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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**WORKING GROUP ON THE MODIFICATION OF THE COMMON
REGULATIONS UNDER THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF
MARKS AND THE PROTOCOL RELATING TO THAT
AGREEMENT**

Second Session
Geneva, June 11 – 15, 2001

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

(2) NEW AND REVISED PROPOSALS

Document prepared by the International Bureau

Rule 1
Abbreviated Expressions

For the purposes of these Regulations,

.....

(xix) “**notification of provisional refusal**” means a ~~notification-declaration~~ by the Office of a designated Contracting Party, ~~according to~~ **in accordance with** Article 5(1) of the Agreement or Article 5(1) of the Protocol ~~that protection cannot be granted in the said Contracting Party;~~

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

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*Rule 7**Notification Of Certain Special Requirements*

(1) ~~*[Presentation of Subsequent Designations by the Office of Origin]*~~ Where a Contracting Party requires that, where its Office is the Office of origin and the holder's address is in the territory of that Contracting Party, designations made subsequently to the international registration be presented to the International Bureau by the said Office, it shall notify that requirement to the Director General. **[Deleted]**

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

(3) *[Notification]* (a) Any notification referred to in paragraph ~~(1)~~ or (2) may be made at the time of the deposit by the Contracting Party of its instrument of ratification, acceptance or approval of, or accession to, the Protocol, and the effective date of the notification shall be the same as the date of entry into force of the Protocol with respect to the Contracting Party having made the notification. The notification may also be made later, in which case the notification shall have effect three months after its receipt by the Director General, or at any later date indicated in the notification, in respect of any international registration whose date is the same as or is later than the effective date of the notification.

(b) **Any notification made under paragraph (1), as in force before [date], shall be withdrawn by, at the latest, [date].** Any notification made under paragraph ~~(1)~~ or (2) may be withdrawn at any time. The notice of withdrawal shall be addressed to the Director General. The withdrawal shall have effect upon receipt of the notice of withdrawal by the Director General or at any later date indicated in the notice.

Rule 9

Requirements Concerning the International Application

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

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

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

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(b) The international application may also contain,

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(v) where the applicant wishes to disclaim protection for a non-distinctive element of the mark, an indication of that fact and of the element for which protection is disclaimed.

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

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

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

*Rule 16**Time Limit for **Notifying Provisional Refusal** ~~in Case of~~ **Based on an Opposition***

(1) [*Information Relating to Possible Oppositions*] (a) Where a declaration has been made by a Contracting Party pursuant to Article 5(2)(b) and (c), first sentence, of the Protocol, the Office of that Contracting Party shall, where ~~applicable~~ **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 ~~the that~~ international registration ~~in respect of which oppositions may be filed after the expiry of the 18-month time limit referred to in Article 5(2)(b) of the Protocol~~.

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

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

(2) [*Recordal and Transmittal of the Information*] The International Bureau shall record in the International Register the information received under paragraph (1); and shall transmit that information ~~to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such information, and, at the same time,~~ to the holder.

Rule 17

Notification of Provisional Refusal and Statement of Grant of Protection

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

(b) A ~~The~~ notification of **any provisional** refusal ~~of protection under Article 5 of the Agreement and Article 5 of the Protocol~~ shall relate to one international registration, shall be dated and shall be signed by the Office making ~~it~~ **the notification**.

(2) [~~Content of the Notification Refusals Not Based on an Opposition~~] ~~Where the A~~ notification of **provisional** refusal ~~of protection is not based on an opposition, the notification referred to in paragraph (1)~~ shall contain or indicate

(i) the Office making the notification,

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

(iii) [Deleted]

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

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

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

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

~~————(viii) the date on which the refusal was pronounced.~~

(3) [*Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition*] Where the **provisional** refusal of protection is based on an opposition, or on an opposition and other grounds, the notification ~~referred to in paragraph (1)~~ shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name and address of the opponent; however, notwithstanding paragraph (2)(v), the Office **making the notification** ~~communicating the refusal~~ must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.

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

~~————(b) Where the notification of refusal under paragraphs (2) or (3) indicates that the refusal may be subject to review or appeal, the Office that communicated the refusal~~

~~————(i) shall, where a request for review or an appeal has been lodged, or where the applicable time limit has expired without a request for review or an appeal having been lodged, and the said Office is aware thereof, inform the International Bureau of that fact in a way agreed upon between the International Bureau and that Office;~~

~~————(ii) shall, where it has informed the International Bureau that a request for review or an appeal has been lodged or where a request for review or an appeal has been lodged without the International Bureau having been informed accordingly, notify the International Bureau as soon as possible of the final decision taken on the review or appeal or, where the request for review or the appeal has been withdrawn, inform as soon as possible the International Bureau of that withdrawal.~~

~~————(c) The International Bureau shall record in the International Register the relevant facts and data referred to in subparagraph (b) of which it has been informed.~~

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

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

¹ These words will be deleted if alternative B for Rule 18(1)(c) to (e) is chosen.

