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**SPECIAL UNION FOR THE INTERNATIONAL REGISTRATION OF MARKS  
(MADRID UNION)**

**ASSEMBLY**

**Thirty-Third (14<sup>th</sup> Ordinary) Session  
Geneva, September 24 to October 3, 2001**

PROPOSALS FOR MODIFICATION OF THE COMMON REGULATIONS UNDER THE  
MADRID AGREEMENT AND PROTOCOL

*Document prepared by the International Bureau*

1. In accordance with the program and budget of WIPO for the biennium 2000-2001 (see document A/34/2, page 128), proposals for amending the Common Regulations Under the Madrid Agreement and Protocol have been prepared with the help of a Working Group convened by the Director General.
2. The Working Group, entitled “Working Group for the Modification of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto”, held two sessions, from October 9 to 13, 2000, and from June 11 to 15, 2001. The reports of the two sessions are contained in documents MM/WG/1/5 and MM/WG/2/6 respectively.
3. The Common Regulations were adopted by the Assembly of the Madrid Union in January 1996 and came into force on April 1, 1996. As their title indicates, they govern procedures under both the Agreement and the Protocol and their entry into force marked the coming into operation of the Protocol. They resulted from the discussions in the framework of the Working Group on the Application of the Madrid Protocol, which met six times between 1990 and 1994. A number of minor amendments to the Regulations were adopted by the Assembly in September 1997 and in September 2000. There has however been no general review of the Regulations since they entered into force over five years ago.
4. By and large, the Common Regulations are working well. Nonetheless, experience has shown that some of the provisions deserve substantive revision and that others would benefit from clarification and simplification. It was therefore considered opportune for the International Bureau to review, in cooperation with the Offices of the Members of the Madrid Union and taking account of the views of organizations representing users of the Madrid system and of observers from Offices of potential Contracting Parties, what changes should be made.
5. The text of the proposed amendments, as approved by the Working Group at the end of its second session, is given in Annex II to the report of the said session (MM/WG/2/6) and is reproduced in Annex I to the present document. The text of the amended provisions, showing the changes *vis-à-vis* the Common Regulations as currently in force, will be made available on the WIPO website on the Internet.

#### Summary of Amendments to the Regulations

6. The text of the Common Regulations has undergone extensive revision; the following are the most significant changes:
  - (a) several new definitions have been included in Rule 1, including a definition of “Contracting Party of the holder”; this enables the term “interested Office”, which was not defined and was widely misunderstood, to be replaced by “Office of the Contracting Party of the holder” in several rules;
  - (b) paragraph (1) of Rule 7 (which provides for the possibility for a Contracting Party to notify the Director General that it requires subsequent designations to be presented through its Office when it is the Office of origin) has been deleted; the notifications already made under this provision by six Contracting Parties remain effective, though several of these Contracting Parties have indicated that they expect to withdraw their notifications in the near future;

(c) Rule 9 (which relates *inter alia* to the contents of the international application) has been simplified; provision has also been made for the applicant to indicate that the mark consists of a color or a combination of colors as such and to include a disclaimer in respect of one or more elements of the mark;

(d) Rule 15 (which relates to the date of the international registration) has been simplified and the number of irregularities that may affect the said date has been reduced from seven to four;

(e) Rule 17 (which concerns refusal of protection) has been extensively revised; paragraph (1) makes clear that the initial notification of refusal is provisional and that it may be based on grounds raised *ex officio* or on an opposition or both; paragraph (4)(b) (which provided for the communication of information relating to the fact that an appeal against the refusal has been filed or has not been filed or has been withdrawn) has been deleted, since experience has shown that this provision was implemented by only a minority of Offices and was interpreted differently by different Offices; paragraph (5) now provides for the Office of a designated Contracting Party to send a statement indicating the goods and services for which the mark is protected once all procedures before the Office have been completed and to send a further statement where a further decision affecting the protection of the mark is taken (for example by an external appeal board or a court);

