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(MADRID UNION)

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PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE
MADRID AGREEMENT AND PROTOCOL

Document prepared by the International Bureau

I. INTRODUCTION

1. At its Thirty-fourth session, which took place in September 2002, the Assembly of the Madrid Union considered the question of including Spanish as an additional language of the Madrid System taking into account a study conducted by the International Bureau on the "Implications and Advantages of Including Spanish in the Language Regime of the Madrid System" (document MM/A/34/1). The Assembly noted that a large number of delegations of the Madrid Union and of observers had expressed support for the idea of including Spanish as an additional language in the Madrid system, particularly as a way of encouraging the accession of new members. The Assembly also acknowledged that other delegations, most of them also favorable to the inclusion of Spanish, had noted, however, that they needed to clarify some of the issues involved before they could take position on the question. The Assembly finally "agreed that it would revert to the question of the inclusion of Spanish as an additional language of the Madrid system at its next session and requested that the International Bureau meanwhile hold further consultations with Madrid Union members and, in the light of progress made on the issues concerned, prepare concrete proposals for consideration at that next session" (see Report, document MM/A/34/2, paragraph 38).

2. Following consultations between the International Bureau and Member States of the Madrid Union, it appears that progress has been made regarding both the issues of the possible inclusion of Spanish as an additional language of the Madrid system and of the possible accession of the European Community to the Madrid Protocol.

3. In view of these developments, two sets of amendments to the Common Regulations under the Madrid Agreement and Protocol have been prepared by the International Bureau for consideration by the Assembly of the Madrid Union. One set of proposed amendments relates to the possible accession of the European Community to the Madrid Protocol; the other concerns the possible inclusion of Spanish as an additional language of the Madrid system.

4. The text of all proposed amendments, showing the changes *vis-à-vis* the Common Regulations as currently in force, is reproduced in Annex I of the present document (the proposed to be deleted is struck through and the text proposed to be added is in bold). Corresponding explanatory notes are provided below. For the sake of clarity, these notes do not follow the numerical order of the proposed amended Rules but are set out separately for each of the issues concerned.

5. Where a provision does not require explanation, no note has been provided.

II. PROPOSED AMENDMENTS RELATED TO THE POSSIBLE ACCESSION OF THE EUROPEAN COMMUNITY TO THE MADRID PROTOCOL (Rules 9(5)(g), 14(2)(vi), 21*bis*, 24, 32(1)(a)(v) and (xi) and 36(viii))

6. In the event of the accession of the European Community to the Madrid Protocol, a number of amendments to the Common Regulations would be required in order to take special account of some specific features of the Community Trade Marks system, arising from its regional nature. It is noted that the proposed amendments to Rules 9(5)(g), 14(2)(vi), 21*bis*, 24, 32(1)(a)(v) and (xi) and 36(viii) have been prepared by the International Bureau after consultation with the services of the European Commission. Moreover, the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) has been closely involved in the preparatory technical work.

Notes on Rule 9

7. The proposed new Rule 9(5)(g) is designed to take account of two features which are particular to the Community Trade Marks system: the concept of seniority and the indication of a second language of proceedings before OHIM.

8. Item (i) of Rule 9(5)(g) deals with the issue of seniority. The proprietor of an earlier mark registered in or for a Member State who applies for registration of an identical mark with OHIM for goods or services which are covered by the earlier mark, may claim the seniority of that earlier trademark in respect of the Member State concerned. The effect of such a seniority claim is that where the proprietor of the Community trademark surrenders the earlier trademark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trademark had continued to be registered (Article 34(2) of the Community Trade Mark Regulation).

9. Under Rule 9(5)(g)(i) as proposed, international applicants wishing to claim seniority in respect of a designation of the European Community under the Madrid Protocol would be required to indicate the four elements listed in that provision, which correspond to those needed by OHIM (namely, each Member State in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration and the goods and services for which the earlier mark is registered).

