent designation. However, it should be noted that in the case of a subsequent designation of the EU, the second language may not be the language of the international application from which the international registration resulted, regardless of the language of the subsequent

designation. Thus, for example, if the international application had been filed in French and the subsequent designation in question is filed in English, French may not be selected as the second language for the purpose of the subsequent designation of the EU. [Rule 24(3)(c)(iii)]

Item 5: Goods and Services Concerned by the Subsequent Designation

439. Where the subsequent designation is for all goods or services covered by the international registration concerned in respect of all Contracting Parties designated, this fact should be indicated by checking box (a). Where the subsequent designation is for only some of the goods or services covered by the international registration in respect of all Contracting Parties concerned, this fact should be indicated by checking box (b) and the goods or services covered by the subsequent designation should be listed in a continuation sheet. Where the subsequent designation is for only some of the goods or services covered by the international registration in respect of some of the Contracting Parties designated, and for all the goods or services listed in the international registration in respect of the other Contracting Parties designated, this fact should be indicated by checking box (c) and details of the goods and services concerned and of the designated Contracting Parties concerned should be indicated in a continuation sheet. [Rule 24(3)(a)(iv)]

Item 6: Miscellaneous Indications

440. This item relates to a number of indications which may be required by certain designated Contracting Parties, and which the holder may wish to indicate to forestall a refusal by that Contracting Party. Where these indications have already been given in the international application, they need not be repeated here, since they will automatically be included in the notification of the subsequent designation to the Offices concerned. [Rule 24(3)(c)]

(a) Indications Concerning the Holder

441. The holder may, if he or she is a natural person, indicate the State of which he or she is a national. Legal entities may indicate their legal nature, together with the name of the State in which they are incorporated or organized and, where applicable, the territorial unit of that State.

(b) Indication of Part(s) of the Mark in Color

442. If color was claimed in the international application as a distinctive feature of the mark, the holder may indicate, in item 6(b), in respect of each color, the principal parts of the mark which are in that color.

(c) and (d) Translation

443. Where the mark consists of a word or words that may be translated, the holder may indicate, in the appropriate space, a translation of these words into English and/or French and/or Spanish. If the words contained in the mark have no meaning and therefore cannot be translated, this should be indicated in item (d).

(e) Voluntary description

444. The holder may include a voluntary description of the mark where such has not already been included in the international registration. This allows the holder to meet the requirements of designated Contracting Parties regardless of whether such description was contained in the basic mark or differs in wording.

Item 7: Date of the Subsequent Designation

445. The holder may 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. [Rule 24(3)(c)(ii)]

Item 8: Signature of the Holder and/or their Representative

446. Where the holder communicates the subsequent designation directly to the International Bureau, the holder (or the representative) must sign it. [Rule 24(2)(b)]

447. If the subsequent designation is presented to the International Bureau by an Office, the International Bureau does not require the signature of the holder or the representative; item 8 may therefore be left blank. The Office may, however, require or allow the holder (or representative) to sign.

Items 9 and 10: Date of Receipt and Declaration by the Office of the Contracting Party of the Holder Presenting the Subsequent Designation

448. A subsequent designation presented to the International Bureau by an Office must be signed by the Office, which must also indicate the date on which it received the request to present the subsequent designation. If the holder presents the subsequent designation directly to the International Bureau, items 9 and 10 should be left blank. [Rule 24(2)(b)] [Rule 24(3)(a)(vi)]

Fee Calculation Sheet

See the remarks concerning completion of the fee calculation sheet in the international application form (paragraphs 291 to 305), and the general remarks concerning payment of fees to the International Bureau (paragraphs 154 to 167).

449. The fees payable in connection with a subsequent designation consist of: [Rule 24(4)]

- the basic fee;
- an individual fee for the designation of each designated Contracting Party that has made the relevant declaration (see paragraph 294), except where that 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 designation, a complementary fee is payable);
- a complementary fee for each designated Contracting Party for which no individual fee is payable.

The Fee Calculator on the Madrid System web page of WIPO's website may be used to calculate the fees payable in respect of a subsequent designation.

450. These fees are in respect of the remainder of the 10 years for which the fees have already been paid for the international registration concerned. In other words, the amount of the fees is the same irrespective of the number of years during which the subsequent designation will have effect until the renewal of the international registration.

451. The payment may be made by any of the different means listed in the fee calculation sheet. As in the case for an international application, probably the most convenient method of payment is to use a current account with the International Bureau and merely instruct the International Bureau (by completing the fee calculation sheet) to debit the required amount; where payment is made by this method, the amount to be debited should not be specified. Where the fees are paid other than by debit from an account with the International Bureau, or where the party making the payment wishes to specify the amount to be debited from an account with the International Bureau, the method of payment, the amount paid or to be debited and the party making the payment or giving the instructions should be indicated in the fee calculation sheet.

Effect of Subsequent Designation

Date of Subsequent Designation

452. A subsequent designation, which is presented by the holder directly to the International Bureau will bear the date on which it was received by the International Bureau. [Rule 24(6)(a)]

453. A subsequent designation, which is presented to the International Bureau by an Office bears, if it complies with the applicable requirements, the date on which it was received by the Office, provided that it has been received by the International Bureau within two months from that date. If the International Bureau receives the subsequent designation after the expiry of that time limit, it will bear the date of its receipt by the International Bureau. This applies also in the cases of continued processing under Rule 5*bis* of the Regulations, because the procedure of continued processing has no impact on the determination of the date of the subsequent designation under Rule 24(6) of the Regulations. [Rule 24(6)(b)]

454. The date of a subsequent designation may be affected if it contains irregularities (see paragraph 460).

455. In general, the possibility of being accorded an earlier date will be of advantage to the holder. In certain circumstances however, this new possibility can cause complications, and may have even disadvantages. For example, a subsequent designation, which is presented through an Office shortly before renewal of the international registration is due, but reaches the International Bureau after that date will nonetheless bear a date earlier than the renewal date. It will therefore expire on that date and, to maintain it in force, it will be necessary to pay again the complementary fee or (where appropriate) the individual fee required in respect of the newly designated Contracting Party.

456. In contrast to a subsequent designation, the recording of a change under Rule 25 is deemed to take effect when it is actually recorded in the International Register, whether the request to record the change was presented through an Office or directly to the International Bureau. Thus, where a subsequent designation and a request to record a change are presented at the same time through an Office, the subsequent designation will generally bear a date which is earlier than the date of the change. For example, it sometimes happens that a holder wishes to renounce protection in respect of a particular Contracting Party (because of a threatened refusal by that Contracting Party) and then immediately re-extend the protection to that Contracting Party by means of a subsequent designation. If the renunciation and the subsequent designation are presented simultaneously through an Office then, as a consequence of Rule 24(6)(b), the renunciation with respect to the Contracting Party concerned will take effect after the new territorial extension to that Contracting Party.

457. To avoid problems of the kind just described, the holder can indicate that the subsequent designation must 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, by checking the appropriate box in item 7 of the subsequent designation form. Such a change or cancellation must be specified. [Rule 24(6)(d)]

458. Where the date of the subsequent designation, determined as described in the foregoing paragraphs, is not more than six months after any priority date recorded in respect of the international registration, the priority which the latter enjoys will also have effect in the Contracting Parties covered by the subsequent designation (see paragraph 466).

Irregular Subsequent Designation

459. Where the International Bureau considers that there is an irregularity regarding the subsequent designation, it will so notify the holder. Where the subsequent designation was presented by an Office, it will also notify the Office. [Rule 24(5)(a)]

460. Where a subsequent designation contains an irregularity, which relates to the number of the international registration concerned, the indication of the Contracting Parties designated, the indication of the list of goods or services or any declaration of intention to use to be annexed to the subsequent designation, the date of the subsequent designation will be the date on which the irregularity is remedied. Where, however, the subsequent designation was presented to the International Bureau by an Office, the date of the subsequent designation will not be affected by any of these irregularities if they are remedied within two months of the date on which the request to present the subsequent designation was received by the Office; in this case, the subsequent designation will continue to bear the date on which the request was received by the Office. [Rule 24(6)(c)(i)]

461. Any other irregularity does not affect the date of the subsequent designation. [Rule 24(6)(c)(ii)]

462. If the irregularity is not remedied within three months from the date of the notification by the International Bureau, the subsequent designation will be considered abandoned. Nevertheless, Rule 24(5)(c) provides that where official form MM18 (declaration of intention to use the mark) has not been submitted together with a subsequent designation covering the United States of America, or where the submitted form is defective, and where this irregularity is not remedied within the given time limit, only the designation of the United States of America will be considered as not contained in the subsequent designation. The International Bureau will continue processing the subsequent designation where other Contracting Parties are included therein. The International Bureau will refund the fees paid, subject to the retention of one-half of the basic fee, to the party (holder, representative or Office) that paid them. [Rule 24(5)(b)] [Rule 24(5)(c)]

463. The rules do not specify who should remedy the irregularity. If the holder presented the subsequent designation directly to the International Bureau, then clearly he or she has to remedy the irregularity. If the subsequent designation was presented by an Office, that Office may remedy the irregularity. Indeed, depending on the nature of the irregularity, it may be difficult or even impossible for the holder to remedy the irregularity alone (for example, if the Office has not signed the subsequent designation or has not indicated the date when it received the request to present it). Where, therefore, a holder is notified by the International Bureau that there is an irregularity in a subsequent designation which has been presented through an Office, he or she would be well advised to contact that Office to ensure that the irregularity will be remedied in good time.

464. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the failed time limit has ended. Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5bis]

Recording, Notification and Publication

465. Where the International Bureau finds that the subsequent designation conforms to the applicable requirements, it will record it in the International Register and notify the Office of the Contracting Party that has been designated. It will at the same time inform the holder and, if the subsequent designation was presented through an Office, that Office. [Rule 24(8)]

466. The subsequent designation will be published in the Gazette. The Gazette can be accessed by Madrid Monitor (<https://www3.wipo.int/madrid/monitor/en/>). Where the date of the subsequent designation, as determined in accordance with Rule 24(6) (see paragraphs 452 to 458) is not more than six months after the priority date of the international registration, the information concerning the declaration of priority will be included in the publication of the subsequent designation. [Rule 32(1)(a)(v)]

467. The subsequent designation will be recorded and published in English, French and Spanish. As regards international registrations that, under the previous versions of Rule 6, were published only in French, or were published only in English and French, they will be published in English and Spanish and republished in French, or published in Spanish and republished in English and French, respectively. That subsequent designation itself will be recorded in the International Register in English, French and Spanish. [Rule 6(3)]

Period of Protection

468. The period of protection under the subsequent designation expires on the same date as the international registration. For example, if an international registration has already been registered for eight years (or the last installment of fees was paid eight years ago), the fees to be paid for a subsequent designation will cover a period of only two years. This means that the date of renewal of the international registration (or the date of payment of the renewal fees) is the same for all designations contained in the international registration, irrespective of the date on which the designations were recorded (see also paragraph 455). [Rule 31(2)]

Refusal of Protection

469. The refusal of protection, by a designated Contracting Party, of a subsequent designation follows the same procedures as for the refusal of protection of a designation contained in the international application. Rules 16 to 18ter therefore apply *mutatis mutandis*, it being understood that the time limit for a Contracting Party to notify a refusal of protection starts from the date on which the International Bureau has notified the subsequent designation to the Office of that Contracting Party. The comments made in paragraphs 410 to 414 are referred to. [Rule 24(9)]

A Particular Case of Subsequent Designation: Subsequent Designation Resulting from the Conversion of the Designation of a Contracting Organization (the European Union)

470. Under the European Union Trade Mark system, where a European Union trademark application is withdrawn or refused, or where a European Union trademark registration ceases to have effect, the proprietor of that European Union Trade Mark may request its conversion into a national trademark application with the Office of one or more member States of the European Union.

471. The effect of a conversion is that the national trademark application resulting from conversion is allocated the same filing date as that of the European Union trademark application or registration (and enjoys, if applicable, the same priority date and/or seniority claimed), provided in particular that the request for conversion is filed within the time limit prescribed by the European Union legislation.

472. Due to this feature of the European Union Trade Mark system, the Regulations provide that, where a Contracting Organization (in practice the European Union) is designated in an international registration and to the extent that such designation has been withdrawn, refused or has ceased to have effect, conversion may also be requested through a subsequent designation of its member States under the Madrid System. This mechanism, offering the holder of an international registration the option of converting the designation of the European Union into either a national application filed directly with the Office of a member State or a subsequent designation of that member State under the Madrid System, is often referred to as the “opting-back” provision. [Rule 24(7)(a)]

473. As a general principle, subsequent designations resulting from conversion must comply with the requirements set out for “ordinary” subsequent designations (see paragraphs 416 to 469), subject however to the following.

Official Form and Contents

474. A subsequent designation resulting from conversion must be presented on an official form, which could be the form MM16 established by the International Bureau, distinct from that used for an “ordinary” subsequent designation (MM4), or the form established by the EUIPO (see more on this below). [A.I. Section 3]

475. A request for the recording of a subsequent designation resulting from conversion must contain or indicate the following: [Rule 24(7)(b)]

- the number of the international registration concerned;
- the name and address of the holder;
- the Contracting Organization whose designation is to be converted;
- the member State or States of the Contracting Organization that are the subject of the subsequent designation;
- 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;

- the amount of 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.

