

## **PART B**

### **CHAPTER II: THE INTERNATIONAL PROCEDURE**

#### **INTRODUCTION**

This Chapter describes the procedures under the Agreement, the Protocol, the Common 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**

01.01 The Madrid system is founded on the requirement of a basic national or regional registration or application for registration. Under the Agreement, an applicant for the international registration of a mark must have already obtained registration of the mark in the country of origin (basic registration). Under the Protocol, 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). The international application may relate only to goods and services covered by the basic application or registration.

01.02 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 registrations (under the Agreement) or on several applications and/or registrations (under the Protocol) which together cover the goods and services to which the international application relates. The basic applications and/or registrations 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 application or basic registration, it being understood that this includes the possibility of several basic applications and/or registrations.

### The Office of Origin

02.01 Before filing an international application, the potential applicant must establish which Office or Offices may be the Office of origin for the international application in question. This will depend on whether the international application will be governed by the Agreement or by the Protocol or by both – which, in turn, depends on which Contracting Parties are to be designated (see paragraphs B.II.03.01 to 03.03).

*Rule 1(viii), (xxv)  
and (xxvi)*

02.02 To the extent that an international application is governed *by the Agreement*, the Office of origin is defined as the Office in charge of the registration of marks in, or on behalf of, the applicant's country of origin. The applicant's country of origin is defined (Article 1(3) of the Agreement) as:

*A Article 1(3)*

(a) any country, party to the Agreement, in which he has a real and effective industrial or commercial establishment; or

(b) *if he has no establishment in such a country*, the country, party to the Agreement, in which he has his domicile; or

(c) *if he has neither an establishment nor a domicile in such a country*, the country, party to the Agreement, of which he is a national.

The applicant must follow this so-called “cascade”; he therefore does not have a free choice of Office of origin. He cannot, for example, base his international application on a registration in the country of his domicile if, in fact, he has an industrial or commercial establishment in *another* country which is a party to the Agreement.

*P Article 2(2)  
Rule 1(ix), (xxv)  
and (xxvi)*

02.03 In contrast, where the international application is governed *exclusively by the Protocol*, no such cascade applies. “Office of origin” is defined (Article 2(2) of the Protocol) in a way which means that the applicant may freely choose his Office of origin on the basis of establishment, domicile or nationality, it being understood that there can be only *one* Office of origin. Thus, 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.

*Rule 2(1)(i)(ii)*

02.04 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.

02.05 “National”, under the Agreement and Protocol, is intended to have the same meaning as in Article 2 of the Paris Convention. It is taken to be capable of including 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.

02.06 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 - 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).

02.07 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 Agreement or Protocol. In such a case, any of the Offices of the respective States may qualify as the Office of origin, both under the Agreement and under the Protocol.

02.08 Where the Contracting State of which an applicant is a national, or in which he is domiciled or has 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.

### **What Kind of International Application?**

03.01 Three kinds of international application are possible. An international application may be (a) governed exclusively by the Agreement, (b) governed exclusively by the Protocol, or (c) governed by both the Agreement and the Protocol, depending on which treaty or treaties (Agreement or Protocol) are applicable to, on the one hand, the Office of origin and, on the other, the Contracting Parties designated in the application (see also paragraphs A.02.16 to 02.25). The principles are as follows:

- Rule 1(viii)* (a) *where the Office of origin is the Office of a country which is bound by the Agreement only, then only countries which are also party to the Agreement may be designated; the international application will be governed exclusively by the Agreement;*

*Rule 1(ix)* (b) where the Office of origin is the Office of a country which is bound by the Protocol only or, is the Office of a Contracting Organization bound by the Protocol, then only countries or organizations which are also party to the Protocol may be designated; the international application will be *governed exclusively by the Protocol*;

*Rule 1(viii), (ix) and (x)* (c) where the Office of origin is the Office of a country which is bound by both the Agreement and the Protocol, then any country which is a party to either the Agreement or the Protocol (or to both), or any organization which is a party to the Protocol, may be designated; in this case:

– where only countries are designated and all the designated countries are party to the Agreement but not to the Protocol, the international application will be *governed exclusively by the Agreement*;

– where all the designated Contracting Parties are party to the Protocol, irrespective of whether or not they are also party to the Agreement, the application will be *governed exclusively by the Protocol*;

– where the international application designates at least one country party to the Agreement but not to the Protocol and at least one Contracting Party which is a party to the Protocol, whether or not that Contracting Party is also party to the Agreement, the application will be *governed by both the Agreement and the Protocol*.

03.02 It is important for an applicant to know into which of these categories his application falls, since this determines such matters as the form to be used and the fees which are payable. Moreover, where the international application will be governed exclusively by the Agreement or by both the Agreement and the Protocol it must be based on a registration (as distinct from an application) with the Office of origin.

03.03 To summarize:

(a) The international application is *governed exclusively by the Agreement* if:

– the Office of origin is the Office of a State bound only by the Agreement, or

– the Office of origin is the Office of a State bound by both the Agreement and the Protocol, where only countries are designated and all the designated countries are bound by the Agreement but not by the Protocol.

The international application must be based on a registration in the Office of origin.

(b) The international application is *governed exclusively by the Protocol* if:

– the Office of origin is the Office of a Contracting Party bound only by the Protocol, or

– the Office of origin is the Office of a Contracting Party bound by both the Agreement and the Protocol, and all the designated Contracting Parties are party to the Protocol irrespective of whether or not they are also party to the Agreement.

The international application may be based on *either an application or a registration* in the Office of origin.

(c) The international application is *governed by both the Agreement and the Protocol* if the Office of origin is the Office of a Contracting Party bound by both the Agreement and the Protocol, and the applicant has designated at least one State bound by the Agreement but not by the Protocol and at least one State bound by the Protocol (whether or not that State is also bound by the Agreement) or one intergovernmental organization bound by the Protocol.

The international application must be based on a *registration* in the Office of origin.

### Several Applicants

*Rule 8* 04.01 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

– where the international application will be governed exclusively by the Agreement, or by both the Agreement and the Protocol, the country of origin (as defined in paragraph B.II.02.02) is the same for each of the applicants;

– where the international application will be governed exclusively by the Protocol, each of the applicants has the necessary connection through establishment, domicile or nationality with the Contracting Party whose Office is the Office of origin.

04.02 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.

## Presentation of the International Application

*A Article 1(2)* 05.01 The international application must be filed through the Office of origin.  
*P Article 2(2)*  
*Article 8(1)* 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. It is possible that an Office which receives a request to present an international application governed by both the Agreement and the Protocol will not be the correct Office of origin under the Agreement, but would be the correct Office of origin under the more liberal rule in the Protocol. In such a case, the Office should inform the applicant that the application cannot be forwarded as it stands, but that it could proceed as an application governed exclusively by the Protocol if all designations of States party to the Agreement but not to the Protocol were cancelled.

*Rule 11(7)* 05.02 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.

05.03 In such case, the International Bureau is not obliged to acknowledge receipt of an international application. Where transmitted by facsimile or by electronic communication, the International Bureau will acknowledge the receipt of a facsimile or an electronic communication (see paragraphs B.I.02.07 and 03.04) and will return the sending as described above.

## Language of the International Application

*Rule 6(1)* 06.01 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 11(7)* 06.02 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.

## The Application Form

*Rule 9(2)(a)* 07.01 An international application must be presented to the International Bureau on the official form.

07.02 Whether the applicant can or must complete the official international application form or whether the form is completed by the Office of origin on the basis of information supplied by the applicant depends on the practice of the Office concerned. The Offices of some Contracting Parties provide forms for requesting the presentation of an international application, which are different from the official

international application form and 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.

*A.I. Section 2* 07.03 There are three different official forms (MM1, MM2 and MM3 respectively) for presenting an international application, depending on whether the application is governed exclusively by the Agreement, exclusively by the Protocol, or by both the Agreement and the Protocol. The official forms are available on WIPO's website under the heading *Madrid – The International Trademark System/Forms*.

*A.I. Section 2* 07.04 The Office of origin must ensure that the correct form is used. Where the Office is the Office of a Contracting Party bound only by the Agreement, or only by the Protocol, only one of these forms will ever be used for applications presented by that Office. Where, however, the Office is bound by both the Agreement and the Protocol, the correct form is determined by which Contracting Parties have been designated (see earlier "*What Kind of International Application*", paragraphs B.II.03.01 to 03.03).

07.05 The general remarks concerning official forms (see paragraphs B.I.04.01 to 04.04) should be studied. In particular, the 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 B.I.04.03 must be followed.

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

07.06 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<sup>quater</sup> of the Agreement or the Protocol, the name of the single State that the Contracting Parties concerned are deemed to constitute should be given, e.g. "Benelux".

07.07 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*

- A.I. Section 12(a), (b) and (c) 07.08 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.

*Address*

- A.I. Section 12(d) 07.09 The address of the applicant must be given in such a way as to satisfy the customary requirements for prompt postal delivery. In addition, telephone or facsimile numbers and an e-mail address may be given.

*Address for Correspondence*

07.10 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 that address. Where no address of a representative is given in item 4, such communications will be sent to the address of the applicant given in item 2(b). Where communications are to be sent to an address other than that indicated in item 2(b), 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.

*Phone and Facsimile Numbers: E-mail Address*

07.11 The numbers or e-mail address given should be those of the person whom the International Bureau should contact when it needs to get in touch with the applicant.

*Application in the Names of More than One Applicant*

07.12 Where there is more than one applicant, the name and address of each applicant should be given, if necessary using a continuation sheet.

- A.I. Section 13 07.13 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 address of the applicant first named in the international application.

*Preferred Language for Correspondence*

- Rule 6(2)(iv)* 07.14 In the case of an international application, the applicant may (by checking the appropriate box) indicate whether he 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.

*Other Indications*

- Rule 9(4)(b)(i) and (ii)* 07.15 Where the applicant is a natural person, he may indicate the State of which he 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. There is no provision for these indications to be given in the form which is to be used for an international application which is governed exclusively by the Agreement.

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

*Item 3: Entitlement to File*

- Rule 9(5)(a)* 07.17 Where the international application is *governed (in whole or in part) by the Agreement* (and is therefore filed on form MM1 or MM3), the applicant should check only one of the boxes (i), (ii) and (iii) under item 3(a), in that order of priority. That is:

– where the applicant has a real and effective industrial or commercial establishment in the country through whose Office the international application is presented, box (i) must be checked;

– if the applicant has no establishment in a country party to the Agreement, but is domiciled in the country through whose Office the international application is presented, box (ii) must be checked;

– if the applicant has neither an establishment nor a domicile in any country party to the Agreement but is a national of the country through whose Office the international application is presented, box (iii) must be checked.

*Rule 9(5)(b)* 07.18 Where the international application is governed *exclusively by the Protocol* (filed on form MM2), 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.

07.19 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.

*Rule 9(5)(c)* 07.20 In general, it is sufficient to provide the information described in paragraphs B.II.07.17 and 07.18 (by naming a State or checking a box). Where however the applicant indicates, by checking the appropriate box(es) in item 3(a), that he has an establishment or domicile in the territory of the Contracting Party through whose Office the international application is presented, but his 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 his establishment or domicile in that territory.

07.21 As indicated in paragraph B.II.04.01, 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. Where appropriate therefore, information concerning the entitlement of each applicant must be given; unless a self-generated form is used, this information should be given in a continuation sheet.

#### ***Item 4: Appointment of a Representative***

*Rule 9(4)(a)(iii)* 07.22 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. *A.I. Section 12(d)* The information should be sufficient to enable correspondence to be sent to the representative, and should preferably include telephone and facsimile numbers and any e-mail address (see also paragraphs B.I.09.01 to 11.02).

07.23 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.

07.24 Giving the name and address of the representative in the international application is all that is necessary to effect his appointment; no power of attorney or other separate document should be sent to the International Bureau.

07.25 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.

07.26 The appointment of a representative in the international application only empowers him 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 Registration or Basic Application*

*A Article 1(2)* 07.27 An international application which is governed (in whole or in part) by the Agreement must be based on the registration of a mark (or on several registrations of the same mark) by the Office of origin. An international application which is governed exclusively by the Protocol 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).

*P Article 2(1)*

*Article 3(1)*  
*Rule 9(5)(a) and (b)*

07.28 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.**

*Rule 9(5)(b)*

07.29 A *basic application* filed with the Office of origin must be indicated by its application number and date of filing. A basic application may be indicated only when the international application is governed exclusively by the Protocol.