10. Given that such elements could only be furnished where the European Community is designated, and in order not to unnecessarily encumber the international application form, Rule 9(5)(g)(i) provides also that these indications be made on a *separate* official form, to be annexed to the international application form. Section 4 of the Administrative Instructions would be amended accordingly (see Annex II).

11. Item (ii) of Rule 9(5)(g) requires international applicants designating the European Community to indicate a second language (in addition to the language of the international application) for the purposes of procedures which may be lodged before OHIM. This second language, which must be one of the five official languages of OHIM (namely, English, French, German, Italian or Spanish), would serve exclusively as a language in which third parties may lodge opposition and cancellation proceedings before OHIM.

Note on Rule 14

12. The proposed amendment to Rule 14 aims at providing that a number of indications relating to a claim of seniority shall be recorded in the International Register and published in the Gazette (namely, the date and registration number of the earlier mark from which seniority is claimed, and the Member State in which it is registered). The remaining indications referred to in Rule 9(5)(g) (list of goods and services for which the earlier mark is registered and the indication of a second language) will not be recorded in the International Register or published in the Gazette. OHIM will, however, receive the notification of the international registration concerned, and its annex, containing all such information and will publish them in its own Community Trade Marks Bulletin.

Notes on Rule 21 bis

13. The proposed new Rule 21 *bis* is intended to reflect a number of operations which may arise in relation to a seniority claim under the Community Trade Marks system.

14. Paragraph (1). Any claim of seniority in respect of a designation of the European Community would have to be examined by OHIM, which may either accept or reject it in accordance with its applicable legislation. Provision has been made in Rule 21 *bis*(1) to require that where OHIM *refuses* the validity of such claim and to the extent that this decision is final, that fact must be notified to the International Bureau. Where the seniority claim has been *accepted* by OHIM, Rule 21 *bis*(1) does not provide for any notification to be sent to the International Bureau since the previous recording of such claim in the International Register and its publication in the Gazette would not require any modification.

15. Paragraph(2). The Community Trade Mark Regulation allows for a seniority claim to be made *subsequent* to a Community trademark registration. It results firstly from Rule 21 *bis*(2) that where the European Community is designated in an international registration, any such “late” seniority claim would be required to be presented *directly with OHIM*. Moreover, if that seniority claim is refused by OHIM following its examination, there is clearly no reason to provide for a corresponding notification to the International Bureau (since there is no recording of this claim in the International Register). It is therefore only where a late seniority claim has been *accepted* by OHIM that, according to Rule 21 *bis*(2), the relevant information would be required to be notified to the International Bureau, recorded in the International Register and published in the Gazette (for the information of third parties).

16. Paragraph(3). Under the Community Trade Marks system, a seniority claim which has been accepted by OHIM may subsequently cease to have effect (following, in particular, a withdrawal or a cancellation). Therefore, where the corresponding claim has been recorded in the International Register, Rule 21 *bis*(3) provides that any further final decision affecting such claim, including withdrawal and cancellation, must be notified by OHIM to the International Bureau. Such information will be recorded in the International Register and published in the Gazette.

Notes on Rule 24

17. The proposed amendment to Rule 24 concerns, on the one hand, the subsequent designation of a Contracting Organization (see paragraphs 18 and 19 below) and, on the other hand, the possibility of designating subsequently Member States of a Contracting Organization following a request for conversion (these so-called “opting -back” provision; see paragraphs 20 to 27 below).

Subsequent Designation of a Contracting Organization

18. Paragraph(3)(c)(iii). To the extent that the designation of a Contracting Party may take place not only at the stage of the international application but also subsequently to the international registration, it is also necessary to provide that the particulars relating to seniority claim and to the indication of a second language, as referred to in Rule 9(5)(g) (see paragraphs 7 to 11 above), may be furnished where the Contracting Organization is designated subsequently to the international registration.