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

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

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

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

~~——(5) [Transmittal of Copies of Notifications] The International Bureau shall transmit copies of notifications received under paragraphs (2) to (4) to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies, and, at the same time, to the holder.~~

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

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

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

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

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

Rule 18

*Irregular **Notifications of Provisional Refusals***

(1) [Contracting Party Designated Under the Agreement] (a) ~~In the case of a A notification of provisional refusal communicated by the Office of concerning the effect of the international registration in~~ a Contracting Party designated under the Agreement, ~~the notification of refusal~~ shall not be regarded as such by the International Bureau

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

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

(iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of one year from the date on which the recordal of the international registration or the recordal of the designation made subsequently to the international registration has been effected, it being understood that the said date is the same as the date of sending the notification of the international registration or of the designation made subsequently. ~~In the case of a notification of refusal sent through a postal service, the date of dispatch shall be determined by the postmark. If the postmark is illegible or missing, the International Bureau shall treat such notification as if it was sent 20 days before the date of its receipt by the International Bureau. However, if the date of dispatch thus determined is earlier than the date on which the refusal was pronounced, the International Bureau shall treat such notification as if it had been sent on the latter date. In the case of a notification of refusal sent through a delivery service, the date of dispatch shall be determined by the indication given by such delivery service on the basis of the details of the mailing as recorded by it.~~²

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

(c) If the notification ~~of refusal~~

(i) is not signed on behalf of the Office which communicated ~~it the refusal~~, or does not otherwise comply with the requirements of Rule 2(1)(a) or with the requirement applicable under Rule 6(2),

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

²

Transferred to the Administrative Instructions.

- (iii) does not **comply with the requirements of** ~~contain, where the refusal indicates that not all the goods and services are affected, the indication of those goods and services that are affected by the refusal or the indication of those goods and services that are not affected by the refusal~~ (Rule 17(2)(vi)),
- (iv) does not **indicate** ~~contain, where applicable, the indication of~~ the authority **with** ~~to~~ which a request for review, ~~or~~ an appeal **or a response to an opposition may be filed** ~~lies~~ and the applicable time limit, ~~reasonable under the circumstances,~~ for lodging such a request, ~~or~~ appeal **or response** (Rule 17(2)(vii)), **or**
- ~~(v) does not contain the indication of the date on which the refusal was pronounced (Rule 17(2)(viii)), or [Deleted]~~
- (vi) does not contain, where applicable, the name and address of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)),

Alternative A

the International Bureau shall invite the Office which communicated the refusal to ~~rectify its~~ **send a rectified** notification within two months from the invitation. **The International Bureau and** shall transmit to the holder copies of the irregular notification of refusal and of the invitation sent to the Office concerned.

(d) Any rectified notification should indicate a new time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires.

(e) If ~~the notification is so rectified, the~~ a rectified notification is sent within this time limit, it shall be regarded, **for the purposes of Article 5 of the Agreement,** as having been sent to the International Bureau on the date on which the defective notification had been sent to it. The International Bureau shall transmit **a copy** ~~copies~~ of the rectified notification ~~to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies,~~ ~~and~~ to the holder.

(f) If the notification is not so rectified, it shall not be regarded as a notification of refusal. In the latter case, the International Bureau shall inform, at the same time, the holder and the Office that sent the notification that the notification of refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

Alternative B

the International Bureau shall invite the Office which communicated the refusal to ~~rectify its~~ **send a rectified** notification ~~within two months from the invitation. The International Bureau~~ and shall transmit to the holder copies of the irregular notification of refusal and of the invitation sent to the Office concerned.

(d) Any rectified notification should indicate a new time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires.

~~(e) If the notification is so rectified, As soon as it receives~~ the rectified notification, ~~shall be regarded as having been sent to the International Bureau on the date on which the defective notification had been sent to it. The International Bureau shall transmit a copy thereof copies of the rectified notification to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies, and~~ to the holder.

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

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

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

Rule 20

Restriction of the Holder's Right of Disposal

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

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

(c) ~~Such information, if~~ **information, if given in accordance with subparagraph (a) or (b)** shall consist of a summary statement of the main facts concerning the restriction.

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

(3) *[Recordal]* The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform the holder accordingly.

~~— (4) *[Licenses]* The present Rule shall not apply to licenses.~~

Rule 20bis
Licenses

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

(b) The request shall contain or indicate

- (i) the number of the international registration concerned,**
- (ii) the name of the holder,**
- (iii) the name and address of the licensee, given in accordance with the Administrative Instructions,**
- (iv) the designated Contracting Parties with respect to which the license is granted,**
- (v) that the license is granted for all the goods and services, or the goods and services for which the license is granted,**
- (vi) where the license is an exclusive license or a sole license, that fact,**
- (vii) where applicable, the duration of the license.**

(c) The request may also contain or indicate

- [(i) where the licensee is a natural person, the State of which the licensee is a national,]**
- [(ii) where the licensee is a legal entity, the legal nature of that entity and the State and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized,]**
- [(iii) that the license concerns only a part of the territory of a specified designated Contracting Party.]**

(d) The request shall be signed by the holder or by the Office through which it is presented.