476. Where the holder wishes to appoint a representative for the first time, or to change his or her representative, the appointment may be made by indicating his or her name and address in the corresponding item of the official form. [Rule 3(2)(a)]

Presentation of the Subsequent Designation Resulting from Conversion

477. A subsequent designation resulting from conversion must always be presented to the International Bureau through the Office of the Contracting Organization (in practice, EUIPO). This implies in particular that the said Office must determine, before transmitting the subsequent designation resulting from conversion to the International Bureau, whether such request complies with the necessary conditions under its own legislation (in particular, whether requirements concerning time limits have been complied with). Users are advised to use the form established by the EUIPO given that requests must be presented directly to that Office. [Rule 24(2)(a)(iii)]

Date of Subsequent Designation Resulting from Conversion

478. A subsequent designation resulting from conversion bears the date on which the designation of the Contracting Organization in the international registration concerned was recorded in the International Register. [Rule 24(6)(e)]

CHANGES AND OTHER RECORDINGS IN THE INTERNATIONAL REGISTRATION

Recording of a Change of Name or Address of the Holder; Recording of a Change to the Legal Nature of the Holder Where the Holder is a Legal Entity; Change of Name or Address of the Holder's Representative

479. The possibility to provide information on the legal nature and State of organization of the holder, as a legal entity, was introduced in the Madrid System to enable holders to satisfy the requirements in the laws of certain Contracting Parties. In certain Contracting Parties, a legal entity may change its legal nature without this change resulting in a new legal entity. This could pose significant challenges for holders of international registrations in, for instance, prosecution, enforcement and litigation proceedings because the holder's information contained in the International Register and notified to the Contracting Parties is no longer current. This information shall become part of the international registration. Rule 25 allows the holder of an international registration to add or update its legal nature as recorded by the International Bureau (for example, limited liability company or corporation) where the legal nature has changed or needs to be added, to comply with the applicable domestic legislation using the same form required for a change of name and/or address. A request to indicate the legal nature of the holder, or record a change in name, address or legal nature of the holder, must be presented to the International Bureau on the official form (MM9) established by the International Bureau (or on a form having the same contents and format). [Rule 25(1)(a)(iv)] [A.I. Section 2]

480. The request may be presented to the International Bureau directly by the holder or through the Office of the Contracting Party of the holder. [Rule 25(1)(b)]

Official Form (MM9)

481. The form for a request to indicate the legal nature of the holder, or record a change in name, address or legal nature of the holder must not be used where the change of name results from a change in ownership. In such a case, form MM5 should be used (see paragraphs 534 to 568).

Item 1: International Registration Number

482. A single request may relate to several international registrations recorded in the name of the same holder. It is sufficient, for the purpose of the identification of the international registrations to which the request refers, to indicate the numbers of the respective registrations.

483. If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given; the holder should wait until he or she is notified of the international registration number concerned and make a further request.

Item 2: Name of the Holder

484. The name of the holder as recorded in the International Register must be indicated.

Item 3: Change in Name and/or Address of the Holder

485. Spaces are provided in item 3 to indicate the new name and/or new address. Only the information which has changed need be indicated. That is, where only the name has changed, it is sufficient to indicate the new name, leaving the other spaces blank; similarly, where only the address has changed, there is no need to repeat the name.

486. Where there are joint holders and the change only applies to one of them, it must be clear to which holder the change applies. If there are several joint holders **but** only one of them has a new name and/or address, provide the new name and/or address of the holder concerned, **as well as** the unchanged name and/or address of the other holders in the continuation sheet.

Item 4: If the Holder is a Legal Entity, Recording of or Change in the Indications Concerning the Legal Nature of the Holder

487. Where the holder is a legal entity it may record or change the details of the legal entity, including its legal nature and/or the State under the law it was organized, in the spaces provided in item 4.

488. To request a change in the holder's contact details (for example, e-mail address or address for correspondence) use Contact Madrid (under "My request concerns", select the topic "a change in contact details of the holder"). [Rule 36(ii)]

Item 5: Appointment of a (New) Representative

489. The opportunity may be taken, in a request to record the legal nature of the holder, or a change in the name, address or legal nature of the holder, to appoint a representative. As from February 1, 2021, it is mandatory to provide the e-mail address of the representative.

490. Where there is no change in the representative already recorded, this item of the form should be left blank.

Item 6: Signature of the Holder and/or Their Representative

491. Where the request is presented directly to the International Bureau, it must be signed by the holder (or the representative as recorded). [Rule 25(1)(d)]

492. Where the request is presented to the International Bureau through an Office, that Office may require or permit the holder or the representative to sign the form. The International Bureau will not question the absence of a signature from this item.

Item 7: Office of the Contracting Party of the Holder Presenting the Request

493. A request which is presented to the International Bureau by an Office must be signed by that Office. [Rule 25(1)(d)]

Fee Calculation Sheet

See the general remarks concerning payment of fees to the International Bureau (paragraphs 154 to 167).

494. A request to record the legal nature of the holder, or a change in the name, address or legal nature of the holder is subject to the payment of the fee specified in the Schedule of Fees, which covers any number of international registrations and/or recordings or changes mentioned in the request. The payment may be made by any of the different means listed in the fee calculation sheet. The most convenient method of payment is to use a current account with the International Bureau and simply instruct the International Bureau (by completing part (a) of the fee calculation sheet) to debit the required amount; where payment is made by this method, the amount to be debited should not be specified. There is a flat fee of 150 Swiss francs to be paid to record the changes requested in the official form MM9.

Change of Name or Address of the Representative

495. Rule 25(1)(a)(vi) provides that a request to record a change in the name or address, including the e-mail address, of the representative needs to be made on an official form. Form MM10 is available for this purpose. This form is similar to the form MM9 to be used for the request to record a change in the name or address of a holder. The main differences are that for form MM10 it is not necessary to indicate the name of the holder and that the change indicated relates to the name or address, including the new e-mail address, of the representative. The recording of a change in name or address of a representative is free of charge. [Rule 25(1)(a)(vi)] [A.I. Section 2] [Rule 36(i)]

496. Form MM10 is to be used only to request the recording of the change in the name or address, including a new e-mail address, of a representative whose appointment has already been recorded in the International Register. It may not be used to request the recording of the appointment of a new representative.

497. A single request may relate to several specified international registrations. The International Bureau cannot accept a request to record a change in the name or address of a representative which simply refers to all international registrations in the name of the same representative.

Irregular Requests

498. If a request to record a change in name or address of the holder or the representative does not comply with the applicable requirements, the International Bureau notifies that fact to the holder and, if the request was presented through an Office, to that Office. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned; any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the fee. [Rule 26]

499. Where the request was presented through an Office, the holder should establish whether that Office intends to remedy the irregularity, or whether the holder must do this.

500. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the expiry of the failed time limit. Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. In the case of continued processing, the date of recording of the change will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5*bis*] [Rule 27(1)(c)]

Recording, Notification and Publication

501. The International Bureau records the legal nature of the holder, or the change of name, address or 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 in the International Register and notifies accordingly the Offices of the designated Contracting Parties. At the same time, it informs the holder and, where the request was presented by an Office, that Office. Information concerning an introduction of the legal nature of the holder or any changes concerning the holder's name, address or legal nature or change in name or address of the representative are recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements. However, where so requested, they may be recorded after the recording of a change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration. In addition, the International Bureau publishes the relevant data in the Gazette. [Rule 27(1)(a)] [Rule 27(1)(b)] [Rule 32(1)(a)(vii)]

Limitation, Renunciation and Cancellation

502. The holder may wish to record one of the following restrictions in the protection of the international registration:

- a limitation of the list of goods and services, which may affect some or all of the designated Contracting Parties (“limitation”);
- a renunciation of the protection in respect of some of, but not all, the designated Contracting Parties, for all the goods and services (“renunciation”);
- the cancellation of the international registration in respect of all the designated Contracting Parties, for some or all of the goods and services (“cancellation”).

Effects and Consequences of Limitation, Renunciation or Cancellation

503. The recording of a limitation does not result in the removal of the goods and services concerned from the international registration as recorded in the International Register; the goods and services are not removed from the main list of the international registration. The sole effect is that the international registration is no longer protected for the goods and services concerned in the Contracting Parties covered by the limitation. Even if a limitation of the list of goods and services has been recorded with effect for all designated Contracting Parties, the goods and services which have been the subject of a limitation may later be made the subject of a subsequent designation. Since the goods and services subject of a limitation remain in the main list of the international registration, they are taken into account when calculating any supplementary fees due on renewal.

504. The effect of renunciation is that protection of the international registration would no longer apply to the Contracting Parties subject of a renunciation. However, Contracting Parties in respect of which protection has been renounced can always be designated again.

505. In contrast, where an international registration is cancelled, the goods and services are permanently removed from the main list of the international registration in the International Register. If the cancellation is recorded for all goods and services, nothing remains on the Register. In case of a partial cancellation, the goods and services for which a cancellation has been recorded are eliminated from the International Register. The consequence of this is that, in the case of a total cancellation, no subsequent designation may later be made for the international registration, since it does not exist anymore. If the former holder wishes to protect the mark again he or she must file a new international application. Similarly, in the case of a partial cancellation, the holder of the international registration cannot ask for any subsequent designation with respect to goods and services for which the international registration has been cancelled. If he or she wishes to protect the mark again for such goods and services he or she must file a new international application.

506. If the holder voluntarily limits or renounces the protection of the international registration, or asks for its cancellation in accordance with Rule 25 of the Regulations, the holder cannot then make use of the possibility provided for in Article 9*quinquies* of the Protocol to ask for transformation of the international registration into national or regional applications while keeping the date of the international registration. Transformation can only follow a cancellation of the international registration requested by the Office of origin in accordance with Article 6(4) of the Protocol (see paragraphs 698 to 703).

Request for Recording

507. A request to record a limitation, renunciation or cancellation must be presented to the International Bureau on the appropriate official form (MM6, MM7 or MM8) established by the International Bureau or on a form having the same contents and format. [Rule 25(1)(a)] [A.I. Section 2]

508. The request may be presented to the International Bureau directly by the holder or through the Office of the Contracting Party of the holder. [Rule 25(1)(b)]

509. In general, the request may be in English, French or Spanish. However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of a subsequent designation: [Rule 6(2)] [Rule 40(4)]

- if governed exclusively by the Agreement, French will continue as the sole language of communication, recording and publication.
- if governed wholly or partly by the Protocol, French and English will continue as the language of communication, recording and publication.

For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of a subsequent designation:

- if governed exclusively by the Agreement, then, as above, French will continue as the sole language of communication, recording and publication. (Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004).

Official Form

510. Separate official forms (MM6, MM7 and MM8 respectively) are available for requesting the recording of a limitation, renunciation or cancellation. They are broadly similar and are described together, with the differences being commented on.

511. The simplest way to record a limitation is to use WIPO's online limitation form in the WIPO IP Portal. Once the international registration number is entered into the online form, the list goods and services as currently recorded for each of the designated Contracting Parties will be clearly displayed. These goods and services can then be easily modified, and entire class(es) can be deleted to reflect the limitation. Furthermore, various options to pay the required fees including by credit card, or debiting the required amount from your WIPO Account will be made available.

International Registration Number

512. The number(s) of the international registration(s) concerned should be indicated. A single request may relate to several international registrations, provided the scope of the limitation, renunciation or cancellation is the same for each; that is, the Contracting Parties affected are the same for each international registration (as is necessarily the case for cancellation) and either the change relates to the same goods and services for each registration or else (as is necessarily the case for renunciation) it relates to all the goods and services covered by each registration.

513. If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given; the holder should wait until he or she is notified of the number of the international registration concerned and make a further request.

Holder

514. The name of the holder must be the same as the name recorded in the International Register.

Appointment of a Representative

515. The holder may appoint a representative in a request to record a limitation, renunciation or cancellation.

516. Where there is no change in the representative already recorded, this item of the form should be left blank.

Contracting Parties

517. If a limitation of the list of goods and services is to apply to all the designated Contracting Parties, it is sufficient to check the relevant box under item 4 of form MM6. Otherwise, those Contracting Parties in respect of which the limitation is to be recorded should be listed; where the request relates to several international registrations, this list will apply to all of them.

518. In the case of a renunciation, the Contracting Parties affected should be listed under item 4 of form MM7; where the request relates to several international registrations, the same list must apply to all of them.

Goods and Services

519. In the case of a limitation, the scope of the limitation of the list of goods and services should be set out under item 5 of form MM6. Where any of the terms used to describe a particular good or service are to be replaced by another (narrower) term, it must be clearly indicated which terms are to be replaced by which. Whatever method is used to indicate the limitation, the limited goods and services must be grouped under the corresponding number of the classes, indicating the number of the respective class, and in the sequence of the numbers of the International Classification of Goods and Services. Where the limitation affects all the goods and services in one or more of the classes, the request must indicate the classes to be deleted.

520. In the case of a cancellation in respect of all the goods and services covered by the international registration, the relevant box under item 4 of form MM8 should be ticked. In the case of a partial cancellation, the scope of the cancellation should be indicated, under item 4, in the manner described in paragraph 519.

Signature of the Holder and/or Their Representative

521. Where the request is presented directly to the International Bureau, it must be signed by the holder (or his or her representative). [Rule 25(1)(d)]

522. Where the request is presented to the International Bureau through an Office, that Office may require or permit the holder or his or her representative to sign the form. The International Bureau will not question the absence of a signature from this item.

Office of the Contracting Party of the Holder Presenting the Request

523. A request which is presented to the International Bureau by an Office must be signed by that Office. If the holder submits a request directly to the International Bureau, this field should be left blank. [Rule 25(1)(d)]

Fee Calculation Sheet (Limitation Only)

See the general remarks concerning payment of fees to the International Bureau (paragraphs 154 to 167).

524. A request to record a limitation is subject to the payment of the fee specified in the Schedule of Fees. Where the request relates to several international registrations, a fee of 177 Swiss francs must be paid with regard to each one of them. The payment may be made by any of the different means listed in the fee calculation sheet. The most convenient method of payment is to use a current account with the International Bureau and merely instruct the International Bureau (by completing the fee calculation sheet) to debit the required amount; where payment is made by this method, the amount to be debited should not be specified. Where the fees are paid other than by debit from an account with the International Bureau, or where the party making the payment wishes to specify the amount to be debited from an account with the International Bureau, the method of payment, the amount to be paid or to be debited and the person (holder, representative or Office) making the payment or giving the instructions should be indicated in the fee calculation sheet.

525. A request to record a renunciation or a cancellation is exempt from the payment of a fee. Accordingly, the forms for these requests do not contain a fee calculation sheet. [Rule 36(iii) and (iv)]

Irregular Requests

526. If a request to record a limitation, renunciation or cancellation does not comply with the applicable requirements, the International Bureau notifies that fact to the holder and, if the request was presented through an Office, to that Office. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned; any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the fee. [Rule 26]

527. Where the request was presented through an Office, the holder should establish whether that Office intends to remedy the irregularity, or whether the holder must do this.

528. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the expiry of the failed time limit. Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. In the case of continued processing, the date of recording of the change will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5bis] [Rule 27(1)(c)]

Recording, Notification and Publication

529. The International Bureau records the limitation, renunciation or cancellation in the International Register and notifies accordingly the Offices of those designated Contracting Parties concerned (necessarily all of them in the case of a cancellation). At the same time, it informs the holder and, where the request was presented by an Office, that Office. The recording is made as of the date of receipt by the International Bureau of a request complying with the applicable requirements; where, however, the holder has so requested, it may be made 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. In addition, the International Bureau publishes the relevant data in the Gazette. [Rule 27(1)(a)] [Rule 32(1)(a)(vii) and (viii)] [Rule 27(1)(b)]

530. Where the request to record a cancellation pursuant to Rule 25 is presented before the end of the five-year period referred to in Article 6(3) of the Protocol (see paragraph 669), the International Bureau will inform the Office of origin of the cancellation, even if the request was presented through an Office other than the Office of origin or directly by the holder. With regard to the language of recording, notification and publication, see paragraph 509.

Declaration that a Limitation Has No Effect

531. The Office of a designated Contracting Party, which is notified by the International Bureau of a limitation in the list of goods and services affecting it, may declare that the limitation has no effect in its territory (in particular, because it considers that the change requested is not in fact a limitation but an extension of the list). Any such declaration must be sent to the International Bureau before the expiry of 18 months from the date on which that notification was sent to the Office concerned. In its declaration, the Office must indicate the reasons for which the limitation has no effect and 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, as well as the corresponding essential provisions of the law and whether the declaration is subject to review or appeal. The International Bureau will notify accordingly the party (holder or Office) that presented the request for the recording of the limitation. [Rule 27(5)(a) to (c)]

532. Where the declaration indicates that it may be subject to review or appeal, it is for the holder to ascertain from the Office concerned the time limit for requesting such review or appeal and the authority to which the request must be made. The Office must notify any final decision relating to the declaration to the International Bureau, which will notify accordingly the party (holder or Office) that presented the request to record the limitation. [Rule 27(5)(e)]

533. Any declaration that a limitation has no effect, or any final decision in respect of that declaration, will be recorded in the International Register. The relevant information will be published in the Gazette. [Rule 27(5)(d) and (e)]

Change in Ownership

534. The ownership of a trademark may change for various reasons and in different ways. A change in ownership may result from a contract, such as an assignment, from court decision or operation of law, such as an inheritance or bankruptcy. An automatic change in ownership can result from the merger of two companies.

535. The change in ownership of an international registration may relate to all the goods and services covered by the international registration, or to only some of those goods and services. Similarly, the change in ownership may be in respect of all the Contracting Parties designated or only some of them.

536. The Regulations do not distinguish between such different causes for, or different types of, change in ownership. Like Article 9 of the Protocol, they use the uniform terminology “change in ownership” for all cases. Until the change has been recorded in the International Register, the former owner of the international registration is referred to as the “holder”, since this term is defined as the person or legal entity in whose name the international registration is recorded, and the new owner is referred to as the “transferee”. Once the change in ownership has been recorded, he or she becomes the holder of the international registration. [Rule 1(xxi)]

Entitlement of the Transferee to Be the New Holder

537. The change in ownership may be recorded only if the transferee is a person who is entitled to file international applications.

538. In the request to record the change in ownership, the transferee must indicate the Contracting Party or Parties with respect to which he or she fulfills the conditions, under Article 2(1) of the Protocol, to be the holder of an international registration. In other words, the transferee must indicate the Contracting Party or Parties in which he or she has a real and effective industrial or commercial establishment or is domiciled, or the country which is party to the Protocol (or a member State of an organization party to the Protocol) and of which he or she is a national. A transferee may claim the necessary connection with several Contracting Parties. [Rule 25(2)(a)(iv)]

539. If there are several transferees, each of them must fulfill the conditions under Article 2(1) of the Protocol. It is, however, not necessary that the Contracting Party or Parties through which the conditions are fulfilled be the same for each transferee. [Rule 25(4)]

Request to Record a Change in Ownership

540. A request to record a change in ownership must be presented to the International Bureau on the official form (MM5) established by the International Bureau or on a form having the same contents and format. [Rule 25(1)(a)(i)] [A.I. Section 2]

541. The request may be presented to the International Bureau directly by the holder (or the recorded representative), or through the Office of the Contracting Party of either the (recorded) holder or the transferee. In one situation, the form must be presented through the Office of the Contracting Party, this is where the recorded holder has not signed the form MM5, for example, because the holder does not exist anymore (for example, due to a death or bankruptcy). [Rule 25(1)(b)]

542. Where the request is to be presented to the International Bureau through an Office, that Office may require evidence concerning the change of ownership. The International Bureau does not require evidence of the change in ownership and no supporting documents (such as copies of the deed of assignment or other contract) should be sent to the International Bureau.

543. In general, the request may be in English, French or Spanish. However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of the first subsequent designation: [Rule 6(2)] [Rule 40(4)]

- if governed exclusively by the Agreement, French will continue as the sole language of communication, recording and publication.
- if governed wholly or partly by the Protocol, French and English will continue as the language of communication, recording and publication.

For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of the first subsequent designation:

- if governed exclusively by the Agreement, then, as above, French will continue as the sole language of communication, recording and publication. (Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004 (see also paragraphs 150 to 153).

544. In practice, the question of language affects only the list of goods and services, since the other contents of the request are independent of language.

Official Form

Item 1: International Registration Number

545. The number(s) of the international registration(s) concerned should be indicated. A single request may relate to several international registrations being transferred from the same holder to the same transferee provided that, for each of the international registrations concerned, the change applies to all the designated Contracting Parties, or to the same Contracting Parties, and that it concerns all the goods and services, or the same goods and services.

546. If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given. It is not possible to record a change in ownership for a pending international application. Therefore, the holder would need to wait until he or she is notified of the number of the international registration concerned before requesting the recording of the change in ownership.

Item 2: Name of the Holder (Transferor)

547. The name of the holder must be the same as the name recorded in the International Register.

Item 3: New Holder (Transferee)

548. The name and address of the transferee should be given, following the guidelines concerning the name and address of the applicant in an international application (see paragraphs 216 to 222). [Rule 25(2)(a)(iii)]

549. As from February 1, 2021, a request for the recording of a change in ownership must also indicate the e-mail address of the transferee. Where the transferee has not indicated an e-mail address, the International Bureau will issue a notification of irregularity under Rule 26.

550. Where the transferee is a natural person, the nationality may be given under item (e). Where the transferee is a legal entity, the nature of the entity may be indicated, together with the State (and, where appropriate, the territorial unit within that State) in which it is incorporated. These indications are optional and their absence will not be questioned by the International Bureau (see paragraph 224). However, it would be useful to include this information as the Offices of some Contracting Parties may issue provisional refusals where such indications are not provided. The transferee may indicate the preferred language for further communication with the International Bureau, English French or Spanish. [Rule 25(2)(b)]

Item 4: Entitlement of the New Holder (Transferee) to Be the Recorded Holder of the International Registration(s)

551. The new holder (transferee) should indicate the Contracting Party or Parties of which he or she is a national, is domiciled or in which he or she has a real and effective industrial or commercial establishment. Any or all of these spaces may be used, and more than one Contracting Party may be given in any one space. Where the transferee is domiciled or has an establishment in, a Contracting State, which is also a member State of a Contracting Organization, both of these Contracting Parties may be indicated in any or all of the spaces, as appropriate. [Rule 25(2)(a)(iv)]

552. Where more than one Contracting Party may apply, it is a matter for the transferee to decide which ones should be mentioned. The indications must, however, be sufficient to show that the transferee (or, where there are several transferees, each of them) is entitled to be the holder of the international registration.

553. Where the transferee has indicated, under item 4(a)(iii) or (iv), to be domiciled or have an establishment in a particular Contracting Party, but the address as given in item 3 is not in the territory of that Contracting Party, it is necessary to give under item 4(b) the address of such domicile or establishment unless it has been indicated that the transferee is a national of a Contracting State or of a State member of a Contracting Organization. [Rule 25(2)(a)(v)]

Item 5: Appointment of a Representative by the New Holder (Transferee)

554. The new holder (transferee) may appoint a representative in form MM5.

555. Item 5 should be used for the appointment of a representative of the new holder (the transferee). In the case of a total change in ownership, the recording of the representative of the transferor will be cancelled *ex officio* by the International Bureau. Where the person recorded as the representative of the transferor is to be recorded as the representative of the transferee, he or she should be reappointed by completing item 5. [Rule 3(6)(a)]

Item 6: Scope of the Change in Ownership

556. If the change in ownership relates to all the designated Contracting Parties covered by the international registration and to all the goods and services covered by the said registration, box (a) should be checked. This is a total change in ownership.

557. In the case of a partial change in ownership, box(b) should be checked. The Contracting Parties in respect of which the change in ownership is to be recorded should be named, and a list of the goods and services affected, grouped in the classes and sequence of the International Nice Classification.

Item 7: Signature of the Holder (Transferor) and/or Their Representative

558. Where the request is presented directly to the International Bureau, it must be signed by the holder (or the recorded representative). [Rule 25(1)(d)]

559. Where the request is presented to the International Bureau through an Office, that Office may require or permit the holder to sign the form. The International Bureau will not question the absence of a signature from this item.

Item 8: Office of the Contracting Party of the Recorded Holder (Transferor) or that of the New Holder (Transferee) Presenting the Request

560. A request which is presented to the International Bureau by an Office must be signed by that Office. [Rule 25(1)(d)]

Fee Calculation Sheet

See the general remarks concerning payment of fees to the International Bureau (paragraphs 154 to 167).

561. A request to record a change in ownership is subject to the payment of the fee specified in the Schedule of Fees. Where the request relates to several international registrations, a fee of 177 Swiss francs must be paid for each one of them. The payment may be made by any of the different means listed in fee calculation sheet. The most convenient method of payment is to use a current account with the International Bureau and merely instruct the International Bureau (by completing the fee calculation sheet) to debit the required amount; where payment is made by this method, the amount to be debited should not be specified. Where the fees are paid other than by debit from an account with the International Bureau, the method of payment, the amount paid or to be debited and the party making the payment or giving the instructions should be indicated in the fee calculation sheet.

Irregular Requests

562. If a request to record a change in ownership does not comply with the applicable requirements, the International Bureau notifies that fact to the holder and, if the request was presented through an Office, to that Office. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned; any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the fee. [Rule 26]

563. Where the request was presented through an Office, the holder or the transferee should establish whether that Office intends to remedy the irregularity, or whether this would be for the holder or the transferee to do.

564. If the holder has failed to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the expiry of the failed time limit. Together with the request, the holder or the transferee must remedy the irregularity concerned and pay the fee for continued processing. In the case of continued processing, the date of recording of the change will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5*bis*] [Rule 27(1)(c)]

Recording, Notification and Publication

565. The International Bureau records the change in ownership in the International Register and notifies accordingly the Offices of the designated Contracting Parties in respect of which the international registration has been transferred. At the same time, it informs the new holder and, where the request was presented through an Office, that Office. The International Bureau will also inform the former holder (in the case of a total change in ownership) or the holder of the part of the international registration that has not been subject of the change (in the case of a partial change in ownership). [Rule 27(1)(a)]

566. The change is recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements. It may, however, be recorded with a later date where the holder has requested that it be recorded after the recording of another change, or cancellation, or a subsequent designation in respect of the same international registration, or after the renewal of the international registration. The International Bureau publishes the relevant data in the Gazette. [Rule 27(1)(b)] [Rule 32(1)(a)(vii)] [Rule 6(3)]

Partial Change in Ownership

567. Where a request to record a change in ownership of an international registration only concerns some of the goods and services or some of the designated Contracting Parties, the change will be recorded in the International Register under the number of the international registration concerned. The part which has been transferred will be recorded as a separate international registration, which will bear the same number as the registration of which a part has been transferred, together with a capital letter. The publication in the Gazette consists of the part of the international registration which has been transferred (with, *inter alia*, the reproduction of the mark, the list of goods and services and the designated Contracting Parties concerned). [Rule 27(2)] [A.I. Section 16]

568. Either of the resulting separate international registrations may be the subject of a subsequent total or partial change in ownership.

Several Consecutive Changes in Ownership

569. Where an international registration has been the subject of several consecutive changes in ownership that have not yet been recorded in the International Register, the recording of the chain in ownership may be requested by submitting separate MM5 forms, one for each change in ownership together with the payment of fees. With this approach, the full history of ownership would be recorded in the International Register. Alternatively, the holder could request the recording of a change of ownership from the recorded holder to the latest owner. However, in this case, the International Register would only reflect one change in ownership and not show the full history of the international registration.

Declaration that a Change in Ownership Has No Effect

570. It is up to the Contracting Parties concerned to determine the effects of the change in ownership. The validity of a change in ownership of an international registration in respect of a particular Contracting Party is governed by the law of that Contracting Party. In particular, where the change in ownership is for only some of the goods and services, a designated Contracting Party has the right to refuse to recognize the validity of the change if the goods and services included in the part transferred are similar to those remaining in the name of the holder. This might also be done where the transferee is a person or legal entity which, under the law of that Contracting Party, is not entitled to own marks, or where the law of the Contracting Party concerned does not allow a transfer which, in its view, would be likely to mislead the public.