19. For the sake of simplicity, it is suggested that the annexed official form on which such indications would be furnished as part of a subsequent designation be the same as that used for designation of the Contracting Organization at the stage of the international application (see proposed Section 4(i) of the Administrative Instruction in Annex II).

Subsequent Designation of a Member State of a Contracting Organization Resulting from Conversion (“opting -back” Provision)

20. Under the Community Trade Marks system, where a Community trademark application is withdrawn or refused, or where a Community trademark registration ceases to have effect, the proprietor of that Community trademark may request its conversion into a *national* trademark application with the Office of one or more Member States of the European Community.

21. The effect of a conversion is that the national trademark application resulting from conversion is allocated the same filing date as that of the Community trademark application or registration (and enjoys, if applicable, the same priority date and *seniority* claimed), provided in particular that the request for conversion is filed within a three *-month* time limit following the withdrawal, refusal or ceasing of effect of the Community trademark.

22. Having regard to this feature of the Community Trade Marks system, it is proposed that Rule 24 of the Common Regulations be amended in order to provide that, where a Contracting Organization is designated in an international registration and to the extent that such designation has been withdrawn, refused or has ceased to have effect, conversion may also be requested through designation of its Member States *under the Madrid system*. This mechanism, offering the holder of an international registration the option of converting the designation of the European Community into *either* a national application filed directly with the Office of a Member State *or* a designation of that Member State under the Madrid system, is often referred to as the “opting -back” provision.

23. The principle of such subsequent designation resulting from conversion has been introduced in a new paragraph(7), and is subject to four main requirements.

24. Firstly, as regards the presentation to the International Bureau of a subsequent designation resulting from conversion, a new item(iii) of paragraph(2)(a) requires a subsequent designation resulting from conversion to be presented to the International Bureau by the Office of the Contracting Organization. This implies in particular that the said Office will have to determine, before transmitting the subsequent designation resulting from conversion to the International Bureau, whether such request complies with the necessary conditions under its own legislation (in particular, whether requirements concerning *time* limits have been complied with).

25. Secondly, in Rule 24(7)(b) as proposed, the contents of a subsequent designation resulting from conversion have required adaptation by:

- omitting the indications referred to in items (iv) and (vi) of paragraph(3)(a), which are irrelevant in the case of subsequent designations resulting from conversion, and
- providing for additional indications listed in items (i) and (ii).

26. Thirdly, Rule 24(6) deals with the date of a subsequent designation and has been supplemented by a new subparagraph(e), so as to provide that a subsequent designation resulting from conversions shall bear the date on which the designation of the *Contracting Organization* was recorded in the International Register (which is the very purpose of the optional back-provision).

27. Lastly, in order to avoid any misunderstanding as to the type of subsequent designation concerned, it is proposed that a subsequent designation resulting from conversion be presented on a distinct official form. Therefore, Section 3 of the Administrative Instructions would be amended accordingly (see Annex II).

III. PROPOSED AMENDMENTS RELATED TO THE POSSIBLE INCLUSION OF SPANISH AS AN ADDITIONAL LANGUAGE OF THE MADRID SYSTEM (Rules 6, 7(2), 9(4)(b)(iii) and 40(4))

28. Two alternative sets of amendments are being proposed concerning the inclusion of Spanish as an additional language of the Madrid system, each set reflecting one of the two scenarios considered by the Assembly of the Madrid Union in 2002 and described in document MM/A/34/1 entitled "Implications and Advantages of Including Spanish in the Language Regime of the Madrid System."

Notes on Rule 6 (Scenario A)

29. Under Scenario A, Spanish is put on the same footing as English. This implies that the use of Spanish, as of English, would be allowed insofar as the provisions of the *Protocol* are applicable in respect of the international application or registration concerned (for more details, see paragraphs 25 to 30 of document MM/A/34/1).