(f) Rule 18 (which relates to irregular notifications of refusal) has been revised; in particular, where a notification of refusal is received in due time but is irregular on formal grounds, the International Bureau will, in general, nonetheless record and publish the refusal; it will invite the Office that sent it to send a rectified notification within two months (as is the case at present) but there will be no legal consequences if no rectified notification is received within this period (the irregular notification, however, will not be recorded and, unless rectified, will not be considered as a notification of refusal if the irregularity is that the required information concerning the remedies available to the holder is missing);

(g) Rule 20 (which concerns the notification and recording of a restriction on the holder's right to dispose of the international registration) has been amended to allow the holder or the Office of the Contracting Party of the holder to request the recording of such a restriction in respect of the international registration with regard to all or some of the designated Contracting Parties;

(h) Rule 20*bis* is new and provides for the recording of licenses in respect of international registrations, it being understood that the sole purpose of including this provision is to enable holders of international registrations or their licensees to record licenses if they so wish and does not introduce any obligation to do so; paragraphs (1) and (3) deal with the procedure to be followed and paragraph (4) with the amendment or cancellation of the recording of a license; paragraph (5) provides for a Contracting Party to declare that the recording of a given license has no effect in its territory, it being understood that, where such declaration is made on formal grounds, it should always be open to re-examination; paragraph (6) provides for a Contracting Party to declare that the recording of licenses has no effect in its territory (see also paragraph 10(d), below);

(i) Rule 25 (dealing with requests to record a change relating to an international registration) has been amended in particular to allow a request to record a change in ownership or a limitation in the list of goods and services to be presented directly to the International Bureau by the holder even where the change affects Contracting Parties designated under the Agreement.

(j) Rule 28 (which relates to corrections in the International Register) has been amended to provide for a time limit (of nine months) for requesting the correction of an error in the International Register which is attributable to an Office where the correction of the error would affect the rights deriving from the international registration; in addition, paragraph (3) has been amended to make clear that it relates to the right of an Office to notify a refusal in respect of *the international registration as corrected*;

(k) Rule 34 (which concerns the amounts and payment of fees) has been amended by the inclusion of a new paragraph (1) which makes clear that the Schedule of Fees is annexed to the Regulations and forms an integral part thereof (the present Schedule of Fees was adopted by the Assembly in January 1996 at the same time as the Regulations); in addition, new paragraph (3) provides for a Contracting Party that makes or has made a declaration under Article 8(7) of the Protocol (requiring the payment of an individual fee) to notify the Director General that the fee payable in respect of a designation of that Contracting Party comprises two parts, the first part to be paid at the time of filing the international application or subsequent designation and the second part to be paid at a later date determined in accordance with the law of that Contracting Party (in practice, when the Office is satisfied that the mark qualifies for protection); this proposal was made at the request of the Office of Australia, which has recently become a party to the Protocol, and is intended to take account of the fact that in that country (and in other countries and intergovernmental organizations), an applicant for the registration of a trademark must pay an application fee at the time of filing and, if the application is accepted, a registration fee; the proposal is based on the solution that was adopted in order to deal with a similar situation in the framework of the Geneva Act of the Hague Agreement (see Rule 12(3) of the Regulations under the Geneva Act);

(l) the Working Group also agreed that the Schedule of Fees should be amended to provide for a fee of 177 Swiss francs to be payable for the recording of a license in respect of an international registration (this is the same amount as is charged for the recording of a change of ownership or a limitation); in addition, it is proposed that the same amount should be payable for the amendment of the recording of a license; the proposed amendment to the Schedule of Fees appears in Annex II.

7. Finally, Rule 41 is new and provides for the establishment of Administrative Instructions, as is already the case under the Hague Agreement and the Patent Cooperation Treaty. Such Administrative Instructions typically deal with matters which need to be specified in the interests of transparency and legal certainty but which are too detailed and not sufficiently substantive to warrant inclusion in the Regulations themselves. Moreover, given the nature of the matters treated in Administrative Instructions, it is convenient and appropriate to be able to amend the provisions on the initiative of the International Bureau without the need for formal submission to the Assembly of the Madrid Union. However, the Assembly is empowered to invite the Director General to modify any provision of the Administrative Instructions and the Director General is required to act accordingly.