571. The Office of a designated Contracting Party, which is notified by the International Bureau of a change in ownership affecting, it may therefore declare that the change in ownership has no effect in its territory. Any such declaration must be sent before the expiry of 18 months from the date on which the notification of the change in ownership was sent to the Office concerned. In its declaration, the Office must indicate the reasons for which the change in ownership has no effect, the corresponding essential provisions of the law and whether the declaration is subject to review or appeal. The Office notifies such declaration to the International Bureau, which will notify accordingly the party (holder or Office) that presented the request for the recording of the change and the new holder. [Rule 27(4)(a) to (c)]

572. Where the declaration indicates that it may be subject to review or appeal, it is for the transferee to ascertain from the Office concerned the time limit for requesting such review or appeal and the authority to which the request must be made. The Office must notify any final decision relating to the declaration to the International Bureau, which will notify accordingly the party (holder or Office) that presented the request to record the change in ownership and the new holder. [Rule 27(4)(e)]

573. Any declaration that the change in ownership has no effect, or any final decision in respect of that declaration, will be recorded in the International Register. The part of the international registration, which has been the subject of the declaration or of the final decision, will be recorded as a separate international registration in the same manner as for the recording of a partial change in ownership (see paragraph 567). The relevant information will be published in the Gazette. [Rule 27(4)(d) and (e)] [A.I. Section 18] [Rule 32(1)(a)(xi)]

574. The effect, as far as the International Register is concerned, of a declaration by a designated Contracting Party that a change of ownership has no effect is that, with respect to that Contracting Party, the international registration concerned remains in the name of the transferor (former holder). The effect of such a declaration as far as the parties to the transfer are concerned is, however, a matter for the applicable national law. [Rule 27(4)(a)]

Division of an International Registration

575. Rule 27*bis* provides holders of international registrations with the possibility to request the division of an international registration in respect of a designated Contracting Party. [Rule 27*bis*]

576. A request for the division of an international registration must be filed with the Office of the designated Contracting Party in respect of which the international registration is to be divided. The request cannot be filed directly with the International Bureau. [Rule 27*bis*(1)(a)]

577. Division may be useful where, for example, the Office of a designated Contracting Party refuses an international registration for only some of the classes of goods or services (or refuses only some of the goods or services within one class) covered by the international registration. Rule 27bis enables the holder to take advantage of division by opting to turn the accepted or refused classes (or goods or services) into a new international registration (the divisional registration or the child) that will be given the same number as the original registration, together with a capital letter. As a result, the international registration containing the acceptable classes (or goods or services) may proceed to protection without further delay, enabling the holder to deal with the objectionable classes (or goods or services), in the divisional registration at a later stage. It may be the holder's preference to turn the refused classes (or goods and services) into the divisional registration, especially if the international registration contains other designations.

578. The Office concerned may examine the request for division of an international registration to ensure that it meets the requirements of its applicable law, before presenting it to the International Bureau. The Office concerned may also request a fee for processing the divisional request. This fee is separate to the fee to be paid to WIPO, and would be payable directly with the Office concerned.

579. It is important for the holder to check with the relevant Office of the designated Contracting Party whether such request for division is possible. A number of Contracting Parties have notified the International Bureau that they will not present requests for division (Rule 27bis(6) or Rules 40(6) and 27bis(1)). Any such notification received by the International Bureau is published in the Gazette and on WIPO's website (<https://www.wipo.int/madrid/en/members/declarations.html>).

Official Form

580. The request for the division must be presented to the International Bureau on the official form (MM22) established by the International Bureau or on a form having the same contents and format. [Rule 27bis(1)(a)] [A.I. Section 2]

Item 1: Contracting Party of the Office Presenting the Request

581. The name of the Contracting Party in respect of which the international registration is to be divided should be given. [Rule 27bis(1)(b)(i)]

Item 2: Name of the Office Presenting the Request

582. The name of the Office of the Contracting Party indicated in item 1 should be given. [Rule 27bis(1)(b)(ii)]

Item 3: International Registration Number

583. The number of the international registration concerned should be indicated. [Rule 27bis(1)(b)(iii)]

Item 4: Name of the Holder

584. The name of the holder must be the same as the name recorded in the International Register. [Rule 27bis(1)(b)(iv)]

Item 5: Goods and Services for Which Division is to be Recorded

585. The goods and services to be set apart in the divisional international registration must be indicated and grouped in the appropriate classes of the International Classification of Goods and Services. If necessary, a continuation sheet should be used and the appropriate box should be checked. [Rule 27bis(1)(b)(v)]

Item 6: Signature of the Holder and/or Their Representative

586. The Office may require or permit the holder or the representative to sign the form. The International Bureau will not question the absence of a signature from this item. [Rule 27bis(1)(c)]

Item 7: Statement

587. The Office presenting a request under Rule 27bis may also include in or send with the request either a statement of interim status of the mark under Rule 18bis (see paragraphs 395 to 400) or a statement of grant of protection under Rule 18ter(1) or (2) (see paragraphs 403 to 409) in respect of the goods and services listed in the request. This should be indicated by checking the appropriate box. [Rule 27bis(1)(d)]

Item 8: Signature of the Office Presenting the Request

588. The request must be signed by the Office presenting the request to record a division. [Rule 27bis(1)(c)]

Payment Information

See the general remarks concerning payment of fees to the International Bureau (paragraphs 154 to 167).

589. A request to record a division is subject to the payment of the fee specified in the Schedule of Fees. The payment of 177 Swiss francs may be made by any of the means listed in the payment information in the form. The most convenient method of payment is to instruct the International Bureau to debit the required amount from a current account. Where the fees are paid other than by debit from an account with the International Bureau, the method of payment and the person (holder, representative or Office) making the payment, or giving the instructions for payment should be indicated in the form. [Rule 27bis(1)(b)(vi) and (2)]

Irregular Request

590. The International Bureau will examine the request to determine whether it meets the requirements prescribed in amended Rule 27bis. If the request is irregular, the International Bureau will notify the Office that presented the request, as well as the holder. If the irregularity concerns insufficient payment of the fee due to the International Bureau, the holder would have three months to pay the outstanding balance directly to the International Bureau. Regarding any other irregularity, the Office will need to remedy the request within three months. If the irregularity is not remedied, the request will be considered abandoned and the International Bureau will refund any fee paid, after the deduction of an amount corresponding to one-half of the fee. [Rule 27bis(3)]

Recording, Notification and Publication

591. Where the request complies with the applicable requirements, the division of the international registration will be recorded with the date on which the International Bureau received the request or, where the request was irregular, the date on which the irregularity was remedied. However, the effective date of the divisional registration will be the same as the original international registration. Therefore, it follows that the renewal date of the divisional international registration will also be the same as the original international registration (the parent), and not the recorded date of the request for division. [Rule 27bis(4)(a)]

592. Following the recording of division, the International Bureau will create a divisional international registration for the goods and services specified in the request and with the Contracting Party concerned as the sole designated Contracting Party, notify the Office that presented the request and inform the holder. The part which has been divided will be recorded as a separate international registration, which will bear the same number as the registration of which a part has been divided, together with a capital letter. The publication in the Gazette consists of the part of the international registration which has been divided. [Rule 27bis(4)(b)] [A.I. Section 16] [Rule 32(1)(a)(viii**bis**)]

593. 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 Nice Classification mentioned in the request will not be considered as such. [Rule 27bis(5)]

594. For more information on division of international registrations, see Information Notice No. 21/2018 (https://www.wipo.int/edocs/madrdocs/en/2018/madrid_2018_21.pdf).

Merger of International Registrations

595. It is possible to request the merger of international registrations resulting from:

- the recording of a partial change in ownership; and
- the recording of division.

It is only possible to merge two or more international registrations that were separated from the same international registration due to a partial change in ownership or a division. It is not possible to merge international registrations that originated as separate international applications.

596. All provisions dealing with the merger of international registrations are consolidated in amended Rule 27ter.

Request for Merger of International Registrations Resulting From the Recording of a Partial Change in Ownership

597. Rule 27ter(1) deals with merger of international registrations resulting from the recording of a partial change in ownership. [Rule 27ter(1)]

598. A request for the merger of an international registration may be submitted to the International Bureau directly or through the Office of the Contracting Party of the holder.

599. Where the same party has been recorded as the holder of two or more international registrations of the same mark resulting from a partial change in ownership, that party may request the International Bureau to record the merger of the international registrations. [Rule 27(3)]

600. Two or more international registrations may be merged in this way only when they result from the splitting of a single international registration because of a partial change in ownership (see paragraph 567); there is no provision for the merging of international registrations which have come into the same ownership where they resulted from separate international applications.

Official Form

601. The request for the merger of international registrations resulting from the recording of a partial change in ownership must be presented to the International Bureau on the official form (MM23) established by the International Bureau or on a form having the same contents and format. [Rule 27ter(1)] [A.I. Section 2]

Item 1: Name of the Holder

602. The name of the holder must be the same as the name recorded in the International Register for all the international registrations requested to be merged.

Item 2: International Registration Numbers

603. The number of all the international registrations to be merged should be indicated.

Item 3: Signature of the Holder and/or Their Representative

604. Where the request is presented directly to the International Bureau, it must be signed by the holder or the recorded representative.

Item 4: Office of the Contracting Party of the Holder Presenting the Request

605. Where the request to record the merger is presented through the Office, the request must be signed by that Office.

Request for Merger of International Registrations Resulting From the Recording of Division

606. It is possible to request the merger of international registrations resulting from the recording of division. A divisional international registration may only be merged with the international registration from which it was divided.

607. It is important for the holder to check with the relevant Office of the designated Contracting Party whether requests for merger are possible. A number of Contracting Parties have notified the International Bureau that they will not present requests for merger (Rule 27ter(2)(b) or Rules 40(6) and 27ter(2)(a)). Any such notification received by the International Bureau is published in the Gazette and on WIPO's website (<https://www.wipo.int/madrid/en/members/declarations.html>).

Official Form

608. The request for the merger of international registrations resulting from the recording of division must be presented to the International Bureau on the official form (MM24) established by the International Bureau or on a form having the same contents and format. [Rule 27ter(2)(a)] [A.I. Section 2]

Item 1: Name of the Holder

609. The international registration resulting from the recording of division (divisional international registration) and the international registration from which it was divided (parent international registration) must both be in the name of the same person).

Item 2: International Registration Number

610. The number of the international registration resulting from the recording of division to be merged with the international registration from which it was divided should be indicated.

Item 3: Signature of the Holder and/or Their Representative

611. The Office may require or permit the holder or the representative to sign the form. The International Bureau will not question the absence of a signature from this item.

Item 4: Office Presenting the Request

612. The request to record a merger of international registrations resulting from the recording of division must be presented through the Office that requested the recording of the division of the international registrations in the first place. The request must be signed by that Office.

Recording, Notification and Publication

613. When a request for merger meets the applicable requirements, the International Bureau will record the merger of the international registrations concerned, notify the Office of that presented the request and inform the holder. The relevant data are published in the Gazette. [Rule 27ter(1) and (2)(a)] [Rule 32(1)(a)(viii**bis**)]

614. The international registration resulting from the merger will bear the number of the international registration of which a part had been assigned or divided, together, where applicable, with a capital letter. The following examples may explain this: [A.I. Section 17]

- if all or some of the assigned parts of the international registration (recorded under the original number plus a letter) are merged with the original international registration (still recorded under its original number without a letter), the resulting international registration will bear the number of the original international registration (i.e. without a letter);
- if all or some of the assigned or divided parts of the international registration (each recorded under the original number plus a letter) are merged amongst themselves and each of the assigned or divided parts covers the same goods and/or services, the resulting international registration will bear the number of the original international registration together with the capital letter used earlier in respect of the first assigned part;
- if all or some of the assigned or divided parts of the international registration (each recorded under the original number plus a letter) are merged amongst themselves, but the assigned divided parts do not cover the same goods and/or services, the resulting international registration will bear the number of the original international registration together with the next capital letter (in the alphabetical order) not previously used in conjunction with the number of the international registration concerned.

615. For more information on merger of international registrations resulting from division, see Information Notice No. 21/2028 (https://www.wipo.int/edocs/madrdocs/en/2018/madrid_2018_21.pdf).

Corrections in the International Register

616. Where the International Bureau considers that there is an error concerning an international registration in the International Register, it corrects that error *ex officio*. It will also correct such an error on request of the holder or of an Office. [Rule 28(1)]

617. Before giving effect to a request for the correction of an error, the International Bureau must be satisfied that the International Register is in fact incorrect. Its practice is as follows:

- (a) where there is a discrepancy between what is recorded in the International Register and the documents filed with the International Bureau, that is to say there has been a mistake on the part of the International Bureau, the error will be corrected without further question;
- (b) where there is an obvious error in the International Register and the correction sought is likewise obvious, in the sense that a reader would recognize that there was an error and that nothing else could have been intended other than what is offered as the correction, the error will be corrected as soon as it comes to the attention of the International Bureau;

- (c) where there is an objective error in a fact recorded in the International Register, for example, where there are typographical errors in a name or address or in a date or number as recorded, this may in general be corrected; where the error results from a discrepancy between a document filed with the International Bureau and what is recorded in the register of a Contracting Party, the request for correction should be submitted by the Office of that Contracting Party;
- (d) in any other case, in particular where the request is for a change in the list of designated Contracting Parties or the list of goods and services, this cannot be treated as the correction of an error in the International Register unless there has been a mistake by the Office by which the document containing the error was presented to the International Bureau; a request for a correction of this kind must therefore be submitted to the International Bureau by the Office concerned. Where the list of designated Contracting Parties or the list of goods and services as recorded in the International Register corresponds to what was submitted to the Office concerned by the applicant or holder or his or her representative, there is not an error in the International Register. It follows that mistakes made by an applicant, holder or representative in indicating the designated Contracting Parties or in the list of goods and services cannot be corrected under Rule 28.

618. 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 erroneous entry in the International Register. This time limit does not apply to errors made by the International Bureau, since the document on which the entry containing the error was based has always been in the custody of the International Bureau. [Rule 28(4)]

619. Where an error in the International Register has been corrected, the International Bureau notifies 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 will also inform that Office. The correction is also published in the Gazette. [Rule 28(2)] [Rule 32(1)(a)(ix)]

Optional Form

620. The request for the correction of a recording may be presented to the International Bureau on the optional form (MM21) established by the International Bureau. [Rule 28] [A.I. Section 3]

Item 1: International Registration Number

621. The number of the international registration should be indicated.

Item 2: Reference Number

622. If the holder or his or her representative requests the correction, the WIPO reference number should be indicated. If the Office requests the correction, the WIPO notification number should be indicated.

Item 3: Description of the Requested Correction

623. The details of the error to be corrected should be described.

Item 4: Presentation and Signature

624. The form must indicate who is presenting the form (the holder, the representative of the holder or the Office), the signature and e-mail address.