30. If Scenario A is chosen, paragraphs (1)(b) and (2)(b) are proposed to be amended so as to provide that an international application, and other communications relating thereto (such as requests for the recording of changes in ownership, limitations, licenses, etc.), may be made in Spanish, in addition to English or French, provided that the international application or registration concerned is governed exclusively by the Protocol or by both the Agreement and the Protocol. Where a communication, including the international application, is transmitted to the International Bureau through the intermediary of an Office, however, that Office would remain entitled to restrict the choice of the applicant or holder to only *one* language, or to two languages, or could permit the applicant or holder to choose between any of the three languages (Rule 6(1)(b) *in fine*). International applications governed *exclusively* by the Agreement, and other communications relating thereto, would continue to be filed in French only, as set forth in paragraphs (1)(a) and (2)(a) which would remain unchanged.

31. Regarding the language of communications addressed by the International Bureau to Offices of designated Contracting Parties, item (iii) of paragraph (2)(b) is proposed to be amended with a view to maintaining the principle that such communications be addressed in the language of the international application, unless the Office concerned has notified the International Bureau that any such notifications are to be in English, or in French or in Spanish. That would enable an Office not to accept notifications in a prescribed language (or in two such languages) and to indicate to the International Bureau which other language should be used instead.

32. Paragraph(3)(b), dealing with the language of recordings in the International Register and publication in the Gazette, is proposed to be amended so as to provide that, where the data concerned relate to an international registration governed in whole or in part by the Protocol, these recordings and publications will be made in Spanish (in addition to English and French). Data relating to international registrations governed *exclusively* by the Agreement would continue to be recorded and published in French only, pursuant to subparagraph (a), which would remain unchanged.

33. Paragraph(3)(c) is proposed to be amended so as to provide that international registrations that have already been published only in French, or only in English and French, be published/republished in the three working languages of the Madrid system following a first¹ subsequent designation *made under the Protocol*.

*Notes on Rule 6
(Scenario B)*

34. Scenario B provides for full integration of English, French and Spanish. This implies that all international applications, and other communications relating thereto, could be filed in English, French or Spanish, regardless of whether the international application is governed by the Agreement, by the Protocol or by both treaties. In addition, all recordings in the International Register and all publication in the Gazette would be made in English, French and Spanish (for more details, see paragraphs 31 to 37 of document MM/A/34/1).

35. If Scenario B is chosen, all references in paragraphs(1) to (3)(a) to the treaty or treaties, Agreement and/or Protocol, governing an international application are proposed to be deleted, so as to provide that all international applications and all other communications relating thereto may be filed in any of the three working languages, and that all recordings and publications will be made in English, French and Spanish. As in Scenario A (see paragraph 30 above), it results also from Scenario B that where a communication is transmitted to the International Bureau through the intermediary of an Office, such Office would be entitled to restrict the choice of the applicant or holder to only one language, or to two languages, or could permit the applicant or holder to choose between the three languages. Likewise, under paragraph (2)(b)(iii) as proposed, the principle would remain that communications addressed by the International Bureau to Offices of designated Contracting Parties would be in the language of the international application, unless the Office concerned has notified the International Bureau that any such notifications are to be in English, in French or in Spanish.

36. Proposed paragraph(3)(b) (formerly paragraph(3)(c)) provides that an international registration that has already been published only in French, or only in English and French, will be published/republished in the three working languages of the Madrid system where it is the subject of *any* subsequent designation (not necessarily *made under the Protocol*). The last sentence of paragraph(3)(b) becomes unnecessary under Scenario B and would therefore be deleted.

¹ It being understood that the “first” subsequent designation to be taken into account would be the first made *as from the date of entry in force of Rule 6 as amended*.

Note on Rule 9
(Scenarios A and B)

37. Paragraph (4)(b)(iii) is proposed to be amended so as to provide that international applications governed exclusively or partly by the Protocol (under Scenario A), or *all* international applications (under Scenario B) may include a translation into Spanish of the word or words contained in the mark.

