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AD HOC WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

Fourth Session
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AMENDMENT OF THE COMMON REGULATIONS

Document prepared by the International Bureau

I. INTRODUCTION

1. On the occasion of its third session, held in Geneva from January 29 to February 2, 2007, 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") adopted a document containing a proposal for the review of Article 9*sexies* of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks[1], commonly referred to as "the safeguard clause".

[1] Hereinafter referred to as "the Protocol". Similarly, the Madrid Agreement Concerning the International Registration of Marks, and the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, will be hereinafter referred to, respectively, as "the Agreement" and "the Common Regulations".

2. The proposal of the Working Group (hereinafter referred to as "the Proposal") read as follows:

"The Proposal

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)."

3. In relation to the Proposal, the document adopted by the Working Group at the conclusion of its third session also stated the following principles:

"Conversion principles

Principles concerning the conversion of existing designations governed by the Agreement into designations governed by the Protocol:

1. The period of refusal applicable to a recorded designation should not be affected.

2. Converted designations should enjoy the benefit of possible transformation.

Transitional principles

Regarding international applications, subsequent designations and requests for the recording of renunciations and cancellations that are pending on the date of the coming into force of the amendments, it is proposed, for certainty, to provide that their processing continue according to the regime applicable on the date on which these were filed, or are deemed to have been filed."[2]

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[2] For the full report of that session, see document MM/LD/WG/3/5, hereinafter referred to as "the Report".

4. Furthermore, on the occasion of its third session, the Working Group approved a proposal for a new Rule 1*bis* to provide, under certain circumstances, for a change in the treaty applicable to the designation of a Contracting Party bound by both the Agreement and the Protocol[3].

5. The Working Group thus requested the International Bureau to organize a fourth session and, in view of that session, to prepare, in particular, draft amendments to the Common Regulations in order to provide for:

(i) the implementation of the proposed amendment to Article 9*sexies*;

(ii) the addition of a new Rule 1*bis,* as agreed at the third session.

6. Document MM/LD/WG/4/2, which is also submitted to the Working Group in view of this fourth session, recalls the background of the review of the safeguard clause and contains a draft amendment of Article 9*sexies* of the Protocol along the lines of the Proposal. Annex I of the present document contains the text of the draft amendments to the Common Regulations, including to the Schedule of Fees established there under. Notes in support of these draft amendments are provided in the following chapters, arranged in the following order:

- Chapter II: New Rule 1*bis*;

- Chapter III: Consequential amendments to the introduction of new Rule 1*bis* and to the amendment to Article 9*sexies* of the Protocol;

- Chapter IV: Transitional provisions.

7. The conclusions of the Working Group will be reported to the Assembly of the Madrid Union in September 2007 and will serve as a basis for the International Bureau to prepare draft amendments to the Common Regulations for adoption by the Assembly. These amendments will accompany the draft amendment of Article 9*sexies* of the Protocol that the Working Group may wish to recommend, following its consideration of document MM/LD/WG/4/2. In addition, the draft amendments to the Common Regulations relating to the implementation of a full trilingual regime that the Working Group already approved, at its second session, for submission to the Assembly in the framework of the review of the safeguard clause[4] will be formally submitted to the Assembly for its approval. For the sake of convenience, these latter draft amendments are reproduced in Annex II of the present document, together with updated notes.

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[3] This proposal was contained in document MM/LD/WG/3/4.

[4] See paragraph 123 of the Report of the second session of the Working Group, document MM/LD/WG/2/11. The proposal to amend the Common Regulations so as to establish a full trilingual regime was set out in document MM/LD/WG/2/4.

II. NEW RULE 1*BIS*

General considerations relating to proposed new Rule 1*bis*

8. As explained in document MM/LD/WG/3/4, the proposed Rule 1*bis* would apply in the event that a Contracting Party denounces one of the two treaties, in certain cases of change in ownership and, as far as subparagraph (i) of the draft provision is concerned, in case of a repeal of the safeguard clause. As further recalled in that document, the change of the treaty applicable following certain types of change in ownership is already an established practice under the Common Regulations.