8. Besides, according to Rule 41, the Administrative Instructions are to be established by the Director General after consulting the Offices that have a direct interest in them. The inclusion of the draft Administrative Instructions (approved at the second session of the Working Group) in Annex III to the present document serves the purpose of that consultation.

#### Understandings Reached by the Working Group Concerning the Amendments to the Regulations

9. The Working Group agreed at its second session that the Assembly would be invited to recommend that Contracting Parties that have made notifications under Rule 7(1) (see paragraph 6(b), above) take steps to withdraw them as soon as possible.

10. The Working Group also agreed that the proposals submitted to the Assembly be accompanied by interpretive statements as follows:

(a) that the reference in Rule 17(5)(b) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed, for example in the case of *restitutio in integrum*;

(b) that the references in Rule 17(6)(a)(ii) and (iii) to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations;

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

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

(e) that the necessity of providing for a time limit of nine months to request a correction under Rule 28 will be kept under review, with a view to reducing that time limit to six months in the future if experience showed that a period of six months was sufficient.

#### Date of Entry into Force

11. It is proposed that the amendments to Rule 7 and Rule 34 should enter into force at once, in order that no more notifications may be made under Rule 7(1) and in order to enable a notification in accordance with Rule 34(3) to be made immediately, to the benefit of users of the Madrid Protocol. It is proposed on the other hand that all the other amendments should enter into force on April 1, 2002, in order to give both the International Bureau and the Offices of the Contracting Parties adequate time to prepare for the implementation of the changes. The Administrative Instructions would be established to come into effect on the same date.

*12. The Assembly of the Madrid Union is invited*

*(i) to adopt the amendments to the Common Regulations, including the Schedule of Fees, as set out in Annexes I and II, and*

*(ii) to decide that the amendments to Rule 7 and Rule 34 will enter into force on October 4, 2001, and that all the other amendments will enter into force on April 1, 2002.*

*13. The Assembly is also invited to adopt the recommendation referred to in paragraph 9, above, and to endorse the interpretative statements set out in paragraph 10, above.*

[Annexes follow]

Common Regulations Under the Madrid Agreement Concerning the International  
Registration of Marks and the Protocol Relating to that Agreement

Amended Rules as Approved by the Working Group\*

*Rule 1*  
*Abbreviated Expressions*

For the purposes of these Regulations,

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

.....

(xvii**bis**) “Contracting Party whose designation is governed by the Agreement” means a Contracting Party designated under the Agreement or, where a change of ownership has been recorded and the Contracting Party of the holder is bound by the Agreement, a designated Contracting Party which is bound by the Agreement;

.....

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

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

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\* It was also agreed that, in the English version of the Common Regulations, the word “recordal” or “recordals” would be replaced by the word “recording” or “recordings” in the following provisions:

Rule 3(4) (title), Rule 3(4)(b) (twice), Rule 3(6) (title), Rule 3(6)(a) (twice), Rule 3(6)(c)(ii), Rule 3(6)(e), Rule 6(2)(b)(iii), Rule 6(3) (title), Rule 6(3)(a), Rule 6(3)(b) (twice), Rule 6(3)(c), Rule 6(4)(a) (twice), Rule 21(2) (title), Rule 22(2) (title), Rule 24(3)(c)(ii), Rule 24(7) (title), Rule 25(2)(b), Rule 25(2)(c) (twice), Rule 25(4), Rule 26 (title) (twice), Rule 26(1) (twice), Rule 26(2) (twice), Rule 31 (title), Rule 31(1) (title), Rule 36 (twice), Rule 39(3), Rule 40(2)(iii) and Rule 40(3)(d).

(xxvibis) “Contracting Party of the holder” means

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

.....

