

# WIPO



MM/A/38/2

ORIGINAL: English

DATE: July 23, 2007

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

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

**ASSEMBLY**

**Thirty-Eighth (17<sup>th</sup> Ordinary) Session  
Geneva, September 24 to October 3, 2007**

**REVIEW OF THE SAFEGUARD CLAUSE AND RELATED AMENDMENTS OF THE  
MADRID PROTOCOL AND OF THE COMMON REGULATIONS**

*Document prepared by the International Bureau*

## I. INTRODUCTION

1. Article 9*sexies*(1) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol” and “the Agreement”, respectively), commonly known as the “safeguard clause”, provides that where, with regard to a given international application or international registration, the country of origin is party to both the Protocol and the Agreement, the provisions of the Protocol shall have no effect in the territory of any other State that is also party to both the Protocol and the Agreement.

2. In simple terms, in the relations between States bound by both treaties, it is the provisions of the Agreement which apply as part of the international registration procedure.

3. Under paragraph (2) of Article 9*sexies*, the Assembly of the Madrid Union (hereinafter referred to as “the Assembly”) may, by a three-fourths majority<sup>1</sup>, either repeal or restrict the scope of the safeguard clause, after the expiry of a period of 10 years from the entry into force of the Protocol (December 1, 1995), but not before the expiry of a period of five years from the date on which the majority of States party to the Madrid (Stockholm) Agreement have become party to the Protocol. To the extent that this latter condition has also been fulfilled<sup>2</sup>, repeal or restriction of the scope of the safeguard clause became possible on the tenth anniversary of the coming into force of the Protocol, namely, on December 1, 2005.

4. The *ad hoc* Working Group on the Legal Development of the Madrid system for the International Registration of Marks (hereinafter referred to as “the Working Group”) was convened by the Director General in order to, *inter alia*, facilitate the review of the safeguard clause envisaged by Article 9*sexies*(2) of the Protocol. It held four sessions between July 2005 and June 2007, with the last session leading to an agreement to recommend to the Assembly a compromise solution consisting in a repeal of the safeguard clause accompanied by an increase of the amount of the complementary and supplementary fees.

5. The main purpose of the present document is to submit, for adoption by the Assembly, all the necessary amendments to implement this compromise solution, as recommended by the Working Group. The document is structured as follows:

– Chapter II first recalls the conclusions and recommendations of the Working Group following each of its four meetings, as well as the operational consequences associated with the proposed repeal of the safeguard clause, and invites the Assembly to take note of these;

– Chapter III contains the respective submissions for the adoption of the two elements of the compromise solution, namely, on the one hand, the amendment of Article 9*sexies* of the Protocol and, on the other hand, the increase of the amount of the complementary and supplementary fees;

– Chapter IV contains the submission for the adoption of the consequential and related amendments to the Common Regulations, including the Schedule of Fees, as listed in paragraph 23, below, or referred to in paragraph 12, below, respectively.

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<sup>1</sup> Article 9*sexies*(2) further provides that in the vote of the Assembly, only those States which are party to *both* the Agreement and the Protocol shall have the right to participate. This is accounted for by the fact that, by definition, the safeguard clause only comes into play in the mutual relations between States bound by both treaties.

<sup>2</sup> This condition has been fulfilled since April 1, 2003, following the (simultaneous) accession to the Protocol of Belgium, Luxembourg and the Netherlands, with effect from April 1, 1998. At that time, out of 39 countries party to the Madrid Agreement, 21 had become party to the Protocol.

6. Chapters III and IV also provide notes in support of the proposed amendments. In addition to these, it should be noted that the consideration of the present document should follow that of document MM/A/38/1, submitting a proposal for the adoption of a new Rule *1bis* to provide, in certain circumstances, for a change of the treaty applicable to a recorded designation. This rule would become the key implementing provision of the repeal of the safeguard clause, as per its subparagraph (1)(i), all recorded designations that were until then governed by the Agreement by virtue of the safeguard clause would, following the repeal of the latter, become governed by the Protocol.

## II. CONCLUSIONS AND RECOMMENDATIONS OF THE WORKING GROUP, AND OPERATIONAL CONSEQUENCES OF THE PROPOSED REPEAL OF THE SAFEGUARD CLAUSE

### First Session of the Working Group – July 4 to 8, 2005

7. At its first session, the Working Group undertook a primary analysis of the implications of a repeal of the safeguard clause with respect to six features of the Madrid system procedure. The Working Group concluded, in principle, that the safeguard clause should no longer be maintained with regard to four of those features, namely, the required basis for filing an international application, the determination of the entitlement to file according to the “cascade” principle, the presentation of subsequent designations and requests for the recording of renunciations and cancellations, and the possibility of transformation. However, the Working Group was unable to reach a consensus as to whether the safeguard clause should or should not be maintained with regard to two further features of the Madrid system procedure, namely, the time period for the notification of provisional refusals and the fee system.

8. On another question, namely, the use of languages under the Madrid system, a feature which is only *indirectly* concerned by the application of the safeguard clause, the Working Group recommended at its first session that the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as the “Common Regulations”) be amended so as to provide for the application of all three languages (English, French and Spanish) in the mutual relations between States bound by both treaties.

9. At its thirty-sixth session (September-October 2005), the Assembly of the Madrid Union took note of the conclusions of the Working Group and decided that the Director General should convene a further meeting of the Working Group to, *inter alia*, continue the preparatory work for a review of Article 9*sexies*(1) of the Protocol (documents MM/A/36/3, paragraph 15 and MM/A/36/1, paragraph 18).

Second Session of the Working Group – June 12 to 16, 2006

10. On the occasion of its second session, the Working Group considered five options in the context of the review of the safeguard clause<sup>3</sup>. Despite the divergence of views expressed, there emerged a consensus on the objectives to be achieved by the review of the safeguard clause, namely, to:

(a) simplify, as much as possible, the operation of the Madrid system, keeping in mind the ultimate goal that the system be governed by only one treaty;

(b) ensure equal treatment among all Contracting Parties to the Madrid Protocol;

(c) allow users of States which are today bound by both the Agreement and the Protocol to be able to benefit from the advantages offered by the Protocol, while limiting undesired effects that might affect them as a result of the application of the Protocol.