07.30 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*

*Article 4(2)* 07.31 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:

– 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 Convention<sup>1</sup>; or

– an application which, under a bilateral or multilateral treaty concluded between countries of the Paris Union, is equivalent to a regular national filing<sup>2</sup>.

*Rule 9(4)(a)(iv)* 07.32 Where priority is claimed, there must be indicated 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.

07.33 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.

07.34 Where the earlier filing does not relate to all of the goods and services listed in item 10 of the international application form, there should be indicated 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.

*Rule 14(2)(i)* 07.35 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

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<sup>1</sup> 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.

<sup>2</sup> 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.

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 B.II.12.01 to 12.06).

*Rule 14(2)(i)* 07.36 As described in paragraphs B.II.12.03 to 12.06, 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.

### ***Item 7: The Mark***

*Rule 9(4)(a)(v)* 07.37 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 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.

07.38 The boxes in this item of the application form measure 8cm x 8cm, which is the standard size for publication of a mark in the *WIPO Gazette of International Marks*. Where a self-generated form is used, the reproduction of the mark must nonetheless be of a size that would fit in the box, that is, it must not exceed 8 cm x 8 cm. Moreover where, in accordance with paragraph B.II.07.43, two reproductions of the mark are provided, both reproductions must be on the same page.

07.39 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.

07.40 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. Since the image used for publication is produced by scanning the application form, *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.

*A.I. Section 9(a)* 07.41 Where the application is communicated by facsimile, the original of that page of the official form which bears the reproduction of the mark must also be sent to the International Bureau. *Only this page should be sent; the whole application must not be sent, since it may be mistaken for a new application*. There must be included on the page sufficient indications (the number of the basic application or basic registration or the Office reference number contained in the international application) to enable the international application to be identified;

*A.I. Section 9(b)*

the Office must also sign the page. The International Bureau will, in its confirmation of receipt of the facsimile communication, remind the Office that sent it of the need to send the original of the page bearing the mark. The International Bureau will not examine the application until the original has been received or until a period of one month has elapsed since the facsimile was received, whichever is the earlier. This is because it is only when a clear reproduction of the mark is received that the International Bureau may be able to identify certain irregularities. The Office of origin should therefore ensure that the original is sent without delay (preferably on the same day as the facsimile is sent), in order to avoid these adverse consequences for the applicant.

*Special Kinds of Mark*

07.42 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 application or registration. If the representation in the basic application or registration 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 B.II.07.53). Non-graphical representations of such marks (such as samples of three-dimensional marks, or recordings of sound marks) must *not* be included.

*International Registration to Be in Color**Article 3(3)  
Rule 9(4)(a)(vii)*

07.43 Where the applicant claims color as a distinctive feature of the mark but the reproduction of the mark in the basic registration or basic application 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 (b)*, in addition to the black and white reproduction to be provided in *box (a)*. Otherwise *box (b)* should be left empty.

*Standard Characters**Rule 9(4)(a)(vi)*

07.44 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 which are not standard in the language(s) used in that Contracting Party.

07.45 This box should not be checked where the mark contains special characters or figurative elements. Although the International Bureau will not question a declaration concerning standard characters, 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.

*Rule 9(4)(a)(viibis)* 07.46 Where the mark that is the subject of the basic registration or basic application 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.

### ***Item 8: Color(s) Claimed***

*Article 3(3)* 07.47 Where color has been claimed as a distinctive feature of the mark in the  
*Rule 9(4)(a)(vii)* basic application or basic registration, 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 application or basic registration. Where there is no such claim in the basic application or basic registration, the basic mark must be in the color or combination of colors claimed in the international application. Finally, where color is claimed, the  
*Rule 9(4)(b)(iv)* 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 B.II.07.78).

### ***Item 9: Miscellaneous Indications***

#### ***(a) Transliteration***

*Rule 9(4)(a)(xii)* 07.48 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.

#### ***(b) Translation***

*Rule 9(4)(b)(iii)* 07.49 Where the mark consists of or contains words which 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. The provision of a translation is at the option of the applicant, and is intended to forestall requests for a translation by the Office of a designated Contracting Party.  
*Rule 6(4)(b)* 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.

(c) *Indication that the Mark Cannot Be Translated*

07.50 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 a request by the Offices of designated Contracting Party for translation or for confirmation that no translation is possible.

(d) *Special Type or Category of Mark*

Rule 9(4)(a)(viii) 07.51 Where the mark is a three-dimensional mark, a sound mark or a  
to (x) 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 registration or basic application.

07.52 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. In order to forestall a 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 receives the certificate of international registration.

(e) *Descriptions of the Mark*

Rule 9(4)(a)(xi) 07.53 Where the basic application or basic registration contains a description of  
Rule 9(4)(b)(vi) 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 B.II.07.51), such as a hologram mark, provided that such an indication is present in the basic application or registration. Where the description in the basic application or basic registration 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.

07.54 As from November 1, 2017, the applicant will also be able to include a description of the mark in the international application that is not included, or differs from the one in the basic application or registration. 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*

07.55 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 in order 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 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*

*Rule 9(4)(b)(v)* 07.56 Where the applicant wishes to disclaim protection for any verbal element of the mark, the appropriate box should be checked and the element or elements for which protection is disclaimed should be indicated. 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.

07.57 It does not matter if there was no corresponding disclaimer in the basic registration or basic application. Conversely, if there was a disclaimer in the basic registration or basic application, this does not make it obligatory to include it in the international application. There is not any possibility for the making of a disclaimer once the mark has been registered by the International Bureau.

***Item 10: Goods and Services for Which International Registration Is Sought***

*Rule 9(4)(a)(xiii)* 07.58 There must be indicated 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.

07.59 This list of goods and services may be narrower than the list in the basic registration or application. It may not however be broader or contain different goods and services. This does not mean that exactly the same terms must be used; the terms used in the international application must however be equivalent to, or fall within the scope of, those used in the basic registration or application.

07.60 The Office of origin must check that all the goods and services listed are covered by those appearing in the basic application or basic registration, so that it can make the declaration referred to in paragraph B.II.07.78. The Office should also check that the classification and grouping of the goods and services is correct, in order to avoid the need for the International Bureau to notify it of any irregularity in this regard (see paragraphs B.II.09.03 to 09.13).

*Rule 9(4)(a)(xiii)* 07.61 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 6(4)(a)* 07.62 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 B.II.16.02), it may assist the Bureau in ensuring that the translation reflects the applicant's intentions, particularly where the list in the basic registration or basic application is in a language other than English, French or Spanish.

### ***Item 11: Designated Contracting Parties***

*Rule 9(4)(a)(xv)* 07.63 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.

07.64 The name of a Contracting Party for which there is no box on the official form, because it has ratified or acceded to the Agreement or Protocol since the form was printed, may be written in, provided that the ratification or accession has entered into force.

07.65 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 wishes the designation to be cancelled or whether he 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.

07.66 Only States or organizations which are party to the same treaty (Agreement or Protocol) as the Contracting Party whose Office is the Office of origin may be designated. Where a State or an organization which the applicant has designated

– is a party to the Protocol only, while the Contracting Party whose Office is the Office of origin is a party to the Agreement only,

– is a State party to the Agreement only, while the Contracting Party whose Office is the Office of origin is a party to the Protocol only, or

– is not a party to either the Agreement or the Protocol,

the designations will be disregarded by the International Bureau, which will so inform the applicant.

*Indication of a Second Language (Where the European Union Is Designated)*

*Rule 9(5)(g)(ii)* 07.67 Where the European Union 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 European Union in a subsequent designation, refer to paragraph B.II.37.09.

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

07.69 Where the European Union 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 (Where the European Union Is Designated)*

*Rule 9(5)(g)(i)* 07.70 Under the European Union Trade Mark system, the proprietor of a mark already registered in or for a member State of the European Union who applies for registration of an identical mark with EUIPO for goods or services which 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 European Union trademark surrenders the earlier mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier mark had continued to be registered.

*A.I. Section 4* 07.71 Applicants wishing to claim seniority in respect of a designation of the European Union under the Madrid Protocol are required to indicate the following elements in a *separate* official form (MM17), to be annexed to the international application form:

- 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.

07.72 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 B.II.101.01 to 101.04.

*Declaration of Intention to Use the Mark*

*Rule 9(5)(f)* 07.73 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, 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 himself.

07.74 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 has the intention that the mark will be used by him or with his consent in that Contracting Party for the goods and services covered by the international application.

***Item 12: Signature by Applicant or Representative***

*Rule 9(2)(b)* 07.75 The Office of origin may require or permit the applicant or his representative to sign the international application. The International Bureau will not question the absence of a signature from item 12.

*A.I. Section 7* 07.76 Any signature by the applicant or the representative may be replaced by the affixing of a seal. In that case, an indication in letters of the name of the natural person whose seal was used is not needed. As regards electronic communications, the signature may be replaced by a mode of identification to be determined by the International Bureau.

*A.I. Section 11(a)(ii)*

***Item 13: Certification and Signature by Office of Origin***

*Rule 9(2)(b)* 07.77 The Office of origin must sign the international application and must  
*Rule 9(5)(d)(i)* certify the date on which it received the request to present the international application (or is deemed to have received the application (see paragraphs B.II.08.02 and 08.04)). This date is important because, in principle, it will become the date of the international registration (see paragraph B.II. 12.01). The Office of origin must also certify certain facts concerning the relationship between the international application and the basic registration or basic application.

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

*Rule 9(5)(d)(ii)* (a) that the applicant for the international registration is the same as the holder of the basic registration or the applicant named in the basic application mentioned in item 5; where the international application is filed jointly by several applicants, they must all also be joint holders of the basic registration or applicants  
*Rule 8* for the basic application;

*Rule 9(5)(d)(iv)* (b) that the mark indicated in item 7 is identical to the mark in the basic registration or application mentioned in item 5; where the Office of origin allows a mark to be altered (whether during the application stage or after registration), the declaration may be made provided that the mark that is the subject of the international application is identical to the mark in the basic registration or application at the time when the Office certifies the international application;

*Rule 9(4)(a)(vii bis)-(xi), (5)(d)(iii)* (c) that, where any of the following indications appears in the international application, the same indications appear also in the basic registration or application:

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

*Rule 9(5)(d)(v)*

*Rule 9(5)(d)(vi)* (e) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic registration or application 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 registration or application, 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 application or registration.

*Rule 9(5)(e)* 07.79 Where the international application is based on two or more basic applications and/or registrations, this declaration may be made only if the statements under (a), (b), (c) and (d) in paragraph B.II.07.78 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 application(s) and/or registration(s), taken together, cover those listed in the international application.

*Rule 9(2)(b)*  
*A.I. Section 7*

07.80 The international application must be signed by the Office of origin. This signature may be handwritten, printed or stamped, or may be replaced by a seal. In the latter case, an indication in letters of the name of the natural person whose seal is used is not needed. 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.

07.81 The declaration to be signed by the Office of origin and referred to in paragraph B.II.07.78 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 registration or basic application, or the international application includes goods and services not covered by the basic registration or application, 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 registration or application). Until this has been done, the application must not be forwarded to the International Bureau.

07.82 The Office of origin should check the content of the form to the extent that this is necessary in order to avoid any irregularities for which it would be responsible (see paragraphs B.II.09.18 and 09.19). 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 B.II.12.02).

### ***Fee Calculation Sheet***

*The following paragraphs should be read in conjunction with the general remarks in paragraphs B.I.08.01 to 08.14 concerning the payment of fees to the International Bureau.*

*Rule 9(4)(a)(xiv)*

07.83 There must be indicated, in the fee calculation sheet contained in the official form:

– 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*

07.84 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.

*Article 8(2)* 07.85 Article 8(2) of the Agreement and Article 8(2) of the Protocol provide that the fees payable in connection with an international application consist of:

- 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.

*P Article 8(7)* 07.86 Article 8(7) of the Protocol however provides that a Contracting Party may declare that, instead of a share in the revenue produced by the supplementary and complementary fees, it wishes to receive an individual fee. 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 A.04.21) that the supplementary and complementary fees, and not the individual fee, are payable.

*Rule 34(3)* 07.87 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 5bis* 07.87*bis* 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 B.I.06*bis*.01 to 05.

07.88 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 B.II.07.86) and is designated 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.

07.89 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 B.II.07.43), 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 ([www.wipo.int/madrid/en/fees/calculator.jsp](http://www.wipo.int/madrid/en/fees/calculator.jsp)). 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 site.