Refusal Following a Correction

625. Any Office so notified of a correction may declare in a notification to the International Bureau that protection cannot, or can no longer, be granted to the international registration as corrected. This may be done where there are grounds for refusal of the international registration as corrected, which did not apply to the international registration as originally notified to the Office concerned. [Rule 28(3)]

626. Articles 5 and 9*sexies* of the Protocol and Rules 16 to 18*ter* apply *mutatis mutandis* to the notification of refusal of the effects of a correction, and in particular to the time limits for notifying such a refusal (see paragraphs 361 to 372). Such time limits are to be counted from the date of sending the notification of the correction to the Office concerned.

No Other Change in the International Register

627. No other changes affecting the mark that is the subject of an international registration may be recorded in the International Register (see however, below, the section entitled “Facts in Contracting Parties Affecting International Registrations” as regards the recording of such facts in the International Register).

628. In particular, there is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form that differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic mark where such change is possible according to the law of the Contracting Party whose Office is the Office of origin. This does not mean that, where the holder is now using the mark in a form that differs from that recorded in the International Register, it is indispensable for him or her to file a new international application. The holder may rely on Article 5C(2) of the Paris Convention, according to which use of the mark in a form that differs from the mark as registered in respect of elements which do not affect the distinctive character of that mark does not entail invalidation and does not diminish the protection of the international registration in the designated Contracting Parties.

629. It is not possible to extend the list of goods and services of the international registration. If the holder wishes to protect the mark for additional goods and services, the holder must file a new international application. This is true even if those goods and services were included in the basic mark; that is, they could have been included in the original international application but were omitted from it.

RENEWAL OF INTERNATIONAL REGISTRATION

630. The registration of a mark at the International Bureau is effected for a period of 10 years from the date of the international registration. It is then renewable for a further 10 years upon payment of the required fees. Please remember that an international registration cannot be renewed until **all** the required fees are paid **in full**. [Article 6(1)] [Article 7(1)]

Renewal Following Refusal, Renunciation or Invalidation

631. Rule 30 provides holders of international registrations with a simplified renewal of international registrations.

632. International registrations will be renewed in respect of a designated Contracting Party for all the goods and services not affected by limitation, partial invalidation or partial cancellation. It is not possible to renew the international registration for goods and services that have been cancelled or for designated Contracting Parties for which total invalidation or renunciation has been recorded.

633. Holders have the options of not renewing an international registration in respect of some of the designated Contracting Parties, or renewing it in respect of designated Contracting Parties that have refused protection for all goods and services in a statement under Rule 18*ter* of the Regulations.

634. For Contracting Parties that have declared for an individual fee per class, the renewal fee would be calculated taking into account only the number of classes for which protection has been granted in a statement recorded under Rule 18*ter* of the Regulations (final or further decision). [Rule 18*ter*(1), (2) or (4)].

635. Upon renewal, holders of international registrations who have been granted partial protection in a statement under Rule 18*ter* of the Regulations and are appealing such decision would no longer be required to pay individual fees for classes that are not protected. Consequently, the Online Renewal options and the renewal form MM11 have been amended (removing former item 4).

636. Where a designated Contracting Party that has declared for an individual fee per class informs in a further statement under Rule 18*ter* of a change in the goods and services protected, the next renewal fee in respect of that Contracting Party would then be calculated in accordance with this further statement.

637. It is possible to renew the international registration for designated Contracting Parties that have refused protection for all goods and services in a final decision under Rule 18*ter*. Rule 30(2)(b) clarifies that the international registration must be renewed in respect of that designated Contracting Party for all the goods and services concerned. The Contracting Parties concerned must be indicated in the Online Renewal or in item 3 of the form MM11 and the corresponding fees for all the goods and services for which that Contracting Party remains designated (i.e., those goods and services not affected by a limitation, a partial invalidation or a partial cancellation) must be paid.

638. Where a Contracting Party has issued a provisional refusal under Rule 17 of the Regulations, which has not yet been confirmed under Rule 18*ter*, and the holder wishes to renew the international registration also for this Contracting Party, the international registration would need to be renewed for all the goods and services covered by the international registration for that Contracting Party concerned.

639. Following the above, the renewal fee for designated Contracting Parties that have declared for an individual fee per class and have refused protection for all goods and services must be calculated taking into account the number of classes corresponding to all the goods and services not affected by limitation, partial invalidation or partial cancellation.

640. Changes to the goods and services for which protection has been granted in a designated Contracting Party will not have retroactive effect on renewal fees that have already been paid in accordance with Rule 34(6)(a) of the Regulations.

641. The situation is different with respect to an invalidation since the recording of an invalidation in the International Register must mean that the invalidation is no longer subject to appeal. The international registration therefore may not be renewed with respect to a Contracting Party for which a total invalidation has been recorded or with respect to a Contracting Party for which a renunciation of protection has been recorded. Furthermore, in the case of a partial invalidation, a limitation of the list of goods and services with respect to a particular Contracting Party, or a partial cancellation with respect to all designated Contracting Parties, a renewal may not be effected with respect to those goods and services to which the invalidation, limitation or cancellation relate. [Rule 19(1)] [Rule 30(2)(c)]

Procedure for Renewal

642. Six months before expiry of each 10-year term of protection, the International Bureau, by sending an unofficial notice, reminds the holder of the international registration and the holder's representative (if any) of the exact date of expiry. If the holder (or representative) does not receive such unofficial notice, this does not constitute an excuse for failure to comply with any time limit for payment of the fees due. [Article 7(3)] [Rule 29]

643. Since renewal is considered to be a simple prolongation of the period of protection of the international registration against payment of the necessary fees, it may not include any change in relation to the international registration in its latest form, that is at the expiry of the current period of protection. Therefore, no change in the name or address of the holder or in the list of goods and services may be made as part of the renewal procedure. Any changes to the international registration that the holder wishes to have recorded in the International Register when the registration is renewed must be communicated separately to the International Bureau according to the applicable procedures. They will be included in the data recorded at renewal only if they are recorded in the International Register not later than the date of expiry of the international registration. [Article 7(2)]

644. The fact that the international registration may be renewed for some only of the Contracting Parties covered is not regarded as a change to the international registration under Article 7(2) of the Protocol [Rule 30(2)(a)] [Rule 30(2)(e)]

645. No official form is prescribed for the renewal of an international registration. Renewal may be effected by any communication giving the necessary information (number(s) of the international registration(s) concerned and purpose of the payment). It is recommended that the Online Renewal tool is used when paying the renewal fees with a credit card or debiting them from a WIPO current account. Online Renewal is available at: <https://www3.wipo.int/authpage/signin.xhtml?goto=https%3A%2F%2Fwww3.wipo.int%3A443%2Fmadrid%2Frenewal%2F>. Holders may alternatively use the optional form MM11, which is available on WIPO's website (<https://www.wipo.int/madrid/en/forms/>). This form provides for indications of:

- the number of the international registration to be renewed (item 1);

- the name of the holder, which must be the same as the one recorded in the International Register (item 2);
- all the Contracting Parties for which the renewal is requested, including, if the holder so wishes, the Contracting Parties in respect of which a partial or total refusal is recorded in the International Register (item 3);
- the signature of the holder or their representative or of the Office through which the request for renewal is presented (new item 4);
- the fees being paid and the method of payment, or instructions to debit the required fees from an account with the International Bureau (Fee Calculation Sheet).

Fees for Renewal

646. The fees due for the renewal of an international registration consist of: [Rule 30(1)] [Article 7(1)] [Article 9*sexies*]

- the basic fee;
- an individual fee for the designation of each designated Contracting Party that has made the relevant declaration (see paragraph 294), except where that designated Contracting Party is a State bound by both the Protocol and the Agreement and the Office of origin is the Office of a State bound by both the Protocol and the Agreement (in respect of such a designation, a complementary fee is payable);
- for each designated Contracting Party for which no individual fee is payable, a complementary fee;
- for each class of goods and services in excess of three, a supplementary fee; where however all the designated Contracting Parties are ones in respect of which an individual fee is payable, no supplementary fees are payable.

647. It is recalled that Article 9*sexies*(1)(b) of the Protocol provides for a derogation from the liability to pay individual fees in the mutual relations between States that are both party to the Agreement and to the Protocol. Thus, if the State whose Office is the Office of origin is party to both treaties and the international registration contains the designation of a Contracting Party that is also bound by both treaties, then, notwithstanding the fact that the latter may have opted for individual fees, by virtue of Article 9*sexies*(1)(b), the standard fees only will be payable to that Contracting Party. If, in due course, a change in ownership is recorded in respect of that international registration and the new owner claims entitlement to be recorded as owner through a connection with a Contracting Party that is bound only by the Protocol, then, there will be a change in the fee regime on the renewal of that international registration. Whereas, previously, the derogation provided for in Article 9*sexies*(1)(b) would have applied, it will no longer do so, and individual fees will be payable on renewal. [Rule 1*bis*]

648. The Fee Calculator on the Madrid System page of WIPO's website may be used to calculate the fees payable for the renewal of an international the registration (<https://www.wipo.int/madrid/feescalculator/>).

649. The fees should be paid to the International Bureau by, at the latest, the date of expiry. The earliest the holder may pay the renewal fees is three months before the due date. The payment can still be made up to six months after the date on which the renewal was due, provided that a surcharge (which amounts to 50% of the basic fee for renewal) is paid at the same time. [Article 7(4)]

650. Where the amount of a renewal fee changes between the date on which the fee was paid to the International Bureau and the date on which renewal is due, [Rule 34(7)(d)]

- where payment is made not more than three months before the date on which renewal is due, it is the fee that was valid on the date of payment that is applicable;
- where the renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable.

651. The fees may be paid directly to the International Bureau by the holder. Where the Office of the Contracting Party of the holder agrees to collect and forward such fees, the fees may instead be paid through that Office. The holder cannot, however, be required to pay through an Office. Payment of renewal fees may be made by bank transfer, credit card or through a WIPO current account (see paragraph 97 and 158).

652. It is recommended that WIPO's Online Renewal tool is used when paying the renewal fees with a credit card or debiting them from a WIPO current account. Online Renewal is available at: <https://www3.wipo.int/madrid/renewal>.

653. Where the Office of origin accepts to collect the renewal fees and forward them to the International Bureau, that Office may fix, at its own discretion, and collect, for its own benefit, a handling fee for this service. [Article 8(1)]

Insufficient Fees Paid

654. If the amount of the fees received is less than the amount of the fees required, the International Bureau will notify both the holder and the representative, if any, and specify the missing amount. If the fees have been paid by a party other than the holder, the representative or an Office, the International Bureau will inform accordingly that other party. [Rule 30(3)(a)]

655. If the amount received, after the expiry of the period of six months following the date on which renewal was due, is less than the amount required (including the surcharge for late payment), the renewal will not be recorded. The International Bureau will reimburse the amount received to the party that paid it and will notify the holder and the representative accordingly. [Rule 30(3)(b)]

656. There is an exception, however, to the rule just explained. Where the notification of insufficient fees paid referred to in paragraph 654 was sent less than three months before the expiry of the six-month period, and the amount paid by the end of that period is at least 70% of the amount due, the International Bureau will proceed to renew the international registration. If, however, the full amount is not paid within three months of the notification, the International Bureau will cancel the renewal and reimburse the amount paid. [Rule 30(3)(c)]

657. Where the amount paid is insufficient, the holder may, instead of paying the missing amount, ask for some of the designated Contracting Parties to be omitted, thereby reducing the amount due. This request must be made within the time within which the missing payment would have had to be made.

Recording of the Renewal; Notification, Certificate and Publication

658. The International Bureau records the renewal of the international registration in the International Register, with the date on which it was due, even if the fees required were paid within the grace period of six months after the due date. [Rule 31(1)]

659. The effective date of the renewal is the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register. [Rule 31(2)]

660. Where the international registration has been renewed, the International Bureau so notifies the Offices of the designated Contracting Parties concerned and sends a certificate to the holder. [Rule 31(3)]

661. Where an international registration is not renewed in respect of a given designated Contracting Party, the International Bureau notifies accordingly the holder, the representative, if any, and the Office concerned. [Rule 31(4)(b)]

662. Where an international registration has been renewed, the relevant data concerning the renewal are published in the Gazette. The publication is in effect a re-publication of the international registration, in the form at which it stands after renewal. [Rule 32(1)(a)(iv)]

663. In general, the recording and publication will be in English, French and Spanish. However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of the first subsequent designation: [Rule 6(3)] [Rule 40(4)]

- if governed exclusively by the Agreement, French will continue as the sole language for the recording of a renewal.
- if governed wholly or partly by the Protocol, French and English will continue as the languages of renewal.

For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of the first subsequent designation:

- if governed exclusively by the Agreement, then, as above, French will continue as the sole language for the recording of renewals. (Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004, and will therefore be renewed in all three languages (see also paragraphs 150 to 153)).

664. An Office which is notified of the renewal (or non-renewal) of an international registration need take no action, beyond amending any records which it keeps for its own use.

Complementary Renewal

665. Where an international registration has been renewed in respect of only some of the designated Contracting Parties and the holder decides, after the due date, to renew said registration in respect of a designated Contracting Party not covered by the renewal already effected, this may be done through a so-called “complementary renewal”, provided that the period of grace of six months (see paragraph 649) has not yet expired. The fees payable are the basic fee, a complementary or individual fee in respect of the Contracting Party concerned, and the surcharge.

Non-Renewal

666. If an international registration is not renewed (because the holder did not pay the renewal fees or because the fees paid were not sufficient), it lapses with effect from the date of expiry of the previous period of protection.

667. Where the international registration has not been renewed, that fact is notified to the holder, the representative, if any, and the Offices of the designated Contracting Parties and is published in the Gazette. The publication consists simply of the number of the international registration and the date on which renewal was due. The notification and publication are not made until there is no longer any possibility that the international registration might be renewed, that is, it is after the expiry of the period of six months after the due date (within which period renewal was possible upon payment of a surcharge). Where the renewal has been canceled for lack of payment of the balance of renewal fees (see paragraph 655 to 657), that fact is also published in the Gazette. [Rule 31(4)(a)] [Rule 32(1)(a)(xii)]

668. Where the required renewal fees have not been paid by the due date, no subsequent designation and no changes may be recorded in the International Register during the period of six months after the due date within which renewal remains possible upon payment of a surcharge. It is only after renewal has been recorded in the International Register that the subsequent designation or the change may be recorded in the Register.