9. At present, this practice entails no consequences as to the fees payable with respect to the international application or subsequent designation, the required basis for filing an international application or the determination of the entitlement to file, as these matters are, by definition, already settled with respect to a recorded designation. Neither does it have an impact on the refusal period, even where that period is still running when the change occurs. The only possible implications of this practice thus relate to the fees payable on renewal, the presentation of a request for the recording of a cancellation or a renunciation and the possibility of transformation, that is provided only by the Protocol.

10. Draft Rule 1*bis* contained in Annex I, sets out the conditions under which a designation which, as a matter of principle, is governed by the treaty (Agreement or Protocol) under which it was made (in the international application or subsequent to the international registration) may become governed by the other of the two treaties.

11. The draft contained in Annex I differs slightly from that contained in document MM/LD/WG/3/4. In particular, the suggestions made during the third session of the Working Group have been introduced. However, the operation of the provision is the same, with, in particular, item (i) providing for a change of the treaty governing a designation from the Agreement to the Protocol, and item (ii) providing for a change of the treaty governing a designation from the Protocol to the Agreement.

12. For the understanding of the proposed new Rule, it is necessary to recall that, in the Common Regulations, the term "designation" means *either* the request for extension of protection ("territorial extension"), under the Agreement or the Protocol, *or* such extension as recorded in the International Register[5]. In the proposed new Rule, the term "designation" is used in the second of its two possible meanings. Under items (i) and (ii) of paragraph 1 of that Rule, therefore, the expressions "Contracting Party whose designation is governed by the Agreement" and "Contracting Party whose designation is governed by the Protocol" refer to the treaty which, at any given moment governs the *recorded* designation of a Contracting Party, irrespective of the treaty under which that Contracting Party may have originally been designated[6].

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[5] See Rule 1(xv). Similarly, under Rule 1(xvi), the expression "designated Contracting Party" means either a Contracting Party for which the extension of protection has been requested, under the Agreement or the Protocol, or a Contracting Party in respect of which such extension has been recorded in the International Register.

[6] The fact that the expressions "Contracting Party whose designation is governed by the Agreement" and "Contracting Party whose designation is governed by the Protocol" can only refer to a *recorded* designation follows from the words "with regard to a given international registration" in items (i) and (ii) of paragraph 1 of draft Rule 1*bis*.

13. In order to clearly distinguish the treaty governing a given designation at a given time from the treaty under which the designation was originally made in the international application or subsequent to the international registration, it is proposed to amend the definitions of the expressions “Contracting Party designated under the Agreement” and “Contracting Party designated under the Protocol” which appear in items (xvii) and (xviii) of Rule 1, to the effect that those expressions would refer exclusively to the treaty under which the designation has originally been made. The proposed amendment of items (xvii) and (xviii) of Rule 1 would have the added advantage of reducing to a minimum the need for transitional provisions or other amendments of the Common Regulations to give effect to the “conversion principles” and “transitional principles” under the Proposal.

14. Under draft Rule 1*bis*, the first condition for a change of the applicable treaty to occur in respect of a given recorded designation is that the treaty originally applicable ceases to apply in relations between the Contracting Party of the holder and the designated Contracting Party.

15. The second condition is that, on the date on which the treaty heretofore applicable ceases to apply, both Contracting Parties are bound by the other treaty. It is, however, not necessary that these two Contracting Parties had been already bound by that other treaty on the date of effect of the designation concerned.

16. The change of the applicable treaty takes place at the moment when the above conditions are met. Proposed paragraph (2) ensures that the identity of the treaty governing the designation, as a result of the application of Rule 1*bis* will be reflected in the data accessible to offices and third parties[7].

Considerations specific to the amendment of Article 9*sexies* of the Protocol

17. Should the envisaged amendment of Article 9*sexies* be adopted by the Assembly, designations of States party to both the Agreement and the Protocol recorded in the International Register before the date of effect of this amendment would, where they originate from a State also bound by both treaties, become *on that date* designations under the Protocol, by virtue of item (i) of proposed Rule 1*bis*.