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

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request was presented by an Office, that Office, and refund any fees paid,

after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

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

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

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

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

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

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

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

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

(c) The declaration referred to in subparagraph (a) shall be notified to the International Bureau which shall notify accordingly the party (holder or Office) that presented the request to record the license.

(d) Any final decision relating to the declaration referred to in subparagraph (a) above shall be notified to the International Bureau which shall notify accordingly the party (holder or Office) that presented the request to record the license.

(e) The International Bureau shall record in the International Register any declaration referred to in subparagraph (a) and any final decision referred to in subparagraph (d).

(6) *[Declaration that the Recording of a License in the International Register has No Effect in a Contracting Party]* The Office of a Contracting Party may, before the date on which this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, notify the Director General that, according to the law which is applicable in that Contracting Party, the recording of a license in the International Register has no effect in that Contracting Party. Such notification may be withdrawn at any time.

Rule 25

Request for Recordal of a Change or a Cancellation

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

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

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

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

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

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

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

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

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

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Rule 27

*Recordal and Notification of a Change or of a Cancellation;
Declaration That a Change in Ownership **or a Limitation** Has No Effect*

.....

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

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(e) The International Bureau shall record in the International Register any declaration referred to in subparagraph (a) ~~which is not subject to review or appeal~~ or any final decision referred to in subparagraph (d), and, as the case may be, record as a separate international registration that part of the international registration which has been the subject of the said declaration or final decision. ~~The separate international registration shall bear the number of the registration of which a part has been assigned or otherwise transferred, together with a capital letter.~~³

(5) *[Declaration That a Limitation Has No Effect]* (a) The Office of a designated Contracting Party which is notified by the International Bureau of a limitation of the list of goods and services affecting that Contracting Party may declare that the limitation has no effect in the said Contracting Party.

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

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

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

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

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

(c) The declaration referred to in subparagraph (a) shall be notified to the International Bureau which shall notify accordingly the party (holder or Office) that presented the request to record the limitation.

(d) Any final decision relating to the declaration referred to in subparagraph (a) above shall be notified to the International Bureau which shall notify accordingly the party (holder or Office) that presented the request to record the limitation.

(e) The International Bureau shall record in the International Register any declaration referred to in subparagraph (a) and any final decision referred to in subparagraph (d).

³ This sentence transferred to the Administrative Instructions.

Rule 28
Corrections in the International Register

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

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

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

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

Rule 32

Gazette

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

(i) international registrations effected under Rule 14;

(ii) information communicated under Rule 16(1);

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

.....

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

.....

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

(i) any notification made under Rule 7 **or Rule 20bis(6)**;

.....

(v) a list of the days on which the International Bureau is not scheduled to be open to the public during the current and the following calendar year ~~and such a list for each Office which has communicated it to the International Bureau.~~

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Rule 34
Amounts and Payment Of Fees

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

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

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

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

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

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

- (i) the number of the international registration concerned,**
- (ii) the name of the holder,**
- (iii) the date by which the second part of the individual fee must be paid,**
- (iv) where the amount of the second part of the individual fee is dependent on the number of classes of goods and services for which the mark is protected in the designated Contracting Party concerned, the number of such classes.**

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

~~(2)~~(4) [*Modes of Payment of Fees to the International Bureau*] ~~The fees indicated in the Schedule of Fees~~ may be paid to the International Bureau

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

~~(3)~~(5) [*Indications Accompanying the Payment*] At the time of the payment of any fee to the International Bureau, an indication must be given,

- (i) before international registration, of the name of the applicant, the mark concerned and the purpose of the payment;
- (ii) after international registration, of the name of the holder, the number of the international registration concerned and the purpose of the payment.

~~(4)~~(6) [*Date of Payment*] (a) Subject to Rule 30(1)(b) and to subparagraph (b), any fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives the required amount.

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

~~(5)~~(7) [*Change in the Amount of the Fees*] (a) Where the amount of the fees payable in respect of the filing of an international application is changed between, on the one hand, the date on which the request to present the international application to the International Bureau is received, or is deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin and, on the other hand, the date of the receipt of the international application by the International Bureau, the fee that was valid on the first date shall be applicable.

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

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

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

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

Rule 38

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

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

SCHEDULE OF FEES

Swiss francs

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7. ~~Change~~ *Miscellaneous recordings*

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**7.5 Recording of a license in respect of an international
registration**

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