DEPENDENCE AND INDEPENDENCE

Ceasing of Effect During the Dependency Period

669. For a period of five years from the date of the international registration, the protection resulting from the international registration remains dependent on the mark registered or whose registration has been applied for with the Office of origin (basic application, registration resulting therefrom, or basic registration). The protection resulting from the international registration may no longer be invoked if, or to the extent that, the basic registration, or the registration resulting from the basic application is canceled, renounced, revoked, invalidated or has lapsed, or if the basic application is the subject of a final decision of rejection or is withdrawn, either within that five-year period or as a result of an action commenced within that period.

670. This dependence is absolute, and is effective regardless of the reasons why the basic application is rejected or is withdrawn or the basic registration ceases to enjoy, in whole or in part, legal protection. The process by which an international registration may be defeated for all countries in which it is protected, by means of a single invalidation or revocation action against the basic registration has become generally known by the term “central attack”.

671. There is an increased risk of the holder who chooses to base an international registration on an application with the Office of origin losing his or her protection as a result of the basic application ceasing to have effect. This need not be the result of a “central attack”, in the sense of an action brought by a third party. The basic application may be refused protection, totally or partially, on absolute grounds or because of the existence of a prior right cited *ex officio* in the examination procedure, or as a result of an opposition by the holder of such earlier right in that territory. In all these cases, and provided the decision in respect of the basic application is final (that is, no longer subject to review or appeal), the Office of origin is required to request the International Bureau to cancel the international registration, either totally or partially.

672. To soften the consequences of the five-year dependency feature of the Madrid System, the Protocol provides for an opportunity for the holder of an international registration which is canceled as a result of the ceasing of effect of the basic mark to continue securing protection in the designated Contracting Parties. Using this transformation procedure, the holder must apply for protection of the same mark directly before the Offices of all Contracting Parties where the international registration had effect, within three months of the date of the recording of the cancellation of the international registration in the International Register. The national or regional applications resulting from this so-called “transformation” are treated as if they had been filed on the date of the original international registration, or on the date of the subsequent designation, as the case may be. (For details, see paragraphs 698 to 703).

673. Although an international application must be filed by the person who is the holder of the national or regional registration or application on which it is based, the validity of an international registration is not affected if it and the national or regional registration or application subsequently become owned by different persons. It does not even matter if the national or regional application or registration is transferred to a person who would not qualify to be the holder of an international registration. Since the international registration continues to be dependent on the fate of the basic mark, the holder of an international registration runs a risk if, during the five-year dependency period, he or she does not control the basic mark (see paragraph 691).

674. At the end of the five-year dependency period, the international registration becomes independent of the basic mark (subject to paragraphs 675 to 677). It should be noted that there is no separate dependency for subsequent designations; the only dependency period is the one which runs from the date of the international registration. [Article 6(2)]

Ceasing of Effect of the Basic Application or Registration

675. The protection resulting from the international registration may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom or the basic registration no longer enjoys legal protection because it: [Article 6(3)]

- has been withdrawn;
- has lapsed;
- has been renounced; or
- has been the subject of a final decision of rejection, revocation, cancellation or invalidation.

Where the ceasing effect of the basic mark is in respect of only some of the goods or services listed in the international registration, the protection of the international registration is restricted accordingly.

676. This provision applies also when legal protection (resulting from international registration) has later ceased as the result of an action begun before the expiry of the period of five years. The same rules apply if:

- an appeal lodged within the five-year period against a decision refusing the effects of the basic application,

- an action started within the five-year period requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
- an opposition to the basic application which is filed within the five year period, results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, the registration resulting therefrom or the basic registration, as the case may be.

677. Furthermore, the same rules apply if the basic application is withdrawn, or the registration resulting therefrom or the basic registration is renounced, after the expiry of the five-year period, in a case where, at the time of the withdrawal or renunciation, the application or registration was the subject of one of the proceedings referred to in paragraph 676, such proceeding having begun before the expiry of the five-year period. This provision prevents the holder of an international registration from frustrating the effects of central attack, when his or her basic application, the registration resulting therefrom or the basic registration has come under attack within the five-year period of dependency, by abandoning that application or registration after the end of that period but before an Office or a court has given a final decision on the matter.

Procedure for Notification of Ceasing of Effect

678. Where the basic mark has ceased to have effect within the five-year period of dependency, the Office of origin notifies the International Bureau the following facts and decisions: [Rule 22(1)(a)]

- the basic application is refused *ex officio* before the end of the period of five years from the date of the international registration, or such a refusal becomes final (for example, following an appeal) after the expiry of that period;
- the basic application is refused as a result of an opposition which was begun before the expiry of that five-year period, whether or not such refusal becomes final before the end of that period;
- the basic application has been withdrawn following a request made before the expiry of the five-year period;
- the basic application has lapsed because of some event (for example, failure to comply with a procedural requirement of the Office of origin) before the expiry of the five year period, even if a decision concerning the lapsing of the application becomes final only after the end of that period;
- the basic registration (or the registration resulting from the basic application) is renounced, canceled, revoked or declared to be invalid following a request made (whether by the holder or by another party) before the end of the five-year period, even if the renunciation, cancellation, revocation or invalidation becomes effective or final only after the expiry of that period;
- the basic registration (or the registration resulting from the basic application) has lapsed (for example, because of failure to pay renewal fees) before the end of the five-year period, even if a decision concerning the lapsing becomes final only after the end of that period.

679. Such notification must indicate the number of the international registration concerned and the name of the holder. The notification must also indicate the facts and decisions affecting the basic application (or the registration resulting therefrom) or the basic registration, and the effective date of those facts and decisions. By an indication of the facts and decisions is meant some statement such as: [Rule 22(1)(a)]

- application number [###] has been refused by a decision of the [name of Office] dated [date]; the period allowed for filing an appeal against this decision expired on [date];
- application number [###] has been withdrawn following a request dated [date];
- registration number [###] ceased on [date]; the period within which the registration could be restored expired on [date];
- by a decision of the [name of court] dated [date], registration number [###] was revoked with effect from [date]; the period allowed for filing an appeal against this decision expired on [date].

There is no need for the Office of origin to give the International Bureau any indication of the grounds for the refusal or other decision.

680. Where these facts and decisions affect only some of the goods and services covered by the international registration, the notification must indicate which goods and services are affected or which goods and services are not affected. The obligation of the Office of origin to notify relates to relevant facts and decisions; where therefore a refusal, withdrawal, cancellation etc., affects the basic mark only in respect of goods and services which are not covered by the international registration, no notification should be sent to the International Bureau. [Rule 22(1)(a)(iv)]

681. In general, the notification may be in English, French or Spanish, at the option of the Office making the communication. However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of the first subsequent designation: [Rule 6(2)]

- if governed exclusively by the Agreement, French will continue as the sole language of notification. [Rule 6(2)(i)]
- if governed wholly or partly by the Protocol, French or English will continue as the languages of notification. [Rule 6(2)(i)]

For international registrations resulting from applications filed between April 1, 2004, and August 31, 2008, and pending the recording of the first subsequent designation: [Rule 40(4)]

- if governed exclusively by the Agreement, then, as above, French will continue as the sole language of notification. (Registrations resulting from applications filed during this period and governed wholly or partly by the Protocol will enjoy the full trilingual regime, following the introduction of Spanish as from April 1, 2004 (see also paragraphs 150 to 153).

682. The notification should not be sent until it is clear that there is no possibility of the ceasing of effect being reversed (but see also paragraph 683). For example, in the case of an administrative or judicial decision, the notification should not be sent until any appeal has been decided or until the period allowed for filing an appeal has expired. In particular, in the case of ceasing of effect of the registration resulting from the basic application or of ceasing of effect of the basic registration for failure to pay renewal fees, the notification should not be sent until any period of grace allowed for late payment, or for applying for restoration of the registration has expired.

683. Where however the Office of origin is aware that any of the following is pending at the end of the period of five years from the date of the international registration: [Rule 22(1)(b)]

- a judicial action concerning the basic registration;
- an appeal against a decision refusing the basic application;
- an action requesting withdrawal of the basic application;
- an opposition to the basic application;
- an action requesting the revocation, cancellation or invalidation of the basic registration, or of the registration resulting from the basic application, it should notify accordingly the International Bureau as soon as possible. Such notification should make clear that the action in question has not yet resulted in a final decision.

684. Where the Office of origin has sent a preliminary notification as referred to in paragraph 683, the Office should, once the decision has become final, promptly notify the International Bureau accordingly. Where the Office is not directly notified of the decision (where, for example, the decision is given by a court or similar authority), the Office should notify the International Bureau as soon as it becomes aware of the decision. For example, the Office may be informed about the decision by the holder or by another party to the proceedings. Rule 22(1)(c) provides that the Office of origin must follow up all completed decisions on ceasing of effects and notify the International Bureau of any decision it is aware of, or at the request of the holder. Recordings in the International Register will thus be confirmed, modified or withdrawn accordingly, and greater clarity and more complete information on the history of the mark will be available. [Rule 22(1)(c)]

685. Where applicable, the Office of origin will request the International Bureau to cancel the international registration to the extent applicable (that is, for those goods and services with respect to which the basic mark has ceased to have effect). [Article 6(4)]

686. An Office can only notify the International Bureau if it is aware of the action in question. This will be the case if the action is before that Office or is an appeal against a decision of the Office. The Office will, however, not necessarily be aware of an action brought by a third party before a court. It may be expected, however, that, where the decision is one which adversely affects the basic mark, and which thus requires cancellation of the international registration, the party who brought the action will bring it to the attention of the Office.

687. The International Bureau records any notification in the International Register, and transmits copies of the notification to the holder and to the Offices of the designated Contracting Parties. Where the notification requests cancellation of the international registration, it will be so canceled, to the extent applicable; the International Bureau will notify accordingly the holder and the Offices of the designated Contracting Parties. Rule 22(2)(b) provides that the International Bureau must also cancel international registrations resulting from partial change in ownership or division recorded under the cancelled international registration, as well as those resulting from their merger. [Rule 22(2)] [Rule 22(2)(b)]

688. Any cancellation of the international registration will be published and recorded, with an indication of the date of the cancellation. Similarly, any notification that an action begun before the end of the five-year period of dependence is still pending at the end of that period will be published in the Gazette. [Rule 32(1)(a)(viii)] [Rule 32(1)(a)(xi)]

689. There is no official form for use by an Office of origin for requesting cancellation of an international registration. The form (MM8) for use by a holder for requesting cancellation should not be used by an Office. However, a Model Form (MF 9) is available for such notification on WIPO's website (https://www.wipo.int/madrid/en/contracting_parties/model_forms.html).

690. Where the notification does not comply with the requirements mentioned in paragraphs 679 to 682, the International Bureau will inform the Office which sent it that it cannot record the ceasing of effect until the notification is put in order.

Change in Ownership of the International Registration During the Dependency Period

691. A change in ownership of the international registration or the basic mark (or both) during the five-year period of dependence has no influence on the effects of that dependence. The international registration remains dependent on the protection of the basic mark in the Contracting Party whose Office is the Office of origin. Thus, for example, the international registration will cease to be protected if the basic registration or the registration resulting from the basic application is not renewed, or if the basic application is withdrawn or is refused by the Office of origin, even if it stands in the name of a person who is not the holder of the international registration. [Article 6(3)]

Division or Merger of the Basic Application, the Registration Resulting Therefrom, or the Basic Registration

692. It may be possible for a national or regional application or registration on which an international registration is based to be divided into several applications or registrations by distributing among them the goods and services listed in the initial application or registration, or for several basic applications or basic registrations to be merged into a single application or registration. Where this is done during the five-year period of dependence of the international registration, the Office of origin must notify the International Bureau accordingly. [Rule 23]

693. This notification must indicate: [Rule 23(1)]

- the number of the international registration concerned; where this is not yet available, the number of the basic application should be given instead (this will enable the International Bureau to identify the international registration concerned);
- the name of the holder or applicant;

- the number of each application resulting from the division of the basic application or the number of the application resulting from the merger.

694. Similarly, the Office of origin must notify the International Bureau of a division of the basic registration or merger of the basic registrations, or of the registration(s) which resulted from the basic application(s), during this five-year period. [Rule 23(3)]

695. The International Bureau records the notification in the International Register and notifies the division or merger to the Offices of the designated Contracting Parties and to the holder of the international registration. The relevant data are published in the Gazette. [Rule 32(1)(a)(xi)]

696. The entry in the International Register will only record the fact that the basic application or the basic registration has been divided or that the basic applications or basic registrations have been merged. It will not mention the goods and services covered by each application or registration resulting from the division. The full particulars of those applications and/or registrations may be obtained from the Office of origin.

697. Such division or merger has no legal effect on the international registration. The purpose of the notification by the Office of origin and its recording, notification and publication by the International Bureau is simply to provide the Offices of designated Contracting Parties and third parties with information concerning the situation of the basic mark during the period when the international registration is dependent on it. Such information is particularly pertinent in cases of third party central attack (see also paragraphs 670, 671 and 677).

Transformation

698. The effect of transformation of an international registration into one or more national or regional applications is that an application to the Office of a Contracting Party for the registration of a mark which was the subject of an international registration designating that Contracting Party will be treated by that Office as if it had been filed on the date of the international registration or, where that Contracting Party had been designated subsequently, the date of the subsequent designation. Where the international registration claimed priority, the national or regional application will benefit from that claim. [Article 9*quinquies*]

699. Transformation may take place only where the international registration has been cancelled, in respect of all or some of the goods and services, at the request of the Office of origin, as described in paragraphs 678 to 683. It is not available where the international registration has been canceled at the request of the holder in accordance with Rule 25 of the Regulations.

700. Transformation may take place with respect to any of the Contracting Parties in the territory of which the international registration had effect, that is any of the designated Contracting Parties in respect of which the international registration had not been the subject of a total refusal, invalidation or renunciation.