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[7] In the draft contained in document MM/LD/WG/3/4, the words “and the International Register shall contain the indication that the Contracting Party is a Contracting Party designated under the [Protocol/Agreement]” in the last lines of both items (i) and (ii) served that purpose. However, it is now proposed to amend the definitions of these expressions (see below under “Rule 1, items (xvii) to (xviii)”). One should further note that, pursuant to the combined application of Rules 14(2)(v) and 32(1), the first publication of an international registration would always indicate the designation of a given Contracting Party in relation to the treaty under which the territorial extension was requested.

18. Rule 1*bis*(i) would thus become the key implementing provision of the "conversion principles" recalled under paragraph 3, above. In particular, designations concerned by the repeal of the safeguard clause would be capable of transformation under Article 9*quinquies* of the Protocol, as they would then be "governed by the Protocol".

19. Also, and as foreseen in the "conversion principles" recalled under paragraph 3 above, the period of refusal applicable to a recorded designation should not be affected by the repeal of the safeguard clause. As described under paragraph 9, this is already the case under the general practice relating to a change in the applicable treaty following the recording of a change in ownership. The amendments to items (xvii) and (xviii) of Rule 1, proposed below, would now clearly consolidate that practice.

20. However, contrary to the general implications of a change of applicable treaty as described in paragraph 9 above, the repeal of the safeguard clause would entail no change in the fees payable in respect of the renewal of such designations. This results not from Rule 1*bis*(i) itself, but from the proposed amendment to Article 9*sexies*, as described in the Proposal (see document MM/LD/WG/4/2). This principle, however, would require consequential amendments to the Schedule of Fees. A draft amendment to that effect is proposed in Annex I to this document (see paragraph 42, below).

Considerations relating to the date of entry into force of proposed Rule 1*bis*

21. As the primary rationale for the proposed new Rule 1*bis*, document MM/LD/WG/3/4 raised the question of the implications for holders of international registrations in the event that a Contracting Party bound by both treaties were to denounce one of them. In concluding that the adoption of proposed Rule 1*bis* would bring certainty to the system, the Working Group further noted that as Uzbekistan's denunciation of the Agreement will take effect on January 1, 2008, it would be desirable that proposed Rule 1*bis* be in force on that date.

III. CONSEQUENTIAL AMENDMENTS

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

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

23. 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"[8].

Rule 1, items (xvii) to (xviii) (*Abbreviated Expressions*)

24. These amendments are proposed as consequential amendments to the proposal for a new Rule 1*bis*.

25. As mentioned above, pursuant to item (xvi) of Rule 1, the expression "designated Contracting Party" means, for the purpose of the Common Regulations, either a Contracting Party for which territorial extension has been requested or a Contracting Party in respect of which such extension has been recorded in the International Register. The purpose of the proposed amendments to items (xvii) and (xviii) is to make the definitions of "Contracting Party designated under the Agreement" and "Contracting Party designated under the Protocol" refer to the former concept and no longer to the latter[9].

26. As a consequence of the proposed amendments, and as foreseen in the "conversion principles" recalled under paragraph 3 above, the period of refusal applicable to a recorded designation could not be affected by the repeal of the safeguard clause, nor by any other case of change of the applicable treaty under Rule 1*bis*. This would result from the fact that the application of paragraph (1) or of paragraph (2) of Rule 18 (dealing with irregular notifications of provisional refusal) is dependent on the expressions "Contracting Party designated under the Agreement" and "Contracting Party designated under the Protocol".

27. Aside from Rule 18, the only other provisions of the Common Regulations where these expressions are currently used in the sense of a recorded territorial extension are item (xvii*bis*) of Rule 1 and Rule 30(4). A consequential amendment to Rule 30(4) is proposed in Annex I and commented upon further below.

28. Concerning item (xvii*bis*) of Rule 1, the definition of the expression "Contracting Party whose designation is governed by the Agreement" currently makes reference to the situation where a change in ownership has been recorded in the International Register. It is thus too narrow to take into account all the possible circumstances leading to a change of the applicable treaty under proposed new Rule 1*bis*. However, to the extent that the latter proposed provision clearly establishes what should be understood by this expression it is proposed to delete item (xvii*bis*). The sole provision of the Common Regulations where this expression is currently used is Rule 25(1)(c), dealing with requests for the recording of a cancellation and renunciation.

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[8] 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).