Notes on Rule 40
(Scenarios A and B)

38. The first sentence of Rule 40(4) specifies that the new linguistic regime proposed under Scenario A or B above would apply only in respect of international applications and other communications filed *as from the date of entry into force of Rule 6 as amended*.

39. The second sentence of Rule 40(4) specifies however that, once the trilingual regime enters into force, the "previous" linguistic regimes shall cease to apply in respect of a given international registration following a first subsequent designation *made under the Protocol* (under Scenario A) or following *any* subsequent designation (under Scenario B). A similar principle concerning the transition from one language regime to another is already contained in current Rule 6(3)(c).

Financial Implications Resulting from the Inclusion of Spanish as an Additional Language of the Madrid System

40. The overall financial implications resulting from the inclusion of Spanish as an additional language of the Madrid system were analyzed in detail in the study submitted to the Madrid Union Assembly in September 2002 (document MM/A/34/1, paragraphs 59 to 69). The financial implications outlined in that study were recalculated on the basis of the level of activities of the International Trademark Registry in 2001.

41. In the process of preparing proposals for the Program and Budget 2004 - 2005, the International Bureau reviewed the financial implications of including Spanish as an additional language in the Madrid system taking into account the expected level of activities of the International Trademark Registry for the biennium 2004 - 2005. As indicated in the proposed Program and Budget 2004 - 2005 (document WO/PBC/6/2, paragraph 100), a decision to the effect of including Spanish as an additional language of the Madrid system would require the establishment of either 8.5 or 16 additional translator posts under, respectively, Scenario A or Scenario B. Resource allocations under the proposed Program and Budget 2004 - 2005 would suffice to cover all other costs resulting from the inclusion of Spanish as an additional language, including, in particular, costs related to the adaptation of computer programs and the estimated additional costs for the publication of the WIPO Gazette in three languages.

42. It should also be recalled that, in view of the overall financial situation of the Madrid Union, the International Bureau does not anticipate a need to modify the current Schedule of Fees of the Madrid system if Spanish were to become an additional language of the system.

IV. DATE OF ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

43. In order to give both the Offices of the Contracting Parties and the International Bureau adequate time to prepare for the implementation of the proposed amendments to the Common Regulations, it is proposed that the amendments in respect of Rules 9(5)(g), 14(2)(vi), 21 *bis*, 24, 32(1)(a)(v) and (xi) and 36(viii), related to accession by the European Community to the Madrid Protocol, and in respect of Rules 6, 7(2), 9(4)(b)(iii) and 40(4), either under Scenario A or under Scenario B, related to the inclusion of Spanish as an additional language of the Madrid system, should enter into force on April 1, 2004.

V. PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS

44. The proposed amendments related to the accession of the European Community to the Madrid Protocol would also require certain amendments to be made to Sections 3 and 4 of the Administrative Instructions (in order to take into account the two additional official forms referred to in paragraphs 10 and 27). Sections 3 and 4 as amended are reproduced in Annex II of this document. These amended Administrative Instructions would be established to come into effect on the same date as that of entry into force of the amended provisions of the Common Regulations.

45. Under Rule 41 of the Common Regulations, Administrative Instructions are to be established by the Director General after consulting the Offices directly interested. The inclusion of the proposed amendments to Sections 3 and 4 of the Administrative Instructions in the present document serves the purpose of such consultation.

46. The Assembly of the Madrid Union is invited

*(i) to adopt the amendments to the Common Regulations in respect of Rules 9(5)(g), 14(2)(vi), 21 *bis*, 24, 32(1)(a)(v) and (xi) and 36(viii), as set out in Annex I;*

(ii) to decide whether, in respect of Rules 6, 7(2), 9(4)(b)(iii) and 40(4), Scenario A or Scenario B should be chosen and adopt the amendments to these provisions, as set out in Annex I, accordingly; and

(iii) to decide that all these amendments enter into force on April 1, 2004.