#### *Fee Reduction for Applicants from Least Developed Countries (LDC)*

07.90 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 ([www.wipo.int/madrid/en/fees/calculator.jsp](http://www.wipo.int/madrid/en/fees/calculator.jsp)).

07.91 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 [www.un.org/](http://www.un.org/). The list may also be consulted on the WIPO website at [www.wipo.int/ldcs/en/country](http://www.wipo.int/ldcs/en/country).

*Payment by Debit from an Account with the International Bureau*

07.92 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*

07.93 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, in order to assist the International Bureau in identifying the error if the total is incorrect.

07.94 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.

07.95 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, though it may do so if it thinks fit, for example by asking to see a receipt issued by the International Bureau before transmitting the international application.

07.96 The method by which the fees are being paid (see paragraph B.I.08.05) should be indicated by checking the appropriate box in part (c) of the fee calculation sheet.

### Premature Request for International Application

08.01 Under the Agreement, an international application can be based only on a registration of the mark recorded in the register of the Office of origin. Where an Office receives a request to present an international application that will be governed (exclusively or in part) by the Agreement, before it has registered the mark on which the international application is based, the Office will treat the request as premature. It will be dealt with as follows.

*Rule 11(1)(a)* 08.02 Where the international application will be governed *exclusively by the Agreement*, there is no possibility of it proceeding in respect of any of the designated countries until the basic mark has been registered. The Office of origin will therefore put the international application aside until it has registered the basic mark. The request is then deemed to have been received *on the date on which the basic mark was actually recorded in the register of the Office of origin*. Under the Agreement, this is a frequent practice. Applicants in States whose Offices register applications for protection in their territory relatively quickly, or whose laws provide for an accelerated procedure where the applicant intends to file an international application on the basis of the national registration, sometimes find it convenient to send to the Office of origin, on the same day, an application for the basic registration and a request to present an international application to the International Bureau once the basic mark is registered.

*Rule 11(1)(b)* 08.03 Where the international application will be governed *both by the Agreement and the Protocol*, the request is not premature as far as those designations that are made under the Protocol are concerned. The Office of origin is therefore required to delete those designations that would be governed by the Agreement and allow the international application to proceed as an application governed exclusively by the Protocol, *unless the applicant has explicitly requested that the application be treated as one which is governed by both the Agreement and the Protocol*. In the latter case, the international application can only proceed once the basic mark has been registered; it will therefore be treated as described in the above paragraph.

*Rule 11(1)(c)*

08.04 If the designations made under the Agreement have been deleted, the date of the international registration will, for those Contracting Parties which have been designated under the Protocol, be the date on which the Office of origin received the request to present the international application (provided the international application is received by the International Bureau within two months from that date, and subject to any irregularity which may affect the date of international registration). Those countries whose designations (under the Agreement) have been deleted may be the subject of subsequent designations under Rule 24, once the basic mark has been registered; the provisions of Rule 24(6) concerning the effective date of a subsequent designation will apply. On the other hand, if the applicant has explicitly requested that the application be treated as one under the Agreement and the Protocol, so that the Office of origin will put the application on one side until the basic mark has been registered, the effective date of *all* designations will be the date on which the basic mark is actually recorded in the register of the Office of origin (provided that the international application is received by the International Bureau within two months from that date, and subject to any irregularity that may affect the date of international registration).

08.05 A person who wishes to file an international application in which some designations will be governed by the Agreement and some by the Protocol, but whose basic mark has not yet been registered by the Office of origin, should therefore weigh up the relative advantages and disadvantages of these two courses before filing the request for an international application with the Office of origin.

08.06 Paragraphs B.II.08.01 to 08.05 apply in any case where the international application is based on an application, even if it is also based on a registration. It cannot proceed as an international application governed (exclusively or in part) by the Agreement until the (or each) application has resulted in a registration. Alternatively, the applicant could decide to delete the reference to the application and the goods and services to which it relates.

08.07 These problems cannot arise where the international application is governed *exclusively by the Protocol*.

### **Irregularities in the International Application**

09.01 Whenever the International Bureau considers that there is an irregularity in an international application forwarded to it, 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.

09.02 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***

09.03 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 the possibility of intervening with that Office.

- Rule 12(1)(a)* 09.04 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 to 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. Such an interpretation does not, however, bind a designated Contracting Party with regard to the determination of the scope of the protection of the mark.
- A Article 4(1)*  
*P Article 4(1)(b)*
- Rule 12(1)(b)* 09.05 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.
- 09.06 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 to intervene with the Office of origin. The International Bureau cannot however accept proposals or suggestions directly from the applicant.
- Rule 12(2)* 09.07 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 received from the International Bureau, may have intervened with the Office of origin or may have been invited to give his opinion. The Office of origin is, however, not obliged to give an opinion on the proposal.
- Rule 12(3)* 09.08 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 the above paragraph.
- Rule 12(4) to (6)* 09.09 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(7)(c)*

*Rule 12(7)(a)* 09.10 Any additional fees that may have to be paid as a consequence of the proposed reclassification must be paid:  
*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.

09.11 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 was informed), he receives the reminder of the International Bureau, he should intervene with the Office of origin in order to check whether the Office intends to communicate an opinion on the proposal. He 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.

*Rule 12(8)* 09.12 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(8bis)* 09.13 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 BII.07.59 to 07.61) 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 BII.09.04 to 09.09). 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 BII.09.04 to 09.09) 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(9)* 09.13**bis** 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.

### *Irregularities with Respect to the Indication of Goods and Services*

*Rule 13(1)* 09.14 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(2)(a)* 09.15 The Office of origin may, within three months of the notification, make a proposal for remedying the irregularity. The applicant may communicate his 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 B.II.09.03 to 09.13).

*Rule 13(2)(b)* 09.16 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.

### *Other Irregularities*

09.17 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*

*Rule 11(4)* 09.18 There are a number of irregularities which have to be remedied by the Office of origin within three months after notification, failing which the international application will be considered abandoned, and the Office of origin will be notified accordingly. The applicant will be informed of such a notification.

*Rule 11(4)(a)* 09.19 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:

(a) application not presented on the correct official form, or not typed or otherwise printed, or not signed by the Office of origin;

(b) in the case of an application sent to the International Bureau by facsimile, the original of the page bearing the mark has not been received (see paragraph B.I.02.06);

(c) 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 1(3) of the Agreement or, as the case may be, Article 2(1) of the Protocol with regard to the Office of origin through which the application was filed (see paragraphs B.II.02.02 and 02.03); this would be the case if, for example, the applicant has indicated (in item 3(a)) that he has an establishment or domicile in the territory of the Contracting Party whose Office is the Office of origin, while his address (given in item 2(b)) is not in that territory, but no address has been given under item 3(b) (see paragraph B.II.07.20), 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;

(d) 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 his representative;

– indications concerning the applicant's connection with the Office of origin (see paragraphs B.II.07.17 to 07.21);

– the date and the number of the basic registration or the basic application;

– 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 B.II.07.78).

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.

09.20 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 B.II.07.19 and 07.20).

*Irregularities Which Can Be Remedied by the Office of Origin or by the Applicant*

*Rule 11(3)* 09.21 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 5bis* 09.21*bis* 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 B.I.06*bis*.01 to 05.

*Irregularities Which Must Be Remedied by the Applicant*

*Rule 11(2)(a)* 09.22 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:

- 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 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.

*Rule 11(2)(b)* 09.23 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 5bis* 09.23bis 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 B.I.06bis.01 to 05.

*Rule 11(5)* 09.24 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.

09.25 Where the international application purports to designate a Contracting Party that may not be designated (for example, because it is a party only to the Protocol and the Office of origin is the Office of a country party only to the Agreement, or 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*

*Rule 11(6)(a)* 09.26 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)(c)* 09.27 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.

## **Registration, Notification and Publication**

*Rule 14(1)* 10.01 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 referred to in paragraph B.II.07.14. Certified copies of a certificate of international registration may be requested upon the payment of a fee.

*Rule 32(1)(a)(i)* 10.02 The international registration is published in the Gazette. The Gazette can be accessed by Madrid Monitor ([www.wipo.int/madrid/monitor/en](http://www.wipo.int/madrid/monitor/en))

## **THE INTERNATIONAL REGISTRATION**

### **Effects of the International Registration**

*Articles 3bis and 3ter* 11.01 The effects of the international registration extend to the Contracting Parties expressly designated by the applicant in the international application.

*Article 4(1)* 11.02 From the date of 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.

### **Date of the International Registration**

*Article 3(4)* 12.01 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 (or, in the case of a premature international application, was deemed to have been received; see paragraphs B.II.08.01 to 08.04).

12.02 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 B.I.06.01 to 06.03), 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***

*Rule 15(1)* 12.03 The date of 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 his 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 Common 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 Common Regulations.

*Rule 11(4)* 12.04 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 in order 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.

12.05 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.

*Rule 15(2)* 12.06 The date of an international registration is not affected by any deficiencies other than those referred to in paragraph B.II.12.03 (such as the late payment of fees or irregularities concerning the classification of goods and services).

### **Period of Validity**

*P Article 6(1)* 13.01 Under the Protocol, registration of the mark is effected for 10 years from  
*P Article 7(1)* the date of international registration, with the possibility of renewal for further periods of 10 years.

*A Article 6(1)* 13.02 The Agreement provides for registration and renewal to be effected for  
*A Article 7(1)* periods of 20 years. Under the Regulations however, the fees due in the case of an international application governed by the Agreement must be paid in two installments of 10 years. In respect of the payment of the second installment, the procedures and requirements which apply to the renewal of a registration are applicable. For all practical purposes therefore, any international registration can be regarded as due for renewal every 10 years (see paragraphs B.II.73.01 *et seq.*).  
*Rule 10*  
*Rule 30(4)*

## **Registration in the International Register**

### **Content of the International Registration**

*Rule 14(2)* 14.01 The international registration contains:

- 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;

- an indication, with respect to each designated Contracting Party, as to whether it is designated under the Agreement or designated under the Protocol;
- indications relating to a seniority claim (see paragraphs B.II.07.70 to 07.72), 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**

- Rule 32(1)(a)(i)* 15.01 The international registration is published in the Gazette. The Gazette can be accessed by Madrid Monitor ([www.wipo.int/madrid/monitor/en](http://www.wipo.int/madrid/monitor/en)).
- Rule 32(1)(b)* 15.02 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 he wishes that the mark be considered as a mark in standard characters, the publication will include an indication of that fact.
- Rule 32(1)(c)* 15.03 Concerning the PDF version only, where a color reproduction of the mark has been furnished, the main entry of the Gazette will contain a reproduction of the mark in black and white, while the reproduction in color will be published in a separate section at the end of the Gazette. Where the international application contained both a reproduction in black and white and a reproduction in color, the black and white reproduction in the main entry will be accompanied by the indication “see color reproduction at the end of this issue.” Where the reproduction of the mark in the international application was only in color, a black and white reproduction will be prepared by the International Bureau for the purposes of publication in the main entry in the Gazette and will be accompanied by the indication “see original in color at the end of this issue.”
- Rule 33(1) and (2)* 15.04 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 A.08.01 to 08.04).

### **Language of Registration and Publication**

- Rule 6(3)* 16.01 An international registration will be recorded and published in English, French and Spanish.
- Rule 6(4)(a)* 16.02 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)(b)* 16.03 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.

## REFUSAL OF PROTECTION

### Grounds for Refusal

- Article 5(1)* 17.01 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.

17.02 If a trademark is duly registered in a country of origin, Article 6*quinquies*A. of the Paris Convention requires that this trademark be accepted and protected as is in the other countries of the Paris Union. A refusal may be based in this case on the grounds that would apply under Article 6*quinquies*B. of the Paris Convention. This is the case where the international registration is based on a registration (as must always be so where the designation of the Contracting Party concerned is governed by the Agreement). Where an international registration is based on an application in the country of origin (as can be the case where the designation of the Contracting Party concerned is governed by the Protocol), one could argue that an Office would not be obliged under Article 6*quinquies*A. of the Paris Convention to accept and protect the mark as is. For this reason, there is a discussion whether Offices of Contracting Parties which are designated under the Protocol can refuse protection on grounds other than those mentioned in Article 6*quinquies*B. when the international registration is based on a basic application. In practice, such considerations have little impact. If, an Office of origin totally or partially refuses to register a mark that Office must, under Article 6(4) of the Protocol, request that a corresponding cancellation be made of the international registration (see later paragraphs B.II.84.01 to 85.13). Hence, the negative decision of the Office of origin will be reflected in the international registration and the scope of the protection of the international registration will correspond to the registration resulting from the basic application in the designated Contracting Party. Moreover, even if the mark has not yet been registered by the Office of origin, the obligation to limit objections to the grounds mentioned in Article 6*quinquies*B. would apply if the mark has been registered in another country which is a party to the Paris Convention, even if that country is not a party to either the Agreement or Protocol.