11. The Working Group thus concluded that it should continue its preparatory work for a review of the safeguard clause with the aim of achieving the aforementioned objectives.

12. On the occasion of this second session, the Working Group also considered the operational consequences of a repeal or restriction of the safeguard clause on the use of languages under the Madrid system. It first noted that a repeal or restriction of the safeguard clause would automatically entail an extended application of the existing trilingual regime and, consequently, a significant increase in the volume of translation work to be undertaken by the International Bureau. It also noted that, without any further significant cost implications, a full trilingual regime could be implemented (i.e., a regime whereby French, English and Spanish would be working languages, even in situations where the Agreement alone applies) if a decision to that effect were taken in the context of a repeal or restriction of the safeguard clause. The Working Group noted that the introduction of a full trilingual regime would be advantageous both for users and Offices of Contracting Parties as it would offer more opportunities for the choice of language and would result in substantial simplification of the overall language regime of the Madrid system. The Working Group thus

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<sup>3</sup> Those options were the following:

Option 1: Maintaining the safeguard clause.

Option 2: Repeal of the safeguard clause.

Option 3: Repeal of the safeguard clause accompanied by certain measures aimed at limiting undesired effects that might result from such repeal.

Option 4: Restriction of the scope of the safeguard clause to cover only certain features of the international procedure (in particular, the refusal period and the fee system).

Option 5: Restriction of the safeguard clause to cover only existing international registrations or designations (“freezing”).

For the full report of that session, see document MM/LD/WG/2/11. It is also recalled that an analysis of the implications and operational consequences associated with each of those options was provided in document MM/LD/WG/2/3, entitled “Review of Article 9*sexies* of the Protocol”.

considered and approved draft amendments to the Common Regulations for the implementation of a full trilingual regime and recommended that these be submitted for adoption by the Assembly on the occasion of the review of the safeguard clause<sup>4</sup>.

13. At its thirty-seventh session (September-October 2006), the Assembly of the Madrid Union endorsed the conclusion recalled in paragraph 11, above, and requested the Director General to convene a further session of the Working Group in order to, inter alia, continue the preparatory work for a review of the safeguard clause to be undertaken by the Assembly<sup>5</sup>. The Assembly also took note of the recommendation recalled in paragraph 12, above.

#### Third Session of the Working Group – January 29 to February 2, 2007

14. At the termination of this session, the Working Group adopted a document containing its conclusion, reading as follows<sup>6</sup>:

“After having explored several options, the Working Group came to the conclusion that the following proposal could be the best possible compromise:

1. The safeguard clause should be amended to the effect of clearly establishing that, in the relationship between countries bound by both the Protocol and the Agreement, the provisions of the Protocol alone shall apply.

2. The amendment should also specify that, notwithstanding the above, a declaration on individual fees by a State party to both the Protocol and the Agreement shall not be applicable to the renewal of an international registration in respect of that State if the territorial extension to that State was effective from a date prior to the amendment and the Contracting Party of the holder in respect of such international registration is party to both treaties.

3. The Assembly would be entitled to repeal the provision indicated under 2, above, only after the expiry of a period of 10 years as from the date of entry into force of the amendment, and by a special three-fourths majority (only States bound by both treaties having the right to vote).

[...]”

15. The document referred to above also contained certain principles concerning the conversion of existing designations governed by the Agreement into designations governed by the Protocol, and identified certain approaches in terms of transitional provisions.

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<sup>4</sup> For the full background to the proposal to amend the Common Regulations so as to establish a full trilingual regime, see document MM/LD/WG/2/4, entitled “The Language Regime Under the Madrid System”.

<sup>5</sup> See document MM/A/37/4, paragraph 13(c)(i).

<sup>6</sup> For the full report of that session, see document MM/LD/WG/3/5.

16. The Working Group requested the International Bureau to prepare draft amendments to Article 9*sexies* and the Common Regulations, reflecting these conclusions.

Fourth Session of the Working Group – May 30 to June 1, 2007

17. For this fourth session, the International Bureau submitted two documents of relevance to the review of the safeguard clause, namely, document MM/LD/WG/4/2, containing the requested draft amendment of Article 9*sexies*, and document MM/LD/WG/4/3, containing, *inter alia*, the requested draft amendments to the Common Regulations.

18. At the conclusion of that session, the Working Group agreed to recommend a new compromise solution with regard to the possible repeal of the safeguard clause, consisting of the following two elements: (1) an amendment to Article 9*sexies* of the Protocol, and (2) an increase in the amount of the complementary and supplementary fees payable under the Madrid system.

19. The delegations from the following States bound by both the Agreement and the Protocol supported this new compromise solution: Austria, Belgium, China, Croatia, Czech Republic, France, Germany, Hungary, Italy, Kenya, Latvia, Moldova, Netherlands, Poland, Portugal, Romania, Russian Federation, Slovakia, Slovenia, Switzerland and The former Yugoslav Republic of Macedonia (21). The Delegations of Cuba and Spain expressed their preference for the original compromise solution adopted at the third session of the Working Group as reflected in document MM/LD/WG/4/2. However, the Delegation of Spain declared that it would not oppose a consensus. The Delegation of Cuba reserved its position. The Delegations of Australia and the United States of America reserved their position on the new compromise solution, to the extent that it was linked to the fee increase indicated in paragraph 18.

20. Regarding the first element of the compromise solution, the Working Group more precisely agreed that:

– Paragraph (1)(a) of draft amended Article 9*sexies*, should read as set forth in the Annex to document MM/LD/WG/4/2, subject only to the replacement of the words “Contracting Parties” by the words “States party”.

– Paragraph (1)(b) should include a reference to Article 5(2)(b) and Article 5(2)(c), dealing with the refusal period, and the revised text of paragraph (1)(b) should read, in its entirety, as follows:

“(b) Notwithstanding subparagraph (a), a declaration made under Article 5(2)(b), Article 5(2)(c) or Article 8(7) of this Protocol, by a State party to both this Protocol and the Madrid (Stockholm) Agreement, shall have no effect in the relations with another State party to both this Protocol and the Madrid (Stockholm) Agreement.”