[Annex I follows]

ANNEXI

PROPOSED CHANGES TO THE COMMON REGULATIONS UNDER THE MADRID
AGREEMENT AND PROTOCOLRule 6
Languages

Scenario A

(1) [International Application] (a) An international application governed exclusively by the Agreement shall be in French.

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(b) An international application governed exclusively by the Protocol or governed by both the Agreement and the Protocol shall be in English, French or Spanish according to what is prescribed by the Office of origin, it being understood that the Office of origin may allow applicants to choose between English, French and Spanish.

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(2) [Communications Other Than the International Application] (a) Any communication concerning an international application governed exclusively by the Agreement or the international registration resulting therefrom shall, subject to Rule 17(2)(v) and (3), be in French, except that, where the international registration resulting from an international application governed exclusively by the Agreement is or has been the subject of a subsequent designation under the Protocol, the provisions of sub-paragraph (b) shall apply.

(b) Any communication concerning an international application governed exclusively by the Protocol or governed by both the Agreement and the Protocol, or the international registration resulting therefrom, shall, subject to Rule 17(2)(v) and (3), be

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

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

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

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

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Supprimé : although the language of the international application is

(3) [Recording and Publication] (a) Where the international application is governed exclusively by the Agreement, the recording in the International Register and the publication in the Gazette of the international registration resulting therefrom and of any data to be both

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recorded and published under these Regulations in respect of that international registration shall be in French.

(b) Where the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol, the recording in the International Register and the publication in the Gazette of the international registration resulting therefrom and of any data to be both recorded and published under these Regulations in respect of that international registration shall be in English, French and Spanish. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

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(c) ~~Where a first~~ subsequent designation ~~is~~ made under the Protocol, in respect of ~~an~~ international registration ~~that has been published only in French, or only in English and French~~, the International Bureau shall, together with the publication in the Gazette of that subsequent designation, ~~either~~ publish the international registration in English and Spanish and republish the international registration in French, ~~or publish the international registration in Spanish and republish it in English and French, as the case may be~~. That subsequent designation shall be recorded in the International Register in English, French and Spanish. ~~Thereafter,~~ the recording in the International Register and the publication in the Gazette of any data to be both recorded and published under these Regulations in respect of the international registration concerned shall be in English, French and Spanish.

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

Supprimé : from English into French or from French into English

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

Rule 6
Languages

Scenario B

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

(2) [Communications Other Than the International Application]

Any communication concerning an international application or the international registration resulting therefrom, shall, subject to Rule 17(2)(v) and (3), be

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

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

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

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

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Supprimé : governed exclusively by the Agreement shall be in French.

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(b) Any international application governed exclusively by the Protocol or governed by both the Agreement and the Protocol

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Supprimé : (a) Any communication concerning an international application or the international registration resulting therefrom shall, subject to Rule 17(2)(v) and (3), be in French, except that, where the international registration resulting from an international application governed exclusively by the Agreement or has been the subject of a subsequent designation under the Protocol, the provisions of subparagraph (b) shall apply.

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Supprimé : or in French although the language of the international application is English

(3) [Recording and Publication] (a)

The recording in the International Register and the publication in the Gazette of an international registration and of any data to be both recorded and published under these Regulations in respect of that international registration shall be in English, French and Spanish. The recording and publication of the international registrations shall indicate the language in which the international application was received by the International Bureau.

Supprimé : Where the international application is governed exclusively by the Agreement, the recording in the International Register and the publication in the Gazette of the international registration resulting therefrom and of any data to be both recorded and published under these Regulations in respect of that international registration shall be in French.

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

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... (b) ... Where the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol, t

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Supprimé : Thereafter, that subsequent designation shall be recorded in the International Register in English and French. The recording in the International Register and the publication in the Gazette of any data to be both recorded and published under these Regulations in respect of the international registration concerned shall be in English and French.

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

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

Rule 7
Notification of Certain Special Requirements

[...]

(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, ~~French~~ ~~or Spanish~~, the notification shall specify the required language.