701. To benefit from this provision, the national or regional application must be filed within three months of the date of the recording of the cancellation of the international registration in the International Register. The goods and services listed in the application must have been covered by the list in the canceled international registration (or in the canceled part of the international registration) in respect of the Contracting Party concerned.

702. Apart from the special provisions regarding date, an application resulting from transformation is in effect an ordinary national or regional application. The application must be filed with the Office concerned. This filing is not governed by the Protocol or the Regulations, nor is the International Bureau involved in any way.

703. It is up to each Contracting Party to determine the modalities for giving effect to such transformation into a national or regional application. It may require that such an application comply with all requirements that apply to national or regional applications filed with its Office, for example, using a specific form through a local representative and payment of fees in local currency. The Office may require that the full amount of application and other fees be paid; alternatively, and particularly where the Office concerned has already received individual fees in respect of the international registration concerned, it may decide to provide for reduced fees in the case of such an application.

FACTS IN CONTRACTING PARTIES AFFECTING INTERNATIONAL REGISTRATIONS

704. The following paragraphs deal with facts in designated Contracting Parties other than the refusal of protection, which is covered in paragraphs 411 to 414.

Invalidation in a Designated Contracting Party

705. Invalidation, by the competent authorities of a Contracting Party, of the effects, in the territory of that Contracting Party, of an international registration may not be pronounced without the holder having, in good time, been afforded the opportunity of defending his or her rights. Proceedings concerning such invalidation take place directly between the holder of the international registration, the party who has brought the action for invalidation and the competent authority concerned (Office or court). It may be necessary for the holder to appoint a local representative. The proceedings are governed entirely by the law and practice of the Contracting Party concerned. [Article 5(6)]

706. The procedures and substantive law governing such invalidation should be the same as for marks registered by the Office of that Contracting Party. For example, the protection of the mark may be revoked because the holder has not complied with provisions of the law of the Contracting Party concerning the use of the mark, or because the mark has been allowed to become generic or misleading, or because it has been established (for example, in proceedings brought by a third party, or in a counterclaim in infringement proceedings) that protection ought to have been refused when the designation was originally examined.

707. Where the effects of an international registration are invalidated (in whole or in part) in a Contracting Party, and the invalidation is no longer subject to any appeal, the Office of that Contracting Party must notify the International Bureau of the relevant facts, namely: [Rule 19]

- the authority (for example, the Office or a particular court) which pronounced the invalidation, the date on which it was pronounced and the fact that it is no longer subject to appeal;
- the number of the international registration and the name of the holder;

- if the invalidation does not concern all the goods and services, those which are concerned (either by indicating those goods and services which are no longer covered or those which are still covered);
- the date on which the invalidation was pronounced and its effective date.

The International Bureau records the invalidation in the International Register, as of the date of receipt of a notification complying with the applicable requirements, together with the data contained in the notification, and informs accordingly the Office of origin, if that Office has informed the International Bureau that it wishes to receive such information, and the holder. It also publishes the invalidation in the Gazette. [Rule 32(1)(a)(x)]

708. In the Regulations, the term “invalidation” means any decision by a competent authority (whether administrative or judicial) of a designated Contracting Party revoking or canceling 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 that Contracting Party. For this reason, an Office should notify not only the date on which the invalidation was pronounced but also, wherever possible, the effective date of the invalidation. [Rule 1(xixbis)] [Rule 19(1)(vi)]

Restriction of the Holder’s Right of Disposal

709. The holder, 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. Such restriction may apply to the international registration as a whole or in respect of only some of the designated Contracting Parties; in the latter case, this should be specified in the information given to the International Bureau. Similarly, the Office of a designated Contracting Party may inform the International Bureau that the holder’s right of disposal has been restricted but, in this case, the information may only relate to a restriction in the territory of that Contracting Party. Such information should consist of a summary statement of the main facts concerning the restriction – for example, that it results from a court order concerning the disposal of the assets of the holder. This statement should be brief, and in a form suitable for recording in the International Register. Copies of court decisions or deeds should not be sent to the International Bureau. The International Bureau cannot, however, act on the basis of such information coming from a source other than the holder or an Office, for example, from a third party. [Rule 20(1)] [A.I. Section 2]

710. An example of a reason for such a restriction would be that the extension of the international registration in that Contracting Party has been given as security or is the subject of a right *in rem*, or that there is a court order concerning the disposal of the assets of the holder. However, this provision does not apply to licenses, which are the subject of a separate provision (see paragraphs 713 to 734).

711. Where the International Bureau has been informed of a restriction in accordance with this provision, the party that communicated the information should similarly inform the International Bureau of any partial or total removal of the restriction. [Rule 20(2)]

712. The International Bureau records any information communicated about restrictions and their removal in the International Register, as of the date of its receipt, provided that the communication complies with the applicable requirements and informs, accordingly, the holder, the Office of the Contracting Party of the Holder and the Offices of the designated Contracting Parties concerned. The information is also published in the Gazette. [Rule 20(3)] [Rule 32(1)(a)(xi)]

Licenses

713. Some Contracting Parties provide for the recording at the national level of licenses in respect of international marks, such recording then having the same legal effect as the recording of a license in respect of a national mark. However, it is possible for such licenses to be recorded in the International Register, thereby relieving holders of international registrations from the need to take such action with the Office of each Contracting Party in respect of which a license has been granted. Rule 20*bis* does not cover the recording of a sub-license.

Presentation of Request

714. A request to record a license may be presented to the International Bureau either directly by the holder or through the Office of the Contracting Party of the holder or a Contracting Party in respect of which the license is granted. The request must be signed by the holder or by the Office through which it is presented. No supporting documents, such as copies of the license agreement, should be sent to the International Bureau. [Rule 20*bis*(1)]

715. A licensee who wishes to have the license recorded in the International Register may ask the Office of the Contracting Party of the holder or the Office of a Contracting Party with respect to which the license is granted to present the request. That Office may take whatever measures it considers appropriate to verify that the person concerned is entitled to be recorded as a licensee. The International Bureau cannot, however, accept such a request from the licensee (who is a person unknown to the International Bureau) which is not signed by either the holder or an Office.

716. The request must be presented on the official form (MM13) and must indicate [Rule 20*bis*(1)(b)] [A.I. Section 2]

- the number of the international registration concerned,
- the name of the holder,
- the name and address of the licensee, given in accordance with the guidelines concerning the name and address of the applicant (paragraphs 216 and 217),
- the designated Contracting Parties with respect to which the license is granted,
- that the license is granted for all the goods and 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.

717. The above list is based on the indications or elements listed in Article 2 of the Joint Recommendation Concerning Trademark Licenses adopted by the General Assembly of WIPO and the Assembly of the Paris Union in September 2000¹¹, and in Rule 10 of the Regulations under the Singapore Treaty on the Law of Trademarks¹². Those indications or elements which do not appear pertinent in the framework of the recording of licenses at the international level have not been included.

718. The request may also indicate [Rule 20bis(1)(c)]

- where the licensee is a natural person, the State of which the licensee is a national,
- 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,
- that the license concerns only a part of the territory of a specified designated Contracting Party,
- where the licensee has a representative, the name and address of the representative, given in accordance with the Administrative Instructions,
- where the license is an exclusive license or a sole license, that fact¹³,
- where applicable, the duration of the license.

719. The list in paragraph 718 comprises additional elements, which may be required by some designated Contracting Parties with respect to which the license is granted.

720. The recording of a license is subject to the payment of the fee specified in the Schedule of Fees. It is possible for a single request to cover several international registrations in the name of the same holder where the facts to be recorded (licensee, Contracting Parties and goods and services concerned) are the same, though the fee of 177 Swiss francs will need to be paid for each international registration mentioned in the request.

Irregular Request

721. If the request for the recording of a license does not comply with the applicable requirements, the International Bureau will notify that fact to the holder and, if the request was presented by an Office, to that Office. [Rule 20bis(2)(a)]

722. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request will be considered abandoned, and the International Bureau will 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 to the party having paid those fees. [Rule 20bis(2)(b)]

¹¹ WIPO publication No. 835.

¹² WIPO publication No. 259.

¹³ Where there is no indication that a license is exclusive or sole, it may be considered that the license is non-exclusive (*interpretative statement endorsed by the Assembly of the Madrid Union when adopting Rule 20bis*).

723. If the holder has failed to comply with the time limit of three months to remedy an irregularity, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the failed time limit has ended. Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. In the case of continued processing, the date of recording of the license will be the date on which the time limit to comply with the corresponding requirement expired. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5*bis*] [Rule 20*bis*(3)]

Recording and Notification

724. Where the request complies with the applicable requirements, the International Bureau will record the license in the International Register, as of the date of receipt of a request complying with the applicable requirements, together with the information contained in the request, notify accordingly the Offices of the designated Contracting Parties in respect of which the license is granted and inform at the same time the holder and, if the request was presented by an Office, that Office. [Rule 20*bis*(3)]

Declaration that the Recording of a Given License Has No Effect

725. 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 the recording of that license has no effect in the said Contracting Party. Such a declaration may be made, on a case-by-case basis, where the law of the Contracting Party concerned recognizes the effects of licenses recorded in the International Register but there are objections with respect to a particular license, for example, on the ground that the public could be misled. [Rule 20*bis*(5)]

726. The declaration must 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.

727. The declaration must be sent to the International Bureau before the expiry of 18 months from the date on which the notification of the recording of a license was sent to the Office concerned. The International Bureau will record the declaration in the International Register, as of the date of receipt of a communication complying with the applicable requirements, publish the information in the Gazette and notify accordingly the party (holder or Office) that presented the request to record the license. Any final decision relating to a declaration should also be notified by the Office to the International Bureau, which will record it in the International Register and notify accordingly the party (holder or Office) that presented the request to record the license.

Declaration that the Recording of Licenses in the International Register Has No Effect in a Contracting Party

728. The Office of a Contracting Party whose law does not provide at all 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. [Rule 20*bis*(6)(a)]

729. The Office of a Contracting Party, whose law does provide for the recording of trademark licenses but does not recognize the effects of licenses recorded in the International Register, may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party. [Rule 20*bis*(6)(b)]

730. Any notification made as described in the above paragraphs is published in the Gazette and on WIPO's website (<https://www.wipo.int/madrid/en/members/declarations.html>).

Amendment or Cancellation of the Recording of a License

731. After the recording of a license, the holder may wish to amend some details concerning the license (for example, its duration). The request must be made on the official form (MM14). Paragraphs 714 to 718 apply. [Rule 20*bis*(4)] [A.I. Section 2]

732. Where a new licensee is to be recorded in respect of an international registration, this request is not considered as an amendment of a license but as a request for the recording of a new license and should be filed on form MM13.

733. A request for cancellation of the recording of a license must be made on the official form MM15.. Once the cancellation has been requested, the license will be removed from the International Register. There is no fee for the cancellation of the recording of a license.

734. Where several licenses are recorded in respect of a given international registration, any request to amend or cancel the recording of license should specify clearly and unambiguously to which license the request relates.

Replacement of National or Regional Registration by International Registration

What is Replacement?

735. Replacement was introduced in the Agreement in 1900, with the reasoning to relieve the holder from the burden of having to renew previous national registrations in one or several countries of the Madrid Union. Accordingly, the international registration benefits from the precedence of the previous national or regional registration, preserving all rights acquired by virtue of the latter.

736. This rather old feature was intended to make the centralized management of trademark portfolios under the Madrid System more efficient, as international registrations, under certain conditions, are deemed to replace national or regional registrations in designated Contracting Parties.

737. The terminology is somewhat misleading as there would not be any physical replacement in the national or regional registers, but this feature would allow the holder of an international registration to benefit from an earlier date of protection in a jurisdiction covered by an earlier national or regional right. The reference to the international registration being “deemed to replace the national or regional registration” does not mean that the national or regional registration is suspended or otherwise affected. This will remain on the register of the Contracting Party concerned, with all the rights attaching to such a registration, as long as it is renewed by the holder.

738. One international registration may replace more than one national or regional registration. This would typically be the case where the Contracting Party concerned used to have a single class system, meaning one national registration could only cover one class of goods and services, whereas the international registration can cover up to 45 classes of goods and services.

Legal Basis of Replacement

739. Replacement is set out in Article 4*bis* of the Protocol and in Rule 21 of the Regulations. Rule 21 of the Regulations was amended with effect from February 1, 2021¹⁴.

740. Article 4*bis* was adopted and included in the Agreement¹⁵ at the Brussels Diplomatic Conference, on December 4, 1900, which stated that “[w]hen a mark already deposited in one or more of the contracting States is subsequently registered by the International Bureau in the name of the same proprietor or his successor in title, the international registration shall be considered as replacing the earlier national registrations, without prejudice to any rights acquired by reason of such earlier registrations.”

741. Article 4*bis* of the Agreement has been slightly amended over the years, at the London Diplomatic Conference in 1934, at the Stockholm Diplomatic Conference in 1967, and at the Madrid Diplomatic Conference in 1989¹⁶.

742. While Article 4*bis*(1) of the Protocol is not identical to Article 4*bis*(1) of the Agreement, the intention of the different wording in Article 4*bis*(1) of the Protocol was to add greater clarity, not to change the substance of replacement. The text in the Protocol provides more detail than in the Agreement on the conditions that are required for replacement to take place.

Conditions

743. Article 4*bis* of the Protocol provides that a mark that is the subject of a national or regional registration in the Office of a Contracting Party is deemed to be replaced by an international registration of the same mark under the following conditions: [Article 4*bis*(1)]:

- both the national or regional registration and the international registration are in the name of the same holder;

¹⁴ See decision by the Madrid Union Assembly at its fifty-third session in 2019 (https://www.wipo.int/edocs/mdocs/govbody/en/mm_a_53/mm_a_53_1.pdf).

¹⁵ Provisional English translation prepared by the International Bureau and set out in WIPO Publication No. 880 (E) of 1991. *1891 to 1991 Madrid Agreement Centenary (International Registration of Marks)*.

¹⁶ See more on the history of replacement in the Madrid System in document MM/LD/WG/18/4 discussed in the 18th session of the Madrid Working Group (https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_18/mm_ld_wg_18_4.pdf).