[9] These abbreviated expressions are used in the following provisions of the Common Regulations:
- item 1(xvii): Rules 1(xvii*bis*), 10(3), 14(2)(v), 18(1), 24(2)(a)(ii) and 30(4);
- item 1(xviii): Rules 7(2), 10(3), 14(2)(v), 18(2) and 30(4).

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

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

30. 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. 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), which address the handling, by the Office of origin, of a premature request, would no longer need to encompass the case of such a designation.

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

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

32. 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. Subparagraphs (b) and (c) of Rule 24(1), which determine when a subsequent designation is made under the Agreement or is made under the Protocol, therefore require amendment to reflect this fundamental change.

Rule 25(1)(c) (*Presentation of a Request for the Recording of a Cancellation or Renunciation*)

33. This amendment is proposed as a consequential amendment to the proposal for a new Rule 1*bis*.

34. It is recalled that, amongst the several types of change that may be recorded in respect of an international registration, renunciation and cancellation are the only two in respect of which the Agreement and the Protocol provide differently.

35. More precisely, pursuant to Rule 25(1)(c), where a renunciation or a cancellation affects a Contracting Party whose designation is governed by the Agreement, the request must be presented to the International Bureau through the Office of the Contracting Party of the holder. Pursuant to Rule 26(3), when this aforementioned condition is not complied with, the request is not considered as such by the International Bureau. By comparison, where all the designations affected are governed by the Protocol, the request may, at the holder's option, be presented direct to the International Bureau.

36. The effect of the proposed amendment to Rule 25(1)(c) would be that requests that should not be considered as such for the reason indicated in the previous paragraph would not become suddenly admissible following a change of applicable treaty. It is to be further stressed that when Rule 26(3) applies, the defective request may not be corrected: the only solution for the holder is to present a new request in compliance with the requirements of Rule 25(1)(c). Following a change in the treaty applicable from the Agreement to the Protocol, the holder whose request was not considered as such because it did not comply with the requirements of Rule 25(1)(c) would then be in a position to file a new request direct to the International Bureau.

37. The greatest interest of the proposed amendment, however, does not relate to the repeal of the safeguard clause but concerns the more ordinary case of a change in ownership entailing a change in the treaty applicable. By focusing on the date of receipt of the request by the International Bureau, the amendment would ensure that a request for the recording of a cancellation or a renunciation presented direct to the International Bureau would not be disregarded simply because, in during its processing, the designation (or one of the designations) affected converted into a designation under the Agreement[10].

Rule 30(4) (*Details Concerning Renewals – Period for Which Renewal Fees are Paid*)

38. This amendment is proposed as a consequential amendment to the proposed amendments to items (xvii) and (xviii) of Rule 1. It substitutes the expressions “Contracting Party whose designation is governed by the [Agreement/Protocol]” for the expressions “Contracting Party designated under the [Agreement/Protocol]” (see also paragraph 12, above).

Items 3.4 and 6.4 of the Schedule of Fees

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

40. 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. As a result, when that Contracting Party has made the declaration relating to individual fees under Article 8(7)(a), its designation in an international application governed by both the Agreement and the Protocol would, without exception, entail the payment of its individual fee. The proposed amendment to sub-item 4 of item 3 of the Schedule of Fees (*International applications governed by both the Agreement and the Protocol*) would reflect that fact.

41. If the proposed amendment of Article 9*sexies* were adopted there would, however, be an important exception to the application of individual fees in relation to renewals, as provided under item 2 of the Proposal. As proposed in document MM/LD/WG/4/2, that exception would be enshrined in a new subparagraph (b) of Article 9*sexies*(1). By introducing a reference to that provision, the proposed amendment to sub-item 4 of item 6 of the Schedule

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[10] Admittedly, such situations would become relatively rare should the safeguard clause be repealed.

of Fees would make it clear that whether or not an individual fee is payable upon renewal would not depend on Article 8(7)(a) alone. Of course, where a declaration under Article 8(7)(a) would not apply by virtue of proposed Article 9*sexies*(1)(b), the standard fee regime would apply and the complementary fee would therefore be payable.

42. One would further note that item 5 of the Schedule of Fees (*Designations subsequent to international registration*) would not appear to necessitate amendment.