17.03 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.

17.04 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).

17.05 The International Bureau will already have established, before notifying the designation to the Contracting Party, that all applicable formal requirements of the Agreement or of the Protocol and the Common 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.

17.06 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 of course use its own interpretation of the classification, for example, in order 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.

*A Article 4(1)*  
*P Article 4(1)(b)*

17.07 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 replacement of the broad or vague term by a more narrow or precise term in the entry in the International Register as it applies to that Contracting Party – in effect, a limitation of protection for that Contracting Party.

## Time Limits for Refusal

18.01 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 B.II.21.02). 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 time limit. However, the Office may not base a confirmation of total provisional refusal or a statement of grant of protection indicating the goods and services for which the protection of a mark is granted on a ground which was not mentioned in a notification of provisional refusal made within the applicable time limit.

*A Article 5(2)*  
*P Article 5(2)(a)* 18.02 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.

*P Article 5(2)(b)* 18.03 However, any Contracting Party to the Protocol may declare that, for international registrations in which it is designated under the Protocol, the time limit of one year is replaced by 18 months (see paragraph B.II.18.05).

*P Article 5(2)(c)* 18.04 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, with respect to a given international registration in which that Contracting Party is designated under the Protocol, notify, after the expiry of the 18-month time limit, a refusal of protection resulting from an opposition, but only if

– 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.

*P Article 9sexies* 18.05 Notwithstanding the general principle that the Protocol applies between States bound by both the Agreement and the Protocol (see paragraphs A.02.16 to 02.25), 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. What this means, in effect, is that in the case of an international application 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, while being governed by the Protocol, and not the Agreement, nevertheless 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.

*A.I. Section 14* 18.06 In order 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.

*Rule 16(1)(b)* 18.07 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 ([www.wipo.int/madrid/monitor/en](http://www.wipo.int/madrid/monitor/en)).

*Rule 16(2)*  
*Rule 32(1)(a)(ii)*

18.08 Provided that the warning concerning the possibility of later oppositions has been given, as described in the preceding paragraph, 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 wishes to request review of this refusal; it also informs him 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.

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– 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.

18.09 In summary, upon the expiry of one year the holder will know whether his 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 that are governed by the Agreement;
- for all designations that are governed by the Protocol, where the designated Contracting Party has not made a declaration extending the refusal period to 18 months; and
- for all designations that are governed by the Protocol 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 A.02.16 to 02.25).

18.10 In respect of any designation, governed by the Protocol, of a Contracting Party that 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 his 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.

18.11 A change may occur in the treaty applicable to the *recorded* designation of a Contracting Party bound by both the Agreement and the Protocol (see paragraphs A.02.26 to 02.31). However, such a change will not have an impact on the refusal period, even where that period is still running. This results from the fact that the application of paragraph (1) and paragraph (2) of Rule 18 of the Common Regulations (dealing with irregular notifications of provisional refusal) is dependent on the expressions “*Contracting Party designated under the Agreement*” and “*Contracting Party designated under the Protocol*”. By virtue of Rule 1(xvii)

and (xviii), these terms are defined as *requests* for extension of protection. Thus, the refusal period is determined by reference to the situation which pertained at the time of filing and is unaffected by any subsequent change in the applicable treaty.

18.12 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

*Rule 17(1)* 19.01 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.

### *Contents of the Notification*

*Rule 17(2)* 19.02 A notification of provisional refusal must contain the following information and indications:

- 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 application or basic registration 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.

19.03 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 on which are printed all the relevant provisions of the law applicable to that Office which could constitute a ground for refusal (those provisions being translated, where necessary, into the language which is used by the Office for sending communications to the International Bureau). The grounds applicable in a particular case are mentioned in the notification, with a reference to the corresponding provision or provisions of the law as reproduced on the form.

19.04 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***

*Rule 17(3)* 19.05 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. In addition to the indications referred to in paragraph B.II.19.02, it will 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).

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

*Rule 17(4)* 20.01 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 B.II.21.05). The provisional refusal is also 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 32(1)(a)(iii)*

*Rule 17(4)* 20.02 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 16(2)*

### ***Language of the Notification of Provisional Refusal***

*Rule 6(2)* 20.03 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 B.I.07.04).

*Rule 6(3)*

*Rule 6(4)*

*Rule 40(4)* 20.04 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:

– 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**

21.01 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.

- Rule 18(1)(a) and (2)* 21.02 A notification of provisional refusal will not be regarded as such by the International Bureau if:
- 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 B.II.18.02 to 18.03 (and 18.05) or, in the case of a refusal based on an opposition issued by the Office of a Contracting Party that has made the declaration referred to in paragraphs B.II.18.04 and 18.05, 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. In this regard, see also paragraph B.II.18.11, concerning a change in the applicable treaty.
- Rule 18(1)(b) and (2)(c)* 21.03 In all these cases, the International Bureau will nevertheless transmit a copy of the notification to the holder and inform him (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)(c)* 21.04 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 the following paragraph) 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)(d)* 21.05 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 Agreement and 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 Agreement or 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, within this two-month time limit, rectify its notification which is defective in this respect, 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)(e)* 21.06 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)(f)*

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

21.08 It is useful for the holder of the international registration that the International Bureau transmits to him 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.

21.09 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**

*Article 5(3)* 22.01 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 B.II.21.04 to 21.05), he 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.

22.02 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 Agreement, Protocol and Common Regulations, and is governed by the law and practice of the Contracting Party concerned.

22.03 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

23.01 Rules 18*bis* and 18*ter* of the Common Regulations, as in force since September 1, 2009, 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

*Rule 18bis(1)(a)* 24.01 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) of the Agreement or Article 5(2)(a) or (b) of the Protocol, send to the International Bureau a statement to the effect that the *ex officio* examination has been completed and that the Office has found no grounds for refusal, but that the protection of the mark is still subject to opposition or observations by third parties . The Office should indicate also the date by which such oppositions or observations may be filed.

*Rule 18bis(1)(b)* 24.02 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.

24.03 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.

*Rule 18bis(2)* 24.04 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.

24.05 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*.

24.06 Rule 18*bis* of the Common 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 Common Regulations, after having had sent a positive statement under Rule 18*bis* of the Common Regulations.

### **Final Disposition on the Status of a Mark**

*Rule 18ter* 25.01 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.

25.02 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**

*Rule 18ter(1)* 26.01 Firstly, where, before the expiry of the applicable refusal period under Article 5(2) of the Agreement or 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. Regarding the period within which a notification of provision refusal is required to be sent, see paragraphs B.II.18.01 to 18.12. Generally, this situation may occur when the Office uses an examination system without opposition or observations or when the opposition or observations period begins at the same time as the examination.

26.02 Thus, 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. Rule 18*ter*(1) reduces the disadvantages linked to what is known as the principle of “tacit acceptance”. However, this principle remains applicable.

*Rule 18ter(1)* 26.03 Rule 18*ter*(1) makes it obligatory to send a statement of grant of protection.



### Further Decision

*Rule 18ter(4)* 29.01 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.

29.02 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. As from November 1, 2017, Rule 18ter(4) has been amended to also include the possibility of sending 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 also 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

*Rule 18ter(5)* 30.01 The International Bureau shall record any statement received under Rule 18ter 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 18ter 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 A.08.04).

*Rule 32(1)(a)(iii)*

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

*Rule 23bis*

31.01 As from November 1, 2017, 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.

## SUBSEQUENT DESIGNATION

*Article 3ter(2)*

32.01 If the effects of an international registration do not extend to a Contracting Party (for example, because 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 as a result of a final decision subsequent to a refusal, an invalidation or a renunciation), the extension of protection to that Contracting Party may be effected by filing a subsequent designation. The holder may wish to do this where, for example, the grounds for such refusal, invalidation or renunciation no longer exist.

32.02 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 either the Agreement or the Protocol, or that it was not bound by the same treaty (Agreement or Protocol) as the Contracting Party of the holder. 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.

32.03 A subsequent designation may be made for part only of the goods and services recorded in the International Register. A given Contracting Party may therefore be the subject of several subsequent designations, each referring to a different part of the list of goods and services recorded in the International Register.

32.04 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

*Rule 24(1)(a)* 33.01 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.

33.02 The designation of a particular Contracting Party will be made either under the Agreement or under the Protocol. It is important to know which is the governing treaty, since this will determine such matters as the fees which are payable.

*Rule 24(1)(b)* 33.03 The position is as follows:  
*and (c)*

– where the Contracting Party of the holder is a party only to the Agreement, a country which is also a party to the Agreement may be designated; the designation is made *under the Agreement*;

– where the Contracting Party of the holder is a party only to the Protocol, only a Contracting Party to the Protocol may be designated; the designation is made *under the Protocol*;

– where the Contracting Party of the holder is a party to both the Agreement and the Protocol, the designation of any Contracting Party which is a party to the Protocol (even if that Contracting Party is also a party to the Agreement) will be made *under the Protocol*, while the designation of any country party to the Agreement only will be made *under the Agreement*. In applying the above principles, the question of whether a country is a party to the Agreement or to the Protocol or whether an organization is a party to the Protocol is to be determined as of the date of the subsequent designation.

33.04 A further consideration arises where a country is designated under the Agreement in respect of an international registration resulting from an international application which was governed exclusively by the Protocol. Under the Agreement, an international application must be based on a registration in the country of origin. If the international application was based on an application filed with the Office of origin, a subsequent designation under the Agreement can be made only after the basic application has resulted in a registration.

## No Subsequent Designations Possible in Certain Cases

*A Article 14(2)*  
*P Article 14(5)* 34.01 In principle, a subsequent designation may be made with respect to any Contracting Party which is bound by the same treaty as the Contracting Party of the holder. However, there is an exception from this principle; when acceding to the Agreement or to the Protocol, any State or (in the case of the Protocol) 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.

34.02 A subsequent designation of a country which has made a declaration under Article 14(2) of the Agreement is however possible if the holder of the international registration is also the holder of an earlier national registration of the same mark in that country. A subsequent designation of such a country should therefore be accompanied by the number and date of such earlier national registration; otherwise the International Bureau will not be able to record the subsequent designation of that country. Where no such earlier national registration exists, the only way to protect a mark in a country concerned through international registration is to file a new international application designating that country.

### **Presentation of the Subsequent Designation**

- Rule 24(2)(a)* 35.01 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. However, the subsequent designation
- Rule 24(2)(a)(ii)* must be presented to the International Bureau by the Office of the Contracting Party of the holder where any of the Contracting Parties to which it relates is a country which is designated under the Agreement.
- A.I. Sections 6 to 11(a)* 35.02 A subsequent designation may be transmitted to the International Bureau by mail, by facsimile (no confirmation is needed) or by electronic means (see paragraphs B.I.03.01 to 03.05 and 03.09).
- Rule 24(10)* 35.03 Where a subsequent designation should have been presented through an Office (see paragraph B.II.35.01) but is presented directly to the International Bureau, that subsequent designation will not be considered as such. Any fees already paid will be reimbursed to the party having paid them.

### **Language of the Subsequent Designation**

- Rule 6(2)* 36.01 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 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 him to one or two of these languages.
- Rule 6(4)(a)* 36.02 The holder may annex to his 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.

## Official Form

*Rule 24(2)(b)* 37.01 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 B.I.04.02 and 04.03). One form may be used to designate several Contracting Parties.  
*A.I. Section 3*

### *Item 1: International Registration Number*

*Rule 24(3)(a)(i)* 37.02 The holder must indicate the number of the international registration for which he makes a subsequent designation. The subsequent designation may relate to one international registration only.

### *Item 2: The Holder*

#### *Name and Address*

*Rule 24(3)(a)(ii)* 37.03 The holder must indicate his name and address, which must be the same as recorded in the International Register. If the holder has changed his name or address without the change having been recorded in the International Register, he 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.

### *Item 3: Appointment of a Representative*

37.04 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, he should not name a representative in the space provided for appointing a representative. Item 3 should therefore be left blank.

*Rule 3(2)(a)* 37.05 Where the holder wishes to appoint a representative for the first time, or to change his representative, the appointment may be made by indicating his name and address in this item of the official form. No separate communication relating to the appointment is needed.