- Paragraph (2) should be revised to read as follows:

“(2) The Assembly shall, after the expiry of a period of three years from September 1, 2008, review the application of paragraph (1)(b) and may, at any time thereafter, either repeal it or restrict its scope by a three-fourths majority. In the vote of the Assembly, only those States which are party to both the Madrid (Stockholm) Agreement and this Protocol shall have the right to participate.”

21. The Working Group agreed to recommend to the Madrid Union Assembly to amend Article 9*sexies* as indicated in paragraph 20, above, with September 1, 2008, as the proposed date of entry into force.

22. Regarding the second element of the compromise solution, the Working Group, with reservations from the Delegations of Australia and the United States of America, agreed to recommend to the Madrid Union Assembly that the amounts of the supplementary and complementary fees in the Schedule of Fees be set at 100 Swiss francs, along with the amendment of Article 9*sexies* of the Protocol. This increase was supported by the following NGOs: AIM, AROPI, ATRIP, BUSINESSSEUROPE, CEIPI, ECTA, FICPI, GRUR and INTA.

23. The Working Group further agreed to recommend that, in conjunction with the amendment of Article 9*sexies* of the Protocol, the Madrid Union Assembly amend the Common Regulations as follows, with September 1, 2008, as the proposed date of entry into force:

(i) with respect to Rules 1(viii) to (x), 11(1)(b) and (c), 24(1)(b) and, subject to a minor revision, 24(1)(c), as provided in the draft contained in Annex I of document MM/LD/WG/4/3, and

(ii) with respect to Rules 16(1) and 18(2) and the text of items 2.4, 3.3, 3.4, 5.2, 5.3 and 6.2 to 6.4 of the Schedule of Fees, as contained in a paper informally distributed by the International Bureau<sup>7</sup>.

#### Operational Consequences of the Proposed Repeal of the Safeguard clause

24. The proposed repeal of the safeguard clause will, if adopted, entail certain operational consequences for the Offices of States that are bound by both the Agreement and the Protocol, as well as for the International Bureau. These consequences were analyzed in documents MM/LD/WG/2/3 and 4, submitted to the second session of the Working Group in June 2006, and are briefly summarized below.

25. The repeal of the safeguard clause will ensure an overall simplification of the system since, once the remaining few Contracting Parties bound only by the Agreement have joined the Protocol<sup>8</sup>, the system will become governed by only one treaty, namely the Protocol.

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<sup>7</sup> This paper is annexed to the Summary by the Chair, document MM/LD/WG/4/6, which is itself annexed to document MM/A/38/3 submitted to the Assembly.

26. However, to give effect to the proposed amendment, the Offices of States bound by both treaties and the International Bureau will need, as a first step, to adapt their procedures and automated systems. It is against this background that the Working Group proposed September 1, 2008, as the date of entry into force of the proposed amendment to Article 9*sexies* of the Protocol, to give those Offices and the International Bureau enough time to proceed to the necessary adaptations.

*Offices of the Contracting Party of the Holder*

27. In their capacity as Office of the Contracting Party of the holder, the Offices of States bound by both the Agreement and the Protocol will need to adjust their procedures and automated systems so as to provide, where appropriate, for the application of the Protocol, instead of the Agreement, with respect to:

- the required basis when filing an international application,
- the determination of the entitlement to file, and
- the presentation to the International Bureau of certain requests.

*Offices of Designated Contracting Parties*

28. The Offices of States bound by both the Agreement and the Protocol will need to provide for an enlarged scope for the possible application of the transformation procedure under Article 9*quinquies*.

29. In addition, the Offices of States bound by both the Agreement and the Protocol, which have made a declaration under Article 5(2)(b) or (c) of the Protocol (extending the time limit for notification of provisional refusals), will need to put in place a system that will exclude the application of that provision where they are notified of designations governed by the Protocol that are originating from Contracting Parties also bound by both treaties, as such designations are subject to the application of proposed Article 9*sexies*(1)(b).

*The International Bureau*

30. The International Bureau will need to adjust its procedures, automated systems and databases in order to implement amended Article 9*sexies*. Those adjustments will concern, *inter alia*, the information regarding the treaty governing a given designation for the purposes of the issuing of the registration certificate to be given to the holder, publication in the *WIPO Gazette of International Marks* and notification to the Office of each designated Contracting Party. In addition, there will be the need to provide specifically for the handling of designations governed by the Protocol but that are subject to the application of proposed Article 9*sexies*(1)(b).

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<sup>8</sup> At the time of issuance of the present document, only seven Contracting Parties remain bound by the Agreement only, compared to 11 when the Working Group started its preparatory work in July 2005.



31. Finally, the proposed repeal of the safeguard clause will entail important consequences for the International Bureau with respect to the use of languages, as noted in detail in document MM/LD/WG/2/4. In particular, because of the increased application of the Protocol in place of the Agreement, the use of English and Spanish in the international procedure, including publication in the *WIPO Gazette of International Marks*, will become considerably broader than at present. Translation needs will therefore increase.

32. Based on the current forecast of registration activity for the year 2008, it is estimated that, as from September 1, 2008, i.e., date of the proposed entry into force of the amendment of Article 9*sexies*, some 1,500 additional documents concerning international registrations and subsequent designations will require translation into another language each month<sup>9</sup>.

33. The proposed Program and Budget for the 2008/09 biennium, as submitted to the Program and Budget Committee in June 2007, makes provision under Program 18 of the necessary resources to cope with the increased workload that will result for the International Bureau from the proposed repeal of the safeguard clause, if adopted.

*34. The Assembly is invited to note the conclusions and recommendations of the Working Group on the review of the safeguard clause, as well as the operational consequences of the proposed repeal of the safeguard clause for the Offices of States that are bound by both the Agreement and the Protocol and for the International Bureau.*

### III. IMPLEMENTATION OF THE COMPROMISE SOLUTION WITH REGARD TO A REPEAL OF THE SAFEGUARD CLAUSE

#### A) *Amendment of Article 9sexies of the Protocol*

35. The text of the proposed amendment of Article 9*sexies* of the Protocol is contained in Annex I. For ease of reference, the proposed amendment is reproduced in “track changes” mode, i.e., with the text proposed to be deleted, struck through and the text proposed to be added, appearing underlined. For clarity, the final text of Article 9*sexies*, as it would result following the adoption of the proposed amendment, is reproduced in Annex II to the present document.