- protection resulting from the international registration extends to the Contracting Party in question;
- goods and services listed in the national or regional registration are also listed in the international registration in respect of that Contracting Party concerned;
- the extension of the international registration to that Contracting Party (which may be a subsequent designation) takes effect after the date of the national or regional registration.

744. The international registration is deemed to replace the national or regional registration without prejudice to any rights acquired by virtue of the latter (for example, rights resulting from a priority claim or from prior use of the mark).

The Effective Date of Replacement

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

The Time at Which a Request under Article 4*bis*(2) of the Protocol May Be Filed with the Office of the Designated Contracting Party Concerned

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

747. The Office (in whose national or regional register the mark is recorded) is required, upon request by the holder made directly to that Office, to take note in its register of the international registration. This should not be interpreted as a mandatory requirement to benefit from replacement. The wording of Article 4*bis*(1) of the Protocol clearly provides that the replacement is deemed to take place automatically. This means that the holder is not required to do anything: replacement will happen even where the holder does not require the Office to take note. It is, however, advisable that the holder request that the Office take note of the international registration in its register, to inform third parties. [Article 4*bis*(2)]

The Extension of the International Registration to that Contracting Party Takes Effect After the Date of the National or Regional Registration

748. Before taking note (see below), the Offices should verify that the requirements under Article 4*bis*(1) of the Protocol are met, specifically, that the date of any extension of protection under Article 3*ter* of the Protocol is subsequent to the date of the national or regional registration.

The Goods and Services Listed in the National or Regional Registration

749. Furthermore, the Office should verify that, at least, some of the goods and services listed in the national or regional registration are listed in the international registration. While Article 4*bis*(1)(ii) says “all the goods and services listed in the national or regional registration [...]”, this should not be read literally.

750. When introducing Rule 21 of the Draft Regulations Under the Madrid Agreement and the Madrid Protocol at the sixth session of the Working Group on the Application of the Madrid Protocol of 1989, held in Geneva from May 2 to 4, 1994, the International Bureau explained in detail the principle that a national or regional registration could be *partially* covered by the international registration that had replaced it. This is set out in paragraph 99 of the “Comments on Some of the Rules of the Draft Regulations Under the Madrid Agreement and the Madrid Protocol”¹⁷. These comments are relevant as Rule 21 of the Draft Regulations corresponds to Rule 21 of the current Regulations.

751. Paragraph 99 of the above-mentioned document stated the following:

“It should be understood that nothing in the Agreement or the Protocol prevents a Contracting Party from checking that all the goods and services listed in the national or regional registration are also listed in the international registration (see Article 4*bis*(1)(ii) of the Protocol). In that respect, it should be emphasized that the word ‘listed’ should be understood as including the word ‘covered’. For example, if a mark which is the subject of an international registration covers “alcoholic beverages” and designates a Contracting Party where the same mark is registered for “wines”, the replacement should be limited to wines and the prior rights resulting from the national or regional registration will benefit the holder of the international registration irrespective of the fact that the national or regional registration is not renewed. On the other hand, if a mark which is the subject of an international registration covers “wines” and designates a Contracting Party where the same mark is registered for “alcoholic beverages” or for “wines and spirits”, the replacement would apply to wines and the holder, if he intends to maintain the national or regional registration in force in respect of the goods (or services) not covered by the international registration, would have to request renewal, at the time of the expiry of the national or regional registration, for those goods (or services).”

752. Offices of Contracting Parties have followed one of two interpretations of Article 4*bis*(1) and of the scope of replacement; (i) a literal reading, which required that all the goods and services in the national or regional registration concerned by replacement be covered by the international registration; or (ii) the more flexible reading, which acknowledged partial replacement. However, it is clear from the legal history of Article 4*bis* of the Protocol and Rule 21 of the Regulations that replacement was intended to be partial and total.

753. The international registration does not need to have an identical list of goods and services as the national or regional registration. The list in the international registration can be broader in scope or it can be narrower, but there needs to be, at least, some goods and services overlapping, meaning covered by the national or regional registration and the international registration. The names of the overlapping goods and services do not need to be the same, but they must be equivalent.

¹⁷ See document GT/PM/VI/3, *Comments on Some of the Rules of the Draft Regulations Under the Madrid Agreement and the Madrid Protocol*, paragraph 99.

754. At its eighteenth session in October 2020, the Madrid Working Group¹⁸ agreed to recommend to the Madrid Union Assembly, for its formal adoption in 2021, that Rule 21 of the Regulations be amended to clarify that replacement could also be partial. While many Offices of Contracting Parties already accept that replacement may be partial, and not only total, a number of Contracting Parties would need time to amend their domestic legislation to implement this proposed amendment to Rule 21 of the Regulations. It is suggested that the proposed amendment to Rule 21 enters into force on November 1, 2021. However, it is also proposed that there be a transitional period in Rule 40 of the Regulations, which would specify that the amendment concerning partial replacement would not be mandatory until February 1, 2025.

The Effects of Replacement on the National or Regional Registration

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

756. The following example illustrates how partial replacement should work: the prior national or regional registration covers “clothing, headwear and footwear” in class 25, while the international registration covers only “clothing” in class 25. The national or regional register could reflect that replacement of the prior national or regional right is limited to “clothing” in class 25. Should the holder later decide to let the prior national or regional right lapse, there would no longer be any protection for goods in class 25 beyond “clothing”. However, the national or regional register would show that, under the international registration, the holder has protection for the mark concerned for “clothing” in class 25, as from the date of protection of the prior national or regional registration.

757. It is up to the holder to ensure whether, in a given case, the conditions under Article 4*bis* of the Protocol are actually fulfilled. In other words, provided the conditions have been met, replacement has effect and the possibility of requesting an Office to take note of that fact is an option which the holder may elect, or not, to exercise. However, apart from the qualification relating to earlier acquired rights, the Protocol does not elaborate further on the effects of replacement.

¹⁸

https://www.wipo.int/edocs/mdocs/madrid/en/mm_id_wg_18/mm_id_wg_18_4.pdf.

Taking Note

758. Article 4*bis*(2) of the Protocol provides that the Office, in whose national or regional register the mark is recorded, is required, upon request, to take note in its register of the international registration. Where the holder requires the Office of a designated Contracting Party to take note in their national or regional register that replacement has taken place, this will be a procedure before that Office. This means that the holder must present the request directly before the Office concerned, possibly through a local representative, using a local form and pay a fee for such request. For more information on the procedures before the various Offices, holders may contact the Offices directly, or consult the Member Profiles Database¹⁹ on WIPO's website.

759. Where the Office of a designated Contracting Party, following a request made by the holder, has taken note in its register that a national or regional registration has been replaced by an international registration, that Office must notify the International Bureau accordingly. This follows from Rule 21(1) of the Regulations²⁰.

760. Such notification to the International Bureau must indicate the number of the international registration, the filing date and number, the registration date and number and the priority date (if any) of the national or regional registration which has been replaced and, where the replacement concerns only some of the goods and services listed in the international registration, those goods and services. In addition, the notification should include information relating to any other rights acquired by virtue of the national or regional registration²¹. The International Bureau has made available templates (Model Forms) for communications by Offices; one is specifically for replacement (MF 17)²².

761. The International Bureau records the indications so notified in the International Register, as of the date of receipt of a notification complying with the applicable requirements, and informs the holder accordingly. It also publishes them in the Gazette. The purpose of this procedure for an Office to take note is to ensure that the relevant information concerning replacement is made available to third parties in the national or regional registers as well as in the International Register; it creates publicity and notoriety towards third parties. [Rule 21] [Rule 32(1)(a)(xi)]

762. While replacement is a fundamental feature of the Madrid System and potentially one of the most attractive features, the use remains low. For example, by March 2020, the International Bureau had received and recorded only about 1,600 notifications from Offices having taken note of replacement under Article 4*bis*(2) of the Protocol.

¹⁹ <https://www.wipo.int/madrid/memberprofiles/selectmember>.

²⁰ Rule 21 was introduced with the adoption of the Common Regulations, which entered into force on April 1, 1996. There was no equivalent procedure in the Regulations under the Agreement.

²¹ In this respect, it is further recalled that, following the recommendation of the Working Group, the Assembly of the Madrid Union adopted, at its thirty-seventh (21st extraordinary) session, an amendment to Rule 21(1) to broaden its scope by allowing the communication by Offices to the International Bureau of information relating to "other rights" acquired by virtue of a replaced national or regional registration. This amendment entered into force on April 1, 2007, and reads as follows: "The notification may also include information relating to any other rights acquired by virtue of that national or regional registration, in a form agreed between the International Bureau and the Office concerned."

²² https://www.wipo.int/export/sites/www/madrid/en/contracting_parties/pdf/model_form_17.pdf.

763. Replacement would allow for a simplified and centralized management of a holder's trademark portfolio, by gathering all their previously acquired national/regional rights into one international registration. With only one renewal date, the need to only monitor and maintain one registration (the international registration) and no requirement of local representatives, replacement would lead to lower maintenance costs.

764. Notwithstanding replacement of a national or regional registration, it will be in the interest of the holder of the international registration to renew the national or regional registration during the five-year period, where the international registration is dependent on the fate of the basic mark.

Replacement and BREXIT

765. As of January 1, 2021, an EU designation in an international registration will no longer cover the United Kingdom (UK). Where the EUIPO had granted protection to the designation of the EU before December 31, 2020, a national UK right based on the scope of the EU designation concerned, ("comparable right") will automatically be created by the Office of UK (UK IPO). The protection of the UK is no longer part of the international registration and its designation of the EU, but the holder will now have a national right in the UK reflecting the scope of the designation of the EU. Where the EU designation was still pending before the EUIPO by December 31, 2020, the holder has the opportunity to file a national application before the UK IPO, and that national application date would reflect the date of the designation of the EU (either the date of the international registration or the date of the subsequent designation, where applicable).

766. Following the scenario above, where the holder would like to have protection of the UK covered by their international registration, they would need to subsequently designate the UK under the Madrid System. In such case, the holder may later, provided the conditions in Article 4*bis* of the Protocol are met, request the UK IPO to take note of the replacement of the national registration. In this way, the UK national register would reflect the fact that the holder had protection through a national right in the UK, which would refer to the date of their designation of the EU in the international registration.

Facts Concerning Seniority Claims

767. Where a claim of seniority has been recorded in the International Register in respect of a designation of the EU (see paragraphs 278 to 280), such claim is examined by EUIPO, which may either accept or refuse it, in accordance with its applicable legislation. Where EUIPO refuses the validity of such claim, and to the extent that the corresponding decision is final, that fact must be notified to the International Bureau. On the other hand, where the seniority claim is accepted by EUIPO, there is not any necessity for the International Bureau to be notified, since the recording of the seniority claim in the International Register and its publication in the Gazette would not require any modification. [Rule 21*bis*(1)]

768. The EU Trade Mark Regulation allows for a seniority claim to be made subsequently to a EU trademark registration. Where the EU is designated in an international registration, any such "late" seniority claim must be presented directly with EUIPO. Moreover, if such seniority claim is refused by EUIPO following its examination, there is no corresponding notification by EUIPO to the International Bureau (since there is nothing to be recorded in the International Register). It is therefore only where a late seniority claim has been accepted by EUIPO that the relevant information must be notified to the International Bureau. The matters which must be notified are as follows: [Rule 21*bis*(2)]

- (i) the number of the international registration concerned,

- (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.

769. Under the EU Trade Mark system, a seniority claim which has been accepted by EUIPO may subsequently cease to have effect (following, in particular, a withdrawal or a cancellation). Therefore, where the corresponding seniority claim has already been recorded in the International Register, any further final decision affecting such claim, including withdrawal and cancellation, must be notified by EUIPO to the International Bureau. [Rule 21*bis*(3)]

770. All information notified to the International Bureau under the above paragraphs is recorded in the International Register and published in the Gazette. [Rules 21*bis*(4) and 32(1)(a)(xi)]

CONTINUATION OF EFFECTS OF INTERNATIONAL REGISTRATIONS IN CERTAIN SUCCESSOR STATES

771. These paragraphs deal with the protection of an international registration when a State which had been designated is affected by changes resulting in a part of the territory of that State (“the predecessor Contracting Party”) becoming an independent State (“the successor State”). In such a case, the successor State may deposit with the Director General a declaration of continuation, the effect of which is that the Protocol is applied by the successor State. [Rule 39]

772. Any holder of an international registration with a territorial extension to the predecessor Contracting Party which is effective from a date prior to a date notified by the successor State will receive from the International Bureau a notice. The holder can ensure continued protection of his or her international registration in the successor State by filing with the International Bureau, within six months from the date of the notice, a request that the international registration continue its effects in the successor State and by the payment, within the same period of six months, to the International Bureau of a fee, the amount of which is specified in the Regulations. Part of that fee is transferred by the International Bureau to the successor State. [Rule 39(1)]

773. If the holder has failed to comply with the time limit of six months to request that the international registration continue its effects in the successor State and to pay to the International Bureau the corresponding fee, the holder has the option to request continued processing. A request for continued processing must be filed with the International Bureau on the official form MM20 within two months after the failed time limit has ended. Together with the request, all requirements in respect of which the failed time limit applied must be complied with and the fee for continued processing must be paid. For further details on the relief measure of continued processing, see paragraphs 145 to 149. [Rule 5*bis*]

774. After the time limit for requesting continued protection has expired, protection of the international registration in the Contracting Party concerned can only be achieved by way of a subsequent designation.

775. Upon receipt of the request and the fee, the International Bureau notifies the Office of the successor State and makes the corresponding recording in the International Register. It also publishes the relevant data in the Gazette. [Rule 39(3)]

776. The successor State may refuse protection to the international registration only if the time limit referred to in Article 5(2) of the Protocol has not expired with respect to the territorial extension to the predecessor Contracting Party. Rule 39(4) of the Regulations, however, does not preclude the Office of a successor State from notifying, beyond the time limit fixed in Article 5(2) of the Protocol, a final decision on a refusal of protection regularly notified to the International Bureau by the predecessor Contracting Party (before the succession took place) in respect of an international registration which has been the subject of a request for continuation of effect in the successor State. [Rule 39(4)]

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