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

*Rule 2*  
*Communication with the International Bureau*

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

*Rule 3*  
*Representation Before the International Bureau*

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

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

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

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

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

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*Rule 7*  
*Notification of Certain Special Requirements*

(1) [Deleted]

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

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

(b) Any notification made under paragraph (1), as in force before October 4, 2001<sup>\*</sup>, or paragraph (2) may be withdrawn at any time. The notice of withdrawal shall be addressed to the Director General. The withdrawal shall have effect upon receipt of the notice of withdrawal by the Director General or at any later date indicated in the notice.

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\* Paragraph (1) of Rule 7 read:

“Where a Contracting Party requires that, where its Office is the Office of origin and the holder’s address is in the territory of that Contracting Party, designations made subsequently to the international registration be presented to the International Bureau by the said Office, it shall notify that requirement to the Director General.”

[This footnote is not part of Rule 7 but will be added in the published text of the Regulations; it will be deleted from such text once all notifications made under paragraph (1) of Rule 7 have been withdrawn.]

*Rule 9*  
*Requirements Concerning the International Application*

.....

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(xv) the designated Contracting Parties.

(b) The international application may also contain,

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

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

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into French if the international application is governed exclusively by the Agreement, or into English or French or both if the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol;

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(ii) be included in the international application.

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

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

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*Rule 15*  
*Date of the International Registration*

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

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

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

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

*Rule 16*  
*Time Limit for Notifying Provisional Refusal Based on an Opposition*

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

(b) Where, at the time of the communication of the information referred to in subparagraph (a), the dates on which the opposition period begins and ends are known, those dates shall be indicated in the communication. If such dates are not yet known at that time, they shall be communicated to the International Bureau at the latest at the same time as any notification of a provisional refusal based on an opposition.

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

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

*Rule 17*  
*Provisional Refusal and Statement of Grant of Protection*

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

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

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

(i) the Office making the notification,

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

(iii) [Deleted]

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

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

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

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

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

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

(5) [*Confirmation or Withdrawal of Provisional Refusal*] (a) An Office which has sent to the International Bureau a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau a statement indicating either

(i) that protection of the mark is refused in the Contracting Party concerned for all goods and services,

(ii) that the mark is protected in the Contracting Party concerned for all goods and services requested, or

(iii) the goods and services for which the mark is protected in the Contracting Party concerned.

(b) Where, following the sending of a statement in accordance with subparagraph (a), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned.



(c) The International Bureau shall record any statement received under subparagraph (a) or (b) in the International Register and shall transmit a copy thereof to the holder.

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

- (i) any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such review has been requested by the holder, and
- (ii) the decision taken on the said review may be the subject of a further review or appeal before the Office.

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

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

(6) [*Statement of Grant of Protection*] (a) An Office which has not communicated a notification of provisional refusal may, within the period applicable under Article 5(2) of the Agreement or Article 5(2)(a) or (b) of the Protocol, send to the International Bureau any of the following:

(i) a statement to the effect that all procedures before the Office have been completed and that the Office has decided to grant protection to the mark that is the subject of the international registration;

(ii) a statement to the effect that the *ex officio* examination has been completed and that the Office has found no grounds for refusal but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions may be filed;

(iii) where a statement in accordance with item (ii) has been sent, a further statement to the effect that the opposition period has expired without any opposition or observations being filed and that the Office has therefore decided to grant protection to the mark that is the subject of the international registration.

(b) The International Bureau shall record any statement received under subparagraph (a) in the International Register and shall transmit a copy to the holder.

*Rule 18*  
*Irregular Notifications of Provisional Refusal*

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

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

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

(iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of one year from the date on which the recording of the international registration or the recording of the designation made subsequently to the international registration has been effected, it being understood that the said date is the same as the date of sending the notification of the international registration or of the designation made subsequently.

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

(c) If the notification

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

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

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

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

(v) [Deleted]

(vi) does not contain, where applicable, the name and address of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)),

the International Bureau shall, except where subparagraph (d) applies, nonetheless record the provisional refusal in the International Register. The International Bureau shall invite the Office that communicated the provisional refusal to send a rectified notification within two months from the invitation and shall transmit to the holder copies of the irregular notification and of the invitation sent to the Office concerned.