IV. TRANSITIONAL PROVISIONS

43. In the context of the Proposal, two different types of situation need to be taken into account: on the one hand, the processing of international applications and subsequent designations which are pending on the date of entry into force of the proposed amendment of Article 9*sexies*; on the other hand, the processing of requests for the recording of renunciations and cancellations that are pending on the date the applicable treaty changes from the Agreement to the Protocol as a result of the entry into force of the proposed amendment of Article 9*sexies*[11].

44. With respect to either of the above, the "Transitional Principles" adopted by the Working Group proposed, for certainty, to provide that their processing continue according to the regime applicable on the relevant date of filing.

45. With respect, more precisely, to pending applications and pending subsequent designations, it follows from the "Transitional Principles" recalled above that any designations effected under the Agreement would have to be processed under that same treaty, up to registration or recordal in the International Register[12]. This would naturally be the case since, as indicated in Chapter II above, the change of applicable treaty would be operated under Rule 1*bis*(1)(i), and that provision only applies to recorded designations. Thus, no transitional provision would be required with respect to the processing of international applications and subsequent designations, as such processing cannot be affected by the entry into force of the proposed amendment of Article 9*sexies*.

46. Regarding fees, one would further note that there would be no exception to the principle described above in case the date of the international registration or of the subsequent designation is affected by an irregularity, with the consequence that it may postdate the date of entry into force of the amendment of Article 9*sexies*. Although this would require some flexibility in the automated programs of the Offices of Contracting Parties, it appears necessary so as to achieve the objective of certainty underlying the "Transitional Principles".

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[11] None of the other types of change affecting an international registration need to be taken into account, as the fact that a designation is under the Agreement or under the Protocol makes no difference in respect of their handling.

[12] This would be necessary to ensure that the Office of the designated Contracting Party receives a notification consistent with the fee and refusal systems applicable to that designation. This would be particularly important where the Contracting Party in question has made declarations under Article 8(7) or 5(2) of the Protocol. It would also ensure that, where such Contracting Party was designated under the Agreement, the fees paid would remain sufficient for the registration procedure to follow its course, notwithstanding the fact that that Contracting Party had made a declaration under Article 8(7) of the Protocol.

Moreover, such situations should be rare[13] and the principle is in line with the rules applicable to the determination of the amount payable in case of a change in the amount of an individual fee[14].

47. With respect to requests for the recording of renunciations and cancellations, if such requests are pending at the time the proposed amendment of Article 9*sexies* enters into force, some of the designations to which they relate may become governed by the Protocol. The amendment to Rule 25(1)(c) proposed in Annex I and commented upon in paragraphs 35 to 38, above, would address, *inter alia*, the need for transitional provisions in that respect.

48. The Working Group is invited to indicate whether it would recommend that:

(i) a proposal to amend the Common Regulations with respect to the addition of a new Rule 1bis and with respect to Rules 1(xvii) to (xviii), 25(1)(c) and 30(4), as provided in the draft contained in Annex I hereto, be submitted to the Assembly of the Madrid Union for adoption, with January 1, 2008, as proposed date of entry into force, and

(ii) in conjunction with the proposal under (i), above, a proposal to amend the Common Regulations with respect to Rules 1(viii) to (x), 11(1)(b) and (c), and 24(1)(b) and (c), and with respect to items 3.4 and 6.4 of the Schedule of Fees, as provided in the draft contained in Annex I hereto, be submitted to the Assembly of the Madrid Union in the framework of the review of the safeguard clause, with a date of entry into force to be determined (see document MM/LD/WG/4/2, paragraph 19).

[Annexes follow]

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13 In 2006, the date of international registration was affected in 0.03% (i.e., 12 out of 37,224) of all registrations recorded that year and the date borne by a subsequent designation was affected in 0.16% (i.e., 18 out of 10,798) of all subsequent designations recorded that year. It needs to be further stressed, moreover, that not all the cases where the date of the international registration or of a subsequent designation is affected would lead to the date being moved to a date subsequent to the date of entry into force of the amendment of Article 9*sexies*.

14 See Rule 34(7)(a) and (b).

ANNEX I

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

(as in force on …………….)