### *Item 4: Contracting Parties Subsequently Designated*

*Rule 24(3)(a)(iii)* 37.06 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 own form, he may instead list the Contracting Parties he wants to designate.

37.07 The official form is regularly updated and the latest version made available under the heading *Madrid – The International Trademark System/Forms* of WIPO's website. If however the holder wishes to designate a Contracting Party that is not listed (because it has become party to the Agreement or Protocol since the form was printed), he should write the name of that Contracting Party in the space available for that purpose in item 4. The holder should check that the accession of that Contracting Party has become effective. If it has not, 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*

*Rule 24(3)(b)* 37.08 The remarks in paragraphs B.II.07.73 and 07.74 apply *mutatis mutandis* to a subsequent designation.

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

*Rule 24(3)(c)(iii)* 37.09 The remarks in paragraphs B.II.07.67 to 07.69 (concerning the indication of a second language before EUIPO) and in paragraphs B.II.07.70 to 07.72 (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 European Union, 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 European Union.

***Item 5: Goods and Services for Which the Subsequent Designation Is Made***

*Rule 24(3)(a)(iv)* 37.10 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.

**Item 6: Miscellaneous Indications**

*Rule 24(3)(c)* 37.11 This item relates to a number of indications which may be required by certain Contracting Parties designated under the Protocol, and which the holder may wish to indicate in order 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.

(a) *Additional Indications Relating to the Holder*

37.12 The holder may, if he is a natural person, indicate the State of which he 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*

37.13 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*

37.14 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.

(e) *Voluntary description*

37.14*bis* As from November 1, 2017, the applicant may include a voluntary description of the mark. This allows the applicant to meet the requirements of designated Contracting Parties regardless of whether such description was contained in the basic mark or differs in wording. This also applies to subsequent designations where the voluntary description has not already been included in the international registration.

**Item 7: Request Relating to the Date of Effect**

37.15 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.

**Item 8: Signature of the Holder or His Representative**

*Rule 24(2)(b)* 37.16 Where the holder communicates his subsequent designation directly to the International Bureau, he (or his representative) must sign it.

37.17 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 his 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 of the Request by the Office and  
Signature by the Office***

*Rule 24(2)(b)* 37.18 A subsequent designation which is presented to the International Bureau  
*Rule 24(3)(a)(vi)* 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(3)(d)* 37.19 Where the international registration was based on a basic application and any of the Contracting Parties mentioned is being designated under the *Agreement*, the Office of origin should complete the declaration in item 9(b), certifying that the said application has resulted in a registration and indicating the date and number of that registration, unless such a declaration has already been received by the International Bureau. Where the subsequent designation is presented through an Office other than the Office of origin, the holder should obtain an equivalent declaration from the Office of origin and send it to the International Bureau.

***Fee Calculation Sheet***

*See the remarks concerning completion of the fee calculation sheet in the international application form (paragraphs B.II.07.83 to 07.96), and the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.08.01 to 08.14).*

*Rule 24(4)* 37.20 The fees payable in connection with a subsequent designation consist of:

- the basic fee;
- an individual fee for the designation of each designated Contracting Party that has made the relevant declaration (see paragraph B.II.07.86) and is designated 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 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.

37.21 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.

37.22 The payment may be made by any of the different means listed in part (b) of 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 part (a) in 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 part (b) of the fee calculation sheet.

## **Effect of Subsequent Designation**

### **Date of Subsequent Designation**

*Rule 24(6)(a)* 38.01 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)(b)* 38.02 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 Common 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 Common Regulations.

38.03 The date of a subsequent designation may be affected if it contains irregularities (see paragraph B.II.39.02).

38.04 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, in order 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.

38.05 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 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 effective 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.

*Rule 24(6)(d)* 38.06 In order to avoid problems of the kind just described, where a subsequent designation contains a request that it take effect immediately after some other event (such as renewal or the recording of a change or cancellation), the subsequent designation will bear the date of the recording of that other event.

38.07 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 B.II.40.02).

### **Irregular Subsequent Designation**

*Rule 24(5)(a)* 39.01 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(6)(c)(i)* 39.02 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)(ii)* 39.03 Any other irregularity does not affect the date of the subsequent designation.

*Rule 24(5)(b)* 39.04 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, as from November 1, 2017, amended Rule 24(5)(c) provides that where official form MM18 (declaration of intention to use the

*Rule 24(5)(c)* 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.

39.05 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 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 himself (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 would be well advised to contact that Office to ensure that the irregularity will be remedied in good time.

*Rule 5bis* 39.05*bis* 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 B.I.06*bis*.01 to 05.

*Rule 24(5)(c)* 39.06 An exception to the general rule relating to irregularities is made in the case where the International Bureau considers that the holder is not entitled to make the subsequent designation with respect to some or all of the Contracting Parties mentioned (see paragraphs B.II.33.01 to 33.04). Where the lack of entitlement applies to only some of the Contracting Parties mentioned, the subsequent designation will be deemed not to contain the designation of those Contracting Parties; the respective complementary or individual fees paid in respect of them will be refunded. Where the deficiency applies to all the Contracting Parties mentioned, the subsequent designation is considered to be abandoned. In addition to all the complementary and individual fees, the International Bureau will also reimburse one half of the basic fee.

### **Recording, Notification and Publication**

*Rule 24(8)* 40.01 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 32(1)(a)(v)* 40.02 The subsequent designation will be published in the Gazette. The Gazette can be accessed by Madrid Monitor ([www.wipo.int/madrid/monitor/en](http://www.wipo.int/madrid/monitor/en)). Where the date of the subsequent designation, as determined in accordance with Rule 24(6) (see paragraphs B.II.38.01 to 38.07) 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 6(3)* 40.03 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 (see paragraphs B.I.07.05 to 07.07). That subsequent designation itself will be recorded in the International Register in English, French and Spanish.

### **Period of Protection**

*Rule 31(2)* 41.01 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 B.II.38.04).

*Rule 40(3)(a)* 41.02 Where an international registration was effected before the entry into force of the Common Regulations (April 1, 1996) and the required fees had been paid for 20 years and a subsequent designation is made during the first 10 years of this period, fees paid in respect of the subsequent designation will cover only the remainder of that 10-year period. At the end of that period, it will be necessary to pay the appropriate complementary and/or individual fees in respect of the second 10-year period (see also paragraphs B.II.75.01 and 75.02).

### **Refusal of Protection**

*Rule 24(9)* 42.01 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 18<sup>ter</sup> 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 B.II.17.01 to 31.01 are referred to.

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

43.01 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.

43.02 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.

*Rule 24(7)(a)* 43.03 Having regard to this feature of the European Union Trade Mark system, the Common 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.

43.04 As a general principle, subsequent designations resulting from conversion must comply with the requirements set out for “ordinary” subsequent designations (see paragraphs B.II.32.01 to 42.01), subject however to the following.

### **Official Form and Contents**

*A.I. Section 3(a)* 44.01 A subsequent designation resulting from conversion must be presented on the official form MM16 established by the International Bureau, distinct from that used for an “ordinary” subsequent designation (MM4).

*Rule 24(7)(b)* 44.02 A request for the recording of a subsequent designation resulting from conversion must contain or indicate the following:

- 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.

*Rule 3(2)(a)* 44.03 Where the holder wishes to appoint a representative for the first time, or to change his representative, the appointment may be made by indicating his name and address in the corresponding item of the official form.

### **Presentation of the Subsequent Designation Resulting from Conversion**

*Rule 24(2)(a)(iii)* 45.01 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).

### **Date of Subsequent Designation Resulting from Conversion**

*Rule 24(6)(e)* 46.01 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.

## **CHANGES AND OTHER RECORDINGS IN THE INTERNATIONAL REGISTRATION**

### **Change of Name or Address of the Holder; Recording of/or Changes to the Legal Nature of the Holder; Change of Name or Address of the Holder's Representative**

*Rule 25(1)(a)(iv)* 47.01 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. As from July 1<sup>st</sup>, 2017, amended Rule 25 allows the holder of international registration to add or update its legal nature

*A.I. Section 4*

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 national 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)(b)* 47.02 The request may be presented to the International Bureau directly by the holder or through the Office of the Contracting Party of the holder.

### **Official Form (MM9)**

48.01 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 B.II.60.01 to 67.02).

#### ***Item 1: International Registration Number***

48.02 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.

48.03 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 is notified of the international registration number concerned and make a further request.

#### ***Item 2: Name of the Holder***

48.04 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***

48.05 Spaces are provided in item 3 to indicate the new name and 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.

***Item 4: Recording of/or Changes to the Legal Nature of the Holder***

48.06 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.

***Item 5: New Contact Details***

48.06bis Boxes are provided in item 5 to delete or update the holder's address for correspondence, phone and fax numbers, as well as the e-mail address. If no change is requested in this item, the International Bureau will maintain the holder's existing contact information.

*Rule 36(ii)* 48.07 Where the address of correspondence, email address, phone or fax number of the applicant or holder has changed, it is sufficient to indicate the new address for correspondence or email or the new phone or fax number. It should be noted that, where this is the only change to be recorded, no fee is payable for the request.

***Item 6: Appointment of a New Representative***

48.08 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.

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

***Item 7: Signature by the Holder or His Representative***

*Rule 25(1)(d)* 48.10 Where the request is presented directly to the International Bureau, it must be signed by the holder (or his representative as recorded).

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

***Item 8: Signature of the Office***

*Rule 25(1)(d)* 48.12 A request which is presented to the International Bureau by an Office must be signed by that Office. ).

### ***Fee Calculation Sheet***

*See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.08.01 to 08.14).*

48.13 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 part (b) of the fee calculation sheet. 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 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. 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 part (b).

### **Change of Name or Address of the Representative**

*Rule 25(1)(a)(vi)* 49.01 As from November 1, 2017, amended Rule 25(1)(a)(vi) provides that a request to record a change in the name or 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 the name of the holder need not be indicated and that the change to be indicated, of course, relates to the name or address of the representative. The recording of a change in name or address of a representative is free of charge.

*Rule 36(i)*

49.02 Form MM10 is to be used only to request the recording of the change in the name or address of a representative whose appointment has already been recorded. *It may not be used to request the recording of the appointment of a new representative.*

49.03 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**

*Rule 26* 50.01 If a request to record a change in name or address of the holder or its 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.

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

*Rule 5bis* 50.03 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 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 B.I.06*bis*.01 to 05.

*Rule 27(1)(c)*

### **Recording, Notification and Publication**

*Rule 27(1)(a)* 51.01 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, and or any changes concerning the holder's name, address or legal nature or change in name or address of the representative, requested, 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)(b)*

*Rule 32(1)(a)(vii)*

### **Limitation, Renunciation and Cancellation**

52.01 The holder may wish to have recorded one of the following restrictions in the protection of his 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

53.01 The recording of a limitation does not entail the removal of the goods and services concerned from the international registration as recorded in the International Register. 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 be made the subject of a subsequent designation. They are therefore taken into account when calculating any supplementary fees due on renewal. Similarly Contracting Parties in respect of which protection has been renounced can always be designated again.

53.02 In contrast, where an international registration is cancelled, the goods and services are permanently removed from 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 Register. The consequence of this is that, in the case of a total cancellation, no subsequent designation may be made for the international registration, since it does not exist anymore. If the former holder wishes to protect his mark again he 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 wishes to protect his mark again for such goods and services he must file a new international application.

53.03 If the holder voluntarily limits or renounces the protection of his international registration, or asks for its cancellation, he 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 B.II.88.01 to 88.07).

### Request for Recording

- Rule 25(1)(a)*  
*A.I. Section 4* 54.01 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)(c)* 54.02 Where a renunciation affects any Contracting Parties whose designation is, on the date of receipt of the request by the International Bureau, governed by the Agreement, the request must be presented to the International Bureau through the Office of the Contracting Party of the holder.
- Rule 25(1)(c)* 54.03 Where a cancellation affects any Contracting Parties whose designation is, on the date of receipt of the request by the International Bureau, governed by the Agreement, a request to record a cancellation must be presented to the International Bureau through the Office of the Contracting Party of the holder.

*Rule 25(1)(b)* 54.04 In all other cases, 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 26(3)* 54.05 Where the request should have been presented through an Office (see paragraphs B.II.54.02 and 54.03) but is presented directly to the International Bureau, the request will not be considered as such and the International Bureau will inform the sender accordingly.