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[...]

Rule 9
Requirements Concerning the International Application

(4) *[Content of the International Application]*

[...]

(b) The international application may also contain,

[...]

Scenario A. (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 ~~French~~ ~~and/or Spanish~~ if the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol;

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Scenario B. (iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words ~~into English~~ ~~French~~ ~~and/or Spanish~~;

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Supprimé : both if the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol

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

[...]

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

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

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

Rule 14

Registration of the Mark in the International Register

(2) *[Content of the Registration]* The international registrations shall contain

[...]

(vi) indications annexed to the international application in accordance with Rule 9(5)(g)(i) concerning the Member State or Member States in or for which an earlier mark, from which seniority is claimed, is registered, the date from which the registration of that earlier mark was effective and the number of the relevant registration.

Rule 21bis

Other Facts Concerning Seniority Claim

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

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

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

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

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

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

Rule 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 20 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 redesignated under the Agreement, the subsequent designation must be presented by the Office of the Contracting Party of the holder

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

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

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

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(i) the number of the international registration concerned,

(ii) the name and address of the holder,

(iii) the Contracting Party that is designated,

(iv) where the subsequent designation is for all the goods and services listed in the international registration concerned, that fact, or, where the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services,

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

(vi) where the subsequent designation is presented by an Office, the date on which it was received by that Office.

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

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

(ii) be included in the subsequent designation.

(c) The subsequent designation may also contain

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

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

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

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

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

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

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

(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraph (1)(b) or (c) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designations 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.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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Rule 32
Gazette

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

[...]

(v) subsequent designations recorded under Rule 24(8);

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[...]

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

Rule 36
Exemption From Fees

Recording of the following shall be exempt from fees:

[...]

(viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rule 17(5) or (6) or any declaration under Rule 20 bis(5) or Rule 27(4) or (5),

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[...]

Rule 40
Entry into Force; Transitional Provisions

Scenario A

[...]

(4) [Transitional Provisions Concerning Languages] Rule 6 as in force before [date of entry into force of Rule 6 as amended] shall continue to apply to any international application which was received, or in accordance with Rule 11(1)(a) or (c) is deemed to have been received, by the Office of origin before that date, to any international registration resulting therefrom and to any communication relating thereto. Rule 6 as in force before [date of entry into force of Rule 6 as amended] shall cease to apply where a subsequent designation under the Protocol is filed directly with the International Bureau or is filed with the Office of the Contracting Party of the holder on or after the date, provided that the subsequent designation is recorded in the International Register.

Scenario B

[...]

(4) [Transitional Provisions Concerning Languages] Rule 6 as in force before [date of entry into force of Rule 6 as amended] shall continue to apply to any international application which was received, or in accordance with Rule 11(1)(a) or (c) is deemed to have been received, by the Office of origin before that date, to any international registration resulting therefrom and to any communication relating thereto. Rule 6 as in force before [date of entry into force of Rule 6 as amended] shall cease to apply where a subsequent designation is filed directly with the International Bureau or is filed with the Office of the Contracting Party of the holder on or after that date, provided that the subsequent designation is recorded in the International Register.

[Annex II follows]

PROPOSEDCHANGESTO ADMINISTRATIVEINSTR UCTIONSFOR THE
APPLICATIONOF THE MADRID AGREEMENT AND THE MADRID PROTOCOL

Section 3: Designation Subsequent to the International Registration

(a) A subsequent designation resulting from conversion pursuant to Rule 24(7) shall be made on form MM1 6

(b) ~~Any other~~ subsequent designations shall be made on form MM4

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[...]

Section 4: Other Official Forms

[...]

(i) Where an international application or a subsequent designation contains the designation of a Contracting Organization, the indications referred to in Rule 9(5)(g) (i) shall be made on form MM1 7 which shall be annexed to the international application or to the subsequent designation, as the case may be.

[End of Annex II and of document]