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<sup>9</sup> The average number of such documents to be translated per month would increase from 5,810 in August 2008 to 7,310 as from September 2008. Based on the current forecast of registration activity for 2009, the average number of such documents to be translated per month in 2009 would be 7,540.

Paragraph (1)(a)

36. This provision would replace existing paragraph (1) of Article 9*sexies*. As proposed, it establishes the principle that the Protocol, and the Protocol alone, will, in all aspects, apply between States bound by both the Agreement and the Protocol. It thus implements a repeal of what was commonly referred to as “the safeguard clause”, as is further reflected in the proposed amendment of the title of Article 9*sexies*. The wording proposed is in line with that of Article 16(1) of the Agreement, dealing with the application of the earlier Acts thereof, as well as that used in similar provisions of other WIPO treaties<sup>10</sup>.

Paragraph (1)(b)

37. As agreed by the Working Group on the occasion of its fourth session, this proposed new paragraph (1)(b) would render inoperative a declaration under Article 5(2)(b), Article 5(2)(c) or Article 8(7) of the Protocol in the mutual relations between States bound by both treaties. As a result, the standard regime of Article 5(2)(a) and of Articles 7(1) and 8(2) would apply between such States, that is, the time limit of one year for the notification of a provisional refusal, and the payment of the supplementary and complementary fees.

Paragraph (2)

38. If amended as proposed, paragraph (2) would make it necessary for the Assembly to review the application of new paragraph (1)(b) after a period of three years from its entry into force. Following this review, the Assembly would then have the power to repeal paragraph (1)(b), or to restrict its scope.

Adoption of the Proposed Amendment

39. As provided for in the last sentence of Article 9*sexies*(2), should the Assembly need to revert to a vote on the issue of the review of the safeguard clause, then, only those States which are party to *both* the Agreement and the Protocol would have the right to participate in that vote. In line with this principle, the proposal to amend Article 9*sexies*, as set out in Annex I, is submitted only to those members of the Madrid Union which are party to both the Agreement and the Protocol.

*40. The Assembly, consisting for this purpose of the States party to both the Agreement and the Protocol, is invited to adopt the amendment of Article 9sexies of the Protocol, as set out in Annex I hereto, effective September 1, 2008.*

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<sup>10</sup> See in particular Article 31(1) of the 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs and Article 27(1) of the Singapore Treaty on the Law of Trademarks. Proposed Paragraph (1), however, uses the term “States” as opposed to “Contracting Parties”, since intergovernmental organizations cannot be party to the Agreement.

*B) Increase in the amount of the complementary and supplementary fees*

41. As recalled in paragraph 22, above, the Working Group agreed to recommend to the Madrid Union Assembly that the amounts of the supplementary and complementary fees in the Schedule of Fees be set at 100 Swiss francs. This proposal for amendment concerns sub-items 1.2 and 1.3 of item 1 of the Schedule of Fees (“*International applications governed exclusively by the Agreement*”), sub-items 2.2 and 2.3 of item 2 (“*International applications governed exclusively by the Protocol*”), sub-items 3.2 and 3.3 of item 3 (“*International applications governed by both the Agreement and the Protocol*”), sub-item 5.2 of item 5 (“*Designation subsequent to international registration*”) and sub-items 6.2 and 6.3 of item 6 (“*Renewal*”).

*42. The Assembly is invited to set the amounts of the supplementary and complementary fees under sub-items 1.2, 1.3, 2.2, 2.3, 3.2, 3.3, 5.2, 6.2 and 6.3 of the Schedule of Fees at 100 Swiss francs, as set out in Annex III, effective September 1, 2008.*

**IV. AMENDMENTS TO THE COMMON REGULATIONS CONSEQUENTIAL, OR RELATING, TO THE IMPLEMENTATION OF THE COMPROMISE SOLUTION**

43. The text of the proposed amendments to the Common Regulations (including to the Schedule of Fees, which forms an integral part thereof) is contained in Annex III. For ease of reference, the proposed amendments are reproduced in “track changes” mode, i.e., with the text proposed to be deleted, struck through and the text proposed to be added, appearing underlined. For clarity, the final text of the provisions is reproduced in Annex IV.

*Rule 1, items (viii) to (x): Abbreviated Expressions*

44. These amendments are proposed as consequential amendments to the amendment of Article 9*sexies* of the Protocol.

45. Should the latter be adopted, the designation of a Contracting Party bound by both treaties would, where the country of origin is also bound by both treaties, be made under the Protocol, as opposed to being made under the Agreement, as at present. The purpose of the proposed amendments to items (viii) to (x) of Rule 1 is therefore to redefine what, consequently, is to be considered an “international application governed exclusively by the Agreement”, an “international application governed exclusively by the Protocol”, and an “international application governed by both the Agreement and the Protocol”<sup>11</sup>.

<sup>11</sup> These abbreviated expressions are used in the following provisions of the Common Regulations:

- item 1(viii): Rule 6(1)(a), 6(2)(a), 6(3)(a), 8(1), 9(4)(b)(iii), 9(5)(a), 10(1) and 11(1)(a);
- item 1(ix): Rule 6(1)(b), 6(2)(b), 6(3)(b), 8(2), 9(4)(b)(iii), 9(5)(b), 10(2) and 11(1)(b);
- item 1(x): Rule 6(1)(b), 6(2)(b), 6(3)(b), 8(1), 9(4)(b)(iii), 9(5)(b), 10(3), 11(1)(b) and (c).

*Rule 6: Languages*

46. These amendments are proposed so as to implement a full trilingual regime under the Madrid system.

47. It is proposed to delete, in Rule 6, all references to international applications governed exclusively by the Agreement, exclusively by the Protocol or by both the Agreement and the Protocol, since there would henceforth be one single (trilingual) language regime for all international applications and, subject to the transitional provisions referred to below, all international registrations.

48. The changes in items (iii) and (iv) of paragraph (2) (former subparagraph (2)(b)) are of a purely editorial nature. They are suggested for the sake of clarity or for syntactical reasons.