*Rule 6(2)* 54.06 In general, the request may be in English, French or Spanish.  
*Rule 40(4)* However, for all international registrations resulting from applications filed before April 1, 2004, and pending the recording of a subsequent designation:

– 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).

### **Presentation of Request to Record Renunciation or Cancellation Following Change in Applicable Treaty**

*Rule Ibis* 55.01 A change may occur in the treaty applicable to the recorded designation of a Contracting Party bound by both the Agreement and the Protocol (see paragraphs A.02.26 to 02.31).

*Rule 25(1)(c)* 55.02 Where a renunciation or a cancellation affects any of the Contracting Parties whose designation is governed by the Agreement, the request to record same must be presented to the International Bureau through the Office of the Contracting Party of the holder.

55.03 The issue as to whether a given designation is governed by the Agreement is, however, settled on the date of receipt of the request by the International Bureau, in accordance with the wording of Rule 25(1)(c). Thus, a change in the applicable treaty will not have any impact on requests for the recording of a renunciation or cancellation that have already been presented to the International Bureau.

## **Official Form**

56.01 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.

### ***International Registration Number***

56.02 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.

56.03 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 is notified of the number of the international registration concerned and make a further request.

### ***Holder***

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

### ***Appointment of a Representative***

56.05 The opportunity may be taken, in a request to record a limitation, renunciation or cancellation, to appoint a representative.

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

### ***Contracting Parties***

56.07 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.

56.08 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***

56.09 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.

56.10 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 the previous paragraph.

### ***Signature by the Holder or Representative***

*Rule 25(1)(d)* 56.11 Where the request is presented directly to the International Bureau, it must be signed by the holder (or his representative).

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

### ***Signature of the Office***

*Rule 25(1)(d)* 56.13 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 and produces his own form, he may omit this item).

### ***Fee Calculation Sheet (Limitation Only)***

*See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.08.01 to 08.14).*

56.14 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 must be paid with regard to each one of them. The payment may be made by any of the different means listed in part (b) of the fee calculation sheet. 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 part (a) in 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 part (b).

*Rule 36(iii) and (iv)* 56.15 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.

### **Irregular Requests**

*Rule 26* 57.01 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.

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

*Rule 5bis* 57.03 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.

*Rule 27(1)(c)* 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 B.I.06*bis*.01 to 05.

### **Recording, Notification and Publication**

*Rule 27(1)(a)* 58.01 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

*Rule 27(1)(a)* 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;

*Rule 32(1)(a)(vii) and (viii)* 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)(b)*

58.02 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 Agreement and Article 6(3) of the Protocol (see paragraph B.II.83.01), 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 B.II.54.06.

### **Declaration that a Limitation Has No Effect**

*Rule 27(5)(a) to (c)* 59.01 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)(e)* 59.02 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)(d) and (e)* 59.03 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.

### **Change in Ownership**

60.01 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. Other reasons might be a 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.

60.02 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.

60.03 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  
*Rule 1(xxi)*

legal entity in whose name the international registration is recorded. The new owner is referred to as the “transferee”. Once the change in ownership has been recorded, he of course becomes the holder of the international registration.

60.04 *This terminology is different from that used in the Agreement.* Article 9bis of the Agreement uses the term “transfer” for a change in ownership in respect of all goods and services and for all countries covered by the international registration, whilst Article 9ter of the Agreement uses the term “partial assignment” for a change in ownership for part of the goods and services or for some of the contracting countries.

### **Entitlement of the Transferee to Be the New Holder**

61.01 The change in ownership may be recorded only if the transferee is a person who is entitled to file international applications. Moreover, his entitlement needs to be considered in respect of each of the Contracting Parties in respect of which he seeks to be recorded as the new holder of the international registration concerned.

*Rule 25(2)(a)(iv)* 61.02 In the request to record the change in ownership, the transferee must indicate the Contracting Party or Parties with respect to which he fulfills the conditions, under Articles 1(2) and 2 of the Agreement or 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 to the Agreement and/or the Protocol in which he has a real and effective industrial or commercial establishment or is domiciled, or the country which is party to the Agreement and/or Protocol (or which is a member State of an organization party to the Protocol) and of which he is a national. A transferee may claim the necessary connection with several Contracting Parties, some of which may be party to the Agreement and some to the Protocol.

*Rule 25(3)* 61.03 The principles which determine whether a person may be recorded as the holder of an international registration in respect of a given designated Contracting Party are as follows:

– where the designated Contracting Party is bound by the Agreement but not the Protocol, he may be recorded as the holder in respect of that Contracting Party provided that the Contracting Party (or one of the Contracting Parties) indicated as mentioned in the preceding paragraph is also a party to the Agreement;

– where the designated Contracting Party is bound by the Protocol but not the Agreement, he may be recorded as the holder in respect of that Contracting Party provided that the Contracting Party (or one of the Contracting Parties) indicated as mentioned in paragraph B.II.61.02 is also a party to the Protocol;

– where the transferee is able to indicate a Contracting Party which is a party to both the Agreement and the Protocol, or to indicate a country party to the Agreement and a Contracting Party to the Protocol, he will be able to be recorded as the holder of any international registration, in respect of whatever Contracting Parties have been designated.

61.04 The following examples will illustrate what is indicated in paragraphs B.II.61.02 and 61.03:

The transferee is a national of a State, bound only by the Protocol and has no domicile or establishment in any other country;

– if the international registration extends only to Contracting States bound exclusively by the Agreement, the change in ownership cannot be recorded in the International Register;

– if the international registration extends to Contracting States bound exclusively by the Agreement but also to Contracting Parties bound by the Protocol (whether or not bound also by the Agreement), the change in ownership can be recorded with respect to all Contracting Parties bound by the Protocol;

– if the international registration extends only to Contracting Parties bound by the Protocol (whether or not bound also by the Agreement), the change in ownership may be recorded with respect to all designated Contracting Parties.

If, on the other hand, that same transferee also has a real and effective establishment in a Contracting Party bound by the Agreement, the change in ownership can be recorded with respect to all designated Contracting Parties.

*Rule 25(4)* 61.05 If there are several transferees, each of them must qualify as described in paragraph B.II.61.03. As a consequence, the change in ownership may not be recorded in respect of a given designated Contracting Party if any of the transferees does not fulfill the conditions to be the holder of the international registration in respect of that Contracting Party. It is however not necessary that the Contracting Party or Parties through which the conditions are fulfilled be the same for each transferee.

61.06 Where, for the reasons explained in the foregoing paragraphs, a change in ownership which cannot be recorded in the International Register in respect of one or more designated Contracting Parties, the transfer is recorded as a partial change in ownership, as described in paragraph B.II.65.01. A separate international registration is therefore created in respect of the designated Contracting Parties for which the new owner is entitled to be recorded as the holder. For the remaining Contracting Parties, the international registration remains in the name of the current holder. If the new owner subsequently becomes entitled to be recorded as the holder in respect of these latter Contracting Parties, the merger of the international registrations may be requested, as described in paragraphs B.II.68.01 to 68.04. The consequences between the parties of a change in ownership which cannot be recorded in the International Register are a matter for the law of the Contracting Parties concerned.

*A Article 9bis(1)* 61.07 According to the last sentence of Article 9bis(1) of the Madrid Agreement, where a transfer to a person established in a contracting country other than the country of origin is effected during the five-year dependency period, the International Bureau should seek the consent of the Office of the country of the new proprietor, and publish, if possible, the date and registration number of the mark in the country of the new proprietor. This procedure was justified by the fact that, at one time in the history of the Madrid Agreement, such a transfer entailed a change of the country of origin. In order to ensure that the mark was the subject of

a national registration in the new country of origin, on which central attack could be based, the consent of the Office of the new country of origin was requested before the transfer would be recorded. As from the Nice Act of 1957, however, the country of origin remains unchanged following a change in ownership; the procedure prescribed in the last sentence of Article 9*bis*(1) of the Madrid Agreement has therefore lost its justification. Accordingly, the Assembly of the Madrid Union decided in 1995 that the International Bureau should cease to apply this provision.

### **Change of Applicable Treaty Following the Recording of a Change in Ownership**

*Rule 1bis* 62.01 It is possible for a designation which was governed by the Agreement to become governed by the Protocol, or *vice versa*, following a change in ownership of the international registration. (In this regard, see also paragraphs A.02.26 to 02.31). For example, where a country which is party to both the Agreement and the Protocol was designated in an international application filed through the Office of a country party to the Agreement only, the designation will have been governed by the Agreement; if, subsequently, following a change in ownership of the international registration, the new owner's claim to be entitled to be the holder of an international registration is through a Contracting Party to both the Agreement and the Protocol, the designation will henceforth be governed by the Protocol (see paragraphs A.02.21 to 02.25). Such a change does not affect matters which are already completed, or procedures which have already started. Thus, matters such as the presentation of a request for renunciation or cancellation are governed by whichever was the applicable treaty at the time when the request in question was received by the International Bureau. Subsequent renewal of the international registration with respect to that Contracting Party will however, in the example given, be governed by the Protocol (however, as regards the liability to pay individual fees, see paragraph B.II.77.02).

### **Request to Record a Change in Ownership**

*Rule 25(1)(a)(i)* 63.01 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.  
*A.I. Section 4*

*Rule 25(1)(b)* 63.02 The request may be presented to the International Bureau by the holder (or his recorded representative), by the Office of the Contracting Party of the (recorded) holder or by the Office of the Contracting Party of the transferee, that is, the Contracting Party (or one of the Contracting Parties) indicated as described in paragraph B.II.61.02. It should be noted that, with effect from April 1, 2002, there is no longer any restriction concerning the presentation of a request to record a change in ownership, even where the change affects Contracting Parties whose designation is governed by the Agreement. It is however no longer possible to present the request through the Office of origin (that is, the Office through which the international application was filed) where neither the present holder nor the new owner (transferee) has any connection with the Contracting Party whose Office is the Office of origin.

63.03 Where the request is to be presented to the International Bureau through an Office, that Office may require the furnishing of evidence concerning the change of ownership. The International Bureau does not however 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.

*Rule 6(2)*  
*Rule 40(4)*

63.04 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:

– 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 B.I.07.01 to 07.07).

63.05 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***

64.01 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.

64.02 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 is notified of the number of the international registration concerned in order to make the request.

**Item 2: Holder**

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

**Item 3: Transferee**

*Rule 25(2)(a)(iii)* 64.04 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 B.II.07.08 to 07.13).

**Item 4: Entitlement of the Transferee to Be the Holder**

*Rule 25(2)(a)(iv)* 64.05 There should be indicated, in the appropriate spaces, the Contracting Party or Parties of which the transferee is a national (or the name of the member State of a Contracting Organization of which he is a national), in which he is domiciled or in which he 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.

64.06 Where the transferee may cite more than one Contracting Party, it is a matter for him 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 in respect of the designated Contracting Parties affected by the change in ownership (see paragraphs B.II.61.03 to 61.06).

*Rule 25(2)(a)(v)* 64.07 If it has been indicated, under (a)(iii) or (iv), that the transferee is domiciled in or has an establishment in a particular Contracting Party but his address as given in item 3 is not in the territory of that Contracting Party, it is necessary to give under (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.

**Item 5: Appointment of a Representative**

64.08 The opportunity may be taken, in a request to record a change in ownership, to appoint a representative.

*Rule 3(6)(a)* 64.09 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 should be reappointed by completing item 5.

***Item 6: Scope of the Change in Ownership***

64.10 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.

64.11 In the case of a partial change in ownership (6(b)), the Contracting Parties in respect of which the change in ownership is to be recorded should be named, and the goods and services affected should be listed and grouped in the classes and sequence of the International Classification.

***Item 7: Miscellaneous Indications***

*Rule 25(2)(b)* 64.12 Where the transferee is a natural person, his nationality may be given under (a) (whether or not this information has already been given under item 4(a)). 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 B.II.07.15).

***Item 8: Signature by the Holder or His Representative***

*Rule 25(1)(d)* 64.13 Where the request is presented directly to the International Bureau, it must be signed by the holder (or his recorded representative).

64.14 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 however question the absence of a signature from this item.

***Item 9: Signature of the Office***

*Rule 25(1)(d)* 64.15 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 and produces his own form, he may omit item 9.)

***Fee Calculation Sheet***

*See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.08.01 to 08.14).*

64.16 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 must be paid with regard to each one of them. The payment may be made by any of the different means listed in the third part of the fee calculation sheet. 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 part (a) in 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 part (b).