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

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

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

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

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

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

*Rule 19*  
*Invalidations in Designated Contracting Parties*

.....

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

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

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

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

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

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

(3) *[Recording]* The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform accordingly the holder, the designated Contracting Parties concerned and, where the information has been given by an Office, that Office.

*Rule 20bis*  
*Licenses*

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

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

- (c) The request may also indicate
- (i) where the licensee is a natural person, the State of which the licensee is a national,
  - (ii) where the licensee is a legal entity, the legal nature of that entity and the State and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized,
  - (iii) that the license concerns only a part of the territory of a specified designated Contracting Party,
  - (iv) where the licensee has a representative, the name and address of the representative, given in accordance with the Administrative Instructions,
  - (v) where the license is an exclusive license or a sole license, that fact,
  - (vi) where applicable, the duration of the license.
- (d) The request shall be signed by the holder or by the Office through which it is presented.

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

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

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

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

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

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

(i) the reasons for which the recording of the license has no effect,

(ii) where the declaration does not affect all the goods and services to which the license relates, those which are affected by the declaration or those which are not affected by the declaration,

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

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

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

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

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

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

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

*Rule 23*

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

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

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

(ii) the name of the holder or applicant,

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

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

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

*Rule 24*

*Designation Subsequent to the International Registration*

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

(b) Where the Contracting Party of the holder is bound by the Agreement, the holder may designate, under the Agreement, any Contracting Party that is bound by the Agreement.

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

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

(i) where Rule 7(1), as in force before October 4, 2001, applies, it must be presented by the Office of origin;

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

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

(3) [*Contents*]

.....

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

.....

(5) [*Irregularities*]

.....

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

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*Rule 25*  
*Request for Recording of a Change;*  
*Request for Recording of a Cancellation*

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

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

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

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

(iv) a change in the name or address of the holder;

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

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

(c) The request for the recording of a renunciation or a cancellation may not be presented directly by the holder where the renunciation or cancellation affects any Contracting Party whose designation is governed by the Agreement.

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

(2) [*Contents of the Request*] (a) The request for the recording of a change or the request for the recording of a cancellation shall, in addition to the requested change or cancellation, contain or indicate

(i) the number of the international registration concerned,

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

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

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

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

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

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

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#### *Rule 27*

#### *Recording and Notification of a Change or of a Cancellation; Merger of International Registrations; Declaration That a Change in Ownership or a Limitation Has No Effect*

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

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

(2) [Deleted]

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

(4) [*Declaration That a Change in Ownership Has No Effect*]

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

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

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

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

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

(i) the reasons for which the limitation has no effect,

(ii) where the declaration does not affect all the goods and services to which the limitation relates, those which are affected by the declaration or those which are not affected by the declaration,

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

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

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

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

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

*Rule 28*  
*Corrections in the International Register*

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

(2) [*Notification*] The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect.

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

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

*Rule 32*  
*Gazette*

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

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(iii) provisional refusals recorded under Rule 17(4), with an indication as to whether the refusal relates to all the goods and services or only some of them but without an indication of the goods and services concerned and without the grounds for refusal, and statements and information recorded under Rule 17(5)(c) and (6)(b);

.....

(viii) cancellations effected under Rule 22(2) or recorded under Rule 27(1) or Rule 34(3)(d);

.....

(xi) information recorded under Rules 20, 20*bis*, 21, 22(2)(a), 23, 27(3) and (4) and 40(3);

.....

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

(i) any notification made under Rule 7 or Rule 20*bis*(6) and any declaration made under Rule 17(5)(d) or (e);

.....

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

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

.....