49. In paragraph (3)(b) (former subparagraph (3)(c)), the words “under previous versions of this Rule” have been added merely to clarify, for future readers, why international registrations may have been published only in French or only in English and French. In the same paragraph, the last sentence of former subparagraph (3)(c) has been deleted as unnecessary because the change to the trilingual regime of the international registrations concerned will result from the new transitional provisions referred to below (see under Rule 40).

*Rule 9(4)(b)(iii): Contents of the International Application*

50. This amendment is proposed as part of the implementation of a full trilingual regime under the Madrid system.

51. More precisely, the proposed amendment to Rule 9(4)(b)(iii) is consequent on the proposed amendments to Rule 6 since, under the latter, any international application could be filed in any of the three languages (irrespective of the treaty or treaties governing it). It is believed that the proposed amendment is self explanatory.

*Rules 11(1)(b) and (c): Premature Request to the Office of Origin*

52. These amendments are proposed as consequential amendments to the amendment of Article 9*sexies* of the Protocol.

53. It is recalled that one of the fundamental differences between the Agreement and the Protocol is that, under the former, an international application needs to be based on a registration. Thus, if in an international application based on a mere application, a Contracting Party is designated under the Agreement, the request to present this international application to the International Bureau is to be considered premature and the Office of Origin should handle that international application as provided for under paragraph (1) of Rule 11.

54. Should the amendment of Article 9*sexies* be adopted, the designation of a Contracting Party bound by both treaties would, where the country of origin is also bound by both treaties, be made under the Protocol, as opposed to being made under the Agreement, as at present. Such a designation could thus be made before the basic mark is registered, without the request to present the international application being considered premature. As a consequence, Rules 11(1)(b) and (c) would no longer need to encompass the case of such a designation.

55. Rules 11(1)(b) and (c), as proposed to be amended, would thus only take into account the case of the designations of a State that is party *only* to the Agreement.

*Rule 16(1): Information Relating to Possible Oppositions*

56. This amendment is proposed for the sake of clarity, in order to avoid an apparent conflict with proposed new Article 9*sexies*(1)(b) of the Protocol.

57. Rule 16(1) provides that where the combined declarations under Articles 5(2)(b) and 5(2)(c) of the Protocol have been made by a Contracting Party, the Office of that Contracting Party must, within the 18-month time limit, provide information relating to possible oppositions taking place beyond this 18-month time limit. However, under Article 9*sexies* as proposed to be amended, there would be situations where the Office of such a Contracting Party would still have to comply with the standard time limit of one year to notify a provisional refusal, even though that Contracting Party is designated under the Protocol. The proposed addition of the words “Subject to Article 9*sexies*(1)(b) of the Protocol”, in Rule 16, aims at acknowledging this situation.

*Rule 18(2): Irregular Notifications of Provisional Refusal – Contracting Party Designated Under the Protocol*

58. This amendment is proposed for the sake of clarity, in order to avoid an apparent conflict with proposed new Article 9*sexies*(1)(b) of the Protocol, which would, of course, prevail. It is believed that the proposed amendment is self explanatory.

*Rule 24(1)(b) and (c): Designation Subsequent to the International Registration – Entitlement*

59. These amendments are proposed as consequential amendments to the amendment of Article 9*sexies* of the Protocol.

60. Rule 24(1) deals with the entitlement to make a subsequent designation, and it does so by specifying under what treaty a holder is allowed to designate a Contracting Party, depending on whether the Contracting Party of the holder and the designated Contracting Party are linked by a single common treaty or two common treaties.

61. Should the amendment of Article 9*sexies* be adopted, the designation of a Contracting Party bound by both treaties would, where the country of origin is also bound by both treaties, be made under the Protocol, as opposed to being made under the Agreement, as at present. As a consequence, subparagraph (b) of Rule 24(1) needs to be amended to specify that a subsequent designation will be made under the Agreement only if the Protocol *is not* a common treaty between the Contracting Party of the holder and the designated Contracting Party. Subparagraph (c) of Rule 24(1) also needs to be amended to specify that a subsequent designation will be made under the Protocol in all situations where the Protocol is a common treaty between the Contracting Party of the holder and the designated Contracting Party.

*Rule 40(4): Transitional Provisions Concerning Languages*

62. These amendments are proposed as part of the implementation of a full trilingual regime under the Madrid system.

63. As a consequence of the proposed amendments to Rule 6, an additional transitional provision would be required for the purposes of maintaining the monolingual regime for international registrations resulting from international applications governed exclusively by the Agreement filed between April 1, 2004, and August 31, 2008 (that is, the day before the proposed date of entry into force of Rule 40(4) as amended), inclusively, to the extent, of course, that such international registrations have not, in the meantime, moved to the trilingual regime as a result of a subsequent designation under the Protocol.

64. Besides, whereas under Rule 6 as it currently stands, only subsequent designations made under the Protocol trigger a change to the trilingual regime, under Rule 6, as proposed to be amended, *any* subsequent designation would trigger that change. As a result, Rule 40(4) had to be restructured and substantially reworded for the sake of clarity.

*Text of sub-items 2.4, 3.3, 3.4, 5.2, 5.3 and 6.2 to 6.4 of the Schedule of Fees*

65. These amendments are proposed as consequential amendments to the amendment of Article 9*sexies* of the Protocol.

66. Should the proposed new subparagraph (1)(a) of Article 9*sexies* be adopted, the designation of a Contracting Party bound by both treaties would, where the country of origin is also bound by both treaties, be made under the Protocol, as opposed to being made under the Agreement, as at present. As a result, when that Contracting Party has made the declaration relating to individual fees under Article 8(7)(a), its initial designation and the renewal of that designation should entail the payment of those individual fees. However, as indicated in paragraph 37, above, proposed new subparagraph (1)(b) of Article 9*sexies* would, precisely, preserve the application of the complementary fees in such situations.

67. The proposed amendment to the text of sub-items 2.4, 5.3 and 6.4 aims at reflecting the effect of proposed new subparagraph (1)(b) of Article 9*sexies*. It follows the language already found in sub-item 3.4 and is believed to be self explanatory. The proposed amendments to the text of sub-items 3.3, 5.2, 6.2 and 6.3 are suggested for the sake of clarity, with a further proposed amendment of a purely editorial nature to the text of sub-item 5.2. Finally, the proposed amendment to the text of sub-item 3.4 is also of a purely editorial nature<sup>12</sup>.