### **Irregular Requests**

*Rule 26* 65.01 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.

65.02 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 he must do this himself.

*Rule 5bis* 65.03 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 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 B.I.06*bis*.01 to 05.

*Rule 27(1)(c)*

### **Recording, Notification and Publication**

*Rule 27(1)(a)* 66.01 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 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 which has not been assigned or otherwise transferred (in the case of a partial change in ownership).

*Rule 27(1)(b)* 66.02 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 as of 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. With regard to the language of recording, see paragraph B.II.63.04.

*Rule 32(1)(a)(vii)*  
*Rule 6(3)*

### **Partial Change in Ownership**

*Rule 27(2)*  
*A.I. Section 16*

67.01 Where a request is made to record a change in ownership of an international registration in respect of some only of the goods and services or some only of the designated Contracting Parties, the change will be recorded in the International Register under the number of the international registration concerned. Where the change relates to all the designated Contracting Parties, the goods and services that are the subject of the change in ownership will be canceled from the international registration. 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).

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

### **Merger of International Registrations Following Change in Ownership**

*Rule 27(3)*

68.01 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.

68.02 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, as described above in paragraph B.II.67.01; there is no provision for the merging of international registrations which have come into the same ownership where they resulted from separate international applications.

68.03 There is no form (official or optional) for requesting the recording of a merger of international registrations. The request may be submitted to the International Bureau directly or through the Office of the Contracting Party of the holder.

*A.I. Section 17*

68.04 The international registration resulting from the merger will bear the number of the international registration of which a part had been assigned, together, where applicable, with a capital letter. The following examples may explain this:

– 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 parts of the international registration (each recorded under the original number plus a letter) are merged amongst themselves and each of the assigned 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 parts of the international registration (each recorded under the original number plus a letter) are merged amongst themselves, but the assigned 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.

### **Declaration that a Change in Ownership Has No Effect**

69.01 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 possibility is expressly mentioned in Article 9<sup>ter</sup>(1) of the Agreement. This might 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 it may be done because the law of the Contracting Party concerned does not allow a transfer which, in its view, would be of such a nature as to mislead the public.

*Rule 27(4)(a) to (c)* 69.02 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 of 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 (it being noted that, where the designation of the Contracting Party concerned is governed by the Agreement, the grounds on which a partial change in ownership may be declared as having no effect are limited to the grounds specified in Article 9<sup>ter</sup>(1) of the Agreement). 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)(e)* 69.03 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)(d)* 69.04 Any declaration that the change in ownership has no effect, or any final  
*and (e)* decision in respect of that declaration, will be recorded in the International Register.  
*A.I. Section 18* The part of the international registration which has been the subject of the declaration  
*Rule 32(1)(a)(xi)* 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 B.II.67.01). The relevant information will be published in the Gazette.
- Rule 27(4)(a)* 69.05 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. 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.

### **Corrections in the International Register**

- Rule 28(1)* 70.01 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.

70.02 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 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.

*Rule 28(4)* 70.03 With effect from April 1, 2002, 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. Nor does it apply to non-substantive errors such as those concerning the name or address of the holder or obvious mistakes in the list of goods and services.

*Rule 28(2)* 70.04 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 32(1)(a)(ix)*

### **Refusal Following a Correction**

*Rule 28(3)* 71.01 Any Office so notified 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.

71.02 Article 5 of the Agreement and of the Protocol, Article 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 B.II.18.01 to 18.12). Such time limits are to be counted from the date of sending the notification of the correction.

### **No Other Change in the International Register**

72.01 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).

72.02 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 which 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 application, the

registration resulting from the basic application or the basic registration, as the case may be (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 which differs from that recorded in the International Register, it is indispensable for him to file a new international application. He may rely on Article 5C(2) of the Paris Convention, according to which use of the mark in a form which 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.

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

## RENEWAL OF INTERNATIONAL REGISTRATION

*P Article 6(1)* 73.01 Under the Protocol, registration of a mark at the International Bureau is effected for a period of 10 years from the date of international registration. It is then renewable for a further 10 years upon payment of the required fees.  
*P Article 7(1)*

*A Article 6(1)* 73.02 Under the Agreement, registration of a mark is effected for a period of 20 years, and is then renewable for a further 20 years upon payment of the required fees. *Under the Regulations however, the fees must be paid in two installments of 10 years.* The requirements and provisions concerning payment of the second installment are the same as for renewal. For all practical purposes therefore, it is simplest to regard the second installment as a renewal fee.  
*A Article 7(1)*  
*Rule 10*  
*Rule 30(4)*

### Renewal Following Refusal, Renunciation or Invalidation

*Rule 30(2)(b) and* 74.01 If a refusal is recorded in the International Register under Rule 18*ter*(5) of the Common Regulations with respect to a particular Contracting Party for some or all the goods and services covered by the international registration, the holder may nevertheless request the renewal of the international registration with respect to that Contracting Party and to the refused goods and services. The payment of the renewal fees must however be accompanied by an express statement by the holder that the renewal is to be recorded in respect of that Contracting Party, and, in the case of a partial refusal, in respect of all goods and services for that Contracting Party. The reason for allowing a renewal with respect to a Contracting Party that has pronounced a refusal is that, at the time of renewal, there may still be pending a judicial or administrative procedure in respect of such refusal. The rights of the holder need to be preserved where the refusal was the subject of an appeal and no final decision had been taken by the date on which the renewal was due. A designated Contracting Party which has pronounced a refusal is of course free to determine the effects in its territory of such a renewal. This applies to any statement recorded under Rule 18*ter*(5) of the  
*(d)*

Common Regulations limiting the scope of protection. This does not apply where a provisional refusal under Rule 17 of the Common Regulations is recorded and where this provisional refusal has not yet been confirmed under Rule 18*ter*. In this situation, the international registration would be renewed for all the goods and services covered by the international registration without an express statement by the holder regarding those goods and services covered by the provisional refusal.

*Rule 30(2)(d)* 74.01*bis* Before January 1, 2015, if a partial refusal had been recorded, the international registration was automatically renewed for all goods and services, including those for which a refusal had been recorded. For international registrations for which renewal is requested on or after January 1, 2015 and for which the said renewal is due on or after that date, an international registration will be renewed only for the goods and services that are effectively protected, if any, in respect of the designated Contracting Party concerned, unless the renewal is expressly requested for all the goods and services. This change will have an impact on the amount of the renewal fee due in respect of a designated Contracting Party that has made a declaration to receive an individual fee, where this individual fee ought to be calculated taking into account the number of classes of the International Classification of Goods and Services (the Nice Classification) for which renewal is sought.

*Rule 19(1)* 74.02 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. Nor may it be renewed with respect to a Contracting Party for which a renunciation of protection has been recorded. Nor, 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, may renewal be effected with respect to those goods and services to which the invalidation, limitation or cancellation relate.

*Rule 30(2)(c)*

### **International Registrations Effected Before the Entry into Force of the Common Regulations**

75.01 In the case of an international registration effected before the entry into force of the Common Regulations (i.e., April 1, 1996):

*Rule 40(2)(c)* – where the fees were paid for 20 years, no further fees were due until the expiry of that period (except in the case where there had been a subsequent designation, see below); renewal fees would then have been due (for 10 years) under the Common Regulations;

– where the fees were paid for a first installment of 10 years and the balance for the remainder of the 20-year period had not been paid before the entry into force of the Common Regulations, renewal fees would have been due, under the Common Regulations, at the expiry of the first 10-year period.

*Rule 40(3)* 75.02 Where, after the entry into force of the Common Regulations, a subsequent designation was made in respect of an international registration for which the requisite fees had been paid for a period of 20 years, and the effective date of the

subsequent designation fell within the first 10 years (i.e., between April 1, 1996, and March 31, 2006) of this period, the complementary or individual fees paid at the time of the subsequent designation covered only the period up to the end of the first 10 years. At the end of that period, a further complementary or individual fee would have had to be paid in respect of the Contracting Party concerned by this subsequent designation. The procedure concerning the payment of that fee was the same as for a normal renewal (see paragraphs B.II.76.01 to 76.04).

### Procedure for Renewal

*A Article 7(4)* 76.01 Six months before expiry of each 10-year term of protection, the  
*P Article 7(3)* International Bureau, by sending an unofficial notice, reminds the holder of the international registration and his representative (if any) of the exact date of expiry. If  
*Rule 29* however 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(2)* 76.02 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 such changes which 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.

*Rule 30(2)(a)* 76.03 The following two situations are not regarded as a change to the international registration which, according to Article 7(2) of the Agreement and  
*Rule 30(2)(d) and* Article 7(2) of the Protocol, may not be included in the renewal: (i) the international registration may be renewed for some only of the Contracting Parties covered (in that case, the payment of fees must be accompanied by a statement listing the Contracting Parties for which no renewal is to be recorded); and (ii) the international registration is renewed for only those goods and services which are effectively protected in a given designated Contracting Parties and not for those goods and services for which a refusal has been recorded under Rule 18*ter*(5) of the Common Regulations.  
*(e)*

76.04 A system for electronic renewal of international registrations is available on the WIPO website and can be accessed under *Forms* ([www.wipo.int/madrid/en/forms](http://www.wipo.int/madrid/en/forms)) and also under *Online Services* ([www.wipo.int/madrid/en/services](http://www.wipo.int/madrid/en/services)) on the Madrid system web page. 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). Holders may however find it convenient to use the optional form (MM11) which is sent by the International Bureau to the holder and the representative with the unofficial notice of expiry. 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);
- those Contracting Parties for which a partial refusal under Rule 18*ter* of the Common Regulations is recorded, but the renewal shall nevertheless be requested for all the goods and services (item 4 – this indication needs to be made in addition to the indication in item 3);
- the signature of the holder or representative or of the Office through which the request for renewal is presented (item 5);
- 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

- Rule 30(1)* 77.01 The fees due for the renewal of an international registration consist of:
- P Article 9sexies*
- the basic fee;
  - an individual fee for the designation of each designated Contracting Party that has made the relevant declaration (see paragraph B.II.07.86) and is designated 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);
  - 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.
- P Article 9sexies(1)(b)* 77.02 Subject to Article 9*sexies*(1)(b) of the Protocol, an individual fee is payable on renewal where the designated Contracting Party concerned has opted to receive individual fees and the designation of the Contracting Party is governed by the Protocol. It may happen that there has been a change of the applicable treaty governing a designation, following the recording of a change in ownership, and this may have implications on the fees paid on renewal (see paragraph B.II.62.01). If, for example, the treaty governing a designation has changed from being the Protocol to being the Agreement, then of course it is the complementary fee, rather than the possible individual fee, that would be payable in respect of the designated Contracting Party concerned, on the renewal of that international registration. The

*Rule 30(1)* converse might occur if the change of applicable treaty were from the Agreement to the Protocol. It should be noted that there may also occur a change in the liability to pay individual fees following the recording of a change in ownership, even when there has *not* been a change in the applicable treaty.

*Rule Ibis* 77.03 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 application 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 *and* that the designation in question is a designation governed by the Protocol, 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, while there has not been a change of the treaty governing the designation in question – i.e., the designation is still governed by the Protocol – 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.

77.04 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 ([www.wipo.int/madrid/en/fees/calculator.jsp](http://www.wipo.int/madrid/en/fees/calculator.jsp)).

*A Article 7(5)*  
*P Article 7(4)*

77.05 The fees should be paid to the International Bureau by, at the latest, the date of expiry. Any payment received by the International Bureau earlier than three months before the due date is considered as having been received three months before that 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.

*Rule 34(7)(d)*

77.06 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,

– 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 fee is paid more than three months before the date on which renewal is due, the payment is considered to have been received three months before the due date, and it is the fee that was valid three months before the due date 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.

77.07 The fees may be paid directly to the International Bureau by the holder. Where however 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.

77.08 It is noted that an electronic interface (“E-Renewal”) for renewing international registrations is available on the WIPO Madrid system website at the following address: [https://webaccess.wipo.int/trademarks\\_ren/erenewal\\_en.jsp](https://webaccess.wipo.int/trademarks_ren/erenewal_en.jsp). Payment of renewal fees may be made by credit card or through a WIPO current account (see paragraph A.05.01).

*Article 8(1)* 77.09 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.

### **Renewal Fees Following Change in Applicable Treaty**

*Rule Ibis* 78.01 A change may occur in the treaty applicable to the *recorded* designation of a Contracting Party bound by both the Agreement and the Protocol (see paragraphs A.02.26 to 02.31). Depending on whether or not a given Contracting Party has made the declaration for individual fees under Article 8(7) of the Protocol, there may be a change in the amount of fees payable on renewal, following a change in the treaty applicable (see also paragraph A.04.21).