*Rule 34*  
*Amounts and Payment Of Fees*

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

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

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

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

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

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

(i) the number of the international registration concerned,

(ii) the name of the holder,

(iii) the date by which the second part of the individual fee must be paid,

(iv) where the amount of the second part of the individual fee is dependent on the number of classes of goods and services for which the mark is protected in the designated Contracting Party concerned, the number of such classes.

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

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

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

(i) before international registration, of the name of the applicant, the mark concerned and the purpose of the payment;

(ii) after international registration, of the name of the holder, the number of the international registration concerned and the purpose of the payment.

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

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

(7) *[Change in the Amount of the Fees]* (a) Where the amount of the fees payable in respect of the filing of an international application is changed between, on the one hand, the date on which the request to present the international application to the International Bureau is received, or is deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin and, on the other hand, the date of the receipt of the international application by the International Bureau, the fee that was valid on the first date shall be applicable.

(b) Where a designation under Rule 24 is presented by the Office of the Contracting Party of the holder and the amount of the fees payable in respect of that designation is changed between, on the one hand, the date of receipt, by the Office, of the request by the holder to present the said designation and, on the other hand, the date on which the designation is received by the International Bureau, the fee that was valid on the first date shall be applicable.

(c) Where paragraph (3)(a) applies, the amount of the second part of the individual fee which is valid on the later date referred to in that paragraph shall be applicable.

(d) Where the amount of the fees payable in respect of the renewal of an international registration is changed between the date of payment and the due date of the renewal, the fee that was valid on the date of payment, or on the date considered to be the date of payment under Rule 30(1)(b), shall be applicable. Where the payment is made after the due date, the fee that was valid on the due date shall be applicable.

(e) Where the amount of any fee other than the fees referred to in subparagraphs (a), (b), (c) and (d) is changed, the amount valid on the date on which the fee was received by the International Bureau shall be applicable.

*Rule 35*  
*Currency of Payments*

(1) *[Obligation to Use Swiss Currency]* All payments due under these Regulations shall be made to the International Bureau in Swiss currency irrespective of the fact that, where the fees are paid by an Office, that Office may have collected those fees in another currency.

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*Rule 38*  
*Crediting of Individual Fees to the Accounts*  
*of the Contracting Parties Concerned*

Any individual fee paid to the International Bureau in respect of a Contracting Party having made a declaration under Article 8(7)(a) of the Protocol shall be credited to the account of that Contracting Party with the International Bureau within the month following the month in the course of which the recording of the international registration, subsequent designation or renewal for which that fee has been paid was effected or the payment of the second part of the individual fee was recorded.

*Rule 41*  
*Administrative Instructions*

(1) *[Establishment of Administrative Instructions; Matters Governed by Them]* (a) The Director General shall establish Administrative Instructions. The Director General may modify them. Before establishing or modifying the Administrative Instructions, the Director General shall consult the Offices which have a direct interest in the proposed Administrative Instructions or their proposed modification.

(b) The Administrative Instructions shall deal with matters in respect of which these Regulations expressly refer to such Instructions and with details in respect of the application of these Regulations.

(2) *[Control by the Assembly]* The Assembly may invite the Director General to modify any provision of the Administrative Instructions, and the Director General shall proceed accordingly.

(3) *[Publication and Effective Date]* (a) The Administrative Instructions and any modification thereof shall be published in the Gazette.

(b) Each publication shall specify the date on which the published provisions become effective. The dates may be different for different provisions, provided that no provision may be declared effective prior to its publication in the Gazette.



(4) [*Conflict with the Agreement, the Protocol or These Regulations*] In the case of conflict between, on the one hand, any provision of the Administrative Instructions and, on the other hand any provision of the Agreement, the Protocol or these Regulations, the latter shall prevail.

[Annex II follows]

Amendment to the Schedule of Fees

*Swiss francs*

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7. *Miscellaneous recordings*

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7.5 Recording of a license in respect of an international registration  
or amendment of the recording of a license

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[Annex III follows]

Administrative Instructions for the Application of the Madrid Agreement  
Concerning the International Registration of Marks  
and the Protocol Relating Thereto

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Part One

Definitions

*Section 1: Abbreviated Expressions*

- (a) For the purposes of these Administrative Instructions:
- (i) “Regulations” means the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement;
  - (ii) “Rule” means a Rule of the Regulations.
- (b) For the purposes of these Administrative Instructions an expression which is referred to in Rule 1 has the same meaning as in the Regulations.