*68. The Assembly is invited to adopt the amendment of Rules 1(viii) to (x), 6, 9(4)(b)(iii), 11(1)(b) and (c), 16(1), 18(2), 24(1)(b) and (c), and 40(4), and of the text of sub-items 2.4, 3.3, 3.4, 5.2, 5.3 and 6.2 to 6.4 of the Schedule of Fees, as set out in Annex III, effective September 1, 2008.*

[Annexes follow]

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<sup>12</sup> Further amendments of a purely editorial nature but that are specific to the French or the Spanish versions only of the Schedule of Fees are also set out in Annex III of these language versions of the present document.

**Protocol Relating to  
the Madrid Agreement Concerning  
the International Registration  
of Marks**

adopted at Madrid on June 27, 1989,  
as amended on October 3, 2006  
[and on October 3, 2007]

[...]

**Article 9<sup>sexies</sup>**

**Safeguard of Relations Between States Party to both this Protocol  
and the Madrid (Stockholm) Agreement**

(1) ~~(a) Where, with regard to a given international application or a given international registration, the Office of origin is the Office of a State that is party to both this Protocol and the Madrid (Stockholm) Agreement, the provisions of this Protocol shall have no effect in the territory of any other State that is also party~~ This Protocol alone shall be applicable as regards the mutual relations of States party to both this Protocol and the Madrid (Stockholm) Agreement.

(b) Notwithstanding subparagraph (a), a declaration made under Article 5(2)(b), Article 5(2)(c) or Article 8(7) of this Protocol, by a State party to both this Protocol and the Madrid (Stockholm) Agreement, shall have no effect in the relations with another State party to both this Protocol and the Madrid (Stockholm) Agreement.

(2) The Assembly ~~may, by a three-fourths majority, repeal paragraph (1), or restrict the scope of paragraph (1), shall,~~ after the expiry of a period of ~~ten~~ three years from September 1, 2008, ~~the entry into force of this Protocol, but not before the expiry of a period of five years from the date on which the majority of the countries party to the Madrid (Stockholm) Agreement have become party to this Protocol~~ review the application of paragraph (1)(b) and may, at any time thereafter, either repeal it or restrict its scope, by a three-fourths majority. In the vote of the Assembly, only those States which are party to both the Madrid (Stockholm) ~~said~~ Agreement and this Protocol shall have the right to participate.

[Annex II follows]



**Protocol Relating to  
the Madrid Agreement Concerning  
the International Registration  
of Marks**

adopted at Madrid on June 27, 1989,  
as amended on October 3, 2006  
[and on October 3, 2007]

[...]

**Article 9*sexies***

**Relations Between States Party to both this Protocol  
and the Madrid (Stockholm) Agreement**

(1) (a) This Protocol alone shall be applicable as regards the mutual relations of States party to both this Protocol and the Madrid (Stockholm) Agreement.

(b) Notwithstanding subparagraph (a), a declaration made under Article 5(2)(b), Article 5(2)(c) or Article 8(7) of this Protocol, by a State party to both this Protocol and the Madrid (Stockholm) Agreement, shall have no effect in the relations with another State party to both this Protocol and the Madrid (Stockholm) Agreement.

(2) The Assembly shall, after the expiry of a period of three years from September 1, 2008, review the application of paragraph (1)(b) and may, at any time thereafter, either repeal it or restrict its scope, by a three-fourths majority. In the vote of the Assembly, only those States which are party to both the Madrid (Stockholm) Agreement and this Protocol shall have the right to participate.

[Annex III follows]

COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE  
INTERNATIONAL REGISTRATION OF  
MARKS AND THE PROTOCOL RELATING  
TO THAT AGREEMENT

(as in force on ~~January~~September 1, 2008)

**Chapter 1**  
**General Provisions**

*Rule 1*  
*Abbreviated Expressions*

For the purposes of these Regulations,

[...]

(viii) “international application governed exclusively by the Agreement” means an international application whose Office of origin is the Office

- of a State bound by the Agreement but not by the Protocol, or
- of a State bound by both the Agreement and the Protocol, where ~~all the only~~ States are designated in the international application and all the designated States are bound by the Agreement but not (~~whether or not those States are also bound~~) by the Protocol;

(ix) “international application governed exclusively by the Protocol” means an international application whose Office of origin is the Office

- of a State bound by the Protocol but not by the Agreement, or
- of a Contracting Organization, or
- of a State bound by both the Agreement and the Protocol, where the international application does not contain the designation of any State bound by the Agreement but not by the Protocol;

(x) “international application governed by both the Agreement and the Protocol” means an international application whose Office of origin is the Office of a State bound by both the Agreement and the Protocol and which is based on a registration and contains the designations

- of at least one State bound by the Agreement but not (~~whether or not that State is also bound~~) by the Protocol), and
- of at least one State bound by the Protocol ~~but not~~, whether or not that State is also bound by the Agreement or of at least one Contracting Organization;

[...]

*Rule 6*  
*Languages*

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

~~———— (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.~~

(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 subparagraph (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 an 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 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~~ all such notifications are to be in English, or are to be in French or are to be in Spanish; where the notification addressed by the International Bureau concerns the recording in the International Register of an international registration, the notification 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 be in French or be in Spanish.

(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 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~~ the 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.~~

(e)(b) Where a first subsequent designation is made ~~under the Protocol~~ in respect of an international registration that, under previous versions of this Rule, 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.~~

(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.

(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 9*  
*Requirements Concerning the International Application*

[...]

(4) [Contents of the International Application]

[...]

(b) The international application may also contain,

[...]

(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, or in any one or two of those languages;~~

[...]

## **Chapter 2** **International Applications**

### *Rule 11* *Irregularities Other Than Those Concerning* *the Classification of Goods and Services* *or Their Indication*

(1) *[Premature Request to the Office of Origin]* [...]

(b) Subject to subparagraph (c), where the Office of origin receives a request to present to the International Bureau an international application governed by both the Agreement and the Protocol before the mark which is referred to in that request is registered in the register of the said Office, the international application shall be treated as an international application governed exclusively by the Protocol, and the Office of origin shall delete the designation of any Contracting Party bound by the Agreement [but not by the Protocol](#).