*P Article 8(7)*

### **Insufficient Fees Paid**

*Rule 30(3)(a)* 79.01 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, his representative or an Office, the International Bureau will inform accordingly that other party.

*Rule 30(3)(b)* 79.02 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 his representative accordingly.

*Rule 30(3)(c)* 79.03 There is an exception, however, to the rule just explained. Where the notification referred to in paragraph B.II.79.01 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.

79.04 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 however be made within the time within which the missing payment would have had to be made.

**Recording of the Renewal; Notification, Certificate and Publication**

- Rule 31(1)* 80.01 The International Bureau records the renewal 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(2)* 80.02 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(3)* 80.03 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(4)(b)* 80.04 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 32(1)(a)(iv)* 80.05 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 6(3)* 80.06 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 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 B.I.07.01 to 07.07).
- 80.07 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

81.01 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 B.II.77.05) 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 referred to in paragraph B.II.77.05.

## Non-Renewal

82.01 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. (This is true also in the case of subsequent designations in respect of which fees due for the second installment of 10 years – see paragraph B.II.75.02 – have not been paid).

82.02 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 B.II.79.02 to 79.04), that fact is also published in the Gazette.

*Rule 31(4)(a)*  
*Rule 32(1)(a)(xii)*

82.03 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

83.01 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.

83.02 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”.

83.03 Under the Protocol, there is an increased risk of the holder who chooses to base his international registration on an application with the Office of origin losing his 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.

83.04 In order to soften the consequences of the five-year dependency feature of the Madrid system, the Protocol provides for the holder of an international registration which is canceled as a result of the ceasing of effect of the basic application, the registration resulting therefrom, or the basic registration to apply, within three months of the date of the cancellation of the international registration in the International Register, for registration of the same mark with the Offices of all Contracting Parties whose designation are governed by the Protocol where the international registration had effect. 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. (For details, see paragraphs B.II.88.01 to 88.07).

83.05 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 however 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 does not control the basic mark (see paragraph B.II.86.01).

*Article 6(2)* 83.06 At the end of the five-year dependency period, the international registration becomes independent of the basic mark (subject to paragraphs B.II.84.01 to 84.03). 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.

### Ceasing of Effect of the Basic Application or Registration

*Article 6(3)* 84.01 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:

- 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 application, of the registration resulting therefrom or of the basic registration 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.

84.02 Under the Agreement, this provision applies also when legal protection has later ceased as the result of an action begun before the expiry of the period of five years. The Protocol contains a more detailed provision, which takes into account the possibility of a basic application; 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.

84.03 Furthermore the same rules apply under the Protocol 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 the preceding paragraph, 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 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

*Rule 22(1)(a)* 85.01 Where the basic application, the registration resulting therefrom or the basic registration 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:

- 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.

*Rule 22(1)(a)* 85.02 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:

- 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.

*Rule 22(1)(a)(iv)* 85.03 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 application, the registration resulting therefrom or the basic registration 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 6(2)* 85.04 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:

– 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 40(4)* 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 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 B.I. 07.01 to 07.07).

85.05 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 the following paragraph). 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.

*Rule 22(1)(b)* 85.06 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:

- 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.

*Rule 22(1)(c)* 85.07 Where the Office of origin has sent a preliminary notification as referred to in the preceding paragraph, 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. As from November 1, 2017 amended 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.

*Article 6(4)* 85.08 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 application, the registration resulting therefrom, or the basic registration has ceased to have effect).

85.09 It is of course possible for an Office to notify the International Bureau only 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 application, the registration resulting therefrom or the basic registration, and which thus requires cancellation of the international registration, the party who brought the action will bring it to the attention of the Office.

*Rule 22(2)* 85.10 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. As from November 1, 2017, amended Rule 22((2)(b) provides that the International Bureau must also cancel international registrations resulting from partial change in ownership recorded under the cancelled international registration, as well as those resulting from their merger.

*Rule 32(1)(a)(viii)* 85.11 Any cancellation of the international registration will be published and recorded, with an indication of the date of the cancellation. Similarly, any  
*Rule 32(1)(a)(xi)* 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.

85.12 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.

85.13 Where the notification does not comply with the requirements mentioned in paragraphs B.II.85.02 to 85.05, 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**

*Article 6(3)* 86.01 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.

### **Division or Merger of the Basic Application, the Registration Resulting Therefrom, or the Basic Registration**

*Rule 23* 87.01 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(1)* 87.02 This notification must indicate:

- 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.

*Rule 23(3)* 87.03 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 32(1)(a)(xi)* 87.04 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.

87.05 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.

87.06 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 B.II.61.07, 83.02-03 and 84.03).

## **Transformation**

*P Article* 88.01 The effect of transformation of an international registration into one or  
*9quinquies* 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.

88.02 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 B.II.85.01 to 85.06. It is not available where the international registration has been canceled at the request of the holder.

88.03 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.

88.04 In order to benefit from this provision, the national or regional application must be filed within three months of the date of cancellation of the international registration. 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.

88.05 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.

88.06 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, including requirements concerning fees. That is, it 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.

88.07 Since transformation is provided for only in the Protocol (and not in the Agreement), its benefits can be claimed only in a Contracting Party whose designation is governed by the Protocol.

### **Transformation Following Change in the Applicable Treaty**

*Rule Ibis* 89.01 A change may occur in the treaty applicable to the *recorded* designation of a Contracting Party in the International Register (see paragraphs A.02.26 to 02.31). Since the possibility of transformation is provided for under the Protocol only, a holder will become entitled to request transformation, in the appropriate circumstances, following a change in the applicable treaty from the Agreement to the Protocol, provided that this change took place, at the latest, on the date of recording of the cancellation of the international registration.

## **FACTS IN CONTRACTING PARTIES AFFECTING INTERNATIONAL REGISTRATIONS**

90.01 The following paragraphs deal with facts in designated Contracting Parties other than the refusal of protection, which is covered in paragraphs B.II.17.01 to 31.01.

### **Invalidation in a Designated Contracting Party**

*Article 5(6)* 91.01 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 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.

91.02 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.

*Rule 19* 91.03 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:

– 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)*

*Rule 1(xixbis)* 91.04 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 19(1)(vi)*

## Restriction of the Holder's Right of Disposal

- Rule 20(1)* 92.01 With effect from April 1, 2002, the scope of this provision has been greatly expanded. 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.
- 92.02 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 B.II.93.01 to 99.04).
- Rule 20(2)* 92.03 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(3)* 92.04 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
- Rule 32(1)(a)(xi)* is also published in the Gazette.

## Licenses

93.01 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 does the recording of a license in respect of a national mark. With effect from April 1, 2002, 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.

### Presentation of Request

*Rule 20bis(1)* 94.01 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.

94.02 A licensee who wishes to have his 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 in order 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.

*Rule 20(bis)(1)(b)* 94.03 The request must be presented on the official form (MM13) and must  
*A.I. Section 4(f)* indicate

- 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 B.II.07.08 and 07.09),
- 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.

94.04 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 2000<sup>3</sup>, and in Rule 10 of the Regulations under the Singapore Treaty on the Law of Trademarks<sup>4</sup>. 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.

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<sup>3</sup> WIPO publication No. 835.

<sup>4</sup> WIPO publication No. 259.

- Rule 20 bis(1)(c)* 94.05 The request may also indicate
- 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 fact<sup>5</sup>,
  - where applicable, the duration of the license.

94.06 The list in the preceding paragraph comprises additional elements which may be required by some designated Contracting Parties with respect to which the license is granted.

94.07 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 will need to be paid for each international registration mentioned in the request.

### **Irregular Request**

*Rule 20bis(2)(a)* 95.01 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)(b)* 95.02 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.

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<sup>5</sup> 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*).

- Rule 5bis* 95.03 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 B.I.06*bis*.01 to 05.
- Rule 20bis(3)*

### **Recording and Notification**

- Rule 20bis(3)* 96.01 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.

### **Declaration that the Recording of a Given License Has No Effect**

- Rule 20bis(5)* 97.01 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.

97.02 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.

97.03 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**

*Rule 20bis(6)(a)* 98.01 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 20bis(6)(b)* 98.02 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 32(2)(i)* 98.03 Any notification made as described in the above paragraphs are published in the Gazette. A holder or licensee will therefore be aware that a request to record a license in respect of a Contracting Party that has made such a notification will have no legal effect. The International Bureau will nonetheless proceed with the recording and will notify the Office of the Contracting Party concerned. There is no need for that Office to issue a declaration as described in paragraphs B.II.97.01 to 97.03 since, by virtue of the general notification under Rule 20bis(6)(a) or (b), it is to be understood that the recording has no legal effect in that Contracting Party.

### **Amendment or Cancellation of the Recording of a License**

*Rule 20bis(4)* 99.01 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 B.II.94.01 to 94.05 apply.

99.02 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.

99.03 Paragraphs B.II.94.01 and 94.02 also apply to the request for cancellation of the recording of a license. The request 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.

99.04 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**

*Article 4bis(1)* 100.01 Article 4bis of the Agreement and 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, under certain conditions, deemed to be replaced by an international registration of the same mark. These conditions are:

- both the national or regional registration and the international registration must be in the name of the same holder;
- the protection of the international registration extends to the Contracting Party in question;
- all the goods and services listed in the national or regional registration are also listed in the international registration in respect of that Contracting Party;
- 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.

100.02 Furthermore, it is expressly stated that such effect is without prejudice to any rights acquired by virtue of the earlier national or regional registration (for example, rights resulting from a priority claim or from prior use of the mark).

100.03 It is up to the holder to satisfy himself whether, in a given case, these conditions are actually fulfilled, in particular, the requirement that all the goods and services listed in the national or regional registration must also be listed in the international registration. Clearly, the international registration need not have an identical list of goods and services; the list can be broader in scope. However, it cannot be narrower. Furthermore, the names used in the international registration must, at least in their meaning, be equivalent.

100.04 The reference to the international registration being deemed to replace the national or regional registration is not to be taken as meaning that that registration is suspended or otherwise affected. It remains on the register of the Contracting Party concerned, with all the rights attaching to such a registration, as long as it is renewed by its holder.

*Article 4bis(2)* 100.05 The Office in whose national or regional register the mark is recorded is required, upon request by the holder (made direct to that Office), to take note in its register of the international registration. This should not be interpreted as a mandatory requirement in order to benefit from replacement. The wording of Article 4bis(1) clearly provides that the replacement is deemed to take place automatically, without any action by the holder being necessary and without any record having to be made of the replacement. It is however advisable, for the information of third parties, to request that the Office take note of the international registration in its register.

100.06 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 during which the international registration is dependent on the fate of the basic application, the registration resulting therefrom or the basic registration.

*Rule 21* 100.07 Where the Office of a designated Contracting Party has taken note in its Register, following a request made by the holder with that Office, that a national or regional registration has been replaced by an international registration, that Office must notify the International Bureau accordingly. Such notification 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 registration, in a form agreed between the International Bureau and the Office concerned. 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.

*Rule 32(1)(a)(xi)*

### Facts Concerning Seniority Claims

*Rule 21bis(1)* 101.01 Where a claim of seniority has been recorded in the International Register in respect of a designation of the European Union (see paragraphs B.II.07.70 to 07.72), 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 21bis(2)* 101.02 The European Union Trade Mark Regulation allows for a seniority claim to be made *subsequently* to a European Union trademark registration. Where the European Union 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:

- (i) the number of the international registration concerned,

*Rule 21bis(3)* (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.

*Rules 21bis(4) and 32(1)(a)(xi)* 101.03 Under the European Union 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.

101.04 All information notified to the International Bureau under the above paragraphs is recorded in the International Register and published in the Gazette.

## **CONTINUATION OF EFFECTS OF INTERNATIONAL REGISTRATIONS IN CERTAIN SUCCESSOR STATES**

*Rule 39* 102.01 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 Agreement, the Protocol, or both the Agreement and the Protocol are applied by the successor State.

*Rule 39(1)* 102.02 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 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 5bis* 102.02*bis* 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 B.I.06*bis*.01 to 05.

102.03 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.

- Rule 39(3)* 102.04 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(4)* 102.05 The successor State may refuse protection to the international registration only if the time limit referred to in Article 5(2) of the Agreement or 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 Agreement and 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.