Part Two

Forms

*Section 2: International Application*

- (a) An international application governed exclusively by the Agreement shall be made on form MM1.
- (b) An international application governed exclusively by the Protocol shall be made on form MM2.
- (c) An international application governed by both the Agreement and the Protocol shall be made on form MM3.

*Section 3: Designation Subsequent to the International Registration*

A subsequent designation shall be made on form MM4.

*Section 4: Other Official Forms*

- (a) A request for the recording of a change in ownership shall be made on form MM5.
- (b) A request for the recording of a limitation of the list of goods and services shall be made on form MM6.
- (c) A request for the recording of a renunciation shall be made on form MM7.
- (d) A request for the recording of a cancellation shall be made on form MM8.
- (e) A request for the recording of a change in the name or address of the holder shall be made on form MM9.
- (f) A request for the recording of a license shall be made on form MM13.

*Section 5: Unofficial Forms*

- (a) A request for the recording of a change in the name or address of the representative may be made on form MM10.
- (b) A request for the renewal of an international registration may be made on form MM11.
- (c) The separate communication relating to the appointment of a representative, referred to in Rule 3(2)(b), may be made on form MM12.

Part Three

Communications with the International Bureau; Signature

*Section 6: Communication in Writing; Several Documents in One Envelope*

- (a) Subject to Section 11(a), communications addressed to the International Bureau shall be effected in writing by typewriter or other machine and shall be signed.
- (b) If several documents are mailed in one envelope, they should be accompanied by a list identifying each of them.

*Section 7: Signature*

A signature shall be handwritten, printed or stamped; it may be replaced by the affixing of a seal or, as regards the electronic communication referred to in Section 11(a) by a mode of identification agreed upon between the International Bureau and the Office concerned.

*Section 8: Communications by Telefacsimile*

Any communication may be addressed to the International Bureau by telefacsimile, provided that, where the communication must be presented on an official form, the official form is used for the purposes of the telefacsimile communication.

*Section 9: The Original Reproduction or Reproductions of the Mark*

(a) Where the international application is sent by the Office of origin to the International Bureau by telefacsimile, the original of the page of the official form bearing the reproduction or reproductions of the mark, signed by the Office of origin and containing sufficient indications to allow identification of the international application to which it relates, shall be sent to the International Bureau.

(b) Where an international application is addressed to the International Bureau by telefacsimile, examination by the International Bureau as to conformity of the international application with the applicable requirements shall start

(i) upon receipt of the original if such an original is received within a period of one month from the date on which the communication by telefacsimile was received, or

(ii) upon expiry of the period of one month referred to in subparagraph (i) if the said original is not received by the International Bureau within that period.

*Section 10: Acknowledgement and Date of Receipt of Telefacsimile by the International Bureau*

(a) The International Bureau shall promptly and by telefacsimile inform the sender of a telefacsimile communication of the receipt of that communication, and, where the telefacsimile communication received is incomplete or illegible, of that fact also, provided that the sender can be identified and can be reached by telefacsimile.

(b) Where a communication is transmitted by telefacsimile and, because of the time difference between the place from where the communication is transmitted and Geneva, the date on which the transmittal started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.

*Section 11: Electronic Communications; Acknowledgement and Date of Receipt of Electronic Transmission by the International Bureau*

(a) Where an Office so desires, communications between that Office and the International Bureau, including the presentation of the international application, shall be by electronic means in a way agreed upon between the International Bureau and the Office concerned.

(b) The International Bureau shall promptly and by electronic transmission inform the originator of an electronic transmission of the receipt of that transmission, and, where the electronic transmission received is incomplete or otherwise unusable, also of that fact, provided that the originator can be identified and can be reached.