(c) Where the request referred to in subparagraph (b) is accompanied by an express request that the international application be treated as an international application governed by both the Agreement and the Protocol once the mark is registered in the register of the Office of origin, the said Office shall not delete the designation of any Contracting Party bound by the Agreement [but not by the Protocol](#) and the request to present the international application shall be deemed to have been received by the said Office, for the purposes of Article 3(4) of the Agreement and Article 3(4) of the Protocol, on the date of the registration of the mark in the register of the said Office.

## **Chapter 4** **Facts in Contracting Parties** **Affecting International Registrations**

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

(1) *[Information Relating to Possible Oppositions]* (a) [Subject to Article 9sexies\(1\)\(b\) of the Protocol](#), ~~w~~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.

[...]

*Rule 18*  
*Irregular Notifications of Provisional Refusal*

[...]

(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) or, subject to Article 9sexies(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol.

[...]

**Chapter 5**  
**Subsequent Designations; Changes**

*Rule 24*  
*Designation Subsequent to the International Registration*

(1) *[Entitlement]* [...]

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

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

[...]

**Chapter 9**  
**Miscellaneous**

*Rule 40*  
*Entry into Force; Transitional Provisions*

[...]

(4) *[Transitional Provisions Concerning Languages]* (a) Rule 6 as in force before April 1, 2004, shall continue to apply to any international application filed 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 and to any international application governed exclusively by the Agreement filed between that date and August 31, 2008, inclusively, to any international registration resulting therefrom and to any communication relating thereto and to any communication, recording in the International Register or publication in the Gazette relating to the international registration resulting therefrom. ~~Rule 6 as in force before April 1, 2004 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 that date, provided that the subsequent designation is recorded in the International Register.~~ unless

(i) the international registration has been the subject of a subsequent designation under the Protocol between April 1, 2004, and August 31, 2008; or

(ii) the international registration is the subject of a subsequent designation on or after September 1, 2008; and

(iii) the subsequent designation is recorded in the International Register.

(b) For the purposes of this paragraph, an international application is deemed to be filed on the date on which the request to present the international application to the International Bureau is received, or deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin, and an international registration is deemed to be the subject of a subsequent designation on the date on which the subsequent designation is presented to the International Bureau, if it is presented directly by the holder, or on the date on which the request for presentation of the subsequent designation is filed with the Office of the Contracting Party of the holder if it is presented through the latter.

[...]

#### SCHEDULE OF FEES

(in force on ~~January~~ September 1, 2006~~2008~~)

*Swiss francs*

1. *International applications governed exclusively by the Agreement*

[...]

1.2 Supplementary fee for each class of goods and services beyond three classes (Article 8(2)(b) of the Agreement)

10073

1.3 Complementary fee for the designation of each designated Contracting State (Article 8(2)(c) of the Agreement)

10073

2. *International applications governed exclusively by the Protocol*

[...]

2.2 Supplementary fee for each class of goods and services beyond three classes (Article 8(2)(ii) of the Protocol), except if only Contracting Parties in respect of which individual fees (see 2.4, below) are payable are designated (see Article 8(7)(a)(i) of the Protocol)

10073

2.3 Complementary fee for the designation of each designated Contracting Party (Article 8(2)(iii) of the Protocol), except if the designated Contracting Party is a Contracting Party in respect of which an individual fee is payable (see 2.4, below) (see Article 8(7)(a)(ii) of the Protocol)

10073

2.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned

3. *International applications governed by both the Agreement and the Protocol*

[...]

3.2 Supplementary fee for each class of goods and services beyond three classes

10073

3.3 Complementary fee for the designation of each designated Contracting Party in respect of which ~~no~~-an individual fee is not payable (see 3.4, below)

10073

3.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee is payable (see Article 8(7)(a) of the Protocol), except where the designated ~~State~~ Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a ~~State~~Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned

[...]

5. *Designation subsequent to international registration*

The following fees shall be payable and shall cover the period between the effective date of the designation and the expiry of the then current term of the international registration:

[...]



5.2 Complementary fee for each designated Contracting Party indicated in the same request where an individual fee is not payable in respect of such designated Contracting Party (~~the fee covers the remainder of 10 years~~[see 5.3, below](#)) ~~10073~~

5.3 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) [except where the designated Contracting Party is a State bound \(also\) by the Agreement and the Office of the Contracting Party of the holder is the Office of a State bound \(also\) by the Agreement \(in respect of such a Contracting Party, a complementary fee is payable\)](#): the amount of the individual fee is fixed by each Contracting Party concerned

## 6. *Renewal*

[...]

6.2 Supplementary fee, except if the renewal is made only for designated Contracting Parties in respect of which individual fees are payable ([see 6.4, below](#)) ~~10073~~

6.3 Complementary fee for each designated Contracting Party in respect of which an individual fee is not payable ([see 6.4, below](#)) ~~10073~~

6.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) [except where the designated Contracting Party is a State bound \(also\) by the Agreement and the Office of the Contracting Party of the holder is the Office of a State bound \(also\) by the Agreement \(in respect of such a Contracting Party, a complementary fee is payable\)](#): the amount of the individual fee is fixed by each Contracting Party concerned

[...]

[Annex IV follows]

COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE  
INTERNATIONAL REGISTRATION OF  
MARKS AND THE PROTOCOL RELATING  
TO THAT AGREEMENT

(as in force on September 1, 2008)

**Chapter 1**  
**General Provisions**

*Rule 1*  
*Abbreviated Expressions*

For the purposes of these Regulations,

[...]

- (viii) “international application governed exclusively by the Agreement” means an international application whose Office of origin is the Office
- of a State bound by the Agreement but not by the Protocol, or
  - of a State bound by both the Agreement and the Protocol, where only States are designated in the international application and all the designated States are bound by the Agreement but not by the Protocol;
- (ix) “international application governed exclusively by the Protocol” means an international application whose Office of origin is the Office
- of a State bound by the Protocol but not by the Agreement, or
  - of a Contracting Organization, or
  - of a State bound by both the Agreement and the Protocol, where the international application does not contain the designation of any State bound by the Agreement but not by the Protocol;
- (x) “international application governed by both the Agreement and the Protocol” means an international application whose Office of origin is the Office of a State bound by both the Agreement and the Protocol and which is based on a registration and contains the designations
- of at least one State bound by the Agreement but not by the Protocol, and
  - of at least one State bound by the Protocol, whether or not that State is also bound by the Agreement or of at least one Contracting Organization;

[...]