LIST OF RULES

Chapter 1: General Provisions

[…]

Rule 1*bis*: Designations Governed by the Agreement and Designations Governed by the Protocol

[…]

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;

[…]

(xvii) "Contracting Party designated under the Agreement" means a ~~designated~~ Contracting Party for which the extension of protection ("territorial extension") has been requested under Article 3*ter*(1) or (2) of the Agreement ~~has been recorded in the International Register,~~;

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

(xviii) "Contracting Party designated under the Protocol" means a ~~designated~~ Contracting Party for which the extension of protection ("territorial extension") has been requested under Article 3*ter*(1) or (2) of the Protocol ~~has been recorded in the International Register,~~;

[…]

Rule 1bis

Designations Governed by the Agreement and Designations Governed by the Protocol

(1) [General Principle and Exceptions] The designation of a Contracting Party shall be governed by the Agreement or by the Protocol depending on whether the Contracting Party has been designated under the Agreement or under the Protocol. However,

(i) where, with regard to a given international registration, the Agreement ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Agreement, the designation of the latter shall become governed by the Protocol as of the date on which the Agreement so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Protocol, and

(ii) where, with regard to a given international registration, the Protocol ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Protocol, the designation of the latter shall become governed by the Agreement as of the date on which the Protocol so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Agreement.

(2) [Recording] The international Bureau shall record in the International Register an indication of the treaty governing each designation.

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 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 both the said Contracting Parties are also bound by the Agreement.

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

(1) *[Presentation of the Request]* […]

(c) The request for the recording of a renunciation or a cancellation may not be presented directly by the holder where the renunciation or cancellation affects any Contracting Party ~~designated under~~ whose designation is, on the date of receipt of the request by the International Bureau, governed by the Agreement.

[…]

Chapter 6
Renewals

[…]

Rule 30
Details Concerning Renewal

[…]

(4) *[Period for Which Renewal Fees Are Paid]* The fees required for each renewal shall be paid for ten years, irrespective of the fact that the international registration contains, in the list of designated Contracting Parties, only Contracting Parties whose designation is governed by ~~designated under~~ the Agreement, only Contracting Parties whose designation is governed by ~~designated under~~ the Protocol, or both Contracting Parties whose designation is governed by ~~designated under~~ the Agreement and Contracting Parties whose designation is governed by ~~designated under~~ the Protocol. As regards payments under the Agreement, the payment for ten years shall be considered to be a payment for an instalment of ten years.

SCHEDULE OF FEES

(in force on …)

[…]

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

[…]

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 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, a complementary fee is payable)~~: the amount of the individual fee is fixed by each Contracting Party concerned

[…]

6. *Renewal*

[…]

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~~s~~ 8(7)(a) of the Protocol, ~~and~~subject however to Article 9*sexies*(1)(b) thereof~~of the Protocol~~): the amount of the individual fee is fixed by each Contracting Party concerned

[…]

[End of Annex I]

ANNEX II

DRAFT AMENDMENTS TO THE COMMON REGULATIONS
TO INTRODUCE A FULL TRILINGUAL REGIME
AS APPROVED BY THE WORKING GROUP AT ITS SECOND SESSION

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, t~~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.

~~(c)~~(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

(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;

[…]

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 […][15], 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 the international registration has been the subject of a subsequent designation under the Protocol between [April 1, 2004] and […]; or

(i) the international registration is the subject of a subsequent designation on or after **[…]**; and

(ii) 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.

NOTES ON THE PROPOSED AMENDMENTS

Notes on Rule 6

1. All references to international applications governed exclusively by the Agreement, exclusively by the Protocol or by both the Agreement and the Protocol have disappeared, 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.

2. 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.

3. In paragraph (3)(b) (former (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 paragraph (3)(c) has been deleted as unnecessary because the change to the trilingual regime of the international registrations concerned will result from the transitional provisions referred to below.

Note on Rule 9

[15] Day before the date of entry into force of the amendment of Article 9*sexies*.

7. 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.

Notes on Rule 40(4)

4. 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 the day before the 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.

5. 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.

6. The date of entry into force of Rule 40(4) as amended would have to be the same as that of entry into force of the amendment of Article 9*sexies* of the Protocol.

[End of Annexes and of document]