(c) Where a communication is by electronic means and, because of the time difference between the place from where the communication is sent and Geneva, the date on which the sending started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.

#### Part Four

#### Requirements Concerning Names and Addresses

##### *Section 12: Names and Addresses*

(a) In the case of 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.

(b) In the case of a legal entity, the name to be indicated is the full official designation of the legal entity.

(c) In the case of a name in characters other than Latin characters, the indication of that name shall consist of a transliteration into Latin characters which shall follow the phonetics of the language of the international application. In the case of a legal entity whose name is in characters other than Latin characters, the said transliteration may be replaced by a translation into the language of the international application.

(d) An address shall be given in such a way as to satisfy the customary requirements for prompt postal delivery and shall consist, at least, of all the relevant administrative units up to, and including, the house number, if any; in addition, telephone and telefacsimile numbers, an e-mail address as well as a different address for correspondence may be indicated.

##### *Section 13: Address for Correspondence*

Where there are two or more applicants, new owners or licensees with different addresses, one address for correspondence shall be indicated. Where no such address is indicated, the address of the person named first shall be treated as the address for correspondence.

## Part Five

### Notification of Provisional Refusals

#### *Section 14: Date of Sending of Notification of Provisional Refusal*

In the case of a notification of provisional refusal sent through a postal service, the date of dispatch shall be determined by the postmark. If the postmark is illegible or missing, the International Bureau shall treat such notification as if it was sent 20 days before the date of its receipt by the International Bureau. However, if the date of dispatch thus determined is earlier than the date on which the refusal was pronounced, the International Bureau shall treat such notification as if it had been sent on the latter date. In the case of a notification of refusal sent through a delivery service, the date of dispatch shall be determined by the indication given by such delivery service on the basis of the details of the mailing as recorded by it.

#### *Section 15: Contents of a Notification of Provisional Refusal Based on an Opposition*

(1) A notification of provisional refusal based on an opposition shall be confined to the elements specified in Rule 17(2) and (3). The indication of the grounds on which the provisional refusal is based, in accordance with Rule 17(2)(iv), shall, in addition to stating that the refusal is based on an opposition, state concisely what are the grounds of the opposition (for example, conflict with an earlier mark or other right, lack of distinctive character). Where the opposition is based on a conflict with an earlier right other than a mark which is registered or is the subject of an application for registration, that right, and preferably the owner of that right, shall be identified as concisely as possible. The notification shall not be accompanied by memoranda or evidence.

(2) Any document accompanying the notification which is not on separate sheets of A4 paper or is otherwise not suitable for scanning, and any non-documentary item such as samples or packaging, will not be recorded and will be disposed of by the International Bureau.

## Part Six

### Numbering of International Registrations

#### *Section 16: Numbering Following Partial Change in Ownership*

(a) Assignment or other transfer of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration of which a part has been assigned or otherwise transferred.



(b) Any assigned or otherwise transferred part shall be cancelled under the number of the said international registration and recorded as a separate international registration. The separate international registration shall bear the number of the registration of which a part has been assigned or otherwise transferred, together with a capital letter.

*Section 17: Numbering Following Merger of International Registrations*

The international registration resulting from the merger of international registrations in accordance with Rule 27(3) shall bear the number of the international registration of which a part had been assigned or otherwise transferred, together, where applicable, with a capital letter.

*Section 18: Numbering Following Declaration that a Change in Ownership Has No Effect*

The separate international registration which is recorded in the International Register in accordance with Rule 27(4)(e) shall bear the number of the registration of which a part has been assigned or otherwise transferred, together with a capital letter.

Part Seven

Payment of Fees

*Section 19: Modes of Payment*

Fees may be paid to the International Bureau

- (i) by debit to a current account with the International Bureau,
- (ii) by payment into the Swiss postal cheque account or to any of the specified bank accounts of the International Bureau,
- (iii) by a banker's cheque,
- (iv) by payment in cash at the International Bureau.

[End of Annex III and of document]