*Rule 6*  
*Languages*

(1) [*International Application*] The 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 an international registration 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 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 all such notifications are to be in English, or are to be in French or are to be in Spanish; where the notification addressed by the International Bureau concerns the recording in the International Register of an international registration, the notification 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 be in English, or be in French or be in Spanish.

(3) [*Recording and Publication*] (a) The recording in the International Register and the publication in the Gazette of the international registration and of any data to be both recorded and published under these Regulations in respect of the 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.

(b) Where a first subsequent designation is made in respect of an international registration that, under previous versions of this Rule, 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.

(4) [*Translation*] (a) The translations needed for the notifications under paragraph (2)(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 9*  
*Requirements Concerning the International Application*

[...]

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

[...]

(b) The international application may also contain,

[...]

(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 Spanish, or in any one or two of those languages;

[...]

**Chapter 2**  
**International Applications**

*Rule 11*  
*Irregularities Other Than Those Concerning*  
*the Classification of Goods and Services*  
*or Their Indication*

(1) *[Premature Request to the Office of Origin]* [...]

(b) Subject to subparagraph (c), where the Office of origin receives a request to present to the International Bureau an international application governed by both the Agreement and the Protocol before the mark which is referred to in that request is registered in the register of the said Office, the international application shall be treated as an international application governed exclusively by the Protocol, and the Office of origin shall delete the designation of any Contracting Party bound by the Agreement but not by the Protocol.

(c) Where the request referred to in subparagraph (b) is accompanied by an express request that the international application be treated as an international application governed by both the Agreement and the Protocol once the mark is registered in the register of the Office of origin, the said Office shall not delete the designation of any Contracting Party bound by the Agreement but not by the Protocol and the request to present the international application shall be deemed to have been received by the said Office, for the purposes of Article 3(4) of the Agreement and Article 3(4) of the Protocol, on the date of the registration of the mark in the register of the said Office.

**Chapter 4**  
**Facts in Contracting Parties**  
**Affecting International Registrations**

*Rule 16*

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

(1) *[Information Relating to Possible Oppositions]* (a) Subject to Article 9*sexies*(1)(b) of the Protocol, 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.

[...]

*Rule 18*

*Irregular Notifications of Provisional Refusal*

[...]

(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) or, subject to Article 9*sexies*(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol.

[...]

**Chapter 5**  
**Subsequent Designations; Changes**

*Rule 24*

*Designation Subsequent to the International Registration*

(1) *[Entitlement]* [...]

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

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

[...]

## **Chapter 9** **Miscellaneous**

### *Rule 40* *Entry into Force; Transitional Provisions*

[...]

(4) *[Transitional Provisions Concerning Languages]* (a) Rule 6 as in force before April 1, 2004, shall continue to apply to any international application filed before that date and to any international application governed exclusively by the Agreement filed between that date and August 31, 2008, inclusively, to any communication relating thereto and to any communication, recording in the International Register or publication in the Gazette relating to the international registration resulting therefrom, unless

- (i) the international registration has been the subject of a subsequent designation under the Protocol between April 1, 2004, and August 31, 2008; or
- (ii) the international registration is the subject of a subsequent designation on or after September 1, 2008; and
- (iii) the subsequent designation is recorded in the International Register.

(b) For the purposes of this paragraph, an international application is deemed to be filed on the date on which the request to present the international application to the International Bureau is received, or deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin, and an international registration is deemed to be the subject of a subsequent designation on the date on which the subsequent designation is presented to the International Bureau, if it is presented directly by the holder, or on the date on which the request for presentation of the subsequent designation is filed with the Office of the Contracting Party of the holder if it is presented through the latter.

[...]

SCHEDULE OF FEES

(in force on September 1, 2008)

*Swiss francs*

1. *International applications governed exclusively by the Agreement*  
[...]
  - 1.2 Supplementary fee for each class of goods and services beyond three classes (Article 8(2)(b) of the Agreement) 100
  - 1.3 Complementary fee for the designation of each designated Contracting State (Article 8(2)(c) of the Agreement) 100
2. *International applications governed exclusively by the Protocol*  
[...]
  - 2.2 Supplementary fee for each class of goods and services beyond three classes (Article 8(2)(ii) of the Protocol), except if only Contracting Parties in respect of which individual fees (see 2.4, below) are payable are designated (see Article 8(7)(a)(i) of the Protocol) 100
  - 2.3 Complementary fee for the designation of each designated Contracting Party (Article 8(2)(iii) of the Protocol), except if the designated Contracting Party is a Contracting Party in respect of which an individual fee is payable (see 2.4, below) (see Article 8(7)(a)(ii) of the Protocol) 100
  - 2.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned

3. *International applications governed by both the Agreement and the Protocol*

[...]

- |  |     |
|--|-----|
| 3.2 Supplementary fee for each class of goods and services beyond three classes  | 100 |
| 3.3 Complementary fee for the designation of each designated Contracting Party in respect of which an individual fee is not payable (see 3.4, below)   | 100 |
| 3.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee is payable (see Article 8(7)(a) of the Protocol), except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned |     |

[...]

5. *Designation subsequent to international registration*

The following fees shall be payable and shall cover the period between the effective date of the designation and the expiry of the then current term of the international registration:

[...]

- |  |     |
|--|-----|
| 5.2 Complementary fee for each designated Contracting Party indicated in the same request where an individual fee is not payable in respect of such designated Contracting Party (see 5.3, below)  | 100 |
| 5.3 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of the Contracting Party of the holder is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned |     |



6. *Renewal*

[...]

- |  |     |
|--|-----|
| 6.2 Supplementary fee, except if the renewal is made only for designated Contracting Parties in respect of which individual fees are payable (see 6.4, below)  | 100 |
| 6.3 Complementary fee for each designated Contracting Party in respect of which an individual fee is not payable (see 6.4, below)  | 100 |
| 6.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of the Contracting Party of the holder is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned |     |

[...]

[End of Annex IV and of document]